

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today
(1) was not written for publication in a law journal and
(2) is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM A. BAKER AND WARREN D. KETOLA

Appeal No. 97-3653
Reexamination Control No. 90/003,513¹

Gerald F. Chernivec - Attorney for Appellants
Jeffrey S. Melcher - Requestor

ON BRIEF

Before R. SMITH, CAROFF and METZ, **Administrative Patent
Judges.**

METZ, **Administrative Patent Judge.**

DECISION ON APPEAL

This is an appeal under 35 U.S.C. §§'s 134 and 306

¹ Request filed August 2, 1994, for the reexamination of U.S. Patent Number 4,166,152, issued August 28, 1979, based on application Serial Number 05/825,259, filed August 17, 1977. Tacky Polymeric Microspheres.

Appeal No. 97-3653
Reexamination Control No. 90/003,513

from the examiner's refusal to confirm the patentability of claims 7 through 10 in this reexamination proceeding. The patentability

of claims 1 through 6 has been confirmed by the examiner and, accordingly, forms no issue in this appeal.

BACKGROUND

On September 17, 1997, this merits panel rendered its opinion on the issues raised by appellants in their brief based on the entire record before us, including appellants' brief and the examiner's answer. On September 24, 1997, appellants filed a paper captioned "Request for Vacation of Decision" (Paper Number 24) requesting, *inter alia*, that our opinion be vacated because, although appellants had requested and paid for an oral hearing in this appeal, appellants had not been afforded an oral hearing and the decision we rendered was based solely on the written record. Additionally, appellants requested that the appeal be assigned to a different panel.

In an order mailed on December 5, 1997 (Paper Number 25), we vacated our decision and informed appellants that a

Appeal No. 97-3653
Reexamination Control No. 90/003,513

notice of oral hearing would be mailed in due course. In an order mailed on even date with the order vacating our opinion, Chief Administrative Patent Judge Sooner denied appellants' request that the case be assigned to a new merits panel (Paper Number 26).

On December 9, 1997 (Paper Number 27), a Notice of Hearing was mailed and sent by electronic facsimile to appellants informing them that an oral hearing was scheduled for Wednesday, December 17, 1997, at 10:00 A.M. Confirmation or waiver of the oral hearing was required. In a paper received by electronic facsimile on December 12, 1997 (Paper Number 28), appellants requested, *inter alia*, modification of the hearing date alleging business conflicts with the hearing date as set in the Notice of Hearing and requested a hearing date in January. The request to change the hearing date was denied (Paper Number 29) and appellants were ordered to inform the Board whether or not appellants would attend by no later than 5:00 P.M. on December 16, 1997. No confirmation or notification of attendance was received and appellants legal

Appeal No. 97-3653
Reexamination Control No. 90/003,513

representative did not appear at the hearing scheduled for December 17, 1997.

Subsequently, in late January, the merits panel rescheduled the oral hearing for February 25, 1998. Thereafter, appellants orally informed the Board that they no longer desired a hearing and would waive the request for oral hearing.

On March 4, 1998, appellants filed by electronic facsimile a paper confirming that the oral hearing had been waived (Paper Number 30). Appellants also requested that the fee paid for the oral hearing be credited to appellants' account. We direct appellants' attention to 37 CFR 1.26(a) concerning the issue of refunding the fee paid for the oral hearing.

On the matter of the issues raised by appellants in their brief, we have carefully reconsidered the entire record before us but we conclude that the examiner's refusal to confirm the patentability of claims 7 through 10 in this reexamination proceeding was sound. The patentability of claims 1 through 6 has been confirmed by the examiner and forms no issue in this appeal.

Appeal No. 97-3653
Reexamination Control No. 90/003,513

THE APPEALED SUBJECT MATTER

The appealed subject matter is directed to a suspension polymerization process for the production of adhesive microspheres useful in the manufacture of repositionable notes. In its broadest sense, the process comprises charging four chemical components to a reaction vessel, agitating the vessel to create an emulsion and heating the emulsion while agitating whereby the desired microspheres are formed from the emulsion.

