

**IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE**

AGROFRESH INC.,

Plaintiff,

v.

MIRTECH, INC., NAZIR MIR, ESSENTIV
LLC, DECCO U.S. POST-HARVEST, INC.,
CEREXAGRI, INC. d/b/a DECCO POST-
HARVEST, and UPL, LTD.,

Defendants.

C.A. No. 16-662-JFB-SRF

**DEFENDANTS DECCO U.S. POST-HARVEST, INC., CEREXAGRI, INC. D/B/A
DECCO POST-HARVEST, AND UPL, LTD.’S INITIAL INVALIDITY CONTENTIONS**

Pursuant to the Court’s Scheduling Order (D.I. 122) and Paragraph 4(d) of the Court’s Default Standard for Discovery, Including Discovery of Electronically Stored Information (“Default Standard”), Defendants Decco U.S. Post-Harvest, Inc., Cerexagri, Inc. d/b/a Decco Post-Harvest, and UPL, Ltd. (collectively, “the Decco/UPL Defendants” or “the Defendants”)¹ through their undersigned counsel, provides the following Initial Invalidity Contentions to Plaintiff AgroFresh, Inc. The Decco/UPL Defendants contend that each of the claims asserted by AgroFresh is invalid under at least 35 U.S.C. §§ 102, 103, and/or 112. The Decco/UPL Defendants reserve the right to supplement these Initial Invalidity Contentions.

I. GENERAL STATEMENTS AND OBJECTIONS

A. Asserted Claims

AgroFresh served the Decco/UPL Defendants with Infringement Contentions pursuant to Paragraph 4(c) of the Default Standard alleging infringement of U.S. Patent Nos. 6,017,849,

¹ Essentiv is a joint venture between MirTech, Inc. and Decco U.S. Post-Harvest, Inc. Due to the settlement and consent judgment by MirTech, these Initial Invalidity Contentions are also being served by Decco as a member of that joint venture.

AgroFresh Inc. Exhibit 2048

UPL, Ltd. v. AgroFresh Inc.

6,313,068, and 9,394,216 (collectively, “Asserted Patents”). Specifically, AgroFresh has alleged that the Decco/UPL Defendants infringes claims 1 and 10 of the ’849 Patent, claims 1 and 6 of the ’068 Patent, and claims 1, 6-8, and 13 of the ’216 Patent (collectively, “Asserted Claims”).

Paragraph 4(d) of the Default Standard requires that a defendant accused of infringement provide initial invalidity contentions with regard to the claims asserted against it. The Decco/UPL Defendants therefore provide these contentions for each Asserted Claim. Pursuant to Paragraph 4(d), the Decco/UPL Defendants do not provide any contentions regarding any claim not asserted against them. To the extent that AgroFresh is permitted to assert additional claims against the Decco/UPL Defendants in the future, the Decco/UPL Defendants reserve all rights to disclose new or supplemental invalidity contentions regarding such claims.

B. Claim Construction

The Court has not yet construed the Asserted Claims. The Decco/UPL Defendants’ Initial Invalidity Contentions are based, at least in part, on its present understanding of the Asserted Claims and/or the claim constructions AgroFresh appears to be asserting—based on AgroFresh’s Infringement Contentions—whether or not the Decco/UPL Defendants agree with such claim constructions.

The Decco/UPL Defendants take no position on any matter of claim construction in these Initial Invalidity Contentions. If they are consistent with or implicit in AgroFresh’s Infringement Contentions, no inference is intended or should be drawn that the Decco/UPL Defendants agree with such claim constructions. Any statement herein describing or tending to describe any claim element is provided solely for the purpose of responding to AgroFresh’s Infringement Contentions. Similarly, any statement herein describing or tending to describe any claim element’s relationship to the prior art is provided solely for the purpose of responding to AgroFresh’s Infringement Contentions. The Decco/UPL Defendants expressly reserve the right

to propose any claim construction they consider appropriate and/or to contest any claim construction they consider inappropriate.

The Decco/UPL Defendants reserve all rights to further supplement or modify the positions and information in these Invalidity Contentions, including without limitation, the prior art and grounds of invalidity set forth herein, after the Court has construed the Asserted Claims.

