

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HENKEL CORPORATION,
Petitioner,

v.

H.B. FULLER COMPANY,
Patent Owner.

IPR2014-00606
Patent 6,833,404 B2

Held: June 10, 2015

BEFORE: BRIAN P. MURPHY, CHRISTOPHER L.
CRUMBLEY, and DONNA M. PRAISS, Administrative Patent
Judges.

The above-entitled matter came on for hearing on Wednesday,
June 10, 2015, commencing at 10:02 a.m., at the U.S. Patent and
Trademark Office, 600 Dulany Street, Alexandria, Virginia.

APPEARANCES:

ON BEHALF OF THE PETITIONER:

ANTHONY C. TRIDICO, Ph.D.
Finnegan Europe LLP
16 Old Bailey
London EC4M 7EG
United Kingdom

ON BEHALF OF PATENT OWNER:

TIMOTHY E. GRIMSRUD, ESQUIRE
Faegre Baker Daniels LLP
2200 Wells Fargo Center
90 S. Seventh Street
Minneapolis, Minnesota 55402-3901

P R O C E E D I N G S

1 - - - - -

2 JUDGE MURPHY: Good morning, everyone. Please
3 be seated. In case you were wondering, I'm Judge Murphy.
4 Welcome to the Board. It's nice to see you, a reasonably full
5 courtroom.

6 All right. We're going to hear arguments today in the
7 case of IPR2014-00606, Henkel Corp. v. H.B. Fuller. This case
8 concerns the patentability of certain claims in U.S. Patent
9 Number 6,833,404.

10 Counsel for the parties, please introduce yourselves
11 beginning with the Petitioner.

12 MR. TRIDICO: Good morning. Anthony Tridico
13 representing Henkel Corp., Petitioner.

14 MS. BOSCH: Michele Bosch. I'm also representing
15 Henkel.

16 MS. CHLEBOWSKI: Mary Chlebowski also
17 representing Henkel.

18 JUDGE MURPHY: Welcome, good morning.

19 MR. LINDER: Good morning, Your Honors. I'm
20 Walter Linder, lead counsel for Patent Owner H.B. Fuller.

21 MR. GRIMSRUD: Timothy Grimsrud, counsel for
22 Patent Owner H.B. Fuller. And with us today, Your Honor, is

1 Linzey Erickson, also from our law firm of Faegre Baker Daniels,
2 and Kristi Halloran from H.B. Fuller.

3 JUDGE MURPHY: Welcome. Thank you, counsel.

4 All right. So pursuant to our trial hearing order, each
5 side is going to have one hour for their argument. Petitioner will
6 argue first and please let us know upfront if you're going to
7 reserve any time.

8 Mr. Tridico, are you going to be --

9 MR. TRIDICO: Yes, thank you.

10 JUDGE MURPHY: All right. Let us know what your
11 rebuttal time might be.

12 Then the Patent Owner will have their turn, but no
13 rebuttal time. So you will each have one hour.

14 I'll remind everybody that Petitioner bears the burden of
15 proof by a preponderance for any assertion of unpatentability. I
16 will also remind the parties and counsel that the hearing is open
17 to the public. We'll have a transcript of the hearing. It will be
18 available to the public.

19 One last request from me on behalf of the panel,
20 counsel, when you refer to demonstratives during your argument,
21 if you could please reference the slide number so we have a clear
22 record so our court reporter can follow you, so we can follow it
23 when we read the transcript after the argument.

24 Okay. Any questions? All right. Mr. Tridico?

1 MR. TRIDICO: Thank you. Before I start, can Mary
2 approach and provide copies of the slides?

3 JUDGE MURPHY: Of course. Thank you.

4 MR. TRIDICO: Good morning. Thank you. Anthony
5 Tridico for Petitioner Fuller.

6 As we get started, I would like to emphasize four points
7 that I think are important as we go through the case and for the
8 Board to consider as we move forward. The first is --

9 JUDGE MURPHY: Mr. Tridico, are you going to
10 reserve any --

11 MR. TRIDICO: Oh, yes. Sorry about that, yes. May I
12 reserve 30 minutes?

13 JUDGE MURPHY: 30 minutes. Okay.

14 MR. TRIDICO: Yes, thank you.

15 As I mentioned, four key points that I'd like to bring to
16 the Board's attention. First, is that in instituting this IPR the
17 Board determined that Henkel met its burden of proof from the
18 beginning when it was instituted.

19 Now, since that time Fuller has provided no expert
20 testimony, no evidence of record and nothing to refute the
21 testimony that was put forth to the Board that you considered
22 when you instituted the IPR.

23 The second point, hot melt adhesive is merely an
24 intended use. If we begin with Federal Circuit case law and the
25 presumption provided by the Fed Circuit in *Symantic Corp.*,

1 whether or not a preamble is a limitation. If there is a clear --
2 unless, excuse me, there is a clear instance in the prosecution
3 history where the preamble has been used to distinguish over the
4 prior art or to argue patentability or it references a limitation, an
5 antecedent basis in the body of the claim, then generally the
6 preamble is not a limitation. It is clear that neither of those have
7 taken place in this case.

8 Third, Fuller can't deny that the Eastotac reference and
9 the Exxon reference meet all of the limitations of the body of the
10 claim.

11 Now, they've made some arguments trying to equate,
12 which are examples provided in the prior art, with a picking and
13 choosing, but this is a very different situation. I think the prior art
14 clearly directs one to the examples in the references and there's no
15 denying that all of the claim limitations are present in those
16 references.

17 And, fourth, Fuller never provided any testimony and
18 even failed to question Dr. Hsu about his opinion regarding the
19 obviousness of Claim 27. So the evidence put forth to begin the
20 case in which the Board instituted remains today the only
21 evidence unquestioned with regard to the obviousness of Claim
22 27. Okay?

23 JUDGE MURPHY: All right. Mr. Tridico, why don't
24 you start with the preamble issue, please.

25 MR. TRIDICO: Okay. No problem.

1 So a little background, if I may, as we go through the
2 preamble issue. This is slide 3 of our demonstratives.

3 Both parties agree that hot melt adhesives are broadly
4 defined, that hot melt adhesives are adhesive materials that are a
5 hundred percent solid thermoplastic material.

6 Now, it's very simple, like any other adhesive, except
7 they flow when they're heated and then they form the final bond
8 as they return to ambient temperature and solidify. So you have
9 thermoplastic materials in adhesive, flows when heated, bonds as
10 it returns to ambient material or ambient temperature. That's
11 agreed the definition of a hot melt adhesive.

12 The parties also agree that they typically or generally
13 comprise polymers, tackifying resins and waxes. Now, in their
14 most basic form they're polymers and tackifying resins as is
15 established by the art of record. Often they do have waxes and
16 quite often they have waxes, but not all.

17 JUDGE MURPHY: Well, take me through the
18 evidence on that because for me that's one of the questions. In
19 other words, if you look at Claim 22.

20 MR. TRIDICO: Claim 22. Yes, slide 4.

21 JUDGE MURPHY: Our independent claim or our first
22 independent claim, has two limitations, A is a hydrocarbon
23 tackifying resin and, B, is the thermoplastic base polymer.

24 MR. TRIDICO: Yes.

1 JUDGE MURPHY: So my question is, are all
2 compositions that fit within the body of limitations A and B
3 necessarily hot melt adhesives?

4 MR. TRIDICO: Absolutely. They're absolutely hot
5 melt adhesives.

6 JUDGE MURPHY: What's the evidence --

7 MR. TRIDICO: Well, first, let's just look at the plain
8 definition. What is a hot melt adhesive? You have an adhesive
9 material, a tackifier. Okay. That's an adhesive material. It flows
10 when heated. It has a Tg of greater than 65.

11 What does Tg mean? Tg is the point at which the
12 crystal lattice of the polymer starts to flow, starts to break down.
13 Okay. A lot of the references we refer to also talk about
14 softening point. Softening points can be a higher temperature
15 than Tg. Some manufacturers refer to Tm, Tg, some softening
16 point. So you're always going to have a higher temperature that's
17 a softening point. That's when the polymer starts to flow.

18 But if we have a Tg greater than 65, we know that it's
19 going to begin to flow at above 65 degrees C. So heated up it
20 begins to flow. It cools, it solidifies and bonds, tackifier.

21 Thermoplastic base polymer, they're a selected group of
22 thermoplastic base polymers. Dr. Hsu tested thermoplastic base
23 polymers also flow when heated, solidify when they return to
24 ambient temperature.

1 You have a hot melt adhesive. That's all it is. You heat
2 it up, it adheres. You cool it down, it bonds as it solidifies.
3 That's it. Nothing else is needed. That's all the structure required
4 for a hot melt adhesive.

5 JUDGE MURPHY: So taking the question in a
6 different form, are there any possibilities or combinations within
7 Claim 22A and B, ignoring the preamble, which could not be a
8 hot melt adhesive?

9 MR. TRIDICO: It will function as a hot melt adhesive.

10 JUDGE MURPHY: Right.

11 MR. TRIDICO: Are they going to be the best one? No.
12 Are they going to work in all applications? Of course not. But
13 will they function as a hot melt adhesive, will they flow when
14 heated, will they bond when cooled? Yes. That's all a hot melt
15 adhesive is. This is the technology.

16 If we go to some of the record, look at Litz, look at
17 Kraus, references that Dr. Hsu relied on to talk about the state of
18 the art, and I can go through those, but references that he relied
19 on to talk about the state of the art, those are from the '70s. It was
20 routine to formulate hot melt adhesives and that's all that it takes.

21 Yes, some hot melt adhesives, and we hear a lot of that
22 in Patent Owner's response, have better properties. They are
23 good for bondability. They may work in all types of paper stock,
24 yes. But to just function basically as a hot melt adhesive, that's
25 all it is.

1 JUDGE MURPHY: Okay.

2 MR. TRIDICO: Okay? So let's move on, then, and talk
3 about the anticipation reference. So we'll go to slide 10.

4 The Eastotac reference is 102(b) prior art. It published
5 more than five years before the filing date or the priority date of
6 the '404 patent.

7 What's in the Eastotac reference? Well, we start with
8 Table 3. Table 3, which is slide 11, Table 3 provides composition
9 ranges for Eastotac resins in hot melt adhesives. It gives
10 examples of hot melt adhesives.

11 Now, let's look at the context of this reference. This is a
12 reference that's provided by a manufacturer of resins. Not just
13 any manufacturer, a large manufacturer. It's Eastman Kodak.
14 They're selling you resins to use in your hot melt adhesive
15 compositions. These aren't possibilities. They're not going to sell
16 you a resin that's not going to work. They say these are four hot
17 melt adhesive uses.

18 Table 3 clearly says composition ranges for Eastotac
19 resins in hot melt adhesives. It refers to -- and we have annotated
20 this slide. It refers to the Eastotac resin that is a tackifying resin
21 as defined in the brochure -- and I'll get to that in a moment -- and
22 it provides two of the three claimed thermoplastic base polymers,
23 an amorphous polyolefin or amorphous alpha polyolefin referred
24 to in the top as APP based and it also refers to an EVA based or
25 an ethylene-vinyl acetate copolymer. The percentages

1 completely overlap with what's in the claims other than by a small
2 amount.

3 As you can see, some have a wax, some do not, but they
4 all comprise a thermoplastic base polymer and a -- excuse me, or
5 a thermoplastic material and a tackifying resin.

6 Now, Eastotac resin, as I mentioned, is a tackifying
7 resin. If we look at the reference, how do they define and what
8 do they describe as the Eastotac resins?

9 JUDGE MURPHY: Right. That's what I'm interested
10 in. In other words, to respond to the Patent Owner's rebuttal, as I
11 understand it, what's the information in the reference itself that
12 tells one to select H-142 as the resin to use in a hot melt
13 adhesive?

14 MR. TRIDICO: Understood. Let's look at what the
15 reference says. It says, as the Board -- and as the Board
16 recognized that the resins used here -- and the resins, not one
17 resin, not two resins, the resins, all of the resins are expressly
18 suited for hot melt adhesives, therefore, use in hot melt adhesives,
19 yes, there are other uses that are possible, but the resins are
20 especially suited for hot melt adhesives.

21 Okay. So Table 3. This is on slide 12, excuse me.
22 Table 3 then refers you directly -- and we show this in slide 14
23 annotated. It refers you directly -- it's Eastotac resins -- to the
24 only Eastotac resins that are disclosed in the reference and that's
25 Table 1.

1 So you have four examples of hot melt adhesives that
2 are provided by Table 3, one using each of the different Eastotac
3 resins provided in Table 1. It clearly directs you to that and it
4 says these resins are four hot melt adhesive applications. There's
5 nowhere else to go.

6 Let's look at Table 1 in a little more detail and, again,
7 we've annotated this slide --

8 JUDGE MURPHY: Mr. Tridico, just let me interrupt
9 you there for one moment.

10 MR. TRIDICO: Yes.

11 JUDGE MURPHY: One of Patent Owner's arguments
12 is that, well, it's not really four resins. It's really 13, but they're
13 colored -- each resin type, if you will, has four different color
14 possibilities.

15 MR. TRIDICO: Yes.

16 JUDGE MURPHY: Does that matter?

17 MR. TRIDICO: It doesn't matter in terms of the
18 function of the resin and I can explain.

19 JUDGE MURPHY: Yes.

20 MR. TRIDICO: If we look at Table 1, there are four
21 series of resins, H-100, H-115, H-130, H-142. The number refers
22 to the softening point. As I mentioned, softening point it's
23 correlatable to Tg. You can't calculate between the two, but you
24 know the higher Tg is going to be a higher softening point. Okay.

