UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Dr. Squatch LLC

Petitioner

v.

The Procter & Gamble Company

Patent Owner

Case IPR2024-01104

U.S. Patent No. 11,540,999

PATENT OWNER'S SUBMISSION REGARDING PETITIONER'S IMPROPER REPLY BRIEF EVIDENCE

Every claim of the ’999 Patent recites a deodorant stick “having a hardness from about 80 mm*10 to about 140 mm*10, as measured by penetration with ASTM D-1321 needle.” As a POSA would have recognized (and as a matter of common sense), hardness values only have meaning in the context of the test used to determine them. The needle penetration test described with respect to the hardness claimed in the ’999 Patent uses a needle and shaft with a combined load of 50 grams. (Ex. 1001 at 12:24-25; Ex. 2011 at ¶ 92.) This differs significantly from the needle penetration tests described in Petitioner’s prior-art Bianchi references, which use a load of 100 grams, *i.e.*, *2x greater than the load used in the ’999 Patent’s method*. (Ex. 2011 at ¶¶ 88-93.)

Petitioner did not address this test method discrepancy in its Petition, and, despite having the burden of proof, presented no evidence in support of its *prima facie* case of obviousness as to any relationship between hardness ranges disclosed in the Bianchi references and the hardness range of the challenged claims. Indeed, Petitioner avoided presenting any such evidence: its expert did not consider conducting any testing or otherwise attempt to correlate the different methods. In its POR, P&G highlighted this significant—and dispositive—deficiency of Petitioner’s *prima facie* case. In the Reply, under the guise of “rebuttal,” Petitioner for the first time submitted evidence purporting to correlate the test methods. The Board should disregard this belated submission of new testing evidence. On its

merits, the testing suffers from numerous defects Patent Owner will address in its Sur-Reply. But permitting Petitioner to inject new evidence into the proceedings at this stage runs counter to the rules of the PTAB and is simply improper. Petitioner should not be able to insulate itself from the full-throated attack on flawed testing that P&G could have levied had it been submitted it in the Petition. Petitioner's new hardness testing of present-day (not prior art) deodorant sticks (Exs. 1078-79), Petitioner's expert's opinion on the same (Ex. 1086 at ¶¶ 2-5), and any portion of the Reply relying on that evidence, is improper and should be not be considered.

A. The Different Testing Methods Are Readily Apparent From Petitioner's Prior Art Reference And The Challenged Patents.

"Petitioner *may not submit new evidence or argument* in reply that it *could have presented earlier*, e.g. to make out a prima facie case of unpatentability." Consolidated Trial Practice Guide ("CTPG") at 73-74; 37 C.F.R. § 42.23. Petitioner initiated this IPR with full knowledge of the '999 Patent's hardness limitation and its test method. The '999 Patent presents a hardness range premised on the use of a 50 gram total load: "*Ensure the total weight of the shaft and needle is 50±0.2 grams when the shaft is in free fall.*"[1] (Ex. 1001 at 12:24-25.) Bianchi-518, too, is clear in

[1] Petitioner's post-hoc argument that the '999 Patent's 50-gram load is only used for calibration is unsupported and nonsensical. Obviously the "periodic calibration" is to "[e]nsure" the instrument's total load remains consistent and within proper parameters (*i.e.*, "50±0.2 grams") upon use. (*See* Ex. 1001 at 12:24-25.)

its use of a *different* test method in presenting its hardness range—it sets forth the ASTM D-1321 test method with a total load of 100 grams. (POR at 39-42; Ex. 1006 at 2:58-59 (hardness measured by "ASTM D-1321 @ *100*/77/5"); Ex. 2011 at ¶ 91 (a POSA would have understood Bianchi-518's hardness measurements used 100-gram load); Ex. 2018 at 5-6.) Similarly, Bianchi-254 presents its hardness values as measured by the DIN 51-579 method, which also uses a total load of 100 grams. (POR at 56-57; Ex. 1008 at [0026], [0117]; Ex. 2011 at ¶¶ 124-26 (a POSA would have understood Bianchi-254's hardness measurements used 100-gram total load of DIN 51-579 method); Ex. 2019 at 2.)

Petitioner cannot dispute that its prior art references and the challenged patents explicitly provide different test methodologies, and does not offer any reason why it could not have addressed these differences in its *prima facie* case. Of course it could have. But, instead, Petitioner chose to wait for its Reply to submit entirely new hardness testing (that it could have submitted in the Petition) that purports to convert the hardness ranges outlined in the Bianchi references to those taught in P&G's claims. (*See* Exs. 1078-79; Ex. 1086 at ¶¶ 2-5.) This data does nothing of the sort for the reasons P&G will explain in its Sur-Reply. But the Board should not consider Petitioner's belated evidence in the first place. It belonged in the Petition as a part of the *prima facie* case; it is improper on reply.

B. The New Hardness Testing Is Not Proper Rebuttal Evidence.

Petitioner cannot plausibly argue its new data is within the appropriate scope of rebuttal. While Petitioner contends its "testing evidence properly rebuts" P&G's position that "the prior art's disclosed ASTM hardness range would not overlap with the claimed hardness range," the lack of proof of a correlation between the two was something Petitioner could have (and should have) addressed in its Petition. (*See* Patent Owner's August 1, 2025 Email to the Board.) Petitioner appears to contend it could not have anticipated P&G would argue "the ASTM hardness test named in the claims should be understood to be a modification of that test," but that is simply not plausible. (*See id.*) In submission of the Petition, Petitioner's expert contemplated P&G's exact argument in her initial Declaration: "To the extent Patent Owner alleges that the claim requires a specific test, in my opinion, based on the references to ASTM D-1321 in the claims and specification of the '999 Patent, a POSA would understand that test to be the ASTM D-1321 test known in the art and referred to in Bianchi '518." (Ex. 1002 at 44 n.13.) Given its expert's express acknowledgement, Petitioner cannot now argue it did not expect or anticipate a dispute about the hardness testing methods.

In sum, when it filed the Petition, Petitioner was aware both that the '999 Patent specified a needle test using 50 grams of total load, and its Bianchi references specified a needle test using 100 grams of total load. Petitioner had the *prima facie*

burden of producing a correlation between these two test methods in its Petition and did not.

C. Any Consideration Of Petitioner's Belated Hardness Testing Is Highly Prejudicial To P&G.

P&G cannot respond to Petitioner's belated and unreliable hardness testing with expert testimony or testing of its own. *See, e.g.*, *Bluecatbio MA Inc. v. Yantai Ausbio Lab'ys Co.*, PGR2020-00051, Paper 63 at (PTAB July 8, 2021) ("The CTPG does not contemplate allowing Patent Owner to submit new testimony evidence with its sur-reply, even when Patent Owner believes that Petitioner's reply includes improper new arguments or evidence."); CTPG at 73-74 (Sur-Reply "*may not be accompanied by new evidence* . . . ."). Petitioner should not be permitted to prejudice Patent Owner by submitting this purported correlation evidence with its Reply when P&G is precluded from challenging it in the same way it could have had it been properly submitted. Petitioner should not be rewarded for failing to present its full case in the Petition.

Patent Owner respectfully requests that the Board decline to consider Petitioner's new testing and argument—specifically, Exs. 1078-79 (new hardness testing), Ex. 1086 at ¶¶ 2-5 (Reply Expert Declaration relying on testing), and the portions of Petitioner's Reply that refer to and rely on the aforementioned exhibits.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. 42.6(e), I certify that I caused to be served on the counsel for Petitioner a true and correct copy of the foregoing by email on August 14, 2025, at the following address:

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