

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 11,445,727

Record of Oral Hearing
Held: April 15, 2024

Before SUSAN L. C. MITCHELL, ZHENYU YANG, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

PGR2023-00017
Patent 11,445,727

APPEARANCES:

ON BEHALF OF THE PETITIONER:

CARSON, ESQUIRE
BakerHostetler LLP
1050 Connecticut Avenue, NW
Suite 1100
Washington, DC 20036
ccarson@bakerlaw.com
(202) 861-1771

ON BEHALF OF THE PATENT OWNER:

FELDSTEIN, ESQUIRE
Finnegan, Henderson, Farabow, Garrett, & Dunner, LLP
901 New York Avenue, NW
Washington, D.C. 20001
mark.feldstein@finnegan.com
(202) 408-4092

The above-entitled matter came on for hearing on April 15, 2024, commencing at 2:02 p.m., at the U.S. Patent and Trademark Office, 600 Dulany Street, Alexandria, Virginia.

P R O C E E D I N G S

- - - - -

JUDGE YANG: Good afternoon. This is the hearing for PGR2023-00017 involving Patent No. 11,445,727. I am Judge Yang and here joining me is Judge Mitchell and Judge Valek is appearing remotely. Now, Counsel, please introduce yourselves. Let's start with Petitioner, please.

MS. HERBERT: Toni Herbert with Syngenta Crop Protection. I am from BakerHostetler.

MR. CARSON: I'm Charles Carson with BakerHostetler for the Petitioner.

JUDGE YANG: Thank you. Patent Owner, please.

MR. FELDSTEIN: Mark Feldstein, Your Honor, with Finnegan Henderson for the Patent Owner.

JUDGE YANG: Thank you.

MR. GUERRA: Kenneth Guerra from Finnegan Henderson on behalf of Patent Owner.

JUDGE YANG: Thank you and welcome, everyone. As we stated in the trial order, each party has 60 minutes, and we'll start with Petitioner and then Patent Owner. And each party, if you desire, you can reserve at most 15 minutes for rebuttal.

Before we go into today's arguments, I'll start with a few housekeeping matters, I'll just go through it quickly. First, when you do your presentation, your argument, please clearly identify the record so the transcript is clear, and we can follow you well. And, also, Judge Valek

1 cannot see what you put on the screen, but he has the record so if you
2 identify your slide number, the page number, column, line number, whatever
3 is helpful. He will be able to follow you.

4 Second, I want to mention that we do know that we have an
5 outstanding motion to submit supplemental information, and a motion from
6 Petitioner also to exclude. That is paper 48. For today's argument, you are
7 free to proceed however you want. Eventually if we determine certain
8 evidence should not be admitted or should be excluded then we will not
9 consider them, and we will not consider the argument related to them.

10 The third thing I want to mention is as far as I can tell, there are
11 two motions to seal, both filed by Patent Owner. And if I understand it
12 correctly, the reason Patent Owner filed the motions to seal is because the
13 information is -- the alleged confidential information is actually Petitioner's.

14 I looked around, I think Exhibits 1031, 1032, and 1033 were filed
15 as Board and parties only but I did not see a motion to seal for those
16 exhibits. I might be wrong, but I think it will be a good idea for Petitioner to
17 double check, make sure there is a motion to seal for that. Without a proper
18 basis to seal those information, I think Patent Owner's motions to seal, we
19 also cannot grant those.

20 For today's hearing, this is a public hearing, and I understand that
21 there is a -- at least one on the public line. I see Patent Owner actually filed
22 your demonstratives as a sealed document. Do you plan to present any -- at
23 this time, let's just assume it is confidential -- do you plan to present any
24 argument using the confidential information?

25 MR. FELDSTEIN: Your Honor, we will present argument based
26 on the information. I don't think that we'll verbally be referring to any

1 specific information that is in the sealed exhibits.

2 JUDGE YANG: Okay. That's good. And if you change your
3 mind, if any, either of you would like to discuss confidential information,
4 please let us know. And our very able technical staff will close the public
5 line. That way we'll keep the information confidential.

6 MR. FELDSTEIN: Okay. And, Your Honor, just to be clear,
7 we're going to refer to the information that's on our slides, but not
8 specifically the numbers. So if Petitioner has an issue with that, they have
9 our slides. And so I just wanted to bring that to your attention and their
10 attention.

11 JUDGE YANG: So, Petitioner, I imagine you have reviewed
12 Patent Owner's slides. Do you have any objection to them presenting it?

13 MR. FELDSTEIN: No, we don't.

14 JUDGE YANG: May I also ask the two gentlemen --

15 MR. KLECYNGIER: I am David Klecyngier.

16 JUDGE YANG: Are you from the public? Sorry?

17 MR. KLECYNGIER: David Klecyngier with BakerHostetler.

18 JUDGE YANG: Okay.

19 MR. BUCCA: Daniel Bucca with BakerHostetler with Syngenta.
20 Thank you.

21 JUDGE YANG: Okay. Are we all covered under the protective
22 order. All right. So it is fine for you to discuss it. Thank you. So, lastly,
23 for today's argument if you have any objection during the other party's
24 presentation, please just hold your horse and you can object after they finish.
25 And Petitioner you also get a chance after the sur-reply. We would
26 appreciate it if you don't interrupt each other so it's easier for the

1 presentation. All right. That will be it on my side. Any questions?

2 MR. FELDSTEIN: No, Your Honor.

3 MR. CARSON: No.

4 JUDGE YANG: Great. Then, Petitioner, would you like to
5 reserve any time for rebuttal?

6 MR. CARSON: Ten minutes, Your Honor.

7 JUDGE YANG: Ten minutes. All right. So the clock behind me
8 will show the time remaining. I'll try to give you a warning, say five
9 minutes before but keep an eye on it.

10 MR. CARSON: Thank you.

11 JUDGE YANG: All right. So whenever you're ready, please go
12 ahead.

13 MR. CARSON: Good afternoon. I'm Charles Carson,
14 BakerHostetler, on behalf of Petitioner Syngenta. And let me begin by first
15 thanking the Board for its consideration of Syngenta's petition for post-grant
16 review. Let's start with the patent at issue. This is Exhibit 1001. Do I need
17 to announce the slide numbers as I advance them? Is that --

18 JUDGE YANG: Judge Valek, I understand you can actually -- we
19 have just used a new system. I understand Judge Valek might be able to see
20 the slides, actually. Is that right?

21 JUDGE VALEK: Yes. I can see the slides. Although it would
22 probably be helpful for the transcript if you record the slide number.

23 MR. CARSON: Okay.

24 JUDGE VALEK: So if we need to go back later.

25 MR. CARSON: Okay. So, Slide 2, let's start with the patent at
26 issue. Exhibit 1001. Slide 3. The UPL patent also referred to in the papers

1 as the '727 patent bears a title that is indicative of the subject matter in the
2 scope of the claims. And that is simply fungicidal combinations. The
3 priority date is November 4, 2016.

4 Slide 4. Here is Claim 1. This is directed to a fungicidal
5 combination that consists of at least three fungicides. Benzovindiflupyr and
6 mancozeb are required, and then the claim provides a list of 55 fungicides
7 from at least one fungicide is required. And these 55 fungicides are in two
8 categories, the ergosterol biosynthesis inhibitors and quinone outside
9 inhibitors.

10 And I want to note that there's a typo on this slide, actually. In the
11 quinone outside inhibitor category, three fungicides were inadvertently
12 omitted from the list.

13 Now if we could focus for a moment on the beginning of the claim,
14 the consisting of at least another language of the claim. As this language
15 indicates, the combination consists of -- a combination consisting of three
16 fungicides which fall within the scope of the claim as long as the third
17 fungicide is among the list of 55.

18 But also, a combination of four or more fungicides would fall
19 within the claim as long as those additional fungicides were among the list
20 of 55. The language is, "consists of benzovindiflupyr, mancozeb, and at
21 least another fungicide" from the list of 55.

22 The UPL patent has four independent claims, Claims 1, 2, 5, and
23 10. In terms of the fungicidal combination, Claims 5 and 10 mirror Claim 1
24 which I've just described. And I'll have more to say about Claim 2 later on.

25 I'll finally note that Claim 1 and the other independent claims do
26 not require that the combination be effective in any degree. There's no

1 limitation with respect to efficacy. The claims also don't require that the
2 individual fungicides are compatible with each other, and the claims don't
3 require that the combination not harm the plant if applied. So there's no
4 efficacy limitations, there's no compatibility limitations, there's no
5 phytotoxicity limitations. The claims are simply directed to the
6 combination.

7 Slide 5. Claim construction. Slide 6. The terms "combination"
8 and "composition." Now the parties agree that these two terms should be
9 construed consistent with each other. But the Patent Owner, in its
10 preliminary response advanced a construction of combination and
11 composition that is directly at odds with the intrinsic evidence, the
12 specification of the UPL patent.

13 Specifically what UPL is arguing is that the terms require a
14 simultaneous tank mix application and exclude a sequential application.
15 And in our reply we addressed UPL's construction and explained why it was
16 wrong. And we also explained that it doesn't matter in terms of the validity
17 over the prior art. And UPL has suggested that our reply arguments are
18 improper and should have been raised at the petition, and I want to address
19 that very briefly.

20 This Board's precedent and that of the federal circuit is clear that
21 when a patent owner raises a claim construction position for the first time in
22 its response, the petitioner is entitled to respond to it, which is exactly what
23 we did.

24 We cited that precedent in our papers, and I would add a more
25 recent case, *Axonics v. Medtronic* at 75 F.4d 1374. That's Federal Circuit
26 2023 in which the Federal Circuit held, "Where a patent owner proposes a

1 claim construction in a patent owner response the petitioner must be given
2 the opportunity to reply, to argue, and present evidence of anticipation or
3 obviousness under the new construction at least where it relies on the same
4 embodiments for each invalidity ground as were relied on in the petition."
5 And that is exactly what we've done in this proceeding. So let's look at the
6 intrinsic evidence.

7 Slide 7. We've highlighted here a single sentence from the UPL
8 patent that is dispositive. Here the Patent Owner draws a distinction. A
9 distinction between simultaneous tank mix application on the one hand, and
10 sequential application on the other. And affirmatively states that the
11 composition of the invention covers both.

12 And UPL in its briefing has avoided addressing this particular
13 sentence. In fact, in its response when it advanced its novel construction for
14 the first time, it failed to acknowledge this language at all. Only in its sur-
15 reply did UPL argue that when the '727 patent describes sequential
16 application what it's really talking about is repeated treatments over the life
17 cycle of the plant.

18 But in support, UPL ignores the sentence that's highlighted here,
19 and it focuses instead on the language below that, which we've also
20 excerpted, and you can see. And although this language is describing
21 repeated treatments over the life cycle of the plant, it's clear that it's not
22 addressing how the treatment is applied for any given application.

23 That question is only addressed by the sentence before which
24 we've highlighted. Now focusing on the highlighted sentence, it says, may
25 be applied simultaneously or may be applied sequentially. The composition
26 of the present invention may be applied simultaneously or may be applied

1 sequentially.

2 UPL is effectively rewritten this sentence to say that the
3 composition may be applied once as a tank mix or formulation or may be
4 applied repeatedly. But the sentence doesn't say once, it says
5 simultaneously. And it doesn't say repeatedly, it says sequentially. Those
6 words have different meanings.

7 Slide 8. We looked at the intrinsic evidence. This slide addresses
8 the extrinsic evidence. Now in terms of the extrinsic evidence UPL has
9 argued, and I presume they're going to argue again today, that the testimony
10 of Syngenta's expert, Dr. Brannen supports a construction in combination
11 and composition to be limited to a tank mix and to exclude sequential
12 application.

13 But the testimony they cite refers only to "combining or adding
14 materials together," which only begs the question as to what's meant by
15 combining or adding materials together. Does that include a sequential
16 combination?

17 Dr. Brannen actually answered that question later in his deposition
18 testimony that UPL does not cite, but which we've provided here at the
19 bottom of the slide. And he affirmed that the claims of the '727 patent based
20 on the spec, would not be limited to a tank mix. And this is also
21 consistent --

22 JUDGE VALEK: Counsel?

23 MR. CARSON: Yes.

24 JUDGE VALEK: Counsel, I have a question for you. Does the
25 prior art in specifically Tobler, does it disclose a tank mix consisting of the
26 three recited fungicides in Claim 1?

