

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

RECKITT BENCKISER LLC,
Petitioner,

v.

ANSELL HEALTHCARE PRODUCTS LLC,
Patent Owner.

Case IPR2017-00063
Patent 9,074,027 B2

Before MICHAEL J. FITZPATRICK, SUSAN L. C. MITCHELL, and
AMANDA F. WIEKER, *Administrative Patent Judges*.

FITZPATRICK, *Administrative Patent Judge*.

DECISION
Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Reckitt Benckiser LLC, filed a Petition to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 9,074,027 B2 (Ex. 1001, “the ’027 patent”) pursuant to 35 U.S.C. § 311(a). Paper 2 (“Pet.”). Patent Owner, Ansell Healthcare Products LLC, waived filing a Preliminary Response under 35 U.S.C. § 313. Paper 11.

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a). Upon consideration of the Petition, and for the reasons explained below, we determine that the information presented shows a reasonable likelihood that Petitioner would prevail with respect to at least one claim challenged in the Petition. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108. We institute an *inter partes* review of the challenged claims.

A. Related Matters

The parties identify *Ansell Healthcare Products LLC v. Reckitt Benckiser LLC*, C.A. No. 1:15-cv-00915 (D. Del.). Pet. 2–3; Paper 8, 2. The parties also identify a petition, filed by Petitioner, requesting an *inter partes* review of the claims of related U.S. Patent No. 9,074,029 B2. Pet. 2–3; Paper 8, 2; IPR2017-00066.

B. The ’027 Patent

“The invention [of the ’027 patent] relates to producing synthetic polyisoprene articles and method therefor with improved inter particle and intra particle bond using controlled *pre-vulcanized* particles of synthetic latex that is dip formed into a thin latex article from an aqueous latex

emulsion.” Ex. 1001, 1:20–24 (emphasis added). In describing the invention, the specification consistently describes the synthetic latex particles as pre-vulcanized. *See, e.g., id.* at 4:50–53 (“The present invention provides a latex article that is formed by dipping a condom shaped former in a *pre-vulcanized* synthetic latex emulsion without use of any coagulants and curing the condom thus produced.” (emphasis added)), 16:38–41 (“[T]he present invention provides an article made from the above-described surfactant-stabilized, *pre-vulcanized*, synthetic polyisoprene latex emulsion composition.” (emphasis added)). Pre-vulcanization is accomplished by incorporating sulfur within the interstices of the synthetic latex particles. *Id.* at 4:55–57 (“The synthetic latex particles in the latex emulsion are pre-vulcanized by the incorporation of sulfur within the interstices of latex particles.”); *see also id.* at 4:58–5:8 (explaining the pre-vulcanization process in more detail). The ’027 patent further states:

The present invention is predicated on the discovery that soluble sulfur, such as S₈ rings of sulfur, is catalyzed by a zinc complex of dithiocarbamate in combination with potassium caprylate and sodium dodecyl benzene sulphonate (SDBS) surfactant creating pre-vulcanized, synthetic polyisoprene particles in a latex composition.

Ex. 1001, 8:36–41(emphasis added).

C. The Challenged Claims

The ’027 patent includes twenty claims, all of which are challenged. Only claim 1 is independent. It is illustrative and reproduced below.

1. A synthetic, dip-formed polyisoprene elastomeric condom comprising:

synthetic polyisoprene particles, said synthetic polyisoprene particles bonded to each other through intra-polyisoprene particle crosslinks and inter-polyisoprene particle crosslinks;

wherein the intra-polyisoprene particle crosslinks and the inter-polyisoprene particle crosslinks are such that the molecular weight is less than about 8000 g/mol between the crosslinks.

Thus, claim 1 recites “synthetic polyisoprene particles” without also reciting that they are pre-vulcanized. The term “pre-vulcanized” also is not recited by any of claims 2–20.

D. Asserted Ground of Unpatentability

Petitioner asserts that claims 1–20 are unpatentable on the ground that they are anticipated by U.S. Patent Application Publication No. US2009/0272384 A1 (“the ’384 publication”), which published November 5, 2009. Pet. 6; Ex. 1010.

II. ANALYSIS

A. Claim Construction

“A claim in an unexpired patent that will not expire before a final written decision is issued shall be given its broadest reasonable construction in light of the specification of the patent in which it appears.” 37 C.F.R. § 42.100(b). Pursuant to that standard, the claim language should be read in light of the specification, as it would be interpreted by one of ordinary skill in the art. *In re Suitco Surface, Inc.*, 603 F.3d 1255, 1260 (Fed. Cir. 2010). Thus, we generally give claim terms their ordinary and customary meaning. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007) (“The

ordinary and customary meaning ‘is the meaning that the term would have to a person of ordinary skill in the art in question.’” (quoting *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005) (en banc))).

