

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNGENTA CROP PROTECTION AG,
Petitioner,

v.

UPL LTD,
Patent Owner.

PGR2023-00017
U.S. Patent No. 11,445,727

**PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL
INFORMATION PURSUANT TO 37 C.F.R. § 42.223(a)**

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TABLE OF AUTHORITIES

Cases

<i>Genzyme Therapeutic Products Ltd. Partnership v. Biomarin Pharmaceutical Inc.</i> 825 F.3d 1360 (Fed. Cir. 2016)	3
<i>Pacific Market Int’l LLC v. Ignite USA, LLC</i> IPR2014-00561, Paper No. 23 (PTAB Dec. 2, 2014)	3, 7
<i>Palo Alto Networks, Inc. v. Juniper Networks, Inc.</i> IPR2013-00369, Paper 37 (PTAB Feb. 5, 2014).....	5
<i>Redline Detection, LLC v. Star Envirotech, Inc.</i> 811 F.3d 435 (Fed. Cir. 2015)	2, 8

Other Authorities

37 C.F.R. § 42.20(c).....	2
37 C.F.R. § 42.223(a).....	1, 2, 7

EXHIBIT LIST

Ex. No.	Description
1001	U.S. Patent No. 11,445,727 (“the ’727 Patent”).
1002	Selected Excerpts of the File History of the ’727 Patent
1003	Declaration of Phillip M. Brannen, Ph.D.
1004	Godoy et al. “Eficiência de fungicidas multissítios no controle da ferrugem-asiática da soja, <i>Phakopsora pachyrhizi</i> , na safra 2015/16: resultados sumarizados dos ensaios cooperativos”, Londrina, PR Agosto 2016 (Embrapa Soja, Circular Técnica, 121) (“Godoy”)
1005	Certified Translation of Godoy “Efficiency of multisite fungicides in controlling Asian soybean rust, <i>Phakopsora pachyrhizi</i> , in the 2015/16 harvest: summarized results of cooperative trials”, Londrina, PR August 2016 (Embrapa Soja, Circular Técnica, 121)
1006	U.S. Patent No. 9,314,022 to Tobler et al. of Syngenta (“the ’022 Patent” or “Tobler”)
1007	WO Application Pub. No. 2015/079334 to De Oliveira of UPL, Ltd (the “WO’334” or “De Oliveira”)
1008	Wiglesworth et al. “Solatenol™ fungicide – a new SDHI fungicide from Syngenta” <i>Phytopathology</i> (2015) 105(Supl. 2) No. 4, p. S2.11 (“Wiglesworth”)
1009	Elatus EPA Reg. No. 100-1480 dated 8/28/2015 (“Elatus EPA Label”)
1010	Gullino et al. “Mancozeb Past, Present, and Future”, <i>Plant Disease</i> (2010) Vol. 94, No. 9, pp. 1076-1087 (“Gullino”)

Ex. No.	Description
1011	The Pesticide Manual, 17 th Ed. Turner, J.A. Editor (2015), excerpted monographs
1012	Colby, S.R., “Calculating Synergistic and Antagonistic Responses of Herbicide Combinations”, Weeds, Vol. 15, No. 1 (1967) pp. 20-22 (“Colby”)
1013	Gisi et al. “Synergistic Interactions of Fungicides with Different Modes of Action”, Trans. Br. Mycol. Soc. (1985) 85(2), pp. 299-306 (“Gisi”)
1014	Levy et al. “The joint action of fungicides in mixtures: comparison of two methods for synergy calculation”, European and Mediterranean Plant Protection Organization (EPPO) Bulletin (1986) 16(4), pp 651-657 (“Levy”)
1015	Koller et al. “Evaluation of Tactics for Managing Resistance of <i>Venturia inaequalis</i> to Sterol Demethylation Inhibitors”, Plant Disease (1999) pp 857-863 (“Koller”)
1016	Emery et al. “Assessment of interactions between components of fungicide mixtures against <i>Monilinia fructicola</i> ”, Crop Protection (2002) 21, pp 41–47 (“Emery”)
1017	Moura et al., “Effects of cyproconazole, azoxystrobin and mineral oil on soybean leaf anatomy”, Dourados (2013) v.6, n.20, p.154-160 (“Moura”)
1018	Della Vechia et al., “Physical characteristics of insecticide spraying liquids with mineral oil and droplets formed on citrus leaves”, Citrus Research & Technology, (2016) v. 37, n. 1, pp. 102-107 (Della Vechia”)
1019	Declaration of Sylvia Hall-Ellis, Ph.D.
1020	Declaration of Caio Prates

