Paper No. _____
Filed: May 29, 2015

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HENKEL CORPORATION
Petitioner

v.

H.B. FULLER COMPANY
Patent Owner

Patent No. 6,833,404
Filing Date: APRIL 27, 1999
Issue Date: DECEMBER 21, 2004
Title: HOT MELTS UTILIZING A HIGH GLASS TRANSITION TEMPERATURE SUBSTANTIALLY ALIPHATIC TACKIFYING RESIN

Inter Partes Review No. IPR2014-00606

PATENT OWNER REPLY TO MOTION TO EXCLUDE EVIDENCE PURSUANT TO 37 C.F.R § 42.64

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REGULATIONS

I. Introduction

Contrary to Petitioner's assertion, Exhibits 1040 and 1041 were not properly submitted "in response" to Patent Owner's arguments. (Paper 32 at 2-5.) In its Petition, Petitioner treated the "hot melt adhesive" preamble as a limitation to the claims of the '404 patent. It was only after Patent Owner's Response pointed out that Petitioner failed to recognize that the footnote 1 composition's use of an ethylene copolymer and 40% wax is inconsistent with the '404 patent that Petitioner tried to introduce Exhibits 1040 and 1041. Petitioner's belated reliance on Exhibits 1040 and 1041 is untimely and prejudicial to Patent Owner. Accordingly, the Board should exclude Exhibits 1040 and 1041.

II. The "Hot Melt Adhesive" Issue Is Not Unanticipated

Contrary to Petitioner's assertion, the issue of whether the "hot melt adhesive" preamble constitutes a limitation was not first raised by Patent Owner. Instead, in each claim chart included in its Petition, Petitioner itself separately identified the "hot melt adhesive" preamble as an independent limitation. (Paper No. 1 at 26-29, 36-38, 40, 43, 49-54.) In the Exxon Reference claim charts specifically, Petitioner cited "Exxon Reference at 2, FN1" as the sole support for its argument that the Exxon Reference discloses a "hot melt adhesive." (*Id.* at 36-38.) Patent Owner responded by explaining that relying on the footnote 1 composition without analysis or support was insufficient to meet Petitioner's

burden of proof, especially given that the footnote 1 composition is inconsistent with the teachings of the '404 patent. (Paper No. 23 at 30-38.) In its Reply, Petitioner for the first time cited Exhibits 1040 and 1041 in an attempt to support its new assertion that "ethylene copolymer hot melt adhesives with 40% wax are consistent with the art as a whole." (Paper No. 24 at 13 n.4.)

Petitioner's belated disclosure of and reliance on Exhibits 1040 and 1041 is inappropriate. Exhibits 1040 and 1041 constitute improper "new evidence that could have been presented in [Petitioner's] prior filing." *Intri-Plex Techs., Inc. v. Saint-Gobain Performance Plastics Reconl Ltd.*, IPR2014-00309, Paper 83 at 13 (PTAB Mar. 23, 2015); Trial Practice Guide, 77 Fed. Reg. at 48767. As stated above, in its Petition, Petitioner asserted that the Exxon Reference disclosed the claimed "hot melt adhesive" in its claim charts. Thus, at the time it filed the Petition, Petitioner was well aware that it needed to prove the reference taught this limitation. Petitioner chose to rely on a single citation to the Exxon Reference—"Exxon Reference at 2, FN1"—rather than on experimental testing, analysis, or evidence of the "art as a whole" in support of its argument. There is no reason why Petitioner could not have presented Exhibits 1040 and 1041 in its Petition. Indeed, "although Petitioner's newly submitted evidence might have been stimulated by Patent Owner's Response to the Petition . . . it was Petitioner who decided to rely on the declaration of its expert without [Exhibits 1040 and 1041]."

Baxter Healthcare v. Millenium Biologix, LLC, IPR2013-00582, Paper 32 at 6 (PTAB Oct. 13, 2014).

The cases cited by Petitioner are not on point. For example, in *Kyocera*, the petitioner's new evidence either responded to the patent owner's evidence of non-obviousness, which it could not have identified prior to filing its Petition, or relied on "references [the expert] relied upon in his earlier declaration." *Kyocera Corp. Motorola Mobility LLC v. Softview LLC*, IPR2013-00004, Paper 53 at 33-35 (PTAB Mar. 27, 2014). In *Vibrant Media*, in its motion to exclude petitioner's new evidence, the patent owner did not address arguments that it made in its response which may have "triggered" the new evidence submitted in the petitioner's reply, and the Board denied the motion to exclude on that basis. *Vibrant Media, Inc. v. Gen. Elec. Co.*, IPR2013-00170, Paper 56 at 32 (PTAB June 26, 2014). Here, far from being used to address an unanticipated issue, Petitioner is using Exhibits 1040 and 1041 to try and support an assertion expressly raised in the Petition—namely, that the footnote 1 composition is a hot melt adhesive. Thus, Petitioner was aware of the issue at the time it filed its Petition and should have submitted Exhibits 1040 and 1041 in the first instance.

III. Petitioner's Submission of New Evidence in its Reply is Prejudicial

Moreover, Petitioner should not be permitted to submit Exhibits 1040 and 1041 to overcome its failure to meet its burden of proof. Trial Practice Guide, 77

Fed. Reg. at 48767 ("Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a *prima facie* case . . . ."). As explained above, Petitioner provided no evidence in its Petition showing that the footnote 1 composition in the Exxon Reference is a "hot melt adhesive" other than pointing to the composition itself. (*See* Paper No. 23 at 31-38.) Petitioner's expert, Dr. Hsu, also failed to consider the discrepancy between the footnote 1 composition's use of 40% wax and the '404 patent's teaching that the wax should not exceed 30% when working with an ethylene copolymer. (*See id.* at 37.) Having made a strategic choice not to analyze the footnote 1 composition or to review the "art as a whole" in its Petition, Petitioner should not be allowed to submit new evidence in its Reply. *Baxter Healthcare,* IPR2013-00582, Paper 32 at 6 (not considering evidence after finding "it was Petitioner who decided to rely on the declaration of its expert without experimental evidence in support of its inherent anticipation argument").

IV. Patent Owner Does Not Use the Motion to Exclude to Reargue Its Case

Petitioner also incorrectly asserts that "Fuller improperly uses this motion to reargue its case." (Paper 32 at 5-7.) As already explained, Patent Owner is properly objecting to the new exhibits as untimely and prejudicial. Petitioner's late submission of evidence not only improperly raises new evidence but also prevents Patent Owner from responding to the evidence on the merits. *Saint-Gobain*,

IPR2014-00309, Paper 83 at 13 ("By waiting and filing its expert declaration after Saint-Gobain filed its Patent Owner Response (Paper 21), Intri-Plex effectively precluded Saint-Gobain from addressing Dr. McCarthy's Declaration in its Reponse."). Accordingly, Exhibits 1040 and 1041 should be excluded.

V. Conclusion

For the foregoing reasons, Patent Owner respectfully requests that the Board exclude Petitioner's Exhibits 1040 and 1041 as untimely and unfairly prejudicial.

Dated: May 29, 2015

Respectfully Submitted,

/ Timothy E. Grimsrud/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6, I hereby certify that I caused a true and correct copy of the **Patent Owner Reply to Motion to Exclude Evidence Pursuant to 37 C.F.R. § 42.64** to be served via electronic mail on the following:

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Dated: May 29, 2015

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