

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 TO EXCLUDE**

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I. INTRODUCTION

Patent Owner moves to exclude two categories of exhibits, which it characterizes as: (1) “exhibits [that] were filed along with the petition but were not cited in the petition or reply”; and (2) exhibits that “Petitioner and its experts improperly cite to and rely on” because they were “publicly available after the priority date applied in the Petition” (“Post-filing Date Exhibits”). Paper 47 (“Motion”) at 1-3. PO’s Motion should be denied for both categories of exhibits.

First, the vast majority of exhibits that PO identified as not being cited to in Petitioner’s briefing were cited to and relied on by Petitioner’s experts.¹ Thus, they are relevant to understanding the weight to be given to its experts’ testimony. PO also identifies no prejudice if these exhibits were not excluded.

As to the Post-filing Date Exhibits, these exhibits should not be excluded because they: (1) are relied on by Petitioner to show inherent qualities/properties of various compounds and products and, thus, the exhibits’ publication dates are irrelevant; (2) relate to arguments that PO has not contested to and are thus exclusion (which is not proper anyhow) is moot; and (3) are relied on in addition to other

¹ The only exception to this are Exhibits 1082 and 1180, which were not cited to in either Petitioner’s briefs or its experts’ declarations.

exhibits for the same premise and hence their publication date merely goes to the weight of the evidence.

II. EXPERT EXHIBITS

PO moves to exclude Exhibits 1021, 1027, 1029-1032, 1034-1036, 1046-1047, 1049, 1056, 1060, 1064, 1073, 1082, 1084, 1087, 1095-1096, 1098-1101, 1107-1115, 1119-1120, 1123, 1133, 1135, 1137-1138, 1141, 1146-1147, 1149-1150, 1152, 1157-1159, 1180, and 1184 because these exhibits were not cited in the Petition or Reply. However, except for Exhibits 1082 and 1180, these exhibits were all cited to and relied on by one or more of Petitioner's experts Dr. Rodrigo Tarté, Dr. Robert McGorin, and Dr. Carl Batt in their declarations ("Expert Exhibits"). *See generally* Ex. 1003 (Tarté) (citing Exhibits 1021, 1027, 1029, 1030, 1035, 1036, 1046, 1073, 1087, 1101, 1107, 1123, 1133, 1135, 1150); Ex. 1005 (McGorin Opening) (citing Exhibits 1021, 1031, 1032, 1034, 1047, 1049, 1056, 1060, 1064, 1095, 1096, 1098, 1099, 1100, 1108-1115, 1119, 1120, 1141, 1146, 1147, 1149, 1150, 1152, 1157, 1159); Ex. 1007 (Batt) (citing Exhibits 1084, 1137, 1138); Ex. 1181 (McGorin Reply) (citing Exhibit 1184).

For instance, Dr. Tarté cited to and relied on Exhibits 1021, 1027, 1029, 1030, 1035, 1036, 1046, 1087, 1107, 1123, 1133, and 1135 as evidence of, but not limited to, the background knowledge of a POSITA, state of the art at the time of the invention, and/or factual information about compound, product, or process. Ex.

1003, ¶¶ 50, 51, 53, 55, 56, 61, 62, 63, 64, 67, 68, 69, 70, 73. Similarly, Dr. McGorin cited to and relied on Exhibits 1031, 1032, 1034, 1047, 1049, 1056, 1060, 1064, 1095, 1096, 1099, 1100, 1108-1112, 1119, 1141, 1152, and 1184 as evidence of the background knowledge of a POSITA, state of the art at the time of the invention, factual information about compound, product, or process, and/or PO's failure to show unexpected results. Ex. 1005, ¶¶ 33, 35, 36, 39, 40, 46, 47, 57, 58, 60, 64, 65, 112, 159, 168, 172, 174, 179, 185; Ex. 1181, ¶ 95. Dr. Batt cited to and relied on Exhibits 1084, 1137, and 1138 as evidence of the background knowledge of a POSITA and/or state of the art at the time of the invention. Ex. 1007, ¶¶ 41, 49.

