

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 IPR2014-00628
Patent 6,649,155 B1

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

OBERMANN, *Administrative Patent Judge*.

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

I. BACKGROUND

Conopco, Inc. dba Unilever (“Unilever”) filed a Corrected Petition requesting *inter partes* review of claims 1–23 of U.S. Patent No. 6,649,155 B1 (Ex. 1001, “the ’155 patent”). Paper 5 (“Pet.”). The Procter & Gamble Company (“P&G”) filed a Patent Owner Preliminary Response. Paper 17 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314(a), which

provides that an *inter partes* review may, but not must, be instituted if “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” For the reasons that follow, based on the particular circumstances presented in this case, we decline to institute review. *See* 35 U.S.C. §§ 314(a), 325(d).

A. Related Proceedings

Unilever is a named defendant in a district court case involving the ’155 patent. *Procter & Gamble Co. v. Conopco Inc.*, 13-cv-00732 (S.D. Ohio); *see* Pet. 2 (statement of related cases). Unilever filed, and we rejected, an earlier petition for *inter partes* review of claims 1–23 of the ’155 patent (“the 510 Petition”). IPR2013-00510, Paper 2 at 3; *see* Pet. 2.

B. The ’155 Patent (Ex. 1001)

The ’155 patent relates to a shampoo composition and method for providing a combination of anti-dandruff efficacy and conditioning. Ex. 1001 2:32–34. According to the ’155 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 a cationic guar derivative; and (E) water.” *Id.* at 2:34–41. The specification further discloses that “[t]he cationic guar derivative has a molecular weight from about 50,000 to about 700,000, and has a charge density from about 0.05 meq/g to about 1.0 meq/g.” *Id.* at 2:41–44.

Each challenged claim requires a combination of shampoo ingredients that includes a cationic guar derivative having a molecular weight and charge density that falls within specified ranges. The specification identifies polymers sold by Rhodia Company, under the trade names JAGUAR™ C13S and JAGUAR™ C17, as suitable cationic guar derivatives for use in the invention. *Id.* at 20:9–12, 21:6–11.

C. Illustrative Claims

Unilever seeks *inter partes* review of claims 1–23, all of the issued claims of the '155 patent. Claims 1 and 19 are independent claims.

Claim 1, reproduced below, is illustrative of the claimed subject matter.

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 a cationic guar derivative;
 - i) wherein said cationic guar derivative has a molecular weight from about 50,000 to about 700,000; and
 - ii) wherein said cationic guar derivative has a charge density from about 0.05 meq/g to about 1.0 meq/g;
 - e) water.

Claim 19 further narrows the weight-percent, molecular weight, and charge density ranges of the cationic guar derivative. Specifically, claim 19 requires that the derivative must comprise from about 0.1% to about 5% of the composition by weight, have a molecular weight from about 100,000 to about 400,000, and have a charge density from about 0.4 meq/g to about 1.0

meq/g. The '155 patent also specifies a method for applying the composition to wet hair to provide anti-dandruff efficacy and hair conditioning (claim 20) and to regulate hair growth (claims 22 and 23).

D. Prior Art Relied Upon

Unilever relies upon the following prior art references:

Cothran *et al.*, WO 96/32919, published October 24, 1916 (Ex. 1044) (“Cothran”).

Sime, US Patent 5,037,818, issued August 6, 1991 (Ex. 1028) (“Sime”).

Evans *et al.*, WO 97/14405, published April 24, 1997 (Ex. 1010) (“Evans”).

Bar-Shalom *et al.*, US Patent 5,618,798, issued April 8, 1997 (Ex. 1034) (“Bar-Shalom”).

Cosmedia® Guar C 261, Product Data Sheet, Rev. January 3, 1997, Reg. 9 (Ex. 1040) (“Cosmedia”).

Uchiyama *et al.*, WO 97/14406, published April 24, 1997 (Ex. 1045) (“Uchiyama”).

