

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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UNILEVER, INC. dba UNILEVER  
Petitioner

v.

THE PROCTER & GAMBLE COMPANY  
Patent Owner

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Case IPR2014-00506  
Patent 6,974,569 B2

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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 13, 14, 16, 20-22, 24, 25, 27, 31, and 33 of U.S. Patent No. 6,974,569 B2 (Ex. 1001, “the ’569 patent”). Paper 2 (“the Petition” or “Pet.”). The Procter & Gamble Company (“P&G”), the owner of the ’569 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 IPR2013-00505 (“the 505 proceeding”)*

Unilever filed an earlier Petition that sought an *inter partes* review of claims 1-33 of the ’569 patent. *Conopco, Inc. dba Unilever v. The Procter & Gamble Co.*, Case IPR2013-00505 (“IPR2013-00505”), Paper 4 (PTAB August 14, 2013) (“the 505 Petition” or “505 Pet.”). We granted review of claims 1-12, 15, 17-19, 23, 26, 28-30, and 32, and denied review of claims 13, 14, 16, 20-22, 24, 25, 27, 31, and 33. IPR2013-00505, Paper 9 (“505 Dec. on Inst.”). Unilever filed an unsuccessful Request for Rehearing, seeking reconsideration of our decision denying review of claims 20-22. IPR2013-00505, Paper 11 (Request for Rehearing).

Unilever then filed the instant Petition, challenging the patentability of each claim that was denied review in the 505 proceeding. Pet. 1. Unilever concurrently filed a Motion for Joinder requesting that we join the instant Petition with the 505 proceeding. Paper 4 (“Joinder Mot.”).

*B. The '569 Patent (Ex. 1001)*

The '569 patent relates to a shampoo composition and method for providing a combination of anti-dandruff efficacy and hair conditioning. Ex. 1001, 2:44-46; 2:66-3:1. The '569 patent Specification discloses that whether the requisite criteria of anti-dandruff efficacy and hair conditioning for a given composition are met depends on, “for example, the level and type of cationic polymer [for conditioning] employed in the composition, the type of anti-dandruff agent employed, the amount of anionic surfactant employed [for hair cleansing], the level and type of polyalkylene glycol employed, if any, and the rheological characteristics of the coacervate.” *Id.* at 2:36-43; *see id.* at 1:24-28; 1:56-58.

The shampoo composition of the '569 patent is defined further by four indices that correspond to four properties of a conditioning, anti-dandruff shampoo: (1) a bioavailability and coverage index, which corresponds to anti-dandruff efficacy; (2) a first conditioning index, which provides an indication of the comb-ability of wet hair; (3) a second conditioning index, which assesses clean hair feel; and (4) a minimal inhibitory concentration index, which measures the ability of the shampoo composition to inhibit growth of microorganisms. *Id.* at 2:25-35, 58-65. The '569 patent tabulates those indices for three of the five disclosed examples of the inventive shampoo composition. *Id.* at 43:15-44:41.

*C. Illustrative Claim*

Claim 13, which depends from claim 1, 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 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 polymer;
  - e) water;
  - f) from about 0.1% to about 10%, by weight of the composition, of a suspending agent;
- wherein said composition:
- i. has a bioavailability/coverage index value, of at least about 1.25;
  - ii. has a first conditioning index value, of less than or equal to about 1.0;
  - iii. has a second conditioning index value, of at least about 1.5; and
  - iv. has a minimal inhibitory concentration index value, of at least about 0.125.

13. A shampoo composition according to claim 1, wherein said anti-dandruff particulate is ketoconazole.

*D. The Asserted Grounds of Unpatentability*

Unilever challenges claims 13, 14, 16, 20-22, 24, 25, 27, 31, and 33 on the following asserted grounds of unpatentability:

<b>Reference[s]</b>	<b>Basis</b>	<b>Claims challenged</b>
Kanebo <sup>1</sup> and Kalla <sup>2</sup>	§ 103	16, 20-22
Kanebo, Kalla, Evans <sup>3</sup>	§ 103	27
Kanebo, Sime, <sup>4</sup> Hoshowski <sup>5</sup>	§ 103	20-22

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

<sup>2</sup> Kalla WO 97/026854 (July 31, 1997) (Ex. 1031).

<sup>3</sup> Evans WO 97/14405 (Apr. 24, 1997) (Ex. 1010).

<sup>4</sup> Sime US 5,037,818 (Aug. 6, 1991) (Ex. 1028).

<sup>5</sup> Hoshowski US 5,137,715 (Aug. 11, 1992) (Ex. 1021).

