

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CHAMPION LABORATORIES, INC.,

FIRST BRANDS GROUP, LLC,

Petitioners,

v.

HENGST SE,

Patent Owner.

Case No. IPR2024-00603

U.S. Patent No. 6,023,203

PETITIONERS' PRELIMINARY REPLY

LIST OF EXHIBITS

Exhibit	Description
1001	U.S. Patent No. 9,023,203 B2
1002	File History for U.S. Patent No. 9,023,203 B2
1003	Declaration of Mr. Michael Nranian
1004	European Patent No. 1,714,688
1005	Certified Translation of European Patent No. 1,714,688 to Brisson (“Brisson”)
1006	U.S. Patent Pub. No. 20100044295 A1 (“Honermann”)
1007	JP Application 2002-303171
1008	Certified Translation of JP Application 2002-303171 (“Yokoyama”)
1009	U.S. Patent Pub. No. 20040232063 (“Cline”)
1010	U.S. Patent Pub. No. 20120261326 (“Deschamps”)
1011	<i>Curriculum Vitae</i> of Mr. Michael Nranian
1012	Plaintiff’s Final Infringement Contentions, <i>Hengst SE v. Champion Laboratories, Inc.</i> , No. 23-cv-00794 (Jan. 16, 2024)
1013	Time-to-trial statistics for N.D. Ill.
1014	Defendant Champion Laboratories’ Opening Claim Construction Brief, <i>Hengst SE v. Champion Laboratories, Inc.</i> , 23-cv-00794, Dkt. 30 (N.D. Ill. May 7, 2024).
1015	Plaintiff’s Local Patent Rule 4.1 Exchange of Proposed Claim Terms, <i>Hengst SE v. Champion Laboratories, Inc.</i> , 23-cv-00794 (N.D. Ill. Feb. 27, 2024).

PO does not dispute the merits of Petitioners' grounds of challenge. PO's discretionary denial arguments should be denied.

I. THE BOARD SHOULD NOT DENY UNDER *FINTIV*

Each *Fintiv* factor weighs against denial or is neutral at best. Factor 1 is neutral because neither party has requested a stay and there is no indication a Court will or will not grant one. *See, e.g.*, IPR2020-00019, Paper 15 at 12 (informative). PO mischaracterizes *10X Genomics*, where this factor favored denial because of a “prior denial of a motion to stay.” POPR 7; IPR2023-01299, Paper 15 at 16.

For Factor 2, no trial date has been set. This heavily weighs against denial. PO's speculative trial date relies on the Northern District of Illinois's general schedule for patent cases, which the Court in the parallel litigation declined to adopt. POPR 8, Ex. 2010, Ex. 2005; IPR2020-01258, Paper 18, 45-46 (declining to rely on court's standard schedule). The parties may instead use the “median time-to-trial for civil actions” (Interim Procedure at 8-9), which for N.D. Ill. is 56.9 months from filing. Ex. 1013. That would place trial in late 2027 or 2028.

For Factor 3, the parties have not invested significant resources. Little investment was expended to conduct fact discovery, where less than 17 hours of deposition time was taken and few documents were produced. There is no schedule in place for expert discovery, and PO again merely speculates that a claim construction order will issue prior to institution. POPR 9. Indeed, the claim

construction hearing has not yet occurred. This factor weighs against institution.

For Factor 4, there is not significant overlap. There are substantial differences between the challenged claims and asserted claims, such as challenged, but unasserted, claim 1, which is directed to a liquid filter with both a filter housing and a ring filter insert. By contrast, claim 15, is directed only to a ring filter insert. Thus, there are many more issues for the Board to resolve in this proceeding.

Petitioner has also stipulated not to present the same grounds of challenge in the district court. Pet. 24. PO concedes that, in the litigation, Petitioner is asserting grounds it could not present before the Board because it relies on system art. POPR 12-13. Thus, the outcome of the district court litigation could not have any bearing on the Board's decision making. This factor weighs against denial.

For Factor 5, while the parties are the same, this factor is either neutral or only slightly weighs in favor of denial.

Factor 6 weighs heavily in favor of institution, as Petitioner presents compelling grounds of unpatentability. IPR2024-00137, Paper 15, 14-16 (factor 6 outweighing other factors, including trial 8 months in advance). PO does not dispute the merits of these grounds, only arguing in connection with discretionary denial that the prior art is cumulative of art cited (but not discussed) by the examiner. POPR 14-16. Thus, not only are the grounds objectively compelling, there are no merits-based arguments on the record disputing the Petition, nor will

there be before institution, as PO may not present any such arguments in sur-reply.

