

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 IPR2024-01498

U.S. Patent No. 11,844,752

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

Exhibit No.	Description
Ex. 2001	File History of the '752 Patent (excluding copies of Foreign References)
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	U.S. Patent No. 10,966,915
Ex. 2006	U.S. Patent No. 10,543,164
Ex. 2007	International Publ. No. WO 99/21528
Ex. 2008	Notice of Allowance of '647 Patent

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. The modern consumer demanded “natural, aluminum-free deodorant offerings” that were “mostly free of silicones” and also exhibit “good glide, non-sticky, and non-greasy application.” (Ex. 1001 at 1:10–13.) This was a challenge because natural oils were typically used to replace silicones, but those natural oils often lead to undesirably hard, and undesirably greasy, deodorant sticks. (*Id.* at 1:14–16.)

P&G carefully developed its aluminum-free deodorant formulations to achieve the ideal hardness, ingredient composition, and grease-free application. It sought and received numerous patents for these novel aluminum-free deodorant inventions, including U.S. Patent No. 11,844,752 (“the ’752 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 multi-reference combinations that have clear failings both procedurally and on the merits. Procedurally, Petitioner’s principal references were of record during prosecution of the ’752 patent. Petitioner does not explain why those grounds are anything other than a request for a reconsideration of the Examiner’s proper decision to allow the ’752 patent. And Petitioner offers only a

single paragraph arguing that its challenge is not cumulative to matters explicitly considered by the Examiner.

On substance, Petitioner fails to explain why a person of ordinary skill in the art (“POSA”) would be motivated to cobble together its combinations beyond the use of the ’752 patent claims as a roadmap. The Petition offers only weak argument consisting of conclusory statements and impermissible hindsight to justify its obviousness grounds. Moreover, Petitioner falls short of its burden to show its combinations meet key elements of the independent claims.

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 ’752 PATENT

A. The Claimed Invention

The ’752 patent describes and claims “deodorant compositions and methods relating thereto.” (Ex. 1001 at 1:5–6.) The patent teaches that consumers “are seeking more natural, aluminum-free deodorant offerings, often mostly free of silicones” and “also want a good glide, non-sticky, and non-greasy application.” (*Id.* at 1:10–13.) “This is a challenge, because a mostly silicone-free formula will often use natural oils or natural oil-based triglycerides... [that] bring a large portion of wax with them, often making the resulting deodorant sticks too hard to meet a more preferable product application for both shaven and unshaven underarms.” (*Id.* at

1:13–20.) These too-hard deodorant sticks were also “undesirably greasy due to the non-volatile nature” of natural oils. (*Id.* at 1:20–21.) Thus, the ’752 patent addresses the “challenge to formulate an aluminum-free, mostly silicone-free deodorant stick that is not too hard.” (*Id.* at 1:22–24.)

The ’752 patent notes the shortcomings of formulations available at the time with natural ingredients, including those that use emollients like liquid triglyceride paired with “a number of waxes and other structurants.” Often those formulations “lead to deodorant sticks that are very hard.” (*Id.* at 2:59–2:61.) To illustrate, the specification provides two comparative formulas of products: Comparative Formula 1 “has 34.15% liquid triglyceride, along with a number of structurants, resulting in a very hard stick” that “does not necessarily provide a good consumer experience when used”; Comparative Formula 2 used even higher amounts of structurants, “resulting in a harder stick with an even lower hardness score.” (*Id.* at 2:62–3:4.)

By contrast, the inventive deodorant examples of the ’752 patent were able to balance the use of “consumer-preferred natural ingredients” while maintaining “higher hardness scores, meaning they are softer products.” (*Id.* at 3:4–7.) The ’752 patent explains “[t]he present inventors have discovered that a deodorant stick having at least about 25% of a liquid triglyceride, and that uses a primary structurant that has a melting point of at least about 50° C..., while limiting the amount of secondary structurants having a melting point of at least about 60° C. to 8% or less,

can result in a deodorant stick with a hardness from about 80 mm*10 to about 140 mm*10.” (*Id.* at 3:40–48.) The formulas described and claimed in the ’752 patent are thus “able to comprise consumer-perceived natural ingredients, while offering a pleasant consumer experience in terms of its hardness.” (*Id.* at 3:49–51.)

For example, independent claim 1 recites an aluminum-free deodorant stick with certain composition requirements:

1. A deodorant stick, comprising:
 - a. at least one antimicrobial; and
 - b. a structurant that is stearyl alcohol;said stick being free of an aluminum salt; and

said stick having a hardness from about 80 mm*10 to about 140 mm*10, as measured by penetration with ASTM D-1321 needle;

wherein the deodorant stick is anhydrous and is substantially free of silicones.

