

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BORAGEN, INC.,
Petitioner,

v.

SYNGENTA PARTICIPATIONS AG,
Patent Owner.

IPR2020-00124
Patent 10,130,096 B2

Before SHERIDAN K. SNEDDEN, ROBERT A. POLLOCK, and
TIMOTHY G. MAJORS, *Administrative Patent Judges*.

MAJORS, *Administrative Patent Judge*.

DECISION
Denying Petitioner's Request on Rehearing
of Decision Denying Institution of Inter Partes Review
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Boragen, Inc., (“Petitioner”), requests rehearing of our decision (Paper 16, “Decision” or “Dec.”) denying institution of inter partes review of claims 1–12 of U.S. Patent No. 10,130,096 (Ex. 1001, “the ’096 patent”). Paper 17 (“Request” or “Req.”). We deny the Request for the reasons explained below.

II. STANDARD OF REVIEW

In response to a request for rehearing, the panel reviews a decision whether to institute trial for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be found if there was an erroneous interpretation of law, a factual finding not supported by substantial evidence, or an unreasonable judgment in weighing relevant factors. 37 C.F.R. § 42.71(c); *Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *The Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). “The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). The rehearing request “must specifically identify all matters the [requesting] party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

III. OVERVIEW OF PETITIONER’S REQUEST

Petitioner contends that the Board “overlooked or misapprehended key distinctions regarding the evidence” on which the Petition was based. Req. 1. According to Petitioner, the matters overlooked or misapprehended

include the declarations of Drs. Brannen and Hall, and the subject matter of the asserted “Sibley” reference (Ex. 1006). *Id.* at 1, 3–8. Petitioner also contends that, “there were material errors by the Office” in prosecution of the ’096 patent that were “not properly considered by the Board.” *Id.* at 1–2, 8–10 (citing in *Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 10 (Feb. 13, 2020) (precedential) (hereafter “*Advanced Bionics*”)). From this, Petitioner argues “the Board failed to exercise its discretion under 325(d) and improperly concluded that the information presented does not show that there is a reasonable likelihood that Petitioner would prevail in establishing that at least one claim of the ’096 patent is unpatentable.” *Id.* at 2.

IV. ANALYSIS

Petitioner’s argument requesting rehearing is flawed from the outset. Petitioner contends the Board “failed to exercise its discretion under 325(d)” (Req. 2), but this is plainly inconsistent with the Decision, because we *did* exercise discretion under § 325(d) and denied the Petition because it was based on substantially the same prior art as already considered by the Office. *See* Dec. 6–35 (analyzing, *inter alia*, the asserted prior art, the prosecution history, declarant testimony, and the precedential *Becton, Dickinson* factors under a framework explained further in *Advanced Bionics*, in route to denial under § 325(d)).¹ Petitioner continues, arguing the Board “improperly

¹ *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first para) (hereafter “*Becton, Dickinson*”).

concluded” that the Petition “does not show a reasonable likelihood” that any challenged claims are unpatentable. Req. 2. This too is incorrect. We denied the Petition on a discretionary basis, and the Decision does not reach a conclusion on the “reasonable likelihood” issue.

Petitioner’s other contentions fare no better in demonstrating that its Request should be granted. We discuss below.

Petitioner argues the “Board misapprehended the evidence and misapplied its own governing regulations by overlooking or giving no weight to Dr. Brannen’s *unrebutted expert testimony*, which demonstrates that the claims are invalid.” Req. 3 (citing 37 C.F.R. § 42.108(c)).² According to Petitioner, the Board “made no mention of the Brannen Decl. in the decision, much less viewed the [declaration] . . . in the light most favorable to Petitioner.” *Id.* at 4.

