

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
PATENT No. 11,445,727

**PATENT OWNER'S OPPOSITION TO PETITIONER'S
MOTION TO EXCLUDE (PAPER 48)**

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Patent Owner UPL Ltd. respectfully submits this Opposition to Petitioner Syngenta's Motion to Exclude certain opinions of Dr. Jacobsen's declaration (EX2020) (Paper 48, "Motion").¹

Petitioner seeks to exclude "Dr. Jacobsen's opinions related to 1) public accessibility and availability of Godoy" ("Godoy public availability opinions") and "2) determination and assessment of whether there is synergy in disease efficacy, yield, or defoliation" ("field data opinions"), by Fed. R. Evid. ("FRE") 402, 403, and 702. Motion, 1, 3, 6. Petitioner's Motion, however, includes arguments not preserved by objection and improperly attempts to argue the merits of this case.²

Substantively, Dr. Jacobsen's testimony is relevant and admissible evidence. Indeed, his testimony shows that (1) it can take considerable time for a publication to be indexed and become publicly available to a POSA and (2) the data Petitioner collected in preparation for this litigation demonstrates unexpected synergy in contrast to what is asserted in the Petition. Petitioner's Motion should be denied.

¹ Pursuant to Paper 50, Patent Owner understands that Petitioner's second motion to exclude (Paper 49) has been withdrawn.

² Patent Owner's request for leave to move to strike Paper 48 was denied "because the Board is capable of distinguishing arguments on the admissibility and those on the sufficiency of the evidence." Paper 50, 2-3.

I. Dr. Jacobsen’s Godoy Public Availability Testimony Is Relevant and Admissible

Dr. Jacobsen provided testimony relevant to Petitioner’s failure to establish the public availability of Godoy “[b]ased on [his] experience.” EX2020, ¶¶88-90. *See also* EX1043, 106:1-4, 100:8-103:7. He testified, for example, that

Even if Godoy had been uploaded to the Embrapa website in 2016, this does not mean that Godoy was indexed or otherwise searchable prior to November 4, 2016. In my experience from teaching, publishing, and conducting research in plant pathology, I have seen it takes considerable time for a publication to be indexed and searchable. Based on this, it cannot be assumed that Godoy was indexed and searchable as of the date listed on its face. And, in my experience, once a publication is indexed, it is generally assigned a digital object identifier (“DOI”). I did not see any DOI for Godoy provided in the materials submitted with Syngenta’s petition. Without this indicium of being indexed, it cannot be assumed that Godoy was searchable as of the date listed on its face or by November 4, 2016.

EX2020, ¶90. Petitioner does not challenge the factual basis of Dr. Jacobsen’s testimony to argue that it should be excluded. Nor does Petitioner argue that the substance of Dr. Jacobsen’s unchallenged testimony would not be relevant to whether Petitioner met its burden to establish the public availability of Godoy.

Indeed, the challenged testimony based on Dr. Jacobson’s personal experience is relevant at least to show that Petitioner failed to meet its burden to establish that Godoy was indexed and publicly accessible. *See* Paper 31 (“POR”), 14-15; *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1349-50 (Fed. Cir. 2016). Dr. Jacobson’s testimony *from his personal experience* is also relevant in response to the “opinions” of Dr. Hall-Ellis regarding public availability, which were *not* based on personal knowledge. POR, 10-11; *see also Unified Patents Inc. v. Am. GNC Corp.*, IPR2019-00505, Paper 31 at 14-16 (PTAB July 19, 2019) (finding Dr. Hall-Ellis’s publication date testimony “would be speculation” and holding that Petitioner failed to establish that the asserted reference constituted prior art). Notably, Petitioner does not dispute that Dr. Jacobsen is entitled to testify as an expert given his qualifications as (more than) a POSA. *See Kyocera Senco Indus. Tools v. Int’l Trade Comm’n*, 22 F.4th 1369, 1376-77 (Fed. Cir. 2022).

