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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TAKASHI YASUKOCHI, TOSHIRO
YAMAGUCHI, TETSURO TATEISHI,
and NARUHITO HIGO

Appeal 2011-000986
Reexamination Control No. 90/008,491
Patent 7,034,083
Technology Center 3900

Before: RICHARD E. SCHAFER, ROMULO H. DELMENDO, and
MICHAEL P. TIERNEY, *Administrative Patent Judges*.

SCHAFER, *Administrative Patent Judge*.

DECISION ON APPEAL¹

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

Hisamatsu Pharmaceutical Co., Inc. (Appellant) appeals the final rejection of Claims 1 and 3-10. 35 U.S.C. §§ 134(b) and 306. We have jurisdiction. 35 U.S.C § 6(b).

We affirm.

Background

A decision on the merits affirming all grounds of rejections during the reexamination of Appellant's patent was previously entered in this appeal. One of the issues Appellant raised related to the permissible scope of reexamination during the course of the proceeding following an unchallenged initial order for reexamination:

The rejection of claims 1, 3, 4, 6 and 8-10 over Tsubota alone, does not support a substantial new question of patentability ("SNQ"), which is required for each rejection during Reexamination under 35 U.S .C. § 303(a)

Br. 18. The Examiner held that the question was petitionable, i.e., procedural, and not reviewable by the Board. Ans. 23. Our earlier opinion agreed with the Examiner. We held that the issue was not related to the threshold condition of initiating a reexamination - a substantial new question of patentability. Rather Appellant was actually challenging the propriety of entry of a particular rejection made during the course of a properly initiated reexamination. We stated:

We are unaware of any statutory or delegated authority that would allow us to review the decision to enter a particular rejection in a properly initiated reexamination. Challenges to the Director's statutory authority to conduct the reexamination and enter a particular rejection must be made to the Director or the Director's designee, not to this board.

BPAI Decision, Appeal 2009-015332, mailed June 15, 2010 p. 10.

Shortly after our decision was entered the Director delegated certain matters related to ex parte reexamination and the existence of substantial new question of patentability to the Chief Administrative Patent Judge. Notice, *Clarification on the Procedure for Seeking Review of a Finding of a Substantial New Question of Patentability in Ex Parte Reexamination Procedures*, 75 Fed. Reg. 36,357 (June 25, 2010). In light of the notice we withdrew our opinion in order to consider the effect of the notice on our decision. Subsequently we issued an order under 37 CFR § 41.50(d) requiring further briefing. Order issued September 9, 2010. Both Appellant and the Examiner filed supplemental briefs.

Decisions

For the reasons detailed below enter the following decisions:

1. We remain of the view that the question --whether a particular rejection made during the course of a properly initiated reexamination should not be entered because that rejection is outside the scope permitted by the reexamination statute-- is procedural and petitionable and therefore not before us;
2. The Director's Notice did not delegate authority to the Board to review the examiner's decision to enter a particular rejection of the type made here because it is outside the scope permitted for ex parte reexamination;
3. We affirm the rejections of Claim 1 and 3-10 under 35 U.S.C. § 103(a).

Statement of the Case

An examiner finally rejected the claims under 35 U.S.C. § 103(a) relying on the teachings of the following prior art:

5,049,417	Tsubota
5,344,655	Sakai
3,221,745	Coover
4,190,492	Eckert
4,544,699	Biale

Ans. 4.

The examiner entered four rejections relying on (1) Tsubota alone² and Tsubota combined with (2) Sakai and Coover,³ (3) Eckert and Biale,⁴ and (4) Sakai, Coover, Eckert, and Biale.⁵ Ans. 6-14.

The Claimed Subject Matter

The claimed subject matter relates to adhesive compositions. The adhesives are a type that may incorporate drugs for epidermal administration, for example, as part of a drug-delivery patch. In relevant part, Claim 1, the sole independent claim, is directed to:

An adhesive . . . said adhesive comprising a polymer consisting of [two classes of specified monomers] . . . the polymer is crosslinked by boric acid or a boric acid derivative, and substantially no water is used in production of the adhesive.

