

From: [Guerra, Kenneth](#)
To: [Trials](#)
Cc: [Feldstein, Mark](#); raj.gupta@finnegan.com; [Giannelli, Maximilienne](#); [Esper, William](#); [Herbert, Toni-Junell](#); [Klecynsier, David M.](#); [Bucca, Daniel](#); [Carson, Charles C.](#); EXT-Mrick@bakerlaw.com
Subject: RE: PGR2023-00017 – Motion for Additional Discovery
Date: Tuesday, October 24, 2023 2:15:26 PM

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Honorable Board,

Both parties can be available anytime between 2:00-4:00 pm ET on 10/26 or 10/27. Further, below are the parties' positions regarding scheduling:

Patent Owner's Position

-

- <!--[if !supportLists]-->i. <!--[endif]-->Modify DD1 and DD2 by the later of: 10 days (to November 9th) or 7 days after Petitioner produces all discovery ordered by the Board; and
<!--[if !supportLists]-->ii. <!--[endif]-->Modify DD3 by the number of days by which modification (i) exceeds 10 days, if any.

Patent Owner believes that this is reasonable under the circumstances, including where Patent Owner will not be filing a motion to amend, and without prejudice to Petitioner.

Petitioner's Position

Petitioner's position regarding scheduling is that further modification of the due dates are unnecessary at this time. Rather, the due dates in this case have already been extended once, by two-weeks, at the request of Patent Owner. As a result, under Patent Owner's proposed schedule, Patent Owner would have about one extra month from institution to file its Response. In contrast, if any unforeseen challenges arise during Petitioner's Reply to Patent Owner's Response, it may not be possible to satisfactorily modify the schedule. Accordingly, Petitioner cannot agree to the proposed modification.

At most, as previously indicated, Petitioner proposed a conditional compromise to November 3 rather than November 9 as Patent Owner requests.

Best,
Ken

Counsel for Patent Owner UPL, Ltd.

Kenneth S. Guerra
Associate

PGR2023-00017
Ex. 3004

Pronouns: He, Him, His

Finnegan, Henderson, Farabow, Garrett & Dunner, LLP

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FINNEGAN

From: Trials <Trials@USPTO.GOV>

Sent: Monday, October 23, 2023 2:11 PM

To: Guerra, Kenneth <Kenneth.Guerra@finnegan.com>; Trials <Trials@USPTO.GOV>

Cc: Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Esper, William <William.Esper@finnegan.com>; Herbert, Toni-Junell <therbert@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>

Subject: RE: PGR2023-00017 – Motion for Additional Discovery

EXTERNAL Email:

Counsel,

The panel is not available to conference on 10/25. The parties should confer and respond by joint email with a time between 2-4 pm ET on either 10/26 or 10/27 when both sides are available for a call. That email should also identify the parties' competing positions regarding the second issue in Patent Owner's email, i.e., the rescheduling of Due Date 1.

Regards,

Esther Goldschlager

Supervisory Paralegal Specialist

Patent Trial & Appeal Board

U.S. Patent & Trademark Office

From: Guerra, Kenneth <Kenneth.Guerra@finnegan.com>

Sent: Monday, October 23, 2023 9:46 AM

To: Trials <Trials@USPTO.GOV>

Cc: Feldstein, Mark <mark.feldstein@finnegan.com>; raj.gupta@finnegan.com; Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Esper, William <William.Esper@finnegan.com>; Herbert, Toni-Junell <therbert@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>

Subject: RE: PGR2023-00017 – Motion for Additional Discovery

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Dear Honorable Board,

Patent Owner writes to request a conference to further address two unresolved issues related to the October 16, 2023, conference with the Board (EX2017) and the Board's corresponding Order (Paper 22). The parties have reached an impasse on these issues, as reflected in the attached correspondence.

First, Patent Owner believes that Petitioner failed to produce "the underlying data from the 'field books' for the testing described in Petitioner's [Prates Declaration]," as so ordered by the Board.

Paper 22, 2-3; EX2017, 20:15-18. Instead, according to Petitioner, it has produced and will only produce "data that Dr. Prates used" for calculations reported in EX1020. This excludes, at least, data in those "field books" related to (1) % Phytotoxicity, (2) % Defoliation, and (3) Yield. E.g., EX1020, ¶¶ 5, 9.

Second, the Parties have been unable to reach agreement on rescheduling Due Date 1 (currently October 30, 2023) for the POR in view of (i) Petitioner's delay and still incomplete production of the "field books" and (ii) Patent Owner's pending Motion for Additional Discovery.

Both parties can be available at the Board's convenience on Wednesday October 25.

Best,

Ken

Kenneth S. Guerra

Associate

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FINNEGAN

From: Trials <Trials@USPTO.GOV>

Sent: Friday, October 13, 2023 3:15 PM

To: Guerra, Kenneth <Kenneth.Guerra@finnegan.com>; Trials <Trials@USPTO.GOV>

Cc: Feldstein, Mark <mark.feldstein@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>;

Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Esper, William

<William.Esper@finnegan.com>; Herbert, Toni-Junell <therbert@bakerlaw.com>; Klecyngier, David

M. <dklecyngier@bakerlaw.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Carson, Charles C.

<ccarson@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>

Subject: RE: PGR2023-00017 – Motion for Additional Discovery

EXTERNAL Email:

Counsel,

A conference call is scheduled for **3 pm ET on October 16, 2023.**

The dial-in number is: 877-934-8037 and the passcode is: 9450035#.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Guerra, Kenneth <Kenneth.Guerra@finnegan.com>

Sent: Friday, October 13, 2023 12:19 PM

To: Trials <Trials@USPTO.GOV>

Cc: Feldstein, Mark <mark.feldstein@finnegan.com>; raj.gupta@finnegan.com; Giannelli, Maximilienne <Maximilienne.Giannelli@finnegan.com>; Esper, William <William.Esper@finnegan.com>; Herbert, Toni-Junell <therbert@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>

Subject: PGR2023-00017 – Motion for Additional Discovery

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Dear Honorable Board,

Patent Owner hereby requests leave to file a Motion for Additional Discovery Under 37 C.F.R. § 42.51(b)(2) ("Motion"). The Motion will relate to documents identified in the deposition of Petitioner's declarant Dr. Caio Prates that would contradict Petitioner's assertion that the claimed combinations are obvious, did not exhibit any unexpected benefits such as synergy, and are not enabled. The Parties have discussed but have been unable to reach agreement.

The parties can be available at the Board's convenience for a conference on Monday, October 16, 2023, from 3:00-6:00pm ET. Patent Owner is additionally available Wednesday, October 18, 2023, from 3:00-6:00pm ET.

Best,
Ken

Kenneth S. Guerra
Associate

Pronouns: He, Him, His

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