Petitioner proposes that “synthetic polyisoprene particles” be construed to “encompass both (1) synthetic polyisoprene articles that include ***‘pre-vulcanized’*** synthetic polyisoprene particles, and (2) synthetic polyisoprene particles that do not include ***‘pre-vulcanized’*** synthetic polyisoprene particles.” Pet. 20–21. Petitioner’s proposed construction is supported by the specification, which discloses that synthetic polyisoprene and other synthetic latex particles may be pre-vulcanized *or not*. See, e.g., 3:31–35 (pointing out that, in certain prior art patents, “the addition of antioxidants does not pre-vulcanize the synthetic polyisoprene latex”), 4:12–16 (pointing out that, in a certain prior art patent, “accelerators are not indicated to pre-vulcanize the synthetic polyisoprene particles”), 4:55–57 (“The synthetic latex particles in the latex emulsion are pre-vulcanized by the incorporation of sulfur within the interstices of latex particles.”).

In light of the record before us at this time, we adopt Petitioner’s proposed construction.

B. The ’384 Publication as Prior Art

The ’384 publication was published November 5, 2009, before the June 5, 2013, filing date of the ’027 patent. Thus, unless the challenged claims of the ’027 patent are entitled to an earlier effective filing date, the ’384 publication is prior art to them. See 35 U.S.C. § 102(a)(1).

The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29,

which was enacted September 16, 2011, amended 35 U.S.C. § 102 from what we term here its “pre-AIA” version to its “post-AIA version.” AIA § 3(b). The post-AIA version of 35 U.S.C. § 102 became effective eighteen months later—on March 16, 2013. *Id.* at § 3(n). The post-AIA version applies to any patent issuing from an application that contains (or ever contained) “a claim to a claimed invention that has an effective filing date . . . that is on or after the effective date described in this paragraph,” i.e., March 16, 2013. AIA § 3(n)(1)(B).

Petitioner’s asserted ground of unpatentability is premised on all of the claims of the ’027 patent having an effective filing date of June 5, 2013, which is later than the March 16, 2013, effective date of the AIA amendment to 35 U.S.C. § 102. If that is the case, as we preliminarily find below, then the post-AIA version of 35 U.S.C. § 102 would apply, and the ’384 publication would be prior art under 35 U.S.C. § 102(a)(1).¹

C. Effective Filing Date of the Challenged Claims

The ’027 patent claims priority to multiple parent applications, stating:

This application is a continuation of U.S. patent application Ser.

¹ The ’384 publication was published more than one year before the ’027 patent was filed. Thus, even if the pre-AIA version of 35 U.S.C. § 102 were to apply, the ’384 publication would still be prior art to the claims of the ’027 patent (unless they are entitled to an earlier effective filing date). *See* 35 U.S.C. § 102(b) (2002); Pet. 6 n.1 (arguing the same). Unless otherwise indicated, our citation herein to a section of Title 35 is to its post-AIA version.

No. 13[/]277,445 [“the ’445 application”], filed Oct. 20, 2011, now U.S. Pat. No. 8,464,719, which is a continuation of Ser. No. 12[/]194,118 [“the ’118 application”], filed Aug. 19, 2008, now U.S. Pat. No. 8,087,412 which in tum claims priority to U.S. Patent Application Ser. No. 61[/]049,637 [“the ’637 application”], filed May 1, 2008.

Ex. 1001, 1:9–14. The challenged claims could have an effective filing date based on these parent applications, but only if the parent applications disclose the claimed inventions of the challenged claims in the manner provided by 35 U.S.C. § 112(a). *See* 35 U.S.C. §§ 119(e), 120.

Petitioner argues that none of the parent applications provides adequate written description support for the claims of the ’027 patent. Pet. 29–47. In doing so, Petitioner focuses on the written description requirement and not, for example, the enablement requirement of 35 U.S.C. § 112(a). *Id*; *see also Ariad Pharm., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (“Since its inception, this court has consistently held that § 112, first paragraph [now § 112(a)], contains a written description requirement separate from enablement, and we have articulated a ‘fairly uniform standard,’ which we now affirm.”) (citing *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1562–63 (Fed. Cir. 1991)).

