

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 RESPONSE BRIEF REGARDING REMAND

Contrary to Petitioner’s brief, the Federal Circuit did *not* suggest that the Board merely needs to more “fully articulate its analysis regarding certain nonwoven parameters.” Paper 36, 1. Instead, the Federal Circuit held that the Board “erred” and did “not satisfy the high ‘necessarily so’ standard required for inherency” and that there was no substantial evidence in support of the decision. Paper 33, Slip. Op., 7-9 (internal citations omitted). While Petitioner suggests that the Board can now cite additional evidence to support its decision, the substantial evidence standard requires evaluating the entire record, which the Federal Circuit found lacking. *See, e.g., Intelligent Bio-sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1366. Since the Federal Circuit already determined there is no substantial evidence supporting the Board’s decision, and Petitioner submitted no additional evidence, there is nothing remaining for the Board to do on the grounds based on Benning and Karami ’626. Accordingly, the Board need only rule on the remaining grounds and confirm the patentability of the claims.

I. Petitioner’s Citation of Its Expert Declaration Does Not Salvage the Benning-Karami ’626 Grounds

Petitioner urges the Board to rely on ¶ 115 of its expert’s declaration to provide missing characteristics of the nonwovens in the modified Benning diaper. Paper 36, 2-3. But that argument fails at least because (1) Petitioner did not rely on ¶ 115 for that purpose, (2) the cited testimony is conclusory and does not provide the missing details, and (3) relying on it now would require an entirely new

combination and motivation to make the combination.

In his declaration, Petitioner's expert Mr. Jezzi proposed using Karami '626's fastening system in Benning. Ex. 1012, ¶ 115. For that purpose, he stated that "a POSITA would have readily chosen other nonwoven characteristics (e.g., bonding area, fiber size, and intersticy size) such that side flaps 34 satisfy Karami '626's other preferred criteria." *Id.* In ¶ 115, however, Mr. Jezzi did not mention different retaining forces, and the Petition never cites that testimony in support of that limitation. Pet., 60-61. Indeed, the Petition relies only on relative basis weights as determining relative retention forces, not other nonwoven parameters. *Id.*

Mr. Jezzi also never identified what actual characteristics would have been chosen, gave a reason one skilled in the art would have selected particular characteristics, or showed that those characteristics would have resulted in a modified diaper that necessarily had higher retaining forces on the sides than the front. Even Karami '626 only gives ranges of values for those characteristics. Ex. 1004, ¶¶ [62]-[63].

Also, the Board expressly stated that the proposed combination does not require modifying the nonwoven used on Benning's sides. Paper 30, 51. Thus, further modifying that nonwoven as Petitioner now suggests would require an entirely different combination than what was presented in the Petition and relied on by the Board. The new combination would require identifying not only the

parameters of the nonwovens but also why one of skill in art would have selected them.¹ Neither the Petition nor Petitioner's expert proposed this combination or provided a reason for a further modification other than hindsight. *See* Ex. 1012, ¶ 115.

II. Petitioner's Arguments Regarding Retaining Forces Ranges Fail

In response to the Federal Circuit's holding that the Board's decision on the claimed retaining forces ranges was not supported by substantial evidence, Petitioner makes a nonsensical argument that the Board should rely on "the art described in the '249 Patent's example's nonwoven." Paper 36, 3. The '249 patent, however, does not describe its examples as prior art. And the Petition never identifies the characteristics of the nonwovens in the combination that would necessarily provide the claimed retaining forces and never provides a reason one of skill in the art would have selected the nonwovens used in the examples in the '249 patent in the modified Benning diaper other than hindsight. Pet. 64-75.

Respectfully submitted,

Date: June 12, 2024

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¹ Indeed, the Federal Circuit recognized that, at most, the cited testimony referred to a "further modification" of the combination and did not support the actual combination. Paper 33, Slip. Op., 8.

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing Patent Owner's Response Brief Regarding Remand was served electronically via email on June 12, 2024, in its entirety on the following:

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