

Case IPR 2025-00136
Patent No. 11,140,841

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AARDEVO NORTH AMERICA, LLC,
Petitioner,

v.

Agventure B.V.,
Patent Owner.

IPR 2025-00136

U.S. Patent No. 11,140,841

PATENT OWNER'S SUR-REPLY

Petitioner’s Reply, limited to § 325(d), focuses on whether “substantially the same arguments were considered.” Reply at 1. But § 325(d) is not so limited. Indeed, “[w]here *either* the prior art references advanced *or* the arguments raised in a petition previously were presented to the Office, the inquiry shifts to whether the petitioner establishes a material error.” *Nespresso Usa, Inc. v. K-Fee Sys. Gmbh*, IPR2021-01222, Paper 9 at 11 (P.T.A.B. Jan. 18, 2022). Because substantially the same art *and* arguments were presented to the Examiner, the Reply fails to demonstrate why denial is not warranted. Reply at 1; *Gardner Denver, Inc. v. Utex Indus., Inc.*, IPR2020-00333, Paper 12 at 16 (P.T.A.B. Aug. 5, 2020).

First, Petitioner does not dispute that Jong was presented to the Examiner, only that the reference was not “fully considered.” Reply at 1. But a reference’s appearance on an IDS “is sufficient to satisfy the first prong of *Advanced Bionics*.” *Atrium Med. Corp. v. Bard Peripheral Vascular, Inc.*, IPR2021-01199, Paper 11 at 23 (P.T.A.B. Jan. 20, 2022); *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 7–8 (P.T.A.B. Feb. 13, 2020) (precedential) (“Previously presented art includes art made by record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS)”); *Siemens Mobility, Inc. v. Metrom Rail, LLC*, IPR2024-00947, Paper 12 at 13 (P.T.A.B. Nov. 19, 2024) (distinguishing *Bowtech* (cited in Reply at 1) as predating *Advanced Bionics*); *Nespresso*, IPR2021-01222,

Paper 9 at 11. Here, Jong was not only disclosed in an IDS considered by the Examiner, but also included in a Notice of References Cited and applied by the Examiner in a rejection during '436 prosecution. Ex. 1010 at 0478; Ex. 2009 at 1134–36, 1140. Therefore, Jong clearly was previously presented under *Advanced Bionics*; that Jong was not specifically “applied as a reference against” a '841 claim does not refute this. *Siemens*, IPR2024-00947, Paper 12 at 13. And as explained in Patent Owner’s Preliminary Response (Paper 6, “POPR”), substantially the same arguments based on Jong were considered. POPR at 39–43. Petitioner’s alleged “unique disclosures” in Jong were also considered by the Examiner as taught by Phumichai, Phumichai and Hosaka, as well as Maris, which Petitioner fails to address. POPR at 41.

Second, substantially the same arguments based on Spooner, Chase, Spring, and Bamberg were considered. For ***Bamberg***, Petitioner ignores that the Examiner considered references teaching the claimed “agronomically desirable trait[s], such as nematode resistance” and “disease resistance.” POPR at 50–51. Bamberg also relates to only a subset of dependent claims (2, 6, and 9) and thus is less relevant for institution. Reply at 2; *Nespresso*, IPR2021-01222, Paper 9 at 15. Petitioner also points to ***Springer***’s “specific teachings as to the importance of genetic distance to achieving heterotic benefit,” which it relies on to argue “[a] POSA would thus have been motivated . . . to cross two inbred lines with at least 20% contrasting

homozygous loci.” Reply at 3; Petition at 50. However, the Examiner already considered “the teachings of Phumichai [] regarding the heterozygosity of two lines” and concluded that “two breeding lines that comprise at least 20% contrasting homozygous loci are obvious,” POPR at 51, to which Petitioner does not respond. For *Chase*, Petitioner does not dispute the breeding scheme of Claim 5 is identical to pending Claim 41, which was previously rejected over Phumichai. Reply at 3, POPR at 48–50. While Petitioner argues that Chase “expressly disclos[es] every step” of Claim 5, the passages it cites do not compare Chase to Claim 5; nor does Petitioner explain how the breeding scheme in Chase meaningfully differs from pending Claim 41 or Phumichai in relation to the challenged claims. Reply at 3. Further, whether Chase’s analytic breeding applies to “all polyploid plants” is irrelevant to the ’841 claims, which recite only *diploid* potatoes. Indeed, Chase describes its “analytic breeding” as involving reducing polyploids to diploids, breeding at the diploid level, and “resynthesis of the polyploid.” Ex. 1007 at 0007, 0005, 0001. Petitioner is also incorrect that arguments based on *Spooner* “clearly were not considered.” *See infra* at 4–5. Further, Petitioner submitting expert testimony does not by itself show substantially the same arguments were not considered. *Regeneron Pharms., Inc. v. Kymab Ltd.*, IPR2019-01579, Paper 9 at 18 (P.T.A.B. Mar. 20, 2020).