C. Ongoing Discovery and Right to Supplement

The Decco/UPL Defendants' investigation, including its investigation of prior art and grounds for invalidity, is ongoing. Furthermore, the Decco/UPL Defendants' invalidity positions will be the subject of expert testimony. The Decco/UPL Defendants reserve the right to supplement their Initial Invalidity Contentions including, without limitation, adding additional prior art and grounds of invalidity in accordance with the Federal Rules of Civil Procedure, the Local Rules of the United States District Court for the District of Delaware, the Default Standard, or otherwise.

D. Prior Art Identification and Citation

The Decco/UPL Defendants identify specific portions of prior art references that disclose the elements of the Asserted Claims. The specific portions, however, are not exhaustive. They are simply exemplary as to the teachings of a particular prior art reference and how those teachings relate to the elements of the Asserted Claims. For example, while the Decco/UPL Defendants have identified at least one citation per claim element for each prior art reference, each and every disclosure of that same element in that prior art reference is not necessarily identified. In addition, where the Decco/UPL Defendants identify a particular figure in a prior art reference, the identification should be understood to encompass the caption and description of the figure as well as any text relating to the figure in the specification and prosecution history in addition to the figure itself. Similarly, where an identified portion of text refers to a figure or

other material, the identification should be understood to include the referenced figure or other material as well.

It also should be recognized that a person of ordinary skill in the art would generally read a prior art reference as a whole and in the context of other publications, literature, and general knowledge in the field. To understand and interpret any specific statement or disclosure in a prior art reference, a person of ordinary skill in the art would rely upon other information including other publications and general scientific or engineering knowledge.

The Decco/UPL Defendants therefore reserve the right to rely upon other unidentified portions of the prior art references and on other publications and expert testimony to provide context and to aid understanding and interpretation of the identified portions. The Decco/UPL Defendants also reserve the right to rely upon other portions of the prior art references, other publications, and the testimony of experts to establish that the alleged inventions would have been obvious to a person of ordinary skill in the art, including on the basis of modifying or combining certain cited references. The Decco/UPL Defendants also reserve the right to rely upon any admissions relating to prior art in the Asserted Patent, its prosecution history, in this litigation, in any post-grant challenge at the Patent Office, or otherwise.

II. INVALIDITY CONTENTIONS PURSUANT TO PARAGRAPH 4(D)

A. Asserted Claims Invalid under 35 U.S.C. §§ 102 and 103

1. The '849 Patent

Each of the Asserted Claims is anticipated and/or rendered obvious by prior art. Pursuant to Paragraph 4(d), the Decco/UPL Defendants identify the prior art that anticipates or renders an Asserted Claim obvious in Exhibits A1-A24. Exhibits A1-A24 include invalidity claim charts specifically identifying where each element of each Asserted Claim is found in the prior art. These charts, however, are merely examples. The claimed features are similarly described or

disclosed in other places (including in all of the documents cited during prosecution of each piece of prior art), and also were present when prior art systems practicing the described prior art were used before the applications that led to the Asserted Patents were filed. Thus, the Decco/UPL Defendants reserve the right to rely on other evidence of the prior art beyond merely the exemplary references cited in Exhibits A1-A24. For the references cited in Exhibits A1-A24, each listed document or item became prior art at least as early as the dates given.

Exhibits A1-A24 include charts directed to each of the following prior art references:

- R. Breslow *et al.*, *Very strong binding of appropriate substrates by cyclodextrin dimers*, J. Am. Chem. Soc., Vol. 111, pp. 8296-8297 (1989), DECCO-00074190 - DECCO-00074191
- D. Duchene and D. Wouessidjewe, *Industrial uses of cyclodextrins and their derivatives*, J. Coord. Chem. 1992, Vol. 27, pp. 223-236 (1992), DECCO-00074202 - DECCO-00074215
- EthylBloc Product, DECCO-00074267; DECCO-00074416 - DECCO-00074429; DECCO-00074430 - DECCO-00074440; DECCO-00074397 - DECCO-00074403; DECCO-00074390 - DECCO-00074396
- U.S. patent No. 5,321,014 (“Janz”), DECCO-00073617 - DECCO-00073643
- JP Patent H4-41438 (“JP 438”), DECCO-00074155 - DECCO-00074164; DECCO-00074165 - DECCO-00074170
- European Patent No. EP 0572743 (“Mazomenos EP ’743”). DECCO-00074091 - DECCO-00074101

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