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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ex parte SASA ANDJELIC and DENNIS D. JAMIOLKOWSKI¹

Appeal 2018-007617
Application 14/176,232
Technology Center 1600

Before DONALD E. ADAMS,² RICHARD M. LEBOVITZ, and
JEFFREY N. FREDMAN, *Administrative Patent Judges*.

LEBOVITZ, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

This is Request for Rehearing under 37 C.F.R. § 41.52 (dated July 29, 2019) (“Req. Reh’g”) of the Decision on Appeal entered May 28, 2019 (“Dec.”). In the Decision on Appeal, the Examiner’s determination to reject claims 23, 24, and 26–31 as obvious in view of Venkatraman, Baimark, and Verser was affirmed. Appellant appealed from this decision and we affirmed the rejection.

¹ We use the word “Appellant” to refer to “applicant” as defined in 37 C.F.R. § 1.42. Appellant identifies the real party in interest as Ethicon, Inc. Appeal Brief (“Br.”; entered Jan. 29, 2018).

² Because of Judge Elizabeth A. LaVier’s unavailability, Judge Adams has replaced Judge LaVier who was on the panel that authorized the original Decision of the Board. *Cf. In re Bose Corp.*, 772 F.2d 866, 869 (Fed. Cir. 1985).

Independent claim 23 is directed to a semi-crystalline copolymer comprising an A-B-A block configuration made by melt polymerization. Dec. 2. The Examiner found that Venkatraman describes an A-B-A copolymer with the same structure as claimed, but not produced by melt polymerization. *Id.* at 3. To meet this deficiency, the Examiner cited Verser’s teaching of the advantages of melt polymerization. *Id.* at 4.

In affirming the Examiner, the following statements were made in the Decision on Appeal:

The Examiner found that Verser describes making a copolymer of lactide and epsilon caprolactone by melt polymerization, the same monomers as claimed. [Final Act. 5]. The Examiner also found that Verser teaches “that the pre-copolymer has ‘reduced crystallinity’ and is exemplified as having no melting peak, which would indicate an amorphous pre-copolymer (e.g. column 4, lines 55-63; Example 50).” *Id.*

Dec. 3–4.

Appellant asks us to reconsider these statements because “Verser fails to teach low crystallinity mid-block in his melt process.” Req. Reh’g 2. Appellant states that the Example 5 (erroneously referenced by the Examiner as Example 50) would produce a non-linear and branched and have no mid-block “B” section, unlike the claimed polymer. *Id.* at 2–3.

This argument is not persuasive.

First, Appellant did not previously address Example 5 of Verser in the Appeal Brief, despite acknowledging and directly quoting the Examiner’s findings with respect to this example in the Final Office Action. Appeal Br. 8 (first incomplete paragraph). New arguments are not permitted in Request for Rehearing except as permitted by paragraphs (a)(2) through (a)(4) of 37

C.F.R. § 41.52(a). Appellants did not make a showing that a condition recited in one of these paragraphs was met.

Second, although Appellant argued in the Appeal Brief that “Verser et al. disclose branched polymers made with polyols, while Applicants’ polymers are linear” (Br. 13), it was stated in the Decision on Appeal that “the Examiner did not rely on Verser for disclosing the claimed copolymer structure, rather the Examiner cited Venkatraman for describing the claimed bioabsorbable copolymer structure.” Dec. 8. Thus, Appellant’s argument regarding the differences in structure and function between Verser’s polymers (“Verser polymers would be expected to be comparatively weak, not suitable for extrusion or for the production of suture type medical devices.”) and those claimed and described in Venkatraman (Req. Reh’g 3) is not persuasive because Verser’s polymer was not the basis for the rejection.

With respect to Appellant’s argument that Verser fails to teach low crystallinity mid-block in its melt-process (Req. Reh’g 2), Appellant did not address the statement in Verser about “reduced crystallinity”³ and or explain it would *not* have given one of ordinary skill in the art reason to use Verser’s procedure to make Venkatraman’s polymer.

The Examiner also relied on an independent basis for using Verser’s melt polymerization method to Venkatraman’s polymer: to reduce costs, waste, and by-products, and because the method is less technically

³ “For example, a pre-copolymer material can comprise a first polymer-forming material and an additional polymer forming material such that when polymerized, the first polymer is a copolymer having reduced crystallinity relative to a homopolymer of the first polymer-forming material.” Verser 4:60–63.

complicated and more environmentally sound. Dec. 4. A deficiency in this reasoning has also not been identified by Appellant.

Appellant also argues in the Request for Rehearing that Verser “distinguish their polymers from biodegradable plastics that are implanted in the body and teach away from bioabsorbable implantable polymers (See col. 3, lines 20–30).” Req. Reh’g 3. Appellant contend that “production of polymers with accelerated degradation, as shown in Verser, is inconsistent with the primary function of the polymeric materials in Venkatraman.” *Id.*

This argument was addressed in the Decision on Appeal. Dec. 8–9. As stated in the Decision, Verser is not limited to the embodiments cited by Appellants and Verser’s polymer structure is not the basis of the rejection. *Id.* at 8. The issue raised by Appellant’s argument is whether the differences in structure and properties exhibited by Verser’s polymers would have dissuaded one of ordinary skill in the art from utilizing its melt polymerization process to make Venkatraman’s polymer’s or not to have provided the motivation to do so. The Decision on Appeal explained that at least because of the similarity in the monomers incorporated in the polymers (Dec. App. 10) and the overlap in properties (Dec. App. 8), one of ordinary skill in the art would have recognized that melt polymerization would be useful to make Venkatraman’s polymers. The Decision on Appeal also concluded that “Appellants have not provided persuasive evidence or explanation as to why it would *not* have been expected that Verser’s process could be used to produce a polymer of Venkatraman.” *Id.* at 11.

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For the foregoing reasons, we decline to modify the Decision on Appeal entered May 28, 2019. The Request for Rehearing has been considered, but it is denied.

DENIED