

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

VIANCE, LLC,
Petitioner,
v.

KOPPERS PERFORMANCE CHEMICALS, INC.,
Patent Owner.

PGR2026-00023
Patent 12,370,716

**PETITIONER'S CORRECTED OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	ARGUMENT.....	1
A.	Petitioner Identified All RPIs in the Petition	1
1.	Background	2
2.	Venator is <i>not</i> an RPI to this Proceeding.....	2
3.	REDACTED are also <i>not</i> RPIs to this proceeding	6
B.	Discretionary Denial is Not Warranted Under Section 325(d).....	10
1.	Grounds 7 and 8 do not rely on substantially the same prior art previously presented to the Office.....	10
2.	Petitioner was not required to demonstrate, in the Petition, material error by the Office	14
C.	PO has Failed to Show that Petitioner’s Expert Testimony Attempts to Fill in Any Gaps in Printed Publication Evidence or is Otherwise Improper.....	14
D.	Patent Owner Mischaracterizes the Petition’s Grounds as a “Multitude of Unfocused Grounds”	17
III.	CONCLUSION.....	20

I. INTRODUCTION

Patent Owner's (PO) request for discretionary denial is wrong on the facts and wrong on the law.

First, under the controlling LLC agreement, neither of Petitioner's two Members, including Venator, has the right to control Petitioner.

Second, PO's arguments that the "Office has already considered and rejected" the prior art challenges for references cited for Grounds 7 and 8 are meritless. Rak teaches the very limitations that the Examiner found missing from the prior art of record. PO also fails to show that the Examiner considered Rak's disclosure for its substance, resting on a search query argument squarely rejected by the Board.

Third, PO fails to show that the supporting expert testimony seeks to "fill gaps" in the prior art references or is otherwise improper. PO relies on mischaracterizations and glaring omissions from Petitioner's expert declaration.

Fourth, Contrary to PO's assertions, the grounds are in no way "unfocused." Petitioner properly relies on four primary references—and two of them apply only to the asserted loss of priority to a provisional application, which PO ignores.

II. ARGUMENT

A. Petitioner Identified All RPIs in the Petition

PO's request reflects a strained effort to overextend *AIT* to show control by Venator and Petitioner's customers. *See Applications in Internet Time, LLC v. RPX Corp.*, 897 F.3d 1336 (Fed. Cir. 2018) ("*AIT*"). The Board has cautioned that "[t]he

RPI analysis set out in *AIT* and the common law require more than simply confining the analysis to determining whether a party benefits generally from the filing of this Petition and also has a relationship with the Petitioner.” *Dr. Reddy's Lab 'ys S.A. v. Indivior UK Ltd.*, IPR2019-00329, Paper 21 at 11 (PTAB June 3, 2019).

1. Background

Petitioner is an LLC which has two “Members.” (LLC Agreement, Ex1088, p.5; Moyes Decl., Ex1091, ¶¶4, 6 (“The current Members of the company are Venator Materials PLC (“Venator”), which has a 50.001% ownership interest, and Lanxess AG (“Lanxess”), which has a 49.999% ownership interest.”).) Each Member has an equal number of director-representatives seated on the Board of Directors—and thus equal voting rights (50:50). (Ex1088, p.9, Section 2.2 (a); Moyes Decl., Ex1091, ¶7.) Thus, under the controlling LLC Agreement, neither Member has the right to control Petitioner. (Ex1088, pp.8-9.)

Additionally, neither of the alleged customer-RPI’s have funded, controlled, or directed this PGR petition, nor have the ability to control it. (Moyes Decl., Ex1091, ¶15.) PO has not sued Petitioner or any of its customers. Neither of the two alleged customer-RPIs are time-barred from filing their own PGR petition.

2. Venator is *not* an RPI to this Proceeding

To decide whether a nonparty is a real party in interest, the Board seeks to determine whether some party other than the petitioner is the “party or parties at

whose behest the petition has been filed.” (Office Patent Trial Practice Guide, 84 Fed. Reg. 64,280 at 14, §I.D.1, (Nov. 21, 2019) (“Trial Practice Guide”).)¹ “[A] party that funds and directs and controls an IPR or PGR [proceeding] constitutes a ‘real party-in-interest,’ even if that party is not a ‘privy’ of the petitioner.” (*Id.* at 17.)

PO first argues that Venator is a “majority” shareholder having a 50.001% interest in Viance. (Req. at 5-6.) But, Venator does not have control over Petitioner’s operations, and certainly does not have control with respect to this “proceeding.” (Moyes Decl., Ex1091, ¶¶6-8.) Petitioner is an LLC having two Members, neither of whom can individually control Petitioner. (Ex1088, pp.5, 8; Moyes Decl., Ex1091, ¶¶4, 6-8.) The LLC agreement states “no Member, by virtue of its status as a Member, shall have any management power over the business and affairs of the Company or actual or apparent authority to enter into Contracts on behalf of, or otherwise to bind, the Company, except through the Board of Directors.” (Ex1088, p.8, Section 2.1(a).) Each of the two Members has an equal voting interest in the form of three “Representatives” on the Board of Directors. (Ex1088, p.9, Section 2.2(a).) Thus, while Venator has a slight majority in ownership interest, Venator does not have the ability to control Petitioner, let alone control this PGR proceeding.

¹ All emphasis herein has been added unless otherwise noted.