1 MR. CARSON: It discloses a fungicidal combination that includes
2 all three. And it says, it discloses that that can be applied as either a tank
3 mix or sequential.

4 JUDGE VALEK: If that's so, why are we arguing about this claim
5 construction?

6 MR. CARSON: Well, the Godoy reference, in Patent Owner's
7 view, discloses only sequential application, not a tank mix. And so that's
8 one of their arguments as to why Godoy does not anticipate. And argue
9 again, the claim is clear, it covers both. And so whether Godoy covers one
10 or the other or both, it doesn't matter.

11 JUDGE VALEK: Do we have to resolve this claim construction
12 issue to rule in your favor on the Tobler ground?

13 MR. CARSON: I don't believe you do. The Tobler definition is
14 actually very similar to the '727 patent definition. They describe it as
15 unconventional when they're referring Tobler, but it's identical to their own
16 definition. The composition can be applied either simultaneously or
17 sequentially. So you do not have to resolve this for Tobler.

18 I think though when we get to Tobler that you'll see that UPL is
19 making some, I'll call them novel arguments with respect to the complexity
20 or the uncertainty associated with the Tobler list. And one of the ways they
21 build upon that uncertainty and magnify it, excuse me, in their view is by
22 focusing on Tobler's disclosure of both simultaneous application and
23 sequential application.

24 And then they take the sequential application, and they multiply
25 that by 13 different ways you could do sequential. And then they take that
26 number 13 and multiply it by -- you know, and they create this huge list. So

1 it does matter in their view with respect to the, I guess the magnitude of the
2 list in Tobler.

3 But if the Board decides, as we think it should, that the '727 claims
4 cover both, then that entire argument about the uncertainty and length and
5 complexity of the Tobler list, that also goes away. So I think it is useful to
6 the Tobler analysis, at least as the way it has been presented by UPL.

7 And I was just going to add that Dr. Brannen's testimony is
8 consistent with his declaration which also makes the point that the patent
9 discloses, the UPL patent both simultaneous and sequential application.

10 Now the next term, consisting of. The parties agree that the
11 standard meaning of that phrase in patent law should apply. So in the
12 context of the '727 claims, the combination -- the fungicidal combination is
13 limited to the particular fungicides recited in the claims. In other words, the
14 presence of a fungicide not recited in the claims would place the
15 combination outside the scope of the claims.

16 But remember, remember, independent Claims 1, 5, and 10 recite a
17 fungicidal combination consisting of benzovindiflupyr, mancozeb and at
18 least one of the list of 55 additional fungicides. So notwithstanding that
19 consisting of language, the claims are not limited to three active ingredients.
20 In fact, a combination of 57 different active ingredients would still fall
21 within the scope of the claim.

22 Quickly, I want to emphasize that consisting of does not preclude
23 the use of inert carriers or adjuvants. And I don't think this is disputed
24 between the parties. This becomes important though for Godoy. The '727
25 patent actually describes the use of inert carriers or adjuvants. We have this
26 language here.

1 Slide 11 provides specific examples of inert carriers and adjuvants.
2 One of those is petroleum aliphatic hydrocarbons which is mineral oil. And
3 you'll see testimony from Dr. Jacobson confirming that. So the patent itself
4 describes mineral oil, which will become an issue with Godoy, as an inert
5 carrier or adjuvant which is not excluded from the claims.

6 JUDGE YANG: So this, on the mineral oil part, my understanding
7 is Patent Owner's argument goes two prongs. First is, there is no mention of
8 nimbus as mineral oil. And second, even if it is mineral oil, at the
9 concentration it's presented in the reference, it has fungicidal effect.

10 So it's not that -- like you said -- I don't think anybody argues you
11 cannot have adjuvant or a carrier despair. It's whether it is mineral oil or
12 not.

13 MR. CARSON: That's right, Your Honor. And I'd be happy to
14 address those questions. I'm about to in about three slides.

15 JUDGE YANG: That's fine.

16 MR. CARSON: Okay.

17 JUDGE YANG: You can have that.

18 MR. CARSON: I'll get to it in just a moment.

19 JUDGE YANG: Okay.

20 MR. CARSON: Okay. So let's look at Godoy. And Petitioner
21 asserts that the particular claims identified here are anticipated by Godoy.
22 Godoy is referenced one exhibit -- sorry -- Exhibit 1005. Godoy, and this is
23 the first page of Godoy, Slide 13. On its face it provides a publication date
24 of August 2016 which is prior to the priority date of November 2016.

25 Here we've reproduced Table 3 from Godoy which discloses the
26 fungicidal treatments for soybeans that were evaluated. And you can see

1 here there were 23 treatments. Two of those treatments involved a
2 combination of azoxystrobin, benzovindiflupyr, and mancozeb.

3 And if we place this disclosure next to the claim, as you can see
4 here again, at treatment 23. Placing it next to it's clear that there's
5 anticipation. Treatment 23 includes benzovindiflupyr, underlined in the
6 salmon color, you can see that over in the claim. Treatment 23 has
7 mancozeb, that's highlighted in purple, that's the second ingredient
8 required -- second fungicide required by Claim 1. And then the third
9 fungicide in this combination as disclosed in Table 3 of Godoy is
10 azoxystrobin. And that is one of the quinone outside inhibitors. It's one of
11 the 55 fungicides listed that can be added, or to be added, one of which is to
12 be added to mancozeb and benzovindiflupyr. So anticipation by Godoy is
13 established by a simple comparison of Godoy Table 3 to the claim.

14 Now, in response, UPL makes three arguments and I'm going to
15 get to your question, Your Honor. They make three arguments. One, there's
16 no evidence of -- that Godoy was publicly available prior to the November
17 2016 priority date. Godoy in their view discloses sequential application, not
18 a mix. And finally, that Godoy includes a fourth active ingredient that's not
19 recited in the claims.

20 So let me address those individually. In terms of -- going to Slide
21 16, excuse me. In terms of public availability, Syngenta included with this
22 petition a declaration from Dr. Hall-Ellis. It's Exhibit 1019. She has a PhD
23 in library science and is an adjunct professor in that field.

24 Dr. Hall-Ellis attached to her declaration the page from the
25 Embrapa website. We've got it here on the slide. This is attachment 1B to
26 her declaration where the Godoy article, this is from the Embrapa website

1 where the Godoy article was published.

2 The page includes information regarding the current date,
3 September 1, 2016, the date of last update, September 22nd of the same
4 year. Both dates of course prior to November 2016. The Embrapa page also
5 includes the year of publication, 2016 which is consistent with the dates
6 above. It also includes a URL where the page can be accessed, and below
7 that is a link to the MARC record where it says, "show complete MARC"
8 where you can view the MARC record for this page.

9 And Dr. Ellis explained in her original declaration that MARC
10 records include fields identifying publication date and also include fields
11 that show information regarding subject matter classification that provide
12 access according to generally accepted thesaurus building words. So that's
13 the original Hall-Ellis declaration.

14 In addition to that, Dr. Jacobsen, UPL's expert testified that
15 Embrapa, he confirmed that Embrapa, where Godoy was published, is the
16 Brazilian equivalent of the USDA. And he also testified that as a plant
17 pathologist, he has personally monitored and read Embrapa publications for
18 years and that in his -- and they quote, "any good scientist would do so."

19 So Petitioner contends that with the original Hall-Ellis declaration
20 and attachment coupled with Dr. Jacobsen's deposition testimony regarding
21 Embrapa, we've put forward more than sufficient evidence to show that
22 Godoy is publicly available and accessible prior to primary data.

23 Nevertheless, UPL argued that it was not sufficient in its
24 preliminary response, and Syngenta timely served supplemental evidence
25 including a supplemental Hall-Ellis declaration. UPL opposes that
26 declaration, that supplemental evidence as improper. And I feel the need to

1 briefly address that because we think it's entirely proper.

2 There's two points here. First, Syngenta served the supplemental
3 evidence after the institution decision and within the 10 days that -- or
4 month, I'm sorry -- the timeframe provided by section 42.132a. Second, the
5 supplemental evidence relating to the public availability of Godoy falls
6 squarely within this Board's decision Palo Alto v. Juniper which we cited in
7 our motion to supplement. That's paper 14.

8 Palo Alto, just like here, involves supplemental information
9 directed to public availability to the prior art. In Palo Alto, or just in Palo
10 Alto the supplemental Hall-Ellis declaration "does not change the grounds of
11 patentability," and "does not change the evidence initially presented in the
12 petition to support those grounds of patentability."

13 In addition, there's no suggestion here that the supplemental
14 information was withheld intentionally, nor was it, and supplementation has
15 not affected in any way the timely disposition of this proceeding. And under
16 Palo Alto, under the Board's decision, consideration of whether the
17 supplemental information reasonably could have been obtained earlier does
18 not apply to supplementation as here under section 41.132a.

19 And finally, the other thing that's emphasized in Palo Alto is the
20 absence of prejudice. And here UPL has not argued prejudice, nor could
21 they argue prejudice. This supplemental information was timely served, and
22 UPL has had ample time to explore it. They actually noticed the deposition
23 of Dr. Hall-Ellis after getting both her original and supplemental declaration.
24 We agreed to a date. I believe the date was calendared and prior to the
25 deposition UPL withdrew its notice and decided not to depose her.

26 So there's been no prejudice. They've had ample time to review

1 this and there's no basis for excluding the supplemental declaration of Dr.
2 Hall-Ellis.

3 Now quickly to go through that supplemental declaration and the
4 documents that were attached to it. And I think you'll see the public
5 availability of Godoy is unassailable.

6 First we have here the MARC record. Again, this was the record
7 that was actually linked to the original declaration. And you can see here
8 that the MARC record provides the date that it was -- that Godoy was
9 published, at least as early as September 22, 2016. And if you look at field
10 650, those provide the subject matter classifications assigned to the record to
11 provide public access.

12 Also attached to the supplemental declaration of Dr. Hall-Ellis was
13 the Dublin Core record. This is the Dublin Core record. It provides the date
14 created the date available, the date accessioned, all of which, September
15 2016 before the priority date.

16 We also provided actual download statistics that Dr. Hall-Ellis did
17 during the month of September 2016 clearly showing that the publication
18 was available, and it was accessed. Finally she included an excerpt from
19 ResearchGate. There's a printout from ResearchGate. And what this shows
20 is that Dr. Godoy herself uploaded her publication to ResearchGate on
21 September 9, 2016.

22 Now what is ResearchGate? Dr. Jacobsen actually provided
23 testimony that answers that question for us, although Dr. Hall-Ellis also
24 described it. But looking at his testimony, he was familiar with
25 ResearchGate and confirmed that. And as he testified, ResearchGate is a
26 publication service that allows the public to search for publications using

1 key words. And he testified that he has personally used search engines such
2 as ResearchGate throughout his entire professional career. So again, I think
3 this evidence establishes definitively that Godoy was publicly available,
4 publicly accessible prior to the priority date.

5 And then you know, UPL could have retained their own expert in
6 library science. They didn't do that. Instead they asked their technical
7 expert, Dr. Jacobsen to opine on Dr. Hall-Ellis' declaration. Curiously when
8 they asked him to do that they only provided her original declaration to him.
9 They withheld, didn't provide to him, her supplemental declaration.

10 But during his deposition he admitted he has no expertise in library
11 science, and he would not consider himself competent to render opinions in
12 the area.

13 This is more of the testimony. We showed him the MARC record
14 that I showed you a few minutes ago. He didn't know what it was, didn't
15 know what the fields meant, had never heard of Dublin Core. That's his
16 testimony.

17 And finally, UPL in other patent proceedings outside the United
18 States is actually represented on the record in formal proceedings that Godoy
19 was published in August 2016, so they should be held to that. Now
20 disclosure of the tank mix. This is the -- Slide 25 -- this is the second
21 argument.

22 JUDGE MITCHEL: Will you excuse -- can I -- may I ask one
23 question? So are you relying on Dr. Ellis at all for showing the appropriate
24 public had access? Did she provide evidence that these databases are looked
25 at by scientists or were you looking at Dr. Jacobsen's testimony?

