

Petitioner's Request for Director Review
IPR2025-00136
U.S. Patent No. 11,140,841 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Aardevo North America, LLC,
Petitioner

v.

Agventure B.V.,
Patent Owner

Case IPR2025-00136
U.S. Patent No. 11,140,841 B2
Issue Date: October 12, 2021

Title: HYBRID SEED POTATO BREEDING

**PETITIONER'S REQUEST FOR
DIRECTOR REVIEW UNDER 37 C.F.R. § 42.75**

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Petitioner Aardevo North America, LLC respectfully requests Director Review of the Board's decision not to institute IPR of U.S. Patent No. 11,140,841 B2 ("841 patent"). Paper 9 ("Decision"). Director Review is warranted for several reasons. First, the Decision overlooked and ignored several of Petitioner's well-supported arguments. For example, the Decision concluded that Grounds 6-9 were not based on printed publications as required by 35 U.S.C. § 311 when, in fact, they were expressly based on printed publications. Additionally, the Decision erroneously determined that Petitioner failed to address secondary considerations, overlooking specific arguments in the Petition and the accompanying unrebutted expert declaration directly addressing those issues. Second, the Decision did not properly weigh Petitioner's evidence of *prima facie* obviousness. Instead, it wrongly relied only on unreliable statements made during prosecution of a parent patent as evidence of secondary considerations, and failed to assess nexus as required. Third, the Decision rejected unrebutted testimony of Petitioner's expert in favor of unsubstantiated Patent Owner ("PO") attorney argument regarding anticipation. As to the second and third of these defects, at most, PO's attorney arguments and unreliable evidence raise factual disputes that are best resolved only on a full trial record. Each of these defects independently constitutes an abuse of discretion sufficient to merit reversal of the Decision and institution of trial.

I. The Decision Erroneously Overlooked or Ignored Several of Petitioner's Arguments and thus Was an Abuse of Discretion (Ground 2-9)

The Director has held that the Board abuses its discretion when, as here, it fails to address the petitioner's contentions. *See Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 18 at 2-3, 5 (PTAB Mar. 28, 2024) (vacating the Board's denial of institution when it "did not sufficiently explain its findings" and "did not adequately address Petitioner's contentions"); *Prime Time Toys LLC v. Spin Master, Inc.*, IPR2023-01339, Paper 12 at 2-3 (PTAB July 9, 2024) (reversing the Board's denial to institute IPR when the Board failed to consider petitioner's evidence of obviousness); *Semiconductor Components Indus., LLC v. Greenthread, LLC*, IPR2023-01242, Paper 94 at 4 (PTAB Apr. 24, 2025) (finding that the Board abused its discretion by not fully addressing arguments). Here, with respect to Petitioner's Grounds 6-9, the Board erroneously found they were not based on patents or printed publications as required by 35 U.S.C. § 311 – when in fact they were. *See Decision*, 7-8. Further, the Board wrongly held Petitioner entirely failed to address secondary considerations issues when, in fact, Petitioner expressly addressed them. *See id.*, 32.

A. The Decision Erroneously Ignored Petitioner's Evidence Regarding Inherent Anticipation Based on the Express Disclosures of Printed Publications (Grounds 6-9)

The rejection of Grounds 6-9 was based entirely on the Board's mistaken finding that "Petitioner [did] not cite any specific printed publication[.]" *Decision*,

7-8. This finding was clearly erroneous and overlooked Petitioner's arguments based on the express disclosures of at least two printed publications: Jong (EX1004) (describing the W4 potato line) and Voort (EX1070) (describing the RH89-039-16 potato line). Paper 2 ("Pet."), 69 ("the US-W4 line disclosed in Jong as a self-compatibility donor meets all the limitations of Claim 1"); *id.*, 71 ("RH89-039-16 was described in several prior art references, such as Voort."). These arguments were further supported by Petitioner's expert, Dr. Jansky. EX1002, ¶¶291-313. The record simply cannot support the Board's finding that "Petitioner [did] not cite any specific printed publication," or that the "Patent Owner ha[d] the better position" on this issue. Decision, 8. Instead, the literal words of the Petition made clear that each of Grounds 6-9 was based on printed publications; the Decision's unsupported finding otherwise was clearly erroneously and an abuse of discretion.

