

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ATTENDS HEALTHCARE PRODUCTS, INC.,  
Petitioner,

v.

PAUL HARTMANN AG,  
Patent Owner.

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Case No. IPR2020-01479  
U.S. Pat. No. 8,771,249

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**PATENT OWNER'S SUR-REPLY**

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## **I. Introduction**

In its Reply, Petitioner abandons prior arguments and presents new ones. Petitioner also frequently disguises its failure to meet its burden of proving obviousness by arguing that Patent Owner failed to prove nonobviousness or failed to disprove the possibility that a combination would yield the claimed invention. Petitioner, however, bears the burden of proving obviousness. Further, because Petitioner's obviousness grounds are premised on inherency, it also bears the burden of establishing that the claimed invention would have necessarily resulted from the combinations. Petitioner did not and cannot meet either burden, particularly given its express disavowal of inherency.

## **II. The References, Alone or In Combination, Do Not Teach Differing Retaining Forces Sufficient to Secure the Diaper**

The Beckert patents teach a diaper where retaining forces between fasteners and the front of the diaper are lower than retaining forces between fasteners and the sides of the diaper, and where both retaining forces are sufficient to secure the diaper on the wearer. *See, e.g.*, Ex. 1001, 2:7-45. This arrangement encourages proper securement. *Id.* Claim 1 requires that closure components “selectively fasten[] to either said outer face of said chassis or to said outer face of said first and second ears,” and that retaining forces between the closure components and the outer face of the chassis or first and second ears “hold the diaper on the user body

when” fastened. *Id.*, 16:13-18. It also requires that the retaining forces between the closure component and outer face of the chassis “are lower than retaining forces between said closure component” and the outer face of the first and second ears. *Id.*, 2:19-22. No reference teaches this arrangement.

In the Petition, Petitioner acknowledged that the claims require that the lower retaining forces be sufficient to secure or hold the diaper on the wearer. Pet., 3, 31, 35-36, 38, 60. Petitioner’s failure on this limitation is illustrated by its attempt to recast it as “necessarily broad.” Reply, 1. But because Petitioner’s belated construction would read a limitation out of the claims, it should be rejected. *In re Power Integrations, Inc.*, 884 F.3d 1370, 1376 (Fed. Cir. 2018).

Because the prior art does not teach the claimed differing retaining forces sufficient to hold the diaper on the wearer, Petitioner relied on inherency. Prelim. Resp., 28-42, 47-53; Resp., 24-34, 49-55. As discussed below, Petitioner failed to establish inherency and now disavows inherency. Petitioner also argues that “size adjustability” and using material with different basis weights would lead to the claimed retaining forces. Pet., 54-58, 35-39. But neither does.

**A. Size adjustability does not provide the claimed differing retention forces or a motivation to arrive at the claimed invention**

Throughout the Reply, Petitioner recites “size-adjustability” as a cure-all for its failings. Reply, 1, 4, 16-18. Petitioner argues that the reference to “size

adjustability” in Karami ’626 somehow demonstrates the claimed differing retaining forces for all combinations and provides a reason to arrive at the claimed invention. *Id.*

For Karami ’772-Benning, Petitioner argues that Karami ’626’s mention of size adjustability shows that the stay-away-zone in Karami ’772 sufficiently engaged fasteners. *Id.*, 5-6; Pet., 35-36. For Benning-Karami ’626, Petitioner reiterates that the combination is “founded on size adjustability.” Reply, 1; Pet. 56. But “size adjustability” would not have led one of ordinary skill to the claimed differing retaining forces or to the combinations.

Karami ’626’s reference to size adjustability is not a teaching of differing retaining forces, let alone differing retaining forces that are sufficient to secure the diaper. Petitioner continues to rely solely on one sentence in Karami ’626: “when the T-shaped brief 12 is made according to the present invention so that the fastener elements 41, 42 do not require landing zones and may engage directly with any portion of the nonwoven surface constituting the frontsheet 30, backsheet 32 or wings 40 of the brief, the accommodation of both small and large waisted persons by a single brief 12 with elastic wings 40 is substantially simplified.” Ex. 1004, ¶ [0040]; Reply, 6, 16. But that statement says nothing about differing retaining forces, and Karami ’626 says nothing about differing retaining forces for size adjustability or any reason.

