

No. 24-866

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IN THE  
**Supreme Court of the United States**

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CONVERTER MANUFACTURING, LLC,

*Petitioner,*

*v.*

TEKNI-PLEX, INC.,

*Respondent.*

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ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED  
STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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**BRIEF IN OPPOSITION TO PETITION  
FOR A WRIT OF CERTIORARI**

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DIANE SIEGEL DANOFF  
*Counsel of Record*  
KEVIN FLANNERY  
MICHAEL A. FISHER  
ROBERT W. ASHBROOK, JR.  
LUKE M. REILLY  
DECHERT LLP  
2929 Arch Street  
Philadelphia, PA 19104  
(215) 994-2179  
diane.danoff@dechert.com

*Counsel for Respondent*  
*Tekni-Plex, Inc.*

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## QUESTIONS PRESENTED

One way to invalidate a patent claim is by “prior art.” Prior art consists of documents or information showing that the claimed invention was previously made available to the public. A prior art reference must contain teachings sufficient to “enable” a person of ordinary skill in the art to make and use the article, apparatus, or process disclosed in the reference. This requirement is known as “enablement.” *See Cohn v. U.S. Corset Co.*, 93 U.S. 366, 370 (1876).

The law on the burden of proof for prior art enablement is longstanding and well-established: There is a rebuttable presumption of enablement. A patentee bears the initial burden of producing some evidence that the cited art is *not* enabling, whereupon the patent challenger has the burden of persuasion to establish that the art *is* enabling. *See, e.g., Impax Labs., Inc. v. Aventis Pharms., Inc.*, 545 F.3d 1312, 1316 (Fed. Cir. 2008); *In re Morsa*, 713 F.3d 104, 110 (Fed. Cir. 2013); *In re Antor Media Corp.*, 689 F.3d 1282, 1287–88 (Fed. Cir. 2012); *In re Sasse*, 629 F.2d 675, 681 (C.C.P.A.1980).

The questions presented are:

1. Whether this Court should eliminate the well-established, rebuttable presumption of prior art enablement despite the lack of conflict with U.S. Supreme Court precedent, despite petitioner’s waiver of the issue by failing to raise it below, and despite the fact that petitioner’s proposed change in the law would not alter the outcome of this case.

2. Whether *Loper Bright Enterprises v. Raimondo* prohibits the Federal Circuit from summarily affirming Patent Trial and Appeals Board decisions that do not reinterpret, but rather, expressly follow, well-established Federal Circuit precedent on the burden of proof for prior art enablement.

**PARTIES TO THE PROCEEDING**

Petitioner Converter Manufacturing, LLC was the named Patent Owner in the Patent Trial and Appeal Board proceedings below and was the Appellant in the Court of Appeals.

Respondent Tekni-Plex, Inc. was the Petitioner in the Patent Trial and Appeal Board proceedings and the Appellee in the Court of Appeals.

## **CORPORATE DISCLOSURE STATEMENT**

Pursuant to Supreme Court Rule 29.6, Respondent Tekni-Plex, Inc. discloses that the following entities are parents of Respondent or own 10% or more of Respondent's stock:

- Tekni-Plex Holdings, LLC
- Trident TPI Holdings, Inc.
- Trident Intermediate, Inc.
- Tekni-Plex Parent, Inc.
- Genstar Trident Holdings, L.P.

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## INTRODUCTION

Contrary to the argument of Petitioner Converter Manufacturing, LLC (“CM”), the Federal Circuit’s rebuttable presumption of prior art enablement does not conflict with U.S. Supreme Court precedent. Moreover, CM has forfeited the argument by failing to raise it below. And in any event, abolition of the presumption would not change the outcome of this case. Nor is *Loper Bright* relevant. CM is challenging a presumption created by the Federal Circuit, not by the Patent Trial and Appeal Board (“PTAB” or “Board”). Similarly, the Federal Circuit’s use of Federal Rule of Appellate Procedure 36 is irrelevant, because CM specifically alleges the basis for the Federal Circuit’s opinion. *See, e.g.*, Pet. at 38-39.

Under well-established Federal Circuit precedent, there is a rebuttable presumption that a prior art reference is enabling. The PTAB applied the rebuttable presumption, noting that “the ultimate burden of persuasion remains with [Respondent Tekni-Plex],” App. 26a n.7; App. 131a n.8; App. 240a n.8. The PTAB found all the references at issue to be enabling and the Federal Circuit affirmed.

