

[BoxInterferences@uspto.gov](mailto:BoxInterferences@uspto.gov)  
Tel: 571-272-4683

Paper 260  
Entered: March 16, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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ANAI LEVIN  
and MICHAEL GRABARNICK,  
Junior Party,  
(Application 13/926,389)

v.

ANDREA PASTORIO  
and PAOLO BETTI  
Senior Party,  
(Patent 8,304,559)

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Patent Interference No. 105,995  
(Technology Center 1600)

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Before RICHARD E. SCHAFER, SALLY GARDNER LANE, and DEBORAH  
KATZ, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

**JUDGMENT - Bd. R. 127(a)**

A decision denying the junior party Levin motion for judgment on priority (Levin Priority Motion, Paper 174) and motion for judgment that the Pastorio involved claims are unpatentable (Levin Motion 4, Paper 175) has been entered. (Decision, Paper 259). In view of the Decision, judgment on priority is entered against Levin.

### Order

It is

ORDERED that judgment on priority is entered against junior party Levin as to Count 2, the sole Count of the interference (Redeclaration 2, Paper 145, at 3);

FURTHER ORDERED that claims 1-10 of Levin application 13/926,389, which correspond to Count 2, are FINALLY REFUSED. 35 U.S.C. § 135(a);<sup>1</sup>

FURTHER ORDERED that the parties are directed to 35 USC § 135(c) and Bd. R. 205 regarding the filing of settlement agreements;

FURTHER ORDERED that a party seeking judicial review timely serve notice on the Director of the United States Patent and Trademark Office. 37 C.F.R. §§ 90.1 and 104.2. *See also* Bd. R. 8(b). Attention is directed to *Biogen Idec MA, Inc., v. Japanese Foundation for Cancer Research*, 785 F.3d 648, 654–57 (Fed. Cir. 2015) (determining that pre-AIA § 146 review was eliminated for interference proceedings declared after September 15, 2012); and

FURTHER ORDERED that a copy of this judgment be entered into the administrative records of the involved Levin application and Pastorio patent.

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<sup>1</sup> Any reference to a statute in this Judgment is to the statute that was in effect on March 15, 2013 unless otherwise indicated. See Pub. L. 112-29, § 3(n), 125 Stat. 284, 293 (2011).

cc (via electronic):

Attorney for Levin:

Gary J. Gershik  
Norman H. Zivin  
COOPER & DUNHAM, LLP  
ggershik@cooperdunham.com  
nzivin@cooperdunham.com

Attorney for Pastorio:

E. Anthony Figg  
R. Danny Huntington  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
efigg@rfem.com  
dhuntington@rfem.com

[BoxInterferences@uspto.gov](mailto:BoxInterferences@uspto.gov)  
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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ANAI LEVIN  
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Patent Interference No. 105,995  
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Before RICHARD E. SCHAFER, SALLY GARDNER LANE, and DEBORAH  
KATZ, *Administrative Patent Judges*.

LANE, *Administrative Patent Judge*.

Decision on Priority and other Motions – Bd. R. 121(a)

## I. Introduction

Earlier in the proceeding a decision on the non-priority motions was entered. (Decision on Non-Priority Motions, Paper 144). In that decision, we granted Pastorio Motion 2 to substitute Count 2 for Count 1 and accorded Pastorio additional priority benefit as to Count 2 such that Pastorio is now senior party in the interference. (Decision on Non-Priority Motions at 27 and Redeclaration 2, Paper 145).

We now have before us a motion by each party seeking judgment on the basis of priority as to Count 2. In addition, Levin was authorized to file (Order Authorizing Motion, Paper 155), and did file, a motion seeking judgment that the Pastorio involved claims are unpatentable over a prior art reference.

Thus, the following motions are before us for decision.<sup>1</sup>

### *Levin*

1. Levin Motion 3 for judgment on the basis of priority. (Levin Priority Motion, Paper 174). Pastorio filed an opposition to this motion (Pastorio Opposition 3, Paper 229). Levin filed a reply. (Levin Reply 3, Paper 248).
2. Levin Motion 4 for judgment that the Pastorio involved claims are unpatentable over certain prior art. (Levin Motion 4, Paper 175).<sup>2</sup> Pastorio filed an opposition to this motion (Pastorio Opposition 4, Paper 227). Levin filed a reply. (Levin Reply 4, Paper 251). Pastorio was authorized to file (Order of 19

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<sup>1</sup> The parties' requests for oral argument were considered but the Board has determined that no oral argument is necessary. (Levin Request, Paper 254 and Pastorio Request, Paper 255).

