

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

THE SCOTTS COMPANY LLC  
Petitioner

v.

ENCAP, LLC  
Patent Owner

---

Case IPR2013-00110  
Patent 6,209,259

---

Before MICHAEL P. TIERNEY, LORA M. GREEN, and RAMA G. ELLURU,  
*Administrative Patent Judges.*

ELLURU, *Administrative Patent Judge.*

DECISION  
Institution of *Inter Partes* Review  
37 C.F.R. § 42.108

## I. BACKGROUND

Petitioner The Scotts Company LLC (“Scotts Company”) requests *inter partes* review of claims 1-5, 7-11, and 13-14 of U.S. Patent 6,209,259 (“the ’259 patent”). (“Pet” Paper No. 1.) The Patent Owner, Encap, LLC (“Encap”), filed a preliminary response opposing institution of review. We have jurisdiction under 35 U.S.C. §§ 6(b)(4) and 314. The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a) which provides as follows:

THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

We determine that based on the record that there is a reasonable likelihood that Scotts Company would prevail in establishing the unpatentability of all the challenged claims. Accordingly, we grant the petition for an *inter partes* review of the ’259 patent as to claims 1-5, 7-11, and 13-14.

Scotts Company indicates that the ’259 patent is currently the subject of co-pending litigation styled, *Encap LLC v. The Scotts Company LLC, The Scotts Company Miracle-Gro Company and OMS Investments, Inc.*, Case No. 1:11-cv-000685-WCG. (Pet. 1.) The ’259 also is the subject of a concurrent *ex parte* reexamination filed by Scotts Company (Reexamination No. 90/012,183), which is currently stayed.

### A. Timeliness of Petition

Encap alleges that Scotts Company failed to file the instant petition timely because Encap notified Scotts Company of its alleged infringement of the ’259

patent more than one year before Scotts Company filed the instant petition.

(Prelim. Resp. 9.) We determine that Scott Company's petition was filed timely.

Under 35 U.S.C. § 315(b), a party may not file a petition for *inter partes* review if the party had been *served* with a complaint alleging infringement more than one year previously. Thus, mere notification of a complaint does not trigger the one-year statutory bar. Furthermore, Rule 4(d)(4) of the Federal Rules of Civil Procedure provides that “[w]hen the plaintiff files a waiver, proof of service is not required and these rules apply *as if a summons and complaint had been served at the time of filing the waiver.*” (Emphasis added.) Thus, where Petitioner waives service of a summons, the one-year time period begins on the date on which waiver is filed. *See* Decision – Service Under 35 U.S.C. § 315(b) – in case no. IPR2013-00010 (Paper 20). Here, Scotts Company waived service of a summons in the infringement action no earlier than January 12, 2012, and filed the instant Petition on January, 10, 2013. (Ex. 1012, Waiver of Service form; Paper 2.) Thus, the petition was filed timely.

#### *B. Stay of the Concurrent Reexamination of the '259 Patent*

Encap asserts that Scotts Company's petition should be denied because it is an improper maneuver by Scotts Company to participate in the *ex parte* reexamination of the '259 patent filed by Scotts Company on March 9, 2012. (Prelim. Resp. 1-4.) In Paper No. 10, the Board stayed reexamination of the '259 patent pending the termination or completion of the instant proceeding. On May 31, 2013, the Board held a conference call at Encap's request to discuss the stay and address Encap's concerns. (Paper 11.) As the Board explained, the Board ordered the stay to prevent the possibility of any inconsistency between the reexamination proceeding and the *inter partes* review proceeding.

*C. The '259 Patent*

The invention of the '259 is directed to a combination seed capsule comprising at least one viable seed, a coating of a composition comprising a soil conditioning material mounted proximate and disposed outwardly of the outer surface of the seed, and optionally including one or more of inorganic chemical fertilizers, growth enhancer, binder, and/or an anti-fungal agent. (Ex. 1001, Abstract, 4:5-11.) According to the '259 patent specification, the primary object of the invention is to “provide solid plant seed capsule products that supply both soil conditioning properties and the seed, which benefits from such conditioned soil, in a given seed capsule product.” (Ex. 1001, 3:28-31.)

*D. Representative Claims*

Claims 1 and 7 are independent claims directed to a “[a] combination seed capsule.” The only difference between these claims is that claim 7 additionally states that the seed coating is applied by an agglomeration process. The remaining challenged claims depend from either claim 1 or 7. Claim 1 is reproduced below:

1. A combination seed capsule comprising:  
one viable seed;  
said seed acting as a core or pseudo core of said combination seed capsule;  
a coating of a composition comprising soil conditioning materials;  
said soil conditioning materials being in a solid state at time of coating.

