Paper No. _____
Filed: May 20, 2015

Filed on behalf of: Henkel Corporation
By: Anthony A. Tridico
Michele C. Bosch
Finnegan, Henderson, Farabow, Garrett & Dunner, LLP
901 New York Avenue, NW
Washington, D.C. 20001-4413
Telephone: 202.408.4000
Facsimile: 202.408.4400
anthony.tridico@finnegan.com
michele.bosch@finnegan.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT AND TRIAL AND APPEAL BOARD

HENKEL CORPORATION
Petitioner

v.

H.B. FULLER COMPANY
Patent Owner

Case IPR2014-00606
Patent 6,833,404

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE

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I. INTRODUCTION

"A motion to exclude is neither a substantive sur-reply, nor a proper vehicle for arguing whether a reply or supporting evidence is of appropriate scope." *Kyocera Corp. Motorola Mobility LLC v. Softview LLC*, 2014 WL 1382058, at *19 (PTAB Mar. 27, 2014). Nonetheless, H. B. Fuller Company ("Fuller") improperly relies on a motion to exclude in yet another attempt to distract the Board. The fact remains that the instituted claims of the '404 patent are not patentable and that Fuller has failed to elicit any evidence whatsoever to support its untenable position to the contrary.

The issue of claim construction of the preamble "hot melt adhesive" was first raised by Fuller in the patent owner response. (Patent Owner's Resp. at 11.) Fuller raised the claim construction issue because it was necessary to enable Fuller's unsubstantiated argument that 40% wax in the prior art Exxon ethylene copolymer-based composition was inconsistent with such a limitation. (*See*, *e.g*., *id*. at 35-36.) Without placing the preamble in issue, Fuller's contentions fall flat at the outset.

In response to Fuller's contention, Henkel Corporation ("Henkel") explained that the phrase "hot melt adhesive," which provides no structure to the claim and is merely an intended use, is not a claim limitation. (Petitioner's Reply at 3-8.) But even if it is a claim limitation, Fuller's unsupported contention regarding the 40%

wax was not only incorrect but is contrary to the '404 patent itself as well as the prior art. (Petitioner's Reply at 2, 13 (citing '404 patent (Ex. 1001) at claims 2, 14, 20 and 21; Fuller's U.S. Patent No. 5,939,483 (Ex. 1040) at claims 1 and 9; and U.S. Patent No. 5,176,779 (Ex. 1041) at abstract, Examples 12-16).) Thus, Ex. 1040 and Ex. 1041 were merely submitted *in response* to Fuller's arguments in its patent owner reply -- which is entirely proper.

Finally, it is clear that Fuller is using this motion, which it admits is not the proper way to challenge alleged "new" evidence in a reply, to again contend that Henkel has failed to meet its burden. (*See* Motion at 11 n.4.) But Fuller is wrong. Henkel proved that the Exxon composition meets every element of the claim, including the preamble. (Exxon Ref. (Ex. 1003) at 2, FN1; Hsu Decl. (Ex. 1015) at ¶¶ 15-26; Litz (1005) at 3-4; '404 patent (Ex. 1001), col. 1, ll. 21-24.) And, as pointed out in Henkel's reply, Fuller offered only unconvincing attorney argument to contend otherwise.

II. EX. 1040 AND EX. 1041 WERE SUBMITTED IN RESPONSE TO THE PATENT OWNER'S ARGUMENTS AND DO NOT "CHANGE" THE GROUNDS OF INSTITUTED REVIEW

In *Kyocera Corp. v. Softview*, the Board denied the patent owner's motion to exclude new evidence, reasoning that the "Petitioner was entitled to rebut [the] Patent Owner's arguments concerning [claim construction]" and that the additional references "were not presented as new challenges to the claims, but to support that

[a limitation] was well known in the art." 2014 WL 1382058 (PTAB Mar. 27, 2014.) at *19. Namely, the Board considered important whether a new reference may bring in any "change" to the grounds on which the Board instituted review. *Id*. ("In this case, however, the references are not applied specifically to the claims, and the grounds on which the Board instituted review did not change.").

