

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 IPR2024-01173

U.S. Patent No. 10,905,647

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	Full File History of the '647 Patent
Ex. 2002	<i>Reserved</i>
Ex. 2003	Mayo Clinic, <i>Zinc Oxide (Topical Application Route)</i> , https://www.mayoclinic.org/drugs-supplements/zinc-oxide-topical-application-route/description/drg-20075525
Ex. 2004	Wayback Machine, Mayo Clinic, <i>Zinc Oxide (Topical Application Route)</i> , https://web.archive.org/web/20150102193922/https://www.mayoclinic.org/drugs-supplements/zinc-oxide-topical-application-route/side-effects/drg-20075525?p=1 (archived Jan. 2, 2015)
Ex. 2005	<i>Reserved</i>
Ex. 2006	<i>Reserved</i>
Ex. 2007	International Publ. No. WO 99/21528

All emphasis has been added and all internal citations have been omitted unless otherwise indicated.

I. INTRODUCTION

Patent Owner The Procter & Gamble Company (“P&G” or “Patent Owner”) is a leading consumer products company that makes and sells many different products, including aluminum-free deodorant. Modern consumers have been increasingly interested in more natural formulations “that do not contain aluminum,” seeking natural deodorants “that provide[] low irritation while maintaining sufficient odor protection.” (Ex. 1001 at 1:21–23, 41–43.) This was a challenge because the use of certain natural ingredients yielded sticks with low stability, grittiness, increased skin irritation, and/or an increased hardness that did not provide a pleasant consumer experience during application. (*See id.* at 1:20–43, 15:7–14.)

Thus, P&G carefully developed its aluminum-free deodorant formulations to achieve the ideal ingredient composition, providing its customers with softer sticks with less irritants. It sought and received numerous patents for these novel aluminum-free deodorant inventions, including U.S. Patent No. 10,905,647 (“the ’647 patent”).

Petitioner Dr. Squatch, LLC (“Petitioner”) now seeks to cash in on P&G’s success at meeting present consumer needs by attacking P&G’s duly-issued patents. To do so, Petitioner relies on references and combinations that have clear failings both procedurally and on the merits. Procedurally, Petitioner’s alleged silver bullet prior-art disclosure was already evaluated by the Patent Office during prosecution

of the '647 patent, and was *expressly distinguished* by the Examiner when allowing the challenged claims. On substance, Petitioner fails to explain why a person of ordinary skill in the art ("POSA") would have been motivated to combine the references in its obviousness grounds beyond the use of the '647 patent claims as a roadmap. The Petition offers only weak argument consisting of conclusory, unsupported statements to justify its combinations.

The Petition for *inter partes* review fails to demonstrate a reasonable likelihood of success. The Board should exercise its discretion and deny institution.

II. SUMMARY OF THE '647 PATENT

A. The Claimed Invention

The '647 patent relates to "antiperspirant and deodorant compositions and methods relating thereto." (Ex. 1001 at 1:15–16.) The patent notes that "[m]any antiperspirant and deodorants use actives that are astringent metallic salts, or in particular, aluminum salts." (*Id.* at 1:20–21.) And while aluminum "is highly effective as an active," consumers have been increasingly interested in more natural formulations "that do not contain aluminum." (*Id.* 1:22–24.) Some products use baking soda as an alternative to aluminum, but the '647 patent explains consumers may seek "products with lower irritation than they have experienced with baking soda based products." (*Id.* 1:25–29.) The move to more natural ingredients extends to fragrances as well, with the '647 patent acknowledging consumers are also

looking for “more natural products complete with fragrances that are mostly natural or essential oil based.” (*Id.* at 1:25–27.)

Formulating a product with these consumer preferences is difficult because “natural and essential oil fragrances... can be less stable in the presence of heat and extreme pH.” (*Id.* at 1:29–31.) And products utilizing highly water-soluble alkaline powders instead of aluminum as actives “contribute negatively towards natural or essential oil stability as well, especially in a hot process needed to melt waxes” into sticks. (*Id.* at 1:35–37.) “[H]igh water solubility powders can also lead to gritty products, as the water soluble powders can agglomerate when exposed to moisture released from powders during the hot batch process.” (*Id.* at 1:37–40.) Accordingly, “there is a continuing challenge to formulate a non-aluminum, natural fragrance deodorant that provides low irritation while maintaining sufficient odor protection.” (*Id.* at 1:41–43.)

The '647 patent describes and claims deodorant sticks that meet these customer demands for more natural ingredients. For example, independent claim 1 recites:

1. A deodorant stick comprising:
 - a. at least 25% by weight liquid triglyceride;
 - b. a primary antimicrobial having a water solubility of at most about 90 g/L at 25° C.;

- c. a fragrance composition comprising at least about 50% by weight of natural oils, essential oils, or a combination thereof; and
- d. a primary structurant with a melting point of at least about 50° C.;

said deodorant stick being free of an aluminum salt; and

said deodorant stick having a hardness from about 70 mm*10 to about 140 mm*10, as measured by penetration with ASTM D-1321 needle.

Starting with limitation (a), the '647 patent explains “[a]s consumers seek more natural ingredients in their antiperspirants and deodorants,” one approach to formulations is to use “emollients derived from natural oils,” like a liquid triglyceride. (*Id.* at 14:58–64.) “[P]roducts that hope to emphasize natural ingredients may have a significant amount of liquid triglyceride,” and the independent claims of the '647 patent require varying amounts. (*See* Ex. 1001 at 14:65–67; *id.* at cls. 1 (“at least 25% by weight”), 14 (“at least 50% by weight”), 16 (“at least 60% by weight”), 18 (“at least 50% by weight”).)