The purpose of the “written description” requirement is broader than to merely explain how to “make and use”; the applicant must also convey with reasonable clarity to those skilled in the art that, as of the filing date sought, he or she was in possession *of the invention*. The invention is, for purposes of the “written description” inquiry, *whatever is now claimed*.

Vas-Cath, 935 F.2d at 1563–64. The written description requirement “guards against the inventor’s overreaching by insisting that he recount his

invention in such detail that his future claims can be determined to be encompassed within his original creation.” *Id.* at 1561; *see also ICU Med., Inc. v. Alaris Med. Sys.*, 558 F.3d 1368, 1376 (Fed. Cir. 2009) (“[T]he purpose of the written description requirement is to ensure that the scope of the right to exclude, as set forth in the claims, does not overreach the scope of the inventor’s contribution to the field of art as described in the patent specification.” (internal quotations omitted)). The test for sufficiency of the written description “is whether the disclosure of the application relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharm.*, 598 F.3d at 1351.

Petitioner argues that the parent applications describe (and claim) only synthetic polyisoprene elastomeric products having pre-vulcanized synthetic polyisoprene particles (and methods of manufacturing the same). Pet. 13–18, 30; *see also* Ex. 1005 (the ’637 application); Ex. 1006 (the ’118 application); Ex. 1007 (the ’445 application). On the present record, we agree with Petitioner. For example, like the ’027 patent, each of the parent applications states:

The present invention is predicated on the discovery that soluble sulfur, such as S₈ rings of sulfur, is catalyzed by a zinc complex of dithiocarbamate in combination with potassium caprylate and sodium dodecyl benzene sulphonate (SDBS) surfactant creating pre-vulcanized, synthetic polyisoprene particles in a latex composition.

Ex. 1005 ¶22; Ex. 1006 ¶29; Ex. 1007 ¶29; Ex. 1001, 8:36–41 (emphasis added). As another example, and like the ’027 patent, each of the parent applications also states:

The present invention provides a latex article that is formed by dipping a condom shaped former in a *pre-vulcanized* synthetic latex emulsion without use of any coagulants and curing the condom thus produced.

Ex. 1005 ¶17; Ex. 1006 ¶18; Ex. 1007 ¶18; Ex. 1001, 4:50–53 (emphasis added).

Petitioner has shown sufficiently that the claims of the '027 patent are not entitled to the benefit of the filing date of any of the parent applications. Accordingly, on the present record, the '384 publication is prior art. *See* 35 U.S.C. § 102(a)(1).

D. Claims 1–20 as Anticipated by the '384 Publication

Petitioner argues that the '384 publication anticipates each of claims 1–20. In a claim chart, Petitioner maps the teachings of the '384 publication to each of the challenged claims. Pet. 52–63. We are persuaded based on the record before us that Petitioner has shown a reasonable likelihood of success that the teachings of the '384 publication that it identifies anticipate claims 1–20. It is noteworthy that the '384 publication is virtually identical to that of the '027 patent, save the latter's claims. *Compare* Ex. 1010, *with* Ex. 1001.

The '384 publication is the '118 application as published, and the '118 application is one of the parent applications to which the '027 patent claims priority. A parent application, however, may anticipate a claimed invention even though it fails to provide written description support of the claimed invention. *See, e.g., In re Lukach*, 442 F.2d 967, 969–970 (C.C.P.A. 1971) (“[T]he description of a single embodiment of broadly claimed subject matter constitutes a description of the invention for anticipation purposes,

whereas the same information in a specification might not alone be enough to provide a description of that invention for purposes of adequate disclosure.”) (internal citations omitted); *Chester v. Miller*, 906 F.2d 1574, 1577 (Fed. Cir. 1990) (rejecting the proposition that “it is legally anomalous for the EIC [examiner-in-chief] first to assert that the ’280 patent fails to provide sufficient written description to support his CIP [continuation-in-part] claims and then find that the ’280 patent anticipates those very claims”).

On the present record, Petitioner has shown sufficiently for purposes of institution that the ’384 publication teaches all the limitations of each claim of the ’027 patent.

III. CONCLUSION

We have considered the information presented in the Petition and determine that there is a reasonable likelihood that Petitioner would prevail with respect to at least one claim challenged in the Petition. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.108.

IV. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314, an *inter partes* review of claims 1–20 of U.S. Patent No. 9,074,027 B2 is hereby instituted on the ground that they allegedly are anticipated by U.S. Patent Application Publication No. US2009/0272384 A1; and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial

IPR2017-00063
Patent 9,074,027 B2

commences on the entry date of this Decision.

IPR2017-00063
Patent 9,074,027 B2

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