In its petition, Henkel demonstrated, and the Board agreed, that the Exxon hot melt adhesive composition meet all the limitations of the claims. (Exxon Ref. (Ex. 1003) at 2, FN1; Hsu Decl. (Ex. 1015) at ¶¶ 15-26; Litz (1005) at 3-4; '404 patent (Ex. 1001), col. 1, ll. 21-24.) Fuller responded by arguing that the preamble "hot melt adhesive" was a limitation and then suggested without any evidence to support its claim that, because the Exxon composition contained 40% wax with an ethylene copolymer, the composition might not function as a hot melt adhesive. (Patent Owner's Resp. at 35-36.) Henkel's reply exposed the flaws in Fuller's argument by pointing to the '404 patent itself, which *claims* 40% wax in an ethylene copolymer hot melt adhesive, as well as pointing to Ex. 1040 and Ex. 1041 to further support that such compositions were well known in the art. (Petitioner's Reply at 2, 13.) Because Henkel was responding to Fuller's argument, the exhibits to Henkel's reply were not untimely. Here, like *Kyocera*, this "new" evidence was directly responding to a position of the patent owner that the petitioner could not have addressed previously. Moreover, Ex. 1040 and Ex.

1041 are not applied specifically to the claims, and the grounds on which the Board instituted review did not change.

Kyocera, which was recently affirmed by the Court of Appeals for the Federal Circuit, is consistent with 37 C.F.R. § 42.23(b) and with other Board decisions that have denied motions to exclude on the ground that the petitioner merely rebutted or simply addressed the arguments raised in the patent owner's response. *See, e.g*., *Vibrant Media, Inc. v. General Electric Co*., 2014 WL 295703, at *19-20 (PTAB Jun. 26, 2014). Indeed, as the Board has noted, "[t]he need for relying on evidence not previously discussed in the petition may not exist until a certain point has been raised in the patent owner response..." *Id.* at *19. Just as here, Henkel had no reason to rely on Ex. 1040 and Ex. 1041 until Fuller raised for the first time the argument regarding 40% wax in the prior art.

The present case is also quite distinct from *Corning Inc. v. DSM IP Assets B.V.*, 2014 WL 1783279 (PTAB May 1, 2014), and *Baxter Healthcare v. Millenium*, 2014 WL 5113140 (PTAB Oct. 13, 2014), cited by Fuller. In those cases, the petitioners in submitting a reply brief attempted to add (in *Baxter*) or replace (in *Corning*) "experimental evidence" to show that a claim limitation was "inherent" in the prior art. *Baxter*, 2014 WL 5113140; *Corning*, 2014 WL 1783279, at *9. In *Corning*, the new evidence was deemed to improperly "restart the case," and in *Baxter*, the Board noted that the petitioner could have presented

the experimental evidence with its original petition. *Corning*, 2014 WL 1783279, at *9; *Baxter*, 2014 WL 5113140. Thus, in both cases, the Board held that the petitioner did "more than respond to" the patent owner's response. The present case is quite different. Henkel cited Ex. 1040 and Ex. 1041 in direct reply to Fuller's unsupported contentions to show the state of the art regarding the use of 40% wax in hot melt adhesives.

III. FULLER IMPROPERLY USES THIS MOTION TO REARGUE ITS CASE

"A motion to exclude is not a mechanism to argue that a reply contains new arguments or relies on evidence necessary to make out a prima facie case. A motion to exclude, for instance, must state why the evidence is inadmissible (e.g., based on relevance or hearsay), identify the corresponding objection in the record, and explain the objection. *See* 37 C.F.R. § 42.64(c); Office Patent Trial Practice Guide, 77 Fed. Reg. [48,786,] 48,767. Whether a reply contains arguments or evidence that are outside the scope of a proper reply under 37 C.F.R. § 42.23(b) is left to [the Board's] determination." *Vibrant*, 2014 WL 2965703, at *19.

Here, Fuller improperly uses this motion to reargue its case and again mischaracterize the record by suggesting that Henkel submitted Ex. 1040 and Ex. 1041 "in an apparent attempt to meet its burden of proof" and that "if [Henkel] believe it had met its burden of proof, [Henkel] should have simply pointed to the

existing record." (Motion at 7.) Indeed, Fuller argues that Ex. 1040 and Ex. 1041 are "the only" evidence supporting Henkel's position that 40% wax in an ethylene copolymer-based composition is consistent with the prior art. (*Id*.)