E. The Asserted Grounds of Unpatentability

Unilever challenges the patentability of claims 1–23 of the '155 patent on the grounds set forth in the chart below. *See* Pet. ii.¹

¹ Unilever’s chart of grounds (Pet. 13) is inconsistent with its table of contents (Pet. ii) and argument (Pet. 43–44). We identify the grounds as presented in the table of contents and argument.

Reference(s)	Basis	Claims challenged
Cothran	§ 102(b)	1–11, 19, and 20
Cothran and Sime	§ 103	1, 4–11, 19, and 20
Cothran and Evans	§ 103	2–3 and 12–18
Cothran and Bar-Shalom	§ 103	21–23
Cothran, Sime, and Cosmedia	§ 103	1, 4–11, 19, and 20
Cothran, Evans, and Cosmedia	§ 103	23– and 12–18
Cothran, Bar-Shalom, and Cosmedia	§ 103	21–23
Uchiyama	§ 102(b)	2–3 and 12–18
Uchiyama	§ 103	2–3 and 121–8

II. ANALYSIS

The Board has discretion to decline to institute an *inter partes* review. 35 U.S.C. § 314(a). One factor the Board may take into account when exercising that discretion is whether “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d) (“[i]n determining whether to institute or order a proceeding” for *inter partes* review, “the Director may take into account” that factor, and “reject the petition” on that basis).

Unilever seeks *inter partes* review of claims 1–23 of the ’155 patent for a second time. Pet. 1; *see* IPR2013-00510, Paper 9 (review declined). Unilever does not address § 325(d) or compare the prior art or arguments

applied in the instant Petition to those raised previously in the 510 Petition. Unilever avers, however, that it “is not barred or estopped from requesting” review “of any claim of the ’155 patent.” Pet. 1.

P&G responds that § 325(d) supports rejecting the instant Petition. Prelim. Resp. 1–2. Specifically, P&G argues that “Unilever relies on the same arguments that the Board considered and rejected in the” 510 Petition. *Id.* at 5. P&G argues also that the instant Petition relies on prior art that is “cumulative and duplicative” of art raised in the 510 petition. *Id.* In P&G’s view, institution of review in this case would encourage petitioners to file serial petitions against the same patent claims to gain “an unwarranted and unfair procedural advantage in pending infringement litigation.” *Id.*

We have compared the prior art and arguments raised in the instant Petition to those raised in the 510 Petition. Based on the information presented, we are persuaded that the instant Petition raises, at minimum, “substantially the same . . . arguments” that “previously were presented to the Office” in the 510 Petition. 35 U.S.C. § 325(d). That is one of several circumstances that inform our decision to decline to institute review. *See* 35 U.S.C. § 314(a) (institution of review is discretionary, not mandatory).

A. Grounds Based on Anticipation

In the 510 Petition, Unilever raised anticipation grounds based on Bowser² or Reid.³ IPR2013-00510, Paper 2 at 10, 31. In the instant Petition, Unilever raises anticipation grounds based on Cothran or Uchiyama. Pet. 13, 45. Although the instant Petition and the 510 Petition

² US Patent 5,723,112, issued March 3, 1998 (IPR2013-00510, Ex. 1009).

³ US Patent 5,085,857, issued February 4, 1992 (IPR2013-00510, Ex. 1018).

rely upon different prior art references, for the reasons that follow, we are persuaded that both petitions apply that art to make out “substantially the same” argument regarding anticipation. 35 U.S.C. § 325(d) (Board has discretion to reject a petition that raises “substantially the same prior art *or* arguments” as an earlier-filed petition) (emphasis added).

The ’155 patent claims are directed to a shampoo composition comprising a plurality of ingredients. Both petitions contain argument focused on a particular ingredient—the cationic guar derivative—and, specifically, on two characteristics of that ingredient—the molecular weight and charge density. An argument common to both petitions is that the applied art teaches a cationic guar derivative that meets the molecular weight and charge density limitations of the ’155 patent claims.

