

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THORNE RESEARCH, INC. and THORNE HEALTHTECH, INC.,
Petitioners,

v.
CHROMADEX, INC.,
Patent Owner.

IPR2026-00400
U.S. Patent No. 12,252,506

**PATENT OWNER'S REPLY IN SUPPORT OF ITS REQUEST FOR
DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	THE <i>FINTIV</i> FACTORS FAVOR DENIAL	1
III.	PETITIONER’S UNTIMELY LEXICOGRAPHY ARGUMENT IS IMPROPER	4
IV.	CONCLUSION.....	5

EXHIBIT LIST

Exhibit	Description
2001	Conference and Scheduling Order, Case No. 2:26-cv-01758-RMG (D.S.C.)
2002	Complaint for Declaratory Judgment, Case No. 2:26-cv-01758-RMG (D.S.C.)
2003	Notice of Filing Proof of Service, Case No. 2:26-cv-01758-RMG (D.S.C.)
2004	U.S. Patent No. 11,981,698 to Migaud et al.
2005	U.S. Patent No. 11,584,770 to Migaud et al.
2006	U.S. Patent No. 10,815,262 to Migaud et al.
2007	U.S. Patent No. 10,000,519 to Migaud et al.
2008	U.S. Patent No. 10,815,262 File History
2009	U.S. Patent Publication No. 2018/0186824 to Migaud et al.
2010	Answer and Counterclaim, Case No. 2:26-cv-01758-RMG (D.S.C.)
2011	Declaration of Ron Bihovsky, Ph.D in support of Patent Owner's Preliminary Response
2012	Curriculum Vitae of Dr. Ron Bihovsky
2013	Clayden et al., Organic Chemistry (2 nd ed. 2012)
2014	U.S. Patent Application Publication No. 2005/0010603 A1

I. INTRODUCTION

Petitioner's Opposition confirms that discretionary denial is warranted. Petitioner does not dispute any of the material facts raised in Patent Owner's Motion for Discretionary Denial. Instead, it injects a claim-construction theory that appears nowhere in its Petition and resorts to mischaracterizing the district-court record. Both moves fail. Applied correctly, the *Fintiv* factors favor denial at least because (1) a scheduled district-court trial will precede any final written decision, (2) the parties have already invested substantially in the parallel case, and (3) Petitioner's limited stipulation does not reach the dispositive issue regarding the risk of overlapping litigation. Independently, Section 325(d) supports denial because Petitioner asks the Board to revisit the very R₆–R₈ priority question the Office already resolved during prosecution of the great-grandparent '262 patent. The Director should deny institution.

II. THE *FINTIV* FACTORS FAVOR DENIAL

Regarding Factor 2, Petitioner mischaracterizes the likely trial date. The operative Scheduling Order entered by the district court notes the case is “subject to being called for jury selection and/or trial on or after July 06, 2027.” EX2001 at 3. The parties have submitted competing schedule proposals, with Patent Owner's proposed date matching the operative schedule's date of July 6, 2027 and Petitioner

requesting a trial setting of April 3, 2028. EX1030 at 22. Petitioner's reliance on the median figure asks the Board to ignore the court's operative order and Patent Owner's proposed trial date. Factor 2 strongly favors discretionary denial.

Concerning Factor 3, Petitioner's claim of "minimal" investment, resting on the absence of a claim-construction order, is both legally incomplete and factually inaccurate. The parties have taken active steps to litigate the corresponding district court case, including (1) Patent Owner's filing of a counterclaim for infringement of the '506 patent; (2) Petitioner's filing of a counter-counterclaim for invalidity; (3) meeting for a Rule 26(f) conference; (4) filing a detailed joint report containing fact- and expert-witness disclosures; (5) exchanging initial disclosures on September 21, 2026; and (6) serving written discovery requests interrogatories, requests for production, and requests for admission—many of which concern validity of the '506 Patent. *See* EX2010; EX1030. By the time the institution decision is decided, under either proposed schedule, the parties will have additionally served (i) non-infringement contentions; (ii) invalidity contentions; and (iii) responses to invalidity contentions. EX1030 at 19–20. Further, if Defendants' proposed schedule, which takes into account the operative trial date, is adopted, the parties will have additionally exchanged proposed claim terms for construction, exchanged preliminary constructions, and filed a joint claim construction statement. EX1030 at

20. That is substantial, duplicative investment. Factor 3 supports discretionary denial.

As to Factor 4, Petitioner treats its stipulation as dispositive proof of “no risk of overlapping litigation.” Opp. at 2–4. It is neither. Under the Office’s March 24, 2025 guidance, a *Sotera* stipulation is “highly relevant” but not dispositive; the Board weighs it as one part of a holistic *Fintiv* analysis. Here, the stipulation does not come close to eliminating overlap. Factor 4 favors denial.

