

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UMICORE AG & CO. KG,

Petitioner,

v.

BASF CORPORATION

Patent Owner.

IPR2015-01123
U.S. Patent 8,404,203

**PATENT OWNER'S MOTION FOR LATE SUBMISSION OF
SUPPLEMENTAL INFORMATION**

I. INTRODUCTION

Petitioner (“Umicore”) has argued that the copper chabazite (“CuCHA”) catalyst claimed in the 203 Patent is obvious based on the combination of prior art describing the synthesis of a high SAR synthetic chabazite zeolite and the use of low SAR copper-exchanged zeolites for the selective catalytic reduction (SCR) of NO_x. Umicore further argues that the combination of these decades-old prior art elements produced predictable results, and more generally, that the ranges of atomic ratio of copper to aluminum (“Cu/Al ratio”) and silica-to-alumina ratio (“SAR”) claimed in the 203 Patent are “insignificant” and “performance of zeolites falling both within the range and outside the range are what would be fully expected by one of ordinary skill in the art.” IPR2015-01123, Petition at 14-15. As explained in BASF’s Patent Owner Response, the combination of a CHA zeolite with the claimed Cu/Al ratio and SAR produced unexpected results in comparison to known prior art zeolite catalysts and solved a longstanding problem that was well documented in the prior art. BASF presents this motion to submit additional information showing that, not only does Umicore’s claim of obviousness run directly contrary to an array of objective publications regarding the use of zeolite catalysts for the SCR of NO_x, but it also runs contrary to Umicore’s own prior statements. Specifically, statements by Umicore in U.S. Patent Application Publication No. 2016/0038875 (“the 875 Publication”) (Exhibit-2036) directly

contradict Umicore's contention that the claimed Cu/Al ratio and SAR in the 203 Patent are insignificant and produce expected results. Therefore, and as explained more fully herein, BASF contends that consideration of the 875 Publication in these proceedings would be in the interests of justice.

BASF also contends that it could not have reasonably obtained the information earlier. BASF first learned of the 875 Publication when it was published in English on February 11, 2016 (the day before BASF's Patent Owner Response was due in the IPR). After examining the history of the 875 Publication and comparing it to the positions taken by Umicore in this IPR, BASF, on April 21, 2016, notified Umicore of the inconsistency and its intention to submit the 875 Publication to the Board. Umicore argues that BASF could have found the German language publication earlier by conducting searches, but offers no explanation for why BASF knew or should have known to search for inconsistent statements in Umicore's own later-filed CuCHA patent applications. Moreover, Umicore's position is at odds with the IPR rules, which require that "a party must serve relevant information that is inconsistent with a position advanced by the party." 37 C.F.R. § 42.51(b)(1)(iii). The existence of the earlier German publication and the 875 Publication fall squarely within the scope of this rule, and thus it was Umicore that was obligated to bring this information to light at the very outset of this proceeding.

BASF respectfully requests that the Board grant its motion for submission of supplemental information.

II. APPLICABLE RULES

A request for late submission of supplemental information is governed by 37 C.F.R. § 42.123(b) which states as follows: “A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.”

III. ARGUMENT

A. Consideration of the 875 Publication is in the Interests-of-Justice

Considering information that contradicts a parties’ stated position is in the interests-of-justice because it promotes the search for the truth. *See Edmund Optics*, Case No. IPR2014-00599, Paper 44 at 4 (“With respect to the issue of whether submission of the supplemental information is in the interests of justice, we are mindful that a trial is, first and foremost, a search for the truth.”) (citing *Nix v. Whiteside*, 475 U.S. 157, 166 (1986)). As explained below, the 875 Publication plainly contradicts Umicore’s position in the Petition that the Cu/Al ratio and SAR are insignificant and produce expected results.

The 203 Patent claims priority to a provisional application filed on February 27, 2007, and claims a CuCHA catalyst for the SCR of NO_x having a Cu/Al ratio between 0.25 and 0.50, and a SAR between 15 and 100. Exhibit-1001 at Claim 1. The 203 Patent also includes dependent claims narrowing those ranges. *See, e.g.*, Exhibit-1001 at Claim 22 (requiring a Cu/Al ratio of about 0.40 and SAR of about 30). In the Petition, Umicore asserts that the claimed CuCHA catalyst is obvious in view of Zones (U.S. 6,709,644), which discloses a process for synthesizing a CHA zeolite having a SAR greater than 10, and Maeshima (U.S. 4,046,888), which discloses the use of metal-exchanged zeolites having a low SAR (2-6) for the SCR of NO_x. Umicore has conceded that the claimed Cu/Al ratio and SAR ranges are not highlighted in the prior art, but nonetheless contends that Cu/Al ratio and SAR are insignificant and produce entirely predictable results both inside *and* outside the claimed ranges:

While the particular limits of those claimed SAR and Cu/Al ranges are not highlighted in the prior art, those claimed ranges and the limits lend no patentable significance, but rather are either insignificant or the obvious and natural result of routine design and optimization. As shown in the attached declarations of Dr. Frank-Walter Schütze (Ex. 1015) and Dr. Johannes Lercher (Ex. 1008), there is no criticality to the claimed SAR and Cu/Al ranges, and the performance of zeolites falling both within the range and outside the range are what would be fully expected by one of ordinary skill in the art from the teachings of

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