Br. 29. Claim 1 is reproduced in its entirety in the margin with indenting added.⁶ The specific monomers recited in Claim 1 that make-up the polymer and the relative amounts of each are not at issue in this appeal.⁷

² Claims 1, 3, 4, 6, and 8-10. Ans. 6-9.

³ Claims 5 and 7. Ans. 9-10.

⁴ Claims 1, 3, 4, 6, and 8-10. Ans. 10-14.

⁵ Claims 5 and 7. Ans. 14.

⁶ Claim 1.

An adhesive
to be affixed to a skin surface,
said adhesive comprising
a polymer consisting of

According to the Appellant's written description, the adhesive is made by dissolving or emulsifying the polymer in an appropriate solvent. Written

one or more kinds of acrylic or methacrylic monomer unit,

at least one of the kinds of acrylic or methacrylic monomer unit having a hydroxy group, and one or more kinds of other monomer unit selected from the group consisting of

vinyl acetate,
N-vinyl-2-pyrrolidone,
itaconic acid,
maleic acid,
allylamine,
vinyl propionate,
methylvinylpyrrolidone,
vinylpyridine,
vinylpiperidone,
vinylpiperazine,
vinylpyrazine,
vinylpyrrole,
vinylimidazole,
vinylcaprolactam,
vinylloxazole,
vinylmorpholine, and
vinylpyrrolidone,

wherein the acrylic or methacrylic monomer unit contained in the polymer is 50% to 90% by weight, the polymer is crosslinked by boric acid or a boric acid derivative, and substantially no water is used in production of the adhesive.

⁷ The examiner made detailed findings and explained why the specific monomer and the relative amounts would have been obvious. Final Office Action filed January 14, 2008, pp. 6-14; Ans. 6-14. Appellants have not challenged those findings and conclusions. Rather, they rely on the process recitation in the claims.

Description⁸, p. 8, ll. 1-4. The solvent may be aqueous or organic (non-aqueous). Written Description, p. 8, ll. 1-4. The solvent is removed by heating. Written Description, p. 8, ll. 1-5. The aqueous solvent is “water or a mixed solvent containing water as a main component.” Written Description, p. 3, ll. 22-23. The non-aqueous solvent is “an organic solvent or a mixed solvent containing an organic solvent as a main component.” Written Description, p. 3, ll. 19-21. The polymer must also be cross-linked using boric acid or a boric acid derivative. Written Description, p. 8, ll. 10-23. According to Appellant, the resulting adhesive composition, whether using an aqueous or non-aqueous solvent, “contains substantially no water.” Written Description, p. 4, ll. 18-19. Appellant defines “containing substantially no water” as meaning (1) that no water is used in making the adhesive or (2) that the adhesive produced contains no water:

“containing substantially no water” means that no water is used in the production of the adhesive or the patch, or that the adhesive or the patch that is produced contains no water.

Written Description, p. 5, ll. 3-6.

Appellant’s written description identifies a broad assortment of materials that may be part of the adhesive. These include liquids compatible with the polymer; such as absorption promoting agents, solubilizing agents and plasticizers (written description, p. 9, ll. 4-9), a wide variety of drugs (written description, p. 10, l. 3 – p. 14, l. 8), and antioxidants, preservatives, ultraviolet-absorbing agents, and anti-crystallizing agents (written description, p. 15, l. 26 – p. 16, l. 19).

⁸ All references to the “written description” are to the written description that was a part of the original specification filed July 23, 2004.

The Prior Art

Appellant's brief only addresses the Tsubota reference in detail, and does not address the specific teachings of the other references. Appellant refers to these references, only in passing, as not remedying the alleged deficiencies in Tsubota's teachings. Br. 24, 25, and 28. Accordingly, we only need address the teachings of the Tsubota patent to decide this appeal.

Tsubota

Tsubota describes an air-permeable medical adhesive tape for application to skin. Tsubota 1:7-14. The tape includes a layer of an adhesive composition. In order to obtain the desired air permeability, Tsubota teaches forming pores or voids in the layer. Air permeability is said to allow dissipation of moisture from the skin. Moisture trapped under the skin may lead to inflammation. Tsubota 1:14-17.