PO next argues that “[because] Venator manufactures the wood-treatment products marketed by Viance, it stands to reason that Venator is the manufacturer of UP-50.” (Req. at 7.) This cited language, apparently directed to other products, is not correct as to (at least) the subject UP-50 product. (Moyes Decl., Ex1091, ¶¶11-13.) Petitioner has shown that Venator does not manufacture UP-50. (Moyes Decl., Ex1091, ¶¶11-13; Ex1045, Ex1047, Ex1051, Ex1054.) Rather, Viance has control over the manufacture of UP-50, which it alone procures via contracts between Viance and third-party toll manufacturers, neither of which are associated with Venator. (Moyes Decl., Ex1091, ¶¶11-13; Ex1089 (tolling contract); Ex1090 (tolling contract); *see also* Exs1045, 1047, 1051, 1054 (toll invoices).) Moreover, Viance is a stand-alone company and is fully responsible for research and development, technical and engineering services, marketing and sales, finance, and supply chain management, including tolling operations. (Moyes Decl., Ex1091, ¶11.) PO’s speculation is thus factually incorrect.

PO also relies on select statements from Venator’s financial statements that are apparently directed to the matter of “control” for accounting purposes, namely, consolidating financial statements. That Venator’s consolidated financial statements include Petitioner merely reflects reporting for accounting purposes. It does not convert Venator into an RPI, and PO cites no law to that effect. *Cf., VirnetX Inc. v. Mangrove Partners Master Fund, Ltd.*, 778 Fed. Appx. 897, 902-903 (Fed. Cir.

2019) (nonprecedential) (holding that investment manager of the petitioner was not a real party in interest simply because it controlled petitioner's assets). Nor does mere relationship via a consolidated financial statement somehow show RPI status; indeed, it is not uncommon for a parent to include a more-than-50%-owned subsidiary in a consolidated financial statement. (Ex1093, pp.3-4) (<https://www.investopedia.com/ask/answers/06/subsidiaries.asp> last accessed on June 10, 2026). Mere financial or ownership interest does not impart RPI status. *Enovate Medical, LLC v InterMetro Indus.*, IPR2015-00301, Paper 50 at 9 (PTAB May 11, 2016) (stating that “[o]wning a percentage of a party (or even all of it) ... does not render the owner a real party-in-interest.”). Still further, Venator has not funded, controlled, or directed this PGR petition, and Venator does not have the ability to control the PGR. (Moyes Decl., Ex1091, ¶¶6-8.)

PO's assertions therefore rest on incorrect and unsupported factual assertions that lack support in law. None of PO's unsupported arguments even arguably show that Venator has control over this PGR proceeding, let alone that it is an RPI.²

² Petitioner notes that it has submitted an Updated Mandatory Notice in accordance with *Tianma Microelectronics Co., Ltd. v. LG Display Co., Ltd.*, IPR2025-01579, Paper 12 at 8, n. 6 (PTAB Mar. 18, 2026), issued after filing of the present Petition.

3. **REDACTED** are also *not* RPIs to this proceeding

PO's argument that two of Petitioner's customers are RPIs also rests on an incorrect assertion of the facts and incomplete and unsupported legal arguments—that overextend the reasoning of *AIT* and by extension also *Ventex*. See *AIT*, 897 F.3d at 1336; *Ventex v. Columbia Sportswear North America, Inc.*, IPR2017-00651, Paper 148 (PTAB Jan. 24, 2019).

In *Ventex*, the Board relied on key facts to show that the petitioner filed its IPR petition at the behest of an unnamed customer-RPI. There, unlike the present case, the customer had been charged with infringement (and sued) and was time-barred from filing its own IPR petition. *Ventex*, IPR2017-00651, Paper 148 at 7.

In an effort to apply *Ventex* to the present case, PO misstates the record, asserting that PO charged Petitioner with infringement. (Req. at 10 (citing Ex2008).) PO's carefully worded letter, however, does not use the word "infringement." More importantly, PO sent a subsequent letter to Petitioner in which it expressly stated that it was not charging the subject product with infringement. (Ex1092, p.1 ("I would like to clarify that Koppers Performance Chemicals Inc. ("Koppers") has not asserted that Viance's UltraPole NXT UP-50 ("UP-50") infringes the '716 patent.") PO's assertion that it has asserted infringement is thus demonstrably incorrect—and PO's reliance on *Ventex*, which rests on this key fact, is thus unsupported.

In *Ventex*, the Board made it clear that it was important to its decision that the

customer (Seirus) was time-barred from filing its own IPR petition. *Ventex*, IPR2017-00651, Paper 148 at 8 (“Importantly, Ventex seeks relief in this forum that Seirus [the customer] is barred under § 315(b) from seeking for itself.”). Here, no infringement action has ever been filed against Petitioner’s customers—and no customer is barred under § 315(b) from seeking relief for itself.

As discussed below, the Board has repeatedly rejected such attempts to overextend the reasoning of *AIT* in situations where the unnamed party was not time-barred, recognizing that the presence of a time-barred customer was “crucial” to the holding of *AIT*. It stands to reason that the filing of a petition by a supplier can more readily be deemed filed at the “behest” of a customer in a situation where the customer was charged with infringement and not free to file a petition on its own.

