2019-2013

In The
United States Court of Appeals
For The Federal Circuit

SOLENIS TECHNOLOGIES, LP,

Appellant,

v.

SNF SAS,

Appellee.

APPEAL FROM THE UNITED STATES PATENT AND TRADEMARK OFFICE, TRADEMARK TRIAL AND APPEAL BOARD IN APPLICATION NO. 95/002,397.

BRIEF OF APPELLEE

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FORM 9. Certificate of Interest **Form 9**
Rev. 10/17

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

CIBA SPECIALTY CHEMICALS WATER **v.** SNF SAS

Case No. 19-2013

CERTIFICATE OF INTEREST

Counsel for the:
☐ (petitioner) ☐ (appellant) ☐ (respondent) ■ (appellee) ☐ (amicus) ☐ (name of party)

certifies the following (use "None" if applicable; use extra sheets if necessary):

1. Full Name of Party Represented by me	2. Name of Real Party in interest (Please only include any real party in interest NOT identified in Question 3) represented by me is:	3. Parent corporations and publicly held companies that own 10% or more of stock in the party
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4. The names of all law firms and the partners or associates that appeared for the party or amicus now represented by me in the trial court or agency or are expected to appear in this court **(and who have not or will not enter an appearance in this case)** are:

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5. The title and number of any case known to counsel to be pending in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal. *See* Fed. Cir. R. 47. 4(a)(5) and 47.5(b). (The parties should attach continuation pages as necessary).

None

6/26/2019
Date

/s/ B. Aaron Schulman
Signature of counsel

Please Note: All questions must be answered

B. Aaron Schulman
Printed name of counsel

cc: Andrew T. Meunier

Reset Fields

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I. STATEMENT OF RELATED CASES

Appellee states that is unaware of any other case pending in this or any other court that will be directly affected by, or have a bearing on, this Court's decision in the pending appeal.

II. JURISDICTIONAL STATEMENT

This action is an appeal by the Appellant from the first decision of the Board dated August 19, 2016 ("2016 Board decision"), its second decision dated July 16, 2018 ("2018 Board decision"), and its denial of Appellant's request for rehearing dated April 10, 2019 ("2019 Board decision), all holding that all claims of Appellant's patent were obvious. Appellee concurs with Appellant that jurisdiction arises pursuant to 28 U.S.C. § 1295(a)(4)(A).

III. STATEMENT OF THE ISSUES

The present appeal relates to the claims of Appellant's US Patent No. 6,454,902 (the "'902 patent") which were found to be unpatentable in three separate decisions of the Patent Trials and Appeal Board ("Board") of the United States Patent and Trademark Office (USPTO) in an Inter Partes reexamination ("reexamination"). In its brief, Appellant alleges several reasons for these decisions, ranging from the Board somehow overlooking or misconstruing the voluminous evidence developed over the long course of the reexamination, a failure for Appellant to be afforded the opportunity to provide yet additional evidence beyond what was properly developed over the course of the reexamination, and the Board not following well-established procedures governed by the regulations concerning patent reexaminations. However, there is another, more logical explanation for the repeated and consistent decisions of the Board

rejecting Appellant's claims: namely those claims were clearly obvious in light of prior art.

As is set forth below, following the institution of the Inter Partes reexamination by the USPTO on the basis of a request from Appellee, the prosecution of the reexamination proceeded for several years with both the Appellant and Appellee being able to provide responses to all of the actions by the Examiner, including any desired evidence, and have their arguments considered by the Board at the appropriate times. Considering all of the evidence, and considering the weak and limited nature of Appellant's claims, the Board on three occasions saw fit to issue well-reasoned decisions rejecting all of Appellant's claims, and each aspect of the decision was fully supported in great detail by citations to the record. The primary issues on appeal are thus whether, based on the voluminous evidence of record developed over the course of the reexamination, the Board's ultimate decision with regard to obviousness is supported by substantial evidence, and whether the Board followed the proper procedures as prescribed by USPTO rules governing reexamination procedures. As indicated below, both of these questions can be answered in the affirmative, and there is no reversible error in this case on the part of the Board.

IV. STATEMENT OF THE CASE[1]

This appeal arises from the result of the decisions of the Board in an Inter Partes reexamination holding the claims of US Patent No. 6,454,902 ("'902 patent") to be obvious under 35 U.S.C. § 103(a). Appellant's brief attempts to characterize these proceedings as limited, and that the Board's multiple decisions somehow resulted from an incomplete examination of the record, or Appellant's inability to have its evidence properly considered. To the contrary, the prosecution of the reexamination took over seven years from start to finish and afforded Appellant every opportunity to present any evidence it wanted in order to make its case regarding the relevant issues, including the specific ones referred to in Appellant's brief. Further, because the reexamination was Inter Partes, the record included not only what was provided by the Examiner or Appellant, it included evidence provided by the Appellee, all of which was relied upon to form the basis of the Board's decisions. When the Board's decision is considered in terms of the full record including submissions by all parties, there is no question that this decision was supported by substantial evidence.

[1] The Board's decision held all of the claims of the '902 patent to be obvious based on the factual evidence of the record. However, since Appellant's brief focuses on claims 10 and 13 and does not attempt to address the other dependent claims, Appellee's brief will also focus primarily on these two claims.