The crux of Petitioner’s argument is that Dr. Jacobsen “is not qualified as an expert by ‘knowledge, skill, experience, training, or education’ to render opinions on the subject of the public availability of Godoy” because he does not have a degree in “library science” and therefore his testimony is not relevant and unduly prejudicial. Motion, 4-6. However, Petitioner does not establish that the challenged testimony requires a degree in library science.

For example, Petitioner has not shown that “scientific, technical, or other

specialized knowledge” (FRE 702) is necessary for Dr. Jacobsen to have testified that:

The Embrapa website attached to Dr. Hall-Ellis’s declaration has no “***publication date*** of September 1, 2016” shown. Exhibit 1019 (Hall-Ellis Declaration) at 134-135 (Attachment 1b). While I see “[y]ear of publication: 2016,” there is no associated month or day. Exhibit 1019 (Hall-Ellis Declaration) at 134-135 (Attachment 1b). At most, Attachment 1b provides the publication *year* was “2016,” not “September 1, 2016.” Exhibit 1019 (Hall-Ellis Declaration) at 134-135 (Attachment 1b).

EX2020, ¶89.

Petitioner’s suggestion that a degree in library science (or in any field) is needed for the pertinent questions here misunderstands the rules of evidence. The rules of evidence are explicit that an expert’s qualifications are in the disjunctive, and that one may testify based on “knowledge, skill, experience, training, *or* education....” FRE 702. In terms of such “knowledge, skill, experience, [and] training,” Petitioner does not dispute that Dr. Jacobsen:

- “published 53 book chapters as author or coauthor, 55 peer-reviewed articles, and 316 technical bulletins” (EX2020, ¶22);
- has experience “teaching, publishing, and conducting research in plant pathology” (EX2020, ¶90);

- was an editor for *Plant Disease* (1994-1997) and *Biological Control* (2011-2014) (EX2020, ¶¶115-116);
- has “experience [that] in many of these kinds of situations [related to time between uploading an article and its availability] there is a lag” (EX1043, 105:13-106:4); and
- has “experience as being an editor of scientific papers and a technical editor of scientific papers” (EX1043, 126:1-3).

Dr. Jacobsen’s unchallenged “knowledge, skill, experience, [and] training” is plainly relevant to the question of whether Godoy “was disseminated or otherwise made available *to the extent that persons interested and ordinarily skilled* in the subject matter or art exercising reasonable diligence, *can locate it.*” *Blue Calypso*, 815 F.3d at 1348 (“To qualify as a printed publication, a reference must have been sufficiently accessible to the public interested in the art.”) (quotations omitted). And on this question, Dr. Jacobsen was a qualified expert—indeed, the only qualified witness that has opined on this issue—to testify that Petitioner has not shown that Godoy would have been locatable to a POSA in the prior art. EX2020, ¶90; *Salesforce.com, Inc. v. WSOU Invs., LLC*, IPR2022-00428, Paper 10 at 14 (PTAB July 13, 2022) (“To the extent Petitioner contends that Dr. Hall-Ellis has offered an ‘opinion’ about public accessibility,” it is “insufficiently supported by record evidence to meet the ‘reasonable likelihood’ standard for institution.”).

Moreover, Petitioner does not challenge the factual basis of Dr. Jacobsen's testimony, which is of course key under FRE 702. *See* FRE 702 ("A witness who is qualified as an expert... may testify in the form of an opinion... if... the testimony is based on sufficient facts or data"). To the contrary, as Petitioner notes, ***Dr. Jacobsen's testimony is directed to facts*** from his personal perception and experience, e.g., "there is no associated month or day" (EX2020, ¶89) and that, as a result, "it cannot be assumed that Godoy was indexed and searchable as of the date listed on its face" (EX2020, ¶90). Motion, 5; EX2020, ¶90 (testimony based on "experience from teaching, publishing, and conducting research in plant pathology").