26 MR. CARSON: No, she brought -- I didn't go into all of her

1 declarations, there's two of them. But she discusses these records that I've
2 been covering in detail. Their purpose, what they're used for, who has
3 access. So all of that is covered by her.

4 I'm just highlighting Dr. Jacobsen's testimony to supplement and
5 confirm that from his perspective. I think if you look at the ResearchGate
6 document by itself, Dr. Jacobsen -- and Hall-Ellis addresses ResearchGate as
7 well.

8 ResearchGate is a site where you can upload, you can publish your
9 publications, it's available to scientists everywhere, and scientists regularly,
10 like Dr. Jacobsen, go to that site and they use keywords to find documents.
11 And the excerpt from ResearchGate that we provided through Dr. Hall-Ellis
12 shows that Dr. Godoy put her paper on that site making it available for Dr.
13 Jacobsen to do a keyword search and find in September of 2016 before the
14 priority date.

15 Okay. Now if we go to the second argument, and this finally, I
16 apologize for the delay, but this gets to your question. They argue that
17 Godoy discloses sequential application, not simultaneous tank mix
18 application.

19 Now as an initial threshold point here, none of this matters if the
20 Board construes the claims as we think they should, it's what I talked about
21 already, to cover both sequential and simultaneous application. This
22 argument goes completely away.

23 But nevertheless, if you take a look at Godoy we see that it
24 discloses first treating the soybean plants with the multisite fungicides
25 alone -- fungicides alone -- one of those is mancozeb, and then applying a
26 treatment in which mancozeb is used in association with azoxystrobin and

1 benzovindiflupyr.

2 Godoy then explains that a knapsack sprayer was used for the
3 application. There's no mention here or anywhere else in Godoy of a
4 sequential application. And Dr. Brannen, Syngenta's expert pointed to this
5 disclosure and concluded in his declaration that a person of ordinary skill in
6 the art would have understood Godoy to disclose fungicidal combinations
7 mixed with water or another carrier and applied by a sprayer, i.e. a tank mix.

8 He also testified in his deposition, Dr. Brannen did, that Godoy
9 disclosed a tank mix application. And when Dr. Brannen was asked if there
10 was anything he would expect to see in Godoy, if in fact Godoy was
11 disclosing sequential applications instead of a tank mix, is there anything
12 he'd expect to see in there. He testified that it would be spelled out as such
13 in the materials and methods.

14 And UPL has actually trotted out other documents from the time
15 saying hey, this document uses association, and these documents explicitly
16 describe sequential application. And so when Godoy uses association it's
17 also using a sequential application. Those references to Souza and Reyes
18 actually spell out a sequential application. They confirm Dr. Brannen's
19 testimony that if a reference is disclosing sequential application, it's going to
20 do so explicitly.

21 This is an excerpt from the Machado Reference which provides
22 further support for Dr. Brannen's opinion that a person of skill in the art
23 would read Godoy to disclose a tank mix. The Machado Reference actually
24 cites the Godoy publication directly. That's the reference 2016b. That's the
25 Godoy at issue here. It actually cites to it specifically and describes it as a
26 tank mix. And we've included that language here.

1 And one of the co-authors of Machado Reference is Godoy herself.
2 And so what this provides is simply further support for Dr. Brannen's
3 opinion that a person of ordinary skill in the art would read Godoy as they
4 read Godoy to disclose a tank mix.

5 I think we can cover these dictionary definitions very quickly.
6 Again Godoy, UPL's argument is Godoy uses the term "association"
7 although I will point out Godoy also uses the term "combination." UPL
8 ignores that. They focus on the fact that Godoy uses the term "association."

9 They contrast that with their own patent which uses the term
10 "combination," and they say hey, see association Godoy is sequential,
11 combination in our patent is simultaneous. And they try out some dictionary
12 definitions. Which if you look at those definitions they use the terms
13 interchangeably.

14 What we have at the top is a definition of association. It's defined
15 to be in combination, they're synonymous. And then below that two
16 definitions of combination and association, each of which is defined to mean
17 union. They have the same definition.

18 Nimbus. This is UPL's third argument, or final argument. And
19 again, they argue that Godoy discloses a fourth active ingredient that places
20 Godoy outside the scope of the '727 patent. And this finally, I apologize, I
21 teased this for a number of slides. This actually does address your question.

22 What UPL points to is a footnote. A footnote in Godoy. A
23 footnote reference to Nimbus. And they say Godoy doesn't define Nimbus
24 and so it must be assumed that Nimbus is a fungicide. But that's just not a
25 credible reading of this reference.

26 You can see here on Slide 31, Godoy expressly labels the first

1 column of the chart active ingredients and Nimbus appears nowhere in that
2 column. Line 17 lists azoxystrobin, benzovindiflupyr, and mancozeb as the
3 active ingredients which together anticipate the claims. No mention as
4 Nimbus as an active ingredient.

5 Nimbus appears only in the footnote indicating that it's not an
6 active ingredient. In fact, if you search Godoy you'll find that the only time
7 that Nimbus is ever mentioned is in the table footnotes. In the body of
8 Godoy it discusses the fungicidal combinations at length and the outcomes
9 of the various treatments repeating the names of the fungicides that are
10 provided on this page. At no point does it ever mention Nimbus in the body
11 of the disclosure talking about the treatments, how they were applied, the
12 outcome of the treatments. Nimbus is not mentioned anywhere.

13 Consistent with this disclosure, and Dr. Brannen's declaration
14 accompanying the petition he explained that Nimbus is not an active
15 ingredient but rather, it's a well-known adjuvant mineral oil.

16 And as we saw before the '727 patent itself describes you know,
17 describes inert adjuvants and carriers, provides a specific example, and that
18 includes aliphatic hydrocarbons which Dr. Jacobsen, Slide 34 confirmed
19 included mineral oil.

20 So I believe -- just to continue for a moment -- Nimbus, so UPL
21 tries to suggest that Nimbus is something other than mineral oil. And they
22 point to registrations of the term Nimbus in other countries where it's a
23 sulfur product. But the Godoy experiments were performed in Brazil. And
24 Nimbus is only registered as a mineral oil in Brazil.

25 Excerpted here is a declaration of Mr. Ryan Cody Jones, which
26 UPL has not challenged or sought to depose, describing the registration of

1 Nimbus in Brazil and that it's a mineral oil that does not contain a fungicide.

2 And UPL has reproduced, they trotted forth registrations
3 themselves. Every single one of those registrations is outside Brazil. The
4 only -- all the Nimbus registrations in Brazil identify it, register it as mineral
5 oil.

6 This registration is consistent with Godoy's mention of Nimbus
7 only in a footnote, not as an active ingredient in the disclosed reams.

8 Now in addition to arguing that Nimbus is a sulfur product,
9 Nimbus also argues that even if it is a mineral oil it can have a fungicidal
10 effect. And what we have here are a series of slides, Syngenta patents that
11 show Nimbus is an inert adjuvant. It has zero fungicidal effect.

12 Here is a Syngenta patent in which Nimbus is again described as a
13 commercial available adjuvant. The treatments include Nimbus at a rate of
14 600 ml/ha. That's the same rate used in Godoy, the same application rate.

15 This Syngenta patent actually tested Nimbus. Again it describes it
16 as a commercial adjuvant, tested it on its own and found zero effect. Zero
17 fungicidal effect.

18 Now this is not in my slides, this is going to be in their slides, and
19 this is in response to your question. UPL has asserted repeatedly that the
20 concentration of mineral oil in Godoy has been shown in other context to
21 have fungicidal effect.

22 They rely on a single reference for that proposition. That's the
23 Wojdyla reference. The Wojdyla reference was not produced in this case.
24 They rely on and cite to a table from Wojdyla 2015, but what was actually
25 produced in this case was Wojdyla 2005. We've never seen that exhibit; it's
26 never been produced. In Dr. Jacobsen's deposition I confronted them. Dr.

1 Jacobsen confirmed it was not produced. And in fact UPL's Counsel on the
2 record confirmed it had never been produced. So we have no way of
3 actually testing what Dr. Jacobsen and UPL say about that Wojdylareference
4 because it's not in the record.

5 Not only that, in Dr. Jacobsen's deposition, and we cite this in our
6 reply, in his deposition he confirmed that what Godoy provides is the
7 application rate, what Wojdylaprovides is the concentration. And if you
8 want to equate the two and compare them you need both. You need both.

9 A perfect example of that. If I fill a vial with five percent mineral
10 oil, the concentration is five percent. I can take that vial, and I can add one
11 drop to a leaf, or I can completely douse the leaf. Whether or not you do
12 that matters. Wojdylais silent, at least in terms of -- as Dr. Jacobsen has
13 described it -- is silent as to the application rate. In his deposition he
14 admitted it was silent. He didn't know the application rate. And he admitted
15 that you needed both application rate and concentration to draw any
16 conclusions. The cites to his transcript are in our reply.

17 This is Dr. Jacobsen's own patent, Slide 38. It describes mineral
18 oil as inert. He also provides a list of fungicides. Mineral oil is not among
19 those. I think you're probably going to hear from UPL that oh, in his patent
20 there's a list of fungicides. It includes oils. In Dr. Jacobsen's deposition he
21 said yes, there are oils there, they do not include mineral oil. That was cited
22 in our reply as well.

23 Okay. Anticipation by Tobler. Petitioner asserts that Claims 1,
24 and 3 through 10 are anticipated by Tobler. Tobler, this is Slide 40, is
25 entitled fungicidal compositions. Date of patent, April 19, 2016 before the
26 priority date.

1 Here is the relevant excerpt from Tobler. I want to spend just a
2 few minutes on this. The first thing we see here is that Tobler is disclosing
3 two embodiments, E1 and E2, and describes that each is comprising three
4 active ingredients. Tobler then discloses that one embodiment is mancozeb
5 plus TX1 and defines TX1 to mean compound A-1.1 which the parties all
6 agree is benzovindiflupyr. Plus a compound selected from group P.

7 So Tobler is disclosing a three-active ingredient composition of
8 mancozeb, benzovindiflupyr, and a compound selected from Group P.
9 That's the disclosure.

10 Tobler then provides a list of 250 individual Group P compounds.
11 That list includes 47 of the 55 compounds in Claim 1, in the claims of the
12 '727 patent. So if we compare Tobler to independent Claim 1 again,
13 compound A-1.1 is benzovindiflupyr, mancozeb. And both, those are the
14 two required fungicides that were disclosed on. Those are part of the claim
15 number one. And then the Group P list, which I've included part of here.
16 Among the list there is azoxystrobin in Tobler, that's one of the 55 additional
17 fungicides listed in Independent Claim 1 of the '727. And again, in fact of
18 the 55, 47 of them are in Group P.

19 And Dr. Jacobsen, UPL's expert, has admitted that this reading of
20 Tobler which I've just provided to you it's in our papers, it's Dr. Jacobsen's
21 reading, Dr. Brannen's reading, Dr. Jacobsen confirmed that that is the right
22 reading of the Tobler reference. He acknowledged that compound A-1.1 is
23 benzovindiflupyr. And thus he acknowledged that embodiment E1 of Tobler
24 was mancozeb, benzovindiflupyr, and a compound selected from Group P.
25 He also admitted that Tobler discloses a list of the members of Group P, and
26 he went on to identify in his deposition multiple members of the Group P list

1 that fall within the 55-fungicide list in the claims of the '727 patent.

2 Now notwithstanding the fact that Tobler expressly discloses 47 of
3 the 55 fungicidal combinations that fall within the scope of the claim, UPL
4 argues that there's no anticipation by Tobler. And frankly they throw the
5 kitchen sink here. They vigorously argue that some members of Group P are
6 purportedly incompatible with others. Or they argue that when combined
7 they could be phytotoxic to the plants.

8 They also suggest that some combinations might not be effective,
9 or that a person of ordinary skill in the art would not be motivated to choose
10 certain combinations over others. None of that matters. The claims don't
11 require any level of effectiveness. They don't require that the compounds be
12 compatible, and they don't require the combinations not be phytotoxic. The
13 claims simply recite a list of fungicidal combinations and Tobler similarly
14 lists individual combinations that fall within the claims.

15 And UPL argues that the uncertainties that it purportedly identifies
16 that they matter under the case law, citing a handful of cases, finding no
17 anticipation where the prior art discloses a genus. And a person of ordinary
18 skill in the art would not have immediately recognized the members of that
19 genus.

