

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ADAMA MAKHTESHIM LTD.,
Petitioner,

v.

FINCHIMICA S.P.A.,
Patent Owner.

Case IPR2016-00577
Patent 8,304,559 B2

Held: February 14, 2017

BEFORE: RICHARD E. SCHAFER, SALLY GARDNER
LANE, and DEBORAH KATZ, Administrative Patent Judges.

The above-entitled matter came on for hearing on Tuesday,
February 14, 2017, commencing at 10:02 a.m., at the U.S.
Patent and Trademark Office, 600 Dulany Street, Alexandria,
Virginia.

Case IPR2016-00577
Patent 8,304,559 B2

APPEARANCES:

ON BEHALF OF THE PETITIONER:

GARY J. GERSHIK, ESQUIRE
ERIC EISENBERG, ESQUIRE
Cooper & Dunham LLP
30 Rockefeller Plaza, 20th Floor
New York, New York 10112

ON BEHALF OF PATENT OWNER:

E. ANTHONY FIGG, ESQUIRE
SETH E. COCKRUM, Ph.D.
Rothwell Figg
607 14th Street, N.W.
Suite 800
Washington, D.C. 20005

1 P R O C E E D I N G S

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3 JUDGE LANE: Okay. Good morning again. Can I
4 find out who we have here for Petitioner?

5 MR. GERSHIK: Your Honor, Gary Gershik for
6 Petitioner.

7 JUDGE LANE: And who do you have with you?

8 MR. GERSHIK: Eric Eisenberg, an associate. We're
9 both from the firm of Cooper & Dunham.

10 JUDGE LANE: Okay. Thank you. And for Patent
11 Owner?

12 MR. FIGG: Good morning, Your Honor. Tony Figg
13 for the Patent Owner. With me is Seth Cockrum. We're both for
14 Finchimica.

15 JUDGE LANE: Okay. Good morning.

16 So I believe in the order we said that each side would
17 have 20 minutes -- I'm sorry, 30 minutes and each side may
18 reserve time for rebuttal. So we'll start with Petitioner and do you
19 have any demonstratives?

20 MR. GERSHIK: Yes, we do. Can we hand you some?
21 They're also going to be on the screen.

22 JUDGE LANE: Okay. And I know that you filed
23 them --

1 MR. GERSHIK: And we filed them as well, but we can
2 hand you hard copies.

3 JUDGE LANE: Great. Thank you.

4 Would you like to reserve some time for rebuttal?

5 MR. GERSHIK: Yes, Your Honor. I'd like to reserve
6 10 minutes, if I could, and speak for 20 minutes. I'll try to go
7 through this quickly.

8 JUDGE LANE: All right. So 20 minutes. Okay.

9 MR. GERSHIK: Good morning. We're here on behalf
10 of the Petitioner. The patent in question is the Finchimica '559
11 patent and I'll reply to -- is Claim 1 of the '559 patent together
12 with a simplified version of that claim.

13 Essentially the claim is to a method for the preparation
14 of fipronil through oxidation of the sulfide precursor of fipronil.
15 Fipronil is the sulfoxide, the oxidized version of that sulfide
16 precursor in the presence of DCA, dichloroacetic acid, and an
17 oxidizing agent, which is opened-ended as been construed by the
18 Decision Instituting Trial.

19 And there is a negative limitation in the Claim 1
20 wherein the oxidation is conducted in the absence of
21 trichloroacetic acid or TCA and/or -- and we'll be talking about
22 that term at some point -- and/or TCPA, trichloroperacetic acid,
23 which is the peroxide form, the oxidized form, if you will, of
24 TCA.

1 On to slide 3, slide 3 a claim element chart aligning the
2 claim elements with the references that we cited. Our primary
3 reference -- and I emphasize it's important here, the order of
4 references is important. Our primary reference is the European
5 patent, what we refer to as EP '117. That is our primary
6 reference.

7 In particular, although we cite the entire disclosure, in
8 particular we focused on Example 1. And if we align the
9 elements of Example 1 of the EP '117, we see that it is a method
10 that prepares fipronil. It does so through the oxidation of the
11 sulfide precursor of fipronil. It does so in the presence of a
12 compound called dichloromethane or DCM.

13 The oxidizing agent in that example is mCPBA,
14 meta-chloroperbenzoic acid, and it is conducted in the absence of
15 TCA and in the absence of TCPA. There's no mention of those
16 two elements. And so if you align these elements of Example 1
17 with the claim elements of Claim 1 -- and, by the way, Claim 1 is
18 the only claim at issue that Patent Owner has not argued for the
19 dependent claims in their Response.

20 If you align it, you'll see the only distinction between
21 Example 1 of the '117 and the Claim 1 is that Example 1 uses
22 DCM, whereas Claim 1 of the '559 requires DCA.

23 We've then cited another reference, the '440, WO '440
24 reference also known as the Gharda reference, and we've cited it
25 as a secondary reference to show the interchangeability of DCM

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