

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HNI CORPORATION and ALLSTEEL INC.
Petitioners,

v.

DIRTT ENVIRONMENTAL SOLUTIONS LTD.
Patent Owner.

Case No. IPR2015-01691
Patent No. 8,024,901
Issue Date: September 27, 2011

Title: INTEGRATED RECONFIGURABLE WALL SYSTEM

**PATENT OWNER'S MANDATORY NOTICE
UNDER 37 C.F.R. § 42.8(a)(2)**

PATENT OWNER'S MANDATORY NOTICE INFORMATION

Patent Owner respectfully submits the following mandatory notice information under 37 C.F.R. § 42.8(a)(2) for Petition for *Inter Partes* Review of U.S. Patent No. 8,024,901 (the “’901 patent”).

I. Real Party in Interest under 37 C.F.R. § 42.8(b)(1)

Patent Owner DIRTT Environmental Solutions Ltd. (“DIRTT”) is the real party in interest in this Petition for *Inter Partes* Review. DIRTT owns all right, title and interest to the ’901 patent via assignment, recorded August 31, 2006, Reel 018197, Frame 0667.

II. Related Matters under 37 C.F.R. § 42.8(b)(2)

The following matters may affect or be affected by a decision in this proceeding:

Concurrently with this Petition, Allsteel filed another petition for *inter partes* review of the ’901 patent, which has been assigned Case No. IPR2015-01690.

DIRTT filed claims against Allsteel for infringement of the claims of the ’901 patent in United States District Court for the District of Utah, Case No. 2:15-cv-00123-PMW. The parties subsequently agreed to dismiss the action in the District of Utah in favor of pursuing the claims pertaining to the ’901 patent in a

related action currently pending in the Northern District of Illinois, Case No. 1:15-cv-4874.

The '901 patent is also currently the subject of three pending reissue applications: (1) 14/681,874 filed on September 20, 2013; (2) 14/305,819 filed on June 16, 2014; and (3) 14/681,874 filed on April 8, 2015. While none of the pending reissue applications has received a notice of allowance, the examiner in Reissue Application No. 14/681,874 has indicated that the application contains allowable subject matter in an Office Action mailed July 16, 2015. The art raised in this Petition has been identified in Information Disclosure Statements filed in each of pending reissue applications.

III. Lead and Back-up Counsel and Service Information under 37 C.F.R. § 42.8(b)(3)-(4)

DIRTT designates the following counsel and consents to electronic service at the email addresses provided below.

| LEAD COUNSEL | BACK-UP COUNSEL |
|---|---|
| Chad E. Nydegger (Reg. No. 61,020) (cnydegger@wnlaw.com) WORKMAN NYDEGGER 60 East South Temple, Suite 1000 Salt Lake City, UT 84111 T: 801-533-9800 F: 801-328-1707 | Michael J. Frodsham (Reg. No. 48,699) (mfrodsham@wnlaw.com) David R. Todd (Reg. No. 41,348) (dtodd@wnlaw.com) WORKMAN NYDEGGER 60 East South Temple, Suite 1000 Salt Lake City, UT 84111 T: 801-533-9800 |

| | |
|--|---|
| | F: 801-328-1707 Robert L. Florence (Reg. No. 54,933) (rflorence@wnlaw.com) WORKMAN NYDEGGER 1075 Peachtree Street NE, Suite 3650 Atlanta, GA 30309 T: 801-533-9800 F: 801-328-1707 |
|--|---|

CONCLUSION

DIRTT respectfully submits that the foregoing satisfies its requirements with respect to the Mandatory Notice of Information under 37 C.F.R. § 42.8(a)(2). If the Board requires additional information, DIRTT respectfully requests that the Board communicate directly with DIRTT’s lead or back-up counsel.

Date: August 28, 2015

Respectfully submitted.

By /Chad E. Nydegger/
Chad E. Nydegger, Reg. No. 61,020
Michael J. Frodsham, Reg. No. 48,699
David R. Todd, Reg. No. 41,348
WORKMAN NYDEGGER
60 East South Temple, Suite 1000
Salt Lake City, UT 84111
Telephone: 801-533-9800
Facsimile: 801-328-1707

Robert L. Florence, Reg. No. 54,933
WORKMAN NYDEGGER
1075 Peachtree Street NE, Suite 3650
Atlanta, GA 30309
T: 801-533-9800
F: 801-328-1707

Attorneys for Patent Owner
DIRTT Environmental Solutions Ltd.

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.