Claim 1 requires a combination of shampoo ingredients that includes a “cationic guar derivative” having “a molecular weight from about 50,000 to about 700,000” and “a charge density from about 0.05 meq/g to about 1.0 meq/g.” In the 510 Petition, Unilever argued that Bowser or Reid, by referencing a material identified by the trade name Jaguar® C15, teaches a cationic guar derivative that meets those molecular weight and charge density ranges. IPR2013-00510, Paper 2 at 10, 14–15 (for Bowser); *id.* at 32, 35–36 (for Reid). Unilever identified no disclosure in Bowser or Reid that established the molecular weight or charge density of the material identified as Jaguar® C15, but argued that the material inherently would have met the specified ranges. *Id.* We denied that first request for review because Unilever did not show sufficiently that the material identified as Jaguar® C15 necessarily possessed a molecular weight or charge density

that satisfies the limitations of the challenged claims. IPR2013-00510, Paper 9 at 7–9.

In the instant Petition, Unilever similarly argues that Cothran or Uchiyama teaches a cationic guar derivative that meets the specified molecular weight and charge density ranges. Pet. 15–16 (claim chart for Cothran); *id.* at 47 (claim chart for Uchiyama). Unilever relies on Cothran’s disclosure of a “cationic polymer,” which may include a cationic guar derivative, defined by molecular weight and charge density ranges that overlap the specified ranges. *Id.* at 15 (claim chart, citing Ex. 1044 at 36:15–20). In a separate anticipation ground, Unilever relies on Uchiyama for a disclosure of cationic polymers defined by broad molecular weight and charge density ranges that subsume or overlap the ranges specified in the challenged claims. *Id.* at 47 (claim chart, citing Ex. 1045 at 20:25–27, 30–32). In other words, as P&G points out, the instant Petition relies on Cothran and Uchiyama “for the disclosure of broad ranges of molecular weights and charge densities of cationic polymers.” Prelim. Resp. 7 (citing Pet. 15, 47).

We recognize that the prior art disclosures relied upon in the two petitions are not identical. Whereas the 510 Petition focused on a particular compound—specifically, Jaguar® C15—for a disclosure of a cationic guar derivative that satisfies the molecular weight and charge density limitations, the instant Petition focuses on a general disclosure of cationic polymers, which may include a cationic guar derivative, defined by molecular weight and charge density ranges that overlap or subsume the specified ranges. *Compare* IPR2013-00510, Paper 2 at 10, 14–15, 32, 35–36 *with* Pet. 15–16, 47.

Based on the information presented, however, we are persuaded by P&G's argument that both petitions apply the prior art references to support substantially the same argument: "Although Unilever now relies on different references, its argument remains the same: The Board should assume that the cited references meet the claimed cationic guar limitations, even though they provide no disclosure of particular materials that actually meet" the molecular weight and charge density limitations recited in the challenged claims. Prelim. Resp. 7–8. On this record, we determine that the anticipation grounds presented in the two petitions are based on "substantially the same" argument; namely, that the prior art identifies, with anticipatory specificity, a cationic guar derivative having a molecular weight and charge density that meet the specified ranges. 35 U.S.C. § 325(d).

B. Grounds Based on Obviousness

Similarly, for the grounds based on obviousness, both petitions are based on "substantially the same" argument that a person of ordinary skill in the art would have been led to select a cationic guar derivative, having the required molecular weight and charge density, for use in the inventive shampoo composition. *Id.* As explained above, the 510 Petition relied on the disclosure of a specific guar derivative—Jaguar® C15—for the requisite molecular weight and charge densities; whereas the instant Petition relies on a general disclosure of cationic polymers, which may include a cationic guar derivative, defined by molecular weight and charge density ranges that overlap or subsume the specified ranges.

Here again, we recognize that the prior art disclosures relied upon are somewhat different in the two petitions. The statute, however, states that a

petition may be rejected when “substantially the same prior art *or* arguments previously were presented to the Office.” 35 U.S.C. § 325 (d) (emphasis added). The statute expressly contemplates denial of review when the art applied in two petitions is different, but the arguments are “substantially the same.” *Id.* Although substantial similarity of argument, standing alone, is sufficient reason for a denial under § 325(d), several other circumstances, explained below, further influence our decision to decline review.

