

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEW NGC, INC., dba NATIONAL GYPSUM COMPANY,
Petitioner

v.

UNITED STATES GYPSUM COMPANY,
Patent Owner.

Case No. IPR2017-01011
U.S. Patent No. 7,964,034

**MOTION & CERTIFICATION UNDER 37 C.F.R. § 42.100(b)
REQUESTING EXPIRED PATENT CLAIM CONSTRUCTION**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
US Patent and Trademark Office
PO Box 1450
Alexandria, Virginia 22313-1450

I. Notice of Request for Relief

Pursuant to 37 C.F.R. §§ 42.21(a) and 42.100(b), Patent Owner United States Gypsum Company (“USG”) requests that the Board apply a district court-type claim construction approach in this proceeding. Amended Rule 37 C.F.R. § 42.100(b) (effective May 2, 2016) provides in part:

A party may request a district court-type claim construction approach to be applied if a party certifies that the involved patent will expire within 18 months from the entry of the Notice of Filing Date Accorded to Petition. The request, accompanied by a party’s certification, must be made in the form of a motion under § 42.20, within 30 days from the filing of the petition.

The patent subject to this proceeding, U.S. Patent 7,964,034 (’034 patent) was filed on June 9, 2010, and claims priority to Application No. 08/916,058, which was filed on August 21, 1997. (*See Ex. 1029.*) Thus, the ’034 patent will expire 20 years from filing, i.e., no later than August 21, 2017. Accordingly, the ’034 patent will necessarily expire within 18 months from the entry of the Notice of Filing Date Accorded to Petition. *See also* Section II, *infra*.

This motion is made within 30 days from the filing of the Petition. Petitioner filed its Petition for *inter partes* review against the ’034 patent on March 17, 2017. (Paper 1.) This motion is made on April 13, 2017.

In its Petition, Petitioner noted the approaching expiration of the '034 patent and has already applied claim constructions under both the broadest reasonable interpretation standard as well as a district court-type claim construction under *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005). (Paper 1 at 9–15.)

On April 5, 2017, the Board issued its Notice Of Filing Date Accorded to Petition And Time For Filing Patent Owner Preliminary Response, making USG's preliminary response due July 5, 2017. (Paper 3 at 1–2.) USG intends to file a preliminary response in which it will address a district court-type claim construction under *Phillips*.

On April 12, 2017, the Board authorized USG to file this motion under 37 C.F.R. § 42.100(b).

II. Certification

USG hereby certifies, through the undersigned signature of its counsel, that the '034 patent will expire no later than August 21, 2017 (*see* Ex. 1029), which is 20 years from the filing date of the application from which the '034 patent claims priority. 35 U.S.C. § 154. This expiration date is within 18 months from the entry of the Notice of Filing Date Accorded to Petition.

III. Requested Relief

USG respectfully requests that the Board apply a district court-type claim construction in this proceeding.

Date: April 13, 2017

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned certifies service of the foregoing **MOTION & CERTIFICATION UNDER 37 C.F.R. 42.100(b) REQUESTING EXPIRED PATENT CLAIM CONSTRUCTION** on counsel of record for Petitioner by filing this document through the PTAB E2E System as well as by delivering a copy via email to the following addresses:

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Date: April 13, 2017

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