

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 SUR-REPLY

The Board should exercise its discretion to deny the petitioned review.

I. The Relevant Prosecution History Does Not Support Petitioner’s Reply

As explained in the Patent Owner Preliminary Response (POPR), claims broader than those challenged in the ’801 patent issued in the grandparent ’474 patent. *See* POPR (Paper 7), at 12–13. Those broader claims issued after the independent claims were amended recite a contact angle of “less than 30°.” *Id.* The challenged independent claims of the ’801 patent recite a contact angle of “less than 10°,” but are otherwise similar to the ’474 patent’s claims. *Id.* at 10 (Table B). On closer review of the prosecution history—prompted by Petitioner’s Reply—the amendment appears to be the reason the claims in the two patents issued.

During prosecution of the ’474 patent, P&G *twice* presented several arguments attempting to traverse the examiner’s prior art rejections, including one that Anderson’s (Ex. 1007) focus to make discontinuous fibers (filaments) could not properly be combined with Schwarz’s (Ex. 1005) non-knife-edge die design features. *Compare* Ex. 1013 at 66–71 (March 2014 Response), *with id.* at 28–37 (May 2014 Amendment and Response). Intervening those two presentations, was the examiner’s April 2014 final action maintaining the prior art rejections *despite* P&G’s arguments. *Id.* at 55–62. Specifically, the examiner dismissed the improper combination argument as “not commensurate with the scope of the pending claims”—claims that did not specify whether the fibers are continuous or discontinuous. *Id.*

at 60. Further, the examiner noted that his rejection based on the combination of Anderson and Schwarz '616 “concerns the details of the filament-forming holes and of the fluid-releasing holes.” *Id.*

Through his final action, the examiner made sufficiently clear that he was unconcerned with whether Anderson’s die made discontinuous fibers. This clarity is further confirmed by the subsequent examiner interview summary, which similarly expresses no such concern. *See id.* at 26. The examiner allowed the '474 patent following the amendment noted above, stating nothing further about the dismissed arguments P&G had re-presented. *Id.* at 16 (notice of allowability).

II. The Petition Presents Substantially the Same Art and Arguments

Despite this prosecution history, petitioner’s Reply repeatedly asserts the examiner allowed the broader claims of the grandparent '474 patent because he “found persuasive” P&G’s argument regarding the impropriety of combining Anderson and Schwarz. Reply (Paper 9) at 2, 3, 5, 8, 9. Petitioner further characterizes this as the examiner’s error, which “error was carried into prosecution of the '801 patent.” *Id.* at 10. Respectfully, however, the error here is petitioner’s assertion of why the claims were allowed. Relying on that erroneous assertion, petitioner’s Reply argues that the petition does not present substantially the same art and arguments the examiner already considered.

A. McDowall Is Cumulative. Only Ground 3 concerns the application of McDowall (Ex. 1003) to the '801 patent's independent claims. Ground 3 relies on McDowall's disclosure of "adding solid additives, or specifically wood pulp fibers, to polymer filaments to form a mixture." Pet. at 52. Ground 3 does not rely on McDowall's purported disclosure of a continuous filament. *Id.* But even if it did, that still would not matter. The examiner was unconcerned with whether the prior art, combinable with Schwarz, concerns the production of continuous or discontinuous filaments. *See* Section I, *supra*. McDowall remedies no disclosure deficiency in Anderson on which the examiner relied in issuing the challenged claims. *See* POPR at 27–29. Further still, regardless of what type of die McDowall suggests, Ground 3 relies on McDowall's disclosure of a co-form process, which disclosure is substantively indistinguishable from Anderson's co-form disclosure the examiner considered. *Id.* at 27–28 (Table F).

B. Fabbicante Is Cumulative. Only Ground 5 concerns the application of Fabbicante (Ex. 1018) to the '801 patent's independent claims. Ground 5 applies Fabbicante in the same way the examiner applied Schwarz '616 during prosecution. POPR at 34–35. Petitioner's Reply ignores that, asserting instead that Fabbicante offers "strong motivational factors for use of Fabbicante's process for the preparation of absorbent articles." Reply at 8 (citing testimony not cited in the Petition). The '801 patent's independent claims do not recite absorbent articles. The

belated assertion therefore is inapposite and, importantly, does not explain what disclosure deficiency in Schwarz '616 Fabbicante remedies.

C. Schwarz '616 Was Previously Considered. Ground 2 concerns the application of Schwarz '616 (Ex. 1005) to the '801 patent's independent claims. The examiner applied Schwarz '616 during prosecution of the grandparent '474 patent's broader claims. *See, e.g.*, POPR at 20, 21, 33 (Table I), 35, 39. Petitioner's Reply argues that when Schwarz '616 is *reconsidered* in combination with prior art co-form processes directed to continuous filaments (Keck, Ex. 1004), the claims are obvious. This argument relies on the assertion that the examiner allowed the claims *because* the prior art co-form process applied in prosecution was limited to discontinuous filaments. Reply at 5. But that assertion is incorrect. *See* Section I, *supra*.

D. Schwarz '223 Is Cumulative to Schwarz '616. Grounds 1, 3, 4, and 6 concern the application of Schwarz '223 (Ex. 1002) to all claims. The Petition identifies no material differences in Schwarz '223 and Schwarz '616. POPR at 22. The Petition relies on the same disclosure in Schwarz '223 that is present in Schwarz '616. *Id.* at 22–26. Petitioner's Reply offers no rebuttal, arguing instead that Schwarz '223 offers “strong motivational basis for using the Schwarz dies in a coform process.” Reply at 5. Sufficient motivation apparently was present in the examiner's combination of the same disclosure of the Schwarz die with the

Anderson coform process. Petitioner's Reply explains no deficiency in Schwarz '616 remedied by Schwarz '223.

E. Keck Was Previously Considered. All Grounds except Ground 3 concern the application of Keck to all claims. Keck was presented to the Patent Office. POPR at 18–20. The Petition relies on Keck for its disclosure of a co-form process. *Id.* at 27–29. Petitioner's Reply offers no rebuttal besides arguing that Keck involves a co-form process directed to continuous filaments whereas Anderson, applied during prosecution, involved a co-form process directed to discontinuous filaments. Reply at 6–8. The examiner was unconcerned with the filament type, which the claims do not recite. *See* Section I, *supra*. Keck's application in each Ground is therefore also cumulative to the examiner's application of Anderson.

In view of the foregoing and the POPR, the Board should deny the petitioned review.

Respectfully submitted,

February 16, 2024

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CERTIFICATE OF COMPLIANCE

The undersigned certifies that this paper complies with the 5-pages limit the Board set in its authorizing email (Exhibit 3001). The undersigned also certifies that this paper complies with the typeface requirements of 37 C.F.R.

§ 42.6(a)(2)(ii), because this paper was prepared using 14-point, Times New Roman proportional font, and complies with the spacing requirements of 37 C.F.R. § 42.6(a)(2)(iii).

CERTIFICATE OF FILING AND SERVICE

The undersigned certifies that, pursuant to 37 CFR § 42.6(e), a copy of the foregoing “PATENT OWNER PRELIMINARY SUR-REPLY” is being electronically filed and served via the Patent Trial and Appeal Case Tracking System and redundantly served via email today, February 16, 2024, on Petitioner’s counsel:

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February 16, 2024

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