

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 PGR2018-00034  
Patent 9,644,368 B1

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

HOSKINS, *Administrative Patent Judge*.

DECISION  
Institution of Post-Grant Review  
*35 U.S.C. § 324(a)*

## I. INTRODUCTION

Schul International Company, LLC (“Petitioner”) has filed a Petition (Paper 1, “Pet.”) pursuant to 35 U.S.C. §§ 321–329 to institute a post-grant review of claims 1–17 of U.S. Patent No. 9,644,368 B1 (“the ’368 patent”). Emseal Joint Systems, Ltd. (“Patent Owner”) has filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Institution of post-grant review requires the information presented in the Petition to demonstrate that, if not rebutted, it is more likely than not that at least one challenged claim is unpatentable. 35 U.S.C. § 324(a). Applying that standard on behalf of the Director (37 C.F.R. § 42.4(a)), we institute a post-grant review to determine whether claims 1–17 of the ’368 patent are unpatentable, as described further below.

## II. BACKGROUND

### A. *Real Parties in Interest and Related Proceedings*

Petitioner identifies itself as the real party in interest for this proceeding, with Steven R. Robinson being its member. Pet. 7. Patent Owner identifies itself as the real party in interest for this proceeding, and indicates Patent Owner is a wholly owned subsidiary of Sika Corporation, having Sika AG as a parent company. Paper 4, 2. The parties identify two consolidated U.S. District Court litigations as matters that might affect, or be affected by, a decision in this proceeding. Pet. 8; Paper 4, 2.

The parties also identify PGR2017-00053 (“the ’053 PGR”) as a related matter to the present proceeding because the ’053 PGR concerns a challenge to U.S. Patent No. 9,528,262 B2, which claims benefit of the filing date of the ’368 patent as a continuation application. Pet. 8–9; Paper 4, 3.

*B. The '368 Patent*

The '368 patent discloses a fire and water resistant expansion joint system. Ex. 1001, (54), 1:21–26. Figures 1 and 1A of the '368 patent, for example, are reproduced below.

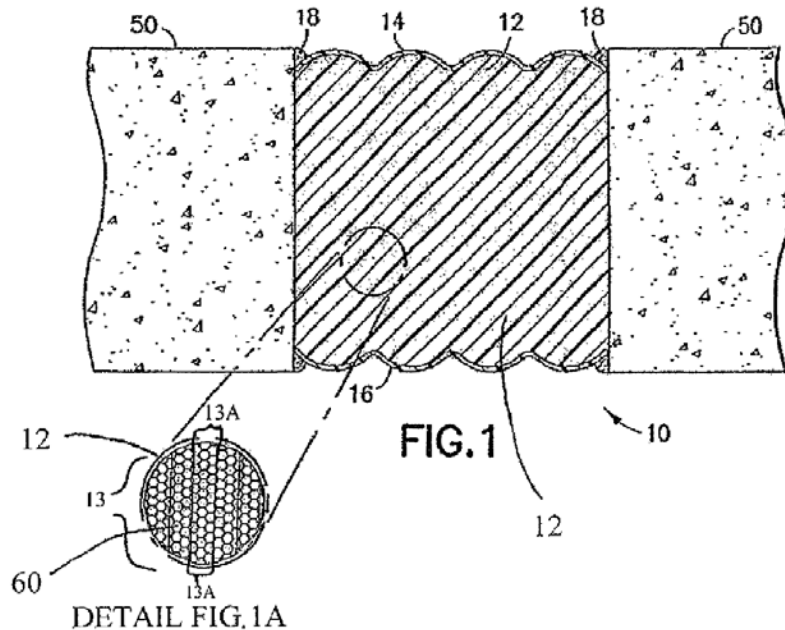


Figure 1 illustrates expansion joint system 10 installed between concrete substrates 50, to accommodate thermal and/or seismic movements of substrates 50 relative to each other. *Id.* at 1:30–34, 4:37–52. The accommodation is provided by open celled foam 12, illustrated in the detail view of Figure 1A. *Id.* at 4:46–55. The accommodation is additionally provided by the bellows-type profile of waterproof elastomer coating 14, and fire-resistant intumescent material coating 16, on foam 12. *Id.* at 5:21–22, 5:49–52, 5:59–67.

Elastomer 14 resists the passage of water in one direction of system 10, from the top to the bottom in Figure 1. *Id.* at 3:28–35, 5:21–22,

6:4–8. Fire retardant material 60, which is infused into foam 12, and intumescent material 16 resist the passage of fire in the opposite direction of system 10, from the bottom to the top in Figure 1. *Id.* at 4:55–58, 6:4–8. In an alternate embodiment illustrated in Figure 3, expansion joint system 30 provides fire resistance in both directions, by providing intumescent material 16 on both sides of foam 12. *Id.* at 3:38–43, 6:35–49.

Additional disclosures of the '368 patent are discussed below in connection with Petitioner's various written description challenges to the '368 patent claims.

### *C. Related Applications to the '368 Patent*

The '368 patent issued from U.S. Patent Application Serial No. 14/278,210 (“the '210 application”). Ex. 1001, (21).

The '210 application has at least one child application, U.S. Patent Application Serial No. 14/540,514 (“the '514 application”), filed as a continuation of the '210 application and issued as U.S. Patent No. 9,528,262 B2 (“the '262 patent”). Ex. 2002, (10), (21), (63).

The '210 application was a continuation of U.S. Patent Application Serial No. 13/721,855 (“the '855 application”). Ex. 1001, (63). The parent '855 application was a continuation of U.S. Patent Application Serial No. 12/622,574 (“the '574 application”), and issued as U.S. Patent No. 8,739,495 B1 (“the '9,495 patent”). Ex. 1013, (10), (21), (63). The parent '574 application asserted priority to U.S. Provisional Application Serial No. 61/116,453 (“the '453 application”), and issued as U.S. Patent No. 8,365,495 B1 (“the '5,495 patent”). Ex. 1012, (10), (21), (60); Ex. 1009.

*D. The Challenged Claims of the '368 Patent*

The '368 patent contains 17 claims, all of which are challenged by Petitioner. Claims 1, 8, and 15 are independent. Claim 1 illustratively recites:

1. An expansion joint system, comprising:  
foam;  
a fire retardant material infused into the foam; and  
wherein the expansion joint system is configured to facilitate compression of the system when installed between substrates, wherein the foam has a density when installed in a range of about 200 kg/m<sup>3</sup> to about 700 kg/m<sup>3</sup>, and  
the system is capable of withstanding exposure to a temperature of about 540° C. at about five minutes, and  
the fire retardant infused foam is configured to pass testing mandated by UL 2079.

Ex. 1001, 7:62–8:5 (some line breaks added).

*E. Proposed Grounds of Unpatentability*

Petitioner challenges claims 1–17 of the '368 patent on the following proposed grounds.<sup>1</sup> Pet. 28–29.

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<sup>1</sup> We have re-stated Petitioner's proposed written description grounds to focus on the claim limitations at issue, rather than the bases for Petitioner's contentions. Our summary, further, identifies only the representative limitations of claim 1 at issue, except as noted. Our analysis below considers all of Petitioner's contentions, and the limitations of other claims.

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