

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROCKWOOL INTERNATIONAL A/S,
Petitioner,

v.

KNAUF INSULATION, INC. and KNAUF INSULATION SPRL,
Patent Owner.

PGR2022-00022
Patent 10,968,629 B2

Before KRISTINA M. KALAN, ELIZABETH M. ROESEL, and
JULIA HEANEY, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

A. Background and Summary

Rockwool International A/S (“Petitioner”) filed a Petition (Paper 4, “Pet.”) seeking a post-grant review of claims 1–19 of U.S. Patent No. 10,968,629 B2 (Ex. 1001, “the ’629 Patent”). Knauf Insulation, Inc., and Knauf Insulation SPRL (collectively, “Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

Exercising the authority delegated to the Board under 35 U.S.C. § 324 and 37 C.F.R. § 42.4(a), we may not institute a post-grant review unless “the information presented in the petition . . . , if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a) (2018). After considering the information presented in the Petition and the Preliminary Response, we determine that Petitioner has not established that the ’629 Patent is eligible for post-grant review.

B. The ’629 Patent (Ex. 1001)

The ’629 Patent discloses a method of manufacturing a mineral fiber insulating board using a formaldehyde free binder to produce an insulating board having strength and dimensional stability characteristics comparable to products containing phenol formaldehyde. Ex. 1001, code (57), 1:13–14, 1:18–24, 1:45–49, 2:3–7.

C. Illustrative Claim

Claim 1 is the only independent claim and is reproduced below.

1. A method of manufacturing a mineral fiber insulating board comprising

i) spraying a formaldehyde free aqueous binder solution onto a plurality of mineral fibers, the aqueous binder solution comprising binder reactants comprising

- a) a reducing sugar reactant; and
- b) an amine reactant,

wherein the reducing sugar reactant is selected from the group consisting of: a reducing sugar; a reducing sugar yielded by a carbohydrate in situ under thermal curing conditions; and combinations thereof,

wherein the percent by dry weight of the reducing sugar reactant with respect to the total weight of the binder reactants in the binder solution ranges from about 73% to about 96%, and

wherein the percent by dry weight of the amine reactant with respect to the total weight of the binder reactants in the binder solution ranges from about 4% to about 27%,

ii) dehydrating the aqueous binder solution such that a dehydrated binder is disposed on the plurality of mineral fibers, and

iii) curing the dehydrated binder on the plurality of mineral fibers to provide the mineral fiber insulating board with a cured binder in about 0.5%–15% by weight as determined by loss on ignition, wherein

- a) the mineral fiber insulating board has a density from about 100 kg/m³ to about 200 kg/m³,

- b) the mineral fiber insulating board has an ordinary compression strength of at least 60 kPa,

- c) the mineral fiber insulating board has a weathered compression strength of at least 40 kPa, and

- d) the mineral fiber insulating board has a change in thickness of less than 2% after autoclave, and wherein the mineral fibers are rock wool mineral fibers.

Ex. 1001, 5:62–6:27 (paragraph breaks adjusted).

D. Asserted Grounds and Evidence

Petitioner asserts the following grounds of unpatentability:

Claims	35 U.S.C. § ¹	Reference/Basis
1–19	102(a)(1)	'726 Publication ²
1–19	112(a)	Lack of sufficient written description

Pet. 6. As support for these grounds, Petitioner submits the Declaration of Allan Myerson, Ph.D. Ex. 1003.

II. ELIGIBILITY FOR POST-GRANT REVIEW

A. Legal Standards

Petitioner has the burden of establishing eligibility for post-grant review. *See Commonwealth Scientific & Indus. Res. Org. v. BASF Plant Science GmbH*, PGR2020-00033, Paper 11 at 7 (PTAB Sept. 10, 2020).

The post-grant review provisions of the Leahy-Smith America Invents Act (“AIA”) apply only to patents subject to the first-inventor-to-file provisions of the AIA. AIA, Pub. L. No. 112–29, 125 Stat. 284 (September 16, 2011), § 6(f)(2)(A) (stating that the provisions of section 6(d) “shall apply only to patents described in section 3(n)(1)”). Patents subject to the first-inventor-to-file provisions are those that issue from applications that contain or contained at any time:

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”), included revisions to 35 U.S.C. §§ 102, 112 that became effective on March 16, 2013. Petitioner’s asserted grounds are based on the versions of 35 U.S.C. §§ 102, 112 applicable after the effective date of the AIA.

² Ex. 1004, US 2010/0086726 A1, published April 8, 2010 (“the ’726 Publication”).