Dr. Tarté also cited to and relied on Exhibits 1073 and 1101 as evidence in support of his conclusions that the prior art satisfied one or more limitations of the claims. Ex. 1003, ¶¶ 129, 144, 206, 317, 333. Dr. McGorin additionally cited to and relied on Exhibits 1098, 1113, 1114, 1115, 1120, 1146, and 1147 at least as relevant to the lack of secondary considerations of non-obviousness of the challenged patent.

Exhibits 1149, 1150, 1157, and 1159 are patents or prosecution histories of patents related to the challenged patent and were cited to and relied on by Drs. Tarté and/or McGorin in their declarations as relevant for understanding the prosecution history of the challenged patent and/or representations made by the Patent Owner.

The PTAB has declined to exclude exhibits under similar circumstances. *See Twinstrand Biosciences, Inc. v. Guardant Health, Inc.*, IPR2022-01400, Paper 41, at 47 (Jan. 26, 2024) (declining to exclude uncited exhibits because Petitioner’s experts relied on the exhibits as relevant to “background knowledge of a POSA” and “general knowledge in the art”); *Envirotainer AB v. Doubleday Acquisitions, LLC*, IPR2022-00851, Paper 70, at 88 (Feb. 1, 2024) (declining to exclude uncited material because “some portions of the uncited material may provide helpful context to the cited material,” “Patent Owner offers no compelling argument that it suffers any prejudice from the mere existence of this uncited material in the record”).

All of the Expert Exhibits meet the “low threshold for relevancy” under FRE 401 because they are relevant for all of the reasons Petitioner’s experts relied on them in forming their opinions, as described above, including background/state of the art. *OddzOn Prods., Inc. v. Just Toys Inc.*, 122 F.3d 1396, 1407 (Fed. Cir. 1997); *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015) (“evidence of the background understanding of skilled artisans” is admissible in an IPR, and “can legitimately serve to document the knowledge that skilled artisans would bring to bear in reading the prior art identified as producing obviousness.”).

Patent Owner’s reliance on 37 C.F.R. § 42.6(a)(3) is also misplaced. Motion at 1-2. “The mere fact that the exhibits are cited by an expert witness to support his or her testimony on the state of the art, but not cited in the Petition, does not establish

automatically that they are irrelevant or an improper incorporation by reference, as Patent Owner alleges.” *Cellco P’ship v. Bridge and Post, Inc.*, IPR2018-00055, Paper 40 at 75 (April 15, 2019). Accordingly, the Exhibit Exhibits are relevant and admissible, and Patent Owner fails to show otherwise. F.R.E 401, 402.

Patent Owner’s conclusory statement characterizing these exhibits as “unduly prejudicial, misleading, and a waste of time” also fails. Patent Owner has not identified *any* prejudice it might suffer should these exhibits remain in the record, nor make any attempt to explain how the relevance of these exhibits is outweighed by the unidentified “prejudice.” *See Envirotainer*, Paper 70 at 88 (declining to exclude where “Patent Owner offers no compelling argument that it suffers any prejudice from the mere existence of this uncited material in the record”). As the Board stated in *Corning Inc. v. DSM IP Assets B.V.*:

Thus, in this *inter partes* review, the better course is to have a complete record of the evidence to facilitate public access as well as appellate review ... “If the record on review contains not only all evidence which was clearly admissible, but also all evidence of doubtful admissibility, the court which is called upon to review the case can usually make an end of it, whereas if evidence was excluded which that court regards as having been admissible, a new trial or rehearing cannot be avoided.”

IPR2013-00053, Paper 66, at 19 (May 1, 2014) (quoting *Donnelly Garment Co. v. NLRB*, 123 F.2d 215, 224 (8th Cir. 1941)); *see also El Lilly & Co. v. Teva Pharms. Int’l. GMBH*, IPR2018-01422, Paper 80, at 162 (Feb. 18, 2020); *SK Hynix Inc. v. Netlist, Inc.*, IPR2017-00561, Paper 36, at 60 (July 5, 2018) (“Thus, in this *inter*

partes review, the better course is to have a complete record of the evidence to facilitate public access as well as appellate review.”).

