

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 PGR2023-00049
U.S. Patent No. 11,649,626

**PATENT OWNER'S SUR-REPLY
TO THE PETITION FOR POST GRANT REVIEW**

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EXHIBIT LIST

Exhibit No.	Description
2001	U.S. Patent No. 537,504
2002	1994 Timber Construction Manual
2003	2012 International Building Code
2004	2000 International Building Code
2005	MiTek FWH Spec. Sheet
2006	DU/DHU/DHUTF Drywall Hangers

I. EXPERT TESTIMONY WAS NOT REQUIRED TO REBUT PETITIONER’S ARGUMENTS

Simpson argues that Petitioner’s lack of expert testimony is reason alone for the Board to “dispense with PO’s Response and affirm the Board’s findings in the Institution Decision as a final written decision.” To the contrary, there is no requirement that a party rely exclusively on expert testimony in Post Grant Review proceedings or that attorney argument must be disregarded.

Notably, both of the cases that Simpson cites to suggest that the Board should disregard Patent Owner’s attorney argument are inapposite and taken of context. *Enzo Biochem, Inc.* was addressing whether there was a genuine issue of material fact in the context a motion for summary judgement where the attorney argument was being offered to rebut documentary evidence. *Enzo Biochem, Inc. v. Gen-Probe, Inc.*, 424 F.3d 1276, 1283 (Fed. Cir. 2005). *Gemtron Corp.* concerned attorney argument that was raised for the first time at the appeal oral argument to contradict the evidence presented at trial concerning fact issues. *Gemtron Corp. v. Saint-Gobain Corp.*, 572 F.3d 1371, 1380 (Fed. Cir. 2009). In contrast to Simpson’s cited cases, the instant Patent Owner Response was not presenting attorney argument in the place of evidence. Instead, the attorney argument was addressing *questions of law* (namely claim construction and obviousness) and not questions of fact.

Simpson’s arguments also incorrectly assume that the only form of evidentiary support available is the bought-and-paid-for testimony of an advocate

expert. Contrary to Simpson’s assertion, Patent Owner’s Response *was* supported by evidentiary support—namely the unambiguous disclosure of U.S. Patent No. 11,649,626 and Simpson’s asserted prior art reference.

Much of the Patent Owner’s Response is reliant on applying proper claim constructions to the term “channel-shaped portion” and the phrase “engaging each other along a juncture.” Under the *Phillips* standard, the process of construing claim terms begins not with expert testimony, but with the intrinsic evidence—*i.e.*, the contents of the patent itself and the prosecution history. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1314-1317 (Fed. Cir. 2005) (en banc). While expert testimony *can assist*—in the appropriate instance—in explaining the disclosures of the intrinsic evidence, it is merely extrinsic evidence and should be viewed “as less reliable than the patent and its prosecution history.” *Phillips*, 415 F.3d at 1318; *see also Seabed Geosolutions (US) Inc. v. Magseis FF LLC*, 8 F.4th 1285, 1287 (Fed. Cir. 2021) (“If the meaning of a claim term is clear from the intrinsic evidence, there is no reason to resort to extrinsic evidence.”).

Expert testimony is unnecessary to construe the claims at issue. While subsidiary fact finding may be required in some instances, claim construction is ultimately a question of law. *Teva Pharms USA, Inc v Sandoz, Inc.*, 574 U.S. 318, 330 (2015) (“subsidiary factfinding [i.e. weighing expert testimony] is unlikely to loom large in the universe of litigated claim construction”). Tellingly, Simpson does

not identify any of the disputed claim terms as being terms-of-art that have a particular and specialized meaning within the field. Nor does Simpson's expert rely on any evidentiary support outside of the specification itself in providing testimony as to the claim construction issues. Rather, Simpson's expert merely parrots the attorney argument without providing any additional insight or evidentiary support. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15 (August 24, 2022) (designated precedential) (holding a declaration is entitled to little weight when it contains an exact restatement of the petition's unsupported, conclusory assertions without any additional supporting evidence or reasoning). Thus, the arguments on *both* sides are purely legal in nature, and appropriate for attorney argument. No factual assertion relevant to this issue has been made by either party that requires expert testimony.