(A) a claim to a claimed invention that has an effective filing date as defined in section 100(i) of title 35, United States Code, that is on or after [March 16, 2013]; or

(B) a specific reference under section 120, 121, or 365(c) of title 35, United States Code, to any patent or application that contains or contained at any time such a claim.

AIA § 3(n)(1).

Determining whether a patent is subject to the first-inventor-to-file provisions of the AIA, and therefore eligible for post-grant review, is straightforward when the challenged patent issued from an application filed before March 16, 2013, or when the challenged patent issued from an application filed on or after March 16, 2013, without any priority claim. The determination is more complex, however, for a patent that issues from a “transition application,” that is, an application filed on or after March 16, 2013, that claims the benefit of an earlier filing date. *See* MPEP § 2159.04.³ Entitlement to the benefit of an earlier filing date under 35 U.S.C. §§ 119, 120, 121, or 365 is premised on disclosure of the claimed invention “in the manner provided by § 112(a) (other than the requirement to disclose the best mode)” in the earlier application. *See* 35 U.S.C. §§ 119(e)(1), 120. Thus, for a patent issuing from a transition application, eligibility for post-grant review depends on whether the patent contains or contained at any time a claim that lacks written description or enabling support in a priority application filed before March 16, 2013.

The application that matured into the ’629 Patent is a transition application because it was filed after March 16, 2013, but claims the benefit of an application filed before March 16, 2013. Specifically, the ’629 Patent

³ Our citations to the Manual of Patent Examining Procedure (“MPEP”) are to the 9th edition, revision 10.2019 (June 2020).

issued from Application No. 15/690,623, filed August 30, 2017 (“the ’623 Application”) as a continuation of Application No. 12/524,512, filed January 25, 2007 (“the Priority Application”).⁴ Ex. 1001, codes (22), (63).

Petitioner asserts two separate bases for post-grant review eligibility. *First*, Petitioner asserts that the Priority Application lacks written description support for a limitation recited in claims presented during prosecution, but not recited in the issued claims of the ’629 Patent. Pet. 1–3, 16–25. *Second*, Petitioner asserts that the Priority Application lacks written description support for a limitation recited in the issued claims of the ’629 Patent. Pet. 1–3, 25, 38–41. We address each of these bases below.

B. Claims Presented During Prosecution

During prosecution of the ’623 Application and the Priority Application, the applicant submitted amended claims that recite an aqueous binder solution having “a solids content of less than about 26.5% by weight” (the “Solids Content Limitation”). Ex. 1002,⁵ 392 (amended claim 24); Ex. 1005,⁶ 68 (amended claim 13).⁷ The Examiner rejected the amended claims under the written description requirement of § 112, finding that the original disclosure lacked support for the Solids Content Limitation.

⁴ The Priority Application was published as the ’726 Publication (Ex. 1004), which Petitioner asserts as anticipatory prior art. Pet. 9 n.1, 26.

⁵ Exhibit 1002 is the file history for the ’623 Application.

⁶ Exhibit 1005 is the file history for the Priority Application. Prosecution of the Priority Application continued after the filing of the ’623 Application, and prosecution of both applications proceeded in parallel.

⁷ The applicant also amended withdrawn claim 24 of the Priority Application to include the Solids Content Limitation. Ex. 1005, 69. The Examiner had previously withdrawn that claim as drawn to a non-elected species, and the applicant later cancelled the claim. *Id.* at 26, 28.

Ex. 1002, 364–65; Ex. 1005, 41–42. In response to the rejection, the applicant further amended the claims to remove the Solids Content Limitation. Ex. 1002, 351, 356; Ex. 1005, 25, 30; *see* Pet. 9–12 (summarizing the prosecution history). The Solids Content Limitation is not recited in the issued claims of the ’629 Patent. Ex. 1001, 5:62–7:5.

Petitioner contends that the Priority Application lacks written description support for the Solids Content Limitation. Pet. 16–25. Patent Owner argues that the temporary presence of the Solids Content Limitation does not trigger the AIA. Prelim. Resp. 4–8. We agree with Patent Owner.

Petitioner relies on statutory language providing that the AIA applies to any patent issuing on an application “that contains *or contained at any time* . . . a claim to a claimed invention that has an effective filing date . . . that is on or after” March 16, 2013. Pet. 13 (quoting AIA § 3(n)(1) with emphasis added). Petitioner does not, however, address the MPEP, which explains that the submission of amended claims directed to new matter does not convert a pre-AIA application to an AIA application.

