

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JOHNS MANVILLE CORPORATION and JOHNS MANVILLE, INC.,
Petitioners,

v.

KNAUF INSULATION, INC. and KNAUF INSULATION SPRL,
Patent Owners.

Case IPR2016-00130
Patent D631,670 S

Before SCOTT A. DANIELS, KRISTINA M. KALAN, and
JAMES A. WORTH, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioners, Johns Manville Corporation and Johns Manville, Inc. (“Johns Manville”) filed a Petition to institute an *inter partes* review of the sole claim of U.S. Patent No. D631,670 S (Ex. 1001, “the ’670 patent”). Paper 1 (“Pet.”). We instituted trial for the sole claim of the ’670 patent on certain grounds of unpatentability alleged in the Petition. Paper 7 (“Decision to Institute” or “Inst. Dec.”).

After institution of trial, Patent Owner Knauf Insulation, Inc. (the assignee of record) and Knauf Insulation SPRL (collectively, “Knauf”), responded to Johns Manville’s challenges including filing a Patent Owner Response, along with declarations by Knauf’s Declarants, James Worden (Ex. 2008), Professor Karen B. Schloss (Ex. 2010), Professor Lance Rake (Ex. 2012) and Greg Freemyer (Ex. 2013). Paper 14 (“PO Resp.”). Johns Manville timely filed a Reply. Paper 18 (“Reply”).

A hearing for IPR2016-00130 was held on February 2, 2017. We have jurisdiction under 35 U.S.C. § 6. This final written decision is issued pursuant to 35 U.S.C. § 318(a).

Based on the complete record now before us, we determine that Johns Manville has not shown by a preponderance of the evidence that the sole claim of the ’670 patent is unpatentable.

A. *Additional Proceedings*

In addition to this Petition, Johns Manville indicates that the ’670 patent has been asserted against them by Knauf in the U.S. District Court for the Southern District of Indiana, in *Knauf Insulation, LLC v. Johns Manville Corp.*, 1:15-cv-00111-WTL-MJD. Pet. 1–2. The ’670 patent was also challenged by Johns Manville in IPR2015-01453. In that proceeding, on

January 11, 2017, the Board entered a final written decision upholding the patentability of the sole claim. On March 10, 2017, Johns Manville filed a Notice of Appeal of the Board's decision in that proceeding under 35 U.S.C. § 141(c) to the United States Court of Appeals for the Federal Circuit.

B. The '670 Patent

The '670 patent (Ex. 1001), titled "Insulation Material," relates to a design for mineral fiber insulation, for example, glass mineral wool insulation, used in commercial and residential construction applications. Ex. 1001, 1. The sole drawing illustrating "[t]he ornamental design for insulation material," as recited in the '670 patent claim is reproduced below, as a black and white photocopy reproduction on the left, and as a color image on the right. Exs. 1001, 3001.¹



This figure, on the left, is the claimed design as it appears on the front page of the '670 patent as a photocopy of the color photograph



This figure, on the right, is an image of the actual color photograph depicting the claimed design, as filed during prosecution of the '670 patent.² Ex.

¹ For efficiency in the record of this proceeding, we enter certain documents from the prosecution history of the '670 patent as Exhibits 3001 et seq.

² The color photograph was accepted by the Examiner pursuant to a Petition under 37 C.F.R. 1.84(a)(2). See Ex. 1002, 10–11 (Notice of Allowance,

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filed during prosecution. Ex. 1001, 1002 (Reply to Off. Act. Aug. 6, 2010,
1. 4).

C. The Instituted Grounds of Unpatentability

We instituted a trial on the following specific grounds:

Reference	Basis
JM 1997 Brochure and either Soundproofing or OC 2006 Report.	§ 103
JM 2000 Brochure and either Soundproofing or OC 2006 Report.	§ 103
JM 1997 Brochure.	§ 102
JM 2000 Brochure.	§ 102

Johns Manville supports its challenges with the Declarations of Mr. Martin J. Bide (Ex. 1013) (“Bide Declaration”), Mr. Mark A. Granger (Ex. 1015) (“Granger Declaration”), Ms. Teresa K. O’Brien (Ex. 1016) (“O’Brien Declaration”), Mr. Joe Mota (Ex. 1017) (“Mota Declaration”), Ms. Anne N. Barker (Ex. 1018) (“Barker Declaration”), and Mr. Michael Fay (Ex. 1019) (“Fay Declaration”). Pet. 19, 29, 33, 35 and Appendix – List of Exhibits.

II. MOTION TO TERMINATE UNDER SECTION 315(e)(1)

Based on the Board’s authorization, Knauf filed a Motion to Terminate (Paper 30, “Mot. to Terminate”) this proceeding, arguing that because a final written decision was entered in IPR2015-01453, Johns

mailed Dec. 10, 2010, 1–2). The color photograph is part of the prosecution history of the ’670 patent and may be accessed via the USPTO’s Patent Application Information Retrieval (PAIR) system. *See* Ex. 1001, Description.

Manville is estopped from maintaining this proceeding. Mot. to Terminate, 1; 35 U.S.C. § 315(e)(1). Knauf’s contention is that the current grounds each rely on either Exhibit 1004 (JM 1997 Brochure) or Exhibit 1005 (JM 2000 Brochure), documents Johns Manville “reasonably could have raised” in the previous proceeding. *Id.* Johns Manville filed an Opposition to Patent Owner’s Motion to Terminate (Paper 31, “Opp. Mot. to Terminate”). Johns Manville disputes that Exhibits 1004 and 1005 are documents that a skilled researcher reasonably could have been expected to discover prior to filing its first petition in IPR2015-01453. Opp. Mot. to Terminate, 2.

A. Patent Owner’s Argument

In their Motion to Terminate, Knauf asserts specifically that “JM ‘reasonably could have raised’ these grounds in its original petition in IPR2015-01453” because Exhibits 1004 and 1005 were in Johns Manville’s possession, and also notes that Johns Manville did not request joinder of this proceeding with IPR2015-01453. Mot. to Terminate, 1–2.

Knauf argues initially that Johns Manville “did have knowledge of Exhibits 1004 and 1005 at the time of filing IPR2015-01453 because its employee, Mr. Joe Mota, possessed that knowledge as a result of his work for JM.” *Id.* at 2–3 (citing *Kellogg Brown & Root Servs., Inc. v. U.S.*, 728 F.3d 1348, 1369 (Fed. Cir. 2013)). Knauf insists, therefore, that section 315 (e)(1) estoppel extends “to the references of which a petitioner *reasonably should have known.*” *Id.* at 3. Knauf argues that because Mr. Mota, and hence Johns Manville, had these exhibits in their possession, Johns Manville and Mr. Mota had knowledge of these advertising brochures and that “[a]ny reasonably diligent search by JM would have uncovered Exhibits 1004 and 1005 prior to the filing IPR2015-01453 on June 19,

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