Paper No. 11

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MOTIF FOODWORKS, INC.,

Petitioner,

v.

IMPOSSIBLE FOODS INC.,
Patent Owner.

U.S. Patent No. 9,943,096

"METHODS AND COMPOSITIONS FOR AFFECTING THE FLAVOR AND AROMA PROFILE OF CONSUMABLES"

Inter Partes Review No. 2023-00206

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION PURSUANT TO 37 C.F.R. § 1.323

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Petitioner respectfully opposes PO's Motion because it fails to show there is a "sufficient basis" that the alleged mistake in priority claim is correctable. To the contrary, PO's proposed "correction" is legally defective because it repeats (and exploits) an existing error in the priority claim where one application is linked to another as a "continuation" despite the two applications having entirely different specifications and figures.

Moreover, during prosecution, PO made a deliberate choice—the opposite of a mistake—to identify the prior-filed applications as being merely "related to" the Challenged Patents instead of claiming "priority to" them under 35 U.S.C. §§119-120, as it did for other patent applications. The timing of PO's attempted "correction"—in an attempt to defeat Petitioner's grounds based on PO's own prior art ("Brown") disclosure—reveals PO's proposed changes are strategic rather than fixing an innocent mistake. PO's 7-year delay in seeking a priority change further reveals that the entire delay in seeking correction was not unintentional. Even if PO supposedly only learned of its "mistake" after Petitioner filed IPRs, PO offers no explanation for why it waited 3.5 months to provide notice or seek correction.

PO's request has serious, unforeseeable consequences for Petitioner—if PO is granted leave and the Board gives retroactive effect to any Certificate of Correction ("CoC") issued by the Director, PO will argue that multiple grounds in the IPRs are obviated. However, Petitioner cannot now pursue different, additional

grounds in this proceeding. And absent Board authorization, Petitioner will not have an opportunity to show that the applications Petitioner now seeks priority to fail to provide written description support for the Challenged Claims.

PO's motion to cede jurisdiction should be denied.

I. THE BOARD SHOULD MAINTAIN EXCLUSIVE JURISDICTION

PO incorrectly contends that the rules only require a motion to cede jurisdiction after trial has been instituted. Mot. 3-5. Notwithstanding PO's misstatement of the law, PO's contention is moot. The Board directed the parties to submit briefing concerning PO's request and PO has now filed its Motion pursuant to § 1.323. Petitioner opposes PO's motion and requests that the Board maintain its exclusive jurisdiction under 37 C.F.R. § 42.3(a) and deny PO's request for leave.

II. NO "SUFFICIENT BASIS" FOR CORRECTION

To prevail on its motion, PO must show that "there is sufficient basis … that the mistake may be correctable." *Honeywell Int'l v. Arkema, Inc.*, 939 F.3d 1345, 1351 (Fed. Cir. 2019). PO cannot do so for multiple reasons.

First, to correct priority via a CoC, it "must be clear from the record of the patent and the parent application(s) that priority is appropriate." MPEP § 1481.03.II.A; *see also* 35 U.S.C. §§ 119(e), 120. As explained below, the proposed change to the priority claim fails to satisfy this standard.

The existing priority claim for the Challenged Patents has a defect that

forecloses the priority claim changes that PO now proposes. Specifically, the challenged ’096 and ’241 patents (“Fraser Patents”) currently claim priority through multiple continuation applications to PCT/US2014/011347 (“PCT ’347”). PCT ’347 is allegedly a ***continuation*** of U.S. application no. 13/941,211 (“’211 App.”). However, PCT ’347 is not actually a continuation of the ’211 App. because they have ***completely different*** specifications and figures. *Compare* EX1160 (PCT ’347) *with* EX1161 (’211). Indeed, a redline comparison illustrates that there is virtually no overlap between these two applications. EX1162 (redline comparison) (non-overlapping text shown in blue/red). The same is true for the challenged ’250 and ’306 patents (“Vrljic Patents”), which currently claim priority to PCT/US2014/011361 (“PCT ’361”) (instead of PCT ’347) as allegedly being a continuation of the ’211 App. Here again, PCT ’361 and the ’211 App. have substantially different specifications and completely different figures. *Compare* EX1163 (PCT ’361) *with* EX1161 (’211); *see also* EX1164 (redline comparison). This contravenes the well-known rule that “[b]y definition, ***a continuation adds no new matter***.” *Applied Materials, Inc. v. Advanced Semiconductor Materials America, Inc.*, 98 F.3d 1563, 1579 (Fed. Cir. 1996)[1]; MPEP § 201.07; *see also Medtronic CoreValve, LLC v. Edwards Lifesciences Corp.*, 741 F.3d 1359, 1363-67

[1] All emphasis added unless otherwise stated herein.

