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 EXCLUDE EVIDENCE

Pursuant to 37 C.F.R. § 42.64(c) Petitioner (Syngenta Crop Protection AG) hereby moves to exclude the following evidence as inadmissible under the Federal Rules of Evidence (FRE).

I. EXHIBITS 2003-2010 AND EXHIBIT 2020, ¶¶119-120 ("NIMBUS" REFERENCES)

UPL and Dr. Jacobsen offered Exhibits 2003-2010 for the purpose that a person of skill in the art (POSA) would have understood the term "Nimbus", as cited in the reference to Godoy (EX1005), to be the proprietary name for pesticides containing a sulfur fungicide. See Patent Owner Statement (Paper 6, 25-26), Patent Owner Response (Paper 31, 20-21), Patent Owner Sur-Reply (Paper 46, 8-9), UPL Expert Jacobsen Declaration (EX2020, ¶¶119-120). UPL's expert, Dr. Jacobsen, relied on Exhibits 2003-2010 at paragraphs 119-120 of his declaration (Exhibit 2020). Each of Exhibits 2003, 2004, 2005, 2006, 2006, 2007, 2008, 2009 and 2010 ("Exhibits 2003-2010") and Dr. Jacobsen's reliance thereon in his declaration at Exhibit 2020 (¶¶ 119-120) should be excluded as irrelevant, confusing the issues, and inadmissible hearsay under FRE 401-403 and FRE 801-802.[1]

[1] Petitioner timely objected to Exhibits 2003-2010 on grounds each exhibit was irrelevant and confusing the issues under FRE 401-403 and inadmissible hearsay under FRE 801-802. Paper 10, 2-5, filed August 14, 2023. Pursuant to 37 CFR

Since UPL is offering each of Exhibits 2003-2010 for the purpose of what a POSA would have understood from the use of "Nimbus" in the Godoy reference (EX1005) and with regard to unpatentability, these exhibits are only relevant if they were publicly accessible to a POSA as of the priority date of November 4, 2016. *Spectrum Solutions LLC v DNA Genoteck Inc*, IPR2022-01347, Paper 43 at 26-28 (excluding a reference not shown to be publicly available at the time of the invention). Further, UPL bears the burden to established each of Exhibits 2003-2010 was publicly accessible as of the priority date. 37 C.F.R. § 42.20(c).

After Petitioner's objections to the exhibits, UPL served supplemental evidence on August 28, 2023 (Declaration of Lauren Gluckman, EX2014). However, UPL's supplemental evidence only sought to purportedly authenticate Exhibits 2003-2010. UPL provided *no* evidence that any of Exhibits 2003-2010 were publicly accessible as of the priority date of November 4, 2016. Indeed, one exhibit bears a date well after the priority date. For example, Exhibit 2009 and its translation Exhibit 2010 show a date of "November 2019" in the footer; and Exhibit 2003 does not appear to bear any date whatsoever.

42.64(b)(1), Petitioner filed its objections to Exhibits 2003-2010 within ten business days of the institution of the trial, which was instituted on July 31, 2023.

Hence, Exhibits 2003-2010 are not probative of what a POSA would have understood as of the priority date since none were shown to be publicly accessible as of the priority date. Thus, each of Exhibit 2003, 2004, 2005, 2006, 2007, 2008, 2009 and 2010 is irrelevant under FRE 401 and each constitute inadmissible hearsay under 801 and should be excluded.

In addition, testimony from UPL's expert confirms the irrelevancy of Exhibits 2003-2010. As explained above, UPL is offering Exhibits 2003-2010 for the purpose of what a POSA would have understood from the use of "Nimbus" in the Godoy reference (EX1005). However, UPL's expert admitted during his deposition that there were two sets of Nimbus documents he reviewed in preparing his report: (1) one set he found himself that related to the use of Nimbus as mineral oil in Brazil where Godoy was published, but that he did not cite in his declaration and UPL never produced; and (2) a second set that he did not find but were provided to him by counsel (Exhibits 2003-2010) that related to the use of Nimbus outside of Brazil. Dr. Jacobsen testified:

> **Q.** You understand that the experiments described in Godoy were conducted in Brazil?
>
> **A.** That is correct.
>
> **Q.** And the Godoy paper was published in Brazil?
>
> **A.** That is correct.
>
> **Q.** Did you search for any documentation with respect to Nimbus in Brazil?