Hence, Exhibits 1021, 1027, 1029-1032, 1034-1036, 1046-1047, 1049, 1056, 1060, 1064, 1073, 1082, 1084, 1087, 1095-1096, 1098-1101, 1107-1115, 1119-1120, 1123, 1133, 1135, 1137-1138, 1141, 1146-1147, 1149-1150, 1152, 1157-1159, 1180, and 1184 should not be excluded.

III. POST-FILING DATE EXHIBITS

PO moves to exclude Exhibits 1047, 1050, 1057, 1059, 1064, 1067, 1070, 1074, 1085, 1089, 1106, 1118, 1183, 1185, and 1187 because these documents were publicly available after July 12, 2013, the effective filing date assumed for this proceeding. Motion at 2-4; Paper 23 (Institution Dec.) at 12. PO’s motion should be denied because none of these exhibits are being used as prior art, as explained below:

1. **Exhibits 1047, 1064, 1118:** Dr. McGorin relied on: Ex. 1047 to show that 2-methyl-3-furanthiol (MFT) is a volatile compound inherently found in Moutai, a type of traditional Chinese liquor; Ex. 1064 to show that thiophene is a volatile compound inherently found in truffles; and Ex. 1118 to show that 2-acetylthiazole has a nutty, cereal-like, popcorn-like aroma. Ex. 1005, ¶¶ 171, 172 n. 9, 13, 15. Dr. McGorin relied on these inherent qualities about these products and compounds to show that these volatile compounds are not found exclusive in meaty aromas but

also in fruits, coffee, wine, and grains. *Id.*, ¶ 171. This finding does not hinge on whether a POSITA knew at the time of the invention whether in fact these volatile compounds were associated with other aromas. Thus, that the publication dates of the references disclosing these qualities are after the effective filing date of the challenged patent is irrelevant.

2. Exhibits 1050, 1057, 1059, 1067, 1106: The Petition and Dr. Tarté relied on Exs. 1050, 1057, 1059, 1067, 1070, and 1106 to show that pea flour inherently contains various amino acids, globulin, and albumin. *See, e.g.*, Pet., 23, 25, 37, 38; Ex. 1003, ¶¶ 122-24, 154-56, 161, 237. This was relevant because the prior art reference Brown used pea flour as an ingredient in its compositions. *See* Pet., 22-23, 25. That the publication date of the references disclosing these inherent qualities about pea flour are after the effective filing date of the challenged patent is irrelevant as it does not matter whether a POSITA at the time of the invention knew that pea flour inherently contained the subject amino acids and proteins, just that pea flour does in fact contain these amino acids and proteins.

3. Exhibit 1074: The Petition and Dr. Tarté relied on Ex. 1074 to show that gum Arabic, as disclosed as a potential ingredient in the Giacino prior art reference (Ex. 1015), was, in fact, a plant-based emulsifier, as required by claims 18 and 19. *See, e.g.*, Pet., 41; Ex. 1003, ¶¶ 262, 263, 374, 375. That the publication date of this reference disclosing that gum Arabic is an emulsifier is after the filing date of the

challenged patent is irrelevant as it does not matter whether a POSITA at the time of the invention knew that gum Arabic was an emulsifier. Giacino already disclosed that it could be used as an ingredient in its compositions. Pet., 41 (citing ex. 1015, 9:21-27). Moreover, Ex. 1074 was publicly available no later than May 8, 2015, and stated that “Arabic gum has wide industrial uses as ... [an] emulsifier, mainly in the food industry.” Pet., 41 (citing Ex. 1074, 233). It is reasonable to conclude that because gum Arabic had already been *widely* used as an emulsifier in the food industry by 2015, it was known in the art to use gum Arabic as an emulsifier (in some capacity) prior to July 12, 2013. Its 2015-publication date simply goes to the weight of the evidence. *See Yeda Research v. Mylan Pharmaceuticals Inc.*, 906 F.3d 1031, 1041-42 (Fed. Cir. 2018) (permissible for the PTO to consider evidence of a clinical drug trial that was not statutory prior art when using that material not as prior art but for “considering the knowledge, motivations, and expectations of a POSITA regarding the prior art”). Moreover, Petitioner and Dr. Tarté relied on another reference for this same point (Ex. 1122) that pre-dated the challenged patent. *See, e.g.*, Pet., 41 (citing Ex. 1122 (Saha)); Ex. 1003, ¶¶ 262, 263, 374, 375 (same).

