

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CASCADES CANADA ULC and
TARZANA ENTERPRISES, LLC,
Petitioner,

v.

ESSITY HYGIENE AND HEALTH AB,
Patent Owner.

Case IPR2017-01902
Patent 8,597,761 B2

Before JO-ANNE M. KOKOSKI, KRISTINA M. KALAN, and
JON B. TORNQUIST, *Administrative Patent Judges*.

KOKOSKI, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Withdrawing Grounds in the Petition
37 C.F.R. § 42.5

The Petition in this proceeding challenges claims 1–26 of U.S. Patent No. 8,597,761 B2 on five grounds: (1) anticipation of claims 1–3, 6, 10–18, and 21, and 23 based on Hochtritt¹ (“Ground 1”); (2) anticipation of claims 1–3, 8, 9, 12, 13, and 23 based on Grosriez² (“Ground 2”) (3) anticipation of claims 1–3, 8, 9, 12–14, and 23 based on Pigneul³ (“Ground 3”); obviousness of claims 1–26 based on Hochtritt (“Ground 4”); and (5) obviousness of claims 1–26 based on the combined teachings of Hochtritt and Grosriez (“Ground 5”). Paper 3, 8. In our institution decision, we ordered review of all challenged claims, but limited the proceeding to Grounds 1, 2, 4 (claims 1–3, 6–23, and 26), and 5. Paper 10, 32. On April 27, 2018, we modified our institution decision to include review of “all challenged claims and all of the grounds presented in the Petition.” Paper 18, 2.

On May 10, 2018, without Board authorization, the parties filed a Notice of Stipulation to Withdraw Certain Grounds. Paper 19. Specifically, the parties stipulated to withdraw newly-instituted Ground 3 and Ground 4 (with respect to claims 4, 5, 24, and 25 only). *Id.* at 2. The parties further agreed “that these grounds were ‘raised’ for purposes of 35 U.S.C. § 315(e).” *Id.*

As set forth in 37 C.F.R. §§ 42.20(a) and (b), “[r]elief, other than a petition requesting the institution of trial, must be requested in the form of a motion,” and “[a] motion will not be entered without Board authorization.” The parties, therefore, should have sought authorization to file a joint request to remove the newly-instituted grounds from this proceeding. Our rules recognize, however, that there are instances when failure to comply with the regulations may be mitigated.

¹ U.S. Patent App. Pub. No. 2005/0058807 A1, published March 17, 2005 (Ex. 1015).

² U.S. 6,602,575 B2, issued Aug. 5, 2003 (Ex. 1021).

³ European Patent App. Pub. No. 0 286 538 B1, published Oct. 12, 1998 (Exs. 1013, 1023 (English translation)).

See, e.g., 37 C.F.R. §§ 42.5(a) (“The Board may determine a proper course of conduct in a proceeding for any situation not specifically covered by this part and may enter non-final orders to administer the proceeding.”); 42.5(b) (“The Board may waive or suspend a requirement of parts 1, 41, and 42 and may place conditions on the waiver or suspension.”). Under the circumstances, where the parties have come to an agreement and jointly indicated so in writing, we waive the prior authorization requirement in this instance. Removing grounds from a dispute, pursuant to a joint request of the parties, serves our overarching goal of resolving this proceeding in a just, speedy, and inexpensive manner. 37 C.F.R. § 42.1(b).

Accordingly, it is

ORDERED that, pursuant to the parties’ agreement set forth in Paper 19, Ground 3 and Ground 4 (with respect to claims 4, 5, 24, and 25 only), which were newly-instituted in Paper 18, are withdrawn from this proceeding; and

FURTHER ORDERED that the Petition is limited to Grounds 1, 2, 4 (claims 1–3, 6–23, and 26), and 5.

IPR2017-01902
Patent 8,597,761 B2

PETITIONER:

Rudolph A. Telscher, Jr.
Daisy Manning
HUSCH BLACKWELL LLP
Ptab-rtelscher@huschblackwell.com
Ptab-dmanning@huschblackwell.com

PATENT OWNER:

David A. Mancino
William F. Smith
Kevin Flynn
BAKER & HOSTETLER LLP
dmancino@bakerlaw.com
wsmith@bakerlaw.com
kflynn@bakerlaw.com