

24-2335

**United States Court of Appeals
for the Federal Circuit**

FMC CORPORATION,

Plaintiff-Appellee,

– v. –

SHARDA USA, LLC,

Defendant-Appellant.

*On Appeal from the United States District Court for the
Eastern District of Pennsylvania in No. 2:24-cv-02419-MRP,
Honorable Mia Roberts Perez, Judge*

**DEFENDANT-APPELLANT’S RESPONSE TO
PLAINTIFF-APPELLEE’S COMBINED PETITION
FOR REHEARING AND REHEARING *EN BANC***

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OCTOBER 28, 2025

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF INTEREST

Case Number 2024-2335

Short Case Caption FMC Corporation v. Sharda USA, LLC

Filing Party/Entity Sharda USA LLC

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Signature: /s/ Mircea A. Tipescu

Name: Mircea A. Tipescu

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<p>Sharda USA LLC</p>		<p>Sharda Cropchem Limited</p>

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TABLE OF CONTENTS

CERTIFICATE OF INTEREST	i
TABLE OF CONTENTS.....	iv
TABLE OF AUTHORITIES	v
INTRODUCTION	1
BACKGROUND	2
I. The Patents and Technology at Issue	2
II. District Court Proceedings.....	3
III. The Panel Decision	4
IV. FMC’s Petition for Rehearing	5
ARGUMENT	6
I. The Panel’s Treatment of The “Miticidal” Preamble Does Not Warrant En Banc or Panel Rehearing.....	6
A. The Panel’s Decision Does Not Conflict with Binding Precedent	6
B. The Panel Did Not Refuse to Consider Claim Construction Principles	8
C. The Petition Also Does Not Present A Question of Exceptional Importance.....	12
II. The Panel’s Construction of “Composition” Does Not Warrant Panel Rehearing.....	13
A. The Panel Did Not Misunderstand <i>DDR</i>	13
B. The Panel Also Did Not Overlook Evidence on Insecticidal Activity or Stability	15
CONCLUSION.....	16

TABLE OF AUTHORITIES

Cases

<i>Arctic Cat Inc. v. GEP Power Prods., Inc.</i> , 919 F.3d 1320 (Fed. Cir. 2019)	7
<i>Bell Commc 'ns Rsch., Inc. v. Vitalink Commc 'ns Corp.</i> , 55 F.3d 615 (Fed. Cir. 1995)	6, 7
<i>Bernklau v. Principi</i> , 291 F.3d 795 (Fed. Cir. 2002)	10
<i>Bicon, Inc. v. Straumann Co.</i> , 441 F.3d 945 (Fed. Cir. 2006)	12
<i>Bristol-Myers Squibb Co. v. Ben Venue Lab'ys, Inc.</i> , 246 F.3d 1368 (Fed. Cir. 2001)	8, 11
<i>Catalina Mktg. Int'l, Inc. v. Coolsavings.com, Inc.</i> , 289 F.3d 801 (Fed. Cir. 2002)	7, 10, 11
<i>Cochlear Bone Anchored Sols. AB v. Oticon Med. AB</i> , 958 F.3d 1348 (Fed. Cir. 2020)	9
<i>Comark Commc 'ns, Inc. v. Harris Corp.</i> , 156 F.3d 1182 (Fed. Cir. 1998)	8
<i>DDR Holdings, LLC v. Priceline.com LLC</i> , 122 F.4th 911 (Fed. Cir. 2024)	4, 5, 14
<i>Eli Lilly & Co. v. Teva Pharms. Int'l GmbH</i> , 8 F.4th 1331 (Fed. Cir. 2021)	6, 12, 13
<i>Finjan LLC v. ESET, LLC</i> , 51 F.4th 1377 (Fed. Cir. 2022)	4, 14
<i>In re Taylor</i> , 484 F.App'x 540 (Fed. Cir. 2012)	9
<i>Intervet Am., Inc. v. Kee-Vet Lab 'ys, Inc.</i> , 887 F.2d 1050 (Fed. Cir. 1989)	16

MPHJ Tech. Invs., LLC v. Ricoh Americas Corp.,
847 F.3d 1363 (Fed. Cir. 2017) 4, 14

Pacing Tech., LLC v. Garmin Int’l, Inc., 778 F.3d 1021 (Fed. Cir.
2015)..... 4, 6, 7

