

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FITESA SIMPSONVILLE, INC.,
Petitioner,

v.

THE PROCTER & GAMBLE COMPANY,
Patent Owner.

IPR2023-01451
Patent 11,326,276 B2

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,
and AVELYN M. ROSS, *Administrative Patent Judges*.

ROSS, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 325(d)

I. INTRODUCTION

Fitesa Simpsonville, Inc. (“Petitioner”), filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claims 1–24 of U.S. Patent No. 11,326,276 B2 (Ex. 1001, “the ’276 patent”). Pet. 4. The Procter & Gamble Company (“Patent Owner”) filed a Preliminary Response. Paper 7 (“Prelim. Resp.”). The Board *sua sponte* authorized a petitioner’s reply and patent owner’s sur-reply on January 22, 2024. Ex. 3001. Thereafter, Petitioner filed its Reply to Patent Owner’s Preliminary Response (Paper 9 (“Reply”)) and Patent Owner filed its Sur-reply in Support of Patent Owner’s Preliminary Response (Paper 10 (“Sur-reply”)).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314 (2018); 37 C.F.R. § 42.4(a) (2019). The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted “unless the Director determines . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least [one] of the claims challenged in the petition.”

For the reasons set forth below, upon considering the Petition, the Preliminary Response, the Reply, the Sur-reply, and evidence of record, we exercise discretion under 35 U.S.C. § 325(d) to deny institution of an *inter partes* review.

A. Real Parties-in-Interest

Petitioner identifies itself, Fitesa Simpsonville, Inc., as the real party-in-interest. Pet. 4. Patent Owner identifies itself, the Procter & Gamble Company, as the real party-in-interest. Paper 5, 1.

B. Related Matters

Petitioner asserts that it “is not aware of any related matters at this time.” Pet. 4. “Patent Owner identifies U.S. patent application No. 17/729,323 filed April 26, 2022, which is pending and claims the benefit of priority to the application that issued as the ’276 patent.” Paper 5, 1. “Patent Owner also identifies U.S. Patent No. 10,513,801, which is the subject of a pending petition for *inter partes* review (Case IPR2023-01450), and to which the application for the ’276 patent claims the benefit of priority.” *Id.*

C. The ’276 patent

1. Specification

The ’276 patent, titled “Process for Making Fibrous Structures,” issued on May 10, 2022. Ex. 1001, codes (45), (54). The ’276 patent is directed to processes for making fibrous structures having filaments. *Id.* at 1:18–19.

The ’276 patent explains that a problem with current processes for making fibrous structures is that the distribution of average filament diameters does not optimize absorbency properties including absorption capacity and rate of absorption of the fibrous structures. *Id.* at 1:32–38. The ’276 patent purports to address this problem by using a fibrous structure making process in which the fibrous structure includes a mixture of filaments and solid additives that “exhibit a pore volume distribution unlike

pore volume distributions of other known fibrous structures.” *Id.* at 7:2–5. According to the ’276 patent, the fibrous structures may be “[c]o-formed fibrous structures,” which entails that “the fibrous structure comprises a mixture of at least two different materials wherein at least one of the materials comprises a filament, such as a polypropylene filament, and at least one other material, different from the first material, comprises a solid additive, such as a fiber and/or a particulate.” *Id.* at 3:48–56. The ’276 patent depicts an exemplary co-formed process in Figure 10, reproduced below:

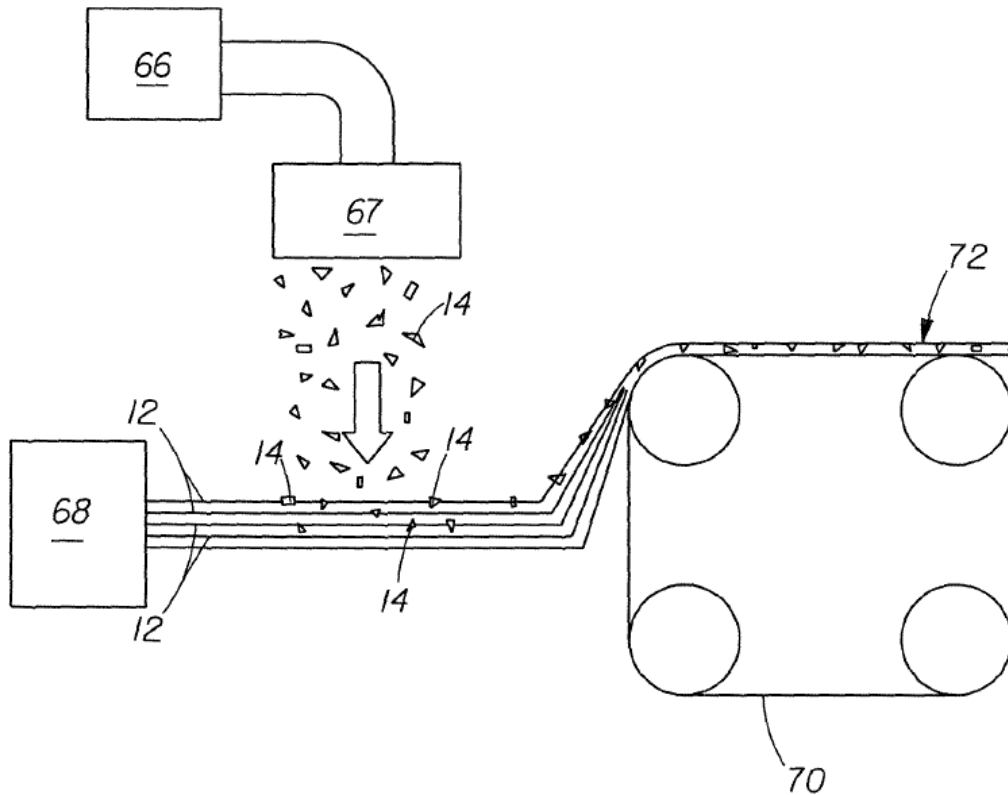


Fig. 10

Figure 10 “is a schematic representation of an example of a process for making a fibrous structure.” *Id.* at 2:57–58. Figure 10 depicts “the step

of mixing a plurality of solid additives 14 with a plurality of filaments 12.” *Id.* at 13:30–32. In this embodiment, the ’276 patent explains that “solid additives 14 are wood pulp fibers, such as SSK fibers and/or Eucaly[pt]us fibers, and the filaments 12 are polypropylene filaments.” *Id.* at 13:32–34. Solid additives 14 may be combined with filaments 12 by being delivered to a stream of filaments 12 from hammermill 66 using solid additive spreader 67 to form a mixture of filaments 12 and solid additives 14. *Id.* at 13:35–38. For the process depicted in Figure 10, filaments 12 are created by meltblowing from meltblow die 68. *Id.* at 13:38–39. According to the ’276 patent, the mixture of solid additives 14 and filaments 12 is “collected on a collection device, such as a belt 70 to form a fibrous structure 72.” *Id.* at 13:40–42.

The ’276 patent further describes that “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.” *Id.* at 13:48–52. “At least one row of holes contains 2 or more and/or 3 or more and/or 10 or more filament-forming holes.” *Id.* at 13:52–53. The ’276 patent explains that 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.” *Id.* at 13:53–57. According to the ’276 patent, “[o]ne 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.” *Id.* at 13:57–62. In a preferred embodiment, 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°, less than 20°, less than 10°, less than 5°, or about 0°. *Id.* at 13:52–56.

2. *Illustrative Claim*

The Petition challenges claims 1–24. Pet. 4. Claims 1 and 24 are independent. Claim 1 is illustrative and is reproduced below.

1. A process for making a fibrous structure, the process comprising the steps of:

- a. providing a die comprising three or more rows of three or more filament-forming holes;
- b. supplying at least a first polymer to the die;
- c. producing a plurality of filaments comprising the first polymer from the die;
- d. combining the filaments with solid additives to form a mixture; and
- e. collecting the mixture on a belt to produce a fibrous structure.

Ex. 1001, 21:37–47.

