

PTAB Denies Institution of IPR Petition in Victory for Rothwell Figg Client AmorePacific

The Patent Trial and Appeal Board (“PTAB”) denied institution of an IPR petition filed by Cosmax Co. in a victory for the patent owner, AmorePacific, who was represented by Rothwell Figg.

The petition for IPR challenged all claims of U.S. Patent No. 8,784,854, an AmorePacific patent directed to a stable UV-blocking cosmetic composition impregnated into an expanded urethane foam. The result is AmorePacific’s “cushion foundation” product, which combines the favorable properties of a liquid cosmetic with the portability and convenience of a compact foundation. The IPR is IPR2018-01516.

On behalf of AmorePacific, Rothwell Figg opposed the petition for IPR on the basis that (1) the petition failed to establish any motivation to combine the prior art references or any reasonable expectation of success in doing so, and (2) the arguments in the petition were substantially the same as those previously considered and rejected by the Patent Office during prosecution. The PTAB denied institution under 35 U.S.C. § 325(d), agreeing with AmorePacific that the petition relied on substantially the same arguments considered during prosecution and failed to demonstrate any errors during prosecution to justify reconsideration. The PTAB noted it was “troubled by” discrepancies in petitioner’s expert opinion challenging a declaration submitted during prosecution, and declined to give any weight to that aspect of petitioner’s expert testimony. Although the petition relied on certain references not cited by the examiner during prosecution, the PTAB found that none of the additional information or arguments presented by petitioner was sufficient to warrant reconsideration of the Examiner’s previous finding of patentability.

The lead partner in this case, Joo Mee Kim, stated that “AmorePacific is extremely pleased by this excellent decision. With this decision, our client’s most important and valuable cushion technology will continue to be fully protected in the U.S. market.”

AmorePacific was represented in this case by Rothwell Figg attorneys Joseph Hynds, Joo Mee Kim, Jennifer Nock, and Nicole DeAbrantes.

Key Contacts

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