Trials@uspto.gov
571-272-7822

Paper: 108
Entered: January 23, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

L'ORÉAL USA, INC.,
Petitioner,

v.

LIQWD, INC.,
Patent Owner.

PGR2017-00012
Patent 9,498,419 B2

Before CHRISTOPHER M. KAISER, MICHELLE N. ANKENBRAND, and DAVID COTTA, *Administrative Patent Judges.*

KAISER, *Administrative Patent Judge.*

ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5

In our Final Written Decision, we concluded that claims 1–8 and 10 of the '419 patent would have been obvious. Paper 102, 48–49. After we issued that decision, Patent Owner appealed to the United States Court of Appeals for the Federal Circuit. Paper 103. The Federal Circuit vacated our obviousness determination and remanded the case with instructions to "consider [the finding that Petitioner copied Patent Owner's confidential information] and weigh it appropriately in [our] obviousness analysis." *Liqwd, Inc. v. L'Oreal USA, Inc.*, 941 F.3d 1133, 1139 (Fed. Cir. 2019).

After the Federal Circuit issued its mandate, we held a conference call with the parties to discuss procedures for resolving the issues arising from the remand of this case. During the conference call, both parties agreed that there is no need to introduce new evidence or for the Board to hold a new hearing.

The parties disagreed, however, as to whether we should allow additional briefing and, if so, how long the briefs should be and when and in what order they should be filed. Petitioner proposed a single round of briefing, with the parties filing simultaneous briefs of no more than eight pages each, directed to the issue of the appropriate weight we should give the finding of copying in our analysis of whether the subject matter of the challenged claims would have been obvious over the prior art. Patent Owner argued instead that no briefing was necessary. Should we decide to allow briefing, Patent Owner argued that the briefs should be limited to two pages. Because Patent Owner was concerned that Petitioner might raise inappropriate issues in its brief, Patent Owner proposed having Petitioner file its brief first, with Patent Owner having the opportunity to respond.

The question the Federal Circuit's opinion poses—whether the challenged claims would have been obvious when weighing the evidence supporting obviousness and the finding that legally relevant copying occurred—is not one that we feel permits easy resolution in the abstract. Accordingly, the question would benefit from some briefing from both parties directed to how to weigh the evidence in a case like this one, where some evidence supports a conclusion of obviousness and other evidence opposes such a conclusion. For this reason, we will authorize the parties to file remand briefs in this case.

We adopt Petitioner's suggestion to authorize both parties to file briefs of up to eight pages, with the briefs to be filed simultaneously. The briefs will be due no later than February 13, 2020. The panel would appreciate any guidance the parties may be able to offer regarding how to weigh the divergent evidence on the obviousness issue.

We also adopt Patent Owner's suggestion to authorize response briefs addressing any issue raised in the opposing party's opening briefs. The response briefs will be due no later than February 27, 2020, and they may not exceed five pages each.

In consideration of the foregoing, it is hereby:

ORDERED that each party may file an opening remand brief not exceeding eight pages no later than February 13, 2020, with the brief to address at least how to weigh the divergent evidence on the obviousness issue; and

FURTHER ORDERED that each party may file a responsive remand brief not exceeding five pages no later than February 27, 2020, with the brief limited to addressing any issues raised in the opposing party's opening brief.

PETITIONERS:

Michelle E. O'Brien
Timothy J. Murphy
THE MARBURY LAW GROUP, PLLC
mobrien@marburylaw.com
tjmurphy@marburylaw.com

PATENT OWNER:

Matthew K. Blackburn
DIAMOND MCCARTHY LLP
mblackburn@diamondmccarthy.com

Rivka Monheit
PABST PATENT GROUP LLP
rivka@pabstpatent.com