A. Institution of the Inter Partes Reexamination

The present case was initiated with the original Request for Inter Partes Reexamination was filed by Appellee on September 15, 2012. ("Request", Appx1051) against the '902 patent (Appx0109) relating to processes of making paper and paperboard from a cellulosic stock employing a particular flocculating system. Appellee in its request provided detailed grounds detailing why each and every claim of the '902 patent was invalid on the basis of prior art, and the Request included citations to numerous prior art references that formed the basis of the proposed obviousness rejections. Included in the original Request, among other prior art references, were the following three prior art citations:

1. WO 98/24973 (WO '973)

WO '973 is directed towards a process for the production of paper and describes non-ionic and anionic polymers as additives to the flow in a dilution headbox which improves retention and dewatering. Appx1190, ln 17-31. WO '973 describes how the HC flow and the LC flow are mixed in the headbox and which is essentially constant. Appx1191, ln 21-23.WO '973 enumerates that the main flow or the HC flow of WO '973 is between 0.1-3.5% by weight. Appx1191, ln 3-7. WO '973 further states:

> "[s]uitable organic polymers for use in this invention can be *anionic, non-ionic, amphoteric, or cationic in nature*, they can be derived from natural or synthetic sources and they can be linear, *branched* or cross-linked, e.g. in the form of microparticles. Preferably the polymer is

> water-soluble or water-dispersable. Examples of suitable main polymers include anionic, amphoteric and cationic starches, anionic, amphoteric and cationic guar gums, and anionic, amphoteric and cationic acrylamide-based polymers, as well as chitosans, poly-(diallyldimethyl ammonium chloride), polyethylene imines, polyamines, polyamidoamines, meiamine-formaldehyde and urea-formaldehyde resins. Cationic starches and cationic acrylamide-based polymers are particularly preferred polymers according to the invention, both as single retention components as well as in retention systems with and without anionic inorganic particles. The molecular weight of the main polymer is usually above 200,000, suitably above 300,000, preferably at least 500,000 and most preferably at least 1,000,000. Usually the molecular weight is below about 20,000,000."

Appx1194, ln 13-25. (emphasis added).

WO '973 also specifically contemplates acrylamide based polymer additives stating: "[p]referably the LC flow additives is a water-soluble or water-dispersable organic or inorganic polymer which can be derived from natural or synthetic sources. The LC flow additive is suitably selected from non-ionic and anionic organic polymers, which can be linear, branched or cross-linked. Examples of suitable LC flow additives include non-ionic and anionic polymers based on acrylamide… [f]or acrylamide-based polymers the molecular weight should suitably be above 1,000,000, preferably above 5,000,000 and most preferably above 10,000,000." Appx1197, ln 14-23. (emphasis added).

2. EP 0877120 (EP '120) (English language equivalent of WO 97/234691 or WO '691)

EP '120 is directed towards a papermaking method and process for improving retention and/or drainage property by the addition of an ionic water

soluble polymer prepared by a specific method. See Appx1169, ln 5-7. EP '120 describes "[a]n ionic water-soluble polymer produced by a polymerization method for obtaining a dispersion of fine polymer particles by carrying out polymerization under agitation in an aqueous salt solution capable of dissolving monomers but not the produced polymer in the presence of a dispersant..." See Appx1170, ln 21. EP '120 further describes how "[i]f the average particle diameter of the particles of the ionic water-soluble polymer exceeds 150 μm, they can easily precipitate to damage the stable storability of the dispersion and require a long time before they are completely dissolved into water because of low solubility due to the large sizes of the particles of the ionic-water soluble polymer if the dispersion is mixed with water for use." Appx1174, ln 25-28. The product of the polymerization method is stated to be as "water-soluble" even though the method for producing the product creates a "dispersion of fine polymer particles." Appx1175, ln 24 ("the dispersion contains an ionic water-soluble polymer"). The method described in EP 120 merely uses a salt solution to separate the polymer from the monomer in such a manner that dispersion occurs. EP '120 specifically contemplates branched polymers. EP '120 further discloses branched water soluble polymers; see, e.g., Appx1172, ln 30-32 ("it is assumed that a polymer having a specific molecular structure, such as a branched polymer or block copolymer, is produced unlike polymerization in an aqueous solution or water-in-oil type emulsion

polymerization in which polymerization is carried out in a uniform phase . . . ") and Appx1176, ln 31-32 ("Therefore, a specific molecular structured polymer such as branched polymer is produced unlike polymerization which is carried out in a uniform phase . . . "). As evidenced in the Examiner's rejections in the reexamination, this reference discloses the elements of original claim 1 with regard to the anionic and cationic polymers and the claimed intrinsic viscosity. Appx1275-1278.

3. EP 0235893 (EP '893)

EP '893 is directed towards a papermaking process in the field of the claimed invention that involves making paper or paperboard by passing an aqueous cellulose suspension through a centriscreen or other shear device and then draining the purified suspension, and obtaining improved drainage by adding to the suspension an excess of high molecular weight linear synthetic cationic polymers. EP '893 also adding the polymer to thin stock streams. Appx1204.

Appellee's reexamination request began with a detailed showing that the only independent claim of the '902 patent, claim 1, was obvious over the prior art for several reasons, including various combination of the WO '973, EP '120, and EP '893 references. Appx1056. In the original '902 patent, claim 1 read as follows:

> 1. A process for making paper or paper board comprising forming a cellulosic suspension, flocculating the suspension, draining the suspension on a screen to form a sheet and then drying the sheet, wherein the cellulosic suspension is flocculated by the addition of a

> water soluble cationic synthetic polymer of intrinsic viscosity of at least 4 dl/g, wherein the flocculated cellulosic suspension is subjected to mechanical shearing and then reflocculated by a subsequent addition of a reflocculating system, and in which the reflocculating system comprises
>
> > i) a siliceous material and
> > ii) a water soluble anionic polymer of intrinsic viscosity at least 4 dl/g, and in which the siliceous material (i) and water soluble anionic polymer (ii) are added to the cellulosic suspension subsequent to the centriscreen and wherein the cationic polymer is added to a thin stock stream of the cellulosic suspension.

The Request also included arguments as to why claims 10 and 13 were also made obvious by the same prior art. Appx1098-1104. Prior to reexamination, these claims read as follows:

> 10. A process according to claim 1 in which the water cationic soluble polymer is a branched water soluble polymer which exhibits a rheological oscillation value of tan delta at 0.005 Hz of above 0.7 (calculated on a 1.5% by weight aqueous solution of the polymer).
>
> 13. A process according to claim 1 in which the water soluble anionic polymer has an intrinsic viscosity of at least 7 dl/g.

See Appx0116.

