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Paper 20
Entered: September 16, 2016

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*.

ORDER – CONDUCT OF THE PROCEEDING - 37 CFR 42.5(a)

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On 13 September 2016 Petitioner contacted the Board via email communication "to request that the Board revisit Petitioner's Request for Partial Rehearing ([Petitioner rehearing request] Paper No. 10), in which Petitioner requested that the Board also institute the IPR on Ground 3 of the Petition." The email addressed substantively the Petitioner's position that the Board should revisit the Petitioner rehearing request. Thereafter, on 14 September 2016, Patent Owner responded via email communication and addressed substantively its position that the Board should not revisit the Petitioner rehearing request. Each party indicated that it was available for a conference call if needed. (See attached email communication).

A decision on the Petitioner rehearing request was entered on 22 July 2016 (Decision on Petitioner rehearing request, Paper 17). In that decision, we declined to modify our decision instituting *inter partes* review (Decision instituting review, Paper 7) but indicated that "we may do so later if our final conclusions regarding claim construction make it necessary and appropriate to do so". (Decision on Petitioner rehearing request, Paper 17, at 4). Petitioner was not invited or otherwise authorized to file a paper requesting that we revisit our Decision on Petitioner rehearing request. To the extent Petitioner is requesting authorization to file such a paper that request is DENIED.

The 13 September 2016 email communication from Petitioner amounts to an unauthorized supplemental or additional rehearing request. The 14 September 2016 email communication from Patent Owner amount to an unauthorized response thereto. Such unauthorized papers will not be considered by the Board.

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Order

It is

ORDERED that the emails discussed herein are made of record as an attachment to this Order but the substantive arguments made in these emails have not been, and will not be, considered by the Board, and

FURTHER ORDERED that Petitioner is not authorized to file a paper requesting that the Board revisit its Decision on Petitioner rehearing request.

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PETITIONER:

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PATENT OWNER:

Edward Figg
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From:	Interference Trial Section
To:	Lane, Sally; Interference Trial Section; Wilburn, Althea
Subject:	RE: attachment for order in IPR2016-00577
Date:	Friday, September 16, 2016 11:12:19 AM

Attachment to order.

Thanks
Eric

From: Lane, Sally
Sent: Friday, September 16, 2016 10:58 AM
To: Interference Trial Section <InterferenceTrialSection@USPTO.GOV>
Subject: attachment for order in IPR2016-00577

From: Erik van Leeuwen [mailto:evanlee@rothwellfigg.com]
Sent: Wednesday, September 14, 2016 10:40 AM
To: Trials <Trials@USPTO.GOV>
Cc: E. Anthony Figg <efigg@rothwellfigg.com>; Danny Huntington <dhuntington@rothwellfigg.com>; Sharon Crane <scrane@rothwellfigg.com>; Derek F. Dahlgren <ddahlgren@rothwellfigg.com>; Seth E. Cockrum <scockrum@rothwellfigg.com>; 'ggershik@cooperdunham.com' <ggershik@cooperdunham.com>; 'nzivin@cooperdunham.com' <nzivin@cooperdunham.com>
Subject: RE: IPR2016-00577: Adama Makhteshim Ltd. (Petitioner) v. Finchimica S.P.A. (Patent Owner)

Your Honor:

The undersigned counsel for Patent Owner, Finchimica S.P.A., writes in response to Petitioner's second request for reconsideration. Patent Owner wishes to clarify various inaccuracies made by Petitioner regarding the arguments Patent Owner made in its recently filed response. (Paper No. 19).

Petitioner has taken portions of Patent Owner's response out of context to assert that Patent Owner is arguing against the Board's construction of "in the presence of [DCA]" and is seeking to import limitations regarding the functionality of DCA from the specification to the claims. But Patent Owner has done no such thing. Indeed, Patent Owner acknowledged the Board's construction that "the claims do not require that DCA perform any particular function," and did not challenge it as evidenced by its statement, "it is true that the 559 patent claims are not limited to a particular theory of operation…" (Paper No. 19, p. 22, ll. 13-16). Accordingly, Patent Owner has not contested the Board's construction, and there is no need for the Board to revisit again its institution decision denying Ground 3.

Ground 3 was predicated on the Board's acceptance of the "construction of the term 'in the presence of [DCA]' that was advanced by Patent Owner in Interference No. 105,995." (Paper No. 2, p. 43). Patent Owner's proposed construction in the interference "would require DCA in combination with an oxidizing agent such as hydrogen peroxide to react to form the oxidizing agent [DCPA] which in turn acts as an oxidant for the conversion of the compound

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