

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITESA SIMPSONVILLE, INC.,
Petitioner

v.

THE PROCTER & GAMBLE COMPANY,
Patent Owner.

Case IPR2023-01450
Patent 10,513,801

PATENT OWNER PRELIMINARY RESPONSE

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TABLE OF CITED EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 10,513,801
1002	U.S. Patent No. 6,013,223 (“Schwarz ’223”)
1003	Int’l Publ. No. WO 00/029658 (“McDowall”)
1004	U.S. Patent Appl. Publ. No. 2003/0211802 (“Keck”)
1005	U.S. Patent No. 5,476,616 (“Schwarz ’616”)
1006	U.S. Patent No. 6,783,854 (“Bond ’854”)
1007	U.S. Patent No. 4,100,324 (“Anderson”)
1012	File History U.S. Patent No. 10,513,801
1013	File History U.S. Patent No. 8,852,474
1015	Declaration of Gajanan S. Bhat, Ph.D.
1018	U.S. Patent No. 6,114,017 (“Fabbriante”)
1029	U.S. Patent Appl. Publ. No. 2007/0202766 (“Ouellette”)
2001	U.S. Patent No. 8,852,474 B2
2002	M.P.E.P. § 609.02 (9th ed., Rev. 07.2015, Nov. 2015)
2003	PTO Global Dossier Report re Keck (Ex. 1004)
2004	U.S. Patent Appl. Publ. No. 2004/0096656 (“Bond ’656”)

I. INTRODUCTION

The Board should deny the Petition for inter partes review of U.S. Patent No. 10,513,801 (“the ’801 patent,” Ex. 1001). Generally, the patent claims a co-form process that uses a particular type of multifilament die to produce a fibrous product. The recited die contains a particular arrangement of filament-forming and fluid-releasing holes. Through multiple, redundant grounds, the Petition presents a *single* combination of prior art disclosures—cumulative to what the Patent Office already considered—to argue the independent claims are unpatentable. Common to these grounds are (a) a disclosure of a co-form process using a knife-edge die, and (b) a separate disclosure of a *non*-co-form process using a *non*-knife-edge die. Each disclosure appears in multiple, different prior art documents the Petition identifies. But the examiner fully understood and appreciated these types of disclosures. Indeed, he applied and later withdrew the combination during prosecution of *broader* claims that issued in the grandparent patent.

The Petition explains that prosecution of the application for the ’801 patent was limited to an obviousness-type double patenting rejection over claims that issued in the grandparent. Pet. at 10. But the Petition does not explain that the prior art disclosures on which each ground relies were previously presented to the examiner or are cumulative. And while the Petition summarizes the prosecution of the grandparent, *id.* at 11–15, it does not present details that demonstrate the examin-

er's consideration of the same disclosure combination the Petition implores the Board to reconsider. As a result, the Petition does little more than combine the same types of disclosures again, through multiple, materially indistinguishable grounds.

The Board should exercise its discretion, under 35 U.S.C. § 325(d), to deny the Petition. Earlier Board decisions applying § 325(d) did not limit the inquiry to the prosecution of just the challenged patent but looked to what prior art disclosures and arguments were addressed during prosecution of priority patents. By following that approach here, the Board will find that the examiner considered substantially the same prior art disclosures and combinations and did not materially err in issuing the challenged claims. Under these circumstances, the Petition should be denied.

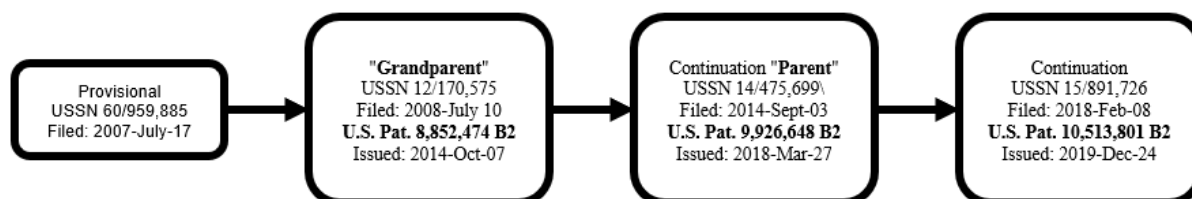
Separately, the Board should deny the Petition on the merits. Across four grounds, the Petition argues that the patent's two independent claims are obvious. But none of these grounds identifies any reliable evidence on which the Board could find that a person having ordinary skill in the art would have had a reasonable expectation of success in combining the prior art. The remaining two grounds challenge only dependent claims and rely on the Board finding the independent claims are obvious. Because the Petition presents no reliable evidence of a reason-

able expectation of success, the petitioner has not shown it is reasonably likely to prevail with respect to any challenged claim.

II. FAMILY HISTORY OF THE CHALLENGED PATENT

The '801 patent is the third patent to issue in a family that claims the benefit of priority to a provisional application filed in 2007. The relationship of these three patents and the provisional application are shown below.

Figure A



The grandparent application issued as the '474 patent. A continuation of the grandparent issued as the '648 patent ("parent"). In turn, a continuation of the parent issued as the '801 patent. As explained below, prosecution of the claims issuing in the grandparent is relevant.

A. The '801 Patent

The specification of the '801 patent discloses a process of making fibrous structures (products). Examples of the products include paper, fabrics, and absorbent pads, like diapers or feminine hygiene products. Ex. 1001 ('801 patent) at 3:8–16.

The specification also describes an exemplary “co-form” process for making these products, referencing Figure 10:

The process shown in FIG. 10 comprises the step of mixing a plurality of solid additives 14 with a plurality of filaments 12. ... The solid additives 14 may be combined with the filaments 12, such as by being delivered to a stream of filaments 12 from a hammermill 66 via a solid additive spreader 67 to form a mixture of filaments 12 and solid additives 14. The filaments 12 may be created by meltblowing from a meltblow die 68. The mixture of solid additives 14 and filaments 12 are collected on a collection device, such as a belt 70 to form a fibrous structure 72.

Id. at 13:17–37. Figure 10 is reproduced below with text annotations mirroring the above quoted description.

Figure B (Fig. 10 of '801 Patent)

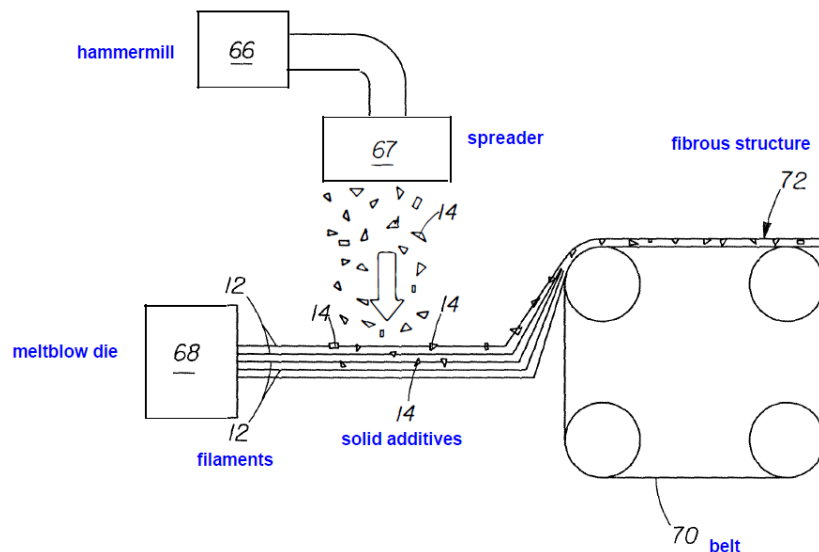


Fig. 10

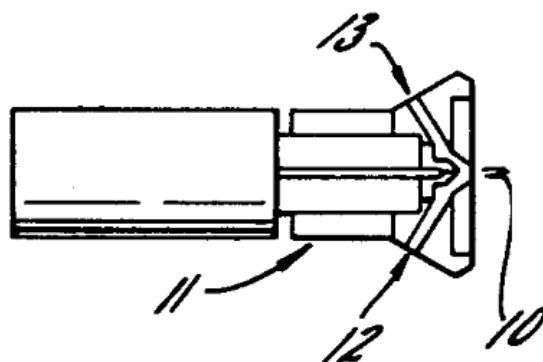
The produced structure is a mixture of two different materials, which the patent calls a “[c]o-formed fibrous structure.” *Id.* at 3:41–49; *see also, id.* at 13:17–37, Fig. 10 (filaments *12* and solid additives *14*).