Following a consideration of the materials provided in the Request, the USPTO instituted an Order granting Appellee's Request, and the Inter Partes Reexamination was instituted on December 3, 2012. Appx1250.

B. The Examiner's Initial Official Action Adopts Several Grounds from the Request and Finds Claim 1 and Other Claims to be Obvious Based on Prior Art

The initial Office Action in the reexamination was also issued on December 3, 2012 (Appx1264) and in this action, the USPTO Examiner adopted several contentions of the Appellee had made in the Request, and also did not adopt certain contentions from the Request. In particular, in the initial action, the Examiner agreed with Appellee that claims 1-9, 11, 12, and 14-18 were obvious under 35 U.S.C. § 103(a) over EP '120 in view of EP '893. Appx1269-1274.

In this regard, the Examiner provided detailed grounds as to his rejection, stating that EP '120 disclosed all of the steps of the process of claim 1, including "**forming a cellulosic suspension**", "**draining the suspension on a screen to form a sheet and then drying the sheet**," (these two steps describing a conventional papermaking process as taught by EP '893), "**the cellulosic suspension is flocculated by the addition of a water soluble cationic synthetic polymer of intrinsic viscosity of at least 4 dl/g**," "**wherein the flocculated cellulosic suspension is subjected to mechanical shearing**," and the "**addition of a reflocculating system**," Appx1269-1274 (bolding in original). The Examiner found that the claimed water soluble cationic polymer having an intrinsic viscosity at least 4 dl/g was met directly in EP '120 because such a polymer was disclosed having an intrinsic viscosity of from 5 dg/l to 30 dl/g, and that the limitation

regarding the anionic copolymer of EP ‘120 which had an intrinsic viscosity of 6 dl/g. Appx1271-1272. The only aspect of claim 1 that the Examiner did not find in EP ‘120 was adding the cationic polymer “to a thin stock stream”, but the Examiner found that this element was disclosed in EP ‘893 which paralleled the papermaking process of the papermaking process and stated that the addition of a cationic polymer to a thin stock provided “better results.” Appx1272. Accordingly, the Examiner concluded that a person of ordinary skill in the art would have added the cationic polymer to a thin stock stream of the papermaking process of EP ‘120 in order to obtain the improved results shown in EP ‘893. Appx1272.

The Examiner also agreed with the Appellee that claims 1-9, 11-12, and 14-18 were obvious under 35 U.S.C. § 103(a) over EP ’120 in view of WO ‘973. In this case, the Examiner again indicated that EP ‘120 had all of the elements of claim 1 but did not specify whether the cationic polymer was added to thin stock or thick stock, but that WO ‘973 taught that the HC flow was a thin stock as shown by the low solids content. Appx1275.

Finally, the Examiner agreed with the Appellee and adopted the proposed rejection that claims 1-9 and 11-18 were obvious under 35 U.S.C. § 103(a) over WO ‘973 in view of WO ‘691 (aka EP ‘120). Appx1277-1280. The Examiner stated that all of the elements of claim 1 (as shown above) were included in ‘WO

‘973 with the exception of specifying that the claimed mechanical shearing was from a centriscreen, but that this element was specifically taught by EP ‘120. With regard to the issue of intrinsic viscosity, the Examiner cited the passages in WO ‘973 relating to cationic starches and acrylamides and the disclosed molecular weights ranging from 1 million to less than 20 million, and stated that since intrinsic viscosity is proportional to molecular weight, these polymers were expected to have the claimed intrinsic viscosity recited both in claim 1 (at least 4 dl/g) and in claim 11 wherein the viscosity of the cationic polymer was at least 7 dl/g. Appx1278.

Similarly, the Examiner determined that because WO ;’973 had anionic polymers ranging from above 10 million to below 40 million in weight, the anionic polymers in WO ‘973 would be expected to have the claims intrinsic viscosities such as recited both in claim 1 (at least 4dl/g) and claim 13 where the viscosity of the anionic polymer was at least 7 dl/g. Appx1278-1279. Although the Examiner mistakenly indicated in this initial action that claim 13 had been confirmed, the Examiner ultimately corrected this mistake in a subsequent action wherein claim 13 was rejected on the same basis as had been stated in the first Official Action. Appx1518-1522.

C. Appellant's Submissions During the Reexamination Afforded Multiple Opportunities to Submit Evidence and Arguments Regarding Both Claim 10 and Claim 13 Long Before the 2016 Decision of the Board

Following the first Action, and given an initial opportunity to respond to the Examiner's determination that the subject matter of Claim 1, including the limitations concerning intrinsic viscosity, was obvious based on the cited prior art, Appellant decided to cancel this claim and only go forward based on dependent claims as reflected in is submission of April 8, 2013. Appx1324.

Even further, in addition to the citations of prior art above, the Examiner provided even further factual support for his original determination that intrinsic viscosity limitations of original claim 1 were made obvious by the prior art. For example, the Examiner cited to even further evidence including the Mark-Houwink-Sakurada equation and the Polymer Handbook in the in his Official Action dated September 23, 2014 (Appx1617). Appellant was also given the opportunity to respond to the additional evidence of record concerning the intrinsic evidence, all prior to the 2016 Board decision.

With regard to claim 10, although this claim was not originally included in the reexamination, it was referred to arguments made by the Appellee during the reexamination even prior to the submission of the case to the Board for its initial decision. For example, the May 8, 2013 submission of Appellee cited US 5,958,188 (US '188) (Appx1345).

Further, claim 10 was officially added to the reexamination in the Examiner's Official Action of March 4, 2014 (Appx1507) by virtue of other amendments that had been made by Appellant. Appx1510-1512. Indeed, because claim 10 at that point was entered in the reexamination, it created yet another opportunity for Appellant to address this claim, which Appellant did in its submission dated May 5, 2014 (Appx1544) when it only stated that it agreed with the arguments of the Examiner regarding Claim 10 in the March 4, 2014 Official Action. Appx1544.

