

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GODBERSEN-SMITH CONSTRUCTION COMPANY
d/b/a/ GOMACO CORPORATION,
Petitioner,

v.

GUNTERT & ZIMMERMAN CONST. DIV., INC.,
Patent Owner.

Case IPR2024-00835
Patent No. 11,535,318

PETITIONER'S REPLY

[REDACTED]

[REDACTED]

TABLE OF CONTENTS

I.	CLAIM CONSTRUCTION	1
A.	“A swing leg assembly configured to be coupled to a paving machine configured to move in a paving direction”	1
B.	“a crawler track rotatably coupled to the jacking column” and “a slew drive coupled to the jacking column and the crawler track, wherein the slew drive is configured to cause rotation of the crawler track relative to the jacking column”	5
II.	PRIOR ART COMBINATIONS.....	6
A.	GOMACO’s Petition and the Board’s Prior Findings in the ’749 IPR Show that the Claims Are Obvious.....	6
B.	G&Z’s Hindsight Arguments Lack Merit.....	12
C.	Even Under G&Z’s Erroneous Construction, the Claims Are Obvious.....	13
III.	SECONDARY CONSIDERATIONS DO NOT SUPPORT NONOBVIOUSNESS	16
A.	G&Z Is Estopped from Raising Its Secondary Considerations Arguments	16
B.	G&Z Has Not Shown a Nexus	17
C.	G&Z’s Alleged Secondary Considerations Evidence Is Deficient	18
1.	Alleged Long-Felt Need	18
2.	Alleged Industry Skepticism.....	19
3.	Alleged Copying	20
4.	Alleged Praise	23
5.	Alleged Commercial Success	24

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Amazon.com, Inc. v. Barnesandnoble.com, Inc.</i> , 239 F.3d 1343 (Fed. Cir. 2001)	22
<i>Ariosa Diagnostics v. Verinata Health, Inc.</i> , 805 F.3d 1359, 1365 (Fed. Cir. 2015)	11
<i>Beable Educ., Inc. v. Achieve3000, Inc.</i> , IPR2021-01169, Paper 34 (PTAB Jan. 3, 2023)	24
<i>Chef Am., Inc. v. Lamb-Weston, Inc.</i> , 358 F.3d 1371 (Fed. Cir. 2004)	1
<i>In re Cree, Inc.</i> , 818 F.3d 694 (Fed. Cir. 2016)	24
<i>Fox Factory, Inc. v. SRAM, LLC</i> , 944 F.3d 1366 (Fed. Cir. 2019)	17, 22
<i>Godbersen-Smith Const. Co. v. Guntert & Zimmerman Const. Div., Inc.</i> , IPR2020-00050, Paper 83 (Apr. 12, 2022)	4
<i>Godbersen-Smith Const. Co. v. Guntert & Zimmerman Const. Div., Inc.</i> , IPR2020-01698, Paper 80 (Apr. 12, 2022)	21
<i>Google LLC v. Hammond Dev. Int’l, Inc.</i> , 54 F.4th 1377 (Fed. Cir. 2022)	4, 16
<i>Iron Grip Barbell Co. v. USA Sports, Inc.</i> , 392 F.3d 1317 (Fed. Cir. 2004)	21
<i>Leo Pharm. Prods., Ltd. v. Rea</i> , 726 F.3d 1346 (Fed. Cir. 2013)	12, 13
<i>Oatey Co. v. IPS Corp.</i> , 514 F.3d 1271 (Fed. Cir. 2008)	3

<i>Ohio Willow Wood Co. v. Alps S., LLC</i> , 735 F.3d 1333 (Fed. Cir. 2013)	16
<i>Realtime Data, LLC v. Iancu</i> , 912 F.3d 1368 (Fed. Cir. 2019)	6
<i>Sensonics, Inc. v. Aerosonic Corp.</i> , 81 F.3d 1566 (Fed. Cir. 1996)	8
<i>SynQor, Inc v. Vicor Corp.</i> , 988 F.3d 1341 (Fed. Cir. 2021)	17
<i>Yita LLC v. MacNeil IP LLC</i> , IPR2023-00173, Paper 70 (PTAB Jun. 6, 2024)	17

I. CLAIM CONSTRUCTION

A. “A swing leg assembly configured to be coupled to a paving machine configured to move in a paving direction”

A claim is construed “as written, not as the patentees wish they had written it.” *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004). G&Z seeks to rewrite claim 1 by confining its processor limitations to scenarios where the paving machine is moving in a paving direction and the crawler tracks are under load. (POR, 19-25.) This construction contradicts the claim’s plain language, improperly reads out embodiments, and differs from the Board’s conclusions about nearly identical claim language in U.S. Patent No. 10,029,749 (“the ’749 patent”).

