

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DR. SQUATCH, LLC,
Petitioner,

v.

THE PROCTER & GAMBLE COMPANY,
Patent Owner.

IPR2024-01498
Patent 11,844,752 B2

Before JOHN G. NEW, SHERIDAN K. SNEDDEN, and
SUSAN L. C. MITCHELL, *Administrative Patent Judges*.

SNEDDEN, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

Dr. Squatch, LLC (“Petitioner”) filed a Petition requesting *inter partes* review of claims 1–19 of U.S. Patent No. 11,844,752 B2 (Ex. 1001, “the ’752 patent”). Petition (“Pet.”), Paper 2. The Procter & Gamble Company (“Patent Owner”) filed a Preliminary Response (“Prelim. Resp.”). Paper 7.

To institute an *inter partes* review, we must determine that the information presented in the Petition shows “a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). The Supreme Court has held that a decision to institute under 35 U.S.C. § 314 may not institute on less than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). After considering the information presented by the parties, we determine that Petitioner has demonstrated a reasonable likelihood of success in proving that at least one of claims 1–19 of the ’752 patent is unpatentable.

B. *Real Parties in Interest*

Petitioner identifies Dr. Squatch, LLC, as its real party-in-interest. Pet. 1. Patent Owner identifies The Procter & Gamble Company as its real party-in-interest. Paper 4, 1.

C. *Related Matters*

The parties indicate that the ’752 patent is involved in *The Procter & Gamble Company v. Dr. Squatch LLC*, Case No. 2-24-cv-04711 (C.D. Cal.), filed November 29, 2022. Pet. 1; Paper 4, 1.

Petitioner has also filed petitions for *inter partes* review of the following patents: IPR2024-01104 against U.S. Patent No. 11,540,999; IPR2024-01105 against U.S. Patent No. 10,966,915; IPR2024-01173 against U.S. Patent No. 10,905,647; and IPR2024-01174 against U.S. Patent No. 11,497,706. Pet. 1; Paper 4, 1.

D. The '752 patent (Ex. 1001)

The '752 patent is titled “Deodorant Compositions.” Ex. 1001, code (54). The '752 patent is directed to deodorant compositions and methods of making the compositions. *Id.* at 1:5–6. More specifically, the '752 patent is directed to formulating, in response to consumer demands, an aluminum-free, mostly silicone-free deodorant stick, which is not too hard. *Id.* at 1:12–13, 1:21–23.

The '752 patent explains that

[c]onsumers also want a good glide, non-sticky, and non-greasy application. This is a challenge, because a mostly silicone-free formula will often use natural oils or natural oil-based triglycerides. But often natural oils, such as coconut oil, 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. They are also often undesirably greasy due to the non-volatile nature.

Id. at 1:12–20. “As consumers seek more natural ingredients in their deodorants, one approach to formulation is to use emollients derived from natural oils.” *Id.* at 2:49–51. The specification describes that products aimed at emphasizing the use of natural ingredients “may have a significant amount of a liquid triglyceride.” *Id.* at 2:56. To provide structure to these products, the '752 patent describes that it is known to include waxes and

other such structurants. *Id.* at 2:58–60. However, the '752 patent explains that

a currently marketed product, Comparative Formula 1 . . . , has 34.15% liquid triglyceride, along with a number of structurants, resulting in a very hard stick, scoring 63 on a needle penetration test under ASTM D-1321 So while Comparative Formula 1 uses consumer preferred natural ingredients, it does not necessarily provide a good consumer experience when used, given its hardness. Comparative Formula 2 contains even higher levels of structurants, resulting in a harder stick with an even lower hardness score. In comparison, Inventive Examples 1–5, while comprising consumer-preferred natural ingredients, have higher hardness scores, meaning they are softer products.

Id. at 2:62–3:7. According to the '752 patent, “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., . . . 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 '752 patent describes that the “deodorant stick is able to comprise consumer-perceived natural ingredients, while offering a pleasant consumer experience in terms of its hardness.” *Id.* at 3:48–51.

The '752 patent describes that the deodorant compositions “can contain a structurant, an antimicrobial, a perfume, and additional chassis ingredient(s) . . . in the form of a solid stick.” *Id.* at 9:11–14. 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. The '752 patent describes a deodorant stick comprising a magnesium hydroxide that is effective against underarm bacteria strains in raw material evaluations. *Id.* at 8:19–25, 8:34–36.

E. The Challenged Claims

Petitioner challenges claims 1–19. Representative independent claims 1 and 15 are reproduced below:

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 30 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.

15. A deodorant stick comprising:

- a. at least about 25% by weight liquid triglyceride;
- b. a starch;
- c. stearyl alcohol;
- d. magnesium hydroxide;
- e. shea butter;
- f. coconut oil;
- g. triethyl citrate; and
- h. sunflower seed oil;

said deodorant stick being free of an aluminum salt; and wherein said stick has a hardness from about 80 mm*10 to about 140 mm*10, as measured by penetration with ASTM D-1321 needle.

Ex. 1001, 15:26–34, 16:13–25.

F. Evidence

Petitioner relies upon information that includes the following.

Ex. 1003, Lesniak et al., US 11,433,018 B2, issued September 6, 2022 (“Lesniak”).

Ex. 1004, Phinney et al., US 9,314,412 B2, issued April 19, 2016 (“Phinney”).

Ex. 1005, John Henderson Lamb, M.D., *Sodium Bicarbonate: An Excellent Deodorant*, THE JOURNAL OF INVESTIGATIVE DERMATOLOGY 7(3) 131–33 (1946) (“Lamb”).

Ex. 1006, Bianchi et al., US 6,048,518, issued April 11, 2000 (“Bianchi ’518”).

Ex. 1007, Wayback Machine archives, captured May 26, 2016, November 23, 2016, and November 1, 2015 respectively for: <https://www.nativecos.com>, <https://www.nativecos.com/product/deodorant/>, and <https://www.nativecos.com> (“Native”).