Moreover, the reference to size adjustability was for the T-shaped diaper. Ex. 1004, ¶ [0040]. Karami '626 teaches how to provide size adjustability in the T-shaped diaper—by having fasteners engage different part of the wings, which has the same nonwoven across its surface. *Id.*, ¶¶ [0040]-[0041], [0050]-[0051]. While Petitioner continues to argue that Karami '626 teaches having fasteners engage the backsheet at the front of the diaper, Petitioner never explains how that could be done with the T-shaped diaper. Reply, 6. Even Petitioner's expert, Mr. Jezzi, acknowledged that fasteners only engage the wings in Karami '626's T-shaped diaper. Ex. 2003, 163:18-21, 164:13-19. This makes sense because Karami '626 teaches donning the T-shaped diaper by fastening the belt and then bringing the main body portion between the legs and attaching fasteners, which are located on the *frontsheet* of the main body, to the belt. Ex. 1004, ¶¶ [0037]-[0038].

Now Petitioner relies on the alleged size adjustability of the diaper in Figures 9-10 even though that is not mentioned. Reply, 6-8. Karami '626 only provides one sentence about the Figures 9-10 diaper and does not describe it as having different retaining forces, permitting size adjustability based on different retaining forces, or using nonwovens having different basis weights. Ex. 1004, ¶ [0055]. And even if the Figures 9-10 diaper permitted size adjustability, it would be because the diaper is shown as a single unit having the same material across it.

It would not provide a reason to use differing retaining forces to achieve size adjustability.

Also, seeking size adjustability would not have led one of ordinary skill to use nonwovens having different basis weights to generate different retaining forces sufficient to secure a diaper. Indeed, Damaghi, which Petitioner cites (Pet. 24, 35; Reply, 3-5, 8, 16), teaches the opposite. Ex. 1028; Resp., 22-24. Damaghi teaches that using a loopless fastening system, i.e., the same nonwoven across a diaper to engage fasteners, can lead to improperly sized diapers resulting from too much permitted size adjustability. Ex. 1028, ¶¶ [0007], [0020]-[0021], [0048]-[0051]. To prevent this, Damaghi teaches creating a “stay-away-zone” where fasteners cannot engage. *Id.*, ¶¶ [0050]-[0051]. Damaghi thus teaches using different retaining forces to *prevent* size adjustability, not to *permit* it. Petitioner identifies no prior art teaching achieving size adjustability through nonwovens with differing retaining forces or even through using different nonwovens having different basis weights.

Petitioner contends that “PO’s final argument here is that size-adjustability was *best achievable* using same-basis-weight wing and backsheet nonwovens.” Reply, 17 (emphasis added). But Patent Owner demonstrated that the prior art *only* teaches size adjustability by using the same basis weight nonwoven. Resp., 23-24, 46-47. And Petitioner has not identified any prior art that teaches using different basis weight nonwovens to achieve size adjustability.

Petitioner also contends that Patent Owner’s argument that size adjustability was achieved using the same nonwoven is supported by “conclusory expert testimony.” Reply, 17. But Mr. Butterworth testified based on his experience as to what one of ordinary skill would have understood and explained that was also what the references showed. Ex. 2004, ¶¶ 85-86, 131, 143, 168-169.

Petitioner also argues that “PO does not dispute that size-adjustability was *achievable* with different-basis-weight wing and backsheet nonwovens, which is sufficient for obviousness.” Reply, 17 (emphasis added). But merely arguing something is achievable is not sufficient for obviousness. *See, e.g., InTouch Techs., Inc. v. VGo Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014) (expert “succumbed to hindsight bias” by focusing on whether one could combine rather than would have been motivated to do so). Indeed, Patent Owner acknowledges that the Beckert patents teach how to achieve it. But Petitioner has not shown that prior art teaches such an arrangement or that it would have been obvious.

**B. The references do not teach using a higher basis weight nonwoven on the sides of a traditional diaper**

Petitioner’s combinations are also premised on using a higher basis weight nonwoven on the sides of a traditional diaper than on the front. But Petitioner has not shown that this is taught by prior art or that it would have resulted in the claimed invention.



