

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SOLVAY USA INC.,
Petitioner,

v.

WORLDSOURCE ENTERPRISES, LLC, ECO AGRO RESOURCES LLC,
and ECO WORLD GROUP LLC
Patent Owner.

IPR2020-00768
Patent 10,301,231 B2

Before KRISTINA M. KALAN, JEFFREY W. ABRAHAM, and
SHELDON M. McGEE, *Administrative Patent Judges*.

ABRAHAM, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Solvay USA, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–17 of U.S. Patent No. 10,301,231 B2 (Ex. 1001, “the ’231 patent”). WorldSource Enterprises, LLC (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 9¹, “Prelim. Resp.”). After receiving authorization from the Board (Paper 8), Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 10, “Reply”), and Patent Owner filed a Sur-reply (Paper 11, “Sur-reply”).

On September 25, 2020, we issued a Decision instituting an *inter partes* review. Paper 12 (“Decision” or “Dec.”).

Petitioner filed a Request for Rehearing and requested Precedential Opinion Panel (“POP”) review of our Decision. Paper 15 (“Rehearing Request” or “Req. Reh’g”). On December 9, 2020, the Board denied Patent Owner’s request for POP review. Paper 22. For the reasons that follow, Patent Owner’s Rehearing Request is *denied*.

II. STANDARD OF REVIEW

The party challenging a decision in a request for rehearing bears the burden of showing the decision should be modified. 37 C.F.R. § 42.71(d). A request for rehearing “must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed.” 37 C.F.R. § 42.71(d). When rehearing a

¹ Patent Owner originally filed a Preliminary Response (Paper 7) that violated the word count limit in our rules. After conferring with Petitioner and the Board, Patent Owner filed a truncated version of Paper 7 that deletes the text that exceeded the word count limit at the end of the document to comply with 37 C.F.R. § 42.24(b)(1). Paper 9. For purposes of this Decision, any references or citations to the Preliminary Response refer to the truncated document filed as Paper 9.

decision on a petition, the decision will be reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c).

III. BACKGROUND

In the Petition, Petitioner argued claims 1–17 are unpatentable as obvious over the combined teachings of Iannotta² and CN400,³ and the combined teachings of Kolc⁴ and CN400. Pet. 4. Patent Owner argued that we should exercise our discretion under 35 U.S.C. § 325 and deny institution. Prelim. Resp. 22–37. Applying the two-part test set forth in *Advanced Bionics LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”), we determined that (1) the references relied upon were either made of record by the Examiner or provided to the Office on an IDS in the prosecution history of the challenged patent, and (2) Petitioner had shown sufficiently that the Examiner erred in the evaluation of the asserted prior art in a manner material to the patentability of the challenged claims. Dec. 5–9. With regard to Examiner error, we determined that

The record does not reflect any substantive consideration of CN400 during prosecution of the ’231 patent, including any consideration of CN400 in combination with Iannotta or Kolc, as presented in the Petition. As discussed in detail below, Petitioner has identified how CN400 discloses a fertilizer composition including a urease inhibitor and DMSO, which is, as Patent Owner acknowledges, the reason the Examiner “dropped the rejection over Iannotta . . . for all of the rejected claims” during prosecution of the ’231 patent. Prelim. Resp. 26; *see also* Reply at 10 (“The Petition cites CN400 for its teaching of what the Examiner saw as missing from Iannotta, namely, the use of

² US 2013/0145806 A1, published June 13, 2013 (Ex. 1007).

³ CN 101200400 B, Jan. 4, 2012 (Ex. 1018 (native language document); Ex. 1006 (certified translation of Ex. 1018)).

⁴ US 4,530,714, issued July 23, 1985 (Ex. 1009).

DMSO.”). As a result, to the extent Patent Owner is correct that the Examiner was “intimately familiar” with CN400, we determine that the Examiner erred by overlooking the disclosure of a limitation of the claims of the ’231 patent in CN400.

Dec. 9. Accordingly, we declined to exercise our discretion under 35 U.S.C. § 325 not to institute *inter partes* review. Dec. 9. We also determined that Petitioner established a reasonable likelihood of prevailing in its obviousness challenges based on Iannotta and CN400 and Kolc and CN400. Dec. 16–29.

IV. DISCUSSION

Patent Owner contends that we improperly applied 35 U.S.C. § 325(d) in our Decision and that we “adopted Petitioner’s erroneous claim as it relates to the date of” Iannotta because “Petitioner did not evaluate the situation to determine if Iannotta ’806 is proper prior art.” Req. Reh’g 2, 9–10.

1. Whether the Board Improperly Applied 35 U.S.C. § 325(d)

Patent Owner contends that the second part of the *Advanced Bionics* test requires that (1) the burden is on Petitioner to point out sufficiently how the Examiner erred, and (2) the error must be a material error. Req. Reh’g 3. According to Patent Owner, neither of these requirements have been met. Req. Reh’g 3–8.

With regard to whether Petitioner met its burden of showing how the Examiner erred, Patent Owner argues that “[t]here is not one instance” of the word “err” or some variation thereof in the Petition or the Reply addressing the section 325(d) issue. Req. Reh’g 4. Additionally, Patent Owner states that it “can find no instance in either the Petition or in the Reply where Petitioner alleges the Examiner erred in his evaluation of the prior art.” Req. Reh’g 5.

We are not persuaded by Patent Owner's argument. First, Patent Owner does not direct us to any matters that we misapprehended or overlooked, and where those matters were addressed in the Preliminary Response or Sur-reply. Second, Patent Owner does not direct us to any authority indicating that the word "err" or some variation of it must appear in Petitioner's papers. Finally, Patent Owner acknowledges that "[a]n example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims." Req. Reh'g 5 (emphasis omitted) (quoting *Advanced Bionics*, 8). Consistent with this, we determined that Petitioner demonstrated the Examiner erred based on Petitioner's presentation of evidence that CN400 discloses a limitation in the claims of the '231 patent that the Examiner overlooked.