Starting with limitation (a), the ’752 patent explains “[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, deodorant antimicrobials are needed that will be effective for long periods of time.” (*Id.* at 7:18–22.) Moreover, the inventors of the ’752 patent “discovered that the water solubilities of certain components,” like the antimicrobial(s) used,” “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 7:44–46, 60–65.) The ’752 patent thus describes and claims a deodorant stick comprising “at least one antimicrobial” in claim 1, with the specification, dependent claims, and other independent claims reciting different antimicrobial options, including magnesium hydroxide. (*See, e.g., id.* at cls. 14–15, 18–19.)

Also recited in claim 1 is “a structurant that is stearyl alcohol,” and the other independent claims similarly recite deodorant sticks comprising “stearyl alcohol.” (*Id.* at cls. 1, 15, 18–19.) The ’752 patent defines a “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 4:57–61.) As the ’752 patent explains, “[t]he deodorant compositions of the present invention comprise a suitable concentration of structurants 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 3:53–58.) In embodiments, the primary structurant—which the specification defines as “the structurant that is present in the composition in the greatest amount”—comprises “about 5% to about 20%, in some cases 7-17% of the deodorant stick,” while secondary structurants “may comprise about 12% or less, or about 8% or less of the deodorant stick.” (*Id.* at 3:63–65, 4:4–7.)

Each deodorant stick claimed in the '752 patent also has a “hardness from about 80 mm*10 to about 140 mm*10, as measured by penetration with ASTM D-1321 needle.” (*Id.* at cls. 1, 15, 18–19.) The specification 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 11:30–33.) As the '752 patent explains, the hardness of the deodorant sticks is important, as sticks that are too hard do not provide a consumer-preferred product application. (*Id.* at 1:17–21, 2:60–3:7.)

B. The Prosecution History

The '752 patent was filed as Application No. 17/979,822 on November 3, 2022, claiming priority to Provisional Application No. 62/647,104, filed on March 23, 2018, and to Provisional Application No. 62/527,180, filed on June 30, 2017.

On March 30, 2023, the Examiner rejected some of the proposed claims as obvious over a combination of two references, and additionally rejected all claims for non-statutory double patenting over other P&G patents. (Ex. 2001 at 120–21.) In response, Applicant amended the claims and filed a terminal disclaimer over the related patents. (*Id.* at 136–40.) The Examiner issued a Notice of Allowance on July 5, 2023. (*Id.* at 193.) Thereafter, Applicant submitted an additional Information Disclosure Statement and claim amendment. (*Id.* at 223.) The Examiner considered

the additional references and issued a second Notice of Allowance on October 27, 2023. (*Id.* at 237.)

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 16.) 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, another Lesniak reference that was of record during prosecution of the ’752 patent. (*See* Ex. 1001; Petition at 6.)

B. 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.) 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.

C. 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, published as U.S. Pat. App. Publ. No. 2014/0271517, 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.) The U.S. Patent Publication of Phinney (U.S. 2014/0271517) was of record during prosecution of the ’999 patent. (*See* Ex. 1001; Petition at 6.)

D. Anconi

U.S. Patent Pub. No. 2016/0089321 (“Anconi”) was published on March 31, 2016. It describes and claims antiperspirant compositions comprising zinc salts. (Ex. 1057.)

E. 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.)

F. 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.

G. Millet

U.S. Application No. 15/575,590, filed on May 10, 2016, and later published as U.S. Pub. No. 2018/0168954 ("Millet") is entitled "ANHYDROUS DEODORANT COMPOSITION MADE FROM BICARBONATE." (Ex. 1044.) It describes a deodorant composition "based on bicarbonate salt." (*Id.* at [0001].)

H. Stoia

Petitioner's Exhibit 1058 is a report titled "Selected Evidence-Based Health Benefits of Topically Applied Sunflower Oil," which purports to "summarize the outcomes of *in vivo* and *in vitro* studies relating to cosmeceutical and phytopharmaceutical potency of sunflower seed oil based on the epidemiological evidence published" prior to 2015. (Ex. 1058 at Abstract.)

I. Sturgis

U.S. Pub. No. 2019/0000734 ("Sturgis") was filed on June 28, 2018, and published on January 3, 2019. (Ex. 1056.) Sturgis later issued as U.S. Patent No. 10,905,647.

J. Squatch

Petitioner's Squatch reference (Ex. 1059) is an employee declaration purporting to include images from the <https://drsquatch.com> website in 2020.