Ex. 1008, Bianchi, US 2007/0166254 A1, published July 19, 2007 (“Bianchi ’254”).

Ex. 1009, Wayback Machine archive, captured January 26, 2017, for <http://soapdelinews.com/2016/11/easy-homemade-deodorantrecipe.html> (“Easy Homemade”).

Ex. 1044, Millet et al., US 2018/0168954 A1, published June 21, 2018 (“Millet”).

Ex. 1057, Anconi et al., U.S. Patent App. Pub. No. 2016/0089321, published March 31, 2016 (“Anconi”).

Ex. 1058, Stoia, et al., Selected Evidence-Based Health Benefits of Topically Applied Sunflower Oil, 10(1) APPLIED SCI. REPS. 45–49 (2015) (“Stoia”).

Ex. 1073, Sturgis et al., U.S. Patent App. Pub. No. 2019/0000747, published January 3, 2019 (“Sturgis”).

Petitioner also relies on the Declarations of Bozena B. Michniak-Kohn, Ph.D. (Ex. 1002) and Mr. Vinod Stephen Pinto (Ex. 1059; “Squatch”) to support its contentions.

G. Asserted Grounds of Unpatentability

Petitioner asserts that claims 1–19 would have been unpatentable on the following grounds:

Ground	Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1	1–13	103	Lesniak, Bianchi '254
2	14	103	Lesniak, Bianchi '254, Phinney
3	15–16, 18–19	103	Lesniak, Bianchi '254, Phinney, Anconi
4	17	103	Lesniak, Bianchi '254, Phinney, Anconi, Easy Homemade
5	1, 4–14	103	Native, Bianchi '254
6	2–3	103	Native, Bianchi '254, Easy Homemade
7	15, 17–19	103	Native, Bianchi '254, Easy Homemade, Anconi, Stoia
8	16	103	Native, Bianchi '254, Easy Homemade, Anconi, Stoia, Millet
9	15–19	103	Squatch and Sturgis

H. Claim Construction

The challenged claims should be read in light of the Specification, as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we generally give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The ordinary and customary meaning is the meaning that the term would have to a person of ordinary skill in the art in question.” (internal quotation marks omitted));

see also 37 C.F.R. § 42.100(b) (stating that claims are construed in IPRs according to the same standard as used in federal court).

Petitioner does not argue that any claim terms require construction. *See generally* Pet. Patent Owner asserts that “reasons exist for denial of institution that do not require addressing the construction of claim terms at this time.” Prelim. Resp. 7.

We determine that no express construction of any claim term is necessary to determine whether to institute *inter partes* review. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))). To the extent further discussion of the meaning any claim term is necessary to our decision, we provide that discussion below in our analysis of the asserted grounds of unpatentability.

I. Level of Ordinary Skill in the Art

Petitioner proposes that a person of ordinary skill in the art (“POSA” or “POSITA”) at the time of the invention “would have (1) at least a B.S. or equivalent degree; and (2) at least two years of experience in cosmetics formulations.” Pet. 16 (citing Ex. 1002 ¶¶ 26–28). Patent Owner does not dispute Petitioner’s proposal about the POSA’s qualifications. Prelim. Resp. 7–8.

For this Decision, we adopt and apply Petitioner’s proposal above, which does not appear to be inconsistent with the level of skill reflected in the asserted prior art.

II. ANALYSIS

A. Introduction

“In an [*inter partes* review], 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) (citing 35 U.S.C. § 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)). This burden of persuasion never shifts to the patent owner. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015). Moreover, a petitioner should not “place the burden on [the Board] to sift through the information presented by the Petitioners, determine where each element [of the challenged claims] is found in [the cited references], and identify any differences between the claimed subject matter and the teachings of [the cited references.]” *Google Inc. v. EveryMD.com LLC*, IPR2014-00347, Paper 9 at 25 (PTAB May 22, 2014).

The question of obviousness is resolved on the basis of underlying factual determinations including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) objective evidence of nonobviousness.¹ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

The obviousness inquiry also typically requires an analysis of “whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.” *KSR Int’l Co. v. Teleflex Inc.*,

¹ Patent Owner does not present any objective evidence of nonobviousness (i.e., secondary considerations) for the challenged claims at this time.

550 U.S. 398, 418 (2007) (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (requiring “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”)). A petitioner cannot prove obviousness with “mere conclusory statements.” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016). Rather, a petitioner must articulate a sufficient reason why a person of ordinary skill in the art would have combined the prior art references. *In re NuVasive*, 842 F.3d 1376, 1382 (Fed. Cir. 2016).

We analyze the asserted grounds of unpatentability in accordance with these principles to determine whether Petitioner has met its burden to establish a reasonable likelihood of success at trial.

B. Summary of the Cited Prior Art

1. Lesniak (Ex. 1003)

Lesniak is titled “NON-GREASY PERSONAL CARE COMPOSITIONS.” Ex. 1003, code (54). Lesniak provides an anhydrous personal care composition, comprising

(a) at least one ester, wherein said at least one ester is selected from one or more of the following groups: (i) triglycerides, (ii) diglycerides, (iii) monoglycerides, (iv) monoesters of dials, and (v) diesters of dials, and wherein a total concentration of said at least one ester is 45 to 60 weight %, based on the total weight of the composition; (b) a first wax having a melting point of 35° C. to 72° C. present in an amount of 5 to 25 weight %, based on the total weight of the composition; (c) a second wax having a melting point of 73° C. to 90° C. present in an amount of 0.5 to 15 weight% based on the total weight of the composition; (d) at least one plant oil having a saponification value of 150 to 275 mg KOH/g, wherein a total concentration of said at least one plant oil is from 5 to 35 weight%, based on the total weight of the composition.