<sup>2</sup> Levin filed a notice informing the Board that it has filed a petition for inter partes review of the involved Pastorio patent. (Levin Updated Notice of Related Proceedings, Paper 257, referring to IPR2016-00577).

November 2015, Paper 252) and did file, a surreply. (Pastorio Surreply 4, Paper 253).

*Pastorio*

1. Pastorio Motion 4 for judgment on the basis of priority. (Pastorio Priority Motion, Paper 177). Levin filed an opposition to this motion (Levin Opposition 4, Paper 230). Pastorio filed a reply. (Pastorio Reply 4, Paper 249).

We deny the Levin Priority Motion and Levin Motion 4.

We dismiss as moot the Pastorio Priority Motion.

II. Findings of Fact

The record supports the following findings of fact, as well as any other findings of fact set forth in this Decision, by a preponderance of the evidence.

*The parties*

1. The interference was declared on 6 February 2014 between now senior party Pastorio and now junior party Levin. (Declaration, Paper 1).
2. The involved Pastorio patent is 8,304,559, issued on 6 November 2012 from application 13/498,245, filed 26 March 2012. (Ex 2001).
3. Pastorio identifies its real party in interest as Finchimica S.p.A. (Pastorio Notice of Real Party in Interest, Paper 8).
4. The involved Levin application is 13/926,389, filed 25 June 2013.
5. Levin identifies its real party in interest as Makhteshim Chemical Works Ltd. (Levin Notice of Real Party in Interest, Paper 6).

*The Count and claims*

6. Count 2, the sole count of the interference, is as follows:

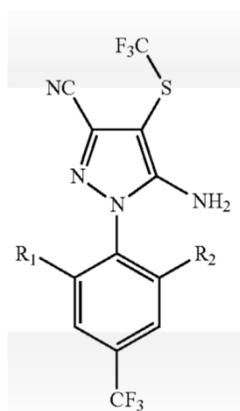
Claim 1 of Pastorio (8,304,559)

or

Claim 2 of Levin (13/926,389).

(Redeclaration 2, Paper 145, at 3).

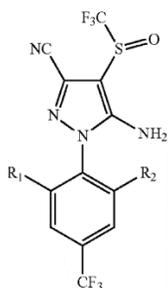
7. The Count, Count 2, generally is directed to a method of making the insecticidal compound fipronil by oxidation of the following compound in the presence of dichloroacetic acid [DCA] and an oxidizing agent such as hydrogen peroxide:



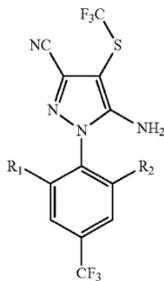
where the oxidation is conducted in the absence of trichloroacetic acid [TCA] and/or trichloroperacetic acid [TCPA] and may be conducted in the presence of a strong acid such as sulfuric acid.

8. Claim 1 of Pastorio is as follows:

A method for the preparation of the compound having the following general formula (I):



wherein R1 and R2 are independently hydrogen or halogen; through oxidation of a compound having the general formula (II) in the presence of dichloroacetic acid and of an oxidising agent:

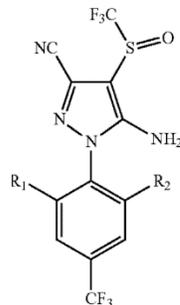


wherein R1 and R2 are defined as above, where the oxidising agent is selected from the group comprising benzoyl peroxides, sodium peroxides, t-butyl peroxides and/or hydrogen peroxide, and wherein the oxidation is conducted in the absence of trichloroacetic and/or trichloroperacetic acid.

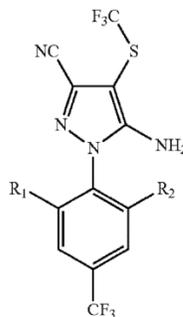
(Pastorio Clean Copy of Claims, Paper 11).