As explained in the specification’s background, known co-form processes use a “knife-edge die” having filament-forming holes. In those processes, air contacts the filaments exiting the holes at angles of 30° to less than 90°. *Id.* at 1:10–21. An exemplary knife-edge die is described and shown in a patent assigned to the Kimberly-Clark Corporation, U.S. Patent No. 4,100,324 (to Anderson, Ex. 1007):

Turning now to the drawings and referring first to FIG. 1, a primary gas stream *10* containing discontinuous polymeric microfibers is formed by a known melt-blowing technique, such as the one described in ... U.S. Pat. No. 3,676,242 Basically, the method of formation involves extruding a molten polymeric material through a die head *11* into fine streams and attenuating the streams by converging flows of high velocity, heated gas (usually air) supplied from nozzles *12* and *13* to break the polymer streams into discontinuous microfibers of small diameter. The die head preferably includes at least one straight row of extrusion apertures.

Ex. 1007 at 2:28–45; *see also*, Ex. 1015 (Bhat Decl.) at ¶ 29 (“The meltblown die head described in Anderson is well-known and is often referred to as a ‘knife-edge’ die.”). As shown in Anderson’s Figure 1, the relevant portion of which is reproduced below, the heated gas streams *12*, *13*, converge to contact the microfiber stream *10* at a readily noticeable angle.

Figure C (Anderson Fig. 1 (portion))



The co-form product made by this known process, however, lacks desirable absorbency properties. Ex. 1001 at 1:22–28.

As an improvement, the inventive co-form process uses a different die. Specifically, the specification of the '801 patent explains that an exemplary die includes filament-forming and associated fluid-releasing holes and where the exiting filament and fluid contact each other at an angle of less than 10°:

In one example of the present invention, the fibrous structures are made using a die comprising at least one filament-forming hole, and/or 2 or more and/or 3 or more rows of filament-forming holes from which filaments are spun. At least one row of holes contains 2 or more and/or 3 or more and/or 10 or more filament-forming holes. In addition to the filament-forming holes, the die comprises fluid-releasing holes, such as gas-releasing holes, in one example air-releasing holes, that provide attenuation to the filaments formed from the filament-forming holes. One or more fluid-releasing holes may be associated with a filament-forming hole such that the fluid exiting the fluid-releasing hole is parallel or substantially parallel (rather than angled like a knife-edge die) to an exterior surface of a filament exiting the filament-forming hole.

In one example, the fluid exiting the fluid-releasing hole contacts the exterior surface of a filament formed from a filament-forming hole at an angle of less than 30° and/or less than 20° and/or less than 10° and/or less than 5° and/or about 0°.

Id. at 13:38–56. The co-form product made with this die and according to the inventive process was surprisingly found to “exhibit a pore volume distribution unlike pore volume distributions of other known fibrous structures.” *Id.* at 6:58–61.

Pore volume distribution is a “distribution of fluid holding void volume as a function of pore radius,” *id.* at 6:39–43, and accordingly an objective metric in assessing a product’s fluid absorbency. Comparative pore volume distributions are reported in Table 1 of the ’801 patent. *Id.* at 10:66–11:39; *see also, id.* at 12:66–13:16 (reporting additional comparative data for other properties).

The ’801 patent’s two independent claims recite the inventive process.

Table A

Claim 1 of ’801 Patent	Claim 25 of ’801 Patent
A process for making a fibrous structure, the process comprising the steps of:	A process for making a fibrous structure, the process comprising the steps of:

Claim 1 of '801 Patent	Claim 25 of '801 Patent
a. providing a die comprising one or more filament-forming holes, wherein one or more fluid-releasing holes are associated with one filament-forming hole such that a fluid exiting the fluid-releasing hole contacts an exterior surface of a filament exiting the filament-forming hole at an angle of less than 10°;	a. providing a die comprising one or more filament-forming holes, wherein one or more fluid-releasing holes are associated with one filament-forming hole such that a fluid exiting the fluid-releasing hole contacts an exterior surface of a filament exiting the filament-forming hole at an angle of less than 10°;
b. supplying at least a first polymer to the die;	b. supplying a polyolefin polymer to the die;
c. producing a plurality of filaments comprising the first polymer from the die;	c. producing a plurality of filaments comprising the polyolefin polymer from the die;
d. supplying a fluid to the die such that the fluid exits the one or more fluid-releasing holes parallel or substantially parallel to the exterior surface of at least one of the filaments;	—
e. combining the filaments with solid additives to form a mixture; and	d. combining the filaments with wood pulp fibers to form a mixture; and
f. collecting the mixture on a collection device to produce a fibrous structure.	e. collecting the mixture on a collection device to produce a fibrous structure.

Ex. 1001 at 21:26–44, 22:47–61.

As previously explained, the produced structure is a mixture of two different materials, which the patent calls a “[c]o-formed fibrous structure.” Ex. 1001 at

3:41–49; *see also, id.* at 13:17–37, Fig. 10 (filaments 12 and solid additives 14).

The claimed process is therefore referred to herein by the shorthand term “a co-form process.” A co-form process is distinguished from a fibrous structure manufacturing process that does not include a second material mixed with the polymer filament—a non-co-form process.

As also explained above, the claimed process uses a die, as recited in step (a) of each independent claim, distinguished from knife-edge dies. The claimed die is one design of a non-knife-edge die.

B. Prosecution of the '801 Patent

The '801 patent issued December 24, 2019, from U.S. patent application No. 15/891,726 (the “'726 application”) filed February 8, 2018. As summarized in Figure A, above, this application is a continuation of the application that issued as the parent '648 patent, which application is a continuation of the application that issued as the grandparent '474 patent.

Prosecution of the '801 patent was straightforward, yet also defined by prosecution of claims issued in the grandparent '474 patent. The '801 patent claims issued as presented when the '726 application was filed. The claims were only rejected as being unpatentable for obviousness-type double patenting over the eighteen claims issued in the grandparent '474 patent. Claim 1 of both patents are reproduced below, with bold-italicized emphases denoting the differences.

Table B

Claim 1 of '801 Patent	Claim 1 of '474 Patent
A process for making a fibrous structure, the process comprising the steps of:	A process for making a fibrous structure, the process comprising the steps of:
a. providing a die comprising one or more filament-forming holes, wherein one or more fluid-releasing holes are associated with one filament-forming hole such that a fluid exiting the fluid-releasing hole contacts an exterior surface of a filament exiting the filament-forming hole at an <i>angle of less than 10°</i> ;	a. providing a die comprising one or more filament-forming holes, wherein one or more fluid-releasing holes are associated with one filament-forming hole such that a fluid exiting the fluid-releasing hole contacts an exterior surface of a filament exiting the filament-forming hole at an <i>angle of less than 30°</i> ;
b. supplying at least a first polymer to the die;	b. supplying at least a first polymer <i>comprising a polyolefin</i> to the die;
c. producing a plurality of filaments comprising the first polymer from the die;	c. producing a plurality of filaments comprising the first polymer from the die;
d. supplying a fluid to the die such that the fluid exits the one or more fluid-releasing holes parallel or substantially parallel to the exterior surface of at least one of the filaments;	d. supplying a fluid to the die such that the fluid exits the one or more fluid-releasing holes parallel or substantially parallel to the exterior surface of at least one of the filaments;
e. combining the filaments with solid additives to form a mixture; and	e. combining the filaments with solid additives to form a mixture; and
f. collecting the mixture on a collection device to produce a fibrous structure.	f. collecting the mixture on a collection device to produce a fibrous structure.

Compare Ex. 1001 at 21:26–44, *with* Ex. 2001 (’474 patent) at 21:10–29.