As to limitation (b), the '647 patent teaches that “[m]any antimicrobials can be effective at minimizing the skin surface bacteria. However, as a leave-on product where odor may not occur until later, even hours after application, antiperspirant and deodorant antimicrobials are needed that will be effective for long periods of time.” (*Id.* at 11:1–32.) When evaluating potential antimicrobials, the inventors of the '647 patent “discovered that the water solubilities... have great importance,” as “certain

antimicrobials may cause irritation due to high water solubility,” and “high water solubility can lead to grittier products.” (*Id.* at 8:38–57.) Moreover, “the use of [] low water solubility actives can provide additional perfume stability and aesthetic benefits that deodorants with high water solubility actives cannot.” (*Id.* at 12:41–44.) The ’647 patent thus requires a deodorant stick comprising “a primary antimicrobial having a water solubility of at most about 90 g/L at 25° C,” across all claims but two. (*See* Ex. 1001 at cls. 1, 14, 18 (limiting the solubility of the claimed antimicrobial to “at most about 90 g/L at 25° C” for all claims except independent claim 16 and dependent claim 17); *see also id.* at cl. 16 (requiring “at least one antimicrobial” without specificity as to solubility).)

Regarding limitation (c), the ’647 patent explains that “[a]ny perfume or fragrance suitable for use in an antiperspirant or deodorant composition may be used.” (*Id.* at 18:18–21.) Where natural ingredients are preferred, “the composition may be free of, or substantially free of a synthetic fragrance” and instead “may comprise a fragrance composition comprising at least about 50% of natural oils, essential oils, or a combination thereof.” (*Id.* at 18:22–24.) “A natural or essential oil fragrance is a result of natural sources wherein the fragrance material is not altered (chemically modified) but extracted from its natural source,” including from “bark, flowers, blossoms, fruits, leaves, resins, roots, bulbs, and seeds.” (*Id.* at 18:30–34.)

As to limitation (d), the '647 patent defines a “solid structurant” as “any material known or otherwise effective in providing suspending, gelling, viscosifying, solidifying, and/or thickening properties to the composition or which otherwise provide structure to the final product form.” (*Id.* at 15:58–62.) As the '647 patent explains, the “compositions of the present invention comprise a suitable concentration of a primary structurant to help provide the compositions with the desired viscosity, rheology, texture and/or product hardness, or to otherwise help suspend any dispersed solids or liquids within the composition.” (*Id.* at 15:46–51.) In embodiments, the primary structurant—which the specification explains is “the structurant that appears in the product in the highest amount”—has “a melting point of at least about 50° C.” (*Id.* at 15:51-55.)

Lastly, with respect to the hardness limitation, the deodorant compositions described and claimed in the '647 patent have a stick hardness “from about 70 mm*10 to about 140 mm*10, as measured by penetration with ASTM D-1321 needle.” (*Id.* at cl. 1.) The specification explains that generally, “the greater amount of liquid in the formulation, the softer the deodorant stick may be.” (*Id.* at 15:15–16.) So “[r]ather than using waxes or other high melting structurants,” the claimed compositions of the '647 patent “comprise [certain] levels of liquid triglycerides,” *e.g.*, “at least about 25% by weight” or more. (*Id.* at 15:21–24; *id.* at cls. 1, 14, 16, 18.) The patent further outlines the process for testing the hardness of the stick,

explaining “[t]he penetration test is a physical test method that provides a measure of the firmness of waxy solids and extremely thick creams and pastes with penetration values not greater than 250 when using a needle for D1321.” (*Id.* at 22:10–13.) As the ’647 patent explains, the hardness of the deodorant sticks is important, as sticks that are too hard do not provide a pleasant consumer experience during application. (*See id.* at 15:7–14.)

B. The Prosecution History

The ’647 patent was filed as Application No. 16/021,931 on June 28, 2018, claiming priority to Provisional Application No. 62/647,111, filed on March 23, 2018, and to Provisional Application No. 62/527,180, filed on June 30, 2017.

On March 13, 2020, the Examiner rejected the proposed claims for nonstatutory double patenting over a related patent and a pending patent application. (Ex. 2001 at 197.) The Examiner added an “Examiner’s Note,” where she analyzed “[t]he closest prior art,” but lodged no claim rejections over any of the cited references. (*Id.* at 198.) In response, Applicant filed a terminal disclaimer over the related patent and application. (*Id.* at 233.) The Examiner issued a Notice of Allowance on August 4, 2020, evaluating again the “closest prior art” and finding in her Reasons for Allowance that none anticipated or rendered obvious the claims. (*See id.* at 253.)

On August 17, 2020, Applicant submitted a Request for Continued Examination and an additional Information Disclosure Statement, which disclosed various prior art references including U.S. Patent Publication No. 2017/0252288 to Lesniak. (*Id.* at 273–81.) The Examiner allowed the claims over these additional references on October 9, 2020. (*Id.* at 437.) In her Reasons for Allowance, the Examiner explicitly addressed the Lesniak publication, finding that Lesniak “is directed toward a sunscreen composition that requires the presence of the sunscreen agent Zinc Oxide” and that “[a] person of ordinary skill in the art would not construe zinc oxide as an ‘antimicrobial agent’” in Lesniak, as required by the instant claims. (*See id.* at 443–44.)

C. Claim Construction

Claim terms are to be construed in accordance with the standard set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc). But “[o]nly terms which are in controversy need to be construed, and then only to the extent necessary to resolve the controversy and material to the decision.” *Facebook, Inc. v. Sound View Innovations, LLC*, IPR2017-01005, Paper No. 13 at 6 (PTAB Sept. 1, 2017) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). As detailed below, reasons exist for denial of institution that do not require addressing the construction of claim terms at this time. If the Board nonetheless institutes trial, P&G reserves its right to put forth constructions for any

claim terms, including terms for which Petitioner formally or otherwise relies on a construction of a term.

D. Person of Ordinary Skill in The Art

Petitioner states that a person having ordinary skill in the art (“POSA”) as of the claimed priority date “would have (1) at least a B.S. or equivalent degree; and (2) at least two years of experience in cosmetics formulations.” (Petition at 24.) At this stage of the proceeding, P&G does not propose a different level of skill in the art, but reserves the right to propose a level of ordinary skill in the art in this proceeding should it be instituted, or in other proceedings.

