# 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. PGR2018 U.S. Patent 9,644,368

### PETITION FOR POST-GRANT REVIEW

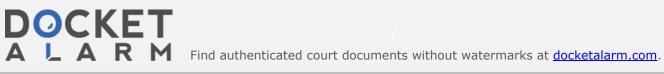


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	A.	The is no support in the '368 patent or priority documents for the claimed limitations of a fire retardant infused foam "configured to pass testing mandated by the UL 2079."			
	В.	There is no support in the '368 patent or priority documents for an expansion joint system absent an intumescent material	19		
	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/m³."			
	D.	The written description and the priority applications improperly seek to incorporate the UL 2079 Tests by reference, and thus fail to provide whis asserted by Emseal to be written description support for elements in each of claims 1-17			
	E.	During prosecution, the application which became the '368 patent contained a claim which had an effective filing date after March 16, 201 and thus the '368 patent is available for post-grant review			
	F.	The effective filing date of claims 1-17 is after March 16, 2013, thus making the '368 patent eligible for post-grant review	27		
	_	nt to File and Grounds for Standing (37 C.F.R. §§42.201, 42.202,	28		
		tification of Challenge under 37 C.F.R. §42.204(b) and Relief Requested			
	Background and Summary of the '368 Patent 30				



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B.	"to pass testing mandated by UL 2079."	35
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В.	Ground 2: Claims 1-17 lack written description support under §112 an expansion joint system absent an intumescent material	
	1. The specification of the '368 patent, and of every application to the '368 claims priority, only discloses expansion joint systems having an intumescent material.	
	2. Because the intumescent layer is unswervingly taught to be a path the invention, the failure to include it as a limitation in the independent claims renders them invalid for lack of adequate will description.	ritten
C.	Ground 3: Claims 1-17 lack written description support under §112 because the UL 2079 cannot be incorporated by reference to augmedisclosure.	ent the
	1. Claims 1-17 lack written description support under §112 for the claimed expansion joint system because the UL 2079 Tests is estimaterial that is non-patent literature, and thus cannot be incorporate by reference.	ssential orated
	2. Even if incorporation by reference of the non-patent literature was permitted, the UL 2079 Tests document provides no singular definition of "to pass" and it provides no definition of "withstan exposure/maintain fire resistance."	ıd
D.	Ground 4: Claims 1-17 lack written description support under §112 an expansion joint system having foam with "a density when instal a range of about 200 kg/m³ to about 700 kg/m³."	led in
E.	Ground 5: Claims 1-17 lack written description support under §112	



			re resistance upon exposure to a temperature of about 540° C. at about 7e minutes."
	F.	du	round 6: Claims 1-17 are indefinite under §112(a) because, as rejected tring prosecution, the meaning of "pass testing mandated by UL 2079" vague and indefinite
	G.		round 7: Claims 1-17 are indefinite under §112 as to the expansion joint stem " at about five minutes."
	H.		round 8: Claims 8-17 are indefinite under §112(a) as to the system on figured to maintain fire resistance."
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	J.		round 10: Because the '368 patent is not entitled to claim priority prior May 15, 2014, claims 1-17 are anticipated by U.S. Patent 8,341,908.73
IX. (	Cor	nclus	sion



## **Exhibit List**

Exhibit	Description
1001	U.S. Patent 9,644,368 B1
1002	US Endodontics, LLC v. Gold Standard Instruments, LLC,
	PGR2015-00019, Paper 54 (Dec. 28, 2016).
1003	U.S. Appl. No. 14/278,210 as filed May 15, 2014.
1004	U.S. Appl. S/N 14/540,514 Notice of Allowance and Fee(s) Due
	(November 3, 2016).
1005	American Heritage® Dictionary of the English Language, Fifth
	Edition. Copyright 2011 by Houghton Mifflin Harcourt Publishing
	Company ("withstand").
1006	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.
1007	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).
1008	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
1000	the District of New Hampshire (Barbadoro).
1009	U.S. Provisional Patent Application No. 61/116,453.
1010	U.S. Patent 8,341,908, issued January 1, 2013 to Hensley et al.
1011	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
1010	the District of New Hampshire (McAuliffe).
1012	U.S. Patent 8,365,495 to Witherspoon Issued on February 5, 2013.
1013	U.S. Patent 8,739,495 to Witherspoon Issued on June 3, 2014.
1014	U.S. Appl. No. 14/278,210 Amendment and Response to Non-Final
1015	Office Action (April 6, 2015).
1015	U.S. Appl. No. 13/721,855 as filed December 12, 2012.
1016	Dow Corning® 790 Silicone Building Sealant Product Information (2005).
1017	U.S. Appl. No. 13/721,855 Amendment and Response to Non-Final
1017	Office Action (December 9, 2013
1018	U.S. Appl. No. 14/278,210 Amendment and Response to Non-Final
	Office Action (August 18, 2016).



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