CM contends in its petition that the rebuttable presumption conflicts with *Seymour v. Osborne*, 11 Wall. 516, 555 (1870) and asks this Court to adopt the burden of proof which CM claims that *Seymour* established. However, *Seymour* says nothing about the burden of proving enablement. Nor is there any reason to believe that the Federal Circuit’s longstanding precedent has been out of step with this Court’s jurisprudence for decades. CM’s strained effort to manufacture a conflict is futile.

It is also plainly forfeited. In the proceedings below, CM never claimed that the law establishing the rebuttable presumption should be changed. CM raises the issue for the first time in its Petition for Certiorari. Accordingly, CM has failed to preserve its argument, which is central to all three of its Questions Presented. That failure alone should doom its request for certiorari.

Furthermore, eliminating the rebuttable presumption would not change the outcome in this litigation. The burden of proof on enablement shifts to the patent challenger in the final analysis, regardless of whether the Court were to change the law as CM requests. Tekni-Plex met that burden. The PTAB credited the proof of enablement offered by Respondent Tekni-Plex and expressly found that CM's alleged evidence of "impossibility" in fact did not show impossibility.

Finally, *Loper Bright* is irrelevant to CM's petition. CM seeks to challenge a legal presumption in longstanding Federal Circuit case law. The PTAB applied that presumption and the Federal Circuit affirmed. The presumption is the result of decisions by the Federal Circuit, not some regulatory interpretation by the PTAB. The Federal Circuit did not defer to an interpretation of the law by the PTAB.

CM also faults the Federal Circuit's use of Federal Rule of Appellate Procedure 36<sup>1</sup> because it "allowed" the Federal Circuit to affirm the PTAB decisions based on

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1. CM cites to Federal Rule of Appellate Procedure 36, not Federal Circuit Rule 36. The Federal Circuit cited the latter, not the former.

the PTAB's reasoning. However, the lack of a written opinion is not the problem here, as CM specifically and repeatedly identifies the alleged basis for the Federal Circuit's opinion, *i.e.*, the Federal Circuit's longstanding presumption of prior art enablement, which CM argues should be abolished. *See, e.g.*, Pet. at 38-39 ("The Federal Circuit's use of Fed. R. App. P. 36 to affirm the USPTO's decision does not bar this Court from finding that the threshold issue of prior art enablement under Section 102 and Section 103 was necessarily raised and determined by the Federal Circuit below.") The allegedly offending legal presumption would exist regardless of whether the Federal Circuit affirmed with or without a written opinion.

The Petition should be denied.

## STATEMENT OF THE CASE

### I. Procedural Background

This case arose from three *Inter Partes* Reviews ("IPRs") that Respondent Tekni-Plex, Inc. filed against patents that Petitioner Converter Manufacturing, LLC, asserted against Tekni-Plex in a related district court case. In the IPRs, Tekni-Plex challenged the validity of 72 patent claims. *Tekni-Plex, Inc. v. Converter Mfg., LLC*, Case No. IPR2021-00916, Paper 1 at 1-2 (P.T.A.B. May 10, 2021) (the "916 IPR"); *Tekni-Plex, Inc. v. Converter Mfg., LLC*, Case No. IPR2021-00918, Paper 1 at 1-2 (P.T.A.B. May 10, 2021) (the "918 IPR"); *Tekni-Plex, Inc. v. Converter Mfg., LLC*, Case No. IPR2021-00919, Paper 1 at 1-2 (P.T.A.B. May 10, 2021) (the "919 IPR"). The PTAB issued Final Written Decisions ("FWDs") finding all 72 claims unpatentable over the prior art relied on by Tekni-Plex. App. 106a-107a; App. 215a-216a; App. 314a-315a.

The Federal Circuit affirmed the Board's decisions and subsequently denied CM's Combined Petition for Rehearing and Rehearing *en Banc*. *Converter Mfg., LLC v. Tekni-Plex, Inc.*, Nos. 2023-1801, -1802, -1803, Docs. 56, 59 (Fed. Cir.) (the "*CM Appeal*").