B. The Decision Erroneously Ignored Petitioner's Evidence and Arguments Regarding Secondary Considerations of Nonobviousness (Grounds 2-5)

The Decision also wrongly stated that Petitioner did not address "any objective indica" and on this basis improperly rejected Obviousness Grounds 2-5. Decision, 23, 33. It further found that Petitioner's failure to address objective indica was "telling" and inferred that Petitioner "does not refute" such evidence. *Id.*, 33. This determination was an abuse of discretion for several reasons as further discussed below. *See infra* Section II. But as a threshold matter, the Board

overlooked that Petitioner and its expert did address alleged secondary considerations available in the prosecution history of the challenged patent family. *See* Pet., 73-74 (Heading “No Secondary Considerations of Nonobviousness”); EX1002, ¶¶314-322. For example,

- No industry praise: any claims of industry praise were due to elements already known in the art, such as self-compatibility conferred by the *Sli* gene and increased homozygosity through selfing (EX1002, ¶316);
- No unexpected results: true breeding lines of potato were known in the art; *Sli* gene had already been used to successfully inbreed potatoes; and breeders knew to select for fertility (*id.*, ¶¶317-319);
- No long-felt need: methods for creating diploid, fertile, self-compatible, highly homozygous, high yielding potatoes were known (*id.*, ¶321).

The Decision never cited or acknowledged this evidence and argument. The Board's finding that Petitioner did not address any known evidence of nonobviousness is plainly incorrect and constituted an abuse of discretion.

Worse still, the Board criticized Petitioner for not responding to such evidence in its Preliminary Reply. Decision, 32. In this case, per 37 C.F.R. § 42.108, Petitioner was authorized to reply only as to the issue of § 325(d) discretionary denial. *See* Paper 7 (“Reply”). Petitioner thus limited the Reply to its authorized

scope. *See Emerson Elec. Co. v. SIPCO, LLC*, IPR2019-00549, Paper 14 at 3 (PTAB July 30, 2019) (“[W]e will . . . disregard or give no weight to arguments and evidence [in preliminary replies] that we deem to be beyond the authorized scope.”). The Board’s unfair criticism of Petitioner’s compliance with the rules further shows why the Decision was an abuse of discretion.

II. The Decision’s Erroneous Determination on Obviousness Was an Abuse of Discretion (Grounds 2-5)

A. The Decision Failed to Consider and Weigh Petitioner’s Obviousness Arguments

As a separate basis for abuse of discretion warranting reversal, the Board also failed to analyze and weigh Petitioner’s evidence and arguments of *prima facie* obviousness. The Petition devoted more than 30 pages to articulating Petitioner’s showing of *prima facie* obviousness, citing numerous prior art references and providing detailed evidence of motivation to combine and reasonable expectation of success – all supported by the detailed (and unrebutted) expert declaration of Dr. Jansky. Pet., 37-69; EX1002, ¶¶156-290. The Board did not discuss or consider (let alone weigh) the strength of any of Petitioner’s substantive showing beyond providing a summary. Decision, 23-28. And as noted above, it also completely ignored Petitioner’s express arguments and evidence dealing with known evidence relating to secondary considerations.

It was an abuse of discretion for the Board to credit PO’s pure attorney

arguments, unsupported by any expert, over sworn testimony of Petitioner's un rebutted expert declaration. *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017) ("Attorney argument is not evidence."); *Giesecke+Devrient GmbH v. Lumenco, LLC*, IPR2024-00838, Paper 8 at 15 (PTAB Nov. 25, 2024) ("Mere attorney argument has little evidentiary value and does not outweigh the testimonial evidence of [petitioner's expert], which presently stands un rebutted."); *Invitrogen Corp. v. Clontech Lab 'ys, Inc.*, 429 F.3d 1052, 1068 (Fed. Cir. 2005) ("Unsubstantiated attorney argument regarding the meaning of technical evidence is no substitute for competent, substantiated expert testimony."). On the current record, Petitioner's expert testimony stands un rebutted; this should have been given significant weight. *See Vizio, Inc. v. Maxell, Ltd.*, IPR2022-01463, Paper 7 at 22 (PTAB Apr. 11, 2023); *Hilti AG v. Specified Techs. Inc.*, IPR2024-00192, Paper 16 at 33-34 (PTAB May 14, 2024).

Here, the claims were found not obvious "as [the Board] balance[s] the objective indicia evidence with Petitioner's case of obviousness and failure to address the objective indicia evidence, even if [it] found Petitioner's case sufficient to establish prima facie obviousness[.]" Decision, 34-35. Yet the Decision never performed balancing or evaluation of Petitioner's *prima face* obviousness case. Instead, the Board skipped that analysis and found the claims nonobvious based on

PO's attorney arguments and the Board's inaccurate belief that Petitioner did not address those issues at all. The Board's failure to engage with the merits of Petitioner's *prima facie* obviousness case, including Dr. Jansky's declaration, was itself an abuse of discretion warranting reversal.

