

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 IPR2018-00879
Patent 9,926,464 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 1, “Pet.”) seeking *inter partes* review of claims 1–3, 5–7, 9–13, 16–18, and 29–41 (the “challenged claims”) of U.S. Patent No. 9,926,464 B2 (Ex. 1001, “the ’464 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 ’464 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 4, 2. The ’464 patent was issued March 27, 2018, 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 '464 patent and/or are identified by Petitioner (Pet. 1–2) as sharing subject matter with the '464 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 '464 patent asserts the benefit of an earlier-filed great-grandparent application that issued as the '445 patent.

² The '464 patent and the '347 patent both assert the benefit of an earlier-filed application that issued as the '445 patent.

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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 ’464 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 ’464 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 IPR2018-00863, involving U.S. Patent No. 9,464,207 B2 (“the
'207 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, 5–7, 9–13, 16–18, and 29–41 as obvious in view of
Strauss,⁶ Tutin,⁷ and Worthington;⁸ and

Claims 1, 3, 6, 7, 9–13, 16–18, 29–38, and 40–41 as obvious in view
of Strauss, Tutin, and Gogek.⁹ Pet. 6–7.

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

C. The ’464 Patent (Ex. 1001)

The ’464 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 an application that issued as
the ’207 patent. Ex. 1001, at (63).

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.

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