4. **Exhibit 1085:** The Petition and Dr. Tarté relied on Ex. 1085 to show that it was well-known that cysteine could be obtained from non-animal sources, including synthetic cysteine made in recombinant microorganisms. *See, e.g.*, Pet., 32-33; Ex. 1003, ¶ 204. Petitioner offered this evidence and argument to show that

Giacino's compositions satisfied the limitation "the flavor additive composition contains no animal products." *Id.* Notably, PO did not dispute that Giacino satisfies this limitation and hence its challenge to this exhibit is moot. *See* Paper 34 (POR), 23-35. Moreover, Petitioner proffered two other exhibits for the same position that pre-date the challenged patent. *See* Pet., 32-33 (citing Exs. 1078, 1079). Finally, that Ex. 1085 was publicly available in 2020 simply goes to the weight of the evidence as to the knowledge of a POSITA prior to the effective filing date of the challenged patent.

5. Exhibit 1089: The Petition and Dr. Tarté relied on Ex. 1089 to show that it was well-known that glucose was obtained from non-animal sources. *See, e.g.,* Pet., 23; Ex. 1003, ¶ 130. Petitioner offered this evidence and argument to show that Brown's compositions satisfied the limitation "the flavor additive composition contains no animal products." *Id.* Notably, PO did not dispute that Brown satisfies this limitation and hence its challenge to this exhibit is moot. *See* Paper 34 (POR), 12-23. Moreover, that Ex. 1089 was publicly available in 2019 simply goes to the weight of the evidence as to the knowledge of a POSITA prior to the effective filing date of the challenged patent.

6. Exhibits 1183, 1185, 1187: Dr. McGorin relied on Exhibits 1183 and 1185 to show that nutritional yeast contains nutrients (*e.g.,* various vitamins such as vitamin B complex) and sodium (in salt) is an essential nutrient for the human body.

See Ex. 1181, ¶¶ 105-106. Dr. McGorin cited these examples to show that PO’s claim that food flavor additives are exclusively used to contribute flavor and not provide nutritive benefits was false. *Id.*, ¶¶ 101, 104-106. That the publication date of the references disclosing these facts and qualities about nutritional yeast and the human body are after the effective filing date of the challenged patent is irrelevant to that point.

Similarly, Dr. McGorin relied on Exhibit 1187 to show that when MSG is added to foods in place of salt, it reduces the amount of sodium in foods (which may for some people provide a nutritive benefit). *Id.*, ¶108. That MSG contains less sodium than salt is a property of MSG. Again, the publication date of a reference disclosing this fact/property is irrelevant.

A. Striking Petitioner’s Experts Declaration in Their Entirety Is Unwarranted

PO argues that because Petitioner’s experts cite to exhibits that are not prior art, their declarations should be struck in their entirety because “it would be unduly prejudicial and burdensome for Patent Owner or the Board to sort proper from improper testimony.” Motion at 4. PO does not cite to any authority supporting such a radical and unprecedented response. *See id.* To the contrary, the Board expressly discourages such “exceptional” action. *See* CTPG (Nov. 2019), 80 (“[S]triking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely.”).

Moreover, even if the Board were to grant PO's Motion as to one or more of the aforementioned exhibits, the exhibits are all relied on by Petitioner and its experts for discrete arguments or positions. These arguments and positions could still stand without support from the exhibits to which they cite, and the Board can give such testimony the weight it merits. Notwithstanding, even the discrete arguments/positions could be struck without necessitating striking the expert declarations in their *entirety*, which is wholly unwarranted.

IV. CONCLUSION

For the foregoing reasons, PO's motion to exclude should be denied.

Date: March 8, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing Petitioner's Opposition to Patent Owner's Motion to Exclude was served in its entirety on March 8, 2024 via Electronic Mail directed to counsel of record for the Patent Owner at the following:

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