

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADAMA MAKHTESHIM LTD.,
Petitioner

v.

FINCHIMICA S.P.A.,
Patent Owner.

Case IPR2016-00577
Patent 8,304,559 B2

Before RICHARD E. SCHAFER, SALLY GARDNER LANE, and
DEBORAH KATZ, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(a)

I. Introduction

In a Decision entered on 24 May 2016, the Board ordered institution of *inter partes* review of claims 1–12 of Patent 8,304,559 ('559) on Petitioner's asserted ground that these claims are unpatentable under 35 U.S.C. § 103(a) as obvious over EP 0295117 B ('EP 117) in view of WO 2007/122440 A1 (Gharda) and further in view of CN 101250158 A (CN '158) for claims 11 and 12 only. (Paper 7, Decision, at 17).

Patent Owner requests "partial rehearing" of the Decision. Patent Owner argues that Decision was incorrect where the Board determined that Petitioner is not estopped from challenging the claims of the '559 patent on grounds 1 and 3 asserted in the Petition. (Paper 9, Request, at 1). Patent Owner does not argue that the Board otherwise erred in determining that there is a reasonable likelihood that Petitioner would prevail.

II. Background

In the Petition, four grounds for challenge of the patentability of the '559 claims were asserted. Grounds 1, 3 and 4 relied upon references that had been raised by Petitioner during the 105,995 interference while ground 2 relied upon a reference that had not been raised during the interference. (Decision at 7-8). (Paper 2, Pet., at 6).

In its Preliminary Response Patent Owner argued that in view of judgment adverse to Petitioner in interference 105,995 Petitioner was estopped under 37 C.F.R. § 41.127(a) from challenging the patentability of the '559 claims on the basis any of the four asserted grounds. (Paper 6, Prel. Resp.). We agreed as to grounds 2 and 4 and no review was instituted on these grounds. (Decision at 13). However, we determined that the Petitioner was not estopped as to grounds 1 and 3. We determined that the Petitioner

properly could not have moved on the issue of whether the '559 claims are patentable over the references cited in grounds 1 and 3 because the Petitioner asked but was not given authorization to file motions asserting unpatentability over these references during the interference. (Decision at 9-12).

III. Discussion

A. *EP '117*

Patent Owner argues that “[t]he Board misapprehended or overlooked that because Grounds 1 and 3 were originally, identified by Petitioner, but **not** included in the grounds for which is ultimately sought leave to file a motion, Petitioner failed to raise an issue that it properly could have raised during the interference.” (Request at 3, original emphasis, citing to Ex 2005 and Patent Owner Preliminary Response, Paper 6, at 17-18). Patent Owner argues that the Petitioner’s abandonment of EP '117 as a basis for alleging unpatentability of the '559 claims does not alter the fact that Patent Owner could have moved for relief and did not do so. (Request at 8).

We do not agree. The record indicates that the Board did not authorize Petitioner’s original request to file motions for unpatentability based on references cited in grounds 1 and 3 which included EP '117. Instead the Board indicated that the motions were not authorized at that time but that Petitioner could renew its request when the interference proceeded to a priority determination. (Interference 105,995, Paper 21 (Ex 1023), Levin Motions List, at 3:3–4:8 and Paper 38 (Ex 1026), Order Setting Times, at 4:12-15). An email communication dated 31 July 2015¹ that is cited in the

¹ An order setting the times for the filing priority motions was entered on 26 June 2015. The email communication was sent prior to the time set for the filing of Petitioner’s priority motion and thus we consider the renewed request to have been made in a timely manner. (Interference 105,995, Paper 146, Order Priority Times).

Request indicates that the Petitioner did in fact timely renew its request to file the originally proposed motions for unpatentability but, in view of Patent Owner's indication that it would oppose the Board's authorization of the filing of these motions, proposed the filing of an additional motion for unpatentability. According to the email Patent Owner indicated that it would not oppose the Board authorizing this additional motion. There is no indication in the email or the Order entered by the Board in view of the email and subsequent call that Petitioner withdrew its original request to file motions for unpatentability based on the references of grounds 1 and 3 including EP '117. (Email (Ex 2005)² and Paper 155 (Ex 1029) Order Authorizing Motion). Instead the email stated that "Levin **also** requests the

² The relevant portion of the email reads:

As directed by the Order dated June 26, 2015, Levin renews its request to file Motions for judgment based on unpatentability of Pastorio involved claims.

Pastorio has indicated that it opposes Levin being authorized to file the three Motions identified as items 4-6 in the Levin Motion List (Paper 21).

In view of Pastorio's opposition, Levin also requests authorization to file a single Motion for judgment based on unpatentability of Pastorio claims which will set forth the following four grounds of unpatentability:

- 1) anticipation by WO 2007/122440 A1 0/110 '440);
- 2) obviousness over WO '440 alone or in view of US 6,013, 761 to Zierer et al. and/or US 3,928,372 to Bochis et al.;
- 3) obviousness over CN 101250158 A in view of WO '440; and
- 4) anticipation by AU 2010100462 A4 (AU 2010100462 A4 is prior art if Pastorio cannot prove its asserted dates of conception and reduction to practice).

Pastorio has indicated that it would consent to Levin being authorized to file a single motion limited to two grounds of unpatentability.

authorization to file a single Motion for judgment based on” additional grounds of unpatentability. (Ex 2005, emphasis added). Thus we are not persuaded that the Petitioner abandoned the issue of patentability of the ’559 claims in view of the EP ’117 reference such that we determine Petitioner properly could have moved but failed to do so.

B. CN ’158

Patent Owner further argues that estoppel should apply to grounds 1 and 3 since Petitioner knew of the CN ’158 reference even before it raised it in the email and subsequent conference call. Patent Owner argues that estoppel applies because Patent Owner could have timely raised the issue of patentability over the reference by including it in its original list. Patent Owner argues that Petitioner is estopped from now raising the issue because it could have “properly, i.e., timely” moved for relief but did not do so. (Request at 11).

We do not agree that Patent Owner properly could have moved for unpatentability of the ’559 claims over the CN ’158 reference during the interference. While Petitioner did not raise the issue of patentability over this reference in its original request, it did so at a time prior to the date set for the filing of its priority motion. As we noted in the Decision “[a]t no time during the interference did the Board include a lack of timeliness as a reason for denying Petitioner authorization to file a motion asserting unpatentability over prior art. (Decision at 12, citing to Interference 105,995, Paper 21 (Ex. 1023), Levin Motions List at 3:3–4:8, Paper 38 (Ex. 1026), Order Setting Times at 4:12-15, and Paper 155 (Ex. 1029), Order Authorizing Motion)).

We are not persuaded that we were incorrect in determining that Petitioner could not have properly moved. We have determined that the issue of unpatentability of the ’559 claims in view of CN ’158 was raised in a timely manner in the 105,995 interference. Because the Board did not

authorize a motion to be filed to address this issue, estoppel under 37 CFR 1.127(a) does not apply.

IV. Order

It is

ORDERED that the Decision instituting review of claims 1-12 of Patent 8,304,559 B2 (Paper 7, Decision) is not modified.

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