In *Unified Patents Inc. v. Bradium Technologies LLC*, the Board explained that the presence of a time-barred customer was a “crucial” fact. *Unified Patents Inc. v. Bradium Techs. LLC*, IPR2018-00952, Paper 31 at 11 (PTAB Dec. 20, 2018) (citations omitted) (“Perhaps most significantly, there is no evidence that any member, including the two members, desires review of the '239 Patent but is time-barred from filing an IPR—a fact that was crucial in *AIT*.”); *see also Unified Patents Inc. v. American Patents LLC*, IPR2019-00482, Paper 132 at 51-52 (PTAB Aug. 3, 2022) (similar); *Polycom, Inc. v. directPacket Research, Inc.*, IPR2019-01233, Paper 21 at 18 (PTAB Jan. 13, 2020) (§315(b) bar “not in evidence here”).

Similarly, in *Dr. Reddy's Lab 'ys*, the Board rejected an attempt to overextend AIT based on the mere notion that the unnamed party/customer would benefit from the petition and had a relationship with the petitioner. IPR2019-00329, Paper 21 at 11 (“[PO]’s reliance on *AIT* and the asserted ‘exclusive contractual relationship’ and ‘status [of LTS] as a beneficiary of this proceeding’ is an overly extensive reading of *AIT* *** The RPI analysis set out in *AIT* and the common law require more than simply confining the analysis to determining whether a party benefits generally from the filing of this Petition and also has a relationship with the Petitioner.”).

The absence of the critical fact of a time-barred customer is not remedied simply by existence of an indemnification obligation in a supply agreement, which the Board has recognized is a “standard” provision. *Luminex Int’l. Co., Ltd v. Signify Holdings B.V.*, IPR2024-00101, Paper 20 at 12 (Vidal Nov. 21, 2024) (Petitioner’s customer was not an RPI where supplier sales contract included “standard indemnification” and the petition was filed after customer’s claim for indemnity).

PO cites no case finding a customer RPI based merely on a customer-supplier indemnification arrangement. Indemnification provisions are particularly commonplace in the manufacture of products that implement standard essential patents and other technologies. *Cf. Id.*; *see also Wi-Fi One, LLC v. Broadcom Corporation*, 887 F.3d 1329, 1340-41 (Fed. Cir. 2018) (rejecting reliance on indemnity agreements and reasoning that the petitioner had “an interest of its own

in challenging the [] patent, based on its manufacturing of the assertedly infringing chips.”); *see also WesternGeco LLC v. ION Geophysical Corp.*, 889 F.3d 1308, 1321 (Fed. Cir. 2018) (rejecting reliance on indemnification agreement).

Lacking “crucial” facts of a time-barred customer (or even an assertion of infringement), PO’s motion is left with a single sentence of alleged assistance by

REDACTED having signed a supporting declaration. (Req. at 11.) While PO’s request says nothing more to develop this argument, corroborating documentation of product sales and testing does not transform **REDACTED** into an RPI. *Cf. WiFi One, supra*, 887 F.3d at 1339-40 (rejecting the notion that “[petitioner]’s use of the report of one of the plaintiff’s experts from the district court litigation *** indicates that [petitioner] and the [petitioner’s customers] were ‘closely coordinating their opposition to the ’215 patent’ [which] should have been sufficient for the Board to [allow discovery on the issue of named RPIs].”). This is particularly so where, as here, there is no showing that, **REDACTED** exercised or could exercise control over this PGR, let alone that there was any §315 bar or other evidence that the Petition was in fact filed on its behalf. *See Merck Sharp & Dohme Corp. v. GlaxoSmithKline Biologicals SA*, IPR2018-01236, Paper 13 at 12-13 (PTAB Dec. 18, 2018). Rather, Petitioner’s filing reflects the “normal desire of a manufacturer or supplier of a product; namely, that its customer not be prohibited from selling the product.” *Dr. Reddy’s Lab ’ys*, IPR2019-00329, Paper 21 at 10-11.

PO also misplaces reliance on Petitioner's supply agreements. In *Ventex*, after a litigation was filed against Seirus accusing Ventex's products, the parties entered into an agreement where Seirus provided Ventex with "an exclusivity fee" in exchange for an "Exclusive Manufacturing Arrangement," which tied all of the manufacturer's output to a single customer. *Ventex*, IPR2017-00651, Paper 148 at 7. Here, Petitioner has no "exclusive manufacturing agreement" for the subject UP-50 product with any customer. (Moyes Decl., Ex1091, ¶¶11-14.) Petitioner's actions cannot be deemed "*specifically representing* the unnamed party's interest."

At bottom, undisputed evidence shows that the alleged RPI-customers "ha[ve] no control over this proceeding.... [Petitioner] alone directed the preparation of the petition, and [Petitioner] alone pays the fees and costs for this proceeding." *Dr. Reddy's Lab's*, IPR2019-00329, Paper 21 at 10; Moyes Decl., Ex1091, ¶15.

B. Discretionary Denial is Not Warranted Under Section 325(d)

PO has failed to establish any basis for discretionary denial of institution under 35 U.S.C. § 325(d). There is no showing that the same or substantially the same prior art was presented to the Office. Further, this paper is the proper vehicle to respond to PO's asserted basis for denial.

1. Grounds 7 and 8 do not rely on substantially the same prior art previously presented to the Office

Contrary to PO's arguments, Rak offers unique teachings that the Examiner found missing in the prior art of record, namely, the recited concentrations of wood

preservative and retaining additives. (See Notice of Allowability, Ex1004, pt.2, p.164 (“Cui fails to teach the DCOI [wood preservative] concentration of 40% by weight to 60% by weight based on the total weight of the composition (claims 43 and 85), [or DCOI concentration of 45% by weight to 55% (claim 67)], and the retaining additive concentration of 45% by weight to 55% by weight based on the total weight of the composition (claim 67). And, there are no prior art references that provide adequate teachings or apparent reason [] to modify Cui as claimed.”).)

