

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ATTENDS HEALTHCARE PRODUCTS, INC.
Petitioner,

v.

PAUL HARTMANN AG
Patent Owner.

Case No. IPR2020-01479
Patent No. 8,771,249

PATENT OWNER'S BRIEF REGARDING REMAND

The Federal Circuit held that the Board's Final Written Decision finding the '249 patent claims unpatentable on grounds 2, 5, 8, 10, and 12 was unsupported by substantial evidence and that "the Board erred in finding that Benning as modified by Karami '626 would meet the relative force limitation." Paper 33, Slip Op., 7, 9, 10. As a result, those grounds have been finally decided against Petitioner. On remand, the Board should dispose of the remaining grounds 1, 3, 4, 6, 7, 9, 11, and 13, which also do not support finding the claims of the '249 patent unpatentable, and confirm the patentability of all claims.

I. The Federal Circuit's Decision

The Federal Circuit held that "the Board erred in finding that Benning as modified by Karami '626 would meet the relative force claim limitation," whether it had relied on inherency or obviousness. Paper 33, Slip Op., 7. The court further held that the Board did "not satisfy the high 'necessarily so' standard required for inherency." *Id.* The Board's alternative statement that different retaining forces is, at least, suggested by Karami '626 was also not supported by substantial evidence. *Id.* at 8. The Federal Circuit stated that "the Board did not provide any reason why a person of ordinary skill in the art would have chosen nonwovens with these characteristics." *Id.* The court did not need to reach the requirement that the retaining forces hold the diaper on the body "given [its] holding regarding the relative retaining force limitation." *Id.* at 9. The Federal Circuit also ruled on the

claimed ranges, holding that “the Board erred in finding that Benning as modified by Karami ’626 would provide retaining forces within the claimed range limitations.” *Id.* at 9. The court vacated the decision and remanded. *Id.* at 10.

II. Issues Remaining to Be Decided on Remand

The Federal Circuit’s decision finally resolves grounds 2, 5, 8, 10, and 12 in favor of Patent Owner. Petitioner had the opportunity to cite evidence anywhere in the record supporting the Board’s decision, *see, e.g., Intelligent Bio-sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1366 (Fed. Cir. 2016) (stating that the substantial evidence standard requires “examination of the ‘record as a whole’”), but did not do so, and has now agreed that it will not be submitting any additional evidence. Thus, Petitioner had a full and fair opportunity to support those grounds before the Board and on appeal, but it failed to do so. There is no basis for revisiting grounds 2, 5, 8, 10, and 12.

Grounds 1, 4, 7, 9, and 11 based on modifying a Karami ’772 embodiment in view of Benning remain to be decided. Those grounds, however, are premised on inherency, which the Petitioner failed to establish. Petitioner did not show that the modified Karami ’772 diaper would necessarily have had retaining forces at the front of the diaper sufficient to secure the diaper on the wearer and lower than the retaining forces at the side. Petitioner did not even identify sufficient characteristics of the nonwovens to establish the actual or relative retaining forces

on the modified diaper. Thus, Petitioner did not meet the high standard for inherency and these grounds fail for the reasons stated in the Response and Sur-reply. *See, e.g.*, Resp., 17-34, 38-40; Sur-reply, 1-19.

When it comes to the claimed retaining force ranges, the grounds based on Karami '772 and Benning fare no better. The Petition merely alleged that the ranges were “workable ranges.” Pet., 35, 36. That is not sufficient for obviousness. Petitioner also did not show that the claimed ranges would have necessarily been present in the combinations. *See, e.g.*, Resp., 34-38; Sur-reply, 24.

Grounds 3, 6, and 13 based on Benning, Karami '626, and Stupperich also remain, but those grounds fail. Stupperich does not teach having different retaining forces or using different nonwovens having different basis weights on the same diaper. For these grounds, Petitioner took nonwovens from different embodiments and added them to Benning, including moving one nonwoven from Stupperich's wing to the backsheet of the modified diaper. But Petitioner never provided a reason one of skill would have combined different embodiments from Stupperich and used them on different parts of Benning. *See, e.g., Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1077 (Fed. Cir. 2017); Resp., 55-58; Sur-reply, 24.

Respectfully submitted,

Date: May 29, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing Patent Owner's Brief Regarding Remand was served electronically via email on May 29, 2024, in its entirety on the following:

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