D. *Prior Art and Asserted Grounds of Unpatentability*

Petitioner asserts that claims 1–24 would have been unpatentable on the following grounds:

Claim(s) Challenged	Statutory Basis	Reference(s)/Basis
1, 2, 6–9, 13, 14, 21–24	§ 102	McDowall ¹

¹ McDowall et al., WO 00/29658 A1, published May 25, 2000 (Ex. 1003, “McDowall”).

Claim(s) Challenged	Statutory Basis	Reference(s)/Basis
1–3, 5–10, 13–24	§ 103	Schwarz '223, ² Keck ³
1–3, 5–10, 13–24	§ 103	Schwarz '616, ⁴ Keck
1–3, 5–9, 13, 14, 19–24	§ 103	Schwarz '223, McDowall
11, 12	§ 103	Schwarz '223, (Keck or McDowall), Bond ⁵
1–4, 6–10, 13–24	§ 103	Keck, Fabbriante ⁶
20	§ 103	(McDowall, Ouellette ⁷) or (Schwarz '616, (Keck or McDowall), Ouellette) or (Schwarz '223, (Keck or McDowall), Ouellette) or (Keck, Fabbriante, Ouellette)

Petitioner also relies on declaration testimony of Gajanan S. Bhat, Ph.D. (Ex. 1015, “the Bhat Declaration”).

² Schwarz, US 6,013,223, issued January 11, 2000 (Ex. 1002, “Schwarz '223”).

³ Keck et al., US 2003/0211802 A1, published November 13, 2003 (Ex. 1004, “Keck”).

⁴ Schwarz, US 5,476,616, issued December 19, 1995 (Ex. 1005, “Schwarz '616”).

⁵ Bond, US 6,783,854 B2, issued August 31, 2004 (Ex. 1006, “Bond”).

⁶ Fabbriante et al., US 6,114,017, issued September 5, 2000 (Ex. 1018, “Fabbriante”).

⁷ Ouellette et al., US 2007/0202766 A1, published August 30, 2007 (Ex. 1029 “Ouellette”). We note that at times in the Petition, Ouellette is mis-identified as Exhibit 1028, rather than Exhibit 1029. *See* Pet. 6, 75.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

We review the grounds of unpatentability in view of the understanding of a person of ordinary skill in the art at the time of invention. *Graham*, 383 U.S. at 17. Petitioner contends that

[a] person of ordinary skill in the art (POSA) at the time of the effective filing date of the application that led to the '276 patent would have been a person with a Bachelor of Science degree in Engineering (or a substantively related engineering or science degree) or equivalent work experience, and/or at least 3 to 5 years of experience in the field of nonwovens. Such experience could include, but is not necessarily required to include, knowledge about the design and operation of meltspun systems, such as meltblown and spunbond systems.

Pet. 13 (citing Ex. 1015 ¶ 11).

Although Patent Owner asserts that there are not “any facts that support the petitioner’s proposed level of ordinary skill in the art . . . , [] Patent Owner does not contest [] Petitioner’s proposed level of ordinary skill in the art.” Prelim. Resp. 17. For purposes of this Decision, and based on the record currently presented, we adopt Petitioner’s definition of the level of ordinary skill in the art. Further, we find that the prior art of record reflects the level of skill in the art at the time of the invention. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001).

B. Claim Construction

In an *inter partes* review filed on or after November 13, 2018, we construe claims “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and

the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b) (2019); *see Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

Petitioner proposes a claim construction for eight terms, namely, “polypropylene,” “synthetic polymer,” “natural polymer,” “post processing operation,” “second polymer,” “solid additive spreader,” and “belt.” Pet. 12–15 (citing Ex. 1015 ¶¶ 54–57, 60).

At this stage of the proceeding, Patent Owner does not disagree with any of Petitioner’s claim constructions or propose alternative constructions of its own. *See generally* Prelim. Resp.

Here, resolution of the claim construction issues identified in the Petition is not necessary to determine whether we should exercise our discretion to deny institution under Section 325(d). *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’”)).

