

Patent Owner's Preliminary Response
IPR2015-00650

UNITED STATES PATENT & TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

OWENS CORNING,
Petitioner

v.

FAST FELT CORPORATION,
Patent Owner

Case IPR2015-00650
U.S. Patent No. 8,137,757

**PATENT OWNER PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107**

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Patent Owner Fast Felt Corporation provides this preliminary response to Petitioner Owens Corning's petition for *inter partes* review of Claims 1, 2, 4, 6, and 7 of U.S. Patent No. 8,137,757 ('757 patent) (Ex. 1001) in accordance with 37 C.F.R. § 2.107(a).

I. INTRODUCTION

The groundbreaking claimed methods of the '757 patent pertain to methods of making a roofing or building cover material. Advantageously, the claimed methods result in a high wind resistance rating such that the roofing or building cover materials are governmentally approved for use in hurricane prone counties of Florida. (Ex. 2001, Miami-Dade Notice of Acceptance). In fact, during the approval process third-party engineers reported consistently better performance of Patent Owner's products than what was considered the industry's toughest regulatory standard at the time. (*See e.g.*, Ex. 2002, Exterior Research & Design Lab Report). Because the product resulting from the claims is so beneficial Petitioner attempts to invalidate the instant claims. However, in its petition Petitioner covers the same obviousness grounds from the original PTO examination using a primary reference that expressly teaches away from both independent claims, adds inapposite and redundant secondary references, and alleges a reference somehow anticipates Claim 7 even though the reference does not even pertain to the claimed "roofing or building cover material".

Independent Claims 1 and 7 of the '757 patent are directed to methods of “making a roofing or building cover material” that require either (1) “depositing tab material ...from a lamination roll” (Claim 1) or (2) “first depositing nail tab material” and then “pressure adhering said nail tab material into nail tabs on said roofing or building cover material with a pressure roll.” (Claim 7). In contrast to the two independent claims of the '757 patent, the Petitioner's primary reference: Lassiter, which is employed in 3 of 4 alleged invalidity grounds of the petition, fundamentally teaches away from these claims. Specifically, Lassiter expressly requires deposition by spraying and teaches away¹ from any pressure or rollers because as Lassiter states:

“the rollers used tend to either melt the adhesive glue, melt the tab material itself, scrape off the tabs, or a combination of all three, any of which renders the resulting saturated felt material unreliable, if not unsuited, for commercial use.” (Ex. 1003, col., 2, lines 35-40).

Thus, the spray deposition from a nozzle system of Petitioner's primary reference of Lassiter expressly teaches away from the instant independent claims that require some roller, as well as pressure or pressure adhering. Lassiter's disclosure

¹ A prior art reference must be considered in its entirety, i.e. as a whole, including portions that would lead away from the claimed invention. *W. L. Gore & Assoc., Inc. v. Garlock, Inc.* 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984).

affirmatively criticizes, discredits, or otherwise discourages the solutions claimed by the '757 patent. (*In re Fulton*, 391 F.3d 1195, 1201, 73 USPQ2d 1141, 1146 (Fed. Cir. 2004)). The skilled artisan would therefore be led directly away from even looking to the secondary references suggested by Petitioner. This is especially true, given (a) the significant technological difficulties depositing or printing a polymer onto, for example, a heavily asphalt coated surface versus a clean surface of paper or fabric substrates of Petitioner's cited secondary references, and (b) Patent Owner's results of a stronger nail tab from the use of a pressure roll.

The secondary references suggested by Petitioner all relate to printing or deposition on paper or other related surfaces via rollers. Rollers and pressure are precisely what the primary reference of Lassiter says will be unreliable and unsuitable for depositing polymer on a roofing or building cover material. Moreover, the secondary references do not teach, suggest, or even mention depositing polymer on any roofing or building cover material and do not remotely suggest even the most common roofing cover material which is typically an asphalt coated surface. Petitioner attempts to justify its reliance on these references by illogically stating a number of times that paper is somehow a roofing or building cover material. Of course, as explained below this is not what the references state and it defies both logic and common sense that paper would be employed to cover

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