Id. at 5:32–48. Lesniak describes that “[o]ptionally, the at least one ester is a combination of caprylic triglyceride and capric triglyceride” in ranges from 50–60 weight %, based on the total weight of the composition. *Id.* at 2:38–39, 3:42–44. “Optionally, the composition further comprises zinc oxide . . . present in a concentration of 10 to 30 weight %.” *Id.* at 3:39–42. Lesniak describes that the composition may be in the form of a stick. *Id.* at 4:22. According to Lesniak, the compositions possess “good micro-robustness, . . . reduced greasiness and an improved after-feel (such as reduced tackiness and drag) on the skin as compared to other anhydrous compositions[, and] . . . are also physically stable at high and low temperatures.” *Id.* at 5:50–54.

Lesniak discloses a desire to “to formulate such compositions from all-natural ingredients (i.e. ‘100% natural’ compositions).” *Id.* at 5:29–31. Lesniak discloses that “the term ‘natural compositions’ indicates that the composition is formulated from ingredients which are extracted from the earth or sea, derived from plants, or synthesized by other organisms.” *Id.* at 4:61–64. Lesniak discloses that the composition may comprise “essential oils which may be used as natural fragrances.” *Id.* at 8:38.

2. *Phinney (Ex. 1004)*

Phinney is titled “DEODORANT FORMULATION.” Ex. 1004, code (54). Phinney relates to a deodorant “formulation and preparation thereof with natural ingredients in the absence of heavy metal complexes and/or petroleum based or related compounds.” *Id.* at 1:7–9. Phinney discloses finding that “a mixture of the hydroxides of zinc and magnesium could provide long lasting protection against odour due to perspiration . . . and are dispersible in aerosols, moisturizing creams, sticks, sprays and roll-on type applicators.” *Id.* at 1:17–22.

Phinney explains that zinc and aluminum oxide are “very unreactive against perspiration odour due to insolubility and low hydrolysis rate.” *Id.* at 2:35–36. According to Phinney, “magnesium hydroxide, . . . has low solubility and therefore does not ‘wash away’ under heavy perspiration” and thus “provides 16–20 hour protection and more for a broad cross section of people.” *Id.* at 5:47–51. Phinney discloses an embodiment of a specific formulation prepared as a solid stick that “includes magnesium oxide in an amount of between 1% and 2.5% by weight and zinc oxide in an amount of between 0.5% and 1.5% by weight.” *Id.* at 6:32–34, 6:12, 8:46–57 (claim 1).

3. *Lamb (Ex. 1005)*

Lamb is an article titled “SODIUM BICARBONATE: AN EXCELLENT DEODORANT” that was published in *The Journal of Investigative Dermatology*. Ex. 1005, 131. Lamb describes a study that evaluated the effectiveness of baking soda as an underarm deodorant in 90 patients. Ex. 1005, 131–33. Lamb hypothesizes that the perspiration’s free fatty acids, which possess a disagreeable odor, forms a less malodorous sodium salt in the presence of sodium bicarbonate. *Id.* at 133. Based on the results of the study, Lamb concludes that “bicarbonate of soda is a valuable underarm deodorant for common daily usage.” *Id.* Lamb observed that “[n]o furunculosis,” or boils, “developed in over 90 cases which have used bicarbonate of soda over periods of from four weeks to a year’s duration.” *Id.*

4. *Bianchi ’518 (Ex. 1006)*

Bianchi ’518 is titled “LOW RESIDUE SOLID ANTIPERSPIRANT.” Ex. 1006, code (54). Bianchi ’518 “relates to

antiperspirant sticks, substantially free of water and long chain fatty alcohols, which provide the user with excellent antiperspirant efficacy, reduced residue when the composition is first applied to the skin, reduced residue after dry down, high temperature stability, and excellent cosmetics and aesthetics. *Id.* at 1:8–13.

Bianchi '518 discloses that the antiperspirant composition possesses a specification of “Penetration-ASTM D-1321@ 100/77/5 10–16.” *Id.* at 2:57–58. Bianchi '518 explains that

[o]ne important physical parameter affecting consumer acceptance of suspensoid antiperspirant sticks of the invention is hardness as measured by needle penetration. Typical 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. Products outside this range will typically generate low consumer acceptance ratings.

Id. at 6:23–29.

5. *Native (Ex. 1007)*

Native is a printed publication from a website advertising a deodorant product sold in 2016. Ex. 1007, 5–8, 11–12, 14–18. Native is advertised as a “Deodorant That Isn’t A Chemistry Experiment,” which contains “NATURAL INGREDIENTS” and is “ALUMINUM-FREE.” *Id.* at 5. Native lists each ingredient for the Native deodorant stick product, including, *inter alia*, shea butter, beeswax, baking soda, and stearyl alcohol. *Id.* at 6, 11.

The picture on page 5 of Native, reproduced below, illustrates a deodorant product. *Id.* at 5.



The picture of the Native deodorant product, reproduced above, illustrates the deodorant stick in a supine position with the cap removed. *Id.*

6. *Bianchi '254 (Ex. 1008)*

Bianchi '254 is titled “ANTIPERSPIRANT STICK COMPOSITIONS.” Ex. 1008, code (54). Bianchi '254 discloses “antiperspirant stick compositions comprising specified amounts of antiperspirant active; carrier oil comprising volatile silicone oil and non-volatile masking oil; structurant comprising fatty alcohol and cosmetically acceptable wax having a melting point of 75 to 95° C., a portion of wax comprises polyethylene in specified amounts.” *Id.* at code (57). Bianchi '254 addresses

a need for non-whitening fatty alcohol-containing antiperspirant sticks, particularly sticks containing fatty alcohol at levels of 12% by weight or above, more particularly, 15 wt % or above. Also desired are non-whitening fatty alcohol-containing sticks that have desirable antiperspirant payouts, while providing a ‘clean’, non-sticky feel. There also remains a need for a non-whitening fatty-alcohol containing stick that provides desirable payout as well as being thermally stable and resistant to dome collapse at temperatures of 50° C.