Petitioner further misunderstands the rules of evidence. Separate and apart from opinion testimony under FRE 702 or 703, a witness may testify based on "personal knowledge of the matter" (FRE 602) and likewise offer opinions based thereon (FRE 701). That is, even if "library science" expertise is required to offer opinions on public availability under FRE 703, Dr. Jacobsen's testimony is admissible under FRE 602 and/or 701. Petitioner never objected to the admissibility of Dr. Jacobsen's testimony on these grounds.

Likewise, Dr. Jacobsen's "Godoy public availability opinions" are relevant and not unfairly prejudicial under FRE 403. Indeed, questions regarding public availability specifically turn on the personal knowledge of the declarant. *See B/E*

Aerospace, Inc. v. C & D Zodiac, Inc., 709 F. App'x 687, 697 (Fed. Cir. 2017).

Petitioner appears to argue prejudice from Dr. Jacobsen's testimony based on his personal experience that "it cannot be assumed that Godoy was indexed and searchable as of the date listed on its face." Motion, 4-5. But his testimony is not "prejudicial" simply because Petitioner failed to put on any contrary evidence, leaving Dr. Jacobsen's testimony an undisputed fact. Nor is it "prejudicial" because the Petition relied solely on testimony of Dr. Hall-Ellis, who, by contrast, did not even purport to have personal knowledge to support her "opinion" testimony. *Cf.* EX1019, ¶47; Paper 31, 11.

II. Dr. Jacobsen's Field Data Opinions Are Admissible

A. Petitioner's Motion Is Improper

First, Petitioner's motion should be denied as Petitioner did not timely object to Dr. Jacobsen's "field data opinions" at all, much less with the required "sufficient particularity." 37 C.F.R. § 42.64(b)(1). Indeed, Petitioner's objections were narrowly directed to the "Godoy public availability" and are short enough to reproduce in their entirety:

Exhibits 2020

Exhibit 2020 is improper under FRE 702. For example, Exhibit 2020 includes Expert Testimony to which Dr. Jacobsen is not qualified to make, (public availability of Godoy) relies on irrelevant references, and fails to use reliable principles and methods. FRE 702.

Further to the above errors, Exhibit 2020 is irrelevant or, at the very least, its probative value is substantially outweighed by a danger of unfair prejudice or confusing the issues. FRE 401-403.

Paper 35, 2. Nowhere did Petitioner even mention Dr. Jacobsen’s “field data opinions.” *See* Paper 35, 2; *cf.* Motion, 1-2. “The lack of an effective objection is sufficient basis to deny Petitioner’s Motion.” *B/E Aerospace, Inc. v. MAG Aerospace Indus., LLC*, IPR2014-01511, Paper 104, 6-8 (PTAB Mar. 18, 2016) (denying motion to exclude where served objections did not assert objections later raised in a motion to exclude); 37 C.F.R. §§ 42.20(c), 42.64(c).

Second, Petitioner violates the rule that “[a] motion to exclude is not a vehicle for addressing the weight to be given evidence—arguments regarding weight should appear only in the merits documents.” Trial Practice Guide (“TPG”) at 79. For example, Dr. Jacobsen testified that:

the Colby calculation assumes independent modes of action... [and that f]or combinations of multisite inhibitors, like mancozeb, component fungicides will not have fully independent modes of action relative to

the other components.... In such cases, the Colby calculation will overestimate the threshold for synergy... [when actually] synergy would be reflected in a lower Colby ratio, such as 0.9.

and that

In practice, a person of ordinary skill in the art would have been concerned with improvements in yield.

EX2020, ¶¶244, 249.