IV. GROUNDS 1–4 SHOULD BE DENIED BECAUSE PETITIONER'S COMBINATIONS LACK A RATIONAL MOTIVATION TO COMBINE AND ARE MISSING KEY CLAIM ELEMENTS

A. The Petition Fails to Adequately Explain Why a POSA Would Have Been Motivated to Combine Lesniak and Bianchi '254 in Grounds 1–4

Petitioner fails to meet its burden to demonstrate why a POSA would have been motivated to combine Lesniak and Bianchi '254—a combination Petitioner relies on to challenge the claims in each of Grounds 1–4. “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, the 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).

Each independent claim of the '752 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.” (Ex. 1001 at cls. 1, 15, 18–19.) Petitioner relies on Lesniak as its primary reference, but concedes that Lesniak “does not expressly disclose using stearyl alcohol as a structurant,” nor does it “expressly teach hardness as measured by penetration with an ASTM-D 1321 needle.” (Petition at 17.) Petitioner adds Bianchi ’254 for these elements, erroneously claiming Bianchi ’254 “establishes that the claimed hardness range was standard.” (*Id.*)

Petitioner only devotes a few paragraphs to supporting its combination, providing no real explanation of (1) what would have motivated the POSA to look to the Bianchi ’254 reference, (2) how a POSA would have implemented the changes to Lesniak’s hardness property, or (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.*")

A POSA would not have been motivated to combine Lesniak with Bianchi '254. For example, Lesniak is actually about sunscreen and diaper cream, *not deodorant*. (See 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"). Lesniak does not describe any deodorant compositions, and only mentions antiperspirants in passing, without connection to the subject matter of the patent.

Moreover, for the reasons explained in more detail below with respect to Bianchi '254's shortfalls on the merits, a POSA would not have had a reasonable expectation of success in attempting to implement Bianchi '254's hardness range in Lesniak's formulas for sunscreen and diaper cream. Indeed, the Petition fails to explain which parameters in Lesniak's formula the POSA supposedly would have

been motivated to change in order to achieve the hardness Bianchi '254 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 to achieve Bianchi '254's alleged hardness while ensuring Lesniak's composition remains aluminum-free—another requirement of each independent claim. Indeed, each of the compositions of Bianchi '254 contain aluminum or mixed aluminum salts. (*See* Section IV.C *supra*.) Petitioner also fails to explain whether a POSA would have been able to implement Bianchi '254's hardness in Lesniak while maintaining that the composition is “substantially free of silicones,” as required by claim 1, since each of Bianchi '254's formulations contain silicone. (*See* Ex. 1008 at Tables 1, 5.)

In sum, the Petition does not explain why (or how) a POSA would have added Bianchi '254's hardness disclosure to Lesniak, especially given that Bianchi '254 discloses numerous different ingredients and does not specifically attribute its hardness to a particular component. These deficiencies apply to all claims challenged in Grounds 1–4, and thus, those grounds all should be denied.

B. The Petition Also Fails to Adequately Explain Why a POSA Would Have Been Motivated to Combine Lesniak with Phinney in Grounds 2–4

Petitioner contends the combination of Lesniak and Phinney in Grounds 2–4 allegedly render obvious deodorant compositions containing the antimicrobial

magnesium hydroxide. (Petition at 26–29, 33, 35.) Petitioner admits that Lesniak does not teach deodorant compositions containing magnesium hydroxide, but insists the “POSA would have found it obvious to add magnesium hydroxide to the composition of Lesniak, as taught by Phinney.” (*Id.* at 27.) According to the Petition, “Lesniak teaches using zinc oxide (a known antimicrobial) and Phinney teaches that using magnesium hydroxide in combination with zinc oxide improves antimicrobial properties,” thus, “a POSA would have had a reason to follow Phinney’s teaching and add magnesium hydroxide to Lesniak’s composition.” (*Id.*) But a POSA would not have been motivated to combine Lesniak and Phinney for the reasons below.

First, Lesniak and Phinney describe entirely different uses for their metal oxides/hydroxides, meaning that a POSA would not have looked 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. (*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.) 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.

Second, 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 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.

Thus, like its failing with respect to a motivation to combine Lesniak with Bianchi ’254 in Grounds 1–4, Petitioner does not articulate a rational motivation to combine Lesniak with Phinney in Grounds 2–4. Those grounds should be denied for this additional, independent reason.

C. The Petition Fails to Show How the Combination of Lesniak and Bianchi ’254 Meets the Hardness Limitation of All Challenged Claims in Grounds 1–4

As previewed above in Section IV.A, Petitioner also fails to explain how its combination of Lesniak and Bianchi ’254 would achieve the ’752 patent’s hardness limitation. Each independent claim of the ’752 patent recites a hardness “from about

80 mm*10 to about 140 mm*10, as measured by penetration with ASTM D-1321 needle.” (Ex. 1001 at cls. 1, 15, 18–19.)