Tsubota describes the technique for making the tape. A layer of a solution of an adhesive polymer in a hydrophobic organic solvent is applied to a substrate. Tsubota 2:36-38. The solvent is evaporated leaving behind a layer of adhesive. Tsubota 4:33-35. The pores are formed in the layer by applying water drops to the adhesive solution layer prior to evaporation of the solvent. Tsubota 2:33-50. Evaporation of the solvent leaves an adhesive layer with entrapped water drops. Tsubota 2:44-47. The water may include a crosslinking agent such as boric acid. Tsubota 11:21-32. The boric acid causes the polymer contiguous to the water drops to crosslink, preserving the shape of the water drops as adhesive-free pores when the water is subsequently removed. Tsubota 2:33-50; 6:36-38. The water is removed by evaporation. Tsubota 4:33-55. Based upon this description, we infer that no

water is left behind after the drying step and Tsubota's adhesive composition contains no water. Tsubota's adhesive appears to have both crosslinked and uncrosslinked polymer. Tsubota notes that the crosslinking agent is not included in the adhesive solution in order to avoid loss of adhesiveness that could occur due to the crosslinking. Tsubota, 6:45-51.

Issues

1.

Appellant contends that the rejection of Claims 1, 3, 4, 6, and 8-10 on Tsubota alone should be withdrawn because the Office is estopped from rejecting the claims on this ground. Br. 18-24. According to Appellant, that rejection would not qualify as a substantial new question of patentability and therefore may not be used to reject the claims:

The rejection of claims 1, 3, 4, 6 and 8-10 over Tsubota alone, does not support a substantial new question of patentability ("SNQ"), which is required for each rejection during Reexamination under 35 U.S .C. § 303(a), because Tsubota: (1) is the identical art as was used before (2) was previously used to show the same limitations already found patentable, (3) and is used now in the same way as it was used to for these same limitations that were previously examined, without being viewed in any discernable new light.

Br. 18.

The examiner contends that the issue is petitionable and not subject to appeal. Ans. 23.

Thus, an issue before us is whether the examiner erred in holding that the issue is petitionable.

2.

Appellant contends that the examiner's rejections should be reversed. According to Appellant, the product-by-process recitation of Claim 1 that "substantially no water is used in production of the adhesive" patentably distinguishes the claimed composition from the prior art:

Structural characteristics of the product produced by the methodology of Tsubota are distinct from the structural characteristics of the present invention.

Br. 13. Specifically, Appellant contends that Tsubota's adhesive is porous while the claimed adhesive is not and that Tsubota's adhesive is not entirely crosslinked while Appellant's adhesive is entirely crosslinked:

The adhesive of the present invention produced with substantially no water does not contain these communicating pores. Further, unlike Tsubota, there is crosslinking through the adhesive layer of the instant invention.

Br. 13 (emphasis added).

The examiner contends that the product-by-process recitation is insufficient to patentably distinguish the claimed adhesives from those suggested by the prior art. Specifically, the examiner construes the claims as not excluding the presence of pores or uncrosslinked polymer. Ans. 19-20.

The dispositive patentability issue in this appeal is whether the examiner correctly construed the Claim 1 subject matter as not excluding pores or uncrosslinked polymer?

Discussion

Estoppel

Appellant argues that the rejection of Claims 1, 3, 4, 6, and 8-10 over Tsubota should be withdrawn because the rejection does not rise to a

substantial new question of patentability. Br. 18-24. The examiner held that this issue is a petitionable matter that is not reviewable by appeal to the board and declined to address the issue. Ans. 23.

A review of the prosecution history shows that Appellant requested reexamination of Claims 1, 3, and 6 of its patent stating that U.S. Patent 5,866,632 (Hashimoto) and a publication titled “Medical Adhesive” (Jiang) were pertinent to the patentability of those claims. Request for Ex parte Reexamination, filed March 22, 2007, pp. 2-6.

An examiner determined that a substantial new question was raised by the request as to Claims 1, 3, and 6. Order Granting Request for Ex Parte Reexamination dated April 11, 2007, pp. 3-5. The examiner ordered that Claims 1, 3, and 6 be reexamined. The examiner also ordered that Claims 2, 4, and 5 would be reexamined along with the other claims. *Id.* at 5. Claims 2-6 depend from Claim 1.

