

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TIDE INTERNATIONAL (USA), INC.,
Petitioner,

v.

UPL NA INC.,
Patent Owner.

IPR2020-01113
Patent 7,473,685 B2

Before SUSAN L. C. MITCHELL, ZHENYU YANG, and
MICHAEL A. VALEK, *Administrative Patent Judges*.

Opinion of the Board filed by *Administrative Patent Judge VALEK*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Tide International (USA), Inc., (“Petitioner”) filed a Petition (Paper 2, “Pet.”), seeking *inter partes* review of claims 1–4 and 7–12 of U.S. Patent No. 7,473,685 B2 (Ex. 1001, “the ’685 patent”). UPL NA, Inc., (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

In its Preliminary Response, Patent Owner asked the Board to apply its discretion under 35 U.S.C. § 314(a) to deny institution “in view of the advanced stage of the related district court proceeding” involving the same patent and parties. Prelim. Resp. 2. Although Petitioner addressed the issue in the Petition, the district court litigation was apparently stayed at that time. Pet. 68. After the Petition was filed, but prior to Patent Owner’s Preliminary Response, the district court lifted that stay and set new deadlines, including a jury trial to commence on August 3, 2021. Ex. 2001, 1. Given this change, we granted Petitioner’s request for leave to file a reply to the Preliminary Response to address “the status of the related district court proceeding . . . and Patent Owner’s allegations regarding overlapping references” asserted therein. Paper 9, 2 (quoting Ex. 3001). Petitioner filed its reply. Paper 10 (“Reply”). Patent Owner filed an authorized sur-reply. Paper 11 (“Sur-Reply”).

Upon consideration of the parties’ briefing, and for the reasons explained below, we decide not to exercise our discretion to deny institution under 35 U.S.C. §§ 314(a) or 325(d). We further determine that Petitioner has satisfied the threshold requirement to show a reasonable likelihood that it would prevail with respect to at least one claim challenged in the Petition. Accordingly, we institute an *inter partes* review of claims 1–4 and 7–12 of

the '685 patent on all of the grounds of unpatentability asserted in the Petition.

II. BACKGROUND

A. Real Parties in Interest

Petitioner identifies itself, “Tide International (USA), Inc.,” as well as “Zhejiang Tide Cropscience Co. Ltd., Ningbo Tide Imp. & Exp. Co., Ltd., and Tide International Company Limited” as the real parties-in-interest. Pet. 73. Petitioner explains that Tide International Company Limited is its parent corporation and that “the remaining parties are defendants in co-pending litigation.” *Id.* Patent Owner identifies itself, “UPL NA Inc.,” as the real party-in-interest. Paper 3, 1.

B. Related Matter

Petitioner and Patent Owner identify the following related matter involving the '685 patent: *UPL NA Inc. v. Tide International (USA), Inc.*, No: 8:19-cv-1201-RSWL-KS (C.D. Cal. 2019). Pet. 73; Paper 3, 1. We refer to this matter herein as the “related litigation.”

C. The '685 Patent

The '685 patent was issued on January 6, 2009, and claims priority to a utility application filed on April 22, 2002, and a provisional application filed December 18, 2001. Ex. 1001, 1 (63, 60).

The '685 patent relates to “[d]ry flow, low compact, dust free, soluble granules” containing the pesticide “acephate” in combination with certain other ingredients, and processes for making such. Ex. 1001, Abstr.

According to the Specification, “[t]he formulation of acephate presently in

containing 2 to 18 carbon atoms or an alkynyl group containing 3 to 18 carbon atoms, R³ is hydrogen or an alkyl group containing 1 to 6 carbon atoms, and Y is oxygen or sulfur, wherein said insecticidal active compound is Acephate:

- (ii) 0.1-5.0% w/w a dispersing agent;
- (iii) 0.1-3% w/w a wetting agent;
- (iv) 0.01-0.08% w/w an antifoaming agent;
- (v) 0.01-1% w/w a stabilizer and
- (vi) fillers to make 100%,

wherein said granule has a length of 1.5-3.0 mm and a diameter of 0.5-1.5 mm.

Ex. 1001, 7:44–8:4. Claim 7 is directed to a granule consisting of the same ingredients as claim 1, but additionally recites the presence of a “binding agent” and “disintegrating agent” in the granule. *See id.* at 8:19–48.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claims Challenged	35 U.S.C. §	References
1–4, 7–12	103(a) ¹	Misselbrook, ² CN '588, ³ JP '902, ⁴
1–4, 7–12	103(a)	Misselbrook, Mayer, ⁵ CN '588

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. §§ 102 and 103 that became effective after the filing of the application that led to the '685 Patent.

Therefore, we apply the pre-AIA versions of 35 U.S.C. §§ 102 and 103.

² U.S. Patent No. 6,387,388 B1, issued May 14, 2002 (Ex. 1005) (“Misselbrook”).

³ CN 1127588A, published July 31, 1996 (Ex. 1006). Petitioner has provided a certified translation (Ex. 1007), which we refer to and cite herein as “CN '588.”

⁴ JP 9-315902, published Dec. 9, 1997 (Ex. 1008). Petitioner has provided a certified translation (Ex. 1009), which we refer to and cite herein as “JP '902.”

⁵ U.S. Patent No. 6,030,924, issued Feb. 29, 2000 (Ex. 1010) (“Mayer”).

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