*E. Prior Art Relied Upon*

Scotts Company relies upon the following prior art references:

Schreiber (Ex. 1002)	U.S. Patent 3,698,133	Oct. 17, 1972
Roth (Ex. 1003)	U.S. Patent 4,065,287	Dec. 27, 1977
Lowe et al. (Ex. 1004)	U.S. Patent 5,019,564	May 28, 1991

IPR2013-00110  
Patent 6,209,259

Evans (Ex. 1005)	WO 85/01736	Apr. 25, 1985
Simmons (Ex. 1006)	U.S. Patent 4,465,017	Aug. 14, 1984
Matthews (Ex. 1007)	GB670,461	Apr. 16, 1952

*F. The Asserted Grounds*

Scotts Company challenges the patentability of claims 1-5, 7-11, 13, and 14 of the '259 patent based on the following grounds:

1. Claims 1, 7, and 13 as anticipated under 35 U.S.C. § 102(b) by Schreiber;
2. Claims 2, 5, 8, 11, and 14 as obvious under 35 U.S.C. § 103 over Schreiber and Roth;
3. Claims 3, 4, 9, and 10 as obvious under 35 U.S.C. § 103 over Schreiber and Lowe;
4. Claims 1, 2, 7, 8, 13, and 14 as anticipated under 35 U.S.C. § 102(b) by Matthews;
5. Claims 1, 2, 5, 7, 8, 11, 13, and 14 as anticipated under 35 U.S.C. § 102(b) by Roth;
6. Claims 1-5, 7-11, 13, and 14 as obvious under 35 U.S.C. § 103 over Roth and Lowe;
7. Claims 1, 7, 13, and 14 as anticipated under 35 U.S.C. § 102(b) by Evans; and
8. Claims 1, 7, 13, and 14 as anticipated under 35 U.S.C. § 102(b) by Simmons.

(Pet. 3.)

## II. ANALYSIS

### *A. Claim Construction*

Consistent with the statute and the legislative history of the AIA, the Board interprets claims by applying the broadest reasonable construction in the context of the specification in which the claims reside. 37 C.F.R. § 42.100(b); *see Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48766 (Aug. 14, 2012). The words of the claim will be given their plain meaning unless the plain meaning is inconsistent with the specification. *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989). There are only two exceptions to the general rule that a claim term is given its ordinary meaning: “1) when a patentee sets out a definition and acts as his own lexicographer, or 2) when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *See Thorner v. Sony Computer Entm't Am. LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012).

In assessing the merit of Scott Company’s arguments, we have construed the following claim term in light of the specification of the ’259 patent.

“soil conditioning materials”

Both independent claims 1 and 7 require “a coating of a composition comprising soil conditioning materials.” The ’259 patent specification states that “all soil conditioning materials . . . beneficially modify soil to which they are applied, in some way other than direct provision of nitrogen, phosphorous, and/or potassium or other plant nutrients.” (Ex. 1001, 8:41-44.) The specification further provides specific examples of soil conditioning materials, such as municipal or other sewage sludge, paper mill sludge, fly ash, and dust. (Ex. 1001, 7:21-23.) Accordingly, we construe “soil conditioning materials” as “materials that beneficially modify soil to which they are applied, in some way other than direct provision of nitrogen, phosphorous, and/or potassium or other plant nutrients,

including for example, municipal or other sewage sludge, paper mill sludge, fly ash, and dust.”

*Product-by-process claims*

We determine that claims 1 and 7 are product-by-process claims because the claimed “combination seed capsule” is defined in part by the process by which it is made. Specifically, claim 1 limits the product by requiring that the soil conditioning materials are “in a solid state at [the] time of coating” of the seed. Claim 7 requires a similar limitation, and also that the coating of a composition comprising soil conditioning materials is “applied to said viable seed by an agglomeration operation.”

The determination of patentability of a product-by-process claim is based on the product itself. “If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698 (Fed. Cir. 1985) (citations omitted). The structure implied by the process steps, however, should be considered when assessing the patentability of product-by-process claims over the prior art. *See, e.g., In re Garner*, 412 F.2d 276, 279 (CCPA 1979). This is especially true where the product can only be defined by the process steps by which the product is made, or where the manufacturing process steps would be expected to impart distinctive structural characteristics to the final product. *Id.* (holding “interbonded one to another by interfusion” to limit structure of the claimed composite and noting that terms such as “welded,” “intermixed,” “ground in place,” “press fitted,” and “etched” are capable of construction as structural limitations.)