## II. Factual Background

Tekni-Plex proved that the prior art was enabled by showing that the methods described in the references were well-known in the art. App. 34a-37a; App. 39a; App. 44a-46a; App. 90a; App. 138a-142a; App. 144a; App. 148a-150a; App. 196a; App. 243a; App. 248a; App. 250a; App. 252a-253a; App. 255a; App. 263a-264a; App. 268a. As the PTAB found, the methods in one of the prior art references had even been used to manufacture products on a commercial scale several years before CM came up with its alleged invention, App. 44a-46a; App. 148a-150a; App. 263a-264a, and the methods in the other prior art reference predated CM's alleged invention by decades, as shown by an authoritative treatise in the field, App. 28a-29a; App. 133a-134a; App. 243a.

Contrary to CM's assertion, it did not invent the world's first thermoformed rectangular article with a rolled rim. Pet. at 12. The PTAB found that others did so before CM. *See, e.g.*, App. 44a-46a ("We further find persuasive in this regard Petitioner's showing that articles made using Long's [prior-art] process were, in fact, produced on a commercial scale 'since at least as early as 2012.' . . . Petitioner shows that actual trays embodying Long have been made since before the priority date."); App. 148a-150a (same); 263a-264a (same).

The Board specifically discredited CM's alleged evidence of "impossibility," finding that the evidence did not in fact characterize the process described in the prior art reference in question as impossible. *See, e.g.*, App. 65a; App. 171a. For example, the Board found that one of the methods that CM characterized as "impossible," App. 43a-45a; 100a; 147a-149a; 208a; 261a-262a; 306a, was not impossible and in fact had been used to manufacture trays on a commercial scale since before CM's filing date. App. 44a-46a; App. 148a-150a; App. 263a-264a. The Board also weighed the competing testimony of the parties' experts on enablement and found Tekni-Plex's expert more convincing on numerous points. App. 27a-31a; App. 37a; App. 89a-90a; App. 132a-137a; App. 142a; App. 195a-196a; App. 243a-250a; 253a-255a; 261a-262a; 264a-269a.

## **REASONS FOR DENYING THE PETITION**

CM's petition should be denied for multiple, independent reasons.

### **I. Converter Manufacturing Has Identified No Conflict Between U.S. Supreme Court and Federal Circuit Law on the Rebuttable Presumption of Enablement**

The rebuttable presumption of prior art enablement has existed for over 60 years. Upon the assertion of a prior art reference, the patentee bears the initial burden of producing some evidence that the cited art was not enabling, whereupon the patent challenger has the burden of persuasion to prove that the art was enabling. *See Impax*, 545 F.3d at 1316; *Sasse*, 629 F.2d at 681 *Antor*, 689 F.3d at 1287-88; *Morsa*, 713 F.3d at 110. *See also In re Jacobs*, 318 F.2d 743, 745-46 (C.C.P.A. 1963) (prior



art presumed enabled); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1354-55 (Fed. Cir. 2003), *abrogated on other grounds by Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 901 (2014) (prior art presumed enabled).

CM contends that this rebuttable presumption, and the Federal Circuit’s decisions in *Antor*, *Amgen*, and *Rasmusson*, conflict with this Court’s decisions in *Seymour* and *Sanofi* by allegedly treating the enablement standard—including the presumption of enablement and the burden of proof—differently for patent applications versus prior art. Petition at i-ii, 1-3, 10-11, 25-29, 34, 37-39 (citing *In re Antor Media Corp.*, 689 F.3d 1282, 1287-88 (Fed. Cir. 2012); *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 314 F.3d 1313, 1355 (Fed. Cir. 2003) (“*Amgen*”); *Rasmusson v. SmithKline Beecham Corp.*, 413 F.3d 1318, 1325 (Fed. Cir. 2005); *Seymour v. Osborne*, 11 Wall. 516, 555 (1870); *Amgen Inc. v. Sanofi*, 598 U.S. 594, 605-06 (2023) (“*Sanofi*”). But there is no such conflict, or at least none relevant to this case. Neither *Seymour* nor *Sanofi* addresses the presumption of enablement or the burden of proof for enablement.<sup>2</sup>

For example, a passage of *Seymour* on which CM relies says only that the “description and drawings” of a prior art reference must be as “full, clear, and exact” as the teachings in a patent. Pet. at 6 (quoting *Seymour*, 11 Wall. at 555). It does not say, as CM argues, *id.* at i-ii, 33-34, that the standards for enablement of patents and prior art are identical as to the applicable presumption

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2. CM also contends that “proof of enablement” is part of a patent challenger’s statutory burden under 35 U.S.C. §§ 282 and 316(e). Pet. at 32. But those sections say nothing about enablement. They pertain only to the overall burden of proving unpatentability.

and the burden of proof. In fact, *Seymour* does not even mention the presumption or the burden of proof on prior art enablement.