Id. at ¶ 10. Table 5 of Bianchi '254 provides eight different formulations of antiperspirant sticks with each of their respective components and amounts listed. *Id.* at ¶ 131.

Bianchi '254 explains that the “[t]he hardness of the sticks can be measured in a needle penetration test.” *Id.* at ¶ 26. Bianchi '254 describes the method for measuring stick hardness using a “brass/steel tapered needle (DIN 51-579)” depth on six locations of the stick, “with the hardness values being reported as an average of the six measurements.” *Id.* at ¶ 117.

7. *Easy Homemade (Ex. 1009)*

Easy Homemade is a printed publication of a blog post titled “Easy Homemade Deodorant Recipe with just 3-Ingredients.” Ex. 1009, 5. Easy Homemade describes the blogger’s first experience with natural deodorant, but falling “victim to the burning fiery rash you get after using deodorant with baking soda.” *Id.* at 6. Easy Homemade describes that the blogger discovered that she “could swap the baking soda with magnesium hydroxide - basically the same thing as Milk of Magnesia - and it worked just as well.” *Id.* The Easy Homemade blogger describes melting “two natural deodorants” that are aluminum-free, and making a “[h]uge difference” in each deodorants’ performance by adding “arrowroot powder and magnesium hydroxide to them.” *Id.* at 7. Easy Homemade provides a deodorant recipe and lists “2.15 oz. natural aluminium free deodorant (base) of choice[,] 1 oz. arrowroot powder[,] .5 oz. magnesium hydroxide[,]” to which one may “[a]dd essential oils if desired.” *Id.* at 7–8.

8. *Millet (Ex. 1044)*

Millet is titled “ANHYDROUS DEODORANT COMPOSITION MADE FROM BICARBONATE.” Ex. 1044, code (54). Millet “relates to

an anhydrous cosmetic composition made from bicarbonate salt, []the cosmetic use of same as a deodorant,” and “a deodorant product containing said composition.” *Id.* at code (57). Millet describes that it is “possible to formulate anhydrous deodorants . . . in the form of sticks of soft texture, based on ingredients of natural origin,” that “have proved easy to apply, effective against perspiration odors and capable of depositing a soft, non-greasy and non-tacky film on the skin.” *Id.* at ¶ 4. Millet describes adding “pulverulent fillers, which are suitable for absorbing moisture and sweat,” such as, “in particular []native starch, []modified starch and cellulose.” *Id.* at ¶¶ 38, 39; *see also id.* ¶¶ 48–50 (disclosing two examples of a “Deodorant Balm” and each of their respective ingredients and percentage amounts.”).

9. *Anconi (Ex. 1057)*

Anconi is titled “ANTIPERSPIRANT COMPOSITIONS.” Ex. 1057, code (54). Anconi discloses deodorant formulations comprising zinc salts that are substantially free of aluminum salts. *Id.* at Abstract. Anconi also discloses triethyl citrate as an “ingredient[] known to have antibacterial and deodorant properties.” *Id.* at ¶ [0027].

10. *Stoia (Ex. 1058)*

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, Abstract.

11. Squatch (Ex. 1059)

The reference Petitioner identifies as Squatch is a declaration by Vinod Stephen Pinto, Senior Director of Product Management, Ecommerce at Dr. Squatch. Ex. 1059 ¶ 1. Mr. Pinto testifies that images provided in Exhibit A of the declaration are images of certain Dr. Squatch products that were published on the <https://drsquatch.com> website in 2020.

12. Sturgis (Ex. 1073)

Sturgis is titled “DEODORANT COMPOSITIONS.” Ex. 1073, code (54). Sturgis discloses using at least about 25% of one or more liquid triglyceride as a structurant in a deodorant stick. *Id.* at ¶¶ [0005], [0042]–[0043]. Sturgis also describes that its deodorant sticks “having a hardness from about 80 mm*10 to about 140 mm*10, as measured by penetration with ASTM D-1321 needle” so as to “offer[] a pleasant consumer experience.” *Id.* at ¶¶ [0005], [0024]. Sturgis discloses that a starch such as tapioca starch or arrowroot powder can be added to deodorant sticks “for dry feel or wetness absorption.” *Id.* at ¶ [0065], Table 1.

C. Petitioner’s Ground 5: Obviousness over Native and Bianchi ’254

1. Petitioner’s Contentions

Petitioner asserts that claims 1 and 4–14 are obvious over the combination of Native and Bianchi ’254. Pet. 38–50. In support of this assertion, Petitioner provides a detailed discussion and claim chart explaining how each claim limitation is disclosed by the combination of Native and Bianchi ’254. *Id.* In particular, Petitioner describes the Native reference as a printed publication from a website for the Native deodorant product, which describes the product as “a natural, aluminum-free deodorant stick” marketed and sold in 2016. *Id.* at 38 (citing Ex. 1007, 5, 11).

Petitioner contends that “[a] POSA looking to formulate new deodorant compositions would have looked to existing formulations and would have understood that commercial deodorant brands typically provided ingredient lists of their products on their websites.” *Id.*

Petitioner contends that Native discloses each element of claims 1 and 4–14 except for the recited hardness limitation of claim 1 and the recited percentages of each ingredient used in dependent claims. *Id.* at 39. For those elements, Petitioner asserts that Bianchi ’254 “establish[es] that the claimed concentrations of ingredients were conventional and that the claimed hardness range was standard.” *Id.* Petitioner then concludes “it would be obvious to formulate a natural deodorant stick such as the stick disclosed by Native using ingredient concentrations and hardnesses as taught by Bianchi ’254.” *Id.*

Petitioner contends that a person of ordinary skill in the art would have been motivated to look to existing products, such as the Native product, when formulating “a natural, aluminum-free deodorant stick composition.” *Id.* Petitioner contends that

Native’s deodorant stick composition is comprised of caprylic/capric triglyceride, baking soda, stearyl alcohol, olyglycerol-3 beeswax, and jojoba esters. Ex. 1007, 11. Aluminum salts, and synthetic fragrances are not included in the composition. *See id.* As a POSA would have understood, Native lists its deodorant stick ingredients in order from greatest to least concentration (Ex. 1002, ¶150 (citing Ex. 1046, 164)); however, it does not expressly teach the percentage of each ingredient used nor state the hardness of the deodorant stick.

