

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KINDERFARMS, LLC,
Petitioner,

v.

GENEXA, INC.
Patent Owner.

Case No. PGR2023-00051
U.S. Patent No. 11,617,795

**PATENT OWNER'S NOTICE IDENTIFYING PETITIONER'S IMPROPER
REPLY ARGUMENTS**

Patent Owner provides the following identification of improper portions of Petitioner's Reply pursuant to the Court's Order regarding Patent Owner's request to file a motion to strike. (*See* Paper 26.)

First, Petitioner's Reply seeks to introduce new and improper arguments regarding a POSA allegedly selecting an agave syrup with appropriate viscosity and adjusting the water content to a final formulation viscosity.

Location in Reply (Paper 25): Page 11, lines 12-14 (“[A] POSA would be capable of selecting an agave syrup with appropriate viscosity and, if necessary, adjusting the water content and/or other components to achieve the desired final viscosity.”); Page 19, lines 14-18 (“Regarding Ground 1 . . . [a] POSA would know how to select agave syrup with an appropriate viscosity and adjust the relative amounts of the formulation components as needed to achieve the desired final viscosity”); Page 20, lines 9-16 (“Regarding Ground 2 . . . [a] POSA would understand how to adjust the amount and/or type of agave syrup (which itself includes water), as well as the amounts of other components, to achieve an effective formulation with a desired viscosity”); Page 21 lines 6-9 (“However, the Petition explicitly addresses the fact that agave syrups can have different viscosities (i.e., thinner or thicker consistency) and one can select the desired viscosity depending on the proposed use. Pet., 4 fn. 1.”).

Explanation: Petitioner's new “selecting an agave syrup” and “adjusting the

water content and/or other components to achieve the desired final viscosity” arguments exceed the proper scope under § 42.23(b) and departs from the Trial Practice Guide (page 74) and Board authority (*e.g.*, *NXP B.V et. al. v. Bell Semiconductor, LLC*, IPR2021-00966, Paper 34 at 37 n.26 (PTAB Oct. 6, 2022)). Petitioner never made any such argument in the Petition. Nor did the Petition ever fairly raise selecting an agave syrup based on its viscosity or propose any modifications to the teachings of the prior art to adjust the water content to achieve a formulation’s final desired viscosity. Indeed, such arguments contradict the Petition. The Petition (wrongly) asserts that agave syrup has a viscosity of 212 cP and never mentions any other agave syrup. (*See* Pet. 31 (citing Ex. 1003, ¶52), 57 (citing Ex. 1003, ¶119 (“***a person of ordinary skill in the art would have known that agave syrup has a viscosity of around 212 centipoise***”))). The Petition also never asserts that the relative amount of water should be adjusted to achieve a desired final viscosity. Again, to the contrary, the Petition asserts that water is added “to bring the formulation ***to the desired final volume.***” (*See* Pet. 30.)

Second, Petitioner’s Reply seeks to introduce new and improper arguments regarding a motivation to combine the agave-syrup teachings of FR458 or WO742 with the specific viscosity ranges of WO133 and/or the ’4666 patent).

Location in Reply (Paper 25): Page 2, lines 16-20 (“A POSA would have been motivated to combine FR458’s low glycemic index agave syrup-based liquid

oral acetaminophen formulation with the viscosity ranges for liquid oral analgesic formulations taught by WO133, the '4666 Patent, or both, to predictably arrive at the claimed invention. Pet. 27-29"); Page 4, lines 7-11 ("A POSA would have been motivated to combine WO742's agave syrup-based liquid dextromethorphan and acetaminophen formulations for oral administration with the viscosity ranges for oral analgesic formulations taught by either WO133, the '4666 Patent, or both, to predictably arrive at the claimed invention. Pet. 54-55").

Explanation: The portions of the Petition cited for Petitioner's new Reply arguments—Pet. 27-29, 54-55—never mentions "viscosity" once. The Petition merely asserts the interrelatedness of the references based on them being in the same field and sharing disclosures related to taste-masked oral formulations for the elderly and children, analgesics suspensions, and/or a lower sugar content. (*See* Pet. 27-29, 54-55.) The Petition never articulated any motivation to combine aspects of FR458 or WO742 to achieve the specific viscosities of WO133 and/or the '4666 patent.

Third, Petitioner's Reply improperly relies on new prior art disclosures.

Location in Reply (Paper 25): Pg. 17, lines 1-4 (FR458: "a preferred range of 1.0% to about 25%"); Page 17, lines 18-19 ("the narrower preferred acetaminophen ranges disclosed by FR458 (1.0% to about 25%) and WO133 (2 to 5%)").

Explanation: The Petition never mentions these preferred ranges regarding claims 5-6. (*See* Pet. 35 (FR458: "0.01% to 90%"), 60 (WO133: "less than 10%").)

Dated: October 2, 2024

/Daniel J. Knauss/

Daniel J. Knauss

(Reg. No. 56,393)

Attorneys for Patent Owner

Cooley LLP

1299 Pennsylvania Avenue, NW

Suite 700

Washington, DC 20004-2400

Tel: 650-843-5287

Fax: 650-849-7400

CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on October 2, 2024, a complete and entire copy of **PATENT OWNER'S NOTICE IDENTIFYING PETITIONER'S IMPROPER REPLY ARGUMENTS** was served via electronic mail on the Petitioner by serving Petitioner's counsel of record as follows:

Brian W. Nolan
Shantelle LaFayette, Ph.D.
Ying-Zi Yang
Mayer Brown LLP
bnolan@mayerbrown.com
slafayette@mayerbrown.com
yyang@mayerbrown.com

Dated: October 2, 2024

/Daniel J. Knauss/

Daniel J. Knauss

Reg. No. 56,393