

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROQUETTE FRERES, S.A.,
Petitioner,

v.

TATE & LYLE INGREDIENTS AMERICAS LLC,
Patent Owner.

Case IPR2017-01506
Patent 7,608,436 B2

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

OBERMANN, *Administrative Patent Judge*.

ORDER

Terminating and Dismissing the Proceeding
35 U.S.C. § 318(a); 37 C.F.R. § 42.72

On May 16, 2018, we directed Petitioner to repay a refund of the post-institution fee paid in connection with 15 patent claims, which were newly instituted by order. *See* Paper 32 (order entered May 16, 2018). We explained that “[r]epayment 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.” *Id.* at 3. Further, we placed Petitioner on express notice that, “**if repayment of the refunded post-institution fee is not timely made, the Board shall terminate this proceeding in its entirety.**” *Id.* (emphasis in original).

On May 23, 2018, the due date for repayment, Petitioner advised the Board that Petitioner “will not be repaying the previously-refunded portion of the post-institution fee.” Ex. 3002, 8 (email dated May 23, 2018, making reference to the order entered May 16, 2018). Petitioner purported to place conditions, relating to issues of estoppel, on its refusal to meet the repayment deadline, but those conditions are neither binding on the Board nor relevant to our analysis.¹ *Id.* at 7–11. Thereafter, on May 28, 2018, Patent Owner authorized the Board to charge Patent Owner’s deposit account “in the amount of \$6000” to cover “the portion of the post-institution fee previously refunded in this matter.” Paper 33, 1.

¹ In this proceeding, we have not, and will not, counsel the parties on the estoppel effects of any action taken by or before the Board, including the effects of, or validity of, Petitioner’s unilateral attempt to condition its failure to repay the refunded fee as directed in the order entered May 16, 2018. We leave all issues, surrounding any estoppel effects, to be resolved by a tribunal competent to decide them when raised and ripe for decision.

The Petition, at the time of filing, was accompanied by payment of the required fee. At this juncture, however, the Petition is defective as a result of Petitioner's failure to timely repay the portion of the fee that was refunded in connection with 15 patent claims. *See* Paper 32, 4 (order, requiring repayment within five (5) business days); Ex. 3002, 7–11 (email from Petitioner's counsel, expressly declining to repay the refunded fee within the time set by the Board for repayment and, further, informing the Board that Petitioner has no intention to repay the refunded fee). Under these particular facts and circumstances, termination of the proceeding is "appropriate." 37 C.F.R. § 42.72 ("[t]he Board may terminate a trial without rendering a final written decision, where appropriate").² Accordingly, effective this date, we hereby *terminate* and *dismiss* this proceeding pursuant to 37 C.F.R. § 42.72. *See* 35 U.S.C. § 318(a) ("[i]f an inter partes review is instituted and not dismissed" then the "Board shall issue a final written decision").

Accordingly, it is

ORDERED that, effective this date, the proceeding is hereby *terminated* and *dismissed*.

² We are not persuaded that the particular facts and circumstances presented here justify the unusual remedy of permitting Patent Owner to pay "the necessary post-institution fees" owed by Petitioner in order to facilitate proceeding to a final written decision over Petitioner's objections. Ex. 3002, 4; *see id.* at 9–10 (Petitioner's reasons for submitting to termination, in view of the Office's newly formulated "binary" institution framework and the burden and expense of presenting its case on the newly instituted claims and grounds within the time remaining in the schedule).

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