Ex. No.	Description
1021	Declaration of Gilson Aparecido Hermenegildo de Oliveira submitted in U.S. Patent App. Ser. No. 15/673,316
1022	Supplemental Declaration of Sylvia Hall-Ellis, Ph.D.
1023	Declaration of Ryan Kody Jones
1024	Brazilian trademark, Process No.: 007161867, registration for NIMBUS, class 1 registration
1025	Certified translation of Ex. 1024, Brazilian trademark registration of NIMBUS
1026	Brazilian trademark, Process No.: 200012975, registration for NIMBUS, class 5 registration
1027	Certified translation of Ex. 1026, Brazilian trademark registration of NIMBUS
1028	NIMBUS material safety and data sheet (MSDS)
1029	Certified translation of Ex. 1028, NIMBUS MSDS
1030	Machado <i>et al.</i> “Is tank mixing site-specific premixes and multi-site fungicides effective and economic for managing soybean rust? a meta-analysis,” Crop Protection, Volume 151, 2022, 105839 (pp. 1-9) (“Machado”)

INTRODUCTION

Pursuant to 37 C.F.R. § 42.223(a), Syngenta Crop Protection AG (“Petitioner”) seeks to submit supplemental evidence. Petitioner requested permission to submit this motion on August 27, 2023, within one month of the institution date, July 31, 2023. By email, on August 28, 2023, the Board authorized Petitioner to file this Motion to submit Supplemental Information.

Petitioner’s supplemental information responds to the Board’s invitation, in the Institution Decision, for the parties to more “fully develop the record during trial.” Paper 8 at 18. The information directly relates to: (1) confirming the public availability of Godoy (Ex. 1004/1005); (2) confirming Nimbus, as disclosed in Godoy, is a mineral oil—not a sulfur-based fungicide; and (3) confirming Godoy discloses tank-mixed fungicides. *Id.* at 17-18.

Accordingly, Petitioner submits: (1) Ex. 1022, a supplemental declaration from Dr. Hall-Ellis, and supporting material, confirming the public availability of Godoy; (2) Exs. 1023-1029, product information and trademark registrations for Nimbus as a mineral oil in Brazil, and supporting material therefor; and (3) Ex. 1030, the “Machado” article—on which Dr. Godoy herself is an author—which states and confirms that Godoy discloses use of a tank-mix.

These documents do not change Petitioner’s Grounds or any evidence already presented. Rather, this supplemental information removes Patent Owner’s

spurious arguments and streamlines the issues as to at least Ground 1 (claims 1, 3-5, 7, 9, and 10) from the Petition for Post-Grant Review (the “Petition”), on which trial has been instituted for all claims.

BACKGROUND

The Preliminary Response of Patent Owner attacked the credibility and expertise of Petitioner’s Declarant, Dr. Hall-Ellis; and asserted Petitioner had not established Godoy was publicly accessible before the critical date of the ’727 patent, November 4, 2016. Patent Owner further presented Exhibits 2003-2010 to support their representation that the Nimbus referred to in Godoy was an additional fungicide—not a mineral oil. Patent Owner used Exhibits 2001/2002 in an attempt to mischaracterize the contents of Godoy. These sham issues could not have been reasonably anticipated by Petitioner.

ARGUMENT

A party may move to submit supplemental information that is “relevant to a claim for which the trial has been instituted.” 37 C.F.R. § 42.223(a)(2). Petitioner bears the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. § 42.20(c). The Board has discretion to grant or deny such motions as it sees fit. *Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435 (Fed. Cir. 2015). The timing and authorization requirements of 37 C.F.R. § 42.223(a) have been met, as discussed above.

The provisions of 37 C.F.R. § 42.223 “contemplate scenarios in which, after institution of trial in an [Post-Grant Review], supplemental information may prove beneficial to the Board in reaching a decision with respect to the trial.” *See Pacific Market Int’l LLC v. Ignite USA, LLC*, IPR2014-00561, Paper No. 23, p. 3 (PTAB Dec. 2, 2014). The Federal Circuit has explained that “the introduction of new evidence in the course of the trial is to be expected in [Post-Grant] review trial proceedings,” that “[t]he development of evidence in the course of the trial is in keeping with the oppositional nature of a [Post-Grant] review proceeding,” and that “[t]he purpose of the trial in a [Post-Grant] review proceeding is to give the parties an opportunity to build a record by introducing evidence—not simply to weigh evidence of which the Board is already aware.” *See Genzyme Therapeutic Products Ltd. Partnership v. Biomarin Pharmaceutical Inc.*, 825 F.3d 1360, 1366-67 (Fed. Cir. 2016).

