

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
U.S. Pat. No. 8,771,249

PATENT OWNER'S PRELIMINARY RESPONSE

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I. Introduction

Petitioner Attends Healthcare Products, Inc. requests *inter partes* review of all fifty-four claims of Patent Owner PAUL HARTMANN AG's U.S. Patent No. 8,771,249. To support its challenge, Petitioner relies on thirteen obviousness grounds that identify eight references. None of the thirteen grounds includes the required particularity, much less demonstrates a reasonable likelihood of success in proving any claim would have been obvious. The Board should deny institution.

The '249 patent relates to an absorbent article or diaper with an improved closure system to correctly secure the diaper to the wearer. For example, the diaper of claim 1 includes a unique "closure component including mechanical closure aids which, when in use, hold the diaper on the user body . . . wherein *retaining forces* between said closure component and said outer face of said chassis are *lower* than *retaining forces* between said closure component and said outer face of said first and second ears." Ex. 1001, 16:12-22 (emphases added). In other words, the claimed diaper requires lower retaining forces at the chassis part of the diaper than at the ears of the diaper. As the '249 patent explains, this novel arrangement leads wearers "to close the diaper in such a way that the closure means are secured on the outer face of the side parts," which advantageously increases comfort and decreases the risk of damage to the diaper and liquid leakage through the closure.

Ex. 1001, 2:21-34. None of the references relied on by Petitioner, whether alone or in combination, teach this unique claimed diaper having differing retaining forces.

Petitioner has submitted a large, confusing, and unwieldy petition that fails to adequately map each claim element to the applied references. Instead of identifying with particularity how each claim element is found in the prior art, Petitioner characterizes the references and then refers back to a “Claim Listing,” requiring Patent Owner and the Board to discern how Petitioner contends the references should be mapped to the claims. Petitioner never quotes the claims in the Petition itself. And throughout the Petition, Petitioner uses references back to other parts of the Petition, shorthand references, and incorporation of a large expert declaration. Not only does this amount to an evasion of the word count limit, but it also creates a confusing and unwieldy Petition that does not provide the required specificity. The Board should deny institution on this basis alone.

The Board should also deny institution because there are fundamental flaws in the two combinations at the basis of all of the grounds in the Petition. For instance, for the grounds based on Karami '772 (Ex. 1003) and Benning (Ex. 1002), Petitioner relies on what Karami '772 describes as two diaper embodiments as if they were one. The Petition does not acknowledge that the diapers are distinct, let alone provide a rationale for combining them.

Petitioner's obviousness arguments also depend on Karami '772 inherently disclosing that a portion of the diaper described as a "stay-away zone" can nevertheless engage with the diaper wings to retain the diaper on a wearer. Despite relying on inherency and disclosures of references other than Karami '772 and Benning, Petitioner fails to acknowledge it is relying on inherency or prove that the claimed retaining forces are necessarily present in Karami '772 or the natural result of the Karami '772-Benning combination.

Notably, in an earlier petition challenging parent patent U.S. Patent No. 8,152,788, the petitioner there proposed Benning as a base reference and modifying it in view of Karami '772—the opposite of what Petitioner proposes here, namely Karami '772 as a base reference and modifying it in view of Benning. *See Medline Indus., Inc. v. PAUL HARTMANN AG*, IPR2013-00173, Paper 4 at 5 (PTAB Feb. 28, 2013). The petitioner in that IPR relied on the same expert, Arrigo D. Jezzi, as Petitioner does here, and he testified about the "stay-away-zone" in Karami '772. But there, he admitted he could not tell whether the retaining forces in Karami '772 are sufficient between the closure means and the main part to hold the diaper on a user. That is contrary to the position Petitioner and Mr. Jezzi take here. Given the absence of an inherency analysis and Mr. Jezzi's prior admission, Petitioner cannot establish inherency for the retaining forces limitation. Indeed,

neither Karami '772 nor the Benning-Karami '772 combination expressly discloses that limitation or implies its existence.

The grounds based on Benning and Karami '626 (Ex. 1004) are likewise flawed. As an initial matter, Petitioner has not provided a sufficient reason to combine the references. Petitioner's first purported rationale for the combination—to “provide a more comfortable and visually appealing cloth-like outer surface for Benning's diaper”—is an improper motivation to modify Benning in view of Karami '626 because it is a generic desire to improve a diaper. Pet. at 53.

Petitioner's other rationale for the combination—to “improve adjustability by enabling fasteners like Karami '626's to ‘[e]ngage directly with any portion of [a diaper's] nonwoven surface[s]’ to secure the diaper on a wearer”—is illogical. *Id.* at 54. Benning, the primary reference, already discloses what Petitioner modifies it to purportedly include: an underlayer to which fasteners can engage. The Benning-Karami '626 combination also fails because, like the Karami '772-Benning combination, Petitioner implicitly relies on inherency for the claimed retaining forces but does not establish inherency.

For these reasons, discussed more fully below, the Board should deny institution.

II. Claim Construction

Under the *Phillips* standard, which controls claim construction in an *inter partes* review, 37 C.F.R. § 42.100(b), the words of a claim “are generally given their ordinary and customary meaning,” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312-13 (Fed. Cir. 2005) (en banc) (citations omitted). The Board need only construe terms that are in controversy and only to the extent needed to resolve the controversy. *See Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (citation omitted). No claim construction is required at this time because the Board should not institute the Petition regardless of Petitioner’s constructions.

III. The Board Should Deny Institution Because the Petition Lacks the Necessary Degree of Particularity and Circumvents the Word Limit

To institute *inter partes* review, there must be “a reasonable likelihood that the petitioner would prevail with respect to at least [one] of the claims challenged in the petition.” 35 U.S.C. § 314(a). The Board has discretion to deny institution even if a petition includes grounds that meet the criteria for institution. *See SAS Inst. v. Iancu*, 138 S. Ct. 1348, 1355-56 (2018); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”); *Deeper, UAB v. Vexilar, Inc.*,

IPR2018-01310, Paper 7 at 2 (PTAB Jan. 24, 2019) (informative) (denying institution despite petitioner having demonstrated a reasonable likelihood of prevailing on one of four unpatentability grounds); *Chevron Oronite Co. v. Infineum USA L.P.*, IPR2018-00923, Paper 9 at 10-11 (PTAB Nov. 7, 2018) (denying institution because it would waste the Board’s time and resources where the petitioner showed a reasonable likelihood of prevailing on two of twenty challenged claims).

An IPR petition must identify “with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). “The petition must specify where each element of the claim is found in the prior art patents or printed publications relied upon” 37 C.F.R. § 42.104(b)(4). The burden to show unpatentability with particularity is on the petitioner. *See Harmonic*, 815 F.3d at 1363. Petitioners should “focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.” Office Patent Trial Practice Guide, November 2019 Ed., 84 Fed. Reg. 64,280 (Nov. 21, 2019); USPTO, Consolidated Trial Practice Guide at 39 (Nov. 2019), <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (“Practice Guide”).

The Board has denied petitions that lack particularity or present deficient or conclusory analysis. *See Adaptics Ltd. v. Perfect Co.*, IPR2018-01596, Paper 20 at 24 (Mar. 6, 2019) (informative) (exercising § 314(a) discretion to deny institution because the petition lacked particularity). Institution is not warranted if a petition lacks a clear statement of the relief requested and a thorough explanation of the alleged unpatentability grounds. *See, e.g., Shopkick, Inc. v. Novitaz, Inc.*, IPR2015-00279, Paper 7 at 29 (PTAB May 29, 2015) (citing 35 U.S.C. § 312(a)(3); 37 C.F.R. § 42.22(a)). Nor is institution warranted when a petition fails to “adequately tie the evidence of the references to specific claim limitations.” *Zetec, Inc. v. Westinghouse Elec. Co.*, IPR2014-00384, Paper 10 at 14 (PTAB July 23, 2014). And the Board denies petitions that address many claims with many grounds when a reasonable likelihood of success is only shown for a small number. *See, e.g., Deeper*, IPR2018-01310, Paper 7 at 2 (denying institution where petitioner showed a reasonable likelihood of prevailing on only one of four asserted grounds).

The Petition here fails to adequately map each claim element to the applied references, requiring the Board and Patent Owner to guess how each reference purportedly covers each claim element. And the Petition, which asserts thirteen separate grounds, never recites each claim element outside of the claim listing, creating a confusing and unwieldy Petition that exceeds the 14,000-word limit and fails to fully address the claims. When taken in the aggregate, the shortcomings in

the Petition—the lack of particularity, the effective disregard of the word limit, and an excessive number of deficient grounds—create a confusing and flawed Petition for which institution should be denied.

A. The Petition’s lack of particularity stems from generic claim element labeling, excessive use of references back, shorthand references, gap-filling with an expert declaration, and redundant and confusing grounds

1. Generic claim element labelling

Petitioner has failed to meet its burden “to show with particularity why the patent it challenges is unpatentable.” *Harmonic*, 815 F.3d at 1363 (citing 35 U.S.C. § 312(a)). Petitioner includes a “Claim Listing” before the first page of the Petition where it assigns a generic label to parts of the claims. But Petitioner never recites all of the claim language within the Petition itself and never repeats each claim element for each alleged unpatentability ground. *See* Pet. at vi-xv, 29-98. Instead, the Petition refers only to “Limitation 1[p],” “Limitation 1[a][1],” etc. *See, e.g., id.* at 29-98. Because of this shortcut, the Petition lacks the requisite particularity and is difficult to follow.¹

¹ Petitioner’s expert, Mr. Jezzi, committed the same error, submitting an omnibus declaration that fails to address each claim element with particularity even though it is 149 pages long and not subject to a word limit. *See generally* Ex. 1012.

