Trials@uspto.gov
Tel: 571-272-7822

Paper 15
Date: August 31, 2022

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FONTERRA CO-OPERATIVE GROUP LIMITED
and FONTERRA USA INC.,
Petitioner,

v.

ARLA FOODS AMBA,
Patent Owner.

IPR2022-00661
Patent 10,709,146 B2

Before DONNA M. PRAISS, CHRISTOPHER M. KAISER, and JEFFREY W. ABRAHAM, *Administrative Patent Judges.*

PRAISS, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

INTRODUCTION

A. Background

Fonterra Co-operative Group Limited and Fonterra (USA) Inc. ("Petitioner") filed a Petition (Paper 3, "Pet.") requesting an *inter partes* review of claims 1–22 of U.S. Patent No. 10,709,146 B2 (Ex. 1001, "the '146 patent"). Arla Foods amba ("Patent Owner") filed a Preliminary Response. Paper 13 ("Prelim. Resp.").

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a) (2020). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless "there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition."

After considering the Petition, the Preliminary Response, and the evidence of record, we determine that Petitioner has not demonstrated a reasonable likelihood that it would prevail with respect to at least one challenged claim. Accordingly, we do not institute an *inter partes* review of any challenged claim on any asserted ground.

B. Related Matters

Petitioner identifies *inter partes* review proceeding IPR2022-00662 filed simultaneously for United States Patent No. 10,729,150 B2, which discloses overlapping subject matter and shares the same priority date as the '146 patent. Pet. 9. Patent Owner identifies Application 17/812,306 filed on July 13, 2022 for a broadening reissue of the '146 patent. Paper 14, 1.

C. The Asserted Grounds of Unpatentability

Petitioner contends that claims 1–22 of the '146 patent are unpatentable based on the following grounds (Pet. 28–62):[1]

Claim(s) Challenged	35 U.S.C. §[2]	Reference(s)/Basis
1–4, 6–9, 22	102	V Powder[3]
1–4	102	Konrad[4]
1–4	103	V Powder, Havea,[5] POSA,[6] Fanning[7]
5	103	V Powder, Havea, POSA
6–13, 17–21	103	V Powder, Havea, POSA, Konrad
14–16	103	V Powder, Havea, POSA, Konrad, Konkoly[8]

[1] Petitioner also relies on declarations from Dr. E. Allen Foegeding (Ex. 1044) and inventor Esra Cakir Fuller, Ph.D. (Exs. 1046, 1052).

[2] The '146 patent has an effective filing date after March 16, 2013. Ex. 1001 codes (22), (30). Accordingly, patentability is governed by the versions of 35 U.S.C. §§ 102 and 103 as amended by the Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, 125 Stat. 284 (2011).

[3] WO 2013/065014 A1, pub. May 10, 2013 (Ex. 1004). Petitioner refers to this publication by the name "the V Powder Publication" rather than the first named inventor, which we adopt to avoid confusion. Pet. 15.

[4] DE 10 2012 216 990 A1, pub. Mar. 21, 2013 (Ex. 1005). Exhibit 1005 is an English language translation.

[5] WO 2010/120199 A1, pub. Oct. 21, 2010 (Ex. 1006).

[6] Petitioner identifies a person having ordinary skill in the art at the time of the invention (POSA) as "an individual with a Masters or PhD degree in food science or similar study and 3 or more years of industry experience developing whey protein ingredients for use in food products." Pet. 11. Patent Owner does not dispute that definition. Prelim. Resp. 12.

[7] AU 2013101214 A4, pub. Oct. 17, 2013 (Ex. 1008). Petitioner refers to this publication by both of the named inventors ("Fanning & Gregory"). Pet. 23. We follow the convention of using only the first named inventor's surname.

[8] US 2003/0194468 A1, pub. Oct. 16, 2003 (Ex. 1007).

Even though the level of ordinary skill in the art plays a significant role in any obviousness analysis, we include it in the table of challenges because Petitioner separately lists "POSA" as a basis for each of the challenges under 35 U.S.C. § 103. Pet. 35–55; *see Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966) ("Under § 103, the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background, the obviousness or nonobviousness of the subject matter is determined."); *Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) ("[T]he level of skill in the art is a prism or lens through which a judge, jury, or the Board views the prior art and the claimed invention.").