9. Levin Claim 1 is as follows:

1. A method for the preparation of the compound having the following general formula (I):



wherein R<sub>1</sub> and R<sub>2</sub> are chlorine; through oxidation of a compound having the general formula (II) in the presence of dichloroacetic acid, of an oxidizing agent, and of a strong acid:



wherein R<sub>1</sub> and R<sub>2</sub> are defined as above, where the oxidizing agent is hydrogen peroxide, and where the strong acid is sulfuric acid.

(Levin Clean Copy of Claims, Paper 4).

10. Pastorio claims 1-12<sup>3</sup> are designated as corresponding to Count 2.

(Redeclaration 2, Paper 145, at 3).

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<sup>3</sup> Pastorio statutorily disclaimed claims 13-15 of its involved patent such that now only its claims 1-12 are involved in the interference. (Pastorio Disclaimer, Paper 26).

11. Levin claims 1-10 are designated as corresponding to Count 2.  
(Redeclaration 2, Paper 145, at 3).

*Priority Benefit*

12. Pastorio is accorded priority benefit of the following for Count 2:

PCT/IB2011/052304, filed 26 May 2011

Italian Patent Application No. BS2010A0118, filed on 7 July 2010

(Declaration, Paper 1, at 5 and Redeclaration 2, Paper 145, at 3).

13. Levin is accorded priority benefit of the following for Count 2:

US13/809,327, filed 14 March 2013

PCT/IL/2011/000546, filed 10 July 2011

US 61/363,366, filed 12 July 2010.

(Redeclaration, Paper 15, at 2).

*Testimony*

14. Inventors Dr. Michael Grabarnick and Dr. Anat Levin provided testimony to support the Levin priority motion. (Grabarnick Declaration, Ex 1039 and Levin Declaration, Ex 1045).

15. Mr. Michael Mogilnitsky, said to be a colleague of Dr. Grabarnick and Dr. Levin, also provided testimony to support the Levin priority motion. (Mogilnitsky Declaration, Ex 1041).

16. Because Levin did not make Dr. Grabarnick, Dr. Levin or Mr. Mogilnitsky available for cross-examination, their testimony was excluded. (Decision of 1 October 2015, Paper 219, at 5, citing, at 3, ¶ 157.3<sup>4</sup>).

17. Levin did not request reconsideration of the Decision of 1 October 2015.

18. Dr. Gordon Gribble also provided testimony on behalf of Levin at, e.g., Fifth Gribble Declaration, Ex 1042 and Sixth Gribble Declaration, Ex 1044).

19. Based on his education and professional experience (see First Gribble Declaration, Ex 1001 at 2-4, and *curriculum vitae*, Ex 1002) we determine Dr. Gribble is qualified to testify about issues relevant to the interference.

#### *Levin Priority Motion*

20. In its Priority Motion, Levin argues that it reduced to practice an invention of the Count prior to Pastorio's earliest accorded benefit date of 7 July 2010. (Levin Priority Motion at 1:11-15).

21. In particular, Levin argues that the Levin inventors reduced to practice an invention of the Count on three separate occasions, two occasions occurring on 23 May 2010 and another on 15 June 2010. (Levin Priority Motion at 1:11-15 and 11:1-14:10).

22. In support of its Priority Motion Levin relies upon, *inter alia*, the testimony of Dr. Grabarnick, Dr. Levin, Mr. Mogilnitsky, and Dr. Gribble to show that the

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4 **¶ 157.3 Cross examination**

The party relying on an affiant must make the affiant available for cross examination; otherwise, the affidavit may be excluded. The parties must confer to reach agreement on reasonable times, dates and location for cross examination of witnesses.

inventors made fipronil using a method of the Count prior to Pastorio's earliest accorded benefit date. (Levin Priority Motion at 11:1-14:10).