Pentax Corp. v. Robison,
135 F.3d 760 (Fed. Cir. 1998)15

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005)6, 7

Symantec Corp. v. Computer Assocs. Int’l, Inc.,
522 F.3d 1279 (Fed. Cir. 2008)7

Taylor v. McKeithen,
407 U.S. 191 (1972)10

United States v. Garza,
165 F.3d 312 (5th Cir. 1999).....10

Rules

FED. CIR. R. 401, 6

FED. R. APP. P. 40.....1, 6

FED. R. CIV. P. 65(b)(2).....4

INTRODUCTION

FMC’s combined petition for panel rehearing and rehearing *en banc* fails to meet the rigorous standards required under Federal Rule of Appellate Procedure 40 and Federal Circuit Rule 40. The panel’s decision applied long established claim construction principles and faithfully adhered to binding precedent. The panel did not misapprehend or overlook any material facts or controlling law, nor did it create a conflict within this Court’s jurisprudence or address a matter of “exceptional importance” that would warrant *en banc* review.

FMC’s arguments rest on a mischaracterization of the panel’s treatment of preambles and the false premise that the panel’s construction of the term “composition” is contrary to intrinsic evidence. The panel did not apply a categorical rule, as FMC asserts, in concluding that the “miticidal” language in the preamble of certain composition claims was not limiting. Instead, the panel considered Sharda’s argument that FMC defined a structurally complete invention in the body of these claims and correctly applied precedent to find that the “miticidal” preamble language is non-limiting because it merely states the purpose or intended use of the composition. The panel also correctly found that the term “composition” is not limited to “stable” compositions based on FMC’s deliberate deletion of stability references in the Asserted Patents. FMC’s dissatisfaction with these outcomes does

not transform routine claim construction disputes into matters of exceptional importance.

The petition fails to offer other compelling reasons for the Court to revisit the panel’s decision. The panel’s decision does not create doctrinal confusion or alter established law. Intervention would therefore do nothing to promote uniformity or resolve a precedent-setting issue. For at least these reasons, the petition should be denied.

BACKGROUND

I. THE PATENTS AND TECHNOLOGY AT ISSUE

The patents at issue claim pesticide compositions that combine two well-known active ingredients—bifenthrin and zeta-cypermethrin—that have long been used in agricultural formulations for insect control. Appx712 at ¶ 6; Appx716 at ¶ 16. But FMC alleges in U.S. Patent Nos. 9,107,416 (“the ’416 patent”) and 9,596,857 (“the ’857 patent”) (collectively, “Asserted Patents”) that certain combinations of the two ingredients within certain weight ratios produced an “unexpected increase in insecticidal activity.” Appx712 at ¶ 6; Appx716 at ¶ 16; Appx37 at 2:8-11; Appx27 at 2:5-8.

In related filings, specifically the provisional application from which the Asserted Patents claim priority and a related issued patent, U.S. Patent No. 8,153,145 (“the ’145 patent”), FMC also identified a different alleged invention, namely

physically “stable” formulations. Appx870-71; Appx876-77; Appx860-61; Appx863-64. When FMC filed the applications that became the Asserted Patents, however, it deleted every reference to “stable” and “stability.” Appx2657-62. The terms appears nowhere in the claims, the specification, or the prosecution history of the Asserted Patents. Appx26-34; Appx36-43. Instead, FMC focused exclusively on the claimed components and their concentration ranges. Appx26-34; Appx36-43; *see also* Appx2061-62. The deletion was deliberate, not inadvertent, and the omission of “stable” and “stability” is central to this appeal.

II. DISTRICT COURT PROCEEDINGS

Sharda developed its own bifenthrin—zeta-cypermethrin formulation, which FMC alleged infringed the Asserted Patents. Appx3; Appx5; Appx2339 at ¶ 28; Appx53. FMC initially moved for both a temporary restraining order and a preliminary injunction, urging a construction for the term “composition” that imported the deleted “stability” concept. Appx702-05. The district court agreed. Appx22. Relying heavily on expert declarations and on language from FMC’s provisional application and the ’145 patent that was deleted from the Asserted Patents, the court construed “composition” to mean “stable compositions, rather than the well-known unstable compositions that produce ineffective results as discussed throughout the prosecution history.” Appx21-22; *see also* Op. at 3.

On a renewed motion for temporary restraining order, the district court concluded that Sharda’s product likely infringed, rejected Sharda’s invalidity defenses based on its “composition” construction, and found that FMC was likely to succeed on the merits. Appx6-7; Appx 11-13. It issued a temporary restraining order which ultimately converted into a preliminary injunction barring Sharda from marketing its product pending trial. Appx1-2; FED. R. CIV. P. 65(b)(2).