D. The '146 Patent

The '146 patent, titled "CMP[9]-Containing, High Protein Denatured Whey Protein Compositions, Products Containing Them, and Uses Thereof," issued on July 14, 2020. Ex. 1001, codes (45), (54). According to the patent, denatured, microparticulated whey protein concentrates have long been used as a food ingredient, particularly in the production of yoghurt and cheese. *Id.* at 1:28–30. Traditionally these products are produced by heating a whey protein solution having a neutral to acidic pH to a protein denaturing temperature to form a gel that is subjected to high shear conditions to form microparticles than can be converted to a powder by spray-drying. *Id.* at 1:30–36. The '146 patent describes the invention as a denatured whey protein composition having particular ranges of total amount of protein, total

[9] CMP is defined as caseinomacropeptide. Ex. 1001, 4:13, 4:43; Pet. 3; Ex. 1044 ¶ 34.

amount of CMP, and an amount and size of insoluble whey protein particles. *Id.* at 1:53–62.

The '146 patent describes CMP resulting from contacting a milk composition with rennet enzyme, which cleaves kappa-casein into para-kappa-casein and the peptide CMP, causing casein to precipitate; the rennet precipitated casein is referred to as "sweet whey" and contains CMP in addition to the whey proteins normally found in milk. *Id.* at 4:10–17. According to the patent, it was discovered that increasing the amount of CMP to more than 10% CMP relative to the total amount of protein decreases the viscosity of the high protein yoghurt product. *Id.* at 1:63–67, 41:46–50. Specifically, the patent describes the presence of significant amounts of soluble CMP in the denatured whey protein compositions as contributing to the emulsifying properties of the composition without forming a gel, and, therefore, keeping the viscosity of the product low. *Id.* at 5:4–8.

E. Illustrative Claim

Claims 1–22 of the '146 patent are challenged. Claim 1 is the sole independent claim and is illustrative. We reproduce claim 1 below:

> 1. A denatured whey protein composition containing:
>
> a total amount of protein of at least 70% (w/w) on a dry weight basis,
>
> a total amount of CMP of at least 16% (w/w) relative to the total amount of protein,
>
> insoluble whey protein particles having a particle size in the range of 1–10 microns, where the amount of said insoluble whey protein particles is in the range of 50–84% (w/w) relative to the total amount of protein.

Ex. 1001, 45:2–11.

ANALYSIS

A. Claim Construction

Petitioner provides claim interpretations based on descriptions provided in the '146 patent for the following recitations in claim 1: "denatured whey protein composition," "total amount of protein . . . on a dry weight basis," "insoluble whey protein particles," and "acidified dairy product." Pet. 11–12.

Patent Owner does not dispute Petitioner's claim interpretations, but, rather, "applies Petitioner's proposed claim constructions to the claim terms." Prelim. Resp. 12.

Because the "total amount of protein . . . on a dry weight basis" required by claim 1 and taught by the asserted prior art is disputed in the parties' papers, we construe this claim term in order to determine whether or not to institute trial. As Petitioner indicates, the '146 patent states "the term 'total protein' pertains to the total amount of true protein of a composition or product and disregards non-protein nitrogen (NPN)." Ex. 1001, 3:53–56; Pet. 11. The '146 patent also specifies "the term 'dry weight' of a composition or product relates to the weight of the composition or product when it has been dried to a water content of 3% (w/w) water." Ex. 1001, 11:26–29; Pet. 11. These portions of the '146 patent support Petitioner's proposed construction of "total amount of protein . . . on a dry weight basis" as the total weight of true protein disregarding non-protein nitrogen when the composition in question has been dried to 3% (w/w) water. Pet. 11. Accordingly, we adopt Petitioner's construction for purposes of the present decision.

To determine whether or not to institute trial, we need not construe any of the remaining terms for which Petitioner proposes a construction. Accordingly, we do not construe any other term expressly. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) ("we need only construe terms 'that are in controversy, and only to the extent necessary to resolve the controversy'" (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc*., 200 F.3d 795, 803 (Fed. Cir. 1999))).

B. Asserted Anticipation by V Powder

Petitioner argues that V Powder anticipates claims 1–4, 6–9, and 22 of the '146 patent. Pet. 28–32, 42–45. Patent Owner disagrees. Prelim. Resp. 27–47.