Without an evidentiary basis or contrary testimony to challenge, Petitioner repeats the substantive mischaracterizations from its Reply.³ *Compare* Motion, 6-8, with Paper 41 (“Reply”), 23-24. Likewise, Petitioner repeats its attorney arguments about applying the Colby calculation to Yield. *Compare* Motion, 12-14 with Reply, 24-27. Had Petitioner wanted to challenge or had a substantive basis to challenge Dr. Jacobsen’s testimony, it was entitled to file a declaration with its Reply. Petitioner did not and cannot use a motion to exclude to remedy its

³ In both its Reply and Motion, Petitioner mischaracterizes Dr. Jacobsen as “lowering the Colby threshold from 1 to about 0.8.” *Compare* Motion, 7 and Reply, 23 with Paper 47 (“Sur-Reply”), 23 and EX2020, ¶244. But Petitioner separately admits Dr. Jacobsen used a “0.9 threshold.” Motion, 9.

substantive failures.

It is further clear Petitioner is using its Motion as a proxy for a Sur-Sur-Reply, as it expressly responds to Patent Owner's Sur-Reply. Motion, 11 ("In its Sur-reply...."). Petitioner then repeats its Reply arguments regarding a clerical error in one chart. Motion, 11. While this is plainly improper, Petitioner's allegations are also wrong. As explained in Patent Owner's Sur-Reply, "Dr. Jacobsen spelled out each step of his calculations, starting with reproductions of Syngenta's produced field book data as arranged and labeled by Syngenta in EX1031-EX1033, making clear" that the "errors" Petitioner cites are merely "a transcription error" (Paper 46, 24). Petitioner's repeated arguments involving these same baseless attacks are an improper attempt to subvert Board rules and have the last word on this already-briefed issue. TPG at 73-74, 79.

B. Petitioner Mischaracterizes Dr. Jacobsen's Disease Severity Conclusions as "Containing Errors"

Petitioner drops any pretense of evidentiary arguments when it challenges Dr. Jacobsen's mathematically accurate *rounding* of 0.87 and 0.88 to 0.9. Motion, 8-9.

Beyond its impropriety in a motion to exclude, Petitioner's argument is contradicted by its declarant, Dr. Prates, whose data (once finally obtained) showed significant synergistic effects of the claimed combinations and compositions as

addressed in the challenged testimony. *See* EX2020, ¶¶258-272. In particular, Dr. Prates rounded data to the nearest whole numbers. *See* EX1020, 5, 9; Paper 31, 78 (citing EX2020, ¶¶268-270).

C. Dr. Jacobsen Properly Applied the Colby Analysis to Petitioner’s Defoliation and Yield Data

Petitioner asserts that Dr. Jacobsen’s opinions regarding defoliation and yield should be excluded as not being reliable or supported by the art. Motion, 9-14. Petitioner’s unsupported attorney argument establishes neither. Again, had Petitioner wanted to substantively challenge and had basis to challenge Dr. Jacobsen’s testimony, it was entitled to file a declaration with its Reply. Petitioner did not and cannot use a motion to exclude to remedy its substantive failures. Petitioner is also factually wrong.

First, Petitioner argues “UPL’s defoliation analysis is designed to confuse and should be excluded” because “it is unclear why a person of ordinary skill in the art would look to defoliation when it is possible to look at the actual efficacy.” Motion, 10. Petitioner further argues “Dr. Jacobsen’s [yield] opinions should be excluded for similar reasons as defoliation.” Motion, 12.

It is Petitioner’s Motion that is plainly designed to confuse, as it lacks even facial evidentiary merit. For instance, contrary to Petitioner’s arguments that there is “no evidence” supporting the use of defoliation or yield to assess fungicidal

activity, its own declarant explained a POSA would “assess the performance of the fungicide using defoliation as a parameter,” further explaining yield is “the normal way that we assess fungicide[s]... [t]his is the regular way....” EX2018, 44:18-46:2 (agreeing to the “same answer” as to defoliation). Petitioner cites no authority for its allegation that Dr. Jacobsen’s defoliation opinions are unreliable as “based on the unproven assumption that defoliation should have some sort of linear relationship to fungicide application.” Motion, 10. Its only cite to Colby (EX1012) provides no support for its argument. Petitioner provides no evidence to substantiate its speculation that defoliation does not have a linear relationship to fungicide application. Indeed, Petitioner does not address that its own data shows fungicide application is directly related to improvements in defoliation (EX2020, 140 & 151 (citing EX1033)) and even its own declarant has provided contradictory testimony, explaining “Defoliation is highly related to the disease pressure. So when the disease pressure is going very high, the soybean defoliated” (EX2018, 44:18-45:2).