Each patent includes one additional independent claim where one difference between those two independent claims is similarly the angle at which the fluid contacts the filament—*viz.*, “less than 10°” in claim 25 of the ’801 patent and “less than 30°” in claim 18 of the ’474 patent. *Compare* Ex. 1001 at 22:47–61 (claim 25), *with* Ex. 2001 at 21:10–29 (claim 18). Dependent claims 2–5, 9, and 14–24 of the ’801 patent respectively recite the same features as dependent claims 2–17 of the ’474 patent. During prosecution of the ’801 patent, the applicant identified all Patent Office actions in the parent and grandparent patents. Ex. 1012 at 58 (referencing in Cite No. 260 “All office Actions in U.S. Application Serial Nos. ... 12/170,575 ([grandparent]), 14/475,699 ([parent])”). The examiner considered these actions. *Id.* at 45.

Notwithstanding the differences in the independent claims, the examiner (Examiner Leo B. Tentoni) considered the claims in the application for the ’801 patent sufficiently similar to those in the ’474 patent to warrant the obviousness-type double patenting rejection. Ex. 1012 at 31–36. In response, the applicant obviated the rejection by submitting a terminal disclaimer. *Id.* at 20–21, 24, and 29–30. Thereafter, the application was allowed and the ’801 patent issued. *Id.* at 1, 13.

C. Prosecution of the Grandparent '474 Patent

The '474 patent claims issued after the independent application claims were amended to recite the “less than 30°” contact angle (in place of simply stating the fluid exits parallel or substantially parallel to the filament). Ex. 1013 at 16, 28–37. Before that amendment, the Patent Office examiner (same examiner as for the '801 patent) rejected these and some dependent claims as being anticipated by a co-form process patent, U.S. Patent No. 4,100,324 (to Anderson, Ex. 1007). *Id.* at 79–82. The examiner rejected other dependent claims—including claims reciting die features identically recited in claims 2–5 of the '801 patent—as being obvious over the combination of disclosures in Anderson patent and U.S. Patent No. 5,476,616 (to Schwarz, Ex. 1005). *Id.* at 82–86. According to the examiner, the Schwarz '616 patent teaches details of the filament-forming and associated fluid-releasing holes of its multifilament die and that the skilled person would have found it obvious to modify the Anderson die with these features:

Anderson et al teaches a melt-blowing process for making a fibrous structure, but Anderson et al does not explicitly teach the recited details of the filament-forming holes or of the fluid-releasing holes. Schwarz (see the entire document, in particular, col. 2, lines 15-52; Figures a [*sic*, 1], 2A and 2B) teaches a melt-blowing process (for making a fibrous structure) including the recited details of the filament-forming holes or of the fluid-releasing holes, and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the details of the filament-forming holes

and of the fluid-releasing holes of Schwarz in the process of Anderson et al in order to manufacture a desired fibrous structure by a melt-blowing process.

Id. at 83.

The examiner effectively rejected the grandparent's claims as unpatentable over the combination of (a) a disclosure of a co-form process using a knife-edge die in Anderson and (b) a separate disclosure of a non-co-form process using a non-knife-edge die in Schwarz '616. But the examiner ultimately withdrew the rejections following amendment to the independent claims, as noted above, and the applicant's arguments that the disclosures were not combinable because the skilled person would not have used the die from Schwarz '616 in Anderson's co-form process. *Id.* at 40–51 (applicant's response). Having reviewed this response, the examiner allowed the application and the '474 patent eventually issued. *Id.* at 16 (notice of allowance).

Unsurprisingly, when the *narrower* claims for the '801 patent, *see* Table B, above, were presented to the same examiner along with copies of his earlier actions in the grandparent application and a terminal disclaimer, he allowed those claims too. *See* Section B, above.

D. The Level of Ordinary Skill in the Art

Neither the Petition nor the declaration (Ex. 1015) on which it relies sets forth any facts that support the petitioner's proposed level of ordinary skill in the

art. For example, the declarant “considered several things” in concluding what level of skill would have been ordinary. Ex. 1015 at ¶ 11. But neither he nor the Petition explains how any of those things, in the context of the claimed invention, support the proposed ordinary skill level. Nevertheless, for the limited purposes of the Board’s consideration of the Petition, the Patent Owner does not contest the petitioner’s proposed level of ordinary skill in the art.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INTER PARTES REVIEW

Institution of inter partes review is discretionary. *See Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016). The Patent Office may elect to deny a petition to institute a proceeding if the petitioned challenges to the patent are based on matters the Office previously considered. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). Discretionary denial is appropriate because all petitioned grounds are based on publications that were of record during prosecution of the ’801 patent, or are substantially the same as, or cumulative of, publications the Office considered during prosecution. Further, the Petition does not demonstrate how the examiner erred in evaluating the prior art and combinations thereof or in evaluating arguments the applicant presented.

A. Legal Framework of 35 U.S.C. § 325(d) Discretion

The Director has discretion to institute an inter partes review and has delegated that discretion to the Board. *See* 35 U.S.C. § 314(a); *see also* 37 C.F.R. § 42.4(a). In determining whether to institute a trial, the Board “may take into account whether, and reject the petition ... because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

In evaluating whether to exercise this discretion, the Board follows a two-part framework. *First*, the Board determines whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office. *Second*, if either of these conditions exists, the Board determines whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics*, Paper 6 at 8. Within this framework, the Board considers several non-exclusive factors:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;

(d) the extent of the overlap between the arguments made during examination and the manner in which petitioner relies on the prior art or patent owner distinguishes the prior art;

(e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and

(f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

See Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first para.); *see also*, *Advanced Bionics*, Paper 6 at 9–11. Factors (a), (b), and (d) relate to whether the art or arguments presented in the petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, Paper 6 at 10. Factors (c), (e), and (f) “relate to whether the petitioner has demonstrated a material error by the Office” in its prior consideration of that art or arguments. *Id.* Only if the same or substantially the same art or arguments were previously presented to the Office will the Board consider whether petitioner has demonstrated a material error by the Office. *Id.* “At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Id.* at 9.

B. Petitioner Relies on Substantially the Same Prior Art Disclosures and Arguments the Examiner Evaluated During Prosecution — (*Becton* Factors (a), (b), and (d))

The prosecution history of the grandparent '474 patent is relevant to the § 325(d) analysis. The Manual of Patent Examination Procedure effective when the '726 application for the '801 patent was filed explains that examination of a continuation application, like the '801 patent, includes the examiner's reconsideration of information previously considered during prosecution of priority applications. *See* M.P.E.P. § 609.02 (9th ed., Rev. 07.2015, Nov. 2015) (Ex. 2002). As explained below, the examiner followed this procedure.

Many Board decisions—including the *Becton* decision—undertaking the § 325(d) analysis have considered the prior art disclosures and examiner's rejections overcome during prosecution of a priority patent/application. *See, e.g., Becton*, Paper 8 at 16, 22–23; *accord, Google LLC v. Kewazinga Corp.*, IPR2021-00524, Paper 17 at 10–12 (PTAB Aug. 24, 2021) (“Google”); *Microsoft Corp. v. IPA Techs., Inc.*, IPR2019-00840, Paper 9 at 15–17 (PTAB Nov. 12, 2019) (citing M.P.E.P. § 609); *R.J. Reynolds Vapor Co. v. Fontem Holdings I B.V.*, IPR2018-00632, Paper 9 at 20–21 (PTAB Sept. 28, 2018) (same).

Prosecution of the priority grandparent '474 patent is particularly relevant to the § 325(d) analysis for the '801 patent because: (a) both patents were examined by the *same* examiner (*compare* Ex. 1013 ('474 patent file history) at 12 (identify-

ing Examiner Tentoni on the Notice of Allowance), *with* Ex. 1012 ('801 patent file history) at 9 (same)); and (b) the examiner rejected the '801 patent claims for obviousness-type double patenting over the grandparent '474 patent's claims (Ex. 1012 at 31–36), and applicant responded with a terminal disclaimer (*id.* at 20–21). *See Becton*, Paper 8 at 23 (finding prosecution of priority patent relevant to § 325(d) analysis of challenged patent because challenged patent was terminally disclaimed over the priority patent, indicating similarity of claim scope between the two patents); *see also, Google*, Paper 17 at 10–12. The terminal disclaimer shows not only that the claims of the '801 patent are similar in scope to those of the grandparent '474 patent but also that the examiner had the latter in mind while examining the '801 patent. Indeed, the examiner expressly indicated as much when he noted he reviewed all of his office actions issued during prosecution of the grandparent '474 patent. Ex. 1012 at 45. Prosecution of the grandparent '474 patent is further relevant to the § 325(d) analysis, as explained below.