Following all of these submissions, an Action Closing Prosecution (ACP) was issued by the Examiner on September 23, 2014 (Appx1617) followed by a Notice of Right to Appeal on November 7, 2014 (Appx1647), and after extensive briefing by both parties on the issues concerning claim 10 and claim 13, the Examiner's determinations as stated in the ACP were submitted to the Board for review.

D. The 2016 Board Decision Confirms the Rejection of Claim 13 and Raises a New Ground of Rejection Holding that Claim 10 is Obvious on the basis of Prior Art

The 2016 Board decision was issued on August 19, 2016. Appx0001. In this decision, the Board not only affirmed the rejection of claim 13, it rejected claim 10 and entered this as a new ground of rejection pursuant to 37 C.F.R. § 41.77(b). Appx0032. Specifically, the Board affirmed the Examiner's rejections of claim 13

and reversed the Examiner's decision not to reject claim 10. The Board held, in relevant part, that (1) it affirmed the Examiner's decision to reject claim 13 under 35 U.S.C. § 103(a) as obvious over WO '973 and WO '691 (EP '120) and entered a new rejection of claim 10 under 35 U.S.C. § 103(a) as obvious over WO '973 in view of WO '691 (EP '120) and US '188. Appx0032. Further, since as indicated above, since the Appellant had proceeded in the reexamination by canceling claim 1 and going forward on the basis of claims 10 and 13 which included the subject matter of claim 1, the identical issues regarding the intrinsic viscosity issues (and thin stock stream issues) originally arising from claim 1 were identical with regard to both claims 10 and 13. Appx0001-0026.

The Board addressed these issues specifically with regard to claim 13 and thus did not need to address the same issues with regard to claim 10 since both claims were identical in this regard. As indicated above, this arose because this aspect regarding intrinsic viscosity was included in original claim 1 and was subsequently added to the independent forms of both claims 10 and 13 using identical language. Appx0001-0035. Instead, the consideration of claim 10 specifically involved a discussion of the branched polymers and rheological oscillation issue {herein "branched polymers/rheological oscillation issue") which was included in the language of the original dependent claim 10 and was the only

feature added by the original form of claim 10 beyond what was already in claim 1. Appx0001-0035.

With regard to Appellant's appeal regarding claim 13, the Board upheld the Examiner's determinations as related to intrinsic viscosity and supported its rationales by making specific references to the prior art of record. For example, the Board provided its reasons as to why cationic acrylamide based polymers of molecular weights of one million or more would have intrinsic viscosities within the range claimed in claim 13 based on the evidence of record. Appx0010-0015. The Board also confirmed the Examiner's previous findings regarding intrinsic viscosity were based on other evidence in the record, including the Mark-Houwink-Sakurada equation and a constant value for poly (N,N'-dimethyl-acrylamide) having a molecular weight range from 50,000 to 1.22 million from the Polymer Handbook, so as to conclude that the polymers having the preferred molecular weights in WO '973 have intrinsic viscosities of 16.8 dl/g." Appx0010-0015. The Board also repeated Examiner's earlier determination that "because intrinsic viscosity is proportional to molecular weight, the intrinsic viscosities of the cationic polymers disclosed in WO '973 having molecular weights greater than 1 million would be expected to have higher intrinsic viscosities than 16.8 dl/g." Appx0010-0015.

The Board further went on to summarize Appellant's arguments against using poly(N,N'-dimethyl-acrylamide) since it is not a cationic acrylamide-based polymer, that WO '973 does not inherently disclose the polymer of claim 13, and that the intrinsic viscosity is 2.3 dl/g for polyacrylamide having a molecular weight of 500,000. Appx0010-0015. The Board stated they were not persuaded by the Appellant's arguments since, despite having since day one the ability to present evidence on the subject, Appellant had not presented persuasive evidence as to why poly(N,N'-dimethyl-acrylamide), could not be used or would not be descriptive of the polymers disclosed in WO '973. Appx0013. The Board concluded the Examiner did not err in concluding WO '973 discloses water soluble cationic or anionic polymers having intrinsic viscosities in the claimed ranges as it pertained to the rejections for claim 13. Appx0010-0015.

The Board also pointed out that because there was a new ground of rejection concerning claim 10, the Appellant had the option of reopening prosecution, but only with regard to this ground, and not to claim 13 which was not subject to the new grounds of rejection. Appx1939. The Board stated that under 37 C.F.R. 41.77(b), if Appellant chose to reopen patent prosecution, such a request must be "limited in scope to the 'claims so rejected." Appx0032.

In response to the Board's 2016 Decision, Appellant filed a Request to Reopen Prosecution on September 19, 2016 (Appx1930) which was required to be

directed only to the claims subject to the new ground of rejection. Appx1939. In this submission, Appellant tried to skirt the well-established regulations concerning remands from the Board by attempting to amend claim 13 and adding further arguments despite the fact that claim 13 was not included in the new grounds of rejection. Appx1930. Appellant also submitted arguments against the new grounds of rejection to claim 10 relating to the branched polymers/rheological oscillation issue and included a Declaration of one if its employees, Jehn-Rendu (herein "Declaration"), but Appellant did not provide any arguments against the rejection of claim 10 on the basis of intrinsic viscosity, even when citing the Declaration. Appx1930.

Accordingly, contrary to the revisionist history provided in Appellant's brief, Appellant's arguments regarding claim 10 only related to the branched polymers/rheological oscillation issue and not to the intrinsic viscosity issue, thus completely contradicting the assertions in this regard made in Appellant's brief. Indeed, as reflected above, the branched polymers/rheological oscillation issue was the only one that could be considered by the Examiner on remand.

