Trials@uspto.gov
571-272-7822

Paper 8
Date: March 19, 2024

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INARI AGRICULTURE, INC.,
Petitioner,

v.

CORTEVA AGRISCIENCE LLC,
Patent Owner.

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IPR2024-00181
Patent 11,299,745 B2

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Before MICHAEL J. FITZPATRICK, ROBERT A. POLLOCK, and TIMOTHY G. MAJORS, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* MAJORS.

Opinion dissenting filed by *Administrative Patent Judge* FITZPATRICK.

MAJORS, *Administrative Patent Judge*.

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

Granting Contingent Motion for Joinder
*35 U.S.C. § 315(c); 37 C.F.R. § 42.122*

# I. INTRODUCTION

Inari Agriculture, Inc. ("Petitioner" or "Inari"), on November 15, 2023, filed a Petition for *inter partes* review of claims 1–29 of U.S. Patent No. 11,299,745 B2 (Ex. 1003, "the '745 patent"). Paper 2 ("Pet." or "Petition"). Inari also filed a Contingent Motion for Joinder (Paper 3, "Mot." or "Motion"), seeking joinder with *Bayer CropScience LP et al., v. Corteva Agriscience LLC*, IPR2023-01038 (hereafter the "Bayer 1038 IPR"), in which Bayer[1] is challenging the patentability of the same claims of the '745 patent. Inari's Motion was styled as "contingent" because it sought joinder in the event the Board instituted trial in the Bayer 1038 IPR or, if the Bayer 1038 IPR terminated before the Board decided Inari's Motion, Inari asked that its Petition be decided on the merits. Mot. 1–2. We instituted *inter partes* review of the Bayer 1038 IPR on December 19, 2023. Bayer 1038 IPR, Paper 12. Because the Bayer 1038 IPR is ongoing, we address Inari's Motion.

Corteva Agriscience LLC ("Patent Owner" or "Corteva") did not file a preliminary response to Inari's Petition or oppose Inari's Motion. The time for filing such preliminary response and opposition has passed. Inari also represents that it conferred with petitioner's (i.e., Bayer's) counsel in the Bayer 1038 IPR and confirmed that Bayer does not oppose the Motion. Mot. 3.

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[1] By "Bayer" herein, we are referring to both petitioners in IPR2023-01038, Bayer CropScience LP and Monsanto Company.

### A. *Real Parties-in-Interest*

Inari identifies itself as the real party-in-interest. Pet. 3. Patent Owner identifies itself as the real party-in-interest. Paper 5, 1.

### B. *Related Proceedings*

The parties identify the following lawsuit involving assertion of the ’745 patent: *Corteva Agriscience LLV v. Monsanto Co.*, 22-cv-01046 (D. Del.); Pet. 3; Paper 5, 1.

The parties also identify related matters before the Board. Pet. 3–4; Paper 5, 1–2. Those matters include the Bayer 1038 IPR, noted above, as well as IPR2023-01036 and IPR2023-01037, in which Bayer challenges, respectively, claims of U.S. Patent Nos. 10,947,555 (“the ’555 patent”) and 11,149,283 (“the ’283 patent”). Pet. 3–4; Paper 5, 1–2. The ’283 and ’745 patents issued from continuation applications to the application that issued as the ’555 patent. Ex. 1002 (’283 patent), code (63); Ex. 1003 (’745 patent) code (63). Inari has filed petitions challenging claims of the ’555 and ’283 patents, and is seeking joinder to the other Bayer IPR proceedings where those patents are challenged. IPR2024-00179, Papers 2 and 3; IPR2024-00180, Papers 2 and 3.

The parties identify *Ex Parte* Reexamination Control No. 90/019,130, requested by Inari and involving the ’555 patent. Pet. 4; Paper 5, 2.