The disclosures of the Cullen, Adams, and Yamaguchi references are unambiguous as well, and as such do not require expert testimony to explain.¹ It is clear from their very disclosures, without resorting to expert testimony, that none of

¹ As an example and in contradiction to the Reply at page 9, the Usage View of EX1041 (Yamaguchi) unmistakably depicts the joist being pushed back past Simpson's imaginary boundary between the supposed channel-shaped portion and the supposed extension portion.

the Cullen, Adams, and Yamaguchi references disclose an “extension portion spacing the channel-shaped portion from the back flange plane,” “an extension flange,” or the “engaging each other along a juncture” limitations as argued by Simpson in its Petition. The Board should reject Simpson’s claims that expert testimony is required when it is clearly not.

II. CLAIMS 38 AND 91

Despite being invited to address the construction of the limitation “the first and second extension flanges engaging each other along a juncture,” Simpson still does not offer its own construction of the limitation. Instead, Simpson cherry-picks the specification of the ‘626 Patent to find an instance in which the word “engage” was supposedly used in a context in which direct contact was absent.

Simpson quotes the Abstract as stating “[a]n extension portion extends from the channel-shaped portion and is configured to extend through the sheathing to engage the wall at a first location.” EX1001, Abstract. Read in isolation, the “extension portion” could appear to be the component that is “engag[ing] the wall at a first location.” Notably though, the Abstract is addressing a “hanger [that] is connected to the wall” as a whole, not strictly the “extension portion.” The better reading of the Abstract is that by extending the extension portion through the sheathing, *the hanger* is able to engage the wall through the sheathing. See MPEP 608.01(b) (limiting the Abstract to 150 words).

Even under Simpson’s reading of the Abstract, Simpson is further relying on its technicality-based argument that the extension portion transitions into the back flange just prior to contacting the wall to argue that the word “engage” does not require touching contact. But Simpson’s reliance on this debatable technicality falls far short of rising to the “clear and explicit statement” that is required to demonstrate that the patentee was defining the word “engage” to have a meaning different from its plain and ordinary meaning. *See Thorner v. Sony Computer Entm’t Am. LLC*, 669 F.3d 1362, 1367-68 (Fed. Cir. 2012) (noting lexicography requires “a clear and explicit statement by the patentee” and any “‘implied’ redefinition must be so clear that it equates to an explicit one”).

Further, in cherry-picking the usage of “engage” in the Abstract, Simpson neglects that “engage” is used elsewhere throughout the specification to explicitly describe surface-to-surface contact, for example:

- “a rear face 86 configured to engage the interior face 50 of the fire retardant sheathing 34 and . . . a bottom face 90 configured to engage a top face of the sheathing” (EX1001, 5:44-48);
- “this motion is resisted by the engagement of the back flanges 66 with the interior vertical 5 face of the top plate 30 (EX1001, 7:4-6); and
- “the connector tabs 74 engage the upper surface of the top plate 30” (EX1001, 6:42-43).

Notably, Simpson’s focus on a single instance in which the word “engage” was used in the Abstract also neglects to address the full claim limitation at issue—

i.e., “the first and second extension flanges engaging each other along a juncture.” Simpson does not dispute that specification uses the same “engage each other along a juncture” at issue in the Claim 38 and 91 to describe the embodiment depicted in Figures 7 and 8 or that Figures 7 and 8 show the first and second extension flanges (60) in touching contact with each other. EX1001: 5:1-6, Figs. 7 and 8.

FIG. 7

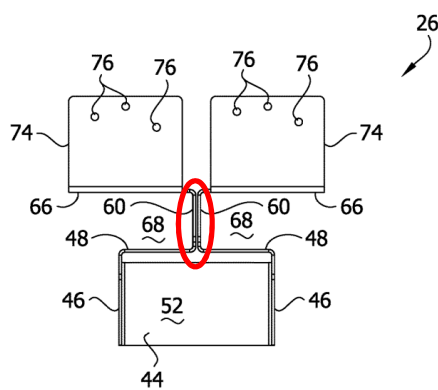
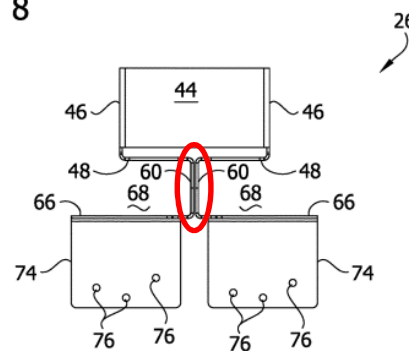