Cui teaches “0.1-30 weight %” wood preservative in an “organic phase” (Ex1016, ¶¶19, 21). Cui states, “The organic phase may comprise a hydrophobe,” e.g., wax, but in lower concentrations than the challenged ‘716 patent claims. (*Id.* at ¶21.) Cui also states, “[e]xemplary concentrations [of the hydrophobe (e.g., wax)] are “0-40 weight %.” (*Id.*) Cui further teaches “water can be added” and “[t]he percentage of water in the formulation is typically 30-70 weight %” (*Id.* at ¶37; *see also id.* at ¶38.) As reflected in the Notice of Allowability above, the Examiner therefore found that Cui does not disclose the recited ranges of “40% by weight to 60% by weight” (and 45% by weight to 55% by weight) of wood preservative and retaining additive. (See Notice of Allowability, Ex1004, pt.2, p.164.)

As explained in the Petition, Rak teaches a wood preservative concentrate composition that falls within and overlaps the recited ranges of 40% by weight to 60% (and 45% by weight to 55%) by weight (based on a total weight of the

composition) of both a wood preservative and retaining additive comprising a wax. (Pet. at 69-74 (§IX.G.2.a-c), Pet. at 78 (§IX.G.7).) In particular, Rak discloses and claims a wood preservative concentrate, without organic solvent, adapted for dilution to form the final solution at the job site. (Ex1015, 17:20-38, claim 9; Ex1002, ¶357.) As explained in the Petition, the amount of wood preservative and retaining additive comprising a wax in the Rak concentrate fall within and overlap the recited ranges of the challenged claims. (Pet. at 71, Table (columns labeled “Wt. % Wood Preservative” and “Wt. % Retaining Additive”) (citing Ex1002, ¶358).) PO’s assertion that Rak is cumulative is therefore demonstrably incorrect. Rak teaches the very limitations that the Examiner found missing from the prior art of record—and Petitioner relies on Rak for disclosure of the same claim elements.

PO also argues that “AWPA Paper, HSA-18, and HCS25 SDS collectively add nothing beyond the disclosures of Cui and Ashmore that the Examiner considered.” (Req. at 16.) This is also incorrect. With respect to the combination of Rak and AWPA Paper, AWPA Paper demonstrates that DCOI is a known substitute for the PCP tested in Rak. The AWPA paper also provides experimental results demonstrating that DCOI in solvents, such as diesel and blends of diesel/biodiesel, provide excellent performance compared to PCP at equivalent retention levels. (Pet. at 20 (§V.G.)) The Petition also cites AWPA Paper for claim 16 (which recites “wherein the organic solvent comprises diesel”), indicating that the “AWPA

paper discloses diesel as a suitable hydrocarbon solvent for wood preservatives, including DCOI. (Ex1028, pp.12-17.)” (Pet. at 85-86.) Neither Cui nor Ashmore disclose diesel as a suitable hydrocarbon solvent for DCOI wood preservatives.

PO also argues that the Examiner “had knowledge of Rak’s disclosures” and (presumably) considered it because he used Rak’s patent number in a search query. (Req. at 14-15.) PO cites no authority directly supporting this argument. Rather, PO’s highlighted search query merely lists each of the U.S. references cited on the face of U.S. Patent No. 7,297,193, which granted from the Ashmore application cited by the Examiner. Such a search query provides no evidence that the Examiner read Rak, let alone made an “informed judgment about how to use” knowledge of Rak’s disclosures. Furthermore, the Board has unequivocally stated that “an examiner does not make a reference ‘of record’ solely by including the reference in a search query.” *Siemens Mobility, Inc. v. Metrom Rail, LLC*, IPR2024-00947, Paper 16 at 11 (PTAB Apr. 4, 2025).³ In *Siemens*, as here, the examiner’s searches included, as a search term, the patent number associated with a prior art reference relied upon by the petitioner. *Id.* at 10-11. The Board concluded this was “not sufficient to indicate that the Examiner considered [the prior art reference’s] disclosures for their substance.”

³ *Siemens* was decided by a Delegated Review Panel that included Chief Judge Scott Boalick and Vice Chief Judge Michael Kim.

Id. at 12. PO’s speculative assertions also ignore that Rak would have been listed on the face of the ‘716 patent, a PTO-892, IDS, or Office action if it had in fact been considered by the Examiner. *See* MPEP §1302.12 (9th ed. Rev.01.2024) (Requiring listing of cited patents on a form PTO-892 or IDS (PTO/SB/08) and initialed.”); *id.* at §707.05 (“Citation of References”).

The guidance of the MPEP and *Siemens* lead to only one conclusion—the Examiner cannot be deemed to have considered the substance of the Rak disclosure.

2. Petitioner was not required to demonstrate, in the Petition, material error by the Office

Contrary to PO’s assertion (Req. at 16-17), discretionary issues are appropriately raised here, not in the Petition. The Interim Director Discretionary Process states: “A petitioner should raise any discretionary issues in its opposition to a patent owner’s discretionary denial brief, including issues related to 35 U.S.C. § 325(d) and any other matter bearing on the Director’s discretion to institute. The petition should not address discretionary issues.” § III.A., available at <https://www.uspto.gov/patents/ptab/interim-director-discretionary-process>. Thus, Petitioner appropriately addresses material error by the Office in this paper.