Similarly, *Sanofi* merely addresses the standard for determining whether the teachings of a patent specification are adequate to meet the enablement requirement. *Sanofi*, 598 U.S. at 605. It says nothing at all about the presumption or the burden of proof.

The only standard pertaining to enablement that *Seymour* and *Sanofi* provide is on the *quality of the disclosure*, not the presumption or the burden of proof. Thus, there is no conflict between the Federal Circuit's approach in *Antor* and *Amgen* and the enablement requirements in *Seymour* and *Sanofi*.

*Rasmusson* has nothing to do with the burden-shifting approach that CM challenges, or with any issue decided below by the PTAB or the Federal Circuit in this case. Rather, *Rasmusson* addressed only the narrow question of whether the enablement requirement for prior art under Section 102 also includes a requirement that the prior art be "useful" under 35 U.S.C. 101. *Rasmusson*, 413 F.3d at 1322-23, 1325. Thus, regardless of how *Rasmusson* decided that issue, it is entirely irrelevant to the present case.

CM also cites *Impression Products*, a patent exhaustion case having nothing to do with prior art enablement, patent validity, or any other issue in the present case. Pet. at 29 (quoting *Impression Prods., Inc. v. Lexmark Int'l, Inc.*, 581 U.S. 360, 374 (2017)).

Finally, CM mischaracterizes *Microsoft* as standing for the proposition that the burden of *production* always remains with the party challenging validity. Pet. at 2, 27, 29-30 (citing *Microsoft Corp. v. I4I Ltd. Partnership*, 564 U.S. 91, 98, 106-07 (2011)). Instead, the Court in *Microsoft* expressly distinguished the burden of persuasion—which it defined as clear and convincing evidence—from the burden of production. *Id.*, 564 U.S. at 100 n.4 (differentiating the burdens of persuasion and production and stating: “Here we use ‘burden of proof’ interchangeably with ‘burden of persuasion’ to identify the party who must persuade the [factfinder] in its favor to prevail. We use the term “standard of proof” to refer to the degree of certainty by which the factfinder must be persuaded . . .”), 106 (“A standard of proof . . . can apply only to a burden of persuasion . . .”) (citations omitted). The Court then addressed the sole question presented, which is not at issue in this case: whether the standard of proof for invalidity overall should be clear and convincing evidence or a preponderance of the evidence. *Microsoft*, 564 U.S. at 95, 98-99.

CM misinterprets the passage on *Microsoft* at 106-107 as suggesting that the Court assigned the burden of *production* on invalidity to the patent challenger, and appears to confuse the burdens of proof, persuasion, and production. Pet. at 2 (citing *Microsoft*, 564 U.S. at 107), 30 (citing *Microsoft* at 106-07). The reference in the cited passage to assigning the burden of production to the patent challenger was a hypothetical from Microsoft’s brief, which that party used to argue that the clear and convincing standard was superfluous. *Microsoft*, 564 U.S. at 106-07. The Court dismissed the hypothetical as unpersuasive. *Id.*

The distinction between the burden of *production* and the burden of *persuasion* is important to the present case, because at no time in the IPRs below did the PTAB ever place the burden of *persuasion* on the patent owner. Instead, in each of the three IPRs, the Board expressly stated that, although “Patent Owner bears a burden of *production* on the issue of the enablement,” “the ultimate burden of *persuasion* remains with Petitioner.” App. 26a n.7 (citing *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1379-81 (Fed. Cir. 2015)) (emphasis added); App. 131a n.8; 240a n.8. Thus, there is no conflict between the current burden-shifting approach on enablement and the principle that the challenger bears the burden of proving invalidity.

CM repeatedly contends, incorrectly, that the burden-shifting approach on enablement is “tantamount to a presumption of *invalidity*.” Pet. i, 2, 11, 26-28, 37. There are many other facts in addition to enablement that a patent challenger must prove in order to prevail on an invalidity challenge, such as the presence of every claim element in the prior art, the obviousness of combining any references that are used together, and additional facts underlying the obviousness analysis, such as the likelihood that the combination would be successful and that a person of skill in the art would be motivated to combine the references, to name a few. Moreover, the challenger enjoys no presumption on any of those additional factual issues. There is no presumption of invalidity based merely on prior art enablement.

