UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KAZ USA, INC.,
Petitioner

v.

BRITA LP,
Patent Owner

CASE IPR2016-01893

U.S. Patent No. 8,167,141

PATENT OWNER'S PRELIMINARY RESPONSE UNDER 37 C.F.R. § 42.107(a)

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Patent Owner Brita LP provides this preliminary response to Petitioner KAZ USA, Inc.'s Petition for *inter partes* review of U.S. Patent No. 8,167,141 ("the '141 patent"; EX1001) in accordance with 37 C.F.R. § 42.107(a).

I. Introduction

The Board should deny institution because the Petition falls far short of establishing a reasonable likelihood of prevailing with respect to any challenged claim. The challenged claims are generally directed to a gravity-fed water filter comprising at least activated carbon and a lead scavenger, wherein the filter achieves certain performance metrics. (EX1001, 34:6-26.) The patent arises from discoveries made by Brita LP, a company known for its innovative household water filter products.

Brita discovered and developed a new class of gravity-fed water filters that improve water safety by enhancing lead removal from drinking water while at the same time achieving flow rates suitable for a home water filtration system. Prior art water filters did not achieve these objectives because they often did not maintain their lead extraction properties over the expected life of the water filter and/or they failed to achieve the flow rates suitable for a gravity-fed water filter. (EX1001, 3:51 – 5:14.) The claimed gravity-fed water filters are an advancement over the art as measured by their ability to achieve the specified Filter Rate and Performance ("FRAP") factor, which takes into consideration the volume of the

filter media (V), the average flow rate over the filter's lifetime (f), and the concentration of lead present in effluent at the end of the filter's lifetime (c_e).

The Petition raises eight grounds for challenging various claims of the '141 patent. Four of these grounds (Grounds 1, 5-8) rely on either Knipmeyer (EX1009) or Rinker (EX1004), the very applications to which the '141 patent claims priority. Because a priority application by definition is not prior art to a patent claiming the benefit of the earlier application, Petitioner first seeks to sever the priority chain by asserting that the '141 patent's priority applications lack written description support for the "FRAP factor or its very specific formulaic relationship between the variables contained therein." (Paper 1 at 19.) However, Petitioner also alleges that the FRAP factor "is merely a performance factor that accounts for various properties and/or characteristics of a tested water filter." (*Id.*) It then contradicts its own assertions by arguing that the same priority applications *inherently* disclose and *anticipate* gravity-fed filters having the claimed FRAP factor. (*Id.* at 23-29, 58-59.) Petitioner cannot have it both ways. It cannot argue that the inventors lacked possession of the claimed filters on the one hand, while arguing on the other hand that the inventors' disclosure of their filters in the priority documents are sufficient to anticipate.

If Knipmeyer and Rinker contain an inherent disclosure of gravity-fed water filters with the properties characterized by the claimed FRAP factor as Petitioner

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