C. PO has Failed to Show that Petitioner’s Expert Testimony Attempts to Fill in Any Gaps in Printed Publication Evidence or is Otherwise Improper

PO argues that the Petition relies on expert testimony to “fill gaps” in the printed publication evidence for Grounds 1 and 7 and loss of priority, section VII

(Pet. at 22-26). (Req. 17-18). Not so. None of PO's assertions show improper use of expert testimony, nor does the Petition rest on an absence of reasoned analysis or evidentiary support. While PO cites to *Arendi S.A.R.L. v. Apple Inc.*, 832 F.3d 1355, 1362 (Fed. Cir. 2016), nowhere does Petitioner's expert rely on "common sense." Notably, PO does not assert that Grounds 2-6 and 8-9 improperly relies on expert testimony to fill gaps. (*See* Req. at 18.)

PO first argues that Mr. Morgan's testimony stating "[t]here is no considerable difference between how the invention would operate within the claimed ranges (e.g., 40-60% by weight) and within the range disclosed in the prior art" is "unsupported." (Req. at 17.) (*See* Pet. at 71 (citing Ex1002, ¶360).) This statement concerns lack of criticality for the recited range, which is a matter of PO's burden, and thus can provide no basis for challenging the Petition in any event. But PO inexplicably ignores express evidentiary support for that statement, as evidenced by the very next sentence in the same paragraph, omitted by PO. (Ex1002, ¶360 ("For example, the '716 specification discloses concentrated compositions that can comprise DCOI in a range of 5% to 80% by weight, 20% to 80% by weight, 30% to 70% by weight, 40% to 50% by weight, or 45% to 55% by weight and does not disclose any difference in properties between the disclosed ranges.")) (citing Ex1001, 10:47-52).) Mr. Morgan further supported his testimony by the next additional sentence, again in the same paragraph, which PO also inexplicably omits. There, Mr. Morgan adds,

“[the ’716 specification] also provides concentrate examples in which DCOI is about 23% by weight, demonstrating a purportedly suitable DCOI concentration outside the claimed range.” (*Id.* (citing Ex1001, 14:41-50, 18:50-19:59).) Mr. Morgan does not rely on the ’716 patent specification to supply a missing element. Rather, he otherwise, explicitly explains how the recited elements are found in the prior art. Ex1002, ¶¶355-360. Likewise, in each paragraph, Mr. Morgan cites the precise reference that he interprets from the perspective of a POSA.

PO likewise mischaracterizes other statements made by Mr. Morgan as conclusory and supported, when in fact those statements provide a POSA’s interpretation of the ’817 provisional’s disclosure and explains *why* the challenged claims are not entitled to claim priority to the ’817 provisional. (*See* Req. at 17 (citing Pet. at 25, which cites Mr. Morgan’s testimony at Ex1002, ¶132, and Pet. at 26, which cites Mr. Morgan’s testimony at Ex1002, ¶133).) Mr. Morgan’s cited testimony *follows* an explicit analysis of the ’817 provisional’s disclosures (Ex1002, ¶¶128-131), after which he provides his conclusions, and is thus plainly not conclusory or unsupported.

PO also misleadingly states that the Petition “makes a blanket citation to over 80 paragraphs of expert testimony.” (Req. at 17-18 (citing Pet. at 27).) PO fails to note, however, that this portion of the Petition is merely an introduction that precedes the detailed, element-by-element analysis of each challenged claim for Ground 1,

which immediately follows beginning at the very next paragraph. (Pet. at 27-28.)

Similar to its argument for paragraph 360 of Mr. Morgan's declaration (regarding lack of criticality), PO asserts that paragraph 148 of Mr. Morgan's declaration concerning a lack of criticality for a recited range in claim 1 (element [1.b]) is unsupported. (Req. at 17-18 (citing Pet. at 31, Ex1002, ¶148).) Here, PO again exclusively cites only part of the conclusion of Mr. Morgan's testimony from paragraph 148—and ignores the three preceding paragraphs (paragraphs 145-147) which support his analysis, along with the rest of his analysis in the same paragraph 148, which cite the '716 patent as providing direct support for his testimony.

PO's remaining assertions likewise fail to show that any particular portion of Mr. Morgan's testimony is conclusory. (*See* Req. at 18 (citing PO's Pet. at 35, Ex1002, ¶165) (exclusively citing the conclusion of Mr. Morgan's testimony for claim 8, but glossing over two preceding paragraphs of supporting testimony, as well as omitting support from paragraph 165 itself); Req. at 18 (citing Pet. at 39-40, Ex1002, ¶187) (exclusively citing the conclusion of Mr. Morgan's testimony for claim 13, element 13.b, but omitting detailed explanation in the same paragraph, as well as support from three preceding paragraphs of testimony).)

PO's assertions of improper expert testimony are therefore meritless.

D. Patent Owner Mischaracterizes the Petition's Grounds as a "Multitude of Unfocused Grounds"

The Petition raises eight prior art Grounds that rely on only four primary

references. (Pet. at 3-4.) The asserted Grounds efficiently show how the 27 challenged claims are invalid, in one petition, based on two different priority dates. It is not uncommon for PGR petitions to have this number of grounds and primary references, particularly where, as here, the challenged patent has a substantial number of claims and there is a dispute over the appropriate priority date.