Petitioner uses Bianchi '254 to allegedly meet this limitation, claiming the reference “describes antiperspirant sticks having, e.g., ‘hardness values of from 8 to 15 mm, preferably 8 to 10 mm, measured pursuant to’ a test with a DIN 51-579 needle... which the '752 Patent admits is an ASTM-D 1321 needle....” (Petition at 18.) But Bianchi '254 ties this alleged hardness disclosure to “[t]he antiperspirant stick compositions contemplated [t]herein,” and limits the hardness value to the specific “embodiment[s] of interest” taught in Bianchi '254. (*See* Ex. 1008 at [0026].) This is notable because each of the antiperspirant formulations disclosed as the invention in Bianchi '254 contain aluminum or mixed aluminum salts—an ingredient all claims of the '752 patent expressly forbid.

Indeed, Bianchi '254 teaches Formulation Nos. 1–19, with their ingredients expressed in weight percentages in the tables below. As highlighted, each of Bianchi '254’s formulations contain one or more aluminum or mixed aluminum salt:

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
Talc				3.5	2						2.5
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	
Steareth 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 on Bianchi '254's use of aluminum salts in its formulations, 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 '254 antiperspirant compositions. This is a fatal flaw. Neither Bianchi '254 nor the Petition explains how to achieve the desired hardness while simultaneously maintaining the '752 patent's aluminum-free requirement.

Petitioner also does not explain how a POSA could achieve the desired hardness given other formulation differences between Bianchi '254 and Lesniak—including in view of the other claim limitations of the '752 patent, which Petitioner also contends the combination discloses. For example, Bianchi '254 calls for the use of silicone as a primary ingredient. (*See* Ex. 1006 at [0042] (“In the practice of this invention, the volatile silicone oil is present in the stick composition in an amount of from 20 to 40 wt. %....”; *see also id.* at Tables 1, 5.) But the '752 patent warns against silicones (Ex. 1001 at 1:10–11), and indeed claims a deodorant stick substantially free of them in independent claim 1. (Ex. 1001 at cl. 1.) Like its failing on the aluminum-free requirement, Petitioner similarly does not explain how a POSA could have implemented and maintained Bianchi '254's hardness without its primary ingredient of silicones.

The inventors of the '752 patent sought to achieve 80 mm*10 to 140 mm*10 hardness in a composition with “natural oils”—and no silicones or aluminum—

which was difficult because “often natural oils . . . bring a large portion of wax with them, often making the resulting deodorant sticks too hard to meet a more preferable product application” (Ex. 1001 at 1:16–20.) Even if Bianchi ’254 shows a similar hardness range to the ’752 patent, it does not mean that Bianchi ’254 teaches or enables a POSA to achieve that hardness rating in *any given composition of ingredients*, much less the specific composition required by the claims of the ’752 patent.

In sum, Petitioner’s cited references have different compositions that affect hardness in different ways, and Petitioner does nothing to explain how a POSA would have taken the hardness of Bianchi ’254 and achieved it in Lesniak’s formula. As the hardness limitation extends throughout all challenged claims, Grounds 1–4 should further be denied for this additional reason.

V. GROUND 5–8 SHOULD ALSO BE DENIED AS PETITIONER FAILS TO DEMONSTRATE THERE IS 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 in Grounds 5–8

Similar to the deficiencies with the Lesniak grounds above, the Petition also does not present adequate rationale for why a POSA would have been motivated to combine the Native publication with Bianchi ’254 in Grounds 5–8. Petitioner relies on Native as the primary reference, adding Bianchi ’254 because Native “does not

expressly teach the percentage of each ingredient used” and “also does not disclose the hardness of the deodorant stick.” (Petition at 39.) According to the Petition, “Bianchi ’254 describes antiperspirant stick compositions[] which establish that the claimed concentrations of ingredients were conventional and that the claimed hardness range was standard.” (*Id.* at 40.)

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*. (See Sections IV.A, IV.C *infra.*) The Petition ignores Bianchi ’254’s inclusion of aluminum and 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 preferred hardness and amount of ingredients.” (Petition at 40.) But Bianchi ’254 is not a “natural, aluminum-free deodorant stick,” and Petitioner fails 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 all claims of the '752 patent.

With respect to the hardness limitation across all challenged claims, the Petition fails to show a POSA would have had a reasonable expectation of success in trying to implement Bianchi '254's hardness range in Native's formula, for the reasons provided in more detail below with respect to the combination's shortfalls on the merits. 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 do they 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 remains substantially free of silicones, how it affects any claimed weight percentages, and similar). (Petition at 38–44; Ex. 1002 at ¶¶ 150–55.)