As 35 U.S.C. 132(a) prohibits the introduction of new matter into the disclosure, an application may not contain a claim to a claimed invention that does not have support under 35 U.S.C. 112(a) in the application (that is directed to new matter). Thus, an application cannot “contain” a claim to a claimed invention that is directed to new matter for purposes of determining whether the application ever contained a claim to a claimed invention having an effective filing date on or after March 16, 2013. . . . [A]mendments to the written description or claims involving new matter are ordinarily entered, but the new matter is required to be canceled from the written description and the claims directed to the new matter are rejected under 35 U.S.C. 112(a)[.] . . . *Therefore, an amendment (other than a preliminary amendment filed on the same day as such application) seeking to add a claim to a claimed invention that is directed to new matter in an application filed on or after March 16, 2013, that, as*

originally filed, discloses and claims only subject matter also disclosed in an earlier application filed before March 16, 2013 to which the application filed on or after March 16, 2013, is entitled to priority or benefit under 35 U.S.C. 119, 120, 121, or 365, *would not change the application from a pre-AIA application into an AIA application.*

MPEP § 2159.02 (emphases added). Relying on the foregoing provision of the MPEP, a panel of the Board held that claims added by amendment and then cancelled after being rejected for containing new matter did not convert a transition application to an application eligible for post-grant review. *Intex Recreation Corp. v. Team Worldwide Corp.*, PGR2019-00015, Paper 7 at 12–14 (PTAB May 14, 2019).

We agree with Patent Owner that the above-quoted guidance from the MPEP and *Intex* applies to the facts presented here. Prelim. Resp. 7. The Solids Content Limitation was added to the claims in both the '623 Application and the Priority Application by amendments filed *after* the respective filing dates of those applications. Ex. 1002, 391–92 (second preliminary amendment filed January 12, 2018 in the '623 Application); Ex. 1005, 66–68 (amendment filed January 13, 2018 with a Request for Continued Examination (“RCE”) in the Priority Application).⁸

⁸ Petitioner makes no argument that either amendment is “a preliminary amendment filed on the same day as such application,” as referenced in MPEP § 2159.02. In the Priority Application, the amendment adding the Solids Content Limitation was filed with an RCE, which “is not the filing of a new application.” MPEP § 706.07(h). In any event, the RCE is outside the priority chain because it was submitted in the Priority Application *after* the filing date of the '623 Application from which the '629 Patent issued. This circumstance provides another reason for rejecting Petitioner’s argument that the amendment filed with the RCE provides a basis for post-grant review eligibility.

As evidenced by the Examiner’s written description rejections, the addition of the Solids Content Limitation resulted in claims directed to new matter. Ex. 1002, 364–65; Ex. 1005, 41–42; *see In re Rasmussen*, 650 F.2d 1212, 1214 (CCPA 1981) (“The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure . . . is § 112, first paragraph, not § 132[, which] prohibits addition of new matter to the original disclosure.”); *see also* MPEP § 2163.06 (“If new matter is added to the claims, the examiner should reject the claims under 35 U.S.C. 112(a) or pre-AIA 35 U.S.C. 112, first paragraph—written description requirement.”).

In response to the Examiner’s written description rejections, the applicant removed the Solids Content Limitation, which does not appear in the issued claims. Ex. 1001, 5:62–7:5; Ex. 1002, 351, 356; Ex. 1005, 25, 30. Under these circumstances and consistent with MPEP § 2159.02 and *Intex*, the temporary presence of the Solids Content Limitation in claims presented during prosecution does not convert the transition application to an AIA application, nor provide a basis for post-grant review eligibility.

C. Issued Claims

Claim 1 of the ’629 Patent recites a method of manufacturing a mineral fiber insulating board using an aqueous binder solution comprising a reducing sugar reactant and an amine reactant,

wherein the percent by dry weight of the reducing sugar reactant with respect to the total weight of the binder reactants in the binder solution ranges from about 73% to about 96%, and

wherein the percent by dry weight of the amine reactant with respect to the total weight of the binder reactants in the binder solution ranges from about 4% to about 27%.

Ex. 1001, 6:4–11 (the “Dry Weight Limitations”).

Claim 1 also recites the physical properties of the mineral fiber insulating board as follows:

- a) the mineral fiber insulating board has a density from about 100 kg/m³ to about 200 kg/m³,
- b) the mineral fiber insulating board has an ordinary compression strength of at least 60 kPa,
- c) the mineral fiber insulating board has a weathered compression strength of at least 40 kPa, and
- d) the mineral fiber insulating board has a change in thickness of less than 2% after autoclave.