PO first (incorrectly) argues that each of Grounds 1, 2, and 4 should be treated as separate grounds merely because they raise challenges under sections 102 and 103. But, PO's attorney argument is divorced from the substance of the grounds. The Petition explains that the section 102 and 103 analyses closely correspond such that they are readily addressed in conjunction with each other, stating "To the extent there is any question whether Archer anticipates any element of 1-5, 7-27, the element or claim would have been obvious based on Archer for substantially similar reasons." (Pet. at 27-28.) This format is proper and preferred because it streamlines the analysis for efficient use of the Board's resources. The same is true for Grounds 2 and 4, which raise section 102 and 103 challenges based on on-sale/public disclosure of UP-50 that closely corresponded to each other, e.g., section 103 might be triggered assuming that "UP-50 and UP-50 label are [deemed] separate prior art references." (See Pet. at 48 (Ground 2) ("To the extent any element is not disclosed by UP-50 alone and/or together with its label, it would have been strongly suggested to a POSA for the same reasons discussed in Ground 2 below for that element.")); *see also id.* at

60 (involving a similar, close correlation between the section 102 and 103 analyses, tied to the on sale/public use of UP-50, but with a different priority date) (“UP-50, offered for sale in the BDES Agreement, is the same UP-50 described above in IX.B.1-20.”.) As shown in the Petition, the section 102 and 103 grounds therefore have a high degree of correspondence and cannot be said to require a high degree of independent analysis such that they should be treated as multiple grounds.

PO’s argument also fails to acknowledge that Grounds 1-3 apply only if the ’716 patent is *not* entitled to the August 5, 2021 priority date of its provisional application. (Pet. at 11 (Archer), Pet. at 12 (UP-50/UP-50 Label).) Petitioners’ effort to address the issue of priority in a single petition is directly in line with recent guidance from the Office and efficient use of Office resources. *PacifiCorp d/b/a Rocky Mountain Power et al v. Birchtech Corp. f/k/a Midwest Energy Emissions Corp.*, IPR Nos. 2025-00687, -00688, -00717, -00718, Paper 40 at 3-4 (PTAB Jan. 12, 2026) (expressing preference for one petition where Petitioner filed two petitions under two different potential priority dates because “this was not a ‘rare’ circumstance that justified the filing of multiple petitions”)(precedential).

PO also argues that Grounds 1, 2, 4, and 7 are somehow “unfocused” because they are directed to the same subset of eleven claims (1-5, 7-10, 12, and 26). (Req. at 19-20 (citing *Zhuhai Cosmc Battery Co., Ltd. v. Ningde Ampere Technology Ltd.*, IPR2025-00405, Paper 24 at 2 (Director Oct. 15, 2025).) This is incorrect, and

Zhuhai is readily distinguishable. In *Zhuhai*, the petition asserted “at least fifteen grounds” and relied on a confusing table to present a matrix of grounds. *Zhuhai*, IPR2025-00405, Paper 24 at 2-3. The present Petition presents far fewer grounds and does not include the objectionable table/matrix approach that rendered the petition in *Zhuhai* grounds “unfocused.” (Pet. at 3-4.) Further, in *Zhuhai*, there was no issue with priority date (which necessarily presents an issue of overlapping claims based on different primary references). Lastly, unlike Ground 4, Ground 2 challenges claims 11, 14-16, and 20-26 under §102. This difference is significant because the UP-50/UP-50 label (Ground 2) discloses matters that are not asserted to be disclosed under §102 by the BDES Agreement reference (Ground 4).

PO has failed to show that the asserted grounds are somehow improper or “unfocused.” To the contrary, the asserted grounds rely on only four primary references to efficiently show that the challenged claims are invalid even if PO was entitled to its earliest possible effective filing date.

III. CONCLUSION

For the reasons presented above, Petitioner respectfully submits that PO’s request should be denied and the Petition should go forward on the merits.

Dated: July 2, 2026

Respectfully submitted,

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PETITIONER'S UPDATED EXHIBIT LIST

Pursuant to 37 C.F.R. 42.63(e), Petitioner hereby submits the following Petitioner's Updated Exhibit List with its Opposition to Patent Owner's Request for Discretionary Denial of Institution:

No.	Reference	Referred to As
1001	U.S. Patent No. 12,370,716	'716 Patent
1002	Declaration of Dennis Morgan	Morgan Declaration
1003	Curriculum Vitae of Dennis Morgan	Morgan CV
1004	Certified File History of U.S. Patent No. 12,370,716	'716 Pat. Hist.
1005	U.S. Provisional Application No. 63/229,817, filed on August 5, 2021	'817 provisional application
1006	PCT/US2022/074619, filed on August 5, 2022	PCT '619 application
1007	PCT application no. WO2023/096905, filed on November 22, 2022, published on June 1, 2023	PCT '905 application or "Archer"
1008	PCT U.S. national stage Application No. US18/294,852 (U.S. national stage application of the PCT '619 application, filed on August 5, 2022.), published on October 17, 2024	'852 application
1009	U.S. Application No. US19/072,608, filed on March 6, 2025, which is a continuation of a PCT U.S. national stage application No. 18/294,852	'608 application