Rather than map the references and combinations to each claim element, the Petition predominantly describes what the references individually disclose, quoting the references and Petitioner's expert for support. *See, e.g., id.* at 29-33 (ground 1 analysis of claim 1). Petitioner positions these descriptions under sub-headings that read "Limitation 1[p]," "Limitation 1[a][1]," etc., but does not recite the claim language or expressly state what feature of the prior art maps to the claim elements. *Id.* This makes the Petition confusing because the only way to evaluate Petitioner's contentions is to turn back to the claim listing and compare the claim language with Petitioner's contentions and then guess what is being alleged to correspond to the claim elements. *Compare id.* at vi-ix *with id.* at 33-91.

This exercise is not something that has to be repeated only once or twice. Instead, Petitioner created numerous subheadings without any identification of claim language or express mapping of the reference to the claim elements. For claim 1, Petitioner created eleven subheadings. For all fifty-four claims, Petitioner created over eighty subheadings. Evaluating Petitioner's arguments just for ground

Indeed, Mr. Jezzi's declaration takes a broader approach than the Petition, contending what purportedly would have been obvious to a person of ordinary skill in the art without addressing each individual claim element by either quoting the claim language or referring to the Petition's "Limitation" labels. *Id.*

1 requires referencing back to the claim listing over fifty times and guessing what aspects of the prior art allegedly map to the claim elements. *Id.* at 29-50. And evaluating the entire Petition requires repeating this tedious process for the other twelve grounds.

In all, the Petition refers to claim elements by “Limitation” instead of their actual terms *over 300 times*. *See generally* Pet. By failing to recite the claim language for each claim element in the body of the Petition and failing to map the claim language to the prior art, and requiring reference back to the claim listing over 300 times, the Petition lacks the requisite degree of particularity to meet Petitioner’s burden to show unpatentability. *See Harmonic*, 815 F.3d at 1363 (citing 35 U.S.C. § 312(a)(3)).

2. Excessive references back to other sections

In addition to the references back to the claim listing for every claim element addressed in each of the thirteen asserted grounds, the Petition also references its own sections frequently. This exacerbates the confusing nature of the Petition. Grounds 1 and 2 each include numerous references to other sections of the Petition. And for each limitation covered by grounds 3-13, the Petition references the section in the Petition that addressed the claim from which claims being addressed depend.

For example, for claim 6 in grounds 4-6, which Petitioner labeled “Limitation 6,” the Petition references three different sections of the Petition. Pet. at 86. Regarding “Limitation 6,” which according to the Claim Listing corresponds to claim 6, the Petition states that *claim 5* was obvious based on grounds 4, 5, and 6. *Id.*² Petitioner provides a table that references these grounds by section number, requiring the reader to search the petition for the relevant pages and then discern which portions of the referenced section are relevant:

Ground	See:
4	§VIII.A.3
5	§VIII.B.2
6	§VIII.C

Id. Making matters worse, § VIII.B.2 identified for ground 5, which spans pages 58-64 of the Petition, does not even address claim 5. The convoluted nature of the references is further worsened by the Petitioner’s supporting argument, which begins: “[a]s explained in Section VIII.D” *Id.* Petitioner does not

² The Petitioner appears to be referencing claim 5 in its Limitation 6 discussion because claim 6 depends from claim 5 of the ’249 Patent; however, this is not clear based on the language of the Petition alone. *See* Ex. 1001 at 16:36-41; Pet. at 86 “Claim 5 was obvious”).

explain how the sections referenced in its table relate to the section introduced in its argument.³ Petitioner also does not explain how the supporting argument applies to each of the grounds but instead lumps grounds 4-6 together. *Id.* at 86-87.

These numerous references back to earlier sections of the Petition, which require further references back to still other parts of the Petition, and then still *further* references back to the claim listing to confirm the language of the claim element being addressed to guess what aspect of the reference is allegedly being mapped to the claim language, create a Petition that is unwieldy and confusing. *See Whole Space Indus. Ltd. v. Zipshade Indus. (B.V.I.) Corp.*, IPR2015-00488, Paper 14 at 9, 18 (PTAB) (July 24, 2015) (denying institution of a Petition that “contain[ed] confusing, inconsistent grounds” and “improperly shift[ed] the burden of deciphering Petitioner’s arguments onto Patent Owner and the Board”).

3. Shorthand references

In addition to express references to other sections, Petitioner uses other shorthand references to refer back to other portions of the Petition, making the Petition even more confusing. For instance, Petitioner refers to annotated figures as “Annotated1,” “Annotated2,” “Annotated3,” “Annotated4,” “Annotated7,”

³ This practice is rampant throughout the Petition. *See, e.g., id.* at 83-84 (introducing arguments that merely reference another section with no explanation).

“Annotated8,” “Annotated10,” and “Annotated11” throughout the Petition. *See, e.g.*, Pet. at 7, 8, 10, 17, 23, 25, 27, 51, 55, 85. When Petitioner refers back to those annotated figures, it merely cites the label without identifying the page the annotated figure appears on. As an example, the Petitioner cites “Annotated10” repeatedly but does not identify the page number the figure is located on, requiring Patent Owner and the Board to flip through the Petition to locate it. *See, e.g.*, Pet. at 29 (“Annotated10”), 30 (five references to “Annotated10”), 31 (“Annotated10”), 34 (two references to “*See Annotated10*”).

To make things more confusing, the number attached to the annotation often does not match the figure being annotated. For instance, annotated Figure 1 of the Rohrl reference (Ex. 1016) patent is called “Annotated3,” annotated Figure 1 of ’249 patent is called “Annotated4,” annotated Figure 6 of Karami ’772 is called both “Annotated8”⁴ and “Annotated10.” *See, e.g.*, Pet. at 10, 17, 21, 23, 25. And still more confusing is that Petitioner has labelled different figures with the same label. Specifically, Fig. 6 of Karami ’772⁵ and Fig. 8 of Karami ’772 are both called “Annotated8.” Pet. at 21, 23. And Fig. 1 of Karami ’626 and Fig. 4 of

⁴ As noted above, Fig. 8 of Karami ’772 is also called “Annotated8.” Pet. at 23.

⁵ Fig. 6 of Karami ’772 is also called “Annotated10.” Pet. at 25.

Miyamoto '499 are both labelled “Annotated11.” Pet. at 55, 85. This random numbering only makes it harder to determine what figure is being referenced and where to find it in the petition, making the petition even more unwieldy.

4. Gap-filling with expert declaration

Further adding to the confusing nature of the petition, Petitioner frequently provides a cursory analysis and then cites its expert to fill in the gaps in the analysis. Often, Petitioner’s analysis is short, relying on multiple paragraphs of the expert declaration for support. *See, e.g.*, Pet. at 29-31 (citing Ex. 1012 for “Limitation 1[a][1],” “Limitation 1[a][2],” “Limitation 1[a][3],” “Limitation 1[a][4],” “Limitation 1[a]5,” “Limitation 1[b],” and “Limitation 1[c][1]”).

For some limitations, this gap-filling through the expert declaration is quite extensive. For instance, for “Limitation 1[c][2]” and “Limitation 1[d],” arguments that together span about two-pages of the Petition, Petitioner cites portions of the Jezzi Declaration spanning at least fifteen pages. *See* Pet. at 31-33 and Ex. 1012 at ¶¶ 45, 67-70, 74-77, 93-95, 103, 120. The cited analysis is not in the Petition itself, and evaluation of Petitioner’s arguments requires further references back to the expert declaration. And even then, Mr. Jezzi does not recite or address the actual claim language and does not map prior art features to claim limitations, again leaving it to Patent Owner and the Board to guess the mappings.

5. Redundant and confusing grounds

The Petition includes thirteen grounds, many of which are redundant and further add to the confusing nature of the Petition. Redundant grounds should be rare. *See, e.g., Gracernote, Inc. v. Iceberg Indus. LLC*, IPR2013-00552, Paper 6 at 20 (PTAB Mar. 7, 2014) (Parties requesting IPR “should ‘avoid submitting a repository of all the information that a judge could possibly consider, and instead focus on concise, well-organized, easy-to-follow arguments supported by readily identifiable evidence of record.’”) (quoting *Office Patent Trial Practice Guide*, 77 Fed. Reg. 48756, 48763 (Aug. 14, 2012)). Yet Petitioner asserts thirteen different grounds, eight of which—grounds 2, 3, 5, 6, 8, 10, 12, and 13—are entirely redundant and one of which—ground 9—is partially redundant.

