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Paper No. 30
Filed: May 11, 2017

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

Before RICHARD E. SCHAFER, SALLY GARDNER LANE, and DEBORAH KATZ, *Administrative Patent Judges.*

LANE, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Adama Makhteshim Ltd. ("Petitioner") filed a Petition (Paper 2, "Pet.") to institute an *inter partes* review of all claims, i.e., claims 1–12,[1] of U.S. Patent No. 8,304,559 B2 ("'559 patent," Ex. 1001) of Finchimica S.p.A. ("Patent Owner"). We instituted review concluding that Petitioner established a reasonable likelihood that it would prevail in an asserted ground of unpatentability of claims 1–12 of the '559 Patent. (Paper 7, "Decision Instituting Review"). 35 U.S.C. § 314(a). In particular we instituted review on the asserted ground, ground 1 of the Petition, that the claimed subject matter would have been obvious under U.S.C. § 103(a) over EP 0295117 B in view of WO 2007/122440 A1 and further in view of CN 101250158 A for claims 11 and 12 only. (Decision Instituting Review, 17).

Patent Owner filed a Patent Owner Response (Paper 19, "PO Resp.") and Petitioner filed a Reply to Patent Owner's Response (Paper 22, "Reply"). An oral hearing was held before the Board on February 14, 2017. (Paper 29, "Hearing Transcript").

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. Having considered the record before us, we conclude that Petitioner has shown by a preponderance of the evidence that claims 1–12 of the '559 patent are unpatentable. *See* 35 U.S.C. § 316(e).

B. Related Matters

The parties are involved in litigation[2] where the Patent Owner has alleged that the Petitioner infringed and will continue to infringe the '559

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[1] Patent Owner statutorily disclaimed claims 13–15 of the '559 patent so now the patent contains only claims 1–12. (Interference 105,995, Paper 26, Ex. 1025).

patent. (Pet., 2–3).

Interference 105,995, involving the '559 patent and Petitioner's U.S. patent application no. 13/926,389, was declared on February 6, 2014. (Interference 105,995, Paper 1, Ex. 1022, Declaration). In the interference, the Board entered judgment against junior party who is the Petitioner here. (Pet., 3 (indicating that Petitioner was a party in the interference) and Interference 105,995,[3] Paper 260, Judgment and Paper 259, Ex. 2002, Decision on Priority and Other Motions).[4]

An application for the reissue of the '559 patent is pending before the USPTO. The examination of this application remains suspended. (Reissue application 14/534,001, filed November 5, 2014, Paper entered March 23, 2016).

C. Evidence Relied Upon

Ground 1, upon which we instituted review, relies upon the following references:

European Patent 0295117 B ("EP '117") (Ex. 1002).

PCT International Publication WO 2007/122440 A1 ("Gharda") (Ex. 1004).

Chinese Patent Application Publication 101250158 A ("CN '158") (Ex. 1003).

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[3] The interference is styled ANAT LEVIN and MICHAEL GRABARNICK, Junior Party, (Application 13/926,389) [Petitioner] v. ANDREA PASTORIO and PAOLO BETTI Senior Party, (Patent 8,304,559) [Patent Owner].

[4] Petitioner requested rehearing of the Judgment and underlying Decision on Priority and Other Motions but the Judgment and Decision were not

Petitioner also relies on the declaration testimony of Dr. Gordon Gribble. ("Gribble Decl.," Ex. 1010). Based on his education and professional experience (*see* Gribble Decl. ¶¶ 1–3, and *curriculum vitae*, Ex. 1011), we find that Dr. Gribble is qualified to testify about issues raised in this trial. Dr. Gribble was deposed by Patent Owner and a transcript of the deposition has been filed. ("Gribble Deposition," Ex. 2021).

Patent Owner relies on the declaration of testimony of Dr. Dennis P. Curran. ("Curran Decl.," Ex. 2026). Based on his education and professional experience (*see* Curran Decl. ¶¶ 2–4, and *curriculum vitae*, Ex. 2020), we find that Dr. Curran is qualified to testify about issues raised in this trial. Dr. Curran was deposed by Petitioner and a transcript of the deposition has been filed. ("Curran Deposition," Ex. 1039).

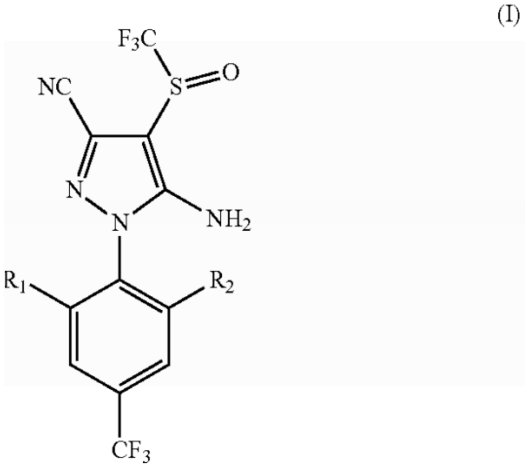
D. The '559 Patent Claims

The '559 claims are directed to a method of making the compounds of formula I, which includes a method of making the insecticidal compound fipronil.

Claim 1 of the '559 patent is the only independent claim. It reads:

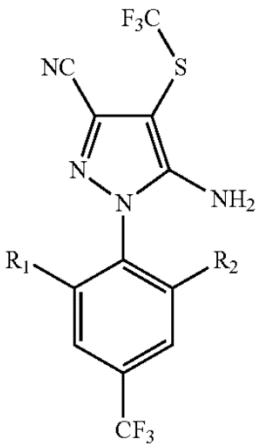
1. A method for the preparation of the compound having the following general formula (I):

(I)



wherein R1 and R2 are independently hydrogen or halogen; through oxidation of a compound having the general formula (II) in the presence of dichloroacetic acid and of an oxidising agent:

(II)



wherein R1 and R2 are defined as above, where the oxidising agent is selected from the group comprising benzoyl peroxides, sodium peroxides, t-butyl peroxides and/or hydrogen peroxide, and wherein the oxidation is conducted in the absence of trichloroacetic and/or trichloroperacetic acid.

('559 patent, Ex. 1001, 9:2–46).

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