Pet. 39–40. Petitioner further contends that “[w]hen 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 hardnesses and amount of ingredients.” *Id.* at 40 (citing Ex. 1002 ¶¶ 150–153).

Finally, Petitioner contends that,

A POSA would have had a reasonable expectation of success in formulating a deodorant stick such as the stick disclosed by Native with percentages of liquid triglyceride within the claimed ranges, because others, such as the inventors of Bianchi '254, had successfully formulated antiperspirant sticks within those claimed ranges. Ex. 1008, ¶¶ [0001], [0015]–[0019], [0023], [0026], [0050], [0058], [0060]–[0061], [0117], [0131], Table 5. Moreover, Native identifies the specific ingredient to use, but lacks the weight percents, where Bianchi '254 teaches the conventional weight percentages to be used for the various components such that the combination would aid the POSA in making a deodorant similar to Native's. With respect to hardness, a POSA would have had a reasonable expectation of success in achieving the same for reasons already discussed above.²⁸ Ex. 1002, ¶154.

Pet. 40–41.

2. Patent Owner's Contentions

Patent Owner contends that “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*.”

Prelim. Resp. 21. Patent Owner further contends

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.

Prelim. Resp. 21.

Regarding the hardness limitation across all challenged claims, Patent Owner contends that

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.)

Prelim. Resp. 22.

3. Discussion

Having considered the parties’ positions and evidence of record, summarized above, we determine that Petitioner has established a reasonable likelihood of prevailing in showing that claims 1 and 4–14 are obvious over the combination of Native and Bianchi ’254. In particular, we are persuaded by Petitioner that the combination of Native and Bianchi ’254 discloses a deodorant stick comprising each element of claims 1 and 4–14. Pet. 41–50. We also find that Petitioner has shown sufficiently on the record before us that a person of ordinary skill in the art would have had a reasonable

expectation of success to implement Bianchi '254's hardness range in Native's formula. Here, we credit Dr. Michniak-Kohn's testimony that a person of ordinary skill in the art would have understood how to adjust hardness using the structurants in a deodorant composition. Ex. 1002 ¶ 41, 191–192.

We have considered Patent Owner's argument that "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*." Prelim. Resp. 21. We do not find this argument persuasive on the current record because Petitioner relies primarily on Native for disclosing the components of a natural deodorant stick. Pet. 41–50. For example, Petitioner relies on Native for its use of baking soda as an antimicrobial and additionally on Native's express exclusion of aluminum salts in its formulation. *Id.* at 42–43. Petitioner adds Bianchi '254 for its express disclosure of a suitable hardness range for conventional deodorant stick compositions, as such details are not disclosed in Native. *Id.* at 43–44. Here, we credit Dr. Michniak-Kohn's testimony that "Bianchi '254 describes antiperspirant stick compositions, which establish that the claimed concentrations of ingredients were conventional and that the claimed hardness range was standard." Ex. 1002 ¶ 149.

We also considered Patent Owner's argument that "Ppetitioner 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." Prelim. Resp. 22. As Petitioner notes, however, both Native and Bianchi '254 are in the same field as the '752 patent—personal care compositions, including deodorant and/or antiperspirant sticks. Pet. 41

(citing Ex. 1001, Abstract, 1:10–2:57, 9:65–10:4; Ex. 1007, 5–8, 11; Ex. 1008, Abstract, ¶¶ [0010]–[0021]; Ex. 1002 ¶ 155). We have not identified any information on this record distinguishing natural, aluminum-free deodorants from antiperspirants containing aluminum in a manner that suggests that ingredients used in one could not be used in the other for the same purpose. Furthermore, Dr. Michniak-Kohn persuasively asserts on the record before us that when looking at particular ingredients of a formulation, a person of ordinary skill in the art would have looked to other references in the same field—personal care compositions, including deodorants and/or antiperspirants—to determine how much of each ingredient should be used. Ex. 1002 ¶¶ 148–152. We further credit Dr. Michniak-Kohn’s testimony that “a POSA would have had a reasonable expectation of success in formulating a deodorant stick such as the stick disclosed by Native with percentages of liquid triglyceride within the claimed ranges, because others, such as the inventors of Bianchi ’254, had successfully formulated antiperspirant sticks within those claimed ranges.” Ex. 1002 ¶ 154.

4. Conclusion

For the foregoing reasons, we determine that Petitioner has shown a reasonable likelihood that at least one of the challenged claims of the ’752 patent is unpatentable.

D. Petitioner’s Ground 6: Obviousness over Native, Bianchi ’254, and Easy Homemade

1. Petitioner’s Contentions

Claims 2 and 3 each depend directly from claim 1 and further require that the deodorant stick include the antimicrobial as a powder with a water solubility of at most about 90 g/L at 25° C (claim 2) or is substantially free

of baking soda (claim 3). Pet. 50–51; Ex. 1001, 15:35–39. Petitioner asserts that claims 2 and 3 would have been obvious over the combination of Native, Bianchi ’254, and Easy Homemade. Pet. 50–54. In support of its assertion, Petitioner provides a detailed discussion and claim chart explaining how each claim limitation is disclosed by the combination of Native, Bianchi ’254, and Easy Homemade. *Id.*

Petitioner relies on Easy Homemade for its disclosure related to replacing baking soda with magnesium hydroxide as an antimicrobial in deodorant compositions. *Id.* at 51 (citing Ex. 1009, 6, 9). Petitioner concludes that,

While 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. A POSA would have looked to publications in the field of deodorants describing natural antimicrobials that were not known to cause skin irritation, and would seek to understand consumer demands in the field (not being suitably met by existing offerings) for guidance on new products. Easy Homemade is a publicly-available website page that sets forth the ingredients for and method of making a natural deodorant. Ex. 1009, 5-9. Easy Homemade 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.*, 6, 9; Ex. 1002, ¶¶188-190.