Following Appellant's submission, the Board remanded to the Examiner to consider the Declaration only with respect to the new grounds of rejection in accordance with 37 C.F.R. § 41.77. Appx1992. The remand order also explicitly stated that the proposed amendments to claim 13 were not in compliance with 37

C.F.R § 41.77(b)(1) and thus not entered for consideration by the Examiner. Appx1775-1776. Following the remand, the Examiner issued a new Official Acton on July 5, 2017 (Appx1978) stating that the rejection of claim 10 with regard to the branched polymer/rheological oscillation issue was overcome by the Declaration. The Examiner's Official Action was thus silent with respect to any issue concerning intrinsic viscosity because this issue had been finally decided and was outside of the scope of permitted arguments relating to the new grounds of rejection. See Appx1978 and 37 C.F.R § 41.77(b)(1).

Following the issuance of the July 5, 2017 Official Action after remand, Appellee was able to file a response dated August 7, 2017 (Appx1993) including arguments and evidence concerning Appellant's submission, including the Declaration. Appellee pointed out that the Appellant's arguments and evidence relied upon by the Examiner against claim 10 were based upon Appellant's misinterpretations of the cited prior art references and supported only by a sketchy and incorrect Declaration by a witness employed by Appellant. Appx1993. Appellee further pointed out that the Board's rejection of claim 10 on the basis of WO '973, EP '120, and US '188 should have been maintained because Appellant had argued (and the Examiner accepted) that claim 10's "claimed rheological properties" required complete dissolution, when in fact there was no such support for this requirement. Appx1993.

Still further, Appellee pointed out that while Appellant's Declaration had asserted that the limitations relating to the delta tan value and branched polymers could not be met by US '188 only if there was a complete dissolution of the polymers, this is fact was not the case, and to the contrary, US '188 when taken in the proper context, disclosed that if branched polymers were in solution like those disclosed in EP '120, then those polymers would have a "relatively high (above 0.5 and preferably above 0.7)" rheological oscillation value. Appx1993. Further, Appellee showed that nowhere in the '902 patent was there any requirement for or discussion of a complete dissolution, nor was there even any mention of the word "dissolve." Appx109.

Appellee through this response argued based on the evidence of record that one of ordinary skill in the art would have found it obvious to optimize the water soluble cationic polymer and select a branched water soluble polymer, as taught by EP '120, which exhibits a rheological oscillation value of tan delta at 0.005 Hz of above 0.7 (calculated on a 1.5% by weight aqueous solution of the polymer) as claimed in claim 10. Appx1993.

Appellant was then given the opportunity to address claim 10 following the 2016 Board Decision, and did so in a response to Appellee's submission filed September 7, 2017. Appx2013. Following this submission, the issues raised in the new ground of rejection were considered by the Board.

E. The Board Again Confirms the Rejections of Claim 10 and 13 on the basis of Prior Art in its 2018 Decision, and Subsequently Denies Appellant's Request for a Rehearing in its 2019 Decision.

Taking all of the evidence of record into account, the Board issued a decision dated July 16, 2018 ("2018 Board decision") (Appx0036) again holding that all of the claims of the '902 patent as amended during the reexamination were obvious. Appx2013. In its decision, the Board made it clear that had fully considered the Declaration in light of all the evidence and arguments of record, and again concluded that based on all of the evidence of record, claim 10 was obvious over the cited prior art. The Board considered all of the evidence, including Appellant's submission and Declaration with regard to the branched polymers/rheological oscillation issue, and held claim 10 was obvious over WO '973 in view of WO '691 (EP '120) and US '188. Appx0036.

Following the 2018 Board decision, Appellant filed its request for rehearing (Appx2046), which included many of the same arguments and allegations that Appellant raises here. Among these was Appellant's claim that the Board's rejection of claim 13 should have been a new grounds of rejection which was ludicrous in light of the fact that the intrinsic viscosity issue had been raised on day one of the reexamination, and after several rejections by the Examiner on this basis leading to a final rejection, the Board's affirmance of the Examiner on this issue ended prosecution of this issue under the applicable USPTO rules. Appellant also

raised the issue concerning improper shifting of the burden regarding obviousness to Appellant despite the fact that the Board followed proper procedure and simply weighed all of the evidence properly when determining that the complete weight of the evidence towards obviousness outweighed the evidence of non-obviousness. The Board issued its decision on the rehearing in 2019 ("2019 Board decision") (Appx0052) denying the request for rehearing, once again supporting each and every aspect of its decisions, and denying Appellant's assertions for reasons as stated above.

Following the 2019 Board decision holding all of the claims of the '902 patent to be obvious on the basis of the prior art, Appellant filed the present appeal.

V. SUMMARY OF THE ARGUMENT

Appellant had full and fair opportunity throughout the reexamination to present any evidence it wished to submit concerning all of the relevant issues regarding this appeal, including the limitations concerning intrinsic viscosity which were raised on day one, and its assertions to the contrary are completely baseless. Further, Appellant's assertions that the Board did not properly consider the evidence of record or somehow improperly shifted any burdens to the Appellant is also completely refuted by the facts, and its allegations that the Board did not properly consider Appellant's Declaration is also baseless. Finally, there was voluminous evidence made of record by all parties during the

reexamination, and this evidence of record was cited to support each and every conclusion reached by the Board in determining that all of Appellant's claimed were obvious. The Board's determination of obviousness was thus supported by substantial evidence, and there is no reversible error upon which its decision can be overturned.

VI. ARGUMENT

A. Standard of Review

In this Appeal, the Appellant has the burden to show that the Board committed reversible error in its finding that the claims were obvious. *In re Watts*, 354 F.3d 1362, 1369 (Fed. Cir. 2004). A claimed invention is unpatentable if the differences between it and the prior art "are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art." 35 U.S.C. § 103(a). Whether an invention would have been obvious is a legal question based on underlying findings of fact, *In re Gartside*, 203 F.3d 1305, 1316 (Fed. Cir. 2000), but what a reference teaches is a question of fact. *Para-Ordnance Mfg., Inc. v. SGS Importers Int'l, Inc.*, 73 F.3d 1085, 1088 (Fed. Cir. 1995). Whether a person of ordinary skill in the art would have been motivated by the prior art to arrive at the claimed invention is also a question of fact. *Gartside*, 203 F.3d at 1316. The prior art would include

[everything that is directly taught in the prior art or what one skilled in the art would be inherently all insights known to one skilled in the art].