Among other limitations, claim 1 of the '146 patent recites "a total amount of protein of at least 70% (w/w) on a dry weight basis." Ex. 1001, 45:3–4. The remaining challenged claims all depend from claim 1. *Id.* at 45:11–21, 45:43–61, 46:66–47:12; *see also* Pet. 7 ("Claims 2–22 depend from claim 1."). Accordingly, all of the challenged claims incorporate the limitations of claim 1. 37 C.F.R. § 1.75(c). Therefore, to show the anticipation of any challenged claim, Petitioner must show that the asserted prior art teaches or suggests "a total amount of protein of at least 70% (w/w) on a dry weight basis."

Petitioner's contention is based on Powder F in V Powder's Table 2, which Petitioner acknowledges does not expressly disclose the total amount of protein of at least 70% on a dry weight basis (or, consequently, the relative amount of CMP protein or the relative amount of protein in insoluble particles). Pet. 28–29. Petitioner supplements V Powder's

disclosure with Fonterra internal test data from 2012 and calculations it asserts a POSA would have used to readily determine Powder F meets claim 1's limitations. *Id.* at 18–19, 28–30; Ex. 1004 ¶¶ 80–95, 105–13. Petitioner's calculations are based on values that are identified as "theoretical" and that rely on a differently defined "dry weight basis." *See* Ex. 1044 ¶ 80 ("theoretical maximum NPN"); *compare* Pet. 11 ("the term 'dry weight' of a composition or product relates to the weight of the composition or product when it has been dried to a water content of 3% (w/w) water."), *with* Pet. 28–29 ("[t]he V Powder Publication taught that 'substantially denatured whey protein . . . is dried to a moisture content of less than 5%.").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *In re Robertson,* 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted); *see PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1195–96 (Fed. Cir. 2014) (inherency "may not be established by probabilities or possibilities."). The proper inquiry for inherent anticipation is whether the claimed limitations "necessarily result" from practicing V Powder. *See, e.g.*, *Allergan, Inc. v. Apotex Inc.*, 754 F.3d 952, 960–61 (Fed. Cir. 2014) (affirming judgment that claims were not inherently anticipated where the prior art only showed that the limitation might occur, not that it inevitably occurred).

Even if a theoretical value is appropriate to establish the claimed limitations "necessarily result" from practicing V Powder, Petitioner has not

established that V Powder discloses a protein amount on a dry weight basis as construed herein. Petitioner argues that "[t]he V Powder Publication taught that 'substantially denatured whey protein . . . is dried to a moisture content of less than 5%'" and that, "[t]hus, the protein content of Powder F was reported 'on a dry weight basis.'" Pet. 28–29 (quoting Ex. 1004, 24:1–2). V Powder does indeed teach that, "[i]n certain embodiments the heat treated, substantially denatured whey protein, for example the WPC or WPI, is dried to a moisture content of less than 5%." Ex. 1004, 24:1–2. Petitioner, however, has not shown sufficiently that a dried to a moisture content of less than 5% necessarily discloses the required dried to a moisture content of 3%. Thus, Petitioner has not established a reasonable likelihood of prevailing in showing V Powder anticipates claims 1–4, 6–9, and 22.

As discussed above, Petitioner argues that the phrase "dry weight basis" in the '146 patent should be interpreted as "relat[ing] to the weight of the composition or product when it has been dried to a water content of 3% (w/w) water." Pet. 11. On the present record, Patent Owner does not dispute this proposed construction, Prelim. Resp. 12, and the construction itself is taken directly from the '146 patent. Ex. 1001, 11:26–29. For these reasons, as discussed above, we construe "dry weight basis" as "relat[ing] to the weight of the composition or product when it has been dried to a water content of 3% (w/w) water." Pet. 11.

Although the '146 patent defines "dry weight basis" as requiring drying "to a water content of 3% (w/w) water," V Powder teaches only drying "to a moisture content of less than 5%." Pet. 11; Ex. 1004, 24:1–2. Petitioner does not explain why the anticipation of a claim requiring a

specific water content of 3% is supported by a reference teaching a much broader range of water contents between 0% and 5%. Pet. 31–32.