1 Now, you choose the resin before the application based on the
2 softening point.

3 If you look at the other properties of their resins, other
4 than Bromine number and Gardner color and Bromine number
5 refers to the hydrogenation of the polymer, so the clarity. More
6 hydrogenated, more clear, more expensive for the H-100W
7 because it's a clear resin. You might use that in a different
8 application as opposed to H-100E, which is darker, not as clean.
9 You'd use that for more of maybe an industrial application as
10 opposed to a consumer application. But the bondability, the
11 application in terms of the function of the adhesive doesn't matter.
12 You have four series of resins.

13 JUDGE MURPHY: Does Dr. Hsu testify about that
14 difference?

15 MR. TRIDICO: He does. He does talk about the
16 differences and I can --

17 JUDGE MURPHY: If you have a reference, that would
18 --

19 MR. TRIDICO: If you could give us a moment, they
20 can look for it.

21 JUDGE MURPHY: Of course, absolutely.

22 MR. TRIDICO: Okay. So going back to that, we have
23 the four different series of resins, correct? Each of them with a
24 different ring and softening points.

1 Now, ring and softening point, as I mentioned, that's
2 when it starts to flow, right, that's when it will deform and Dr.
3 Hsu testified to that. It starts to deform. That, as I said, is
4 correlatable to Tg.

5 Now, why would you choose one that deforms at a
6 higher temperature as opposed to one that deforms at a lower
7 temperature? Well, resins come down to the bondability, you
8 know, the peel value, which is one of the dependent claims. A
9 higher peel value means it takes more energy, higher temperature
10 to pull the polymer apart.

11 If it flows at a higher temperature or doesn't flow let's
12 say, if the crystal lattice doesn't break down until a higher
13 temperature, well, then it takes more energy to pull it apart. So if
14 you pull a resin or choose a resin with a higher softening point,
15 higher Tg, it doesn't start to flow until a higher temperature. It
16 takes more energy to pull it apart. If I want a higher peel value or
17 a stronger bond resin, I'm going to choose a resin with a higher
18 ring and softening point or a higher bondability.

19 So each of those resins form hot melt adhesives as the
20 reference says. These are explicitly used for hot melt adhesives.
21 You'll choose the one based on what peel value you want. You
22 want a higher peel value, higher bondability, I'm going to take
23 one with a higher softening point. That's it.

24 JUDGE CRUMBLEY: Counsel, you're talking about
25 choosing between the different resins.

1 MR. TRIDICO: Yes.

2 JUDGE CRUMBLEY: I'm looking at your slide 14.

3 No picking and choosing.

4 MR. TRIDICO: Yes. No picking and choosing to form
5 a hot melt adhesive. Each of these forms a hot melt adhesive,
6 right.

7 JUDGE CRUMBLEY: So you would still need to pick
8 from among those to reach the composition in the claims.

9 MR. TRIDICO: Well, if you have 20 examples in a
10 patent -- let's say hypothetically you have 20 examples in a
11 patent, prior art reference. One of those falls within the scope of
12 a patent. Does that anticipate? Of course it does.

13 Not every example has to fall within the scope of the
14 claim. You only need one. Not every example has to fall within
15 the scope of the claim. You only need one. One of these clearly
16 falls within the scope of the claim.

17 JUDGE CRUMBLEY: One of -- what do you mean by
18 these?

19 MR. TRIDICO: One of these examples.

20 JUDGE CRUMBLEY: No, but I take issue with that
21 because Table 1 doesn't have exemplary compositions within the
22 scope of the claims. It has exemplary resins and so the example
23 -- there is no exemplary composition in this brochure that meets
24 all of the limitations of the claims.

1 MR. TRIDICO: I would argue that Table 3 provides
2 prophetic examples of four different resins. So you take Eastotac
3 resins at those different compositions. Those are prophetic
4 examples of actual compositions using the four different resins of
5 Table 1.

6 Okay. Now, let's say we disagree and you think that
7 there is some picking and choosing. I think this would then be
8 very similar and on its facts actually identical to the recent Fed
9 Circuit case in Kennametal. There you had choices of three
10 different coatings five different metals. None of them were used
11 in the examples. They were chosen from a list.

12 The Fed Circuit said, if one of skill in the art
13 immediately envisaged the claimed invention reading the
14 reference, that's anticipation. And even if there is some choosing,
15 there's four examples.

16 Dr. Hsu, the only testimony we had, immediately
17 envisaged that that was a hot melt adhesive. So on those facts
18 alone, even if you think there's picking and choosing, I don't see
19 how you can't say it's not anticipation.

20 Okay. So let's move on then to the Exxon reference.

21 Do we have any other questions on the Eastotac or can
22 we --

23 JUDGE MURPHY: No. Please proceed.

24 MR. TRIDICO: So let's talk then about the Exxon
25 reference. The Exxon reference, again a similar reference to the

1 Eastotac reference, it refers to adhesives and sealants provided by
2 Exxon in terms of providing to manufacturers to make adhesives,
3 also, eight years prior to the '404 priority date.

4 Now, let's look closely in this slide that we've annotated
5 to the table that's provided in the Exxon reference. We have
6 Claim 22 on the right, hot melt adhesive composition comprising.

7 Now, in Footnote 1 it provides a specific composition of
8 a hot melt adhesive. How do I know it's a hot melt adhesive?

9 JUDGE MURPHY: Yes, that is the question.

10 MR. TRIDICO: That is the question. First, Dr. Hsu --

11 JUDGE MURPHY: We would like it to be answered.
12 What is the evidence for that?

13 MR. TRIDICO: Dr. Hsu testified that it's a hot melt
14 adhesive. Upon his reading of the brochure, he testified it's a hot
15 melt adhesive. We've heard nothing from another expert to
16 question that. We've heard attorney argument and that's about it.
17 In fact, when given the opportunity to even question Dr. Hsu
18 about that, there's no questions in the record.

19 Now, let's look at that reference. How do we know?
20 Again, the two components of a hot melt adhesive, we have a
21 tackifier. Okay. We have a tackifier that's going to flow as the
22 temperature is raised. We can tell that based on the far left of the
23 table in slide 20. It gives us the softening point. Heat the resin, it
24 starts to flow. Cool it down to ambient temperature, it bonds as it
25 cools and solidifies. It has Escorene UL. That is a copolymer of

1 ethylene, thermoplastic base polymer. Okay. It also has, as
2 we've agreed, is potential for a hot melt adhesive. It also has a
3 wax.

4 Okay. Now, these aren't even prophetic. These are
5 actual examples that were made. How do we know that Exxon
6 made these examples? Well, Patent Owner makes a big deal
7 about this cloud point measurement. Cloud point measurement
8 supports our case. They actually made these examples. They
9 made each one of these hot melt adhesives and they tested the
10 cloud point.

11 Yes. All the cloud point is, it tells you the temperature
12 in which the wax starts to become cloudy. So you get below a
13 certain temperature, it becomes cloudy. You go above that
14 temperature, it starts to clarify. Does it tell us anything about it's
15 hot melt? No. Does it have to? No. It tells us they were made.
16 These compositions were made. We know they're hot melt
17 adhesives. There's no question.

18 JUDGE MURPHY: Pardon me, sir, Mr. Tridico, what's
19 your response to Patent Owner's point that the 40 percent wax
20 component is inconsistent when you use this particular
21 copolymer, this ethylene copolymer, such that you really don't
22 have a functional hot melt adhesive under these particular
23 component concentrations?

24 MR. TRIDICO: If I can address that. Go to slide 24.

25 JUDGE MURPHY: 24.

1 MR. TRIDICO: 24.

2 JUDGE MURPHY: Just give me a second.

3 MR. TRIDICO: No problem.

4 JUDGE MURPHY: All right.

5 MR. TRIDICO: Okay. Our main response to that is it's
6 interesting to us that it's inconsistent when it's actually claimed by
7 the '404 patent. The '404 patent in at least one claim, and actually
8 I think it's four claims that we list, claims a copolymer and
9 terpolymer of ethylene with zero to 40 percent of a wax. If it
10 teaches away, it's a surprise to me because it's in one of the
11 claims.

12 At best what it does say is that in certain applications
13 lower amounts of wax are preferred. Yes, we have in every
14 patent application preferred ranges. It doesn't teach away from a
15 40 percent wax. In fact if it did, they wouldn't have claimed it.

16 We've also provided as additional evidence to support
17 that in response to that argument other patents, including Fuller
18 patents that are known in the art, that show a hot melt adhesive
19 with a copolymer and 40 percent wax.

20 Now, if I can take a moment to kind of diverge to that
21 motion to exclude, if that's all right, just quickly. I think it's clear
22 when you look at the motion to exclude in our opinion why it was
23 filed, and it was filed in order to present their case again and, in
24 fact, a brand-new argument. As I mentioned, the '483 and '779,

1 which were the subject of that motion to exclude, they were only
2 used to further support the fact that the '404 claimed it.

3 JUDGE MURPHY: Well, you are referring to Exhibits
4 1040 --

5 MR. TRIDICO: 1040 and 1041, yes.

6 JUDGE MURPHY: Well, I don't know that it's fair to
7 say it's their new argument, right? You're kind of pointing fingers
8 at each other, aren't you? They're saying it's not appropriate. It's
9 beyond the scope of appropriate reply.

10 MR. TRIDICO: I would say that if you read their reply
11 to our opposition, there is a new argument presented. In that
12 paper for the very first time, they --

13 JUDGE MURPHY: This is in their reply --

14 MR. TRIDICO: To our opposition.

15 JUDGE MURPHY: On the motion.

16 MR. TRIDICO: Yes, to the motion to exclude. So in
17 the motion to exclude our opposition, their reply to our
18 opposition.

19 For the very first time in the case, they argued that the
20 Petitioner treated or admitted, however you want to read the
21 language, that hot melt adhesive is a limitation of the claims by
22 some of the arguments we made. You'll find that nowhere else in
23 the briefing until that reply to the opposition.

1 So I do think it was used for that purpose, especially
2 when 1040 and 1041, again, were just a footnote to support the
3 fact that in the '404 it was claimed.

4 JUDGE MURPHY: Well, I was going to say -- let me
5 ask you this, do you need those exhibits?

6 MR. TRIDICO: No, not at all. We can avoid -- we can
7 ignore them. The '404 patent makes the case for us and I think
8 that's clear. The '404 patent, which claims the 40 percent wax, is
9 really all we need. That was supplemental evidence to show that
10 it's well-known in the art. Okay.

11 So let's go back, then, to the Exxon reference, if we
12 may. So, as I said, the footnote provided are example
13 compositions of each of the resins. More than one may fall into
14 the scope of the claim. I don't know how many fall within the
15 scope of the claim. I know one of them does because the patent
16 itself admits that that has the right Tg. It could be others. We
17 didn't test them. We don't have to.

18 For anticipation there's no requirement that we test
19 them. On its face it is clear to our expert, the only expert in the
20 case, the only testimony you have that this is a hot melt adhesive.

21 JUDGE MURPHY: And so you're saying that even if
22 we were to construe the preamble of hot melt adhesive as a
23 substantive claim limitation, that's still satisfied by Dr. Hsu's
24 testimony.

1 MR. TRIDICO: Absolutely. It's an inherent disclosure
2 of the reference. Reading this, one of skill in the art sees that as a
3 hot melt adhesive and there's nothing else you could see it as.

4 Again, two components. It flows when heated. It
5 solidifies. Tackifier, the adhesive component, thermoplastic base
6 polymer does exactly the same. It flows when heated, solidifies
7 and bonds when cooled.

8 JUDGE CRUMBLEY: Are you saying that a person of
9 ordinary skill would know seeing a tackifier and a -- sorry,
10 polymer, all of them are hot melt adhesives just by looking at
11 them, at the composition?

12 MR. TRIDICO: Yes, looking at the composition,
13 looking at the properties would know it's a hot melt adhesive.
14 You know it if you look at the tackifier providing the adhesive
15 property. You look at the Tg. Does it flow when it's heated and
16 does it solidify and bond when it's cooled? And the same with
17 the thermoplastic base polymer which provides the polymer base
18 for the system. It flows when it's heated, solidifies when it's
19 cooled. That's all the hot melt adhesive is.

20 As I said, there may be better properties in some, better
21 applications in others, but whether it functions as a hot melt
22 adhesive is pretty simple.

23 JUDGE MURPHY: Mr. Tridico, you said earlier that
24 this would be an inherent disclosure, but I don't recall Petitioner
25 arguing inherency per se.

1 MR. TRIDICO: We didn't argue inherency per se, you
2 are absolutely right. We said Dr. Hsu stated that it's a hot melt
3 adhesive and I think it's implied, but you're absolutely correct, I
4 never used the word inherency in our papers.

5 JUDGE MURPHY: Okay. So the bottom line is you're
6 relying on Dr. Hsu's testimonial evidence in the absence of any
7 rebuttal.

8 MR. TRIDICO: Yes, absolutely, to show that these are
9 hot melt adhesives.

10 JUDGE MURPHY: Understood.

11 MR. TRIDICO: And also on its face just from the
12 definition. I'm not too sure we even need his testimony. Based
13 on the definition that we all agreed with regard to what a hot melt
14 adhesive is, it's pretty clear on its face that it's a hot melt
15 adhesive.

16 So let's then move on to Claim 27 and the only
17 obviousness question of record.

18 As I said when we first started, the Board had
19 determined that we had met our burden with regard to
20 obviousness. There's been no testimony of record to refute the
21 position that was put forth by the Petitioner. All Claim 27
22 requires is that the composition has a peel value of greater of 70.
23 As I mentioned and as I explained, that's very straightforward and
24 routine in the art.

