

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.

IPR2021-00135
Patent 9,908,571 B2

Before JOHN P. PINKERTON, TIMOTHY J. GOODSON, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

A. Background

Godbersen-Smith Construction Company d/b/a GOMACO Corporation (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–15 of U.S. Patent No. 9,908,571 B2 (Ex. 1001, “the ’571 patent”). Guntert & Zimmerman Const. Div., Inc. (“Patent Owner”) filed a Preliminary Response. Paper 8 (“Prelim. Resp.”).

Pursuant to 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a), the Board has authority to determine whether to institute *inter partes* review. *Inter partes* review may not be instituted unless “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). For the reasons discussed below, we do not grant institution of *inter partes* review of the ’571 patent.

B. Real Parties in Interest

Petitioner identifies itself as the only real party in interest. Pet. 102–03. Likewise, Patent Owner identifies itself as the only real party in interest. Paper 5, 1.

C. Related Matters

The parties inform us that the ’571 patent has been asserted in *Guntert & Zimmerman Const. Div., Inc. v. GOMACO Corp.*, No. 5:20-cv-4007 CJW-KEM (N.D. Iowa). Pet. 103; Paper 5, 1. The district court has stayed that case pending the outcome of this and other Board proceedings. *See* Ex. 1156 (district court’s order overruling objections to magistrate judge’s order granting motion to stay).

With respect to related matters at the Board, concurrently with the Petition in this proceeding, Petitioner filed a petition for *inter partes* review

of the '571 patent in IPR2021-00136. Pet. 103. Petitioner also identifies the following Board proceedings involving the same parties and patents related to the '571 patent: IPR2020-01698, which challenges U.S. Patent No. 10,029,749; IPR2021-00050, which challenges U.S. Patent No. 9,702,020; and IPR2021-00161, which challenges U.S. Patent No. 10,053,167. *Id.*

D. Summary of the '571 Patent

The '571 patent issued on March 6, 2018, from an application filed on June 14, 2017. Ex. 1001, codes (45), (22). The '571 patent states that it is a continuation-in-part of Application No. 15/148,811, filed on May 6, 2016, which is a continuation of Application No. 13/897,125, filed on May 17, 2013, which is a continuation of Application No. 13/069,096, filed on March 22, 2011. *Id.* at code (63), 1:7–11. The '571 patent also claims the benefit of a provisional application filed on March 26, 2010. *Id.* at code (60), 1:14–15.

The '571 patent relates to “concrete slipform paving machines that have a propelling unit or tractor from which a paving kit is suspended with which a layer of concrete is shaped and finished over the underlying ground as the tractor travels along a road or airfield alignment.” *Id.* at 1:20–24. The '571 patent explains that concrete slipform paving machines include three or four crawler tracks mounted to jacking columns, which are carried on pivoting bolster swing legs mounted to the front, rear, or sides of a center module of a tractor. *Id.* at 1:53–67.

Figure 1, reproduced below, is a front elevation perspective view of a concrete slipform paving machine according to one embodiment:

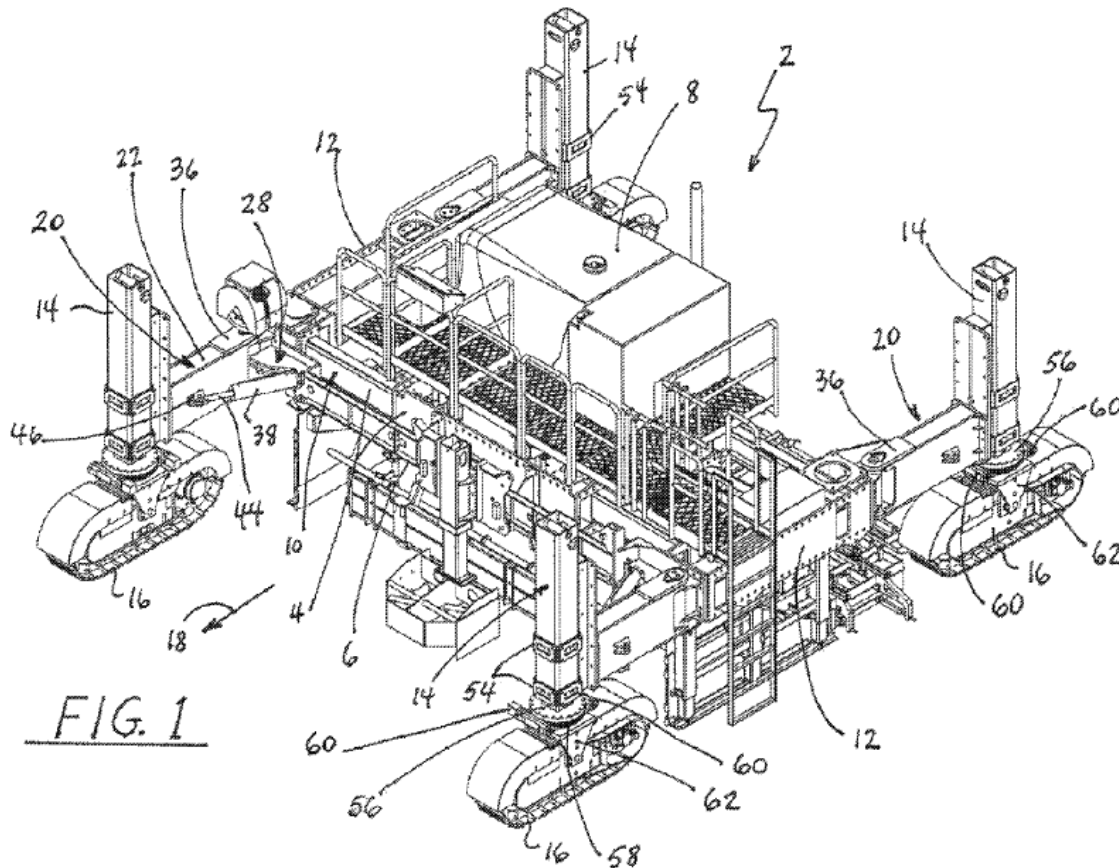


Figure 1 depicts paving machine 2 including main tractor frame 4 defined by center module 6, which carries diesel engine powered power unit 8. *Id.* at 8:45–50. Telescoping support beams 10 extend laterally outward from center module 6, and side bolsters 12 are secured to the outbound ends of support beams 10. *Id.* at 8:48–51. Hydraulically-powered jacking columns 14 are mounted in the vicinity of the fore and aft ends of side bolsters 12, and crawlers 16 are secured to the lower ends of jacking columns 14 such that each crawler is rotatable about a vertical axis. *Id.* at 8:50–60. Jacking columns 14 and associated crawlers 16 are mounted to bolster swing legs 20. *Id.* at 9:23–25.