Nor is it clear to us why such an anticipation argument should prevail. It is true that a prior art reference disclosing a point within a claimed range anticipates the claimed range. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 782 (Fed. Cir. 1985). However, "[i]f the prior art discloses its own range, rather than a specific point, then the prior art is only anticipatory if it describes the claimed range with sufficient specificity such that a reasonable fact finder could conclude that there is no reasonable difference in how the invention operates over the ranges." *Ineos USA LLC v. Berry Plastics Corp.*, 783 F.3d 865, 869 (Fed. Cir. 2015) (citing *Atofina v. Great Lakes Chemical Corp.*, 441 F.3d 991, 999 (Fed. Cir. 2006) (reversing finding of anticipation where the cited prior art disclosed a substantially different temperature range and the claimed temperature range was critical to the operability of the invention)). As explained in *Atofina*, this is because the disclosure of a genus in the prior art is not necessarily a disclosure of every species that is a member of that genus. *Atofina*, 441 F.3d at 999 (citing *In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994). The disclosure of a very small genus, however, may be a disclosure of each species within the genus. *Id.* (citing *In re Petering*, 301 F.2d 676, 682 (CCPA 1962)); *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246 F.3d 1368, 1380 (Fed. Cir. 2001).

Here the specific water content of the challenged claims (precisely "a water content of 3% (w/w) water") is not a range at all; rather, it is a single, discrete point. A single, discrete point suggests a difference in how the invention operates at another discrete point. A single, discrete point compared to a range disclosed in the cited prior art, thus, presents a situation

more analogous to that in *In re Baird*, in which the prior art taught a wide range of chemical compounds and the claims at issue recited a single compound within that range. 16 F.3d 380, 382 (Fed. Cir. 1994) ("the generic diphenol formula disclosed in [the reference] . . . encompasses more than 100 million different diphenols, only one of which is [the claimed] bisphenol A"). Here, the challenged claims require a specific water content unmodified by "about" or any similar term. Ex. 1001, 11:26–29. There are an enormous, and potentially an infinite, number of such discrete points within the continuous range of 0% to 5% water content taught by V Powder. Under these facts, in the absence of some explanation from Petitioner as to why the conclusion would be warranted, we cannot conclude that V Powder's disclosure supports the asserted anticipation of the challenged claims. The present record provides no such explanation. Accordingly, we are not persuaded that Petitioner has shown sufficiently that V Powder discloses the "dry weight basis" limitation present in all the challenged claims, either expressly or inherently.

C. Asserted Anticipation by Konrad

Petitioner argues that Konrad anticipates claims 1–4 of the '146 patent. Pet. 32–35. Patent Owner disagrees. Prelim. Resp. 47–50.

As noted above, claim 1 of the '146 patent recites "a total amount of protein of at least 70% (w/w) on a dry weight basis." Ex. 1001, 45:3–4. The remaining challenged claims all depend from claim 1. *Id.* at 45:11–22; *see also* Pet. 2 ("Claims 2–22 depend from claim 1."). Accordingly, all of the challenged claims incorporate the limitations of claim 1. 37 C.F.R. § 1.75(c). Therefore, to show the anticipation of any challenged claim, Petitioner must

show that the asserted prior art teaches or suggests "a total amount of protein of at least 70% (w/w) on a dry weight basis."

As discussed above, Petitioner argues that the phrase "dry weight basis" in the '146 patent should be interpreted as "relat[ing] to the weight of the composition or product when it has been dried to a water content of 3% (w/w) water." Pet. 11. On the present record, Patent Owner does not dispute this proposed construction, Prelim. Resp. 12, and the construction itself is taken directly from the '146 patent. Ex. 1001, 11:26–29. For these reasons, as discussed above, we construe "dry weight basis" as "relat[ing] to the weight of the composition or product when it has been dried to a water content of 3% (w/w) water." Pet. 11.

The sum and substance of Petitioner's showing that Konrad discloses a "total amount of protein of at least 70% on a dry weight basis" is quoted below:

> Konrad taught preparation of a whey protein composition having "a protein content in the dry isolate of ≥90 wt.% (*Id.*, ¶ [0052].) Example 2 of Konrad disclosed a dried microparticulate having a protein content of 91.2 wt.%." (*Id.*, ¶ [0056].)