C. The Circumstances Favor Declining Review

We have considered the papers filed in this proceeding, as well as the papers filed in the request for *inter partes* review in IPR2013-00510. Based on the circumstances before us, we decline to institute review. 35 U.S.C. § 314(a) (institution is discretionary, not mandatory). We approach our discretion to decline review on a case-by-case basis. As explained above, one circumstance that supports our decision declining to institute review is that the instant Petition raises “substantially the same” arguments as the 510 Petition. 35 U.S.C. § 325(d).

The instant Petition also raises similar, if not “substantially the same,” prior art previously “presented to the Office.” *Id.* (denial may be appropriate when a challenge raises “substantially the same prior art” that “previously [was] presented to the Office”). On that point, P&G observes that Sime and the U.S. counterpart to Cothran are listed on the face of the ’155 patent; those references, therefore, “previously were presented to the Office.” *Id.*; Ex. 1001 at 1; *see* Prelim. Resp. 7. Both references significantly feature in the instant Petition. *See, e.g.*, Pet. ii (applying Cothran in seven of nine grounds); *see id.* at 27–32, 43–45 (discussing Sime at length). The instant

Petition also reasserts Evans, a reference highlighted in Unilever’s earlier, unsuccessful request for *inter partes* review. *See* Pet. 9, 11, 32–41, 43–45 (discussing Evans at length in this proceeding); *compare* IPR2014-00510, Paper 2 at 45–58 (devoting about thirteen pages to grounds based on Evans in the prior proceeding).

Additional factors support our decision declining to institute review. Unilever does not argue that the other references applied in the instant Petition—Cosmedia, Bar-Shalom, or Uchiyama—were unknown or unavailable at the time of filing the 510 Petition. That fact supports a reasonable inference that those references were known and available to Unilever when it requested review the first time. Prelim. Resp. 1, 7. On this record, the interests of fairness, economy, and efficiency support declining review—a result that discourages the filing of a first petition that holds back prior art for use in successive attacks, should the first petition be denied. *See id.* at 1 (the instant Petition “simply swap[s] in new references, all of which were available to Unilever” at the time of filing of the 510 Petition; Unilever should have “presented its ‘best case’ in the first petition”).

In that regard, P&G raises a legitimate concern that Unilever will continue to mount serial attacks against the ’155 patent claims, until a ground is advanced that results in the institution of review. *Id.* at 1–2 (arguing that Unilever, “[u]nsatisfied with the” first result, is “hoping for a different result” in this proceeding). On that point, we find relevant that the instant Petition raises multiple grounds against each challenged patent claim: Five against claims 2 and 3; four against claims 12–18; three against claims 1, 4–11, 19, and 20; and two against claims 21, 22, and 23. *See id.* at 16–19 (chart of grounds). That multi-pronged attack follows our rejection

of numerous grounds that were raised in the 510 Petition. *See* IPR2013-00510 (Paper 2) (asserting, for example, thirteen grounds of unpatentability against claims 1–5, 7, 9–11, 19, 20, and 22). P&G’s concern that it will “have to continually defend against repetitive [] challenges” to the same patent claims is not without merit, given the multiplicity of grounds applied in each petition. Prelim. Resp. 9.

On this record, we are persuaded that our resources are better spent addressing matters other than Unilever’s second attempt to raise a plurality of duplicative grounds against the same patent claims. *See Heckler v. Chaney*, 470 U.S. 821, 831 (1985) (when deciding whether to take action in a particular matter, an agency must determine whether its resources are best spent on one matter or another). Unilever provides no persuasive reason why we should institute *inter partes* review in light of the above facts. Based on the circumstances before us, therefore, we exercise our discretion and decline to institute review. 35 U.S.C. §§ 314(a), 325(d).

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims of the ’155 patent.

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