Accordingly, we determine that claims 1 and 7 require the claimed “combination seed capsule” to have a solid coating of a composition comprising soil conditioning materials by virtue of the limitation that the soil conditioning materials be “in a solid state at [the] time of coating” the seed. Claim 7 additionally includes the “agglomeration operation” limitation, which according to the specification means a method using water and heat, along with physical and/or chemical adhesives and like properties, to bind or agglomerate a plurality of types of particles and/or materials into coated seed capsules, including using binding mechanisms such as adhesion and cohesion. (Ex. 1001, 14:57-15:6.) Thus, the “agglomeration operation” limitation of claim 7 implies that the claimed “combination seed capsule” has a coating of a composition comprising soil conditioning materials consisting of an agglomeration of a plurality of types of particles and/or materials. Thus, a prior art product with those structural limitations, where relevant to the claim, renders unpatentable the challenged claim irrespective of how the prior art product was made.

*B. Anticipation by Schreiber (Ex. 1002)*

Scotts Company contends that claims 1, 7, and 13 are anticipated by Schreiber. Based on our review of the record before us, we determine that there is a reasonable likelihood that claims 1, 7, and 13 are anticipated by Schreiber. (Pet. 32-38.)

Schreiber discloses the limitations of claims 1 and 7. For example, Schreiber discloses a plant seed having multiple coatings thereon, which as explained below, satisfies the claimed “seed acting as a core or pseudo core.” (Ex. 1002, 1:4-6, 9:38-43.) Schreiber further discloses the claimed “coating of a composition comprising soil conditioning materials.” Specifically, Schreiber



describes a seed coating made of a composition comprising solid particulate coating material, such as ground peat moss. (Ex. 1002, 2:34-49, 10:40-42.) Schreiber explains that its invention permits the tailoring of seed coatings for achieving optimum germination and growth while allowing early planting within a wide time period and that other advantages also accrue from the invention, which satisfies our construction of “solid conditioning materials.” (Ex. 1002, 2:15-19, 9:44-49 (provides better root development and drought resistance).) Schreiber also discloses that the coating is an “agglomeration” of a plurality of types of materials because Schreiber explains that the coating composition includes a “binder,” required by claim 13, or a plasticizer and that the coating layers may coalesce. (Ex. 1002, 2:37-39, 2:55-56, 3: 35-42, 6:23-32.)

Encap argues against the relevance of Schreiber<sup>1</sup>, contending that the agglomeration process described in the '259 patent is different from the coating process described in Schreiber. Encap's argument is misplaced because, as discussed *supra*, the determination of patentability of a product-by-process claim is based on the product itself. *See In re Thorpe*, 777 F.2d at 698. Encap has not demonstrated that the coated seed disclosed in Schreiber differs from the combination seed capsule covered by the challenged claims.

In summary, we hold that Scotts Company has demonstrated a reasonable likelihood it would prevail in establishing that claims 1, 7, and 13 are anticipated by Schreiber.

---

<sup>1</sup> Encap's preliminary response does not address each asserted ground individually, but rather argues against the relevance of each reference.

*C. Obviousness over Schreiber (Ex. 1002) and Roth (Ex. 1003)*

Scotts Company contends that dependent claims 2, 5, 8, 11, and 14 are rendered obvious by the combination of Schreiber and Roth. Based on our review of the record before us, we determine that there is a reasonable likelihood that claims 2, 5, 8, 11, and 14 are rendered obvious by the combination of Schreiber and Roth. (Pet. 38-39.)

As discussed above, Schreiber discloses the elements of independent claims 1 and 7. Roth further describes coating seeds with “sludge,” and specifically “municipal sewage,” as required by dependent claims 2, 5, 8, and 11. Roth discloses coating crop seeds with methanol treated sludge (“MAS”), wherein the source material can be from municipal sewage. (Ex. 1003, 3:23-26, 3:32-42, 4:46-50.) In addition, Roth teaches including “fertilizer” as part of the MAS, thus satisfying claim 14. (Ex. 1003, 2:1-5.) Furthermore, because both the inner coating of Schreiber and the MAS taught by Roth are water insoluble and protect the contents of the seed capsule from the elements, a person of ordinary skill would have had reason to substitute the peat moss taught by Schreiber with Roth’s MAS coating. (Ex. 1002, 2:44-45; Ex. 1003, 4:5-8; Pet 38.) We discuss Encap’s arguments against the relevance of Roth *supra*.