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. This is fatal to Grounds 5–8, as each relies on the combination of Native and Bianchi '254 to disclose all elements of the independent claims. Grounds 5–8 should not be instituted.

B. The Petition Also Fails to Adequately Explain Why a POSA Would Have Been Motivated to Combine Native and Easy Homemade in Grounds 6–8

Petitioner contends the combination of Native and Easy Homemade in Grounds 6–8 allegedly discloses deodorant compositions containing the antimicrobial magnesium hydroxide. (Petition at 50–62.) Petitioner insists it “would have been obvious to apply the teachings of Easy Homemade to Native’s deodorant stick composition,” 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.” (Petition at 52.) Accordingly, the Petition claims “[a] POSA would have looked to publications in the field of deodorants describing natural antimicrobials that were not known to cause skin irritation,” like the Easy Homemade hobbyist website which allegedly “confirms what a POSA would have known—namely, that magnesium hydroxide could be used to replace baking soda as an antimicrobial in deodorant compositions, and it works just as well.” (*Id.* at 52–53.)

But Petitioner fails to adequately show why a POSA would have been motivated to look at this hobbyist’s homemade soap blog in the first place,¹ or why

¹ 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 ¶ 187.) Dr. Michniak-Kohn does not support this statement, and she

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 itself contends, Native was “a known leader in the field” and was “internet fam[ous].” (Petition at 39.) Thus, 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 ’752 patent’s successfully formulated deodorant compositions. *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.”)

C. The Petition Fails to Adequately Explain How the Combination of Native and Bianchi ’254 Meets the Hardness Limitation of All Challenged Claims

For the same reasons explained above regarding Grounds 1–4, Petitioner fails to demonstrate how the combination of Native and Bianchi ’254 meets both the

does not describe whether a POSA—as opposed to a hobbyist—would have looked for, and found, this specific blog when developing formulations.

claimed hardness and aluminum-free limitations, as each formulation disclosed in Bianchi '254 contains aluminum. (*See* Section IV.C *infra.*) Neither Petitioner nor Petitioner's expert state that Bianchi's hardness can be achieved regardless of formula composition. (*See id.*) Thus, the Petition again fails to show how or whether the desired hardness can be achieved in the Native composition allegedly free of aluminum salt and containing other ingredients that are not present in Bianchi '254.

As the hardness limitation extends throughout all challenged claims, institution of Grounds 5–8 should be denied for this additional, independent reason.

VI. INSTITUTION OF GROUND 9 SHOULD ALSO BE DENIED AS SQUATCH IS NOT PRIOR ART AND PETITIONER FAILS TO ARTICULATE WHY A POSA WOULD COMBINE IT WITH STURGIS

A. Petitioner's Squatch Reference is Not a "Printed Publication"

Petitioner's primary reference in Ground 9, Squatch (Ex. 1059), is an employee declaration purporting to include images of Dr. Squatch-branded deodorant products at their launch date in November 2020. Exhibit A to the declaration includes photos of three different deodorants, which the declarant alleges each "appeared on Dr. Squatch's publicly-accessible website, <https://www.drsquatch.com/collections/deodorant>, upon their launch in November 2020." (Ex. 1059 at ¶ 4.) But the declaration does not include *any* screenshots of the webpage at the purported product launch date, and wholly fails to show that these Exhibit A images were available and on said webpage at the critical time.

To try and remedy this deficiency, Petitioner’s declarant relies on an internal marketing document, a Shopify timestamp in source code, and an internal quality assurance feedback document allegedly prepared in advance of the website launch. (*Id.* at ¶ 5.) According to Petitioner and its declarant, these sources “confirm that the images in Exhibit A appeared on Dr. Squatch’s website in November 2020.” (*Id.*) *But none of these sources actually show the images in Exhibit A published on the website.* Petitioner thus does not point to any “printed publication” from November 2020 with those deodorant images, and cannot establish those images as publicly accessible prior art at that time.

Determining whether a reference qualifies as prior art “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004); *Schlumberger Tech. Corp. v. Integrated Drive Sys., LLC*, IPR2018-00603, Paper 40 at 12 (P.T.A.B. Sept. 3, 2019) (applying *Klopfenstein* to a post-AIA-patent challenge). A reference is considered “publicly accessible” only if the party shows it was “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence[] can locate it.” *Kyocera Wireless Corp. v. ITC*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (citations omitted); *Activision Blizzard, Inc. v. Acceleration Bay, LLC*, IPR201501951, Paper 107 at 11 (P.T.A.B. Mar. 23, 2017) (same), *aff’d*,

Acceleration Bay, LLC v. Activision Blizzard Inc., 908 F.3d 765 (Fed. Cir. 2018) (citing *Kyocera*). “[T]he burden is on the [P]etitioner to identify with particularity evidence sufficient to establish that the reference was publicly accessible” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 16 (P.T.A.B. Dec. 20, 2019).

