Paper No. _____

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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THE SHERWIN-WILLIAMS COMPANY,
Petitioner,

v.

ARCH CHEMICALS, INC.,
Patent Owner

Patent No. 9,723,842
Issued: August 8, 2017
Filed: May 24, 2007
Inventors: Nicholas Edward Thompson, Malcolm Greenhalgh, Fitzgerald Clark
Title: Isothiazoline Biocides Enhanced By Zinc Ions

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Inter Partes Review Nos.: IPR2019-01497; IPR2019-01498

PETITIONER'S EXPLANATION OF MATERIAL DIFFERENCES BETWEEN PETITIONS AND PETITION RANKING FOR U.S. PATENT NO. 9,723,842

I. Introduction

Petitioner, The Sherwin-Williams Company ("Petitioner") has filed two concurrent *inter partes* review ("IPR") petitions (IPR2019-01497 and IPR2019-01498), challenging the validity of the claims in U.S. Patent No. 9,723,842 ("the '842 patent"). Pursuant to the Board's July 2019 Trial Practice Guide Update, Petitioner submits this paper to identify: "(1) a ranking of the petitions in the order in which it wishes the Board to consider the merits . . . .," and "(2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions." *See* "TRIAL PRACTICE GUIDE UPDATE (July 2019)" at 26-28.

II. Considerations in Allowing Multiple Petitions Covering Different Grounds Where Patent Owner Has Asserted a Large Number of Claims

The '842 patent is subject to a pending lawsuit *Arch Chemicals, Inc. v. The Sherwin-Williams Company et al.*, 1:18-cv-02037-LPS (D. Del.) (the "Litigation"), in which Petitioner is a Defendant. Patent Owner asserted 28 of the 39 claims in the Litigation. Given the large volume of claims being asserted, Petitioner is not able to fit all of its non-redundant grounds into a single petition. Thus, the present circumstance is consistent with the example in the Trial Practice Guide, which states that "the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation." *Id.* at 26.

Further adding to the requisite length to each Petition (and *severely* limiting Petitioner's ability to file a single Petition under the word count limitations), are significant issues of claim construction. The '842 patent claims an antimicrobial composition for use in a functional fluid. Petitioner asserts that the claim structure and specification demonstrate that the antimicrobial composition is distinct from the functional fluid. In addition, the claims recite certain components present in the antimicrobial composition in specific concentrations. Petitioner asserts that the claimed concentrations cover the antimicrobial composition.

Patent Owner has advanced a contrary position in the Litigation that the antimicrobial composition and functional fluid are one in the same. Further, Patent Owner improperly asserts that the claimed concentrations cover the functional fluid.

Different sets of references are used in each Petition to account for these material differences in claim interpretation. This justifies instituting both Petitions. *See* IPR2019-00237, Paper 15 at 14 (instituting multiple petitions based in part on "claim construction arguments resulting in different manner of application of the prior art").

Petitioner has not filed a Petition concerning any of Patent Owner's patents that were not asserted against Petitioner, and due to the statutory time bar, Petitioner has had no choice but to file petitions at the same time. Further, in consideration of 35 U.S.C. § 315(c) estoppel, Petitioner has asserted only a small number of grounds as opposed to the universe of grounds it could potentially raise.

Petitioner believes that both of its Petitions are meritorious and justified in light of the considerations and materials differences discussed herein, and respectfully requests that the Board institute both Petitions.