Claim 7 is adequately representative of the appealed subject matter and reads as follows:

7. A suspension polymerization process for preparing infusible, solvent-insoluble, solvent-dispersible, inherently tacky, elastomeric polymeric microspheres comprising the steps of:

(a) charging to a reaction vessel
(I) at least one alkyl acrylate or methacrylate ester monomer; and

(ii) at least one anionic emulsifier at a concentration above its critical micelle concentration; and

(iii) a substantially water-insoluble polymerization initiator; and

Appeal No. 97-3653
Reexamination Control No. 90/003,513

(iv) an ionic suspension stabilizer,
having an interfacial tension of at
least about 15.0 dynes per centimeter;

(b) agitating the reaction vessel
charge to create an emulsion;

© heating said emulsion while
maintaining said agitation;

whereby elastomeric, solvent-
dispersible polymeric microspheres are
formed from said emulsion.

At page 10 of their brief, appellants state that the
patentability of claims 7 through 10 of their patent
undergoing reexamination stands or falls with the
patentability of claim 7.

THE PATENT UNDERGOING REEXAMINATION

The Baker et al. patent issued on August 28, 1979.
Under the statute in effect when the Baker et al. patent was
issued (35 USC 154), the Baker et al. patent has a term of 17
(seventeen) years. That term expired on August 29, 1986.
Thus, when appellants noted their appeal and when they filed
their brief, their patent term had not yet expired. However,
when the examiner's answer was mailed (January 16, 1997) the
Baker et al. patent expired.

Notwithstanding the expiration of the patent being

Appeal No. 97-3653
Reexamination Control No. 90/003,513

Silver. We affirm.

Silver discloses the preparation of inherently tacky, elastomeric, solvent-dispersible, solvent-insoluble microspheres for use in repositionable notepads (column 1, lines 39 through 44; column 1, line 67 through column 2, line 8). The microspheres are prepared by aqueous suspension polymerization of an alkyl acrylate ester and at least one monomer selected from oil-insoluble, water-soluble ionic monomers and maleic anhydride using an anionic emulsifier in an amount greater than the critical micelle concentration in the absence of externally added protective colloids (column 1, lines 57 through 62; column 4, lines 1 through 35). The process includes a catalyst for polymerizing the alkyl acrylate monomers (column 4, lines 19 through 24). Useful ionic monomers include sodium methacrylate and sodium acrylate (column 3, lines 1 through 40). Example 9 in Table II discloses the process of polymerizing iso-octyl acrylate and sodium acrylate in the presence of sodium p-dodecyl benzene sulfonate as an anionic emulsifier and benzoyl peroxide as a catalyst (column 5, line 60 through column 6, line 50).

We are satisfied from a careful review of the

Appeal No. 97-3653
Reexamination Control No. 90/003,513

complete record before us that the examiner has made out a *prima facie* case that appellants' claimed process lacks novelty. Specifically, we find that Example 9 in Silver describes a suspension polymerization process for preparing infusible, solvent-insoluble, solvent-dispersible, inherently tacky, elastomeric polymeric microspheres by charging to a reaction vessel "at least one alkyl acrylate" (iso-octyl acrylate); and "at least one anionic emulsifier at a concentration above its critical micelle concentration" (sodium p-dodecyl benzene sulfonate); and "a substantially water-insoluble polymerization initiator" (benzoyl peroxide); and an ionic suspension stabilizer, having an interfacial tension of at least about 15.0 dynes per centimeter" (sodium acrylate), with subsequent agitation and heating to form said elastomeric microspheres.

Appellants' urge that the examiner's rejection is founded on an improper interpretation of appellants' claims. Specifically, appellants urge that the language in claim 7, part (iv), "an ionic suspension stabilizer, having an interfacial tension of at least about 15.0 dynes per centimeter", when read in light of appellants' disclosure at

Appeal No. 97-3653
Reexamination Control No. 90/003,513

column 1, lines 23 through 32 of their issued patent, would not have been understood by a person of ordinary skill in the relevant art "to include a Silver monomer regardless of the fact that a Silver monomer may meet the interfacial surface tension elements of the claim language." (see appellants' main brief beginning with the paragraph bridging pages 11 and 12 and concluding with the second full paragraph on page 12). Appellants' urge that Silver teaches away from the use of suspension stabilizers. Additionally, it is urged that Silver's monomer stabilizes by forming part of the copolymer and, accordingly, is not a "suspension stabilizer" as defined by appellants in their disclosure. For reasons set forth fully below, we disagree with appellants' arguments.