20 That's not Tobler. Tobler doesn't disclose the genus without
21 disclosing the members of that genus. Dr. Jacobsen admitted Tobler
22 discloses a list of fungicidal combinations, several of which on their face fall
23 within the scope of the claims.

24 And the Board properly acknowledged in its institution decision,
25 and the Perricone case confirms that, we've excerpted it here, that the case
26 law distinguishes between prior art that's disclosed as only a genus, and prior

1 art that discloses a delineated list, which is exactly what Tobler does.

2 Now UPL has cited various cases depending on which brief you
3 look at. All of them are distinguishable. In fact for a number of the cases
4 UPL just flat out misrepresents the whole. So we've got a summary of most
5 of those cases here. We discuss these at length in our briefing. Just to
6 quickly run through them, the Wrigley case, UPL quotes the dissent. They
7 call it the majority opinion and say hey, this supports us. The Nidec case.
8 They misrepresent the whole. It involves neither genus or a list.

9 The Mylan case. Which they rely on again, I think you're going to
10 see it today in their slides. The Mylan case discloses a genus. It does not
11 disclose the individual members of the genus.

12 In re Arkley. They cite for their picking and choosing quote. They
13 leave out all of the quote from Arkley which says, picking, choosing, and
14 combining various disclosures not directly related to each other by the
15 teachings of the reference. That's not Tobler. We've looked at Tobler. They
16 actually -- it tells you. It tells you exactly what it's disclosing.

17 Leo case. This case is not an anticipation case. It's an obviousness
18 case. And there was a key limitation there that the court relied on, the
19 claimed combination had to be stored stable, and non-aqueous. Again no
20 limitations here regarding effectiveness, et cetera. The FWP case, the
21 written description case. Beckman, like Mylan is a case in which the prior
22 art disclosed only a genus.

23 Turning now to obviousness. And I'm running out of time. I want
24 to first address the obviousness of Claims 1, and 3 through 10. We've
25 covered why we believe Tobler anticipates Claims 1, and 3 through 10.

26 If one were to decide that Tobler does not anticipate, and again we

1 think that runs counter to all of the case law. But if that was the decision,
2 the Petitioner has argued that the claims would be obvious over Tobler in
3 view of Godoy. And the only issue, again assuming anticipation is ruled
4 out, the only issue would be whether Godoy provides the guidance
5 purportedly missing from Tobler that would lead a person of ordinary skill
6 in the art to identify the particular combination in Tobler that meets the
7 claim.

8 And Godoy certainly does that. As we've seen from Godoy, it
9 identifies mancozeb, bensovindiflupyr, and azoxystrobin. In light of Godoy
10 a person of ordinary skill in the art would know to pick that combination
11 from the Tobler disclosure.

12 And moreover a person of ordinary skill in the art would be
13 motivated to combine Tobler and Godoy. UPL argues that we provided no
14 motivation to combine. That's simply not true. The petition identified
15 multiple reasons that a POSITA would be motivated to combine the two
16 references.

17 I point you to Petitioner pages 33 and 34, Dr. Brannen's
18 declaration. For example, at paragraph 153, there Dr. Brannen noted among
19 other things, both references are directed to soybean rust and fungicidal
20 combinations effective against rust. And both references suggest identical
21 and overlapping fungicidal combinations.

22 Claim 2. Claim 2, Petitioner has argued is obvious over Tobler.
23 Claim 2, we've got them side by side here on Slide 48. The only difference
24 is that Claim 2 deletes the language and at least another fungicide selected
25 from. So then you end up with in Claim 2, a fungicidal combination that
26 includes benzo, mancozeb, an ergosterol biosynthesis inhibitor, there's a list

1 there, and a quinone outside inhibitor, there's a list there. So four active
2 ingredients.

3 If we look at Tobler, this is a different disclosure than what we
4 were looking at before. And UPL makes you know, makes hay of the fact
5 that Tobler discloses many different things, many different embodiments. It
6 doesn't matter. We've shown you the particular embodiment that anticipates
7 the claims.

8 This is a different embodiment of Tobler that renders Claim 2
9 obvious. And what we have here in Tobler is the combination of two or
10 three components (B) with a component (A). Now component (A), one of
11 the members of component (A) is benzovindiflupyr. And as we've seen,
12 benzovindiflupyr is the sole member of Group A in the E1 embodiment.

13 And then Group B includes a number of fungicides including
14 mancozeb, including ergosterol inhibitors and including the quinone
15 inhibitors. And as I've already addressed the motivation to combine Tobler
16 with Godoy. But as we've seen in Godoy, Godoy discloses combinations
17 that include benzovindiflupyr, mancozeb, and a quinone outside inhibitor.
18 And Godoy also discloses mancozeb combined with a quinone outside
19 inhibitor and an ergosterol biosynthesis inhibitor.

20 Given the overlap in the disclosures of Tobler and Godoy, the
21 shared focus on soybean rust, as well as the recognition by a person of
22 ordinary skill in the art at the time of selecting fungicides at different modes
23 of action it would have been obvious to arrive at the fungicidal combination
24 covered by Claim 2. And all of this is addressed in our petition at pages 34-
25 36, and Dr. Brannen's declaration at paragraphs 156 to 162.

26 JUDGE VALEK: Counsel, we're running low on time. I have a

1 question for you. And this relates to the unexpected results showing that
2 Patent Owner has put forth specifically for Claim 2.

3 As I understand Claim 2 requires both an ergosterol biosynthesis
4 inhibitor fungicide and a quinone outside inhibitor fungicide. Is there any
5 evidence in any of the combinations that the Patent Owner relies upon for
6 unexpected results that include both of those things along with mancozeb
7 and benzovindiflupyr?

8 MR. CARSON: I'm going to confess to you that I'm not sure
9 standing here right now. I know there is one four-ingredient combination.
10 Whether it falls within the scope of Claim 2 or not I can't say at the moment.
11 But I will say this, that is a single four-active ingredient composition. And if
12 you look at Claim 2, there are many, many combinations that would fall
13 within the scope of Claim 2. And we have cited case law that says if you
14 want to show unexpected results they have to be commensurate with the
15 scope of the claim.

16 And purportedly showing unexpected results for one combination
17 among many does not meet that standard. In fact Dr. Jacobsen himself, their
18 expert, has never once in his declaration or his deposition for that matter
19 addressed whether or not his synergy, his unexpected results analysis is
20 commensurate with the scope of the claims.

21 They've made attorney arguments in their sur-reply to kind of
22 make up -- try to make up ground. Their expert never opines on that.

23 JUDGE YANG: When it comes -- I actually have a different
24 question.

25 MR. CARSON: Yes.

26 JUDGE YANG: So on the slide you have up there, Slide 49, on

1 the (B), (B) is a compound selected from a group consisting of -- you
2 highlight (B1) and (B2). But the group actually continues. There is the (B3)
3 showing on the slide but cut off from that are also the other possibly (B) s.

4 MR. CARSON: That's right.

5 JUDGE YANG: The question is, why would one select two of the
6 (B)s and specifically these two, and not the others?

7 MR. CARSON: Well that's our obviousness argument combining
8 Godoy. Godoy again combines ergosterol inhibitors and quinone outside
9 inhibitors which is what Claim 2 does.

10 JUDGE YANG: So then I just want to confirm. For Claim 2, do
11 you argue obviousness based on, in view of Tobler only or is it Tobler and
12 Godoy?

13 MR. CARSON: We do argue under Tobler alone. And if you look
14 at for example the other embodiment that anticipates the claims, there are
15 specific combinations that include fungicides that attack different modes of
16 operation. There's discussion in Tobler of the importance of including
17 mancozeb and the resistance management effects of mancozeb with
18 benzovindiflupyr.

19 And so we do believe it's obvious over Tobler alone. But there is
20 certainly no question when you combine Godoy and Tobler, given the
21 overlap in the combinations that each discloses individually.

22 JUDGE YANG: Actually we are over your time already. You
23 have the choice to continue for a few minutes, cut into your rebuttal time or
24 you can rest for your rebuttal.

25 MR. CARSON: I'll continue for just a couple of minutes.

26 JUDGE YANG: Okay.

1 MR. CARSON: So I was going to move to just in the interest of
2 time, in terms of obviousness over De Oliveria, I would simply refer the
3 Board to Syngenta's petition at pages of 50 to 68, and the declaration of Dr.
4 Brannen, Exhibit 1003 paragraphs 194 to 249.

5 In terms of secondary considerations, Dr. Jacobsen admits that
6 there is no long felt unmet need. And the case law is clear. If the prior art
7 discloses the solution, then there's no long felt unmet need. And Dr.
8 Jacobsen in his deposition testified that the one reference that he referred to
9 in his declaration to support an unmet need, a long felt unmet need, that
10 reference also provided a solution to that need. That's right here in black
11 and white in his deposition. I think that settles the matter.

12 In terms of unexpected results I've already talked about the results
13 needing to be commensurate with the scope of the claims. One more point
14 about that. I talked about claim 2. Claim 1, Claim 1 again is mancozeb,
15 benzovindiflupyr, and at least one of 55 additional fungicides.

16 I haven't done the math, but a three ingredient would be covered, a
17 four ingredient, five ingredient, a 57-ingredient combination would be
18 covered by Claims 1, and 3 through 10. And multiple permutations within
19 that, right. We're talking about hundreds if not a thousand combinations
20 covered by Claims 1, and 3 through 10.

21 The analysis that Dr. Jacobsen performs on unexpected results is
22 limited to four combinations. That's it. It does not, it's not commensurate
23 with the claims. And then in terms of his actual analysis, and that's if you
24 give his analysis credit. Right. It's given credit, it's not commensurate.

25 His analysis, and we went through this in our briefing, it's in the
26 remainder of these slides, his analysis does not hold up. He admitted in his

1 deposition that there's no scientific basis for a number of the assumptions
2 that he made. And he also admitted that his analysis was replete with errors
3 both in terms of the defoliation analysis and the yield analysis. UPL is
4 returning argument trying to fix some of the foliation errors. They don't
5 even touch the yield errors.

6 Because of the errors, because of the lack of scientific foundation
7 for his methods, we think those results should be discounted in their entirety.
8 With that I'll reserve whatever time I have remaining.

9 JUDGE YANG: All right. Five and a half minutes left.

10 All right. Patent Owner whenever you're ready.

11 MR. FELDSTEIN: Thank you, Your Honor.

12 JUDGE YANG: Let me know if you want to reserve any time
13 or --

14 MR. FELDSTEIN: I'd like to reserve ten minutes if I can, please.

15 JUDGE YANG: Okay.

16 MR. FELDSTEIN: While my computer screen sets up can I hand
17 out hard copies of the demonstratives?

18 JUDGE YANG: Sure. Yeah.

19 MR. FELDSTEIN: Judge Valek I apologize.

20 JUDGE VALEK: That's okay.

21 JUDGE YANG: Thank you.

22 MR. FELDSTEIN: Thank you.

23 JUDGE YANG: Whenever you're ready.

24 MR. FELDSTEIN: Okay. Thank you, Your Honor.

25 Again Mark Feldstein from Finnegan and Henderson for the Patent
26 Owner. I'd like to start just by addressing, I took your direction Your Honor,

1 not to interrupt with any objections during Petitioner's argument but there
2 were several new arguments I would like to flag for the record.

3 There was argument and reference made to Tobler's definition of
4 13 different permutations of like their unique definition of composition is.
5 That was not addressed by Petitioner. There's a new argument responding
6 to, and I'll show it on our slides. We put in slides on contemporaneous
7 meanings of association, there was response on those references, that was
8 never addressed.

9 There's a new argument addressing the incompatibility of mixtures
10 that we addressed in our Patent Owner response with respect to Tobler and
11 the many incompatible combinations. That was not in the argument.

12 There was a new argument, and I think actually wrong, that Godoy
13 somehow discloses four component combinations that would be within the
14 scope of Claim 2. Even if you mix them together, there's nothing more than
15 a three-component treatment in Godoy.

16 And then there were new arguments about the scope of our claims
17 in terms of permutations of Claim 2 if you have multiple components there.

