UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIMPSON STRONG-TIE COMPANY INC.
Petitioner

v.

COLUMBIA INSURANCE COMPANY
Patent Owner

Case No. PGR2023-00047
Patent No. 11,649,626

PETITIONER SIMPSON STRONG-TIE COMPANY INC.'S EXPLANATION REGARDING NECESSITY OF MULTIPLE PETITIONS FOR *POST GRANT* REVIEW OF U.S. PATENT NO. 11,649,626

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. Introduction

Petitioner Simpson Strong-Tie Company Inc. (Simpson) is simultaneously filing three Petitions (PGR2023–00047, PGR2023–00048, PGR2023–00049) collectively challenging the patentability of claims 1–105 in U.S. Patent No. 11,649,626 (the '626 patent), and respectfully asks the Board to institute all three Petitions. Pursuant to the Trial Practice Guide, Simpson ranks -00047 Petition as the first petition the Board should consider, followed by -00048; provides "a succinct explanation of the differences between the petitions;" and explains "why the issues addressed by the differences are material" and "why the Board should exercise its discretion to institute additional petitions." CTPG (Nov. 2019), 60.

II. The '626 Patent Recites an Unusually Large Number of Claims

The Board recognizes that there are instances where more than one petition is appropriate against a single patent, particularly "when the patent owner has asserted a large number of claims in litigation." CTPG (Nov. 2019), 59. This is the case here. The '626 patent includes 105 total claims, altogether comprising over 7,300 words and thirteen columns. The '626 patent recites only two independent claims (i.e., claims 1 and 53), each further limited by various sequences of dependent claims (e.g., claims 2–8/54–60, 9–15/61–66, 16–20/68–72, 33–35/85–88, 39–45/92–98, 47–49/100–102, and 50–52/103–105) that cover distinct features of the recited hanger. Simpson attempted to group the claims into subsets based on

overlapping features so that as many claims as possible could be addressed in one petition. However, not only do the '626 patent claims cover many combinations and permutations of features, but many claims also include a variety of different features and different phrasings of similar features, justifying the need for three Petitions to sufficiently address the variety of claimed aspects.

At the time of filing these three Petitions, Simpson does not know which claims will be asserted against it in district court. On May 17, 2023, Patent Owner served Simpson with a complaint generally alleging that Simpson's products "infringe ***at least*** claim 1 of the '626 Patent." EX1042, 12, ¶48 (emphasis added.) Not knowing which claims Patent Owner will eventually assert in district court, Simpson could not reasonably fit its analysis to address the large number of claims—105 total claims—in fewer than the three Petitions.

III. Material Distinctions Exist Between the Petitions

The main difference between the Petitions is that different sets of claims are challenged in each Petition, with the limited exception that substantively identical analysis for independent claims 1 and 53 is included in each Petition as these form the basis for all the challenged dependent claims. Since the analysis of the two independent claims is the same in each Petition, the Board need only address that analysis once, avoiding inefficient use of the Board's resources. The dependent claims covering different features of the recited hanger were divided among the

three Petitions without any unnecessary overlap, as summarized in the table below:

Petition	Claims	Exemplary Distinct Features
1	1, 2–8, 16–20, 28, 46–49, 53, 54–60, 68–72, 80, 99–102	back panels/stop directly connected to side panels and extension flanges; a first axis normal to back flange's front surface and intersecting the first side panel
2	1, 22–27, 39–45, 50–52, 53, 74–79, 92–98, 103–105	one-piece hanger; second back and top flanges
3	1, 9–15, 21, 29–38, 53, 61–67, 73, 81–91	skewed hanger; juncture at extension flanges

Due to the grouping of the dependent claims, each of the three Petitions addresses distinct features of the recited hanger. First, the -00047 Petition addresses particular features of the recited hanger's stop, such as the first and second back panels being directly attached to both extension flanges and side panels of the channel-shaped portion (*see* claims 4–5/56–57), which are not covered by the claims addressed in the PGR2023–00048 and –00049 Petitions. Second, the –00048 Petition addresses all the claims reciting a one-piece hanger (*see* claims 22–27/74–79) and all the claims reciting second back and second top flanges (*see* claims 39–45/92–98 and 52/105), which are not covered by the PGR2023-00047 and -00049. Third, the –00049 Petition addresses all the claims directed to the skewed hanger embodiment of the '626 patent (*see* claims 15, 31, 37, 67, 83, and 90) and, to address these features, relies on an additional

reference—Gilb'416—not raised in the other Petitions. Accordingly, the Petitions address different material issues based on the groupings of the dependent claims by distinct features.

