

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CONOPCO, INC. dba UNILEVER
Petitioner

v.

THE PROCTER & GAMBLE COMPANY
Patent Owner

Case IPR2014-00507
Patent 6,451,300 B1

Before LORA M. GREEN, GRACE KARAFFA OBERMANN, and
RAMA G. ELLURU, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Unilever filed a Petition for an *inter partes* review of claims 6-10, 14, 15, and 21-23 of U.S. Patent No. 6,451,300 B1 (Ex. 1001, “the ’300 patent”). Paper 2 (“the Petition” or “Pet.”). The Procter & Gamble Company (“P&G”), the owner of the ’300 patent, timely filed a Preliminary Response. Paper 8 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314. Based on the specific facts presented, we exercise our discretion, and deny review under 35 U.S.C. § 325(d).

A. *Related Matter: Case IPR2013-00509 (“the 509 proceeding”)*

Unilever filed an earlier Petition that sought an *inter partes* review of claims 1-25 of the ’300 patent. *Conopco, Inc. dba Unilever v. The Procter & Gamble Co.*, Case IPR2013-00509 (“IPR2013-00509”), Paper 4 (“the 509 Petition” or “509 Pet.”). We granted review of claims 1-5, 11-13, 16-20, 24, and 25, and denied review of claims 6-10, 14, 15, and 21-23. IPR2013-00509, Paper 10 (“509 Dec. on Inst.”). Unilever filed an unsuccessful Request for Rehearing, seeking reconsideration of our decision denying review of claims 6, 14, and 15. IPR2-13-00509, Paper 12) (Request for Rehearing).

Unilever then filed the instant Petition, challenging the patentability of each claim that was denied review in the 509 proceeding. Pet. 1. Unilever concurrently filed a Motion for Joinder requesting that we join the instant Petition with the 509 proceeding. Paper 3 (“Joinder Mot.”).

B. *The ’300 Patent (Ex. 1001)*

The ’300 patent is directed to a shampoo composition and method for providing a combination of anti-dandruff efficacy and conditioning. Ex. 1001, 2:20-22. According to the ’300 patent Specification, “[t]hese shampoos comprise:

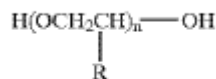
(A) from about 5% to about 50%, by weight, of an anionic surfactant; (B) from about 0.01% to about 10%, by weight, of a non-volatile conditioning agent; (C) from about 0.1% to about 4%, by weight, of an anti-dandruff particulate; (D) from about 0.02% to about 5%, by weight, of at least one cationic polymer; (E) from 0.005% to about 1.5%, by weight, of a polyalkylene glycol; and (F) water.” *Id.* at 2:22-30. The Specification further defines the polyalkylene glycol. *Id.* at 2:30-33.

The Specification sets forth five examples of the inventive shampoo composition. *Id.* at 31:50-33:45. The Specification also describes a method for applying the shampoo to the hair and scalp, which preferably has been wetted with water, in an amount that is effective to confer anti-dandruff efficacy and hair conditioning; the shampoo is thereafter rinsed off. *Id.* at 2:34-37; 31:24-28.

C. Illustrative Claim

Claim 10, which depends from claims 1 and 2, is illustrative of the claimed subject matter. Those claims are reproduced below.

1. A shampoo composition comprising:
 - a) from about 5% to about 50%, by weight of the composition, of an anionic surfactant;
 - b) from about 0.01% to about 10%, by weight of the composition, of a non-volatile conditioning agent;
 - c) from about 0.1% to about 4%, by weight of the composition, of an anti-dandruff particulate;
 - d) from about 0.02% to about 5%, by weight of the composition, of at least one cationic polymer;
 - e) from 0.005% to about 1.5%, by weight of the composition, of a polyalkylene glycol corresponding to the formula:



- i) wherein R is selected from the group consisting of hydrogen, methyl and mixtures thereof;
 - ii) wherein n is an integer having an average value from about 1,500 to about 120,000; and
- f) water.

2. A shampoo composition according to claim 1, wherein said at least one cationic polymer component is selected from the group consisting of guar derivatives, cellulose derivatives, and mixtures thereof.

10. A shampoo composition according to claim 2, wherein said cellulose derivatives have a charge density from about 0.2 meq/g to about 0.6 meq/g.

D. The Asserted Grounds of Unpatentability

In the instant petition, Unilever challenges claims 6-10, 14, 15, and 21-23 of the '300 patent based on the following asserted grounds of unpatentability:

Reference[s]	Basis	Claims challenged
Kanebo ¹ and Cothran ²	§ 103	6-10
Kanebo, Cseh, ³ and Cosmedia ⁴	§ 103	6
Kanebo, Reid, ⁵ and Bartolo ⁶	§ 103	6, 8, 9
Kanebo, Cseh, Sime, ⁷ and Cosmedia	§ 103	6

¹ Kanebo JP 09-188614 (July 22, 1997) (English translation) (Ex. 1006).

² Cothran WO 96/32919 (Oct. 24, 1996) (Ex. 1044).

³ Cseh US 4,676,978 (June 30, 1997) (Ex. 1042).

⁴ Cosmedia® Guar C261 (Product Data Sheet) (Ex. 1040).

⁵ Reid US 5,085,857 (Feb. 4, 1992) (Ex. 1018).

⁶ Bartolo US 5,202,048 (April 13, 1993) (Ex. 1012).

⁷ Sime US 5,037,818 (Aug. 6, 1991) (Ex. 1028).