Appellant did not object to the reexamination of Claims 2, 4, and 5. Appellant responded by filing an amendment to Claim 1 and cancelling Claim 2. Amendment filed May 10, 2007.

The examiner entered rejections of Claims 1 and 3-6. Paper entered October 3, 2007. The claims were rejected relying on U.S. Patents 5,344,655 (Sakai); 5,866,632 (Hashimoto); 3,042,723 (Jenkner); and 3,221,745 (Coover).

Appellant answered with a second amendment to Claim 1 and added new Claims 7-10. Claims 7-10 also depend from Claim 1. Paper filed December 26, 2007, pp. 3-5. Appellant also argued that the rejections had been overcome. Paper filed November 30, 2007, pp. 6-12.

The examiner held that the amendments overcame the rejections. Paper entered January 14, 2008, pp. 2-3. The examiner also entered the four grounds of rejection now under appeal. These rejections relied on Tsubota alone or combined with various combinations of Sakai, Coover, Biale, and Eckert. *Id.* at 5-14.

The rejection of Claims 1, 3, 4, 6, and 8-10 over Tsubota alone is said to be impermissible since that rejection does not constitute a substantial new question of patentability. Br. 18-24.

The existence of a substantial new question of patentability is a prerequisite to the initiation of a reexamination proceeding by the Director. 35 U.S.C. § 303. Appellant, while casting its argument in terms of a substantial new question patentability, does not assert that a substantial new question sufficient to initiate this proceeding did not exist. Indeed, it was Appellant who requested reexamination of its patent and, after reexamination was ordered, took advantage of the reexamination provisions to twice amend its claims. Rather than challenge the propriety of initiating reexamination, Appellant seeks to estop the Director from entering a rejection that, in Appellant's view, was effectively overcome during the original prosecution. Thus, Appellant challenges the scope of the Director's authority under 35 U.S.C. § 305, delegated to the examiner, to conduct the reexamination and enter the rejection. Specifically, Appellant challenges the Director's authority to enter a rejection relying on Tsubota alone in a properly initiated reexamination. This is an issue totally separate from the issue of the patentability of claims over Tsubota. Not all decisions rendered by examiner's are subject to review by the Board.

Whether a disputed issue is reviewed by petition or by appeal generally depends on whether the issue relates to the process or procedures of examination or to the substantive merits of patentability. Issues relating to process or procedure are reviewed by petition, while issues relating to the substantive merits of patentability are reviewed by appeal to the Board. Section 1.181 of 37 CFR reflects this distinction in defining petitionable issues as those that are (1) not appealable to the Board, (2) by statute or rule to be decided or reviewed by the Director, and (3) to invoke the supervisory authority of the Director.⁹ In an *ex parte* reexamination, patent owners may only appeal “any decision adverse to the *patentability* of any original or proposed amended or new claim of the patent” and “the final *rejection* of any claim” (emphasis added). 35 U.S.C. §§ 306 and 134(b). In this appeal, in addition to seeking review of the examiner’s determination on the

⁹ **37 CFR 1.181. Petition to the Director.**

(a) Petition may be taken to the Director:

(1) From any action or requirement of any examiner in the *ex parte* prosecution of an application, or in *ex parte* or *inter partes* prosecution of a reexamination proceeding which is not subject to appeal to the Board of Patent Appeals and Interferences or to the court;

(2) In cases in which a statute or the rules specify that the matter is to be determined directly by or reviewed by the Director; and

(3) To invoke the supervisory authority of the Director in appropriate circumstances. For petitions involving action of the Board of Patent Appeals and Interferences, see § 41.3 of this title.

patentability of the subject matter claimed, Appellant seeks review of the examiner's decision to enter the rejection.

Appellant's challenge to the Office's authority to enter any rejection based on Tsubota because that reference fails to raise a substantial new question of patentability is not a challenge to the examiner's unpatentability decision. Appellant's estoppel argument does not challenge the merits of patentability (35 USC §§ 101, 102, and 103) or sufficiency of the specification (35 U.S.C. § 112), the substantive merits matters typically reviewed by the Board on appeal. Rather it challenges the correctness of the reexamination process. Appellant asks us, in effect, to order that the examiner withdraw the rejections. In other words, Appellant asks the Board to exercise supervisory authority over the examiner. The exercise of supervisory authority over the examination is clearly the prerogative of the Director and, in our view, must be raised by petition. 37 CFR § 1.181(a)(3). We agree with the examiner that the decision to enter the rejections over Tsubota is petitionable. We are unaware of and Appellant has not directed us to a jurisdictional basis for us to exercise such authority.