“[A]lternative grounds may be presented if an actual need for presenting alternatives exists and is adequately explained in the petition.” *Liberty Mut. Ins. Co. v. Progressive Cas. Ins. Co.*, CBM2012-00003, Paper 11 at 3 (PTAB Nov. 26, 2012). Petitioner does not compare the grounds to identify any alleged strengths or weaknesses that may justify redundancy. *See ScentAir Techs., Inc. v. Prolitec, Inc.*, IPR2013-00180, Paper 18 at 3-4 (PTAB Aug. 26, 2013) (explaining that a finding of redundancy can only be avoided if the petitioner “articulate[s] a meaningful distinction in terms of relative strengths and weaknesses with respect to application of the prior art reference disclosures to one or more claim limitations” and that

without such analysis additional grounds “are speculative and should not be the basis of [a] decision to institute”). For instance, grounds 1, 4, 7, 9, and 11 are horizontally redundant with grounds 2, 5, 8, 10, and 12, respectively. And grounds 1, 4, 11 are also horizontally redundant with ground 3, 6, and 13. Concerning the horizontal redundancy between grounds 1 and 2 and grounds 1 and 3, ground 1 applies Karami ’772 and Benning, ground 2 applies Benning and Karami ’626, and ground 3 applies Benning, Karami ’626, and Stupperich. *See* Pet. at 4. Grounds 1 and 2, and grounds 1 and 3 are thus distinct combinations and are horizontally redundant. Yet Petitioner does not explain why Karami ’772 “more closely satisfies the claim limitation[s] at issue in some respects than [Karami ’626 or Stupperich], **and** vice versa.” *Liberty Mut. Ins. Co.*, CBM2012-00003, Paper 7 at 3 (emphasis in original).

Petitioner also does not offer any explanation for why thirteen grounds are necessary and warranted for institution. *Cf. AC Techs. S.A. v. Amazon.com, Inc.*, 912 F.3d 1358, 1364 (Fed. Cir. 2019) (“[W]e have held, if the Board institutes an IPR, it must [] address all grounds of unpatentability raised by the petitioner.”) (citing *Adidas AG v. Nike, Inc.*, 894 F.3d 1256, 1258 (Fed. Cir. 2018); *BioDelivery Scis. Int’l, Inc. v. Aquestive Therapeutics, Inc.*, 898 F.3d 1205, 1208 (Fed. Cir. 2018)). And this excessive redundancy, which includes numerous cross-references, further adds to the confusing nature of the Petition and excessive work required by

Patent Owner and the Board to discern the arguments and alleged mapping of the prior art to the claims.

All of these deficiencies—generic labelling of claim elements, excessive references back, shorthand references, further references to an expert declaration to supplement the analysis, and redundant and confusing grounds—demonstrate that Petitioner has not met its burden to show unpatentability with particularity. The Petition should be denied for this reason alone.

B. Petitioner circumvented the word count limit by excessively introducing generic claim labels and shorthand references, eliminating natural spaces, and incorporating a large expert declaration

1. Generic claim labels, shorthand references, and elimination of natural spaces

A petition for IPR is limited to a maximum of 14,000 words. 37 C.F.R. § 42.24(a)(1)(i). Here, Petitioner circumvented this limit by providing the claim language in a claim listing, assigning each limitation a generic label (“Limitation 1[p],” “Limitation 1[a][1],” “Limitation 1[a][2],” etc.), and using those generic labels rather than the claim language throughout the Petition. *Compare* Pet. at vi-xv *with* Pet. at 29-98. Petitioner then certified that the Petition “includes 13,987 words,” *id.* at 99, which is thirteen words shy of the limit. 37 C.F.R. § 42.24(a)(1)(i).

Excluding the claim numbers, challenged claims 1-54 contain nearly 2,500 words, far more than the thirteen words still available to Petitioner. *See* Ex. 1001, 15:59-20:41. But because Petitioner challenged each claim under multiple grounds, the Petition refers to certain “Limitation[s]” multiple times. *See, e.g.*, Pet. at 29, 58 (discussing “Limitation 1[p],” “Limitation 1[a][1],” and Limitation 1[a][2]” two times each), 45, 70, 80 (discussing “Limitation 12[a],” “Limitation 12[b]”, and “Limitation 12[c]” three times each). Replacing the “Limitation” headings with the claim language therefore totals thousands of additional words. *See* Pet. at 20, 50, 75, 84, 87, 90, 94 (addressing claims 1-5, 7, 8, 11-27, 29-41, and 43-54 in ground 1, the same claims (except claim 20) in ground 2, and claims 1-9, 21-54 in grounds 3-13). But given how Petitioner assigned “Limitation” labels to cover the claim elements, Petitioner’s “Limitation” headings for grounds 1-13 only amount to about 500 words. *Id.* at 33-98. Petitioner therefore avoided thousands of words and could not have recited the claim elements in the Petition headings, much less anywhere else, while complying with Rule 42.24(a)(1)(i).

As discussed above, using generic “Limitation X” labels created an unwieldy and confusing petition without the required particularity. But it also constitutes an impermissible violation of the word limit. This type of abuse, which the Board has warned against, weighs against institution. *See, e.g., Facebook, Inc. v. Sound View Innovations, LLC*, IPR2017-01003, Paper 14 at 6-7 (PTAB Sept. 1,

2017) (“[U]sing excessive acronyms or abbreviations for word phrases, in order to circumvent the rules on word count, may lead to dismissal of a party’s brief.”) (citing *Pi-Net Int’l, Inc v. JPMorgan Chase & Co.*, 600 F. App’x 774 (Fed. Cir. 2015) (per curiam)).

Petitioner also uses other tactics to reduce the word count, which further contributes to creating a confusing petition and circumventing the word limit. For example, the Petition uses the acronym “POSITA” 49 times. In each of those instances, rather than refer to what *a* POSITA or *the* POSITA may understand, the Petition omits the natural article and refers only to “POSITA.” *See, e.g.*, Pet. at 4 n.1 (“All Grounds are supported by POSITA’s general knowledge.”). Also, in the Petition, the Exhibit designations are run together with the number rather than having the usual space between “Exhibit” and the number. For instance, the Petition refers to EX1001, EX1002, etc., rather than Ex. 1001, Ex. 1002, etc. *See, e.g.*, Pet. at 4; *see also* The Bluebook: A Uniform System of Citation (Columbia L. Rev. Ass’n et al. eds., 21st ed. 2020) (“The Bluebook”) (explaining that the conventional abbreviation would be “Ex. X”). The Petition likewise runs “§” and “¶” symbols together with the referenced section or paragraph numeral eliminating a natural space. *See, e.g.*, Pet. at 70 (citing “EX1002, ¶[0032]; §VIII.B.1(b).”) ; *see also* The Bluebook (explaining that the conventional formatting would include a space between the section or paragraph symbol and the following character).

Petitioner similarly created a shorthand for figures that it annotated where it ran the term “Annotated” together with its number, again eliminating a natural space. Specifically, Petitioner refers to annotated figures as “Annotated1,” “Annotated2,” “Annotated3,” “Annotated4,” “Annotated7,” “Annotated8,” “Annotated10,” and “Annotated11” throughout the Petition. *See, e.g., id.* at 7, 8, 10, 17, 23, 25, 27, 51, 55, 85. Petitioner also refers to “PO,” rather than Patent Owner nine times. *See, e.g., id.* at 97. All of these tactics not only reduce the word count, but they make the Petition denser and difficult to follow.

The Board has rejected papers when they violate the word count limits. *See Google Inc. v. Ji-Soo Lee*, IPR2016-00022, Paper 25 at 2-5 (PTAB Nov. 23, 2016) (expunging the petitioner’s reply briefs because they defied the Board’s order setting word count limits and § 42.24); *cf. Google Inc. v. Makor Issues & Rights Ltd.*, IPR2016-01535, Paper 8 (PTAB Dec. 1, 2016) (“[U]sing excessive acronyms or abbreviations for word phrases, in order to bypass the rules on word count, [is] not reasonable. Any party using such tactics to circumvent the word count limits may be subject to corrective action, including but not limited to a party’s brief not being considered, or a petition being dismissed.”); *Limelight Networks, Inc. v. Mass. Inst. of Tech.*, IPR2017-00249, Paper 9 at 7-8 (PTAB May 18, 2016) (refusing to consider a claim chart that, when added to the petition, exceeded the word limit).

Here, the Board should reject the noncompliant petition and deny institution. And the Board should not permit Petitioner to file a replacement petition because Petitioner will have already received this Preliminary Response and could use it to scrutinize the other arguments Patent Owner has raised. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, 17-22 (PTAB Sept. 6, 2017) (precedential as to Section II.B.4.i) (affirming institution denial of follow-on petitions based in part on “Petitioner’s potential benefit from receiving and having the opportunity to study Patent Owner’s Preliminary Response, as well as [the Board’s] institution decisions on the first-filed petitions, prior to [] filing of follow-on petitions”).

2. Incorporation of a large declaration

The Petition also incorporates a large expert declaration. Petitioner submitted a declaration from Mr. Jezzi that spans 149 pages. *See* Ex. 1012. The declaration is not divided into separate sections despite allegedly supporting four petitions, and the Petition here cites to nearly the entire declaration. *See, e.g.,* Pet., citing at least Ex. 1012 at ¶¶ 12, 18, 20-35, 41-44, 49, 50-52, 54, 57, 62-108, 112-130, 132-133, 135-139, 140, 142-144, 147, 153-75, 177-79, 186-87. Thus, Petitioner’s reliance on the majority of a lengthy declaration again effectively increases the word count.