The Court upholds fact findings made by the Board that are supported by substantial evidence, 5 U.S.C. § 706(2)(E), and reviews the Board's legal conclusions *de novo*. *Gartside*, 203 F.3d at 1315-16. Substantial evidence is "more than a mere scintilla" and means "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." *Biestek v. Berryhill*,139 S. Ct. 1148, 1154 (2019) (quoting *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938)). Further, even if the evidence of record will support several reasonable but contradictory conclusions, this Court "will not find the Board's decision unsupported by substantial evidence simply because the Board chose one conclusion over another plausible alternative." *In re Cohen*, 767 Fed. Appx. 985, 988 (2019), citing *In re Jolley*, 308 F.3d 1317, 1320 (Fed. Cir. 2002).

B. Appellant was Never Deprived of the Opportunity to Present Evidence Concerning the Intrinsic Viscosity Issue as it Applied to Claim 10, Since This Issue was Raised on Day One of the Reexamination, and That Aspect of the Claim was Identical in this Respect With Claim 13

The primary argument made by Appellant in its opening brief (herein "Brief") is that it was somehow precluded from providing evidence concerning issues raised during the reexamination proceeding, and that the Board did not

properly consider the Declaration with regard to intrinsic viscosity as included in claim 10. Brief at 22. Such assertions are completely meritless.

Indeed, in the first place, the issue concerning intrinsic viscosity was raised on day one of the reexamination when the Examiner rejected original Claim 1 which contained both the limitation regarding (1) "a water soluble cationic synthetic polymer of intrinsic viscosity of at least 4 dl/g" and (2) "a water soluble anionic polymer of intrinsic viscosity at least 4 dl/g." Appx1264. As shown above, the Examiner had supported the original rejection of claim 1 by stating that "the intrinsic viscosity of the WO '973 anionic polymer would be expected to have the claimed intrinsic viscosities such as recited in claim 1 and claim 13 of the '902 patent." Appx1264. However, instead of immediately challenging the Examiner on this point with regard to claim 1, Appellant proceeded to advance the reexamination only with regard to the limitations added by claims 10 and 13, which were both independent claims incorporating the subject matter of claim 1. Appellant's actions ensured that the reexamination would continue with regard to claims 10 and 13, and that both claims included the identical subject matter of original claim 1 relating to intrinsic viscosity, namely the element relating to the limitation of (1) "a water soluble cationic synthetic polymer of intrinsic viscosity of at least 4 dl/g" and

(2) "a water soluble anionic polymer of intrinsic viscosity at least 4 dl/g". Appx1264.

Accordingly, Appellant's arguments of error on the part of the Board for not considering the intrinsic viscosity issue with regard to claim 10 is a complete red herring since the Board had fully considered the identical issue with regard to claim 13, and there was no need to repeat itself on this issue with regard to claim 10. Further, as shown above, the precise issue relating to intrinsic viscosity of this subject matter was raised on day one of the reexamination, and Appellant had the ability to submit whatever arguments or evidence it wished to present virtually throughout the reexamination.

Appellant also had a full and fair opportunity in the proceedings below with regard to the other aspect of claim 10, namely the branched polymers/rheological oscillation issue. Appellant also had a full opportunity to present evidence concerning this aspect of claim 10 both before and after the 2016 decision of the Board. Indeed, the issue was raised by Appellee in submissions before the Examiner as early as Appellee's submission of May 8, 2013 (Appx1360), and claim 10 formally became part of the reexamination based on an Official Action by the Examiner on November 14, 2013, almost three years before the first Board decision. Appx1396. Thus again, throughout virtually the entire course of the reexamination, Appellant had a full and fair

opportunity to submit whatever evidence or arguments it wished to provide with regard to claim 10, and indeed Appellant did make several submissions regarding claim 10 before the 2016 Board decision (see Appx1442 and Appx1544), in each case arguing only with regard to the branched polymers/rheological oscillation issue, which makes sense because the issue of intrinsic viscosity had been covered in detail with regard to claim 13.

Further, following the 2016 Board decision rejecting claim 10, Appellant had yet an additional opportunity to address the issue concerning the branched polymers/rheological oscillation issue when claim 10 was remanded to the Examiner for further prosecution of the new grounds of rejection. The submission following the remand was the one that included the Declaration, but Appellant was not restricted with regard to whatever evidence it wanted to submit concerning the new ground of rejection. Since Appellant had a full and fair opportunity to provide its response concerning the branched polymers/rheological oscillation issue of claim 10 following the remand, it cannot argue that there was any impropriety in the Board's decision merely because the combined weight of all its submitted evidence throughout the course of the reexamination did not outweigh the mountain of evidence that was cited and relied upon by the Board.

Instead, Appellant's protestations in its brief that it somehow was deprived of the opportunity to present any evidence or argument concerning the intrinsic viscosity issue are completely baseless. In short, Appellant totally misstates the issue regarding the intrinsic viscosity aspect with regard to claim 10 because this issue, which arose at day one, had been fully considered in the 2016 Board decision and was identical to the determination made by the Board on this issue based on the same language included in claims 10 and 13 from original claim 1.

C. Substantial Evidence Supports the Board's Decisions Holding Appellant's Claims Obvious in Every Respect

Appellant's assertion that the detailed and well-reasoned decision of the Board lacked substantial evidence is also meritless. As reflected above, the evidence of record included that provided by the Examiner from day one when found that the elements of claim 1 regarding intrinsic viscosity of both the anionic and cationic polymers were found in the cited prior art of record. Indeed, as shown above, the Examiner specifically found that intrinsic viscosities of both polymers were present both in WO '973 and EP '120.