In summary, we hold that Scotts Company has demonstrated a reasonable likelihood it would prevail in establishing that claims 2, 5, 8, 11, and 14 are rendered unpatentable as obvious over the combination of Schreiber and Roth.

*D. Obviousness over Schreiber (Ex. 1002) and Lowe (Ex. 1004)*

Scotts Company contends that dependent claims 3, 4, 9, and 10 are rendered obvious by the combination of Schreiber and Lowe. Based on our review of the

record before us, we determine that there is a reasonable likelihood that claims 3, 4, 9, and 10 are rendered obvious by the combination of Schreiber and Lowe. (Pet. 40.)

As discussed above, Schreiber discloses the elements of independent claims 1 and 7. Lowe further teaches a material that is a byproduct of a “paper making process,” and specifically that the byproduct is “paper sludge” as required by dependent claims 3, 4, 9, and 10. Lowe describes an agricultural granule for carrying and releasing agricultural chemicals that resembles a clay-based granule. (Ex. 1004, Abstract.) The agricultural granule is made from using waste materials from paper manufacture, referred to as paper sludge. (Ex. 1004, 1:68-2:1, 40-44.) In addition, because Lowe teaches an agricultural granule made from paper sludge for carrying and releasing incorporated agricultural chemicals that resembles a clay-based granule (Ex. 1004, Abstract, 2:1), a person of ordinary skill would have had reason to substitute Schreiber’s water insoluble solid clay-like agricultural coating material (*e.g.*, kaolin) with Lowe’s paper sludge materials. (Pet. 40.)

Encap argues against the relevance of Lowe because Encap alleges that Lowe’s agglomeration process is different from that described in the ’259 patent specification. (Prelim Resp. 23.) We note again, however, that the determination of patentability of a product-by-process claim is based on the product itself and not the method of manufacture. *See In re Thorpe*, 777 F.2d at 698. Encap does not explain how Lowe’s allegedly different agglomeration process combined with Schreiber’s seed would result in a coated seed that differs from the seed claimed by the challenged claims. Encap also contends that because Lowe does not disclose a seed, a person of ordinary skill in the art would not have had a reason to combine Lowe’s agglomeration process with Schreiber’s seed. (Prelim. Resp. 23.) We

disagree as Schreiber discloses clay-like coating materials and Lowe describes coating materials that resemble a clay-based granule.

In summary, we hold that Scotts Company has demonstrated a reasonable likelihood it would prevail in establishing that claims 3, 4, 9, and 10 are rendered obvious by the combination of Schreiber and Lowe.

*E. Anticipation by Matthews (Ex. 1007)*

Scotts Company contends that claims 1, 2, 7, 8, 13, and 14 are anticipated by Matthews. Based on our review of the record before us, we determine that there is a reasonable likelihood that claims 1, 2, 7, 8, 13, and 14 anticipated by Matthews. (Pet. 54-57.)

Matthews discloses the claimed “seed acting as a core or pseudo core” with a “solid” “coating of a composition comprising soil condition materials,” as required by claims 1 and 7. Specifically, Matthews describes a seed pellet product coated with “fly ash,” as required by dependent claims 2 and 8. (Ex. 1007, 2:10-12, 2:61-64.) Matthews further describes alternately spraying and dusting the seed with the coating until the desired thickness is reached and the seed pellets are dried. (Ex. 1007, 2:81-84, 2:88-89.) Matthews also discloses that the coating is an “agglomeration” of a plurality of types of materials, as required by claim 7, because Matthews explains that the coating of dust particles are bound by an adhesive water-soluble plastic, such as polyvinyl alcohol or methyl cellulose, around and about the original seed particle. (Ex. 1007, 2:42-45, 2:50-54, 3:5-9.) Matthews describes applying a “binder,” as required by dependent claim 13, to the seed capsule, *e.g.*, polyvinyl alcohol, to hold the coating substances firmly on the seed. (Ex. 1007, 2:42-45, 3:5-9.) Further, the Matthews seed coating may include “fertilizer,” thus satisfying dependent claim 14. (Ex. 1007, 5:25-27.)

Encap argues against the relevance of Matthews alleging that Matthews does not disclose the claimed “soil conditioning materials.” In support, Encap contends that the Matthews seed pellet “permits” germination, but does not promote or support germination and plant growth; some fly ash materials cannot operate as a soil conditioning material; and, Matthews discloses a water soluble plastic material, that permits the passage of water to allow for germination, with the dust material to form a hard outer coating and the hard outer coating is not a soil conditioning material. (Prelim. Resp. 15-17.) Encap’s arguments lack merit.