Pet. 52–53.

Petitioner contends that a person of ordinary skill in the art would have had a reasonable expectation of success in formulating Native’s deodorant stick based on Bianchi ’254 using Easy Homemade’s magnesium hydroxide antimicrobial as an alternative because “[a] POSA would have appreciated that deodorant compositions could be formed through various

combinations of known ingredients, such as antimicrobials, structurants, and carrier oils, as simple design choices.” *Id.* at 53 (citing Ex. 1002 ¶¶ 191–192).

2. *Patent Owner’s Contentions*

Patent Owner contends that “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, or why a POSA would have found it necessary to modify the already-successful Native product.” Prelim. Resp. 23–24.

Moreover, Patent Owner contends that (1) the Native webpage formulation “includes shea butter and coconut oil, both of which have anti-inflammatory and healing properties for skin;” (2) “the Native site contains glowing reviews from its users, none of which discuss experiencing any skin irritation;” and (3) Petitioner itself acknowledges that Native was “a known leader in the field” and was “internet fam[ous].” *Id.* at 24 (citing Ex. 1007, 15, 17; Pet. 39). Thus, according to Patent Owner,

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, [LLC v. CISCO Systems, Inc., 942 F.3d 1352, 1361–62 (Fed. Cir. 2019)]* (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.”)

Prelim. Resp. 24.

3. *Discussion*

Having considered the parties’ positions and evidence of record, we determine that Petitioner has shown a reasonable likelihood that claims 2

and 3 are unpatentable as obvious over the combination of Native, Bianchi '254, and Easy Homemade. In particular, we are persuaded, based on the current record, that a person of ordinary skill in the art would have known that deodorants containing baking soda could cause skin irritation for some users and would have looked to substitute baking soda with an art recognized equivalent. *See* Ex. 1002 ¶ 189 (“Easy Homemade 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.”).

We are unpersuaded by Patent Owner’s contention that a person of ordinary skill in the art would not have looked to Easy Homemade. Prelim. Resp. 23–24. While Easy Homemade may be a “hobbyist’s homemade soap blog,” we are persuaded, as Petitioner asserts, that Easy Homemade was on a publicly-available website and “[a] would have looked to publications in the field of deodorants describing natural antimicrobials that were not known to cause skin irritation, and would seek to understand consumer demands in the field (not being suitably met by existing offerings) for guidance on new products.” *Id.* at 52.

4. Conclusion

For the foregoing reasons, we determine that Petitioner has shown a reasonable likelihood that claims 2 and 3 of the '752 patent would have been obvious over the combination of Native, Bianchi '254, and Easy Homemade.

E. Petitioner’s Ground 7: Obviousness over Native, Bianchi '254, Easy Homemade, Anconi, and Stoia

Petitioner asserts that claims 15 and 17–19 would have been obvious over the combination of Native, Bianchi '254, Easy Homemade, Anconi,

and Stoia. Independent claims 15, 18, and 19 recite deodorant sticks comprising a particular ingredient list that includes a triglyceride, starch, stearyl alcohol, magnesium hydroxide, shea butter, coconut oil, triethyl citrate, and sunflower seed oil. Ex. 1001, 16:13–56. As in claim 1, each of independent claims 15, 18, and 19 require the recited deodorant stick to be free an aluminum salt and require the stick to have a hardness from about 80 mm*10 to about 140 mm*10, as measured by penetration with ASTM D-1321 needle. *Id.*, *see supra*, Sections III.C and III.D. Claim 17 depends from claim 15 and further limits the starch to arrowroot powder. Pet. 16:28–29.

Petitioner acknowledges that, “[w]hile Native teaches a deodorant stick composition comprising an antimicrobial and various plant compounds, it does not teach a deodorant stick comprising (1) triethyl citrate; or (2) sunflower seed oil.” Pet. 54–55. Petitioner relies on Anconi and Stoia for those elements of the challenged claims. *Id.* Petitioner relies on Anconi for its disclosure that triethyl citrate was “known to have antibacterial and deodorant properties.” Pet. 55 (citing Ex. 1057 ¶ [0027]). Thus, according to Petitioner,

a POSA would have been motivated to incorporate triethyl citrate as an antimicrobial in Native’s deodorant compositions to improve their ability to combat odor after reducing or eliminating the baking soda in the formulation to avoid skin irritation issues. A POSA further would have been motivated to include triethyl citrate in Native’s deodorant compositions because, as discussed above, Native’s compositions contained liquid triglycerides, and triethyl citrate was known to prevent the degradation of triglycerides in compositions for topical use.

Pet. 55.

Petitioner relies on Stoia for its disclosure of the use of sunflower seed oil in skin care products. *Id.* at 59 (“Stoia discloses the ‘proven . . . positive skin effects’ of sunflower seed oil in cosmetic compositions.” (quoting Ex. 1058, 45)). Petitioner contends that a person of ordinary skill in the art would have been motivated to add sunflower seed oil because it was a known “effective, low-cost, and natural alternative” to the tocopherol (Vitamin E) used in Native. *Id.* at 56 (citing Ex. 1058, 45).

Patent Owner at this stage does not offer any arguments specifically addressing Petitioner’s substantive showing with regard to claims 15 and 17–19. *See generally* Prelim. Resp. 20–25.

After considering the information presented in the Petition, we determine that there is sufficient evidence to indicate a reasonable likelihood that Petitioner will prevail in establishing that claims 15 and 17–19 would have been obvious over the combination of Native, Bianchi ’254, Easy Homemade, Anconi, and Stoia.