*Levin Motion 4 (for judgment based on unpatentability)*

23. In its Motion 4, Levin moves for judgment on the basis that the Pastorio involved claims are unpatentable over WO 2007/122440 A1, published 01 November 2007. (Gharda, Ex 2009). (Levin Motion 4, Paper 175).
24. In its Motion 4 Levin relies upon, *inter alia*, the declaration testimony of Dr. Gribble. (Sixth Gribble Declaration, Ex 1044).
25. Relevant to the patentability issue is the proviso in the Pastorio claims that "the oxidation is conducted in the absence of trichloroacetic (TCA) and/or trichloroperacetic acid (TCPA)."
26. Gharda on the other hand calls for a reaction medium comprising TCA and an oxidizing agent (e.g., hydrogen peroxide) or the "pre-made" reaction product(s) of the oxidizing agent and trichloroacetic acid, i.e., TCPA. (Gharda, Ex 2009, at e.g., 4:1-5 and 8:21-9:2).
27. In particular, Gharda states that in a preferred embodiment TCPA is formed "in situ" by contacting hydrogen peroxide with TCA but that TCPA can be pre-made and used in the medium instead but "with no particular advantage". (Gharda at 8:21-9:2).
28. Gharda discloses DCA to be a poor medium for oxidation. (Gharda at 9:17-21).
29. Gharda discloses TCA to be an effective alternative medium for the production of fipronil when used with a melting point depressant. (Gharda at 1:23-2:9).

30. According to Gharda, DCA is included in the reaction medium “only to sufficiently depress the melting point of [TCA] to facilitate ease of processing.” (Gharda at 9:17-21).

### III. Discussion

To be sufficient a motion must provide a showing, supported with appropriate evidence, such that, if unrebutted, would justify the relief sought. Bd. R. 208(b). Where the evidence includes technical data, the party relying upon the data must provide evidence explaining the data sufficient to allow the Board to evaluate the data. Bd. R. 158(b)

#### A. Levin Priority Motion

Priority of invention goes to the first party to reduce to practice an invention of the Count unless the other party can show that it was the first to conceive the invention and that it exercised reasonable diligence in later reducing to practice that invention. *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998). Here Levin argues that it reduced to practice an invention of the Count prior to Pastorio’s earliest constructive reduction to practice date of 7 July 2010. (Levin Priority Motion at 14:8-10). Since Levin does not assert or provide a showing of diligence, it cannot prevail on the basis of having had an earlier conception coupled with the reasonable exercise of diligence.

In order to establish an actual reduction to practice, the inventor must prove that the inventor: (1) constructed an embodiment or performed a process that met all the limitations of the interference count, and (2) determined that the invention would work for its intended purpose. *Cooper v. Goldfarb*, 154 F.3d at 1327.

Levin alleges that it first reduced to practice an invention of the Count on

23 May 2010. (Levin Priority Motion at 10:11-11:3). In particular, Levin argues that “Dr. Levin prepared fipronil by oxidizing 5-amino-3-cyano-1-(2,6-dichloro-4-trifluoromethylphenyl)-4-trifluoromethylthiopyrazole (Compound 420)” and that “Dr. Levin carried out the reaction by pre-mixing dichloroacetic acid (DCA) [which is said to have had been previously obtained from a supplier] and hydrogen peroxide (H<sub>2</sub>O<sub>2</sub>), followed by Compound 420” with “no trichloroacetic acid or trichloroperacetic acid used”. (Levin Priority Motion at 11:1-8). Further, Levin contends that Dr. Levin knew that fipronil had been obtained by testing a reaction sample. (Levin Priority Motion at 11:9-11). According to Levin, Dr. Grabarnick “was aware that Dr. Levin was carrying out the reaction under the specified conditions and was aware of the result.” (Levin Priority Motion 11:17-19). Accordingly, argues Levin, a reduction to practice of an invention of the Count occurred.

In support of its argument of a reduction to practice, Levin directs us to the testimony of Dr. Levin and Dr. Grabarnick. As this testimony was excluded though (See Order of 1 October 2015, Paper 219), we do not consider it in deciding whether Levin has met its burden of proof.

Levin also directs us to “page 119 of Notebook 424” as well as the testimony of Dr. Gribble. (Levin Priority Motion at 11:7 referring to Ex 1030, page 119 of notebook 424 and Fifth Declaration of Gribble, Ex 1042, at ¶¶13-14).

The Exhibit that is “Page 119 of Notebook 424” appears to be a notebook page related to a “project” identified as “fipronil”. The notebook page is dated “23/5/10” but is not signed or witnessed. Also within the same Exhibit is a translation of this notebook page from Hebrew to English, and a “translator certification” of accuracy of the translation.