None of the references teach using a higher basis weight nonwoven on the sides of a traditional diaper. Likewise, none of the references teach that using different basis weight nonwovens would provide differing retaining forces or that such retaining forces would be able to secure the diaper on the wearer. The only discussion of a diaper having different basis weight nonwovens that Petitioner cites is Karami '626's statement that a "slightly higher" basis weight nonwoven is preferred for the wings of a T-shaped diaper. Pet., 57; Ex. 1004, ¶ [0065]. Karami '626, however, never says why that is preferred. And in that embodiment, the fasteners only engage the wings. Resp., 29-31, 49-52.

Now Petitioner appears to have dropped its reliance on Karami '626's T-shaped diaper. Indeed, Petitioner argues that "PO's myopic focus on Karami '626's T-shaped diaper is misplaced" and refers to "the FIGs. 9-10 diaper." Reply, 16. Karami '626, however, provides only one sentence about the Figures 9-10 diaper and never suggests making it from nonwovens having different basis weights. Ex. 1004, ¶ [0055]. Petitioner's reasons for using a higher basis weight nonwoven on the sides of a diaper are based on hindsight.

Petitioner argues that Mr. Butterworth testified that one of ordinary skill would have wanted a higher basis weight nonwoven on the sides. Reply, 13-14. But, referring to Figure 5 of the Beckert patents, which shows a back side-part containing a closure being reinforced where it attaches to the diaper to protect

against tearing, Mr. Butterworth merely explained that this side piece needed to be heavy enough not to be pulled off. Ex. 1054, 125:9-126:12; *see also* Ex. 1001, 14:19-40. He did not reference the front side-parts, which are the relevant parts for having the claimed retaining forces for engaging fasteners. He also did not suggest that the main body did not need to be as strong or that one of ordinary skill would have sought higher retaining forces on the sides. To the contrary, he explained how a heavier nonwoven could have lower retaining forces than a lighter nonwoven. Ex. 1054, 127:25-129:3.

### **III. Petitioner Disclaims Inherency and Thus Fails to Meet Its Burden of Proof Since Petitioner's Grounds Rely on Inherency**

#### **A. Petitioner disclaims inherency**

Petitioner's arguments that the differing retaining force limitations are met are not premised on what the references teach, but on a reference or combination inherently meeting that limitation. Prelim. Resp., 28-42, 47-51; Resp., 28-34, 50-55. "The inherency doctrine allows for a prior art reference to supply a missing limitation if it is 'necessarily present' or 'inherent' in that reference." *Vivint, Inc. v. Alarm.com Inc.*, 741 F. App'x 786, 791 (Fed. Cir. 2018) (quotation omitted).

In the Petition, Petitioner did not acknowledge that the grounds were premised on inherency. In the Reply, Petitioner only addresses inherency to disavow any reliance on it to show that the claims would have been obvious. For

instance, Petitioner calls an inherency argument “non-responsive” because “Petitioner’s argument is that the Benning-Karami ’626 diaper would have obviously—not inherently—included such fastener-engaging nonwovens for size adjustability.” Reply, 17-18. For Karami ’722-Benning, Petitioner calls an inherency argument a “strawman.” *Id.*, 5.

Petitioner has thus disavowed inherency. As a result, if the Board agrees that Petitioner’s combinations require inherency to meet the differing and sufficient retaining forces requirements, then Petitioner has failed to carry its burden.

**B. Petitioner relies on inherency but fails to establish it**

Petitioner’s combinations hinge on inherency. For Karami ’772-Benning, Petitioner does not argue that Karami ’772 discloses or teaches using the stay-away-zone to securely engage fasteners. Indeed, Mr. Jezzi acknowledged that one cannot tell based on Karami ’772 if the retaining forces at the stay-away-zone would be sufficient to secure the diaper. Ex. 2003, 184:4-186:1.

Instead, Petitioner argues that fasteners would have been able to engage the stay-away-zone to secure the diaper on the wearer and relies on Karami ’626, which is not even part of this combination, as allegedly evidencing that inherent property. This is a classic inherency argument. *See, e.g., In re Rijckaert*, 9. F.3d 1531, 1533-34 (Fed. Cir. 1993) (finding that a condition may be “optimal” but not inherent); *Par Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1195-96 (Fed.

Cir. 2014) (considering whether prior art that failed to disclose food effect inherently possessed it).