During the course of the reexamination, the Examiner further supplemented his initial rejections by citing to a well-known treatise, The Polymer Handbook, to assert that cationic polymers of WO '973 with molecular weight of 1 million or more would have intrinsic viscosities of more

than 4dl/g. Appx1659-1661. The Examiner further determined that because intrinsic viscosity is directly proportional to the molecular weight, an anionic polymer would also be expected to have intrinsic viscosities of more than 16.8 dl/g. Appx1660-1661. The Examiner thus provided a well-reasoned factual basis to conclude that polymers of molecular weights of 1 million or more have intrinsic viscosities of 16.8 dl/g or more. Appellant was afforded the full and fair opportunity to respond to the Examiner's findings on this issue, but it never provided a factual basis sufficient to overcome these rejections. Indeed, although Appellant argued that the Examiner's determinations were not correct, it never provided any alternate calculations for polymers having a molecular weight of 1 million or more, the preferred molecular weight of polymers of WO '973. Appellant also failed to present any evidence, such as a calculation of an anionic versus a cationic polymer and why the viscosity would be expected to be different based on charge. Appx1660-1661.

In its 2016 decision (Appx0001) the Board fully supported its conclusions concerning the intrinsic viscosity issue with numerous citations to the record. For example, the Board agreed with Examiner's determination that because intrinsic viscosity is proportional to molecular weight, the intrinsic viscosities of the cationic polymers disclosed in WO '973 would be at least 16.8 dl/g. The Board further reasoned the same logic applies to anionic

polymers disclosed in WO '973. While Appellant argues that the assertion that WO '973 describes anionic acrylamide polymers was not supported by the text, this is clearly erroneous because polyacrylamide anionic polymers described in WO '973 are just one choice and not the preferred choice of WO '973.

The Appellant's arguments with regard to the issue of inherency are also meritless. In the first place, inherent features are part of virtually every patent prosecution, and the Manual of Patent Examination Prosecution ("MPEP_) specifically advises Examiners that inherent features are to be considered with regard to the prior art. Indeed, MPEP 2111, Section II states that:

> II. The express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under **35 U.S.C. 102** or **103**. "The inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness." *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) (affirmed a **35 U.S.C. 103** rejection based in part on inherent disclosure in one of the references). See also *In re Grasselli*, 713 F.2d 731, 739, 218 USPQ 769, 775 (Fed. Cir. 1983).

Accordingly, to the extent the Board relied on any inherent findings, such a determination is a finding of fact which could be used to support its determination of obviousness under 35 U.S.C. § 103(a).

Moreover, many of Appellant's arguments conflate inherency with obviousness, and indeed many of the findings of the Board concerning the prior art are in fact not reliant on inherency. For example, the Board showed that WO

‘973 plainly describes water soluble cationic, non-ionic or anionic acrylamide-based polymers of high molecular weight, and thus inherency was not needed to supply any of these limitations. Appx0001. WO ‘973 states, by Appellant’s own admission, that “Preferably the polymer is water-soluble or water dispersible…suitable main polymers include anionic, amphoteric and cationic acrylamide-based polymers…[t[he molecular weight of the main polymer is… most preferably at least 1,000,000”. See Brief at 38; Appx1194, ll. 13-25. Inherency is not needed since WO ‘973 explicitly describes anionic and cationic water soluble acrylamide based polymers. Appx1194.

As indicated above, the 2016 Board decision also addressed all of the relevant issues concerning claim 10 relating to the branched polymers/rheological oscillation issue based on the evidence of record. For example, the Board found that EP ‘120 clearly envisions branched cationic polymers and also provides a rationale as to why the polymers of EP ‘120 have either a branched or block copolymer structure. Appx0001. The Board added that “that this specific molecular structure is a primary factor of improving retention and/or drainage property.” Appx0001. The Board thus correctly concluded that EP ‘120 taught the skilled artisan that a branched structure may be *a primary factor* of improving retention and/or drainage properties of the

polymer, and that the skilled artisan reading EP '120 would be motivated to use the branched polymers. Appx0001.

Furthermore, the Board cited US '188 for its express teaching that "one way of indicating that the branched polymer is in solution, as in Appellant's claims, rather than being in the form of cross linked particles is by observing that the defined tan delta value is relatively high (above 0.5 and preferably above 0.7" Appx1354, at 4:27-36. The Board thus correctly concluded that the skilled artisan reading US '188 in conjunction with EP '120 patent would be motivated to create a branched polymer having tan delta values of above 0.7 for increased water solubility and improved retention and/or drainage. Appx0007-0009.

Similarly, the 2018 Board decision also reflected a complete review of the issues concerning the subject matter of Claim 10 which formed the basis of the new grounds of rejection. As indicated above, since the Board had already addressed the language relating to intrinsic viscosity from original claim 1 with regard to claim 13, it did not need to further address this issue. Further, by its governing regulations, and the Board could not address this issue because it was not a new ground of rejection pursuant to 37 C.F.R. § 41.77(b). The Board concluded that the subject matter of claim 10 relating to the branched polymers/rheological oscillation issue was obvious on the basis of the cited

prior art, namely a combination of WO '873, WO '691 (EP '120), US '188 for the reasons as stated in its original decision. Appx0036.

However, the Board specifically addressed the Declaration submitted by Applicant, holding that it was not persuasive with regard to the branched polymers/rheological oscillation issue. Appx0043-0047. As indicated above, the Board fully followed all procedural regulations which required it to review only those issues related to the new grounds of rejection. 37 C.F.R. § 41.77(b).

Finally, the Board repeated all of these reasons in denying Appellant's request for rehearing in its 2019 decision (Appx0052), also addressing Appellant's other allegations relating to procedural issues.

As indicated above, this Court must uphold the decision of the Board as long as it is supported by substantial evidence. 5 U.S.C. § 706(2)(E). Substantial evidence means that evidence that is "more than a mere scintilla" and means "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." *Biestek v. Berryhill*,139 S. Ct. 1148, 1154 (2019) (quoting *Consolidated Edison Co. v. NLRB*, 305 U.S. 197, 229 (1938)). In addition, where, as here, the record below arises from a contested case between two opposing parties, the fact finder below often has to make its ultimate decision based on contradictory evidence presented by both sides, and in such a case, this Court "will not find the Board's decision unsupported by

substantial evidence simply because the Board chose one conclusion over another plausible alternative." *In re Cohen*, 767 Fed. Appx. 985, 988 (2019), citing *In re Jolley*, 308 F.3d 1317, 1320 (Fed. Cir. 2002).