Petitioner’s Reply alleges one error by the Examiner, that he accepted Agventure’s “argument that *S. phureja* is not part of a *S. tuberosum* species” and

thus misunderstood Phumichai. Reply at 3. While Agventure disagrees with Petitioner's view of potato classification, Agventure's arguments during prosecution focus on the differences between *S. phureja* and *S. tuberosum* in actual breeding. Ex. 2009 at 560, 647, 989 (severe inbreeding depression of *S. tuberosum*). Indeed, the Examiner was aware of the language "*Solanum tuberosum* Group Phureja" in the '841 specification (Petition at 54) and repeatedly cited a reference stating "*Solanum phureja* . . . has little genetic distinction from . . . *S. tuberosum*" in § 112 rejections. Ex. 1010 at 0511; Ex. 2009 at 477–78, 542, 588, 722, 730, 795, 821.

Petitioner points to no evidence that the Examiner's withdrawal of obviousness rejections during '436 prosecution was driven by the species distinction between *S. phureja* and *S. tuberosum*. Reply at 4 (citing Ex. 2009 at 723 which concerns § 112 rejections). On the contrary, the claim amendments referenced by the Examiner do not concern *S. tuberosum*, and Agventure's arguments and Dr. Lindhout's declaration focus on secondary considerations. Ex. 2009 at 624–31, 717–18; POPR, §§ V.A., V.B. Further, while the Examiner stated that Phumichai "does not mention crossing to *S. tuberosum*" in the last rejection, he concluded *later* in the same rejection that Phumichai "teaches using diploid self-incompatible *S. tuberosum* plants" (which Petitioner appears to admit) and thus rejected pending Claim 13, which Agventure cancelled for allowance. Reply at 4–5 (citing as the last rejection Ex. 2009 at 914–15, which should be 1136); Ex. 2009 at 1173. Even assuming the

Examiner understood Phumichai as not disclosing *S. tuberosum* and assuming such understanding was incorrect, the Examiner did not err materially because he found Bradshaw teaches using *S. tuberosum* lines and combined Bradshaw with Phumichai to find it “*prima facie* obvious . . . to use the *Sli* gene of Phumichai at al. to develop *S. tuberosum* lines.” Ex. 2009 at 915. The ’436 Notice of Allowance also does not mention *S. tuberosum* or *S. phureja*. *Id.* at 1198; *Gardner*, IPR2020-00333, Paper 12 at 15–16. Petitioner’s case law is inapposite. Reply at 5 (citing *Bayer* where Examiner erred for relying on “legally irrelevant information”).

There is further no evidence that the Examiner misunderstood Phumichai during ’841 prosecution. Petitioner is incorrect that Agventure “amended a claim to recite ‘of the species *Solanum tuberosum*’ to overcome an obviousness rejection.” Reply at 5. Indeed, the claim amendment Petitioner cites was not even responsive to the cited rejection. Agventure did not add “*Solanum tuberosum*” in response to the cited rejection, and the amended claim Petitioner cites was responsive to a later Office Action and was revised to require both “*Solanum tuberosum*” and 75% homozygosity. Ex. 1010 at 0447–49, 0520, 1029. The prosecution is clear that “*Solanum tuberosum*” was added to overcome a § 112 rejection and was not relevant to the obviousness rejection in that Office Action, which makes no mention of *S. tuberosum* or *S. phureja*. *Id.* at 0933, 0955–56, 1029, 1044. Petitioner does not show that the Examiner materially erred.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

In compliance with 37 C.F.R. §§ 42.105, 42.6(e), the undersigned hereby certifies that a complete copy of the foregoing document was served on March 31, 2025 on counsel of record for the Petitioner via email to the following addresses:

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