Claim 1 of the ’318 patent recites “[a] swing leg assembly configured to be coupled to a paving machine . . . , the swing arm assembly comprising” various components. (Ex. 1001, 22:41-23:7.) G&Z attempts to repurpose this preamble to require “a paving machine with a swing leg assembly.” (POR, 19.) But the swing leg assembly need only be *configured to be coupled* to a paving machine, not *actually* coupled. In contrast, the rest of the claim uses “coupled to” when actual coupling is required. (See Ex. 1001, 22:50 (jacking column “coupled to” swing leg), 22:51 (crawler track “rotatably coupled to” jacking column), 22:55 (slew

drive “coupled to” jacking column and crawler track).) This, alone, justifies rejecting G&Z’s construction.

G&Z also argues that the preamble somehow requires all limitations to be performed “while the machine is moving in the paving direction,” and for claim 1’s processor limitations to be read “to receive and send the claimed signals to coordinate movements of the swing leg and crawler track when moving and under load.” (POR, 19-20; *see id.*, 23.) Claim 1 contains no language confining the claim to these functionalities. (*Id.*; *see* Ex. 1001, 22:41-23:8.) Instead, the language “configured to move in a paving direction for spreading, leveling, and finishing concrete” modifies the “paving machine.” (Ex. 1001, 22:41-45; *see id.*, 9:12-31.) That limitation is satisfied when a paving machine is configured to move in the paving direction—regardless of when the processor limitations are performed.

Dependent claim 4 provides further support because it recites a situation where “the swing leg is positioned in a transport orientation.” (*Id.*, 23:16-24:2.) As G&Z’s expert acknowledged, the paving machine does not move in a paving direction when operating in transport orientation, contradicting G&Z’s argument that “the limitations are conducted while the machine is moving in the paving direction.” (Ex. 1184, 147:21-148:20; POR, 19.) Claim 1 cannot be construed to exclude features recited in its dependent claims.

G&Z's proposed construction also improperly reads out other embodiments from the '318 patent. These include embodiments where the crawler tracks are pivoted one at a time to new positions while off the ground and under no load. (Ex. 1001, 6:57-65, 11:3-7, 16:58-17:3, 17:9-17.) These scenarios are covered by claim 1. Nothing in claim 1 requires the paving machine to be moving in a paving direction *while the crawler tracks are being relocated*. Indeed, some embodiments include components that *prevent* the swing legs from pivoting while the machine is moving. (See *id.*, 6:1-7 (describing turnbuckles that hold the swing legs "in a fixed position during paving"); *id.*, 10:7-9.) See *Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1276-77 (Fed. Cir. 2008) (explaining that, absent evidence to the contrary, it is improper to exclude an embodiment if the claim can be reasonably interpreted to include that embodiment).

G&Z's proposed construction also directly contradicts the Board's conclusions in the '749 IPR. Similar to claim 1 of the '318 patent, claim 17 of the '749 patent recites "[a] paving machine configured to move in a paving direction" and comprising "two or more swing leg assemblies," each including a processor for performing substantively identical functions to those in claim 1 of the '318 patent. (Ex. 1033, 23:54-24:33.) The Board "discern[ed] nothing" in this claim confining to an embodiment "that rotates a crawler track when the crawler track is in contact with the ground." (Ex. 1036, 37-40.) Claim 1 of the '318 patent does not

materially differ from the claim that the Board previously construed, so collateral estoppel compels the same outcome here. *See Google LLC v. Hammond Dev. Int'l, Inc.*, 54 F.4th 1377, 1381 (Fed. Cir. 2022). The '318 patent claims simply have no language that restricts them to on-the-fly steering embodiments.

G&Z's prosecution arguments about the related '020 patent are unavailing. (POR, 23-24 (discussing the "'811 App.")). Like it did for the '749 patent, the Board concluded that claim 1 of the '020 patent "encompass[es] both an embodiment where the crawler track is rotated when the track is in contact with the ground, and an embodiment where the crawler track is lifted off the ground and rotated." *See Godbersen-Smith Const. Co. v. Guntert & Zimmerman Const. Div., Inc.*, IPR2020-00050, Paper 83 at 37-40 (Apr. 12, 2022). Moreover, G&Z's prosecution arguments for the '020 patent did not focus on the preamble or on-the-fly steering, but rather the prior art's alleged lack of a "rotary connection" where steering collars held the crawler tracks in place. (Ex. 2034, 9.) The arguments from prosecution of the '020 patent do not support limiting the claims to the on-the-fly steering embodiment. (*Id.*)

B. “a crawler track rotatably coupled to the jacking column” and “a slew drive coupled to the jacking column and the crawler track, wherein the slew drive is configured to cause rotation of the crawler track relative to the jacking column”

G&Z attempts to construe these terms “to mean that one side of the slew drive is coupled to the jacking column, one side of the slew drive is coupled to the crawler track, and neither cylinder of the jacking column rotates along with the crawler track.” (POR, 25-26.) G&Z argues that “[u]nlike the ’749 Patent,” this claim language “requires a slew drive that rotatably couples the crawler track to the jacking column and rotates the crawler track relative to the entire jacking column.” (*Id.*, 26.) Nothing about this proposed construction is “[u]nlike the ’749 Patent,” as evidenced by G&Z’s own arguments in the ’749 IPR.