Reference[s]	Basis	Claims challenged
Kanebo, Cardin, ⁸ and Kalla ⁹	§ 103	14, 15, 22
Kanebo and Bar-Shalom ¹⁰	§ 103	21, 23
Evans ¹¹ and Cothran	§ 103	10
Evans, Cseh, and Cosmedia	§ 103	6, 8, 9

II. ANALYSIS

The standard for instituting an *inter partes* review is set forth in 35 U.S.C.

§ 314(a) as follows:

THRESHOLD -- The Director may not authorize an *inter partes* review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

As set forth in 35 U.S.C. § 325(d), the Director, and by extension the Board, has broad discretion to deny a petition that raises substantially the same prior art or arguments previously presented to the Office. That statutory provision provides as follows:

In determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.

⁸ Cardin US 5,104,645 (Apr. 14, 1992) (Ex. 1014).

⁹ Kalla WO 97/026854 (July 31, 1997) (Ex. 1031).

¹⁰ Bar-Shalom US 5,618,798 (Apr. 8, 1997) (Ex. 1034).

¹¹ Evans WO 97/14405 (Apr. 24, 1997) (Ex. 1010).

The instant Petition challenges each claim that was denied review in the 509 proceeding. *Compare* 509 Pet. 6-7 *with* Pet. 9-10 (both raising obviousness challenges against claims 6-10, 14, 15, and 21-23); *see* 509 Dec. on Inst. 18 (denying review of those claims). The instant Petition relies on eleven pieces of prior art: four that were raised in the 509 Petition (Kanebo, Cardin, Evans, and Bartolo) and seven that are new to this proceeding (Cothran, Cseh, Cosmedia, Reid, Sime, Kalla, and Bar-Shalom). *Compare* 509 Pet. 9-10 *with* Pet. 8; 509 Pet. 1, 21, 32, 37 *with* Pet. 8 (for Bartolo). Unilever, however, presents no argument or evidence that the seven newly cited references were not known or available to it at the time of filing of the 509 Petition. Moreover, six grounds rely on Kanebo, a reference previously presented in the 509 Petition. The two remaining grounds rely on Evans, a reference previously presented in the 509 Petition. *Compare* 509 Pet. 9-10 *with* Pet. 10. On this record, we exercise our discretion and “reject the petition” because “the same or substantially the same prior art” previously was “presented to the Office” in the 509 proceeding. 35 U.S.C. § 325(d).

An additional rationale supports our decision. We are persuaded that arguments raised in the instant Petition are “substantially the same” as those “previously [] presented to the Office” in the 509 proceeding. *Id.* Unilever’s treatment of claim 10 is illustrative. Claim 10 includes all the limitations of claims 1 and 2 and, further, requires cellulose derivatives within a specified charge density range.

In the 509 Petition, Unilever argued that Evans discloses each limitation of claim 10, except for the limitation relating to the charge density, arguing that

Coffindaffer¹² suggests that missing feature. 509 Pet. 43, 48-49. We found lacking any persuasive evidence of a reason to combine those references. 509 Dec. on Inst. 15-16. Unilever now contends that claim 10 would have been obvious over Evans and Cothran. Pet. 42-47, 53-54. In both petitions, Unilever advances “substantially the same” argument—namely, that claim 10 would have been obvious over Evans in view of other art disclosing cellulose derivatives that overlap or fall within the specified charge density range. 35 U.S.C. § 325(d).

Similarly, claim 15 includes all the limitations of claim 1 and, further, requires an anti-dandruff particulate having an “average particulate size of about 2.5 μm .” In the 509 Petition, Unilever argued that Kanebo discloses each limitation of claim 15, except for the limitation relating to “average particulate size,” arguing that Cardin discloses that missing feature. 509 Pet. 50-52. We denied review on the ground that Unilever provided only “conclusory arguments” supporting the proposed combination of prior art. 509 Dec. on Inst. 15-16. Unilever now contends that claim 15 would have been obvious over Kanebo, Cardin, and Kalla. Pet. 34-37. Unilever relies on Kalla in support of its reason to combine, and in particular, for a disclosure of advantages of using the platelet particle form of 1-hydroxy-2pyridinethione salts, having the specified particle size range, as the antimicrobial agent in a shampoo composition. Pet. 36-37. On this record, Unilever advances “substantially the same” argument that was previously asserted in the 509 Petition. 35 U.S.C. § 325(d); *compare* 509 Pet. 50-52 *with* Pet. 34-37.

We have considered all of the papers filed in both proceedings. Based on the information presented, we are persuaded that the instant Petition uses our prior

¹² Coffindaffer US 5,624,666 (April 29, 1997).

Decision on Institution to bolster challenges that were advanced, unsuccessfully, in the 509 Petition. Specifically, Unilever argues that the instant Petition “obviates purported deficiencies” illuminated in our prior decision. Joinder Mot. 8. P&G, on the other hand, contends that Unilever seeks to revive and augment challenges that were rejected in the 509 proceeding, “[a]rmed with the Board’s guidance as to the flaws in the [509 Petition].” Prelim. Resp. 7. On this record, we determine that the instant Petition presents “the same or substantially the same prior art or arguments” that were advanced in the 509 Petition. 35 U.S.C. § 325(d).

Unilever has not presented considerations that tip the balance in favor of review. Given that we already have considered the same or substantially the same prior art or arguments in connection with the challenged claims, we deny the request for an *inter partes* review under § 325(d). We deny the motion for joinder as moot.

III. ORDER

It is

ORDERED that the Petition is denied as to all challenged claims of the ’300 patent;

FURTHER ORDERED that Unilever’s Motion for Joinder with IPR2013-00509 is denied as moot.

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Patent 6,451,300 B1

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