## II. CM Waived Its Arguments by Failing to Raise Them Before the PTAB or the Federal Circuit

All three of CM's Questions Presented are grounded in CM's argument that the Court should eliminate the rebuttable presumption of enablement and instead place the burden of proving enablement on the patent challenger at all times. However, the first time CM ever raised that issue was in its Petition for a Writ of Certiorari. Accordingly, CM has waived the arguments it makes in its petition and should not be allowed to pursue them for the first time in this Court.

This Court is “a court of review, not of first view.” *Cutter v. Wilkinson*, 544 U.S. 709, 718 n.7 (2005). Thus, any argument not raised in the lower tribunal is generally forfeited/waived. *U.S. v. Jones*, 565 U.S. 400, 413 (2012) (“We have no occasion to consider [the Government’s] argument. The Government did not raise it below, and the D.C. Circuit therefore did not address it. . . . We consider the argument forfeited.”) (citations omitted); *Sprietsma v. Mercury Marine*, 537 U.S. 51, 56 n.4 (2002) (“Because [respondent’s] argument was not raised below, it is waived.”); *Moyle v. United States*, 603 U.S. 324, 336–37 (2024) (Barrett, J., joined by Roberts, C.J., and Kavanaugh, J., concurring in judgment dismissing writ of certiorari as improvidently granted in view of issue not raised below).

The first time that CM ever suggested changing the burden of proof on enablement was in its Petition for Certiorari. CM did not mention the issue in its filings in the IPRs below, in its oral arguments before the PTAB, in its briefs before the Federal Circuit, in its oral arguments

before the Federal Circuit, or in its Petition for Rehearing in the Federal Circuit. *Tekni-Plex, Inc. v. Converter Mfg., LLC*, Case No. IPR2021-00916, Papers 20, 55 (P.T.A.B.) (the “916 IPR”); *Tekni-Plex, Inc. v. Converter Mfg., LLC*, Case No. IPR2021-00918, Papers 24, 60 (P.T.A.B.) (the “918 IPR”); *Tekni-Plex, Inc. v. Converter Mfg., LLC*, Case No. IPR2021-00919, Papers 25, 61 (P.T.A.B.) (the “919 IPR”); *Converter Mfg., LLC v. Tekni-Plex., Inc.*, Nos. 2023-1801, -1802, -1803, Docs. 22, 30, 56 (Fed. Cir.) (the “*CM Appeal*”).

Indeed, as late as its Petition for Rehearing in the Federal Circuit, CM relied on the presumption of enablement without criticizing it and claimed that CM had overcome the presumption. *See, e.g., CM Appeal*, Doc. 56 at 14-15. CM never argued that the presumption itself is improper, inconsistent with *Seymour*, or should be changed.

CM did cite *Seymour* in its Petition for Rehearing, but never suggested that *Seymour* poses a conflict with the Federal Circuit’s longstanding shifting-burden schema on prior art enablement. *CM Appeal*, Doc. 56 at 2, 12, 14-16. And in any event, the petition for rehearing would have been too late to raise the issue for the first time. In the Federal Circuit, “[a] party may not raise new and additional matters for the first time in a petition for rehearing.” *Pentax Corp. v. Robison*, 135 F.3d 760, 762 (Fed. Cir. 1998) (quoting *United States v. Bongiorno*, 110 F.3d 132, 133 (1st Cir. 1997)); *see also Haas v. Peake*, 544 F.3d 1306, 1307-09 (Fed. Cir. 2008) (declining to consider issue “raised for the first time in the petition for rehearing”).

One reason for the Federal Circuit's unwillingness to allow new arguments on a petition for rehearing is that an appellee is not able to respond as a matter of right to the Petition for Rehearing. *See* Fed. R. App. P. 40(a)(3). ("Unless the court requests, no response to a petition for panel rehearing is permitted."). Here, the Federal Circuit made no such request and therefore Tekni-Plex was permitted no response. CM simply never aired its late-breaking argument that decades of Federal Circuit precedents conflict with *Seymour*. There is thus no record on that issue for this Court to review.