In the ’749 IPR, G&Z proposed construing the claims to require “a power drive physically between the jacking column and the crawler track,” and argued that the claims do not encompass situations where the crawler track rotates relative to only a *portion* of the jacking column. (Ex. 1036, 35-37.) The Board adopted G&Z’s “power drive” construction and found that GOMACO’s proposed combination—the same one presented here—met G&Z’s proposed constructions for the power drive/rotary connection limitations. (*Id.*, 35-37, 68-79.) Nothing about the claims of the ’318 patent materially differ from those of the ’749 patent. The Board need not reach a construction for the terms here because the proposed

combination satisfies the claims under G&Z's construction. *See* Section II.C; *see also Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019).

II. PRIOR ART COMBINATIONS

A. GOMACO's Petition and the Board's Prior Findings in the '749 IPR Show that the Claims Are Obvious

G&Z argues that the Rio/CIII combination does not render obvious the claim features requiring (1) a crawler track to be rotatably coupled to a jacking column, or (2) a slew drive to be coupled to both a jacking column and a crawler track. (POR, 31-43.) G&Z contends these limitations make these proceedings different from the '749 IPR. (*Id.*) G&Z's alleged distinction, however, fails when considering what the Board found in the '749 IPR. (Ex. 1036.)

The Board summarized GOMACO's argument in the '749 IPR as follows: "it would have been obvious to modify CIII's leg assembly by positioning Rio's rotary actuator 44 at the bottom of the jacking column and on top of the crawler track" such that "the entire jacking column would be fixed rotationally, and *the rotary drive would be coupled between the bottom of the lower guide tube and the top of the crawler track* and would *rotate the crawler track relative to the jacking column.*" (Ex. 1036, 69-70 (emphasis added)).

The Board ruled for GOMACO, concluding that "locating the rotary actuator at the bottom of the lifting column, where the actuator could directly steer the

crawler track,” would have eliminated certain lifting column complexities. (*Id.*, 77.) The Board also found that “positioning the actuator at the bottom of CIII jacking column would simplify the jacking column’s design” because “the guide tubes would no longer need to rotate relative to the outer cylinder.” (*Id.*, 75). The Board further concluded that the state-of-the-art evidence supported obviousness by suggesting “positioning a rotary actuator at a position directly atop a crawler track or wheel.” (*Id.*) Thus, the Board agreed with GOMACO’s reasoning showing why the coupling configurations G&Z now raises would have been obvious.

GOMACO’s arguments continue to align with what the Board relied on to find obviousness in the ’749 IPR, including relying on the same rationale to modify CIII with Rio’s slew drive such that the slew drive is physically coupled between the bottom of the jacking column and top of the crawler track. (Pet., 27-31, 43-47.) GOMACO once again relies on Rio’s disclosure that its rotary actuator 44 can be positioned “on the lifting column 46” and “along the lifting column axis 48.” (Pet., 47 (citing Ex. 1006, 5:8-11).) In the ’749 IPR, the Board found that this “express disclosure” in Rio “would include positioning actuator 44 on lifting column 46 at the bottom of the column.” (Ex. 1036, 74; *see also id.*, 76-78.)

GOMACO further shows how the slew drive in its obviousness combination would couple to and function with the jacking column and crawler track. (*See, e.g.*, Pet., 31 (describing fixed or unitary lifting column guide tubes and a rotary drive

connected to the bottom of the lower guide tube); *id.*, 45 (explaining that the rotary actuator would “rotate CIII’s crawler track relative to the entire jacking column, rather than just its outer cylinder”); *id.*, 47 (describing “coupling Rio’s rotary actuator 44 to the jacking column and the crawler track” and causing “the crawler track to rotate relative to the entire jacking column”)).

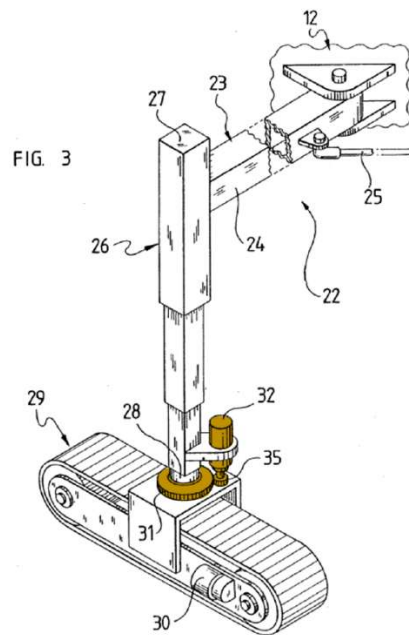
GOMACO also provides significant rationales for its proposed slew drive modification, such as providing increased range of motion (*id.*, 27-28), providing high torque and achieving fine rotary steering control (*id.*, 28), “reduc[ing] the power” needed to rotate the crawler track (*id.*, 31), and simplifying the manufacturing and maintenance of the jacking column (*id.*, 31).¹ The Board relied on each of these rationales when finding all challenged claims obvious in the ’749 IPR. (*See, e.g.*, Ex. 1036, 59-62.)