According to Dr. Gribble, “Page 119 of Notebook 424 (Ex 1030) describes a reaction in which dichloroacetic acid was first combined with hydrogen peroxide, and that mixture was combined with ...the sulfide precursor 5-amino-3-cyano-1-(2,6-dichloro-4-trifluoromethylphenyl)-4-trifluoromethylthiopyrazole, known as ‘420 for its molecular weight.” Dr. Gribble testified that the page “shows that two reaction samples were found to contain substantial fipronil (‘F’) and some starting material.” Dr. Gribble further testified that the process described “falls within the scope of Pastorio claim 1.” (Fifth Declaration of Gribble, Ex 1042, at ¶¶13-14).

Accepting the testimony of Dr. Gribble that the reaction set forth at page 119 of notebook 424 describes a reaction falling within the scope of Pastorio claim 1 and thus the Count, we nonetheless have not been directed to admissible testimony or other evidence sufficient to identify who devised the reaction described or how any testing of the reaction and its product occurred. Accordingly, Levin has not shown, as to this first 23 May 2010 alleged reduction to practice, that the Levin inventors constructed an embodiment or performed a process that met all the limitations of the Count and determined that it would work for its intended purpose. *Cooper v. Goldfarb*, 154 F.3d at 1327.

Levin alleges that a second reduction to practice occurred on the same date as the first, i.e., 23 May 2010. The evidence Levin directs us to regarding this alleged second reduction to practice is similar to the evidence it presented as to the first alleged reduction to practice and is deficient for at least the same reasons stated above. In particular, Levin directs us to a “Page 120 of Notebook 424.” (Ex 1031). (Levin Priority Motion at 12:2-13:2). That notebook page is not signed or witnessed. Moreover, while Dr. Gribble testifies to what he believes the notebook page to convey (Fifth Declaration of Gribble, Ex 1042, at ¶¶15-16), we have not

been directed to admissible evidence to show who authored the notebook page or if and how the reaction described on the page was undertaken or tested.

Levin alleges that another reduction to practice occurred on 15 June 2010. (Levin Priority Motion at 12:6-14:6). The admissible evidence Levin directs us to in support of this reduction to practice is deficient for at least the same reasons as for the 23 May 2010 alleged reductions to practice. While the notebook page in support of this 15 June 2010 alleged reduction to practice, “Page 152 of Notebook 424” (Ex 1034) does have a signature unlike the other notebook pages discussed above, the signature is illegible and we have not been directed to admissible evidence of whose signature it is. Moreover, the unverified English translation provided does not give insight as it does not include the signature. Further Dr. Gribble’s testimony regarding this notebook page (Fifth Declaration of Gribble, Ex 1042, at ¶¶19-20) does not address who recorded the contents of the notebook page.

Levin has not shown that it reduced to practice an invention of the Count on any of the three occasions discussed above. In its Priority Motion, Levin does not allege that there was any other reduction to practice.

We note that in an Appendix to its Priority Motion (i.e., Appendix 2 (Statement of Material Facts), Levin cites to Exhibits not discussed or cited within the argument portion of the Levin Priority Motion, including an additional notebook page, i.e., “Page 138 of Notebook 424” (See, e.g., Statement of Material Fact (SMF) 26 discussing Ex 1032), as well as an analytical report for “Sample 424-138-2” (Ex 1033) and certain e-mails (Exs 1035 and 1036) said to contain an invention disclosure. We do not consider these Exhibits because Levin did not provide within its Motion sufficient explanation of why they are evidence showing

a reduction to practice. Even were we to consider these Exhibits, they suffer from at least the same deficiencies as the evidence relied upon by Levin in its arguments for the 23 May 2010 and 15 June 2010 alleged reductions to practice, including a lack of evidence, such as testimony, to explain and corroborate the content of these Exhibits.

We deny the Levin Priority Motion.

B. Pastorio Priority Motion

In the Pastorio Priority Motion, Pastorio argues that it “conceived an invention within the Count and reduced it to practice well before Levin’s alleged date of invention”. (Pastorio Priority Motion at 4:18-20).

Since we deny the Levin Priority Motion we need not and do not decide if Pastorio has shown an actual reduction to practice prior to Pastorio’s accorded benefit date. Accordingly, we dismiss as moot the Pastorio Priority Motion.

