

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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ASPHALT PRODUCTS UNLIMITED, INC.,  
Petitioner,

v.

BLACKLIDGE EMULSIONS, INC.,  
Patent Owner.

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Case IPR2017-01242  
Patent 7,918,624 B2

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Before MITCHELL G. WEATHERLY, JAMES A. TARTAL, and  
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 318(a) and 37 C.F.R. § 42.73*

I. INTRODUCTION

A. *Background*

Asphalt Products Unlimited, Inc. (“Petitioner”) filed a petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–25 of U.S. Patent No. 7,918,624 B2 (Ex. 1001, “the ’624 patent”) on the following grounds:

Reference(s)	Basis	Claims
Pasquier <sup>1</sup>	§ 102	1–5, 12, 14–18, 25
Pasquier and SBH <sup>2</sup>	§ 103	1–5, 9, 12–18, 21, 22, 24, 25
Pasquier, SBH, and US DOT <sup>3</sup>	§ 103	6, 19
Pasquier, SBH, and Durand <sup>4</sup>	§ 103	7, 8, 10, 20
Pasquier, SBH, US DOT, and Potti <sup>5</sup>	§ 103	11, 23 <sup>6</sup>

Pet. 26–66. Petitioner further asserts that three additional prior art references described by Petitioner as “optional” to its obviousness

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<sup>1</sup> European Patent App. Pub. No. EP 0 859 030 A1 (Ex. 1003). The original French version of this document is in Exhibit 1028. Exhibit 1003 is the English translation.

<sup>2</sup> The Shell Bitumen Handbook (5th ed. 2003) (Ex. 1008).

<sup>3</sup> US DOT Specification FP96-2001 (Ex. 1010).

<sup>4</sup> U.S. Patent No. 5,769,567 (Ex. 1011).

<sup>5</sup> Juan José Potti, José Luis Peña, Francisco Guzmán, “Emulsiones termoadherentes para riegos de adherencia,” *Carreteras: Revista Técnica de la Asociación Española de la Carretera*, July–Aug. 2003, at 17 (Ex. 1006). The original Spanish version of this document is in Exhibit 1017. Exhibit 1006 is the English translation.

<sup>6</sup> In a table summarizing the grounds at the start of the Petition, Petitioner also lists claim 19 in this ground. Pet. 7. However, as we noted in our Decision on Institution, the Petition does not reference Potti in its challenge to claim 19. *See* Paper 23, 2–3 n.2. Instead, Petitioner’s challenge to claim 19 refers to its arguments for claim 6, which are based on Pasquier, SBH, and US DOT. *See* Pet. 58, 65. Petitioner’s summary table does include claim 19 in the ground based on the combination of Pasquier, SBH, and US DOT. *See* Pet. 6. Thus, we consider Petitioner’s inclusion of claim 19 in the ground that includes Potti in the table on page 7 of the Petition to be a typographical error.

challenges reflect the background knowledge of an ordinarily skilled artisan at the time of the alleged invention: Corte,<sup>7</sup> BAEM,<sup>8</sup> and Gordillo.<sup>9</sup> *See, e.g.,* Pet. 49 (describing Corte, BAEM, and Gordillo as “optional[]” references in the obviousness challenge to claim 1). Blacklidge Emulsions, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 10 (“Prelim. Resp.”).

We initially instituted an *inter partes* review on a subset of the asserted grounds. *See* Paper 23 (“Dec. on Inst.”). Specifically, we determined based on the preliminary record that Petitioner had demonstrated a reasonable likelihood of prevailing in its obviousness challenges, but that Petitioner had not demonstrated a reasonable likelihood of prevailing in its anticipation challenge. *Id.* at 11–26. Based on those determinations, and in accordance with the Board’s practice at that time, we instituted an *inter partes* review only as to the obviousness challenges. *Id.* at 26. Subsequently, pursuant to the holding in *SAS Inst., Inc. v. Iancu*, 138 S.Ct. 1348, 1355–57 (2018), we modified our institution decision to institute review of all grounds presented in the Petition. Paper 48, 2. We also authorized supplemental briefing to permit the parties to address the added ground. Paper 51.

