

From: [Trials](#)
To: Scott.McKeown@WolfGreenfield.com; [Trials](#)
Cc: [Michael Kane](#); [PGR58032-0005PS1](#); [PGR58032-0003PS1](#); [PGR58032-0004PS1](#); [Charles Steenburg](#); [Oona Johnstone](#); [Jean Ge](#)
Subject: RE: PGR2024-00019; PGR2024-00020 & PGR2024-00023
Date: Wednesday, July 24, 2024 2:02:53 PM
Attachments: [image001.png](#)
[image002.png](#)
[image003.png](#)

Counsel,

From the Board –

Petitioner is authorized to file a 10-page reply to Patent Owner’s preliminary response in the PGR2024-00019, -00020, and -00023 proceedings addressing the issues outlined in the email dated July 23, 2024. The reply is due within 1 week.

Patent Owner is authorized to file a 10-page sur-reply in response due within 1 week of the filing of Petitioner’s reply.

A phone call is not deemed necessary.

Regards,

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

From: Scott.McKeown@WolfGreenfield.com <Scott.McKeown@WolfGreenfield.com>
Sent: Tuesday, July 23, 2024 5:47 PM
To: Trials <Trials@USPTO.GOV>
Cc: : Michael Kane <kane@fr.com>; PGR58032-0005PS1 <PGR58032-0005PS1@fr.com>; PGR58032-0003PS1 <PGR58032-0003PS1@fr.com>; PGR58032-0004PS1 <PGR58032-0004PS1@fr.com>; Charles Steenburg <Charles.Steenburg@WolfGreenfield.com>; Oona Johnstone <Oona.Johnstone@WolfGreenfield.com>; Jean Ge <Jean.Ge@wolfgreenfield.com>
Subject: PGR2024-00019; PGR2024-00020 & PGR2024-00023

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Trials,

Petitioner seeks authorization for a 12-page Reply to the recently filed Patent Owner Preliminary Responses (POPR) in the 00019 and 00020 proceedings; and a 10-page Reply in the 00023 proceeding. The Replies will address arguments of the POPRs directed to the appropriate standard of obviousness for plant utility patent filings, and the novel and unsettled legal questions presented in the PGR2024-00019 and -20 petitions. Petitioner believes good cause exists given the unique issues, and issues of first impression presented in each of these proceedings, more specifically:

- Patent Owner's position that plant utility obviousness should be conflated to novelty, and the

impact of the recent *en banc* decision in *LKQ Corp. v. GM Global Tech. Operations LLC*, (Fed. Cir. May 21, 2024) on that position;

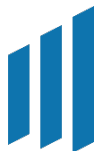
- Patent's Owner's contention that Petitioner's obviousness position would render all new commercial maize varieties obvious;
- Patent Owner's reliance on the deposits accompanying the '803, '020, and '545 patents and the relationship of those deposits to the scope of the challenged claims. This includes Patent Owner's attempt to distinguish *Ex parte C*, 27 USPQ2d 1492 (BPAI 1992).
- Patent Owner's argument in PGR2024-00019 and -20 that the "novel or unsettled legal question[s]" identified by Petitioner pursuant to section 324(b) are outside the scope of post-grant review.

Patent Owner strongly opposes Petitioner's request for a Preliminary Reply for lack of good cause. For at least PGR2024-00019 and PGR2024-00020, Petitioner's requests are untimely. The POPRs in these cases were filed almost 4 weeks ago, and, if additional briefing is granted, the Board will have fewer than 2 months to prepare and issue two Decisions on Institution. And, although the POPR in PGR2024-00023 was filed July 17, there was no reason for Petitioner to have filed its petitions in PGR2024-00019, -00020, and -00023 in a serial manner (February, March, and April, respectively). The challenged patents are not involved in any co-pending litigation. Granting additional briefing under these facts encourages road-mapping. In addition, Patent Owner is currently working on another POPR, due on August 22, in another petition filed by Petitioner (PGR2024-00025).

Moreover, Petitioner does not attempt to address why any of Patent Owner's arguments were unforeseeable. Petitioner had plenty of space in its Petitions to address (and did address) obviousness, each patent's corresponding seed deposit, *Ex parte C*, and § 324(b). Indeed, Petitioner's request for an additional 12 (and 10) pages is excessive, especially considering that each Petition is already over 84 pages. The Board is capable of evaluating each party's arguments on the present record without an additional 65+ pages of briefing, which adds significant costs to Patent Owner without a commensurate value to the Board.

Finally, Petitioner misstates Patent Owner's reply about obviousness, asserting erroneously that "Patent Owner's position [is] that plant utility obviousness should be conflated to novelty," to argue that *LKQ Corp.* (a design patent case) is relevant to the Board's analysis here. It is not. But, in any event, the Board is well equipped to evaluate arguments in view of Federal Circuit caselaw. To the extent the Board wishes to have additional briefing on this case, however, Patent Owner submits that 2 pages for each party would be more than sufficient to address that decision.

Should a teleconference be deemed necessary, the parties are available Thursday, July 25th @9-11AM or 3:30-5PM or Friday July 26th 9-11AM.



Scott McKeown (Mik-Q-En)
Shareholder
Scott.McKeown@wolfgreenfield.com
202.389.6025

Wolf, Greenfield & Sacks, P.C.
BOSTON | NEW YORK | WASHINGTON DC
wolfgreenfield.com in 

This e-mail message and any attachments may contain confidential or privileged information. If you are not the intended recipient, please notify me immediately by replying to this message. Please destroy all copies of this message and any attachments. Thank you.