1 First, the motivation comes from Litz and we refer to
2 that in our briefs. He talks about the Uniform Freight
3 Classification Committee and the requirement to ship by freight
4 rail that you have a certain temperature. So it provides the
5 motivation to have a peel value above 70 degrees.

6 JUDGE MURPHY: I'm sorry, this is slide 26?

7 MR. TRIDICO: Slide 26, yes, I'm sorry. I keep
8 forgetting to do that, apologies. So in slide 26 Litz provides the
9 motivation to have a higher peel value. As explained when I was
10 going through the Eastotac resin or Eastotac brochure, it's routine
11 to do that. You choose a higher Tg. Higher Tg value, higher
12 temperature at which the polymer starts to break down so,
13 therefore, the temperature at which the polymer starts to split
14 apart, the peel value is going to be higher as well. That's clear
15 from both teachings of Litz and Kraus.

16 Kraus specifically says using a higher Tg tackifier
17 would increase the mechanical strength, therefore, increase the
18 peel value and heat resistance. This was well-known in the art
19 and was used to just demonstrate what was known in the art at the
20 time.

21 JUDGE MURPHY: Well -- and just one issue on this
22 since you bring it up, you're referring to slide 27 and I do recall
23 Patent Owner has an objection to that which we'll take under
24 advisement, but I think the objection, in part, was Kraus. We
25 didn't institute on Kraus.

1 MR. TRIDICO: Absolutely.

2 JUDGE MURPHY: And the underlying reference
3 citations in slide 27 to your petition, pages 41 to 43, and to
4 Petitioner's reply at 14 don't cite paragraph 22 of Dr. Hsu's
5 declaration or Kraus.

6 MR. TRIDICO: It does -- well, it does cite actually I
7 think, and let me look at my notes. It is cited. This is slide 27.
8 Okay. In petition, page 9, first full paragraph, by June of 1998, it
9 was known that the use of tackifiers in a hot melt adhesive would
10 increase the use of temperature of adhesives, and particularly
11 using higher Tg tackifiers would increase the overall mechanical
12 strength of the adhesive, and therefore the peel value, citing Hsu
13 at paragraph 22.

14 JUDGE CRUMBLEY: What page is that?

15 MR. TRIDICO: Page 9 of the petition, first full
16 paragraph.

17 JUDGE CRUMBLEY: Your slide says 41 to 43.

18 MR. TRIDICO: Oh, sorry, excuse me.

19 JUDGE MURPHY: So you've got the wrong cite on the
20 slide?

21 MR. TRIDICO: Well, actually in slide 41 it refers to
22 Hsu's same paragraph which then cites to Kraus.

23 JUDGE MURPHY: Okay. So it's a derivative cite back
24 to page 9 of your petition.

25 MR. TRIDICO: Yes.

1 JUDGE MURPHY: Okay. Well, that confuses people.

2 MR. TRIDICO: Apologies.

3 JUDGE MURPHY: Including the Board.

4 MR. TRIDICO: Sorry, my apologies, but it is in the
5 petition at 41 and also at page 9.

6 JUDGE MURPHY: Okay. Mr. Tridico, you have
7 about just under four minutes.

8 MR. TRIDICO: Okay. Excellent. With the last four
9 minutes and if there's no questions about the obviousness
10 position, I'd just like to quickly address slide 9 -- no, sorry, slide
11 8. Excuse me, slide 8.

12 Not having their own expert to establish any testimony
13 or any evidence and not having any references actually to rely on
14 to establish any evidence, the Patent Owner was forced to really
15 just attack the only expert in the case and it's curious that they
16 both attack him and they rely on him, depending whether or not it
17 supports their argument or is in contradiction to their argument.

18 I think the fact remains is that Dr. Hsu is the head of the
19 Polymer Science and Engineering Division of one of the most
20 respected polymer universities in the United States. He is paid by
21 industry to consult on hot melt adhesives, Henkel as well, who we
22 did admit, other industry such as Abbott, Dow Chemical to
23 consult with regard to hot melt adhesives. He's funded to do
24 research by the National Science Foundation and others. He is

1 filled with honors and he has refereed publications in both the
2 adhesive and hot melt adhesive field.

3 It's clear that he is an expert in this area. His polymer
4 background alone provides the expertise needed to understand
5 how adhesives and hot melt adhesives work and that's clear from
6 his publications and the fact that industry, many industries pay
7 him to consult in this area.

8 JUDGE MURPHY: Well, the only question I have on
9 that is Patent Owner points to Dr. Hsu's deposition testimony
10 where he acknowledged that he had not analyzed or tested hot
11 melt adhesive compositions per se, but rather his experiences
12 with the underlying components as I understand it.

13 MR. TRIDICO: Yes.

14 JUDGE MURPHY: The base polymers --

15 MR. TRIDICO: Base polymers.

16 JUDGE MURPHY: -- thermoplastic polymers,
17 hydrocarbon tackifying resins, etcetera. So I'd just like your
18 response to that.

19 MR. TRIDICO: First, I would hope that as head of the
20 department and the head of the research group he's not in the lab
21 making them and testing them. The question is, has he analyzed
22 them, has he worked with them? Is he consulting on them, is he
23 researching, does his research involve them? He has a
24 publication that deals with hot melt adhesives. He's funded by
25 industry. He consults on hot melt adhesives.

1 Yes, he understands how they're formulated based on
2 the interactions of the polymers in the underlying polymer
3 science. Is he in the lab daily making them? Again, no. He's the
4 head of the department and the person who is doing the research.

5 JUDGE MURPHY: In Dr. Hsu's definition of a person
6 of ordinary skill, it doesn't require experience with hot melt
7 adhesives.

8 MR. TRIDICO: No, it doesn't. It requires experience
9 knowing how the underlying polymers work. As I mentioned,
10 there's nothing special about hot melt adhesives. It's about the
11 underlying properties of the polymer, the fact that they flow when
12 heated, they solidify when cooled. That provides the bonding.

13 If you understand the science behind the polymers, you
14 understand how they're going to interact, and that was his point
15 with saying someone with a graduate degree in polymer science
16 is one of skill in the art.

17 JUDGE CRUMBLEY: Counsel, let's assume we
18 determine that the art is not as broad, that it is hot melt adhesive
19 particularly and that a person of ordinary skill in the art would
20 have had actual physical experience working with hot melt
21 adhesives. Under the *Sundance* case, under *SEB*, what level -- I
22 mean, does Dr. Hsu need to have a level of ordinary skill in the
23 art to testify to what a person of ordinary skill in the art would
24 know?

1 MR. TRIDICO: First of all, even if you use that
2 definition, he does, he publishes in the area of hot melt adhesives.

3 JUDGE CRUMBLEY: Again, like I said, let's say he --
4 we determine that a person of ordinary skill in the art has actually
5 had physical experience working with these hot melt adhesives.

6 MR. TRIDICO: We have to look at what he's testifying
7 to, what he's testifying to and what he's discussing is the
8 underlying properties of the polymer. He's talking about you look
9 at these polymers, you appreciate they're a hot melt adhesive
10 based on the polymers. I think even if you use that definition,
11 he's one of skill in the art to testify as to what he's -- as to what's
12 skilled enough, skilled to support his testimony. How's that?

13 So whether you look at it through our definition or some
14 other definition, which I'll point out we haven't been provided one
15 by any expert as to what the other definition would be. We've
16 only seen Patent Owner trying to poke holes in our definition.
17 But even if you use the definition you put forward, his testimony
18 and what he's testifying to, he's clearly an expert in those areas.

19 JUDGE MURPHY: All right. Thank you, Mr. Tridico.

20 MR. GRIMSRUD: Your Honor, may I approach with
21 copies of the demonstratives?

22 JUDGE MURPHY: Of course, Mr. Grimsrud.

23 MR. TRIDICO: The cite you had asked for with regard
24 to Table 1 from Dr. Hsu, it's Exhibit 1015, Dr. Hsu's declaration,
25 and it's paragraph 42.

1 JUDGE MURPHY: Thank you.

2 MR. GRIMSRUD: Good morning, Your Honors.

3 Thank you. H.B. Fuller, Patent Owner's defense in this case is
4 based primarily on failure of proof by Petitioner Henkel. So just
5 to be clear, Petitioner is attacking us saying we're relying on
6 attorney argument and that we don't have our own expert.

7 Our defense in this case is that the Petitioner has failed
8 to meet their burden of proof and there's nothing wrong with that
9 defense. We just want to make perfectly clear that that's a
10 legitimate defense.

11 There's a burden of proof in these proceedings, as Your
12 Honor noted at the beginning, and Petitioner has to come forward
13 with evidence that meets their burden of proof that shows by a
14 preponderance of the evidence that in this case there's anticipation
15 by either their Eastotac brochure or the Exxon reference.

16 And they haven't met that burden of proof and this is a
17 well-recognized defense that the Federal Circuit recognizes, that
18 the Board recognizes. The Board's -- we cite cases, the *ZTE*
19 *Corporation* case as a final written decision where the Board
20 ultimately concluded after instituting the proceedings that the
21 Petitioner had failed to meet the burden of proof on anticipation.
22 The *Ariosa* case similarly, that was on obviousness, but the
23 finding of -- the ultimate finding of failure to meet --

1 JUDGE MURPHY: Well, Mr. Grimsrud, we
2 understand the law and the defense. The question is why should
3 we not credit Dr. Hsu's testimony?

4 MR. GRIMSRUD: So Dr. Hsu's testimony is -- there's
5 multiple problems with Dr. Hsu's testimony, and I'll jump to that.
6 The -- Dr. Hsu, first of all, he does not have experience working
7 with hot melt adhesives. So Dr. Hsu on slide 13, we have this
8 summarized here that he, first of all, did not require a person of
9 ordinary skill in the art to have any experience with hot melt
10 adhesives. That's a fatal flaw in his opinion.

11 The patent is all about hot melt adhesives. That's what
12 this patent is about. It's about hot melt adhesives. Hot melt
13 adhesives is talked about repeatedly. The claims specifically say
14 it's a hot melt adhesive and Dr. Hsu at his deposition admitted
15 that a person of ordinary skill in the art in his view does not have
16 to have any experience working with hot melt adhesives, and
17 that's a fatal flaw in his opinion.

18 It's not a relevant opinion to have -- to be saying a
19 person of ordinary skill in the art doesn't have to have experience
20 in hot melt adhesives.

21 JUDGE MURPHY: Why not?

22 MR. GRIMSRUD: The anticipation standard as the
23 cases we cite talk about how, with anticipation, you look at the
24 references from the perspective of a person of ordinary skill in the
25 art.

1 JUDGE MURPHY: Yes, and the evidence we have in
2 front of us is one expert saying, I believe this is the appropriate
3 level of skill which does not require per se experience testing,
4 analyzing, etcetera, hot melt adhesive compositions, but that
5 experience with the underlying components of those
6 compositions is sufficient. That's what I understand Petitioner's
7 evidence and argument to be.

8 MR. GRIMSRUD: Dr. Hsu, his definition of a person
9 of ordinary skill in the art, just to be clear, is someone who would
10 have some undefined experience in "the field of polymer science
11 and engineering." That's what he says a person of ordinary skill
12 in the art is. It's very broad. Dr. Hsu does not define the person
13 of ordinary skill in the art any more narrowly than field of
14 polymer science and engineering.

15 JUDGE MURPHY: What Dr. Hsu said on page 48 of
16 his deposition transcript from lines 3 to 9, and most of it is in
17 your question is that a person of ordinary skill has a graduate
18 level degree in polymer science, engineering, chemistry, physics
19 or a related field as well as at least two years of experience in the
20 field of polymer science and engineering. That's what he agreed.

21 So it's the education level in polymer science or
22 engineering, chemistry, etcetera, and two years of experience in
23 the field of polymer science and engineering. And I understood
24 your cross examination was, yes, but you've never tested or

1 analyzed a hot melt adhesive and that's what this patent is all
2 about.

3 And so the difficulty is, we have evidence of a level of
4 skill tracking it to the components of the composition that's at
5 issue in the claims and then we have an attack, essentially a legal
6 argument that says that's not sufficient in this case, and I need to
7 know exactly why that's not sufficient in this case given the
8 evidence that we have.

9 MR. GRIMSRUD: Yes, Your Honor. The evidence we
10 have, again in the deposition -- copy of the deposition transcript
11 at page 48, what Dr. Hsu says is two years of experience in the
12 field of polymer science and engineering, which is what he said
13 in his declaration I believe also at paragraph 27, is the field of
14 polymer science and engineering. That is a huge broad field
15 that's -- I mean, polymer science spans all sorts of materials, all
16 sorts of things that qualify as polymers. This invention is all
17 about hot melt adhesives.

18 JUDGE CRUMBLEY: Well, what's so special about
19 hot melt adhesives that someone who is an expert across the field
20 of polymer science would not have expertise in hot melt
21 adhesives?

22 MR. GRIMSRUD: Well, there's no evidence that
23 anyone working in the field of polymer science would have --
24 would know anything about hot melt adhesives. You know, the
25 field of polymer science is very broad. There's no evidence of

1 what someone in that field knows about hot melt adhesives. Hot
2 melt adhesives --

3 JUDGE CRUMBLEY: Well, counsel, let me give you
4 a hypothetical.

5 MR. GRIMSRUD: Sure.

6 JUDGE CRUMBLEY: You've been practicing patent
7 law for a number of years.

8 MR. GRIMSRUD: Yes.

9 JUDGE CRUMBLEY: So one might argue that you're
10 an expert in patent law. Maybe you haven't tried a case that turns
11 on anticipation. Does that mean that you're not an expert in
12 anticipation? I think that's the critical problem here is that how is
13 hot melt adhesive not subsumed within polymer science?

