

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASPHALT PRODUCTS UNLIMITED, INC.
Petitioner

v.

BLACKLIDGE EMULSIONS, INC.
Patent Owner

Case IPR2017-01241, IPR2017-01242
Patents 7,503,724 and 7,918,624

June 15, 2018

PATENT OWNER SUPPLEMENTAL RESPONSE TO PETITION

TABLE OF CONTENTS

I. INTRODUCTION.....1
II. LEGAL STANDARD3
III. ARGUMENT.....4
 **A. APU Failed to Show That Pasquier Discloses a Cured Coating With
 the Claimed Penetration Values and Softening Points**4
 **B. APU Failed to Show That Pasquier Discloses Heating the Asphalt
 Pavement Material**13
IV. CONCLUSION.....14

TABLE OF AUTHORITIES

Cases

In re Robertson
169 F.3d 743 (Fed. Cir. 1999)3

Nidec Motor Corp.v. Zhongshan Broad Ocean Motor Co. Ltd
851 F.3d 1270 (Fed. Cir. 2017)4

SAS Inst., Inc. v. Iancu
138 S.Ct. 1348 (2018)1

Therasense, Inc. v. Becton, Dickinson and Co.
593 F.3d 1325 (Fed. Cir. 2010)4, 7

Verdegaal Bros. v. Union Oil Co. of California
814 F.2d 628 (Fed. Cir. 1987)3, 14

On April 27, 2018, the Board entered an Order “institut[ing] on all of the challenged claims and all of the grounds presented in the Petitions,” in accord with the Supreme Court’s decision in *SAS Inst., Inc. v. Iancu*, 138 S.Ct. 1348 (2018). (IPR2017-01241, Paper 46 (Apr. 27, 2018); IPR2017-01242, Paper 48 (Apr. 27, 2018).) The parties subsequently stipulated that “Patent Owner may submit a Supplemental Response to Petition addressing the grounds instituted by the Board’s April 27, 2018, Order limited to 5,000 words by Due Date 3 (June 15, 2018).” (IPR2017-01241, Paper 49 (May 4, 2018); IPR2017-01242, Paper 51 (May 4, 2018).) Patent Owner hereby submits its Supplemental Response to Petition. Because its arguments are the same for both IPR2017-01241 regarding U.S. Patent 7,503,724 (“the ’724 patent”) and IPR2017-01242 regarding U.S. Patent 7,918,624 (“the ’624 patent”), Patent Owner submits identical briefing in both proceedings, with dual citations where needed.

I. INTRODUCTION

The Board previously denied institution of Petitioner’s anticipation grounds¹ because “Petitioner has failed to demonstrate a reasonable likelihood of establishing that Pasquier anticipates any of these claims.” (IPR2017-01241, Paper 23 at 11 (Oct.

¹ Petitioner asserts that Pasquier anticipates claims 1-5, 12, 23, 24, and 28 of the ’724 patent and claims 1-5, 12, 14-18, and 25 of the ’624 patent. IPR2017-01241, Pet. at 6; IPR2017-01242, Pet. at 6.

24, 2017); IPR2017-01241, Paper 23 at 11 (Oct. 24, 2017).) The Board determined that “Petitioner has, at most, demonstrated merely a probability that Pasquier’s asphalt emulsion, when cured, exhibits [the claimed penetration values and softening points.” (IPR2017-01241, Paper 23 at 14; IPR2017-01241, Paper 23 at 14.) Since that denial, Petitioner has provided no new evidence that would compel a different decision.

For at least the same reasons relied on by the Board in the institution decisions, APU’s primary reference, Pasquier, does not anticipate the independent claims, consisting of claims 1 and 23 of the ’724 patent and claims 1, 14, and 25 of the ’624 patent.² Namely, Pasquier fails to expressly or inherently disclose a cured coating with the claimed penetration values and softening points. Petitioner admitted that Pasquier lacked such an express disclosure. (IPR2017-01241, Pet. at 30; IPR2017-01242, Pet. at 29.) And Petitioner implicitly admitted the possibility that Pasquier’s cured tack coating might not meet the claimed penetration values and softening points, precluding a finding of inherency. (See IPR2017-01241, Paper 23 at 14-15; IPR2017-01241, Paper 23 at 14-15.)

² The arguments set forth herein apply with equal force to Patent Owner’s proposed amended claims. Additional arguments specific to the amended claims will be advanced in contemporaneous briefing in reply to Petitioner’s Opposition to Patent Owner’s Motion to Amend.

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