C. Discretion to Deny Institution Under 35 U.S.C. § 325(d)

Patent Owner argues that we should exercise our discretion to deny all of the asserted grounds under 35 U.S.C. § 325(d) because they present substantially the same prior art and arguments the United States Patent and Trademark Office (“the Office”) previously considered during prosecution. *See* Prelim. Resp. 17–46.

Section 325(d) provides that in determining whether to institute an *inter partes* review, “the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art

or arguments previously were presented to the Office.” The Board uses a two-part framework in determining whether to exercise its discretion under § 325(d), specifically:

- (1) 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;
- and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

In applying the two-part framework, we consider several non-exclusive factors, including: (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. *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 paragraph).

a) Advanced Bionics Framework Part (1)

Under the first part of the *Advanced Bionics* framework, we consider whether the same or substantially the same art or arguments were previously

presented to the Office. *Advanced Bionics*, Paper 6 at 8. Relevant to the first part of the *Advanced Bionics* framework, we evaluate *Becton, Dickinson* factors (a), (b), and (d).

(1) Prior Art References

The grounds of unpatentability set forth in the Petition rely on McDowall, Schwarz '223, Schwarz '616, Keck, Bond '854, Fabbriante, and Ouellette. Pet. 5–6. We determine below that each of the references are the same as, or cumulative to, references presented to the Examiner during prosecution and, thus, we determine that the “same or substantially the same prior art” previously was presented to the Office. We discuss each of the references below.

(a) Schwarz '616, Keck, Ouellette

Petitioner's Ground 3 relies on Schwarz '616 and Keck and Petitioner's Ground 7 relies on the combination of McDowall (discussed later) in view of Ouellette. Pet. 44, 75. Petitioner acknowledges that Schwarz '616 and Keck were previously presented to the Office but states that Ouellette was not before the Examiner. *Id.* at 12.

Patent Owner argues that Schwarz '616 and Ouellette were cited and applied by the Examiner in an Office Action dated January 8, 2021, during prosecution of the '276 patent. Prelim. Resp. 20 (citing Ex. 1028, 202). Patent Owner argues that Keck was cited and considered in an information disclosure statement (IDS) the applicant filed in September, 2018. *Id.* (citing Ex. 1001, code (56); Ex. 1028, 46, 61).

We agree with Patent Owner. We observe that Schwarz '616 and Ouellette were cited and applied by the Examiner during prosecution. Ex. 1028, 202; *see also* Ex. 1001, code (56), 2. We observe that Keck

appears on the IDS presented to and considered by the Office in September, 2018, during prosecution of the '276 patent. Ex. 1028, 46–47, 61; *see also* Ex. 1001, code (56), 2. A reference submitted, but not substantively discussed during prosecution, nonetheless qualifies as prior art previously presented to the Office. As *Advanced Bionics* makes clear, “[p]reviously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.” *Advanced Bionics*, Paper 6 at 7–8. Accordingly, we determine that each of these references were previously presented to the Office.

(b) Schwarz '223

Petitioner’s Ground 2 relies on the combination of Schwarz '223 and Keck, Ground 4 relies on Schwarz '223 and McDowall, and Ground 5 relies on Schwarz '223 and either Keck or McDowall and Bond. Pet. 28, 54, 59. Petitioner argues that Schwarz '223 was not “before the Examiner, nor [is it] cumulative of art the Examiner considered.” *Id.* at 12.

Patent Owner asserts that Schwarz '223 is cumulative of Schwarz '616 and that the Petition relies on the same substantive disclosures of Schwarz '223 as Schwarz '616. Prelim. Resp. 23–28; Sur-reply 4–5. Schwarz '223 also incorporates Schwarz '616 by reference. Prelim. Resp. 24 (citing Ex. 1002, 1:5–12). Patent Owner asserts that Petitioner’s Grounds rely on portions of Schwarz '223 that are present in Schwarz '616. *Id.* at 24–28.

We are persuaded by Patent Owner’s argument and evidence that the portions of Schwarz '223 Petitioner relies on in each of its asserted grounds is substantively the same as the disclosure in Schwarz '616. Prelim.

