

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ROQUETTE FRERES, S.A.,  
Petitioner,

v.

TATE & LYLE INGREDIENTS AMERICAS LLC,  
Patent Owner.

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Case IPR2017-01506  
Patent 7,608,436 B2

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Before LORA M. GREEN, GRACE KARAFFA OBERMANN,  
and JACQUELINE T. HARLOW, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER  
*Conduct of the Proceeding*  
37 C.F.R. §§ 42.5

## DISCUSSION

On April 24, 2018, the Supreme Court held that, in a decision to institute an *inter partes* review under 35 U.S.C. § 314, the Board is not authorized to order a trial to proceed on fewer than all claims challenged in a petition. *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at \*10 (U.S. Apr. 24, 2018). In our institution decision, we determined that Petitioner demonstrated a reasonable likelihood that it would establish that at least one of the challenged claims of the U.S. Patent 7,608,436 is unpatentable. Paper 18, 2, 9–10, 13–14. We modify our institution decision to institute on all claims challenged and all grounds presented in the Petition.

The introduction of newly instituted claims and grounds at this stage of the proceeding presents two issues. The first pertains to the impact of the refund approval entered on April 5, 2018. *See* Paper 28 (request for refund); Paper 29 (notice of refund approval). The second relates to whether a conference call is necessary to discuss any need for additional briefing or a schedule change that cannot be accomplished by stipulation. *See* Paper 19, 2 (scheduling order, authorizing parties to stipulate to schedule changes for Due Dates 1 through 5 (earlier or later, but no later than Due Date 6)). We address each issue in turn below.

### *A. Impact of the Refund Request and Approval*

Petitioner previously requested and received a refund of the post-institution fee paid in connection with 15 patent claims that were denied review in our institution decision. Paper 28 (request for refund); Paper 29 (notice of approval of refund). We, hereby, institute review of all claims challenged in the Petition. Accordingly, we require Petitioner to repay the post-institution fee that was refunded in the amount of \$6,000.00. Paper 28,

1 (requesting refund of “fee in the amount of \$6000”); Paper 29, 1 (notice of refund to Petitioner’s deposit account in “amount of \$6,000.00”).

Repayment of the refunded post-institution fee in the amount of \$6,000.00 is due within five (5) business days of the date of this Order. Given that our authority to institute review is limited to a “binary choice” between proceeding on all, or none, of the claims challenged in a petition, *SAS* at \*5, **if repayment of the refunded post-institution fee is not timely made, the Board shall terminate this proceeding in its entirety.**

*B. Invitation for Conference Call*

The parties shall confer to discuss the impact, if any, of this Order on the current schedule. If, after conferring, the parties wish to change the schedule (beyond that permitted by stipulation (Paper 19, 2)) or submit additional briefing directed to the newly instituted claims or grounds, the parties must, within one week of the date of this Order, request a conference call with the panel to seek authorization for such changes or briefing. If the parties do not request such a call, the parties waive any request for additional briefing on the newly instituted claims and grounds.

As an alternative, if repayment of the refunded post-institution fee in the amount of \$6,000.00 is timely made, the parties are authorized to file, within one week of the date of this Order, a Joint Motion to Limit the Petition to remove from dispute the patent claims and grounds of unpatentability newly instituted by this Order. *See, e.g., Apotex Inc., v. OSI Pharms., Inc.*, Case IPR2016-01284 (PTAB Apr. 3, 2017) (Paper 19) (granting, after institution, a joint motion to limit the petition by removing a patent claim that was included for trial in the institution decision).

ORDER

It is

ORDERED that our institution decision is modified to include review of all challenged claims and all grounds presented in the Petition;

FURTHER ORDERED that Petitioner is required to repay the refunded post-institution fee in the amount of \$6,000.00;

FURTHER ORDERED that repayment of the refunded post-institution fee is due within five (5) business days of the date this Order;

FURTHER ORDERED that, if repayment of the refunded post-institution fee is not timely made, this proceeding shall be terminated in its entirety;

FURTHER ORDERED that Petitioner and Patent Owner shall confer to determine whether they desire any changes to the schedule (that cannot be accomplished by authorized stipulation (Paper 19, 2)) or additional briefing, and, if so, shall request a conference call with the panel to seek authorization for such changes or briefing within one week of the date of this Order;

FURTHER ORDERED that, if repayment of the refunded post-institution fee is timely made, the parties are authorized to file, within one week of the date of this Order, a Joint Motion to Limit the Petition to remove from dispute the patent claims and grounds of unpatentability newly instituted by this Order.

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Patent 7,608,436 B2

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