Figure 2, reproduced below, is a partial view of a portion of the paving machine:

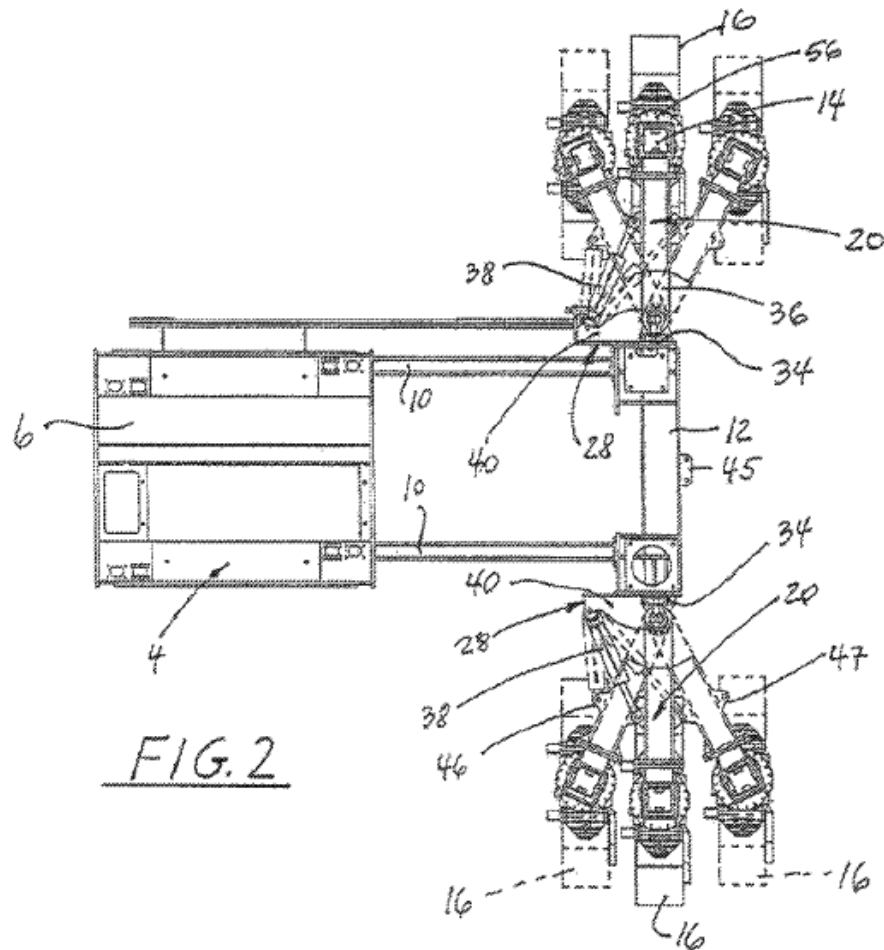


Figure 2 depicts bolster swing legs 20, each having jacking column 14 and associated crawler 16 mounted at one end. *Id.* The opposite ends of bolster swing legs 20 are pivotally mounted to hinge brackets 28, which are fastened to side bolsters 12. *Id.* at 9:25–34. Hydraulic actuators 38 are installed between hinge brackets 28 and bolster swing legs 20 and can be energized to pivot bolster swing legs 20 in a horizontal plane. *Id.* at 10:4–7.

Figure 4, reproduced below, provides a detailed view of jacking column 14 and crawler track 16:

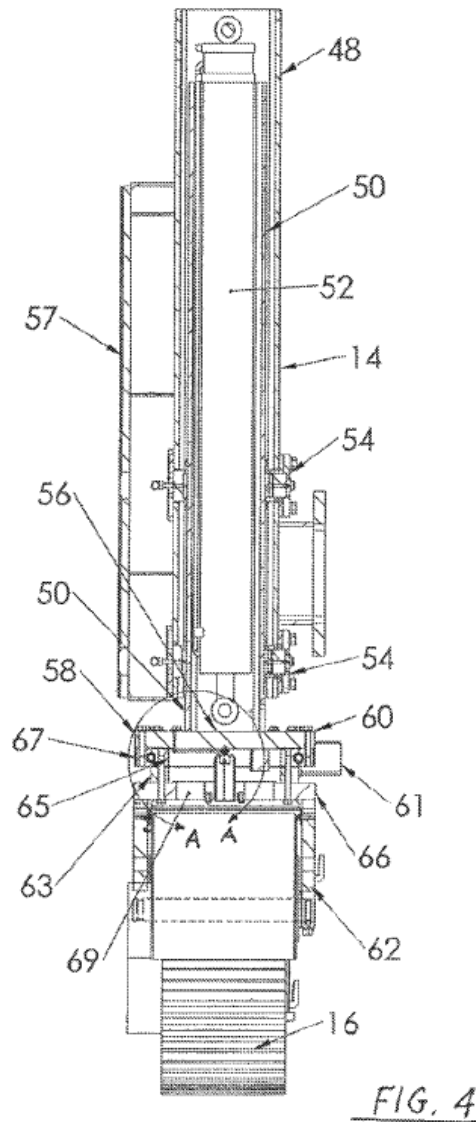


Figure 4 depicts jacking column 14, which includes inner tube 50 with mounting plate 56 at its lower end, and worm gear drive 60 bolted to mounting plate 56. *Id.* at 11:35–37. Worm gear drive 60 provides power to rotate yoke 62 with crawler track 16 about the vertical axis of jacking column 14. *Id.* at 11:49–52.