C. *Asserted Grounds of Unpatentability*

Inari asserts four grounds as set forth below (Pet. 16–17):

| Claims Challenged | 35 U.S.C. §[2] | Reference(s)/Basis |
|---|---|---|
| 1–29 | 102 | Corteva '437[3] |
| 1–29 | 103 | Corteva '437 |
| 1–6, 9–12, 29 | 103(a) | Saari 1998,[4] Saari 1999,[5] Schleinitz,[6] Streber[7] |
| 7, 8, 13–28 | 103(a) | Saari 1998, Saari 1999, Schleinitz, Streber, Jepson[8] |

[2] The Leahy-Smith America Invents Act ("AIA"), Pub. L. No. 112–29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. §§ 102, 103 effective March 16, 2013. Inari's grounds based on Corteva '437 assume that the claims have a priority date no earlier than October 7, 2016, in which case AIA §§ 102, 103 apply. Pet. 16–17. Inari's other grounds assume a priority date of April 30, 2004, in which case pre-AIA §§ 102, 103 apply. *Id.*

[3] Wright et al., WO 2005/107437 A2, publ. Nov. 17, 2005 (Ex. 1021 ("Corteva '437")).

[4] R.E. Saari, Substrate Specificity and Spectroscopic Properties of 2,4-Dichlorophenoxyacetic Acid/α-Ketoglutarate Dioxygenase, Doctoral Thesis, Mich. State Univ. (July 6, 1998) (Ex. 1040 ("Saari 1998")).

[5] R.E. Saari, et al., *Stereospecific Degradation of the Phenoxypropionate Herbicide Dichlorprop*, 6 J. Molecular Catalysis B: Enzymatic 421–428 (1999) (Ex. 1041 ("Saari 1999")).

[6] Accession No. AF516751, publ. Aug. 6, 2002 (Ex. 1013 ("Schleinitz")).

[7] Streber et al., US 6,153,401, issued Nov. 28, 2000 (Ex. 1043 ("Streber")).

[8] Jepson et al., US 2003/0041357 A1, publ. Feb. 27, 2003 (Ex. 1030 ("Jepson")).

Inari submits testimony from Aron Silverstone, Ph.D., in support of its challenge. Ex. 1054 ("Silverstone Declaration"). Inari states, however, that the Silverstone Declaration is "substantively identical" to the declaration submitted by petitioner in the Bayer 1038 IPR, and that Inari will waive its expert declaration and be bound by the testimony of Bayer's declarant if the motion for joinder is granted. Mot. 2, 4–5.

## II. INSTITUTION OF INTER PARTES REVIEW

According to Inari, the Petition advances the same grounds of unpatentability that are included in the instituted Bayer 1038 IPR. *Compare* Pet. 16–65, *with* Bayer 1038 IPR, Paper 2, 16–65; *see also* Bayer 1038 IPR, Paper 12, 20–70 (Institution Decision). Indeed, as Inari states:

> The Bayer Petition and the Inari Petition are substantively identical; they contain the same grounds (based on the same prior art combinations and supporting evidence) against the same claims and rely on the same evidence, including a substantively identical expert declaration.

Mot. 2.

Patent Owner did not file a preliminary response to the instant Petition, and has not otherwise addressed Inari's contentions. Inasmuch as Patent Owner raised counterarguments to the grounds in the preliminary response that it filed in the Bayer 1038 IPR, we addressed those arguments in our Institution Decision in that proceeding. Bayer 1038 IPR, Paper 12. From our review of the preliminary record, we are persuaded that Inari's Petition challenges the same claims of the '745 patent, based on the same grounds and substantially the same evidence, compared to the challenge in the Bayer 1038 IPR.

We grant joinder as explained in Section III below. And, for the reasons set forth in our Institution Decision in the Bayer 1038 IPR, which reasoning we adopt in full here, we determine that Inari has met its burden to demonstrate a reasonable likelihood that it would prevail in showing at least one of the challenged claims are unpatentable. *See generally* Bayer 1038 IPR, Paper 12. We thus institute *inter partes* review on the grounds raised in the instant Petition, which are the same as in the instituted Bayer 1038 IPR.

