UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNGENTA CROP PROTECTION AG,
Petitioner,

v.

UPL LTD.,
Patent Owner.

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

PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO SUBMIT SUPPLEMENTAL INFORMATION PURSUANT TO 37 C.F.R. § 42.223(a) (Paper 14)

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I. Introduction

Petitioner's motion (Paper 14) overreaches in seeking to submit 145 pages of information contained in nine new exhibits, lacking sufficient justification and contravening the principle that "[t]he provision for submitting supplemental information under Rule 42.123(a) 'is not intended to provide a petitioner an advantageous 'wait-and-see' opportunity to use a patent owner's preliminary response and [the Board's] decision on institution in order to refine or bolster petitioner's position.'" *Artesian Home Prods. v. Gutterglove, Inc.*, IPR2018-0031, Paper 24, 3 (PTAB May 31, 2018) (quoting *Ooma, Inc. v. Deep Green Wireless LLC*, IPR2017-01541, Paper 14, 3–4 (PTAB Jan. 23, 2018)). Contrary to Petitioner's leading justification, the Board's suggestion that the parties "fully develop the record during trial" was not an open invitation to submit unlimited supplemental information. *See* Paper 14, 1 (quoting Paper 8, 18); *Triller, Inc. v. TikTok PTE, Ltd.*, IPR2022-00179, Paper 18, 5-6 (PTAB Aug. 25, 2018) (explaining that such statements "are directed at the normal briefing process, and do not justify allowing supplemental information").

Petitioner seeks to cure identified deficiencies in the Petition with three categories of documents: (1) a 115-page declaration by Dr. Hall-Ellis opining on Godoy (EX1004/EX1005); (2) exhibits related to "Nimbus," which are discussed by a new declarant, Ryan Kody Jones; and (3) a 2021 publication co-authored by

Godoy. Paper 14, 1. The first "improperly seeks to change the evidence on which it relied" for Godoy public availability. *American Well Corp. v. Teladoc Health, Inc*., IPR2021-00748, Paper 23, 17 (PTAB Feb. 28, 2022). The "Nimbus" exhibits concern whether Godoy meets the claimed "consisting of" limitation—a necessary element of alleged anticipation that the Petition entirely failed to address. *Nanobebe US Inc. v. Mayborn (UK) Ltd.*, IPR2023-00465, Paper 21, 5 (PTAB Aug. 17, 2023) ("Petitioner has not identified any precedent or rule that suggests [the Board] can simply correct errors and omissions in a petition using supplemental information that results in the addition of a new analysis."). And new information in the 2021 publication is legally irrelevant to how a skilled artisan would have understood Godoy in 2016. *Bestway (USA), Inc. v. Intex Mkt'g Ltd.*, PGR2017-00003, Paper 40, 6-7 (PTAB Jul. 12, 2018) ("Petitioner has not explained sufficiently how the proffered supplemental information is relevant to a claim for which the trial has been instituted.").

UPL thus respectfully submits that the Board should deny Petitioner's motion and expunge Exhibits 1022-1030 from the record.

II. Argument

A. The Board Should Deny Petitioner's Attempt to Change its Basis for Alleged Public Availability (EX1022).

As explained in UPL's preliminary response, Petitioner failed to make a threshold showing that Godoy (EX1004/EX1005) qualifies as prior art. Paper 6, 16-

22. For example, its declarant Dr. Hall-Ellis failed to provide any legitimate basis to opine on the public accessibility of Godoy (*id.*, 17-18); mischaracterized the date on the "Embrapa" website upon which she cited (*id.*, 19); and improperly relied on a search for Godoy's title years conducted after the priority date of the '727 patent that could not establish publicly accessibility in the prior art (*id.*, 19-20).

In response, Petitioner seeks to replace its deficient evidence on Godoy's public *accessibility* with new evidence relying on purported *dissemination* in Proposed EX1022 (Supplemental Hall-Ellis Declaration). Paper 14, 3-4. However, supplemental information under 37 C.F.R. § 42.223 "is not intended to provide a petitioner an advantageous 'wait-and-see' opportunity to use a patent owner's preliminary response and our decision on institution in order to refine or bolster petitioner's positions." *Ooma*, IPR2017-01541, Paper 14, 3-4. Nor can it be used to establish prior art availability when, as here, "the requested supplemental information is *necessary* to potentially remedy an identified deficiency in the ground as provided in the Petition." *Artesian Home Prods.*, IPR2018-0031, Paper 24, 3.