C. Levin Motion 4 (for judgment based on unpatentability)

In an Order entered during the priority phase of the interference Levin was authorized to file a motion that the Pastorio claims are unpatentable as anticipated by, or having been obvious in view of, a single prior art reference, i.e., the Gharda reference (Ex 2009). Levin’s request to rely upon other prior art references, and in particular US 6,013,761 to Zierer et al., US 3,928,372 to Bochis et al., CN 101250158 and AU 2010100462 A4, was not granted. (Order Authorizing Motion, Paper 155). Levin did not request reconsideration of this Order. Where Levin’s arguments in its Motion 4 rely upon prior art references other than Gharda, including those listed above, to show the Pastorio claims to be unpatentable, we

have not considered those arguments.

The Pastorio claims are directed to a method of making fipronil through an oxidation reaction that is conducted in the presence of dichloroacetic acid (DCA) and an oxidizing agent, such as hydrogen peroxide, and with the proviso that the oxidation “is conducted in the absence of trichloroacetic [TCA] and/or trichloroperacetic acid [TCPA]”. (Pastorio Clean Copy of Claims, Paper 11).

In its Motion 4, Levin argues that the involved Pastorio claims are unpatentable because they are anticipated by at least Example 1 of Gharda. (Levin Motion 4 at 7:19-8:11).

Example 1 of Gharda shows a reaction for the preparation of fipronil using a solvent mixture containing TCA, hydrogen peroxide and DCA. (Gharda, Ex 2009, at 10 (Example 1)). Elsewhere Gharda indicates that either TCA combined with hydrogen peroxide (which is said to form TCPA “in situ”) or “pre-formed” TCPA is part of the reaction medium. (Gharda, Ex 2009, at 8:21-9:2). Even so Levin argues that the absence of TCA and TCPA is provided for in Gharda as Gharda discloses that DCA is a “poor medium for oxidation and the purpose of its addition is only to sufficiently depress the melting points of [TCA] to facilitate ease of processing.” (Levin Motion 4 at 7:19-8:10, citing Gharda, Ex 2009, at 9). According to Levin this portion of Gharda amounts to a disclosure that DCA can be used alone as the oxidizing agent for the production of fipronil without the need for TCA and/or TCPA. (Levin Motion 4 at 8:10-11).

Pastorio argues that example 1 of Gharda does not anticipate or render obvious the claimed invention because Gharda, in example 1 or elsewhere, does not disclose the use of DCA in the absence of TCA “as required by the Pastorio claims.” (Pastorio Opposition 4 at 6:9-7:14). Because of the “and/or” used in the

proviso the Pastorio involved claims allow for, but do not require, the exclusion of both TCA and TCPA. Put another way, due to the “and/or” in the proviso the oxidation may be in the absence of both TCA and TCPA or in the absence of either TCA or TCPA. Thus we do not agree with Pastorio that its claims require a reaction medium that necessarily excludes both TCA and TCPA.

Nonetheless we are not persuaded that Gharda anticipates the Pastorio claims since Gharda, when using a medium containing an oxidizing agent such as hydrogen peroxide as is required by the Pastorio claims, discloses that both TCA and TCPA (formed “in situ”) are present in the disclosed reaction medium. In particular, Gharda indicates that the reaction medium contains either an oxidizing agent, e.g., hydrogen peroxide, and TCA, or “pre-made” TCPA.

While we agree with Levin that the involved Pastorio claims contain no limitation with regard to superiority or inferiority of the oxidation reaction” (Levin Motion 4 at 8:13-15), we do not agree that Gharda can be said to anticipate the Pastorio involved claims since anticipation requires that a reference disclose every limitation of the claimed invention, either expressly or inherently. *In re Schreiber*, 128 F.3d 1473, 1477, (Fed. Cir. 1997). Levin has not directed us to a teaching in Gharda of a reaction otherwise meeting the limitations of the involved Pastorio claims where either TCA “and/or” TCPA are not present in the reaction medium. We do not agree with Levin that Gharda’s disclosure of DCA as a poor medium for oxidation is a disclosure that DCA is a replacement for TCPA in the reaction medium.