GOMACO further asserts state-of-the-art evidence that the Board previously found persuasive in the ’749 IPR. (*See, e.g.*, Pet., 27-31; Ex. 1036, 51 (explaining that Miller’s disclosure of “a slipform paver” with rotary actuator components

¹ G&Z relies on *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566 (Fed. Cir. 1996) to argue, like it did in the ’749 IPR, that simplification does not establish obviousness. The Board should reject G&Z’s *Sensonics* argument for the same reasons it did in the ’749 IPR. (Ex. 1036, 75-76.)

“positioned physically between the jacking column and crawler track, at least suggest[s] this location for an actuator”); *id.*, 16 (showing Littman’s rotary actuator 122 positioned just above the wheel); *id.*, 49 (explaining that Johns discloses a construction machine with “a rotary actuator located just above” each wheel).)

GOMACO also relies on Whitaker as state-of-the art evidence, which was not cited in the ’749 IPR. As shown, Whitaker discloses a slew drive (gold) positioned between a telescoping jacking column that rotates the crawler track relative to the jacking column. (*See, e.g.*, Ex. 1002, ¶¶64, 70 (citing Ex. 1011, 3:65-4:16, Fig. 3); Pet., 29-31.)



(Ex. 1011, Fig. 3 (annotated).)

GOMACO further relies on a brochure for the GT-3200, which was a GOMACO slipform paver having a front jacking column with upper and lower guide tubes that are rotationally fixed, and a rotary actuator coupled between the jacking column and crawler track that turns the crawler track up to 180° relative to the entire jacking column, shown right. (Ex. 1010, 3 (annotated); Ex. 1002, ¶¶71, 133; Pet., 29-31; Ex. 1184, 121:14-135:7.) G&Z’s expert confirmed the GT-3200’s rotary actuator “rotates the front crawler track relative to the jacking column components above it” and that “nothing above the rotary drive is rotating.” (Ex. 1184, 128:24-129:23; *see also id.*, 134:17-135:7.)



This GT-3200 evidence, along with the other state-of-the-art evidence, confirms that a POSITA considering CIII and Rio would have known to make the coupling configurations described in GOMACO’s Petition. This is precisely what the Board found in the ’749 IPR. (Ex. 1036, 50; *see also id.*, 75 (relying on GOMACO’s state-of-the-art evidence because it “serve[d] to document the knowledge that skilled artisans would bring to bear in reading’ Rio to encompass

positioning the rotary actuator at the bottom of the lifting columns” (quoting *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1365 (Fed. Cir. 2015))).)

G&Z argues that CIII and Rio *alone* do not disclose certain aspects of the claims. But the Board previously rejected this type of argument, finding that:

numerous prior art references in the record illustrating prior artisans positioning a rotary actuator over a wheel or crawler track to independently steer the wheel or track, sufficiently demonstrate that Petitioner’s combination of CIII’s and Rio’s teachings teaches or suggests the subject matter of the “power drive” limitation.

(Ex. 1036, 76-77.) This reasoning applies with equal force in the current IPR (and with even more force because Whitaker, which was not cited in the ’749 IPR, is cited here and expressly illustrates this arrangement).

G&Z also suggests that differences in prior-art machine size and in forces experienced by the crawler tracks show a lack of motivation to combine and no expectation of success. (POR, 38, 41-43.) The Board rejected similar arguments in the ’749 IPR because *G&Z’s own expert* testified that a POSITA would have known how to do the math necessary to scale components and forces for machines. (Ex. 1036, 55-58, 61-62 (citing Ex. 1157, 13:11-16:13).) If anything, this

admission shows an expectation of success in GOMACO's proposed modification, not the contrary.

B. G&Z's Hindsight Arguments Lack Merit

G&Z is wrong to argue that the CIII/Rio combination was a product of hindsight for the same reasons it was wrong in the '749 IPR. (Ex. 1036, 78-79.) First, GOMACO's proposed combination is derived from Rio's express disclosure stating that its rotary drive (e.g., a slew drive) can be positioned "on the lifting column 46" and "along the lifting column axis 48." (Pet., 47 (citing Ex. 1006, 5:8-11).) Second, GOMACO presented state-of-the-art evidence, which informs how a POSITA would have understood CIII and Rio at the time of the alleged invention. (*Id.*, 27-32.) Third, GOMACO explained how and why the teachings of CIII and Rio would have been combined. (*Id.*, 27-35.) For these reasons, all of which the Board relied on in the '749 IPR, GOMACO's prior-art combination was not a product of hindsight. (Ex. 1036, 78-79.)