## III. GRANT OF MOTION FOR JOINDER

We instituted trial in the Bayer 1038 IPR on December 19, 2023. Bayer 1038 IPR, Paper 12. Petitioner filed its Contingent Motion for Joinder on November 15, 2023—roughly one month before the Institution Decision. Paper 3. We conclude that Inari's Motion is timely. 37 C.F.R. § 42.122(b) (2020) (requiring any joinder motion be filed "no later than one month after the institution date of any *inter partes* review for which joinder is requested").

The statutory provision governing joinder in *inter partes* review proceedings is 35 U.S.C. § 315(c), which reads:

> If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

Furthermore, a motion for joinder should (1) set forth reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15, 4 (PTAB Apr. 24, 2013); Patent Trial and Appeal Board, Consolidated Trial Practice Guide, 76 (Nov. 2019), https://www.uspto.gov/sites/default/files/ documents/tpgnov.pdf. Inari addresses these considerations in its Motion, and we generally agree with Petitioner's assertions in favor of joinder. Mot. 3–10. We discuss below.

The Petition raises the same unpatentability grounds on which we instituted review in the Bayer 1038 IPR, and no others. Mot. 4 (arguing "joinder with the Bayer IPR is appropriate because the Inari Petition submits identical arguments and the same grounds introduced in the existing Bayer IPR, consistent with PTAB joinder practice."). Indeed, Inari contends that the "Petition copies verbatim the challenges set forth in the Bayer [1038 IPR] Petition and relies on a substantially identical expert declaration," with no substantive "changes to the facts, citations, evidence, or arguments." *Id.* at 4–6 (noting the only differences are "formalities" connected to it being a different filing party). Patent Owner provides no argument to the contrary. Thus, this *inter partes* review does not present any ground not already at issue in the Bayer 1038 IPR, supporting the grant of joinder.

We also agree with Inari that granting joinder here should have no material impact on the trial schedule for the Bayer 1038 IPR. *Id.* at 6–7. Because the grounds, issues, and evidence are the same, there should be "no

new issues for the Board to address" if Inari is joined. *Id.* (arguing "Patent Owner will not be required to present any additional responses or arguments"). Furthermore, Inari represents that it "will adhere to all deadlines set by the Board's Scheduling Order for the Bayer IPR" and that it will "rely entirely on, and be bound by" the testimony of Bayer's expert in the Bayer 1038 IPR.[9] *Id.* Here again, Patent Owner raises no counterargument. Because it is unlikely that the existing schedule in the Bayer 1038 IPR will be impacted, joinder is supported.

Inari also argues that granting joinder will simplify briefing and discovery related to the challenge presented in the Petition. Mot. 8–10. According to Inari, it will accept a "complete and silent 'understudy' role and will not raise any issues." *Id.* at 8. In furtherance of that understudy role, Inari agrees that: a) substantive filings will be made by Bayer, which filings Inari will rely upon; b) Inari will introduce no arguments and seek no discovery independent from what is introduced or sought by Bayer; c) Inari will be bound by any agreements between Patent Owner and Bayer related to discovery, including depositions; and d) Inari will be bound by the testimony (whether given by declaration or deposition) of Bayer's expert and "waive" its own expert declaration unless Bayer ceases participation in the proceeding. *Id.* at 8–9.

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[9] Inari notes an exception to such reliance on Bayer's expert if the IPR terminates as to Bayer before that expert is deposed. Mot. 7. That exception has not been triggered and, at present, we have no indication that it will be.

