

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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SALVACION USA, INC.  
Petitioner

v.

TRUTEK CORP.  
Patent Owner

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U.S. Patent No. 8,163,802  
Issued: April 24, 2012

Title: ELECTROSTATICALLY CHARGED MULTI-ACTING NASAL  
APPLICATION, PRODUCT, AND METHOD

*Inter Partes* Review No. IPR-2024-00711

**PATENT OWNER'S RESPONSE IN OPPOSITION TO  
PETITIONER'S MOTION TO STRIKE**

## **I. STATEMENT OF FACTS**

On September 11, 2024, Patent Owner submitted its preliminary response to the petition. That document was intended to be a complete response to all issues raised the petition. On pages 22-24 of its preliminary response, Patent Owner discussed commercial success of the patented product as having a mitigating effect on a determination of obviousness of its patented product. In that discussion, Patent Owner set forth the fact that "since the time the '802 Patent was issued in 2012, more than seven million units of the product based on this patent have been sold in the United States and internationally." This fact is a clear indication of commercial success of the patented product.

On March 4, 2025, Patent Owner submitted its response to the petition. On pages 21-22 of that response, Patent Owner reiterated and supplemented its discussion of commercial success of its NasalGuard<sup>®</sup> Airborne Particle Blocker product. On page 21, there appears a photograph of the product's packaging. The '802 Patent number is clearly marked at the bottom of the rear side. Patent Owner further stated that this product "has been sold continuously throughout the United States since 2012, *i.e.*, the issue date of the '802 Patent."

On May 27, 2025, Petitioner submitted its reply to Patent Owner's response. On pages 23-24 of that reply, Petitioner stated, "no evidence has been introduced to overcome obviousness with commercial success." Petitioner first claimed that the photographs were not introduced as evidence. Then, Petitioner stated that, "Patent Owner has failed to establish the required nexus between the alleged success and the alleged invention in the '802 Patent."

On July 8, 2025, Patent Owner submitted its sur-reply to Petitioner's reply. In that sur-reply, to rebut Petitioner's allegations, Patent Owner included the exhibits, which are the subject of the present motion.

On July 15, 2025, Petitioner submitted objections to Exhibits 2003-2007, to which Patent Owner responded on July 21, 2025. Most of Petitioner's objections were that Patent Owner's exhibits were hearsay without exception. On July 21, 2025, Patent Owner submitted its response in opposition to Petitioner's objections.

## **II. ARGUMENT**

In its petition, Petitioner presented five grounds for review of claims 1, 2, 3, and 8. Each of the first four grounds alleged that these claims are anticipated by the prior art under 35 U.S.C. § 102. In the alternative, if the Board does not find anticipation under § 102,

Petitioner alleged that these claims are obvious over a single prior art reference under 35 U.S.C. § 103.

In *Graham v. John Deere Co.*, 383 U.S. 1 (1966), the United States Supreme Court held that a determination of obviousness can be mitigated by the commercial success of a product covered by a patent. For this to occur, the product must not only have commercial success, but there must also be a nexus between the product and the patent. This normally occurs when the patent number is physically associated with the product and marked so that the public would have knowledge that the product is protected by the patent.

In its preliminary response, Patent Owner, through its attorney with knowledge of the product history, presented facts demonstrating that Trutek's product exhibited significant commercial success since 2012. In its response to the petition, Patent Owner, through its attorney, stated that the product had been sold continuously since 2012. Further, the response to the petition included a photograph, wherein the '802 Patent number is clearly marked on the product packaging, thereby establishing nexus between the patent and the commercially successful product. While these facts were not presented through witness testimony, they were nonetheless presented in a signed document by Patent Owner's Patent Attorney

who has a duty of candor before the tribunal under 37 CFR § 42.11. They should thus be considered by this tribunal in order to make an objective determination of whether '802 Patent's claims are unpatentable based on obviousness.

The exhibits which are the subject of Petitioner's motion could have been presented in Patent Owner's response to the petition. Instead, they were submitted in the sur-reply to rebut the erroneous allegation by Petitioner that "Patent Owner has failed to establish the required nexus between the alleged success and the alleged invention in the '802 Patent." The exhibits were not previously submitted because Patent Owner's Attorney believed that the statements of fact sufficiently established commercial success of the patented product.

It should be apparent that Patent Owner did not waive the issue of commercial success to mitigate obviousness of the asserted claims. Patent Owner raised this issue both in its preliminary response and in its response to the petition. However, the newly submitted exhibits clearly supplement and establish both commercial success of the product and a nexus between the product and the patent. In the interest of justice, it is important that all factors be considered when determining objectively whether the claims of the '802 patent are unpatentable under 35 U.S.C. § 103.

### **III CONCLUSION AND PRAYER FOR RELIEF**

Based on the above arguments, it should be apparent that Patent Owner's failure to submit the exhibits in its reply to the petition was inadvertent. It should also be apparent that Patent Owner did not waive the issue of commercial success. The product sold by Patent Owner and protected by the '802 Patent has had significant commercial success. The patent number was clearly marked on the packaging.

Patent Owner respectfully requests that Petitioner's Motion should be denied. In the alternative, Patent Owner respectfully requests that it be permitted to file a motion for filing the exhibits as supplemental information under 37 CFR §42.123 as it would be in the interests of justice for the Board to consider commercial success to objectively determine whether the claims are unpatentable due to obviousness.

Date: August 6, 2025

Respectfully submitted,  
/s/Stanley H. Kremen  
Stanley H. Kremen  
Reg. No. 51900  
Lead Counsel for  
Patent Owner/Respondent

## CERTIFICATION OF SERVICE

The undersigned hereby certifies that the above-captioned "Patent Owner's Response in Opposition to Petitioner's Motion to Strike," regarding IPR2024-00711 was served on August 6, 2025, upon the following via email:

**VORYS, SATER, SEYMOUR AND PEASE LLP**

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As well as a courtesy copy to the patent owner's litigation counsel, by email:

|                 |                                                                  |
|-----------------|------------------------------------------------------------------|
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/s/ Stanley H. Kremen

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*Lead Counsel for Patent  
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Trutek Corp..*