Ex. 1001, 6:19–26 (the “Physical Property Limitations”).

Petitioner contends that the ’629 Patent claims lack written description support because the specification “fail[s] to describe the [recited] functional properties across the entire range of reactant proportions claimed.” Pet. 3; *see also* Pet. 38–39 (same argument). Relying on Federal Circuit case law addressing written description support for a functionally-defined genus, Petitioner asserts that “claim 1 of the ’629 Patent claims a genus range of acceptable proportions of sugar reactants and amine reactants.” Pet. 39 (citing *AbbVie Deutschland GmbH v. Janssen Biotech, Inc.*, 759 F.3d 1285, 1299 (Fed. Cir. 2014)). According to Petitioner, “neither the ’629 Patent nor the ’929 Specification incorporated into the ’629 Patent specification, contains functional property data across the entire claimed range of sugar and amine reactants.” Pet. 40.⁹ Petitioner concludes that the inventors “failed to demonstrate that the *entire range* possessed the required functional properties.” Pet. 41 (citing Ex. 1003 ¶ 129).

⁹ “The ’929 Specification” refers to PCT/US2006/028929 (Ex. 1006), which is incorporated by reference in the ’629 Patent. Ex. 1001, 2:58–60.

Patent Owner argues that the Petition fails to address the “structural features” portion of the Federal Circuit’s test for written description of a genus. Prelim. Resp. 14–16. Patent Owner contends that the claims of the ’629 Patent identify the common structural features of the genus by reciting the Dry Weight Limitations, which are supported by the specification. *Id.* at 17–18 (citing Ex. 1002, 358; Ex. 1003 ¶¶ 81, 82). According to Patent Owner, the specification “confirms that the claimed properties are attributable to the composition of the binder solution.” *Id.* at 18. Patent Owner concludes that “the claims themselves recite the common ‘structural features’ . . . that give rise to the claimed functional properties.” *Id.* at 19.

“Written description is a question of fact, judged from the perspective of one of ordinary skill in the art as of the relevant filing date.” *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1063 (Fed. Cir. 2020).¹⁰ The test for adequate written description “is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc). “[T]he hallmark of written description is disclosure.” *Id.* The specification must “show that the inventor actually invented the invention claimed.” *Id.* Although written description is a fact-dependent inquiry, there are “a few broad principles that hold true across all cases,” including

¹⁰ Petitioner presents Dr. Myerson’s testimony that person of ordinary skill in the art “would have been a person with a Bachelor’s degree in Chemistry and 2–3 years of industry experience in binder development for joining fibrous or other particulate materials to form insulating or analogous products,” which is undisputed by Patent Owner. Ex. 1003 ¶ 39. We adopt Dr. Myerson’s undisputed definition for purposes of our Decision.

“that the written description requirement does not demand either examples or an actual reduction to practice.” *Id.* at 1352.

In *AbbVie*, the Federal Circuit addressed the written description requirement for a claimed functionally-defined genus as follows:

When a patent claims a genus using functional language to define a desired result, “the specification must demonstrate that the applicant has made a generic invention that achieves the claimed result and do so by showing that the applicant has invented species sufficient to support a claim to the functionally-defined genus.” . . . We have held that “a sufficient description of a genus . . . requires the disclosure of either a representative number of species falling within the scope of the genus or structural features common to the members of the genus so that one of skill in the art can ‘visualize or recognize’ the members of the genus.”

AbbVie, 759 F.3d at 1299 (quoting *Ariad*, 598 F.3d at 1349, 1350 and *Regents of the University of California v. Eli Lilly & Co.*, 119 F.3d 1559, 1568–69 (Fed. Cir. 1997)).

The Federal Circuit has articulated two ways that a claimed genus can be supported by the written description: “the disclosure of either [1] a representative number of species falling within the scope of the genus or [2] structural features common to the members of the genus so that one of skill in the art can ‘visualize or recognize’ the members of the genus.” *Ajinomoto Co., Inc. v. Int’l Trade Comm’n*, 932 F.3d 1342, 1358 (Fed. Cir. 2019) (bracketed text added); *AbbVie*, 759 F.3d at 1299; *Ariad*, 598 F.3d at 1350 (quoting *Eli Lilly*, 119 F.3d at 1568–69) (quoted in Prelim. Resp. 14–15). The two-part test applies “when a patent claims a genus ***using functional language to define a desired result.***” *AbbVie*, 759 F.3d at 1299 (emphasis added).

