

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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RECKITT BENCKISER LLC,  
Petitioner,

v.

ANSELL HEALTHCARE PRODUCTS LLC,  
Patent Owner.

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Case IPR2017-00066  
Patent 9,074,029 B2

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

FITZPATRICK, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a)*

## I. INTRODUCTION

### A. Procedural History

Petitioner, Reckitt Benckiser LLC, filed a Petition to institute an *inter partes* review of claims 1–20 of U.S. Patent No. 9,074,029 B2 (Ex. 1002, “the ’029 patent”) pursuant to 35 U.S.C. § 311(a). Paper 1 (“Pet.”). Patent Owner, Ansell Healthcare Products LLC, waived filing a Preliminary Response under 35 U.S.C. § 313 and 37 C.F.R. § 42.107(a). Paper 8. In a February 1, 2017, Decision, we instituted an *inter partes* review of all challenged claims. Paper 9 (“Inst. Dec.”).

Patent Owner filed a Patent Owner Response (Paper 13, “PO Resp.”) to which Petitioner filed a Reply (Paper 18, “Reply”). Patent Owner also filed Observations on Cross-Examination. Paper 22. Petitioner filed a Response to the Observations and, after obtaining authorization, a Motion to Expunge the Observations. Papers 26 and 28. Patent Owner filed an Opposition to the Motion to Expunge. Paper 30.

Both parties requested a hearing for oral argument (Papers 21 and 23), and a consolidated hearing for this *inter partes* review and related Case IPR2017-00063 was held September 27, 2017. *See* Paper 34 (“Tr.”).

As discussed below, Petitioner has shown by a preponderance of the evidence that all of the challenged claims are unpatentable.

### B. Related Matters

The parties identify *Ansell Healthcare Products LLC v. Reckitt Benckiser LLC*, C.A. No. 1:15-cv-00915 (D. Del.). Pet. 3; Paper 5, 2.

Additionally, related U.S. Patent No. 9,074,027 B2 (“the ’027 patent”) is the subject of Case IPR2017-00063.

### C. The ’029 Patent

“The invention [of the ’029 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. 1002, 1:22–26 (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)), 16:47–50 (“[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 ’029 patent further states:

*The present invention is predicated on the discovery that soluble sulfur, such as S<sub>8</sub> 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. 1002, 8:36–41(emphasis added).

The '029 patent was filed on February 10, 2014. *Id.* at [22].

However, it claims priority to multiple parent applications, stating:

This application is a continuation of U.S. patent application Ser. No. 13/910,364 [now the '027 patent, Ex. 1001], filed on Jun. 5, 2013, which is a continuation of U.S. patent application Ser. No. 13/277,445 [“the '445 application,” Ex. 1007], filed Oct. 20, 2011 (now U.S. Pat. No. 8,464,719 [“the '719 patent,” Ex. 1004], issued on Jun. 18, 2013), which is a continuation of U.S. patent application Ser. No. 12/194,118 [“the '118 application,” Ex. 1006], filed Aug. 19, 2008 (now U.S. Pat. No. 8,087,412 [“the '412 patent,” Ex. 1003], issued on Jan. 3, 2012), which in turn claims priority to U.S. Patent Application Ser. No. 61/049,637 [“the '637 application,” Ex. 1005], filed May 1, 2008.

*Id.* at 1:9–18. Every independent claim of each of these parent patents and the provisional application recites a limitation explicitly directed to pre-vulcanization, except those of the also challenged '027 patent. *See* Ex. 1004, 17:4–5 (claim 1 of '719 patent reciting “synthetic polyisoprene particles that are pre-vulcanized and cured”); Ex. 1003, 17:51–52 (claim 1 of the '412 patent reciting “synthetic polyisoprene particles that are pre-vulcanized and cured”), 18:26–27 (claim 10 of the '412 patent reciting “synthetic polyisoprene particles that are pre-vulcanized”), 18:45 (claim 13 of the '412 patent reciting “pre-vulcanizing the synthetic polyisoprene particles”); Ex. 1005, 23 (claim 1 of the '637 application reciting “synthetic polyisoprene particles that are pre-vulcanized and cured”), 24 (claim 8 of the '637 application reciting “pre-vulcanize synthetic polyisoprene particles”).