18 With that let me start with claim construction. Let's start with
19 composition. There's an ordinary meaning of composition. In this case, the
20 PIN/NIP case very conveniently addresses that the term composition is well
21 established in the art. There shouldn't really be too much dispute that there
22 is a standard meaning.

23 It's not redefined in the patent, and that you can contrast with
24 Tobler which we'll get to where it's literally quoted and in the context of the
25 definition. There's no redefinition of composition or combination in the
26 patent at all.

1 The argument that there is a sentence, a paragraph that refers to
2 sequential application. There's testimony from Dr. Jacobsen that that
3 sequentially mixed testimony. The sequential testimony means that it's
4 applied sequentially and if one continues to read the paragraph in context,
5 the entire paragraph after the first sentence, the next two sentences are
6 expressly about sequential applications.

7 And so in context it is referring to sequential applied at various
8 stages during the crop cycle. It's clearly not a redefinition of the ordinary
9 meaning of composition. Dr. Brannen, we have quoted on the top, Exhibit
10 2021, of page 82 of the transcript. The ordinary meaning of combination is
11 that materials combined are added together. And elsewhere you of course --
12 can be mixed.

13 So there shouldn't really be a basis to argue what the ordinary
14 meaning of composition is. And it's not redefined in the patent. Consisting
15 of, we agree is a legal meaning and there's not much to say there.

16 In terms of Godoy, the Godoy problems are seen from the start.
17 We have on slide, excuse me, Slide 12 we have the Xilinx case. And then
18 actually the bottom is just a direct quote from the trial practice guide.

19 You need to address all of the elements of the claim. Basically
20 your prima facie case in just that petition, that's required. Case law was
21 required by the trial practice guide. And not doing so is prejudicial because
22 then the first time that Patent Owner gets to see an argument about a claim
23 limitation is in the reply which then it's too late to put in expert testimony,
24 it's too late to put in additional evidence.

25 And so what we have here is that in the petition, Slide 13, the
26 petition just does not address combination or composition. We could have

1 stopped there and said it's not addressed period. They lose. We went on to
2 be able to show that in fact, association means in context, sequential
3 administration.

4 We have Godoy distinguishing between the way in Godoy Table 3,
5 Godoy has a plus sign between things that are clearly mixed and an and sign
6 that is with reference to the associated part. And we have a Nimbus in the
7 table, I'll turn to that now actually, in Slide 14, we have that Nimbus is only
8 added to the components that are mixed.

9 The plus sign is azoxystrobin and benzovindiflupyr are mixed
10 together. They're a preformulated composition called Elatus in this case and
11 they add Nimbus to that, in their associated treatments.

12 And we could have stopped there. We didn't need to put in any of
13 this evidence, but we did put it in evidence and there's strong evidence.
14 Again, Exhibit 2009, Exhibit 2041, and Exhibit 2002 are references that
15 describe the term "associated" in the agricultural art as clearly sequential
16 applications.

17 And so the best that can be said for Godoy is that it's ambiguous
18 about what was done. We think that there is strong evidence that it's
19 sequential, but we don't have to prove sequential. They have to prove that it
20 was mixed. They didn't do that at petition. Their arguments that they come
21 back now with in the reply are unavailing.

22 They use Godoy's own later, non-prior art publication to try to read
23 in a later interpretation of Godoy. They're relying on it's at 1030. That
24 again, we didn't have an opportunity to put in an expert to reply to. We
25 didn't have an opportunity to put in evidence to contradict. And they say
26 that the reading of Godoy who was an inventor and knows whatever she did

1 or didn't do. Or excuse me, the author. That contradicts the reading of how
2 a person of ordinary skill in the art as testified by Dr. Jacobsen would read
3 the reference.

4 This quote from Dr. Jacobsen here on slide that just because we
5 insert later, Exhibit 20-- 1030 says, it's a mix. Doesn't mean it's accurate. It
6 doesn't say it. You can't find mixture in Godoy.

7 There is a reference to combination that was referenced by
8 Counsel. I think that was the first time they've ever raised that. It's not --
9 the combination doesn't say that mixture or components are combined.

10 Knapsack sprayer, somehow they convert this into making a
11 mixture. It's just how it was applied. It could have been a watering can that
12 applied it. It doesn't say what was put into the watering can. It doesn't say
13 what was put into the knapsack mixture. It doesn't say there was a mixture
14 in the knapsack sprayer.

15 In terms of the Nimbus component only being applied to use --
16 added to Elatus. They only have attorney argument that somehow you must
17 know that it is an adjuvant, there are some adjuvants which is also not
18 addressed on the record, and therefore you know that it's not necessary for
19 mancozeb, for the mixture once fully combined in their view. But it's just
20 attorney argument. They didn't put in any testimony to suggest this and
21 there's no basis for it on the record.

22 In terms of the consisting of limitation, again they just didn't
23 address it in the petition, that is the end, we didn't need to respond, put in
24 contrary evidence. They just didn't address it. It's a claim limitation, there's
25 no dispute about that. And what's also not disputed is that Nimbus isn't a
26 thing. Nimbus denotes multiple fungicidal ingredients as we have on Slide

1 16. Some are sulfur fungicides; some are mineral oil.

2 And one thing that is never responded to or addressed by Petitioner
3 is they say well, it must be mineral oil, but Elatus, the first two components
4 that are mixed in Godoy, they are called Elatus and Elatus says don't put in
5 mineral oil. And they never address the fact that their own -- their own
6 package label, Elatus is Syngenta product says, don't put in mineral oil.
7 They're saying well everyone would know that even though Nimbus isn't
8 described in Godoy, it must be mineral oil. It's inconsistent. It's contrary to
9 what their label teaches.

10 And their argument that mineral oil is -- we have evidence that
11 mineral oil is fungicidally active in the concentrations used in Godoy. We
12 didn't have to put that on. For them to meet their consisting of limitation
13 burden they have to show it's not. But we nevertheless put into evidence
14 that it is. Their response is only attorney argument in response. Their expert
15 agrees that mineral oil by itself can have an effect on fungus.

16 I do want to address the comment made about how the
17 specification refers to petroleum oils. It is true and there's testimony that
18 mineral oil is a type of petroleum oil. Mineral oil is a distilled, concentrated
19 version of petroleum oil. It's also called mineral oil concentrates in some of
20 the references.

21 And just because generic petroleum oil is maybe inert, that's not a
22 teaching that mineral oil which is a concentrated distillate thereof is also
23 inert. And again we have testimony from Dr. Brannen, their expert, on Slide
24 16 agreeing that it can be inert. It was their burden to address it in the
25 petition. They didn't address it in the petition, and they don't show anything
26 otherwise. There's --

1 Nimbus is multiple fungicides. That's not disputable. There are --
2 well there's a trademark in Brazil as mineral oil. So what? There's no
3 evidence that other things aren't trademarked. And again, this is evidence
4 that they're to put in for the first time in reply that we had no opportunity to
5 put in our own expert in response to. No opportunity to put in responsive
6 evidence.

7 I had mentioned -- I'll move on to Slide 20. I had mentioned that
8 the Elatus label, and this is just showing that from Godoy treatment 17 is a
9 combination of Elatus and another product. The Nimbus is only added, by
10 footnote 1, to the Elatus and Elatus label directs against mineral oil. So
11 again, the best that one can get out of Godoy is that it's ambiguous on what's
12 in there. They didn't establish in the petition what Nimbus was.

13 Their expert actually recognized that it was there, but it was just
14 silent on the petition. And so even if they had addressed it on the petition,
15 even if everything they have argued now was in the petition, they don't
16 establish more than ambiguity which is not anticipation.

17 In terms of Godoy being prior art, I don't think they ever really
18 respond on the question of that public accessibility requires being searchable
19 and indexed in a meaningful way. That was our argument in the Patent
20 Owner response.

21 And let's just point to what they have in the petition. They have
22 one sentence in the petition. This is on Slide 23. They have one sentence
23 saying it was published September 1, 2016. Today we heard a different
24 date. Today we heard I think an August date or a different date in
25 September. And they cite one paragraph of Dr. Hall-Ellis's first declaration.
26 And Dr. Hall's declaration says nothing more than there's a publication date

1 of September 1, 2016. She's wrong.

2 Okay, so, Slide 24. What it says on 1b is it has a year of
3 publication, not a publication date. Nothing to respond to that.

4 Petitioner has a slide, Slide 16, that also has an excerpt of Godoy
5 1b. And there's some funny things about 1b from the Hall-Ellis declaration.
6 It has a -- and they call it on their Slide 16 -- it has a current date of
7 September 1st. And it has a last updated of September 22nd. It's --
8 something's wrong if the current date is before the last update date. It just
9 doesn't make sense on its face.

10 And they also point to on their record, on Slide 16, they bopped
11 around the MARC record clip on it. I think that it was new argument from
12 Patent owner, I mean Petitioner, what the MARC record means. They
13 don't -- they clearly -- go back a slide to Slide 23 -- they clearly don't rely on
14 the MARC record in the petition. Talk about Tobler. I'd like to --

15 JUDGE VALEK: Counsel --

16 MR. FELDSTEIN: Yes.

17 JUDGE VALEK: This is Judge Valek. Before you move on, the
18 Petitioner has filed a motion for supplemental information. They did it for
19 the timeframe of the rule, so you had a chance to respond to it in the
20 response. And in that motion they proposed additional testimony from Dr.
21 Hall-Ellis as well as some additional exhibits.

22 And so the record is, if we were to grant that motion, the record is
23 a little bit broader than just the petition on this subject. I would like to hear
24 if you have a response to the additional evidence they put forward as to the
25 publication date of Godoy.

26 MR. FELDSTEIN: The problem with what they tried to do with

1 supplemental evidence is we saw back on Slide 23, that they make one bare
2 statement about the publishing date. And they failed to establish that it was
3 searchable or indexed as of that date. We have contrary evidence that the
4 publication date isn't necessarily searchable and indexed.

5 What they tried to shift to with the supplemental Hall-Ellis
6 declaration was to show that it was disseminated. They're making a new
7 argument, we have these download arguments that we have on Slide 26.
8 They are relying on downloads of it uploading somewhere else to rely on
9 actual dissemination. Supplemental evidence doesn't allow you to change or
10 make an entirely new argument based on the public availability.

11 JUDGE YANG: But more than dissemination though, right? The
12 supplemental declaration mentioned the MARC record which I think it
13 specifically said what the publication date was. Did I understand that
14 correctly?

15 MR. FELDSTEIN: The MARC record also doesn't address
16 searchable and indexed. That still -- nothing that they filled in. So the flaw
17 in the petition that we pointed out is that it doesn't show searchable and
18 indexed. And they come back with a MARC record, it doesn't show
19 searchable and indexed. And they come back with actual dissemination or
20 alleged actual dissemination, but to whom is unknown, and that is still not
21 searchable and indexed.

22 We can go on to Tobler. I think I'm going to risk -- can we have
23 the ELMO, please? I'm going to risk trying to put -- go old school and go
24 ELMO. Probably -- okay. Fantastic.

25 So this is column 28 and 29 from Tobler. They have it on one of
26 their slides. The yellow is this E1. And what's in yellow is 30,000 potential

1 permutations. That is not an express disclosure of anything. The list case
2 law that is relied upon in the art, like Gleave. Gleave was a literal list of
3 every single possible permutation of a sequence DNA sequence.

4 Every possible permutation. It was like 14,000 or 15,000. It listed
5 out every individual one. And what Gleave said is for anticipation, if it's
6 written out it's written out for anticipation. You're done. Anticipation,
7 obviousness might be another reason.

8 But this is not -- notwithstanding what the papers, Petitioner read,
9 this is not express disclosure or anything in terms of specific species.
10 There's no specific species. It's a massive genus of multiply this times a
11 Group P that is literally pages earlier, that is 250 species and spans four
12 columns.

13 So, I think it was worth that detour. That's 30,000. And then E2 is
14 the orangish one. That's another 30,000. That's not an express disclosure of
15 any species. Can I go back into the projector here, please?

16 JUDGE MITCHELL: But, Counsel, isn't that just the shorthand
17 way in the patent of telling us the combinations? I mean, I can still go to
18 through and manually pick and see the amount of combinations are there.
19 And aren't those disclosed?