We agree with Patent Owner that Petitioner disregards the second part of the Federal Circuit’s two-part test by failing to address whether the specification of the ’629 Patent discloses structural features common to the members of the alleged genus. Prelim. Resp. 15–16; *see* Pet. 39 (quoting *AbbVie*, but omitting the two-part test). More fundamentally, however, we determine that Petitioner fails to establish that the claims of the ’629 Patent recite a “functionally-defined genus” that would trigger the application of the Federal Circuit’s two-part test. *Ajinomoto*, 932 F.3d at 1358, 1360; *AbbVie*, 759 F.3d at 1299; *Ariad*, 598 F.3d at 1349.

Petitioner fails to show that the ’629 Patent claims recite a functionally-defined genus. Petitioner asserts that “claim 1 of the ’629 Patent claims a genus range of acceptable proportions of sugar reactants and amine reactants to the overall binder reactants.” Pet. 39. We agree with Patent Owner, however, that the limitations that Petitioner characterizes as a “genus range” are structural, not functional. *See* PO Resp. 17 (asserting that “[t]he claims themselves identify the[] common ‘structural features,’ specifying the ‘percent by dry weight’ of the ‘reducing sugar reactant’ and ‘amine reactant’ in the ‘binder solution’ used in the claimed method,” citing Ex. 1001, 6:4–11)).

Although Petitioner cites *AbbVie* as support for its contention that claim 1 recites a genus (Pet. 39), the ’629 Patent claims are not like the claims at issue in *AbbVie*, in which the claimed antibodies were defined by their functional properties. *AbbVie*, 759 F.3d at 1292 (“The claims . . . at issue in these appeals define the claimed antibodies by their function.”). The claimed invention in *AbbVie* was “a class of fully human antibodies that are defined by their high affinity and neutralizing activity to human [interleukin] IL–12, a known antigen.” 759 F.3d at 1299. Furthermore, in *AbbVie*, there

was no dispute that the patents-in-suit did not disclose structural features common to the members of the functionally-defined genus. *Id.* Here, in contrast, claim 1 describes the binder solution by its structural components and proportions, not by what it does. Petitioner fails to show that claim 1's recitation of proportions of sugar reactants and amine reactants to the overall binder reactants is a functionally-defined genus. Pet. 39.

Petitioner argues that the '629 Patent disclosure and the '929 Specification do not contain "functional property data across the entire claimed range of sugar and amine reactants" and include "(at most) ***two data points*** for each of the sugar and amine reactants relative to the total binder reactants." Pet. 40–41. Petitioner appears to be addressing the question of whether the patent discloses "a representative number of species falling within the scope of the genus" under the first part of the Federal Circuit's two-part test. *AbbVie*, 759 F.3d at 1299. We are not persuaded by Petitioner's argument because Petitioner has not shown that the '629 Patent claims recite a functionally-defined genus, which is a necessary predicate for the application of the Federal Circuit's two-part test. The only genus Petitioner identifies is a "genus range of acceptable proportions of sugar reactants and amine reactants to the overall binder reactants." Pet. 39. As discussed above, Petitioner's alleged genus is structural, not functional, and does not require application of the Federal Circuit's two-part test for written description support for a "functionally-defined genus." *AbbVie*, 759 F.3d at 1299. Furthermore, as discussed below, there is no requirement for "functional property data" in order to show that the inventors had possession of the claimed invention. Pet. 40.

Petitioner does not dispute that the Priority Application provides written description support for the Dry Weight Limitations, including the

numerical ranges of “from about 73% to about 96%” for the sugar reactant and “from about 4% to about 27%” for the amine reactant. Pet. 28–29. Referring to the Dry Weight Limitations, Petitioner concedes that the Priority Application “incorporates by reference the ‘929 Specification, which describes a number of examples, including ones disclosing this limitation.” *Id.*¹¹ Furthermore, Petitioner concedes that, by incorporating the ‘929 Specification, the Priority Application “teaches use of aqueous binders with the claimed ranges of sugar reactants by weight percent” and “the claimed ranges of amine reactants by weight percent.” *Id.* (citing Ex. 1003 ¶ 81). Dr. Myerson’s testimony demonstrates that Example 1 of the ‘929 Specification discloses seven different binder solutions covering the entire ranges of sugar reactant and amine reactant recited in the Dry Weight Limitations. Ex. 1003 ¶ 81.