G&Z's reliance on *Leo Pharmaceutical Products, Ltd. v. Rea*, 726 F.3d 1346 (Fed. Cir. 2013) is misplaced. G&Z relies on *Leo* to argue, like it did in the '749 IPR, that "considerable" time has elapsed between references like Miller and Littman and the date of the alleged invention. (POR, 40-41.) The Board should reject G&Z's *Leo* argument for the same reason it did in the '749 IPR—i.e., because *Leo* involved an "obvious-to-try" analysis not at issue here, and because

the inventor in *Leo* “discovered the problem to be solved,” which G&Z cannot allege here because of its long-felt need argument. (Ex. 1036, 52.) The dates on the prior-art references here show that the relevant features have been known and used for decades and are mere design choices.

C. Even Under G&Z’s Erroneous Construction, the Claims Are Obvious

G&Z’s claim-construction argument seeking to import an on-the-fly steering requirement into the claims should be rejected for the reasons described in Section I.A. But even under G&Z’s proposed construction, the claims are still obvious. For instance, Rio discloses actively using an actuator to pivot a swing leg from a retracted position to a projecting position while counter-rotating the crawler track *during that pivoting* such that the crawler track always remains parallel to the machine frame. (Ex. 1006, 8:1-37; *see also* Ex. 1157, 70:21-75:14.) As the Board correctly found in the ’749 IPR “Rio discloses that sufficient torque can be generated to rotate the crawler track, both when engaged with the ground and raised off the ground.” (Ex. 1036, 59; *see also* Ex. 2011, 110:6-19.) It would have been obvious to a POSITA combining CIII and Rio to implement Rio’s rotary actuator and control system to pivot the swing legs and rotate the crawler tracks while the paving machine is moving and the crawler track is under load. (Ex. 1002, ¶80.)

The state-of-the-art evidence confirms the obviousness of this modification by disclosing on-the-fly steering designs for heavy machinery with swing legs. For example, G&Z’s expert admitted that Littman discloses an automated “computer” system that uses the sensor on the crawler track’s rotary actuator to hold the crawler track perpendicular as it drives along the ground while the swing arm pivots. (Ex. 1184, 88:10-95:8; Ex. 1007, 9:61-64; Ex. 1002, ¶80.).

G&Z’s expert further admitted that Skotnikov, which discloses an agricultural machine with a helical actuator that pivots a swing leg and a worm-gear drive that rotates crawler the tracks, (Ex. 1185, 35:1-46:19), uses these actuators to pivot its swing legs to desirable widths while “[e]verything’s being coordinated together so that you have the wheels faced in the direction you need to go, and you have the width that you need,” (*id.*, 53:8-56:21.) He then testified that “if the arms . . . and the wheels get out of alignment,” the system “*adjusts them on—on the fly without operator input*” as the machine is moving forward while the crawler tracks are under load. (*Id.*, 55:3-56:21 (emphases added); Ex. 1017, 5:1-38.)

Tax also discloses an on-the-fly steering system for a crane, where track width is narrowed by angling the wheels inward so that, when the vehicle moves

forward, the swing legs pivot inward as wheels roll along the ground under load.

(Ex. 1016, 5:1-27, Figs. 7A-7C; Ex. 1002, ¶80.)²

G&Z’s arguments about “locking mechanisms” that prevent the CIII/Rio swing legs from moving “under load or while in motion” fail. (POR, 30.) Rio teaches an “anti-swing device” that is automatically actuated when it is desired to pivot the swing arm. (Ex. 1006, 6:27-37, 8:21-30.) The Petition explained why it would have been obvious to modify CIII by replacing its locking pin and/or turnbuckles with Rio’s anti-swing device “to fully automate the rotation of the swing leg.” (Pet., 34.) This allows an operator to pivot each swing leg when moving and under load by simply releasing the anti-swing device with a switch. (Ex. 1006, 8:27-30; Ex. 2011, 104:3-19.) Moreover, the ’318 patent discloses its own devices for holding each swing leg “in a fixed position” during paving, showing that Rio’s similar anti-swing device is within the scope of the claims. (Ex. 1001, 6:1-16, 10:3-9.)

² Littman, Tax, and Whitaker are analogous art under Dr. Bryden’s admissions. (Ex. 1184, 29:6-31:15.)

III. SECONDARY CONSIDERATIONS DO NOT SUPPORT NONOBVIOUSNESS

A. G&Z Is Estopped from Raising Its Secondary Considerations Arguments

Collateral estoppel bars G&Z from relitigating secondary considerations because it is the same issue that the Board decided in the prior '749 IPR, it was actually litigated, it was essential to the final finding of unpatentability, which was affirmed by the Federal Circuit, and G&Z had a full and fair opportunity to litigate it in the prior IPR. *See Google*, 54 F.4th at 1381. While the challenged claims here are not identical to those in the '749 IPR, they do raise the same issues, so estoppel applies. *Ohio Willow Wood Co. v. Alps S., LLC*, 735 F.3d 1333, 1342 (Fed. Cir. 2013) (stating that collateral estoppel is not limited “to patent claims that are identical. Rather, it is the identity of the issues that were litigated that determines whether collateral estoppel should apply”). In fact, G&Z presents largely identical arguments and evidence on secondary considerations as it did in the '749 IPR. (*Compare* POR, 58-84, *with Godbersen-Smith Const. Co. v. Guntert & Zimmerman Const. Div., Inc.*, IPR2020-01698, Paper 41 at 70-83 (July 30, 2021) (“’749 POR”). For example, G&Z’s commercial-success and long-felt need arguments in this case are *almost identical* to those presented in the '749 IPR. (*Compare* POR, 82-84, *with* '749 POR, 81-83 (commercial success); *compare* POR, 59-62, *with* '749 POR, 70-74 (long-felt need).). And to the extent G&Z cites

