

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 PGR2017-00053 (Patent 9,528,262 B2)
Case PGR2018-00034 (Patent 9,644,368 B1)¹

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

HOSKINS, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. §§ 42.5 and 42.223

¹ This Order applies to both proceedings. The proceedings have not been consolidated, and the parties are not authorized to use a consolidated caption unless a paper contains a footnote indicating that the identical paper has been filed in each proceeding.

INTRODUCTION

On October 1, 2018, we entered an Order authorizing Petitioner to file, in the '053 PGR and the '034 PGR, a Motion to Submit Supplemental Information. '053 PGR Paper 19 & '034 PGR Paper 9 (“Authorizing Order” or “Auth. Ord.”). The Authorizing Order authorized Patent Owner to file Oppositions to those Motions. *Id.* The authorized briefing has now been filed. The present Order rules on the Motions. However, the present Order first addresses a separate issue relating to the parties’ communications with the Board.

COMMUNICATIONS WITH THE BOARD

Pursuant to the Authorizing Order, Patent Owner’s Oppositions were required to be filed “at or before 5:00 p.m. Eastern Time on October 10, 2018.” Auth. Ord. 4. According to the Board’s filing system audit trail information, the '053 PGR Opposition was filed at about 5:18 p.m. on the due date, and the '034 PGR Opposition was filed at about 5:25 p.m. on the due date. Shortly before 6:00 p.m. on the due date, Patent Owner’s counsel sent e-mail communications to the Board concerning these late filings. The following communication concerning the '053 PGR is representative:

Counsel for Patent Owner writes to inform the Board that due to technical issues related to an internet browser incompatibility that required assistance of the PTAB’s help desk to overcome, Counsel for Patent Owner’s filing of its Opposition to Petitioner’s Motion to Submit Supplemental Information was officially loaded to the PTAB’s E2E shortly after 5:00 pm today, October 10, 2018. The Board had requested filing by 5:00 pm Eastern Time. Counsel for Patent Owner apologizes for any inconvenience and respectfully requests consideration of this filing.

Case PGR2017-00053 (Patent 9,528,262 B2)

Case PGR2018-00034 (Patent 9,644,368 B1)

Thus, Patent Owner's counsel failed to indicate whether Patent Owner's counsel had attempted to confer with Petitioner's counsel concerning the late filing, before writing to the Board to request that we consider the late filing.

Petitioner's counsel previously engaged in similar conduct in its September 11, 2018, e-mail communications to the Board, seeking authorization to file the Motions that are considered below. *See, e.g.,* Auth. Ord. 2. That is, Petitioner's counsel failed to indicate whether Petitioner's counsel had attempted to confer with Patent Owner's counsel concerning the proposed Motions, before writing to the Board to request authorization to file the Motions.

This common practice of counsel in this proceeding is inefficient. The Board expects counsel to confer with each other in an attempt to resolve disputed issues, or, if resolution is not achieved, to crystallize the issue(s) which are disputed, before contacting the Board to seek Board action. Therefore, from this date forward, pursuant to the Order entered below, before communicating with the Board (via e-mail or otherwise) to request the Board to take action, the requesting counsel shall confer with opposing counsel concerning the requested action. The requesting counsel must then, in the succeeding communication to the Board, either (1) certify that the conference took place, and describe the results of the conference, or (2) if no conference took place, describe the action(s) taken by the requesting counsel attempting to schedule a conference.

'053 PGR SUPPLEMENTAL INFORMATION

In the '053 PGR, Petitioner's Motion to Submit Supplemental Information was filed as Paper 20 ("'053 Motion" or "'053 Mot."), and Patent Owner's Opposition was filed as Paper 21.

Petitioner initially sought authorization to file the '053 Motion via an e-mail communication to the Board dated September 11, 2018. '053 PGR, Paper 19, 2. Because that date came more than one month after trial was instituted in the '053 PGR on April 9, 2018, the '053 Motion "must show [i] why the supplemental information reasonably could not have been obtained earlier, and [ii] that consideration of the supplemental information would be in the interests-of-justice." 37 C.F.R. § 42.223(b); '053 PGR, Paper 19, 3. We determine Petitioner has not made showing [ii], so we deny the '053 Motion.

The '053 Motion seeks to submit one document, which Petitioner describes as: "Non-Party UL LLC's Opposition to Emseal Joint Systems, Ltd.'s Motion To Compel; Civil Action No. 1:18-mc-91331 in the US District Court; District of Massachusetts, August 30, 2018" ("UL Opposition").

Petitioner contends the UL Opposition "further bolsters" Ground 5 of the '053 Petition. '053 Motion, 2–3. That ground asserts lack of written description for an expansion joint system having an ability to withstand exposure to a specified temperature (540 or 1010° C) at about a specified time (five minutes or two hours). '053 Pet. 50–53; '053 Ex. 1001, 8:2–4 (representative claim 1 of the '262 patent). Specifically, Petitioner contends the UL Opposition states "a proposed deposition question relating to the time and temperature requirements listed in the UL 2079 test standard *bears*

Case PGR2017-00053 (Patent 9,528,262 B2)

Case PGR2018-00034 (Patent 9,644,368 B1)

no relation to the phrase ‘pass testing mandated by UL 2079.’”

’053 Motion, 2 (emphasis added) (citing UL Opposition, 12–14). Thus, in Petitioner’s view, the UL Opposition “relates to Petitioner’s rebuttal argument . . . that it is improper to presume that the time/temperature limitations are part of the ‘pass’ UL 2079” as claimed (*see, e.g.*, ’053 Ex. 1001, 8:4–6), because “it would render these limitations superfluous.” ’053 Motion, 2–3 (citing Petitioner’s Reply, ’053 Paper 17, at 31–32). Petitioner’s view is that submission of the UL Opposition is in the interests of justice, “because it provides independent, third party verification of Petitioner’s arguments regarding Ground 5 from a reliable source: UL LLC.” *Id.* at 3.

We first conclude the UL Opposition, when viewed in a light most favorable to Petitioner, at best presents only attorney argument. It is not evidence, such as witness testimony under oath, or contemporaneous documentation, probative of how a person of ordinary skill in the art would have understood the claim term “to pass testing mandated by UL 2079.” Further, the argument comes from an attorney opposing discovery sought from the attorney’s client. It is, therefore, advocacy rather than evidence as to the scope of the ’262 patent claims. Thus, we are not persuaded the UL Opposition would aid the Board in resolving any issues of fact or law in considering Ground 5 of the ’053 Petition.

Moreover, Petitioner’s counsel was aware of the UL Opposition, at the latest, on September 11, 2018, when the e-mail requesting authorization to file the ’053 Motion was sent to the Board. Thus, Petitioner’s counsel was aware of the UL Opposition *before* Petitioner’s Reply in the ’053 PGR was filed on September 17, 2018. *See* ’053 Paper 17. Petitioner therefore

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