

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JOHNS MANVILLE CORPORATION AND JOHNS MANVILLE, INC.,
Petitioner,

v.

KNAUF INSULATION, INC. AND KNAUF INSULATION SPRL,
Patent Owner.

Case IPR2018-00863
Patent 9,464,207 B2

Before JAMES T. MOORE, KRISTINA M. KALAN, and
ELIZABETH M. ROESEL, *Administrative Patent Judges*.

ROESEL, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. §§ 314(a)

Johns Manville Corporation and Johns Manville, Inc. (collectively, “Johns Manville” or “Petitioner”) filed a Petition (Paper 2, “Pet.”) seeking *inter partes* review of claims 1–3, 5, 6, 8–10, 12, 14, 16, 17, 19–23, 30–32, 44–54, 56–61, and 66–71 (the “challenged claims”) of U.S. Patent No. 9,464,207 B2 (Ex. 1001, “the ’207 patent”). Knauf Insulation, Inc. and Knauf Insulation SPRL (collectively, “Knauf” or “Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314; 37 C.F.R. § 42.4(a). An *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Applying this standard, and upon consideration of the information presented in the Petition and the Preliminary Response, we determine Petitioner has not established a reasonable likelihood that it would prevail with respect to at least one of the claims challenged in the Petition. Therefore, institution of an *inter partes* review is denied.

I. BACKGROUND

A. *Related Matters*

The parties identify the following civil action as involving the ’207 patent: *Knauf Insulation, Inc. v. Johns Manville Corp.*, No. 1:15-cv-00111-WTL-MJD (S.D. Ind., filed Jan. 27, 2015). Pet. 1; Paper 7, 2. The ’207 patent was issued October 16, 2016, and was asserted by Patent Owner subsequent to the filing date of the civil action. Ex. 1001, at (45); Prelim. Resp. 2–3. Patent Owner does not assert a time bar under 35 U.S.C. § 315(b).

The following administrative and judicial matters involve patents that are either related to the '207 patent and/or are identified by Petitioner (Pet. 1–2) as sharing subject matter with the '207 patent:

U.S. Patent No. 7,888,445 (“the '445 patent”)¹

Reexamination Control No. 90/013,029; PTAB Appeal No. 2016-006341; Federal Circuit Appeal Nos. 2017-1317, 2017-1323, 2017-1324;

Reexamination Control No. 95/000,672; PTAB Appeal Nos. 2015-001313 and 2017-004826; Federal Circuit Appeal No. 2018-1810;

U.S. Patent No. 7,772,347 (“the '347 patent”)²

Reexamination Control 90/013,030; PTAB Appeal No. 2016-006368; Federal Circuit Appeal Nos. 2017-1317, 2017-1323, 2017-1324;

Reexamination Control No. 95/000,675; PTAB Appeal Nos. 2015-001256 and 2017-004910; Federal Circuit Appeal No. 2018-1811;

¹ The '207 patent asserts the benefit of an earlier-filed grandparent application that issued as the '445 patent.

² The '207 patent and the '347 patent both assert the benefit of an earlier-filed application that issued as the '445 patent.

IPR2018-00863
Patent 9,464,207 B2

U.S. Patent No. 7,854,980

Reexamination Control No. 90/013,156; PTAB Appeal
No. 2016-006369; Federal Circuit Appeal Nos. 2017-1317, 2017-
1323, 2017-1324; and

Reexamination Control No. 95/000,674; PTAB Appeal
No. 2015-001824; Federal Circuit Appeal No. 2016-1184;

U.S. Patent No. 7,807,771 (“the ’771 patent”)³

Reexamination Control No. 95/000,673.

The following *inter partes* review proceedings and appeal involve
Johns Manville as Petitioner and Knauf as Patent Owner:

Case IPR2015-01402, involving U.S. Patent No. 8,114,210 B2
 (“the ’210 patent”);⁴ Federal Circuit Appeal No. 2017-1433;

Case IPR2015-01453, involving U.S. Patent No. D631,670 S;

Case IPR2016-00130, involving U.S. Patent No. D631,670 S;

Case IPR2015-01527, involving U.S. Patent No. 8,940,089 B2;

Case IPR2015-01569, involving U.S. Patent No. 8,940,089 B2;

Case IPR2015-01598, involving U.S. Patent No. 8,940,089 B2;

Case IPR2015-01633, involving U.S. Patent No. 9,039,827 B2;

Case IPR2015-01673, involving U.S. Patent No. 9,039,827 B2;

Case IPR2015-01683, involving U.S. Patent No. 9,039,827 B2;

Case IPR2018-00805, involving U.S. Patent No. 9,469,747 B2;

³ The ’207 patent and the ’771 patent both assert the benefit of an earlier-
filed application that issued as the ’445 patent.

⁴ Petitioner contends that the ’207 patent shares subject matter with the ’210
patent. Pet. 2. U.S. Patent Nos. 8,940,089, 9,039,827, and 9,469,747 are
related to the ’210 patent.

Case IPR2018-00827, involving U.S. Patent No. 9,828,287 B2; and
Case IPR2018-00879, involving U.S. Patent No. 9,926,464 B2 (“the
'464 patent”).⁵

B. Petitioner’s Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability under
35 U.S.C. § 103(a):

Claims 1–3, 5, 6, 8–10, 12, 14, 16, 17, 19–23, 30–32, 44–54, 56–61,
and 66–71 as obvious in view of Strauss,⁶ Tutin,⁷ and Worthington;⁸ and

Claims 1, 3, 5, 6, 12, 14, 16, 17, 19–21, 30–32, 44–52, 54, 56–61,
66–77, and 69–71 as obvious in view of Strauss, Tutin, and Gogek.⁹ Pet. 6.

Petitioner supports its challenges with a Declaration of Dr. Frederick
J. Hirsekorn. Ex. 1008.

C. The ’207 Patent (Ex. 1001)

The ’207 Patent relates to fiberglass insulation made using binders,
and more particularly, to methods of manufacturing insulation products
using binders. Ex. 1001, 3:63–66, 4:24–32, 47:50–48:26 (claim 1). The
claimed method involves manufacturing a fiberglass insulation product
having a specified concentration of glass fibers by spraying an aqueous
binder solution onto a mat of glass fibers such that the residual heat from the

⁵ The ’464 patent issued on a continuation of the application that issued as
the ’207 patent.

⁶ US 5,318,990, issued June 7, 1994, Ex. 1003.

⁷ US 2004/0038017 A1, published February 26, 2004, Ex. 1004.

⁸ US 3,513,001, issued May 19, 1970, Ex. 1005.

⁹ US 2,965,504, issued December 20, 1960, Ex. 1006.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.