limited additional evidence, “collateral estoppel applies ‘even if new evidence exists.’” *SynQor, Inc v. Vicor Corp.*, 988 F.3d 1341, 1355 (Fed. Cir. 2021) (citation omitted).

The Board has applied collateral estoppel to prevent relitigation of secondary considerations on a related patent. *See, e.g., Yita LLC v. MacNeil IP LLC*, IPR2023-00173, Paper 70 at 107-10 (PTAB Jun. 6, 2024) (“Patent Owner is collaterally estopped from relitigating the factual issue of the reasons for the industry praise and commercial success.”). Even if the Board declines to apply collateral estoppel, it should consider its previous findings when evaluating substantively identical issues and reach the same conclusions.

B. G&Z Has Not Shown a Nexus

G&Z has not proven that the alleged “evidence of secondary considerations is the ‘direct result of the unique characteristics of the claimed invention’” and has therefore failed to prove a nexus. *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1374 (Fed. Cir. 2019) (citation omitted).³

³ G&Z does not argue a presumed nexus.

C. G&Z's Alleged Secondary Considerations Evidence Is Deficient

1. Alleged Long-Felt Need

G&Z's long-felt need arguments and evidence are very similar to the arguments it presented in the '749 IPR. (*Compare* POR, 59-62, *with* '749 POR, 70-74.) The Board rejected those arguments and found that "Patent Owner d[id] not demonstrate a nexus between the claimed invention and a long-felt need," and that "even if Patent Owner demonstrated a nexus . . . [the] evidence is not entitled to much weight." (Ex. 1036, 86; *see also id.*, 85.)

Here, G&Z's articulation of the alleged need shifts throughout its argument, ranging from the alleged need "for repositioning the swing leg/crawler track when moving and under load," to the alleged need "for a slipform paver with greater maneuverability," to "quickly transform[ing] . . . from a paving mode to 90 degree steering position," to "enabl[ing] a wide range of steering angles." (*See* POR, 58, 60; *see also id.*, 59, 61 (describing other variations of the alleged need).) Despite this inconsistency, G&Z seems to contend that the long-felt need includes repositioning the swing leg/crawler track when moving *under load*, which, as discussed above, is not required by the claims as properly construed. (*See* Section I.A.) As properly construed, the Board previously found that "the prior art already solved any need for a swing leg assembly that automatically positioned a crawler track over 90-degrees, at least when the crawler track is off the ground." (Ex. 1036,

85.) Moreover, even under G&Z’s erroneous construction, the prior art already met the alleged need for repositioning the swing leg/crawler track on-the-fly. (*See* Section II.C.)

In addition, the alleged need was not *long felt*. According to G&Z, an alleged need arose “[i]n the early 2000s.” (POR, 59 (citing Exs. 2015, 2022).) But, as the Board previously found when considering an identical declaration from Mr. Greenwood, any need he articulated arose “*as late as 2009*.” (Ex. 2022, ¶5; *see* Ex. 1036, 86.) Thus, “not much time passed between an identified need and the claimed invention[’s]” alleged 2010 priority date. (Ex. 1036, 86.)

2. Alleged Industry Skepticism

G&Z argues that “the S600’s use of a slew drive for driving and steering under load overcame industry skepticism,” as expressed by “slew drive manufacturers” and “engineers within G&Z.” (POR, 62-63.) As an initial matter, steering under load is not required by the ’318 patent as properly construed, so there is no nexus between the asserted evidence and the claim scope. Regardless, neither piece of evidence shows skepticism.

In Exhibit 2013, Kinematics merely expressed a desire to [REDACTED] [REDACTED] and considered whether [REDACTED] [REDACTED]. (Ex. 2013, 1-2.) The email concludes with Kinematics and G&Z [REDACTED]. (*See id.*)

Kinematics was also incorrect that [REDACTED]
[REDACTED] (*Id.*, 1.) But it was
already known in the art to use slew drives on machines while driving and steering
under load [REDACTED]. (*See* Ex. 1006, 4:61-5:7, 9:15-51;
Ex. 1016, 5:1-27, Figs. 7A-7C; Ex. 1017, 3:53-58, 5:39-67.)

