

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

E. I. DU PONT DE NEMOURS AND COMPANY AND
ARCHER-DANIELS-MIDLAND COMPANY,

Petitioners

v.

FURANIX TECHNOLOGIES B.V.,

Patent Owner.

Case IPR2015-01838

Patent 8,865,921 B2

Before TONI R. SCHEINER, SHERIDAN K. SNEDDEN, and
CHRISTOPHER G. PAULRAJ, *Administrative Patent Judges*.

PAULRAJ, *Administrative Patent Judge*.

DECISION

Request for Rehearing

37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioners E. I. du Pont de Nemours and Company and Archer-Daniels-Midland Company (collectively, “Petitioners”) request reconsideration of our March 9, 2016 Decision on Institution of *Inter Partes* Review in this proceeding (“Decision,” Paper 10) with respect to our denial of institution of Ground 2. Paper 12 (“Req.”). In our Decision, we instituted *inter partes* review of claims 1–5 and 7–9 of U.S. Patent No. 8,865,921 B2 (“the ’921 patent,” Ex. 1001) on obviousness grounds. We denied institution, however, of Petitioners’ obviousness challenge of claims 6 and 10 based on the ’732 publication (Ex. 1002), the ’018 patent (Ex. 1004), RU ’177 (Ex. 1003), and the ’318 application (Ex. 1008). Decision, 16–17. Petitioners request rehearing of our denial of this ground on the basis that we misapprehended and/or overlooked the totality of Petitioners’ arguments based on the ’018 patent, and how those teachings render claims 6 and 10 obvious. Req. 1.

The applicable standard for a request for rehearing of an institution decision is abuse of discretion. 37 C.F.R. § 42.71(c). The requirements are set forth in 37 C.F.R. § 42.71(d), which provides, in relevant part, that “[t]he burden of showing a decision should be modified lies with the party challenging the decision,” and that “[t]he 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.”

For the reasons set forth below, Petitioners’ request for rehearing is denied.

II. ANALYSIS

In our Decision, we determined that Petitioners failed to demonstrate a reasonable likelihood that the cited prior art teachings render obvious the requirement in dependent claims 6 and 10 that the feed used for the preparation of 2,5-furan dicarboxylic acid (“FDCA”) comprises an ester of 5-hydroxymethylfurfural (“HMF”). We noted that Petitioners relied primarily upon the teaching of the ’018 patent in which an “ester derivative” refers to the formation of an ester of FDCA (e.g., 5-(alkoxycarbonyl) furancarboxylic acid (AcMFA)), not the use of an ester of HMF to form FDCA as required by claims 6 and 10. Decision, 16–17. Although we recognized that Example 15 of the ’018 patent separately describes the oxidation of acetoxymethylfurfuryl, we noted that Petitioners failed to provide any explanation of the relevance of this teaching other than a single cursory citation in the Petition. *Id.* at 17 (citing Petition 42, Ex. 1004, 12:9–16).

In their request for reconsideration, Petitioners assert that the Petition’s citation to teachings of the ’018 patent regarding “ester-acid derivatives of HMF” and “products [that] can be further oxidized to form . . . FDCA” refer to esters of HMF. Req. 4 (citing Petition 41; Ex. 1004, 1:11–23). Petitioners further assert that “[d]irectly after citing Example 15, the Petition states that ‘[p]reparing *FDCA* by using the ester of *HMF* and acetic acid instead of or in combination with *HMF* is expressly suggested by the ’018 patent, and therefore obvious.’” *Id.* (citing Petition 42). Additionally, Petitioners contend that “the Petition states that during [the] original prosecution, the Examiner and the Patent Owner understood that the

oxidation of HMF esters to FDCA were well known.” *Id.* at 5 (citing Petition 32–33).

Petitioners have not demonstrated that we misapprehended or overlooked any of the arguments or evidence presented in the Petition with respect to claims 6 and 10. We previously considered the cited teachings of the ’018 patent highlighted in Petitioners’ reconsideration request, but did not find any support for Petitioners’ contention that “ester-acid derivatives of HMF” or “products [that] can be further oxidized to form . . . FDCA” refer to esters of HMF, as opposed to esters of FDCA. Decision, 17. As we previously noted, an ester of FDCA is not the same as an ester of HMF. *Id.* (citing Ex. 1009 ¶¶ 22–23, 32). Moreover, Petitioners’ additional arguments relying upon statements made during prosecution are unpersuasive insofar as the Petition did not rely upon or cite to the prosecution history to support its obviousness arguments for claims 6 and 10. Petition, 40–45. A request for rehearing is not an opportunity to present new arguments not previously presented in the Petition.

III. ORDER

In consideration of the foregoing, it is:

ORDERED that Petitioners’ request for rehearing is denied.

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