In its attempt to manufacture a conflict before this Court, CM also misrepresents the legal standard for enablement employed by the PTAB below. The Board never stated or even suggested that "patentees can only overcome the presumption of prior art enablement if they can show that the disclosures relied on for patent invalidity are always inoperable at any point in time, even after the date of the claimed invention." Pet. at 2, 10-11.

Rather, in the PTAB excerpts that CM cites in purported support of that conclusion, the PTAB found merely that the evidence which CM claimed showed inoperability of the proffered prior art in fact showed no such inoperability. For example, the PTAB found that one of the prior art references is not inoperative or a failure simply because puckering sometimes occurs. App. 30a-31a ("Here, the statements made in Long and its New Zealand counterpart do not persuade us that Portelli's thermoforming method is inoperative or a failure. As Petitioner aptly notes, neither reference states that puckering *always* occurs."); App. 135a (same); App. 243a-244a (same). CM simply disagrees with the PTAB's fact-finding.

This Court will usually decide issues only with “the benefit of thorough lower court opinions to guide [its] analysis of the merits.” *Zivotofsky ex rel. Zivotofsky v. Clinton*, 566 U.S. 189, 201 (2012). The Court lacks that benefit here with respect to the questions presented by CM and should not decide them.

### **III. CM’s Proposed Change in the Law Would Not Alter the Outcome of this Case**

CM proposes to abolish the presumption of enablement of prior art. However, that change in the law would not have changed the outcome of this case.

The PTAB applied the rebuttable presumption of prior art enablement set forth in *Impax*, *Antor*, and *Morsa*, expressly citing those cases. App. 25a-26a; App. 26a n.7; App. 130a-131a, App. 131a n.8; App. 240a; App. 240a n.8. The Board considered the parties’ competing evidence on enablement of the cited prior art (App. 27a-40a; App. 42a-47a; App. 88a-90a; App. 131a-144a; App. 146a-151a; App. 194a-197a; App. 241a-258a; App. 260a-269a), noting that “the ultimate burden of persuasion remains with [Respondent Tekni-Plex],” App. 26a n.7; App. 131a n.8; App. 240a n.8. The Board specifically discredited CM’s alleged evidence of “impossibility,” stating that the evidence does not in fact characterize the prior art reference in question as impossible. *See, e.g.*, App. 65a; App. 171a. Following its analysis, the Board found that all of the cited references were enabled. App. 40a; App. 47a; App. 90a; App. 144a; App. 151a; App. 196a-197a; App. 258a; App. 264a-265a; App. 268a-269a.



Of particular note was the Board's finding that one of the methods that CM characterized as "impossible," App. 43a-45a; 100a; 147a-149a; 208a; 261a-262a; 306a, was not impossible and in fact had been used to manufacture trays on a commercial scale since before CM's filing date, as proven by Tekni-Plex. App. 44a-46a; App. 148a-150a; App. 263a-264a. The Board also weighed the competing testimony of the parties' experts on enablement and found Tekni-Plex's expert more convincing on numerous points. App. 27a-31a; App. 37a; App. 89a-90a; App. 132a-137a; App. 142a; App. 195a-196a; App. 243a-250a; 253a-255a; 261a-262a; 264a-269a.

There is no reason to believe that the Board would have reached a different ultimate conclusion without the rebuttable presumption of enablement. The burden of proving enablement rests with the patent challenger in the final analysis, regardless of whether the Court were to change the law as CM requests. Tekni-Plex met that burden and would have met it with or without the presumption. Accordingly, CM's proposed change in the law on burden of proof would not have had any effect on the outcome of this case.

#### **IV. Policy Considerations Weigh Against Changing the Current Law**

There are also compelling policy reasons for preserving the Federal Circuit's burden-shifting approach.

First, abolishing the presumption of prior art enablement would significantly and unnecessarily increase the cost and complexity of patent litigation. In many (if not most) patent cases, there is no dispute over whether

prior art is enabling. Yet if the patent challenger were to bear the burdens of both production and persuasion on enablement throughout the proceedings, as CM advocates, then the parties, the courts, and the PTAB would need to analyze enablement for every prior art reference in every case. This task would significantly increase the cost and complexity of patent litigation, all of which would be multiplied whenever the patent disputes involve numerous pieces of prior art.