III. THE PANEL DECISION

On appeal, the panel reversed on construction of the term “composition” and vacated the injunction order. Op. at 11, 13. The panel held that the district court’s claim construction violated a bedrock interpretive rule: a court cannot import limitations from a provisional application or related patent that uses deleted language. Op. at 7. The panel emphasized that “stability” appears nowhere in the Asserted Patents and that the specification provides no definition or lexicography linking stability to the claimed compositions. Op. at 7. Citing *DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911 (Fed. Cir. 2024), *MPHJ Tech. Invs., LLC v. Ricoh Ams. Corp.*, 847 F.3d 1363, 1369 (Fed. Cir. 2017), and *Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1383 (Fed. Cir. 2022), the panel concluded that deletions between related applications are significant and must be respected. Op. at 7-8.

The panel also cited *Pacing Technologies, LLC v. Garmin Int’l, Inc.*, 778 F.3d 1021, 1023-24 (Fed. Cir. 2015) in holding that the “miticidal composition” preamble

described only an intended use and did not limit the claim in which the term is employed. Op. at 13. Having found Sharda to have “raised a substantial question of anticipation,” among other things, the panel vacated the preliminary injunction, and remanded for further proceedings consistent with the opinion. Op. at 13, 16.

IV. FMC’S PETITION FOR REHEARING

FMC’s petition argues that:

1. the panel’s treatment of the “miticidal” preamble is contrary to binding precedent and misapprehends when ordinary claim-construction principles apply.
2. the panel perpetuated “disarray” in preamble law.
3. the panel misapprehended *DDR* in construing “composition.”
4. the panel overlooked evidence linking “activity” and “stability” in construing the claim term “composition.”

Petition at iv-v, 1, 7-19.

None of these assertions withstand scrutiny. Each point was fully briefed, squarely addressed, and correctly resolved in the panel decision. The petition identifies no factual or legal oversight and no split in authority. It is, at bottom, an invitation for this Court to revisit the merits—a request the relevant Rules do not permit.

ARGUMENT

Under the applicable rules, “rehearing en banc is not favored” and will be ordered only to secure or maintain uniformity of the Court’s decisions or to resolve questions of exceptional importance. FED. R. APP. P. 40; FED. CIR. R. 40. Panel rehearing is limited to cases involving overlooked or misapprehended points of law or fact. FED. R. APP. P. 40; FED. CIR. R. 40. FMC’s petition satisfies neither standard.

I. THE PANEL’S TREATMENT OF THE “MITICIDAL” PREAMBLE DOES NOT WARRANT EN BANC OR PANEL REHEARING

A. The Panel’s Decision Does Not Conflict with Binding Precedent

FMC contends that the panel categorically ruled that “use” preambles are non-limiting without regard to ordinary claim construction principles. *See* Petition at iv, 1, 10-13. In reality, the panel simply stated: “[p]reamble language that merely states the purpose or intended use of an invention is *generally* not treated as limiting the scope of the claim.” Op. at 13 (quoting *Pacing*, 778 F.3d at 1023 (emphasis added)).

More importantly, the panel’s decision is consistent with binding precedent. Whether a preamble limits claim scope is a context-specific inquiry governed by ordinary claim construction principles. *See Bell Commc’ns Rsch., Inc. v. Vitalink Commc’ns Corp.*, 55 F.3d 615, 620-21 (Fed. Cir. 1995); *see also Eli Lilly & Co. v. Teva Pharms. Int’l GmbH*, 8 F.4th 1331, 1340 (Fed. Cir. 2021); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005). But as set forth in *Bell*, “a claim preamble has the import that the claim as a whole suggests for it.” *Bell*, 55 F.3d at

620; *see also Phillips*, 415 F.3d at 1332 (stating that “[c]laim construction is, or should be, made in context.”).

