

From: [Trials](#)
To: [Guerra, Kenneth](#); [Trials](#)
Cc: [Feldstein, Mark](#); raj.gupta@finnegan.com; [UPL-PGR-FINNEGAN](#); [Herbert, Toni-Junell](#); [Bucca, Daniel](#); [Carson, Charles C.](#); [Klecynsier, David M.](#); EXT-Mrick@bakerlaw.com
Subject: RE: PGR2023-00017
Date: Tuesday, July 30, 2024 8:21:16 AM

Counsel,

From the Board –

Patent Owner affirmatively withdrew “any substantive reliance on the ’727 patent examples in this proceeding.” Paper 39, 3. Because Patent Owner did not rely on the field trial data, there does not appear to be any basis for Petitioner’s proposed motion for sanctions.

Petitioner’s request is denied.

Regards,

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

From: Guerra, Kenneth <Kenneth.Guerra@finnegan.com>
Sent: Wednesday, July 24, 2024 2:54 PM
To: Trials <Trials@USPTO.GOV>
Cc: Feldstein, Mark <mark.feldstein@finnegan.com>; raj.gupta@finnegan.com; [UPL-PGR-FINNEGAN](#) <UPL-PGR-FINNEGAN@finnegan.com>; [Herbert, Toni-Junell](#) <therbert@bakerlaw.com>; [Bucca, Daniel](#) <dbucca@bakerlaw.com>; [Carson, Charles C.](#) <ccarson@bakerlaw.com>; [Klecynsier, David M.](#) <dklecynsier@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>
Subject: RE: PGR2023-00017

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Dear Honorable Board,

We write to correct Petitioner’s mischaracterization of Patent Owner’s position. As Patent Owner has already communicated to Petitioner, “Syngenta’s proposed motion is untimely and without merit.” Specifically, Patent Owner has communicated to Petitioner that “Syngenta’s motion is improperly based on trials on which UPL had previously disclaimed reliance in this PGR.” *See* Paper 39, 3 (withdrawing reliance); Paper 40, 6 (PTAB acknowledging no reliance on trial data to deny Syngenta discovery). Patent Owner further communicated to Petitioner’s counsel that its motion “additionally ignores that the Syngenta field trials conducted at your direction—but which you misrepresented and sought to withhold—independently established enablement and unexpected results.”

We also note that Petitioner again improperly deviates from the procedure set forth in the Scheduling Order (Paper 9). *See* January 1, 2024, Board Email (instructing Petitioner to follow procedure outlined in Scheduling Order and not include substantive argument). Petitioner has bypassed the request for an “additional conference call,” failing to provide “multiple times when all parties are available,” and whether “the parties have met and conferred telephonically or in person.” Paper 9, 2. Petitioner has not asked Patent Owner for availability for a call with the Board and the parties have not met and conferred telephonically or in person to attempt to reach agreement. Further, Petitioner’s email below improperly “contain[s] substantive argument.” Paper 9, 2.

In the event the Honorable Board nevertheless is considering granting Petitioner’s request, Patent Owner requests that a call be held to discuss the matter first, pursuant to the Scheduling Order. Patent Owner is available Friday (7/26) between 10:00am-1:00pm (ET), Monday (7/29) between 10:00am-1:00pm (ET), and Wednesday (7/31) between 10:00am-1:00pm (ET).

Respectfully,

Kenneth S. Guerra
Associate

Pronouns: He, Him, His

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FINNEGAN

From: Herbert, Toni-Junell <therbert@bakerlaw.com>

Sent: Wednesday, July 24, 2024 11:39 AM

To: Trials <Trials@USPTO.GOV>

Cc: Feldstein, Mark <mark.feldstein@finnegan.com>; Guerra, Kenneth <Kenneth.Guerra@finnegan.com>; Gupta, Raj <Raj.Gupta@finnegan.com>; UPL-PGR-FINNEGAN <UPL-PGR-FINNEGAN@finnegan.com>; Bucca, Daniel <dbucca@bakerlaw.com>; Carson, Charles C. <ccarson@bakerlaw.com>; Klecyngier, David M. <dklecyngier@bakerlaw.com>; EXT-Mrick@bakerlaw.com <Mrick@bakerlaw.com>

Subject: PGR2023-00017

Importance: High

To the Honorable Board,

Petitioner (Syngenta) seeks authorization to file a motion for sanctions against Patent Owner (UPL) in the above-referenced matter. Petitioner served Patent Owner with a motion for sanctions, supporting Declaration, and Exhibit in the above-referenced matter on July 2, 2024, which is 21 days prior to seeking authorization to file the motion per Rule 42.11 (d).

Briefly, the issue surrounding the motion is that recent investigations by Syngenta have revealed that the purported field trials described in the '727 Patent and relied upon by UPL in first obtaining issuance of the patent and later in opposing Syngenta’s Petition for post-grant review never took place. UPL’s failure to disclose that fact to the Office and the Board, and thus, its failure to uphold its ongoing duty of candor and good faith is sanctionable misconduct.

Patent Owner's response of July 22, 2024, evening did not dispute or remedy. We are requesting authorization to file our motion for sanctions now that the 21 days have passed.

Respectfully,

Toni-Junell Herbert
Lead Counsel for Petitioner

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