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Paper No. 14
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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 8,404,203 B2

Before CHRISTOPHER L. CRUMBLEY, JO-ANNE M. KOKOSKI, and JEFFREY W. ABRAHAM, *Administrative Patent Judges.*

KOKOSKI, *Administrative Patent Judge.*

DECISION
Patent Owner's Request for Rehearing
37 C.F.R. § 42.71(d)

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On November 16, 2015, BASF Corporation ("Patent Owner") filed a Request for Rehearing (Paper 11, "Req. Reh'g") of our Decision instituting *inter partes* review of claims 1–31 of U.S. Patent No. 8,404,203 B2 ("the '203 patent") (Paper 8). Patent Owner's basis for requesting rehearing is its contention that the Board overlooked arguments demonstrating Petitioner failed to establish that the cited prior art discloses all of the elements of claims 17, 18, 21, and 22. Req. Reh'g 1–2, 4–5.

Specifically, Patent Owner contends that we "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." Req. Reh'g 1 (citing Prelim. Resp. 39–40, 46). Patent Owner contends that the limitations in claims 17, 18, 21, and 22 of the '203 patent are identical to those in claims 3, 4, 7, and 8 of related U.S. Patent No. 7,601,662 ("the '662 patent"), which is the subject of IPR2015-01125 (the "1125 IPR"), also filed by Petitioner. *Id.* at 1, 4–5. Patent Owner further contends that Petitioner made identical allegations in this proceeding with respect to the obviousness of claims 17, 18, 21, and 22 as it did in the 1125 IPR with respect to the obviousness of claims 3, 4, 7, and 8 of the '662 patent. *Id.* at 4. Patent Owner notes that in the 1125 IPR, the Board agreed with Patent Owner that Petitioner did not establish adequately that Maeshima, Breck, and/or Dedecek disclose or suggest the SAR values recited in claims 3, 4, 7, and 8, and declined to institute *inter partes* review as to those claims. *Id.* at 5–6 (citing 1125 IPR Paper 9, 17–18, 23). Petitioner did not request rehearing of the Board's decision denying institution with respect to claims 3, 4, 7, and 8 in the 1125 IPR.

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We agree that we overlooked Patent Owner's arguments that Petitioner failed to demonstrate sufficiently that Maeshima, Breck, and Dedecek disclose or suggest the SAR values recited in claims 17, 18, 21, and 22. Upon further consideration, we agree with Patent Owner that Petitioner has not offered adequate evidence demonstrating that the higher SAR values required by claims 17, 18, 21, and 22 would have been obvious to a person having ordinary skill in the art over the combination of Maeshima and Breck, or over the combination of Dedecek and Breck. *See, e.g.,* Pet. 13–14, 43; Ex. 1108 ¶¶ 122–129.

Patent Owner's Request for Rehearing is granted.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's Request for Rehearing is granted; and

FURTHER ORDERED that the Order instituting trial is modified so that the trial is limited to the following grounds:

Whether claims 1, 14, 15, 19, 20, 26, and 27 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Maeshima and Breck;

Whether claims 2–13, 16, 23–25, and 28–31 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Maeshima, Breck, and Patchett;

Whether claims 1, 14, 15, 19, 20, 26, and 27 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Dedecek and Breck; and

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Whether claims 2–13, 16, 23–25, and 28–31 are unpatentable under 35 U.S.C. § 103(a) as obvious over the combination of Dedecek, Breck, and Patchett.

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