1. The Asserted Prior Art Disclosures and the Prior Art Disclosures Evaluated During Prosecution Are Similar and Not Materially Different — (*Becton* factor (a))

The following publications supporting one or more of Grounds 1–4 and 6 were of record during prosecution of the '801 patent: (a) U.S. Patent No. 5,476,616 (“Schwarz '616,” Ex. 1005), (b) U.S. Patent Appl. Publ. No. 2003/0211802 (“Keck,” Ex. 1004), (c) U.S. Patent Appl. Publ. No. 2007/0202766 (“Ouellette,”

Ex. 1018). These publications are Cite Nos. 52, 142, and 183 respectively on the information disclosure statement (IDS) the applicant filed on April 2, 2018. Ex. 1012 at 39–49. In the IDS, the publication number for Keck contains a typographical error in that the last three digits are reported there as “862” rather than the correct “802.” The IDS entry notes Keck is “equivalent to EP 1 504 145 B1,” and the Patent Office’s Global Dossier database confirms this relationship and the correct publication number. Ex. 2003. There is therefore no merit to the petitioner’s contention that “Keck was not cited ... during prosecution.” Pet. at 23.

The examiner considered all three of these publications. Ex. 1012 at 39–49 (noting in a footer on each IDS page that “ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /L.B.T/,” and lining through none of the three publications). All three publications appear in the references cited section of the ’801 patent. *See* Ex. 1001, code (56). Accordingly, these three publications qualify as “prior art ... previously ... presented to the Office,” under § 325. *Advanced Bionics*, Paper 6 at 7–8; *accord Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01529, Paper 16 at 16 (PTAB Mar. 21, 2023); *Eyenovia, Inc. v. Sydnexis*, IPR2022-00963, Paper 7 at 10–11 (PTAB Nov. 8, 2022); *Fellowes, Inc. v. Treefrog Devs., Inc.*, IPR2020-01509, Paper 11 at 7–8, 17 (PTAB Feb. 22, 2021); *Ocado Grp. PLC v. Autostore Tech. AS*, IPR2021-00412, Paper 9 at 34–35 (PTAB July

21, 2021); *Microsoft Corp. v. Koninklijke Philips N.V.*, IPR2018-00279, Paper 11 at 12, 14-15 (PTAB June 8, 2018).

There is no requirement for the examiner to have applied any of these publications in a rejection for the publications to have been previously presented to the Office. *Apotex Inc. v. Auspex Pharms., Inc.*, IPR2021-01507, Paper 9 at 25 (PTAB Mar. 9, 2022) (“A reference submitted, but not substantively discussed during prosecution, nonetheless qualifies as prior art previously presented to the Office.”). Nevertheless, as explained below, Schwarz ’616 (Ex. 1005) and Ouellette (Ex. 1018) were applied in rejections the applicant overcame. *See* Subsections (a) and (d), below.

The Petition relies on substantially the same prior art disclosures and combinations thereof that the examiner considered during prosecution of the grandparent ’474 patent to which the ’801 patent claims priority. During prosecution of the ’474 patent, the examiner relied on prior art disclosures related to and directed to the same subject matter in all six petitioned grounds.

(a) The Examiner Was Aware of Both Schwarz Patents

Schwarz ’616: Ground 2 relies on disclosures in Schwarz ’616 (Ex. 1005) to challenge the independent claims of the ’801 patent. During prosecution of the grandparent ’474 patent, the examiner applied and rejected the patent’s broader independent claims over Schwarz ’616. There can be no dispute that the same exam-

iner evaluating the grandparent '474 patent and the now-challenged '801 patent was aware of Schwarz '616.

First, the applicant reminded the examiner of as much by citing to him (in an IDS) the actions the examiner issued during prosecution of the grandparent '474 patent, which actions discussed Schwarz '616. *Second*, the applicant cited Schwarz '616 in the same IDS. The examiner initialed both listings, indicating his consideration of this information. Ex. 1012 at 39 (Cite No. 52) and 45 (Cite No. 260). As explained above, the Board's precedent establishes that "[p]reviously presented art includes ... art provided to the Office by an applicant, such as on an [IDS]." *Advanced Bionics*, Paper 6, at 7–8.

During prosecution of the '801 patent, the examiner did not reject the claims over any prior art. Rather, the examiner only rejected the challenged claims for obviousness-type double patenting over claims issued in the grandparent '474 patent. That rejection is further evidence the examiner considered Schwarz '616 and the prosecution of the grandparent '474 patent during prosecution of the '801 patent. *See Google*, Paper 17 at 11 (noting similarly that the Examiner considered prosecution of the reference patent when issuing an obviousness-type double patenting rejection). Thus, the examiner was aware of Schwarz '616 on which petitioned Ground 2 relies.

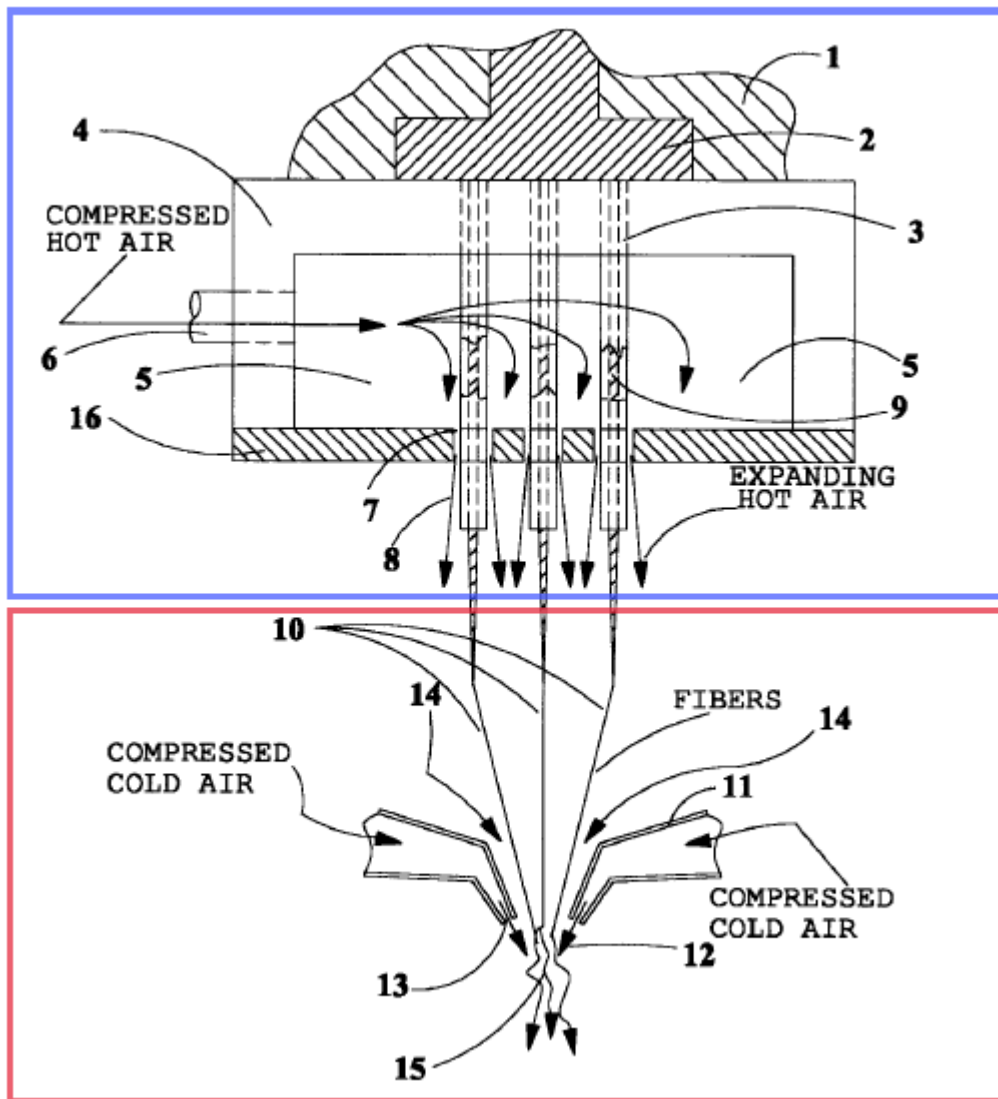
Schwarz '223: Grounds 1 and 3 rely on disclosures in another Schwarz patent, U.S. Patent No. 6,013,223 (Ex. 1002), to challenge the same independent claims. The examiner was also aware of Schwarz '223 because the same examiner examined that patent. Ex. 1002 (cover, “Primary Examiner—Leo B. Tentoni”). He undoubtedly understood all that it claimed and disclosed even if he did not apply it during prosecution of the application for the '801 patent or the priority applications. Indeed, he likely considered its relevant disclosures to be cumulative to those present in Schwarz '616, which he previously applied. The Petition, in presenting Grounds 1–3, identifies no material differences between the two Schwarz patents.