Here, Petitioner fails to meet that burden. Petitioner provides no evidence that the images used in Ground 9 were actually on the website. Instead, it relies on uncorroborated, biased testimony from an employee that the images are “true and correct copies” of what was online in November 2020. This is not enough. “[T]he law has long looked with disfavor upon invalidating patents on the basis of mere testimonial evidence absent other evidence that corroborates that testimony.” *Finnigan Corp. v. ITC*, 180 F.3d 1354, 1366 (Fed. Cir. 1999). Thus, “corroboration is required of any witness whose testimony alone is asserted to invalidate a patent, regardless of his or her level of interest.” *Nobel Biocare Services AG v. Intradent USA, Inc.*, 903 F.3d 1365, 1377-78 (Fed. Cir. 2018) (quoting *Finnigan*, 180 F.3d at 1369).

Petitioner fails to put forth anything to corroborate the declarant’s testimony that the same images of the Dr. Squatch products from Exhibit A were published on the Dr. Squatch website. Without the November 2020 webpage to point to, Petitioner does not even have a Squatch “printed publication” to use as prior art in

the first place. Ground 9 should be denied, as Petitioner failed to establish that the Exhibit 1059 declaration is a prior art “printed publication.”

B. The Petition Fails to Adequately Explain Why a POSA Would Have Been Motivated to Combine Squatch With Sturgis

Even if Squatch is prior art—and it is not—Ground 9 would still fail on the merits. Petitioner argues that claims 15–19 of the ’752 patent are obvious over the Squatch disclosure combined with Sturgis (Ex. 1073). (Petition at 63.) Sturgis, or U.S. Pub. No. 2019/0000747, is a patent publication that later issued as the ’164 patent. (Ex. 2006). The ’164 patent is a great-grandparent to the ’752 patent, is cited on the face of the ’752 patent, and was terminally disclaimed by Patent Owner during prosecution.

The Petition posits that Squatch discloses a deodorant stick that contains all of the ingredients required by claims 15–19, except that “it does not disclose the quantitative amounts of those ingredients.” (Petition at 64.) According to Petitioner, “[a] POSA therefore would have looked to Sturgis for guidance on the amounts of ingredients” when formulating a deodorant stick. (*Id.*) But Petitioner provides just two sentences in its “Motivation Supporting the Combination,” claiming the “POSA would have combined Squatch with Sturgis for the same reasons the POSA would have combined Native with Bianchi ’254; Sturgis, unlike Squatch, teaches the quantitative concentrations of ingredients such as the caprylic/capric triglyceride

included in Squatch’s deodorant at undisclosed concentrations.” (*Id.* at 64–65.) That’s all the Petition says for motivation to combine.

Petitioner’s rationale falls short of its burden to explain with particularity the POSA’s reasons for combining the references. *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)). Rather than a motivation to combine, Petitioner offers only hindsight based on a “roadmap” of the ’752 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.”) *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”) Ground 9 should not be instituted for this additional reason.

VII. THE PETITION ALSO SEEKS TO REHASH THE PROSECUTION HISTORY AND SHOULD BE DENIED UNDER SECTION 325(d)

Every single ground of the Petition includes one or more references previously considered by the Examiner during prosecution of the ’752 patent. As Petitioner admits, “Lesniak, Phinney, Native, and Sturgis were of record during prosecution.”

(Petition at 6.) Bianchi '254 was also evaluated by the Examiner during prosecution, contrary to Petitioner's erroneous assertion that "[a]ll other applied references were not considered during prosecution." (*Id.*) Accordingly, institution of all grounds should be discretionarily denied under 35 U.S.C. § 325(d).

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).² Factors (a), (b), and (d)

² *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)

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” prior art references were before the Examiner during prosecution of the ’752 patent. For the reasons discussed below, the Board should discretionarily deny institution for Petitioner’s rehashing of the ’752 patent’s prosecution history.

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

The Office already evaluated five of the references Petitioner relies on in its Grounds 1–9 challenges. Petitioner’s grounds are copied below, with the references the Examiner previously considered bolded for emphasis:

Ground	References
1	Lesniak in view of Bianchi ’254
2	Lesniak in view of Bianchi ’254 and Phinney
3	Lesniak in view of Bianchi ’254 , Phinney , and Anconi

the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments. *See Becton, Dickson*, IPR2017-01586, Paper 8 at 17–18 (§ III.C.5, first paragraph).