And, as noted above, in many instances the discussion in the expert declaration greatly expands the cursory analysis provided in the Petition. *See, e.g.*, Pet. at 29-30, 34, 39-41, 45, 58-59, 62, 69-70. As another example, Petitioner makes the broad and conclusory allegation: “A POSITA would have understood that the hooks would still attach to the backsheet’s stay-away zone, while the better affinity to wings 131, 133 would encourage fastening thereto for intended sizing.” Pet. at 23 (citing Ex. 1012, ¶¶ 68-70, 75-77) (other citations omitted). The Petition does not explain why a person of ordinary skill in the art would have had this understanding. Instead, Petitioner relies on the expert to provide that analysis. The cited portion of the expert declaration spans over five pages and amounts to an expansion of the Petition. A review of the Petition and Ex. 1012 shows that Petitioner has used the declaration to expand the word count.

The Board has denied institution in numerous cases after deciding this type of reliance on an expert declaration circumvents petition limits and can obscure arguments. *See, e.g., Whole Space Indus. Ltd.*, IPR2015-00488, Paper 14 at 13 (noting that incorporation of a large expert declaration “serves to circumvent the 60-page limit imposed on petitions for *inter partes* review”); *NetApp Inc. v. Crossroads Sys., Inc.*, IPR2014-01233, Paper 8 at 9 (PTAB Feb. 10, 2015) (refusing to consider material in a 140-page expert declaration that was not adequately explained in the petition because “doing so would permit the use of

declarations to circumvent the page limits that apply to petitions”); *Haliburton Energy Servs., Inc. v. Dynamic 3D Geosolutions LLC*, IPR2014-01186, Paper 13 at 3, 13-14, 38 (PTAB Jan. 12 2015) (denying institution of claims because petitioner relied on lengthy expert declarations that improperly “extend[ed] effectively the page limits of the [p]etitions”); *TRW Auto. U.S. LLC v. Magna Elecs. Inc.*, IPR2015-00960, Paper 9 at 35-36 (PTAB Oct. 5, 2015) (denying institution of an obviousness ground and refusing to allow petitioner to circumvent the page limit via an expert declaration insufficiently discussed in the petition); *Hamilton Beach Brands, Inc. v. Courtesy Prods., LLC*, IPR2014-01260, Paper 13 at 3-5 (PTAB Sept. 2, 2015) (denying motion to reconsider institution denial where citations in the petition to two expert declarations represented “improper incorporations by reference of arguments made in the declarations that circumvented page limits that apply to petitions”); *see also Microsoft Corp. v. DataTern, Inc.*, 755 F.3d 899, 910 (Fed. Cir. 2014) (explaining that it “would be fundamentally unfair to allow a party to use incorporation [of a co-party brief] to exceed word count”).

Petitioner’s circumvention of the word limit counsels against institution.

IV. The Petition Does Not Establish Obviousness of Any Claim Based on Karami ’772 and Benning

A. Ground 1 fails for two independent reasons

In ground 1, Petitioner contends independent claims 1 and 34 and their dependent claims 2-5, 7, 8, 11-27, 29-33, 35-41, and 43-54 would have been

obvious over the Karami '772-Benning combination. *See* Pet. at 4, 20. But Petitioner's analysis is flawed; it relies on distinct embodiments of Karami '772 as if they were one embodiment with no rationale for the combination of the embodiments, and also relies on purported inherent disclosures of Karami '772 without recognizing, let alone establishing, the requirements to prove inherency. Thus, Petitioner has not established obviousness of independent claims 1 and 34 or their dependent claims 2-5, 7, 8, 11-27, 29-33, 35-41, and 43-54 based on Karami '772 and Benning.

1. Petitioner improperly relies on two distinct embodiments of Karami '772 with no rationale for combining them

In ground 1, Petitioner relies on the diaper embodiment depicted in Fig. 6 of Karami '772. *See* Pet. at 21-22. Referencing Fig. 6, the Petition states that it is a diaper with a topsheet, a backsheet, an absorbent core between the topsheet and backsheet, and wings with mechanical hook-type fasteners for securing the diaper. *Id.* The Petition then pivots to Fig. 8 of Karami '772, reproducing it and arguing that it shows part of the backsheet having “‘diminished affinity to hook-type fasteners in relation to the remainder of the front waist portion’ to define a stay-away zone 160.” *Id.* at 23-24 (quoting Ex. 1012 at ¶ 75 (citation omitted)). To address the individual elements of claim 1, Petitioner relies on Fig. 6 of Karami '772 for certain elements (Limitations 1[a][2], 1[a][3], 1[b]), Fig. 8 for other

elements (Limitations 1[c][2], 1[d]), and both Figs. 6 and 8 for yet other elements (Limitations 1[a][1], 1[b]). Pet. at 29-33.

Petitioner treats the diapers of Figs. 6 and 8 as if they are identical and interchangeable, applying one or the other, or both to the claim elements. *Id.* But Karami '772 discloses the Fig. 6 diaper and the Fig. 8 diaper as separate and distinct embodiments. They are not described as the same diaper. The “Brief Description of the Drawing[s]” explains that “FIG. 6 is a partially cut away plan view of the inside surface of a stretched out disposable diaper according to an exemplary embodiment of the invention; . . . FIG. 8 shows a disposable diaper according to *another* exemplary embodiment of the invention.” Ex. 1003, ¶¶ [0022], [0024] (emphasis added). The “Detailed Description of Preferred Embodiments” is consistent with the “Brief Description of the Drawing[s],” describing Fig. 6 as “a plan view of a disposable diaper according to an exemplary embodiment of the present invention,” *Id.*, ¶ [0045], and Fig. 8 as “*another* exemplary embodiment [in which] the diaper 100 can be provided with at least one stay-away zone 160 at the front waist portion.” *Id.*, ¶ [0053] (emphasis added).

Some of the reference numbers for the diaper shown in Fig. 6 of Karami '772 overlap with reference numbers for the Fig. 8 diaper. Specifically, for both embodiments, the diaper is referred to by reference number 100, and Figs. 6 and 8 include common reference numbers 120 and 150a-150d. *See* Ex. 1003 at Figs. 6, 8.

But Fig. 6 identifies many more elements by reference numbers that are *not* also identified in Fig. 8. *Id.* Specifically, Fig. 6 includes reference numbers 122, 124, 126, 130L, 130R, 131, 132, 133, 134, 142, and 144, none of which are included in Fig. 8. *Id.* And Fig. 8 identifies the “stay-away zone” as reference number 160, which is not included in or discussed with respect to the Fig. 6 diaper. *Id.* There is nothing in Karami ’772 suggesting that these non-overlapping elements are necessarily part of both Fig. 6 and Fig. 8 diapers. This is unlike the Fig. 5 diaper, which Karami ’772 explicitly discloses as a “T-shaped diaper according to [the Fig. 5] embodiment [that] is *the same* as the previous embodiment except that the wings 40 are made of conventional bonded nonwoven, with at least one patch or landing zone 52 extending laterally across at least a portion of one of the wings 40.” *Id.* at ¶ [0043] (emphasis added). Thus, Karami ’772 is unambiguous when it intends for one diaper embodiment to be nearly the same as another or part of the same embodiment. Unlike the Fig. 5 diaper, Karami ’772 discloses the Fig. 8 diaper as “another exemplary embodiment,” *id.*, ¶ [0053], without describing it as being nearly “the same” as the Fig. 6 diaper.⁶

⁶ Elsewhere in the Petition, Petitioner appreciates that there must be a rationale for combining separate embodiments. In ground 2, Petitioner recognizes

Petitioner's treatment of Figs. 6 and 8 as interchangeable is inconsistent with the disclosure of Karami '772. And the Petition's reliance on separate embodiments for individual elements of claim 1, without recognizing that Figs. 6 and 8 are separate embodiments and discussing whether, how, or why they would have been combined, is improper. *See Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1077 (Fed. Cir. 2017) (affirming the Board's finding in an IPR that Microsoft improperly combined separate embodiments of the reference to argue the reference met a claim limitation). Indeed, in *Abiomed, Inc. v. Maquet Cardiovascular, LLC*, the Board denied institution of a petition that asserted obviousness grounds because the petitioner combined different embodiments of a single prior art reference as if they were one. IPR2017-01204, Paper 9 at 8-12 (PTAB Oct. 23, 2017). Like Petitioner here, the petitioner in *Abiomed* "fail[ed] to explain sufficiently *why* one skilled in the art would have found it obvious to combine those teachings." *Id.* at 11.

that Benning discloses different diaper embodiments and provides arguments for why using one embodiment with another allegedly would have been obvious. *See* Pet. at 52-57. Petitioner failed to apply the same analysis when combining the separate Karami '772 diapers of Figs. 6 and 8.

Rather than acknowledge the distinct diaper embodiments of Karami '772 in the Petition, Mr. Jezzi makes a cursory, one-sentence footnote-attempt to equate the diapers of Figs. 6 and 8. *See* Ex. 1012 at ¶ 75, n.1. Mr. Jezzi notes the overlapping reference numerals discussed above and that the diapers have the “same hourglass configuration.” *Id.* But Mr. Jezzi ignores the explicit disclosure of Karami '772 that “FIG. 8 shows a disposable diaper according to *another* exemplary embodiment of the invention.” Ex. 1003 at ¶ [0024] (emphasis added). Moreover, Mr. Jezzi’s footnote-discussion of the separate Karami '772 diaper embodiments is yet another example of Petitioner’s improper use of an expert declaration “to circumvent the [type-volume] limits that apply to petitions.” *NetApp Inc.*, IPR2014-01233, Paper 8 at 9.

