

UNITED STATES PATENT AND TRADEMARK OFFICE  
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BEFORE THE PATENT TRIAL AND APPEAL BOARD  
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NEW NGC, INC. dba NATIONAL GYPSUM COMPANY,  
Petitioner,

v.

UNITED STATES GYPSUM COMPANY,  
Patent Owner.

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Cases IPR2017-01011 (Patent 7,964,034)  
IPR2017-01086 (Patent 6,632,550)  
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Before RAE LYNN P. GUEST, JON B. TORNQUIST, and JEFFREY W.  
ABRAHAM, *Administrative Patent Judges*.

TORNQUIST, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
*37 C.F.R. § 42.5*

IPR2017–01011 (Patent 7,964,034)

IPR2017–01086 (Patent 6,632,550)

On July 31, 2017, a conference call was conducted between Judges Guest, Abraham, and Tornquist and counsel for Petitioner and Patent Owner. The purpose of the call was to discuss Petitioner’s request to file a reply to Patent Owner’s Preliminary Response in IPR2017–01011 and IPR2017–01086.

On the call, Petitioner explained that it was seeking authorization to file the replies in order to address three issues: (1) whether the version of 35 U.S.C. § 102(e) in force post–November 29, 2000 is applicable to the Hjelmeland (Ex. 1008) reference; (2) whether Hjelmeland is, in any event, prior art under §102(a); and (3) whether additional evidence of record demonstrates that the subject matter identified in the Hjelmeland reference by Petitioner was generally known in the art.

Patent Owner opposed the request, asserting that: (1) to the extent Petitioner considered the post–November 29, 2000 version of § 102(e) applicable to Hjelmeland, it should have raised such arguments in the Petition; (2) any argument by Petitioner that Hjelmeland is prior art under § 102(a) would constitute an improper new ground of unpatentability; and (3) to the extent additional evidence of record supports Petitioner’s arguments relating to the subject matter identified in Hjelmeland, good cause does not exist to allow a reply to re-identify this evidence.

Upon conferring, the panel authorized Petitioner to file a five page reply, addressing the issue of whether Hjelmeland is prior art under § 102(e). We also instructed Petitioner to identify where in the Petition Hjelmeland was asserted as prior art under § 102(a) and, if such an assertion was not set forth expressly in the Petition, to address whether Hjelmeland is prior art under § 102(a) and why it would be appropriate to consider such an

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argument, set forth for the first time in a reply. Petitioner was not authorized to address any other arguments or evidence.

We authorized Patent Owner to file a five page sur-reply.

### ORDER

It is hereby

ORDERED that Petitioner may file a five page reply to the Preliminary Response filed in IPR2017-01011 and the Preliminary Response filed in IPR2017-01086, on or before August 7, 2017, limited to the issues discussed above; and

FURTHER ORDERED that Patent Owner may file a five page sur-reply on or before August 14, 2017.

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