Figure 9, reproduced below, illustrates a concrete slipform paving machine embodiment having three legs:

FIG. 9

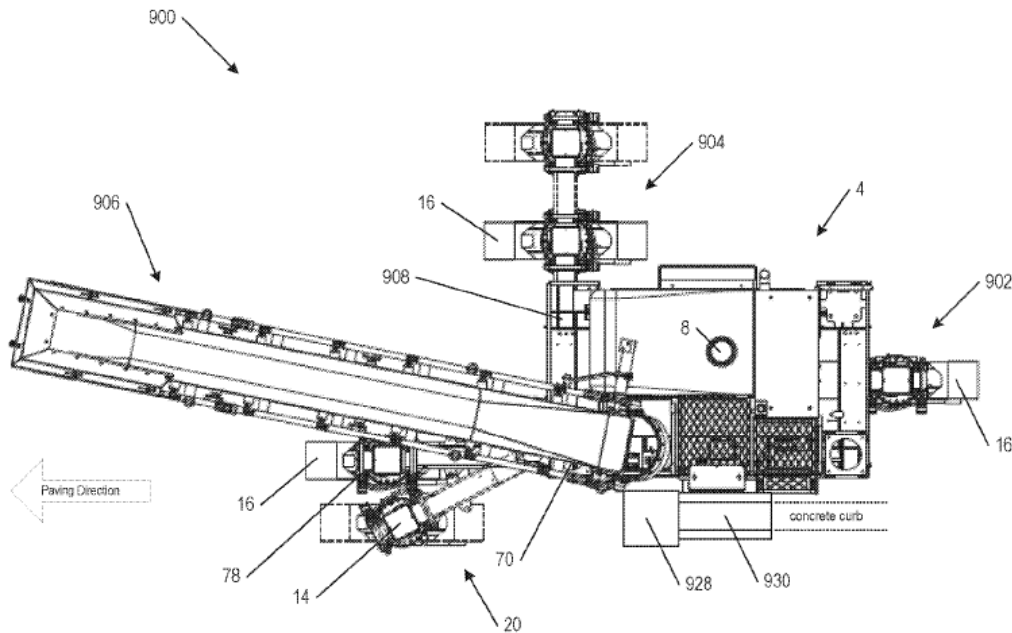


Figure 9 depicts three-leg paving machine 900 including forward swing leg 20 with jacking column 14, aft leg 902, and forward laterally telescoping leg 904, each leg extending from tractor frame 4 and having crawler tracks 16. *Id.* at 17:33–41.

E. Illustrative Claims

Petitioner challenges claims 1–15. Claim 1 is the sole independent claim and is reproduced below, with emphasis added to highlight the limitations that are the focus of the analysis herein:

1. A paving machine configured to move in a paving direction for laying concrete into a molded form, having a generally upwardly exposed concrete surface and terminating in lateral concrete sides, the paving machine comprising:
a center module having a forward end, an aft end, and lateral sides;

- a *forward bolster connected to the forward end of the center module;*
- an *aft bolster connected to the aft end of the center module;*
- a first crawler track and a second crawler track mechanically coupled to the forward bolster and a third crawler track mechanically coupled to the aft bolster;
- the forward bolster having a first swing leg, an upright first jacking column secured to the first swing leg, and a rotary connection between the first jacking column and the first crawler track permitting relative rotational movements of the first crawler track and the first jacking column about an upright axis; and
- a first power drive between the first jacking column and the first crawler track of the first swing leg, configured for translating relative rotational movements between the first jacking column and the first crawler track.

Ex. 1001, 22:38–60 (emphasis added).

F. Asserted Grounds

Petitioner contends that the challenged claims are unpatentable based on the following grounds:

Claim(s) Challenged	35 U.S.C. §	References/Basis
1–7, 9–15	103(a)	Guntert, ¹ CIII ²
8	103(a)	Guntert, CIII, Dahm ³

¹ US 2011/0236129 A1, published Sept. 29, 2011, filed Mar. 22, 2011 (Ex. 1028).

² *Commander III New Generation Trimmer/Paver Operator/Service Manual G2I Controls*, GOMACO (2002) (Ex. 1005, “CIII”). Petitioner contends that CIII is a printed publication qualifying as prior art to the ’571 patent under § 102(a)(1). Pet. 24.

³ US 2015/0354149 A1, published Dec. 10, 2015, filed June 9, 2014 (Ex. 1030).

Pet. 24. In support of its proposed grounds, Petitioner relies on the Declaration of William Singhose, Ph.D. *See* Ex. 1002.

II. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner proposes that a person of ordinary skill in the art would have had “at least a four-year degree in mechanical engineering or a closely related field and at least two years of experience designing, developing, or operating heavy machinery, including their components and control systems.” Pet. 30–31 (citing Ex. 1002 ¶ 22). Petitioner adds that “[a]dditional education could substitute for professional experience and significant work experience—such as working with, servicing, or operating heavy machinery in the field—could substitute for formal education.” *Id.*

In its Preliminary Response, Patent Owner does not comment on Petitioner’s proposed definition of the level of ordinary skill in the art or offer its own definition.

For the purposes of this Decision, we apply Petitioner’s definition of the level of ordinary skill in the art. We determine that this definition is consistent with the prior art of record and the skill reflected in the Specification of the ’571 patent, based on our review of the limited record.