III. THE ASSERTED PRIOR ART

A. Lesniak

U.S. Patent No. 11,433,018 (“Lesniak”), entitled “NON-GREASY PERSONAL CARE COMPOSITIONS,” was filed on October 2, 2019 as U.S. Application No. 16/590,681, and issued as U.S. Patent No. 11,433,018 on September 6, 2022. (Ex. 1003.) Lesniak describes and claims compositions relating to “a sunscreen or a diaper cream,” and does not mention deodorants. (*See id.* at cl. 1.) Lesniak is a divisional of, and shares a specification in relevant part with, the Lesniak publication that was expressly distinguished by the Examiner during prosecution of the ’647 patent. (*See* Ex. 1001; Petition at 6–7; Ex. 2001 at 443–44.)

B. Phinney

U.S. Patent No. 9,314,412 (“Phinney”), entitled “DEODORANT FORMULATION,” was filed on March 14, 2013 as U.S. Application No. 13/803,387 and issued on April 19, 2016. (Ex. 1004.) Phinney describes deodorant formulations comprising both zinc hydroxide and magnesium hydroxide to “provide long lasting protection against odor due to perspiration.” (*Id.* at 17–19.)

C. Bianchi ’518

U.S. Patent No. 6,048,518 (“Bianchi ’518”), entitled “LOW RESIDUE SOLID ANTIPERSPIRANT,” was filed on May 1, 1998 as U.S. Application No. 09/071,654, and issued on April 11, 2000. (Ex. 1006.) Bianchi ’518 describes antiperspirant compositions comprising about 30% to about 50% volatile silicones and from about 5% to about 30% of an antiperspirant active, like aluminum, among other limitations. (*Id.* at cl. 1.) Bianchi ’518 mentions “deodorants” only once, in passing. (*Id.* at 4:9.)

D. Lamb

Lamb is an article titled “Sodium Bicarbonate: An Excellent Deodorant” from *The Journal of Investigative Dermatology* in 1946. (Ex. 1005 at 131.) It describes a survey and study of medical students, the author’s family, and the author’s patients where the participants used sodium bicarbonate as a deodorant. (*Id.* at 131.)

E. Bianchi '254

U.S. Application No. 11/622,682, filed on January 12, 2007, and later published as U.S. Pub. No. 2007/0166254 (“Bianchi '254”) is entitled “ANTIPERSPIRANT STICK COMPOSITIONS.” (Ex. 1008.) Similar to Bianchi '518, Bianchi '254 describes antiperspirant compositions including from about 20% to about 40% volatile silicone and from 15% to 30% antiperspirant active. (*Id.* at cl. 1.) Bianchi '254 does not mention deodorant.

F. Native

Petitioner’s Exhibit 1007 (“Native”) is a Wayback Machine printout of the former website for the Native company, purporting to describe portions of the Native deodorant formula from 2016. Native shows several positive reviews of the Native deodorant product as it existed at that time. (Ex. 1007 at 8, 17.)

G. Easy Homemade

Petitioner’s Exhibit 1009 (“Easy Homemade”) is a printout of a blog post by an apparent deodorant hobbyist from the Wayback Machine, indicating a date of 2017. The blog post relates to creating an at-home deodorant.

H. Nabavi

Petitioner’s Exhibit 1067 (“Nabavi”) is an article titled “Antibacterial Effects of Cinnamon: From Farm to Food, Cosmetic and Pharmaceutical Industries,” seemingly published online in 2015 in a *Nutrients* journal.

IV. GROUNDS 1–4 SHOULD BE DENIED BECAUSE PETITIONER’S ANTICIPATORY REFERENCE WAS ALREADY ANALYZED BY THE EXAMINER AND ITS COMBINATIONS LACK A RATIONAL MOTIVATION TO COMBINE

A. Section 325(d) Counsels Against Institution of Grounds 1–4, as the Petition Hinges on a Disclosure the Examiner Expressly Distinguished During Prosecution

Petitioner relies on Lesniak as an alleged anticipatory reference in Ground 1, arguing claims 14–17 are either anticipated or obvious over the reference. Lesniak holds a prominent position in Grounds 2–4 as well, with the Petition arguing claims 1–13 and 18–19 are obvious over Lesniak combined with one or more of Bianchi ’518, Phinney, and Nabavi. But a version of Lesniak was presented to the Office during prosecution of the ’647 patent and *expressly distinguished by the Examiner* in her Reasons for Allowance; thus, institution should be discretionarily denied under 35 U.S.C. § 325(d). (*See* Petition at 6 (“Lesniak was of record during prosecution of the underlying application”); *id.* at 18 (“[T]he Notice of Allowance mentioned Lesniak and [] suggested ... that a POSA would not consider zinc oxide to be an antimicrobial.”))

The Board employs a two-part framework in analyzing § 325(d) issues: (1) whether the same or substantially the same prior art or arguments were presented to the Patent Office; and if so, (2) whether the petitioner has demonstrated that the Patent Office erred in a manner material to the patentability of the challenged claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-

01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). This framework arises out of the non-exclusive factors set forth in *Becton, Dickinson*. See *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph).¹ Factors (a), (b), and (d) relate to whether the same or substantially the same art or arguments were previously presented to the Patent Office (part 1 of *Advanced Bionics*), and factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Patent Office (part 2 of *Advanced Bionics*). *Advanced Bionics*, IPR2019-01469, Paper 6 at 10.

Here, the same or substantially the same reference was before the Examiner during prosecution of the '647 patent, and thus the Examiner already considered and

¹ *Becton, Dickinson* identifies the following key factors: (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; (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. See *Becton, Dickinson*, IPR2017-01586, Paper 8 at 17–18 (§ III.C.5, first paragraph).

rejected the argument Petitioner now makes in its anticipation ground. The Board should discretionarily deny institution.