F. Petitioner’s Ground 8: Obviousness over Native, Bianchi ’254, Easy Homemade, Anconi, Stoia, and Millet

Petitioner asserts that claim 16 would have been obvious over the combination of Native, Bianchi ’254, Easy Homemade, Anconi, Stoia and Millet. Pet. 60–63. Claim 16 depends directly from claim 15 and further requires the addition of tapioca starch. Petitioner contends that “Millet teaches starch is an effective filler in deodorants capable of absorbing sweat and moisture, and that tapioca starch is specifically preferred.” *Id.* at 60–61 (Ex. 1044 ¶¶ [0038]–[0039], [0042]). Accordingly, Petitioner alleges it would have been obvious to use tapioca starch in the Native deodorant stick, as taught by Millet. *Id.* (citing Ex. 1002 ¶ 238 (“A POSA would have

known that sweat and moisture in the axillary could give rise to malodor via growth of odor-causing bacteria and would have would have looked for natural fillers that were effective in absorbing sweat and moisture.”).

Patent Owner at this stage does not offer any arguments specifically addressing Petitioner’s substantive showing with regard to claim 16. *See generally* Prelim. Resp. 20–25.

After considering the information presented in the Petition, we determine that there is sufficient evidence to indicate a reasonable likelihood that Petitioner will prevail in establishing that that claim 16 would have been obvious over the combination of Native, Bianchi ’254, Easy Homemade, Anconi, Stoia, and Millet.

G. Petitioner’s Ground 9: Obviousness over Squatch and Sturgis

1. Petitioner’s Contentions

Petitioner asserts that claims 15–19 would have been obvious over Squatch and Sturgis. Pet. 63–70. To begin, Petitioner contends that claims 15–19 are not entitled to a priority date before the November 3, 2022 filing of the ’752 patent. Specifically, Petitioner contends that claims 15–19 recite products containing specific combinations of eight ingredients that are not supported by the parent application of the ’752 patent, for example, Application No. 17/194,437 (“the ’437 Application”) to which the ’752 patent claims priority. Pet. 11. More specifically, Petitioner contends that

the ’437 Application mentions sunflower seed oil twice, each time in a list of more than twenty-five potential emollients and/or structurants, including broad classes such as “plant oils.” Ex. 1074, 5:53-65, 6:47-57. The ’437 Application likewise includes triethyl citrate and magnesium hydroxide in a list of more than twenty-five potential antimicrobials. *Id.*, 6:58-7:7, 8:15-9:20. The ’437 Application also discloses coconut oil and

stearyl alcohol in a list of more than twenty-five potential structurants, including broad classes such as “fatty alcohols.” *Id.*, 5:1-65. The ’437 Application expands these laundry lists by incorporating U.S. Patent Nos. 5,976,514 and 5,891,424 for their disclosure of additional structurants (*id.*, 6:13-16) and U.S. Patent Nos. 4,049,792, 5,019,375, and 5,429,816 for their disclosure of “emulsifiers, distributing agents, antimicrobials, pharmaceutical or other topical active, preservatives, surfactants” (*id.*, 10:57-64). *See* Ex. 1054, 12:25-15:8 (disclosing laundry lists of structurants); Ex. 1055, 3:62-8:64 (disclosing laundry lists of, e.g., gelling agents and emollients).

Pet. 12–13. Petitioner contends that “[s]uch laundry lists do not provide written description support for a particular claimed combination. *Id.* at 13 (citing *In Purdue Pharma L.P. v. Iancu*, 767 F. App’x 918, 924 (Fed. Cir. 2019)).

Next, Petitioner contends Squatch is prior art to the ’752 patent because claims 15–19 are not entitled to an earlier priority date. Pet. 63. Petitioner provides a detailed discussion and claim chart explaining how each claim limitation is disclosed by the combination of Squatch and Sturgis. *Id.* at 63–70. Petitioner contends that

Squatch is a website excerpt disclosing known aluminum-free deodorant formulations that comprise caprylic/capric triglyceride, arrowroot powder, stearyl alcohol, and magnesium hydroxide. Squatch published on a well-known website, which received over 12.5 million views in November 2020. Ex. 1059, 2-5, 11, 13. A POSA looking to formulate new deodorant compositions would have looked to existing formulations and would have understood that commercial deodorant brands typically provided ingredient lists of their products on their websites. Squatch, in particular, was a website that would have been well known to a POSA, inasmuch as Dr. Squatch was a well-known personal care company. *Id.*

Pet. 63–64.

Petitioner adds Sturgis because,

While Squatch describes a deodorant stick comprising ingredients recited in claims 15-19, it does not disclose the quantitative amounts of those ingredients. A POSA therefore would have looked to Sturgis for guidance on the amounts of ingredients when formulating an aluminum-free deodorant stick such as Squatch's deodorant stick. And Sturgis discloses the same amount of liquid triglyceride recited in claims 15-19. Ex. 1002, ¶¶245-248.

Pet. 64.

2. *Patent Owner's Contentions*

Patent Owner contends that Petitioner failed to establish Squash as a printed publication. Prelim. Resp. 25–27. Patent Owner points out that “Squatch (Ex. 1059), is an employee declaration purporting to include images of Dr. Squatch-branded deodorant products at their launch date in November 2020,” however, the images fail to show any information relevant to establishing a publication date. *Id.* at 25–26; *see also id.* at 27 (“Petitioner provides no evidence that the images used in Ground 9 were actually on the website.”).

Patent Owner further contends that Squatch provides “uncorroborated, biased testimony from an employee” and the Petition therefore lacks sufficient evidence to establish the images provided in the Squatch declaration as containing prior art printed publication material. *Id.* at 27–28 (citing *Finnigan Corp. v. ITC*, 180 F.3d 1354, 1366 (Fed. Cir. 1999) (“[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.”); *Nobel Biocare Services AG v. Intradent USA, Inc.*, 903 F.3d 1365, 1377-78 (Fed. Cir. 2018) (“corroboration is required of any witness

whose testimony alone is asserted to invalidate a patent, regardless of his or her level of interest.”).

