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Paper 16
September 23, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NESTLÉ PURINA PETCARE COMPANY,
Petitioner,

v.

OIL-DRI CORPORATION OF AMERICA,
Patent Owner.

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IPR2015-00737
Patent 5,975,019

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Before CARL M. DEFRANCO, JO-ANNE M. KOKOSKI, and KRISTINA M. KALAN, *Administrative Patent Judges.*

DEFRANCO, *Administrative Patent Judge.*

DECISION
Patent Owner's Request for Rehearing
*37 C.F.R. § 42.71*

The patent owner, Oil-Dri Corporation of America, requests reconsideration of our decision (Paper 12) instituting *inter partes* review of claims 1–13, 30, and 32 of U.S. Patent No. 5,975,019. Paper 14 ("Req. Reh'g"). "The request must specifically identify all matters the party believes the Board misapprehended or overlooked." 37 C.F.R. § 42.71(d).

At the heart of Oil-Dri's request for reconsideration is its contention that we misapprehended the "reasonable likelihood" standard for institution. Req. Reh'g 3. That standard, according to Oil-Dri, "requires the petitioner to present a *prima facie* case of unpatentability." *Id.* (citing 112 Cong. Rec. S1375 (daily ed. Mar. 8, 2011) (Sen. Kyl remarks)). Oil-Dri argues repeatedly that, because Nestlé did not demonstrate a *prima facie* case, we should not have instituted trial. Req. Reh'g 2, 4, 7, 10, 11.

The demonstration of a *prima facie* case of unpatentability, although helpful, is not necessarily a prerequisite to the institution of an *inter partes* review. That is because, pursuant to our rules, "[a] *prima facie* case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard." 37 C.F.R. § 1.56(b). But, by statute, the preponderance of the evidence standard does not play a role in our proceedings until after an *inter partes* review is "instituted." 35 U.S.C. § 316(e). As far as the standard for institution of an *inter partes* review, the statute speaks only in terms of a "*[t]hreshold*" assessment of the petitioner's case, specifically, whether the record in the first instance—"the information presented in the petition . . . and any response"—persuades us there is a reasonable likelihood of the petitioner prevailing. 35 U.S.C. § 314(a).

Here, in deciding whether to institute, we considered the petition and the preliminary response, and based on the evidence of record at that time, determined a reasonable likelihood existed that Nestlé would prevail on the grounds on which we instituted *inter partes* review. *See* 35 U.S.C. § 314(a). Thus, we applied the correct standard for institution of trial.

Oil-Dri's request for rehearing is *denied.*

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