(Fed. Cir. 2014) (rejecting priority claim where intervening applications failed to accurately identify every patent in the chain per 35 U.S.C. § 120).[2]

This underlying defect in the existing priority claims is critical to the Board's determination here because PO seeks to expand on and exploit the defect by further extending the priority claim back from the '211 App. to earlier-filed applications, including to PCT/US2012/46560 ("Brown"), which Petitioner asserts as prior art to the Fraser Patents.[3] PO's proposed changes to the priority claim are improper as a matter of law, *Applied Materials*, 98 F.3d at 157, and demonstrate that the alleged

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[2] The overlap between PCT '347 and the '211 application is so deficient that PCT '347 could not even be properly characterized as a CIP of the '211 application, which would require PCT '347 or PCT '361 to "***repeat[] some [] substantial portion*** or all" of the '211 application. *Litton Sys., Inc. v. Whirlpool Corp.*, 728 F.2d 1423, 1436-37 (Fed. Cir. 1984) (citing MPEP § 211.08). To be clear, PO has *not* asserted a CIP relationship between PCT '347/PCT '361 and the '211 application and instead has repeatedly made clear that it intends to file the same CoC it recently filed in other related patents that rely on the "continuation" designation discussed above.

[3] PO's proposed priority claim changes also include prov. apps. 61/572,205 and 61/671,069, both of which purport to claim priority through the '211 application. Brown and the '069 and '205 applications are the "Prior-filed Applications."

mistake is not correctable.

Second, 35 U.S.C. § 255 allows a patent owner to correct a "mistake" only if it was made in "good faith." In the context of reissue proceedings, the Federal Circuit has distinguished a correctable "mistake" from an uncorrectable "***deliberate***, but subsequently found to be disadvantageous, choice." *In re Serenkin*, 479 F.3d 1359, 1364 (Fed. Cir. 2007); *id.*, 1362-63 ("the deliberate action of an inventor or attorney … generally fails to qualify as a correctable error under § 251").

Here, it is readily apparent that PO deliberately chose not to claim priority to Brown from the outset. In the first paragraph of the Challenged Patents, PO distinguished Brown from other applications it chose to include in the priority claim:

> This application is a continuation of…14/797,006 filed on Jul. 10, 2015 which is a continuation of and ***claims priority*** to PCT/US2014/011347 which ***claims priority*** to…13/941,211, filed Jul. 12, 2013, … 61/908,634, filed Nov. 25, 2013, and to … 61/751,816, filed Jan. 11, 2013, and is ***related to*** the following patent applications: Application Serial No. ***PCT/US12/46560 [Brown]***; Application Serial No PCT/US12/46552 …"

See, e.g., '096 patent, 1:7-15. PO mischaracterizes the above recitation as an "omission," but in fact PO did not omit Brown—PO deliberately characterized Brown as merely "***related to***" the Challenged Patents. Tellingly, PO carefully reviewed and previously corrected a date within the '096 patent's priority claim after issuance, but left the "related to" language for Brown undisturbed, reinforcing that PO intentionally excluded Brown from its priority claim. EX1165. PO now finds its

choice unhelpful, but this choice was not a mistake and cannot now be corrected.[4]

Third, the "entire delay" in seeking correction to a priority claim must be "unintentional." 37 C.F.R. § 1.78(c), (e). The Office treats a delay of more than two years as an "extended period of delay" that "raises a question as to whether the entire delay was unintentional." EX1166 (85 Federal Register 12222). In such cases, PO is "required to provide an additional explanation of the circumstances surrounding the delay that establishes that the entire delay was unintentional" beyond the simple (but required) "statement that the entire delay was unintentional." *Id.*; *see also* 37 C.F.R. § 1.58(e)(3) ("The Director may require additional information where there is a question whether the delay was unintentional.").