20 MR. FELDSTEIN: You have to go and manually pick. And then
21 it's the same idea as any set of -- if you have a molecule. If you have
22 benzene, and you say our group can be C1 through C60, and you have a list
23 of all of the C1 through C60's, that's not a disclosure of every individual one.
24 It's analogous to a genus case where you have some R group that you want
25 to tack on, and you have a list of R groups. It's not a disclosure of each and
26 every one. It means the genus comprises them, it's not a specific disclosure

1 of any species -- all the species in there.

2 In order for it to be a disclosure, an express disclosure of any
3 species, it would have to be considered an express disclosure of all 30,000
4 species. That one column is not a disclosure of 30,000 species.

5 JUDGE MITCHELL: But isn't it a little different when you're
6 talking about a molecule, and substitutions on the molecule that we know
7 sometimes may or may not work. I mean, these are individual chemicals
8 that you're putting together. And so you've got a list, and you have to put the
9 three together, or you add that one on to the two that are listed in Claim 1.
10 Why is that a problem?

11 MR. FELDSTEIN: It's a problem because, if I can go ahead to
12 Slide 32. It's a problem because of the size of the genus. Perricone and the
13 other cases, it was a list of 14 in Perricone. It was a list that you could
14 concede in your head. You can't concede these 30,000 that are out there
15 now in your head. You can't envision them. They're not written out. You
16 have to be able to envision each and every one of them for them to be a
17 disclosure.

18 And if we go to Slide 33, you mentioned that in the genus case, in
19 the chemical case sometimes there are things that won't work. Here we have
20 evidence of incompatibility. This is evidence that is not only not disputed,
21 it's not responded to by Petitioner in any way.

22 These are among the items in Group P where the testimony from
23 Dr. Jacobsen is, the unrebutted testimony from Dr. Jacobsen is either that
24 they're completely incompatible or you wouldn't know if they're compatible
25 in mixtures.

26 And so you get in, we'll talk about the Mylan case, but this is

1 important. If we can go back now to Slide 30. Unlike the '727 patent, Slide
2 30 is an excerpt from Tobler. Tobler has a definition of composition as the
3 standard format, we're putting the term in quotes and saying what it means.
4 And it says, Syngenta definition and that Tobler is defining it as both
5 combined and sequential where the order doesn't even matter.

6 And they agree, Syngenta agrees that Tobler includes both mixed
7 and sequential. Dr. Brannen confirmed that for a three-component
8 combination you have 13 possible permutations of how you can put them
9 together. Only one of them is fully mixed.

10 And as we saw on Slide 33, what you would know is that if you
11 look, and you look at the various disclosures, the E1 option, Group P
12 options, that you can't expect mixability. So even if Tobler was saying that
13 all of E1's are co-compositions, he doesn't say what kind of compositions
14 they are. He doesn't say that they're mixed compositions, he doesn't say that
15 they're sequential compositions.

16 There are some unknown amorphous type of composition. And
17 what you know from reading it is that you can't read this and say oh, they
18 must all be mixed compositions. And you can't do that for a couple of
19 reasons. You can't do it for a factual matter. If you go back to Slide 31 Dr.
20 Jacobsen explains that this is not like mixing paint dyes where you just get a
21 color and you shade it.

22 They are chemically active components and there's a strong
23 motivation against arbitrarily mixing fungicides. And you're strongly
24 motivated against mixing them. The compatibility was unknown. This is
25 not disputed. This is not responded to by Petitioner. So you have that --

26 JUDGE MITCHELL: Can I ask you? So in the patent how do you

1 explain, and this is on Slide 7 of Petitioner's demonstratives where they call
2 out the description of the composition in the patent. Where it talks about,
3 may be applied simultaneously as a tank mix or a formulation or may be
4 applied sequentially. So how do you explain what that means?

5 MR. FELDSTEIN: So what Dr. Jacobsen said is that -- I'm
6 reading the whole paragraph --

7 JUDGE MITHELL: Okay.

8 MR. FELDSTEIN: And I'm reading the whole paragraph, and the
9 rest of the paragraph goes on to talk about applying sequentially, i.e.
10 multiple times over the growth cycle. And so that's what Dr. Jacobsen
11 testified to. I could probably find you the cite for that. We'll find it during a
12 break, find the cite for that.

13 But the rest of the paragraph on their Slide 16 it says, the
14 applications may be made to the soil before emergence of the plants, either
15 pre-planting or post-planting. The application may be made as a foliar spray
16 at different times during crop development with either one or two
17 applications early or late post-emergence.

18 Dr. Jacobsen read it in the context of that -- the sequential means
19 that you're applying it sequentially multiple times as the rest of the
20 paragraph describes.

21 JUDGE MITCHELL: So he's saying you're applying the entire
22 composition multiple times.

23 MR. FELDSTEIN: Correct.

24 JUDGE MITCHELL: Okay. Thank you.

25 JUDGE YANG: And just to follow up on this one. Looking at the
26 sentence that may be applied sequentially, juxtaposed with simultaneously

1 as a tank mix or a formulation. I understand what you're saying, you've got
2 to keep on reading. And at the bottom of this paragraph there is talking
3 about repeating -- repeated application, and that's what sequentially means.
4 But would that be the normal way that one of skill in the art would read
5 sequentially?

6 MR. FELDSTEIN: That is the testimony of Dr. Jacobsen, the only
7 person that I think to address that whole paragraph in context. That that is
8 the reading. And I think that you should keep in mind, Your Honor, that
9 there is an ordinary meaning of composition and however one reads this is
10 not a redefinition of the term composition. It's not express lexicography that
11 would override the normal use.

12 Dr. Jacobsen reads it in context as I explained. And even
13 Syngenta's reading is not reading it as a lexicography. So the redefinition of
14 an ordinary term. The term has it's ordinary meaning unless it's redefined in
15 the specification of the file history.

16 They've tried to make file history arguments about how the file
17 history also redefined composition. They had it wrong because the examiner
18 was talking about the prior art in terms of what the prior art taught in terms
19 of sequential or in combination. And interestingly it looks like where the
20 examiner was bolding comparisons between the prior art and the claims, the
21 examiner only bolded the mixed idea and left silent the sequential idea.

22 So it appears that the examiner likewise understood that different
23 from the prior art that was cited, the claims are to a mixed combination or a
24 mixed composition.

25 I'll keep going with Tobler. In terms of not arbitrary mixing on
26 Slide 31 and we saw on Slide 33 the incompatibility. This lines up very

1 much with Merck. They keep calling it the genus case. I'm not sure why.
2 There were 33 possible active ingredients, API's and eight preferred salts
3 with various stoichiometries. They said there are 957 permutations where
4 some of them -- and 957 was too much to at once envisage. And there was
5 evidence that some of those don't even work. You couldn't combine them.
6 And so you can't expect a cross breed of every salt and every API.

7 It's the same thing here if I go on to Slide 35. We have 250 Group
8 P. If you leave aside all of the E1 parts and you just focus on the 250 Group
9 P compounds, and the 13 permutations of the undisputed Tobler definition,
10 that's 3250 permutations. There's no possible way to -- that's what's
11 envisioned with 3250 permutations of all the types of Tobler's expressed
12 definition of Tobler.

13 And it's undisputable that Tobler shows incompatibility. That is
14 what we have on Slide 33 and the testimony from Dr. Jacobsen. So you
15 can't read -- it's Tobler's unexpressed disclosure of any specific species. You
16 can't read it as an express disclosure of any specific three components in a
17 specific form such as mixed. And you can't read them all as being mixed
18 because you know there's incompatibility for mixing. It would fail and then
19 some under Merck.

20 JUDGE YANG: Counsel, help me out with one thing. I've been
21 trying to figure out this argument, but I need some help. So you said one
22 skilled in the art would have known some of the compounds listed in the
23 Group P wouldn't have been compatible, right?

24 MR. FELDSTEIN: For mixing.

25 JUDGE YANG: For mixing. Correct.

26 MR. FELDSTEIN: Yes.

1 JUDGE YANG: Wouldn't that somehow narrow it down a bit?
2 Meaning if I know I can't mix the mancozeb with this one, then I wouldn't
3 consider it.

4 If I know something in the B I shouldn't mix it, then I wouldn't.
5 Then I'm not considering 250 compounds there. Is that right?

6 MR. FELDSTEIN: That's a good question, Your Honor. And
7 what you have is you know that some of that list of Group P is unmixable,
8 and you have a lack of direction for the others.

9 And so Tobler doesn't tell you which ones are mixable and which
10 ones are not. You know looking at the list, you can't assume mixability
11 because there are many in there -- and I'll turn back to the testimony we have
12 on Slide 31 that a person -- this is testimony relying on Dr -- this is Dr.
13 Jacobsen's testimony relying on Dr. Brannen's admission that a person of
14 ordinary skill in the art would be reluctant to experiment with mixing
15 fungicides together without some data or direction to do so.

16 There is no data and no direction in Tobler that's been relied on at
17 least, to say well, okay we recognize that some might not be good for mixing
18 but everything else is mixable. It doesn't say that. There's no direction. It's
19 just a laundry list of 250 Group P's that then get combined in various
20 permutations with the preferred two component compositions. The E1
21 composition, the E2.

22 And so short answer, no. The fact that some are openly unmixable
23 doesn't incline that others are mixable. It raises a red flag that you would
24 need to consider mixability and there is no direction to do so in Tobler.

25 On to Slide 39. Tobler has a -- the claims have a "consisting of"
26 limitation. They don't address the "consisting of" limitation based on Tobler

1 in the petition or the reply for their arguments for Claims 1, and 3 through
2 10. They're alleging anticipation. It's just not there.

3 And what we know is that, from their own evidence, and we'll get
4 to it, we'll go to Slide 40. They recognize that Tobler is not closed to three
5 components. They rely on Tobler for Claim 2 which requires at least four
6 components. They're relying on the same disclosure for three or four
7 components, but you know, there was a good question during Petitioner's
8 time that there is no guidance for how you would possibly pick the third or
9 fourth component from Tobler except for maybe it's just different.

10 And if you just pick different, that doesn't put you within the
11 claim. They never address how do you get a "consisting of" limitation out of
12 Tobler when they themselves say that there is three component combinations
13 of E1 are -- could actually be four components. And they could actually be
14 five components.

15 In the reply they say they don't rely on the five component
16 combinations but they're agreeing that it is there, and Dr. Brannen likewise
17 read the Tobler as allowing for fungicide beyond just three. And so
18 "consisting of" is not met, they don't address it. It's an element of the claim
19 is enough to decide Tobler doesn't anticipate by itself.

20 JUDGE YANG: I just want to make sure. Counsel for Petitioner
21 points out for Claim 1 there is no requirement for it to be a three component
22 either, right? Because it's at least one in those two categories. So you could
23 have two from them, or three, or four. It covers a large group of --

24 MR. FELDSTEIN: But there are somewhere around 200 of the
25 Group P that you cannot have because they're not within the 47 that are with
26 their own claim. There are roughly 200 Group P components that would be

1 outside the claim, and what Petitioner says here is that Tobler covers four
2 components, and it would cover four components with one of those 200. It
3 would cover five components with one of those 200. And yes, our claims
4 allow for two or more of the listed egosterol biosynthesis inhibitors or two or
5 more of the quinone outside inhibitors. But it doesn't allow for things
6 beyond that Markush group. And Tobler is complete -- gives you no
7 guidance, and they make no argument for how you would pick a fourth
8 component that has to be in the Markush group as opposed to one of the 200
9 that are not in the Markush group. Or why you would not pick a fifth
10 component outside the Markush group.

11 And so there's nothing to map it and they just don't make the
12 argument, Your Honor. They just don't make the argument. They just don't
13 address "consisting of" in their petition or in their reply for Tobler
14 anticipation.

15 In terms of obviousness, Tobler in view of Godoy. You know they
16 cited to, and they directed the Board's attention to page 33 of the petition
17 during their argument to say oh yeah, we argued the motivation to combine
18 Godoy. Page 33 of the petition has no motivation to combine the references.

19 Pate 33 has one paragraph. It begins, Godoy provides further
20 motivation for the combination. It does use the word combination but in
21 context, they're talking about combination of the three or four components
22 that they're saying are within scope of the claim.