Henkel, however, did meet its burden of proof, and unlike Fuller, Henkel provided evidentiary support. Specifically, Henkel explained and provided expert testimony supporting the fact that the Exxon composition is a hot melt adhesive meeting all the limitations of the claims. (Exxon Ref. (Ex. 1003) at 2, FN1; Hsu Decl. (Ex. 1015) at ¶¶ 15-26; Litz (1005) at 3-4; '404 patent (Ex. 1001), col. 1, ll. 21-24.) Moreover, Henkel pointed to evidence of record – i.e., the '404 patent itself, which claims a hot melt adhesive comprising 40% wax, an ethylene copolymer, and a tackifying resin having a glass transition temperature (T_g) of greater than 65°C. (Reply at 2, 13; *see also* '404 patent (Ex. 1001) at claims 2, 14, 20 and 21.)

Fuller also improperly uses this motion in an attempt to attack the sufficiency of the evidence. *See* Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767. For example, Fuller tries to downplay the teachings in Ex. 1040 and Ex. 1041 by contending that these references are not part of the prior art as a whole because they allegedly do not disclose hot melt adhesives with a tackifying resin having a glass transition temperature (T_g) of greater than 65°C. (Motion at 9-10.) But Fuller, not surprisingly, relies entirely on attorney argument to support this

allegation ignoring the fact that the compositions disclosed in Ex. 1040 and Ex. 1041 are broad enough to encompass a number of resins, including tackifying resins having a glass transition temperature (T_g) of greater than 65°C. (*See*, *e.g.*, Fuller's U.S. Patent No. 5,939,483 (Ex. 1040) at claim 1; U.S. Patent No. 5,176,779 (Ex. 1041) at abstract.)

IV. A MOTION TO EXCLUDE IS AN IMPROPER PROCEDURE FOR CHALLENGING EX. 1040 AND EX. 1041

Finally, "[a] motion to exclude is not a mechanism to argue that a reply contains new arguments or relies on evidence necessary to make out a prima facie case." *Vibrant*, 2014 WL 2965703, at *19 (emphasis added). This is because the rule defines motion-to-exclude practice only in the context of challenging "admissibility." Office Patent Trial Practice Guide, 77 Fed. Reg. at 48,767. The *Corning* opinion, cited by Fuller itself, similarly states that "[t]he proper way to challenge 'new' evidence in a reply is to bring it to the Board's attention in a conference call or during oral argument." *Corning*, 2014 WL 1783279, at *4 n.3. Here, Fuller recognizes that its motion is improper (Motion at 11 n.4) but nevertheless, forces Henkel and the Board to waste time and resources with an issue that could easily have been resolved with a simple discussion with the Board. Fuller's tactics – to ignore the clear rules of the Board in an attempt to reargue its

case – should not be condoned and its motion should be denied outright, at least for this reason.

V. CONCLUSION

For the reasons above, the Board should deny Fuller's motion to exclude.

Dated: May 20, 2015

Respectfully submitted,

/Anthony C. Tridico/

Anthony C. Tridico (Reg. No. 45,958)
Finnegan, Henderson, Farabow,
Garrett & Dunner, LLP
(202) 408.4000
Counsel for Petitioner Henkel Corporation

APPENDIX 1: LIST OF EXHIBITS

Exhibit No.	Description	Previously Submitted
1001	U.S. Patent No. 6,833,404 ("the '404 patent")	X
1002	Eastotac Hydrocarbon Resins Brochure by the Eastman Company (Aug. 1992) ("the Eastotac Brochure")	X
1003	Specialty Polymers for Adhesives and Sealants by the Exxon Chemical Company (Oct. 1990) ("the Exxon Reference")	X
1004	U.S. Patent No. 5,256,717 (issued Oct. 26, 1993) ("the '717 patent")	X
1005	Litz, R.J., *Developments in Ethylene-Based Hot Melt Adhesives*, Adhesives Age 17(8):35-38 (1974) ("Litz")	X
1006	Clark, T., Bookbinding with Adhesives (3rd ed. McGraw-Hill, UK 1994) ("Clark"), p. 1	X
1007	Alger, M.S., Polymer Science Dictionary (Elsevier Applied Science, New York 1989) ("Alger"), p. 115	X
1008	Lee, S.M., Dictionary of Composite Materials Technology (CRC Press, Technology & Engineering 1995) ("Lee"), p. 43	X
1009	U.S. Patent No. 4,233,432 (issued Nov. 11, 1980) ("the '432 patent")	X
1010	Young, R.J. & Lovell, P.A., Introduction to Polymers (2nd ed., Chapman & Hall, New York 1991) ("Young"), pp. 10-11, 292	X
1011	U.S. Patent No. 5,397,843 (issued Mar. 14, 1994) ("the '843 patent")	X
1012	U.S. Patent No. 5,171,628 (issued Dec. 15, 1992) ("the '628 patent")	X
1013	Publication No. WO 97/09393 (published Mar. 13, 1997) ("the '393 publication")	X
1014	Handbook of Adhesives (ed. Irving Skeist, Van Nostrand Reinhold Co. 1977) ("Skeist"), pp. 495-98	X