Pet. 32. Konrad does in fact state "[t]he whey protein isolate is characterized by a protein content in the dried isolate of 90% by weight" in paragraph 52 and "[t]he protein content of the dried microparticulate was 91.2% by weight" in paragraph 56. Ex. 1005 ¶¶ 52, 56. Petitioner does not explain why the anticipation of a claim requiring a specific water content of 3% is supported by a prior art reference teaching "dry isolate" or "dried microparticulate" without any indication of a water content. Pet. 32–34. In the absence of such a showing, Konrad fails to disclose each and every

element as set forth in claim 1, either expressly or inherently. *See Verdegaal Bros., Inc.*, 814 F.2d at 631.

Accordingly, Petitioner has not demonstrated a reasonable likelihood of prevailing on anticipation of the challenged claims by Konrad.

D. Asserted Obviousness Based on V Powder

Petitioner argues that claims 1–21 of the '146 patent would have been unpatentable as obvious over the combination of V Powder with various combinations of secondary references. Pet. 35–42, 45–58. Patent Owner disagrees. Prelim. Resp. 50–54. In part, Patent Owner argues that the use of "and/or" to connect the asserted references in the Petition results in "an unexplained, excessive, and unjustified swarm of possible combinations" of references. Prelim. Resp. 50–51. Patent Owner argues that we should deny institution for this reason. *Id.* (citing *Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 (PTAB Mar. 6, 2019) (informative)). As discussed below, we deny institution on the merits of the Petition. Accordingly, we need not decide whether the Petition's use of "and/or" causes it to present such a "voluminous and excessive" number of grounds as to be "unduly burdensome" and to warrant denial of institution. *See Adaptics*, IPR2018-01596, Paper 20 at 18–20.

Among other limitations, claim 1 of the '146 patent recites "a total amount of protein of at least 70% (w/w) on a dry weight basis." Ex. 1001, 45:3–4. The remaining claims challenged under 35 U.S.C. § 103 (claims 2–21) all depend from claim 1. *Id.* at 45:11–46:65; *see also* Pet. 7 ("Claims 2–22 depend from claim 1."). Accordingly, all of the challenged claims incorporate the limitations of claim 1. 37 C.F.R. § 1.75(c). Therefore, to

show the obviousness of any challenged claim, Petitioner must show that the asserted prior art teaches or suggests "a total amount of protein of at least 70% (w/w) on a dry weight basis."

Petitioner relies solely on V Powder for this teaching. Pet. 35 (referring back to Petitioner's anticipation by V Powder argument for the limitations of claim 1), 40, 46,[10]47–58. As discussed above, with respect to the "dry weight basis" portion of this limitation, Petitioner argues that "the protein content of Powder F [of the V Powder Publication] was reported 'on a dry weight basis'" because "[t]he V Powder Publication taught that 'substantially denatured whey protein . . . is dried to a moisture content of less than 5%.'" *Id.* at 28–29 (citing Ex. 1004, 24:1–2). We are not persuaded that this teaching of V Powder shows sufficiently that the protein content disclosed therein is "reported 'on a dry weight basis,'" as Petitioner argues.

As discussed above, Petitioner argues that the phrase "dry weight basis" in the '146 patent should be interpreted as "relat[ing] to the weight of the composition or product when it has been dried to a water content of 3% (w/w) water." *Id.* at 11. On the present record, Patent Owner does not dispute this proposed construction, Prelim. Resp. 12, and the construction itself is taken directly from the '146 patent. Ex. 1001, 11:26–29. For these

[10] For the ground asserting the obviousness of claims 6–9 over the combination of V Powder "and/or Havea in view of the knowledge of a POSA and/or in view of Konrad," Petitioner additionally cites Konrad for "preparation of denatured microparticulated WPCs with at least 90% protein (w/w)" but not "on a dry weight basis." Pet. 46–47 (citing Ex. 1005 ¶¶ 37, 50). The cited portions of Konrad do not indicate any moisture content; Konrad's paragraph 50 merely states "dried by spray drying" and Konrad's paragraph 37 is silent on both moisture content and protein amount. Ex. 1005 ¶¶ 37, 50.

reasons, as discussed above, we construe "dry weight basis" as "relat[ing] to the weight of the composition or product when it has been dried to a water content of 3% (w/w) water." Pet. 11.

Although the '146 patent defines "dry weight basis" as requiring drying "to a water content of 3% (w/w) water," V Powder teaches only drying "to a moisture content of less than 5%." Ex. 1001, 11:26–29; Ex. 1004, 24:1–2. Petitioner does not explain why the obviousness of a claim requiring a specific water content of 3% is supported by a reference teaching a much broader range of water contents between 0% and 5%. Pet. 28–29.

