

**ALERT**

# Federal Circuit Patent Bulletin: *Organik Kimya AS v. Rohm & Haas Co.*

October 30, 2017

*"Even under the broadest reasonable interpretation, the Board's construction 'cannot be divorced from the specification and the record evidence,' and 'must be consistent with the one that those skilled in the art would reach.'"*

On October 11, 2017, in *Organik Kimya AS v. Rohm & Haas Co.*, the U.S. Court of Appeals for the Federal Circuit (Prost, Newman,\* Taranto) affirmed the U.S. Patent and Trademark Office Patent Trial and Appeal Board inter partes review decisions that certain claims of U.S. Patents No. 6,020,435 and No. 6,252,004, which related to preparing certain emulsion polymers having improved opacity, were not invalid for anticipation or obviousness. The Federal Circuit stated:

The PTAB found that the specification "describes a swelling agent not merely as being capable of permeating a shell and swelling the core of a multistage emulsion polymer in the abstract, but specifically under the conditions of the specific process for which the agent is to be used." The PTAB then found that the Toda and Touda references provide a general teaching of hollow multistage emulsion polymers, but concluded, as we shall discuss, that the processes here described and claimed are not anticipated by or obvious from the cited references. . . .

The Board construed "swelling agent" as follows: expressing a structural element, i.e., "an aqueous or gaseous, volatile or fixed base, or combinations thereof," in functional terms, i.e., "capable of permeating the shell and swelling the core, in the presence of the multistage polymer and monomer, under the conditions of the specific process for which the agent is to be used." . . . *Organik* also argues that the '435 specification provides an open-ended definition of

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“swelling agent,” and that the Board improperly adopted the narrower of two possible constructions of a “grammatically ambiguous passage.” . . . The Board did not deem the criticized words to be ambiguous, observing that “the Specification’s use of the word ‘include,’ in this instance, is modified by the phrase immediately following it, i.e., ‘are those which,’ suggesting that suitable swelling agents include only those which exhibit the functional characteristics thereafter described.” The Board is correct, for the specification makes clear that the swelling agent is a base capable of permeating the shell and swelling the core under the reaction conditions described in the specification. . . .

The Board found that both the Toda and Touda references show the production of voided emulsion polymers, but do not teach the use of a “swelling agent” to produce these polymers. Organik argues that since the references show voided emulsion polymerization and the presence of a base, this suffices to render the claims invalid. The Board recognized the differences between the prior art and the subject matter described and claimed in the ‘435 Patent, and held that unpatentability had not been shown. . . . There was substantial evidence in support of the conclusion that a person of ordinary skill would not have understood the bases as used by Toda to permeate the polystyrene shell and swell the core. The PTAB decision that the ‘435 Patent claims are not anticipated by the Toda reference is affirmed.

Organik also argues that the ‘435 Patent claims are invalid on the ground of obviousness in view of Touda’s use of a base that Organik states is a “swelling agent.” Touda shows a process “for producing polymer particles containing one microvoid or two or more discrete microvoids,” where the base sodium hydroxide is present in the polymerization. . . . The Board concluded that Touda does not render obvious the subject matter of claims 1–5 of the ‘435 Patent. This conclusion is in accordance with law and is supported by substantial evidence in the record.

The PTAB held a separate hearing on the ‘004 Patent, and instituted review on the grounds that claims 1–6 were obvious over the Touda reference, that claim 7 was obvious over the combination of Touda and U.S. Patent No. 5,292,660 (“Overbeek”), and that claims 1–7 were obvious over Toda in view of U.S. Patent No. 2,574,020 (“Crouch”). The challenged claims are directed to a process in which polymerization is stopped by “adding an effective amount of one or more polymerization inhibitors or reducing agents,” such as cresol. . . . The PTAB construed “swelling agent” as in the ‘435 Patent opinion, and with respect to the Toda and Touda references the Board reached the same conclusion as for the ‘435 Patent, on substantially the same analysis. The Board also held that it would not have been obvious to modify Example 2 of Touda to include a polymerization inhibitor by substituting cresol for the toluene used in Touda’s Example 2. ‘004 Pat. Op. at \*9. The Board did not make specific findings as to additional claim limitations. On this appeal Organik challenges the same “swelling agent” interpretation as the Board applied to the ‘435 Patent. For the reasons we have discussed, we conclude that the Board was correct in interpreting the term “swelling agent” as conforming to the conditions and process for which it is used.

Organik again challenges the Board’s findings that the Toda and Touda references do not disclose a “swelling agent.” Organik does not challenge the Board’s findings as to the nonobviousness of the substitution of cresol—a polymerization inhibitor—for toluene in Example 2 of Touda. Nor does Organik address the other limitations of the ‘004 Patent claims. With respect to Toda, the Board focused on Toda’s Example 11. Example

11 follows the same procedure as Example 9, discussed *supra*, but increases the amount of 10% KOH to 40 parts. . . . As for the '435 Patent, we conclude that no error has been shown in the Board's analysis.

With respect to the Touda reference, the Board reached the same conclusion as to the absence of a "swelling agent" as for the '435 Patent, presenting substantially the same analysis. We again conclude Organik has not shown error in that analysis. [T]he Board held it would not have been obvious to substitute cresol for toluene. Substantial evidence supports the Board's conclusion.