

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

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