

**From:** [Suh, Howard S.](#)  
**To:** [Trials](#)  
**Cc:** [Ferri, Lisa M.](#); [Bonner, Amanda Streff](#); [Norton, Gerard P.](#); [Miller, Ryan N.](#)  
**Subject:** RiceTec, Inc. v. BASF SE, PGR2021-00113, PGR2021-00114: Request for authorization to reply to Patent Owner's Preliminary Response  
**Date:** Wednesday, December 29, 2021 4:45:20 PM  
**Attachments:** [RE EXT RiceTec Inc. v. BASF SE PGR2021-00113 PGR2021-00114.msg](#)  
[EXT RE RiceTec v. BASF Cases PGR2021-00113 PGR2021-00114.msg](#)

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Your Honors:

Petitioner RiceTec, Inc. requests authorization to file a reply to Patent Owner's Preliminary Response in the above captioned matters.

The issues upon which Petitioner seeks reply are as follows:

- Patent Owner's statements regarding the relevance of the prosecution history of Petitioner's patent applications while maintaining that the prosecution of BASF applications and patents within the same family are irrelevant. *See e.g.* POPR, PGR2021-00113 at 12-18, n. 5.
- Patent Owner's statements that possession of the inventions is shown because a POSITA reviewing the Mankin PCT and Neuteboom would have a "reasonable expectation of success" of arriving at the claimed inventions. *See e.g.* POPR, PGR2021-00113 at 67, Burgos Decl. at ¶ 40-42, 73-78.
- Patent Owner's statements that the claimed effective amount ranges of the FOPs herbicides are "unimportant" for purposes of practicing the invention and that "no prior art was distinguished from and no rejection was overcome on the basis of the claimed effective amount ranges of herbicides." *See e.g.* POPR, PGR2021-00113 at 74.
- Patent Owner's statements that RiceTec does not dispute that most of the limitations of the challenged claims have written description and enablement support in the priority documents and that RiceTec only challenges a "few limitations" identified by Patent Owner in a subsequent section of the response. *See e.g.* POPR, PGR2021-00113 at 24-25, Section VIII.B.

Counsel for Petitioner and counsel for Patent Owner, who are also copied on this email, met and conferred on December 29, 2021 and Patent Owner opposes Petitioner's request for leave to file the reply papers.

A copy of the Petitioner's email to Patent Owner requesting the meet and confer and Patent Owner's response formally opposing Petitioner's request are attached here.

Petitioner requests a conference call with the Board to seek authorization to file a reply at the Board's convenience. Petitioner and Patent Owner are available for such a call on January 4<sup>th</sup> or 5<sup>th</sup>

from 2:00 – 5:00 p.m. of next week or at another time more convenient to the Board as it sees fit.

Very best regards,

**Howard Suh / Counsel for Petitioner (pro hac vice)**

Partner

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