

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BUTAMAX™ ADVANCED BIOFUELS LLC

Petitioner

v.

GEVO, INC.

Patent Owner

CASE IPR: Unassigned

**PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO.
8,273,565 B2 UNDER 35 U.S.C. §§ 311-319 and 37 C.F.R. §§ 42.1-.80, 42.100-
.123**

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1 **I. INTRODUCTION**

2 BUTAMAX™ ADVANCED BIOFUELS LLC'S ("**Petitioner**") Petition for *Inter*
3 *Partes* Review ("**Petition**") seeks cancellation of claims 1-19 of U.S. Patent No.
4 8,273,565 ("**the '565 patent**") (BMX1001).

5 **II. OVERVIEW**

6 *Inter partes* Review ("**IPR**") was established to improve patent quality and,
7 if warranted, cancel unpatentable claims. IPR is warranted, presently, because the
8 challenged claims should never have issued in view of the prior art. The limited
9 disclosure in its provisional applications does not support the '565 patent's claim
10 for priority benefit, and claims 1-8 and 11-19 are anticipated by intervening prior
11 art. In addition, the combinations of art identified herein — none of which were
12 before the original Examiner — show that a person of ordinary skill in the art
13 ("**POSA**") had a reason, and the know-how, to arrive at the recombinant yeast and
14 method, claimed in the '565 patent, with a reasonable expectation of success,
15 regardless of the priority date to which the claims are entitled.

16 During original prosecution, patent owner Gevo, Inc., ("**Gevo**") overcame
17 prior art rejections by arguing that (i) the art taught away from the claimed yeast,
18 and (ii) the claimed yeast had some alleged unexpected property. But, as shown
19 herein, Gevo's arguments in both respects were directed, not to a *recombinant*
20 yeast as claimed, but instead to a *native* yeast. As explained in detail below and

1 supported by the accompanying declaration of Dr. Dennis J. Thiele, ("**Thiele**
2 **Dec.**" BMX1002), the art would not have dissuaded a POSA from arriving at the
3 claimed *recombinant* yeast. Moreover, a POSA would have expected such a
4 *recombinant* yeast to act in line with Gevo's alleged unexpected property. Thus,
5 Gevo's arguments in favor of patentability made during original prosecution
6 should be accorded no weight.

7 In sum, a further review of the '565 patent claims is necessary because (i)
8 the art presented in the Petition demonstrates that the claims of the '565 patent
9 were either taught in the art or would have been obvious in view of the art
10 combinations presented herein; and (ii) Gevo's alleged teaching away and
11 unexpected property asserted do not relate to the claimed recombinant yeast, but
12 instead relate only to native yeast. There is a reasonable likelihood that Petitioner
13 will prevail with respect to at least one of the challenged claims in view of the
14 prior art discussed herein. IPR of the '565 patent is warranted.

15 **III. MANDATORY NOTICES**

16 **Real party-in-interest (37 C.F.R. § 42.8(b)(1)):** BUTAMAXTM ADVANCED
17 BIOFUELS LLC ("Petitioner") is the real party-in-interest.

18 **Related matters (37 C.F.R. § 42.8(b)(2)):** Administrative Matters: U.S.
19 Patent No. 8,273,565 issued from U.S. Patent Appl. No. 13/246,693, filed
20 September 27, 2011. The '693 application is a division of U.S. Patent Appl. No.

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