Resp. 24–28; *see also id.* at 24 (explaining that “[t]he Petition . . . identifies no material differences between the two Schwarz patents”). Though Petitioner argues that Schwarz ’616 and Schwarz ’223 have differences, Petitioner does not dispute that its Grounds rely on the same portions of Schwarz ’223 that are present in Schwarz ’616. *See generally* Reply. For the foregoing reasons, we are persuaded that Schwarz ’223 is cumulative to Schwarz ’616, which was previously presented to the Office as explained above. Accordingly, we determine that Schwarz ’223 is substantially the same art previously presented to the Office.

(c) McDowall

Petitioner’s Grounds 1, 4, 5, and 7 rely on McDowall alone, Schwarz ’223 and McDowall alone, or Schwarz ’223 and McDowall in combination with Bond or Ouellette. Pet. 22, 54, 59, 75. Petitioner argues that McDowall “was not disclosed or evaluated by the Examiner” (*Id.* at 11–12) and that “nor [is it] cumulative of art the Examiner considered” (*Id.* at 12) during “prosecution of the ’276 patent or its family.” Reply 3. According to Petitioner, McDowall was not used for an anticipation rejection and McDowall differs from art considered during prosecution because McDowall “teaches a coform process having continuous filaments and a coform process that utilizes non-knife-edge spinning die.” *Id.* at 4 (internal citations omitted).

Patent Owner asserts that Anderson was previously before the Office and that the Petition relies on substantially the same disclosure in McDowall that the Examiner considered and relied on in Anderson during prosecution. Prelim. Resp. 29 (citing Ex. 1007).

We agree with Patent Owner. During prosecution of the '276 patent, the Examiner relied on Anderson to reject the claims as obvious. Prelim. Resp. 14–15 (citing Ex. 1028, 155–167); *see also* Ex. 1001, code (56), 1. Moreover, Anderson was applied in an anticipation rejection in an Office Action dated March 13, 2014, during prosecution of the great-grandparent '474 patent. Ex. 1013, 81. The Examiner was aware of the great-grandparent '474 patent because the Examiner rejected the '276 patent claims for obviousness-type double patenting over the great-grandparent '474 patent's claims and reviewed the office actions issued during prosecution of the great-grandparent '474 patent. Prelim. Resp. 10–11; *see* Ex. 1028, 199 (rejecting then-existing claims 1–24 as unpatentable on the ground of nonstatutory double patenting in view of the great-grandparent '474 patent), 214 (identifying all office actions in the great-grandparent '474 patent prosecution in an IDS)); *see also* Ex. 1001, 3 (office actions in the great-grandparent '474 patent prosecution cited as other publication on the face of the '276 patent). Accordingly, we determine that Anderson was previously presented to the Office.

Patent Owner asserts that McDowall is substantially the same art as Anderson because the portions of McDowall relied on by Petitioner are “materially indistinguishable” from those relied on by the Examiner in Anderson. Prelim. Resp. 29–31 (citing Ex. 1007; Ex. 1003; Pet. 55).

We again agree with Patent Owner. Petitioner relies on McDowall for disclosure of “combining the filaments with solid additives to form a mixture,” arguing that McDowall discloses adding solid additives. Pet. 55 (citing Ex. 1003, claim 1, page 4). The Examiner found that Anderson likewise discloses this limitation. Ex. 1028, 158 (“combining the filaments

with solid additives to form a mixture”); *see also* Prelim. Resp. 29–30 (comparing portions of Anderson to McDowall). As such, both McDowall and Anderson disclose substantially the same information, that is, the addition of solid additives to form a mixture, and McDowall is thus cumulative of information already considered by the Office. Petitioner asserts that Anderson and McDowall are different, but does not dispute that the portions of McDowall relied on by Petitioner are substantially the same as those relied on by the Examiner in Anderson. *See generally* Reply. We therefore determine that McDowall is substantially the same as Anderson and because Anderson was previously presented to the Office, we determine that McDowall is substantially the same art previously presented to the Office.⁸

(d) Bond ’854

Petitioner’s Ground 5 relies on Schwarz ’223 with either Keck or McDowall and Bond. Pet. 59. Petitioner argues that Bond was not “before the Examiner, nor [is it] cumulative of art the Examiner considered.” *Id.* at 12.