Attempting to justify changing its basis for Godoy's alleged public availability, Petitioner argues that it could not have predicted that UPL would assert that "a *library record* would be insufficient to establish the public availability of Godoy." Paper 14, 8 (emphasis added). This is a strawman as Petitioner never argued (much less established) that what Dr. Hall-Ellis described as the "Embrapa *website*

for the document" (EX1019, ¶49 (emphasis added)) was a "library record." And given that Dr. Hall-Ellis' conclusory declarations have been repeatedly rejected by the Board, Petitioner was negligent in not expecting that her similar unsupported opinion testimony was again insufficient. Paper 6, 17-22 (citing cases).

Petitioner's motion should also be denied as to Proposed EX1022 since the information in this supplemental declaration from its previously retained declarant was "reasonably available to the petitioner at the time the petition was filed" and Petitioner fails to explain "sufficiently why the supplemental information could not have been presented with its original Petition." *Laboratoire Francais du Fractionnement et Des Biotechnologies S.A. v. Novo Nordisk Healthcare AG*, IPR2017-00028, Paper 22, 4 (PTAB Jun. 13, 2017); *Ooma*, IPR2017-01541, Paper 14, 3; *Merck Sharp & Dohme Corp. v. Microspherix LLC*, IPR2018-00393, Paper 21, 4 (PTAB Sept. 10, 2018).

Petitioner's few cited cases also fail to support admitting its extensive supplemental information.

First, in *Palo Alto Networks, Inc. v. Juniper Networks, Inc.*, the Board determined in its institution decision that "Petitioner made a threshold showing that [prior art publications] are 'printed publications' within the meaning of 35 U.S.C. § 102." IPR2013-00369, Paper 37, 4 (PTAB Fed. 5, 2014). Here, the Board made no such determination in its institution decision. Paper 8, 17-18.

Second, in *Pacific Market Int'l LLC v. Ignite USA, LLC*, the Petitioner sought to supplement the record with a 10-page declaration directed to reasons to combine the prior art references that formed the basis for instituting trial, and the Board determined that the declaration neither changed any ground of unpatentability nor changed "the type of evidence initially presented in the Petition to support those grounds of unpatentability." IPR2014-00561, Paper 23, 3-4 (PTAB Dec. 2, 2014); *see also* IPR2014-00561, EX1021 (10-page suppl. declaration). Here, by contrast, the 115-page supplemental declaration of Dr. Hall-Ellis (EX1022) improperly seeks to change the basis for Godoy public availability from alleged accessibility to purported dissemination with 27 pages of new testimony and 17 new attachments. *See also American Well Corp.*, IPR2021-00748, Paper 23, 6-7 (summarizing decisions by the Board denying motions to supplement the record where the Petitioner sought to "refine or bolster challenges originally presented in the petition, based on information in the preliminary response or institution decision").

Moreover, *Palo Alto* and *Pacific Market* were decided prior to *Redline Detection LLC v. Star Environtech, Inc.* (cited by Petitioner), which affirmed that "the PTAB has discretion to grant or deny motions [for supplemental information] as it sees fit." 881 F.3d 435, 443-47 (Fed. Cir. 2015). They were also prior to numerous more recent determinations denying requests to supplement the record to cure deficiencies in or changes bases for the Petition. *American Well Corp.*,

IPR2021-00748, Paper 23, 6-7; *Laboratoire Francais*, IPR2017-00028, Paper 22, 4; *Artesian Home Prods.*, IPR2018-0031, Paper 24, 3; *Ooma*, IPR2017-01541, Paper 14, 3–4; *Merck*, IPR2018-00393, Paper 21, 3.

Petitioner's remaining case, *Genzyme Therapeutic Products Ltd. Partnership v. Biomarin Pharmaceutical Inc.* held only that in some circumstances the Board may rely on evidence not addressed in its institution decision. 825 F.3d 1360, 1366-67 (Fed. Cir. 2016)). *Genzyme* is entirely irrelevant here. *Cf.* Paper 14, 3.

