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Paper 120
Date: December 9, 2020

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

L'ORÉAL USA, INC.,
Petitioner,

v.

OLAPLEX, INC.,[1]
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*.

JUDGMENT
Final Written Decision on Remand
Determining All Challenged Claims Unpatentable
35 U.S.C. §§ 144, 328(a)

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[1] Previously, the Patent Owner was identified as Liqwd, Inc. *See, e.g.*, Paper 4, 1. The challenged patent is now owned by Olaplex, Inc. Paper 109, 1.

INTRODUCTION

A. Background

L'Oréal USA, Inc. ("Petitioner") filed a Petition requesting post-grant review of claims 1–8 and 10 of U.S. Patent No. 9,498,419 B2 (Ex. 1001, "the '419 patent"). Paper 2 ("Pet."). Liqwd, Inc. ("Patent Owner") filed a Preliminary Response. Paper 7 ("Prelim. Resp."). We instituted trial on two of the grounds asserted in the Petition. Paper 17 ("Inst. Dec."). After the Supreme Court's decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018), we also instituted on the remaining ground presented in the Petition. Paper 97.

After we instituted trial, Patent Owner filed a Response (Paper 44, "PO Resp."), and Petitioner filed a Reply (Paper 55). Patent Owner filed Observations on Cross-Examination of Petitioner's Reply Witnesses. Paper 77 ("PO Obs."). Patent Owner filed a Supplemental Response addressing the ground added to the trial after *SAS*, and Petitioner filed a Supplemental Reply. Paper 100 ("Supp. Resp."); Paper 101 ("Supp. Reply"). In addition, both parties filed Motions to Exclude Evidence. Paper 72 ("PO Mot."); Paper 73 ("Pet. Mot."). On the request of both parties, we held an oral hearing, and the transcript of that hearing is in the record. Paper 98.

After considering the arguments of both parties and the evidence of record, we concluded that each of claims 1–8 and 10 of the '419 patent was unpatentable, and we issued a Final Written Decision explaining those conclusions. Paper 102 ("Dec."). Patent Owner appealed, and the U.S. Court of Appeals for the Federal Circuit vacated our decision and remanded

the proceeding to us with instructions. *Liqwd, Inc. v. L'Oreal USA, Inc.*, 941 F.3d 1133, 1133–39 (Fed. Cir. 2019).

On remand, each party submitted an opening brief setting forth the issues for us to decide and its arguments on those issues. Paper 111 ("PO Remand Br."); Paper 112 ("Pet. Remand Br."). Each party then filed a response to the other party's remand brief. Paper 113 ("PO Remand Reply"); Paper 114 ("Pet. Remand Reply").

We have jurisdiction under 35 U.S.C. § 6, and we issue this Final Written Decision on Remand pursuant to 35 U.S.C. §§ 144 and 328(a). For the reasons discussed below, we conclude that Petitioner has established by a preponderance of the evidence that each of claims 1–8 and 10 of the '419 patent is unpatentable.

B. The Issues on Remand

In our original Final Written Decision, we found that Ogawa[2] did not anticipate claims 1–6, 8, and 10 of the '419 patent. Dec. 11. We also concluded that claims 1–8 and 10 would have been obvious over the combination of Ogawa, Berkemer,[3] and KR '564.[4] *Id.* at 32. Finally, we

[2] Ogawa et al., U.S. Patent No. 7,044,986 B2, issued May 16, 2006 (Ex. 1002, "Ogawa").

[3] Berkemer, German Patent Application Publication No. 1,220,969, published July 14, 1966 (Ex. 1003) (certified translation provided as Ex. 1004, "Berkemer").

[4] Korean Patent Application Publication No. 10-2006-0059564, published 2006 (Ex. 1006) (certified partial translation provided as Ex. 1018, "KR '564").

concluded that claims 1–8 and 10 would have been obvious over the combination of Kitabata,[5] Berkemer, and KR '564. *Id.* at 40. On appeal, Patent Owner argued that we erred in our original Final Written Decision in holding that its evidence of copying was not relevant as evidence of nonobviousness on the basis that Patent Owner had not shown that Petitioner copied a specific patented product. *See, e.g.*, Dec. 31 (relying on *Iron Grip Barbell Co., Inc. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004)). The Federal Circuit affirmed our finding that "L'Oréal copied Liqwd's patented method of using maleic acid." *Liqwd*, 941 F.3d at 1139. But the Court held that we erred by holding this copying immaterial absent evidence that Petitioner had coped a specific patented product. *Id.* at 1136–38. Because of this error, the Federal Circuit vacated our "obviousness determination[s]" and remanded the case with instructions to "consider th[e] finding [of copying] and weigh it appropriately in [our] obviousness analysis." *Id.* at 1139. The Federal Circuit otherwise agreed with our findings and conclusions. *Id.* ("we agree with the other appealed aspects of the Board's final written decision"). We have considered and weighed the evidence of copying. And, having considered our obviousness determinations and conclusions anew in light of the copying evidence, as explained below, we conclude that, based on a preponderance of the evidence of record, the claims are unpatentable based on the obviousness grounds advanced in the Petition. Except to the extent that they are further

[5] Kitabata et al., US 2002/0189034 A1, published Dec. 19, 2002 (Ex. 1005, "Kitabata").

explained below or contradicted by any statement herein, we maintain the analysis, findings, and conclusions reached in the earlier Final Written Decision, which we incorporate by reference. *See* Paper 102.

C. The '419 Patent

The '419 patent "generally relates to formulations and methods for treating keratin in hair, skin, or nails, and in particular for strengthening and/or repairing hair during or after a coloring or permanent wave treatment." Ex. 1001, 1:16–19. Certain treatments of hair, including dyeing and bleaching, can result in the disulfide bonds of the hair's keratin being broken, and the '419 patent expresses "a need for hair formulations and treatments that repair and/or strengthen keratin in hair damaged [by these treatments]." *Id.* at 1:31–2:44. The '419 patent "provide[s] improved formulations and methods for repairing and/or strengthening damaged hair." *Id.* at 2:49–51. The formulations of the '419 patent "may be applied simultaneously with the hair coloring formulation or subsequently to the application of the hair coloring formulation." *Id.* at 17:32–34. These formulations are described as containing "an active agent" that may be any of a large number of compounds, including maleic acid or salts thereof. *Id.* at 7:42–11:18.

D. Illustrative Claim

Of the challenged claims of the '419 patent, claim 1 is independent and illustrative. It recites:

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