

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DR. SQUATCH, LLC
Petitioner

v.

THE PROCTER & GAMBLE COMPANY
Patent Owner

IPR2024-01104
Patent No. 11,540,999

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE**

Patent Owner (“P&G”) incorrectly argues that § 325(d) weighs against institution because Lesniak and Phinney were of record during prosecution of the ’999 patent. First, the Examiner did not apply the references in any rejections. Second, the Examiner erred in not applying this art, as confirmed by later prosecution of a related ’089 application that P&G failed to inform the Board about in its POPR. *See* Ex. 1077 (post-petition excerpts of App. No. 17/961,089). After the Petition’s filing, the Examiner used Lesniak to reject claims of the ’089 application that do not materially differ from claims challenged here. In doing so, the Examiner explicitly disagreed with P&G’s position in this proceeding that Lesniak discloses only sunscreens and diaper creams, not deodorants.

I. Prior art was not adequately addressed during original examination.

Section 325(d) does not weigh against institution because the Examiner did not apply Lesniak or Phinney in any rejections or otherwise substantively address them during prosecution of the ’999 patent. “The Board frequently holds that a reference that was neither applied against the claims nor discussed by the Examiner does not weigh in favor of exercising the Board’s discretion under § 325(d) to deny a petition.” *Dropbox, Inc. v. Motion Offense, LLC*, IPR2024-00286, Paper 12, at 15-16 (P.T.A.B. July 25, 2024) (applying *Becton, Dickinson* factors).

Also, P&G mistakenly argues, without support, that the Examiner’s finding of inherency with respect to the hardness limitation precludes institution based on a

reference (Bianchi '518) that the Examiner never considered, which expressly discloses that limitation. *BlueCatBio MA Inc. v. Yantai Ausbio Labs. Co., Ltd.*, PGR2020-00051, Paper 26, at 39 (P.T.A.B. Dec. 15, 2020) (rejecting § 325(d) denial where the “Petition does not rely on inherency” as Examiner did).

II. Recent events confirm that errors were committed during examination.

Section 325(d) also does not weigh against institution because the Examiner erred in allowing the claims of the '999 patent over Lesniak, as the Examiner subsequently recognized. Claim 1 of the '999 patent recites a “deodorant stick” having an “antimicrobial comprising magnesium hydroxide; and [] a primary structurant with a melting point of at least about 50° C. ... said stick being free of an aluminum salt[] and ... having a hardness from about 80 mm*10 to about 140 mm*10.” Pending claims 3, 4, and 9 of the '089 application contain substantively identical limitations (among others). Ex. 1077, 11-12. As highlighted in the Petition, the Examiner twice rejected the '089 application's claims in view of Lesniak after the '999 patent issued. Thus, by repeatedly rejecting materially identical claims in view of Lesniak, the Examiner recognized that the '999 patent claims should not have been allowed over Lesniak.¹ *See Godbersen-Smith Const.*

¹ References herein to materially/substantively identical claims relate solely to unpatentability over Lesniak. Such positions may differ for infringement.

Co. v. Guntert & Zim. Const. Div., Inc., IPR2024-00835, Paper 9, at 11-12 (P.T.A.B. Nov. 14, 2024) (finding sufficient showing of error under § 325(d) in view of rejection of “similar claims” based on art considered during examination).

P&G largely ignores the '089 application rejections. It does not and could not identify any material difference between the '999 patent claims and the '089 application claims that stand rejected. Instead, P&G dismisses Lesniak as “about sunscreen and diaper cream, *not deodorant*.” POPR, 13. But this exact argument failed to overcome Lesniak in an office action that issued in the '089 application after the filing of the subject Petition—but before P&G submitted its preliminary response, which makes no mention of the rejection despite its relevance.

Specifically, in response to P&G’s argument that “Lesniak does not disclose deodorant compositions and focuses on sunscreens and diaper creams,” the Examiner alluded to Lesniak’s express disclosure that its compositions can be used as antiperspirants. Ex. 1077, 7-8. And the Examiner cited the '089 application’s own disclosure that antiperspirants are equivalent to deodorants. *Id.* The Examiner further dismissed P&G’s theory that Lesniak’s compositions could not be antiperspirants because they lack aluminum. As the Examiner explained, the '089 application itself discloses antiperspirant actives other than aluminum. *Id.*

P&G’s own arguments expose additional errors during examination of the '999 patent, further foreclosing denial of institution under 325(d). For example,

P&G insists that the Osipow reference that it overcame during prosecution replicates the relevant disclosure of Lesniak. P&G circumvented Osipow by adding a limitation requiring magnesium hydroxide, with the Examiner concluding that “Osipow does not disclose . . . magnesium hydroxide” and that there was no “art to indicate that magnesium hydroxide can be used in deodorant stick compositions.” POPR, 27 (quoting Ex. 1033, 31). Notably, the Petition relies upon Lesniak in a manner *consistent* with the Examiner’s application of Osipow (i.e., for everything other than magnesium hydroxide), such that no § 325(d) concern exists for Lesniak. Regarding magnesium hydroxide, P&G *concedes* that Phinney “describes deodorant formulations comprising both zinc hydroxide and magnesium hydroxide to ‘provide long lasting protection against odor due to perspiration.’” *Id.* at 9. Thus, P&G confirms that the Examiner erred by overlooking Phinney’s teachings.

The prosecution of the ’089 application underscores this error during examination of the ’999 patent. In the latest rejection of the ’089 application claims, the Examiner cited EP0471392 (“Park”) as disclosing deodorants with magnesium hydroxide, which contradicts the erroneous finding that led to allowance of the ’999 patent. Ex. 1077, 4-6. The Examiner also found that Park teaches the interchangeability of magnesium hydroxide and zinc oxide as low-solubility antimicrobials in deodorant sticks, rendering obvious the substitution of magnesium hydroxide for Lesniak’s zinc oxide. *Id.*

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Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that a complete copy of this Reply and all Exhibits and other documents filed together with this Reply were served by email on counsel for Patent Owner on November 20, 2024, at the following addresses:

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