Patent Owner argues that Bond ’854 contains the same passages present in U.S. Patent Appl. Publication No. 2004/0096656 (“Bond ’656”) that the ’801 parent patent applicant cited in an IDS on April 2, 2018, during prosecution of the ’801 patent. Prelim. Resp. 31–33 (citing Ex. 2007, 1–11;

⁸ We note that the Petition also relies on portions in McDowall that are substantially the same as portions in Keck (*see* Prelim. Resp. 29–31 (citing Ex. 1003; Ex. 1004; Pet. 31, 47)). Accordingly, because McDowall is substantially the same art as Keck and because Keck (as explained above) was previously presented to the Office, we also determine that McDowall is substantially the same art previously presented to the Office with respect to Keck.

Ex. 2004⁹ ¶¶ 97, 107). The Examiner was aware of the parent '801 patent because the Examiner rejected the '276 patent claims for obviousness-type double patenting over the parent '801 patent's claims and reviewed the office actions issued during prosecution of the great-grandparent '474 patent. *Id.* at 34; *see* Ex. 1028, 199 (rejecting then-existing claims 1–24 as unpatentable on the ground of nonstatutory double patenting in view of the parent '801 patent), 214 (identifying all office actions in the parent '801 patent prosecution in an IDS)); *see also* Ex. 1001, 3 (office actions in the parent '801 patent prosecution cited as other publication on the face of the '276 patent). As explained above, since previously presented art includes art provided to the Office in an IDS, Bond '656 was previously presented to the office.

We are persuaded by Patent Owner's argument that Bond '854 is cumulative of Bond '656. Patent Owner provides argument and a chart comparing the identical text, relied on by Petitioner, found in both Bond '854 and Bond '656. Prelim. Resp. 32–33. Petitioner does not dispute that the Petition relies on the same portions of Bond '854 that are present in Bond '656. *See generally* Reply. Accordingly, because Bond '854 is substantially the same art as Bond '656 and because Bond '656 was previously presented to the Office, we determine that Bond '854 is substantially the same art previously presented to the Office.

(e) Fabbricante

Petitioner's Ground 6 relies on Fabbricante and Keck. Pet. 61. Petitioner argues that Fabbricante was not considered by the Office (*id.* at

⁹ Bond, US 2004/0096656 A1, published May 20, 2004 (Ex. 2004 "Bond '656").

12) and its “teachings are not cumulative of the prior art considered in the prosecution of the ’474 or ’276 patents” (Reply 8). Petitioner argues that Fabbriante is not limited to discontinuous fibers or the use of knife-edge meltblown die. Reply 8–9. In addition, Petitioner asserts that “Fabbriante teaches strong motivational factors for [the] use of Fabbriante’s process for preparation of absorbent articles, such as wipers.” *Id.* at 9.

Patent Owner asserts that the Petition’s combination of Keck with Fabbriante is materially indistinguishable from the combination of Anderson or Pomplun and Schwarz ’616 that the Examiner applied to reject the claims during prosecution of the ’276 patent. Prelim. Resp. 38–40. Patent Owner asserts the Petition relies on disclosures in Fabbriante that are substantially the same as those the Examiner relied on in Schwarz ’616 during prosecution of the ’276 patent. *Id.* at 39 (citing Ex. 1028, 37–43, 71–82, 155–167, 189–202).