For Benning-Karami '626, Petitioner relies on inherent obviousness. Although it disavowed inherency, Petitioner characterizes the “cogent factual issue” as “whether the claimed retaining forces would have naturally resulted from the Benning-Karami '626 diaper,” and cites *Par Pharmaceutical*. Reply, 23. *Par Pharmaceutical* is a leading case on inherency and explains that inherent obviousness is only met when the “natural result of the combination” necessarily occurs from the combination and is not a mere possibility or probability. 773 F.3d at 1195-96 (internal citations omitted).

To prove inherent obviousness, Petitioner must provide substantial evidence that its position is “inevitab[le].” *Vivint, Inc.*, 741 F. App'x at 792 (citations omitted). Petitioner cannot merely allege obviousness, because “what would have been obvious to a skilled artisan is not a valid consideration in an inherency analysis.” *Id.* (citing *W.L. Gore & Assocs., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1555 (Fed. Cir. 1983)). For example, in *Vivint*, the Federal Circuit held that the Board erred in finding inherent obviousness where a petitioner's arguments were based on obviousness and substantial evidence did not show that the missing claim element was necessarily present in the references. *Id.* Here, as in *Vivint*, Petitioner failed to establish that the missing elements—the claimed differing retaining forces

sufficient to secure the diaper on the wearer—are necessarily present in the references and combinations.

#### **IV. Petitioner Failed to Prove Obviousness**

##### **A. The Karami '772–Benning combination fails**

##### **1. Petitioner has not established that the stay-away-zone necessarily would have secured the diaper on the wearer**

The Karami '772-Benning combination fails for the reasons stated in the Response (Resp., 17-34) and above (*supra* Section II), including because Petitioner has not shown that fasteners necessarily would have engaged the stay-away-zone to secure the diaper. Petitioner and Mr. Jezzi pointed to Table 1 of Karami '772 and to Karami '626 as showing that the stay-away-zone would secure the diaper. Pet., 23-24, 31; Ex. 1012, ¶¶ 68-69. They have since disavowed Table 1. Reply, 9, 19-20. And Petitioner has not established that Karami '626 teaches the same nonwoven used at the stay-away-zone in Karami '772 or that the diaper in Karami '772 necessarily would have secured the diaper at the stay-away-zone.

Petitioner argues that “the other stay-away zones support Petitioner’s position.” Reply, 4-5. Petitioner seems to ask why Karami '772 would have had an alternate stay-away-zone unless it was meant to engage fasteners to secure a diaper. *Id.* But providing alternate methods for making a stay-away-zone does not suggest they have different purposes. To the contrary, that one stay-away-zone has no ability to engage fasteners demonstrates that the stay-away-zone is intended *not*

to engage fasteners. Resp., 22-24. It is not evidence that the untreated nonwoven stay-away-zone would be able to “hold a mis-sized diaper on a wearer.” Reply, 4-5. Indeed, Karami ’772 expressly notes that the alternative stay-away-zone has “diminished” affinity—not sufficient affinity to secure the diaper. Ex. 1003, ¶ [0053]. Karami ’772 does not teach using either stay-away-zone to hold a diaper on a wearer. And when Karami ’772 wanted to indicate that a surface could “secure” a diaper, it expressly said so. *Id.*, ¶¶ [0025], [0033], [0042], [0048], [0051]. It did not do that for either stay-away-zone. Also, Mr. Butterworth explained that removing a portion of the backsheet as described for the first stay-away-zone could cause leaking (Ex. 1054, 152:22-155:3), providing a reason why Karami ’772 would have offered an alternate, simpler way to provide a no-engagement stay-away-zone.

## **2. Petitioner’s new alleged fastener-engaging surface fails**

Petitioner raises a new argument that essentially creates a new combination. It should be rejected. Reply, 1-2; *see Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1331 (Fed. Cir. 2018) (stating that a petitioner may not present a new obviousness rationale on reply); *LKQ Corp. v. GM Global Tech. Operations LLC*, PGR2020-00055, Paper 33, 59 (PTAB Oct. 8, 2021) (declining to consider new obviousness theories on reply).

Petitioner now argues that there is an area in Karami '772's diaper, outside of the stay-away-zone but in the containment assembly, that engages fasteners to secure the diaper and would be made from a nonwoven having a different basis weight than the nonwoven on the sides of the diaper and having unidentified treatment. Reply, 1-2. This argument amounts to a new combination.