Schwarz '223 summarized the difference between its disclosure and that of Schwarz '616 as the addition of a cooling technique downstream of the die commonly disclosed in both patents:

This invention relates to a new non-woven and spun-bonded fiber process and apparatus applying multiple rows of spinning nozzles described in U.S. Pat. No. 5,476,616 [Schwarz '616], which is herewith incorporated by reference. More particularly, it relates to a cooling technique using expanding hot air to introduce a high level of molecular orientation to produce strong filaments.

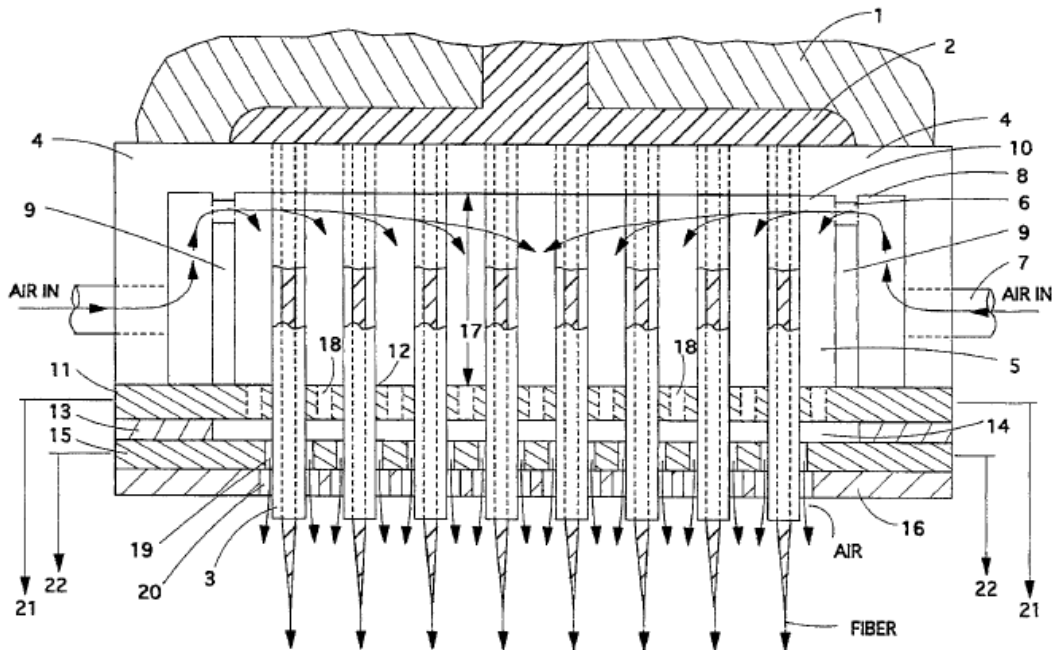
Ex. 1002 at 5–12. The cooling technique is illustrated in the bottom half of Figure 1 of Schwarz '223, denoted by the red-color box:

Figure D (Fig. 1 of Schwarz '223)



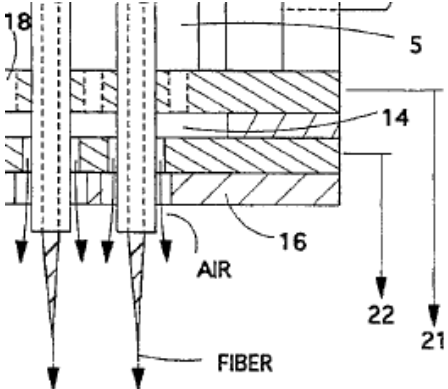
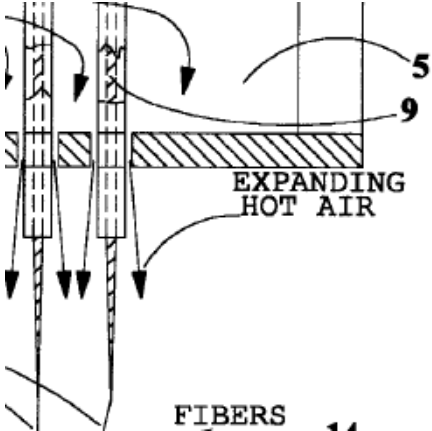
Ex. 1002, Fig. 1. The top half of this figure (denoted by the blue-color box) is materially indistinguishable—as applied in the petitioned grounds—from Figure 1 of Schwarz '616:

Figure E (Fig. 1 of Schwarz '616)



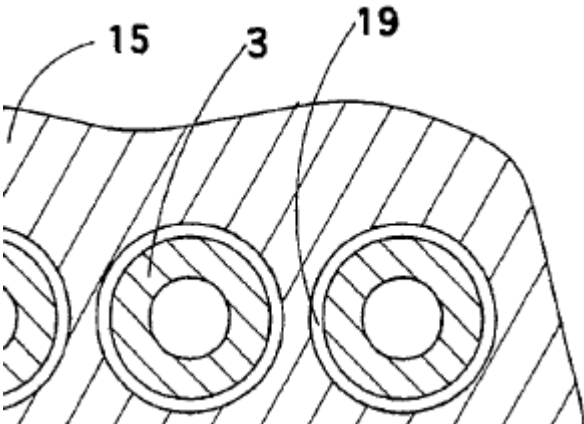
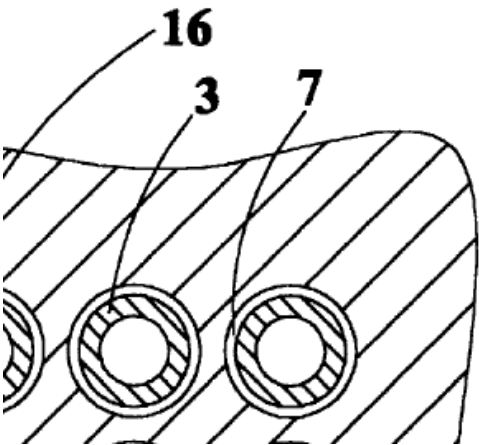
Ex. 1005, Fig. 1. For ease of comparison, below are portions of two figures from each patent illustrating the process and the fiber-forming and fluid-releasing holes expelling the fiber and air, respectively.

Table C

Figure 1 of Schwarz '616 (portion)	Figure 1 of Schwarz '223 (portion)
	

Ex. 1005 (Schwarz '616), Fig. 1; Ex. 1002 (Schwarz '223), Fig. 1.

Table D

Figure 2A of Schwarz '616 (portion)	Figure 2 of Schwarz '223 (portion)
	

Ex. 1005 (Schwarz '616), Fig. 2A; Ex. 1002 (Schwarz '223), Fig. 2.

Across the three grounds, the Petition relies on the same substantive disclosures in both Schwarz patents. The two patents, according to the Petition, describe

the same features recited in the independent claims of the '801 patent. The Petition concedes, however, that both patents fail to disclose the recited co-form step (step (e)) of “combining the filaments with solid additives to form a mixture.”

Table E

Petition (Ground 1)	Petition (Ground 2)
Schwarz '223 explicitly discloses all but one element of independent Claims 1 and 25 of the '801 Patent. The remaining element – combining the filaments with solid additives (wood pulp) to form a mixture – was well known in the art (see below) and would have been obvious to a POSA based on Schwarz's disclosures in light of the teachings of Keck.	Schwarz '616 explicitly discloses all but one element of independent claims 1 and 25 of the '801 Patent. The remaining element – combining the filaments with solid additives (wood pulp) to form a mixture – would have been obvious to a POSA based on Schwarz's disclosures in light of the teachings of Keck.