With regard to whether the Examiner committed a material error, Patent Owner first argues that we failed to give any weight to the fact that the same Examiner examined the application leading to the '231 patent and the parent application to which the '231 patent claims priority, and the fact that the Examiner considered Iannotta, Kolc, and CN400 together during prosecution of the parent application. Req. Reh'g 5–6. Patent Owner further states that during prosecution of the parent application, the Examiner "chose not to use the three references together, even though those three references were present in front of him at the same time" and he "knew that CN400 disclosed DMSO." Req. Reh'g 6.

Patent Owner next argues that the Examiner considered CN400 during prosecution of the '231 patent, and that "[t]here is nothing on the record that shows the Examiner had forgotten CN400 disclosed DMSO, so to assert that he overlooked or misapprehended the teaching of CN400 is to ascribe

thoughts to the Examiner that are simply not present on the record.” Req. Reh’g 7. According to Patent Owner, the Examiner did not misapprehend or overlook the teachings of CN400, but “it is more probable that the Examiner believed CN400 could not be properly combined” with Kolc and Iannotta. Req. Reh’g 6–8. Patent Owner further contends that “[w]hen reasonable minds disagree regarding purported treatment of the art, the default position is to deny institution.” Req. Reh’g 8 (citing *Advanced Bionics*, 9).

We are not persuaded by Patent Owner’s arguments. First, Patent Owner does not clearly identify what matters we misapprehended or overlooked, and where those matters were previously addressed. Instead, it simply repeats arguments and information we have already considered and which we used to form the basis for our determination in the Institution Decision. To the extent Patent Owner believes we did not assign the appropriate weight to events that occurred during prosecution of the parent application of the ’231 patent, we note that Patent Owner’s own arguments derived from that information are based on speculation about what is a “more probable” explanation for the Examiner’s conduct. Rather than rely on speculation about the Examiner’s conduct during prosecution of the parent application, we based our determination on facts derived from the prosecution history of the ’231 patent itself. In that regard, we maintain that “[t]he record does not reflect any *substantive consideration* of CN400 *during prosecution of the ’231 patent*, including any consideration of CN400 in combination with Iannotta or Kolc, as presented in the Petition.” Dec. 9 (emphasis added). Nothing in Patent Owner’s recitation of undisputed facts persuasively contradicts this determination. Req. Reh’g 8.

Nor do we consider this to be a situation where “reasonable minds can disagree regarding the purported treatment of the art or arguments.”

Advanced Bionics, 9. On this record, there is no “purported treatment” of CN400 by the Examiner during prosecution of the ’231 patent, and we decline Patent Owner’s invitation to speculate about what the Examiner knew and was thinking during the prosecution of the ’231 patent. Notably, Patent Owner’s criticism of our determination that the Examiner misapprehended or overlooked the teaching of CN400 as “ascrib[ing] thoughts to the Examiner that are simply not present on the record” is inconsistent with its suggestion that we decide whether to institute *inter partes* review based on what Patent Owner considers to be a “more probable” explanation for the Examiner’s action. Req. Reh’g 6–7.

Furthermore, Patent Owner has not directed us to any authority suggesting that we should speculate about a probable explanation for an Examiner’s conduct. Rather, *Advanced Bionics* instructs us that “if the record of the Office’s previous consideration of the art is not well developed or silent, then a petitioner may show the Office erred by overlooking something persuasive.” *Advanced Bionics*, 10. In view of the Examiner’s silence regarding CN400 during prosecution of the ’231 patent itself, we are not persuaded that we abused our discretion in determining that the Examiner erred by overlooking the disclosure of a limitation of the claims of the ’231 patent in CN400.

Nevertheless, even if we were to give weight to Patent Owner’s argument that “it is more probable that the Examiner believed CN400 could not be properly combined” with Kolc and Iannotta, the outcome here would not change. As set forth in our Institution Decision, we disagree with Patent Owner’s assertions that CN400 is non-analogous art that would not be combinable with Kolc and Iannotta. Dec. 19, 24–25. Thus, to the extent Patent Owner contends the Examiner believed CN400 could not be

combined with Kolc and Iannotta for the same reasons Patent Owner presented in its Preliminary Response, we would consider such hypothetical reasoning by the Examiner to involve a misapprehension of the specific teachings of the relevant prior art, which would constitute material error. *See Advanced Bionics*, 8.

For all of the foregoing reasons, we are not persuaded that we misapplied 35 U.S.C. § 325(d).

2. *Whether Iannotta is Prior Art*

Patent Owner contends Petitioner did not properly evaluate whether Iannotta is prior art. Reh’g Req. 10. In presenting its arguments, however, Patent Owner acknowledges “[t]his issue was not argued in the Patent Owner’s Preliminary Response,” and is based on new information Patent Owner became aware of since the filing date of its Sur-reply. Req. Reh’g 9.

A request for rehearing is not an opportunity to present new arguments or evidence. *See* 37 C.F.R. § 42.71(d). Moreover, Patent Owner has not directed us to any matters that we overlooked or misapprehended, and the place where those matters were previously addressed. 37 C.F.R. § 42.71(d).

In view of the foregoing, we are not persuaded that we committed any legal errors regarding the prior art status of Iannotta.

V. CONCLUSION

For all of the foregoing reasons, Patent Owner has not demonstrated that we abused our discretion in instituting an *inter partes* review of claims 1–17 of the ’231 patent.

VI. ORDER

For the reasons given, it is:

ORDERED that Patent Owner’s Request for Rehearing is denied.

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