The Board's unprecedented finding of nonobviousness based on secondary considerations without analyzing Petitioner's *prima facie* obviousness case has no support from the law, which requires a balancing of the evidence after considering evidence of obviousness. *See Bristol-Myers Squibb Co. v. Teva Pharms. USA, Inc.*, 752 F.3d 967, 977 (Fed. Cir. 2014) (secondary considerations "do not necessarily control the obviousness determination"); *Nearmap US, Inc. v. Eagle View Techs., Inc.*, IPR2022-00734, Paper 43 at 9-10 (PTAB Feb. 20, 2024) (vacating the Board's determination that evidence of secondary considerations "outweigh[ed] Petitioner's obviousness contentions" without explaining "how and why it assign[ed] a weight to each component of its analysis"); *Cubist Pharms., Inc. v. Hospira, Inc.*, 805 F.3d 1112, 1126 (Fed. Cir. 2015); *Newell Cos., Inc. v. Kenney Mfg. Co.*, 864 F.2d 757, 769 (Fed. Cir. 1988).

Indeed, the Federal Circuit refers to objective indica of nonobviousness as "secondary considerations." *In re Huai-Hung Kao*, 639 F.3d 1057, 1071-72 (Fed. Cir. 2011). This nomenclature is telling: any evidence of nonobviousness must be

considered along with evidence of obviousness. The Board itself cites *Pfizer*, where the Court found challenged claims obvious because secondary considerations could not overcome the showing of obviousness. *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1372 (Fed. Cir. 2007). The Board should have made its obviousness determination only after considering “all evidence in the record,” including Petitioner’s evidence of obviousness. *Hanwha Sols. Corp. v. REC Solar PTE. Ltd.*, IPR2021-00988, Paper 40 at 57 (PTAB Dec. 9, 2022); *see also Nuna Baby Essentials, Inc. v. Britax Child Safety, Inc.*, IPR2019-00663, Paper 20 at 63-64 (PTAB Sept. 2, 2020); *Micron Tech., Inc. v. North Star Innovations, Inc.*, IPR2018-01000, Paper 33 at 33 (PTAB Oct. 24, 2019). It failed to do so.

Other cases cited by the Board or PO do not support the Decision because the Board in those cases properly considered and weighed the petitioner’s *prima facie* showing of obviousness. *See Omron Oilfield & Marine Inc. v. MD/TOTCO*, IPR2013-00265, Paper 11 at 12-13 (PTAB Oct. 31, 2013) (finding that evidence of secondary considerations “overcame the *prima facie* case” of obviousness (emphasis added)); *Coalition for Affordable Drugs V LLC v. Hoffman–LaRoche, Inc.*, IPR2015-01792, Paper 14 at 15-18 (PTAB Mar. 11, 2016) (denying institution only after adequately explaining why petitioner failed to establish a *prima facie* case of obviousness); *Merck Sharp & Dohme Corp. v. Genentech, Inc.*, PGR2021-00036,

Paper 10 at 29-34 (PTAB July 24, 2021) (same); *Robert Bosch Tool Corp. v. SD3, LLC*, IPR2016-01751, Paper 15 at 32-33 (PTAB Mar. 22, 2017) (denying institution after “[w]eighing the evidence of obviousness and nonobviousness as a whole” and finding nexus). Unlike the cases relied on by the Board and PO,¹ here, the Board failed to first make a *prima facie* determination of obviousness.

B. The Decision Failed to Assess Nexus Before According Substantial Weight to any Evidence of Secondary Considerations

Even setting aside all these defects, the Decision was fatally flawed for another reason: it failed to assess the nexus requirement between secondary considerations and the invention as claimed. The law is settled that, “[i]n order to

¹ Such cases are distinguishable. In *Stryker Corp. v. KFX Medical, LLC*, the Board found that petitioner's failure to address a prior litigation weighed further in favor of denying institution in addition to the rest of the *Becton, Dickinson* factors. IPR2019-00817, Paper 10 at 28-29 (PTAB Sept. 16, 2019). In *Praxair Distribution, Inc. v. Mallinckrodt Hospital Products*, the Board discretionarily declined to institute when “[d]espite [the Board's] admonition for failing to address the evidence of secondary considerations in the prior proceedings, the current Petitions suffer[ed] from that same fatal flaw.” IPR2016-00779, Paper 11 at 8–10, 12 (PTAB Sept. 22, 2016). There is no such “same fatal flaw” or any past “admonition” in this case.