#### D. The Challenged Claims

The '029 patent includes twenty claims, all of which are challenged. Only claim 1 is independent. It is illustrative and reproduced below.

1. A synthetic polyisoprene elastomeric glove or condom made of a layer of elastomer comprising:

synthetic polyisoprene particles;  
inter-polyisoprene particle crosslinks; and  
intra-polyisoprene particle crosslinks,

wherein the intra-polyisoprene particle crosslinks and inter-polyisoprene particle crosslinks are substantially uniformly distributed among and between the synthetic polyisoprene particles.

Critical to this Decision, claim 1 generally recites “synthetic polyisoprene particles” without specifying whether they are pre-vulcanized. The term “pre-vulcanized” also is not recited by any of claims 2–20.

#### E. 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 was published November 5, 2009. Pet. 6; Ex. 1010. The '384 publication is the publication of the '118 application, one of the parent applications to which the '029 patent claims priority. Ex. 1010, at [21]; Ex. 1002, 1:13–14. The '118 application and the '384 publication each contain the identical description (apart from the claims) as the challenged '029 patent.

Patent Owner does not dispute, and logically cannot dispute, that the '384 publication, if prior art, anticipates the challenged claims. *See*

*generally* PO Resp. Indeed, Patent Owner argues that the same disclosure, set forth in the underlying '118 application, provides a written description, sufficient under 35 U.S.C. § 112(a), of the full scope of the challenged claims, and, as a result, renders their effective filing date prior to the publication date of '384 publication pursuant to 35 U.S.C. § 120. *See, e.g.*, PO Resp. 34 (“[T]he '029 patent claims find support in all priority applications.”).

## II. ANALYSIS

“A person shall be entitled to a patent unless—(1) the claimed invention was patented, described in a printed publication, or in public use, on sale, or otherwise available to the public before the effective filing date of the claimed invention.” 35 U.S.C. § 102(a)(1).<sup>1</sup> Patent Owner concedes that the challenged claims are described in the '384 publication—a printed publication. Patent Owner concedes this by arguing that the same disclosure, set forth in the underlying '118 application, provides adequate written description of the claims under 35 U.S.C. § 112(a). *See, e.g.*, PO Resp. 34 (“[T]he '029 patent claims find support in all priority applications.”).

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<sup>1</sup> The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, which was enacted on September 16, 2011, made amendments to 35 U.S.C. §§ 102, 103. AIA § 3(b), (c). Those amendments became effective eighteen months later on March 16, 2013. *Id.* at § 3(n). Because the application from which the '029 patent issued was filed after March 16, 2013, and because the challenged claims are not entitled to an effective filing date prior to March 16, 2013 (as discussed below), the post-AIA version of 35 U.S.C. § 102 applies. Thus, any citations herein to § 102 are to its post-AIA version.

The dispute before us is whether that description, set forth in a printed publication on November 5, 2009, (*see* Ex. 1010, at [43]), was before the effective filing date of the challenged claims. It clearly was before the actual filing date of the '029 patent, which was February 10, 2014. Ex. 1002, at [22]. An earlier effective filing date, however, is potentially available to Patent Owner under 35 U.S.C. § 120. Petitioner argues that Patent Owner is not entitled to an earlier effective filing because none of the parent applications to the '029 patent contains adequate written description support for the claims of the '029 patent. Pet. 29–47. As previously noted, Patent Owner argues to the contrary. PO Resp. 30–35. And, as discussed below, resolution of this issue, and thus this case, turns on claim construction.

#### 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))).

Claim 1, the only independent claim, recites: “A synthetic polyisoprene elastomeric glove or condom made of a layer of elastomer comprising: synthetic polyisoprene particles . . . .” None of the claims recites that the synthetic polyisoprene particles are “pre-vulcanized.” This case turns on whether the challenged claims require synthetic polyisoprene particles that are pre-vulcanized.

