

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RIMFROST AS,
Petitioner,

v.

AKER BIOMARINE ANTARCTIC AS,
Patent Owner.

IPR2018-00295
Patent 9,320,765 B2

Before TINA E. HULSE, JACQUELINE T. HARLOW, and JOHN E.
SCHNEIDER, *Administrative Patent Judges*.

SCHNEIDER, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding Relating to Request on Rehearing of
Final Written Decision
37 C.F.R. § 42.71(d)

I. INTRODUCTION

On June 12, 2019, the Board issued a Final Written Decision in this proceeding, which included a decision on Patent Owner’s Motion to Amend. Paper 35 (“Final Dec.”). In the Decision, we determined that claims 1–48 of U.S. Patent No. 9,320,765 (“the ’765 patent”) and proposed claims 49–56 were unpatentable over the prior art of record. *Id.* at 69.

On July 12, 2019, Patent Owner, Aker Biomarine Antarctic AS, filed a timely Request for Rehearing under 37 C.F.R. § 42.71(d). Paper 36 (“Req. Reh’g”). On August 15, 2019, Petitioner, Rimfrost AS, with our authorization, filed a Response to the Request for Rehearing. Paper 37 (“Resp. Req. Reh’g”). Patent Owner, with our authorization, filed a Reply on September 4, 2019. Paper 38 (“Reply Req. Reh’g”).

The asserted grounds for rehearing relate to the Board’s reliance on the teachings of Randolph¹ concerning levels of esterified astaxanthin in finding the proposed claims unpatentable. Req. Reh’g 1–2. For the reasons discussed below, we are persuaded that we erred in the Decision, and authorize supplemental briefing on a substantive issue raised in Patent Owner’s Request for Rehearing.

II. LEGAL STANDARD

A request for rehearing “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.” 37 C.F.R. § 42.71(d). The burden of showing a decision should be modified on a request for rehearing lies with the party challenging the decision. *Id.*

¹ Russell K. Randolph et al., US 2005/0058728 A1, published Mar. 17, 2005 (Ex. 1011, “Randolph”).

III. ANALYSIS

Patent Owner contends that the Board erred by rejecting the proposed claims over a combination of references not proposed by Petitioner. Req. Reh'g 7. Patent Owner contends that the Board should have limited its analysis of the proposed claims to the combinations of references advanced in the Petition and the Opposition to Patent Owner's Motion to Amend the Claims. *Id.* Patent Owner also contends that the Board's holding is legal error in view of the Administrative Procedure Act, Federal Circuit precedent, and the PTO's own Trial Practice Guide. *Id.*

Patent Owner contends that because Petitioner only advanced an argument that the proposed claims were unpatentable over Sampalis, Catchpole, Fricke, and NKO, it was improper for the Board to base its decision that the claims were unpatentable over Sampalis, Catchpole, Fricke, and Randolph. *Id.* Patent Owner also contends that the Board erred in that Petitioner did not set forth a motivation to combine Sampalis, Catchpole, Fricke, and Randolph. Req. Reh'g 8.

Petitioner responds that the Board's actions were proper as the Board is obligated to base its findings on the entire record. Resp. Req. Reh'g 6. Petitioner contends that Randolph was properly before the Board as Petitioner properly submitted evidence and arguments regarding the teachings of Randolph in response to Patent Owner's arguments regarding the patentability of the proposed claims. *Id.* at 7.

In reply, Patent Owner contends that even if the Board could properly consider a combination including Randolph, such combination nevertheless fails to establish the unpatentability of the proposed amended claims, as the ordinarily skilled artisan would not have been motivated to combine the teachings of the references or had a likelihood of success in doing so. Reply

Req. Reh’g 2–5. Patent Owner also contends that Petitioner’s assertion that Randolph teaches a composition with 158 mg of astaxanthin ester is in error and that Randolph teaches using a higher amount. *Id.* at 6–7.

We have considered the parties’ arguments and discern that we erred in concluding that proposed claims 49–56 are unpatentable over Sampalis, Catchpole, Fricke, and Randolph without affording Patent Owner the opportunity to fully address Petitioner’s argument concerning the teachings of Randolph.

Our reviewing court has held that “the Board must consider the entirety of the record before it when assessing the patentability of amended claims under § 318(a) and must justify any conclusions of unpatentability with respect to amended claims based on that record.” *Aqua Prods., Inc. v. Matal*, 872 F.3d 1290, 1296 (Fed. Cir. 2017). The PTO’s “Guidance on Motions to Amend in view of *Aqua Products*” specifically provides that “[t]he Board will proceed to determine whether the substitute claims are unpatentable by a preponderance of the evidence *based on the entirety of the record*, including any opposition by the petitioner.” Memorandum from David P. Ruschke, Chief Administrative Patent Judge, to Patent Trial and Appeal Board (Nov. 21, 2017), https://www.uspto.gov/sites/default/files/documents/guidance_on_motions_to_amend_11_2017.pdf”), 2 (emphasis added).

While the record contains evidence regarding the teachings of Randolph, Petitioner did not apply Randolph to the proposed claims until it filed its Sur-Reply. Petitioner’s Sur-Reply to Patent Owner’s Motion to Amend at 10 (paper 30). Given that no further briefing was permitted, we agree with Patent Owner that it has not had an adequate opportunity to respond to this evidence, a possible violation of the Administrative

Procedure Act. Req. Reh'g 10–12. We therefore determine that it is appropriate to allow further briefing on the issue of whether the combined teachings of Sampalis, Catchpole, Fricke, and Randolph render the proposed claims unpatentable.

Patent Owner is authorized to file a Supplemental Brief addressing the issue within 10 business days of this decision. The Supplemental Brief shall be limited to 10 pages. Petitioner is authorized to file a response to Patent Owner's Supplemental Brief within 10 business days after the Supplemental Brief is filed. Petitioner's Response shall be limited to 10 pages. Patent Owner may file a Reply within 5 business days after the Response is filed. Patent Owner's Reply shall be limited to 10 pages.

IV. CONCLUSION

For the foregoing reasons, we allow further briefing as discussed above. Once the record is complete, the panel will evaluate Patent Owner's Request for Rehearing in full and reconsider whether the combined teachings of Sampalis, Catchpole, Fricke, and Randolph render the proposed claims unpatentable.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner is authorized to file a Supplemental Brief, not to exceed ten pages, within 10 business days of this decision;

FURTHER ORDERED that Petitioner is authorized to file a Response to Patent Owner's Supplemental Brief, not to exceed ten pages, within 10 business days of Patent Owner's filing of its Supplemental Brief; and

FURTHER ORDERED that Patent Owner is authorized to file a Reply to Petitioner's Response, not to exceed 10 pages, within 5 business days of Petitioner's filing of its Response.

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