UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SCHUL INTERNATIONAL COMPANY, LLC.,

Petitioner,

v.

EMSEAL JOINT SYSTEMS, LTD.,

Patent Owner.

Case No. PGR2017-00053

U.S. Patent 9,528,262 B2

PETITIONER'S REPLY

DOCKET

Table of Contents

I. INTRODUCTION
A. Petitioner's Reply is Timely8
B. Emseal's Background Discussion is Misleading8
C. Emseal Makes a Critical Misstatement Regarding Fire-Retardant Operation
II. 35 U.S.C. §325(d) Does Not Apply11
III. The prosecution history is irrelevant as to providing written description support. 12
IV. Claim Construction
V. Ground 112
A. Nothing in the '9,495 Patent provides support for foam, alone, being "configured to pass testing mandated by UL2079."
 The original claims of the '9,495 patent do not support foam alone being "configured to pass testing mandated by UL2079" because a joint system having both fire retardant infused foam and a water resistant layer was claimed, and the functionality is discussed with respect to the joint system, not with respect to the foam
2. The examiner did not consider functional abilities of the foam alone during prosecution of the '9,495 patent because only functional features of the expansion joint system as a whole were claimed
B. Nothing in the common specification of the '262 patent or alleged priority documents provide the required support15
1. The fact that the foam is fire retardant and provides fire resistance does not mean the foam alone has the claimed functional features
2. The "resultant composite" does not refer to the foam alone17
C. The claims of continuation applications cannot provide written description support because a continuation cannot add new matter

VI. Gro	und 219			
А.	<i>ICU Medical</i> applies to continuation applications which introduce claims unsupported by the written description at filing because written description is evaluated as of the filing date sought			
В.	The Board has agreed that the specification provides no support for the structure of an expansion joint which omits the intumescent layer23			
C.	Emseal advances multiple misleading arguments23			
VII. Ground 324				
А.	Emseal opens with yet another misleading and irrelevant argument25			
В.	There is no inherent support provided by the specification25			
C.	Both Emseal and the Board cite to the UL2079 non-patent literature to provide written description support, demonstrating that it is essential material			
VIII.	Ground 427			
А.	Discussion of the joint being "compressed" is not necessarily the same as the joint "installed" because while the expansion joint is compressed when installed, it is compressed in other instances too			
В.	The remainder of Emseal's Response to Ground 4 is a series of flawed and/or misleading arguments and misstatements of law			
IX. Ground 5				
А.	The USPTO has found that this claim element is without written description support			
В.	The Board and Emseal improperly assume that these limitations are related to UL2079, rendering them superfluous			
X. Gro	und 632			
A.	The USPTO has found this claim term indefinite			
В.	The Board and Emseal assume that these limitations are related to UL2079, rendering them superfluous			
C.	Emseal again misleads			
XI. Gro	und 733			
XII.Gro	und 834			
	3			

XIII.	Conclusion	.3	5
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PETITIONER'S UPDATED EXHIBIT LIST

Exhibit	Description
1001	U.S. Patent 9,528,262 B1
1002	US Endodontics, LLC v. Gold Standard Instruments, LLC, PGR2015-
	00019, Paper 54 (Dec. 28, 2016).
1003	U.S. Appl. S/N 14/540,514 Specification, Abstract, Claims and
	Drawings as filed November 13, 2014.
1004	U.S. Appl. S/N 14/540,514 Amendment and Response to Final Office
	Action Filed Concurrently with a Request for Continued Examination
	(August 31, 2016).
1005	U.S. Appl. S/N 14/540,514 Notice of Allowance and Fee(s) Due
	(November 3, 2016).
1006	American Heritage® Dictionary of the English Language, Fifth
	Edition. Copyright 2011 by Houghton Mifflin Harcourt Publishing
	Company ("withstand").
1007	Underwriter Laboratories, Inc.'s UL 2079 Tests for Fire Resistance of
	Building Joint Systems, Fourth Edition of October 21, 2004, as revised
	through June 30, 2008.
1008	Original Complaint, Emseal Joint Systems, Ltd. v. Schul International
	Co., LLC and Steven R. Robinson; In the United States District Court
	for the District of New Hampshire (McAuliffe).
1009	Original Complaint, Cause No. 1:14-CV-00359; Emseal Joint
	Systems, Ltd. v. Willseal, LLC, Ion Management, LLC, Brian J. Iske,
	and Steven R. Robinson; In the United States District Court for the
	District of New Hampshire (Barbadoro).
1010	U.S. Provisional Patent Application 61/116,453.
1011	U.S. Patent 8,341,908, issued January 1, 2013 to Hensley et al.
1012	Amended Complaint, Cause No. 1:14-CV-00358; Emseal Joint
	Systems, Ltd. v. Willseal, LLC, Ion Management, LLC, Brian J. Iske,
	and Steven R. Robinson; In the United States District Court for the

5

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