III. Ordering of Petitions

Although Petitioner believes that its Petitions are meritorious and justified, Petitioner requests that the Board consider the Petitions in the following order:

Rank	Petition	Grounds and References
A	IPR2019-01497 (Petition 1)	**Ground 1**: Morpeth (§ 102 anticipation), or Morpeth and knowledge of POSITA (§103 obviousness) [claims 1, 2, 3 and 6] **Ground 2**: Morpeth and Handbook and POSITA (§103 obviousness) [claims 7, 8, 9, 10, 12, 13, 15, 17, 18, 20, 21, 24, 25, 26, 27, 28, 31, 32, 33, 36, and 37] **Ground 3**: Hawkett (§ 102 anticipation) [claims 1, 3, 6, 7, 10, 13, and 15] **Ground 4**: Hawkett in view of Handbook and POSITA (§103 obviousness) [claims 4, 5, 9, 12, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 31, 32, 33, 36, 37, and 38]
B	IPR2019-01498 (Petition 2)	**Ground 1:** Liu and POSITA (§103 obviousness) [claims 1, 2, 3, 6, 7, 8, 10, 13, and 15] **Ground 2:** Liu, Handbook, and POSITA(§103 obviousness) [claims 9, 17, 18, 20, 21, 24, 25, 26, 27, 28, 31, 32, 33, 36, 37, and 38] **Ground 3**: Handbook and the common knowledge of a POSITA (§103 obviousness) [all claims of the '842 patent]

IV. Material Differences that Compel Permitting Multiple Petitions Here

The Petitions are not redundant. No two grounds cover the same set of claims, or treat the claims in the same manner. The grounds are not duplicative.

The claims in each petition are divided into two categories of grounds, or references, necessitated by potential differences in claim interpretation: (1) grounds where the antimicrobial composition is distinct from the functional fluid and the claimed concentrations of the ‘842 patent read on the antimicrobial composition (Category 1) and (2) grounds where the antimicrobial composition and functional fluid are the same and the claimed concentrations read on the functional fluid (Category 2). The grounds that cover Category 1 and Category 2 in any one petition are different. Similarly, grounds that cover the same Category between petitions are different (horizontal difference).

	Petition 1	**Petition 2**
Category 1 [Antimicrobial composition distinct from functional fluid; concentrations in antimicrobial composition]	Ground 1: § 102 Morpeth (claims 1, 2, 3 and 6) Ground 2: § 103 Morpeth/Handbook/POSITA (claims 7, 8, 9, 10, 12, 13, 15, 17, 18, 20, 21, 24, 25, 26, 27, 28, 31, 32, 33, 36, and 37)	Ground 1: § 103 Liu/POSITA (claims 1, 2, 3, 6, 7, 8, 10, 13, and 15) Ground 2: § 103 Liu/Handbook/POSITA (claims 9, 17, 18, 20, 21, 24, 25, 26, 27, 28, 31, 32, 33, 36, 37, and 38)
Category 2 [Antimicrobial composition and functional fluid are the same; concentrations in finished product]	Ground 3: § 102 Hawkett (claims 1, 3, 6, 7, 10, 13, and 15) Ground 4: § 103 Hawkett/Handbook/POSITA (claims 4, 5, 9, 12, 18, 20, 21, 22, 23, 24, 25, 26, 27, 28, 31, 32, 33, 36, 37, and 38)	Ground 3: § 103 Handbook (all claims)

In particular, Morpeth (Ground 1, Petition 1) is different from Liu (Ground 1, Petition 2). Liu discloses an antimicrobial concentrate that is diluted to form an antimicrobial composition. Morpeth discloses an antimicrobial composition. Additionally, in Petition 1, the Category 2 grounds are based on Hawkett, which discloses a paint meeting the concentration claims (per Patent Owner's read of claim scope), while Petition 2 relies on another reference, Handbook, in which Patent Owner's employee taught that each of the claimed components be used a recommended amount, which reads on the claims. Given the different references, the motivation to combine or modify the references materially differs.

V. The Board should exercise its discretion to institute both petitions.

The Board should institute both Petitions because of the material differences and considerations discussed above. The Petitions are not redundant. Moreover, they each provide strong showings of unpatentability and obviousness, without repeating the same theories or points. Accordingly, Sherwin-Williams requests that the Board institute trial on both Petitions.

August 16, 2019 **Robins Kaplan LLP**

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