III. WHETHER GUNTERT IS PRIOR ART

A. Summary of the Issue and Legal Standards

Because each of Petitioner’s asserted grounds relies on Guntert, a threshold disputed issue is whether Guntert is prior art to the claims of the ’571 patent. Guntert is the published version of Application No. 13/069,096 (“the ’096 application”), which is one of the applications in the ’571 patent’s claimed priority chain. *See* Ex. 1001, 1:12; Ex. 1028, code (21). Thus, whether Guntert constitutes prior art depends on the effective filing date of

the claims of the '571 patent. Petitioner argues that the effective filing date of the '571 patent is June 14, 2017, which is the actual filing date of the application that issued as the '571 patent. Pet. 8. Petitioner asserts that none of the applications to which the '571 patent claims priority provides written description support for “a forward bolster connected to the forward end of the center module” and “an aft bolster connected to the aft end of the center module,” as recited in claim 1 of the '571 patent. *Id.* at 8–9. Patent Owner argues that these claim features have written description support in the disclosure of the '096 application. Prelim. Resp. 9–10 (citing Ex. 1004, 107; Ex. 1028 ¶ 4). For the reasons discussed below, we find that Patent Owner has shown that the '096 application adequately supports the disputed limitations, such that Guntert does not qualify as prior art.

For a claim in a later-filed application to be entitled to the filing date of an earlier application, the earlier application must provide written description support for the claimed subject matter. *Anascope, Ltd. v. Nintendo of Am. Inc.*, 601 F.3d 1333, 1337 (Fed. Cir. 2010). The written description requirement “guards against the inventor’s overreaching by insisting that he [or she] recount his [or her] invention in such detail that his [or her] future claims can be determined to be encompassed within his [or her] original creation.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1561 (Fed. Cir. 1991). To satisfy the written description requirement, “the disclosure of the earlier application, the parent, must reasonably convey to one of skill in the art that the inventor possessed the later-claimed subject matter at the time the parent application was filed.” *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998).

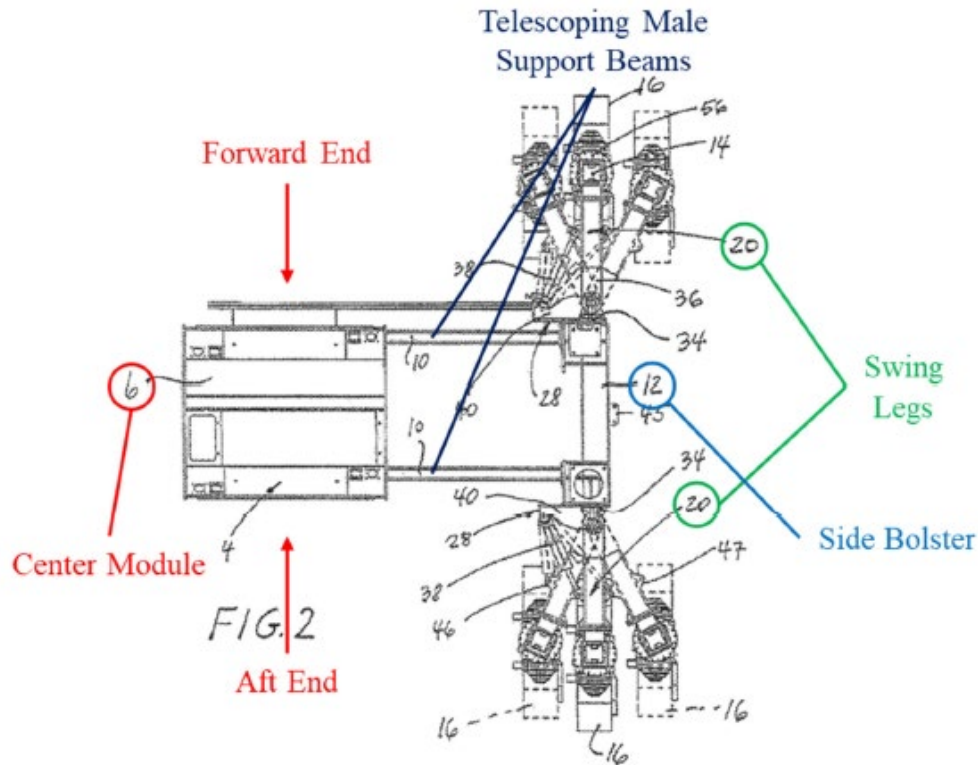
Determining entitlement to an effective filing date can be a complex task when a patent's priority claim includes a lengthy priority chain. That is because "each application in the chain leading back to the earlier application must comply with the written description requirement of 35 U.S.C. § 112." *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571 (Fed. Cir. 1997). Here, the priority chain for the '571 patent includes several applications. *See* Ex. 1001, code (63), 1:7–11. However, because each of the applications before the one that issued as the '571 patent is a continuation, the Petition states that "[f]or purposes of this IPR, Guntert [i.e., the published version of the '096 application] is treated as representative of all priority applications." Pet. 9 n.2. Thus, the priority analysis reduces down to whether Guntert provides adequate support for the challenged claims.

Further simplifying matters, the priority dispute focuses on only a few limitations. The primary dispute is whether the '096 application adequately discloses "a forward bolster connected to the forward end of the center module" and "an aft bolster connected to the aft end of the center module," as recited in claim 1 Pet. 9–22; Prelim. Resp. 13–24. Aside from the forward and aft bolster limitations, Petitioner lists other limitations that it asserts are not adequately described in the priority documents, but Petitioner offers no analysis or explanation to support that assertion. *See* Pet. 23. Petitioner's mere listing of claim limitations provides scant notice of the basis for Petitioner's challenge. *See, e.g., Trading Techs. Int'l, Inc. v. IBG LLC*, 921 F.3d 1378, 1385 (Fed. Cir. 2019) (holding that a conclusory assertion with no analysis was not adequately developed); *Novartis AG v. Torrent Pharms.*, 853 F.3d 1316, 1326 n.2 (Fed. Cir. 2017) (finding that an argument presented in one conclusory sentence and a string cite was "far

from sufficient to raise a meaningful challenge” and “amount[ed] to little more than a request that the Board peruse the cited evidence and piece together a coherent argument on Novartis’ behalf”). In its Preliminary Response, Patent Owner details where and how Guntert discloses each of the limitations Petitioner lists. *See* Prelim. Resp. 25–32. Considering the absence of any explanation from Petitioner, we are satisfied that Patent Owner has demonstrated sufficient written description support for Petitioner’s listed limitations. Returning to the forward and aft bolster limitations, below, we summarize the parties’ contentions on those limitations and then provide our analysis.