Nor is it clear to us why such an obviousness argument should prevail. It is true that "a prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a *prima facie* case of obviousness." *In re Peterson*, 315 F.3d 1325, 1330 (Fed. Cir. 2003). But the specific water content of the challenged claims (precisely "a water content of 3% (w/w) water") is not a "somewhat narrower claimed range" that is encompassed by the broader range of V Powder. *Id.* It is not a range at all; rather, it is a single, discrete point. This distinguishes the present situation from that in *Peterson*, in which the claims at issue recited ranges formed from single values that were modified in each case by the term "about." *Id.* at 1327 (reciting, e.g., "about 14 percent chromium," "about 9.5 percent cobalt," and "about 3.8 percent tungsten").

Instead, this case presents a situation more analogous to that in *In re Baird*, in which the prior art taught a wide range of chemical compounds and the claims at issue recited a single compound within that range. 16 F.3d 380, 382 (Fed. Cir. 1994) ("the generic diphenol formula disclosed in [the

reference] . . . encompasses more than 100 million different diphenols, only one of which is [the claimed] bisphenol A"). The teaching of a genus by a prior-art reference does not necessarily establish the obviousness of all possible species or subgenera that are encompassed by that genus. *In re Baird*, 16 F.3d at 382. Here, the challenged claims require a specific water content unmodified by "about" or any similar term. Ex. 1001, 13:18–21. There are numerous discrete points within the continuous range of 0% to 5% water content taught by V Powder. Under these facts, in the absence of some explanation from Petitioner as to why the conclusion would be warranted, we cannot conclude that the disclosure in V Powder supports the obviousness of the challenged claims. The present record provides no such explanation. Accordingly, we are not persuaded that Petitioner has shown sufficiently that the prior art teaches or suggests the "dry weight basis" limitation present in all the challenged claims.

Thus, Petitioner has not shown sufficiently that the combination of V Powder with any of the cited secondary prior art references teaches or suggests the recited in the challenged claims. Accordingly, Petitioner has not demonstrated a reasonable likelihood of prevailing on the obviousness of the challenged claims over these combinations of references.

E. Discretionary Denial

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 325(d) to deny institution under *Advanced Bionics, LLC v. MED-EL Elektromedizinische Gerate GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential). Prelim. Resp. 12–26. Patent Owner points out that every one of Petitioner's cited references was considered by

the Examiner and is cited on the '146 patent itself, however, the Petition lacks any showing of material error by the United States Patent and Trademark Office. *Id.* at 14–26. While the Petition additionally includes declarations by Dr. E. Allen Foegeding (Ex. 1044) and inventor Dr. Esra Cakir Fuller (Exs. 1046, 1052), Patent Owner directs us to a declaration in the prosecution history by the same inventor regarding the same reference, V Powder, and the same Table 2. *Compare* Ex. 1046 ¶ 6, *and* Ex. 1052 ¶ 7, *with* Ex. 2001, 1593–94 (calculating protein content of 79.1% (w/w) of Powder A in Table 2 of V Powder). We are inclined to agree with Patent Owner based on these facts and the Petition's silence regarding this clear overlap between the Petition's arguments and the '146 patent's prosecution history. Because we deny institution based on the merits of Petitioner's unpatentability arguments, however, we need not decide whether to exercise discretion to deny institution.

CONCLUSION

Upon consideration of the Petition, the Preliminary Response, and the evidence presented, we determine that Petitioner has not shown a reasonable likelihood that it will prevail in showing that at least one of the challenged claims is unpatentable. Accordingly, we do not institute an *inter partes* review of any challenged claim based on any ground asserted in the Petition.

ORDER

It is hereby

ORDERED that, pursuant to 35 U.S.C. § 314, the Petition is denied, and no *inter partes* review is instituted.

For PETITIONER:

Emer L. Simic
Kevin O'Connor
Thomas McDonough
NEAL, GERBER & EISENBERG LLP
esimic@nge.com
koconnor@nge.com
tmcdonough@nge.com

For PATENT OWNER:

Amy E. Simpson
Andrew T. Dufresne
Courtney M. Prochnow, Ph.D.
PERKINS COIE LLP
simpson-ptab@perkinscoie.com
dufresne-ptab@perkinscoie.com
prochnow-ptab@perkinscoie.com