14 MR. GRIMSRUD: Again, polymer science is a very
15 broad field and there's no evidence that hot melt adhesive would
16 be subsumed in the field of polymer science such that anyone of
17 ordinary skill in the art working with polymers would know
18 anything about hot melt adhesives.

19 On slide 8 we have an example here of statements from
20 Henkel's petition that are quoting Dr. Hsu and it talks about -- Dr.
21 Hsu and Henkel talk about how as compared to other adhesives,
22 hot melt adhesives have the distinct advantage of being capable
23 of extremely high tack with medium to very fast setting speeds.
24 So they're acknowledging that a hot melt adhesive is a distinct
25 type of adhesive. It's different than other types of adhesives.

1 There's absolutely no evidence in the record that someone of
2 ordinary skill in the art in the field of polymers would know
3 anything about hot melt adhesives.

4 JUDGE MURPHY: Mr. Grimsrud, let me ask you this,
5 then, if we were to accept your argument, you're asking us to find
6 for a higher level of skill in the art that's specifically directed to
7 hot melt adhesives for the purpose of -- again, and this is only for
8 the purpose of evaluating the obviousness of Claim 27, right?
9 Because we're talking about obviousness here.

10 MR. GRIMSRUD: No. We're talking about
11 anticipation and obviousness, so that's a good -- I want to make
12 clear on that.

13 JUDGE MURPHY: Because of the understanding of
14 the Exxon reference composition. Fair enough.

15 MR. GRIMSRUD: Both the Exxon and the Eastotac
16 with, you know, they cite the *Kennametal* case, for example, and
17 in *Kennametal* the Federal Circuit is very clear that this theory
18 that would someone at once envisage the entire invention is from
19 the perspective of one of ordinary skill in the art, so you need
20 evidence of one of ordinary skill in the art would have once
21 envisaged the invention and so it goes -- the core issue there that
22 the expert did not apply the proper standard for who's someone of
23 ordinary skill in the art.

24 The same with the Exxon reference that there's no
25 evidence that one of ordinary skill in the art would view that

1 footnote 1 composition as a hot melt adhesive. So this is very
2 much an important issue for the anticipation, which that's actually
3 the focus of my argument is the anticipation. I mean, that's the
4 focus of this proceeding is the anticipation arguments and Dr.
5 Hsu's failure to apply the right standard is fatal to those
6 anticipation arguments.

7 And if I may, with what you're getting at with what the
8 -- who the person of ordinary skill in the art is, what we're saying
9 here is that it's not reasonable for Dr. Hsu to say that one of
10 ordinary skill in the art doesn't have to have any experience with
11 hot melt adhesives.

12 So there could have been a battle about is it one year of
13 experience, is it three years of experience with hot melt
14 adhesives. We're not even to that point, because Dr. Hsu just
15 said, no, you don't have to have any experience with hot melt
16 adhesives and that is not reasonable. That's not a reasonable view
17 of one of ordinary skill in the art given that this entire invention is
18 about hot melt adhesives.

19 It's not reasonable to say, you know, basically anyone of
20 ordinary skill who's worked with polymers qualifies. There's just
21 no evidence that someone would qualify with that just broad
22 definition of one of ordinary skill in the art.

23 JUDGE MURPHY: Mr. Grimsrud, if you know, is
24 there -- I'm trying to recall if there's cross examination testimony
25 of Dr. Hsu in particular on that point to establish the point that

1 given the level of skill that he's chosen to define, did that -- did he
2 acknowledge somewhere in his deposition, if you can recall, that
3 he did -- that that level would not have been sufficient to read the
4 Exxon reference to understand it would have been a hot melt
5 adhesive intended use or to read the Eastotac reference and not
6 understand?

7 MR. GRIMSRUD: I don't know, Your Honor, offhand
8 if there's a question that's worded in quite the manner you just
9 asked, but I can give you an example that's similar. This is on
10 page 253 of Dr. Hsu's deposition transcript.

11 I started asking him questions about details of wax and
12 how wax can affect a hot melt adhesive, and this is page 253 at
13 line 16.

14 JUDGE MURPHY: All right. Read slowly, please, so
15 our court reporter can get it down.

16 MR. GRIMSRUD: Yes, Your Honor.

17 Question, so the amount of wax you'd use might depend
18 on the type of ethylene copolymer? Answer, I'd speculate.
19 Maybe I don't want to speculate. I don't know. Question, so
20 sitting here today, you don't know whether or not the amount of
21 wax that you use would depend on the type of ethylene
22 copolymer they use? Answer, I don't.

23 So this is an example where Dr. Hsu, who does not have
24 experience working with hot melt adhesives, is not able to answer
25 questions about how much wax you use and whether or not wax

1 can depend on the type of copolymer. Similarly, Dr. Hsu has no
2 experience working with the resins in the Eastotac brochure.

3 We asked him questions about that as well and this is at
4 page 157 of Dr. Hsu's transcript. The question was, have you
5 ever personally worked with any of the resins in Table 1?

6 Answer, no. The same with the Escorez -- sorry, excuse me, the
7 Exxon reference, the Escorez 5340, Dr. Hsu testified that he had
8 never worked with Escorez at page 217.

9 So what this boils down to is that Dr. Hsu doesn't know
10 the details of things like wax, which are important, important
11 considerations for hot melt adhesives. He's not able to answer
12 those types of questions.

13 JUDGE MURPHY: Let me ask you a different
14 question. If you could look with me at the Eastotac reference,
15 which is Exhibit 1002, and if you could go to Table 1, the text
16 above Table 1, which is on page 4 of Exhibit 1002.

17 MR. GRIMSRUD: Okay.

18 JUDGE MURPHY: So there's a quote that counsel for
19 Petitioner raises in their briefs. On the left column it says, "These
20 resins are especially suited for low-molecular-weight
21 polyethylene-based hot melt adhesives where elevated
22 temperature resistance and high cohesive strength are required."
23 And we saw that in their slides earlier, right?

24 And so the question is why wouldn't a person of
25 ordinary skill, as Dr. Hsu has defined it, understand -- read that

1 and understand that we're talking about a hot melt adhesive use?
2 So regardless of whether they ever worked on or analyzed a "hot
3 melt adhesive."

4 MR. GRIMSRUD: So the Eastotac brochure mentions
5 applications. There's wide-ranging applications. One of those is
6 hot melt adhesives and it does have this sentence where it says,
7 Eastotac resins are especially suited that you read, Your Honor.

8 JUDGE MURPHY: Well, it says for these, it says these
9 resins, meaning the resins disclosed in Table 1.

10 MR. GRIMSRUD: That would be your interpretation
11 of that statement. All this brochure is saying in our view is that
12 it's saying Eastotac resins are suited for hot melt adhesive
13 applications.

14 JUDGE MURPHY: But that's not the testimony of Dr.
15 Hsu. That's your argument, but the evidence that we have is that
16 Dr. Hsu said -- I read this as all of the resins in Table 1 could be
17 used in the prophetic examples of Table 3.

18 MR. GRIMSRUD: And Dr. Hsu said that at his
19 deposition, so I'll go through that in detail. First of all, in his
20 declaration there's nothing of that, nothing of the kind. He never
21 says anything about Eastotac resins means any of them, includes
22 H-142. All he has is a conclusory analysis quoting H-142R,
23 picking it, choosing it from Table 1 and then combining it with
24 Table 3. There's no description in his declaration that one of

1 ordinary skill in the art would read this brochure as meaning
2 Eastotac resins includes any of the resins for hot melt adhesives.

3 At his deposition he made a reference to -- he said
4 something like I read it to include them all. Putting that in
5 context, at page 116 of his deposition transcript he also said the
6 fact that it lists Eastotac resin, I assume all of them can be used.
7 So Dr. Hsu assumed that they could all be used. That is not the
8 standard for anticipation. The standard for anticipation is not
9 whether a person would assume that you could use them all.

10 For this theory that they're going down, this *Kennametal*
11 theory, they need to have evidence that a person of ordinary skill
12 in the art would have once envisaged that the specific -- in this
13 case the specific resin H-142R could be used in a hot melt
14 adhesive and that's not what Dr. Hsu testified to at his deposition.
15 There's nowhere in his deposition where he says a person of
16 ordinary skill in the art would understand at once envisage the
17 Eastotac brochure to include a specific hot melt adhesive with
18 H-142R resin.

19 JUDGE MURPHY: And you're saying that's also
20 nowhere to be found in his declaration?

21 MR. GRIMSRUD: Nowhere to be found in his
22 declaration. He does not have that type of analysis in his
23 declaration. It's a conclusory analysis where he picks H142R
24 from Table 1 and he takes Table 3 and he combines the two and
25 that's picking and choosing. What he's doing is effectively

1 making an obviousness argument, not an anticipation argument
2 and the Board did not institute this proceeding on obviousness for
3 these claims and these references. It's an anticipation.

4 And the reason it's instituted on anticipation is because
5 Henkel, as the Board noted, asserted in its petition that these
6 references disclose each and every limitation and so that's why
7 this is an anticipation case and Henkel has to prove that the
8 references disclose each and every limitation arranged as claimed
9 without picking and choosing.

10 And what Dr. Hsu did in his declaration is clearly
11 picking and choosing. Henkel's argument is picking and
12 choosing and the fact that Dr. Hsu at page 116 of his deposition
13 transcript says that he assumes that it can include them all is not
14 sufficient evidence. That doesn't cut it. He needs evidence --
15 Henkel needs evidence that a person of ordinary skill in the art
16 reading these references would at once envisage that hot melt
17 adhesive composition has the H-142R.

18 JUDGE CRUMBLEY: Counsel, let me ask you this,
19 let's assume that for the -- just for the sake of argument that we
20 take the mention of Eastotac resin in Table 3 to refer to the
21 compositions of Table 1. Okay. So putting that aside, we're left
22 with a set of 4, maybe 13 compositions. How is that not a small
23 enough genus that a person of ordinary skill in the art would at
24 once envisage all of the compositions within that genus? Because
25 that is the standard for anticipation by a genus, right?

1 MR. GRIMSRUD: Our argument is actually, Your
2 Honor, not so much a genus situation as that there's no express
3 teaching or direction of using H-142R in a hot melt adhesive,
4 which is --

5 JUDGE CRUMBLEY: I understand your point, but I
6 guess I'm going back. Let's assume that -- put that aside for a
7 moment. I understand that's your argument, but let's assume that
8 we find that the reference in Table 3 to an Eastotac resin within
9 the scope of this document sufficiently refers back to Table 1, to
10 the resins in Table 1. So, therefore, it is incorporating, in other
11 words, incorporating by reference the resins in Table 1 into the
12 examples of Table 3.

13 That having been done, isn't the genus fairly limited at
14 that point, the genus of possible compositions that one person -- a
15 person of ordinary skill in the art would have to look at?

16 MR. GRIMSRUD: Well, the genus would be if it's 13
17 resins, it would be 13 resins. In Table 3 has three different
18 polymers. Henkel only asserts that two of the polymers fall
19 within the claims. So then you're saying -- what you're saying,
20 then, is, well, pick H-142, don't plug it into the first column of
21 Table 3 because that one doesn't count, plug it into the second or
22 third column. And so they're really picking a specific resin at that
23 point and they're also picking specific polymers from Table 3 and
24 combining them.

1 And there's, you know, cases -- there's cases all over the
2 place on what's a -- you know, when is a genus too big and when
3 is a genus confined enough. The genus here is -- you know, it's
4 not small. You're using, you know, 13 resins and 3 polymers.
5 You're having to pick the right resin or the right polymer and our
6 biggest point is there's no direction of doing that. Table 3 doesn't
7 say all resins, any resin. It says Eastotac resin.

8 And so you're picking and choosing. That's what you're
9 doing. And what they're trying to do is an obvious to try a type of
10 argument and this is just -- that's not the standard for anticipation.

11 Figure -- excuse me, Exhibit 1015, which is Dr. Hsu's
12 declaration, is also -- he has interesting statements in there, too,
13 where page 54 of his -- page 54 is an example. He's analyzing the
14 Eastotac brochure for anticipation purposes. And at the bottom of
15 paragraph 54 -- excuse me, I might have said page 54. At the
16 bottom of paragraph 54 of Dr. Hsu's declaration, he says, one of
17 skill in the art would have been motivated to choose the Eastotac
18 brochure compositions containing Eastotac H-142 resin.

19 So even in his declaration, he's using words like
20 motivated, choose. Counsel for Henkel used words like choose.
21 What they're doing is picking and choosing on the Eastotac
22 brochure. They're picking H-142 and they're combining it with
23 specific polymers in Table 3.

24 Additional evidence that we have in the case, too, is
25 shown on slide 22 of our demonstratives where a year after --

1 roughly a year after the Eastotac brochure was published in 1993,
2 Henkel filed a patent application on a hot melt adhesive and Dr.
3 Hsu explained how this is assigned to National Starch and that
4 was subsequently acquired by Henkel. So at the time it was
5 National Starch, but now it's Henkel.