In addressing this issue, Petitioner first construes the term “‘synthetic polyisoprene particles’ [as] not limited to pre-vulcanized synthetic polyisoprene particles.” Pet. 21. Patent Owner does not dispute this construction. PO Resp. 23 (“The term ‘synthetic polyisoprene particles’ in isolation may be generic with regard to whether the particles are pre-vulcanized or not.”), 31 (“The term ‘synthetic polyisoprene particle’ may, on its face, be generic with regard to whether the particle is pre-vulcanized or not.”); Tr. 26:8–10 (“Patent Owner has not disputed that synthetic polyisoprene particles, that claim term when it’s read in isolation, that it should get its plain and ordinary meaning and that’s generic.”). Next, Petitioner construes the claims as, thus, “encompass[ing] both (1) synthetic polyisoprene articles [i.e., gloves or condoms] that include ***‘pre-vulcanized’*** synthetic polyisoprene particles, and (2) synthetic polyisoprene particles that do not include ***‘pre-vulcanized’*** synthetic polyisoprene particles.” Pet. 21. Patent Owner disputes this latter construction.

Patent Owner argues that, even though “‘synthetic polyisoprene particles’ in isolation may be generic with regard to whether the particles are pre-vulcanized or not” (PO Resp. 19), the claims nonetheless require that such particles are pre-vulcanized. *Id.* at 19–22. This is so, as Patent Owner



argues, because a person of ordinary skill in the art could not achieve other limitations of the claims unless the admittedly generically recited “synthetic polyisoprene particles,” in fact, had been pre-vulcanized. *See, e.g., id.* at 19 (“[T]he structural features recited in every claim—the presence of discrete SPI particles including intra- and inter-polyisoprene particle crosslinks having a substantial uniformity of distribution of the crosslinks among and between the SPI particles—would not be present in a condom that does not include pre-vulcanized SPI particles.”) (citing Ex. 2001 ¶¶40, 49, 54–56), 13 (“[A] condom that includes the recited synthetic polyisoprene particles and associated structural features cannot be achieved if the condom does not include pre-vulcanized SPI [synthetic polyisoprene] particles.”) (citing Ex. 2001 ¶¶41, 46–49, 53, 54, 56, and 62). According to Patent Owner, “[t]he fact that SPI particles exist in the finished product in the claims, and that those particles include intra- and inter-particle crosslinks, precludes articles that do not include pre-vulcanized polyisoprene particles in the claimed condoms.” *Id.* (citing Ex. 2001 ¶¶47, 49). Patent Owner argues that a person of ordinary skill in the art could not obtain, in a finished product (i.e., a glove or condom<sup>2</sup>), the explicitly recited SPI “particles,” “inter-polyisoprene particle crosslinks,” “intra-polyisoprene particle crosslinks,” or the crosslinks being “substantially uniformly distributed among and between

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<sup>2</sup> Patent Owner’s arguments repeatedly mention condoms only but we understand Patent Owner’s arguments as applying to gloves as well. *See* claim 1 (“A synthetic polyisoprene elastomeric *glove or condom . . .*”) (emphasis added).

the synthetic polyisoprene particles” by using only non-pre-vulcanized SPI; rather, pre-vulcanized SPI would be required. *Id.* at 19–22. Without pre-vulcanization, Patent Owner argues that no particles would survive the manufacturing process and there could be no crosslinks among and between the non-existent particles or uniformly distributed. *Id.*

We are not persuaded by Patent Owner’s arguments or its extrinsic evidence offered in support, including Dr. Ho’s opinion that “the claims recite structural features that would have [led] a [person of ordinary skill in the art] to understand that the claims exclude[] condoms that do not contain pre-vulcanized SPI particles.” Ex. 2001 ¶54. That a person of ordinary skill in the art might not be able to make a glove or condom that is within the scope of the challenged claims using only *non*-pre-vulcanized synthetic polyisoprene particles, as Patent Owner argues, does not mean that Patent Owner did not include such a glove or condom within the scope of those claims. We determine that Patent Owner did, as the intrinsic evidence overwhelmingly demonstrates.

The specification of the ’029 patent, like all of the parent applications, repeatedly emphasizes using SPI particles that are “pre-vulcanized” to make condoms and the like. *See, e.g.*, Ex. 1002, 1:20–24, 4:50–53, 16:47–50; *see also id.* at 4:58–5:8 (explaining the pre-vulcanization process). In fact, the specification of the ’029 patent, like all of the parent applications, states:

The present invention is *predicated* on the discovery that soluble sulfur, such as S<sub>8</sub> 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. 1002, 8:36–41 (emphasis added).

