

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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IPR2020-01479  
Patent 8,771,249 B2

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**PETITIONER'S BRIEF ON REMAND**

The Board's ultimate conclusions were right. The CAFC did not reverse those conclusions, instead vacating and remanding due to concerns that the FWD did not fully articulate its analysis regarding certain nonwoven parameters.

In holding that the Benning-Karami '626 diaper met the claimed differential retaining forces, the FWD found that a nonwoven's interstice size and bonding area (in addition to its basis weight) impact the nonwoven's retaining force with a fastener, but that the interstice size and bonding area of Benning's nonwoven wings would have been those of Karami '626's backsheet nonwoven. FWD, 53-54. While the FWD cited a supporting rationale, the CAFC did not read the FWD as adopting it. Paper 33, 7-9. Further, as to the claimed numerical retaining forces, the CAFC viewed the FWD as primarily relying on an admission from PO that the Benning-Karami '626 diaper's nonwovens match those in the '249 Patent's example, which the CAFC was unable to find in the FWD-cited briefing. *Id.*, 9-10.

These issues are straightforward to address. Even assuming retaining forces for fastener-engaging nonwovens meaningfully vary based on more than basis weight, the record contains evidence as to why the Karami '626 nonwoven's interstice size and bonding area were obvious choices for Benning's wings, which the FWD cited, and the Board can explicitly credit on remand. FWD-cited portions of the record also show that the parameters in the '249 Patent's example were disclosed or obvious selections for the Benning-Karami '626 diaper, and the Board

can clarify that its analysis rests on those record portions rather than any admission from PO. The Board should again find the claims invalid based on the Benning-Karami '626 diaper or otherwise rule on the undecided grounds.

**I. Karami '626's Bonding Area and Interstice Size Obvious for Benning**

It is resolved that a POSITA would have sought the Benning-Karami '626 diaper in which the nonwoven wings had a higher basis weight than the backsheet nonwoven, with each being engageable by fasteners to provide size-adjustability. *See* Paper 33, 5, 7. And the evidence shows that the wings, having the higher basis weight, would provide higher retaining forces with the fasteners (EX1012, ¶120 (citing EX1040, 2:35-39, EX1044, 5:3-7)); indeed, the '249 Patent describes a positive correlation between basis weight and retaining force as “essentially ensured” (EX1001, 13:42-49, 7:25-32). Petition, 60-61. The record lacks any allegation that a POSITA would have selected any nonwoven parameter for the Benning-Karami '626 diaper that resulted in lower retaining forces in the higher-basis-weight wings. Reply, 22-23. This is dispositive as to retaining forces.

Nevertheless, the rationale for using the Karami '626 nonwoven's bonding area and interstice size for Benning's nonwoven wings is stated in EX1012's ¶115 (cited in Petition, 56, Reply, 16-17): “a POSITA would have readily chosen other nonwoven characteristics ... such that [Benning's] side flaps 34 satisfy Karami '626's other preferred criteria,” including bonding area and interstice size. These

criteria were explicitly preferred, and thus obvious, for achieving fastener-engagement with Benning's nonwoven wings to meet the Benning-Karami '626 diaper's goal of size adjustability. *See* EX1012, ¶¶115-116; Petition, 54-56.

The FWD cited this testimony throughout, but not specifically for its finding regarding the interstice size and bonding area of Benning's nonwoven wings, rendering it unclear to the CAFC whether the FWD relied on it. Paper 33, 8-9. The Board can explicitly credit EX1012's ¶115 to support this finding.

## **II. The Benning-Karami '626 Diaper Matches the '249 Patent's Example**

The FWD credited the Petition's explanation that the parameters of the '249 Patent's example were disclosed or obvious choices for the Benning-Karami '626 diaper, and noted that PO did not dispute this explanation. FWD, 58-59. The CAFC focused on the latter, finding the FWD to "primarily depend[]" on an admission from PO that the CAFC was unable to locate. Paper 33, 9-10. The Board should clarify that its numerical retaining force finding rests on the Petition's explanation that, e.g., the art described the '249 Patent example's fastener (including its size), and the basis weights, type, fiber size, and bonding area of the '249 Patent example's nonwovens as "optimal"/"preferred" for fastener-nonwoven engagement (Petition, 64-69, Reply, 24-25), rather than any admission from PO.

Dated: May 29, 2024

/Eagle H. Robinson/  
Eagle H. Robinson (Reg. No. 61,361).

## **CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies that on May 29, 2024, a complete copy of Petitioner's Brief on Remand was served on Lead and Backup Counsel for Patent Owner via email (by consent) to:

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