No.	Reference	Referred to As
1010	U.S. Provisional Application No. 63/282,794, filed on November 24, 2021	'794 provisional application
1011	Declaration of Kevin Archer	Archer Declaration
1012	UP-50 Internal Manufacturing Specification	UP-50 manufacturing document
1013	UP-50 Environmental Protection Agency ("EPA") Approval Letter	EPA Approval Letter
1014	UP-50 Wood Preservative Concentrate Product Label	UP-50 Label
1015	U.S. Patent No. 4,143,010, filed March 27, 1978, granted March 6, 1979	'010 patent or "Rak"
1016	U.S. Application No. 11/222,552, filed on September 9, 2005 and published as U.S. 2006/0057300, on March 16, 2006	'300 publication or "Cui"
1017	U.S. Application No. 11/408,425, filed on April 21, 2006 and published as US2006/0240263 on October 26, 2006	'263 publication or "Ashmore '263"
1018	Declaration of Barbara Aldinger	Aldinger Declaration
1019	U.S. Application No. 11/656,100, filed on January 22, 2007 and published as US2007/0175360 on August 2, 2007	'360 publication or "Ashmore '360"

No.	Reference	Referred to As
1020	U.S. Application No. 12/087,106, filed on January 29, 2007 and published as US 2009/0004497 on January 1, 2009	'497 publication or "Blow"
1021	U.S. Application No. 16/497,089, filed on March 29, 2018 and published as U.S. 2021/0112812 on April 22, 2021	'812 publication or "Arumugam"
1022	Letter filed to the Washington Department of Ecology dated January 16, 2020	Customer Letter
1023	EPA Pentachlorophenol Final Registration Review Decision, Case Number 2505, dated December 2021	EPA Final Decision
1024	UP-50 Solubility Report, Received December 1, 2025	UP-50 Solubility Report
1025	Proposed Modified Protective Order	Proposed Modified Protective Order
1026	Proposed Modified Protective Order showing redlines made to the Default Protective Order	Redline Proposed Modified Protective Order
1027	Business Development and Exclusive Supply Agreement dated February 5, 2021	BDES Agreement
1028	AWPA 114 th Annual meeting paper, copyright 2018	AWPA paper
1029	2019 AWPA Book of Standards, P39-18 Standard (p.139)	P39-18
1030	2019 AWPA Book of Standards, HSA-18 Standard (p.161)	HSA-18

No.	Reference	Referred to As
1031	Purchase order from Viance to toll manufacturer dated 04/19/2022 for first sale of UP-50	04/19/2022 Purchase Order from Viance to Toll Manufacturer
1032	Purchase order from customer to Viance dated 05/18/2022 for first sale of UP-50	05/18/2022 Customer Purchase Order
1033	Bill of Lading dated 05/27/2022 for first sale of UP-50	05/27/2022 Bill of Lading
1034	Invoice from Viance to customer dated 06/29/2022 for third sale of UP-50	06/29/2022 Invoice to Customer
1035	Sales Order Acknowledgement from toll manufacturer to Viance dated 06/29/2022 for third sale of UP-50	06/29/2022 Sales Order Acknowledgement
1036	Shipping invoice from shipping company to Viance dated 06/29/2022 for third sale of UP-50	06/29/2022 Shipping Invoice
1037	Bill of Lading dated 06/29/2022 for third sale of UP-50	06/29/2022 Bill of Lading
1038	Invoice from Viance to customer dated 07/07/2022 for third sale of UP-50	07/07/2022 Invoice to Customer
1039	Corrected Invoice from Viance to customer dated 07/07/2022 for third sale of UP-50	07/07/2022 Corrected Invoice to Customer
1040	Fuels and Lubricants Handbook: Technology, Properties, Performance, and Testing; Ch. 19 "Petroleum Waxes", Mansoori, et al.	Petroleum Waxes
1041	Fischer-Tropsch Wax Safety Data Sheet	F-T SDS
1042	Microcrystalline Wax Safety Data Sheet	Microcrystalline SDS
1043	Diesel Fuel SDS	Diesel SDS

No.	Reference	Referred to As
1044	Biodiesel SDS	Biodiesel SDS
1045	Invoice from toll manufacturer to Viance dated 05/20/2022 for first sale of UP-50	05/20/2022 Toll Manufacturer Invoice
1046	Purchase order from Customer to Viance dated 05/20/2022 for second sale of UP-50	05/20/2022 Customer Purchase Order
1047	Invoice from toll manufacturer to Viance dated 06/24/2022 for second sale of UP-50	06/24/2022 Toll Manufacturer Invoice
1048	Invoice from shipping company to Viance dated 07/06/2022 for second sale of UP-50	07/06/2022 Shipping Invoice
1049	Bill of lading dated 06/24/2022 for second sale of UP-50	06/24/2022 Bill of Lading
1050	Sales order dated 06/20/2022 for third sale of UP-50	06/20/2022 Customer Order
1051	Invoice from toll manufacturer to Viance dated 06/29/2022 for third sale of UP-50	06/29/2022 Toll Manufacturer Invoice
1052	Email with customer order dated 07/26/2022 for fourth sale of UP-50	07/26/2022 Order Email from Customer
1053	Sales order dated 07/26/2022 for fourth sale of UP-50	07/26/2022 Customer Order
1054	Invoice from toll manufacturer to Viance dated 08/05/2022 for fourth sale of UP-50	08/05/2022 Toll Manufacturer Invoice
1055	Bill of Lading dated 08/05/2022 for fourth sale of UP-50	08/05/2022 Bill of Lading
1056	Invoice from shipping company to Viance dated 08/24/2022 for fourth sale of UP-50	08/24/2022 Shipping Invoice
1057	Purchase order from Viance to toll manufacturer dated 05/12/2022 for second sale of UP-50	05/12/2022 Invoice from Viance to Toll Manufacturer

