

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAYER CROPSCIENCE LP,
Petitioner,

v.

SYNGENTA LIMITED,
Patent Owner.

Case IPR2017-01332
Patent 8,404,618 B2

Before ZHENYU YANG, CHRISTOPHER G. PAULRAJ, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

DECISION ON PETITIONER'S REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

Bayer Crop Science LP (“Petitioner”) requests a rehearing (Paper 12, “Reh’g Req.” or “Rehearing Request”), under 37 C.F.R. § 42.71(c) of our Decision Denying Institution (Paper 10, “Dec. Den’g Inst.”). Pursuant to our authorization, Sygenta Limited (“Patent Owner”) filed an Opposition to the Rehearing Request (Paper 13, “Opp’n” or “Opposition”) and Petitioner filed a Reply to Patent Owner’s Opposition (Paper 14, “Reply”).

In our Decision Denying Institution, we determined “Petitioner . . . has not shown that a skilled artisan would have understood or recognized KIH-485 [as identified in the prior art Polge and Owen references] as the claimed herbicide prior to the filing date of the ’618 patent.” Dec. Den’g Inst. 10. On that basis, we denied institution as to each of the grounds of unpatentability set forth in the Petition, which relied upon either Polge or Owen. *Id.* at 10–11.

Petitioner requests reconsideration for two reasons. First, Petitioner contends that we “erroneously applied settled law regarding use of post-filing evidence to establish a fact or characteristic about a product in the prior art to support anticipation and nonobviousness” insofar as “[t]here is no requirement that the chemical structure of a known prior art compound must be recognized to anticipate or render obvious later claims to the structure.” Reh’g Req. 1. Second, Petitioner contends that we “failed to appreciate that the combination of Takahashi with any one of the safer references in Grounds 3a-3i discloses all the limitations of the claims and motivates their combination, even without the Owen reference.” *Id.*

II. ANALYSIS

A. Standard of Review

When rehearing a decision on petition, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). “An abuse of discretion occurs if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors.” *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). The party requesting rehearing bears the burden of showing an abuse of discretion, and “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked.” 37 C.F.R. § 42.71(d).

B. Whether We Erred in Our Consideration of Post-Filing Evidence

As its first basis of alleged error, Petitioner contends that we misapprehended and misapplied the law regarding the use of post-filing evidence to establish a fact about the prior art. Reh’g Req. 3–10. The Petition cites Exhibit 1025 to establish that the compound called “KIH-485” in the prior art disclosures of Polge and Owen has a specific chemical structure that meets the claim requirements. *See* Pet. 29, 31. As noted in our Decision Denying Institution, however, Exhibit 1025 does not appear to have been published until well after the priority date claimed for the ’618 patent, and we therefore declined to rely upon its teaching to support Petitioner’s contention that the “KIH-485” referenced in Polge and Owen fell within the scope of the claimed compound. Dec. Den’g Inst, 9–10. Petitioner contends that its reliance upon Exhibit 1025 is “legally sound” because “[i]t is well-established that evidence as to the identity or structure of a molecule can be used even if the evidence arose after the filing date of

the patent.” Reh’g Req. 4 (citing *In re Wilson*, 311 F.2d 266, 268–269 (CCPA 1962); *In re Hogan*, 559 F.2d 595, 605 (CCPA 1977); *Schering Corp. v. Geneva Pharm. Inc.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003)).

We are not persuaded that we committed legal error based on the cited case law. The court cases cited by Petitioner primarily concern later discovered, but inherent, properties or characteristics of a claimed product that was otherwise previously known in the prior art. In *Wilson*, the court found that it was appropriate to rely upon post-filing evidence to show that polyurethane foam products made using processes known in the prior art had an open cell structure as claimed. 311 F.2d at 268. In *Hogan*, the court (in the context of addressing an enablement rejection) stated that it “has approved use of later publications as evidence of the state of art existing on the filing date of an application,” but “[t]hat approval does not extend . . . to the use of a later . . . publication disclosing a later . . . existing state of the art in testing an earlier . . . application for compliance with § 112, first paragraph.: 559 F.2d at 605. In *Schering Corp.*, the court “reject[ed] the contention that inherent anticipation requires recognition in the prior art,” noting that “a prior art reference may anticipate without disclosing a feature of the claimed invention if that missing characteristic is necessarily present, or inherent, in the single anticipating reference.” 339 F.3d at 1377. In that case, the court found that claims directed to the metabolite DCL were anticipated by prior art teaching loratidine where “[t]he record shows that DCL necessarily and inevitably forms from loratidine under normal conditions,” i.e., “DCL is a necessary consequence of administering loratidine to patients.” *Id.* at 1378. There is no support in these cases for Petitioner’s contention that the very “identity” or “structure” of a claimed

compound that was only known in the prior art by an experimental code name can be established using post-filing evidence in order to support a conclusion of anticipation¹ or obviousness.

Here, the '618 patent does not merely claim inherent properties or characteristics of a compound that was publicly known or generally accessible to any person of ordinary skill in the art. Rather, the Polge and Owen references relied upon by Petitioner only refer to a compound designated "KIH-485," and it is undisputed that this experimental code name did not provide any information about the chemical structure, chemical formula, or other proprietary information about the compound before the filing date of the '618 patent. Ex. 1040, 34; Ex. 2001 ¶ 27. Furthermore, we agree with Patent Owner that "[a] code name like KIH-485 could be applied to any chemical structure and could change over time." Opp'n 2-3. In this regard, we note that Polge refers to "KIH-485" as an "acetamide" (Ex. 1008,

¹ The Petition only sets forth anticipation challenges based on the Polge patent and Polge publication, which have the same disclosure (collectively, "Polge"). Pet. 2. Polge identifies "KIH-485" as an "acetamide" that may be selected from a group of 11 herbicides. Ex. 1008, 4:53-58. Polge further identifies "suitable safeners" that may be included in a synergistic composition with any of those herbicides, among which are identified some of the safeners recited in claim 1 of the '618 patent. *Id.* at 4:64-5:2. Given the need to pick and choose among various herbicides and safeners based on the Polge disclosure to arrive at the claimed composition, we are not persuaded that Polge would be considered an anticipating reference even assuming *arguendo* that Petitioner properly establishes "KIH-485" as the claimed herbicide. See *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1369 n.5 (Fed. Cir. 2008) ("[I]t is not enough that the prior art reference discloses part of the claimed invention, which an ordinary artisan might supplement to make the whole, or that it includes multiple, distinct teachings that the artisan might somehow combine to achieve the claimed invention.").

col. 2 ll. 11–15), which the undisputed record shows is different in structure from the pyroxasulfone compound that is disclosed and claimed in the '618 patent and later identified as “KIH-485” in Exhibit 1025. Ex. 2001 ¶¶ 43–46.

C. Whether We Erred in Failing to Consider the Teachings of Takahashi in Combination with Any One of the “Safener References”

As its second basis of alleged error, Petitioner contends that Takahashi in combination with any one of the “safener references” disclose all claim elements even without reliance upon Owen’s teachings concerning “KIH-485.” Reh’g Req. 10–15. As we noted in our Decision Denying Institution, Petitioner expressly relied upon Owen’s teachings concerning “KIH-485” to support its obviousness challenges set forth in Grounds 3(a–i). Dec. Den’g Inst. 10. A request for rehearing is not an opportunity for Petitioner to change the grounds of unpatentability stated in the Petition.

III. CONCLUSION

Upon reconsideration of the record, we are not persuaded that we erred in our Decision Denying Institution. Accordingly, we deny the Rehearing Request.

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