6 They filed this patent for a hot melt adhesive. Dr. Hsu
7 explained in his declaration that this patent is directed to a high
8 heat resistant hot melt adhesive. High heat resistant -- similarly,
9 the '404 patent at issue in this case is directed to a high heat
10 resistant hot melt adhesive, also low heat resistant, but the resins
11 that they pick from the Eastotac brochure in this patent by Henkel
12 are H-100 and H-130, which shows that this is not --

13 The evidence actually shows that this is not a situation
14 where people making -- trying to make high heat resistant hot
15 melt adhesives would just go to H-142R like Henkel is
16 suggesting. What this shows is that people of ordinary skill in the
17 art working at Henkel chose not to use H-142R in a hot melt
18 adhesive.

19 JUDGE MURPHY: Well, that may have been a
20 preference. I think counsel's answer when I questioned him
21 earlier was that it may be preferable, but that doesn't mean it's not
22 fairly disclosed in the reference.

23 Let me ask you this, the picking and choosing cases that
24 you're referring to, particularly when you're talking about
25 chemical compositions or new chemical entities, the argument is

1 usually in the context of there's a prior art reference that discloses
2 thousands or even millions of potential different compositions or
3 compounds, depending on the R groups and all the variables that
4 you can -- and the substituents that you can replace on any part of
5 a molecule.

6 Why does that apply to this case where you either have
7 4 or arguably 13 resins? And I know you say in your brief that
8 there are also 10 different applications, but, I'm sorry, the
9 document says use these resins for a hot melt adhesive. So when
10 I read that, that's the application.

11 So the question is why would you not choose H-142
12 given that it's one of this list of a relatively few resins for the
13 intended use?

14 MR. GRIMSRUD: Sure. H-142, one reason you would
15 not choose the -- this invention, the '404 patent invention was
16 using a high Tg resin. No one had done that before, and the
17 reason being is that high Tg values means your Tg is very high,
18 which people would assume that at, you know, room temperature,
19 for example, it's going to cause things that are very brittle because
20 the Tg is such a big differential.

21 And the invention of the '404 patent was recognizing
22 that you can use high Tg resins. I mean, that's where Henkel is in
23 our view ignoring the invention, that they're not appreciating that
24 this invention was recognizing that a high Tg resin can be used in

1 a hot melt adhesive. There's no evidence of anyone ever using a
2 high Tg -- one of these high Tg resins before H.B. Fuller's patent.

3 These brochures from Eastotac were published in '92
4 and there's no evidence of anyone using a high Tg resin in '93,
5 '94, '95, '96, '97 and that's evidence that people of ordinary skill in
6 the art were choosing not to use high Tg resins right there.

7 JUDGE CRUMBLEY: That's a teaching away
8 argument and we're talking about anticipation. How is it relevant
9 what other people were doing if we find that there is a disclosure
10 in the reference of a particular composition?

11 MR. GRIMSRUD: Right, yes. The question was why
12 wouldn't someone use it? I think that was the question and part of
13 my explanation was that people would not have wanted to use a
14 high Tg resin in a hot melt adhesive because they thought the Tg
15 values were too high and that would cause problems with
16 brittleness and things like that and that the invention was
17 recognizing high Tg resins can be used in hot melt adhesives
18 and --

19 JUDGE CRUMBLEY: But, I mean, I took Judge
20 Murphy's question to presume that the reference does say that
21 they're useful in hot melt adhesives and just presuming that, you
22 know, the remainder of the question, I think that you keep going
23 back to the application and what we're trying to do is ask you
24 about the remainder of your argument because, you know, we
25 want to focus on all elements of it.

1 So, again, I think if you put the application aside, the
2 question remains why isn't this a very small number of potential
3 compositions that you could at once envisage?

4 MR. GRIMSRUD: There's -- well, it's a -- as far as the
5 number of components, I mean, as I was saying before, there are
6 cases that, as Judge Murphy was noting, too, that have higher
7 numbers of combinations than our situation and there's no
8 evidence that a person of ordinary skill in the art would at once
9 envisage all of these resins to be used in a hot melt adhesive. It
10 does say Eastotac resins can be used in hot melt adhesives, but it
11 doesn't say that all of the resins can be used in hot melt adhesives.
12 There's no testimony that one of ordinary skill in the art would at
13 once envisage that all of them can be used in a hot melt adhesive.

14 The patent by Henkel that was filed in '93 also does
15 show that people chose not to use H-142R in hot melt adhesives.
16 That is evidence of people --

17 JUDGE CRUMBLEY: We don't know why they didn't
18 choose to use that. I mean, that's the problem with citing this
19 other, you know, patent because there are other considerations.
20 Who knows why they didn't choose to use it. It may have cost
21 too much. That doesn't mean that it wasn't disclosed in this
22 Eastotac reference.

23 You keep going back to the application of hot melt
24 adhesive and, you know, I think I agree with Judge Murphy that
25 the reference says these resins are specially suited for hot melt

1 adhesives, so let's put that aside. If a person of ordinary skill in
2 the art would look at this and say, okay, even this brochure is
3 telling me that these resins are specially suited for hot melt
4 adhesives, how do they not then immediately envisage that the
5 class of the genus disclosed there in that reference could be used
6 as hot melt adhesives?

7 MR. GRIMSRUD: I think, Your Honor, the issue I take
8 with the question is the question had built into it a person of
9 ordinary skill in the art would envisage the --

10 JUDGE CRUMBLEY: Because that's the test.

11 MR. GRIMSRUD: -- brochure. Right, the brochure to
12 be saying that all these resins, including H-142R, could be used in
13 a hot melt adhesive and the issue we're taking with Henkel's
14 argument on this is that they don't have any evidence of that
15 being the case. They don't have evidence that someone of
16 ordinary skill in the art would read the Eastotac brochure and read
17 the reference to Eastotac resin to include all of them.

18 JUDGE CRUMBLEY: So now you're going back to
19 Dr. Hsu's qualifications.

20 MR. GRIMSRUD: It's Dr. Hsu's qualifications.

21 JUDGE CRUMBLEY: So let me ask you about that.
22 So does Dr. Hsu need to be a person of ordinary skill in the art or
23 higher to testify to what a person of ordinary skill in the art would
24 know or would take from these references?

1 MR. GRIMSRUD: He would need to be one of
2 ordinary skill in the art or higher.

3 JUDGE CRUMBLY: That's your understanding.

4 MR. GRIMSRUD: Or have done the necessary work to
5 get up to speed to put himself in a place of one of ordinary skill in
6 the art. So he -- the fundamental issue is he has to be putting
7 himself in the shoes of one of ordinary skill in the art and doing
8 so accurately and, here, he doesn't have experience working with
9 any of these resins.

10 He -- in the Exxon reference, he never analyzed the
11 composition. His testimony was that he's never made,
12 formulated, analyzed, tested, worked with, experimented with any
13 hot melt adhesives, so he just -- we're not -- he's -- I'm sure Dr.
14 Hsu is a very well -- highly-accomplished professor, but he's not
15 a hot melt adhesive expert.

16 They talk about the publication he's on. There's one
17 publication. Dr. Hsu talked about that at his deposition. He
18 coauthored that with people at Henkel. So there's one recent
19 publication that mentions hot melt adhesive and that's the one
20 publication he's on. He's just -- he's not a hot melt adhesive
21 expert.

22 And when I asked him questions about, you know, how
23 does wax affect things, he doesn't know the details. So he's just
24 not one of ordinary skill in the art in the area of hot melt
25 adhesives and he's not -- more importantly, he's not putting

1 himself in the shoes of one of ordinary skill in the art. He's not
2 requiring one of ordinary skill in the art to have any experience
3 with hot melt adhesives.

4 The *Kennametal* case also that Henkel cites, on the at
5 once envisage test for the Eastotac brochure, in that case when
6 you read that case, the issue is whether or not the prior art
7 reference disclosed ruthenium in a binder and coatingit using
8 physical vapor deposition and the prior art reference in question
9 had a -- first of all, had a dependent claim that specifically said
10 you can use ruthenium in the binder. So the reference said you
11 can use ruthenium in the binder expressly.

12 Then the specification in the reference also said, and
13 you can coat it using this physical vapor deposition method. So
14 when you read the *Kennametal* case, the reference in question had
15 express statements that you can, you know, use the ruthenium in
16 the binder, you can coat it with a specific method.

17 The Eastotac brochure doesn't have that type of express
18 statement saying you can use any of these resins in a hot melt
19 adhesive, you can use H-142R in a hot melt adhesive. Those
20 express statements are not in the reference and there's no
21 evidence of how a person of ordinary skill in the art would
22 interpret the Eastotac brochure.

23 And, you know, with respect to the assertion that the
24 Board already instituted these proceedings, you know, we also
25 just want to make clear that the Board instituted the proceedings,

1 but Henkel still has to meet the burden of proof. The Institution
2 Decision is not a finding of anticipation and there's important
3 things that were left out of the petition when they filed it.

4 You know, at trial, part of the trial process is to discover
5 information which we've done here and we've discovered things
6 that were not in the petition that are very important. For example,
7 in Dr. Hsu's declaration he has a paragraph -- I think it's
8 paragraph 9 that talks about his research experience. The very
9 first thing he lists is hot melt adhesives and that's just not an
10 accurate characterization of his research.

11 As we've talked about, he's never made, he's never
12 worked with hot melt adhesives. He has one paper where he's a
13 co-author with Henkel, but he's not a hot melt adhesive expert. It
14 also turned out that he's never worked with any of the resins in
15 question. He just didn't do anything on the Exxon brochure to
16 analyze whether or not that composition is a hot melt adhesive.
17 He did no testing on --

18 JUDGE PRAISS: Can I ask you, what exactly is your
19 definition of a person of ordinary skill in the art? Because what I
20 keep hearing is about experience, but it seems like you're saying
21 that Dr. Hsu does not meet the qualifications of a person of
22 ordinary skill in the art because he does not have sufficient
23 workbench experience with hot melt adhesives.

24 So what is your definition, is it so many years of
25 workbench experience that you say Dr. Hsu is missing or is it

1 experience with particular resins of the workbench? I'm just
2 wondering what your definition of a person of ordinary skill in
3 the art is.

4 MR. GRIMSRUD: Yes. Well, first of all, we're not
5 saying it's necessarily workbench. Dr. Hsu said he's never even
6 analyzed one. So someone might not be actually, you know,
7 making the hot melt adhesive, but certainly they're doing some
8 sort of analysis looking at, you know, data, doing something,
9 analyzing experiments, you know, doing something, which there's
10 no evidence Dr. Hsu has done any of that.

11 So it's not necessarily workbench, but what Dr. Hsu
12 testified about is he doesn't -- you know, he doesn't have
13 experience working with hot melt adhesives, you know, period.
14 And as far as the level of detail or the level of experience goes,
15 again, we haven't -- we haven't even got into that dispute with
16 Henkel about is it, you know, one year of experience, two years,
17 three years.

18 That issue just hasn't come up because Dr. Hsu has said
19 you don't have to have any experience, and what our position is,
20 is that that's not reasonable. It's not reasonable to say a person of
21 ordinary skill in the art would have no experience with hot melt
22 adhesives. And so because of that, his opinion is not reliable
23 because he just hasn't even attempted to put himself into the shoes
24 of someone with any experience with hot melt adhesives.

1 JUDGE MURPHY: Counsel, I think you answered this
2 and I apologize for re-asking, but you mentioned a portion of Dr.
3 Hsu's deposition where he did not know certain facts about
4 working with wax or what the effects that would have on the
5 composition. Can you point me to that once again?

6 MR. GRIMSRUD: Yes. That was -- I'll double-check
7 to make sure -- page 253 I believe to 254. I think it spanned both
8 of those pages. So 253 starting at line 16. The question was, so
9 the amount of wax you'd use might depend on the type of
10 ethylene copolymer? And his answer was, I'd speculate. Maybe I
11 don't want to speculate. I don't know.

12 So sitting here today you don't know whether or not the
13 amount of wax that he would use would depend on the type of
14 ethylene copolymer that you use? Answer, I don't.

15 JUDGE MURPHY: Okay. Thank you.

16 MR. GRIMSRUD: He did agree with us that increasing
17 the wax, though, can adversely affect bondability, which gets to --
18 if I can touch on our argument with the Exxon reference that the
19 composition in question, first of all, Dr. Hsu never analyzed it.
20 I'll go to slide 27.

21 Dr. Hsu -- there's no evidence of Dr. Hsu doing any sort
22 of analysis on this composition. He just asserts in his declaration
23 that it's a hot melt adhesive without doing any type of analysis
24 whatsoever. And as Henkel has been saying, a hot melt adhesive
25 at a minimum means it has to flow when heated and form a bond

1 when cooled, and there's no evidence that this composition forms
2 a bond when cooled or flows when heated.

3 The specification of the '404 patent talks about how if
4 you have too much wax, you can have -- it can adversely affect
5 bondability and here -- and it says if you're using ethylene
6 copolymer, don't use more than 30 percent wax. This is 40
7 percent wax, so it's inconsistent with that teaching in the patent
8 and Dr. Hsu did no analysis of any kind to see if this composition
9 would flow when heated and form a bond when cooled.

10 JUDGE MURPHY: But it's not inconsistent with the
11 claims.

12 MR. GRIMSRUD: Well, they point to claim -- I
13 believe he was pointing -- counsel pointed to Claim 20 which,
14 first of all, that's a different claim that they're not challenging the
15 validity of.

16 JUDGE MURPHY: So what, it's in the patent. I mean,
17 it's Claim 1, limitation C. It's Claim 20, limitation C. It's Claim
18 30, limitation C.

19 MR. GRIMSRUD: So on Claim 20, Your Honor, it
20 doesn't require using ethylene copolymer, first of all, so there's
21 various polymers that can be used.