1015	Declaration of Shaw Ling Hsu, Ph.D. ("the Hsu Declaration")	X
1016	Curriculum Vitae of Shaw Ling Hsu, Ph.D. ("Hsu CV")	X
1017	American Society for Testing and Materials, Standard Test Method for Softening Point by Ring-and-Ball Apparatus, E-67, from Annual Book of ASTM Standards (1967) ("ASTM E-28")	X
1018	Kraus et al., Tack and Viscoelasticity of Block Copolymer Based Adhesives, J. Adhesion 10:221-36 (1979) ("Kraus")	X
1019	U.S. Patent No. 5,331,033 (issued Jul. 19, 1994) ("the '033 patent")	X
1020	Declaration of Robert C. Schmidt, Jr.	
1021	Current curriculum vitae of Robert C. Schmidt, Jr.	
1022	Eastman Chemical Brochure titled "World of Eastman Chemicals" dated January 1989, Publication No. P-160F	
1023	Eastman Chemical Co. Price List Effective October 1, 1994, Replacing Price List of April 1, 1992	
1024	Eastman AQ Branched Polyesters Brochure dated September 1997, Publication No. WA-62B	
1025	Eastman Chemical Sales Brochure dated February 1993, Publication No. WA-21	
1026	Exxon Chemical Price List of Escorez Tackifying Resins effective March 1, 1988	
1027	Exxon Chemical Material Safety Data Sheet of Escorez 7000 Series dated October 6, 1988	
1028	Letter from Exxon Chemical regarding Samples of Escorez Tackifying Resin ECR-149B dated April 12, 1990	
1029	Letter from Exxon Chemical regarding Updated Version of Escorez Grade Resins dated October 2, 1991	

1030	Exxon Chemical Shipping Order of Certain Escorez Tackifying Resins dated February 24, 1992	
1031	Exxon Chemical TDS of Escorez 2000 series dated September 1993	
1032	Exxon Chemical TDS of Escorez 5000 series dated September 1993	
1033	Exxon Chemical Sales Brochure dated March 1994	
1034	Declaration of Charles W. Paul	
1035	Current curriculum vitae of Charles W. Paul	
1036	Eastman Chemical Eastotac Hydrocarbon Resins dated November 1994, Publication WA-3C	
1037	Exxon Chemical Escorez Tackifiers Brochure dated April 1992	
1038	Transcript of Telephone Conference Call of October 29, 2014	X
1039	Transcript of the deposition of Shaw Ling Hsu of January 14, 2015	X
1040	U.S. Patent No. 5,939,483 (issued Aug. 17, 1999)	X
1041	U.S. Patent No. 5,176,779 (issued Jan. 5, 1993)	X

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e) and 42.105(a), I hereby certify that a true and correct copy of the foregoing **PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE** was served on May 20, 2015, via electronic mail on counsel of record for the Patent Owner at the correspondence address of the Patent Owner as follows:

Walter C. Linder, Esq.
Timothy E. Grimsrud, Esp.
Faegre Baker Daniels LLP
2200 Wells Fargo Center
90 S. Seventh Street
Walter.Linder@FaegreBD.com
Tim.Grimsrud@FaegreBD.com

Dated: May 20, 2015

/Anthony C. Tridico/
Anthony A. Tridico (Reg. No. 45,958)

Counsel for Petitioner Henkel Corporation