4	Lesniak in view of Bianchi '254 , Phinney , Anconi , and Easy Homemade
5	Native in view of Bianchi '254
6	Native in view of Bianchi '254 and Easy Homemade
7	Native in view of Bianchi '254 , Easy Homemade , Anconi , and Stoia
8	Native in view of Bianchi '254 , Easy Homemade , Anconi , and Stoia
9	Squatch in view of Sturgis

(See Petition at 5–6.)

Petitioner’s Lesniak reference is a divisional of another Lesniak publication cited on the face of the ’752 patent. (Ex. 1001.) The two Lesniak references share a specification in relevant part, the disclosure of which was evaluated by the Office during prosecution. (See Ex. 2001 at 246.) The U.S. Patent Publication of Phinney (U.S. 2014/0271517), as well as the Native and Sturgis references, were also of record during prosecution of the ’752 patent. (*Id.*) Petitioner admits all of this.

The Petition asserts that “[a]ll other applied references were not considered during prosecution.” (Petition at 6.) But this is incorrect. Bianchi ’254 was also in front of the Examiner during prosecution and is cited on the face of the ’752 patent:

US 11,844,752 B2			
Page 2			
References Cited		FOREIGN PATENT DOCUMENTS	
U.S. PATENT DOCUMENTS	EP	0471902 A2	2 1992
(56)	JP	201047331	11 2009
8,460,720 B2	6/2013	Berggren et al.	
8,574,559 B2	11/2013	Banowski et al.	
8,581,247 B2	9/2014	Mancle et al.	
8,980,876 B2	3/2015	Schwartz	
9,488,586 B2	10/2016	Fares et al.	
9,517,193 B2	12/2016	Fares et al.	
9,550,864 B2	1/2017	Mancle	
9,586,063 B2	3/2017	Mancle et al.	
9,872,819 B2	1/2018	Mancle et al.	
9,949,920 B2	4/2018	Itakura	
10,076,482 B2	9/2018	Mancle et al.	
10,485,739 B2	11/2019	Yan et al.	
10,541,164 B2*	1/2020	Sturgis et al.	A61Q 1/12
10,555,884 B2	2/2020	Sturgis et al.	
10,901,647 B2	2/2021	Sturgis et al.	
10,933,060 B2	3/2021	Hilland, Jr. et al.	
10,966,915 B2*	4/2021	Sturgis et al.	A61K 8/00
11,045,608 B2	6/2021	Sturgis et al.	
11,111,473 B2	4/2022	Fischer et al.	
11,407,706 B2	11/2022	Sturgis et al.	A61K 8/00
11,540,999 B2*	1/2023	Sturgis et al.	
2013/0046979 A1	11/2001	Landa et al.	
2002/0086039 A1	7/2002	Lac et al.	
2003/0235486 A1	12/2003	Mattai et al.	
2004/0247551 A1	12/2004	Yokomaku	
2005/053572 A1	3/2005	Hwang	
2005/0231797 A1	12/2005	Walling et al.	
2006/024801 A1	11/2006	Hoeflkes	
2007/0034099 A1	1/2007	Shen et al.	
2007/0166254 A1	7/2007	Bianchi	
2007/0201540 A1	8/2007	Oblong et al.	
2009/0108664 A1	1/2009	Banowski et al.	
2010/0130568 A1	5/2010	Mastrodonato	
2011/0076309 A1	3/2011	Hogan et al.	
2011/0076310 A1	3/2011	Fan et al.	
2011/0196786 A1	8/2011	Lacerte et al.	
2013/0049907 A1	2/2013	Lanzalaco et al.	
2013/0109664 A1	5/2013	Kochler	
2013/0174863 A1	7/2013	March	
2014/0139449 A1	5/2014	Tan	
2014/0154189 A1	6/2014	Palmer et al.	
2014/0271217 A1	9/2014	Phinney et al.	
2014/0274852 A1	9/2014	Yang et al.	
2014/0284852 A1	9/2014	Matosiewicz	
2014/0194677 A1	7/2015	Stark et al.	
2016/0074300 A1	3/2016	Salvador et al.	
2016/0090721 A1	3/2016	Amador et al.	
2016/0235661 A1	8/2016	Changpo et al.	
2016/0110393 A1	10/2016	Chang	
2016/0136091 A1	11/2016	Budaksh et al.	
2016/0354306 A1	12/2016	Thompson	
2017/0038800 A1	3/2017	Mancle	
2017/0172873 A1	6/2017	Banowski et al.	
2017/0232288 A1	9/2017	Lesniak et al.	
2017/0304772 A1	10/2017	Chang	
2018/0111135 A1	11/2018	Chang	
2018/0111136 A1	11/2018	Chang	
2018/0325791 A1	11/2018	Lau	
2019/0007730 A1	1/2019	Abdelhag et al.	
2019/0007747 A1	1/2019	Sturgis	
2019/0075330 A1	9/2019	Woo et al.	
2020/0006094 A9	1/2020	Sturgis	
2020/0116153 A1	1/2020	Hilland, Jr. et al.	
2020/0292736 A1	3/2020	Groffman et al.	
2020/073291 A1	3/2020	Wang	
2020/129415 A1	4/2020	Sturgis	
2020/149517 A1	7/2020	Sturgis et al.	
2021/0196617 A1	7/2021	Sturgis et al.	
2021/0274223 A1	9/2021	Sturgis et al.	
2022/0387280 A1	12/2022	Kelly et al.	