We withdrew our earlier opinion to consider the effect of the Notice on our decision. We hold that the Notice does not delegate authority to the Board to decide whether a particular rejection made during the course of prosecution following a properly initiated reexamination is outside the scope permitted in an ex parte reexamination. The notice addresses those situations where a patent owner challenges an examiner's threshold determination that a substantial new question has been presented. The Notice delegates the authority "to review issues related to the examiner's determination that a reference raises a SNQ" to the Chief APJ. Notice, 75

Fed. Reg. 36,357. The examiner's determination is not challenged in this appeal. Appellant requested that its patent be reexamined. Request for Ex parte Reexamination, filed March 22, 2007, pp. 1-6. The examiner held that a substantial new question had been raised by that request. Order Granting Request for Ex Parte Reexamination dated April 11, 2007, pp. 3-5. The examiner's determination that the cited references raise a SNQ is unchallenged.

Patentability

Appellant's allegations of error are principally limited to the subject matter of Claim 1. The additional recitations of dependent Claims 3-5 and 7-10 are not asserted as a basis of patentability separate from Claim 1. Appellant's brief also specifically references dependent Claim 6. We therefore limit our comments to Claims 1 and 6. 37 C.F.R. § 41.37(c)(1)(vii).

Product-by-Process

Appellant relies on a "product by process" recitation to distinguish the claimed subject matter from the prior art. Br. 13.

A claim to a product may include the process by which it is made. However, the patentability of a product ordinarily does not depend on the method of making it. *In re Pilkington*, 411 F.2d 1345, 1348 (CCPA 1969). If the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. *In re Marosi*, 710 F.2d 799, 803 (Fed. Cir. 1983); *Johnson & Johnson v. W.L. Gore*, 436 F.Supp. 704, 726 (D. Del. 1977); *see also In re Fessmann*, 489 F.2d 742, 744-45 (CCPA 1974). However, where the process recitation is shown to impart unobvious

characteristics or properties to the product that are not possessed by the prior art product, the product may be patentable. *Marosi*, 710 F.2d at 803.

(Where a product-by-process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden is upon the applicants to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.)

In other words, regardless of the process recitation, the product itself must have characteristics that patentably distinguish it from the products of the prior art. Thus, Appellant's arguments that the references relied upon by the examiner do not teach the process limitation, are unavailing. It is the properties and characteristics of the adhesive compositions that must be compared.

Appellant asserts two differences to patentably distinguish its composition from Tsubota's: (1) Tsubota's "adhesive" contains pores, while Appellant's "adhesive" is non-porous and (2) that appellant's adhesive is completely crosslinked while Tsubota's is not. Br. 13.

The Presence of Pores in the Adhesive Layer

In our view, the pores described by Tsubota do not patentably distinguish Appellant's composition. The pores are adhesive-free voids that are surrounded by crosslinked adhesive. Notwithstanding Appellant's argument to the contrary, the pores are not part of Tsubota's adhesive composition. The pores are part of the structure of Tsubota's air permeable "adhesive layer." Claim 1 is directed to an adhesive composition, not to an adhesive layer. An adhesive applied to a substrate, such as a patch, in a checkerboard pattern of alternating regions of adhesive and no-adhesive would similarly describe the structure of the adhesive layer, but would not

describe a property of the applied adhesive itself. As noted by the Examiner (Ans. 18), Claim 1 is directed to the adhesive itself, not to an adhesive layer or a medical tape having an adhesive layer.

For this reason, Appellant's declaration evidence, showing the formation of a pore-free "adhesive layer" is insufficient to demonstrate that the claimed adhesive composition is patentably distinguishable from the prior art adhesive composition.

