

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STARA S.A.-INDÚSTRIA DE IMPLEMENTOS AGRÍCOLAS,
Petitioner,

v.

AGCO CORPORATION,
Patent Owner.

Case IPR2024-01459
Patent No. 11,665,989 B1

MOTION TO FILE EXHIBIT
AND TO AMEND PAPERS

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Petitioner, STARA S.A.-INDÚSTRIA DE IMPLEMENTOS AGRÍCOLAS (“Petitioner”) filed a Petition for Inter Partes Review of Claims 1-4, 6-8, 10-13 and 15-18 of U.S. Patent No. 11,665,989 (the “’989 Patent”) on September 19, 2024 (Paper 1.) Grounds 1, 3, and 6 rely, at least in part, on a Korean Patent Publication that predates the ’989 patent. (Paper 1 at 12.) In its Preliminary Patent Owner Response (POPR), Patent Owner asserts that the document submitted at EX. 1012, KR10187702, is not itself prior art despite bearing a publication date prior to the filing date of the ’989 patent. (Paper 8 at 22-25; EX. 1012 at 1.) WIPO code 43 is well known as the date of making available to the public by printing or similar process of an unexamined patent document. Item 43 of Ex. 1012 has a publication date of May 15, 2014, more than two years before the December 16, 2016 filing date of the ’989 patent. Nevertheless, Patent Owner contends that Ex. 1012 is not prior art because it was not issued until July 4, 2018, nor translated until September 15, 2024. (Paper 8 at 23-25.) The Patent Owner provided no affidavit or other evidence supporting its argument.

In order to avoid litigating the issue as to whether the cited prior was publicly available before the filing of the ’989 patent, Petitioner requests permission to file a copy of KR 10-2014-0058776 (KR’776) from the same family as Ex. 1012 and listed thereon, which also bears the same May 15, 2014 publication date as Ex. 1012. See

Ex. 1024 to Tollefson Declaration, Ex. 1023. KR'776 and Ex. 1012 are virtually identical and are identical in all relevant respects. Tollefson Declaration at 5. Only very minor amendments to the IPR and accompany Declaration would need to be made to change citations to include citations to KR'776. No arguments would be modified or added.

There is no precedential opinion on point. In *Hulu, LLC v Soud view Innovations, LLC*, IPR2018-01039 (Paper 29)(precedential), the Board held when a reference qualifies as prior art for the purpose of instituting an IPR. In *Hulu*, the Board noted that if the patent owner files a preliminary response, for good cause, the petitioner may seek leave to file a reply with further evidence. 37 C.F.R. § 42.108(c). The Board also noted that "after institution, the petitioner "may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability."" *Hulu* at 7. The exception to this general rule precluding the submission of new evidence is that the parties can respond to arguments raised in a prior brief and "[a] party also may submit rebuttal evidence in support of its reply." *Id.* (internal citations omitted). After institution, there is also an opportunity for the petitioner to move to submit supplemental information under 37 C.F.R. § 42.123. *Id.* at 8. 37 CFR § 42.104(c) provides that a motion may be filed that seeks to correct a clerical or typographical mistake in the petition.

Petitioner therefore moves pursuant to 37 CFR § 42.104(c) or 37 C.F.R. § 42.108(c), for leave to file a copy of KR'776 (with a verified English translation thereof) and to make minor amendments to the IPR and accompany Declaration to reference the new exhibit, or to explain its significance in a very short paper.

Good cause exists to grant this motion.

Courts routinely follow a four-part test for establishing whether good cause exists. First, the reason for the omission was clerical in nature. Petitioner's counsel made an error in document handling which resulted in the omission of KR'776. Tollefson Decl. at 2-3. Both Ex. 1012 and KR'776 are Korean patent documents from the same family bearing the same publication date. *Id.* Indeed, the Petition for IPR introduces Ex. 1012 as a "Korean patent publication published on May 15, 2014." (Paper 1 at 26.) Petitioner's Counsel is a solo practitioner with no associate, secretary or paralegal. Tollefson Declaration at 2. Petitioner's Counsel is forced to wear many hats. *Id.* This was not the result of a conscious legal decision but rather a mere clerical mistake. *Id.* 2-3.

Petitioner discovered the omission after it reviewed a copy of the POPR, which was filed December 27, 2024. Holidays intervened but Petitioner's counsel promptly contacted counsel for Patent Owner after it reviewed the POPR to seek consent to file the Exhibit.

Second, the relief sought is important to the fair resolution of the IPR. Here, Patent Owner challenges certain grounds based on the availability of Ex.1012. Whether a reference qualifies as a "printed publication" is a legal conclusion based on underlying factual findings." *Hulu* at 8-9 (internal citations omitted). "A given reference is 'publicly accessible' upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it." *Id.* at 10-11(internal citations omitted). KR'776 is additional evidence establishing the public availability of the disclosures relied upon in the Petition. These are patent documents and clearly were publicly available prior to the filing date of the '989 patent. Further, pursuant to 37 C.R.R. § 42.108, when instituting an IPR, the Board must authorize the review to proceed on *all* of the challenged claims and on *all* grounds of unpatentability asserted for each claim, including those based on Ex. 1012. Submission of KR'776 will eliminate this issue from being litigated here, relitigated during the proceeding, and save resources of both the Board and the parties.

Third, there is no prejudice to Patent Owner. Patent Owner is already on notice of the merits of Petitioner's grounds for invalidity and the relief sought will not alter the merits in any fashion. Although Patent Owner chose not to address the

merits of the Grounds involved Ex. 1012, there is time for it to file a supplemental preliminary response should the Board determine that one should be allowed.

Fourth, there is no need for a continuance. A decision whether to institute the IPR is not due until March 27, 2025. 35 U.S.C. 114.¹ There is time for the Board to consider a supplemental preliminary response should the Board determine that one should be allowed.

For the foregoing reasons, Petitioner requests that this motion be granted.

Dated: January 25, 2025

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¹ Petition is unaware whether the submission of a supplemental or replacement POPR would restart the 3-month time for institution.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§42.6(e) and 42.105, I hereby certify that on this 27th day of January 2025, a true copy of the foregoing Motion, together with the Tollefson Declaration (Exhibit 1023) and Exhibit 1024, was served via email on all attorneys of record.

Dated: January 27, 2025

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