This Court has long held that “preambles describing the use of an invention *generally* do not limit the claims, because the patentability of apparatus or composition claims depends on the claimed structure, not on the use or purpose of that structure.” *Catalina Mktg. Int’l, Inc. v. Coolsavings.com, Inc.*, 289 F.3d 801, 809 (Fed. Cir. 2002) (emphasis added). That is, when the body of the claim “defines a structurally complete invention,” the preamble “is not limiting.” *Id.* “Absent clear reliance on the preamble in the prosecution history, or in situations where it is necessary to provide antecedent basis for the body of the claim, the preamble ‘generally is not limiting.’” *Symantec Corp. v. Computer Assocs. Int’l, Inc.*, 522 F.3d 1279, 1288 (Fed. Cir. 2008) (quoting *Catalina*, 289 F.3d at 809). This flexible, context-driven approach has been applied consistently for decades. *See, e.g., Arctic Cat Inc. v. GEP Power Prods., Inc.*, 919 F.3d 1320, 1327 (Fed. Cir. 2019); *Pacing*, 778 F.3d at 1023; *Symantec*, 522 F.3d at 1288. With none of the exceptions to this general proposition present here, the panel correctly found that the “miticidal” language in the context of a preamble of a composition claim does not limit the claims because it merely states a purpose or intended use. *Op.* at 13. The decision in no way conflicts with *Bell*, *Phillips*, and other binding precedent as FMC asserts.

B. The Panel Did Not Refuse to Consider Claim Construction Principles

FMC also accuses the panel of refusing to consider claim-construction principles based on the panel’s rejection of its claim differentiation arguments. Petition at 8-10. Rejection of an argument does not amount to a refusal to consider an argument. In fact, the panel expressly recognized FMC’s claim differentiation argument that certain asserted claims recite “insecticidal or miticidal” in the preamble, while others recite only “miticidal” in the preamble, but reasonably concluded that the “variations in language have no effect if said language is not controlling in the first place.” Op. at 13. As this Court has previously recognized, “[t]he doctrine [of claim differentiation] only creates a presumption that each claim in a patent has a different scope; it is not a ‘hard and fast’ rule of construction.” *Bristol-Myers Squibb Co. v. Ben Venue Lab’ys, Inc.*, 246 F.3d 1368, 1376 (Fed. Cir. 2001) (quoting *Comark Commc’ns, Inc. v. Harris Corp.*, 156 F.3d 1182, 1186 (Fed. Cir. 1998)). Like in *Bristol-Myers Squibb*, this panel had the right to “decline to blindly apply the doctrine in this case to supplant other canons of claim construction.” *Id.*

Sharda’s appeal briefing extensively discussed why the preamble language is not limiting here. ECF 14 at 50-51; ECF 28 at 20. Having considered Sharda arguments and FMC’s responses, the panel correctly found the “miticidal” language is not controlling in the first place. Op. at 13. A “use” preamble of a “composition”

claim is not limiting “when the claim body defines a structurally complete invention,” regardless of the intended use. *In re Taylor*, 484 F.App’x 540, 543 (Fed. Cir. 2012). Here, the body of the relevant composition claim defines the requisite components namely bifenthrin and a cyano-pyrethroid (e.g., zeta-cypermethrin) and the ratio range of the two components. Appx33 at 14:42-49, 14:57-58, 14:66-67; Appx34 at 15:1-4. FMC has never explained how the term “miticidal” further “limits the scope of protection sought, i.e., excludes compositions that would otherwise satisfy the recited structural requirements.” *Taylor*, 484 F.App’x at 543. Under these circumstances, the preamble “miticidal” is not limiting.

The “miticidal” term is also “not necessary to provide antecedent basis for the body of the claims.” *Cochlear Bone Anchored Sols. AB v. Oticon Med. AB*, 958 F.3d 1348, 1355 (Fed. Cir. 2020). The dependent claims rely on the term “composition” rather than “miticidal.” Appx33-34 at 14:48-49, 57-58, 66-67; 15:1-4 (claims 2, 4, 6-8). FMC has never asserted that “miticidal” is necessary to provide an antecedent basis. “The language at issue here, which states only an intended use, adds no structural element, and provides no antecedent basis for the body of the claims, is not limiting.” *Cochlear Bone*, 958 F.3d at 1355. The panel’s decision was proper.

FMC’s reliance on the prosecution history also does not compel a different result.¹ “[S]tatements of intended use or asserted benefits in the preamble may, in rare instances, limit [composition] claims, but only if the applicant clearly and unmistakably relied on those uses or benefits to distinguish prior art.” *Catalina*, 289 F.3d at 809. FMC did not rely on the “miticidal” preamble term to distinguish the art. Original claim 1 of the relevant application was directed to an “insecticidal or miticidal composition.” Appx908. While FMC amended that claim during prosecution to a “miticidal composition,” it did not rely on that aspect to distinguish the prior art. Appx1101, Appx1104-07. Instead, FMC argued that the prior art did not disclose “foliar” application of the composition—nowhere did it represent that the “miticidal” language distinguished the claim from the prior art. Appx1105. Nor did the examiner rely on “miticidal” use to allow the claims. Appx1179-1180 (relying only on claimed weight ratio and foliar application). Under the reasoning in *Catalina*, “the disputed preamble language does not limit [the miticidal composition