Throughout the Petition, Petitioner alleged that fasteners would engage the stay-away-zone to secure the diaper. Pet., 23, 31-36. It did not allege that fasteners would engage an area outside of the stay-away-zone and within the containment assembly to secure the diaper. So, Petitioner is wrong to allege that Patent Owner "does not disagree that fastener engagement with the treated, obviously lower-basis-weight portions of Karami '772's containment assembly meets the" claimed retention forces. Reply, 1.

As support for its new argument, Petitioner cites pages 31-33 of the Petition. Reply, 1. But there, for the retaining forces limitation, Petitioner argued that "[b]ecause the outer nonwovens of wings 131, 133 are treated, while the stay-away-zone 160's [sic] is not, the retaining forces between fasteners 150a-150d and the outer surface of the containment assembly 120 are lower than those between the fasteners and the outer face of the wings." Pet., 32. Petitioner equated the stay-away-zone to the containment assembly and made clear that the wings were treated in contrast to the containment assembly. And Petitioner alleged that forces at the

stay-away-zone “were sufficient to hold the diaper,” establishing that it was relying on the forces at the stay-away-zone. *Id.*, 31. While the Petition vaguely references “treated and stay-away zones” (Pet. 33, 32), it is not sufficient to put Patent Owner on notice of a different combination, particularly when Petitioner only addressed the alleged sufficiency of the retaining forces in the context of the stay-away-zone and not this other alleged area.

Even now, Petitioner does not fully explain this argument. Petitioner does not identify how much of the containment assembly would have been made up of the stay-away-zone and how much of this other area. And while Petitioner argues this other area would be different from the wings and be treated, it does not identify the treatment. Reply, 1-2. Since Karami '772 teaches that different treatments can lead to different retaining forces, Petitioner still has not shown that the combination necessarily would have led to the claimed retaining forces. Indeed, Table 1 of Karami '772 shows that a lower basis weight, treated nonwoven had a higher peel strength than a higher basis weight, treated nonwoven. Ex. 1003, Table 1 (for Binder 25445). While Petitioner and Mr. Jezzi now criticize Table 1, Petitioner relied on it as evidencing obviousness and Mr. Jezzi continued to assert that it could be used for comparative values. Pet. 23-24, 31, 42; Ex. 2003, 175:11-20. Also, claims 1, 12, and 34 recite a chassis having an “outer face” and require that a closure hold the diaper on the wearer when fastened to that outer face. The



claims do not limit fastening to only a portion of the outer face, so Petitioner would still have to show that the stay-away-zone would engage fasteners to secure the diaper but did not.

Petitioner also does not identify where Karami '772 teaches that this supposed region outside of the stay-away-zone in the containment assembly would be used to engage fasteners to secure the diaper. But Karami '772 does not suggest attaching fasteners to such a region. To the extent Petitioner points to Figure 8, drawings cannot be relied on for scale unless so indicated. *See, e.g., Hockerson-Halberstadt, Inc. v. Avia Group Int'l*, 222 F.3d 951, 956 (Fed. Cir. 2000) (“patent drawings do not define the precise proportions of the elements and may not be relied on to show particular sizes if the specification is completely silent on the issue”).

With this new diaper combination, Petitioner also tries to shift its burden to Patent Owner. Petitioner argues that “PO offers no evidence or explanation to suggest that Karami '772-Benning combination encompasses a reasonable configuration that would have yielded a different result.” Reply, 2. But it is Petitioner’s burden to provide a reason one of ordinary skill in the art would have selected the specific combination of materials and properties that allegedly would have resulted in the claimed invention and to establish that the claimed differing retaining forces necessarily would have resulted from that combination.

Petitioner's argument also ignores that Mr. Butterworth identified many factors that impact a diaper's retaining forces that fall within Petitioner's supposed reasonable configuration that could have led to very different retaining forces. Ex. 2004, ¶¶ 99-110, 127-135. Indeed, Karami '772, teaches that different retaining forces are possible for different nonwovens, and Petitioner cannot simply ignore the teachings of its primary reference.

**3. Karami '772 teaches treating “conventional nonwovens” so that they can engage fasteners**

Petitioner raises another new argument, contending that Karami '772 has an embodiment where the nonwoven is not treated because an object of the invention is to provide “a fastener assembly including a hook-type fastening element that does not require a corresponding loop-type fastener element.” Reply, 3. But Karami '772 teaches that this objective is achieved by subjecting a nonwoven surface to water jet treatment and/or aperturing—“the inventive concept.” Ex. 1003, ¶¶ [0025], [0040], [0044], [0052].