1. *Step 1: The Same or Substantially the Same Prior Art was Previously Presented to The Office*

Petitioner's Lesniak reference is a divisional of another Lesniak publication cited on the face of the '647 patent. (Ex. 1001.) The two Lesniak references share a specification in relevant part, the disclosure of which was evaluated by the Office during prosecution. Petitioner admits this. (See Petition at 6 ("Lesniak was of record during prosecution of the underlying application..."); *id.* at 6 n.1 (admitting "Lesniak's specification also published as U.S. Patent Pub. No. 2017/0252288," which is cited on the face of the '647 patent); *id.* at 18 ("[A] version of Lesniak was of record during prosecution of the [application leading to the '647 patent]."))

Petitioner also recognizes that the Examiner *expressly distinguished* Lesniak during prosecution, and found that the challenged claims were *not* anticipated or obvious over the reference. (See *id.* at 18; Ex. 2001 at 443–44.) Specifically, after Applicant submitted a post-allowance IDS identifying Lesniak, Examiner reviewed the reference and issued another Notice of Allowance, explaining that "[t]he claims are distinguishable from Lesniak... because *Lesniak is directed towards a sunscreen composition* that requires the presence of the sunscreen agent Zinc Oxide, whereas the instant claims are drawn to a solid deodorant composition that require the presence of an antimicrobial agent." (Ex. 2001 at 443.) The Examiner further

explains that while zinc oxide “ma[y] have antimicrobial properties under certain conditions,” in Lesniak’s sunscreen composition, “a person of ordinary skill in the art would not consider zinc oxide ‘an antimicrobial agent.’” (*Id.* at 443–44.)

Petitioner tries to circumvent this issue, arguing the grounds are “neither cumulative nor redundant to prosecution of the ’647 Patent” because Lesniak was “not applied by the examiner *in the rejection of any claims.*” (Petition at 6.) Petitioner presents no authority to support its attempt to distinguish between an Examiner applying a reference “in [a] rejection” versus an Examiner applying a reference in the Reasons for Allowance and noting that no rejection could be made over it.

Further, the Board in its *Advanced Bionics* precedential decision explained that “[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*, IPR2019-01469, Paper 6 at 7–8. The Board further explained application of *Advanced Bionics* in the *Biocon Pharma* case:

Both EP ’072 and the ’996 patent were presented previously to the Office during prosecution. The record shows that the Examiner signed an IDS listing both EP ’072 and the ’996 patent. The IDS also states that the Examiner considered both prior-art references. In light of

the Board's precedential *Advanced Bionics* decision, we reject Petitioner's contention that, even though EP '072 appears on an IDS, we should decline to exercise discretion under § 325(d) because EP '072 was 'not applied by the Examiner.' As explained in *Advanced Bionics*, '[p]reviously presented art includes art made of record . . . such as on an Information Disclosure Statement (IDS).' Thus, we accept that the Examiner considered EP '072 because it is listed on the IDS and the Examiner signed the IDS with the statement 'all references considered except where lined through.'

Biocon Pharma Ltd. v. Novartis Pharms. Corp., IPR2020-01263, Paper 12 at 9 (PTAB Feb. 16, 2021); *Medtronic CoreValve LLC v. Speyside Med., LLC*, IPR2021-00241, Paper 9 at 23 (P.T.A.B. Jul. 23, 2021) (denying institution where references were listed on the IDS even though not explicitly considered by the examiner); *see also Ultra-Tex Surfaces Inc. v. Hill Brothers Chemical Co.*, 204 F.3d 1360, 1367 (Fed. Cir. 2000) (stating that patent challengers who rely on the same references considered during prosecution "ha[ve] the added burden of overcoming the deference that is due to a qualified government agency presumed to have properly done its job, which includes one or more Examiners who are assumed to have some expertise in interpreting the references and to be familiar from their work with the level of skill in the art and whose duty it is to issue only valid patents.") (quoting

American Hoist & Derrick Co. v. Sowa & Sons, Inc., 725 F.2d 1350, 1359 (Fed. Cir. 1984)).

In *Biocon Pharma*, the Examiner “signed an IDS” listing the prior-art references, the IDS “stated that the Examiner considered both prior-art references,” and the Examiner “signed the IDS with the statement ‘all references considered unless lined through.’” *Biocon Pharma*, IPR2020-01263, Paper 12 at 9 (PTAB Feb. 16, 2021). So too here, but with even more. During prosecution of the ’647 patent, Lesniak appears on an Information Disclosure Statement signed by the Examiner, where the Examiner attested that “ALL REFERENCES [HAVE BEEN] CONSIDERED EXCEPT WHERE LINED THROUGH.” (*See, e.g.*, Ex. 2001 at 468.) And Examiner expressly applied Lesniak to the claims and found them “distinguishable.” (*Id.* at 443.) Lesniak was thus previously presented to and evaluated by the Examiner, and Petitioner has “the added burden of overcoming the deference” owed to the Examiner’s consideration of Lesniak.

Petitioner fails to overcome this hurdle. Petitioner argues that the Examiner only “recognized the applicability of Lesniak” *after* the ’647 patent issued, during prosecution of U.S. Application No. 17/961,089 (“the ’089 application”). (Petition at 22.) This is pure speculation. What is *not* speculative or contested is the fact that the Examiner reviewed Lesniak during prosecution of the ’647 patent, and intentionally chose not to issue a rejection over it because Lesniak is about sunscreen

(and also diaper cream), *not deodorant*. (See Ex. 2001 at 443 (“The claims are distinguishable from Lesniak... because *Lesniak* is directed towards a sunscreen composition that requires the presence of the sunscreen agent Zinc Oxide, whereas the instant claims are drawn to a solid deodorant composition that require the presence of an antimicrobial agent.”); see also Ex. 1003 at cl. 1 (“What is claimed is...[a]n anhydrous personal care composition selected from a sunscreen or a diaper cream...”); 4:25–26 (“Optionally, the composition is a sunscreen or a diaper cream.”); 8:64–65 (“The composition can be a sunscreen or a diaper cream.”); 10:31 (same); Tables 2–4, 6 (describing sunscreen compositions); Table 5 (describing diaper creams); 14:3–6 (“Various diaper creams were also formulated.”); cl. 12 (“The composition of claim 1, wherein the composition is a sunscreen.”); cl. 14 (“The composition of claim 1, wherein the composition is a diaper cream.”); cl. 19 (“A method of reducing the risk of sun damage to the skin . . .”).