Pet. at 44 (Ground 2 applying Schwarz '616); Pet. at 29–30 (Ground 1 applying Schwarz '223) and 52 (Ground 3 applying Schwarz '223).

Based on the foregoing and apparent from the text of the Schwarz patents cited in these three grounds, *see* Pet. at 29–51, the two Schwarz patents are cumulative of each other. *See Google*, Paper 17 at 10–12 (concluding related patents are substantially similar where the same disclosure in petition reference is found in prosecution reference examiner previously considered).

(b) The Petition Relies on Substantially the Same Purported Disclosures in Keck and McDowall the Examiner Found in Anderson

For each of Grounds 1–3, the Petition also relies on a second publication for its alleged disclosure of a co-form step (step (e)) of “combining the filaments with solid additives to form a mixture.” For Grounds 1 and 2, the Petition relies on U.S. Patent Appl. Publ. No. 2003/0211802 (“Keck,” Ex. 1004). For Ground 3, the Petition relies on Int’l Publ. No. WO 00/029658 (“McDowall,” Ex. 1003). During prosecution of the broader claims in the grandparent ’474 patent, however, the examiner was already aware of prior art he considered as disclosing the same step (e). For this, the examiner relied on the Anderson patent (Ex. 1007). The purportedly relevant disclosure in all three publications is set forth below.

Table F

Publication	Purported Co-form Disclosure
Anderson (Ex. 1007)	“Turning now to the drawings and referring first to FIG. 1, a primary gas stream <i>10</i> containing discontinuous polymeric microfibers is formed by a known melt-blowing technique involve[ing] extruding a molten polymeric material through a die head <i>11</i> into fine streams and attenuating the streams by converging flows of high velocity, heated gas (usually air) supplied from nozzles <i>12</i> and <i>13</i> to break the polymer streams into discontinuous microfibers of small diameter. ... [T]he primary gas stream <i>10</i> is merged with a secondary gas stream containing individualized wood pulp fibers so as to integrate the two different fibrous materials in a single step.”

Publication	Purported Co-form Disclosure
Portion of Keck (Ex. 1004) cited in Peti- tion, Ground 1 Pet. at 32.	“Coform nonwoven webs or coform materials are known in the art and have been used in a wide variety of applications, including wipes. The term “coform material” means a composite material containing a mixture or stabilized matrix of thermoplastic filaments and at least one additional material, often called the “second material” or “secondary material”. Examples of the second material include, for example, absorbent fibrous organic materials such as woody and non-wood pulp”
Portion of McDowall (Ex. 1003) cited in Peti- tion, Ground 3 Pet. at 52.	“[Claim] 1. An absorbent nonwoven web composite, comprising: [a] a plurality of substantially continuous bicomponent filaments including a first thermoplastic polymer and a second thermoplastic polymer arranged in distinct zones across a cross-section of individual bicomponent filaments; and [b] a plurality of pulp fibers contained within the substantially continuous filaments.”

For Ground 2, the Petition cites to no portion of Keck but states that co-form was disclosed in “many other prior art references at the time.” Pet. at 47. The examiner would have agreed that other prior art disclosed co-form processes, insofar as he found that disclosure in Anderson.

The petitioned combinations of one of the Schwarz patents with either of the Keck or McDowall publications in Grounds 1–3 are materially indistinguishable from the combination of Schwarz ’616 and Anderson that the examiner applied to reject the broader claims of the grandparent ’474 patent—a rejection he later withdrew.

Two other petitioned grounds, Grounds 4 and 6, challenge the patentability of three dependent claims (claims 10, 11, and 21) based in part on Schwarz '223. But these two grounds rely on the propriety of Ground 3, which presents the same disclosures as those the examiner considered during prosecution of the broader claims of the grandparent '474 patent.

(c) The Petition Relies on the Same Disclosure in Bond that Applicants Previously Presented to the Office

Ground 4 also relies on U.S. Patent No. 6,783,854 (“Bond ’854”), citing two passages therein as allegedly teaching features recited in dependent claims 10 and 11. Pet. at 57. Both passages are present in another Bond patent publication the applicant presented to the examiner—and he considered—during prosecution of the ’801 patent. Specifically, the applicant cited in its April 2, 2018, IDS: U.S. Patent Appl. Publ. No. 2004/0096656 (“Bond ’656,” Ex. 2004). Ex. 1012 at 39–49 (Cite No. 148). Both Bond ’854 passages the Petition cites to support Ground 5 are identically present in the prior art Bond ’656 publication previously presented to the Office:

Table G

Citations	Cited text in Bond publications
Petition Ground 5 (at p. 57) cites Ex. 1006 (Bond '854) at 12:61–13:4. Identical text is in Ex. 2004 (Bond '656) at ¶ 0097.	The fiber may be made by fiber spinning processes characterized by a high draw down ratio. The draw down ratio is defined as the ratio of the fiber at its maximum diameter (which is typically occurs immediately after exiting the capillary of the spinneret in a conventional spinning process) to the final diameter of the formed fiber. The fiber draw down ratio via either staple, spunbond, or meltblown process will typically be 1.5 or greater, and can be about 5 or greater, about 10 or greater, or about 12 or greater.
Petition Ground 5 (at p. 57) cites Ex. 1006 (Bond '854) at 14:30–45. Identical text is in Ex. 2004 (Bond '656) at ¶ 0107.	The fibers of the present invention may be used to make nonwovens, among other suitable articles. Nonwoven articles are defined as articles that contains greater than 15% of a plurality of fibers that are continuous or non-continuous and physically and/or chemically attached to one another. The nonwoven may be combined with additional nonwovens or films to produce a layered product used either by itself or as a component in a complex combination of other materials, such as a baby diaper or feminine care pad. Preferred articles are disposable, nonwoven articles. The resultant products may find use in one of many different uses. Preferred articles of the present invention include disposable nonwovens for hygiene and medical applications. Hygiene applications include such items as wipes; diapers, particularly the top sheet or back sheet; and feminine pads or products, particularly the top sheet.

There is no merit to the petitioner's contention that the disclosure in Bond '854 on which Ground 4 relies was not before the examiner or that the disclosure is

not cumulative (to the disclosure in Bond '656). *See* Pet. at 16. Whatever differences there may be in the two Bond publications, the Petition's cited disclosures in Bond '854 (as shown above) are *identically present* in Bond '656. It does not matter that the examiner never applied Bond '656. There is no requirement for the examiner to have applied the disclosure in a rejection for it to have been previously presented to the Office. *See Apotex*, Paper 9 at 25. The Petition makes no attempt to show the examiner materially erred in considering this disclosure. Pet. at 15–17.

In several recent decisions, the Board has denied institution based on “substantially the same” art having the same disclosures that a petitioner relied on, where the art was cited in an IDS and the Examiner did not materially err in considering the art. *See Google LLC v. Valtrus Innovations Ltd.*, IPR2022-01197, Paper 18 at 19 (PTAB June 13, 2023) (“Valtrus”) (denying institution where substantially similar art was cited in an IDS, but not cited in a claim rejection); *see also Ivantis*, Paper 16 at 16; *Risen (Suzhou) Pharma Tech. Co. v. Alzheon, Inc.*, PGR2022-00051, Paper 14 at 54 (PTAB Jan. 13, 2023) (same); *see also, Microsoft Corp. v. AlmondNet, Inc.*, IPR2022-01319, Paper 9 at 10 (PTAB Jan. 30, 2023) (denying institution based on “substantially the same” art cited in an IDS, where petitioner did not allege Examiner error). Each of these decisions underscores the Board’s “commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Advanced Bionics*, Paper 6 at 8–9.

(d) The Examiner Was Aware of Ouellette

Ground 6 challenges the patentability of dependent claim 21, which specifies the produced fibrous structure has a particular pore volume distribution. Pet. at 68–70. In support, the Petition relies on Ouellette (Ex. 1018) as purportedly disclosing the recited features. These same '801 patent claim 21 features are recited in dependent claim 14 of the grandparent '474 patent.