We have construed “soil conditioning materials” as “materials that beneficially modify soil to which they are applied, in some way other than direct provision of nitrogen, phosphorous, and/or potassium or other plant nutrients, including for example, municipal or other sewage sludge, paper mill sludge, *fly ash*, and dust.” Matthews states that on planting, the disclosed seed pellet product, which can be coated with fly ash, will have “high germination.” (Ex. 1007, 2:10-12). Thus, Matthews’ coating satisfies our construction of “soil conditioning materials.” Furthermore, Encap fails to identify sufficient credible evidence for the allegation that not all fly ash is the same and that the ’259 patent excludes certain types of fly ash. With respect to Encap’s contention that the Matthews seed coating includes a water soluble plastic that forms a “hard” coating, the claims recite a coating “comprising” soil conditioning materials. Thus, the claimed coating may include other components. Encap has not provided sufficient credible evidence to support the allegation that the claims exclude a seed with a “hard” coating.

In summary, we hold that Scotts Company has demonstrated a reasonable likelihood it would prevail in establishing that claims 1, 2, 7, 8, 13, and 14 are anticipated by Mathews.

*F. Anticipation by Roth (Ex. 1003)*

Scotts Company contends that claims 1, 2, 5, 7, 8, 11, 13, and 14 are anticipated by Roth. Based on our review of the record before us, we determine that there is a reasonable likelihood that claims 1, 2, 5, 7, 8, 11, 13, and 14 are anticipated by Roth. (Pet. 49-54.)

Roth discloses the claimed “seed acting as a core or pseudo core” with a “coating of a composition comprising soil conditioning materials,” as required by claims 1 and 7. Specifically, Roth describes coating seeds with a methanol treated “sludge” carrier having one or more agricultural chemicals dispersed therein, wherein the source material is “municipal sewage,” as required by dependent claims 2, 5, 8, and 11. (Ex. 1003, 3:23-26, 3: 32-33, 3:32-42, 4:46-48.) Roth explains that the MAS coating is “solid” after application, as required by claims 1 and 7. Roth states that the solid content of the MAS product is in the range of 0-1-2.5% (Ex. 1003, 3:50-51) and illustrates an example of seeds dip-coated in a MAS slurry and air dried at room temperature. (Ex. 1003, 12:32-38.) Indeed, the ’259 patent specification contemplates a sewage sludge slurry bound together by a binder that may be applied to the substrate seeds in a combination with a flow of air to evaporate water from the thus applied coating. (Ex. 1001, 8:5-12.) Roth also describes a coating comprising an “agglomeration” of a plurality of types of materials, as required by claim 7, because the coating may be strengthened by the inclusion of the claimed polyvinyl alcohol and or starch derivatives. (Ex. 1003, 5:49-52.) Dependent claims 13 and 14 are satisfied because Roth’s coating may include a “binder,” *e.g.*, polyvinyl alcohol, starch derivatives, and further may include a fertilizer. (Ex. 1003, 2:3-5, 2:48-51, 5:49-52.)

Encap argues against the relevance of Roth. Encap argues that Roth does not disclose the claimed “said soil conditioning materials being in a solid state at time of coating” because Roth’s coating is liquid and viscous at the time of coating. (Prelim. Resp. 19.) Encap’s argument is unavailing because it does not explain how the process in Roth results in a product that differs from the seed product claimed by the challenged claims. *See In re Thorpe*, 777 F.2d at 698. Also, Roth explains that the seeds are air dried at room temperature. (Ex. 1003, 12:32-38.) Encap also argues that Roth does not teach “soil conditioning materials” because Roth describes methanol activated sludge, which according to Encap, transforms the sludge into a new polymer based substance, and further that some sewage sludges are not soil conditioning materials. (Prelim Resp. 20-21.) Encap fails to identify sufficient credible evidence for the allegation that the ’259 patent excludes certain types of sludge, including methanol treated sludge. Indeed, the ’259 patent contemplates treated sludge. For example, the ’259 patent specification states that sewage sludge “need not be treated to transform such sludge into colloidal form” and the preferred embodiment is non-colloidal in nature. However, the ’259 patent does not express a manifest exclusion of sludge that is treated to form a colloidal form. (Ex. 1001, 8:18-24.)