22 JUDGE MURPHY: Well, it doesn't require it, but it's
23 within the scope of the claim, right? Isn't an ethylene copolymer
24 within --

1 MR. GRIMSRUD: Within the scope of Claim 20, yes,
2 it is.

3 JUDGE MURPHY: And that includes a wax
4 component up to 40 percent. The claim doesn't say you can't use
5 40 percent wax with an ethylene copolymer.

6 MR. GRIMSRUD: No, you're correct. It says up to 40
7 percent.

8 JUDGE MURPHY: Correct. So the question is what's
9 the legal relevance of your argument that the claim encompasses
10 what you say is inappropriate?

11 MR. GRIMSRUD: So on Claim 20 there could be
12 various options for how you'd mix something up within the scope
13 of Claim 20. The specification of the patent does say when you're
14 using an ethylene copolymer you should use 10 to 30 percent and
15 this claim has other polymers in it besides ethylene copolymer, so
16 there could be -- if you're using 40 percent wax, for example, you
17 might be using a polymer that's not an ethylene copolymer.

18 In addition to that, though, Your Honor, this is a
19 different claim than Claim 20 is that, again, they're not
20 challenging and it says, wherein said tackifying resin
21 concentration is less than said thermoplastic base polymer
22 concentration. So there's an additional limitation in this claim
23 that says the tackifying resin concentration is less than said
24 thermoplastic base polymer.

1 This Exxon reference has not less tackifier than
2 polymer. It has twice as much tackifier than polymer. So this
3 Exxon reference is a completely different composition than
4 what's being claimed in Claim 20 and there's no analysis of any
5 kind that what would meet Claim 20 is similar to what's in Exxon.

6 I mean, at this point now this is attorney argument from
7 Henkel. Dr. Hsu has no analysis of any kind on Claim 20 or the
8 effects of having, you know, twice as much resin as Claim 20
9 requires.

10 JUDGE MURPHY: Well, what about -- I'm sorry, go
11 ahead, Judge Crumbley.

12 JUDGE CRUMBLEY: Isn't your argument on Exxon
13 premised on hot melt adhesive being a limitation on the claims?

14 MR. GRIMSRUD: Yes.

15 JUDGE CRUMBLEY: And I think -- I don't know how
16 much time you have left, but I think you definitely need to get to
17 that.

18 JUDGE MURPHY: 22 minutes.

19 MR. GRIMSRUD: 22. I'll turn to that right now. Yes,
20 Your Honor, that -- I mean, that's a critical issue that hot melt
21 adhesive is a limitation to these claims and --

22 JUDGE CRUMBLEY: Judge Murphy asked at the
23 outset of Petitioner's argument if all compositions formed within
24 the scope of the two elements in the claim would be a hot melt
25 adhesive and Petitioner's counsel said yes. Do you disagree?

1 MR. GRIMSRUD: We do disagree.

2 JUDGE CRUMBLEY: What evidence is there that that
3 is not true?

4 MR. GRIMSRUD: Okay. One example, Your Honor,
5 would be everybody agrees that a hot melt adhesive -- so these
6 are open-ended --

7 JUDGE MURPHY: You're referring to slide 8 of
8 your --

9 MR. GRIMSRUD: Slide 8, yeah. Everybody -- well,
10 let me just -- let me back up. Everybody agrees that Claim 22
11 and Claim 28 are open-ended claims. So it's a hot melt adhesive
12 comprising A and B. It can also include other stuff as we've
13 talked about, wax, plasticizers, other -- anything else. It's
14 open-ended.

15 So everybody agrees that hot melt adhesives are 100
16 percent solid thermoplastic material, 100 percent thermoplastic
17 material. So, for example, if you added a solvent to a
18 composition to make it a solvent-based adhesive, you no longer
19 have a 100 percent thermoplastic material.

20 JUDGE MURPHY: Well, that's not what it says. It
21 says it's a hundred percent solid. I took that to mean it's a
22 hundred percent solid.

23 MR. GRIMSRUD: No, what they've said in which we
24 would agree with is that a hot melt adhesive on slide 8, as shown

1 here, that hot melt adhesives are 100 percent solid thermoplastic
2 materials, so they're 100 percent solid thermoplastic materials.

3 JUDGE MURPHY: Yeah, but it's not limited to only
4 thermoplastic base polymers. It's the thermoplastic material that
5 might include a resin, that might include a wax or solid
6 benzoate material, right?

7 MR. GRIMSRUD: Well, the hot melt adhesive, Your
8 Honor, can't -- cannot -- they have dictionary definitions I think
9 cited that we didn't -- I can try to dig out where a thermoplastic --
10 a hot melt adhesive, rather, can't have solvent in it. I'd be
11 surprised to hear Henkel come up and say it can have solvent in
12 it, because then you have a -- then it's a solvent-based adhesive.

13 JUDGE CRUMBLEY: So your argument is that it has
14 to be a solid and, therefore, if it's a solvent-based adhesive, which
15 the opened-ended claim might encompass.

16 MR. GRIMSRUD: Right.

17 JUDGE CRUMBLEY: That would not be a hot melt
18 adhesive.

19 MR. GRIMSRUD: Clearly not a -- I mean, that's a
20 simple example where that is clearly not a hot melt adhesive. If
21 you're mixing up these components in a solvent of some kind and
22 then applying the composition as a solvent and then you let the
23 solvent evaporate and then it forms a bond from the solvent
24 dissolving, that's just a whole different beast in adhesives. I
25 mean, that's not a hot melt adhesive.

1 So that's a simple example where a hot melt adhesive in
2 Claims 22 and 28 is the only thing that's limiting the claim to a
3 hot melt adhesive as opposed to something that's a solvent-based
4 adhesive.

5 So these claims are all about hot melt adhesives. It's not
6 an intended use. It's saying these are hot melt adhesives. And
7 then also on slide 8, as Henkel says, as compared to other
8 adhesives. So we're not talking about other kinds of adhesives.
9 We're talking about hot melt adhesives. That's a key limitation.

10 In addition, in Henkel's reply brief on slide 10 they talk
11 about how a hot melt adhesive flows when heated and it forms a
12 bond when cooled. There's nothing in Claims 22 and 28 other
13 than the preamble that imposes the requirement that it flow when
14 heated and form a bond when cooled. You're talking about the
15 composition as a whole.

16 You know, Henkel's point of limitation A as having the
17 resin with a glass transition temperature, which Henkel explains
18 would flow when heated and then cool down and become solid
19 when it cools, that's talking about one constituent of the material.
20 It's the composition that has to flow when heated and form a bond
21 when cooled, the overall composition.

22 So whatever you add to the composition since it's an
23 open-ending claim, you still have to have the requirement that it
24 flows when heated and forms a bond when cooled, for example,
25 as the patent says, if you add too much wax that can adversely

1 affect bondability. So if you're going to add wax to a
2 composition, you could still fall within Claim 22 or 28 as long as
3 it's still a hot melt adhesive, meaning it still flows when heated
4 and forms a bond when cooled.

5 If you add too much wax and so it no longer is forming
6 bonds, no longer will it stick anything together, you no longer
7 have adhesive.

8 JUDGE MURPHY: Is there any support for that in the
9 specification of the '404 patent? Because the only thing I found
10 directly on point was in column 1, lines 20 to 24 roughly, you
11 know, just in the intro to the background of the invention. So
12 that's Exhibit 1001, column 1, lines 20 through 24.

13 MR. GRIMSRUD: So, Your Honor, at column 1,
14 starting at line 20, it is talking about how hot melt adhesives
15 generally comprise thermoplastic polymer components, resins,
16 waxes, plasticizing components, which we agree with. They
17 commonly have those types of things.

18 It's really in column 9, which we refer to in our briefs,
19 where it talks about -- this is at line 52. This paragraph is talking
20 about waxes and it says, at higher wax levels, bondability of the
21 adhesive system may be effective, and then they talk about how
22 lower levels of waxes, the adhesive may set too slowly or heat
23 resistance may be adversely affected.

1 And then it goes on to talk about how, if you're using a
2 particular type of polymer, you need to take that into
3 consideration in choosing how much wax you use. It says --

4 JUDGE MURPHY: Is that a preferred embodiment? I
5 mean, it says it's preferable to use from about 10 percent by
6 weight to about 30 percent by weight of the wax in a
7 composition. I mean, that's a preferred embodiment. It doesn't
8 limit the claim.

9 MR. GRIMSRUD: That itself is a preferred
10 embodiment that doesn't necessarily limit the claim. But what
11 this is showing is that as a general matter if you add wax to a
12 composition, that can adversely affect the bondability and our
13 point tying it back to the preamble, is what the preamble is adding
14 is that it has to be a hot melt adhesive, so it still needs to be
15 forming a bond or it still needs to be flowing when heated and
16 forming a bond when cooled because it has to be an adhesive and
17 stick things together, and so if you add too much wax such that
18 you adversely affect bondability, then it's no longer a hot melt
19 adhesive.

20 JUDGE MURPHY: Well, it doesn't say that. The
21 bondability may be adversely affected and nonpreferred, but it
22 still has bondability. It's just not the bondability one would want
23 to have in a commercial or preferred embodiment. That's not --
24 the claim doesn't carve that out.

1 MR. GRIMSRUD: There's no evidence from Henkel
2 that you can add an unlimited amount of wax, and the patent talks
3 about how adding wax does adversely affect bondability and our
4 point is that the preamble is the only thing limiting the claims to a
5 hot melt adhesive. When you add other components, such as wax
6 or anything else that --

7 JUDGE MURPHY: But other claims contain the wax
8 limitation. They happen not to be the claims at issue. Isn't that
9 the point? I mean, Patent Owner or Patent Applicant understood
10 they could write that limitation into the claims and they did in
11 other claims that are not under consideration.

12 MR. GRIMSRUD: You're right in Claims 22 and 28
13 there is no requirement of wax one way or the other, so it's
14 open-ended. You could add wax.

15 JUDGE MURPHY: You could add as much wax as
16 you want.

17 JUDGE PRAISS: Or none, right?

18 JUDGE MURPHY: But you're trying to jam all of that
19 into the preamble and say, look, it's still got to be a hot melt
20 adhesive which must have these characteristics. Those are use
21 characteristics. See, the fight isn't is it an intended use or is it a
22 substantive compositional limitation and you keep talking about
23 things like bondability, for example, that are use limitations.
24 They're functional limitations.

1 MR. GRIMSRUD: Well, Your Honor, Henkel even
2 agrees that a hot melt adhesive has to form a bond when cooled.

3 JUDGE MURPHY: Yes, but they're not agreeing that
4 it's part of the claim.

5 MR. GRIMSRUD: Understood, and what we're saying
6 is that the claim doesn't limit the amount of wax you can add in
7 the body and that's our point is that the claim body does not limit
8 the amount of wax you add. It's only from the preamble where it
9 has the requirement that you have a hot melt adhesive. And so if
10 you add it --

11 JUDGE PRAISS: It doesn't require any wax at all.

12 MR. GRIMSRUD: It absolutely does not require wax.

13 JUDGE PRAISS: So I could see if you had a wax
14 component required by the claim that needs the hot melt adhesive
15 preamble to make sense of it. But when you have no wax at all,
16 why do we even need to go there? It seems to modulate the
17 amount of wax is what I'm hearing, but I don't understand why
18 we're going there.

19 MR. GRIMSRUD: Let me take an example. Claim 22,
20 for example, says you can have 10 to 50 percent of the tackifier
21 and 10 to 80 percent of the polymer. If someone chose to make a
22 composition with 10 percent of the tackifier, 10 percent of a
23 polymer and 80 percent wax and that composition was not a hot
24 melt adhesive, that composition, because it no longer flowed
25 when heated and formed a bond when cooled, after adding all this

1 wax that composition would not meet -- would not fall within the
2 scope of Claim 22, even though it meets the A requirement of
3 having 10 percent of the tackifier, even though it meets the B
4 requirement of having 10 percent of the polymer.

5 If it's no longer a hot melt adhesive because you've
6 added something to it, it does not fall within the scope of Claim
7 22.

8 JUDGE CRUMBLEY: Counsel, let me ask you this, if
9 hot melt adhesive is a limitation on the claims, it must have --
10 somehow it must have a construction, what is the construction of
11 hot melt adhesive?

12 MR. GRIMSRUD: The hot melt adhesive at a
13 minimum is something that is going to have to be -- something
14 that flows when heated and forms a bond when cooled to stick
15 things together. It has to be an adhesive that will bond things
16 together after being heated and then cooled.

17 JUDGE CRUMBLEY: Okay. My issue with that, and I
18 know that indefiniteness is not at issue before us, but if that is -- if
19 hot melt adhesive is a limitation on the claims, how does that, as
20 you've just defined it, not render the claim indefinite? Because
21 how do I know if I'm a potential infringer, because I've got
22 something that forms a bond that is -- has decreased bondability
23 because it has too much wax in it. Well, it still forms a bond
24 within this broadly defined range that you have here on slide 10.

1 I've got -- the claim gets awful fuzzy if you start saying
2 that hot melt adhesive is a limitation. Do you understand my
3 question?

4 MR. GRIMSRUD: Yep, I understand your question
5 and it's a good question. This is what we're at a minimum would
6 be. We haven't got into issues of how -- what are all the factual
7 considerations you take into account to determine whether or not
8 something qualifies as a hot melt adhesive.

9 Our point is that Henkel has not done any analysis to
10 determine whether or not the Exxon composition would even
11 meet its own definition of flowing when heated and forming a
12 bond when cooled. There's no evidence that it would even
13 qualify under that minimal understanding of a hot melt adhesive.

