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Paper No. 17
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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*.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(a)

I. Introduction

The Board ordered institution of *inter partes* review of claims 1–12 of Patent 8,304,559 ('559) on Petitioner's asserted ground 1 that these claims are unpatentable under 35 U.S.C. § 103(a) as obvious over EP 0295117 B ('EP 117) in view of WO 2007/122440 A1 (Gharda) and further in view of CN 101250158 A (CN '158) for claims 11 and 12 only. We did not institute on the other grounds asserted by Petitioner, i.e., grounds 2-4. (Paper 7, Decision, entered 24 May 2016, at 17).

Patent Owner requested "partial rehearing" of the Decision. (Paper 9, Patent Owner Request, at 1). We considered the Patent Owner Request but did not modify the Decision. (Paper 11, Decision on Rehearing, at 6).

Petitioner too has requested "partial rehearing" of the Decision. (Paper 10, Petitioner Request). In the Petitioner Request, Petitioner asks that we modify the Decision and also institute *inter partes* review of claims 1–12 of the '559 patent on the basis of ground 3 raised in its petition, i.e., on the basis that claims 1–12 of the '559 Patent are unpatentable under 35 U.S.C. § 103(a) as obvious over EP '117 in view of US Patent 6,013,761 (Zierer), and further in view of CN '158 for claims 11 and 12 only. (Petitioner Request at 1). We have considered the Petitioner Request as further discussed below but do not modify the Decision at this time. Upon review of other briefing yet to be filed, including any Patent Owner Response, we may revisit the Petitioner Request if it becomes necessary and appropriate to do so.

II. Background

In our Decision, we noted Petitioner's indication that the ground 3 challenge relied on the Board accepting the construction of "in the presence of [DCA]" that was advanced by Patent Owner in Interference 105,995, an interference that involved the same parties. In the interference, Patent

Owner urged a claim construction that would require that DCA, in combination with an oxidizing agent such as hydrogen peroxide, reacts to form the oxidizing agent dichloroperacetic acid (DCPA) which in turn acts as an oxidant for the conversion of the compound of formula II to fipronil. (Paper 2, Pet., at 13, citing, e.g., Interference 105,995, Paper 227 (Ex 1035), Levin Opposition 4 at 4:5–5:8). In the Interference, the construction advanced by Patent Owner was not accepted by the Board. (Interference 105,995, Paper 259 (Ex 2002), Decision on Priority and Other Motions at 16 and Paper 271, Decision on Rehearing at 3–4).

We stated in the Decision that "[w]e do not accept the construction urged by Patent Owner during the 105,995 Interference and instead conclude, consistent with our decision in the interference, that the claims do not require that DCA perform any particular function. (Decision at 16, citing to Interference 105,995, Paper 259 (Ex. 2002), Decision on Priority and Other Motions at 16 and Paper 271, Decision on Rehearing, at 3–4). We noted that "[t]his third ground only adds to ground 1 if the Board accepts the construction urged by Patent Owner during the Interference [and that] [a]s we do not accept this construction, we determine that ground 3 is unnecessary and redundant to ground 1." (Decision at 16-17).

In its Request, Petitioner notes that the Decision states that the Board has "not yet made a final determination of . . . the construction of any claim term" and that "Patent Owner has not yet indicated that it will not argue against the construction of 'in the presence of [DCA]' used by the Board in the Decision". Thus, Petitioner argues, the Board should proceed with ground 3 since a final claim construction that is contrary to the non-final construction set forth in the Decision may result in ground 3 no longer being unnecessary and redundant to ground 1. (Petitioner Request at 3-4, citing to Decision at 17:6-7).

overlooked the possibility of later changes to the claim construction, and/or the prejudice to Petitioner if such changes occur" citing *Cuozzo Speed Technologies, LLC v. Lee*, 136 S.Ct. 890 (Jan. 15, 2016) (granting certiorari as to whether "the Board may construe claims in an issued patent according to their broadest reasonable interpretation rather than their plain and ordinary meaning"). (Petitioner Request at 5-6).

III. Discussion

As Petitioner points out the claim construction set forth in the Decision was not a final determination by the Board. If the Patent Owner, in its Response or other briefing, argues for the claim construction it urged in Interference 105,995 for "in the presence of [DCA]" and if the Board, contrary to the conclusion reached in the interference, accepts the Patent Owner's construction, then there may be a need to revisit whether we also should institute *inter partes* review of claims 1-12 of the '559 patent on the basis of ground 3. Accordingly, while we do not modify our Decision at this time by instituting review on the basis of ground 3, we may do so later if our final conclusions regarding claim construction make it necessary and appropriate to do so.

Petitioner's argument regarding a possible change in the claim construction standard is not persuasive. Subsequent to the Petitioner Request the propriety of the claim construction standard used in the Decision, i.e., the broadest reasonable construction standard, was confirmed by the Supreme Court. *Cuozzo Speed Technologies, LLC v. Lee*, 136 S.Ct. 2131, 2144-2145 (2016).

IV. Order

It is

ORDERED that the Decision instituting *inter partes* review of claims 1-12 of Patent 8,304,559 B2 (Paper 7, Decision) is not modified at this time.

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