“Where multiple patents derive from the same parent application and share many common terms, we must interpret the claims consistently across all asserted patents.” *SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1316 (Fed. Cir. 2015) (quotation marks omitted). With one exception, every independent claim in every patent in the priority chain of the ’029 patent (as well as the original provisional application) recites a limitation explicitly directed to pre-vulcanization despite also explicitly reciting features Patent Owner argues can only be achieved with pre-vulcanized SPI.<sup>3</sup> *See* Ex. 1004, 17:4–5 (claim 1 of ’719 patent reciting “synthetic polyisoprene particles that are pre-vulcanized and cured”); Ex. 1003, 17:51–52 (claim 1 of the ’412 patent reciting “synthetic polyisoprene particles that are pre-vulcanized and cured”), 18:26–27 (claim 10 of the ’412 patent reciting “synthetic polyisoprene particles that are pre-vulcanized”), 18:45 (claim 13 of the ’412 patent reciting “pre-vulcanizing the synthetic polyisoprene particles”); Ex. 1005, 23 (claim 1 of the ’637 application reciting “synthetic polyisoprene particles that are pre-vulcanized and cured”), 24 (claim 8 of the ’637 application reciting “pre-vulcanize synthetic polyisoprene particles”). Patent Owner’s claim construction position for the ’029 patent would render the explicit pre-vulcanization limitations in the related patents meaningless, as its counsel acknowledged at the hearing. Tr. 37:13–38:3.

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<sup>3</sup> The lone exception is independent claim 1 of the ’027 patent, which is also being challenged by Petitioner in a separate *inter partes* review, which involves the same claim construction issue. *See* Case IPR2017-00063.

Construing claims in a manner that renders some claim language meaningless is generally disfavored. *See, e.g., Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 296 F.3d 1106, 1115 (Fed. Cir. 2002) (proposed construction that rendered a portion of the claim language meaningless held improper); *Haemonetics Corp. v. Baxter Healthcare Corp.*, 607 F.3d 776, 781 (Fed. Cir. 2010) (“[W]e construe claims with an eye toward giving effect to all of their terms even if it renders the claims inoperable or invalid.”) (internal citation omitted). Patent Owner has not presented evidence sufficient to persuade us that we should construe the claims before us in a manner that would render the pre-vulcanization limitations in the claims of the related patents meaningless.

Pre-vulcanization is not some ancillary feature but rather the very heart of the invention described in the '029 patent and described and claimed in the related patents. *See, e.g., Ex. 1002*, 8:36–41 (“The present invention is *predicated on the discovery* [of a chemical reaction] creating *pre-vulcanized*, synthetic polyisoprene particles in a latex composition.”) (emphasis added); *Ex. 1003*, 8:28–33 (same); *Ex. 1004*, 8:34–39 (same). Despite this, Patent Owner chose to generically recite “synthetic polyisoprene particles,” which, standing alone, admittedly includes both non-pre-vulcanized and pre-vulcanized synthetic polyisoprene particles, in the '029 patent. We find that a person of ordinary skill in the art, reading the claims would understand them to be inclusive of pre-vulcanized synthetic polyisoprene particles and non-pre-vulcanized synthetic polyisoprene particles.

In sum, we agree with Petitioner that the challenged claims “encompass both (1) synthetic polyisoprene articles [i.e., gloves and condoms] that include ‘pre-vulcanized’ synthetic polyisoprene particles, and (2) synthetic polyisoprene particles that do not include ‘pre-vulcanized’ synthetic polyisoprene particles.” *See* Pet. 21 (italic and bold typeface removed).

#### B. Effective Filing Date of the Challenged Claims

The ’029 patent claims priority to multiple parent applications, stating:

This application is a continuation of U.S. patent application Ser. No. 13/910,364 [now the ’027 patent], filed on Jun. 5, 2013, which is a continuation of U.S. patent application Ser. No. 13/277,445, filed Oct. 20, 2011 (now U.S. Pat. No. 8,464,719, issued on Jun. 18, 2013), which is a continuation of U.S. patent application Ser. No. 12/194,118, filed Aug. 19, 2008 (now U.S. Pat. No. 8,087,412, issued on Jan. 3, 2012), which in turn claims priority to U.S. Patent Application Ser. No. 61/049,637, filed May 1, 2008.

