

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALMENDRA PTE. LTD.
Petitioner

v.

FIENILE AGRONECÓCIOS LTDA.
Patent Owner.

PGR2025-00055
U.S. Patent No. 12,089,543 B2

**PATENT OWNER FIENILE AGRONECÓCIOS LTDA.'S
REQUEST FOR DISCRETIONARY DENIAL**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent & Trademark Office
P.O. Box 1450
Alexandria, Virginia 22313-1450

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PATENT OWNER'S LIST OF EXHIBITS

Exhibit:	Description:
EX2001	Patents Dashboard USPTO as of July 2025, accessed Sept. 8, 2025

I. INTRODUCTION

The Director should deny institution under 35 U.S.C. § 324(a) because the USPTO is already examining the same patentability issues in Patent Owner’s pending reissue. Running a PGR in parallel with a reissue that squarely addresses the Petition’s § 101, § 112, and prior-art grounds is an inefficient use of Board and Office resources and invites conflicting outcomes. The Board has repeatedly disfavored concurrent Office proceedings on the same issues—“it is not an efficient use of Office resources to review a patent in two separate, concurrent Office proceedings.” The same principle applies here: the reissue will address the very grounds raised in the Petition, making PGR institution duplicative and unnecessary.

II. THE USPTO IS ALREADY EXPENDING RESOURCES REVIEWING THE PATENTABILITY OF THE CHALLENGED PATENT

The Director should exercise discretion under 35 U.S.C. § 324(a) to deny institution, because the Patent Owner’s pending reissue will fully address Petitioner’s challenges. Proceeding on two fronts within the USPTO would be an inefficient use of Board and Office resources and create a risk of inconsistent results. The PTAB has repeatedly recognized that overlapping USPTO proceedings on the same patent and issues are disfavored. For example, in *American Airlines, Inc. & Southwest Airlines Co. v. Intellectual Ventures I LLC*, the Director noted it “is not an efficient use of Office resources to review a patent in two separate, concurrent

Office proceedings”. IPR2025-00785, Paper 11, at *2 (Aug. 29, 2025); *see also* IPR2025-00786, Paper 12, at *2 (Aug. 29, 2025) (same). In other words, duplicating efforts between an AIA trial and an examiner’s reissue examination wastes resources and should be avoided.

Indeed, when parallel Office proceedings do occur, the PTAB’s policy is to prevent duplication. The PTO’s default stance is to not simultaneously run two proceedings on the same patent – one of them must yield. Here, the Patent Owner has already chosen the reissue path to resolve the very issues raised in the Petition. Instituting post-grant review would reduce the PTAB’s efficiency and increase the current workload needs of the PTAB while saddling the Office with duplicitous patentability determinations.

Recent Director decisions confirm that a co-pending reissue or reexamination covering the same patent and issues favors exercising discretion to deny institution. In *Cisco Systems, Inc. v. QPrivacy USA LLC*, the Board denied institution where merely a request for *ex parte* reexamination on the challenged patent was “before the Office.” IPR2025-00836, Paper 11, at *2 (Aug. 29, 2025); *see also* IPR2025-00837, Paper 11, at *2 (Aug. 29, 2025) (same). Here, Patent Owner’s reissue application is similarly before the Office. Allowing this challenge to proceed in parallel with the reissue examination would result in “significant duplication of effort, additional expense for the parties, and a risk of inconsistent decisions.” *Id.* Such

considerations, combined with the parallel examination, outweigh factors favoring institution.

Patent Owner's pending reissue is likely to resolve issues relating to the patentability of the '543 Patent prior to the Final Written Decision. Based on the most recent July 2025 operational statistics for examination, the average number of months from application filing date to disposal is 26.2 months, falling slightly after the anticipated date of the Final Written Decision. EX2001, at 3. However, this average pendency fails to account for the special status accorded to Patent Owner's reissue application. "All reissue applications are taken up 'special,' and remain 'special' even if applicant does not respond promptly." MPEP 1442. Patent Owner's reissue application being granted special status will provide the application to be "docketed and taken up for action expeditiously (e.g., within two weeks of the granting of special status)." MPEP 708.08(a)(II). Patent Owner's special status reissue application indicates total pendency for the reissue will likely be resolved prior to the anticipated Final Written Decision date.

It does not make sense for the PTAB to conduct post-grant review of the '543 Patent that will likely have completed reissue examination before the deadline for a final written decision. It is most efficient to allow the reissue examination of the '543 Patent and conserve the PTAB's resources for other workload needs, including, e.g., *ex parte* appeals. Accordingly, institution should be refused to conserve

resources and avoid conflicting outcomes. These decisions echo the common-sense notion that once the Office is substantively engaged with a patent through a reissue/reexam, launching a parallel PGR would be wasteful and potentially chaotic.

