

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SYNGENTA CROP PROTECTION AG,
Petitioner,

v.

FMC CORPORATION,
Patent Owner.

PGR2020-00028
Patent 10,294,202 B2

Before SUSAN L. C. MITCHELL, ZHENYU YANG, and
CYNTHIA M. HARDMAN, *Administrative Patent Judges*.

HARDMAN, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining Some Challenged Claims Unpatentable
35 U.S.C. § 328(a)
Denying Petitioner's Motions to Exclude
37 C.F.R. § 42.64

I. INTRODUCTION

This is a Final Written Decision in a post grant review challenging the patentability of claims 1–7, 9–13, and 21–31 of U.S. Patent No. 10,294,202 B2 (“the ’202 patent,” Ex. 1001). We have jurisdiction under 35 U.S.C. § 6.

Petitioner has the burden of proving unpatentability of the challenged claims by a preponderance of the evidence. 35 U.S.C. § 326(e) (2018). Having reviewed the parties’ arguments and supporting evidence, for the reasons discussed below, we find that Petitioner has demonstrated by a preponderance of the evidence that claims 1–3, 9–13, and 21–30 are unpatentable, but has not demonstrated by a preponderance of the evidence that claims 4–7 and 31 are unpatentable. We also deny Petitioner’s motions to exclude.

A. *Procedural History*

Syngenta Crop Protection AG (“Petitioner”) filed a Petition requesting post-grant review of claims 1–7, 9–13, and 21–31 of the ’202 patent. Paper 1 (“Pet.”). FMC Corporation (“Patent Owner”) filed a Preliminary Response. Paper 7. Based on the Petition and Preliminary Response, we determined that Petitioner more likely than not would prevail in showing that at least one of the challenged claims was unpatentable. Thus, we instituted trial. Paper 8 (“Inst. Dec.”).

After institution, Patent Owner filed a Response (Paper 15, “Resp.”), Petitioner filed a Reply (Paper 19, “Reply”), and Patent Owner filed a Sur-reply (Paper 20, “Sur-reply”). On June 16, 2021, we held an oral hearing, the transcript of which is of record. Paper 32 (“Tr.”).

Petitioner filed a motion to exclude certain opinions of Patent Owner's expert Dr. Dayan (Paper 24), Patent Owner filed an opposition (Paper 27), and Petitioner filed a reply (Paper 28).

Petitioner also filed a motion to exclude testimony, exhibits, and arguments regarding patents issued to its expert Dr. Hunt (Paper 25), Patent Owner filed an opposition (Paper 26), and Petitioner filed a reply (Paper 29).

B. *Real Parties in Interest*

Petitioner identifies the real parties in interest as Syngenta Crop Protection AG and Syngenta AG.¹ Paper 11, 1. Patent Owner identifies itself as the real party in interest. Paper 3, 2.

C. *Related Matters*

Petitioner identifies two applications to which the '202 patent claims priority: (1) U.S. Provisional Application No. 61/911,324 (filed 12/3/2013); and (2) PCT/US2014/068073, WO2015/084796 (published June 11, 2015). Pet. 3–4.

Patent Owner states that it “knows of no judicial or administrative matters that may affect or be affected by a decision in this proceeding.” Paper 3, 2.

¹ In its Preliminary Response, Patent Owner argued that the Petition “fails to name all real parties in interest.” Paper 7, 2, 61. We authorized Patent Owner to file a brief addressing real parties in interest (Paper 10, 3), but Patent Owner elected not to do so, stating: “In the interest of expediting the proceeding, FMC declined to pursue the issue further. However, FMC does not concede that the petition does, in fact, name all real parties in interest.” Resp. 4 n.4. Because Patent Owner has not raised a real party in interest argument during the trial, it is waived. *See In re NuVasive*, 842 F.3d 1376, 1380–81 (Fed. Cir. 2016) (finding that an argument raised in preliminary proceedings but not raised during trial is waived).

D. *The '202 Patent*

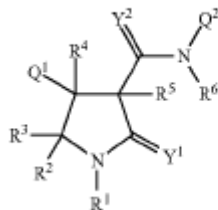
The '202 patent, titled “Pyrrolidinones as Herbicides,” “relates to certain pyrrolidinones, their N-oxides and salts, and compositions and methods of their use for controlling undesirable vegetation.” Ex. 1001, code (54), 1:5–7. The Specification states that “[t]he control of undesired vegetation is extremely important in achieving high crop efficiency,” and that “[m]any products are commercially available for these purposes, but the need continues for new compounds that are more effective, less costly, less toxic, environmentally safer or have different sites of action.” *Id.* at 1:11–23.

The '202 patent provides sixteen compound synthesis schemes (*id.* at 33:9–41:49) and seven example syntheses (*id.* at 42:44–50:35). The '202 patent also discloses approximately 350 compounds that were synthesized (Index Tables A–D), 335 of which were tested for herbicidal effect on various crop and weed species (Tables A–H5). *Id.* at 173:49–54, 174:1–182:50, 182:57–285:27.

E. *Illustrative Claim*

Of the challenged claims, claims 1 and 31 are independent. Claim 1, reproduced below, is illustrative:

1. A compound selected from Formula I, N-oxides and salts thereof:



1

wherein

Q¹ is a phenyl ring optionally substituted with up to 5 substituents independently selected from R⁷; or a 5- to 6-membered heterocyclic ring or an 8- to 10-membered heteroaromatic bicyclic ring system, each ring or ring system containing ring members selected from carbon atoms and 1 to 4 heteroatoms independently selected from up to 2 O, up to 2 S and up to 4 N atoms, wherein up to 3 carbon ring members are independently selected from C(=O) and C(=S), and the sulfur atom ring members are independently selected from S(=O)_u(=NR⁸)_v, each ring or ring system optionally substituted with up to 5 substituents independently selected from R⁷ on carbon atom ring members and selected from R⁹ on nitrogen atom ring members;

Q² is a phenyl ring or a naphthalenyl ring system, each ring or ring system optionally substituted with up to 5 substituents independently selected from R¹⁰; or a 5- to 6-membered fully unsaturated heterocyclic ring or an 8- to 10-membered heteroaromatic bicyclic ring system, each ring or ring system containing ring members selected from carbon atoms and 1 to 4 heteroatoms independently selected from up to 2 O, up to 2 S and up to 4 N atoms, wherein up to 3 carbon ring members are independently selected from C(=O) and C(=S), and the sulfur atom ring members are independently selected from S(=O)_u(=NR⁸)_v, each ring or ring system optionally substituted with up to 5 substituents independently selected from R¹⁰ on carbon atom ring members and selected from R¹¹ on nitrogen atom ring members;

Y¹ and Y² are each independently O, S or NR¹²;

R¹ is H, hydroxy, amino, C₁-C₆ alkyl, C₁-C₆ haloalkyl, C₂-C₆ alkenyl, C₃-C₆ alkynyl, C₄-C₈ cycloalkylalkyl, C₂-C₈ alkoxyalkyl, C₂-C₈ haloalkoxyalkyl, C₂-C₈ alkylthioalkyl, C₂-C₈ alkylsulfinylalkyl, C₂-C₈ alkylsulfonylalkyl, C₂-C₈ alkylcarbonyl, C₂-C₈ haloalkylcarbonyl, C₄-C₁₀ cycloalkylcarbonyl, C₂-C₈ alkoxycarbonyl, C₂-C₈ haloalkoxycarbonyl, C₄-C₁₀ cycloalkoxycarbonyl, C₂-C₈ alkylaminocarbonyl, C₃-C₁₀ dialkylaminocarbonyl, C₄-

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