Appellants' argument that the examiner has improperly interpreted claim 7 does not withstand careful analysis. There is no factual dispute between the examiner and appellants that the claim limitation in question, "an ionic suspension stabilizer, having an interfacial tension of at least about 15.0 dynes per centimeter" neither recites any specific compound or class of compounds nor *per se* limits the claims to either monomeric or polymeric stabilizers. Neither

Appeal No. 97-3653
Reexamination Control No. 90/003,513

is there any factual dispute that sodium acrylate comonomer of Silver possesses an interfacial tension of at least about 15.0 dynes per centimeter.² Rather, appellants urge that claim 7, when interpreted in light of the discussion at column 1, lines 23 through 32 of their specification, would be understood by a person of ordinary skill in the art to exclude the ionic comonomers of Silver. We disagree.

In our view, the relevant part of the cited passage in question is that portion of the text appearing at column 1, lines 29 through 32 wherein it is stated that:

The microspheres are prepared by aqueous suspension polymerization, but have as an essential ingredient in their preparation a hereinafter defined suspension stabilizer.
[emphasis ours]

The stabilizers are "hereinafter defined" at column 2, lines 41 through 51 of Baker et al. Therein, it is recited that:

Ionic suspension stabilizers that assist in the preparation of the microspheres can be characterized by an interfacial tension of at least about 15.0 dynes per centimeter. Interfacial tension herein means the value determined between the monomer

² See the Schlage declaration, Exhibit Number 8, Paper Number 5.

Appeal No. 97-3653
Reexamination Control No. 90/003,513

phase and a 1.0 percent by weight aqueous solution of the stabilizer. To determine the interfacial tension, a standard test, ASTM #D-1331-56, entitled, "Standard Methods of Tests for Surface and Interfacial Tension of Solutions of Surface Active Agents" can be utilized.

At column 3, lines 1 through 48, patentees list "exemplary stabilizers" and "representative stabilizers".

Our reading of the above-noted passage from Baker et al. at column 1, lines 23 through 32 leads us to conclude that the first sentence refers to the components which make up the microspheres, *per se*, and not to the method of preparing the microspheres. That is, the microspheres produced by the Silver process are copolymers and require as a comonomer an ionic comonomer. The microspheres produced by appellants' process are either homopolymers or copolymers but do not contain as a comonomer any "ionic comonomer".

It is the second sentence of the above-noted passage which is directed to the method of preparation and we consider the reference to the "hereinafter" described suspension stabilizers to be separate and distinct from the discussion of the microspheres, *per se*. Indeed, the language "hereinafter

Appeal No. 97-3653
Reexamination Control No. 90/003,513

defined" is clear and simply means defined somewhere in a subsequent portion of the disclosure. That portion of the disclosure is found at column 2, lines 41 through 56. We have carefully read said disclosure and find absolutely no description of useful stabilizers as either polymeric or monomeric.

The listing beginning at column 3 of Baker et al. is considered only to be exemplary of compounds useful as "ionic stabilizers" but is not considered to be descriptive or limiting with respect to only those compounds suitable as "ionic stabilizers". While it cannot be gainsaid that the exemplary stabilizers enumerated in column 3 do not include polymers, the list includes "quaternary amines" broadly and not all quaternary amines are polymeric. Moreover, the listing of exemplary "ionic stabilizers" in the specification does not negative the broad scope of useful stabilizers as defined in claim 7 by their sole physical property of possessing an "interfacial tension of at least about 15.0 dynes per centimeter."