Because the prior art and arguments raised in Grounds 1–4 of the Petition are heavily reliant on the “same” or “substantially similar” references to what the Office already considered, the first part of the *Advanced Bionics* framework is satisfied.

2. *Step 2: Petitioner Fails to Show Any Material Error by the Examiner*

Petitioner has also failed to meet its burden of showing any error by the Office that is material to patentability, as demonstrated by *Becton, Dickinson* factors (c), (e), and (f) (part 2 of *Advanced Bionics*). See *Advanced Bionics*, IPR2019-01469,

Paper 6 at 8 (“If the same or substantially the same prior art or arguments previously were presented to the Office, then the Board’s decisions generally have required a showing that the Office erred in evaluating the art or arguments.”). The Petition provides only superficial statements that Lesniak was “not applied by the examiner in the rejection of any claims” and that Lesniak “was subsequently applied by the same examiner in prosecution of a later application in the family in a manner consistent with the application in this Petition.” (Petition at 6–7.) Thus, the only “error” Petitioner claims is that Lesniak was not applied by the Examiner in the way they would have preferred. This is not enough.

The Petition presents the same art that was already distinguished by the Examiner and then fails to show what the Examiner should have done differently. 35 U.S.C. § 325(d) thus counsels against institution of Grounds 1–4 of the Petition.

B. The Petition Fails to Adequately Explain Why a POSA Would Have Been Motivated to Combine Lesniak with Bianchi ’518, Phinney, and Nabavi in Grounds 2–4

Additionally, Petitioner fails to meet its burden to demonstrate why a POSA would have been motivated to combine (1) Lesniak with Bianchi ’518 in Ground 2; (2) Lesniak with both Bianchi ’518 and Phinney in Ground 3; and (3) Lesniak with Bianchi ’518, Phinney, and Nabavi in Ground 4. “In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir.

2016); *see also Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330 (Fed. Cir. 2019). As part of this burden, when an obviousness ground in a petition asserts a combination of identified prior art, Petitioner “must demonstrate that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.” *Netflix, Inc. v. DivX, LLC*, No. 2022-1083, 2023 WL 2298768 (Fed. Cir. Mar. 1, 2023).

In Ground 2 challenging claims 1, 4–7, 9–12, and 18–19, Petitioner relies on Lesniak as the primary reference, arguing Lesniak discloses and/or suggests all but one of the limitations of independent claims 1 and 18, and then adds Bianchi ’518 because Lesniak “does not expressly teach hardness as measured by penetration with an ASTM-D 1321 needle.” (Petition at 30.) In Ground 3 challenging claim 2, Petitioner relies on the Lesniak–Bianchi combination for the independent claims, and adds Phinney because Lesniak “does not expressly teach the use of magnesium hydroxide,” as required by claim 2. (*Id.* at 37.) And in Ground 4 challenging claims 3 and 13, Petitioner further combines Lesniak, Bianchi ’518, and Phinney with Nabavi, arguing Lesniak does not teach “deodorant stick compositions containing at least one additional antimicrobial,” as required by those dependent claims. (*Id.* at 41.)

Petitioner only devotes a few paragraphs each to supporting its combinations, providing no real explanation of (1) what would have motivated the POSA to look to each reference, (2) how a POSA would have implemented the changes to Lesniak's hardness and antimicrobial properties, and (3) how these changes would have affected the other properties of Lesniak that Petitioner relies on to meet other claimed limitations. *See InTouch Techs., Inc. v. VGO Commc'ns., Inc.*, 751 F.3d 1327, 1351 (Fed. Cir. 2014) ("A reason for combining disparate prior art references is a critical component of an obviousness analysis; 'this analysis should be made explicit.'") (quoting *KSR v. Teleflex*, 550 U.S. 398, 418 (2007)); *TQ Delta, LLC v. CISCO Systems, Inc.*, 942 F.3d 1352, 1361–62 (Fed. Cir. 2019) (warning against use of patent "as a roadmap to reconstruct the claimed invention using disparate elements from the prior art"); *ActiveVideo Networks, Inc. v. Verizon Commc'ns Inc.*, 694 F.3d 1312, 1328 (Fed. Cir. 2012) (challenger "fail[ed] to explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed invention does.*")

In reality, a POSA would not have been motivated to combine Lesniak with any of these references. For example, as discussed above, Lesniak is actually directed to sunscreen and diaper creams, *not deodorant sticks*. (See Ex. 1003 at 4:25–26, 8:64–65, 10:31, 14:3–6; Tables 2–6; cls. 1, 12, 14, 19.) Lesniak does not

describe any deodorant compositions, and only mentions antiperspirants in passing, without connection to the subject matter of the reference.

Moreover, regarding Ground 2, a POSA would not have had a reasonable expectation of success in its attempts to implement Bianchi '518's hardness range in Lesniak's formulas for sunscreen and diaper cream. Petitioner claims "Bianchi '518 explains that a hardness from about 7.0 mm to about 14.0 mm ... was 'typical' for stick compositions, and that products falling outside that hardness range typically generated low consumer acceptance ratings" (Petition at 31.) But Bianchi '518 simply states that "[t]ypical compositions *of the invention* will range in hardness from about 7.0 to about 14.0 mm as shown by the above mentioned needle penetration test." (Ex. 1006 at 6:25–29.) Contrary to Petitioner's assertion, Bianchi '518 does not disclose or otherwise suggest that it is typical for any and all antiperspirant compositions in existence, regardless of the type and amount of ingredients used, to have a hardness within that range. Rather, Bianchi '518 expressly ties its hardness disclosure to the specific inventive compositions described in the reference. (*Id.*) And as Bianchi '518 makes clear, its antiperspirant formulations contain aluminum or mixed aluminum salts—an ingredient all claims of the '647 patent expressly forbid.