PO fails to provide the required explanation. *See* EX2001. Rather, PO merely asserts that the alleged omission "initially occurred" seven years ago in the first-filed application and "[t]his error was inadvertently carried through later-filed applications." *Id.*, 6-7; Mot. 6. This fails to explain why PO identified Brown as

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[4] PO's motivations for making this choice are unknown but could have been two-fold: (1) PO recognized that it could not claim priority to the Prior-filed Applications (see point 1, *supra*), and/or (2) PO chose not to claim priority to the Prior-filed Applications in an effort to extend the life of the patent. Either way, PO's prior deliberate choice forecloses its proposed changes. *In re Serenkin*, 479 F.3d at 1364.

merely "related to " the Challenged Patents instead of claiming priority to Brown. Moreover, even accepting as true PO's assertion that it first learned of the alleged mistake from the IPR Petitions filed on December 7, 2022, PO fails to explain why it intentionally waited 3.5 months to provide notice or request leave to file CoCs.[5]

Fourth, to correct a priority claim, and "[t]o be entitled to the benefit of the filing date of an earlier-filed application, … the disclosure of the prior-filed application must provide adequate support … for the claimed subject matter of the later-filed application." MPEP § 211.05. Here, the Petitions against the Fraser Patents establish that the '816 Provisional, to which the Challenged Patents claim priority, fails to adequately support the claimed sugar and sulfur compounds. *See, e.g.*, IPR2023-00206, Paper 7 (Pet.), 5-10. PO did not dispute this. *See generally id.*, Paper 8 (POPR). The Prior-filed Applications suffer from the same defect. *See, e.g.*, EX2012 (no disclosure of claimed sugar compounds except glucose); EX1012 (same); EX1167 (no claimed sugar disclosed). Hence, PO's concession that the '816 Provisional fails to provide written description support reasonably extends to the

[5] At a minimum, the Board should permit discovery on PO's delays "to determine whether there is sufficient basis supporting Patent Owner's position that the mistake may be correctable." *Honeywell*, 939 F.3d at 1351.

Prior-filed Applications and, thus, there is no sufficient basis for PO's corrections.[6]

III. EFFECT ON PENDING IPR PROCEEDINGS

Even if the Board grants leave to PO, any issued CoCs cannot be applied retroactively and, hence, they would have no effect on these proceedings. Specifically, 35 U.S.C. § 255 states that a CoC "shall have the same effect and operation in law on the trial of actions for causes ***thereafter arising*** as if the same had been originally issued in such corrected form." The Federal Circuit has affirmed that this language only allows "the PTO to make ***prospectively*** effective corrections, and the PTO was given no authority to correct the claims retroactively." *Novo Indus., L.P. v. Micro Molds Corp.*, 350 F.3d 1348, 1356 (Fed. Cir. 2003). The Board has also reached the same conclusion. *Emerson Electric Co. v. SIPCO, LLC*, IPR2016-00984, Paper 52 at 17-20 ("[T]he logical and natural reading of § 255 is that … a [CoC] for an applicant's mistake [] does not receive retroactive application."); *id.* at 20-21 (distinguishing § 255 from § 256 as the latter would apply retroactively).

Notwithstanding, even if 35 U.S.C. § 255 allowed the Board the option to give retroactive effect to any issued CoC (it does not), the Board should decline to do so as it "could impede the Board's ability to meet its statutory deadlines." *See Election*

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[6] At bottom, the combination of all of the above issues shows that PO's mistake is anything but "minor [in] character" and requires a reissue application. MPEP § 1481.

Sys. & Software, LLC v. Hart Intercivic, Inc., PGR2020-00031, Paper 18 at 7-9 (denying retroactive effect to CoC).

IV. PREJUDICE TO PETITIONER AND REQUEST FOR BRIEFING

Petitioner would be irreparably prejudiced if the Board grants PO leave and gives retroactive effect to any issued CoC for IPR2023-00206 or IPR2023-00207. Half of the grounds against the '096 patent's independent claims and a third of the grounds against the '241 patent's independent claims rely on Brown as prior art.[7] Because retroactively applying PO's proposed changes to the priority chain would at least *on its face* remove Brown as prior art,[8] Petitioner will be prejudiced if dozens of pages in those two proceedings' Petitions are rendered meaningless. And Petitioner could not have known PO would attempt to "correct" priority for the Challenged Patents—otherwise, Petitioner could have addressed the lack of written description support for such a claim and/or pursued different, additional grounds. Without the ability to foresee PO's alleged "mistake" and IPR-driven strategy, Petitioner should not have to "bear any consequences incident to the issuing of a certificate of correction … which would be the possible result if that correction were

[7] The Petitions against the Vrljic Patents do not rely on Brown.