Critically, the issue that drives both proceedings is not a stipulated ground. Petitioner’s case turns on a single question: whether the claims of the ’506 Patent are entitled to their pre-2023 priority date, which is a question of Section 112 written description and enablement. Pet. at 12–29. Petitioner’s stipulation is narrower still: by its terms it waives only grounds that “could be raised under Sections 102 or 103 ... only on the basis of prior art patents or printed publications,” and it expressly preserves Thorne’s right to assert invalidity “on any other ground.” Ex. 1028. The Section 112 priority dispute is one such “other ground”: it falls outside the stipulation, is expressly pleaded in Thorne’s district court counter-counterclaim through allegations of invalidity under Section 112 (EX1027 at 19, 23, 28, 29), and will be litigated there, whether or not the Board institutes. Thus, institution would not narrow that dispute; it would replicate it.

Further, even as to prior-art invalidity, the stipulation leaves substantial overlap. It is not a Sotera-plus stipulation and does not foreclose system or product prior art. As the Federal Circuit held in *Ingenico*, IPR estoppel “does not preclude a petitioner from relying on the same patents and printed publications as evidence in asserting a ground that could not be raised during the IPR, such as that the claimed invention was known or used by others, on sale, or in public use.” *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365–66 (Fed. Cir. May 7, 2025). Thorne thus remains free to litigate on-sale and public-use invalidity in the district court—grounds the stipulation does not touch and that no final written decision could ever touch.

Factor 5 (party identity) favors denial because Petitioner is the district-court plaintiff asserting affirmative invalidity claims and seeking a second forum to litigate overlapping invalidity challenges to the same patent. Factor 6 favors denial for the reasons set forth in the Request and below. Together, the factors confirm that institution would not promote efficiency but rather multiply proceedings.

III. PETITIONER'S UNTIMELY LEXICOGRAPHY ARGUMENT IS IMPROPER

Unable to defend its Petition as filed, Petitioner's Opposition unveils a new theory: that Patent Owner “act[ed] as its own lexicographer,” concerning terms R₆–R₈ and that the Examiner “materially erred” by failing to apply the definition to the

claims. Opp. 7–8, 12–14. The Petition says none of this. It never invokes the lexicography doctrine and never contends the Examiner “erred.” Pet. 8–9. Dr. Prestwich’s declaration likewise never mentions lexicography. Likewise, lexicography was not raised in Patent Owner’s Request for Discretionary Denial.

A petitioner may not use later briefing to supply arguments missing from its petition. 35 U.S.C. § 312. The merits relevant to *Fintiv* Factor 6 and to the Section 325(d) analysis are assessed on the petition as filed; a new argument raised for the first time in opposition cannot be treated as part of the challenge and cannot rehabilitate the Petition’s deficiencies. The lexicography theory should be disregarded. Further, 37 CFR § 42.104 requires the Petition to include “a statement of the precise relief requested” including how “the challenged claim is to be construed.” 37 CFR § 42.104(b)(3). Nowhere in the Petition is there a clear recitation of which term(s) are to be construed and how, let alone a clear argument regarding lexicography. At most, Dr. Prestwich explicitly stated that he “applied the plain and ordinary meaning of the claims in [his] analysis.”

IV. CONCLUSION

For the foregoing reasons, and those stated in the Request, Patent Owner respectfully requests that the Director deny institution of inter partes review.

Patent Owner's Preliminary Response
to Petition for *Inter Partes* Review
Patent No. 12,252,506

Date: October 7, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that the foregoing **PATENT OWNER'S
REPLY IN SUPPORT OF ITS REQUEST FOR DISCRETIONARY DENIAL**
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