

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BASF CORPORATION,
Petitioner,

v.

INGEVITY SOUTH CAROLINA, LLC,
Patent Owner.

PGR2020-00037
Patent 10,323,553 B2

Before JON B. TORNQUIST, CHRISTOPHER M. KAISER, and
JULIA HEANEY, *Administrative Patent Judges*.

HEANEY, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision on Remand
Determining No Challenged Claim Unpatentable
37 C.F.R. § 328(a)

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I. Introduction

This decision addresses the opinion of the U.S. Court of Appeals for the Federal Circuit in *BASF Corp. v. Ingevity South Carolina, LLC*, No. 2022-1129 (Fed. Cir. June 22, 2023) (Paper 82) (“Federal Circuit Decision”), affirming the Board’s determination of obviousness of the claims 1–10, 14–28, 32–38, 51, 52, 55–57, 59, 64–72, and 76–82 (“the challenged claims”) of U.S. Patent 10,323,553 B2 (Ex. 1001, “the ’553 patent”), but vacating and remanding the Board’s determination of indefiniteness of those claims. Paper 82. Having analyzed the record relating to the indefiniteness challenge anew in light of the directive in the Federal Circuit Decision, we issue this Final Written Decision on Remand pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73, and for the reasons discussed below we conclude that Petitioner has not shown by a preponderance of the evidence that the challenged claims of the ’553 patent are indefinite.

A. Procedural History

Petitioner filed a petition to institute a post-grant review of the challenged claims of the ’553 patent. Paper 3 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 7. Pursuant to 35 U.S.C. § 324, the Board instituted trial on September 10, 2020, after determining Petitioner had shown it was more likely than not to prevail with respect to its challenge to claims 1 and 21 of the ’553 patent based on obviousness. Paper 19, 37.

During the course of trial, Patent Owner filed a Patent Owner Response (Paper 44, “PO Resp.”); Petitioner filed a Reply to the Patent Owner Response (Paper 52, “Pet. Reply”); and Patent Owner filed a Sur-

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reply (Paper 61, “PO Sur-reply”). The parties also filed motions to exclude evidence (Papers 56 and 57). An oral hearing was held on June 11, 2021, and a transcript of the hearing is included in the record. Paper 71 (“Tr.”).

On September 9, 2021, we issued a Final Written Decision (Paper 75), determining, as discussed above, that Petitioner had not shown by a preponderance of the evidence that the challenged claims are unpatentable as obvious or indefinite. Petitioner appealed our Final Written Decision to the Federal Circuit. *See* Paper 78. The Federal Circuit remanded on the issue of indefiniteness and entered the mandate on July 31, 2023. Paper 82, 14; Paper 81 (mandate).

On August 23, 2023, this panel held a conference call with counsel for Petitioner and Patent Owner to discuss the procedure and schedule on remand, in accordance with the Board’s Standard Operating Procedure 9. During the call, Petitioner requested authorization to file a ten-page brief in light of the Federal Circuit Decision. Patent Owner disputed that any further briefing was necessary or appropriate and opposed Petitioner’s request. We determined that the additional briefing proposed by Petitioner would not be helpful in resolving the issue remanded by the Federal Circuit. *See* Paper 83.

B. The Issue on Remand

In the Final Written Decision, we determined Petitioner had not shown that a person of ordinary skill in the art would have understood measurement of the adsorption capacity of n-butane is subject to significant deviation, depending on whether a gravimetric or volumetric measurement technique is used. Paper 75, 16–18. Finding that this determination was

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dispositive as to Petitioner’s indefiniteness challenge, we thus stated “we need not address Petitioner’s allegations as to the measurement differences reported by Intertek in Exhibit 1020.” *Id.* at 18. In vacating and remanding our determination on the indefiniteness challenge, the Federal Circuit referred to the preceding statement and wrote

The Board’s statement suggests that, because it found Ingevity’s evidence on indefiniteness convincing, the Board did not consider BASF’s evidence on the issue [T]he Board did not explain whether it found Ingevity’s evidence more credible; nor did it explain whether it found BASF’s testing unreliable and therefore did not give that evidence any weight While we may well have affirmed the Board had it articulated any of these purported reasons for its conclusion, we cannot meaningfully review the Board’s opinion to determine whether its underlying factual finding is supported by substantial evidence because we cannot discern the basis for the Board’s finding—other than its very clear statement that it need not consider BASF’s evidence. Such a statement, without further elaboration, runs afoul of the APA’s requirement to consider all the evidence and thus the Board’s analysis is improper.

We therefore vacate the Board’s decision regarding BASF’s indefiniteness challenge and remand for the Board to consider all the proffered evidence of record and make the relevant factual findings and legal conclusion regarding indefiniteness.

Federal Circuit Decision 10–11. The Federal Circuit otherwise did not remark upon our findings and conclusions regarding indefiniteness.

We have considered all of the evidence regarding indefiniteness in light of the Federal Circuit’s directive and, as explained below, we conclude that the challenged claims are not unpatentable based on the indefiniteness

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challenge set forth in the Petition. Except to the extent that they are further explained below or contradicted by any statement herein, we maintain the analysis, findings, and conclusions reached in our earlier Final Written Decision, which we incorporate by reference.

II. Background

A. *Related Proceedings*

The parties identify PGR2020-00035 as a related proceeding involving the '553 patent. Pet. 101; Paper 5, 2. In that case, we denied institution of trial. PGR2020-00035, Paper 11. The parties state they are not aware of any other judicial or administrative proceeding involving the '553 patent. Pet. 101; Paper 5, 2.

B. *The '553 Patent*

The '553 patent describes canister systems that employ activated carbon to adsorb fuel vapor emitted from motor vehicle fuel systems and reduce hydrocarbon air pollution. Ex. 1001, code (54), 1:29–33. The adsorbed fuel vapor can be “periodically removed from the activated carbon by purging the canister systems with ambient air [while the engine is turned on] to desorb the fuel vapor from the activated carbon,” after which the “regenerated carbon is then ready to adsorb additional fuel vapor.” *Id.* at 1:33–38; 53–58. According to the '553 patent, however, “[t]he purge air does not desorb the entire fuel vapor adsorbed on the adsorbent volume, resulting in a residue hydrocarbon (‘heel’) that may be emitted to the atmosphere.” *Id.* at 1:58–61.

The '553 patent states “[a]n increase in environmental concerns has continued to drive strict regulations of the hydrocarbon emissions from

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