[8] Petitioner maintains that because the Prior-filed Applications fail to provide written description support for the Challenged Claims, Brown is still prior art.

to receive retroactive application." *Emerson*, Paper 52 at 23-24.

For this reason, if the Board grants leave to PO to file CoC petitions and considers giving retroactive effect to any CoCs that may issue for the Fraser Patents, Petitioner requests a further 15-page brief to show that the Fraser Patents are not entitled to the benefit of the filing dates of the Prior-filed Applications (and, thus, can still be invalidated by Brown) because the Prior-filed Applications fail to provide written description support to the Fraser Patents' claims. *See Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1571-72 (Fed. Cir. 1997) (finding great-grandparent patent anticipated child patent where priority chain was broken due to lack of continuity of disclosure). Given that any authorized CoC here may issue (if approved) just days or weeks before the institution deadline in these proceedings, Petitioner requests that such briefing be granted now to allow the Board to consider Petitioner's arguments ahead of the institution decision deadline.

Finally, if the Board *does* grant leave to PO to file CoC petitions, Petitioner requests that PO be allowed to file only one CoC petition for each Challenged Patent and also be ordered "in the interests of transparency" to append to its CoC petitions the parties' briefing and any Board order that may issue concerning PO's Motion for leave. *See Arkema Inc. v. Honeywell Int'l Inc.*, PGR2016-00011, Paper 57 at 13; *IP Holding B.V. v. Kokusai Elec. Corp.,* IPR2019-00378, Paper 17 at 5–6); *see also Election*, Paper 12 at 4-5 (allowing only one request).

DATED: April 21, 2022

Respectfully submitted,

By: */Joseph Paunovich/*

Joseph M. Paunovich (Reg. No. 59,044)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
865 S. Figueroa St. at 10th Floor
Los Angeles, California 90017
qeimpossibleipr@quinnemanuel.com

Lead Attorney for Petitioner Motif Foodworks, Inc.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certify that Petitioner's Opposition to Patent Owner's Motion Pursuant to § 1.323, and all exhibits and other documents filed together with the Petitioner's Opposition, were served on Patent Owner on April 21, 2023 by e-mailing copies to:

Lead Counsel	Back-Up Counsel
Michael T. Rosato USPTO Reg. No. 52,182 WILSON SONSINI GOODRICH & ROSATI 701 Fifth Avenue, Suite 5100 Seattle, WA 98104 Tel.: 206-883-2529 Fax: 206-883-2699 Email: mrosato@wsgr.com	Lorelei P. Westin USPTO Reg. No. 52,353 WILSON SONSINI GOODRICH & ROSATI 12235 El Camino Real, Suite 200 San Diego, CA 92130 Tel.: 858-350-2225 Fax: 858-350-2399 Email: lwestin@wsgr.com Wendy L. Devine USPTO Reg. No. 61,309 WILSON SONSINI GOODRICH & ROSATI One Market Plaza, Spear Street Tower, Suite 3300 San Francisco, CA 94105 Tel.: 415-947-2027 Fax: 415-947-2099 Email: wdevine@wsgr.com Matthew R. Reed USPTO Reg. No. 48,879 WILSON SONSINI GOODRICH & ROSATI 650 Page Mill Road Palo Alto, CA 94304 Tel.: 650-565-3990 Fax: 650-493-6811 Email: mreed@wsgr.com

Lead Counsel	Back-Up Counsel
	Tasha M. Thomas USPTO Reg. No. 73,207 WILSON SONSINI GOODRICH & ROSATI 1700 K Street, NW, Fifth Floor Washington, DC, 20006 Tel.: 202-973-8883 Fax: 202-973-8899 Email: tthomas@wsgr.com

Date: April 21, 2023

Respectfully submitted,

By: /s/ *Joseph Paunovich*

Joseph M. Paunovich (Reg. No. 59,044)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
865 S. Figueroa St. at 10th Floor
Los Angeles, California 90017
qeimpossibleipr@quinnemanuel.com

Lead Attorney for Petitioner Motif Foodworks, Inc.