

ORGANIK KIMYA AS v. ROHM AND HAAS CO., Appeal Nos. 2015-1983, 2015-2001 (Fed. Cir. October 11, 2017). Before Prost, Newman, and Taranto. Appealed from Patent Trial and Appeal Board.

### Background:

Rohm owns patents directed to processes for preparing hollow emulsion polymers having improved opacity for use in paints, coatings, inks, and the like. The patents at issue disclose that their manufacturing method produces products with improved opacity and low density by providing an aqueous emulsion of a multistage emulsion polymer, monomer, and a swelling agent under conditions where there is no substantial polymerization of the monomer such that the extent of swelling of the multistage emulsion polymer is enhanced. Organik challenged the validity of Rohm's patents in two related inter partes review (IPR) proceedings, arguing that the patent claims were invalid as anticipated or obvious over two prior patents, referred to as Toda and Touda. The PTAB disagreed with Organik and held that Rohm's patents were patentable over Toda and Touda. Organik appealed.

### Issue/Holding:

Did the PTAB err in holding that the patents are not anticipated or obvious over the applied references? No, affirmed.

### Discussion:

On appeal, Organik argued that the PTAB adopted an overly narrow interpretation of the claim term "swelling agent" and incorrectly determined that Toda and Touda do not disclose a swelling agent. Based on the disclosure in the specification, the PTAB construed "swelling agent" as a volatile or fixed base that is "capable of permeating the shell and swelling the core, in the presence of the multistage polymer and monomer, under the conditions of the specific process for which the agent is to be used." However, Organik argued that the patent specifications disclose that suitable swelling agents include fixed or permanent bases, such as potassium hydroxide. From this, Organik argued that the "swelling agent" requires only the addition of any base, without reference to whether the reaction conditions are suitable for swelling.

Organik further argued that the Toda and Touda references respectively anticipate and render obvious the claims of Rohm's patents because Toda and Touda both disclose processes for producing hollow emulsion particles, which involve a base treatment followed by an acid treatment. Organik argued that the base treatment taught by Toda and Touda corresponds to the swelling agent used in the claimed processes. However, in view of experimental evidence submitted by Rohm, the PTAB found that the base treatment taught by the Toda and Touda references does not actually produce swelling. Thus, the PTAB found that Toda and Touda do not teach or suggest the addition of a swelling agent, as required by the claims of Rohm's patents. Organik's expert criticized the experimental evidence submitted by Rohm as being "irrelevant" and "flawed," but, as pointed out by the PTAB, Organik did not provide any contrary evidence.

The Federal Circuit agreed with the PTAB's claim construction, finding that the specification makes clear that the swelling agent is a base capable of permeating the shell and swelling the core under the reaction conditions described in the specification. The Federal Circuit additionally agreed with the PTAB that the experimental evidence submitted by Rohm outweighed the unsupported criticism of Organik. Therefore, the Federal Circuit concluded that there was substantial evidence to support the PTAB's finding that one of ordinary skill in the art would not have understood the bases used by Toda and Touda to be swelling agents.