B. The Board Should Deny Petitioner's Attempt to Modify its Petition with Exhibits Related to "Nimbus" (EX1023-EX1029).

Petitioner improperly seeks to supplement the record with information regarding "Nimbus"—a component mentioned in Godoy (EX1004/EX1005) that Petitioner failed to mention (much less address) in its Petition. Paper 14, 5-6.

As UPL explained in its preliminary response, the Petition nowhere addresses (1) Godoy's use of "Nimbus" or (2) the '727 patent's "consisting of" limitation as excluding other fungicides. *See* Paper 6, 25 ("The Petition does not dispute that Godoy discloses the addition of Nimbus but fails to address this component in view of the claimed 'consisting of' limitation. *See* Petition, 20."), 26 ("As noted above, the Petition nowhere addresses 'Nimbus' in the context of the 'consisting of' limitation and is not entitled to incorporate arguments it did not raise."). Especially where it entirely failed to address the scope of the "consisting of limitation" or the relevance of "Nimbus" thereto, Petitioner is not entitled to "correct errors and

omissions in a petition using supplemental information that results in the addition of a new analysis." *Nanobebe*, IPR2023-00465, Paper 21, 5; *see also Merck*, IPR2018-00393, Paper 21, 3.

Petitioner argues it "could not have reasonably anticipated Patent Owner would assert Nimbus in Godoy was a sulfur fungicide based on material unrelated to Brazil." Paper 14, 6. In addition to misstating the record, Petitioner's representation is contradicted by its declarant's recognition that Godoy included "Nimbus," prompting him to cite two publications unrelated to Godoy to try to describe the component. *See* EX1003, ¶110 n.3. Even if Petitioner failed to understand that "Nimbus" in the art encompasses sulfur fungicides, that does not excuse its failure to address Nimbus *at all* in its Petition, especially when it repeatedly recognized the claimed "consisting of" language but ignored it in the context of Godoy's Nimbus component. *See, e.g.,* Petion, 12, 15, 21; *Nanobebe*, IPR 2023-00465, Paper 21, 5.

As such, Petitioner should not be allowed to try to plug holes in its Petition with EX1023-EX1029. *Merck*, IPR2018-00393, Paper 21, 3.

C. The Board Should Deny Petitioner's Request to Supplement the Record with an Irrelevant Publication (Proposed EX1030).

EX1030 ("Machado") is not relevant to any ground asserted by Petitioner and should not be admitted as supplemental evidence. 37 C.F.R. § 42.223(a)(2).

According to Petitioner, the 2021 Machado publication indicates that Godoy

"used a tank-mix" (Paper 14, 7) and thus "streamlines the issues as to at least Ground 1" (*id.*, 8). To the contrary, the years-later Machado (EX1030, 1 ("Available online 7 October 2021")) is irrelevant to how a POSA would have read Godoy as of the priority date of the '727 patent (November 4, 2016). *See Teleflex, Inc. v. Ficosa North America Corp*., 299 F.3d 1313, 1335 (Fed. Cir. 2002) ("[W]e have made clear that anticipation does not permit an additional reference to supply a missing claim limitation."). And to the extent Machado (co-authored by Dr. Godoy) teaches anything about the experiments conducted in Godoy, Machado is necessarily polluted by Dr. Godoy's personal information beyond anything knowable to a skilled artisan reading Godoy (EX1004/EX1005). *See Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 (Fed. Cir. 2008) ("[T]o demonstrate anticipation, the proponent must show that the four corners of a single, prior art document describe every element of the claimed invention.") (citations omitted).

III. Conclusion

For the foregoing reasons, UPL requests that the Board deny Petitioner's motion to supplement pursuant to 42 C.F.R. § 42.223.

Respectfully Submitted

Date: September 13, 2023

By: /Mark J. Feldstein/
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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Patent Owner's Opposition to Petitioner's Motion to Submit Supplemental Information Pursuant to 37 C.F.R. § 42.223(a)** was served electronically via email on September 13, 2023, in its entirety on the following:

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Dated: September 13, 2023

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