Table H

'801 Patent Claim 21	'474 Patent Claim 14
The process according to claim 1 wherein the fibrous structure exhibits a pore volume distribution such that greater than about 40% of the total pore volume present in the fibrous structure exists in pores of radii of from about 121 μm to about 200 μm .	The process according to claim 1 wherein the fibrous structure exhibits a pore volume distribution such that greater than about 40% of the total pore volume present in the fibrous structure exists in pores of radii of from about 121 μm to about 200 μm .

Dependent claim 14 of the grandparent '474 patent was application claim 19 during prosecution. Ex. 1013 at 19, 24 (showing application claim 19 would issue as patent claim 14). The examiner applied Ouellette to reject that claim. Ex. 1013 at 84–85 (Office Action dated Mar. 13, 2014). The applicant overcame the rejection by persuading the examiner of the patentability of the base claim on which claim 19 depended. *Id.* at 28–37 (May 29, 2014, applicant response), 16 (June 9, 2014, notice of allowability). The examiner was aware of Ouellette.

There is no merit to the petitioner’s contention that Ouellette was not before the examiner or that its disclosure on which Ground 6 relies is not cumulative to what the examiner considered. *See* Pet. at 16. Because the prosecution history of the grandparent ’474 patent is relevant to the § 325(d) analysis, and because the examiner expressly considered that history and his office actions during prosecution of the ’801 patent, Ex. 1012 at 39–49, the examiner is deemed to have considered Ouellette in examining the narrower claims he allowed to issue in the ’801 Patent. Numerous Board decisions cited above stand for this proposition, including the Board’s precedential decisions in *Becton*, Paper 8 at 16, 22–23, and *Advanced Bionics*, Paper 6 at 7–8.

* * * *

With respect to all six petitioned grounds, the Petition relies on publications (and/or disclosures therein) that were already considered by the examiner during prosecution of the ’801 patent and/or expressly considered—applied—with respect to broader claims of the grandparent ’474 patent over which the ’801 patent is terminally disclaimed.

Table I

Prior Art	Ground(s)	<i>Becton</i> Factor (a)
Schwarz ’616	2	Previously applied by the Office
Schwarz ’223	1, 3, 4, 6	Cumulative to Schwarz ’616

Prior Art	Ground(s)	<i>Becton</i> Factor (a)
Keck	1, 2, 4, 5, 6	Previously presented to the Office
McDowall	3, 4, 6	Cumulative to Keck and Anderson
Bond	4	Previously presented to the Office
Ouellette	6	Previously applied by the Office

Becton factor (a) therefore weighs in favor of denying institution.

2. The Asserted Prior Art Disclosures Are Cumulative of the Prior Art Disclosures Evaluated During Prosecution — (*Becton* factor (b))

Ground 5 relies on a combination of Keck (Ex. 1004) and U.S. Patent No. 6,114,017 (“Fabbriante,” Ex. 1018). But the disclosures in each are similarly no different than those—Anderson and Schwarz ’616—the examiner considered during prosecution of the broader claims of the grandparent ’474 patent.

The examiner relied on Anderson as disclosing all features of the broader application claims of the ’474 patent save those claims’ process feature of supplying a fluid at an angle substantially parallel to the filament. Ground 5 relies on Keck for these same teachings:

Keck explicitly discloses all but one element of independent Claims 1 and 25 of the ’801 Patent. The remaining element – supplying fluid (air) at an angle less than 10° (or substantially parallel) – was well known in the art and would have been obvious to a POSA based on Keck’s disclosures in light of the teachings of Fabbriante.

Pet. at 59.

The examiner also relied on Schwarz '616 as disclosing, among other things, the claims' process feature of supplying, via fluid-releasing holes (in the die), a fluid at an angle substantially parallel to the filament. Ex. 1013 at 83. Ground 5 relies on Fabbriante (Ex. 1018) for this same teaching.

Fabbriante discloses that the air nozzles are capable of producing high velocities with the angle formed between the axis of the filament die holes and the air nozzles varied between 0° and 60°. Ex. 1018, column 3, lines 58-62. When the angle is 0°, the air flows parallel to the filaments as they are extruded from the die holes.

Pet. at 60.

The combination of Keck/Fabbriante offered in Ground 5 is not materially or substantively different than the combination of Anderson/Schwarz '616 the examiner considered, applied, and withdrew during prosecution of the broader claims that issued in the grandparent '474 patent.

Becton factor (b) weighs in favor of denying institution.

3. The Examiner's Positions Applicant Overcame During Prosecution Overlap with the Petitioner's Reliance on the Prior Art Disclosures — (*Becton* factor (d))

Despite the prosecution history of the broader claims in the grandparent, the Petition challenges the narrower '801 patent claims in Grounds 1–4 and 6 with the same substantive combinations of prior art, *viz.*, a disclosure of a non-co-form process using a non-knife-edge die in a Schwarz patent and disclosures in secondary

publications of a co-form process using a knife-edge die. But none of those grounds presents a combination of prior art materially different than the one the examiner applied and withdrew during prosecution of the broader '474 patent's claims.

Specifically, each of Grounds 1–4 and 6 combines a co-form process (with a solid additive feed) using a knife-edge die (in Keck, Ex. 1004, or McDowall, Ex. 1003) with a non-co-form process using a non-knife-edge die (in a Schwarz patent, Ex. 1002 and Ex. 1005). The Petition does not acknowledge the similarities between the asserted prior art and the prior art applied during prosecution. The relevant, common disclosures in the Schwarz patents were expressly considered by the examiner during prosecution. The disclosure in Keck and McDowall is cumulative to that in Anderson applied during prosecution. The combinations presented in these grounds is therefore not substantively different than the one the examiner applied and ultimately withdrew during prosecution of the broader claims in the grandparent.

Likewise, Ground 5 combines a co-form process (with a solid additive feed) using a knife-edge die (in Keck, Ex. 1004) with a non-co-form process using a modular die (in Fabbriante, Ex. 1018) that introduces air streams at angles of not less than 10° relative to the polymer filament. *See* Ex. 1018, 5:24–42 (describing in Fig. 1 air exiting fluid-releasing jets 1 and polymer exiting orifice 6). Although this

combination does not rely on a Schwarz patent, this combination also is not materially different than the combination of Anderson and Schwarz '616 that the examiner applied and later withdrew. And the petitioner hasn't noted any difference exists.

The Petition thus is presenting grounds asserting prior art combinations that are similar and not materially different than a combination the examiner applied, and applicant overcame during prosecution. Further, the Petition presents prior art (common disclosure in the Schwarz patents) that is cumulative (if not identical) to that evaluated, applied to reject the claims, and overcome during prosecution. The Petition effectively asks the Board to second guess the examiner's withdrawal of rejections in view of applicant's (Patent Owner's) prosecution arguments that would apply similarly to the petitioned grounds.

Becton factor (d) weighs in favor of denying institution.

* * * *

The substantive disclosures in the prior art and arguments presented in the Petition, in the context of *Becton* factors (a), (b), and (d), are the same or substantially the same as those previously presented to the Office during prosecution. These factors therefore weigh in favor of denying the Petition.

C. Petitioner Has Not Demonstrated the Examiner Erred in a Manner Material to Patentability — (*Becton* factors (c), (e), and (f))

Where, as here, the Office has considered the same or substantially the same unpatentability arguments, *see Advanced Bionics*, Paper 6 at 10, the Board should consider whether the Petition articulates a material error by the examiner during prosecution. *Id.* But the Board need not independently review and assess the merits of each petitioned ground to conclude whether and how any material error occurred where, as here, the petitioner does not explain adequately what any alleged material error is. *Valtrus*, Paper 18 at 21, *see also, Roku, Inc. v. Universal Elecs., Inc.*, IPR2019-01619, Paper 11, 11, 19 (PTAB Apr. 2, 2020) (declining to consider merits of a patentability challenge where the petitioner did not “explain adequately how the examiner erred in a manner material to patentability”).

1. The Asserted Prior Art Disclosures Were Evaluated During Prosecution — (*Becton* factor (c))

The petitioner asserts that five of the six grounds rely on prior art “not cited in an IDS and ... not evaluated in any manner,” and that “[n]one of these references were before the Examiner, nor are they cumulative of the art the Examiner considered.” Pet. at 16. As explained in Section III.B.1 and III.B.2, above, in all six grounds, the Petition relies on publications (and/or disclosures therein) that were already considered by the examiner during prosecution of the ’801 patent and/or expressly considered with respect to broader claims of the grandparent ’474

patent over which the '801 patent is terminally disclaimed. Table I (at page 33) summarizes the prior art cited in each ground. The Petition presents substantively the same combinations the examiner previously applied to reject broader claims, but later withdrew.