The Presence of Uncrosslinked Polymer

Appellant's second distinction, the presence of both crosslinked and uncrosslinked polymer in Tsubota's adhesive, is more to the point. The presence of uncrosslinked polymer is a characteristic or property of the adhesive itself. Tsubota's adhesive includes crosslinked polymer in the regions of the adhesive contiguous with the pores. The remaining polymer is arguably uncrosslinked.

In the examiner's view, the claims do not require that the polymer in the composition be completely crosslinked. Ans. 19 and 20. We agree.

Claim 1 is directed to an:

adhesive to be affixed to a skin surface, . . . comprising a polymer . . . the polymer is crosslinked by boric acid or a boric acid derivative and substantially no water is used in production of the adhesive.

Br. 29 (emphasis added). The transitional word "comprising" is a term of art in claim drafting indicating that the claim is open ended. Comprising means that the named elements are essential, but other elements may be added.

Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501 (Fed. Cir. 1997). A claim drafter uses the term "comprising" to mean "I claim at least what follows and potentially more." *Vehicular Techs. Corp. v. Titan Wheel Intl.*

Inc., 212 F.3d 1377, 1383 (Fed. Cir. 2000). Regardless of the transitional phrase used, claims must be read in light of specification and teachings in the underlying patent. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Additionally, “the prosecution history can often inform the meaning of the claim language by demonstrating how the inventor understood the invention and whether the inventor limited the invention in the course of prosecution, making the claim scope narrower than it would otherwise be.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1317 (Fed. Cir. 2005) (en banc).

Review of the record does not reveal a clear indication that the applicant departed from the generally understood meaning of “comprising.” Nothing in the claim language, specification, or prosecution history compels an exceptional reading of “comprising” to require the presence of only crosslinked polymer.

There are two recitations in Claim 1 of interest on this point: (1) the functional recitation that the adhesive is “to be affixed to a skin surface,” and (2) the product-by-process recitation stating that “substantially no water is used in production of the adhesive.”

The functional recitation would certainly exclude any polymers or other additions that would preclude affixing the adhesive to the skin. However, the presence of uncrosslinked polymer would not have this result. Tsubota’s adhesive, which includes both crosslinked and uncrosslinked polymer, is said to be for use in adhering the tape to skin. E.g., Tsubota 1:12-21 and 2:33-36.

The product-by-process recitation also does not preclude the presence of uncrosslinked polymer in the claimed composition. The patentability of

the adhesive is determined by a comparison of the claimed composition with the prior art adhesive. On this record there is no basis to conclude that the crosslinked polymer formed according to Tsubota's technique is patentably different than the crosslinked polymer formed without using an aqueous solvent. The fact that water is excluded as a solvent simply does not compel a conclusion that uncrosslinked polymer is excluded from the scope of Appellant's Claim 1. While Tsubota describes using water to create voids in the adhesive layer, Tsubota removes the water (Tsubota 2:48-49) leaving an adhesive containing "substantially no water" as defined by Appellant. Written Description, p. 5, ll. 3-6.

Looking to the specification, Appellant identifies a variety of additional materials that may be added to the adhesive. These include liquids compatible with the polymer; such as absorption promoting agents, solubilizing agents, and plasticizers. Written Description, p. 9, ll. 4-9. A wide variety of drugs may also be incorporated. Written Description, p. 10, l. 3 – p. 14, l. 8. Additionally, antioxidants, preservatives, ultraviolet-absorbing agents, and anti crystallizing agents can be incorporated. Written Description, p. 15, l. 26 – p. 16, l. 19. Thus, Appellant contemplates that Claim 1 encompasses numerous additional components not specifically recited in that claim.

While Appellant's Examples 1 and 2 appear to describe completely crosslinked adhesives, claims are not ordinarily construed to be limited to the disclosed preferred embodiments. *Laitram Corp. v. Cambridge Wire Cloth Co.*, 863 F.2d 855, 865 (Fed. Cir. 1988) ("References to a preferred embodiment, such as those often present in a specification, are not claim

limitations.”) And Appellant has specifically stated that the claims are not limited to the examples:

[T]he present invention is not limited to these Examples and can be modified in a variety of ways without departing from the scope and spirit of the present invention.

Written Description, p. 17, ll. 22-24.