The record as recited above shows that in each and every case, the Board's findings concerning the obviousness of the '902 patent was supported in all cases by detailed citations of the record. At minimum, there are no grounds to dispute that the evidence was substantially more than "a mere scintilla", and was clearly enough to provide "such relevant evidence as a reasonable mind might accept as adequate to support a conclusion." Accordingly, even taking into account the facts and evidence submitted by Appellant on the relevant issues, there was clearly sufficient evidence for the Board to come to its decision, even if the Board was considered to have "chose[n] one conclusion over another plausible alternative." In light of all of these factors, it cannot be disputed that the Board's decision was based on substantial evidence. *Id.*

D. The Board Followed Proper Procedures Throughout the Reexamination and Did Not Improperly Shift Any Burdens to Appellant

Congress delegated rulemaking power to the USPTO to "establish regulations, not inconsistent with the law, which . . . shall govern the conduct of proceedings in the Office." 35 U.S.C. § 2(b)(2) (2000); see also *Star Fruits S.N.C.*

v. United States, 393 F.3d 1277, 1282 (Fed. Cir. 2005). It is well-established that deference is owed to decisions of the USPTO in interpreting these regulations. *In re Garner*, 508 F.3d 1376, 1378 (Fed. Cir. 2007), makes clear that the USPTO's interpretation of its own regulations is entitled to "substantial deference" unless the interpretation is "plainly erroneous or inconsistent with the regulation." *See also Star Fruits*, 393 F.3d at 1277 ("[The USPTO's] interpretation of its own regulations is entitled to substantial deference and will be accepted unless it is plainly erroneous or inconsistent with the regulation."); *In re Sullivan*, 362 F.3d 1324, 1326 (Fed. Cir. 2004). In the present case, the Board clearly followed all of the regulations concerning the handling of the reexamination below.

As described above, the 2016 Board decision found all of the clams of the '902 patent to be obvious on the basis of the prior art of record. The decision confirmed the Examiner's rejection of claim 13 with regard to the intrinsic viscosity issue which had been raised from day one of the reexamination, and which was identical in this respect with the language taken from original claim 1 upon which both claims 10 and 13 depended. Since the intrinsic viscosity issue (related to the original language of claim 1) was identical with regard to the original language of claim 1 that was incorporated into claim 10, there was clearly no reason for the Board to repeat this identical issue as it related to claim 10. The only new ground of rejection thus related to the branched polymers/rheological

oscillation issue which the Board made into a new ground of rejection. Appx0001. When the reexamination was reopened following the Board's decision in 2016, both the Examiner and the Board followed the required procedures which did not allow for consideration of any issues that were not subject to the new grounds of rejection. In this regard, the Board's determination regarding the branched polymers/rheological oscillation issue included a consideration of the Rendu Declaration for this purpose only, since the affirmance of the rejection of claim 13, which had already been considered with regard to the same intrinsic viscosity element found in clam 10, was not subject to further consideration under the Board's rules. Indeed, in this regard, Appellant's arguments concerning claim 10 as made in its first submission following the remand of the reexamination after the first Board decision only addressed the branched polymers/rheological oscillation issue with regard to claim 10. Appx0001.

Accordingly, the allegations of Appellant that the Board did not fully consider the Declaration with regard to the intrinsic viscosity issue are meritless. Appellant in its brief tried to misrepresent the proceedings concerning the intrinsic viscosity issue by arguing that the Board was in error did not properly consider the Declaration with regard to this issue, when as indicated above the Board was precluded from addressing a finally decided rejection, and in fact Appellant in its response did not attempt to use the Declaration with regard to claim 10 for any

purposed other than the rheological issue. Appellant tries to sweep its own actions under a rug by ignoring the plain facts as set forth above, and by only asserting in a footnote that "the Declaration does not refer to claim 10" and "the pertinent paragraphs of the Jean-Rendu declaration are not limited to any claims". Such assertions are baseless since the nature of the Declaration is irrelevant to the arguments made by Appellant in its response where it never advanced arguments regarding intrinsic viscosity with regard to claim 10. Appx1930.

Finally, Appellant in its brief also argues that the Board somehow improperly shifted the burden to Appellant, and also improperly made findings that relied in part on inherent features. Instead, as the Board so indicated in its 2019 Decision, the Board did not shift any burdens, it only weighed all of the evidence, and found that the evidence in favor of obviousness outweighed the evidence provided that was asserted against the finding of obviousness. This is in accordance with the well-established principle that even inherent findings of fact, as well as other finding of fact can shift the burden of production to the patentee (See MPEP 2111), but this never shifts the burden of obviousness which the Board rightly decided was a case where the full evidence of record supporting its decision outweighed any evidence provided on the record which might have supported a opposite conclusion. The Board followed proper procedures in every respect and never shifted the burden of obviousness to the Appellant.

VIII. CONCLUSION

Contrary to Appellant's protestations, Appellant was provided with an opportunity to present whatever evidence or arguments it wished to provide in order to attempt to support its position, including with regard to the intrinsic viscosity issue, but simply could not refute the ultimate facts upon which the Board's decision was based. There was no impropriety by the Board during the reexamination, and its decision below was based on consideration of the large volume of evidence in the record which was cited by the Board to support each and every aspect of the decision holding all of Appellant's claims to be obvious. The Board's decision was thus supported by substantial evidence, and there are no grounds of reversible error. This Court should thus affirm the decision of the Board in all respects.

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CERTIFICATE OF FILING AND SERVICE

I hereby certify that on this 16th day of December, 2019, I caused this Brief of Appellee to be filed electronically with the Clerk of the Court using the CM/ECF System, which will send notice of such filing to the following registered CM/ECF users:

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