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<sup>7</sup> Corte, Jean-Francois, “Development and uses of hard-grade asphalt and of high-modulus asphalt mixes in France,” Transportation Research Circular 503: Perpetual Bituminous Pavements, at 12 (Ex. 1007).

<sup>8</sup> A Basic Asphalt Emulsion Manual, Manual Series No. 19, Third Edition (Ex. 1009).

<sup>9</sup> Jaime Gordillo et al., “Comparison of Different Test Methods for the Obtention and Characterisation of Residual Binders of Pure and Modified Bitumen Emulsions,” Second World Congress on Emulsion, 23–26 Sept. 1997 (Ex. 1012).

The briefing in this proceeding includes the Petition, an Amended Patent Owner Response (Paper 38, “PO Resp.”), a Patent Owner Supplemental Response (Paper 54, “PO Supp. Resp.”), a Petitioner Reply (Paper 45, “Reply”), and a Petitioner Supplemental Reply (Paper 57, “Supp. Reply”). We held an oral hearing, a transcript of which is included in the record. Paper 65 (“Tr.”).

Patent Owner filed a Contingent Motion to Amend, and the parties submitted additional briefing in connection with that motion. We address Patent Owner’s Motion to Amend in Section III. Aside from the Motion to Amend, no motions remain pending. During the proceeding, Patent Owner filed a Motion to Disqualify Dr. Alan James as Petitioner’s Expert Witness and to Strike His Declaration, and we denied that motion. *See* Paper 15; Paper 22.

The evidentiary record in this proceeding is extensive. In addition to the numerous cited prior art references and documents evidencing the state of the art during the relevant time frame, the parties have provided the testimony of several witnesses. The table below summarizes the witnesses, their roles in this proceeding, and the exhibits in which their testimony is presented:

<b>Witness</b>	<b>Role</b>	<b>Exhibit(s)</b>
Alan James, Ph.D.	Petitioner’s technical expert	Ex. 1002 (declaration of Apr. 3, 2017); Ex. 1040 (declaration of July 15, 2017); Ex. 1041 (declaration of Aug. 30, 2017); Ex. 1093 (declaration of Apr. 17, 2018); Ex. 2079 (transcript of deposition of Dec. 19, 2017).

<b>Witness</b>	<b>Role</b>	<b>Exhibit(s)</b>
Laci-Tiarks-Martin	Director of Operations at PRI Asphalt Technologies, Inc., which was retained by Petitioner to conduct testing	Ex. 1013 (declaration of Mar. 15, 2017).
R. Steele Yeargain, III	Vice President of Petitioner	Ex. 1042 (declaration of Aug. 16, 2017); Ex. 1094 (declaration of Apr. 16, 2018).
William F. O'Leary	Patent Owner's technical expert	Ex. 2010 (declaration of Aug. 18, 2017); Ex. 2078 (declaration of Jan. 24, 2018); Ex. 2092 (declaration of Feb. 9, 2017 from IPR2016-01031); Ex. 2093 (declaration of June 15, 2018); Ex. 1092 (transcript of deposition of Mar. 8–9, 2018); Ex. 1095 (transcript of deposition of June 27, 2018).
Roy B. Blacklidge	Inventor of '624 patent and President of Patent Owner	Ex. 2081 (declaration of Sept. 28, 2008 from file history of U.S. Patent No. 7,503,724); Ex. 1096 (transcript of deposition of Apr. 19, 2017 from IPR2016-01031). <sup>10</sup>
R. Grover Allen, Ph.D.	Technical Director of Patent Owner	Ex. 2005 (declaration of July 5, 2017); Ex. 2077 (declaration of Jan. 24, 2018); Ex. 2094 (declaration of June 15, 2018).

<sup>10</sup> The parties stipulated that Mr. Blacklidge's testimony from Case IPR2016-01031 would be admissible in this proceeding. *See* Paper 43, 1.

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