

IN THE 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-_____
U.S. Patent 9,528,262 B2

PETITION FOR POST-GRANT REVIEW

Table of Contents

I. Introduction	6
II. Mandatory Notices (37 C.F.R. §42.8).....	6
A. Real Parties in Interest (37 C.F.R. §42.8(b)(1))	6
B. Related Matters (37 C.F.R. §42.8(b)(2))	6
C. Lead and Backup Counsel, and Service Information (37 C.F.R. §§42.8(b)(3), 42.8(b)(4) and 42.10(a)).....	7
D. Power of Attorney	8
E. Payment of Fees	8
III. Eligibility for Post-Grant Review	9
A. None of the written description or the priority applications provide written description support for “the foam including the fire retardant material is configured to pass testing mandated by UL 2079.”	11
B. None of the written description or the priority applications provide written description support for an expansion joint system which does not include an intumescent material applied to a surface of the foam.	14
C. None of the written description or the priority applications provide written description support for foam including the fire retardant with “a density when installed in a range of 200-700 kg/m ³ .”	16
D. The written description and the priority applications improperly seek to incorporate the UL 2079 Tests by reference, and thus fail to provide written description support for an expansion joint system which “has an ability to withstand exposure to a temperature of about 540/1010° C. at about five minutes/two hours” and “foam including the fire retardant material is configured to pass testing mandated by UL 2079.”	17
IV. Right to File and Grounds for Standing (37 C.F.R. §§42.201, 42.202, 42.204(a))	19
V. Identification of Challenge under 37 C.F.R. §42.204(b) and Relief Requested as to Each Claim	20
VI. Background and Summary of the ‘262 Patent	21
A. Summary of the ‘262 Patent Written Description.....	22
B. Summary of the Prosecution History	25

VII.Claim Construction (37 C.F.R. §42.204(b)(3).....	27
A. “to withstand exposure”	27
B. “to pass testing mandated by UL 2079.”	28
VIII..... Grounds of Unpatentability (37 C.F.R. §42.204(b)(4)-(5)).	31
A. Ground 1: Claims 1-43 lack written description under §112 of an expansion joint system where “the foam including the fire retardant material is configured to pass testing mandated by UL 2079.”	33
B. Ground 2: Claims 1-43 lack written description under §112 of an expansion joint system which does not include an intumescent material applied to a surface of the foam.	35
1. The specification of the ‘262 patent, and of every application to which the ‘262 claims priority, discloses only an expansion joint system having an intumescent material applied to a surface of the foam.....	37
2. Because the intumescent layer is unswervingly taught to be a part of the invention, the failure to include it as a limitation in the independent claims renders them invalid because they claim subject matter that was not disclosed in the written description.	43
C. Ground 3 Claims 1-43 lack written description under §112 of an expansion joint system as no incorporation by reference can be made of UL 2079 to augment the disclosure.....	44
1. Claims 1-43 lack written description under §112 of an expansion joint system as no incorporation by reference can be made of the UL 2079 Tests to augment the disclosure as such material would be essential matter but is non-patent literature.	44
2. Even if resort to the non-patent literature was permitted, the UL 2079 Tests document provides no singular definition of “to pass” and it provides no definition of “withstand exposure.”	46
D. Ground 4: Claims 1-43 lack written description under §112 as to the expansion joint system having foam with “a density when installed in a range of about 200 kg/m ³ to about 700 kg/m ³ .”	48
E. Ground 5: Claims 1-43 lack written description under §112 as to the expansion joint system “has an ability to withstand exposure to a temperature of about 540/1010° C. at about five minutes/two hours.”	50

F.	Ground 6: Claims 1-43 are indefinite under §112 as to the expansion joint system “has an ability to withstand exposure to a temperature of about 540/1010° C. at about five minutes/two hours.”	53
G.	Ground 7: Claims 1-43 lack enablement under §112 to provide an “expansion joint system [which] accommodates movement when installed between substrates, ... and the expansion joint system has an ability to withstand exposure to a temperature of about 540 ° C. at about five minutes, and the foam including the fire retardant material is configured to pass testing mandated by UL 2079.”	55
1.	The broad scope of the claims requires broad disclosure.	56
2.	There is no disclosure of a particular combination of foam and fire retardant, which is necessary in light of the broad scope.....	58
3.	The Patent Owner has established that their claimed invention cannot be arrived at by routine experimentation.	61
4.	No working examples are provided	62
H.	Ground 8: Because the ‘262 patent is not entitled to claim priority prior to November 13, 2014, claims 1-43 are anticipated by U.S. Patent 8,341,908.	63
10.	The expansion joint system of claim 1, wherein the movement is in response to thermal effects on, or seismic movement of, the substrates.	67
11.	The expansion joint system of claim 1, wherein the expansion joint system has the ability to withstand exposure to a temperature of about 1052° C. at about three hours to pass the UL 2079 testing.....	67
12.	The expansion joint system of claim 1, wherein the expansion joint system has the ability to withstand exposure to a temperature of about 1093° C. at about four hours to pass the UL 2079 testing.	67
IX.	Conclusion.....	81

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 District of New Hampshire (McAuliffe).
1013	U.S. Patent 9,644,368 to Witherspoon Issued on May 9, 2017.
1014	U.S. Patent 8,365,495 to Witherspoon Issued on February 5, 2013.
1015	U.S. Patent 8,739,495 to Witherspoon Issued on June 3, 2014.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.