23 They don't address the idea that why someone is going to rely on
24 Godoy to modify Tobler. And we have evidence on why you wouldn't. We
25 have evidence that's undisputed that if you read Tobler, two components
26 which is what's preferred in Tobler, benzovindiflupyr and any of these

1 second components. They often get up to about 100 percent control. No
2 need for mancozeb.

3 And so there's no reason if you read Tobler to start adding in
4 mancozeb when they're getting 100 percent control. And they just don't
5 address this. They just don't address this.

6 I'm going to move on to secondary indicia. And I'm a little
7 troubled, I'm going to jump to Slide 57. I'm a little troubled by the
8 arguments we've heard about oh, don't rely on Dr. Jacobsen because there
9 are some errors in one of his tables, one of his main tables. There's one
10 numerical they point to, we'll address that.

11 The context to remind the Board of how that data came to be is that
12 Syngenta had agreed to produce that more than a month before the original
13 Patent Owner Response deadline was due and then they reneged it. And
14 then the Board, they represented to the Board that they were going to
15 produce it and then they didn't. And then what happened was, there was a
16 further order from the Board that they had to produce the data, and they
17 produced it, and we had one week to work with the data.

18 And so was there a transcription error on one table? There was.
19 But in the context of Syngenta actually misrepresenting what that data is and
20 attempting to withhold it, I'm troubled that their complaint is that there's a
21 calculation error in one table.

22 In terms of long felt need, just to go in order. The testimony they
23 cite to from Dr. Jacobson where they say oh, there's no unfelt need, that it's
24 met. What he says, if you read the previous sentence -- the previous Q&A
25 before the part they quote is that the reference that they're pointing to, it
26 improved over other treatments. Improving over other treatments is not

1 fully fulfilling a long-felt need.

2 And we have Syngenta in Tobler saying that there's a long-felt
3 need. We have De Oliveira from UPL saying there's a long-felt need. It's
4 hard to suggest that there wasn't a need for treating for soybean rust.

5 They don't address the fact that they're marketing the composition
6 within the claims. Slide 59, they have a product called Mitrion, and they say
7 Mitrion should always be applied -- should be applied always in
8 combination with a multi-site applications, bravonil or mancozeb. They say
9 always do it.

10 And we asked Dr. Prates, generally is it safe to say that because
11 Syngenta is recommending the combination of benzovindiflupyr,
12 prothioconazole, and mancozeb that it does have some basis to show added
13 value in terms of resistant management or some other properties, correct?
14 That is correct.

15 So they have in hand, according to Dr. Prates, reasons why they
16 are recommending either publicly in their commercial literature to use
17 Mitrion always with bravonil or mancozeb. They withheld that. They
18 refused to produce that as a matter of routine discovery. It would have been
19 relevant, and it would have we believe, further showed their copy and their
20 effective praise of the composition for its properties.

21 JUDGE VALEK: Counsel I have a question about this and the
22 unexpected results showing. I understood from Petitioner's arguments that
23 they were asserting that you have not established that this evidence, the
24 copying evidence, the long felt need evidence, and the results evidence, that
25 it's reasonably commensurate with the broader scope of your claims.

26 And at least for the copying evidence that I see here on your slide,

1 it appears that it's a specific combination of three fungicides. And if I look
2 at Claim 1, you know, it's not limited to just those three. It has a list, as
3 we've been talking about, of many more.

4 And so how can it possibly be the case that you have shown that
5 your unexpected results showing is commensurate with the broader scopes
6 of the claims?

7 MR. FELDSTEIN: We'll get you on unexpected results in a
8 second. In terms of the copying, it will always be the case that a commercial
9 product is just a thing, and it will always be the case that a commercial
10 embodiment, a thing, would be one data point within a claim.

11 And so it's routine when you rely on copying as evidence that the
12 copying is a thing. It has the weight that it gets. There's not a
13 commensurate in scope analysis that applies --

14 JUDGE VALEK: Yes there is Counsel.

15 MR. FELDSTEIN: -- the same way. There's no way to make a
16 commensurate scope analysis for a copying of a single embodiment.

17 JUDGE VALEK: The way would be that the claim is narrower.
18 You would have a picture claim directed to your commercial embodiment
19 and then it would be reasonably commensurate with the scope of the claim.

20 MR. FELDSTEIN: I --

21 JUDGE VALEK: So what I'm asking you about is your broader
22 claims that we have at issue in this particular proceeding. How can it be the
23 case that the copying of one combination is reasonably commensurate with
24 Claim 1, which seems to recite a great many combinations?

25 MR. FELDSTEIN: So it's true that it's a single component. It has
26 a weight, a value of copying of a single composition.

1 JUDGE VALEK: Is there any evidence that the particular
2 combination that we have -- that you're asserting that they've copied, that
3 that one is representative of all the other combinations encompassed by
4 Claim 1?

5 MR. FELDSTEIN: We have the experiments that they themselves
6 did, that Syngenta did, the Prates declaration. And I'll go on to that, that in
7 aggregate they all show improvements in the net -- a net improvement in
8 disease severity, a net improvement in yield, and a net improvement in
9 foliage retention.

10 And so their data, their Prates data, Exhibit 1020, it shows that all
11 the mixtures have similar properties in terms of their unexpected results.

12 JUDGE VALEK: How many combinations are there in that
13 evidence? In the Prates evidence?

14 MR. FELDSTEIN: I think it's eight total.

15 JUDGE VALEK: Okay. So we have the one that they've copied
16 and then there's eight more in the Prates declaration?

17 MR. FELDSTEIN: I believe it's eight Your Honor, yes.

18 JUDGE VALEK: Now is it eight total, did they test the one that
19 you said that they copied or is it --

20 MR. FELDSTEIN: I don't know. You know, their instructions
21 for -- on Slide 59, at least as far as we know doesn't tell you a specific
22 amount of mancozeb. And they did test different amounts in the different
23 permutations to try to cycle through different amounts.

24 And so I don't think the mitrion combination, at least what we have
25 on Slide 59, it's not a single concentration. So it's -- their unexpected results
26 data or actually specific combinations. Some of them I think are,

1 benzovindiflupyr, prothioconazole, and mancozeb.

2 JUDGE VALEK: Okay. And while we're on the subject, because
3 I asked Petitioner about this during his presentation. Any of the
4 combinations -- are there any combinations made in the Prates declaration or
5 in your copying long felt need evidence that have a nexus to the combination
6 recited in Claim 2?

7 MR. FELDSTEIN: I don't believe that any of them fall within the
8 scope of Claim 2, Your Honor.

9 JUDGE VALEK: Thank you.

10 JUDGE YANG: I have a few related questions. One is if you
11 could put back Slide 59. You just had on there. So mancozeb is not the only
12 one mentioned there, right? It's an "or." So I'm pretty sure I saw the
13 argument that because of that "or," mitrion doesn't have to be used with
14 mancozeb. And the other one, I'm not 100 percent sure, I don't think it falls
15 within the claim scope. Is that correct?

16 MR. FELDSTEIN: I don't think I does either, Your Honor.

17 JUDGE YANG: Okay.

18 MR. FELDSTEIN: And so the responses is, the fact that they're
19 recommending two mixtures doesn't make them recommending one mixture
20 any less. The fact that there are two opportunities here, the bravonil and
21 mancozeb, it doesn't say -- it doesn't underline the fact that they're
22 recommending a combination of benzovindiflupyr, prothioconazole, and
23 mancozeb.

24 They're recommending it. They're recommending something else
25 in addition, but they're clearly recommending the three-part combination of
26 mancozeb, and as Dr. Prates said they have data that would support that.

1 JUDGE YANG: Okay. Second question. I don't know if you're
2 going to get to it. It's about the unexpected results, specifically regarding the
3 yield analysis. I heard you saying the one transcription error. But this one is
4 different. I'm referring to Petitioner's reply on page 26. According to them,
5 Dr. Jacobsen acknowledged that the calculated expected values using the
6 Colby equation should be higher than the observed values for the individual
7 fungicides. But in reality the data he analyzed actually is the other way.

8 I might have missed it, but I don't think I saw any response in the
9 sur-reply. Do you have anything to say about that?

10 MR. FELDSTEIN: The response is, in the first argument, that you
11 can't apply it to yield. We responded to that and showed that their expert
12 says you can apply it to yield. You can plug yield in.

13 The second response is that we have this data that is yield as a
14 whole. And Dr. Jacobsen testifies that Colby is not the only way to evaluate
15 unexpected results or obviousness for fungicide combinations. That you can
16 look in large and significant changes in the comparison of the individual
17 components to the final mixture.

18 And what we have on Slide 60 is that the individual components
19 had improvement in yield of 143 percent. We've got 182 percent yield
20 improvement. And so this is evidence of unexpected results for yield that is
21 independent of the Colby analysis.

22 The issue that Your Honor raised with respect to whether the
23 Colby analysis, whether the components should be higher than the
24 theoretical you know, that's a fair question and a fair comment. Again we
25 had a week with their data after they withheld it. There's no evidence that
26 it's wrong. You know, they didn't bother putting in the expert declaration

1 saying this is how I would calculate the yield differently.

2 Those are the numbers that came out of the yield calculation. But
3 we don't need to rely on the Colby yield data because there is the overall
4 primary data. If we go on to Slide 63 we have disease severity data. You
5 know, one of their complaints is that Dr. Jacobsen used a lower than one
6 threshold for Colby. You see in the disease severity data on Slide 63, you
7 see that there's Colby values of one or greater for every combination. Every
8 combination has Colby values of one or greater at least one time in the cycle.

9 There's a trend that Dr. Jacobsen testified to showing that there's
10 generally a trend that you see more synergy later in time which makes sense
11 as the disease pressure goes up. That if there's not much disease pressure at
12 the beginning you can't really differentiate between the individual
13 components and the combination. And here the data is showing for
14 example, Area A4 you see that by the 35th day post treatment or emergence,
15 whatever it is, that there is greater than one Colby synergy for everything.

16 For Area B6 you have, day 42 you have Colby synergy greater
17 than one for all of the places we got data. We didn't get data for B7 day 42
18 because it was in the protocol, but it just doesn't exist apparently.

19 So for every combination, at least some time period and at least
20 some conditions, every composition shows greater than -- one or greater
21 Colby synergy for disease severity.

22 We have the defoliation data, this is where there was a
23 transcription error for the columns. And correcting for that transcription
24 error only shows more synergy. And so the defoliation you have with the
25 one exception of E7, you have greater than one Colby synergy show for
26 every formulation tested by Syngenta.

1 In terms of their field commensurate in scope. We're on Slide 65.
2 Keep in mind that Syngenta designed this data to be reflective of the scope
3 of the claims. That was their argument for written description and
4 enablement that they've abandoned. That their Counsel, working with Dr.
5 Prates designed the experiments to be representative of the claims. They
6 proposed them for that purpose. They do reflect the claims, and they did
7 them to be representative, and they testified that each of the combinations
8 falls within the claims. They tested both three and four component
9 combinations.

10 And then there's further evidence on the record that the EBIs that
11 ergosterol biosynthesis inhibitors and the quinone outside inhibitors each
12 commonly have a common mode of action.

13 We mentioned that there's some mention data -- Dr. Prates, and we
14 want to raise this just so it's clear on the record. But shown on side 68 is you
15 know the analysis that Dr. -- part of the analysis that Dr. Jacobsen did
16 because we didn't have the data.

17 And what's in yellow in terms of you know, day 35 to day 42. The
18 day 42 points were withheld and not relied upon by Dr. Prates in making his
19 analysis. The yellow data that was part of the per protocol data points. This
20 is just one example where they can -- withheld the data and he didn't rely on
21 it.

22 If you were to build that back in it shows increasing synergy over
23 time as Dr. Jacobsen testified to. It all comes to the idea of that they
24 further -- then they further represented that the data for biotoxicity
25 defoliation yield, it doesn't support, it isn't helpful for the Patent Owner.
26 That was Syngenta's Counsel's representation to the Board when they

1 wanted to withhold the data because it was too hard to pull from the
2 database.

3 We believe that this raises concerns under Spectrum which we
4 relied on Dr. Jacobsen from giving an opinion that they selected the data
5 they relied on for Dr. Prates. They tried to withhold, they reproduced it,
6 they then reneged on an offer to produce it. They then were selective in how
7 they produced it. The representative wasn't helpful, and they had no
8 response.