Petitioner also does not dispute that the Priority Application provides written description support for the Physical Property Limitations. Petitioner concedes that the Priority Application “expressly teaches obtaining a mineral fiber insulating board with the properties listed in claim 1.” Pet. 30–31. More particularly, Petitioner concedes that the Priority Application expressly teaches obtaining a mineral fiber insulating board having the claimed range of density. Pet. 30 (citing Ex. 1003 ¶ 85). Petitioner concedes that Table 1 of the Priority Application summarizes various properties of the desired mineral fiber board and specifically recites the claimed ranges of ordinary compression strength, weathered compression strength, and change in

¹¹ Petitioner’s concession refers to the ‘726 Publication. Pet. 28–29. Because Petitioner agrees that the ‘726 Publication contains the same specification as the Priority Application and the ‘629 Patent (Pet. 9 n.1, 17 n.2), we refer to the Priority Application in our findings.

thickness after autoclave. Pet. 30–31 (citing Ex. 1003 ¶ 86). Dr. Myerson’s testimony confirms that the Priority Application teaches the Physical Property Limitations. Ex. 1003 ¶¶ 85, 86.

Petitioner’s argument about “(at most) *two data points*” (Pet. 41) is not an argument about whether there is written description support for the numerical ranges recited in the claim, including the ranges of binder reactant proportions and the ranges of physical properties, such as density and compression strength. Instead, Petitioner asserts that the ’629 Patent and the ’929 Specification disclose *only one example* “where the four required properties are demonstrated with respect to the reactant proportions.” *Id.* Petitioner’s argument is inconsistent with the legal standard for written description, which “does not demand either examples or an actual reduction to practice.” *Ariad*, 598 F.3d at 1352. To satisfy the written description requirement, the ’629 Patent inventors were not required “to demonstrate that the *entire range* [of binder reactant proportions] possessed the required functional properties,” as argued by Petitioner. Pet. 41. Again, Petitioner’s argument is inconsistent with the legal standard articulated in *Ariad*, which does not require examples.

Even when a patent claim recites a functionally-defined genus, “[a]dequate written description does not require a perfect correspondence between the members of the genus and the asserted common structural feature.” *Ajinomoto*, 932 F.3d at 1360. Here, the common structural feature is actually recited in the claim, so there is no requirement for any correlation between structure (i.e., the Dry Weight Limitations) and function (i.e., the Physical Property Limitations), as would be the case for a claim that recites a functionally-defined genus. *Id.* (“for a functionally defined genus . . . , we have spoken more modestly of a ‘correlation between structure and

function” (quoting *Ariad*, 598 F.3d at 1350)). Nevertheless, we agree with Patent Owner that the ’629 Patent attributes the claimed physical properties to the composition of the binder solution. Prelim. Resp. 18. Specifically, the specification states that “[i]t is surprising that a formaldehyde free binder can confer the strength and/or dimensional stability that has been found.” Ex. 1001, 2:5–7. This statement provides a sufficient correlation between the claimed physical properties and the binder composition.

Petitioner argues that “disclosing a single data point within a claimed range in [*sic*, is] insufficient to demonstrate possession of the claimed range.” Pet. 41 (citing *Indivior UK Ltd. v. Dr. Reddy’s Laboratories S.A.*, 18 F.4th 1323, at *4 (Fed. Cir. 2021)). Petitioner, however, fails to show a lack of written description support for any of the ranges recited in claim 1 of the ’629 Patent. As discussed above, Petitioner agrees that all of the recited ranges are supported by the Priority Application. Pet. 28–32, 40–41; Ex. 1003 ¶¶ 81, 82, 85, 86. More particularly, Petitioner agrees that Example 1 of the ’929 Specification discloses binder solutions covering the full range of reactant proportions. Pet. 28–29, 40; Ex. 1003 ¶¶ 81, 82. Petitioner agrees that Table 1 of the Priority Application expressly discloses the recited ranges of density, compression strength, weathered compression strength, and change in thickness after autoclave. Pet. 30–31, 41; Ex. 1003 ¶¶ 85, 86. Furthermore, Petitioner does not deny that the example disclosed in the Priority Application falls within the claimed ranges of binder reactant proportions. Pet. 40–41.

In sum, Petitioner fails to show that the Priority Application lacks written description support for the invention claimed in the ’629 Patent.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has not established that the '629 Patent is eligible for post-grant review.

IV. ORDER

It is ORDERED that the Petition is *denied*, and no trial is instituted.

PGR2022-00022
Patent 10,968,629 B2

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