We agree with Patent Owner that Fabbriante is substantially the same art as Schwarz ’616 because the portions of Fabbriante relied on by Petitioner are substantially the same as the portions of Schwarz ’616 relied on by the Examiner during the prosecution of the ’276 patent. *Compare* Pet. 63, *with* Ex. 1028, 37; *see also* Prelim. Resp. 38–39 (same). For example, Petitioner relies on Fabbriante for disclosure of “providing a die comprising three or more rows of three or more filament-forming holes,” arguing that Fabbriante discloses “nozzles (filament-forming holes) in which the rows include three or more filament nozzles” and “a multirow meltblown die having a primary plate that includes a polymer orifice (filament-forming hole) in which the polymer orifice is flanked on opposing sides by a pair of air nozzles (fluid releasing holes).” Pet. 62–63 (citing

Ex. 1018, 5:24–48, 5:58–62). During prosecution of the '276 patent, the Examiner found that Schwarz '616 discloses this limitation. *See* Ex. 1028, 39 (“regarding the newly-added limitation of ‘three or more filament-forming holes’ in claim 1, see col. 2, lines 15–52 and Figures 1, 2A and 2B of Schwarz.”). As such, both Fabbriante and Schwarz '616 disclose substantially the same die comprising three or more rows of three or more filament-forming holes, and are therefore cumulative information already considered by the Office. Thus, Fabbriante is substantially the same art as Schwarz '616. We acknowledge Petitioner’s assertions that Fabbriante and Schwarz '616 are different, but Petitioner does not dispute that Fabbriante is relied on by Petitioner in substantially the same manner as Schwarz '616 was relied on by the Examiner. *See generally* Reply. Furthermore, the points of distinction identified by Petitioner are not relevant to the claims here. Accordingly, because Fabbriante is cumulative of Schwarz '616 and because Schwarz '616 was previously presented to the Office, we determine that Fabbriante is substantially the same art previously presented to the Office.

(2) Conclusion as to Advanced Bionics Framework Part (1)

In view of the foregoing discussion, we conclude that the prior art relied upon in the Petition is the same or substantially the same art that was previously presented to the Office. Accordingly, the first condition of the *Advanced Bionics* framework is satisfied. Because we determine that the same or substantially the same art was before the Examiner during

examination, we need not consider *Becton, Dickinson* factor (d)¹⁰ and we turn to the second step of the *Advanced Bionics* framework.

b) Advanced Bionics Framework Part (2)

Having determined that the “same or substantially the same prior art” previously was presented to the Office, we now consider whether Petitioner sufficiently demonstrates that the Office materially erred. In assessing the second part of the *Advanced Bionics* Framework, we consider *Becton, Dickinson* factors (c), (e), and (f) to determine whether material error has been shown. *Advanced Bionics*, Paper 6 at 10. “An example of a material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.” *Id.* However, “[i]f reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.* at 9. Petitioner bears the burden of showing that the Examiner materially erred. *Id.* at 8.

Petitioner argues that despite the fact that, during prosecution of the ’276 patent, Keck was cited in an IDS (and indicated as considered by the Examiner) and Schwarz ’616 was used as a secondary reference to reject the claims, the Examiner did not substantively evaluate Keck or use Schwarz ’616 as a primary reference. Pet. 12. Specifically, Petitioner argues that the

¹⁰ Though we need not reach *Beckton, Dickinson* factor (d), we observe that the record contains substantial evidence that the Office previously considered the same or substantially the same combinations of references during examination of the great-grandparent ’474 patent—which Patent Owner overcame through argument—that overlap with the manner in which Petitioner relies on the prior art in this Petition. Prelim. Resp. 40–42; *see generally* Ex. 1013.

Examiner erred by not combining Schwarz '616 with other art that “taught continuous meltblown filaments and other methods of preparing coform fabrics.” Pet. 12–13; Reply 10. Petitioner argues that the Examiner erred by focusing on old art such as Anderson instead of reviewing more recent art such as Keck that “taught meltblown coform fabrics can include continuous filaments and can be prepared using non-knife-edge dies” and processes. Reply 10. According to Petitioner, when Patent Owner argued that “Anderson requires short fibers to be operative and/or converging air, the Examiner should have immediately pivoted his analysis to prior art references, such as Keck, that showed [Patent Owner’s] arguments presented in prosecution were without merit.” *Id.* Petitioner argues that the Examiner committed this error during prosecution of both the great-grandparent '474 patent and the '276 patent. *Id.*