IV. Every *General Plastic* Factor Weighs In Favor Of Instituting All Three Petitions.

The Board should exercise its discretion to institute all three Petitions here because the equities favor Simpson and doing so would not significantly burden the Board or Patent Owner. 37 C.F.R. § 314(a); *see General Plastic Industrial Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at 5 (P.T.A.B. Sep. 6, 2017) (precedential).

First, as explained above, the three Petitions are not directed to all the same claims and are not cumulative. Specifically, the –00047 Petition challenges 34 claims not covered in the remaining Petitions. The –00048 Petition challenges 32 claims not covered in the remaining Petitions. And the –00049 Petition challenges 37 claims not covered in the remaining Petitions. Thus, *General Plastic* Factor 1 weights in favor of instituting all three Petitions.

Second, the three simultaneous Petitions here do not present the potential inefficiency or prejudice that concerned the Board in *General Plastic*, which examined so-called "staggered" or "follow-on" petitions that are not filed simultaneously. *General Plastic*, Paper 19, 17. Here, the three Petitions are being filed on the same day, and no entity has filed a previous petition against the '626

patent. Thus, no time has elapsed between the Petitions, and Simpson has not gained any advantage by using earlier preliminary responses or institution decisions as a "roadmap" for its Petitions. *See id.*, 16-17. Accordingly, *General Plastic* Factors 2–5 weigh in favor of instituting all three Petitions. *Id.*

Third, for *General Plastic* Factor 6, there would be no excessive burden on the Board's finite resources or Patent Owner in instituting all three Petitions. Simpson is filing three Petitions against a patent containing 105 claims. Each Petition applies the same analysis for the two independent claims, 1 and 53, so as not to gain any advantages for these claims from the separate Petitions. While this similarity does not make the Petitions redundant due to the different claims each Petition addresses, it does minimize the burden on the Board and Patent Owner.

Fourth, *General Plastic* Factor 7 also favors Simpson because three Petitions are being filed on the same day, and thus their respective schedules may be aligned and will not hinder the Board's ability to issue a final determination within one year of institution. Indeed, Simpson foresees requesting consolidation of these three proceedings should they all be instituted.

V. Conclusion

Because all seven *General Plastic* factors weigh in favor of Simpson, the Board should institute all three Petitions.

Respectfully Submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Michelle K. Holoubek/

Michelle K. Holoubek
Registration No. 54,179
Lead Attorney for Petitioner

Date: August 17, 2023

1101 K Street, NW, 10th Floor
Washington, DC 20005-3934
(202) 371-2600

Case PGR2023-00047
Patent No. 11,649,626

CERTIFICATION OF SERVICE (37 C.F.R. § 42.6(e))

The undersigned hereby certifies that on August 17, 2023, a true and correct copy of the foregoing **PETITIONER SIMPSON STRONG-TIE COMPANY INC.'S EXPLANATION REGARDING NECESSITY OF MULTIPLE PETITIONS FOR POST GRANT REVIEW OF U.S. PATENT NO. 11,649,626** was served in its entirety on the following parties via FedEx® Express:

STINSON LLP
7700 Forsyth Blvd.
Suite 1100
St. Louis, MO 63105
PAIR Correspondence Address for U.S.P.N. 11,649,626

Duane H. Mathiowetz
MORGAN FRANICH FREDKIN SIAMAS & KAYS LLP
333 W. San Carlos St., Suite 1050
San Jose, CA 95110
Other address known to the petitioner as likely to effect service

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Michelle K. Holoubek/

Michelle K. Holoubek
Registration No. 54,179
Lead Attorney for Petitioner

Date: August 17, 2023

1101 K Street, NW, 10th Floor
Washington, DC 20005-3934
(202) 371-2600