

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BASF CORPORATION,
Petitioner,

v.

INGEVITY SOUTH CAROLINA, LLC,
Patent Owner.

Case IPR2019-00202
Patent RE38,844 E

Before DONNA M. PRAISS, CHRISTOPHER L. CRUMBLEY, and
JON B. TORNQUIST, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Petitioner BASF Corporation filed a Request for Rehearing (Paper 11, “Req. Reh’g”) of our May 13, 2019 Decision Denying Institution of *Inter Partes* Review (Paper 10, “Dec.”). In its Petition, BASF challenged claims 1–8, 11, 12, 14–16, 18–21, 24, 25, 27–29, 31–33, 36, 37, 39–41, 43–45, 48, 49, and 51–53 of U.S. Patent No. RE38,844 E (Ex. 1001, “the ’844 patent”) on three grounds of unpatentability alleging obviousness over combinations of prior art including the Park¹ reference. Paper 2 (“Pet.”). Our Decision reviewed BASF’s contentions regarding the references, found that BASF had presented insufficient evidence that the combinations of prior art would necessarily result in a method or system that met all limitations of the challenged claims, and as a result determined that BASF had not established a reasonable likelihood that at least 1 challenged claim was unpatentable. Dec. 16–22.

Because institution of an *inter partes* review trial is discretionary, when rehearing a decision on a petition to institute trial the Board “will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). “An abuse of discretion occurs where the decision is based on an erroneous interpretation of the law, on factual findings that are not supported by substantial evidence, or represents an unreasonable judgment in weighing relevant factors.” *Lacaverav. Dudas*, 441 F.3d 1380, 1383 (Fed. Cir. 2006) (quoting *Star Fruits S.N.C. v. United States*, 393 F.3d 1277, 1281 (Fed. Cir. 2005)). The party requesting rehearing has the burden of showing the decision should be modified, and “[t]he request must specifically identify all

¹ U.S. Patent No. 5,914,294 to Park et al., issued June 22, 1999 (Ex. 1010).

matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. § 42.71(d).

II. DISCUSSION

Each challenged claim of the '844 patent requires the presence of a “subsequent adsorbent volume having an incremental adsorption capacity of less than 35 g n-butane/L between vapor concentrations of 5 vol % and 50 vol % n-butane.” Ex. 1001, 10:36–14:64. In its Petition, BASF argued that, if a person of ordinary skill in the art were to create a system by combining the filter of Park with the systems described in the various primary references, the resulting system would have a subsequent adsorbent volume that inherently meets this incremental adsorption capacity (IAC) limitation. *See, e.g.*, Pet. 22–26 (Meiller/Park combination). The details of BASF’s arguments for unpatentability were summarized in our Decision; here, we focus on three primary factual contentions that are central to the Request for Rehearing.

First, BASF argued that, when deciding which filter to use in the subsequent adsorbent volume, the skilled artisan would have selected Park’s Formulation D because of its high axial crushing strength, which Park reports is desirable in automotive air intake applications. *Id.* at 33. Second, BASF contended that the resulting subsequent adsorbent volume would be a honeycomb carbon having the 73.8% voidages disclosed in Park as “desirabl[e].” *Id.* at 36. Finally, according to BASF, a filter formed from Park’s Formulation D, and having 73.8% voidages, “would have an IAC of less than 35 g/L even if it was created exclusively with the activated carbon of the highest possible IAC known at the time of the '844 patent.” Ex. 1003

¶ 111. As we stated in the Decision, this reference to “the activated carbon of the highest possible IAC known at the time of the ’844 patent” is a reference to BAX 1500 carbon, the highest-IAC carbon disclosed in the ’844 patent.

In our Decision, we reviewed BASF’s arguments and submitted evidence, and concluded that the record lacked sufficient support for these three links in BASF’s logical chain. First, we found that BASF had not provided evidence “why a person of skill in the art would have been led by Park’s strength requirement for an air intake system to select Formulation D” for the evaporative emissions systems that are the focus of the ’844 patent. Dec. 17–18. Second, we found no reason to conclude that, even if a person of ordinary skill in the art would have selected Park’s Formulation D to use in an evaporative emissions system, the resulting honeycomb would have the 73.8% voidages that Park considers desirable. *Id.* at 18–19. Finally, we found unsupported Mr. Lyons’ testimony that BAX 1500 carbon was the highest-capacity carbon known in the art at the time of the invention. *Id.* at 19–20. Each of these independent findings was sufficient to lead us to conclude that BASF had not shown that a system resulting from the use of Park’s honeycomb filter in an evaporative emissions system would necessarily have an IAC below 35 g/L, as required by the claims. *Id.* at 20–21. As such, we found that BASF had not established a reasonable likelihood that any claim of the ’844 patent was unpatentable.

BASF challenges each of these three findings in its Request for Rehearing, arguing that they were an abuse of discretion because each was “based on matters that the Board misapprehended, overlooked, or on

erroneous factual findings not supported by substantial evidence.” Req. Reh’g 1. We take each in turn below.

Regarding the question of whether a person of ordinary skill in the art would have selected Park’s Formulation D when creating a filter for use as a subsequent adsorption volume, BASF contends that we misapprehended its evidence supporting such a selection. *Id.* at 9–12. BASF notes its argument was that a person of ordinary skill in the art would have selected Formulation D “because it is the **only formulation** that meets Park’s explicit requirements for the air intake application: a carbon content of 25–35% by weight and an axial crushing strength from 1200–1600 psi.” *Id.* at 10 (citing Pet. 33–34). But BASF’s argument misses the point of our conclusion in the Decision, which was that the record contained no evidence that the requirements of an *air intake application*, as discussed by Park, were the same as the requirements of the *evaporative emissions application* that is the focus of the ’844 patent and the primary prior art references in each combination. In other words, while a person of ordinary skill in the art might have been led to Formulation D if trying to create a filter for an air intake system, the record contains no persuasive evidence that the same is true of the artisan creating an evaporative emissions system. Indeed, as we noted in the Decision, the only evidence on this point is to the contrary, and comes from Ingevity’s expert witness Dr. Ritter. As we noted, “Dr. Ritter testifies that evaporative emission systems and air intake systems are designed for use with different vapor concentrations and, more importantly, different flow rates.” Dec. 17 (citing Ex. 2001 ¶¶ 43–44).

According to BASF, our reliance in the Decision on Dr. Ritter’s testimony was in error, because when deciding whether to institute an *inter*

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