accord substantial weight to secondary considerations. . . , ‘the evidence of secondary considerations must have a nexus to the claims, *i.e.*, there must be a legally and factually sufficient connection between the evidence and the patented inventions.’” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373 (Fed. Cir. 2019); *see also IBG LLC v. Trading Techs. Int’l, Inc.*, CBM2015-00181, Paper 138 at 56 (PTAB Mar. 3, 2017) (“To be relevant, secondary evidence of non-obviousness must be commensurate in scope with the claimed invention.”). In the absence of nexus, evidence of objective indicia is given “little to no weight.” *Affordable Wire Management, LLC v. Cambria Cnty. Ass’n for the Blind & Handicapped, Inc.*, IPR2024-00178, Paper 17 at 40-41 (PTAB Apr. 24, 2024). Yet here, the Board wrongly assumed nexus, without any analysis to support that determination.

The Board’s errors with respect to nexus flow directly from its failure to consider Petitioner’s *prima facie* showing that the claim limitations were obvious in view of the prior art. It is well-established that a nexus cannot be established where the evidence of secondary considerations is based on elements known in the art. *See, e.g., Tokai Corp. v. Easton Enters., Inc.*, 632 F.3d 1358, 1369-70 (Fed. Cir. 2011); *see also, e.g., Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006); *In re Huai-Hung Kao*, 639 F.3d at 1068; *see also supra*, I.B.

In fact, the Board could never have found the required nexus because there is

no evidence in the record to support such a finding. None of the prosecution statements relied on by the Board ties the alleged objective indications of nonobviousness to the elements of the claimed invention. For example, the Board relies on prosecution declarations generically referencing “[t]his research,” “promising material,” “a good performing homozygous potato plant,” and “good agronomical properties” as evidence of nonobviousness of the claimed invention. Decision, 29-34. Similarly, other statements on which the Decision relies generally discuss potato breeding, without any effort to tie the evidence to the claimed invention. Decision, 33 (quoting Dr. Huang’s statement that “This [research] is crucial for the potato breeding worldwide”); *id.*, 34 (quoting National Icon 2014 award that stated “new breeding technique with potato seed instead of potatoes”). Neither PO nor the Board attempts to show how such generic statements have any nexus with the expressly recited limitations of the claims. *Id.*; *see also* Paper 6 (“POPR”), 24, 28-31.

Indeed, the only evidence of record that is tied to the invention as claimed is Dr. Jansky’s un rebutted declaration establishing that there is nothing nonobvious about the invention. For example, the yield and homozygosity limitations of the claims did not satisfy any long felt but unmet need, in part because those limitations were not an improvement over what was already disclosed in the art. *See* EX1002, ¶¶54-55, 72-73, 297-298, 309-310, 314-322. The Decision’s obviousness

conclusion was thus an abuse of discretion.

C. The Decision Gave Undue Weight to Unreliable Inventor Statements Made During Prosecution

The Decision also erred by relying on unreliable inventor statements made during prosecution as evidence of secondary considerations. Decision, 32-35. Inventor declarations provided during prosecution are “inherently inadequate and untrustworthy.” See *Abbott Vascular, Inc. v. Flexstent*, IPR2019-00882, Paper 48 at 31-37 (PTAB Oct. 2, 2020); cf *DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1371 (Fed. Cir. 2006) (reasonable expectation of success is analyzed by “the work of a [POSITA], not of an inventor”). For example, the Board has previously excluded inventor prosecution statements from secondary considerations evidence. *Abbott Vascular*, IPR2019-00882, Paper 48 at 31. As noted, in *Abbott* the Board reasoned that the inventor statement was “inherently inadequate and untrustworthy,” *id.*, 36, when the patent owner failed to make the inventor available for a deposition, thus depriving petitioner the opportunity to cross-examine on the inventor’s prosecution statements. *Id.*, 33-34. So too here, where Dr. Lindhout could not have been examined in the absence of an instituted trial, the testimony is “inherently inadequate and untrustworthy.”