Looking to the prosecution history, we do not see a clear disavowal by Appellant that the scope of Claim 1 excludes adhesives that include uncrosslinked as well as crosslinked polymer. An argument made to the Office constitutes a disclaimer only if it is “clear and unmistakable.” *Schindler Elevator Corp. v. Otis Elevator Co.*, 593 F.3d 1275, 1285 (Fed. Cir. 2010); *Purdue Pharma L.P. v. Endo Pharms., Inc.*, 438 F.3d 1123, 1136 (Fed. Cir. 2006). An “ambiguous disavowal” will not suffice. *Computer Docking Station Corp. v. Dell, Inc.*, 519 F.3d 1366, 1375 (Fed. Cir. 2008). While Appellant has consistently argued that certain language of Claim 1 would not have been obvious, Appellant has not directly answered the Examiner’s claim scope issue. We fail to see any clear indication that an adhesive composition including both crosslinked and uncrosslinked polymer is outside the scope of Claim 1. The issue is whether Claim 1 excludes the presence of uncrosslinked polymer, not whether a totally crosslinked polymer would have been obvious.

Based upon the record argued before us, we conclude that the broadest reasonable construction of the claims does not exclude adhesives comprising both crosslinked and uncrosslinked polymer.¹⁰ Considering the claim

¹⁰ In this regard, we note that Appellant, as the author of its claims, has the responsibility to present claims that clearly and unambiguously

language, the written description and the prosecution history, the relevant question is: Does Tsubota describe an adhesive “comprising a polymer . . . the polymer crosslinked by boric acid?” In light of the presence of boric acid-crosslinked polymer in the adhesive composition described by Tsubota, we think the answer is yes. Appellant’s claim 1 encompasses subject matter that is not patentably distinct from the prior art. Claim 1 is, therefore, unpatentable. A claim that encompasses unpatentable subject matter is unpatentable notwithstanding that the claim may also encompass patentable subject matter. *In re Muchmore*, 433 F.2d 824, 826, (CCPA 1970) (noting that the appellant’s claims were too broad in the sense of section 103, since they read on both obvious and unobvious subject matter).

Appellant’s argument that Tsubota teaches away from a completely crosslinked adhesive is not persuasive in light of our conclusion that Claim 1 does not preclude uncrosslinked adhesive.

We affirm the examiner’s rejections of Claim 1. Since the subject matter of dependent Claims 3-5 and 7-10 have not been asserted to be patentable for reasons different than Claim 1, we affirm the rejections of those claims also. 37 C.F.R. § 41.37(c)(1)(vii).

distinguish its subject matter from the prior art. During the reexamination before the examiner, Appellant had ample opportunity to amend the claims. It would have been a relatively simple matter for Appellant to have modified their claims to exclude the presence of uncrosslinked polymer. Indeed, we think that under circumstances such as those here, where the claims could have been simply amended to clearly exclude uncrosslinked polymer, it would be inappropriate for the Office to accept a disavowal of scope, no matter how clearly stated, in lieu of an amendment to the claims. It should not require litigation to determine to the scope of the subject matter the inventors claim as their property.

Claim 6

Appellant makes separate reference to Claim 6. This claim adds the recitation that “the boron-containing compound is dissolved in a hydrophilic organic solvent.” Appellant notes the pores present in Tsubota’s adhesive layer and again argues that “Claim 6 produced with boric acid or boric acid derivative dissolved in hydrophilic organic solvent does not contain these communicating pores.” E.g., Br. 24.

The additional language of Claim 6 is a statement of how the adhesive is produced. This process step alone can not patentably distinguish the adhesive composition absent some unobvious characteristic or property not shared with the prior art adhesive. *Marosi*, 710 F.2d at 803. Appellant argues that the pores are the distinguishing characteristic. E.g., Br. 24. For the reasons stated above, we disagree that the pores are a required part of Tsubota’s adhesive composition. The presence of pores in Tsubota’s adhesive layer does not patentably distinguish Tsubota’s disclosed composition from Appellant’s.

We affirm the examiner’s rejections of Claim 6.

Final Decision

We affirm the Examiner’s rejections of Claims 1 and 3-10 under 35 U.S.C. § 103(a).

AFFIRMED

KMF

THE HARRIS FIRM
922 N Street, N.W., SUITE 101
Washington, D.C. 20001