Reference[s]	Basis	Claims challenged
Kanebo, Sime, Cardin <sup>6</sup>	§ 103	14, 16
Kanebo, Cseh, <sup>7</sup> Cosmedia <sup>8</sup>	§ 103	20, 21
Kanebo, Cothran <sup>9</sup>	§ 103	24, 25
Kanebo, Ramachandran, <sup>10</sup> Hoeschele <sup>11</sup>	§ 103	13
Kanebo, Ramachandran, Bar- Shalom <sup>12</sup>	§ 103	31, 33
Reid <sup>13</sup> , Sime, Cardin	§ 103	20-22

## 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.

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<sup>6</sup> Cardin US 5,104,645 (Apr. 14, 1992) (Ex. 1014).

<sup>7</sup> Cseh US 4,676,978 (June 30, 1997) (Ex. 1042).

<sup>8</sup> Cosmedia® Guar C 260 (Product Data Sheet) (Ex. 1040).

<sup>9</sup> Cothran WO 96/32919 (Oct. 24, 1996) (Ex. 1044).

<sup>10</sup> Ramachandran US 5,900,393 (May 4, 1999) (Ex. 1033).

<sup>11</sup> Hoeschele, et. al., "In Vitro Analysis of the Interaction between Sucralfate and Ketoconazole," *Antimicrobial Agents and Chemotherapy*, Feb. 1994, pp. 319-325 (Ex. 1036).

<sup>12</sup> Bar-Shalom US 5,618,798 (Apr. 8, 1997) (Ex. 1034).

<sup>13</sup> Reid US 5,085,857 (Feb. 4, 1992) (Ex. 1018).

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.

The instant Petition challenges each claim that was denied review in the 505 proceeding. *Compare* 505 Pet. 6-7 with Pet. 9-10 (both raising obviousness challenges against claims 13, 14, 16, 20-22, 24, 25, 27, 31, and 33); *see* 505 Dec. on Inst. 18 (denying review of those claims). The instant Petition relies on thirteen pieces of prior art: six that were raised in the 505 Petition (Kanebo, Evans, Cardin, Reid, Sime, and Hoshowski); and seven that are new to this proceeding (Kalla, Cseh, Cosmedia, Cothran, Ramachandran, Hoeschele, and Bar-Shalom). *Compare* 505 Pet. 6-7 with Pet. 9-10; 505 Pet. 20-21 with Pet. 9 (for Hoshowski); *and* 505 Pet. 23 with Pet. 10 (for Sime). 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 505 Petition. Moreover, eight grounds rely on Kanebo, a reference previously presented in the 505 Petition. A ninth ground is based on Reid, Sime, and Cardin, references previously presented in the 505 Petition. *Compare* 505 Pet. 6-7 with Pet. 9-10. 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 505 proceeding.  
35 U.S.C. § 325(d).

An additional rationale supports our decision. We are persuaded that arguments raised in the Petition are “substantially the same” as those “previously [] presented to the Office” in the 505 proceeding. *Id.* Unilever’s treatment of claim 13 is illustrative. Claim 13 includes all the limitations of claim 1 and, further, requires ketoconazole as the anti-dandruff particulate.

In the 505 Petition, Unilever argued that Kanebo discloses each limitation of claim 13, except for the limitation requiring “ketoconazole,” arguing that Liu<sup>14</sup> discloses that missing feature. 505 Pet. 23-25. We denied review on the ground that Unilever provided only “conclusory arguments” supporting the proposed combination of prior art. 505 Dec. on Inst.16. Unilever now repeats the same arguments as to Kanebo but, in lieu of Liu, raises two pieces of new prior art (Ramachandran and Hoeschele) for a disclosure of ketoconazole, emphasizing alleged reasons to combine. Pet. 43-45. In both petitions, Unilever advances “substantially the same” argument—namely, that claim 13 would have been obvious over Kanebo in view of other prior art disclosing ketoconazole. 35 U.S.C. § 325(d).

Unilever similarly argued in the 505 Petition that claim 27 would have been obvious over Kanebo and Evans (505 Pet. 26-27), but we found lacking any persuasive evidence of a reason to combine those references. 505 Dec. on Inst. 16. Unilever now contends that claim 27 would have been obvious over Kanebo, Evans, and Kalla. Pet. 25-28. Unilever relies on Kalla in support of its reason to combine (*see* Pet. 27, first full paragraph), but the claim charts essentially are identical in both petitions. *Compare* 505 Pet. 26-27 *with* Pet. 26 (nowhere referring to Kalla in the claim chart relating to claim 27).

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<sup>14</sup> Liu US 5,456,851 (Oct. 10, 1995).

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 Decision on Institution to bolster challenges that were advanced, unsuccessfully, in the 505 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 505 proceeding, “[a]rmed with the Board’s guidance as to the flaws in the [505 Petition].” Prelim. Resp. 9. 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 505 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 ’569 patent;

FURTHER ORDERED that Unilever’s Motion for Joinder with IPR2013-00505 is denied as moot.

Case IPR2014-00506  
Patent 6,974,569 B2

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