B. Summary of the Parties’ Contentions

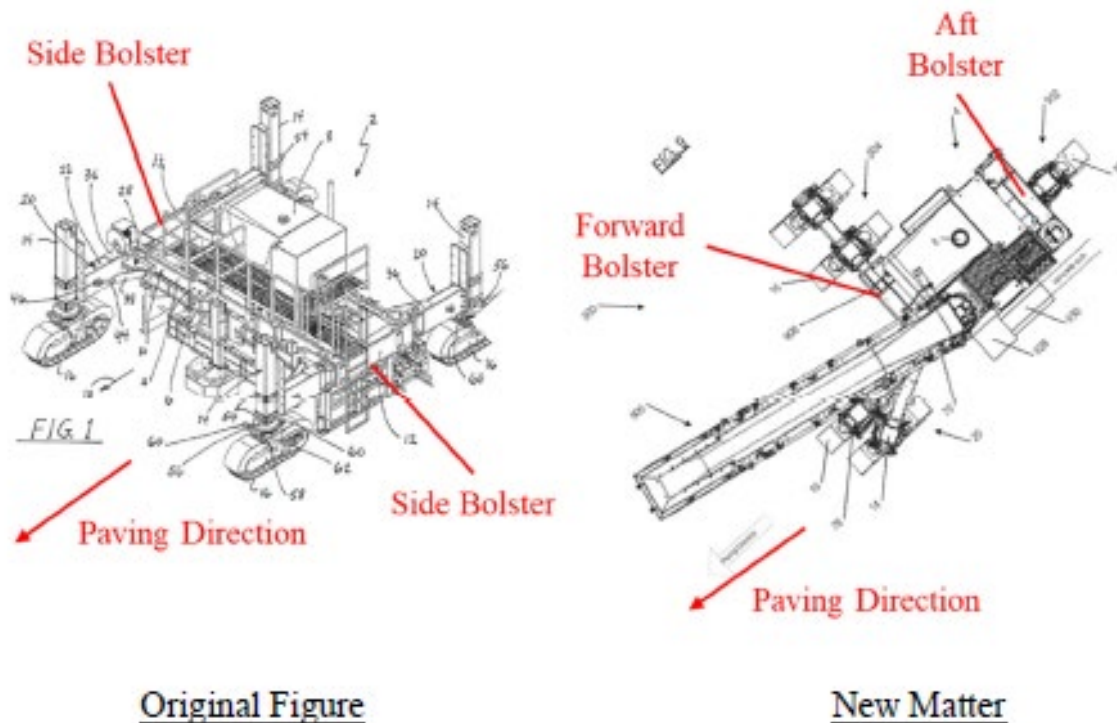
Petitioner argues that Guntert “only discloses paving machines with *side* bolsters ‘laterally movably connected to respective *lateral sides of the center module* for changing a space between the bolsters.’” Pet. 9 (quoting Ex. 1028 ¶ 20). The Petition includes an annotated version of Guntert’s Figure 2, reproduced below:



Petitioner highlights that Guntert's Figure 2 shows telescoping male support beams 10, which can change the paver's width by extending or retracting from center module 6. *Id.* at 9–11 (citing Ex. 1028 ¶¶ 5, 33). Swing legs 20 are pivotally mounted at the front and aft ends of side bolsters 12. *Id.* at 10 (citing Ex. 1028 ¶ 15). Petitioner also points out that in the separate embodiment shown in Guntert's Figure 6, “the swing legs are still coupled to side bolsters that connect to lateral sides of the center module via the telescoping male support beams.” *Id.* at 12. Petitioner further notes that Guntert's claim 1 includes a limitation reciting “a bolster laterally movably connected to respective lateral sides of the center module for changing a spacing between the bolsters.” *Id.* (quoting Ex. 1028, cl. 1).

Petitioner contrasts the “four-track configuration” shown in Guntert's Figures 2 and 6 with the pavers shown in Figures 9–13E of the '571 patent, which Petitioner considers to be new matter added for the first time in the

application that issued as the '571 patent. *Id.* at 13–15; *see also id.* at 4 (“The '571 patent application added Figures 9–13E, which describe pavers with *three* legs, where, for the first time, bolsters attach to the *forward* and *aft* ends of the center module, as opposed to the sides.”). The Petition includes the figures reproduced below, which are annotated versions of Guntert’s Figure 1 and the '571 patent’s Figure 9:



The left figure, labeled by Petitioner as “Original Figure,” is Petitioner’s annotated version of Figure 1 from Guntert, and the right figure, which Petitioner labels “New Matter,” is Petitioner’s annotated version of Figure 9 from the '571 patent. Petitioner argues that in Guntert’s Figure 1, the capability of the side bolsters to move laterally allows paving kits of different widths to be suspended below the tractor frame. *Id.* at 14 (citing Ex. 1028 ¶¶ 3, 12). In the '571 patent’s Figure 9, conveyor 906 conveys concrete to hopper 928 and profile mold 930 at the side of the frame in order

to pave curbs or other structures that do not pass beneath the center of the machine. *Id.* at 15 (citing Ex. 1001, 17:23–25, 17:41–62).

According to Petitioner, “[w]ith the hopper and profile mold on a lateral side of the frame, it is unnecessary to have side bolsters that move laterally to change paver width because the tracks need not straddle the section being paved.” *Id.* at 16 (citing Ex. 1002 ¶ 40). Petitioner further argues that the three-leg paver is easier to transport than the four-leg configuration. *Id.* at 17 (citing Ex. 1001, 16:32–37, 17:64–66; Ex. 1002 ¶¶ 41–42).