Patent Owner argues that Petitioner did not identify any specific error in the Examiner’s evaluation of Schwarz '616. Prelim. Resp. 43–44. Patent Owner also disagrees with Petitioner’s assertion that the Examiner erroneously used Schwarz '616 in rejecting the claims as “neither accurate nor fair” given the Examiner’s use of Schwarz '616 in four Office Actions with different combinations of references during prosecution of the '276 patent. *Id.* at 44. According to Patent Owner, “[t]he examiner understood what Schwarz '616 disclosed, repeatedly applied Schwarz '616 in combinations of prior art to reject claims, and ultimately withdrew the rejections following applicant’s response and amendment.” *Id.* Patent Owner also disagrees with Petitioner’s argument that the Examiner should have combined Schwarz '616 with other references such as those identified in the Petition given Petitioner’s references are cumulative with the

Examiner's references. *Id.* at 44–45. Patent Owner also disagrees with Petitioner's argument that the Examiner withdrew rejections based on Schwarz '616 without any stated reasons and argues that the "the examiner's silence here is not sufficient to show material error" and that the Examiner understood Schwarz '616. *Id.* at 45.

We agree with Patent Owner. Petitioner must demonstrate that the Examiner erred in the evaluation of the prior art, for example, by showing that the Examiner misapprehended or overlooked specific teachings in the relevant prior art such that the error by the Office was material to the patentability of the challenged claims. *Advanced Bionics*, Paper 6 at 21. Here, (1) Schwarz '616 was evaluated and used by the Examiner as a basis to reject the then-pending claims during prosecution of the '276 patent (Ex. 1028, 37–43, 71–82, 155–167, 189–202) and the great-grandparent '474 patent (Ex. 1013, 55–61, 79–86, 103–115, 155–165, 384–394, 405–413); (2) Keck was present on an IDS in the '276 patent (Ex. 1001, code (56); Ex. 1028, 46, 61); (3) the claims of the '276 patent were rejected as unpatentable for obviousness-type double patenting over the issued claims of the parent '801 patent and the great-grandparent '474 patent (Ex. 1028, 199); and (4) the relevance of Schwarz '616 was reassessed in the '276 patent where the Examiner expressly reviewed the office actions related to the prosecution of the great-grandparent '474 (Ex. 1028, 214; Ex. 1001, 3). In light of the Examiner's consideration of Schwarz '616 and Petitioner's failure to identify any specific teaching in the references that the Examiner misapprehended or overlooked, we find the evidence of record insufficient to establish that the Office erred. Rather, Petitioner merely disagrees with

the Examiner's findings and conclusions, which is insufficient to establish material error by the Office. Advanced Bionics, Paper 6 at 9.

We acknowledge Petitioner's argument that during prosecution of the '276 patent and the great-grandparent '474 patent, Patent Owner argued that the combination of Schwarz '616 and Anderson would result in discontinuous fibers because of the knife-edge die which should have prompted the Examiner to seek out art describing continuous filaments prepared using non-knife-edge dies and processes. Reply 1–3, 10. However, we are not persuaded by Petitioner's argument, which includes little, if any, explanation regarding how the use of prior art, describing continuous filaments prepared using non-knife-edge dies, would have made any difference during the prosecution of the '276 patent and the great-grandparent '474 patent. Further, nowhere does Petitioner establish that the issues presented in this proceeding turn on whether the filaments are continuous or prepared using non-knife-edge die. Furthermore, as Patent Owner explains, "Anderson was not part of the withdrawn (final) rejection that led to allowance, Pomplun was . . . [A]nd Pomplun discloses a co-form process involving producing *continuous* fibers. Sur-reply 1 (citing Ex. 1028 at 37–43 (¶¶ 4, 10)). Accordingly, we determine that the "same or substantially the same art previously were presented to the Office" and Petitioner has not demonstrated that the Examiner erred when considering the prior art or arguments.

c) Conclusion

For the foregoing reasons, we exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d).

III. ORDER

After due consideration of the record before us, and for the foregoing reasons, it is:

ORDERED that the Petition is denied as to all challenged claims, and no trial is instituted.

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