In summary, we hold that Scotts Company has demonstrated a reasonable likelihood it would prevail in establishing that claims 1, 2, 5, 7, 8, 11, 13, and 14 are anticipated by Roth.

*G. Obviousness over Roth (Ex. 1003) and Lowe (Ex. 1004)*

Scotts Company contends that claims 1-5, 7-11, 13, and 14 are rendered obvious by the combination of Roth and Lowe. Based on our review of the record before us, we determine that there is a reasonable likelihood that claims 1-5, 7-11,

13, and 14 are rendered obvious by the combination of Roth and Lowe. (Pet. 57-59.)

We have explained above our determination that Roth discloses the limitations of claims 1, 2, 5, 7, 8, 11, 13, and 14. Lowe further teaches a material that is a byproduct of a “paper making process,” and specifically that the byproduct is “paper sludge” as required by dependent claims 3, 4, 9, and 10. Lowe describes an agricultural granule for carrying and releasing agricultural chemicals that resembles a clay-based granule. (Ex. 1004, Abstract.) The agricultural granule is made from using waste materials from paper manufacture, referred to as paper sludge. (Ex. 1004, 1:68-2:1, 40-44.) Furthermore, because Roth teaches a MAS carrier for agricultural chemicals that can coat a seed, and because Lowe likewise teaches an agricultural carrier consisting of paper sludge, a person of ordinary skill in the art would have had reason to substitute Lowe’s paper mill sludge for Roth’s MAS coating. (Pet. 57.)

In summary, we hold that Scotts Company has demonstrated a reasonable likelihood it would prevail in establishing that claims 1-5, 7-11, and 13, and 14 are rendered obvious by the combination of Roth and Lowe.

#### *H. Secondary Considerations*

Encap alleges commercial success and long felt need as secondary considerations of non-obviousness. (Prelim. Resp. 25.) Based on the record before us, we have determined that Encap has not demonstrated commercial success or long-felt need as secondary considerations of non-obviousness. Encap fails to provide sufficient credible evidence to support its allegations and Scotts Company refutes Encap’s allegations. (Prelim. Resp. 25; Pet. 58-59.)



### *I. Other Asserted Grounds*

Scotts also challenges claims 1, 7, 13, and 14 as anticipated by Evans, and; claims 1, 7, 13, and 14 as anticipated by Simmons. Those asserted grounds are redundant in light of the determination that there is a reasonable likelihood that the challenged claims are unpatentable as obvious based on the grounds identified above.

### III. CONCLUSION

For the foregoing reasons, we determine that the information presented in the petition and preliminary response shows that there is a reasonable likelihood that Scotts Company would prevail on its challenge to the patentability of claims 1-5, 7-11, 13, and 14 of the '259 patent.

### IV. ORDER

In consideration of the foregoing, it is hereby:

**ORDERED** that pursuant to 35 U.S.C. § 314, an *inter partes* review of the '259 patent is hereby instituted for the following grounds:

1. Claims 1, 7, and 13 are anticipated by Schreiber;
2. Claims 2, 5, 8, and 11, and 14 are rendered unpatentable as obvious over the combination of Schreiber and Roth;
3. Claims 3, 4, 9, and 10 are rendered unpatentable as obvious over the combination of Schreiber and Lowe;
4. Claims 1, 2, 7, 8, 13, and 14 are anticipated by Mathews;
5. Claims 1, 2, 5, 7, 8, 11, 13, and 14 are anticipated by Roth;
6. Claims 1-5, 7-11, 13, and 14 are rendered unpatentable as obvious over the combination of Roth and Lowe;

**FURTHER ORDERED** that the following grounds are denied:

7. Claims 1, 7, 13, and 14 are anticipated by Evans; and
8. Claims 1,7, 13, and 14 are anticipated by Simmons;

**FURTHER ORDERED** that pursuant to 35 U.S.C. § 314(d) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this decision; and

**FURTHER ORDERED** that an initial conference call with the Board is scheduled for 2 PM Eastern Time on July 24, 2013. The parties are directed to the Office Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012) for guidance in preparing for the initial conference call, and should come prepared to discuss any proposed changes to the Scheduling Order entered herewith and any motions the parties anticipate filing during the trial.

IPR2013-00110  
Patent 6,209,259

Petitioner:

Robert Schulman  
[rschulman@hunton.com](mailto:rschulman@hunton.com)  
Jeff Vockrodt  
[jvockrodt@hunton.com](mailto:jvockrodt@hunton.com)

Patent Owner:

Philip Weiss  
[weissandweiss@aol.com](mailto:weissandweiss@aol.com)