

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SWEEGEN, INC.  
Petitioner

v.

PURECIRCLE USA INC. AND PURECIRCLE SDN BHD  
Patent Owners

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Case: PGR2020-00070  
U.S. Patent No. 10,485,257 B2

**PETITIONER'S REPLY  
TO PATENT OWNERS' PRELIMINARY RESPONSE**

PureCircle's arguments suggesting that the Board should exercise its discretion under 35 U.S.C. § 325(d) to deny instituting this Post Grant Review have no basis in law or the facts of this case. Not only has PureCircle failed to follow the correct legal framework clearly set forth in precedent, but it has also made numerous misstatements of fact in an attempt to bolster its already untenable legal arguments.

The correct legal standard for determining whether the Board should exercise its discretion under 35 U.S.C. § 325(d) is the following two-part framework set forth in the precedential decision in *Advanced Bionics*:<sup>1</sup>

1. whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
2. if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

The six factors set forth in *Becton, Dickinson* are used to apply this framework.<sup>2</sup> Factors (a), (b), and (d) are analyzed with respect to the first part of the

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<sup>1</sup> *Advanced Bionics, LLC v. Med-el Elektromedizinische Geräte GMBH*, IPR 2019-01469, Paper 6 at 8 (PTAB February 13, 2020) (precedential).

<sup>2</sup> *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at

framework, and factors (c), (e), and (f) are considered with respect to the second part. Here, only factors (c), (d) and (f), which relate to the art or arguments actually presented to the Office, are relevant. Factors (a), (b), and (e) relate to the similarities and cumulative nature of asserted prior art and the evaluation of the art during examination, and this type of argument has not been raised by PureCircle.

As demonstrated below, proper application of the two-part framework set forth in *Advanced Bionics* confirms that Section 325(d) does not support a discretionary denial of institution in this Post Grant Review.

#### **I. Petitioner’s Arguments Were Not Previously Before the Office**

As its main argument, PureCircle wants the Board to find that Petitioner's arguments (and lack thereof) in its Petition for Inter Partes Review in IPR2019-01017 (referred to hereinafter as the “‘273 IPR”) show that the same or substantially the same arguments being made in the present Petition were presented previously to the Board. However, PureCircle is wrong on the law, and wrong on the facts.

The relevant *Becton, Dickinson* factor is factor (d): “the extent of overlap between arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art.” Here, there is clearly no overlap between arguments made in the ‘273 IPR and the enablement and

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17–18 (PTAB Dec. 15, 2017) (precedential).

written description challenges against the ‘257 Patent. In the present Petition, for example, Petitioner applied the factors set forth in *In re Wands*, 858 F.2d 731 (Fed. Cir. 1988), to demonstrate that undue experimentation is required to practice the full scope of the ‘257 patent’s claims. No such argument was before the Board in the ‘273 IPR. Importantly, PureCircle concedes this fact along with the fact that Petitioner’s written description arguments set forth in the Petition were also not made in the ‘273 IPR by stating that “the enablement and written-description challenges against the ‘257 Patent asserted here *differ* from the ones asserted against the ‘273 Patent.” Patent Owners’ Preliminary Response at 61 (emphasis added). This alone should end the inquiry under Section 325(d).

Apparently knowing the law is not on its side, an undeterred PureCircle has concocted its own legal standard that deviates significantly from *Advanced Bionics* and the plain language of Section 325(d). PureCircle argues that Petitioner already challenged the present claims under enablement and written description in the ‘273 IPR and that the arguments made in the Petition *could have been* raised in the ‘273 IPR. There is no basis, and PureCircle provides none, for such a legal standard. *Advanced Bionics* clearly states that the same or substantially the same arguments must have been previously presented to the Office, and without any overlap in arguments, the Board’s discretion under Section 325(d) does not apply.

PureCircle is not only wrong on the law, it is also wrong on the facts. Contrary

to PureCircle’s assertions, the ‘273 IPR did not *challenge* the claims under enablement and written description. In fact, the ‘273 IPR did not raise *any* enablement arguments concerning the ‘273 patent or the provisional application. Accordingly, the Board had no reason to consider whether practicing the claims of the ‘273 patent required undue experimentation. *See* Ex. 2002 (lacking any *Wands* analysis). The ‘273 IPR merely raised a question as to whether the prior provisional application provided written description support for a specific claim element of the ‘273 patent. But the claim element at issue in the ‘273 IPR—“wherein the conversion of Rebaudioside D to Rebaudioside X is at least about 50% complete”—is absent from the claims of the ‘257 patent. *Compare* Ex. 2002 at 23-30; Ex. 1001.

PureCircle’s second string argument regarding the Examiner’s notice that the application that matured into the ‘257 patent was being examined under the pre-AIA provisions also fails part one of the *Advanced Bionics* framework. The Examiner never raised a Section 112 rejection during prosecution of the ‘257 patent. *See* Ex. 1002. Accordingly, there is no evidence as to which—if any—enablement or written-description arguments were considered by the Examiner during prosecution. *See Hybrigenics SA v. Forma Therapeutics, Inc.*, PGR2018-00098, Paper 10 at 20-21 (PTAB March, 2019) (“[T]he mere absence of a written description rejection does not establish that the Examiner considered the arguments presented in the Petition. To find otherwise would potentially suggest that we should apply our discretion

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