(Ex. 1001 at p. 2.) Petitioner makes no effort to address the cumulativeness of its Bianchi '254 challenges, and wholly fails to address § 325(d) with respect to the Bianchi '254 reference.

Regarding the other four references, Petitioner tries to circumvent its § 325(d) issue by arguing the grounds are “neither cumulative nor redundant to prosecution of the ’752 Patent” because Lesniak, Phinney, Native, and Sturgis were “not applied by the examiner or otherwise addressed during prosecution.” (Petition at 6.) But the Board in its *Advanced Bionics* precedential decision explained “[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)).

Here, Lesniak, Phinney, Native, Sturgis, and Bianchi ’254 appear on Information Disclosure Statements signed by the Examiner, where she attests that “ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH.” (See, e.g., Ex. 2001 at 103–07, 161; see also *id.* at 75, 246–47.) This is like *Biocon Pharma*, where 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). The Examiner even went further with Sturgis and applied it in a non-statutory double-patenting rejection that Patent Owner overcame via terminal disclaimer. (Ex. 2001 at 120–21, 136–40.) Because Lesniak, Phinney, Native, Sturgis, and

Bianchi '254 were the “same” as 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 only explicitly addresses § 325(d) with respect to Lesniak. (Petition at 11 n.3 (“For the reasons discussed in this section, the application of Lesniak does not implicate 35 U.S.C. § 325(d).”)). Specifically, Petitioner highlights the fact that Lesniak was cited by the same Examiner in a rejection of a related patent. According to Petitioner, the Examiner only “recognized the applicability of Lesniak” *after* the '752 patent issued, during prosecution of U.S. Application No. 17/961,089 (“the '089 application”). (Petition at 10–11). This is speculation. To the contrary, Lesniak was in front of the Examiner for years throughout the prosecution of the parent applications to the '752 patent. Lesniak is cited on the face of the parent (Ex. 1074), grandparent (Ex. 2005), and great-

grandparent (Ex. 2006) of the '752 patent, and all were prosecuted in front of the same Examiner.³

Given the constant presence of Lesniak during prosecution of the '752 patent and related applications, it is likely that the Examiner—who was well aware of the reference—reviewed Lesniak and intentionally chose not to apply it, perhaps because Lesniak is about sunscreen and diaper cream, *not deodorant*. (See Ex. 1003 at 4:25–26, 8:64–65, 10:31, 14:3–6, Tables 2–6.) In fact, Examiner Mercier expressly distinguished Lesniak for this very reason during prosecution of the related '647 patent, which Petitioner is challenging in a co-pending IPR petition in Case No. IPR2024-01173. During that prosecution, the Examiner found that the '647 claims were not anticipated or obvious over Lesniak. (Ex. 2008 at 7.) Specifically, after Applicant submitted a post-allowance IDS identifying the reference, the Examiner reviewed it 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.” (*Id.*)

³ Examiner Mercier was Back-up Examiner for the great-grandparent of the '752 patent (Ex. 2006), then served as Lead Examiner for prosecution of the applications that followed.

Petitioner ignores the Examiner's rationale above, and does not explicitly address any material error the Examiner allegedly committed. Instead, the Petition provides only superficial statements that Lesniak was "not applied ... or otherwise addressed during prosecution" but was subsequently applied against a later application. (Petition at 6, 10–11.) With respect to the other redundant references of Phinney, Native, and Sturgis, the Petition does not even attempt to conduct a § 325(d) analysis. And as for Bianchi '254, the Petition is silent as to its cumulativeness and incorrectly states that it was "not considered during prosecution." (*Id.* at 6.)

Thus, the Petition presents the same references and arguments that were already before the Examiner, and then fails to conduct the § 325(d) analysis and explain what the Examiner should have done differently. Petitioner's failure to articulate any error means that the Petition should be discretionarily denied under 35 U.S.C. § 325(d).

VIII. CONCLUSION

For the reasons set forth above, the Board should decline to institute *inter partes* review of the '752 patent.

Date: January 15, 2024

Respectfully submitted,

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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 8,226.

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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 January 15, 2024, at the following address:

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