A. Yes.

Q. Did you find any registrations for Nimbus in Brazil?

A. I found several things that were Nimbus. They varied in terms of how much mineral oil was there. I'm just trying to recollect back, but yes.

Q. So you did search for and find some documents in Brazil that described Nimbus as being mineral oil?

A. Yes.

Q. You don't cite any of those documents in your declaration, do you?

A. No, I do not.

EX1043, 168:6-169:4; *see also id.*, 166:12-167:22 (admitting that Exhibits 2003-2010 were provided by counsel).

Hence, the testimony from UPL's own expert further supports the conclusion that Exhibits 2003-2010 are irrelevant and would lead to confusion as to what a POSA would have understood from the use of Nimbus in the Godoy reference.

Further, Exhibits 2003-2010 are irrelevant and lead to confusion since none of the exhibits indicate the active ingredient described therein can be used with soybeans, which was the crop studied in the Godoy reference. Accordingly, the Board should exclude each of Exhibits 2003-2010 and paragraphs 119-120 of Exhibit 2020 under FRE 401-403 and FRE 801-802.

II. EXHIBIT 2020 AT ¶¶ 128-132 AND EXHIBIT 2022 (WOJDYLA REFERENCE AND APPLICATION RATE)

The declaration of UPL's expert, Dr. Jacobsen (EX2020), at paragraphs 128-132 should be excluded since these paragraphs rely upon evidence that has never produced.[2] Exhibit 2022 should also be excluded since it was not relied upon. The declaration of UPL's expert (EX2020) was filed with Patent Owner's Response on November 9, 2023. Petitioner timely objected to Exhibit 2020 on grounds it relies on irrelevant references and fails to use reliable principles and methods (FRE 702). Paper 35, 2, filed November 17, 2023. UPL did not serve any supplemental evidence in response to these objections.

Dr. Jacobsen's declaration (EX2020) at paragraphs 128-132 cites to, and relies upon, an article to Wojdyla presumably published in year 2015. EX2020, ¶¶128-132. These paragraphs indicate the 2015 Wojdyla article was Exhibit 2022 (citing the exhibit as "Exhibit 2022 (Wojdyla 2015)"). *Id.* Paragraph 128 of the declaration presumably reproduced Table 2 from the 2015 Wojdyla article. *Id.*

[2] In addition to being inadmissible under FRE, Exhibit 2020 at ¶¶128-132 should be excluded on procedural grounds since UPL's withholding of the 2015 Wojdyla article contravenes 37 C.F.R. § 42.51(b)(i) ("Unless previously served or otherwise by agreement of the parties, any exhibit cited in a paper or in testimony must be served with the citing paper or testimony.").

However, Dr. Jacobsen testified that Exhibit 2022, as produced by UPL, is not the 2015 Wojdyla article that he relied upon in his declaration; but rather Exhibit 2022, as produced, is a different article by the same author published in 2005, not 2015. EX1043, 139:16-141:15. Although UPL's counsel was aware that Dr. Jacobsen had relied upon a Wojdyla reference that was never produced, UPL only notified Petitioner of that fact when directly confronted during the cross examination of UPL's expert on January 10, 2024:

> **Q.** So welcome back, Dr. Jacobsen. I believe I had directed you right before the lunch break to paragraph 128 and '9 of your declaration.
>
> **A.** Okay. I'm on paragraph 128.
>
> **Q.** Okay. And you reference here -- or you cite here Exhibit 2022?
>
> **A.** That's correct.
>
> * * *
>
> **Q.** Now, Wojdyla -- you've read Wojdyla, I take it?
>
> **A.** I've read the 215 [sic, 2015] reference, yes.
>
> **Q.** Well, Exhibit 2022?
>
> **A.** Exhibit 2022 is the 205 [sic, 2005] reference by him.
>
> **Q.** Okay.
>
> **A.** It's not -- what's in my declaration is from the 215 [sic, 2015] paper.
>
> **Q.** Okay. Was that produced in this case?
>
> **MR. CARSON:** I guess I'm directing that to you.
>
> **MR. FELDSTEIN:** We think we had a – we realized recently that there was a mistake in that the 2005 publication got inserted as Exhibit 2022

instead of the 2015 that's quoted in the declaration.

MR. CARSON: Okay. So there's not an exhibit in the case for Wojdyla 2015 as quoted in the declaration; is that fair?

MR. FELDSTEIN: The table is reproduced from the reference, but the reference itself is not an exhibit.

BY MR. CARSON:

Q. So the only Wojdyla reference you reviewed is the one published in 2015, which has not been produced in this case, correct?

A. That is correct.

EX1043, 139:16-141:15.

In addition, Dr. Jacobsen's declaration at paragraphs 128-132 cite to, and rely upon, the 2015 Wojdyla article for the purpose of determining the level at which mineral oil is allegedly a fungicide in an attempt to show the application rate of Nimbus in the Godoy reference (EX1005) reaches such a level.[3] However, the declaration lacks sufficient information to make such a determination and comparison. Indeed, Dr. Jacobsen admitted that to make such a comparison a POSA would need to know *both* the concentration and "*application rate*". He further admitted his declaration did not identify or consider the application rate, nor could he remember the disclosed rate:

[3] UPL relies on Jacobsen's declaration for the same purpose. See Patent Owner Response (Paper 31, 20-21), Patent Owner Sur-Reply (Paper 46, 9-10).

Q. But in terms of, say, for example, liters per hectare, do you -- does Wojdyla say, do you know what that application rate was?

A. In the paper it gives it.

Q. Okay. Is it reflected here in your report?

A. No, but it's reflected in the paper.

Q. Okay.

A. I only took out table 2 to illustrate my point.

Q. But I mean, if you're going to compare two different applications of mineral oil, for example, to each other, don't you need to know the application rate in addition to the concentration?

A. The answer is yes.

Q. Do you know how -- so when I say "application rate," are we on the same page as to what I'm referring to?

A. If you're talking about how many liters of X mix is applied to a hectare, that would be – the application rate could be that or the application rate could be what amount of active ingredient is added per hectare. Okay.

Q. Okay. But you need a per-area measurement?

A. Yes.

Q. Okay. So to compare -- again, to compare two different applications of mineral oil against each other you would need to know both the application rate and the concentration?

A. Yes.

Q. Now, in your declaration here, your discussion of Wojdyla, you do not indicate in here what the application rate was, do you?

A. No. Had you been supplied the correct exhibit, you would have that.

***

Q. Okay. But the question I asked was you don't -- you testified a few minutes ago that you would need both the application rate and the concentration to do a comparison?

A. Yes.

Q. And I'm just asking you to confirm that in your declaration here you do not address the application rate in Wojdyla?

A. That is correct.

Q. And sitting here today, you don't know what the application rate in Wojdyla was?

A. Do I have it in my memory, no, but if I had the reference in front of me I could point it to you.

Q. Yeah. But you don't -- you don't know right now? I mean, you don't remember what it was?

A. I don't remember specifically, no.

EX1043, 146:18-148:16, 149:17-150:12. Accordingly, the Board should exclude EX2020, ¶¶128-132 under 37 C.F.R. § 42.51(b)(i) and FRE 702.

III. CONCLUSION

For the reasons set forth above, Petitioner moves the Board to grant this Motion to Exclude.

Date: March 19, 2024

Respectfully submitted,

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Certificate of Service

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on March 19, 2024, a copy of the foregoing PETITIONER'S MOTION TO EXCLUDE EVIDENCE was provided via email to the following:

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