We have not overlooked appellants' arguments and citations concerning claim interpretation. However, in our

Appeal No. 97-3653
Reexamination Control No. 90/003,513

view, appellants are simply reading into the claims a limitation from their specification, that the stabilizers may be polymeric, where no such limitation is found in claim 7 or in the specification, for that matter. We know of no authority which stands for the proposition that the meaning of a claim may be narrowed by importing into the claims a limitation found only in the disclosure. Indeed, the weight of authority is to the contrary.

Claims in a reexamination proceeding are given their broadest, reasonable interpretation consistent with the specification under the rule pronounced in *In re Yamamoto*, 740 F.2d 1569, 1571, 222 USPQ 934, 936 (Fed. Cir. 1984). Furthermore, the Supreme Court in *United States v. Adams*, 383 U.S. 39, 48, 49, 148 USPQ 470, 482 (1966), citing to *McCarty v. Lehigh Valley R. Co.*, 160 U.S. 110, 116 (1895) stated :

We know of no principle of law which would authorize us to read into a claim an element which is not present, for the purpose of making out a case of novelty or infringement. The difficulty is that if we once begin to include elements not mentioned in a claim in order to limit such claim and avoid a defense or anticipation, we should never know where to stop.

Appeal No. 97-3653
Reexamination Control No. 90/003,513

Additionally, in ***E.I du Pont de Nemours & Co. v. Phillips Petroleum Co.***, 849 F.2d 1430, 1433, 7 USPQ2d 1129, 1131 (Fed. Cir. 1988), *cert denied*, 109 S.Ct. 542 (1988) our reviewing court held:

It is entirely proper to use the specification to interpret what the Patentee meant by a word or phrase in the claim. But this is not to be confused with adding an extraneous limitation appearing in the specification, which is improper. By "extraneous," we mean a limitation read into a claim from the specification wholly apart from any need to interpret what the patentee meant by particular words or phrases in the claim. Where a specification does not *require* a limitation, that limitation should not be read from the specification into the claims.
[citations omitted]

See also ***SRI International v. Matsushita Electric Corp. of America***, 775 F.2d 1107, 1121, 227 USPQ 577, 585 (Fed. Cir. 1985) (in banc).

We have not overlooked the decision of this Board in ***Ex parte Papst-Motoren***, 1 USPQ2d 1655 (Bd. Pat. App. & Int. 1986) wherein the rule of broad claim interpretation for claims under reexamination as expressed in ***In re Yamamoto***, *id.*, was modified. Therein, the Board held in reexamination

Appeal No. 97-3653
Reexamination Control No. 90/003,513

proceedings in which the Patent and Trademark Office is considering the patentability of claims of an expired patent which are not subject to amendment, a policy of "liberal claim construction may properly and should be applied." *Papst-Motoren* at 1 USPQ2d 1656. Nonetheless, the Board also recognized at 1 USPQ2d 1657 that:

We are mindful that it has been held improper for "inferential limitations" to be added to a claim. *In re Priest*, 582 F.2d 33, [199 USPQ 11] (CCPA 1978).

Appellants have cited no authority for the proposition, and we are aware of none, that would permit us to read the term "polymeric" from appellants' disclosure into component (iv) in claim 7. Most importantly, we repeat that appellants' disclosure does not specifically describe useful "ionic stabilizers" as being polymeric but only that they have a particular "interfacial tension".

It is also appellants' stated position that Silver teaches away from the use of any type of suspension stabilizers by their statement at column 1, lines 57 through 62 that the suspension polymerization is conducted in the "absence of externally added protective colloids or the like."

Appeal No. 97-3653
Reexamination Control No. 90/003,513

This conclusion by appellants is stated to be based on the fact that "[t]he term `suspension stabilizer' is essentially synonymous with `protective colloid'." (page 12 of appellants' brief). However, glaring by its absence from appellants' brief is any evidence or authority which supports appellants' bare conclusory statement. Accordingly, we treat the unsupported conclusion as mere attorney argument. Similarly, appellants' arguments concerning the mechanism of how a "suspension stabilizer" performs during the polymerization process is without any support in the record or citation in the brief.