For this reason alone, Petitioner has failed to establish a reasonable likelihood that it will prevail on ground 1 based on Karami '772 and Benning.

2. Petitioner does not establish that Karami '772 inherently discloses retaining forces at the “stay-away-zone”

Petitioner relies on purported inherent disclosures of Karami '772 for ground 1. Specifically, Petitioner’s arguments for the Karami '772-Benning combination hinge on Karami '772 inherently disclosing that the diaper section defined as a “stay-away zone” can nonetheless engage with the diaper wings to retain the diaper on a wearer. Yet Petitioner fails to argue, let alone establish, that

the alleged capability of the “stay-away zone” is necessarily present in Karami ’772 or Benning, or the natural result of the Karami ’772-Benning combination as required for inherency. Accordingly, Petitioner fails to show inherency.

a. Claim 1 and Petitioner’s perceived mapping to Karami ’772

Claim 1 of the ’249 patent requires “mechanical closure aids,” and Limitations 1[c][1], 1[c][2], and 1[d] (as labeled in the Petition claim listing) recite:

mechanical closure aids which, when in use, hold the diaper on the user body . . . wherein retaining forces between said closure component and said outer face of said chassis are *lower* than retaining forces between said closure component and said outer face of said first and second ears.

Ex. 1001 at 16:14-22 (emphasis added); *see also* Pet at vi-vii. Independent claim 34 has the same requirement. Ex. 1001 at 18:53-62. This requires at least some retaining forces between the closure component and the outer face of the first and second ears, and that they be sufficient to hold the diaper on the wearer. *See* Ex. 1001 at 16:19-22, 18:53-62. Petitioner agrees. *See, e.g.*, Pet. at 31 (addressing Limitation 1[c][2] by alleging the existence of retaining forces in the stay-away zone of Karami ’772 that are “sufficient to hold the diaper on a wearer”).

Although not expressly stated because Petitioner did not map the references to the claim language, Petitioner appears to equate the following: the “containment

assembly 120 having topsheet 122 defining a user-facing inner face and backsheet 130 defining an opposing outer face” of Karami ’772 with the claimed “chassis” having a “backsheet”; wings 131-134 of Karami ’772 with the claimed ears; and “hook-type fasteners 150a-150d’ with ‘hook-type material’” of Karami ’772 with the claimed “closure component including mechanical closure aids.” Pet. at 33-34 (citations omitted).

In the overview of ground 1, Petitioner acknowledges that Karami ’772 discloses that “a portion of backsheet 130 underlying containment assembly 120 is untreated ‘such that it has “diminished affinity to hook-type fasteners in relation to the remainder of the front waist portion” to define a stay-away zone 160.’” *Id.* at 22 (quoting Ex. 1012 at ¶ 68-70). Petitioner concludes, however, that a “POSITA would have understood that the hooks would still attach to the backsheet’s stay-away zone, while the better affinity to wings 131, 133 would encourage fastening thereto for intended sizing.” Pet. at 23.

Applying this conclusion and Karami ’772 to “Limitation 1[c][1]” and “Limitation 1[c][2],” Petitioner contends the “fasteners can also be releasably attached to the outer nonwoven surface of containment assembly 120, in both its treated zones and its untreated stay-away zone 160.” *Id.* at 31. Petitioner argues the zone that Karami ’772 defines as a *stay-away zone* “‘will have diminished’—rather than no—‘affinity to hook-type fasteners’” *Id.* (emphasis in Petition). And for

the required differing retention forces in “Limitation 1[c][2],” Petitioner contends “[e]ven in stay-away zone 160, retaining forces between fasteners 150a-150d and backsheet 130 were sufficient to hold the diaper on a wearer.” *Id.* at 31.

Petitioner’s argument is unsupported by Karami ’772 or Benning and relies on inherency.

b. Legal standards for inherency

“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) (quoting *Schering Corp. v. Geneva Pharm.*, 339 F.3d 1373, 1377 (Fed. Cir. 2003)). “[A] prior art reference, which does not expressly disclose every limitation of a claim, may still anticipate that claim if the missing limitation is ‘necessarily present, or inherent, in the single anticipating reference.’” *Vivint, Inc.*, 741 F. App’x at 791 (quoting *Schering Corp.*, 339 F.3d at 1377). If the missing limitation is probably or possibly in the prior art, it is not “necessarily present” and therefore not inherent. *See Trintec Indus., Inc. v. Top-U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002).

Inherency may apply in an obviousness context, but in a more limited way than for anticipation. Use of inherent obviousness must “be ‘carefully circumscribed’ because ‘that which may be inherent is not necessarily known and that which is unknown cannot be obvious.’” *Vivint, Inc.*, 741 F. App’x at 792

(quoting *Honeywell Int’l Inc. v. Mexichem Amanco Holding S.A.*, 865 F.3d 1348, 1354-55 (Fed. Cir. 2017)). Inherency in obviousness “is present only when the limitation at issue is the ‘natural result’ of the combination of prior art elements.” *PAR Pharm., Inc. v. TWI Pharms., Inc.*, 773 F.3d 1186, 1195 (Fed. Cir. 2014) (quoting *In re Oelrich*, 666 F.2d 578, 581 (C.C.P.A. 1981)). Probabilities or possibilities are insufficient. *Id.* “A party must . . . meet a high standard in order to rely on inherency to establish the existence of a claim limitation in the prior art in an obviousness analysis.” *Millennium Pharms., Inc. v. Sandoz, Inc.*, 862 F.3d 1356, 1367 (Fed. Cir. 2017) (quoting *PAR Pharm.*, 773 F.3d at 1195-96).

c. Mr. Jezzi’s prior testimony contradicts Petitioner’s inherency position

Petitioner’s ground 1-challenge depends on Karami ’772’s stay-away zone having at least *some* affinity to hook-type fasteners. *See, e.g.*, Pet. at 35-36. Petitioner even acknowledges that it must have sufficient affinity to retain the diaper on the wearer. *See, e.g.*, Pet. at 35 (alleging the existence of retaining forces in the stay-away zone of Karami ’772 that are “sufficient to hold the diaper on a wearer”).

Petitioner relies heavily on the opinion of its expert, Mr. Jezzi. *Id.* at 35-36 (citing Ex. 1012). But Mr. Jezzi testified in an earlier IPR that he could not tell whether the retaining forces in Karami ’772 are sufficient between the closure

means and the main part to hold the diaper on a user. Ex. 2001 at 157:9-158:14.

While Mr. Jezzi initially testified that the retaining force would hold the diaper on the user, he noted that it would “depend[] on the actual numbers, but they could be varied to do that.” *Id.* at 157:23-158:5. When asked whether he could know if the retaining forces are sufficient in Karami ’772, his response was unequivocal: “*No, I cannot.* There is no magic number on retentive forces working or not working especially when most companies have proprietary tests that measure and vary from one to the other. So making a correlation yes or no on numbers even that are published *would be very hard to do.*” *Id.* at 158:6-14 (emphases added). Mr. Jezzi does not address his prior testimony in the declaration he submitted in support of the Petition here. *See generally* Ex. 1012. He instead offers inconsistent testimony on Karami ’772, now contending that “retaining forces between the hook fastener and the untreated nonwoven [stay-away zone] were high enough to hold the diaper on a wearer during use,” *id.* at ¶ 69, and relying on Karami ’626 for support, *id.* at ¶ 70.

d. Petitioner does not acknowledge inherency is an issue, much less show it

Petitioner does not acknowledge that ground 1 depends on inherency, whether in an anticipation context based on the disclosure of Karami ’772 alone or in an obviousness context based on the Karami ’772-Benning combination. Nor

does Petitioner show that the claimed retaining forces between the fasteners and stay-away zone of the Karami '772 diaper are necessarily present or are the natural result of the Karami '772-Benning combination. Petitioner therefore fails to show the retaining forces limitation is inherent based on Karami '772 alone or on the Karami '772-Benning combination.

As noted, claims 1 and 34 require that the “retaining forces between said closure component and said outer face of said chassis are *lower* than retaining forces between said closure component and said outer face of said first and second ears.” Ex. 1001 at 16:19-22, 18:59-62 (emphasis added). This requires at least some retaining forces between the closure component and first and second ears and that they be sufficient to hold the diaper on the wearer. Ex. 1001 at 16:19-22; *see also* Pet. at 31. But Petitioner does not meet the high standard required for showing Karami '772, alone or in combination with Benning, inherently discloses that the stay-away zone 160 at the diaper's front waist portion can retain hook-type fasteners. *See* Ex. 1003 at ¶ [0053]. Petitioner fails to even acknowledge that the grounds based on Karami '772—grounds 1, 4, 7, 9, and 11—depend on inherency because they rely on information that Karami '772 does not explicitly disclose.