Second, preserving the presumption keeps the initial burden with the party who is in the better position to offer some evidence of non-enablement. Typically the patent owner or inventor is in a better position than the patent challenger to show, by experiment or argument, why the disclosure in question is not enabling or operative. Often it would be overly cumbersome for the party proffering the prior art to show that it is enabling. *In re Antor Media Corp.*, 689 F.3d 1282, 1288 (Fed. Cir. 2012).

Third, the current burden-shifting approach assigns the patent owner only a very light initial burden: to “make a non-frivolous argument that cited prior art is not enabling.” *In re Morsa*, 713 F.3d 104, 110 (Fed. Cir. 2013). This is a burden of production, not a burden of persuasion. Once the patent owner makes the non-frivolous argument, the burden of proof shifts to the party challenging validity, who has the heavier burden, *i.e.*, the burden of persuasion. *Id.* Under this approach, the only instances in which the patent challenger need not prove enablement are those in which (1) the patent owner did not even contest the issue, or (2) the patent owner’s non-enablement position is frivolous. That is an eminently reasonable approach, because those are the two situations in which it would be

a waste of the parties' and tribunal's time and money to litigate enablement in the first place. The burden-shifting approach prevents that waste.

The current, burden-shifting approach will never prevent a patent owner from shifting the burden to the patent challenger if there is any merit to the patent owner's position, whereas eliminating the current approach would significantly increase the cost and time expenditure of every single patent case by forcing the challenger to address enablement every time for every reference, regardless of whether it is a genuine issue.

However, CM contends that the policy considerations supporting the Federal Circuit's presumption of enablement and its burden-shifting approach apply only to *ex parte* patent examination. Pet. at 30-32. That is incorrect. Although some early cases invoking the presumption were appeals of patent examiner decisions, *see, e.g., In re Sasse*, 629 F.2d 675, 676 (C.C.P.A. 1980), the same policy considerations—containing cost and complexity, avoiding wasteful litigation on issues that are not genuinely in dispute, the fact that the patent owner is usually in the best position at least to raise a non-frivolous argument of non-enablement, and the certainty that the burden of proof will be assigned to the patent challenger if there is any merit at all to the patent owner's assertion of non-enablement—apply equally to *inter partes* adversarial matters in the PTAB and the district courts.

#### **V. *Loper Bright* is Irrelevant to CM's Petition**

In a last-ditch effort to present the veneer of cert-worthiness, CM argues that the decision below is

inconsistent with *Loper Bright Enters. v. Raimondo*, 603 U.S. 369 (2024), But this case was not one in which the federal judiciary deferred to an agency’s interpretation of an ambiguous statute. On the contrary, in the proceedings below, the PTAB faithfully applied the Federal Circuit’s precedents—and the Federal Circuit affirmed that fact-bound determination. Thus, *Loper Bright* is inapplicable here.

CM seeks to challenge the rebuttable presumption of prior art enablement in longstanding Federal Circuit case law. The PTAB applied that presumption and the Federal Circuit affirmed. The presumption was created by the Federal Circuit, not the PTAB. Accordingly, *Loper Bright* is not implicated. The Federal Circuit did not defer to an interpretation of the law by the PTAB. On that ground alone, CM’s third Question Presented should be rejected as a basis for certiorari.

Finally, CM alleges that the Federal Circuit accomplished the alleged deference using Federal Rule of Appellate Procedure 36 (“Rule 36”). However, that allegation, too, fails to raise any cert-worthy issue. First, as explained above, there was no deference to an interpretation of the law by the PTAB. Second, CM does not identify why the Rule 36 affirmances here were allegedly problematic—except that those affirmances were based on Federal Circuit precedent about the enablement presumption which CM asks this Court to modify, an argument that has nothing to do with Rule 36. This alleged problem would exist regardless of whether the Federal Circuit affirmed with opinion or without opinion.

**CONCLUSION**

The petition for a writ of certiorari should be denied.

Respectfully submitted,

DIANE SIEGEL DANOFF

*Counsel of Record*

KEVIN FLANNERY

MICHAEL A. FISHER

ROBERT W. ASHBROOK, JR.

LUKE M. REILLY

DECHERT LLP

2929 Arch Street

Philadelphia, PA 19104

(215) 994-2179

diane.danoff@dechert.com

*Counsel for Respondent*

*Tekni-Plex, Inc.*

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