In any event, the scope of protection obtained in a patent is determined by the language of the claims. Appellants chose to claim their "ionic suspension stabilizer" broadly, in terms of the stabilizer's sole physical property of having a particular interfacial tension of about 15.0 dynes per centimeter. We find any compound having the claimed interfacial tension is embraced by appellants' claim language.

Indeed, in responding to the examiner's first action on the merits in the original examination, appellants argued that the formal rejection of process claim 7 (on the grounds

Appeal No. 97-3653
Reexamination Control No. 90/003,513

that the claim embraced subject matter broader than the subject matter enabled by their disclosure) was improper because:

As to the stabilizer, the limitation thereof relative to the stabilizer defines same in terms of its interfacial tension, and this term is defined specifically at lines 11 through 16 on page 4 of the specification. Since this is the only criteria necessary for functionality of the stabilizer, and same has been similarly limited in the claim language, no further amendment is considered necessary relative thereto. [emphasis ours]

Thus, appellants made a conscious, deliberate decision to draft their claims broadly with respect to the "ionic stabilizer" and define same in terms of a single physical property: the stabilizer's interfacial tension. Having drafted the claims broadly, appellants request that we now import narrowing limitations from the specification into claim 7 to avoid prior art owned by appellants' assignee comes too late in the prosecution of their patent. In light of the comments made in the amendments discussed above, we consider appellants' representations concerning the disclosure of Silver in another, different proceeding (see page 14 of

Appeal No. 97-3653
Reexamination Control No. 90/003,513

appellants' main brief, under the heading "D.") and the examiner's discussion thereof to at least be consistent with the representations made in the prosecution of the patent here being reexamined. We do not, however, treat the statements as "admissions". *Aktiebolagert Karlstads Mekaniska Werkstad v. U.S. ITC*, 217 USPQ 865 (CAFC 1983); mod'g. 217 USPQ 179; *Issidorides v. Ley*, 4 USPQ2d 1854 (BPAI 1987).

Appellants urge that the critical issue here before us is not whether Silver's ionic comonomer functions like a suspension stabilizer but, rather, whether Silver's ionic comonomer is a suspension stabilizer as the term is used in appellants' patent. While we agree with appellants that how the ionic monomers in Silver perform is irrelevant to the question of anticipation before us we disagree with appellants that the name given to Silver's ionic monomers is determinative of the question of anticipation. Appellants obtain patent protection, not for the names or words used to define the things they claim as their invention, but rather they obtain protection for the things their claims actually describe. Thus, the sole issue before us under 35 USC 102(b) is whether Silver describes the invention claimed by

Appeal No. 97-3653
Reexamination Control No. 90/003,513

appellants. For reasons set forth fully above, we find Example 9 of Silver's patent describes the subject matter claimed by appellants in claim 7 of their patent.

Finally, appellants have suggested that the issues here before us were already considered by another forum, the International Trade Commission (ITC), and found by said other forum to lack merit (see page 15 of appellants' main brief). Suffice it to say that this statutory proceeding is founded on a different record than was considered by the ITC. Moreover, we know of no authority and appellants have cited none, as was their responsibility, for the proposition that we are bound by the decisions of the ITC.

OTHER ISSUES

Subsequent to appellants noting their appeal in this reexamination proceeding, our reviewing court has handed down two opinions concerning the scope of reexamination proceedings before the Patent and Trademark Office. In the first decision, the court interpreted the meaning of "substantial new question of patentability" in 35 USC § 303(a)(1994) as barring reexamination for questions decided in the original examination based on the same prior art and same statutory

Appeal No. 97-3653
Reexamination Control No. 90/003,513

ground as applied against patentees' claims in the original examination. *In re Recreative Technologies Corp.*, 83 F.3d 1394, 38 USPQ2d 1776 (Fed. Cir. 1996). In *In re Portola Packaging Inc.*, 110 F.3d 786, 42 USPQ2d 1295 (Fed. Cir. 1997), the court held that a rejection made during reexamination does not raise a substantial new question of patentability under the statute if it is supported only by prior art previously considered by the Patent and Trademark Office with respect to the same or broader claims.