Karami '772 does not describe using stay-away zone 160 to retain the diaper on a wearer. The term itself—“stay-away zone”—suggests the opposite: that Karami '772's hook-type fasteners could *not* interact with the stay-away zone 160

to retain the diaper on a wearer. Petitioner therefore resorts to information *outside* of Karami '772 to argue against this plain understanding of how the stay-away zone functions. In doing so, Petitioner fails to establish inherency because the Petition does not *allege*, let alone *show*, that retaining forces are necessarily present between the hook-type fasteners and the stay-away zone 160 of the Karami '772 diaper. *See Vivint, Inc.*, 741 F. App'x at 791. Petitioner also fails to establish inherent obviousness because the Petition does not *allege*, let alone *show*, that the natural result of the Karami '772-Benning combination is a diaper with retaining forces between the hook-type fasteners and the stay-away zone 160 of Karami '772. *See PAR Pharm., Inc.*, 773 F.3d at 1195.

Petitioner concludes that, because Karami '772 discloses that the stay-away zone has “diminished” affinity as opposed to “no” affinity to hook-type fasteners, “[a] POSITA would have understood that the hooks would still attach to the backsheet’s stay-away zone.” Pet. at 23. And Petitioner contends that “[e]ven in stay-away zone 160, retaining forces between fasteners 150a-150d and backsheet 130 were sufficient to hold the diaper on a wearer.” *Id.* at 31. These are arguments and conclusions of what Petitioner believes Karami '772 *inherently* discloses. Yet, as noted above, Petitioner fails to apply the Federal Circuit’s standard for inherency, omitting any evaluation of whether the claimed lower retaining forces between the closure aids and the outer face of the chassis are “necessarily present”

in or “the ‘natural result’ of the combination of prior art elements.” *PAR Pharm., Inc.*, 773 F.3d at 1195 (quoting *In re Oelrich*, 666 F.2d at 581). They are not.⁷

e. Petitioner relies on additional references without proper analysis to fill the gaps

Petitioner did not show that the claimed retention forces are necessarily present in Karami '772 or the natural result of the Karami '772-Benning combination and incorporates other unrelated references to try to fill the gaps in Karami '772. For example, Petitioner relies on U.S. Patent Application No. 2005/0261650 (“Damaghi”). *See* Pet. at 24. While Damaghi names Hamzeh Karami as a co-inventor, Ex. 1028 at 1, Damaghi is unrelated to Karami '772. There are no priority claims linking Damaghi and Karami '772, they do not share a disclosure, and neither publication incorporates the other by reference. *Compare*

⁷ Petitioner also uses hindsight to improperly attack “Limitation 1[d],” relying on the challenged '249 patent to support the conclusion that “[i]t also would have been obvious to use a higher-basis-weight nonwoven in Karami '772’s wings than in its containment assembly 120, which would have rendered fastener retaining forces lower in the containment assembly, including in its treated and stay-away zones.” Pet. at 33 (internal citations omitted). *See Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1296 (Fed. Cir. 2012) (“The inventor’s own path itself never leads to a conclusion of obviousness; that is hindsight.”).

Ex. 1028 *with* Ex. 1003. Petitioner nonetheless relies on Damaghi to support a skilled artisan’s purported understanding “that the hooks would still attach to the backsheet’s stay-away zone.” Pet. at 23. Petitioner cites Damaghi’s alleged disclosure of a “central stay-away zone 100 [that], with no affinity rather than diminished affinity, prevents ‘improper sizing.’” Pet. at 24 (quoting Ex. 1028 at ¶¶ [0021], [0024], [0049]-[0051]).

But Damaghi explicitly discloses that “[a] portion of the backsheet is provided with an area to which the loopless fasteners *cannot* attach. By controlling the size and location of this ‘stay-away-zone’ improper sizing of diapers can be prevented.” Ex. 1028 at ¶ [0021] (emphasis added).⁸ Thus, contrary to Petitioner’s assertion, according to Damaghi there would be *no* retaining forces at the stay away zone portion of the backsheet because that portion could not accommodate fasteners. Rather than showing that hooks would attach to Karami ’772’s “stay away zone,” Damaghi also shows that the common understanding of a “stay away zone” is an area designed *not to retain*.

⁸ Damaghi is a continuation of U.S. Patent Application No. 10/841,119, published as 2005/0261647. Ex. 1028, ¶[0001]; Ex. 2002 at 1. That publication likewise discloses a stay-away zone “to which the loopless fasteners cannot attach.” Ex. 2002 at ¶ [0020].

Damaghi is not the only reference Petitioner relies on to try to superficially fill the gap in the Karami '772-Benning combination for the claimed retaining forces. Petitioner also turns to Karami '626. *See* Pet. at 31-32. Aside from having the same named inventor, Karami '772 and Karami '626 are unrelated. There are no priority claims linking them, they do not share a disclosure, and neither publication incorporates the other by reference. *Compare* Ex. 1003 *with* Ex. 1004.⁹ Yet Petitioner relies extensively on Karami '626 to address the lower “retaining forces” at “the outer face of said chassis” required in claims 1 and 34.

Petitioner first tries to link Karami '772 and Karami '626 by discussing alleged similarities in their backsheets and fasteners: “Karami '772’s backsheet—like Karami '626’s—is a film-nonwoven laminate, with a 5-45 gsm nonwoven Karami '772 also uses (or at last shows was an obvious option) the same fastener as Karami '626: the Binder 25445.” Pet. at 32 (citations omitted). Petitioner then relies explicitly on Karami '626 to attack the retaining forces limitation: “Karami '626 explains that ‘the fastener elements 41, 42 . . . may engage directly with any portion of the nonwoven surface constituting the . . . backsheet 32 . . . [to]

⁹ Damaghi incorporates Karami '626 by reference. Ex. 1028 at ¶ [0006].

This does not alter the lack of relationship between Karami '772 and either Damaghi or Karami '626.

accommodate[e]’—and thus secure the diaper on—‘both small and large-waisted persons.’” Pet. at 32. “Per Karami ’626, this is also true using two fastener elements, let alone Karami ’772’s four.” *Id.* at 37 (citations omitted). Petitioner’s expert, Mr. Jezzi, similarly relies on Karami ’626. *See, e.g.*, Ex. 1012 at ¶¶ 70, 75, 77. But Karami ’626 is not part of proposed ground 1. Instead, Petitioner relies on inherency and Karami ’626 to fill the gap in the Karami ’772-Benning combination without applying the inherency standard or undertaking a proper inherency analysis.

To the extent Petitioner intends to argue incorporation of additional references shows obviousness rather than inherency, the Petition neglects to include the full and proper obviousness analysis prescribed by *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1 (1966) and *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). Petitioner cites Damaghi once in ground 1, in a parenthetical asserting that Damaghi’s “central stay-away zone 100, with no affinity rather than diminished affinity, prevents ‘improper sizing of diapers.’” Pet. at 24 (quoting Ex. 1028 at ¶¶ [0021], [0024], [0049]-[0051]). And Petitioner merely alleges similarities between the backsheets and fasteners of Karami ’772 and Karami ’626 before attempting to map Karami ’772 to the retaining forces limitation of claim 1. Pet. at 31-32. Petitioner provides no rationale as to why it would have been obvious to modify the Karami ’772-Benning combination based on *either* Damaghi

or Karami '626. It is thus apparent Petitioner is not arguing that adding Damaghi or Karami '626 to the Karami '772-Benning combination would have been obvious. If Petitioner's argument *is* obviousness, rather than inherency, the Petition lacks the full and proper analysis required to show even a reasonable likelihood that any claim in ground 1 would have been obvious. *See KSR*, 550 U.S. at 406 (providing the objective framework required to show obviousness) (citing *Graham*, 383 U.S. at 1).

f. Petitioner and its expert rely on *possible* disclosures of Karami '772 and Karami '626, which are insufficient to show inherency

Petitioner not only fails to show that Karami '772 or the Karami '772-Benning combination inherently has “mechanical closure aids . . . [that can] be secured detachably at least in regions both on the outer face of the main part” and “retaining forces between said mechanical closure means and the outer face,” Ex. 1001, 2:7-16, Petitioner's and Mr. Jezzi's analyses admittedly depend on supposedly preferred or possible—rather than essential or unavoidable—disclosures of Karami '772 and Karami '626, proving the combination does *not* inherently include the claimed features. *See Trintec Indus.*, 295 F.3d at 1295 (explaining that probabilities or possibilities are insufficient to show inherent anticipation); *PAR Pharm., Inc.*, 773 F.3d at 1195 (explaining the same in the context of inherent obviousness). For example, in addressing the retaining forces

limitation, Petitioner asserts “Karami ’772 also uses (*or at least shows was an obvious option*) the same fastener as Karami ’626: the Binder 25445.” Pet. at 32 (emphasis added).¹⁰ Mr. Jezzi similarly states “Karami ’772’s nonwoven (FABRILEX [sic] 307 or 305) and fastener (Binder 25445 hook fastener) *may be the same* as that of Karami ’626.” Ex. 1012 at ¶ 70 (emphasis added). And that “Karami ’772’s untreated nonwoven *may* be the same nonwoven and hook fastener suitable to secure an absorbent article to a wearer—as explained by Karami ’626” *Id.* (emphasis added). Mr. Jezzi relies on additional *possible* disclosures of Karami ’626, namely, that the “nonwoven is *preferably* a spunbond having a basis weight of 13-50 grams per square meter (gsm), which is within the range *contemplated by* Karami ’772’s untreated nonwoven.” *Id.*

Karami ’626 itself shows that Petitioner’s arguments about overlapping ranges of basis weight for nonwovens in Karami ’626 and Karami ’772 are speculative and do not establish that the nonwovens in Karami ’772 inherently act the same as nonwovens in Karami ’626 and have the same retentive forces. For instance, Karami ’626 states that “pore size. . . typically affects the peel strength”

¹⁰ To the extent Petitioner intends to argue it would have been obvious to use the same fastener from Karami ’626 in Karami ’772, the Petition and Mr. Jezzi again omit the comprehensive obviousness analysis *Graham* and *KSR* require.

of a nonwoven. Ex. 1004 at ¶ [0069]. Petitioner makes no mention of pore size or other characteristics that affect retentive forces when comparing Karami '626 and Karami '772, again failing to meet the high standard required for inherency.