Inari persuades us that, by taking on the role of understudy and complying with the conditions summarized above, briefing and discovery will be simplified and streamlined, with no impact to the existing schedule in the Bayer 1038 IPR. This supports joinder of Inari to the Bayer 1038 IPR. The alternative—denial of Inari's Motion—would, under the circumstances, result in two proceedings moving ahead on two different timetables with redundant or (more likely) different briefing and trial records by the time those proceedings concluded. Joining Inari as a party (Petitioner) in one proceeding—the Bayer 1038 IPR—is, thus, the more efficient course for the parties and the Board.

Altogether, for the reasons discussed above, we grant Inari's Motion.

## IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of claims 1–29 of U.S. Patent No. 11,299,745 B2 is instituted in IPR2024-00181;

FURTHER ORDERED that the Motion for Joinder with IPR2023-01038 is *granted*, and Inari is joined as a party Petitioner to IPR2023-01038;

FURTHER ORDERED that all further filings by Inari and Patent Owner, except for those which concern a request for rehearing of this decision, shall be made only in IPR2023-01038;

FURTHER ORDERED that, subsequent to joinder, the grounds and claims for trial in IPR2023-01038 remain unchanged;

FURTHER ORDERED that, subsequent to joinder, the Scheduling Order for IPR2023-01038 (Paper 13) remains unchanged, subject to any

changes already made by stipulation between the parties or otherwise ordered by the Board;

FURTHER ORDERED that, except as permitted by separate order from the Board, Inari will make no substantive filing in the proceeding to which it is joined unless Bayer ceases to participate in IPR2023-01038 (ministerial filings, such as updates to mandatory notices, are allowed);

FURTHER ORDERED that, except as permitted by separate order from the Board, Inari will comply with conditions (a) through (e) as set forth on pages 8 and 9 of the Motion;

FURTHER ORDERED that the case caption in IPR2023-01038 shall be changed in a manner consistent with the example included below; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2023-01038.

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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INARI AGRICULTURE, INC.,
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IPR2024-00181
Patent 11,299,745 B2

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FITZPATRICK, *Administrative Patent Judge*, dissenting.

I join the majority's Decision in so far as it grants Inari's Motion to join itself as a petitioner in the Bayer 1038 IPR. However, I dissent from the Decision to grant Inari's Petition to institute an *inter partes* review.

I agree that Inari's Petition presents a reasonable likelihood of Inari prevailing, as it is substantively identical to the successful petition upon which we instituted the Bayer 1038 IPR. However, institution of an *inter partes* review is discretionary. *See* 35 U.S.C. § 314(a) (authorizing institution of an *inter partes* review under particular circumstances, but not requiring institution under any circumstances); *Cuozzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016) ("[T]he agency's decision to deny a petition

is a matter committed to the Patent Office's discretion."); *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1356 (2018) ("[Section] 314(a) invests the Director with discretion on the question whether to institute review . . . ." (emphasis omitted)); *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."). I would exercise that discretion here and deny the Petition.

The Bayer 1038 IPR is governed by the petition filed by Bayer. *See Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1336 (Fed. Cir. 2020) ("The already-instituted IPR to which a person may join as a party is governed by its own petition and is confined to the claims and grounds challenged in that petition."). However, "[t]he instant Petition is substantively identical to the petition filed by Bayer, challenging the same claims of the '745 patent on the same grounds and relying on substantively identical expert testimony." Pet. 3. Thus, institution based on the instant Petition creates a second *inter partes* review that is duplicative of the Bayer 1038 IPR. As we are already granting Inari's request to join the Bayer 1038 IPR as a petitioner, I see no benefit to granting Inari's Petition to institute a second *inter partes* review. I would deny Inari's Petition.

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[SAMPLE CASE CAPTION]

UNITED STATES PATENT AND TRADEMARK OFFICE

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INARI AGRICULTURE, INC.,
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v.

CORTEVA AGRISCIENCE LLC,
Patent Owner.

IPR2023-01038[1]
Patent 11,299,745 B2

[1] The Board joined Inari Agriculture, Inc. as a party (Petitioner) to this proceeding via a Motion for Joinder in IPR2024-00181.