At the very least, at this point in the proceeding, where none of the declarants relied on for secondary considerations evidence have testified, such evidence should

be given “greatly lessen[ed] probative value.” *Skyhawk Techs., LLC v. L&H Concepts, LLC*, IPR2014-00437, Paper 31 at 25-26 (PTAB July 10, 2015). This is particularly problematic here, where such prosecution statements were the only type of evidence cited by the Board (and the PO) as evidence of nonobviousness. *See generally* Decision, 32-35. The Decision's crediting of PO attorney argument and unreliable declaration statements over Petitioner's unrebutted expert declaration was an abuse of discretion warranting reversal.

III. The Decision's Determination on Anticipation Based on Jong Was an Abuse of Discretion (Ground 1)

Lastly, the Decision wrongly accepted PO's unsubstantiated attorney argument over the unrebutted evidence of Petitioner's expert regarding Ground 1, anticipation based on Jong. For example, Jong teaches that heterozygosity is reduced by 50% every generation of selfing and expressly discloses S₂ potato lines. Pet., 32-35. Dr. Jansky testified that, based on these teachings of Jong, a POSA would have understood that Jong's S₂ plant was at least 75% homozygous. EX1002, ¶¶140-143. In response, PO argued that Jong fails to “expressly disclose” the 75% homozygosity element and instead relied on the disclosures of Phumichai. POPR, 14-16. The Board similarly rejected Petitioner's Ground 1 because Jong does not expressly disclose “75% homozygosity.” Decision, 14-15. In doing so, the Board completely ignored Dr. Jansky's testimony regarding how a POSA would have

understood the teachings of Jong, instead crediting PO's unsubstantiated attorney argument, despite that attorneys cannot give evidence of what a POSA would understand. *See Abbott Diabetes Care Inc. v. Dexcom, Inc.*, IPR2024-00859, Paper 12 at 43 (PTAB Nov. 20, 2024). Therefore, the Board's decision on Ground 1 was an abuse of discretion that warrants a reversal.

IV. Conclusion

Petitioner need only establish a "reasonable likelihood" of prevailing as to one Ground for institution of a trial. 35 U.S.C. § 314(a); *PreOmics GmbH et al v. Brigham and & Women's HospitalHosp., Inc.*, IPR2024-01473, Paper 11 at 24 (PTAB Apr. 17, 2025). Further, "there is a significant difference between a petitioner's burden to establish a 'reasonable likelihood of success' at institution, and actually proving invalidity by a preponderance of the evidence at trial." *Liberty Energy, Inc. v. U.S. Well Services., LLC*, IPR2024-01274, Paper 6 at 34 (PTAB Mar. 24, 2025). Here, Petitioner amply discharged its burden of showing a "reasonable likelihood" of prevailing for institution, supported by unrebutted expert testimony.

At most, PO's attorney arguments and unreliable evidence raise factual disputes that should be resolved on a full trial record. *See, e.g., Arashi Vision LLC v. GoPro, Inc.*, IPR2024-01186, Paper 9 at 32-33 (PTAB Jan. 22, 2025) (instituting IPR in view of "a disputed fact issue to finally resolve at trial" and patent owner's argument that did not "undermine Petitioner's showing for institution purposes");

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Samsung Elecs. Am., Inc. v. Snik LLC, IPR2020-01324, Paper 9 at 20 (PTAB Mar. 9, 2021) (“At most, Patent Owner’s alternative reading of [prior art] raises a factual dispute best resolved on a full record.”); *Permian Glob. Inc. v. Fuel Automation Station, LLC*, IPR2023-01238, Paper 11 at 17 (PTAB Feb. 28, 2024). Especially, “full[] evaluat[ion]” of evidence of secondary considerations has traditionally been reserved for trial “when the ultimate determination of obviousness is made.” *Gene Co. Pty Ltd. v. The Trustees. of Columbia Univ.*, IPR2024-00313, Paper 13 at 41-42 (PTAB June 24, 2024); *Mueller Sys., LLC v. Rein Tech, Inc.*, IPR2020-00098, Paper 11 at 23 (PTAB May 12, 2020) (reserving evaluation of secondary considerations for after a complete trial and the record is “more fully developed”).

For the foregoing reasons, Petitioner respectfully requests Director Review of the Decision, and for an order reversing the Decision and instituting IPR.

Dated: May 30, 2025

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CERTIFICATE OF SERVICE

I hereby certify, pursuant to 37 C.F.R. Sections 42.6, that a complete copy of the attached **Petitioner's Request for Director Review** is being served via electronic mail on May 30, 2025, upon Patent Owner by serving Patent Owner's counsel of record in this proceeding as follows:

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