Trials@uspto.gov
571-272-7822

Paper No. 21
Entered: December 19, 2017

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*.

DECISION
Denying Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

On November 30, 2017, we entered a decision instituting trial on claims 1–4, 15–29, 31, and 32 of U.S. Patent No. 7,608,436 B2 ("the ''436 patent). Paper 18 ("Decision" or "Dec."). On December 14, 2017, Petitioner filed a Request for Rehearing of our Decision to the extent that we instituted trial on claim 4 of the '436 patent. Paper 20 ("Req. Reh'g").

Petitioner correctly observes that, concurrently with our Decision, we entered a separate decision in Case IPR2017-01507 ("IPR1507"), which denied institution of patent claims that state or incorporate a limitation that is similar to a limitation of claim 4 of the '436 patent, requiring a "slowly digestible" composition. Req. Reh'g 3 (citing IPR1507, Paper 21). Petitioner argues that "it is clear . . . that the Board overlooked the digestibility limitation in Claim 4 of the '436 patent" given that "no reference to digestibility is contained in the Decision. *Id*. at 3–4.

We did not overlook the digestibility limitation in claim 4. Nor did we overlook the decision that we entered concurrently in IPR1507. On the contrary, having determined that Petitioner met the threshold for review of claim 1 of the '436 patent (Dec. 10), we ordered (as permitted by our authorizing statute) "that trial shall proceed on all other claims challenged as anticipated" or obvious over Shah (Ex. 1008). *Id*. at 10 (citing 35 U.S.C. § 314(a)), 11 (for obviousness grounds based on Shah).

We specifically included those other claims in the trial "without reaching any preliminary findings or conclusions on the merits." *Id*. at 10. We pointed out that doing so serves our mission of securing the just, speedy, and efficient resolution of the parties' dispute. *Id*. (citing 37 C.F.R. §§ 42.1(b), 42. 108). That action was not inconsistent with any finding in

the decision declining to institute trial in IPR1507. Nor does it establish that we overlooked or misapprehended any matter in the Decision entered in this proceeding.

We are not persuaded that we erred by including the patentability of claim 4 as an issue in the trial. On that point, Petitioner directs us to no persuasive reason why we should exclude claim 4 or otherwise disturb the application of any estoppels that may result, should a final written decision be entered in this proceeding. *See* 35 U.S.C. § 315(e) (estoppel provision); *see generally* Req. Reh'g.

Petitioner also points out a clerical error in the Decision (Req. Reh'g 13), which we correct in a Conduct of the Proceeding Order filed concurrently herewith.

It is:

ORDERED that Petitioner's Request for Rehearing (Paper 20) is *denied*.

PETITIONER:

David L. Glandorf
Joseph Evall
Daniel J. Thomasch
GIBSON, DUNN & CRUTCHER LLP
dglandorf@gibsondunn.com
jevall@gibsondunn.com
dthomasch@gibsondunn.com

PATENT OWNER:

Paul H. Berghoff
James V. Suggs
S. Richard Carden
MCDONNELL BOEHNEN HULBERT & BERGHOFF LLP
Berghoff@mbhb.com
Suggs@mbhb.com
Carden@mbhb.com