For these additional reasons, Petitioner has not shown a reasonable likelihood of prevailing on ground 1 based on Karami '772 and Benning.

B. Grounds 4, 7, 9, and 11 do not cure the deficiencies of ground 1

Grounds 4, 7, 9, and 11 cover claims 6, 9, 10, 28, and 42, which depend from claim 1 and 37. Each of these grounds starts with the Karami '772-Benning combination and adds another reference. Pet. at 84-98. But none of these grounds addresses, let alone cures, the deficiencies in the base Karami '772-Benning combination. Accordingly, Petitioner has not shown a reasonable likelihood of prevailing on grounds 4, 7, 9, and 11.

V. The Petition Does Not Establish Obviousness of Any Claim Based on Benning and Karami '626

A. Ground 2 fails for two independent reasons

In ground 2, Petitioner contends that independent claims 1 and 34, and dependent claims 2-5, 7, 8, 11-17, 19-27, 29-33, 35-41, and 43-54 would have been obvious over Benning combined with Karami '626. *See* Pet. at 4, 50-75. But Petitioner's arguments for modifying Benning are conclusory and nonsensical. And even assuming there would have been reasons for the Benning-Karami '626 combination, Petitioner's arguments are premised on the combination inherently

meeting the claimed retention forces limitation. But as with ground 1, Petitioner fails to prove inherency. Thus, Petitioner has not established obviousness for independent claims 1 and 34, or their dependent claims 2-5, 7, 8, 11-17, 19-27, 29-33, 35-41, and 43-54 based on Benning and Karami '626.

1. Petitioner's alleged reasons for modifying Benning are conclusory and nonsensical

Petitioner's proposed combination of Benning and Karami '626 is premised on replacing "Benning's underlayer 30" with "a film-nonwoven laminate like Karami '626." Pet. at 51-51. In order to demonstrate that challenged claims would have been obvious, a petitioner must show "'a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so.'" *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327 (Fed. Cir. 2012) (citing *Procter & Gamble v. Teva Pharms. USA, Inc.*, 566 F.3d 989, 994 (Fed. Cir. 2009) (quoting *Pfizer, Inc. v. Apotex, Inc.*, 480 F.3d 1348, 1361 (Fed. Cir. 2007))); *see also Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016).

As a motivation, Petitioner gives two reasons one of ordinary skill in the art allegedly would have changed Benning: "a) provide a more comfortable and

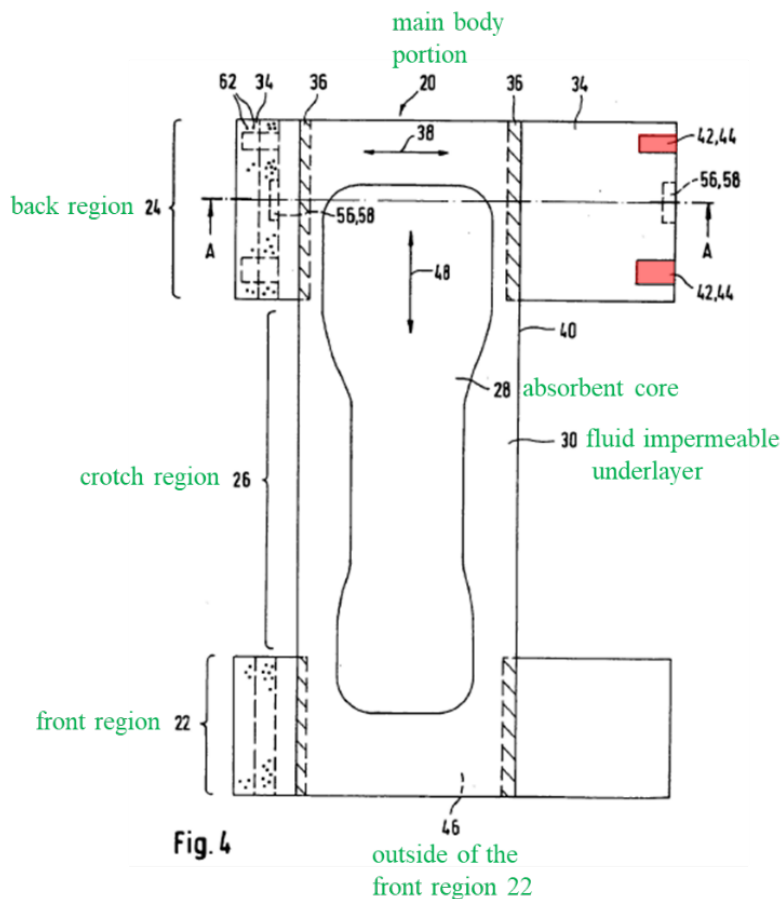
visually appealing cloth-like outer surface for Benning's diaper; and b) improve adjustability by enabling fasteners like Karami '626's to '[e]ngage directly with any portion of [a diaper's] nonwoven surface[s]' to secure the diaper on a wearer." Pet. at 53-54 (citations omitted). But neither of these reasons holds up. The first is conclusory and unsupported, and Benning is not even alleged to suffer from defects in this regard. The second is nonsensical since Benning already discloses having a fastener engage directly with the main body portion of Benning and there thus would have been no reason to change Benning to enable fastening there.

On the first reason, Petitioner has not alleged that Benning's diaper suffers from being uncomfortable or visually unappealing. Petitioner has not identified that as an issue with Benning or alleged that Benning is deficient in that regard. *See* Pet. at 53-54. Petitioner has not demonstrated or even alleged that Benning's underlayer 30 is uncomfortable. Likewise, Petitioner has not shown or even alleged that Benning's underlayer 30 is visually unappealing, even assuming such a speculative standard could provide a reason to combine references. Instead, Petitioner's argument is a superficial, speculative, and conclusory allegation that is not even tied to Benning. Such generic statements do not show a motivation to combine references. *See, e.g., ActiveVideo Networks, Inc.*, 694 F.3d at 1327 (finding no motivation where an argument was based on generic desire for improvement); *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-00582, Paper

34 at 21-22 (PTAB Aug. 5, 2019) (informative) (generic desire and bald statement not sufficient for motivation).

Petitioner's identified second reason, in addition to being conclusory, is nonsensical. As shown below in the annotated version of Fig. 4, Benning discloses an incontinence article with a main body portion 20 that "comprises a front region 22, a back region 24, and a crotch region 26" and "an absorbent core 28" with "a fluid-impermeable underlayer 30 which can also form the outer visible side of the incontinence article." Ex. 1002 at ¶ [0053]. Benning further discloses that closing tapes 44 (red in the annotated Fig. 4 below) "interact in a releasably adherent manner with an outside 46 of the front region 22 of the main body portion 20." Ex. 1002 at ¶ [0055]. As a result, Benning discloses enabling a fastener to engage with the outer surface of the main body portion, i.e., underlayer 30, since that can "form the outer visible side of the incontinence article." Ex. 1002 at ¶ [0053]. There would have been no reason to modify underlayer 30 to enable fasteners to engage to it when Benning already teaches that is done. *See In re Schweickert*, 676 F. Appx 988, 995 (Fed. Cir. 2017) (noting that an alleged beneficial functionality from a proposed combination is not a reason to modify a reference when that reference already performs the functionality). And modifying underlayer 30 would have no impact on how a fastener engages with other portions of Benning's

incontinence article. Thus, Petitioner's stated reason for modifying Benning is redundant and therefore erroneous.



To the extent Petitioner is alleging that changing the main body portion of Benning permits the use of “hook-type fasteners” as disclosed in Karami ’626, Pet. at 56, that makes no sense as well because Petitioner alleges that this is already taught by Benning. *See id.* at 52 (stating that Benning’s “closures 42 can ‘be designed to grip mechanically’ . . . , which POSITA would have understood to refer to hook-type fasteners”). Thus, there would have been no reason to make the

alleged modification because Benning already achieves what Petitioner alleges would have been sought by the change.

The only reason for Petitioner's proposed modification to Benning's underlayer 30 is hindsight, which is not a sufficient reason to support an obviousness combination. *See Otsuka Pharm. Co.*, 678 F.3d at 1296.

Because Petitioner's purported reasons for combining Benning and Karami '626 are conclusory, nonsensical, based on hindsight, and not supported, they are insufficient to establish obviousness. Petitioner has thus failed to establish a reasonable likelihood that it will prevail on ground 2 based on Benning and Karami '626.