14 So as far as the indefiniteness and all the details of what
15 facts do you take into consideration of determining whether a
16 given material is a hot melt adhesive, that just hasn't come up
17 and, in part, it's because Henkel has done no analysis of the
18 Exxon composition. There's nothing. There's just an assertion
19 that it's a hot melt adhesive when it has a wax that's higher than
20 specified in the specification.

21 So the whole issue of how exactly do you determine
22 whether everything is a hot melt adhesive, I mean, that just has
23 not been fleshed out.

24 JUDGE CRUMBLEY: I take your point from an
25 evidentiary standpoint, but I guess my question is going back to

1 whether you could even have this as a limitation on the claims.
2 Because if the patent doesn't tell us whether something is a hot
3 melt adhesive or not, how can it possibly be a limitation on the
4 claims? Because a person of ordinary skill in the art would never
5 be able to know whether they fall within or without the claim.

6 MR. GRIMSRUD: If we went down this road of
7 having people analyzing the details of what it means to be a hot
8 melt adhesive and how you show whether or not something's a
9 hot melt adhesive, people of ordinary skill in the art would
10 understand that term.

11 I mean, here's Henkel saying in their petition that as
12 compared to other adhesives, hot melt adhesive has the distinct
13 advantage of being capable of extremely high tack with medium
14 to very fast setting speeds. They're 100 percent solid
15 thermoplastic materials that flow when heated, can bond wide
16 possible ranges of paper stock.

17 So, you know, Henkel knows that there's specific types
18 of adhesives called hot melt adhesives. H.B. Fuller knows there's
19 specific adhesives that are hot melt adhesives. That issue,
20 though, of how exactly one of ordinary skill in the art would as a
21 factual matter pick apart compositions to analyze, whether it's a
22 hot melt adhesive, that hasn't been done and it hasn't been an
23 issue in this proceeding because -- again, because Henkel just
24 gave such a conclusory analysis of hot melt adhesive.

1 JUDGE MURPHY: Mr. Grimsrud, let me stay with
2 that for a minute. I mean, we're all talking about extrinsic
3 evidence in this presumed definition of a hot melt adhesive, but
4 the only thing I found in the patent was at column 1, lines 20
5 through 24 or 25, where it says hot melt adhesives generally
6 comprise, right? And it lists the composition components.

7 Is there any other place in the intrinsic evidence
8 whether it's in the spec or even in the prosecution history that
9 sheds light on a definitional component or a functional
10 definitional use for a hot melt adhesive that you're proposing to
11 read into the claim?

12 MR. GRIMSRUD: Well, Your Honor, the term hot
13 melt adhesive as noted in the term itself has to be an adhesive, so
14 it has to be able to act as an adhesive and, you know, bond things
15 together as an adhesive would do. So at a minimum, a hot melt
16 adhesive has to be an adhesive. So if you have a composition
17 that's just not adhesive, that can't be a hot melt adhesive.

18 JUDGE CRUMBLEY: But aren't there degrees of
19 adhesiveness? I mean, that gets me back to my problem, right, is
20 where is the boundary on this claim? If hot melt adhesive is a
21 limitation, how is the claim bounded at all?

22 MR. GRIMSRUD: Again, that issue just hasn't come
23 up, so --

24 JUDGE CRUMBLEY: I take your point, but I'm
25 looking at the intrinsic evidence as Judge Murphy is.

1 MR. GRIMSRUD: Sure.

2 JUDGE CRUMBLEY: And then trying to find any sort
3 of boundary. Maybe you're telling me that it's so well understood
4 where those boundaries are that a person of ordinary skill in the
5 art doesn't need the patent to tell from that, but I don't see that in
6 the record anywhere.

7 And, again, the only definition that we have is a very --
8 for lack of a better word -- mushy one where it's degrees. As
9 compared to this, it has extremely high this and it has low that
10 and it has bondability, right? But -- sufficient bondability, but,
11 you know, we don't know what that sufficient is.

12 MR. GRIMSRUD: Right.

13 JUDGE CRUMBLEY: So I just think that -- I'm not
14 hearing anything from you that gives me comfort that, if we do
15 say that hot melt adhesive is a limitation on the claims, that we
16 now have not generated a claim that no one knows whether
17 they're infringing or not.

18 MR. GRIMSRUD: Well -- and I know I've said this
19 before, but it's not a -- this is not an indefiniteness issue. The full
20 scope of hot melt adhesives has not been fleshed out and --

21 JUDGE CRUMBLEY: Can it be? I mean, is there
22 some boundary that is reflected in the patent?

23 MR. GRIMSRUD: Sure. You could have people of
24 ordinary skill in the art explaining what a hot melt adhesive is,
25 explaining tests they used to determine if something's a hot melt

1 adhesive. You know, it has to bond to a wide possible variety of
2 paper stock, for example. You know, there are tests people can
3 do to see, you know, does this form a bond.

4 JUDGE CRUMBLEY: We just don't have that --

5 MR. GRIMSRUD: They're just not on record and it's
6 because that issue just -- I mean, that has not been an issue in the
7 proceeding.

8 JUDGE CRUMBLEY: Okay. Thank you.

9 MR. GRIMSRUD: Henkel also -- and part of this with
10 my few minutes left, in Henkel's petition they treated hot melt
11 adhesive as a limitation, so they have these claim charts -- this is
12 the one that's for the Exxon reference. There's a similar one for
13 the Eastotac reference where they say the table below shows how
14 each limitation of Claims 22 through 25 and 28 is taught by the
15 Exxon reference, and the very first thing they hit there is a hot
16 melt adhesive composition comprising and they assert the
17 footnote 1 of the Exxon reference disclosed as a hot melt
18 adhesive, which, again, we disagree with them and believe they
19 have not met their burden of proof on showing that the footnote 1
20 is a hot melt adhesive.

21 But the point here is that in their petition they treated
22 hot melt adhesive as a limitation. They all have a similar
23 statement in their petition that says each of the claims is directed
24 to a hot melt adhesive.

1 If I can find it here, I think it's at page 8. No, it's not.
2 It's at page 6 of their petition. Henkel says, each of the
3 challenged claims is directed to a hot melt adhesive composition.
4 Nowhere in their petition or Dr. Hsu's analysis was there any sort
5 of suggestion that hot melt adhesive was not a limitation.

6 They never analyzed limitations A and B and said, you
7 know, it doesn't matter whether this is a hot melt adhesive or not.
8 It meets limitations A and B. There's just no suggestion of that in
9 their petition.

10 JUDGE MURPHY: Well, but what they said is it's in
11 the preamble and the presumption, the legal presumption is it's
12 not a limitation, unless there's a reason to make it a limitation. So
13 we're looking to you to provide the reason for us to consider it to
14 be a limitation.

15 MR. GRIMSRUD: Okay. And the reasons -- first of
16 all, we do believe that this is waiver. We believe that if someone
17 is treating something as -- the preamble as a limitation they need
18 to -- they can't just switch in their reply brief and say, you know,
19 no, it's not a limitation.

20 JUDGE CRUMBLEY: But claim construction is a
21 legal question and we have to get it right whether or not the
22 parties agree. A party can come in and agree to a claim
23 construction and it would still be error for us to adopt that if we
24 think it's wrong, so it doesn't matter whether they waived it or
25 not. It just matters whether there's a limitation. So, you know, I

1 don't know that you're spending -- this is a good use of your time
2 to talk about this.

3 MR. GRIMSRUD: Well, I'll move on. The Federal
4 Circuit does recognize waiver of claim construction arguments,
5 but as far as why it's a limitation, it's the reasons that we've
6 explained that there is nothing in limitation A or B of Claim 22 or
7 28 that limits the invention to a hot melt adhesive, that it's an
8 open-ended claim --

9 JUDGE MURPHY: Let me ask you this, is the fact that
10 the base polymer is claimed as a thermoplastic base polymer and
11 you have a hydrocarbon-derived tackifying resin, do those two
12 things alone mean that it must be a hot melt adhesive assuming
13 you're within the compositional ranges given?

14 MR. GRIMSRUD: No, Your Honor.

15 JUDGE MURPHY: Okay. So why not?

16 MR. GRIMSRUD: So you could -- first of all, you
17 could add things to it, like solvents or wax or plasticizers, and if it
18 changed the properties of the composition so it was no longer a
19 hot melt adhesive, it would not be a hot melt adhesive. Setting
20 that aside, even with like the polymer, for example, if you picked
21 a polymer that was a very high molecular weight polymer, that's
22 not going to flow when heated. A very high molecular weight
23 polymer will not flow when heated, so that can't be a hot melt
24 adhesive, even though it would meet the claim limitation.

1 JUDGE MURPHY: So what you're saying is without
2 the preamble of being a limitation, these claims wouldn't -- I
3 mean, that they are overbroad, right? I mean, you're saying
4 they're not necessarily operable, right?

5 MR. GRIMSRUD: Yeah, we're saying it makes no
6 sense to have these claims not be limited to a hot melt adhesive.
7 If you did that, you'd be saying these claims are just any
8 composition that has A and B and that's not the invention. The
9 invention is not any composition that has the tackifier and the
10 polymer. That is not the invention. The invention is a hot melt
11 adhesive.

12 JUDGE PRAISS: But you would then be construing
13 the claim to preserve the validity rather than the broadest
14 reasonable interpretation of the claim.

15 MR. GRIMSRUD: We're not relying on that doctrine.
16 We're construing the claim to be -- to include the essential
17 structure, essence of the invention, which is a hot melt adhesive.
18 That's where we're really coming down is that I think it's the
19 *Catalina* case, other ones we cite where the preamble, if it's an
20 essential component of the invention, it is a limitation.

21 The *American Medical* case they cite, Henkel cites, says
22 something like the preamble is not limiting if deletion of the
23 preamble phrase does not affect the structure or steps in the
24 claimed invention.

25 JUDGE MURPHY: You have one minute.

1 MR. GRIMSRUD: And here deletion of the preamble
2 would -- you'd be wiping away what the invention is. The
3 invention is a hot melt adhesive. You can't just ignore the
4 preamble language hot melt adhesive to this invention or else
5 you're just undermining and ignoring the entire invention.

6 And so with that, Your Honors, we do not believe
7 Henkel has met their burden of proof. They haven't applied the
8 correct perspective of one of ordinary skill in the art. Dr. Hsu
9 hasn't analyzed any of these references from the perspective of
10 one of ordinary skill in the art and we believe their invalidity
11 arguments should all be rejected. Thank you.

12 JUDGE MURPHY: Thank you, Mr. Grimsrud.

13 All right. Mr. Tridico, you have 30 minutes.

14 MR. TRIDICO: Okay. Great. Thank you.

15 It should be coming up. Okay. I'd like to address a
16 couple of the points that were raised and, of course, any questions
17 you have. But if I can start with slide 32 of our presentation and
18 there was a discussion about intrinsic evidence and what do we
19 learn about the preamble from the intrinsic evidence.

20 I think what's clear is we learn that the preamble was
21 never relied on in the intrinsic evidence. In fact, it was used
22 interchangeably. You have hot melt adhesive, you have adhesive,
23 you have composition. These are some excerpts from the
24 prosecution history.

1 Adhesive composition, it refers to different
2 compositions provided by the invention. It's never in any way
3 used to distinguish prior art, to get an enablement, to get
4 indefiniteness, nothing of that nature.

5 JUDGE MURPHY: Well, but what about Mr.
6 Grimsrud's point that -- let me put it to you this way, even
7 looking at the prosecution history cited in your slide, doesn't it --
8 does it make sense that the composition at least should require
9 that it be an adhesive, that it have some type of adhesive
10 capability?

11 MR. TRIDICO: Well, I think you get that structure
12 from Claim 22 and from the body of the claim. It doesn't require
13 the preamble. 22 requires the tackifier in a certain amount which
14 has the glass transition temperature. That's the adhesive --

15 JUDGE MURPHY: And the response to that is it's an
16 open-ended claim. If you throw solvents in, other stuff in the
17 claim, but it's not necessarily an adhesive.

18 MR. TRIDICO: Well, if you -- maybe if you choose
19 and throw something that one of skill in the art wouldn't, okay, if
20 you throw 90 percent solvent, one of skill in the art is not going to
21 do that.

22 JUDGE MURPHY: Well, they do that if they want a
23 hot melt adhesive.

24 MR. TRIDICO: They're not going to do that if they
25 want any type of composition, right? If you add solvent, it's still

1 a hot melt adhesive. There's diluted hot melt adhesives. They do
2 exist. This isn't a question of what can we think of that's absurd
3 to add to the claim that wouldn't give it any utility, right?

4 JUDGE MURPHY: Let me ask you this, the only
5 intrinsic evidence that I'm aware of is the part in column 1 that
6 talks generally about hot melt adhesives, which I cited earlier,
7 and the slide you were just on -- was it 32 with the prosecution
8 history?

9 MR. TRIDICO: Yes.

10 JUDGE MURPHY: So take -- just take me through this
11 slide in more detail, please, in terms of --

12 MR. TRIDICO: Okay. Our point was that in the
13 specification in the prosecution history they don't just refer to the
14 invention as a hot melt adhesive. They refer to it as a
15 composition. They refer to it as an adhesive composition. They
16 also refer to it as a hot melt adhesive composition. They're used
17 interchangeably.

18 For example, in the '404 patent they say the invention is
19 an adhesive composition. In the example, the example illustrates
20 a composition. In the response to the Examiner, they refer to
21 adhesive compositions in compositions. They clearly weren't
22 consistent in using hot melt adhesive in any way to define the
23 invention or to distinguish the invention. That's our point and I
24 think that's the intrinsic -- that is the intrinsic record. There's
25 nothing else.

