UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

UMICORE AG & CO. KG,
Petitioner

v.

BASF Corporation,
Patent Owner

Case IPR2015-01124
Patent Number: 8,404,203

PATENT OWNER'S REQUEST FOR REHEARING

PURSUANT TO 37 C.F.R. § 42.71(d)

I. INTRODUCTION

Patent Owner, BASF Corporation, hereby respectfully requests rehearing of the November 2, 2015 Decision ("Decision") instituting an *inter partes* review as to claims 1-31 of the U.S. Patent No. 8,404,203 ("203 Patent"). The Board instituted as to dependent claims 17, 18, 21, and 22 of the 203 Patent, which require, *inter alia*, a CuCHA zeolite having a silica to alumina ratio ("SAR") between 25 and 40 (claims 17, 21) or about 30 (claims 18, 22). In rendering its Decision as to these dependent claims, the Board appears to have overlooked Patent Owner's argument that the prior art at issue—Maeshima, Breck, and Dedecek—does not disclose a CuCHA zeolite with a SAR above 20. *See* IPR2015-01124 Patent Owner's Preliminary Response at 39-40, 46.

Dependent claims 17, 18, 21, and 22 of the 203 Patent contain identical dependent limitations as claims 3, 4, 7, and 8 of related U.S. Patent No. 7,601,662 ("662 Patent"). The 662 Patent is the subject of another IPR filed by Petitioner, IPR2015-01125. The Board instituted *inter partes* review of the 662 Patent as to claims 1, 2, 5, 6, 12-24, 30, and 32-38, but ***declined*** to institute on dependent claims 3, 4, 7, and 8. IPR2015-01125 Decision Institution, Paper No. 9, at 17, 23. In rendering the Decision on the 662 Patent, the Board agreed with Patent Owner that Petitioner had not demonstrated a reasonable likelihood that the subject matter of claims 3, 4, 7 and 8 of the 662 Patent would have been obvious over the

combinations of Maeshima and Breck, and Dedecek and Breck. *Id*.

Given that dependent claims 17, 18, 21 and 22 contain identical limitations as claims 3, 4, 7, and 8 of the 662 Patent ***and*** Petitioner has asserted the same prior art against both sets of claims (Maeshima, Breck, and Dedecek), it appears that the Board overlooked this issue with respect to the 203 Patent. Accordingly, Patent Owner requests that the Board reconsider its decision to institute as to claims 17, 18, 21, and 22 of the 203 Patent.

II. APPLICABLE RULES

37 C.F.R. § 42.71(d) states as follows:

> A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply. A request for rehearing does not toll times for taking action. Any request must be filed:
>
> (1) Within 14 days of the entry of a non-final decision or a decision to institute a trial as to at least one ground of unpatentability asserted in the petition; or
>
> (2) Within 30 days of the entry of a final decision or a decision not to institute a trial.

In accordance with 37 C.F.R. § 42.71(d)(1), this request is being filed within 14 days of entry of a decision to institute trial as to at least one ground of unpatentability asserted in the petition.

III. REQUESTED RELIEF

Patent Owner respectfully requests a rehearing of the Board's Decision to institute *inter partes* review on claims 17, 18, 21, and 22 of the 203 Patent. In light of the information below, Patent Owner requests that the Board decline to institute *inter partes* review of claims 17, 18, 21, and 22.

IV. RATIONALE FOR REHEARING

Patent Owner specifically identifies all matters that it believes the Board overlooked in rendering its Decision.

In IPR2015-01124, Petitioner challenged claims 17, 18, 21, and 22 of the 203 Patent based on Maeshima in view of Breck, and Dedecek in view of Breck. *See* IPR2015-01124 Petition at 17-20. Petitioner made an identical challenge to claims 3, 4, 7, and 8 of the 662 Patent based on Maeshima in view of Breck, and Dedecek in view of Breck. *See* IPR2015-01125 Petition at 18-21. As shown in the table below, claims 17, 18, 21, and 22 of the 203 Patent and claims 3, 4, 7, and 8 of the 662 Patent claim the same dependent limitations:

203 Patent	**662 Patent**
17. The process of claim 15, where the mole ratio of silica to alumina is from	3. The catalyst of claim 2, wherein the mole ratio of silica to alumina is from

about 25 to about 40.	about 25 to about 40.
18. The process of claim 15, wherein the mole ratio of silica to alumina is about 30.	4. The catalyst of claim 2, wherein the mole ratio of silica to alumina is about 30.
21. The process of claim 15, wherein the mole ratio of silica to alumina is from about 25 to about 40 and the atomic ratio of copper to aluminum is from about 0.30 to about 0.50.	7. The catalyst of claim 2, wherein the mole ratio of silica to alumina is from about 25 to about 40 and the atomic ratio of copper to aluminum is from about 0.30 to about 0.50.
22. The process of claim 15, wherein the mole ratio of silica to alumina is about 30 and the atomic ratio of copper to aluminum is about 0.40.	8. The catalyst of claim 2, wherein the mole ratio of silica to alumina is about 30 and the atomic ratio of copper to alumina is about 0.40.

In response to both IPR2015-01124 and IPR2015-01125, Patent Owner noted that Petitioner had failed to establish that the prior art at issue—Maeshima, Dedecek, and Breck—disclosed a SAR greater than 20. *See* IPR2015-01124 Patent Owner's Preliminary Response at 39-40; IPR2015-01125 Patent Owner's Preliminary Response at 40.

The Board concurred with Patent Owner in rendering its decision as to IPR2015-01125:

> As to claims 3, 4, 7, and 8, we agree with Patent Owner that Petitioner has not offered adequate evidence demonstrating that Maeshima and/or Breck disclose or otherwise suggest a zeolite having an SAR value above 20. It is uncontested that Breck does not expressly disclose an

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