Petitioner further argues that Karami '772 does not require treating a nonwoven to engage fasteners because it “is confirmed by Karami '626 achieving secure engagement with an untreated, ‘conventional nonwoven.’” Reply, 3. But Karami '772 does not disclose an embodiment where a “conventional nonwoven” is used to engage fasteners. To the contrary, Karami '772 teaches that the

“conventional nonwoven” is not sufficient to engage fasteners, which is why it needs to be treated if a “landing zone” mating fastener is to be avoided. Ex. 1003, ¶ [0003] (stating that “conventional” “nonwoven articles have had affixed to the surface thereof along one axis (e.g., sewn thereon) a miniloop fastener element strip”), ¶ [0025] (“In various exemplary embodiments of the present invention, an absorbent article is provided with a fastening system that does not include a loop fastening element. Instead, hook-type fasteners are able to securely attach to a bonded nonwoven surface that has been subjected to water jet treatment and/or aperturing.”).

Also, as Mr. Butterworth explained, “there is no such animal as a conventional nonwoven. All non-wovens are different.” Ex. 1054, 59:23-60:1; *see also id.*, 25:25-26:18, 57:22-60:8. He explained that there are many types of nonwovens and that they must be engineered to engage fasteners, so one could not say that a fastener “will necessarily attach to the surface” of a “conventional nonwoven.” *Id.*, 26:9-18. As a result, Petitioner’s references to a “conventional nonwoven” are not evidence that the nonwoven would engage fasteners to secure the diaper.

Petitioner further argues that “Binder 25445 fastener” “is ‘for use only with’—and thus adequately mates with—‘conventional nonwovens’ like those Karami ’772 uses.” Reply, 3. But the fact that Karami ’626 states that the

“preferred fastener element is preferred for use only with conventional nonwovens,” Ex. 1004, ¶ [0070], does not mean that it can engage *all* allegedly “conventional nonwovens.” As a result, merely alleging fastener Binder 25445 would be part of the modified diaper does not establish that it would have engaged the stay-away-zone to secure the diaper.

Although Petitioner continues to argue that Karami ’626 shows that fasteners in the Karami ’772-Benning combination could engage the stay-away-zone, Petitioner has not shown that Karami ’626’s nonwoven is same as Karami ’772’s nonwoven. Petitioner focuses solely on basis weight, but many factors impact retaining forces (Ex. 2004, ¶¶ 99-110), and Petitioner does not show that those factors are the same between Karami ’626 and Karami ’772. And even with basis weights, Petitioner continues to change its position.

Petitioner asserted that “Karami ’772’s backsheet—like Karami ’626’s—is a film-nonwoven laminate, with 5-45 gsm nonwoven.” Pet., 31. Patent Owner pointed out that Karami ’626 does not disclose such a nonwoven. Resp., 28-29. For basis weight, Karami ’626 mentions “13-50 gsm.” Ex. 1004, ¶¶ [0063], [0065]. Patent Owner also pointed out that Mr. Jezzi acknowledged that a 5 gsm nonwoven could not be used as a backsheet. Ex. 2003, 191:6-10 (“I don’t think any POSITA in their right mind would look at a 5 gsm for an outer cover”). Petitioner now alleges that its “grounds are based on Karami ’772’s disclosed 10-30-gsm

nonwoven backsheet—not the 5-gsm-nonwoven backsheet—and specifically including its 20 gsm-nonwoven backsheet.” Reply, 5. But Karami ’772 does not disclose a 10-30 gsm backsheet. And in the Petition, Petitioner relied on a range of 5-45 gsm for Karami ’772’s nonwoven. Pet., 31, 37, 42, 66-67.

Petitioner mentioned a supposed Karami ’772 10-30 gsm nonwoven when discussing dependent claims reciting that range. Pet., 42-45. Karami ’772 does not teach a range of 10-30 gsm, and Petitioner identifies no prior art suggesting it. Petitioner cited Mr. Jezzi’s declaration as supporting the range, but he obtained this range from the Beckert patents, not prior art. Pet. 42-43 (citing Ex. 1012, ¶¶ 90-91, 93-95); *see also* Ex. 1001, 7:18-19. Petitioner cannot just pick and choose values and cannot change those positions on reply. *In re Fine*, 837 F.2d 1071, 1075 (Fed. Cir. 1988) (reversing obviousness rejection and explaining that “[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention”); *Atofina v. Great Lakes Chem. Corp.*, 441 F.3d 991, 999-1000 (Fed. Cir. 2006) (broader temperature range could not anticipate narrower range because “a range is no more than a disclosure of endpoints”).