Indeed, Bianchi '518 discloses Compositions A–R, with their ingredients expressed in weight percentages in the tables below. As highlighted, each of Bianchi '518's compositions contain one or more aluminum or mixed aluminum salt:

Ingredient	A	B	C	D	E	F	G	H
Cyclomethicone DC245	40.3	38.0	37	41.32	41.57	36.49	39	36
Phenyl Trimethicone DC556			4			2.0		2
Paraffin wax SF1642	16.92	9.25	18	16.05	16.05	9.37	17	12.08
Silicone wax		7.75		1		3.22		
Castorwax	6.85	10.0	3	5.98	5.98	10.13	7	10.98
PEG-8 Distearate	2.85			4.5	4.2	4.63		4.94
Hydrogenated Vegetable oil							1	
Finsolv TN	1.55				1		2	
PPG-14 Butyl ether	10.03	12.5	12.5	10.4	10.4	12.66	10	12.5
AZG-370	20.00	22.0	22.0	20.0	20	20	22	20
Talc			1.5					
Fragrance	1.50	0.5	2.0	0.75	0.8	1.5	2	1.5

Ingredient	I	J	K	L	M	N
Cyclomethicone DC245	41.05	41.32	38.85	36.8	39.10	37.07
Paraffin wax	16.92	16.05	16.01	16.92	15.19	16.05
Castorwax	6.85	5.98	6.48	6.85	5.66	5.98
PPG-14 Butyl ether	10.03	10.40	9.49	10.03	9.84	10.40
Finsolv TN	1.55	—	1.47	1.55	—	—
PEG-8 Distearate	2.85	4.50	2.70	2.85	4.26	4.50
SF 1642	—	1.00	—	—	0.95	1.00
AZG-370	20.00	20.0	—	—	—	—
Q 5-7167	—	—	24.00	24.00	24.00	24.00
Fragrance	0.75	0.75	1.00	1.00	1.00	1.00

Ingredient	S	T	U
CYCLOMETHICONE DC 245	34.8	37.8	36.7
PHENYL TRIMETHICONE DC556	—	—	—
Paraffin wax	8.5	9.25	9.05
SF 1642 Silicone Wax	1.5	1.5	1
Castor wax	10.5	6.85	8
PEG-8 Distearate	5.5	9.25	5
Hydrogenated Vegetable Oil	—	—	—
Finsolv TN	—	—	—
PPG-14 Butyl Ether	18.5	16	16.5
AZG-370	20	20	—
W ZR3OB DM CP5**	—	—	23
Talc	—	—	—
Fragrance	0.7	0.7	0.75

**Aluminum Zirconium Trichlorohydrate-Gly

(*Id.* at 5:15-6:14; *see also id.* at 3:45-67 (explaining that “AZG” antiperspirant compounds are “complexes of aluminum, zirconium, and amino acids such as glycine”); Ex. 2007 at 1:17-18 (noting “AZG” is an abbreviation for “aluminum zirconium glycine salts”); *id.* at 7:15 (explaining “Q5-7167” is an aluminum zirconium glycine salt), 9:18-21 (listing “Q5-7167” as “Aluminum Zirconium Tetrachlorohydrex”).

The Petition is silent on Bianchi ’518’s use of aluminum salts in its compositions, and it does not explain how (or whether) an aluminum-free composition, Lesniak or otherwise, could achieve the hardness result of the aluminum-containing Bianchi ’518 compositions. The Petition fails to explain which parameters in Lesniak’s formula the POSA would have been motivated to change in order to achieve the hardness Bianchi ’518 desires, nor does it address how changes to hardness would have affected the other properties of Lesniak that Petitioner relies on to meet other claimed limitations. For example, Petitioner does not explain how the formulation would remain aluminum-free, nor how the modification to incorporate Bianchi ’518’s hardness affects the specific weight percentages required by the ’647 patent’s claims. *ActiveVideo*, 694 F.3d at 1328 (challenger “fail[ed] to explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed invention does.*”) Thus, the Petition fails to articulate a rational motivation to combine for Ground 2.

As for Ground 3, Petitioner’s rationale for combining or substituting Lesniak’s zinc oxide with Phinney’s magnesium hydroxide is similarly weak. According to the Petition, “[b]ecause Lesniak teaches using zinc oxide (a known antimicrobial) and Phinney teaches that using magnesium hydroxide in combination with zinc oxide improves antimicrobial properties, a POSA would have had a reason to follow Phinney’s teaching and add magnesium hydroxide to Lesniak’s composition” and “would have been motivated to incorporate known improvements to odor protection, particularly where the known improvement also was known to maintain the ‘natural’ composition intended by Lesniak.” (Petition at 38.)

But Lesniak and Phinney describe entirely different uses for their metal oxides/hydroxides, and a POSA would not have had reason to look to combine their teachings on this topic. Lesniak’s zinc oxide is included in its sunscreen and diaper cream products as a protective barrier—*i.e.*, to protect the skin from sun and other irritants, and in the case of the diaper cream, to help prevent diaper rash—not as any sort of antiperspirant or deodorant antimicrobial. (*See, e.g.* Ex. 1003 at cl. 13 (“[W]herein the composition comprises *a sun-protective level* of zinc oxide particles”) (emphasis added); *see also* Ex. 2003 (“Zinc oxide topical cream is used to treat and prevent diaper rash. It is also used to protect skin from being irritated and wet caused by diaper use.”); Ex. 2004.) The Examiner recognized this during prosecution of the ’647 patent when she distinguished Lesniak on the basis of its

sunscreen disclosure. (*See* Ex. 2001 at 443.) Lesniak does not discuss odor protection at all, let alone describe the use of zinc oxide for odor protection. Thus, the Petition fails to adequately explain why a POSA would have looked to Phinney to modify Lesniak.

Further, Lesniak notes that metal oxides, like zinc oxide, “can leave a white residue on the skin following application” that consumers may find “undesirable.” (Ex. 1003 at 1:25–29, 5:14–16.) Thus, Lesniak discloses compositions with optimized amounts of zinc oxide to reduce this undesirable “whitening” effect. (*See* Ex. 1003 at 1:25-35, 3:39-4:21, cl. 1(e).) Petitioner’s Ground 3 combination ignores these warnings from Lesniak, and does nothing to explain why a POSA would have been motivated to modify the already-optimized zinc oxide parameters of Lesniak to introduce Phinney’s magnesium hydroxide.