3. Discussion

Having considered the parties’ positions and evidence of record, summarized above, we find Patent Owner to have, at this stage of the proceeding, the better position.. Accordingly, we determine that there is insufficient evidence to indicate a reasonable likelihood that Petitioner will prevail in establishing that that claims 15–19 would have been obvious over the combination of Squatch and Sturgis for the reasons set forth in the Preliminary Response and summarized above. However, we will make our final determination on these issues on the full record developed during this proceeding. *See Hulu LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29, 11 (PTAB Dec. 20, 2019) (precedential) (“To prevail in a final written decision in an *inter partes* review, the petitioner bears the burden of establishing by a preponderance of the evidence that a particular document is a printed publication.”).

H. Remaining Grounds 1–4

Having found that Petitioner has demonstrated a reasonable likelihood of prevailing for at least one claim, we need not reach Petitioner’s arguments with respect to the remaining grounds in determining whether to institute *inter partes* review. The Supreme Court has held that a final written decision in an *inter partes* review must decide the patentability of all claims challenged in the corresponding petition. *SAS*, 138 S. Ct. at 1348. The USPTO has also provided guidance on implementing *SAS*. *See* Guidance on the Impact of *SAS* on AIA Trial Proceedings (Apr. 26, 2018), <https://www.uspto.gov/patents-application-process/patent-trial-and->

appealboard/trials/guidance-impact-sas-aia-trial (“As required by [*SAS*] decision, the PTAB will institute as to all claims or none,” and “[a]t this time, if the PTAB institutes a trial, the PTAB will institute on all challenges raised in the petition.”); PTAB Consolidated Trial Practice Guide (Nov. 2019), 5–6.

Notwithstanding the above, we direct the parties to the Board’s discussion in the concurrent institution decision for the related IPR2024-01174 proceeding. There we discuss in greater detail Petitioner’s grounds that rely on the Lesniak, Phinney, Bianchi’254, and Anconi references, and Patent Owner’s arguments in response. Because the parties’ arguments on Grounds 1–4 here are substantially similar to the arguments made in IPR2024-01174, the parties may consider our reasoning there for information or guidance.

We therefore grant the Petition and institute trial as to all challenged claims of the ’752 patent on all grounds asserted by Petitioner.

I. Discretionary Denial Under 35 U.S.C. § 325(d)

Patent Owner argues that the Petition should be denied under 35 U.S.C. § 325(d). Prelim. Resp. 29–38. In determining whether to deny institution under § 325(d), we use

the following two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6, 8 (PTAB Feb. 13, 2020) (precedential).

The *Becton, Dickinson* factors provide useful insight into how to apply the framework under 35 U.S.C. § 325(d). *Id.* at 9 (referencing *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph)).

In this proceeding, the parties appear to agree that Lesniak, Phinney, Native, and Sturgis were of record during prosecution. Pet. 6; Prelim. Resp. 29. Bianchi '254 was also before the examiner during prosecution. Ex. 1001, 2; Prelim. Resp. 32–33. Patent Owner, however, acknowledges that Easy Homemade (Ex. 1009) was not part of the record during prosecution of the '752 patent, and therefore, not presented to the Office. Prelim. Resp. 31–32.

Petitioner relies on Easy Homemade in Grounds 6–8 for its disclosure of replacing baking soda with magnesium hydroxide as an antimicrobial in deodorant compositions. *See e.g.* Pet. 51 (citing Ex. 1009, 6, 9). We do not discern that any of Lesniak, Phinney, Bianchi '254, Native, and Sturgis to disclose that use of magnesium hydroxide and therefore Easy Homemade is not cumulative to any of Lesniak, Phinney, Bianchi '254, Native, and Sturgis. Furthermore, Easy Homemade does not appear to be cumulative to any prior art reference relied upon by the examiner during the prosecution of the '752 patent. *See generally* Ex. 1033. Thus, there is new, noncumulative prior art asserted in the Petition, e.g., Easy Homemade, which is relied upon by Petitioner in this proceeding to challenge three of the four independent claims. Under these circumstances, where neither condition of the first part of the *Advanced Bionics* framework is satisfied, we decline to exercise our discretion under § 325(d) to deny the Petition. *Oticon Medical AB v.*

Cochlear Limited (§ II.B and II.C), IPR2019-00975, Paper 15, 20 (October 16, 2019) (precedential as to § II.B and II.C).

III. CONCLUSION

After considering the evidence and arguments presented in the current record, we determine that Petitioner has demonstrated a reasonable likelihood of success in proving that at least one of the challenged claims of the '752 patent is unpatentable. We therefore institute trial on all challenged claims under the grounds raised in the Petition. *See PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (indicating that a decision whether to institute an *inter partes* review “require[s] a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”); 37 C.F.R. § 42.108(a). We emphasize that, at this stage of the proceeding, we have not made a final determination with respect to the patentability of any of the challenged claims.

Any argument not raised in a timely Patent Owner Response to the Petition, or as permitted in another manner during trial, shall be deemed waived even if asserted in the Preliminary Response. *See In re NuVasive, Inc.*, 842 F.3d 1376, 1380–81 (Fed. Cir. 2016) (holding Patent Owner waived an argument addressed in the Preliminary Response by not raising the same argument in the Patent Owner Response). Finally, nothing in this Decision authorizes Petitioner to supplement information advanced in the Petition in a manner not permitted by the Board’s Rules. *See* 37 C.F.R. § 42.123.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to claims 1–19 of the '752 patent based on the unpatentability challenges presented in the Petition; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this decision.

IPR2024-01498
Patent 11,844,752 B2

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