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Paper 46
Date Entered: August 30, 2018

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ALLSTEEL INC.,
Petitioner,

v.

DIRTT ENVIRONMENTAL SOLUTIONS LTD.,
Patent Owner.

Case IPR2015-01691
Patent 8,024,901 B2

Before SALLY C. MEDLEY, SCOTT A. DANIELS, and JACQUELINE T. HARLOW, *Administrative Patent Judges.*

MEDLEY, *Administrative Patent Judge.*

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

Petitioner, Allsteel Inc., filed a Petition requesting an *inter partes* review of claims 1, 4–11, 13–23, and 25 of U.S. Patent No. 8,024,901 B2 (Ex. 1001, "the '901 patent"). Paper 1 ("Pet."). Patent Owner, DIRTT Environmental Solutions Ltd., filed a Preliminary Response. Paper 9 ("Prelim. Resp."). Upon consideration of the Petition and Preliminary Response, we instituted an *inter partes* review of claims 1, 4–7, 9, 10, 14–20, and 25, pursuant to 35 U.S.C. § 314. Paper 10 ("Institution Decision").

We did not institute an *inter partes* review with respect to claims 8, 11, 13, and 21–23. *Id*.

Per a Final Written Decision, we determined that Petitioner had shown by a preponderance of the evidence that claims 1, 4–7, 9, 10, 14–20, and 25 are unpatentable. Paper 44 ("Final Written Decision"). Patent Owner filed a notice of appeal with the U.S. Court of Appeals for the Federal Circuit ("Federal Circuit"). In the meantime, and on April 24, 2018, the Supreme Court held that a decision to institute under 35 U.S.C. § 314 may not institute on fewer than all claims challenged in the petition. *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348, 1354 (2018). Accordingly, the Federal Circuit vacated our Final Written Decision in this proceeding and remanded "to allow the Board to issue a final written decision consistent with *SAS Institute Inc. v. Iancu*, 138 S. Ct. 1348 (2018)." *DIRTT Environmental Solutions Ltd. v. Allsteel Inc*., Case No. 17-1797, slip op. 2 (Fed. Cir. July 23, 2018); Exs. 3001, 3002.

In light of the Federal Circuit's vacatur and remand, we modify our Institution Decision to institute on all of the challenged claims and all of the grounds presented in the Petition. In particular, we now institute on Petitioner's assertion that claim 8 is unpatentable under 35 U.S.C. § 103(a) as obvious over Raith and Yu; claims 11 and 13 are unpatentable under 35 U.S.C. § 103(a) as obvious over Raith and EVH; and claims 21–23 are unpatentable under 35 U.S.C. § 103(a) as obvious over Raith and MacGregor.

Based on the record of this proceeding, a conference call is scheduled for 2:00 PM ET on September 13, 2018. The parties shall be prepared to discuss (1) whether there should be further briefing and oral hearing for

claims 8, 11, 13, and 21–23; (2) whether either party waives any issues regarding claims 8, 11, 13, and 21–23; and (3) due dates, not to exceed four months, for taking action regarding any proposed subsequent briefing and oral argument regarding claims 8, 11, 13, and 21–23. The parties are strongly encouraged to meet and confer on these issues prior to the scheduled conference call in order to mutually agree as to the issues outlined per this order.

It is:

ORDERED that our Institution Decision is modified to include review of all challenged claims and all grounds presented in the Petition; and

FURTHER ORDERED that a conference call is scheduled for 2:00 PM ET, September 13, 2018, whereby the parties shall be prepared to discuss the issues outlined per this order.

PETITIONER:

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