Finally, with respect to Ground 4, Petitioner argues “[w]hile Lesniak teaches deodorant stick compositions that may contain zinc oxide (a known antimicrobial), it does not expressly teach deodorant stick compositions containing at least one additional antimicrobial.” (Petition at 41.) Petitioner first claims “it would be obvious to use magnesium hydroxide as an additional antimicrobial in Lesniak’s deodorants,” but for the reasons discussed with respect to Phinney and Ground 3, this rationale fails. In the alternative, Petitioner adds Nabavi for this element, arguing “it would have been obvious to include another antimicrobial such as the

cinnamon essential oil taught by Nabavi for both its aromatic and antibacterial effects.” (*Id.* at 41.) But Petitioner’s reason for combining Lesniak and Nabavi is attenuated at best, particularly because Nabavi never teaches the use of cinnamon as an antimicrobial in deodorants or even antiperspirants. The Ground 4 combination also suffers from the same issues as above regarding Petitioner’s failure to show a motivation to combine Lesniak with Bianchi ’518 and Phinney.

* * *

In sum, Petitioner’s alleged anticipatory reference, Lesniak, was already expressly distinguished by the Examiner during prosecution. And the Petition fails to explain why or how a POSA would have implemented Bianchi ’581’s hardness disclosure to Lesniak, especially given that Bianchi ’581 discloses numerous different ingredients and does not specifically attribute its hardness to a particular component. The Petition also fails to explain why a POSA would be motivated to add or replace the use of zinc oxide in Lesniak’s diaper cream/sunscreen composition with Phinney’s magnesium hydroxide, or Nabavi’s cinnamon essential oil, for odor protection. Institution of Grounds 1–4 should be denied for all of these reasons.

V. THE BOARD SHOULD DECLINE TO INSTITUTE ON GROUNDS 5 AND 6 BECAUSE PETITIONER FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD IT WILL PREVAIL ON THE MERITS

A. The Petition Fails to Adequately Explain Why a POSA Would Have Been Motivated to Combine Native and Bianchi ’254

Like the combinations above, Petitioner similarly fails to meet its burden to demonstrate why a POSA would have been motivated to combine the Native publication with Bianchi '254 in Grounds 5 and 6.

In its Ground 5 challenge to claims 16–17, Petitioner relies on Native as the primary reference, but notes that Native does not expressly teach the percentage of liquid triglyceride required by independent claim 16. (Petition at 47.) In Ground 6 challenging claims 1–2, 4–7, 9–12, 14–15, and 18–19, Petitioner again uses Native as the primary reference, but admits that Native “does not disclose the hardness of the deodorant stick.” (*Id.* at 54.) To fill these missing elements, the Petition adds Bianchi '254, arguing Bianchi '254 discloses the claimed percentages of liquid triglyceride and also allegedly “establish[es] the claimed hardness range was standard.” (*Id.* at 47, 54.) But Petitioner fails to meet its burden to show why a POSA would have been motivated to combine Bianchi '254 with Lesniak in the first place.

The Petition argues with respect to the composition requirements in Ground 5 that Native “does not expressly teach the percentage of each ingredient used, including the percentage of liquid triglyceride (i.e., carrier oil).” (*Id.* at 47.) According to Petitioner, “[i]n the absence of express teachings on these points, a POSA would have looked to other publications in the field with suitable weight percentage examples.” (*Id.* at 47.)

But a POSA seeking to develop a *natural* deodorant stick would not have been motivated to look to Bianchi '254, which describes and claims antiperspirant sticks that *contain aluminum*. Indeed, highlighted in the Tables below, the antiperspirant formulations touted as the invention in Bianchi '254 all include aluminum or mixed aluminum salts:

TABLE 1											
<u>Antiperspirant Formulations</u>											
COMPONENT (wt. %)	FORMULATION NO.										
	1	2	3	4	5	6	7	8	9	10	11
Castor Wax (mp 80° C.)	3.5	4	3.5	3.5	3.5	3.5	3.5	3.5	3.5	4	4
Stearyl Alcohol (mp 60°)	18	18	20	18	18	18	18	18	18	18	18
Polyethylene (400 mw; mp 82–84° C.)	0.3	0.5	0.5	0.5	0.5	1	1	1	1	1	1
Silica	0.3			0.3	0.3			0.5	0.5	0.75	1
PPG-14 Butyl Ether	20	5	5	20	20	9.5	15	15	25	31.25	8
C12–C15 Alkyl Benzoate (Finsolv TN)	5	20	18	5	5	15	23.5	23	13	8	31
Dimethicone, 50 cst; (Dow Corning 200)	1	1	1	1	1	1	1	1	1	1	1
Sunflower Oil	0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5
Total				3.5	2						3.5
AAZG (17.8%)	24	20	20	20	20	20	24	24	24	24	24
Fragrance	1	1	1	1	1	1	1	1	1	1	1
BHT (butylated hydroxytoluene)	0.05	0.05	0.05	0.05	0.05	0.05	0.05	0.05	0.05	0.05	0.05
Cyclomethicone; (Silicone 245; Dow Corning)	26.35	29.95	30.45	26.65	28.15	30.45	12.45	12.45	12.45	10.45	7.95