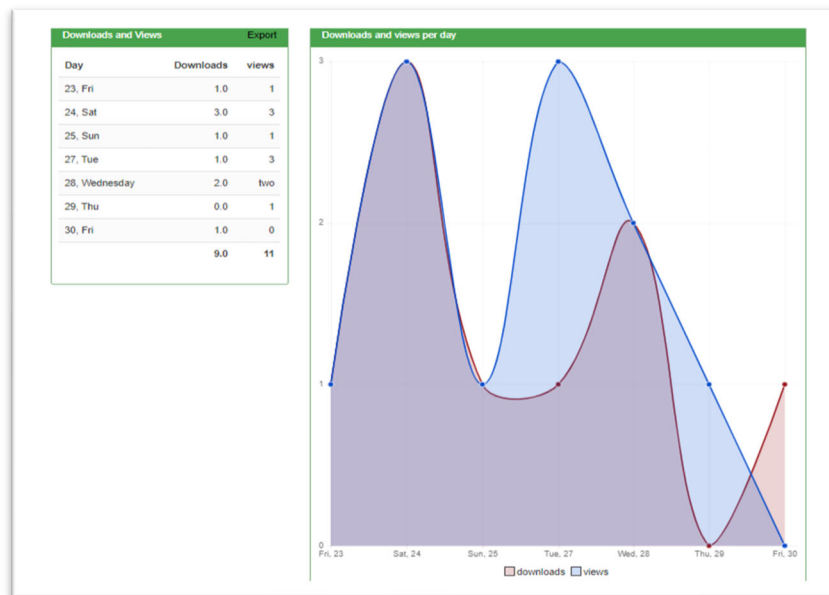
I. The Supplemental Declaration of Dr. Hall-Ellis, and Supporting Material Therewith, Confirm the Public Availability of Godoy.

The Petition included Exhibits 1001-1021. Among these exhibits, Ex. 1019 is a declaration by Dr. Hall-Ellis addressing the public availability of, *inter alia*, Godoy: Ex. 1004/1005. Patent Owner attacked Dr. Hall-Ellis’s credibility by referring to two of her previous cases and asserted that Dr. Hall-Ellis’s testimony was not credible and that the cover of Godoy and the library record from Embrapa

were insufficient to establish the public availability of Godoy before November 4, 2016. Dr. Hall-Ellis maintains Godoy was publicly available (Ex. 1022 ¶ 4.). *See also Id.* ¶¶ 4-53.

Therefore, Petitioner respectfully submits the Supplemental Declaration, and documentation presented by Dr. Hall-Ellis, to clarify and confirm the information already presented in her Original Declaration (Ex. 1019).

As confirmed in Dr. Hall-Ellis's Supplemental Declaration, Godoy was not only publicly available as of at least September 22, 2016, but was in fact viewed and downloaded as of September 23, 2016:



Ex. 1022, p. 3, **Attachment 1**. Further, in paragraphs 18-30, Dr. Hall-Ellis clarifies **Attachment 1b** of her Original Declaration and demonstrates that Godoy was available in the form of Exhibit 1004. *Id.* ¶¶ 4-53.

The Board has recognized submission of evidence confirming public availability does not change a ground of unpatentability nor does it change original evidence, it “merely constitutes additional evidence.” *See, e.g., Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, IPR2013-00369, Paper 37 at 3 (PTAB Feb. 5, 2014) (“...Petitioner has met its burden because the supplemental information Petitioner seeks to submit does not change the grounds of unpatentability authorized in this proceeding, nor does it change the evidence initially presented in the Petition to support those grounds of unpatentability. Instead, such information merely constitutes additional evidence that allegedly confirms the public accessibility of the [] references.”)

II. Exhibits 1023-1029 Clarify for the Board that in Brazil, Where Godoy Performed and Published her Fungicide Tests, Nimbus is a Syngenta Trademark for an Adjuvant Mineral Oil.

Patent Owner represents to the Board that “Nimbus” as used and cited by Godoy in Brazil is the proprietary name for pesticides containing a sulfur fungicide—oddly citing product registrations outside of Brazil (Ex. 2003-2007). *See* Paper 6 at 25-26. Petitioner has objected to these documents based on, *inter alia*, relevance. While there may be a “Nimbus” in, *e.g.*, Australia, Spain, or Portugal, these documents say nothing about Nimbus in Brazil where Godoy carried out and published the results of her field trials. Patent Owner’s exhibits are irrelevant and distractions; despite this, they raise the possibility of doubt or an

inaccurate conclusion as to the nature of Nimbus in Godoy. As a result, Petitioner seeks to submit Exhibits 1023-1029. Exhibits 1024/1025 and 1026/1027 are copies of the Nimbus adjuvant product trademark in Brazil for Syngenta's Nimbus product—both granted in 1980, and valid until 2030.