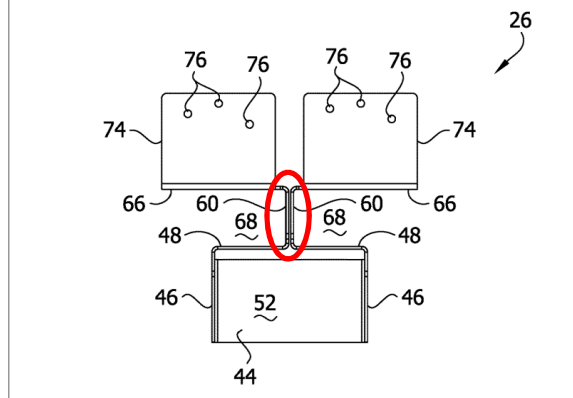
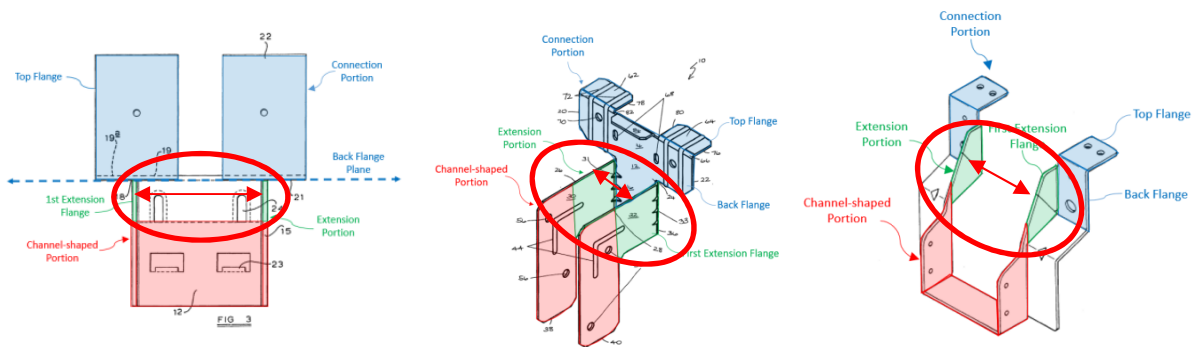
FIG. 8



EX1001: Figures 7 and 8 (annotated)

Simpson continues to argue that the claim limitation is met merely because each of Adams’s, Cullen’s, and Yamaguchi’s extension flanges “are in an opposed, face-to-face relation and symmetrical to each other across a juncture *like the extension flanges shown in Figure 7 of the ‘626 patent.*” Reply, 31 (emphasis added). But Figure 7 of the ‘626 patent shows the extension flanges touching each other along the juncture, while Adams’s, Cullen’s, and Yamaguchi’s extension flanges are spaced well apart.

FIG. 7



Comparing EX1001, Fig. 7 and EX1040, Fig. 3, EX1039, Fig. 1, EX1041, Perspective View (each annotated)

Beyond asserting that the word “engaging”—standing alone—does not require “touching contact,” Simpson still does not address how the extension flanges of Yamaguchi, Cullen, and Adams can be said to “engage” each other. Under a plain and ordinary meaning of “engage”, they clearly cannot be said to do so. Therefore, the prior art references do not disclose the claim limitation in Claims 38 and 91 requiring “the first and second extension flanges engag[e] each other along a juncture, the juncture arranged to be positioned within the two layers of $\frac{5}{8}$ -inch-thick drywall.”

III. CONCLUSION

Notwithstanding Simpson's call to "dispense" with the Patent Owner's Response, Patent Owner's arguments are entitled to be heard. As addressed in the Response, Patent Owner's arguments relating to claim construction were supported by the intrinsic evidence. Likewise, Patent Owner's arguments relating to obviousness were supported by the actual disclosures of asserted prior art references. Nor has Simpson successfully rebutted those arguments. For the reasons raised in the Patent Owner's Response, Simpson has failed to demonstrate that any of the '626 Patent's claims are invalid.

Dated: October 18, 2024

Respectfully submitted,

/Kurt F. James/

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CERTIFICATE OF SERVICE

Under 37 C.F.R. § 42.6(e), the undersigned certifies that on October 18, 2024, a copy of the foregoing PATENT OWNER'S SUR-REPLY was served via email on the following:

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**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME
REQUIREMENTS UNDER 37 C.F.R. § 42.24**

Under 37 C.F.R. § 42.24(d), the undersigned certifies that this Patent Owner's Sur-Reply complies with the type-volume limitation of § 42.24(c)(4) because it contains 1,551 words, excluding the parts of the Patent Owner's Sur-Reply exempted by § 42.24(c).

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(2)(ii) and the type style requirements of 37 C.F.R. § 42.6(a)(2)(iii) and (iv).

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