

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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**CONOPCO, INC. d/b/a UNILEVER**  
**Petitioner**

**v.**

**THE PROCTER & GAMBLE COMPANY**  
**Patent Owner**

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**Case IPR2014-00507**  
**Patent 6,451,300**

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**PATENT OWNER'S RESPONSE TO PETITIONER'S  
REQUEST FOR REHEARING BY AN EXPANDED PANEL**

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U.S. Patent and Trademark Office  
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Having lost in its latest attempt to initiate *inter partes* review of certain claims of U.S. Patent No. 6,451,300, Unilever now seeks rehearing by an expanded panel. The Board should deny Unilever's request because there is no authority for expanded panel review of an *inter partes* review decision under the America Invents Act ("AIA"). In any event, Unilever fails to raise any issue that merits review by an expanded panel. Finally, Unilever's fax to the Chief Administrative Patent Judge ("CAPJ") was an improper communication and should be disregarded.

## **I. ARGUMENT**

There is no basis for Unilever's request for an expanded panel. Although Unilever points to the February 12, 2009 Standard Operating Procedure 1 (Revision 13) ("SOP") of the Board of Patent Appeals and Interferences ("BPAI"), Unilever provides no legal authority to support its assertion that this five-year-old SOP applies to proceedings under the AIA. In the absence of any such authority, the Board must decline Unilever's improper request to extend the BPAI's expanded panel review provisions to rehearing of an IPR under the AIA.<sup>1</sup>

Unilever assumes, without support, that the 2009 SOP applies to IPRs, but

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<sup>1</sup> Unilever quotes 37 C.F.R. § 42.71(c), but that rule simply says "When rehearing a decision on petition, a panel will review the decision for an abuse of discretion." The rule says nothing about expanded panels.

Unilever is wrong. By its express terms, the SOP applies only to the BPAI. The BPAI adopted the SOP more than two years before President Obama signed the AIA into law, and the PTAB has taken no further administrative action or given any indication that the 2009 SOP applies to IPR proceedings. Further, the SOP expressly applies only to “the assignment of Administrative Patent Judges (judges) to merits panels, motions panels, and expanded panels in *appeals and interferences*.” (emphasis added). Without an SOP specifically authorizing expanded panel review of IPR decisions, this panel has no authority to grant Unilever’s request.

Even if this panel were to conclude that the 2009 SOP applies to IPRs, Unilever fails to show that an expanded panel is warranted. Unilever relies on only Section III(A)(2) of the SOP, which provides that a panel may be expanded to address “[c]onflicting decisions by different panels of the Board.” Request at 5. Unilever points to prior IPR decisions that allegedly provide what it calls “inconsistent analyses” under Section 325(d). *Id.* at 6-7. Unilever’s arguments fail.

Section 325(d) provides that in determining whether to institute a proceeding, the Board “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.” The provision is discretionary. It gives

the Board the authority not to institute review, but it does not require that result.

*See* IPR2013-00100, Paper 8 at 20.

In light of Section 325(d)'s discretionary standard, the decisions Unilever cites do not conflict with each other or with this panel's decision. IPRs 2013-00368 and 2013-00100 dealt with the application of Section 325(d) to prior art cited and/or arguments made during *ex parte* prosecution. Indeed, in IPR2013-00100, the panel distinguished the IPR proceeding from the *ex parte* prosecution proceeding, and noted that the petitioner presented different arguments that were not before the examiner. In IPR2013-00581, the panel rejected certain grounds of a second-filed petition because they presented "substantially the same prior art and arguments previously presented." Paper 15 at 21-22.

Here, the panel undertook the same discretionary review as did the panels in the proceedings Unilever cites, and based on the facts and evidence presented, this panel rejected the second petition because it presented "substantially the same" prior art and arguments. Decision at 6. Because every IPR proceeding will have unique facts, just because panels may reach different results in other proceedings does not mean that the decisions are conflicting. Nor are the decisions conflicting because some panels chose to address the merits of the grounds in the Institution Decision, while others only discussed Section 325(d), as Unilever argues. *See* Request at 6-8. Every case is different. Unilever's dissatisfaction with the

outcome in this proceeding is not a justification to declare it “conflicting” with other IPR proceedings in which the panels decided differently. Expanded panel review is not warranted.

Unilever further argues that “[t]his case presents an opportunity to set clear guidelines on what qualifies as the ‘same or substantially the same’ prior art and/or arguments, and the appropriate factors for a § 325(d) analysis.” Request at 5. This panel should decline such an invitation. A determination under Section 325(d) involves a close comparison of the particular prior art combinations and arguments of record in the two proceedings. Trying to create particular “guidelines” or “factors” to govern a Section 325(d) analysis makes little sense in light of the heavily fact-dependent nature of the inquiry.

Unilever also argues that rehearing by an expanded panel is warranted to address “whether and to what extent a proposed obviousness combination that relies on both a new and a previously-cited reference can serve as a basis for rejection under § 325(d)...” Request at 7. Even if this question was appropriate for consideration by an expanded panel, which P&G does not concede, this case is not the proper vehicle. Unilever mischaracterizes the panel’s decision in this case as a “summary dismissal,” arguing that the panel rejected the petition because it was based on a previously cited reference in view of other prior art, and the panel “declined to consider what the ‘other prior art’ taught.” Request at 7. Contrary to

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