Levin also argues that Gharda would have rendered obvious the involved Pastorio claims. Levin argues that because of certain known disadvantages to the use of TCA, one skilled in the art would have been motivated to try the oxidation

reaction in the absence of TCA and/or TCPA. Levin argues that, even though DCA was known to be a poor medium for oxidation one skilled in the art would have known to compensate by adding a strong acid such as sulfuric acid or, alternatively, another agent that would achieve the goal of the claimed oxidation reaction. (Levin Motion 4 at 10:12-22).

We do not agree that Gharda's characterization of DCA as a poor medium for oxidation would have provided sufficient reason for one skilled in the art to eliminate TCPA, disclosed by Gharda as being an effective medium for the oxidation reaction to produce fipronil. (Gharda, Ex 2009, at 2:3-9). We are not persuaded that one skilled in the art would have sufficient reason to eliminate what is said to be an effective medium to rely upon what is said to be a poor one. Further Gharda states that the "purpose of [DCA's] addition is only to sufficiently depress the melting point of trichloro acetic acid to facilitate ease of processing". (Gharda, Ex. 2009 at 9:17-21, Sixth Gribble Declaration, Ex 1044, at ¶75). Thus, even if one skilled in the art would have had reason to substitute or eliminate TCA from the reaction medium, the addition of DCA would no longer be needed and the Pastorio claims would not be met.

Levin, citing to the involved Pastorio patent (Ex. 2001) argues that one skilled in the art would be motivated to substitute trifluoroacetic acid [TFA] or 3-chlorobenzene for the required TCPA given disclosure of the past use of these compounds in producing fipronil. (Levin Motion 4 at 11:1-7). As noted above, we are not convinced that such a substitution would result in the Pastorio claimed method since that method requires DCA in the reaction medium. Further we are not persuaded that one skilled in the art would have had reason to make such a substitution given the disclosed disadvantages of TFA and 3-chlorobenzene. Levin

acknowledges, and Gharda discloses, TFA as being corrosive and expensive. (Levin Motion 4 at 12:18-21 and Gharda at 1:15-17). The Pastorio involved patent specification, relied upon by Levin to teach substitution of TCPA with chlorobenzene, states that this compound has “evident disadvantages both in terms of yield and cost”. (Pastorio involved patent, Ex 2001, at 1:61-65).

Accordingly, Levin has not shown that one skilled in the art would have had sufficient reason to eliminate or substitute the TCA and TCPA, or that, if one has sufficient reason, a composition otherwise meeting the Pastorio claims would result. We have considered the testimony of Dr. Gribble relied upon in Levin Motion 4 where that testimony discusses Gharda. We do not find this testimony convincing to show that one skilled in the art following Gharda would have found DCA to be an acceptable oxidizing medium such that elimination of TCPA “and/or” TCA is disclosed or would have been obvious. Further Dr. Gribble does not explain to our satisfaction why one skilled in the art would have included DCA if TCA were eliminated from the oxidizing medium in view of Gharda’s disclosure that its only function is to depress the melting point of TCA to facilitate ease of processing. We have not considered Dr. Gribble’s testimony to the extent it is discusses prior art references that are beyond the scope of the motion Levin was authorized to file in the Order Authorizing Motion. (Paper 155).

As Levin has not shown the Pastorio involved claims to be unpatentable over Gharda, Levin Motion 4 is denied.

IV. Order

Upon consideration of the record, it is

ORDERED that Levin Motion 3 for judgment on the basis of priority is DENIED;

FURTHER ORDERED that Pastorio Motion 4 for judgment on the basis of priority is DISMISSED as moot; and

FURTHER ORDERED that Levin Motion 4 for judgment on the basis of unpatentability of the Pastorio involved claims is DENIED; and

FURTHER ORDERED that judgment against Levin is entered in a separate paper.

cc: (via electronic)

Attorney for Levin:

Gary J. Gershik  
Norman H. Zivin  
COOPER & DUNHAM, LLP  
ggershik@cooperdunham.com  
nzivin@cooperdunham.com

Attorney for Pastorio:

E. Anthony Figg  
R. Danny Huntington  
ROTHWELL, FIGG, ERNST & MANBECK, P.C.  
efigg@rfem.com  
dhuntington@rfem.com