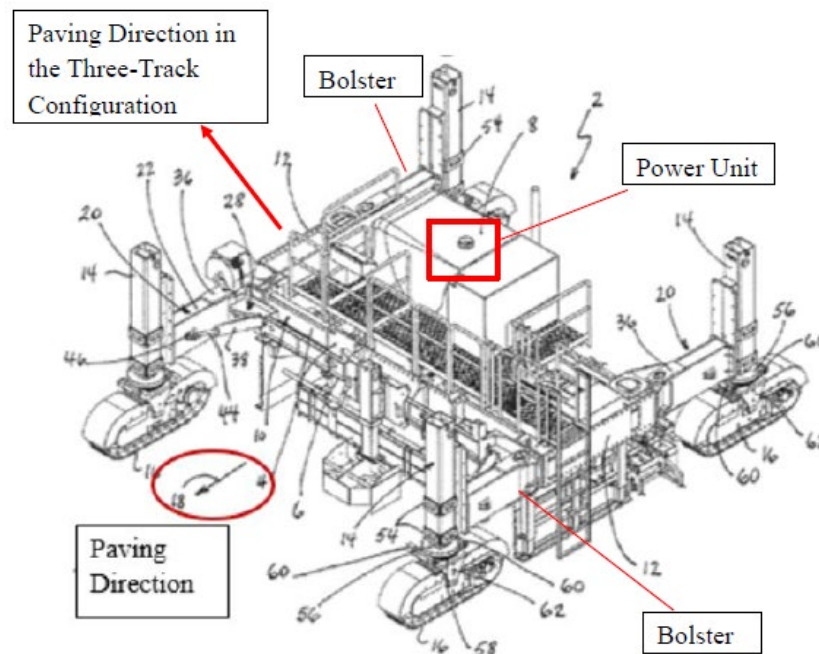
Petitioner also argues that the prosecution history supports its view that forward and aft bolsters were not described in Guntert. *See id.* at 18. Specifically, Petitioner relies on Patent Owner’s explanation when it introduced claims reciting bolsters connected to the forward and aft ends of the center module that “the front and aft ends of the paving machines claimed herein correspond to the paving direction indicated within Figures 9–13E.” *Id.* (quoting Ex. 1004, 108).

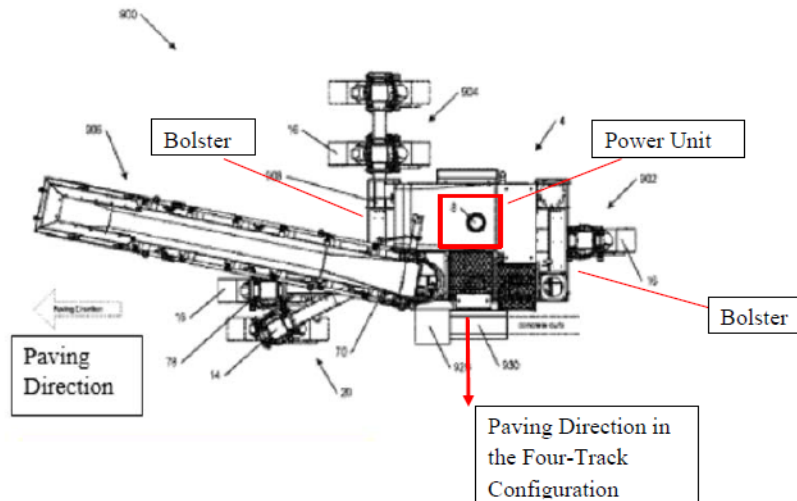
It is notable, according to Petitioner, that in Guntert, the term “[b]olster swing legs’ does not refer to an apparatus where the bolster and swing leg components have been combined—it simply refers to the swing leg.” Pet. 18 (citing Ex. 1028 ¶¶ 15, 36, 43). Thus, when Guntert describes that “bolster swing legs with jacking columns and crawlers can be . . . relocated and mounted directly to the front and rear of the tractor center module,” Petitioner contends that “Guntert does not disclose a *bolster* connected to the front or rear of the center module, and a swing leg attached to that bolster, as claimed. It simply discloses a swing leg *mounted directly*

to the front and rear of the center module (i.e., no indirect connection through an intermediary bolster).” *Id.* at 20 (citing Ex. 1028 ¶ 4).

Patent Owner responds that Guntert provides written description support for forward and aft bolsters connected to the center module, most notably in its disclosure in paragraph 4 that bolster swing legs can be mounted directly to the front and rear of the tractor center module. Prelim. Resp. 14–15 (citing Ex. 1028 ¶ 4). Patent Owner urges that a bolster swing leg is a swing leg mounted to a bolster, such that “bolster swing legs mounted directly to the front and rear of the center module inherently include the forward and aft bolsters recited in the Challenged Claims.” *Id.*

Patent Owner provides annotated versions of Figures 1 and 9 in the ’571 patent, which are reproduced below:





Id. at 17–18. Patent Owner argues that these annotated figures from the '571 patent show that the power unit is located on the center module and is oriented in the same relative position in both the four-track and three-track paver configurations, with bolsters located on opposing ends of the power unit in both figures. *Id.* “While the orientation of the bolsters on the frame is unchanged, . . . the identification of whether a bolster is located at the forward/aft or lateral position of the paver is premised upon the paving direction—as the bolster is aligned with the paving direction.” *Id.* at 18. Thus, Patent Owner argues that “one skilled in the art would understand from *Guntert* that the bolster swing leg is mounted to the center module via a forward bolster which is identified based upon the paving direction for a three-track paver.” *Id.* at 19 (citing Ex. 1028 ¶ 4).

As for the '571 patent's prosecution history, Patent Owner contends that the same paragraph 4, as is present in *Guntert*, was relied on “for providing written description support for the claimed three-track paver machine that includes the claim features of forward and aft bolsters.” *Id.* (citing Ex. 1004, 107).