1 JUDGE CRUMBLEY: But, I mean, you told us in your
2 opening that anything that has the proportions of the two
3 compositions would be a hot melt adhesive. Do you stand by that
4 statement? I mean, again, Mr. Grimsrud made a good point that
5 there's -- if you get 10 percent of A, 10 percent of B and 80
6 percent of something that completely destroys the adhesive
7 qualities of the composition, that's not going to be a hot melt
8 adhesive.

9 MR. TRIDICO: This claim has no utility either.

10 JUDGE CRUMBLEY: That may be the case, but it still
11 falls within the claim whether it has utility or not.

12 MR. TRIDICO: You're right, it would fall -- I can't
13 deny that. It would fall within the claim, right? But one of skill
14 in the art looking at the invention, looking at the claim, they're
15 not going to have 10 percent of an adhesive composition. The
16 question is whether or not the structure necessary is provided in
17 the body of the claim.

18 The structure necessary is provided in the body of the
19 claim. Can you destroy that structure by adding something else?
20 Yes. But is the structure necessary provided in the body of the
21 claim? Yes, it is, the adhesive composition and the thermoplastic
22 composition.

23 I can't deny you could destroy any properties of the
24 composition like you could any composition that's open-ended. If
25 that was the analysis, you would say that every composition

1 claim, every method claim, you had to put weight into the
2 preamble. Because I could pick any patent up and any
3 composition claim that has comprising. You could destroy what
4 it does by adding something to it.

5 I'll add ice cream, I'll add anything. We could be
6 absurd. So does every preamble provide patentable weight? No.
7 The case law is clear. In fact, it's the exception when the
8 preamble adds patentable weight. So, yes, can we destroy the
9 claim? I can't argue with you about that. I'd be lying. It can, but
10 the structure needed to provide the properties of the invention are
11 in the body of the claim.

12 JUDGE MURPHY: And so what you're saying is if we
13 have a composition with the components A and B within the
14 recited ranges and nothing else, it will always be --

15 MR. TRIDICO: It would always function as a hot melt,
16 that's correct.

17 JUDGE MURPHY: Okay.

18 MR. TRIDICO: Another point I'd like to go to, which
19 is with regard to Dr. Hsu and his background and the testimony.
20 First of all, Patent Owner pointed to his deposition transcript
21 saying that he asked him questions that Dr. Hsu was unable to
22 answer. I think the context of those questions should be looked
23 at.

24 I think if you look at the context of the discussion on
25 pages 250 I think, 253 is what's referred to. They were walking

1 Dr. Hsu through the '404 patent and asking him questions with
2 regard to what does this say, what does that say. He refers in
3 earlier pages saying, this says thermoplastic polymer. It doesn't
4 say wax.

5 He was not speculating as he walked through and he
6 says that. I'm not going to speculate. He's a scientist. Does he
7 know if you add a copolymer to a wax if it's going to work? It
8 depends. There's a lot of factors. He wasn't going to speculate.
9 It's not that he didn't know the answer, so I would suggest that
10 you read the context of the questions before you accept that he
11 was being asked things that he didn't know about.

12 Again, if we look at Dr. Hsu's background, he said in
13 his declaration that he is an expert and does research in hot melt
14 adhesives. Does he have the lab experience? Again, I'd hope not.
15 He's the head of the department.

16 JUDGE CRUMBLEY: Well, at some point he wasn't
17 the head of the department and, you know, maybe he was a lab
18 technician and didn't work on it.

19 MR. TRIDICO: Maybe he was, maybe he was, but
20 the --

21 JUDGE CRUMBLEY: So, I mean, I think our
22 discomfort or my discomfort with this -- I shouldn't speak for the
23 panel -- is that -- and I'm looking at 253 of his deposition. So the
24 amount of wax you'd use might depend on the type of ethylene

1 copolymer. I mean, that's a fairly general question about these
2 compositions and he says I don't know and --

3 MR. TRIDICO: I'd speculate. He started with I'd
4 speculate.

5 JUDGE CRUMBLEY: But by saying "I'd speculate"
6 means he doesn't know, right, because he'd be speculating. So
7 how do you square that up with now you're telling us that he can
8 look at the Exxon reference and without doing any testing,
9 without doing anything other than looking at the components
10 know I've got a hot melt adhesive right there?

11 MR. TRIDICO: Let's go to the Exxon reference.

12 JUDGE CRUMBLEY: Aren't those two things
13 inconsistent?

14 MR. TRIDICO: I don't think so. I mean, this doesn't
15 specify any amounts of wax, any amount of copolymer, what
16 copolymer you're talking about, what wax you're talking about.
17 There's a lot of unknowns here. Of course he wouldn't know.
18 The Exxon reference we talk about specific tackifiers, a specific
19 polymer, a specific wax. That's very different from just saying
20 any ethylene copolymer and any wax. You'd be speculating. He
21 wouldn't know. He's a scientist. Here, he's looking at specific
22 amounts, specific compositions and specific components. I think
23 that's very different. That's a very different question.

24 If industry is paying him to consult, which he testifies
25 they are, which is in his declaration, would he not be an expert in

1 this area? I mean, let's look at it practically. Let's look at his
2 background. Yes, one of his references talks about in the title hot
3 melt adhesives.

4 Go through the rest of the references. They all talk
5 about the different polymers that are used in hot melt adhesives.
6 He understands and does research and consults on the basis of
7 these polymers. His definition of one of skill in the art is if you
8 have a graduate degree and experience in polymer engineering,
9 you understand the basics of these systems. Again, this isn't
10 rocket science. We're talking about references from the '70s.
11 This is well-known basic textbooks with regard to how to
12 formulate these systems.

13 Counsel said that no one has made prior to Fuller a hot
14 melt adhesive composition with a high Tg. What are the
15 examples here in the Exxon reference, what are the examples that
16 are given in the Eastotac reference? Again, let's look at it in
17 context.

18 Is Eastman going to tell you to make this composition?
19 Here's our prophetic example. If they didn't know that it was
20 going to work, you'd never buy something from them again. This
21 isn't speculation. These are compositions that they're trying to
22 sell you.

23 JUDGE MURPHY: Mr. Tridico, I want to go back to
24 Dr. Hsu's expertise or competence.

25 MR. TRIDICO: Yes.

1 JUDGE MURPHY: And as I understand it, the issue
2 raised by the Patent Owner is a legal question. Has Petitioner
3 satisfied the burden of proof or in their view not satisfied the
4 burden of proof because Dr. Hsu has utilized an incorrect
5 standard for a person of ordinary skill and part of that is an attack
6 on his credentials or experience.

7 MR. TRIDICO: His credentials, yes.

8 JUDGE MURPHY: And I have to say, though, there's
9 an aspect of his deposition -- this is from pages 34 through 36 of
10 Dr. Hsu's deposition, which is Exhibit 1039.

11 MR. TRIDICO: I'm sorry, pages --

12 JUDGE MURPHY: It starts on page 34 and it runs
13 through the top of page 36.

14 MR. TRIDICO: Okay.

15 JUDGE MURPHY: If you're with me. So, for example
16 -- I don't want to run through all this, but I want to give you a
17 chance to see it. So on the top of page 34, line 1, "Question,
18 During your research at the University of Massachusetts Amherst,
19 have you personally formulated hot melt adhesives? Answer,
20 No."

21 MR. TRIDICO: No.

22 JUDGE MURPHY: "During the course of your
23 research, have you ever personally made a hot melt adhesive?"

24 MR. TRIDICO: "No."

1 JUDGE MURPHY: "So have you ever made a hot melt
2 adhesive? No." And, you know, it goes on. And then if you
3 jump with me to the top of page 36 at lines 1 through 3,
4 "Question, Have you ever done any experiments of any kind on
5 an actual hot melt adhesive? Answer, No."

6 So I take the point that if it was done in his lab, he could
7 have said yes. I mean, he runs the lab.

8 MR. TRIDICO: But he didn't understand the question
9 that way. It was asked did he do it? Let's look at page 35, lines 2
10 to 7.

11 JUDGE MURPHY: Well, hang on, stay with me.

12 MR. TRIDICO: Yes, sorry.

13 JUDGE MURPHY: Don't deflect me, until I want to be
14 deflected. You're saying -- look, the testimony, as I read it, he
15 has never personally done any of those things and I guess it
16 means other people in his lab might have done those things, but
17 he didn't. I mean, how does that square?

18 MR. TRIDICO: I think that's a possibility. The other
19 possibility, if we look at the questions, all deal with laboratory
20 work. Dr. Hsu -- look at some of his publications. He does a lot
21 of computer modeling. He does a lot of --

22 JUDGE MURPHY: No, I understand how it goes.

23 MR. TRIDICO: Okay. I think, again, look at 35, lines
24 2 to 7. We have certainly worked on components associated with
25 hot melts. That's where the structural characterizations come in.

1 That's where the solidification, crystallization comes in, but we
2 have not worked directly on hot melt formulations.

3 On page 37, line 12, have you ever done any type of
4 testing? Cohesive property is an inherent property of material
5 and that we have done. So it's not that he hasn't done anything.
6 We then asked him a question at the very end. We redirected and
7 we asked, in the last 16 years of advising companies such -- have
8 you advised on tackifiers, polymers and waxes as a component of
9 hot melt adhesives? I've looked at the waxes and the polymers as
10 the components of polymer adhesives.

11 It's his background. He does this work. Has he done
12 any of the specific questions they asked him? No, but I don't
13 think you can say that he's not qualified to opine on hot melt
14 adhesives as they're used. That's what he does for a living.

15 I'd also like to address that counsel said that Dr. Hsu
16 didn't opine on whether or not the Eastotac brochure immediately
17 envisaged the examples. Actually he did. He didn't use the word
18 at least one envisaged, but I think if you look at his declaration,
19 paragraphs 42 and 43, the Eastotac brochure lists the following
20 specific examples of hydrocarbon resins and he lists them.

21 The color, the resin. Eastotac effectively lists only four
22 examples of Eastotac hydrocarbon resins were available. In these
23 two paragraphs, he walks through how you go from Table 3 and
24 you are directed to Table 1. He doesn't say that you at least

1 envisage, but he is in his actions in the way he walks through his
2 analysis. He started with Table 3. It says to use the resins.

3 As you pointed out in the brochure, it says these resins.
4 There's no other resins disclosed and he follows the table to Table
5 1 and lists them and says these are examples as I read it in this
6 brochure.

7 So I read that as a disclosure of exactly that. Yes, he
8 doesn't use the legal terms, but that's exactly I think what he did.

9 JUDGE MURPHY: And so whether or not a person of
10 ordinary skill had any experience directly with hot melt
11 adhesives, are you saying that the document itself walks you
12 through --

13 MR. TRIDICO: I think the document itself walks you
14 directly through it. It directs you. There's nowhere else to go.

15 If we look at the document, there's Table 3. It says
16 Eastotac resins. The only other -- the only resins are the ones in
17 Table 1 and the reference says these are especially useful for hot
18 melt adhesives. I'm not sure what else you need. It's all provided
19 there.

20 JUDGE CRUMBLEY: What about Mr. Grimsrud's
21 argument about Table 3 having three columns, including the PE
22 base, that doesn't fall within, so --

23 MR. TRIDICO: It's a different thermoplastic polymer.

24 JUDGE CRUMBLEY: No, I understand that, but his
25 point was it's not just a matter of picking between the four

1 Eastotac resins and then plugging it in Table 3. You also have to
2 know which column of Table 3 to plug it into to reach the claims.

3 MR. TRIDICO: Again, I would say that those are --
4 there are multiple examples. One hypothetical example falls
5 within the scope. You don't need all of them to --

6 JUDGE CRUMBLEY: I understand that, but, again, it
7 expands the genus that you would have to examine to find --

8 MR. TRIDICO: If you view this as a genus.

9 JUDGE CRUMBLEY: Yes. Do you not view it as a
10 genus?

11 MR. TRIDICO: I don't view it as a genus. I view these
12 as, these are specific compositions you can make and it directs
13 you to the Eastotac resin as the resin to use. There are four
14 different resins. I see those as four different examples of each of
15 the different resins. I don't see that as a genus. I see that as a
16 number of hypothetical examples that it directs you to.

17 Just to sum up, unless there's any other questions. This
18 started in Fuller's presentation with the discussion of Petitioner
19 not meeting its burden and not providing evidence. I think the
20 evidence is pretty clear. We provide Dr. Hsu, the only expert in
21 the case, his testimony. We have an argument that he's not one of
22 skill in the art. We've not seen testimony from anyone else who's
23 defined what one of skill in the art would be if it's not what Dr.
24 Hsu says it is. They've provided no testimony from anyone to ask
25 them what one of skill in the art is.

1 Dr. Hsu is the only expert in the case. His testimony
2 and his definition is what we have. We've provided references
3 and examples to support his testimony. It's not just his lone
4 testimony. There are references and examples that we've
5 provided that support his testimony.

6 We've also provided a number of pieces of prior art to
7 describe, such as Litz, such as Kraus, what the knowledge of
8 prior art was at the time. So I think we've provided a record with
9 complete evidence that the Board reviewed when instituting and
10 in this case there's been nothing else to refute any of that evidence
11 that the Petitioner has put forward.

12 JUDGE MURPHY: All right. Anything further from
13 the Board?

14 Mr. Tridico, thank you.

15 MR. TRIDICO: Thank you very much.

16 JUDGE MURPHY: All right. We stand adjourned.

(Concluded at 11:56 a.m.)