This argument is unavailing for at least two reasons. First, that an “expert” may opine on the unpatentability of the challenged claims generally represents one factor that we account for in exercising our discretion under § 325(d) (e.g., insofar as it may comprise “additional evidence” addressing prior art that the Office may have already considered). *Becton, Dickinson* at 17–18. It is not, however, a super-factor that overrides others in the manner urged by Petitioner that would, in effect, require we institute inter partes review so long as the challenge is accompanied by “new” testimony

² In its discussion about Drs. Brannen and Hall (Req. 3–6), Petitioner cites a handful of paragraphs from their declarations, but fails to identify where *in the Petition itself* the allegedly “misapprehended” or “overlooked” subject matter was addressed, as is required by rule. 37 C.F.R. § 42.71(d).

declaring the claims obvious. *Becton, Dickinson* is instructive on this point. In that case, the Board expressly weighed, under factor (f), the testimony of Petitioner’s expert, which “was not [previously] considered by the Examiner,” yet still determined that discretionary denial was warranted. *Id.* at 28 (finding “Mr. Griffis’s declaration does not provide persuasive facts, data, or analysis to support the stated [unpatentability] opinion”).³ Second, Petitioner’s contention that the Board “made no mention” of the Brannen Declaration in our Decision here is not accurate. We noted generally Petitioner’s reliance on Dr. Brannen’s (and Dr. Hall’s) declarations, and we expressly cited numerous paragraphs of the Brannen Declaration—including paragraphs Petitioner argues we overlooked—and we explained that such declaration testimony was only vaguely addressed in the Petition and, in any event, conclusory and unpersuasive on issues such as reasons for combining the asserted prior art. Dec. 6, 19 n.14 (citing Ex. 1018 (Brannen Declaration) ¶¶ 63–65, 82–85).⁴

³ *Becton, Dickinson* was decided pre-*SAS* and, thus, the Board denied some grounds under § 325(d), but instituted on other grounds. *Becton, Dickinson* at 28, 38; *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

⁴ To show consideration of the evidence, it is not necessary that our Decision recite every paragraph of the declaration. *Cf. Plant Genetic Systems, N.V. v. DeKalb Genetics Corp.*, 315 F.3d 1335, 1343 (Fed. Cir. 2003). (“The fact that the district court did not in its opinion recite every piece of evidence does not mean that the evidence was not considered.”); *Medtronic, Inc. v. Daig Corp.*, 789 F.2d 903, 906 (Fed. Cir. 1986) (“We presume that a fact finder reviews all the evidence presented unless he explicitly expresses otherwise.”).

We also do not agree that the Board “misapplied its own governing regulations” under Rule 42.108(c) as asserted by Petitioner. Req. 3; *see also id.* at 6 (raising same argument with respect to the Hall Declaration). In context, the cited rule expressly relates to a petitioner’s institution burden, where the “Board decides” such burden is met—whether the petition shows “that there is a reasonable likelihood that at least one of the claims challenged in the petition is unpatentable.” 37 C.F.R. § 42.108(c) (2019). We did not reach a decision on the “reasonable likelihood” question as already explained, and, in any case, we evaluated the declaration testimony in determining that the Board’s exercise of statutory discretion under § 325(d) was appropriate (e.g., in assessing whether material error was shown). We did not misapply the rule in doing so. Nor does the rule, as Petitioner later argues, “requir[e] factual disputes involving expert testimony *be resolved in favor of institution.*” Req. 6 (emphasis added). The rules do not require or favor institution. Institution is, ultimately, at the Patent Office’s discretion. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

Turning to the Hall Declaration, Petitioner argues “the Board misapprehended the evidence by diminishing Dr. Hall’s *unrebutted expert testimony* as lacking documented support.” Req. 4. Petitioner’s argument that we “misapprehended . . . *by diminishing*” this evidence is not an argument that the Board overlooked or misapprehended anything. *Id.*

(emphasis added). Quite the opposite, this argument goes to the weight we gave the evidence. But the Board is not required to find a parties' argument or evidence persuasive, and the weight we accord evidence does not, as a general matter, support a request for rehearing. Petitioner does not contest our determination that there was no documented factual support in the record to buttress Dr. Hall's bare opinion that certain prior art compounds with a "bulky" substituent would have low antifungal activity. Dec. 31; *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004) ("[T]he Board is entitled to weigh the declarations and conclude that the lack of factual corroboration warrants discounting the opinions expressed in the declarations."); *see also Becton, Dickinson* at 28 (discounting expert opinion that lacked factual support). And, Petitioner's attempt to explain away now (via attorney argument) the record evidence we cited as undermining Dr. Hall's unsupported opinion comes too late and is insufficient. Req. 5–6.

