Paper No. 34
Filed: June 8, 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'S OBJECTIONS TO PETITIONER'S DEMONSTRATIVE EXHIBITS

Pursuant to the Board's May 11, 2015 Order (Paper 31), Patent Owner H.B. Fuller Company ("Patent Owner") objects to particular portions of the demonstrative exhibits served by Petitioner. The slides to which Patent Owner is objecting have been submitted as Ex. 2006. As required by the Board's May 11, 2015 Order, the parties have met and conferred in an attempt to resolve objections, and the parties were unable to resolve the objections specified below.

Patent Owner's objections are made pursuant to the Board's guidelines regarding the appropriate content of demonstrative exhibits, which cannot "rely on evidence that, although it is in the record, was never specifically discussed in any paper before the Board" and "are not an opportunity for additional briefing." *St. Jude Med., Cardiology Div., Inc. v. The Bd. of Regents of the Univ. of Mich.*, IPR2013-00041, Paper 65 at 2-3 (P.T.A.B. Jan. 27, 2014). "Arguments that have not been made previously cannot be made at the trial hearing, and thus, cannot be in a demonstrative exhibit." *Id.* at 3. "Impermissible . . . are mischaracterizations of the record, or citations to the record that do not support the content of a demonstrative exhibit." *Id.* at 3. It is improper for slides to include "characterizations of evidence that are not found in the citations provided" or "characterizations that are not supported adequately by the citations to the record appearing on the slides." *Id.* at 3-4. This is in keeping with the Board's guidance that:

> "It is unfair to the other party to bring a new twist or angle into a party's case at such a late stage of the proceeding. That would include different characterizations of the evidence and different inferences drawn from the evidence. If certain testimony was not developed, discussed, or explained in a party's papers, it may not be developed, discussed, explained, or summarized, for the first time, in the form of demonstrative slides at final oral hearing."

CBS Interactive Inc. v. Helferich Patent Licensing LLC, IPR2013-00033, Paper 118 at 3 (P.T.A.B. Oct. 23, 2013).

Patent Owner submits the following objections to particular portions of the demonstrative exhibits served by Petitioner.

- **Slide 6 (Ex. 2006-1):** Patent Owner objects to the right-hand portion of this slide, where Petitioner has equated claim limitations with particular interpretations. Patent Owner objects to this portion of the slide because it is an attempt to present new claim construction arguments regarding the meaning of the limitations in question that Petitioner has not previously presented in any paper of this proceeding and that differ from the claim constructions presented in the Petition.
- **Slide 9 (Ex. 2006-2):** Patent Owner objects to the inclusion of Figure 2 of Litz (Ex. 1005) and the associated passage highlighting the discussion of Figure 2. Patent Owner's objection is based on the fact that Figure 2 of Litz was never cited or discussed in the Petition or Petitioner's Reply and is also

being used to try and support a new argument. *See CBS Interactive Inc. v. Helferich Patent Licensing LLC*, IPR2013-00033, Paper 118 at 3 (P.T.A.B. Oct. 23, 2013) ("If certain testimony was not developed, discussed, or explained in a party's papers, it may not be developed, discussed, explained, or summarized, for the first time, in the form of demonstrative slides at final oral hearing.").

- **Slide 11 (Ex. 2006-3):** Patent Owner objects to the annotation added to Table 3 by Petitioner—"H-142" with an arrow pointing to "*Eastotac* resin" in Table 3—because it is a characterization of the evidence not found in the citations provided on this slide, and is also an attempt to present new arguments that Petitioner has not previously presented in any paper of this proceeding.
- **Slide 22 (Ex. 2006-4):** For the same reasons identified with respect to slide 9, Patent Owner objects to the inclusion of Figure 2 of Litz (Ex. 1005), because Figure 2 was never specifically discussed in any paper before the Board and is being used to try and support a new argument. Patent Owner also objects to the second bullet point of this slide, because it is an attempt to present a new argument and is a characterization not found in the citations Petitioner provided on this slide.

- **Slide 27 (Ex. 2006-5):** Patent Owner objects to the reference to Kraus (Ex. 1018) in the bullet point of this slide and to the inclusion of paragraph 22 of Dr. Hsu's declaration (Ex. 1015) on this slide because these are attempts to present a new argument and are mischaracterizations of the record because neither Ex. 1018 nor paragraph 22 of Ex. 1015 are found in the portions of the record Petitioner cites on this slide (Petition at pages 41-43 or Petitioner's Reply at page 14).
- **Slide 28 (Ex. 2006-6):** For the same reasons identified with respect to slides 9 and 22, Patent Owner objects to the inclusion of Figure 2 of Litz (Ex. 1005) and the associated passage highlighting the discussion of Figure 2, because this evidence was never specifically discussed in any paper before the Board and is being used to try and support a new argument.
- **Slide 31 (Ex. 2006-7):** For the same reasons identified with respect to slide 6, Patent Owner objects to the right-hand portion of this slide, where Petitioner has equated claim limitations with particular interpretations, because it is an attempt to present new claim construction arguments regarding the meaning of the limitations in question that Petitioner has not previously presented in any paper of this proceeding and that differ from the claim constructions presented in the Petition. Patent Owner also objects to the title of this slide ("All Claimed Compositions Will Function As Hot Melt

Adhesives") and the first bullet point and citation to paragraph 15 of Dr. Hsu's declaration (Ex. 1015), as this is also a new argument and a characterization not found in the citations to the record Petitioner provided on this slide.

Dated: June 8, 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's Objections To Petitioner's Demonstrative Exhibits and Exhibit 2006** to be served via electronic mail on the following:

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Dated: June 8, 2015

By: */Debbie Cairns /*
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