TABLE 5									
<u>Antiperspirant Stick Formulations</u>									
COMPONENT (wt. %)	FORMULATION NO.								
	12	13	14	15	16	17	18	19	
Castor Wax (mp 80° C.)	3.5	3.5	3.5	3.5	3.5	3.5	3.5	3.5	
Stearyl Alcohol (mp 60°)	18	18	18	18	18	18	18	18	
Polyethylene (400 mw; mp 82–84° C.)	1	1	1	1	1	1	1	1	
Stearth 100	0.5	0.5	0.5	0.5	—	—	—	0.5	
PPG-14 Butyl Ether	9.5	9.5	9.5	9.5	9.5	9.5	9.5	9.5	
C12–C15 Alkyl Benzoate (Finsolv TN)	15	15	15	15	15	15	15	15	
Dimethicone, 50 cst (Dow Corning 200)	1	1	1	1	1	1	1	1	
Sunflower Oil	0.5	0.5	0.5	0.5	0.5	0.5	0.5	0.5	
AAZG (17.8%)	20	20	20	20	30	24	20	24	
Fragrance	1.25	1.25	1.25	1.25	1	1	1.25	1	
Fragrance Encapsulate							1.5	1.5	
BHT (butylated hydroxytoluene)	0.05	0.05	0.05	0.05	0.05	0.05	0.05	0.05	
Cyclomethicone (Silicone 245; Dow Corning)	28.7	27.7	28.2	29.7	20.45	26.45	28.2	24.95	
Cyclodextrin	1	2	1.5						

(Ex. 1008 at Tables 1, 5; *see also id.* at [0033] (defining AAZG as “an aluminum zirconium tetrachlorohydrate complex with glycine”).

The Petition is silent as to Bianchi '254's inclusion of aluminum and completely ignores the fact that Bianchi '254 does *not* teach natural, aluminum-free deodorant sticks. This is notable because Petitioner's sole reason for combining Native and Bianchi '254 hinges on formulating natural deodorants: “*When formulating a natural, aluminum-free deodorant stick based on the composition in Native, a POSA would have looked at publications describing other stick compositions, like Bianchi '254, for information regarding amount of ingredients.*” (Petition at 47.) But Bianchi '254 is not a “natural, aluminum-free deodorant stick,” and Petitioner does nothing to reconcile this with its supposed motivation to combine. The Petition does not explain what would have motivated a POSA to implement the weight-percentages from a non-natural antiperspirant stick into the natural, aluminum-free stick of Native (if it is even possible). Nor does the Petition explain what a POSA would have substituted for aluminum in order to preserve the same weight-percentages without the presence of the mixed aluminum salt—an ingredient prohibited by the claims of the '647 patent.

With respect to the hardness limitation in Ground 6, the Petition fails to show a POSA would have had a reasonable expectation of success in its attempts to implement Bianchi '254's hardness range in Native's formula. Indeed, Petitioner

and its expert fail to explain which parameters in Native’s formula the POSA would have been motivated to change in order to achieve the hardness of Bianchi ’254’s compositions, nor does it address how changes to hardness would have affected the other properties of Native that Petitioner relies on to meet other claimed limitations (*e.g.*, how it remains aluminum-free, how it affects the weight percentages in the claims, and similar). (Petition at 55–56.)

In sum, Petitioner fails to meet its burden to show a POSA would have been motivated to combine the aluminum-free Native with the aluminum-containing Bianchi ’254. As such, Grounds 5 and 6 should not be instituted.

B. The Petition Fails to Adequately Explain Why a POSA Would Have Been Motivated to Combine Native and Bianchi ’254 With Easy Homemade

Also in Ground 6, Petitioner argues the POSA would have been motivated to further combine Native and Bianchi ’254 with the Easy Homemade blog post, as “neither Native nor Bianchi ’254 expressly teach a deodorant stick composition wherein the antimicrobial is a powder with a water solubility of at most about 50 g/L at 25°C,” as required by the claims. (Petition at 55.) Petitioner insists it would have been obvious to add the teachings of Easy Homemade to the Native-Bianchi combination, because “[w]hile Native teaches a deodorant stick composition comprising an antimicrobial (baking soda), ... a POSA would have known that deodorants containing baking soda could cause skin irritation for some users.” (*Id.*)

Accordingly, the Petition claims “[a] POSA would have looked to publications in the field of deodorants describing known and, preferably, natural antimicrobials that were effective and which were not known to cause skin irritation,” like the Easy Homemade hobbyist website, which allegedly “explains that magnesium hydroxide could be used to replace baking soda as an antimicrobial in deodorant compositions, and it works just as well.” (*Id.* at 55–56.)

But Petitioner fails to show why a POSA would have been motivated to look at this hobbyist’s homemade soap blog in the first place,² or why a POSA would have found it necessary to modify the already-successful Native product. Petitioner claims baking soda can be a skin irritant, but the Native webpage also shows that its formulation includes shea butter and coconut oil, both of which have anti-inflammatory and healing properties for skin. (Ex. 1007 at 15.) Moreover, the Native site contains glowing reviews from its users, none of which discuss experiencing any skin irritation. (*Id.* at 17.) And as Petitioner admits, Native was “a known leader in the field” and was “internet fam[ous].” (Petition at 46.) Thus,

² Petitioner’s expert Dr. Michniak-Kohn describes that the Easy Homemade blog was “part of a series . . . with significant engagement from individuals globally.” (Ex. 1002 at ¶ 143.) Dr. Michniak-Kohn does not support this statement, and does not describe whether a POSA—as opposed to a hobbyist—would look for, and find, this specific blog when developing formulations.

Petitioner fails to show any issue with the Native formula that would have motivated a POSA to modify it. Rather than a motivation to combine, Petitioner offers only hindsight based on a “roadmap” of the ’647 patent’s successful formula. *See TQ Delta*, 942 F.3d at 1361 (cautioning against “allowing the challenger to use the challenged patent as a roadmap to reconstruct the claimed invention using disparate elements from the prior art—i.e., the impermissible *ex post* reasoning and hindsight bias that *KSR* warned against.”) Ground 6 should not be instituted for this additional reason.

VI. CONCLUSION

For the reasons set forth above, the Board should decline to institute *inter partes* review of the ’647 patent.

Respectfully submitted,

Date: October 30, 2024

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CERTIFICATE OF WORD COUNT

Pursuant to Rule 37 C.F.R. 42.24(d), the undersigned hereby certifies that, based upon the word count of the word-processing system used to prepare this Preliminary Response, the number of words in this Preliminary Response is 7,167.

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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 October 30, 2024, at the following address:

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