

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UMICORE AG & CO. KG

Petitioner

v.

BASF CORPORATION

Patent Owner

Case IPR2015-01124

U.S. Patent 8,404,203

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PETITIONER'S OPPOSITION TO BASF'S MOTION FOR LATE  
SUBMISSION OF SUPPLEMENTAL INFORMATION

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Umicore respectfully opposes BASF's motion for the late entry of supplemental evidence. Despite the fact that the parties have filed their briefs and completed cross-examination of each other's witnesses, BASF now belatedly seeks to interject into these IPRs additional evidence, U.S. 2016/0038875 ("the '875 publication") (Ex. 2036). This evidence was admittedly known to BASF for over two months, and was known or should have been known to BASF for two years.

BASF has not made either of the showings required by § 42.123(b). Most importantly, it has not even attempted to explain why the '875 publication could not have been reasonably introduced earlier in the proceeding. BASF admits that it delayed for more than two months after it purports to have learned of the '875 publication. BASF provides no explanation or excuse for this delay. Moreover, an international version of the '875 publication was available long before BASF's briefs were due and could have been cited in any of the BASF's IPR filings. Not only is BASF's motion untimely, but the "interests of justice" do not require admission of the '875 publication. Contrary to BASF's attorney arguments, the disclosure of the publication is consistent with Umicore's positions in this IPR.

#### **I. BASF Inexplicably Delayed for More than Two Months**

BASF claims that it "first learned of the 875 Publication when it was published in English on February 11, 2016." (BASF Motion at 2.) BASF did not,

however, immediately raise any purported relevance of the publication to this IPR. Instead, it delayed more than two months until April 21, 2016. (*See id.*)

This two month delay occurred during a very critical period. During this time, BASF filed its response brief. Umicore assessed BASF's opposition briefing and exhibits, deposed BASF's technical expert witness (who offered opinions on unexpected results), and was heavily engaged in finalizing its own IPR replies. By waiting to raise the '875 publication, BASF deprived Umicore of the ability to cross examine BASF's expert on the publication.<sup>1</sup> It also circumvented the Board's briefing rules, which provide BASF with only a single response brief.

§ 42.123(b) requires BASF to show why it "reasonably could not have obtained" the supplemental evidence earlier. BASF makes no attempt to explain its delay. This alone justifies denial of BASF's motion. *See, e.g., Illumina v. Columbia Univ.*, IPR2012-0006, Paper 87 at 4-5 (Oct. 30, 2013) (finding a motion to submit supplemental information untimely because it was not filed "when [the

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<sup>1</sup> BASF notes that Umicore cancelled three depositions after being informed of the '875 publication issue. (BASF Motion at 8.) These were depositions of BASF fact witnesses. Umicore did depose BASF's only technical expert witness on April 13, 2016. BASF waited over a week after that long-scheduled deposition before raising the '875 publication.

movant] first became aware that the [information] allegedly presented a contrary ... position”); *see also Arctic Cat, Inc. v. Polaris Indus., Inc.*, IPR2014-01427, Paper 40 at 2-3 (Aug. 20, 2015).

## **II. The '875 Publication's Disclosure Has Been Available Since 2014**

Next, while the '875 publication itself published in 2016, it is simply the U.S. national stage of an earlier international application. (*See generally* Ex. 2036 at cover.) That international application published October 9, 2014 as WO 2014/161860 and has been publicly available for almost two years. (*See* Ex. 1121.) BASF could have (but failed to) cite the disclosure in its August 2015 preliminary response, during the depositions of Umicore's witnesses in January 2016, or even in its February 2016 response.

BASF argues that Umicore is attempting to “shift[] the burden to BASF to exhaustively search for inconsistent positions” by noting the earlier availability of the '875 publication's disclosure. (BASF Motion at 7.) But, §42.123(b) requires BASF to show both that it would be in the interests of justice to admit its late evidence *and* that it could not have reasonably located the evidence earlier. BASF has made no attempt to explain what efforts it took to locate pertinent evidence.

Furthermore, an “exhaustive” search was not even required to locate WO 2014/16186. As noted during the teleconference with the Board, this publication is one of only a handful that uses the term “chabazite,” identifies Umicore as the

assignee, and names Mr. Schuetze (a Umicore witness deposed by BASF) as the inventor. Further, since BASF and Umicore directly compete in the automotive catalyst field, it would be highly unusual if BASF were not monitoring for patents and published applications assigned to Umicore, including international patents, as they become available. Such international patents are of interest to BASF as it routinely files international versions of its own patents. Indeed, BASF does not even state in its motion that it was not already in possession of WO 2014/161860 prior to the filing of its response brief in February 2016. Absent some showing of the reasonableness of its actions, BASF's motion must be denied. *See Standard Innovation v. Lelo, Inc.*, IPR2014-00148, Paper 39 at 3 (Feb. 20, 2015) (denying motion to submit supplemental information because the movant did “not explain[] adequately why it did not obtain or offer to submit [the] information earlier”).

### **III. The '875 Publication Does Not “Contradict” Umicore’s Positions**

BASF is also wrong that the '875 publication “directly contradicts Umicore’s contention that the claimed Cu/Al ratio and SAR in the 203 Patent are insignificant and produce expected results.” (BASF Motion at 1-2.) The '875 publication is not inconsistent with Umicore’s arguments and admission of the publication is not required to further the “interests of justice.”

The '203 patent claims priority to an application filed in February 2007. (*See generally* Ex. 1101.) Thus, the relevant issue in this IPR is whether the

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