Similarly, in Exhibit 2024, Mr. Dahlinger’s [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] (Ex. 2024, 4.) If anything, this expresses [REDACTED]
[REDACTED]
[REDACTED]. (*Id.*) In fact, the next sentence and
paragraph [REDACTED]
[REDACTED] showing optimism—not skepticism—about a
slew drive solution. (*Id.*)

3. Alleged Copying

G&Z contends it demonstrated its S600 with SmartLeg/Accusteer at
ConExpo in March 2011 and that GOMACO attended and had access to the
machine. (POR, 64-67.) G&Z then suggests GOMACO “decid[ed] to copy G&Z’s
design” (POR, 67), but does not point to a single piece of evidence showing that
GOMACO copied G&Z.

First, G&Z cites Dr. Bryden’s declaration, which parrots the same conclusory allegation that GOMACO “decid[ed] to copy G&Z’s design” without any supporting evidence. (Ex. 2015, ¶88.) Second, G&Z cites the Board’s findings in the ’749 IPR, where the Board found GOMACO’s development documents reflected that GOMACO’s [REDACTED] [REDACTED] (*Godbersen-Smith Const. Co. v. Guntert & Zimmerman Const. Div., Inc.*, IPR2020-01698, Paper 80, at 60, 90 (Apr. 12, 2022)), rather than copying. (Ex. 1036, 91.) Finally, G&Z contends GOMACO’s GP3 “copied its design from G&Z’s S600.” (POR, 68.) But G&Z provides no evidence of copying and instead provides a claim chart annotating pictures of GOMACO’s GP3 with terms from the ’318 patent. (POR, 68-75.) GOMACO disputes infringement, but *even if* GOMACO’s GP3 infringed the ’318 patent, that alone is not evidence of copying. *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004) (“Not every competing product that arguably falls within the scope of a patent is evidence of copying. Otherwise every infringement suit would automatically confirm the nonobviousness of the patent.”).

Next, G&Z presents a litany of marketing terms containing the word “Smart” and unclaimed features that it contends GOMACO copied. (POR, 76.) But GOMACO used the word “Smart” for sensor-based features years before G&Z’s 2011 launch of the S600, so GOMACO’s continued use of “Smart” is not evidence

of copying G&Z. (*See, e.g.*, Ex. 1005, 44, 408 (referring to “Smart steer controls” and “Smart steer cylinder” in prior art CIII manual from 2002); Ex. 1183, 10 (referring to “‘smart’ cylinders” on GT-3600 in 2006); Ex. 1181, 4-5, 14 (referring to “‘smart’ cylinders” on GT-3400 and GT-3600 in 2007).)

G&Z also argues that GOMACO’s GP3 has similar frame widening, paving kit, front tie bar inserter, and dowel bar inserter attachment as the S600. (POR, 76.) But G&Z has not shown that GOMACO introduced each of these features after G&Z introduced the S600. Nor could it. For example, GOMACO introduced its dowel bar inserter attachment (IDBI attachment) in 2009, well before G&Z launched the S600 in 2011. (Ex. 1182, 20-21.) Regardless, none of these features are claimed in the ’318 patent, so there is no nexus to the claimed invention.

Amazon.com, Inc. v. Barnesandnoble.com, Inc., 239 F.3d 1343, 1366 (Fed. Cir. 2001) (“[E]vidence of copying [a] feature is legally irrelevant unless [that] feature is shown to be an embodiment of the claims.”); *Fox Factory*, 944 F.3d at 1378 (stating that evidence must be “attributable to the claimed *combination* of [features], as opposed to . . . unclaimed features”).

Finally, G&Z argues that Wirtgen copied G&Z’s SmartLeg / AccuSteer features because Wirtgen had access to the machine at ConExpo and then launched the SP64i slipform paver, which allegedly has “similarities” to G&Z’s S600. (POR, 76-77.) But G&Z provides nothing more than conclusory annotations of a

Wirtgen product with elements of the '318 patent. (*Id.*, 77-80.) Also, G&Z *has not sued Wirtgen*, further undermining G&Z's assertion that Wirtgen copied and G&Z's implication that Wirtgen infringes.

4. Alleged Praise

G&Z's praise arguments fail, and the limited evidence G&Z presents is deficient. First, G&Z cites Exhibit 2014, an article in Heavy Equipment Guide. (POR, 81-82.) But the portions of the article G&Z quotes do not mention SmartLeg/AccuSteer (POR, 81-82 (quoting Ex. 2014)), and the other portions of the article that do mention SmartLeg/AccuSteer merely describe, rather than praise, that technology, (Ex. 2014, 1-2), which the Board previously found when considering this same article. (Ex. 1036, 87 (finding this article "falls short of praising the technologies").) Moreover, the article discusses other features of the S600, like "TeleEnds," "VariWidth," and "NoLine," as much as "SmartLeg" and "AccuSteer." (*See* Ex. 2014, 1-2.) As the Board found on the same evidence in the '749 IPR, this "somewhat limit[s] the nexus to the claimed invention, and consequently, the weight of the evidence." (Ex. 1036, 87.)