II. THE BOARD SHOULD NOT DENY UNDER SECTION 325(D)

PO concedes that the primary reference for Ground 3, Honermann, was not presented to the Patent Office. POPR 17. PO argues, however, that Honermann is cumulative of Yokoyama, a Japanese-language reference that was cited in an IDS but never translated and not discussed by the examiner. The basis of PO's argument is that Petitioner relied on both Yokoyama and Honermann for the same limitations against Claim 15. Yet PO ignores that Petitioner relies on Honermann, but not Yokoyama, for Claim 1, which recites additional limitations, indicating the art is not substantially the same. PO does not address this distinction.

Moreover, PO's general assertions of similarity between Honermann and Yokoyama are not sufficient to show substantial overlap. It is not surprising that Honermann and Yokoyama share overlapping disclosures given they are directed to the same field. IPR2024-00200, Paper 9 at 6 (“[G]eneral allegations of similarity [are not] sufficient to satisfy the first part of the *Advanced Bionics* framework. Rather, PO must provide **a more substantive analysis** comparing the teachings to show that they are substantially the same.”).

Indeed, PO must explain how Petitioner relies on Honermann “in substantially the same manner as the Examiner cited [Yokoyama] during prosecution such that [Honermann] discloses substantially the same information as

[Yokoyama] *in relevant part.*” *Advanced Bionics*, IPR2019-01469, Paper 6 at 15 (precedential). PO cannot do so because the examiner did not discuss Yokoyama and it is unlikely the examiner gave it much consideration because Yokoyama is a Japanese-language reference *that was never translated*.

And thus, with respect to Ground 1’s reliance on Yokoyama the examiner made a material error in not considering Yokoyama (at least for Claim 15). As explained in the Petition, both Yokoyama and Honermann disclose the limitation the examiner found missing in “the closest prior art,” an inclined plane on the outer circumference of the central nozzle. Pet. 21-22. PO does not address the examiner’s error and instead focuses on other limitations that the examiner found in the prior art, and thus was not relevant to the examiner’s failure to consider Yokoyama.

For these reasons, discretionary denial is not warranted.

III. PETITIONERS DID NOT ADVANCE INCONSISTENT CLAIM CONSTRUCTIONS

PO accuses Petitioner of taking “inconsistent claim construction positions.” POPR 23-28. This is flatly incorrect. Here, Petitioner give the terms “panel” and “rotating the ring filter insert relative to the filter housing” their ordinary meaning. PO argues that this is inconsistent with Petitioner’s litigation position, where Petitioner proposed a specific construction.

But PO mischaracterizes the record. First, the parties have agreed on a

construction for “panel” that is “[c]onsistent with the plain and ordinary meaning.” Ex. 1014, 4 n.3; Ex. 1015, 2. And with respect to the “rotating” term, Petitioner’s Markman briefing makes plain that the proposed construction **is** the ordinary meaning for that term. Ex. 1014, 7. Providing an express construction for a term is not inconsistent with plain and ordinary meaning because when construing terms, they are “given their ordinary and customary meaning.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005). Only in limited situations, such as claim disavowal or lexicography, will a claim term not be given its plain and ordinary meaning. *Id.* at 1316. Consistent with these principles, Petitioner argued in its claim construction briefing that its proposed construction for the one term in dispute is “consistent with ... the plain and ordinary meaning.”

Moreover, the prior art here would render the claims unpatentable regardless of whether the litigation construction is applied. The Board has consistently held that terms need not be expressly construed if not necessary to resolve any disputes, even if a Court has previously given an express construction. *Interactive Communications Int’l, Inc. v. Blackhawk Network Inc.*, IPR2023-01235, Paper 11 at 15 (declining to adopt earlier claim construction because “none are in dispute”). Similarly, despite the claim construction dispute in the district court litigation, the Board need not construe any of the terms here because it would not resolve any disputes—for PO has raised none. Doing so would not present any inconsistency.

Date: August 6, 2024

Respectfully submitted,

By: /s/ Quincy Lu
Quincy Lu

Counsel for Petitioners

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 6, 2024, true and correct copies of the foregoing document were served in its entirety on the following parties via Electronic Mail

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Date: August 6, 2024

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