Becton factor (c) weighs in favor of denying institution.

2. Petitioner Has Not Sufficiently Pointed Out How the Examiner Erred in Evaluating the Prior Art Disclosures — (*Becton* factor (e))

The petitioner has not pointed out sufficiently how the examiner erred in allowing the claims to issue. *First*, the petitioner simply asserts the examiner “erred by not substantively evaluating” the Ground 2 prior art publications (Schwarz '616 and Keck) because “they invalidate the claims of the '801 Patent.” Pet. at 16. But the petitioner identifies no specific error in the examiner’s evaluation of what Schwarz '616 discloses. *Second*, the petitioner asserts the examiner “erred in not using Schwarz '616 as a basis for rejection of the claims.” *Id.* But that assertion is neither accurate nor fair because the examiner rejected similar claims (in the grandparent) as unpatentable over the combination of (a) a disclosure of a knife-edge die and co-form process in Anderson and (b) a disclosure of a non-co-form process using a non-knife-edge die in Schwarz '616. The examiner understood what Schwarz '616 disclosed, applied Schwarz '616 in combinations of prior art to reject claims, and ultimately withdrew the rejections following the applicant’s re-

sponse and amendment to recite features even broader than those now recited in the challenged claims of the '801 patent.

Third, the petitioner conjectures that “[h]ad the Examiner properly evaluated Schwarz '616, Keck, or the other references [*sic*, references] not cited [during prosecution] that are presented in this Petition, the Examiner would not have allowed the claims.” *Id.* at 17. But the examiner understood and applied Schwarz '616, and rejected broader claims over a combination of disclosures (including Schwarz '616) that are commonly present in the prior art asserted in the Petition and in the prior art applied during prosecution. The Petition does not explain *how* the examiner erred in allowing the narrower claims of the '801 patent to issue.

Becton factor (e) also weighs in favor of denying institution.

3. Petitioner Presents No Additional Evidence or Facts Warranting the Board’s Reconsideration — (*Becton* factor (f))

The petitioner has shown no material error during prosecution and has hardly even attempted to present this showing. In the context of the *Becton* factors, the Board has sufficient bases to find that factors (c) and (e) weigh in favor of denying the Petition. With respect to factor (f), at most, the Petition relies on declaration testimony of an expert witness. *See* Ex. 1015 (Bhat Decl.). Notably, the Petition does not explain how (if at all) this testimony shows that the examiner erred in allowing the claims. Specifically, the Petition does not even cite the testimony in ar-

guing that discretionary denial is inappropriate. Pet. at 15–17. Further, the declaration testimony nowhere suggests the examiner erred. *Becton* factor (f) therefore also weighs in favor of denying institution.

Regardless, the presentation of declaration testimony should not, by itself, overcome the other five *Becton* factors that Patent Owner respectfully submits weigh in favor of denying the Petition.

IV. PETITIONER HAS NOT SHOWN IT IS REASONABLY LIKELY TO PREVAIL ON ANY GROUND

The Petition asserts the inventions recited in the patent’s two independent claims (claim 1 and 25) are obvious. These assertions are set forth in Grounds 1, 2, 3, and 5. As explained below, the petitioner has not shown it is reasonably likely to prevail on any of these grounds. Specifically, the Petition identifies no reliable evidence on which the Board could find that a person having ordinary skill in the art would have had a reasonable expectation of success in combining the prior art these grounds present.

A conclusion of obviousness requires finding that a person of ordinary skill in the art would have had a reasonable expectation of success. *In re Stepan Co.*, 868 F.3d 1342, 1345–46 (Fed. Cir. 2017). Reasonable expectation of success refers to the likelihood of success in combining references to meet the limitations of the claimed invention. *Intelligent Bio–Systems, Inc. v. Illumina Cambridge Ltd.*, 821

F.3d 1359, 1367 (Fed. Cir. 2016). Evidence of a reasonable expectation of success “may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved.” *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1125 (Fed. Cir. 2000).

The Petition includes a conclusory argument that the person having ordinary skill in the art would have had a reasonable expectation of success in combining the asserted prior art to arrive at the inventions recited in the two independent claims (claims 1 and 25), on the basis that “[t]he simple substitution of a multirow meltblown die in lieu of a knife-edge meltblown die in the coform process would be within the routine skill of the POSA and such a substitution would not result in the coform process ... being inoperable.” *E.g.*, Pet. at 33–34. In each such instance, the Petition supports the argument by citing only to its expert witness’s declaration (Exhibit 1015), which merely repeats the Petition’s conclusory argument.

Table J

Ground	Argument	Supporting Evidence
1	Pet. at 33–34	Ex. 1015 at ¶ 168*
2	Pet. at 47–48	Ex. 1015 at ¶ 233
3	Pet. at 54	Ex. 1015 at ¶ 286
5	Pet. at 64	Ex. 1015 at ¶¶ 357–59

* The petition incorrectly cites Ex. 1015 at ¶ 161.

Importantly, these paragraphs of the expert witness's declaration identify no evidence of a reasonable expectation of success. Specifically, the expert witness does not declare that any prior art reference, knowledge of a skilled artisan, or the nature of improvement over the prior art would have offered the skilled person a reasonable expectation of success. *See Brown & Williamson*, 229 F.3d at 1125. The declaration should be accorded little weight. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (PTAB Aug. 24, 2022) (precedential) (giving little weight to expert testimony unsupported by evidence or reasoning). Having identified no such evidence either in the Petition or in the expert witness's declaration, the petitioner has not shown it is reasonably likely to prevail in establishing that the independent claims recite obvious inventions.

Although arguments and evidence of a motivation to combine may support a finding of a reasonable expectation of success, the Petition's conclusory arguments are not sufficient to support such a finding. *See Elekta Ltd. v. Zap Surgical Sys., Inc.*, 81 F.4th 1368, 1377 (Fed. Cir. 2023) (noting that "a finding of a motivation to combine does not necessarily establish a finding of reasonable expectation of success") (citing *Eli Lilly & Co. v. Teva Pharms. Int'l GmbH*, 8 F.4th 1331, 1344 (Fed. Cir. 2021)). And in any event, neither the Petition nor the expert witness's

declaration explains how the arguments and evidence concerning a motivation to combine would also establish a reasonable expectation of success.

Grounds 4 and 6 challenge only dependent claims and necessarily rely on a conclusion the independent claims are obvious. The petitioner is no more likely to succeed in demonstrating those dependent claims are unpatentable.

The petitioner had to identify “with particularity” all “evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). Its failure to do so may not be remediated in a reply to this response. *Intelligent Bio-Systems*, 821 F.3d at 1369 (disregarding new arguments and evidence in reply and noting “the expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute”).

Accordingly, the Board should deny the Petition on its merits.

* * * *

V. CONCLUSION

Consistent with the Board precedent discussed above, the Board should determine that the same or substantially the same (cumulative) prior art and combinations thereof previously were presented to the Office and that the petitioner has not demonstrated the Office erred in a manner material to the patentability of the challenged claims. The Board should therefore exercise its discretion to deny institution of trial. Separately, the Board should determine that the petitioner has not shown it is reasonably likely to prevail on any ground and, thus, deny institution of trial on its merits.

Respectfully submitted,

December 28, 2023

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that, pursuant to 37 C.F.R. § 42.24(d), the foregoing “PATENT OWNER PRELIMINARY RESPONSE” complies with 37 C.F.R. § 42.24(b)(i) permitting up to 14,000 words because, excluding the exempted portions of the response, the response contains 9,588 words as counted by the word-processing system used to prepare the response.

CERTIFICATE OF FILING AND SERVICE

The undersigned certifies that, pursuant to 37 CFR § 42.6(e), copies of the foregoing “PATENT OWNER PRELIMINARY RESPONSE” and Exhibits 2001–2004 are being electronically filed via the Patent Trial and Appeal Case Tracking System (P-TACTS) and served today, December 28, 2023, on Petitioner’s counsel:

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December 28, 2023

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