No.	Reference	Referred to As
1058	Email with customer order dated 06/17/2022 for third sale of UP-50	06/17/2022 Order Email from Customer
1059	Invoice from Viance to customer dated 05/27/2022 for first sale of UP-50	05/27/2022 Invoice to Customer
1060	Invoice from Viance to customer dated 06/24/2022 for second sale of UP-50	06/24/2022 Invoice to Customer
1061	Invoice from Viance to customer dated 08/05/2022 for fourth sale of UP-50	08/05/2022 Invoice to Customer
1062	Invoice from shipping company to Viance dated 06/08/2022 for first sale of UP-50	06/08/2022 Shipping Invoice
1063	Correlation Between the Composition and Flash Point of Diesel-Biodiesel Blends	de Mattos
1064	HCS 25 Treating Oil SDS, Prepared January 3, 2014; Revised on January 15, 2015	HCS 25 Treating Oil SDS
1065	Invoice for HCS 25 Treating Oil Dated January 10, 2014	01/10/2014 Invoice for HCS 25 Treating Oil
1066	Invoice for HCS 25 Treating Oil Dated April 28, 2014	04/28/2014 Invoice for HCS 25 Treating Oil
1067	Gardner's Commercially Important Chemicals Synonyms, Trade Names and Properties	Gardner's Commercially Important Chemicals
1068	Paraffin solubility curves of diesel fuels from thermodynamic model adjusted through experimental DSC thermograms, Fuel, Carmo, Rafael et al. (2018)	Paraffin Solubility Curves of Diesel Fuel
1069	Wood Treatment Plant Had a Clean Operating Record, Nevada Appeal, January 31, 2002	Wood Treatment Plant Fire Article

No.	Reference	Referred to As
1070	Evaluation report titled “DCOI Treatment Analysis – UP50 Treatment 1, 2, 3 and 4” and dated December 3, 2020	12/03/2020 UP-50 Report
1071	Evaluation report titled “DCOI - UP50” and dated January 7, 2021	01/07/2021 UP-50 Report
1072	Evaluation report titled “DCOI Summary Report” dated April 15, 2021	04/15/2021 UP-50 Report
1073	Presentation titled “DCOI Treatments Summary” dated May 2, 2021	05/02/2021 Presentation
1074	Presentation titled “Quick DCOI Summary” dated December 23, 2020	12/23/2020 Presentation
1075	Cover letter submitted to the Environmental Protection Agency for registration of UP-50 and proposed label, dated February 28, 2021	EPA Proposed Label
1076	Presentation summarizing evaluations of UP-50 dated September 28, 2020	09/28/2020 Presentation
1077	Document summarizing evaluations of UP-50 dated September 28, 2020	09/28/2020 UP-50 Report
1078	Environmentally friendly properties of vegetable oil methyl esters	Gateau
1079	Business Development and Exclusive Supply Agreement dated October 16, 2018 with amendments	10/16/2018 Agreement with Amendments
1080	UP-23 Wood Preservative Concentrate Product Label	UP-23 Label
1081	July 15, 2022 and July 26, 2022 emails reporting transition to UP-50	Emails regarding transition to UP-50
1082	June 10, 2022 timeline for transitioning to UP-50	06/10/2022 UP-50 transition timeline report
1083	Records of UP-50 treatments conducted from June 29, 2022 to July 2, 2022	06/29/2022-07/02/2022 Treatment Records

No.	Reference	Referred to As
1084	July 29, 2022 Invoice from Viance's Customer to Third-Party	06/29/2022 First Invoice from Viance's Customer to Third-Party
1085	July 29, 2022 Invoice from Viance's Customer to Third-Party	06/29/2022 Second Invoice from Viance's Customer to Third-Party
1086	Records of UP-50 treatments conducted from June 19, 2022 to August 4, 2022	06/19/2022-08/04/2022 Treatment Records
1087	Declaration by Viance's Customer	Customer Declaration
1088	Amended and Restated Limited Liability Company Agreement, dated January 2, 2007	LLC Agreement
1089	Customer Toll Manufacturing Agreement executed December 2021	Customer Tolling Agreement
1090	Second Customer Toll Manufacturing Agreement executed September 2023	Second Customer Tolling Agreement
1091	Declaration of Jonathan Moyes	Moyes Decl.
1092	12/09/2025 Letter from Koppers Performance Chemicals to Viance LLC	12/09/20025 Letter
1093	Subsidiary vs. Affiliate: Key Differences Explained, The Investopedia Team, available at https://www.investopedia.com/ask/answers/06/subsidiaries.asp	Subsidiary v. Affiliate Article
1094	Declaration of John Husa	Husa Decl.

CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that the foregoing Petitioner's Corrected Opposition to Patent Owner's Request for Discretionary Denial of Institution complies with the 20-page limit set forth by the Interim Director Discretionary Process webpage, which is available at <https://www.uspto.gov/patents/ptab/interim-directordiscretionary-process>. This page count does not include the items excluded by 37 C.F.R. § 42.24 as not counting towards the page limit.

Date: July 2, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that the foregoing Petitioner's Corrected Opposition to Patent Owner's Request for Discretionary Denial of Institution was served on July 2, 2026, via Electronic Mail on the Patent Owner's lead and backup counsel at the following addresses of record:

Robert R. Riddle (Reg. No. 69,599)
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