**B. The Benning–Karami ’626 combination fails**

The Benning-Karami ’626 combination fails for many reasons as detailed in the Response and above. Resp. 40-55; *supra* Section II. Additionally, Petitioner

has not shown that the combination necessarily would have resulted in the claimed retaining forces. For that limitation, Petitioner relies on the Beckert patents. Reply, 22-25. Petitioner argues that the '294 patent "forecloses" the argument that the Benning-Karami '626 diaper does not result in the claimed invention.<sup>1</sup> Reply 23. That is not so.

Petitioner has the burden of showing that the claimed invention would have been obvious based on prior art, not the Beckert patents. Also, the Beckert patents do not state that a higher basis weight nonwoven necessarily and always has higher retaining forces than a lower basis weight nonwoven. In the specific example given, the higher basis weight at the sides ensured a higher retaining force. Ex. 1001, 12:62-13:49. It did not suggest this was some universal principal that applied based solely on basis weight, regardless of the fiber thickness, embossing pattern, density of the fiber arrangement, how the joining region is formed, the width of the lines and distance between the lines forming the joining regions, whether there are unconnected patterns produced, and the foil laminate used. *Id.* The Beckert patents teach factors that impact retention and how to engineer a nonwoven to engage fasteners. Ex. 1001, 5:22-9:44; Ex. 2004, ¶ 36.

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<sup>1</sup> Petitioner makes a similar argument for Karami '772-Benning, which fails for the same reasons. Reply, 2.

Petitioner also improperly modifies Benning-Karami '626. Petitioner asserted that one of ordinary skill would have used the 20 gsm backsheet from Karami '626's T-shaped diaper for Benning's backsheet because it was identified as optimal. Pet., 53; Ex. 1004, ¶ [0065]. Now, Petitioner contends that it could instead use a 20 gsm nonwoven from the wings of the T-shaped diaper even though Karami '626 describes that nonwoven as optimally 34 gsm. Reply, 21; Ex. 1004, ¶ [0065]. Petitioner's arguments and change in positions show that it has no meaningful reason for selecting nonwovens and basis weights other than the roadmap the claims provide.

#### **V. Mr. Jezzi's Testimony Does Not Credibly Support Obviousness**

Mr. Jezzi has provided contradictory testimony and shown a lack of understanding of the art. Patent Owner pointed out that Mr. Jezzi previously admitted that he could not tell whether the retaining forces between the closure and main part in Karami '772 are sufficient to hold the diaper on the wearer. Prelim. Resp., 32-33. In this proceeding, Mr. Jezzi asserted that he could tell those retaining forces would be sufficient based on Table 1 of Karami '772 and on Karami '626. Ex. 1012, ¶¶ 68-70 (stating Table 1 confirms that "there still were retaining forces between the hooks and untreated nonwoven" and they were "high enough to hold the diaper on the wearer"); *id.*, ¶ 70 (relying on Karami '626's description of the nonwoven used for the T-shaped diaper). He subsequently

disavowed reliance on Table 1 and demonstrated that he did not understand how Karami '626's T-shaped diaper works. Given his shifting positions and lack of understanding of references, his testimony should be given little or no weight.

Petitioner argues that Patent Owner mischaracterizes Mr. Jezzi's testimony by "attempting to extend his statement that Karami '772's TABLE 1 alone renders it 'speculative' whether fastener engagement in Karami '772's stay-away zone meets the Diaper-Holding Requirement." Reply, 9. Notably, Mr. Jezzi did not refer to Table 1 "alone," but stated: "It's speculative either way. Just with the '772 patent." Ex. 2003, 185:9-10. And he testified that he could not rely on Table 1. *See, e.g., id.*, 119: 8-9 ("I cannot make heads or tails of these numbers, honestly."); 175:11-20 (saying he could only "rely on the numbers within themselves, not outside or making comparisons"), 195:12-17, 117: 6-15. Even Petitioner has disavowed Table 1, despite relying on it in the Petition. Reply, 9 (criticizing Patent Owner for citing Table 1). In any event, Petitioner now agrees that Mr. Jezzi has jettisoned reliance on Table 1 as showing that retaining forces in the stay-away-zone would have been sufficient.