Ex. 1002, 1:9–18. 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 support for the claims of the ’029 patent that suffices under 35 U.S.C. § 112(a). 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 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). We agree with Petitioner. For example, like the '029 patent, each of the parent applications states:

*The present invention is predicated on the discovery that soluble sulfur, such as S<sub>8</sub> 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. 1008 ¶29; Ex. 1002, 8:36–41 (emphasis added). As another example, and like the '029 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. 1008 ¶18; Ex. 1002, 4:50–53 (emphasis added).

Petitioner has shown sufficiently that the claims of the '029 patent are not entitled to the benefit of the filing date of any of the parent applications because none of those applications describes the full scope of the claims, which include, within their scope, condoms comprising only *non*-vulcanized synthetic polyisoprene particles.<sup>4</sup> Accordingly, on the present

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<sup>4</sup> Additionally, in advancing its claim construction position, Patent Owner conceded that the '029 patent and, thus, the parent applications do not enable a person of ordinary skill in the art to make condoms comprising only *non*-

record, the '384 publication is prior art. *See* 35 U.S.C. § 102(a)(1).

### C. 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. 49–68. We are persuaded that the cited portions of the '384 publication demonstrate anticipation of each challenged claim. It is noteworthy that the '384 publication is virtually identical to the '029 patent, save the latter's claims. *Compare* Ex. 1010, *with* Ex. 1002. Indeed, Patent Owner has argued that the substantively-identical parent applications disclose the full scope of the claims. *See, e.g.*, PO Resp. 34 (“[T]he '029 patent claims find support in all priority applications.”).<sup>5</sup> Petitioner's citations to portions of the '384 publication disclosing each claim element, in essentially identical terms, is sufficient to satisfy its burden to show by a preponderance of the evidence that the challenged claims are anticipated by the '384 publication.

The '384 publication is the '118 application as published, and the '118 application is one of the parent applications to which the '029 patent claims

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pre-vulcanized synthetic polyisoprene particles and having the other requirements of the claims. *See, e.g.*, PO Resp. 17 (“[A] condom that includes the recited synthetic polyisoprene particles and associated structural features cannot be achieved if the condom does not include pre-vulcanized SPI particles.”).

<sup>5</sup> Patent Owner argues against anticipation only by contesting that the '384 publication is prior art; Patent Owner does not argue that the '384 publication lacks a disclosure within the scope of the claims. PO Resp. 36–37.



priority. A parent application, however, may anticipate a claimed invention even though it fails to provide written description support for the claimed invention. *See, e.g., In re Lukach*, 442 F.2d 967, 969–70 (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 . . . CIP [continuation-in-part] claims and then find that the ’280 patent anticipates those very claims”). In this case, due to the near identical disclosure as the ’029 patent, which at least describes using pre-vulcanized synthetic polyisoprene particles that both parties agree are encompassed by the challenged claims, the ’384 publication anticipates the challenged claims.

### III. CONCLUSION

Petitioner has shown by a preponderance of the evidence that all of the challenged claims of the ’029 patent are unpatentable.

### IV. PETITIONER’S MOTION TO EXPUNGE

Patent Owner filed Observations on Cross-Examination of Petitioner’s Reply Witness, Dr. William Duncan Potter. Paper 22. In addition to responding to the Observations, Petitioner, with our authorization, filed a Motion to Expunge the Observations. Paper 28. Notwithstanding our

consideration of Patent Owner's Observations, we hold all challenged claims unpatentable. Thus, Petitioner's Motion to Expunge the Observations need not be decided. We dismiss it as moot. *See* 37 C.F.R. § 42.71(a) ("The Board may take up petitions or motions for decisions in any order, may grant, deny, or dismiss any petition or motion, and may enter any appropriate order.").

#### V. ORDER

Accordingly, it is

ORDERED that claims 1–20 of U.S. Patent No. 9,074,029 B2 are unpatentable; and

FURTHER ORDERED that Petitioner's Motion to Expunge is dismissed.

IPR2017-00066  
Patent 9,074,029 B2

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