2. Petitioner does not establish that the Benning-Karami '626 combination inherently meets the claimed retaining forces

As with ground 1, Petitioner's assertion of obviousness based on Benning in combination with Karami '626 relies on inherency. But Petitioner has not shown that the claimed invention is *necessarily present* in Benning or Karami '626 or the *natural result* of the Benning-Karami '626 combination, as required for inherency. *See Vivint, Inc.*, 741 F. App'x at 791; *PAR Pharm.*, 773 F.3d at 1195.

Neither Benning nor Karami '626 discloses a chassis and ears with a closure component including mechanical closure aids where "retaining forces between said closure component and said outer face of said chassis are lower than retaining

forces between said closure component and said outer face of said first and second ears,” as required in claims 1 and 34. Petitioner argues that once the underlayer 30 of Benning is modified to be “a film-nonwoven backsheet like Karami ’626’s” and once “fasteners like Karami ’626’s” are used “for Benning’s closures 42,” the modified Benning diaper would have “higher fastener retaining forces [for wings 34] . . . than in the lower-basis-weight nonwoven of underlayer 30.” Pet. at 60-61. This is an argument based on inherency, but Petitioner has not met the high standard for inherency. *Millennium Pharms.*, 862 F.3d at 1367 (stating a “high standard” is required to inherency). Petitioner must do more than show that the Benning-Karami ’626 combination could possibly result in the claimed retentive forces. *PAR Pharm.*, 773 F.3d at 1195. It must show it would have been the natural result. *Id.*

Petitioner cites disclosure in the ’249 patent to support its inherency arguments. Pet. at 61. Apart from being improper hindsight to the extent Petitioner is relying on obviousness, the fact that the differing retentive forces are described in the ’249 patent is not evidence that those differing retentive forces would have been inherent in the Benning-Karami ’626 combination. Petitioner also cites basis weight *ranges* for the “wings” and “backsheets/underlayer” of its proposed combination and argues this establishes the claimed retentive forces. Pet. at 61. But this shows that Petitioner is only arguing about *possibilities*. And Petitioner never

addresses the teachings of Benning or Karami '626, which are contrary to its arguments, or the combination as a whole.

For instance, Petitioner's argument about retaining forces is premised on the "wings" in the combination having a higher basis weight than the "backsheet/underlayer," yet Petitioner has not established that this would be the natural result of the combination. *Id.* Even the ranges cited by Petitioner show that the combination could have "wings" with a lower basis weight than the "backsheet/underlayer." *Id.* (alleging "from '25-50 [gsm] (EX1002 ¶[0032], from '20-40 gsm (optimally 34 gsm),' (EX1004, ¶[0065], or from 18-60 gsm (e.g., 30 gsm) (§VIII.B.1(c))" for the wings and alleging "'from 15-30 gsm (optimally 20 gsm)' (EX1004, ¶[0065]), or from 10-30 (e.g., 20 gsm) (§VIII.B.1(c))" for "backsheet/underlayer"). While Petitioner cites Benning for the range of 25-50 gsm for wings, *Id.*, it does not mention the broader ranges that Benning discloses. Benning states that the material sections attached at the sides "advantageously have a surface weight of 10 to 150 g/m², in particular 20-100 g/m², and specifically of 25-50 g/m². Ex. 1002 at ¶ [0032]. As a result, the ranges are even broader than Petitioner suggests, but even the ranges cited by Petitioner demonstrate that Petitioner is arguing about possibilities and not what would be the natural result of the combination.

Petitioner also argues that “Karami ’626’s broader teachings also render these differential basis weights, and others, obvious.” Pet. at 57. And Petitioner focuses on the following passage from Karami ’626: “While the nonwoven is preferably a spunbond having a basis weight of 13-50 grams per square meter (gsm), slightly higher basis weights of 20-40 gsm (optimally 34 gsm) are preferred for use on the wings of a T-shaped brief, while relatively lower basis weights of 15-30 gsm (optimally 20 gsm) are preferred for the backsheet of the front and back portions.” Ex. 1004 at ¶ [0065]; Pet. at 70-71. But Karami ’626 only states that “*slightly* higher basis weights” are preferred for wings and does not say *why*. See Ex. 1004 at ¶ [0065] (emphasis added). Also, Petitioner proposes modifying Benning’s underlayer 30, not the material sections attached at the sides or alleged wings. And Benning teaches having “material sections attached to the main body portion” that are “less rigid than the main body portion or the chassis-forming materials of the main part.” Ex. 1002 at ¶ [0033]. Petitioner does not address this aspect of Benning or discuss the respective retentive forces of the combination when the “wings” are more flexible than the “backsheet/underlayer.” More flexible “wings” could have a lower, not higher, basis weight than the “backsheet/underlayer” of the modified Benning diaper.

Petitioner also does not address the teachings of Karami ’626, which state that the “pore size in the nonwoven (that is, the size of the interstices formed by the

fibers) typically affects the peel strength, a higher pore size providing greater peel strength for the fastener elements according to the present invention.” Ex. 1004 at ¶ [0069]. This undermines Petitioner’s argument that the respective retentive forces of the “wings” and “backsheet/underlayer” of the Benning-Karami ’626 combination are based solely on the basis weight of the nonwovens. Petitioner does not address the pore size of the nonwovens in the alleged Benning-Karami ’626 combination even though Karami ’626 states that would impact retentive forces.

Simply put, Petitioner has not met the high standard for showing the claimed retentive forces are the natural result of modifying Benning’s underlayer 30 and closures 42, and its grounds based on the Benning-Karami ’626 combination fail. For this additional reason, Petitioner has thus failed to establish a reasonable likelihood that it will prevail on ground 2 based on Benning and Karami ’626.

B. Ground 3 does not cure the deficiencies of ground 2

Ground 3 applies the Benning-Karami ’626 combination of ground 2 but adds Stupperich. Pet. at 75-84. Ground 3 applies to claims 1-5, 7, 12-18, 19-22, 24-27, 31, 32, 34-41, 43-46, 48, and 50-54, Pet. at 75, which overlaps with the claims in ground 2. Pet. at 4. The addition of Stupperich does not cure any of the deficiencies identified in the Benning-Karami ’626 combination. Petitioner fails to explain *why* Stupperich is necessary and not redundant. *Id.* at 75-84. Indeed, Petitioner claims the Benning-Karami ’626-Stupperich combination would not

have improved, but rather only “maintained Karami ’626’s simplicity of using otherwise similar nonwovens that have different basis weights for the wings and backsheet.” *Id.* at 78. This conclusory statement is not sufficient to support obviousness. *See, e.g., Comcast Cable Commc’ns, LLC v. Promptu Sys. Corp.*, IPR2018-00340, Paper 58 at 22-26 (PTAB Mar. 29, 2019). Also, this conclusory statement does not cure the deficiencies in the Benning-Karami ’626 combination.

In addition, Petitioner contends that all limitations of claims 1, 26-27, 29-30, 34, and 51-53 except two—“Limitation 1[d] and 34[d]”—“are met by Benning-Karami ’626-Stupperich in the same way as in Benning-Karami ’626.” Pet. at 78. But the Petition does not explain why the Benning-Karami ’626-Stupperich combination purportedly covers these limitations differently. *Id.* Petitioner cites disclosures in Stupperich of numerical differences in measured retaining forces between the “Lower-Basis-Weight Nonwoven” and the “Higher-Basis-Weight Nonwoven.” *Id.* But Petitioner fails to explain *how* those disclosures map to limitations 1[d] and 34[d] or *why* those measurements are relevant when those limitations do not recite numerical values for the retaining forces. *Id.*

For these reasons, Petitioner has not shown a reasonable likelihood of prevailing on ground 3.

C. Grounds 5, 8, 10, and 12 do not cure the deficiencies of ground 2

Grounds 5, 8, 10, and 12 cover claims 6, 9, 10, 18, 28, and 42, which depend from claims 1 and 34. Each of these grounds starts with the Benning-Karami '626 combination and adds another reference. Pet. at 4. But none of these grounds addresses, let alone cures, the deficiencies in the base Benning-Karami '626 combination. Accordingly, Petitioner has not shown a reasonable likelihood of prevailing on grounds 5, 8, 10, and 12.

D. Grounds 6 and 13 do not cure the deficiencies of grounds 2 and 3

Grounds 6 and 13 cover claims 6 and 28, which depend from claim 1. Each of these grounds starts with the Benning-Karami '626-Stupperich combination and adds another reference. Pet. at 4. But neither of these grounds addresses, let alone cures, the deficiencies in the base Benning-Karami '626 combination of ground 2 or the deficiencies in the base Benning-Karami '626-Stupperich combination of ground 3. Accordingly, Petitioner has not shown a reasonable likelihood of prevailing on grounds 6 and 13.

VI. Conclusion

For these reasons, the Board should deny institution of *inter partes* review.

Respectfully submitted,

Dated: November 25, 2020

By: /Joshua L. Goldberg/
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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 PRELIMINARY RESPONSE** contains 12,146 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 25, 2020

By: /Joshua L. Goldberg/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I, William Esper, certify that on November 25, 2020, a copy of **PATENT OWNER'S PRELIMINARY RESPONSE** was served upon the below-listed counsel by electronic mail:

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Petitioner has consented to service by electronic mail.

Dated: November 25, 2020

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