We turn next to the Sibley reference. Petitioner argues the Board "misapprehended the evidence by improperly narrowly interpreting the teachings of Sibley." Req. 7. Here again, this is not an argument that supports the grant of Petitioner's rehearing request. That the Board disagreed with Petitioner's unreasonably broad reading of the reference, for the reasons explained in detail in the Petition (Dec. 22–27), does not show that the Board overlooked or misapprehended the teachings of Sibley. Petitioner's attempt to reargue the same issue fails for the reasons it did initially. Dec. 22–27 (rejecting Petitioner's contention that Sibley teaches that AN2718 had a known utility as an agricultural fungicide).

Petitioner now also contends that “Sibley is not cited for suggesting selection of [AN2718] as the preferred embodiment for use as an agricultural fungicide.” Req. 7 (contending such teaching is supplied by Austin). “Rather,” Petitioner argues, “Sibley is provided to show that a POSITA would have reasonably expected that AN2718 could be used successfully as an agricultural fungicide.” *Id.* at 8 (contending that Sibley “has clearly offered that reasonable expectation [of success]”). This is an apparent change in position, and we did not misapprehend or overlook it because it was not presented in the Petition. The notion that Sibley was not offered by Petitioner in specific “combination” with Austin (or Austin, Kohn), for Sibley’s alleged teaching of use of AN2718 as an agricultural fungicide in order to satisfy the limitations of the claimed method is contradicted, *repeatedly*, by the Petition itself. *See, e.g.*, Pet. 30 (“The combination of Austin and Sibley discloses all the limitations of claims 1-12 Sibley discloses the use of 5-chloro benzoxaborole [i.e., AN2718] as an agricultural fungicide.”); *id.* at 34–41 (claim chart citing Austin and Sibley).

Petitioner, to justify its changed reliance on Sibley, now cites its Petition at page 8. Req. 8. But that page is simply an overview of Sibley, and says nothing about the newly alleged “reasonable expectation” of success evidenced by Sibley in arriving at the method claimed. *Id.*; Pet. 8. And, Petitioner’s new argument is all the more troubling when Petitioner argued previously, in trying to avoid § 325(d) denial, that “[o]f the four grounds presented herein, three rely on new combinations of prior art that were not previously presented to the Examiner.” Pet. 3. The only “new” art asserted in any of the four proposed art combinations is Sibley because

Austin, Kohn, and Baker were before the Examiner during prosecution as we explained in our Decision. Dec. 6–12 (prosecution history summary, 15–22 (explaining that Austin and Kohn were the basis of five obviousness rejections, and that a Baker family member with the same key disclosures as Baker was cited to the Examiner as well)).⁵ Regardless, we are unpersuaded our earlier interpretation of Sibley was incorrect, and we decline to change the Decision based on Petitioner’s attempt to reargue settled issues (or inject new issues it did not argue clearly in the Petition) based on Sibley.

Finally, Petitioner contends that there were material errors by the Office during prosecution of the ’096 patent. Req. 8–10. According to Petitioner, such errors “are apparent based on the statements and references presented in the Petition.” *Id.* (“Accordingly, the Petition identified material errors by the Office under the second prong of *Advanced Bionics*”).