While appellants have not argued in their brief that reexamination under the statute is improper based on Silver, in their response to the order granting reexamination (Paper Number 9), appellants have urged that the Patent and Trademark Office "considered the issue of whether the Baker-Ketola invention was patentable over Silver during the original prosecution of the Baker-Ketola patent, and decided that it was." (page 4 of Paper Number 9). The basis for appellants' position was stated to be that "the Silver patent was before the Examiner at the time, even though it had not been submitted formally, because it was discussed thoroughly in the background section of the Baker-Ketola application."

Appeal No. 97-3653
Reexamination Control No. 90/003,513

(paragraph bridging pages 4 and 5). In an abundance of caution, and for the sake of thoroughness, we shall address these contentions below.

Notwithstanding appellants' representations, we have obtained the patent file of the Baker-Ketola patent here being reexamined. On page 1 of the specification, at lines 5 through 27, the Silver patent is discussed in the section captioned "Background of the Invention". The examiner in charge of the application did not initial and date the citation of the Silver patent as he would have if he had read and considered the patent. See MPEP § 609, Revision 52, April 1977.

The first office action was a requirement for restriction without the citation of any prior art. Appellants' response to the requirement for restriction did not include any prior art citation. In the first office action on the merits, the examiner withdrew the requirement for restriction and rejected the claims on both substantive and formal grounds. All the claims were rejected under 35 USC § 102 and § 103 over U.S. Patents to Pohlemann et al. (Patent Number 3,513,120) and Morehouse et al. (4,049,604), both of

Appeal No. 97-3653
Reexamination Control No. 90/003,513

which were cited on FORM PTO 46-42. No other prior art was cited by the examiner. In their response to the examiner's action, no additional prior art was cited by appellants. In the final rejection, the examiner maintained both formal and substantive rejections but cited no additional prior art. After receiving an amendment after final rejection which cited no additional prior art, the examiner allowed all the claims in the application. No additional prior art was cited either by the examiner or appellants after allowance. The patent issued with only the citation of Pohlemann et al. and Morehouse et al. printed under the caption "**References Cited**".

From all of the above, we are unable to ascertain the basis for appellants' pronouncement that "the Patent and Trademark Office has already passed on the issue of whether Baker-Ketola is patentable over Silver." (lines 3 through 5 on page 5, Paper Number 9). Even assuming, *arguendo*, that the examiner had fully considered Silver during the prosecution of the Baker-Ketola patent, the basis for the examiner's rejection here is founded on the declaration of Schlage, wherein the interfacial tension of a 1% solution of sodium acrylate was independently determined to be within the claim

Appeal No. 97-3653
Reexamination Control No. 90/003,513

limitation in claim 7 for the "ionic suspension stabilizer".

In other words, absent the Schlage declaration, even with the Silver patent in hand, the examiner could not have known that sodium acrylate met the requirements of claim 7. See *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433, 434 (CCPA 1977) ("Whether the rejection is based on 'inherency' under 35 USC 102, on 'prima facie obviousness' under 35 USC 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products" [footnote and citations omitted]). Accordingly, the evidentiary record in this proceeding raises "substantial new questions of patentability" based on the inherent properties of sodium acrylate which were neither known to the examiner examining the Baker-Ketola application in the first instance nor before him when the Baker-Ketola application was examined and passed to issue.

The examiner's rejection of claims 7 through 10 under 35 U.S.C. § 102(b) is affirmed.

Further proceedings in this case may be taken in accordance with 35 U.S.C. §§ 141 to 145 and 306, and 37 CFR §§

Appeal No. 97-3653
Reexamination Control No. 90/003,513

1.301 to 1.304. Note also 37 CFR § 1.197(b). If the patent owner fails to continue prosecution, the reexamination proceeding will be terminated and a certificate under 35 U.S.C. § 307 and 37 CFR § 1.570 will be issued canceling the patent claims, the rejection of which has been *affirmed*.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED

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Appeal No. 97-3653
Reexamination Control No. 90/003,513

	RONALD H. SMITH)	
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