To reduce any perceived speculation surrounding the conduct and outcome of Patent Owner's reissue application, Patent Owner hereby stipulates that if the Director exercises discretion to deny institution in this post-grant review based on the copending reissue proceeding, then (1) Patent Owner will not withdraw the reissue application before issuance of a reissued patent and (2) Patent Owner will not assert the challenged '543 Patent in any litigation during the pendency of the reissue proceeding. It is understood that the '543 Patent remains in effect even after the filing of a reissue application; however, Patent Owner would be required to surrender the '543 Patent upon issuance of a reissued patent. *See* 37 C.F.R. § 1.178.

Denying institution at this juncture aligns with the purpose of the Board's discretion—to allocate PTAB resources to matters that truly require PTAB resolution. The Board's finite resources should not be spent racing an examining corps process handling the same task. It is an inefficient use of Board resources to review a challenged patent that is also being examined in a concurrent proceeding. Here, the reissue examination offers a more efficient, single-forum path to potentially resolve validity issues, including offering the patent owner a chance to amend claims—a flexibility that promotes a just outcome without burdening the

Board. At present, instituting this post-grant review would serve little purpose except to duplicate and complicate what the reissue will address in due course.

In sum, allowing the PGR to proceed in parallel with the reissue would needlessly squander Board and party resources and create a risk of inconsistent judgments within the USPTO. The better course, well-supported by recent Director decisions, is to deny institution now in favor of the reissue. This approach heeds the PTAB's own guidance that parallel Office proceedings on the same patent and issues should be avoided when possible. The Director should therefore exercise discretion to deny institution of this PGR petition, permitting the patentability issues to be resolved efficiently through the pending reissue proceeding. This will promote efficiency, prevent duplicative efforts, and eliminate any danger of conflicting outcomes.

III. CONCLUSION

Institution should be denied to preserve Office resources and avoid inconsistent intra-USPTO results. The reissue—taken up “special” (MPEP §§ 1442, 708.08(a)(II))—provides a single, efficient forum to resolve the Petition's §§ 101, 112, and 103 challenges, including with claim-amendment flexibility. *See, e.g., Cisco v. QPrivacy*, IPR2025-00836, Paper 11, at *2 (Aug. 29, 2025) (parallel Office proceeding warrants denial); *id.*, IPR2025-00837, Paper 11, at *2. Patent Owner further stipulates that, if discretion is exercised to deny based on the copending

reissue, it will (1) not withdraw the reissue before issuance of a reissued patent and (2) not assert the '543 patent in litigation during the reissue, acknowledging surrender upon reissue. *See* 37 C.F.R. § 1.178. The Director should deny institution so the USPTO can resolve the issues once, efficiently, in the reissue.

Date: September 9, 2025

Respectfully submitted,

By: /s/ Seth R. Ogden

Seth R. Ogden (Reg. No. 65,168)

Mark A. Kilgore (Reg. No. 75,994)

Sam A. Raque (Reg. No. 77,890)

Patterson Intellectual Property Law, P.C.

1600 Division Street, Suite 500

Nashville, TN 37203

sro@iplawgroup.com

mak@iplawgroup.com

sar@iplawgroup.com

Tel.: (615) 242-2400

Fax: (615) 242-2221

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24, the undersigned certifies that this Request complies with the type-volume limitation of 37 C.F.R. § 42.24(a)(v). The page count application of the word processing program used to prepare this Request indicates that Patent Owner's Request for Discretionary Denial contains 7 pages, excluding the parts of the Petition exempted by 37 C.F.R. § 42.24(a).

Dated: September 9, 2025

/s/ Seth R. Ogden
Seth R. Ogden (Reg. No. 65,168)

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that the foregoing **PATENT OWNER FIENILE AGRONECÓCIOS LTDA.'S REQUEST FOR DISCRETIONARY DENIAL** was served in its entirety electronically via e-mail on September 9, 2025, on the following counsel of record for Petitioner:

Thomas F. Finch (Lead Counsel)
Kenneth A. Knox (Back-up Counsel)
Jason M. Perilla (Back-up Counsel)

By: /s/ Seth R. Ogden
Seth R. Ogden (Reg. No. 65,168)
Patterson Intellectual Property Law, P.C.
1600 Division Street, Suite 500
Nashville, TN 37203
sro@iplawgroup.com
Tel.: (615) 242-2400
Fax: (615) 242-2221