Petitioner also alleges that Patent Owner "neglects the entirety of Mr. Jezzi's unequivocal opinion: 'yes, [the retentive forces] are sufficient.'" *Id.*, 9-10. But Mr. Jezzi was far from "unequivocal." *See, e.g.,* Ex. 2003, 184:4-185:2 (discussing his prior testimony that he could not tell whether the retaining forces in Karami '772



would have been sufficient and stating that “there’s no magic number on retentive forces working or not working”), 185:11-186:1 ( “today I would *probably* say they have sufficient retentive forces to hold a diaper next to the body”) (emphasis added).

Petitioner further argues that Mr. Jezzi’s opinions on the ability of the stay-away-zone to engage fasteners and secure a diaper are supported by Karami ’626. Reply, 9. But Mr. Jezzi lacked an understanding of how Karami ’626’s T-shaped diaper embodiments work. Resp., 42-44 (citing Ex. 2003, 143:7-149:3, 151:1-158:13). During his deposition, Mr. Jezzi explained that he thought fasteners engaged with the backsheet of the main part of the T-shaped diaper. Ex. 2003, 146:11-19, 151:19-152:13. He failed to understand that the fasteners were located on the frontsheet of the main part and were attached to the outside of the belt when donned so that no fasteners could engage the backsheet of the main part. *Id.*, 153:12-158:13. After reviewing Karami ’626, Mr. Jezzi agreed that all fasteners engage the belt and do not engage the backsheet of the main part. *Id.*, 163:18-21, 164:13-19. Thus, any opinion by Mr. Jezzi that the stay-away-zone in Karami ’772 could securely engage fasteners because Karami ’626’s T-shaped diaper engaged fasteners at the backsheet is not credible.

Given Mr. Jezzi’s shifting positions on Karami ’772 and his lack of understanding of Karami ’626, his testimony on those subjects lacks credibility.

**VI. Petitioner Does Not Establish that the Claimed Retaining Force Ranges Would Have Been Obvious**

When it comes to the specific retaining force ranges claimed in the '294 patent, Petitioner does not argue that they are taught by prior art. Reply, 10-11. Instead, Petitioner suggests that it did not need to because the claimed ranges are “workable” ranges and naturally resulted from the claimed invention. Reply, 10, 23. But there is no “workable” range exception to Petitioner’s burden of showing obviousness. Petitioner has not shown that the claimed ranges were taught or would have been obvious based on prior art. Petitioner also has not shown that the claimed ranges would have been necessarily present in the combinations. *See Par Pharm.*, 773 F.3d at 1195.

**VII. The Stupperich Combination Fails**

For the Stupperich combination, Petitioner selects nonwovens from different embodiments and uses them in different parts of the diaper without providing a reason for combining Stupperich’s embodiments. Reply, 25-26. For the *backsheet* in the Benning-Karami '626 diaper, Petitioner selects a nonwoven used on the *wing* in Stupperich based on its basis weight. For the wings in the Benning-Karami '626 diaper, Petitioner selects a nonwoven used on the wing in another embodiment in Stupperich based on its basis weight. Pet. 75-76; Reply, 26. Petitioner provides no reasoning for its selection other than improper hindsight.

### **VIII. Conclusion**

The Board should find that the challenged claims are not unpatentable.

Respectfully submitted,

Dated: November 10, 2021

By: /Joshua L. Goldberg/  
Joshua L. Goldberg  
Reg. No. 59,369

**CERTIFICATE OF COMPLIANCE**

Pursuant to 37 C.F.R. § 42.24(d), I, Joshua L. Goldberg, certify that **PATENT OWNER'S SUR-REPLY** contains 5,595 words, excluding those portions identified in 37 C.F.R. § 42.24(a), as measured by the word-processing system used to prepare this paper.

Dated: November 10, 2021

By: /Joshua L. Goldberg/  
Joshua L. Goldberg  
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**CERTIFICATE OF SERVICE**

The undersigned certifies that a copy of the foregoing **PATENT OWNER'S SUR-REPLY** was served electronically via email on November 10, 2021, in its entirety on the following:

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