9 We have unquestionable evidence of, for example, defoliation that
10 they have not disputed that defoliation was synergistic in at least some
11 examples. They said it's not helpful. It raises the concerns under Spectrum.

12 If there are no questions now I'll reserve my ten minutes.

13 JUDGE YANG: Okay.

14 You have five minutes, 30 seconds. I don't know how to program
15 the 30 seconds so I'm generous. You've got six minutes.

16 MR. CARSON: Okay. Thank you, Your Honor. I appreciate that.

17 I want to start with Slide 7 from UPL's presentation. They suggest
18 that there's some ordinary meaning that establishes what composition means.
19 And that we've got to somehow overcome that with some overwhelming
20 contrary definition from their spec.

21 First of all, what we pointed to in their spec is uncontroversial.
22 We'll get to that again in a second. But this is what they point to to say the
23 composition you know, is well known, it's ordinary. They cite this one case.
24 And you know, they've got ellipses here and a bracket, and you know,
25 whenever you do that it raises red flags. What they're omitting here is that
26 the PIN/NIP case, first it's a chemical case. This is not a chemical case; this

1 is a mix of fungicides. This is not chemistry.

2 But then also they present this quote as if to suggest that there's
3 just general definition of composition applies broadly, and that composition,
4 mixture, combination, conjunction all mean essentially the same thing.

5 If you go to that case and you read what's omitted by the ellipses
6 there's I don't know, five or six sentences, an entire paragraph that
7 emphasizes the fact that this term must be construed in the context of the
8 patent at issue in this case. And goes on to talk about that patent and explain
9 by reference to that patent why the Court concludes that composition,
10 mixture, combination, conjunction all mean essentially the same thing.

11 So you know, if this case tells you anything it's that if you want to
12 understand the meaning of a term you look to the intrinsic evidence. And
13 here the intrinsic evidence is clear. We looked at that sentence. The
14 sentence from the spec clearly juxtaposes simultaneous application from
15 sequential application.

16 And they can't explain that sentence. They have not come up with
17 a plausible explanation. All they do is hide behind their expert who also just
18 simply throws up his hands and says oh it's all -- it's about applying it at
19 different times during the plant's life cycle.

20 Applying sequentially is not the same thing as applying repeatedly.
21 If I ask you to play three notes sequentially, that's not the same thing as
22 asking you to play the three notes repeatedly. Those are different things.
23 And the patent says applies simultaneously or applies sequentially. The
24 sentence is clear. It goes on to discuss something altogether different.

25 UPL's Counsel repeatedly says that in our petition we have failed
26 to address the "consisting of" limitation. I showed you the excerpts from

1 Tobler. I showed you Table 3 from Godoy. Those same excerpts procure
2 our position. Those excerpts show a three active ingredient combination
3 comprising three fungicides, all of which fall within the scope of the claim.

4 I mean, I don't know what more you can do to show the "consisting
5 of" language. The claim says consisting of benzo, mancozeb, and one of the
6 following. And we showed you disclosure from both references that
7 contains benzo, mancozeb, and one of the following.

8 We've met you know, we've shown the limitation of the claims in
9 the petition. I don't understand where that's coming from.

10 And in terms of composition, UPL's the one who came up in their
11 response with this novel construction of composition that runs contrary to
12 the plain language with respect when you're looking at it. That was
13 completely out of the blue.

14 And I quoted you a recent federal circuit case law, and there were
15 other Board decisions in federal circuit cases that we cite in our papers that
16 say this is actually the right thing to do. They come up with a claim
17 construction in response. We are entitled to respond to that, and we're
18 entitled to put forward, to discuss the evidence of anticipation and
19 obviousness in light of that new construction as long as we don't change the
20 bases, right, as long as we don't change the prior art, what we're relying on.
21 And we didn't do that. We simply amplified what we already said and
22 explained why their construction didn't matter.

23 JUDGE VALEK: Counsel.

24 MR. CARSON: Yes.

25 JUDGE VALEK: Briefly because we're running low on time.

26 Could you respond to Patent Owner's argument that you have changed the

1 thrust of your argument with respect to the availability of Godoy as prior
2 art? I believe Counsel said --

3 MR. CARSON: Right.

4 JUDGE VALEK: Do you understand what I'm talking about?

5 MR. CARSON: He tried to -- yeah. He tried to recast it as well.
6 Her initial declaration, Hall-Ellis declaration focused on availability or
7 accessibility. And the new declaration focuses on dissemination. That is a
8 mischaracterization that's going on. He looked at Hall-Ellis's original
9 declaration.

10 And I don't have the cite for you here, but if you look at her
11 declaration early on she actually opines that the evidence she presents and
12 considers shows dissemination. She uses the word dissemination when
13 describing the references attached to the subject matter of her original
14 declaration.

15 And then beyond that, so dissemination is in the original
16 declaration. Dissemination is just simply the manifestation of public
17 accessibility, right? The Dublin Core index and the Supplemental index.
18 That doesn't address dissemination per say, it addresses accessibility. It
19 shows the key words and the dates the document was available.

20 The MARC record shows the subject matter key words that can be
21 used. ResearchGate in the supplemental declaration, that's focused solely on
22 the fact that Dr. Godoy put her article on that site in September 2016 and
23 that site is key word searchable, according to her, and confirmed by Dr.
24 Jacobsen their expert, and is regularly searched by people in the field.

25 And all of that evidence goes to public availability and public
26 accessibility. There's been no shift in argument.

1 On Mylan, I'll just -- this will be my last point. You know, they
2 seem confused as to why we keep saying Mylan is a genus case. Mylan, the
3 prior art in Mylan discloses a genus of pharmaceutically acceptable salts that
4 are formed when reacting Sitagliptin and with phosphoric acid.

5 And so what's disclosed in the prior art is Sitagliptin, however
6 that's pronounced, phosphoric acid, and the fact that you can react those with
7 one another to achieve a group of pharmaceutically acceptable salts. The
8 prior art does not tell you what those salts are yet the claim at issue recites a
9 particular salt. And so the prior art in Mylan does not disclose the particular
10 salt recited in the claims.

11 Only a genus and some instruction on how to get there. The
12 individual members are not disclosed. And in fact Mylan says if you try to
13 create the list there's going to be uncertainty as to who the members will be.
14 That is completely different from Tobler. Tobler spells out the individual
15 components.

16 If there aren't any more questions I think I'm done.

17 JUDGE YANG: All right. Okay.

18 While he works on that I'll just explain. You reserved ten minutes.
19 Petitioner went over a minute and a half, so you have 12 minutes.

20 MR. FELDSTEIN: Okay, Your Honor, I don't think I'll need it,
21 but I appreciate it.

22 JUDGE YANG: All right.

23 MR. FELDSTEIN: Could I have the ELMO, please? So I don't
24 know how legible it will be at this distance, but this is Dr. Brannen's
25 deposition, Exhibit 2021 page 83. He's asked, he had referred to at the top
26 that the terms "combination" and "composition" are used interchangeably.

1 He said that in his declaration.

2 And we asked him what is the common meaning. And he
3 answered that the materials are combined or added together. And then both
4 of them came to the conclusion that they would be together in a common
5 product or a common mix. So that was Dr. Brannen's testimony and
6 declaration of what he understood the meaning of combination and
7 composition was in the context of the '727 patent.

8 This is the ordinary meaning. It is the same ordinary meaning that
9 is accepted in the PIN/NIP case. I'm not sure what the distinction is between
10 a chemistry case and a fungicide case. I don't know why one would think
11 the terminology between the two is used differently.

12 Can I have the slides again, please?

13 I'm going to go to Slide 23. You know we heard all the things that
14 were in the opening Dr. Hall-Ellis declaration. It doesn't really matter what
15 was in the Hall-Ellis declaration, actually what was in the petition. The
16 petition they said that Hall-Ellis argued dissemination the whole time. Hall-
17 Ellis argued MARC the whole time.

18 I don't know if that's true. What I do know is that the petition said
19 Godoy published September 1, 2016 before the filing date citing a single
20 paragraph from Hall-Ellis. Hall-Ellis said that -- has a publication date of
21 September 1st, 1b we saw that she was wrong on that because it has a year
22 of publication.

23 So I get that they switched to a different horse, the dissemination
24 horse is accurate. But the petition is one sentence. The petition has nothing
25 to do with dissemination. The petition has to do with the publication date
26 that's wrong.

1 In terms of the argument that we heard that -- of you know, they
2 didn't address combination or composition in terms of Tobler. And -- but
3 they're allowed to now because of the claim construction. The argument that
4 they've made and the cases they've cited is that if there's a claim
5 construction, we can respond to the claim construction.

6 That's not the issue. Maybe there is an issue with claim
7 construction obviously, but the issue is that the petition just didn't address
8 the element under any construction at all. They didn't say this is the claim
9 combination meaning it's mixed or sequential. They didn't offer -- they just
10 omitted the terms for both Godoy and for Tobler and at the end of the day,
11 there are two I think, they just didn't address those limitations.

12 They said we can find three components, but they didn't address
13 whether it met the meaning of composition which they offered none of and
14 they didn't address whether they meant the meaning of composition. Those
15 are prima facie elements if I can use that phrase. They're prima facie
16 elements of claim limitations that dispute the claim limitations and they just
17 don't address it.

18 They can't come now and say oh well, we get to respond to a new
19 claim construction. That is not a panacea for having failed to address the
20 limitation under any meaning at all.

21 And again, when they come back and address and now they try to
22 say that Godoy teaches a mixed combination and Godoy teaches "consisting
23 of" for Tobler as well, is prejudicial because we don't get an opportunity
24 after the reply, we don't get an opportunity to put in our contrary evidence.
25 We don't get an opportunity to put in our own expert testimony.

26 And notably all the arguments they came back with are

1 unsupported by any expert testimony of their own. The only declarations
2 they're relied on, I think new in the reply, are their in-house Counsel who did
3 a trademark search for -- or identified trademark Nimbus products. It
4 doesn't preclude the existence of other nimbus products in Brazil and the
5 supplemental Hall-Ellis declaration that we've raised issues with.

6 In terms of obviousness from Tobler, you know there's really not a
7 dispute about how massive Tobler's disclosure is. And there's nothing to
8 navigate you through the maze of Tobler. They say that there's a reason
9 given in the petition on a motivation to combine with Godoy, and I think I
10 already raised that, that in the petition Godoy, 33, doesn't even tell you a
11 reason to combine the two references.

12 But none of them, they make no argument to show how Godoy
13 helps you map through all of this except for that there's overlap between the
14 two references.

15 And let me just finish with, by going back to Slide 30 which is the
16 Tobler composition definition. Again it's undisputed. They didn't address
17 this in the petition on how Tobler's definition of composition reads on the
18 claims. It doesn't. And on Slide 33 they don't dispute that like Mylan there's
19 incompatibility. It's self-evident where you know you wouldn't be able to
20 arbitrarily mix these 30,000 possible combinations into single component
21 mixtures. And with that I'll rest unless there's questions, Your Honor.

22 JUDGE YANG: Judge Valek, do you have any questions?

23 JUDGE VALEK: No further questions from me.

24 MR. FELDSTEIN: Okay.

25 JUDGE YANG: I don't have any either.

26 MR. FELDSTEIN: Thank you for your consideration.

1 JUDGE YANG: So we would like to thank Counsel for putting
2 down your tax filing and come here to explain this case to us. The argument
3 has been very helpful, at least to me. I'm sure my colleagues appreciate it
4 too. This case is submitted, and we will issue a final decision in due course.
5 We are adjourned.

6 (Whereupon, the above-entitled matter was concluded at 4:10
7 p.m.)

PGR2023-00017
Patent 11,445,727

PETITIONER:

Toni-Junell Herbert
David M. Klecyngier
Daniel Bucca
Charles C. Carson
BAKERHOSTETLER LLP
therbert@bakerlaw.com
dklecyngier@bakerlaw.com
dbucca@bakerlaw.com
ccarson@bakerlaw.com

PATENT OWNER:

Mark J. Feldstein
Rajeev Gupta
Kenneth S. Guerra
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.
mark.feldstein@finnegan.com
raj.gupta@finnegan.com
kenneth.guerra@finnegan.com