

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BASF CORPORATION,
Petitioner,

v.

INGEVITY SOUTH CAROLINA, LLC,
Patent Owner.

Case IPR2019-00202
Patent RE 38,884

Before DONNA M. PRAISS, CHRISTOPHER L. CRUMBLEY, and
JON B. TORNQUIST, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

Petitioner BASF Corporation contacted the Board seeking authorization to file a reply to Patent Owner Ingevity South Carolina, LLC's Preliminary Response, and requested a conference call with the panel. On April 1, 2019, Judges Praiss, Crumbley, and Tornquist held a conference call

with counsel for both parties. A court reporter was present during the call, and BASF agreed to file the transcript in the record once it is available.

The details of the parties' positions will be reflected in the reporter's transcript and need not be repeated herein. In summary, BASF sought authorization to file a five-page brief responding to Ingevity's arguments on the use of inherency in an obviousness ground of unpatentability, because the Preliminary Response allegedly misstates the law and mischaracterizes BASF's arguments in its Petition. At the end of the call, the panel took the matter under advisement.

Upon reflection, we deny authorization for BASF to file the requested briefing. As counsel for BASF recognized during the call, the Board is familiar with the law of obviousness. To the extent that the Preliminary Response has misstated the law or BASF's positions, there is no reason those misstatements will not be apparent upon the Board's review of the papers filed to date. Our initial review of the Petition and Preliminary Response does not reveal any issues on which we currently believe further briefing would be necessary or beneficial.

Counsel for BASF directed our attention to a recent Board decision in *Neptune Generics, LLC, v. Aventis Generics S.A.*, Case IPR2019-00136 (Paper 11) (PTAB Mar. 1, 2019), in which the panel permitted additional briefing pre-institution to address alleged misstatements of the law of obviousness in the preliminary response. We have reviewed the Board's order in *Neptune Generics* and find the current case distinguishable. First, we note that in *Neptune Generics*, the preliminary response addressed Board decisions that post-dated the filing of the petition, and therefore the petitioner there had not had the opportunity to address these cases. *Id.* at 3.

The same is not true here, where the alleged misstatements of law center on the interpretation of two Federal Circuit decisions—*Par Pharmaceutical, Inc. v. TWi Pharmaceuticals, Inc.*, 773 F.3d 1186 (Fed. Cir. 2014) and *Honeywell International v. Mexichem Amanco Holding*, 865 F.3d 1348 (Fed. Cir. 2017)—that issued well before the filing of the Petition.

In addition, the requested briefing in *Neptune Generics* was primarily requested to address arguments other than obviousness; specifically, newly-raised arguments based on denial of institution under 35 U.S.C. §§ 314(a) and 325(d). *Id.* Therefore, although the Board noted that it “is familiar with the law of obviousness, and capable of determining whether the law’s requirements have been misstated,” the panel stated that, in the authorized brief, the petitioner “may (though need not)” address the obviousness issue. *Id.* Here, by contrast, BASF seeks a brief for the sole purpose of addressing obviousness. As discussed above, we see no reason to authorize additional briefing for this purpose alone.

For these reasons, we *deny* BASF’s request for authorization to file a reply to the Preliminary Response. The Board’s decision regarding institution of trial will issue in due course.

In light of the foregoing, it is:

ORDERED that BASF is not authorized to file a reply to the Preliminary Response.

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