Patent Owner also argues that the testimony of Petitioner’s expert, Dr. Singhose, supports the view that Guntert adequately describes a three-track paver configuration with fore and aft bolsters. *Id.* at 20–22. Specifically, Patent Owner points to Dr. Singhose’s analysis that an ordinarily skilled artisan would have been motivated to combine Guntert and CIII to achieve a three-track paver: “In my opinion, it would have been obvious to use CIII’s frame, including its forward and aft bolsters, to implement three jacking columns and crawler tracks, as Guntert itself teaches that pavers can be so configured.” Ex. 1002 ¶ 63 (discussed in Prelim. Resp. 20–21). Patent Owner also cites Dr. Singhose’s testimony that three-track pavers with swing legs mounted to forward and aft bolsters were known in the art and that ordinarily skilled artisans would have known that mounting swing legs to forward and aft bolsters of the center module would allow the paver to be configured for different tasks without risking the paver’s stability. *See* Prelim. Resp. 21 (citing Ex. 1002 ¶¶ 63–64).

C. Analysis

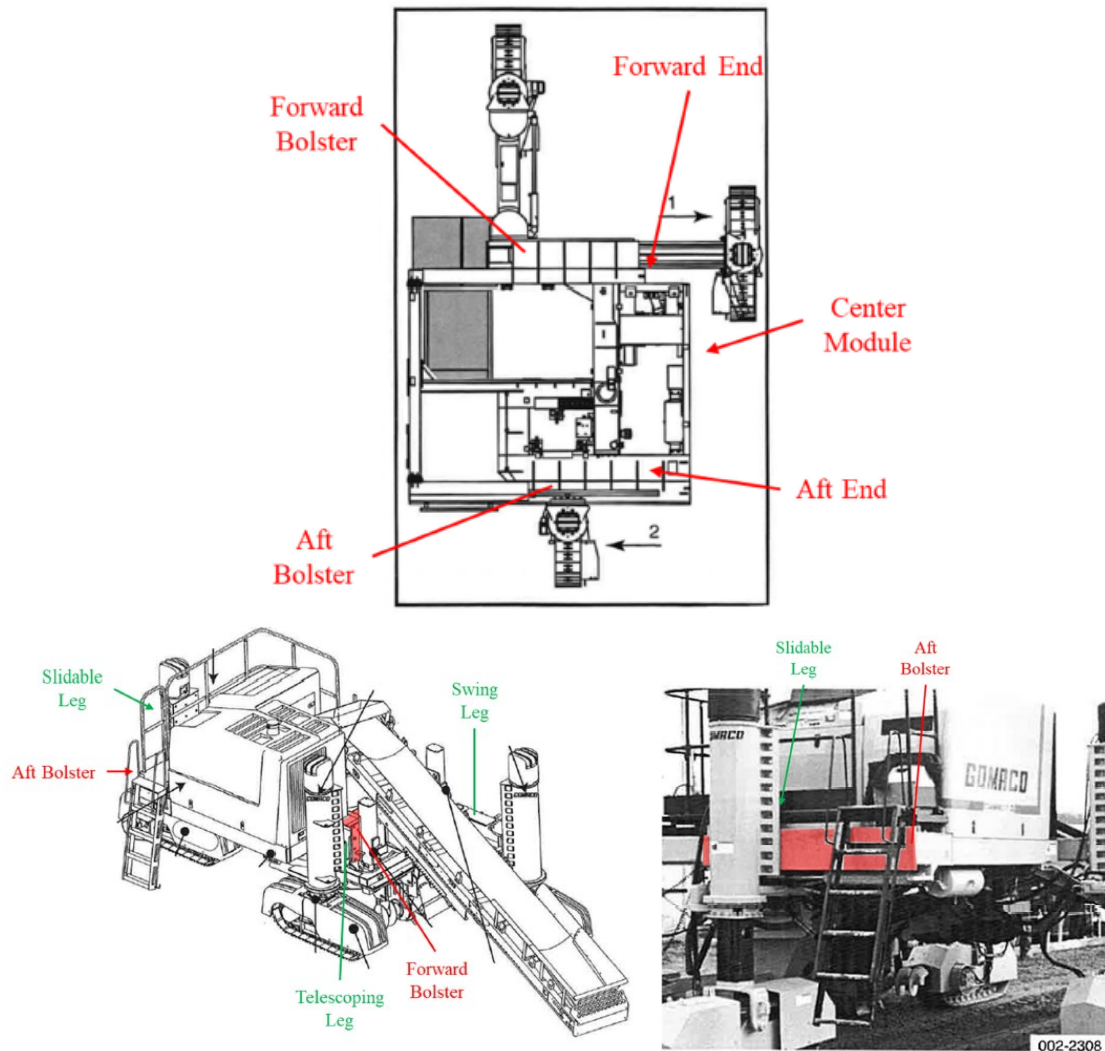
On the record before us, we are persuaded that Guntert provides adequate written description support for the forward and aft bolster limitations in claim 1. The most important evidence in our analysis is Guntert’s paragraph 4, which is reproduced below:

The tractor ***normally has four crawler tracks, but can also have only three***, each mounted to a jacking column, supporting and propelling the frame during use of the paver in the paving direction. The jacking columns are carried on the bolsters, or on ***bolster swing legs connected to the fore and aft ends of the side bolsters***, that are pivotable about vertical axes to change the relative position of the crawlers for a variety of reasons and/or for changing the movement correction of the crawlers and therewith of the paving machine during use. The bolster swing

legs with jacking columns and crawlers *can also be relocated and mounted directly to the front and rear of the tractor center module, to the outside of the side bolsters or directly to the outside of the tractor center module* in some less conventional paving applications. For the purposes of this description, the focus is on the manner in which bolster swing arms and the orientation of the crawlers can be changed and controlled in the more conventional paving configuration of the machine.