¹ FMC asserts that the prosecution history supports its claim differentiation argument and complains that the “opinion never mentions the prosecution history.” Petition at 10. But this Court has held that a “litigant’s right to have all issues fully considered and ruled on by the appellate court does not equate to a right to a full written opinion on every issue raised.” *Bernklau v. Principi*, 291 F.3d 795, 801 (Fed. Cir. 2002) (quoting *United States v. Garza*, 165 F.3d 312, 314 (5th Cir. 1999); see also *Taylor v. McKeithen*, 407 U.S. 191, 194 n. 4 (1972) (stating that courts of appeals “have wide latitude” in deciding whether and how to write an opinion”).

claims]. To hold otherwise would effectively impose a method limitation on [a composition] claim without justification.” *Catalina*, 289 F.3d at 810.

Finally, incorporating a use limitation into the composition claim here is nonsensical. FMC has pointed to no support in the intrinsic evidence to demonstrate when the claimed composition would be considered “miticidal” as opposed to “insecticidal.” The preamble’s recitation of intended use does not limit the claimed composition because it provides no objective structural or compositional distinction, nor does it supply a clear standard for determining infringement. As written in the claims, the composition itself remains the same whether or not it is ever employed in a “miticidal” manner or for that matter in an “insecticidal” manner. Appx33-34 at 14:42-47, 15:9-14. Indeed, while the composition sits on a store shelf, it would not, and could not, satisfy the preamble’s intended use unless and until a consumer happens to use it in that particular way. FMC also tacitly agreed to this proposition in the district court proceedings. Appx167 (infringement claim chart only alleging that “Winner can also be used to control mites”); Appx2229 (same). This Court has consistently held that such intended-use language in a composition claim is non-limiting because it fails to provide a meaningful boundary for infringement. *See, e.g., Bristol-Myers Squibb.*, 246 F.3d at 1375 (finding “[t]he express dosage amounts are material claim limitations; the statement of the intended result of administering those amounts does not change those amounts or otherwise limit the claim.”).

C. The Petition Also Does Not Present A Question of Exceptional Importance

FMC devotes much of its petition to attacking this Court’s significant preamble jurisprudence as an “incoherent mess,” “nonsense,” and “untenable” in order to manufacture a question of exceptional importance. Petition at iv, 1, 11-14. While it is true that certain judges and scholars have requested clarification on the law of preambles, their complaints are directed to policy disagreement rather than legal error. FMC fails to demonstrate how the panel’s decision conflicts with existing law or introduces new uncertainty warranting *en banc* review under the particular facts of this case. FMC readily concedes that there is over half of a century of precedent assessing whether preambles are limiting in the context of different types of claims and technologies. Petition at 12-14. This case does not present any new issues that merit an overhaul of this long-standing precedent. In fact, the context-specific inquiry applied by the panel here has produced coherent and tenable results including recently in the *Lilly* case that FMC cites.

The Court in *Lilly* recognized settled law that “[w]ith regard to claims directed to apparatuses or compositions, we have often relied on the proposition that ‘[p]reamble language that merely states the purpose or intended use of an invention is generally not treated as limiting the scope of the claim.’” 8 F.4th at 1340-41 (quoting *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 952 (Fed. Cir. 2006)). But the Court reaffirmed that there are exceptional circumstances when statements of

intended purpose may be limiting, namely where the preamble “recites essential elements of the invention pertaining to the structure” or provides “antecedent basis for the structural terms in the body of the claim.” *Id.* at 1341. Applying this logic, the Court in *Lilly* found the preamble phrase “treatment of migraine” limiting because it provided antecedent basis in the claim body. *Id.* at 1343. In contrast, with no such exceptional circumstance available here, the panel properly found “miticidal” not limiting. *Op.* at 13.

FMC’s attempt to recast settled determination as doctrinal confusion is meritless. No question of exceptional importance warrants *en banc* review.