Indeed, it was Petitioner’s declarant, Dr. Prates, in consultation with Petitioner’s counsel, who designed and collected the defoliation and yield data that Dr. Jacobsen considered. EX2018, 31:11-21. Petitioner has provided no evidence to show why, in its field tests to measure synergy, defoliation and yield were measured to assess anything other than synergy. Beyond the relevance underscored by Petitioner and its counsel choosing to generate the defoliation and yield data to

support its §112 arguments that the claimed subject matter does not demonstrate synergy (*see* Paper 2 (“Pet.”), 80-81), additional record evidence supports the reliability of Dr. Jacobsen’s analysis.

First, the original Colby reference nowhere indicates that its framework is limited to the disease severity evaluated therein. EX1012. In fact, reflecting that it is not so limited, while Colby is directed to herbicidal combinations, Petitioner relied on it for fungicidal combinations. EX1012, 4; Pet., 72-73. Thus, Petitioner’s attorney argument fails to establish that fungicidal synergy can be only assessed with disease severity and not with defoliation or yield. EX2020, ¶246.

Second, Petitioner’s attorney argument theories as to why it disagrees with Dr. Jacobsen’s opinions are replete with speculation and lack citations to the art. The fact of the matter is Dr. Brannen admitted that *a POSA “could substitute percent yield” in Colby*. EX2021, 119:5-120:2. Whether Dr. Brannen personally has applied or seen Colby applied to yield only speaks to his own lack of qualifications. Tellingly, Petitioner pointed to no art and provided no declarant testimony in the Reply indicating that the Colby calculation cannot be applied to defoliation or yield data. Petitioner cannot resort to an evidentiary motion to plug these holes.

Petitioner also criticizes Dr. Jacobsen for “reanalyz[ing] Petitioner’s disease severity/efficacy data” generated for the purposes of this litigation. Motion, 6;

EX1018, 31:16-21, 32:22-33:21). Reanalysis was, of course, necessary and directly contradicted Petitioner's representations to the Board that the data "doesn't support... patent owner" (EX2019, 10:6-14). Just as its prior representations regarding this data were untrue, so are its arguments regarding Dr. Jacobsen's analysis.

Dr. Jacobsen's opinions show, in step-by-step detail, that Petitioner had "selectively and improperly withheld [disease severity (EX1031 EX1032), yield, and defoliation (EX1033)] material results that were inconsistent with its arguments" (EX2020, ¶¶246-247, 253-257), and reported cumulative data that were artificially construed from cherry-picked timeframes (EX1031; EX1032; EX2020, ¶¶262-266). *Spectrum Sols. v. Longhorn Vaccines & Diagnostics, LLC*, IPR2021-00847, Paper 107 at 2, (PTAB May 3, 2023).⁴ Petitioner does not—and cannot—deny the substance of Dr. Jacobsen's opinions on the data that Petitioner generated and misrepresented as not supporting Patent Owner (EX2019, 10:6-14).

At bottom, Petitioner points to no evidentiary (or substantive) basis to exclude Dr. Jacobsen's testimony.

⁴ Also listed in P-TACTS as Paper 113.

III. Conclusion

For the foregoing reasons, Patent Owner respectfully requests that Petitioner's Motion be denied.

Date: March 26, 2024

Respectfully submitted,

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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 Exclude (Paper 48)** was served electronically via email on March 26, 2024, in its entirety on the following:

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Dated: March 26, 2024

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