Ex. 1028 ¶ 4 (emphasis added). We observe that this paragraph plainly discloses that pavers can come in three-track configurations. We further observe that it discloses that bolster swing legs can be mounted at various locations: the fore and aft ends of side bolsters, the outside of side bolsters, the front and rear of the center module, or the outside of the center module.

Petitioner does not persuasively explain why attaching bolster swing legs to the front and rear ends of the center module, as described in Guntert's paragraph 4, fails to disclose forward and aft bolsters as claimed. Neither party proposes a construction of the term "bolster," but in its obviousness analysis, Petitioner relies on portions of the CIII paver's frame that extend across the front and rear of the center module as the claimed forward and aft bolsters. *See* Pet. 55–58. Petitioner's annotated figures from CIII are reproduced below:



In these annotated figures, Petitioner notes the portions of the CIII paver's frame it contends are forward and aft bolsters. Pet. 55–58. Neither Petitioner nor Dr. Singhose explains why these identified portions of the paver's frame are bolsters, apart from noting their location at the forward and aft ends of the center module and the similarity of the CIII paver's frame to the one shown in Figures 9–13E of the '571 patent. *See* Pet. 55–58; Ex. 1002 ¶¶ 73–74. Petitioner also asserts that Patent Owner's infringement contentions in the parallel district court case likewise point to the same portions of the CIII paver's frame as meeting the claimed forward and aft bolster limitations. *See id.* at 59–60. Similarly, Dr. Singhose testifies that it

would have been obvious to attach swing legs on either or both ends of a front bolster because “[a]ttaching a swing leg on each end of a structure that extends across the front of a slipform paver was a well-known configuration prior to the effective filing date of the ’571 [patent].” Ex. 1002 ¶ 63. In our review of the record, we find that the parties and Dr. Singhose regard a bolster as simply generic structure that extends across one end or side of the center module, to which a leg can be attached. Against this backdrop, it is unclear how attaching bolster swing legs to the front and rear ends of the center module could be accomplished *without* a structure that would qualify as a bolster. If, for example, a bolster swing leg were attached directly to the front of the center module, as Guntert’s paragraph 4 discloses, Petitioner does not explain why the portion of the center module’s frame to which a bolster swing leg is attached would not qualify as a bolster.

We also agree with Patent Owner’s point that Dr. Singhose undercuts Petitioner’s argument on the inadequacy of Guntert’s description with his testimony that “[i]n my opinion, it would have been obvious to use CIII’s frame, including its forward and aft bolsters, to implement three jacking columns and crawler tracks, as *Guntert itself teaches that pavers can be so configured.*” Ex. 1002 ¶ 63 (citing Ex. 1028 ¶ 4) (emphasis added). It is difficult to reconcile Dr. Singhose’s reliance on Guntert’s paragraph 4 to teach that pavers can be configured like CIII’s with Petitioner’s argument that Guntert’s paragraph 4 fails to adequately describe forward and aft bolsters.

We have also considered Petitioner’s argument concerning the operational differences between three- and four-leg pavers. *See* Pet. 9–17. However, the question of entitlement to an earlier filing date does not turn

on whether any new disclosure was added in one application relative to earlier applications. The relevant question is whether adequate, supporting disclosure for the claims of the '571 patent is present throughout the priority chain. Petitioner's arguments regarding the advantages of the three-leg configuration vis-à-vis the four-leg configuration merely compare embodiments disclosed in the '571 patent against those in earlier related applications, and do not show why Guntert fails to describe forward and aft bolsters as claimed. As discussed above, on the record presented here, we are persuaded that Guntert adequately describes the forward and aft bolster limitations of claim 1.

Petitioner's reliance on the prosecution history of the '571 patent is also unavailing. *See* Pet. 18. Petitioner argues that the prosecution history shows Patent Owner's reliance on new matter to support the subject matter of claim 1 because when it added the claim, it "told the Examiner that '*the front and aft ends of the paving machines claimed herein correspond to the paving direction indicated within Figures 9–13E.*'" *Id.* (quoting Ex. 1004, 108). Yet the statement on which Petitioner relies does not indicate that only Figures 9–13E support the claimed subject matter; it simply orients the Examiner by explaining that the directions referred to in the terms "front" and "aft" ends line up with the paving directions shown in Figures 9–13E. It was natural for Patent Owner to refer to those figures because they include an arrow labeled "Paving Direction." *See* Ex. 1004, 45–50. Further, Patent Owner's orienting statement was prefaced by its "emphasi[s] that the proper benefit of priority for all of the claims is to the original effective filing date of March 26, 2010." Ex. 1004, 107. And in setting out for the Examiner the portions of the application that support the claim features, Patent Owner

referenced broad swaths of the application, including the same paragraph 4 as in Guntert. *Id.* Accordingly, we disagree with Petitioner's argument that the prosecution history shows that Patent Owner tethered support for the claimed subject matter exclusively to Figures 9–13E, and not to disclosure that was present in Guntert.

For these reasons, on the record before us, we determine that Guntert adequately supports the forward and aft bolster limitations of claim 1. Consequently, Guntert has not been shown to be prior art to the '571 patent. Because each of Petitioner's challenges relies on Guntert, Petitioner has not shown a reasonable likelihood of prevailing on any challenge.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that institution of an *inter partes* review on the grounds presented in the Petition is denied.

FOR PETITIONER:

Jason Stach
Luke McCammon
David Mroz
Sonja Sahlsten
Robert High
FINNEGAN HENDERSON FARABOW GARRETT & DUNNER LLP
Jason.stach@finnegan.com
Luke.mccammon@finnegan.com
David.mroz@finnegan.com
Sonja.sahlstren@finnegan.com
Robert.high@finnegan.com

FOR PATENT OWNER:

James Hannah
Jeffrey Price
KRAMER LEVIN NAFTALIS & FRANKEL LLP
jhannah@kramerlevin.com
jprice@kramerlevin.com