

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SCHUL INTERNATIONAL COMPANY, LLC,  
Petitioner,

v.

EMSEAL JOINT SYSTEMS, LTD.,  
Patent Owner.

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Case PGR2017-00053  
Patent 9,528,262 B2

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Before GEORGE R. HOSKINS, JAMES A. WORTH, and  
SCOTT C. MOORE, *Administrative Patent Judges*.

HOSKINS, *Administrative Patent Judge*.

ORDER

*Guidance on Potential Motion to Amend*  
37 C.F.R. § 42.5

On June 20, 2018, counsel for Patent Owner sent an e-mail communication to the Board requesting a telephone conference to discuss a potential Motion to Amend, which would be due on or before July 2, 2018 under the current case schedule. This request was made to ensure compliance with 37 C.F.R. § 42.221(a), which provides Patent Owner may file a Motion to Amend “only after conferring with the Board.”

Accordingly, a telephone conference was held on June 22, 2018.

Administrative Patent Judges Hoskins, Worth, and Moore appeared for the Board. Mr. Connaughton appeared for Petitioner. Mr. Kinney and Ms. Beninati appeared for Patent Owner.

The parties were informed that they should look to the decision in *Western Digital Corp. v. SPEX Technologies, Inc.*, IPR2018-00082, Paper 13 (PTAB Apr. 25, 2018), for guidance regarding motions to amend. The *Western Digital* decision has been designated as informative by the Board. The *Western Digital* decision arose in the context of an *inter partes* review, whereas this proceeding is a post-grant review. The parties were informed that if either party believes the *Western Digital* decision should not apply to this proceeding in one or more ways, or if the party otherwise has a question concerning the *Western Digital* decision, then the parties should contact the Board to schedule another telephone conference to discuss the issue.

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