Paper No. 13

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SWEEGEN, INC.
Petitioner,

v.

PURECIRCLE SDN BHD AND PURECIRCLE USA INC.,
Patent Owners.

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

Dated: December 3, 2020

PATENT OWNERS' AUTHORIZED SURREPLY SUPPORTING PATENT OWNER'S PRELIMINARY RESPONSE

I. INTRODUCTION.

Petitioner's reply brief ignores the common issues raised by Petitioner in both this PGR regarding the '257 Patent and the prior IPR (IPR2019-01017) regarding the parent '273 Patent. The threshold issue in both proceedings is whether these patents are entitled to their priority dates. The fact that both proceedings cannot proceed unless Petitioner prevails on its priority-date argument shows that "substantially the same … arguments" are addressed in both proceedings, and that Petitioner's priority-date arguments were "previously presented to the Office," as required by § 325(d).

Petitioner also overlooks a key purpose of § 325(d): to combat "the potential for abuse of the review process by repeated attacks on patents." *General Plastic Indus. Co. v. Canon K.K.*, IPR2016-01357, Paper 19, 17 (P.T.A.B. Sept. 6, 2017) (precedential). "The absence of any restrictions on follow-on petitions would allow petitioners the opportunity to strategically stage their prior art and arguments in multiple petitions, using [Board] decisions as a roadmap, until a ground is found that results in the grant of review." *Id.* Petitioner has done just that: the same claim term supporting Petitioner's PGR priority arguments—"UDP-glucosyltransferase"—is in the parent '273 Patent's claims. Petitioner's strategic decision to stage its priority-date arguments to get a second bite at the apple is precisely what the Board sought to prevent in its precedential *General Plastics* and *Advanced Bionics* decisions.

II. THE TWO PROCEEDINGS' PRIORITY ARGUMENTS OVERLAP.

There is substantial overlap between this PGR and Petitioner's prior IPR. In this PGR, the threshold issue is whether Petitioner can change the '257 Patent's priority date so that the AIA applies (Petition at 3-4), and U.S. Publication No. 2015/0031869 A1 (published more than two years after the '257 Patent's priority date) becomes prior art. (*Id.* at 69.) Petitioner's priority argument is that the claim term "UDP-glucosyltransferase" comprises numerous enzymes that have mutant forms, and that the '257 Patent does not satisfy § 112 because it does not describe or enable those mutants. (Petition at 29.) If Petitioner's priority argument fails, the Board must deny institution of this PGR because the '257 Patent is a pre-AIA patent. Moreover, if its argument fails, US2015/0031869 is not prior art.

In the prior IPR, the threshold issue was likewise whether the parent '273 Patent (sharing the same specification as the '257 Patent) was entitled to its priority date and whether a publication (called "WO227") dated after the '273 Patent's priority date qualified as prior art. (Ex. 2002 at 20-21.) According to Petitioners, the '273 Patent's claims did not deserve their priority date under § 112 because Patent Owner did not prove that it achieved conversion above 50% with its new process as of its priority date. (*Id.* at 26.) The Board rejected that argument, finding the claims of the parent '273 Patent entitled to that patent's priority date. (Ex. 2002 at 30.)

Significantly, all of the parent '273 Patent's claims include the same "UDP-glucosyltransferase" claim term that forms the basis for Petitioner's § 112 arguments

in this PGR petition. The '273 and '257 Patents also share the same specification. As a result, Petitioner could have made these exact same arguments in the previous IPR. Petitioner *chose* not to do so, however, and instead argued that a "UDP-glucosyltransferase" was so well-known to a POSITA that the claims were obvious. (Ex. 2002 at 12-13.)

In short, Petitioner revisits the priority question the Board rejected in the prior IPR. Moreover, Petitioner's § 112 arguments concerning "UDP-glucosyltransferase" apply equally to the '273 and '257 Patent claims. While Petitioner's priority challenges differ in the two proceedings, these differences stem from Petitioner's decision to withhold arguments it now asserts to gain a strategic advantage. Indeed, there is such substantial overlap between Petitioner's priority arguments in this PGR and the prior IPR that allowing Petitioner to reargue priority would defeat *General Plastics*' goal of preventing "the potential for abuse of the review process by repeated attacks on patents" and instead "would allow petitioners the opportunity to strategically stage their … arguments in multiple petitions, using [Board] decisions as a roadmap, until a ground is found that results in the grant of review." IPR2016-01357, Paper 19, 17. *Becton Dickinson* factors (a), (b), and (d) favor denial.

Petitioner argues that § 325(d) does not apply because it made only a written-description challenge in the IPR and did not address the *Wands* factors. (Paper 12 at 4.) Although Petitioner's previous IPR challenge was not explicitly framed as an

enablement challenge, its essence was that Patent Owner had not achieved the claimed above-50% conversion. Indeed, Petitioner prefaced a description of its challenge with a statement describing the standard *for enablement*. (Ex. 2007 at 39 ("To be enabling under 35 U.S.C. § 112(1), the disclosure in the provisional application must be sufficient for the POSITA to practice the claimed invention without undue experimentation.").) And the Board recognized the underlying enablement issue, citing Patent Owner's argument that the claimed method "'is routinely used by PureCircle, and by SweeGen, to convert Rebaudioside D to Rebaudioside [X] with at least about 50% conversion' and is, therefore, enabled." (Ex. 2002 at 29.) While Petitioner chose to ignore *Wands* in the IPR, the Board in *Advanced Bionics* did not require identical arguments to be made when applying § 325(d), but only "substantially the same arguments." *See Pharmacosmos A/S v. American Regent, Inc.*, PGR2020-00009, Paper 17, 14-15 (P.T.A.B. Aug. 14, 2020) (rejecting argument that "the Examiner never formally construed" a claim term when the substance of the argument was effectively the same). Indeed, in *Pharmacosmos*, the Board held that prior arguments regarding enablement warranted an institution denial for a parallel written-description challenge, despite the fact that there had been no written-description challenge in the previous matter before the Office. *Id.* at 20.

III. THE '257 PATENT HAS ALREADY BEEN FOUND TO BE PRE-AIA.

As detailed in Patent Owner's Preliminary Response, the '257 Patent's claims

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