Petitioner’s final argument is unavailing because it fails to identify anything that the Board misapprehended or overlooked in arriving at the Decision. We considered, for example, the extensive prosecution history related to whether the Applicant’s data was sufficiently commensurate in scope with the claims, Petitioner’s argument that the Examiner was misled by the “Zeun Declaration” because it allegedly failed to test structurally closer prior art compounds. *See, e.g.*, Dec. 28–31; *see also id.* at 6–11 (analysis of prosecution history). So too, we considered Dr. Hall’s testimony about the alleged “bulky” groups on some antifungal compounds

⁵ Although Sibley was not officially of record during the ’096 patent’s prosecution, it is cumulative to art before the Examiner during prosecution for reasons explained in our Decision. Dec. 26–27.

and whether that meant the results reported during prosecution would have been expected. *Id.* at 31–32. We need not repeat our analysis applying the precedents of *Becton*, *Dickinson* and *Advanced Bionics*—that too, is detailed in the Decision. *Id.* at 27–35.

Petitioner urges us to reach a different result on the issue of “material error” upon considering this same evidence. But that is not a basis for granting its rehearing request. At bottom, as we explained in the Decision, we were not persuaded that Petitioner’s criticisms of the prosecution record demonstrate an error by the Office that justifies the Office reconsidering in inter partes review the patentability of the same claims over substantially the same prior art. Dec. 15–35. On that, Petitioner’s Request does not change our mind. The discretionary denial under § 325(d) stands.

V. OTHER

Petitioner, in a footnote, points out that *Advanced Bionics* became precedential after the Petition was filed, and requests “additional briefing to directly address the *Advanced Bionics* factors” if this Request is denied. Req. 1 n.1. Petitioner’s request for additional briefing is denied. Additional briefing is unnecessary because the arguments and evidence already submitted by the parties is sufficient for us to make a determination based on the two-part framework in *Advanced Bionics*. Furthermore, we have reviewed the arguments based on *Advanced Bionics* submitted by Petitioner on rehearing and do not find them persuasive. Req. 8–10 (“Petitioner highlights such errors herewith separately under the guidelines set forth in *Advanced Bionics*”). Moreover, *Advanced Bionics* became precedential six weeks before we denied institution in this case, where discretionary denial

under 35 U.S.C. § 325(d) was clearly at issue—an entire section of Patent Owner’s Preliminary Response is devoted to the topic. Paper 15, 54–60. Under such circumstances, Petitioner could have, yet did not, request additional pre-institution briefing to address *Advanced Bionics* if it believed that was prudent. And finally, the “factors” in *Advanced Bionics* come from the Board’s earlier precedential decision in *Becton, Dickinson*. *Becton, Dickinson*, at 17–18. *Advanced Bionics* analyzes the six factors of *Becton, Dickinson* in a two-part framework. *Advanced Bionics* at 9–11 (explaining that “the *Becton, Dickinson* factors[□] provide useful insight into how to apply the framework under 35 U.S.C. § 325(d)”). But the factors of *Becton, Dickinson* remain—indeed, we applied them here in deciding that discretionary denial was justified. Dec. 14–35 (describing and applying “the *Becton, Dickinson* factors”). *Becton, Dickinson* was designated informative in 2018, and precedential in August 2019, well before the present Petition was filed. Yet the Petition neither cites *Becton, Dickinson*, nor addresses explicitly its enumerated factors (e.g., factor (e), “whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted art”). *Becton, Dickinson* at 17–18; *see, e.g.*, Pet. 3–4 (Section titled “Considerations under § 325(d)” with no express factor-based analysis)). As we pointed out, “Petitioner d[id] not expressly assert any ‘error’ by the Office,” (Dec. 27); our Decision is clear, however, that we liberally construed Petitioner’s various criticisms of the prosecution of the ’096 patent as allegations of error in our § 325(d) analysis. *Id.* at 27–35.

VI. CONCLUSION

For the reasons above, we conclude that Petitioner has not shown that we abused our discretion in denying institution under 35 U.S.C. § 325(d). Accordingly, we deny Petitioner's Request.

VII. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Rehearing is *denied*.

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FOR PETITIONER:

Chen Chen
Lauren Krickl
COOLEY LLP
cchen@cooley.com
lkrickl@cooley.com

FOR PATENT OWNER:

James Cueva
james.cueva@syngenta.com

Toni-Junell Herbert
Michael E. Anderson
BAKERHOSTETLER LLP
therbert@bakerlaw.com
meanderson@bakerlaw.com