

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RICETEC, INC.,
Petitioner,

v.

BASF SE,
Patent Owner.

PGR2021-00113 (Patent 11,096,345 B2)
PGR2021-00114 (Patent 11,096,346 B2)

Record of Oral Hearing
Held: December 13, 2022

Before ULRIKE W. JENKS, TINA E. HULSE, and
ROBERT A. POLLOCK, *Administrative Patent Judges*.

PGR2021-00113 (Patent 11,096,345 B2)
PGR2021-00114 (Patent 11,096,346 B2)

APPEARANCES:

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The above-entitled matter came on for hearing on Tuesday,
December 13, 2022, commencing at 1:00 p.m. EDT, via Video-conference.

1 PROCEEDINGS

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3 1:00 p.m.

4 USHER: Good afternoon. You are here for PGR 2021-00113 and 114
5 with Judge Hulse, Jenks and Pollock. Our IT person is a man and he will be
6 here to assist us with any technical issues that we have.

7 Please speak loud and clear when it's your turn to speak so that the
8 court reporter can hear you. After the hearing is over please stay on the line
9 because the court reporter might have questions about spellings. Thank you
10 and have a great day.

11 JUDGE HULSE: Good morning, everyone. I'm Judge Hulse. With
12 me online are Judges Jenks and Pollock. Unfortunately, Judge Pollock is
13 unable to appear by video today, but we assure you he's there and he can hear
14 and he can see you. This a consolidated final hearing in PGR2021-00113
15 and PGR2021-00114.

16 I'd like to start with appearances, please, starting with Petitioner.

17 MR. NORTON: Yes. Judges Jenks, Hulse and Pollock, this Gerard
18 Norton from Fox Rothchild representing the Petitioner RiceTec. And with
19 me I have my partners Howard Suh and Ryan Miller.

20 JUDGE HULSE: Welcome.

21 And for Patent Owners?

22 MR. McCORMICK: Yeah, good afternoon, Your Honors. Richard
23 McCormick from the Mayer Brown law firm representing Patent Owner
24 BASF. I have with me today Lisa Ferri and Yang-zi Yang from my firm as
25 well.

1 JUDGE HULSE: Great, thank you. Welcome everyone. As we stated
2 in our hearing order, each party will have 60 minutes of time to present their
3 arguments. We'll start with Petitioner and then hear Patent Owner's response.
4 And then assuming both parties reserve time, we'll hear Petitioner's rebuttal
5 and finally Patent Owner's surrebuttal.

6 Please remember to be explicit when you're referring to any slides on
7 the screen so that our transcript is clear. I'll be timing you and we'll give you
8 a five-minute and a one-minute warning. Does anyone have any questions?

9 MR. NORTON: No.

10 MR. McCORMICK: No thank you.

11 JUDGE HULSE: All right. Thanks.

12 MR. SUH: And, Your Honor -- I'm sorry. And, Your Honor, this
13 Howard Suh on behalf of Petitioners. I will be arguing, and good morning or
14 good afternoon depending on where the judges are. I'd like to start by
15 sharing the screen with respect to some slides that we prepared.

16 JUDGE HULSE: Great. And, Mr. Suh, will you be reserving any
17 time?

18 MR. SUH: I will. I will be reserving five minutes if that's
19 appropriate?

20 JUDGE HULSE: Okay. You may begin.

21 MR. SUH: Now, can anyone -- can -- I just want to make sure can
22 everyone see the slide that's on on the screen?

23 JUDGE HULSE: Yes, yes.

24 MR. SUH: Okay, good. So, Your Honors, I just want to put some
25 perspective and background with respect to these particular proceedings.

1 Last August when Petitioner filed its petitions for cancellation of the
2 challenged claims it raised five particular grounds.

3 Ground one was the lack of written description. Ground two was the
4 lack of enablement. Ground three was anticipation based upon prior art,
5 which was actually RiceTec's prior published applications the Hinga and the
6 Hinga2013 publications. And grounds four and five were to obviousness
7 based upon the combination of the Hinga references and other prior art
8 references.

9 Now, Patent Owners' response in these proceedings were that they
10 failed to substantively address any of these particular grounds. They had six
11 opportunities to do so, including their preliminary response, their surreply to
12 their preliminary response. They submitted a declaration by one expert, Dr.
13 Burgos. They formally put in their actual response after the Board actually
14 instituted these proceedings. And then they submitted another expert's
15 declaration replacing Dr. Burgos, and finally they put in another surreply.

16 And in all those papers they did not substantively address any of the
17 particular grounds. Instead, they chose to actually focus only on the grounds
18 of standing, namely that the challenged claims are not PGR eligible because
19 they are entitled to the filing date of their parent CIP Mankin Line. So
20 therefore, based upon that and the way that the issues have been framed in
21 these proceedings, there's really essentially a single issue for the PTAB to
22 decide, and that is a priority issue.

23 Are the challenged claims adequately described and enabled by the
24 Mankin CIP parent application? And the reason why I emphasize describe
25 and enabled is because in order to prove priority Patent Owner has to prove
26 both written description and enablement.

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