Second, G&Z argues that the sale of four S600s with SmartLeg/AccuSteer before its formal launch and its customers' use of them for urban paving and highway rehabbing shows industry praise. (POR, 82 (citing Ex. 2025).) But Exhibit 2025 is G&Z's own marketing literature, stating that "G&Z couldn't have been

happier with the initial reception.” (Ex. 2025, 5 (emphasis added).) It is entitled to no weight. *See In re Cree, Inc.*, 818 F.3d 694, 702 (Fed. Cir. 2016) (self-serving statements from researchers about their own work do not demonstrate industry praise); *Beable Educ., Inc. v. Achieve3000, Inc.*, IPR2021-01169, Paper 34 at 77 (PTAB Jan. 3, 2023) (“Patent Owner’s *own* laudatory comments in marketing materials for the Achieve3000 Literacy product are not praise *from the industry*.”).

The Board should find, as it did in the ’749 IPR, that “the totality of the evidence . . . does not provide persuasive evidence of industry praise, given the sources of the evidence, the tone of the language, and, importantly, the positive discussions of other technologies associated with the pavers.” (Ex. 1036, 87-88.)

5. Alleged Commercial Success

G&Z’s commercial-success arguments in this case are almost identical to the arguments it presented in the ’749 IPR. (*Compare* POR, 82-84, *with* ’749 POR, 81-83.) The Board rejected those arguments and found “Patent Owner’s commercial success evidence is entitled to very little weight.” (Ex. 1036, 93.) The Board should do so again here, where the evidence of commercial success is even more deficient.

For example, Exhibits 2035 and 2036 are supposedly authored by Lieven Van Broekhoven (Ex. 2035, 14; Ex. 2036, 17), but Mr. Van Broekhoven did not provide a declaration in this case, despite having done so in the ’749 IPR. In

addition to being inadmissible hearsay, G&Z provided no information on how the information in the reports was obtained. They should get no weight.

The same is true for Exhibit 2031, which purports to be a spreadsheet of “Guntert & Zimmerman Pavers and Swing Leg Sales.” (POR, x; Ex. 2031.) G&Z submitted a declaration of Mr. Guntert stating that “the contents of [the spreadsheet] are a true and accurate represent [sic] of G&Z’s concrete paver sales.” (Ex. 2016, ¶11.)⁴ But the spreadsheet goes well beyond providing sales data—it contains conclusory allegations about [REDACTED]

[REDACTED] (*id.*, 11-12). The data is also inconsistent. For example, one page states there were [REDACTED] (*id.*, 12), while another shows [REDACTED] [REDACTED] (*id.*, 8).

Finally, G&Z contends it lost market share because of GOMACO. (POR, 83-84.) But the evidence shows other factors caused G&Z’s sales decline, including:

- [REDACTED]
[REDACTED] (Ex. 1166, 16, 23; Ex. 2036, 10);

⁴ In the ’749 IPR, G&Z submitted a declaration of Salima Ismaylova, who allegedly created the spreadsheet, but did not in this case.

- [REDACTED]
[REDACTED] (Ex. 1166, 24);
- [REDACTED] (*id.*, 21);
- [REDACTED]
[REDACTED] (*id.*, 32, 36; *see also* Ex. 1167, 3);
- [REDACTED] (*See*,
e.g., Ex. 1168, 3 ([REDACTED]); Ex. 1169, 1 (same); Ex. 1170 (same);
Ex. 1162, 121:21-122:11, 124:7-126:14 ([REDACTED]
[REDACTED]));
- [REDACTED]
[REDACTED] (Exs. 1186, 1194-1208); and
- [REDACTED] (Ex. 1186,
46:14-57:12).

The Board should find, like it did in the '749 IPR, that G&Z has failed to provide persuasive evidence that its change in market share is attributable to GOMACO rather than the factors above. (*See* Ex. 1036, 94.)

Respectfully submitted,

Dated: May 21, 2025

By: /Jason Stach/
Jason Stach, Reg. No. 54,464

*Counsel for Petitioner Godbersen-
Smith Construction Company d/b/a/
GOMACO Corporation*

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the foregoing PETITIONER'S REPLY contains 5,590 words, excluding parts of the paper exempted under § 42.24(a), as measured by the word-processing system used to create the paper.

Dated: May 21, 2025

/Jason Stach/

Jason Stach

Reg. No. 54,464

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing **PETITIONER’S REPLY** was served on May 21, 2025. The parties have agreed that filing with the Board through the PTAB’s P-TACTS system constitutes electronic service on Patent Owner, and Petitioner filed the documents via the PTAB’s P-TACTS system. Accordingly, Petitioner electronically served Patent Owner’s counsel of record, including James Hannah, Jeffrey H. Price, and Jenna Fuller.

Dated: May 21, 2025

By: /Daniel E. Doku/
Daniel E. Doku
Senior Litigation Legal Assistant

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, LLP