

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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JOHNS MANVILLE CORPORATION and JOHNS MANVILLE, INC.,  
Petitioner,

v.

KNAUF INSULATION, INC. and KNAUF INSULATION SPRL,  
Patent Owner.

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Case IPR2016-00130  
Patent D631,670 S

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Before SCOTT A. DANIELS, KRISTINA M. KALAN, and  
JAMES A. WORTH, *Administrative Patent Judges*.

DANIELS, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceedings  
37 C.F.R. § 42.5

Patent Owner requested, by an email dated January 26, 2017, a telephone conference with the Board seeking authorization to file a Motion to Terminate this proceeding under 35 U.S.C. § 315(e)(1). Patent Owner argued that the Board issued a Final Written Decision in IPR2015-01435 and that because this proceeding includes grounds that reasonably could have

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been raised in IPR2015-01435 Petitioner is estopped from maintaining this subsequent *inter partes* review proceeding. The Board instructed the parties to address the § 315 issue at oral hearing in this proceeding on February 2, 2017.

Section 315(e)(1) states:

The petitioner in an inter partes review of a claim in a patent under this chapter that results in a final written decision under section 318(a) . . . may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that inter partes review.

The single claim of the '670 design patent is the subject of this proceeding and was the subject of case IPR2015-01435. A Final Written Decision was entered in IPR2015-01435 on January 11, 2017.

During the oral hearing in this proceeding Patent Owner's counsel argued that Exhibits 1004 and 1005, upon which Petitioner bases its grounds of anticipation and obviousness in the present proceeding, were in the possession of Petitioner at the time of filing IPR2015-01435 and thus under § 315(e)(1) "reasonably could have [been] raised during that inter partes review." Petitioner's counsel argued to the contrary that a diligent search was undertaken and the circumstances relating to the discovery of further documents and filing of the present petition were reasonable under § 315.

Because the parties dispute factually whether Petitioner reasonably could have raised Exhibits 1004 and 1005 in IPR2015-01435, we authorize Patent Owner to file a motion to terminate this proceeding no later than February 22, 2017. Petitioner is authorized to file an opposition to the motion no later than March 8, 2017. The motion and opposition are both limited to 7 pages. The parties should focus their respective briefs on facts

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and evidence of record supporting, or not, the reasonableness of Petitioner's search for relevant prior art documents. No Reply is authorized at this time.

It is

ORDERED that Patent Owner is authorized to file a motion to terminate, no more than 7 pages, no later than February 22, 2017.

FURTHER ORDERED that Petitioner is authorized to file an opposition to the motion to terminate, no later than March 8, 2017.

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