II. THE PANEL’S CONSTRUCTION OF “COMPOSITION” DOES NOT WARRANT PANEL REHEARING

A. The Panel Did Not Misunderstand *DDR*

FMC asserts that in reaching its construction of “composition,” the panel misapprehended *DDR* and FMC’s arguments regarding the same. Petition at 16. In so arguing, FMC admittedly rehashes prior arguments, *id.* at 16-17, ignoring this Court’s clear directive that “[p]etitions for rehearing should not be used to reargue issues previously presented that were not accepted by the merits panel during initial consideration of the appeal.” *See* <https://www.cafc.uscourts.gov/home/case-information/case-filings/petitions-for-rehearing-rehearing-en-banc/>.

Regardless, the panel did not misapprehend *DDR* or FMC’s arguments. The panel correctly applied *DDR*, in finding that the deletion of stability-related language

from the Asserted Patents indicated that the inventors did not intend to limit the claims to stable compositions. Op. at 7. FMC recognizes that the panel extensively evaluated the same definitional language from the provisional and downstream patent in *DDR* now cited by FMC. Petition at 16. The panel also clearly addressed FMC's attempt to distinguish *DDR* and found it unavailing. Op. at 8.

FMC complains now that the panel misunderstood its argument, and it was actually “about how Sharda’s construction would broaden the claims in a matter that defies prosecution history.” Petition at 16-17. But the panel extensively addressed the so-called “disclaimers made during prosecution” as these were all statements that were expressly deleted from the Asserted Patents. Op. at 8-9. FMC’s attempt to downplay these deletions as a mere decision “not to carry forward into the body of the patent” or a “decision not to repeat those statements in the asserted patents” that should have no consequences in the interpretation of the claims of the Asserted Patents flies in the face of precedent in *DDR*, *Finjan*, and *MPHJ*. See, e.g., *DDR*, 122 F.4th at 916-17; *Finjan*, 51 F.4th at 1383; *MPHJ*, 847 F.3d at 1369. FMC’s contrary view—that the deletions should be disregarded—is unsupported by case law and would invert the public-notice function of the patent system. It would allow patentees to broaden during prosecution and then re-narrow in litigation or vice versa, leaving competitors uncertain about what the claims mean. The panel correctly refused to endorse that instability.

B. The Panel Also Did Not Overlook Evidence on Insecticidal Activity or Stability

FMC's refrain that the panel "overlooked" evidence that skilled artisans understood superior insecticidal activity to require stability in reaching its "composition" construction is also baseless. Petition at 18-19. The panel discussed FMC's alleged evidence and found no basis for any argument in support of FMC's "stable" construction. Op. at 10-11. FMC's primary evidence was based on statements in the provisional application. Petition at 19 (citing Appx870-71). Not only were those statements expressly deleted from the Asserted Patents, but the panel also evaluated those statements and held that nothing in them implied that compositions possessing "unexpected effectiveness" must necessarily be stable. Op. at 10.

FMC also cites testimony from Sharda's expert allegedly admitting that "to be significantly more effective than bifenthrin and zeta-cypermethrin 'individually,' a 'composition' with both active ingredients 'would necessarily have to have been stable.'" Petition at 18-19. First, FMC did not cite this expert testimony in the underlying appeal and should not be allowed to rely on it now. *Pentax Corp. v. Robison*, 135 F.3d 760, 762 (Fed. Cir. 1998) (declining to address new theory raised for the first time in petition for rehearing). Second, as the panel recognized, activity and stability are different properties. Op. at 10. And neither of these properties are recited in the Asserted Claims. Appx43 at 13:41-14:7, 14:23-25; Appx33 at 14:42-

49, 57-67; Appx34 at 15:1-20, 28-29. This Court has found it improper to interpret claims by reading in properties “which were not recited in the claims.” *Intervet Am., Inc. v. Kee-Vet Lab ’ys, Inc.*, 887 F.2d 1050, 1053 (Fed. Cir. 1989). Further, given the express deletion of references to stability in the Asserted Patents, the panel rightly held that “[a] skilled artisan ... would not understand ‘composition’ as claimed in the asserted patents to cover only stable formulations.” Op. at 7. FMC’s attempt to override the intrinsic evidence with extrinsic testimony should be rejected. FMC presents no reason to disturb the panel’s “composition” construction.

CONCLUSION

For the forgoing reasons rehearing and rehearing en banc are not warranted here, and FMC’s petition should be denied.

October 28, 2025

Respectfully submitted,

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**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATIONS

Case Number: 2024-2335

Short Case Caption: FMC Corporation v. Sharda USA, LLC

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Signature: /s/ Mircea A. Tipescu

Name: Mircea A. Tipescu