As can be seen from Ex. 1028/1029, the Material Safety and Data Sheet (MSDS) for Nimbus, the Brazilian Nimbus product is a mineral oil adjuvant and not a “sulfur fungicide” as represented by Patent Owner. This is consistent with Godoy's use of Nimbus as a mineral oil adjuvant.

Petitioner could not have reasonably anticipated Patent Owner would assert Nimbus in Godoy was a sulfur fungicide based on material unrelated to Brazil.

III. Petitioner Could Not Have Reasonably Anticipated Patent Owner Would Present an Argument Based on a Single Unrelated Reference—de Souza—In an Attempt to Contradict the Plain Text of Godoy.

Petitioner explained that Godoy discloses a combined application of benzovindiflupyr, mancozeb, and azoxystrobin, as relevant to the '727 patent. Paper 2 at 20-21. In fact, Petitioner pointed to language in Godoy which indicated a single treatment: “Godoy discloses ‘[t]o apply the products, a knapsack sprayer pressurized with CO₂ and a minimum application volume of 120 L ha⁻¹ was used.’” *Id.* at 21 (emphasis added). In response, Patent Owner surprisingly provided the unrelated de Souza (Ex. 2001/2002) in an effort to suggest Godoy used the

fungicides individually rather than together in a tank-mix. Paper 6 at 23-24.

Petitioner could not have reasonably anticipated that Patent Owner would rely on an unrelated reference for an assertion that runs contrary to the plain text of Godoy.

De Souza is irrelevant and a distraction. Despite this, de Souza, as erroneously presented by Patent Owner, raises the possibility of doubt or an inaccurate conclusion as to the contents of Godoy. As a result, Petitioner seeks to submit Machado (Ex. 1030). Machado, on which Dr. Godoy herself is an author, is consistent with the disclosure of Godoy. Machado reiterates and states that Godoy (Ex. 1004/1005) used a tank-mix. Machado page 2, col. 1, last paragraph (“Since 2015, multi-site fungicides, e.g. chlorothalonil, copper oxychloride, and mancozeb, have been recently evaluated **in tank mix** with commercial premixes to improve SBR control efficacy and reduce the risk of resistance (Godoy et al. 2015, 2016b, 2017, 2018)” (emphasis added) [2016b = Godoy (Ex. 1004), Machado page 8, col. 2, penultimate citation].)

CONCLUSION

While a petitioner should not rely on §42.223 as an opportunity to revise a petition after initial comments or arguments have been laid out by a patent owner (*Pacific Market*, Paper No. 23 at 3), it is the vehicle to supplement the record to address patent owner arguments that were not reasonably foreseeable. As such, the Board considers petitioner’s justification for presenting supplemental information,

including why a petitioner could not have reasonably been expected to submit the supplemental information with its petition. *See Redline Detection, LLC v. Star Envirotech, Inc.*, 811 F.3d 435, 443, 441-49 (Fed. Cir. 2015).

Here—at the very least—Petitioner could not have predicted Patent Owner’s use of unrelated references to confuse the plain disclosures in Godoy; nor could Petitioner have predicted Patent Owner’s bare assertion that a library record would be insufficient to establish public availability of Godoy. These issues were unanticipated. Again, this information removes Patent Owner’s erroneous attempts to dismiss Godoy and streamlines the issues as to at least Ground 1.

For at least these reasons, Petitioner respectfully requests the Board grant this motion to submit supplemental information.

Date: September 5, 2023

Respectfully submitted,

/Toni-Junell Herbert/

Toni-Junell Herbert

Registration No. 34,348

David Klecyngier

Registration No. 72,632

Daniel Bucca, Ph.D.

Registration No. 42,368

Charles C. Carson

Registration No. 46,603

BAKER & HOSTETLER LLP

Washington Square, Suite 1100

1050 Connecticut Ave, N.W.

Washington, DC 20036-5304

Telephone: 202.861.1500

Facsimile: 202.861.1183

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on September 5, 2023,
a copy of the foregoing PETITIONER'S MOTION TO SUBMIT
SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. § 42.223(a) was
provided via email to the following:

Mark Feldstein
Mark.feldstein@finnegan.com

Maximilienne Giannelli
maximilienne.giannelli@finnegan.com

Rajeev Gupta
raj.gupta@finnegan.com

UPL-PGR-FINNEGAN@finnegan.com

/Toni-Junell Herbert/
Toni-Junell Herbert