

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 IPR2021-00135
U.S. Patent No. 9,908,571

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

EXHIBIT No.	DESCRIPTION
Exhibit-2001	Memorandum Opinion and Order, <i>Guntert & Zimmerman Constr. Div., Inc. v. Gomaco Corp.</i> , No. 20-cv-4007-CJW-KEM, Dkt. No. 82 (N.D. Iowa Jan. 13, 2021)
Exhibit-2002	Guntert & Zimmerman webpage, "Product Range", dated February 11, 2021, available at https://www.guntert.com/products.html .
Exhibit-2003	Gomaco webpage, dated February 15, 2021, available at https://www.gomaco.com .
Exhibit-2004	U.S. Patent No. 8,118,518
Exhibit-2005	U.S. Patent No. 9,180,909
Exhibit-2006	U.S. Patent No. 9,663,162
Exhibit-2007	U.S. Patent No. 9,764,762
Exhibit-2008	U.S. Patent No. 10,005,489
Exhibit-2009	U.S. Patent No. 8,690,123
Exhibit-2010	Gomaco Corp. "Commander II Trimmer/Slipform Paver" brochure

I. INTRODUCTION

The Board should deny this Petition because U.S. 9,908,571 (Ex. 1001, the “’571 Patent”) properly claims priority to *Guntert et al.*, U.S. App. Pub. No. 2011/0236129, (Ex. 1028, “*Guntert*”) thus, eliminating *Guntert* as prior art which is required for all grounds in the Petition. Claims 1-15 (“the Challenged Claims”) are supported by, claim priority to *Guntert* and, in fact, are entitled to the benefit of the priority filing date as *Guntert* supports the Challenged Claims. *Guntert*’s disclosure reasonably conveys to one skilled in the art that the inventors had possession of the claimed subject matter by at least *Guntert*’s filing date.

Petitioner’s case is founded on the false premise that “[e]very application to which the ’571 Patent claims priority only disclosed bolster designs where the bolster and swing-leg combination attached to *sides* of the center module.” Petition at 1. Contrary to Petitioner’s misrepresentation, *Guntert* explicitly discloses that its novel bolster swing legs could be “relocated” from the side bolsters and attached to a bolster essentially anywhere on the frame of a three or four-track paver machine, including “the front and rear of the tractor center module.” *Guntert* at ¶ [0004]. Because the Challenged Claims claim the benefit of, and are entitled to, *Guntert*’s filing date, *Guntert* is not prior art. As a result, the Board should deny institution.

The Board should also deny institution under § 325(d). Ex. 1005 (“*CIIP*”), art relied on in the Petition Grounds, is substantially the same art that was considered by the Patent Office during prosecution of U.S. Patent Appl. No. 15/623,012 (the “’012 Application”), which matured into the ’571 Patent. This is further supported by the fact the Patent Office also considered the patentability of the Challenged Claims over multiple patents stemming from *Guntert* during prosecution. In fact in the parallel district action, the Court suggested that an obviousness combination based on *CIII* and *Guntert* would be “frivolous.” Ex. 2001 at 10.

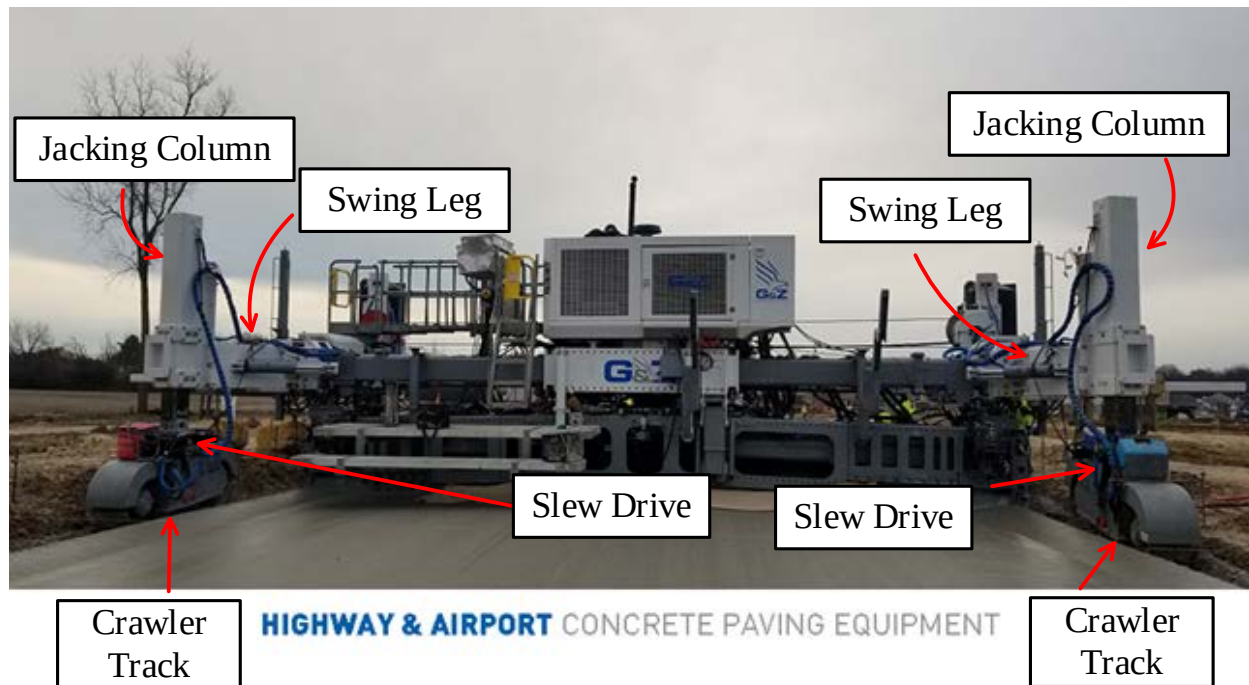
Although there are a variety of reasons why the ’571 Patent is valid over Petitioner’s asserted prior art references, this Preliminary Response focuses on only limited reasons why *inter partes* review should not be instituted. See *Travelocity.com L.P. v. Conos Techs., LLC*, Case CBM2014-00082, Paper 12 at 10 (P.T.A.B. Oct. 16, 2014) (“[N]othing may be gleaned from the Patent Owner’s challenge or failure to challenge the grounds of unpatentability for any particular reason.”). The deficiencies of the Petition noted herein, however, are sufficient for the Board to find that Petitioner has not met its burden to demonstrate a reasonable likelihood that it would prevail in showing unpatentability of any of the challenged claims.

II. HISTORY OF GUNTERT & ZIMMERMAN CONST. DIV., INC.

Guntert & Zimmerman Const. Div., Inc. (“G&Z” or “Patent Owner”) is an innovative, family owned company spanning three generations. G&Z was founded in 1942 and contributed to the war effort, building floating crane barges, landing crafts, steel tugboats, and inter-island supply vessels for the U.S. Navy and U.S. Army Transportation Corp. After the war, G&Z focused on the design and fabrication of canal construction equipment, supplying its first set of canal machines in 1946 which were used in many major projects, including the Grand Coulee Dam project in Washington and the Delta Mendota Canal Project in California. In 1956, G&Z placed its canal lining equipment onto crawler tacks and built the first viable crawler track-mounted concrete slipform paver for highway and airfield paving. These machines built the Orly airfield in Paris, Dallas-Fort Worth Airport, the shuttle landing strip at Cape Kennedy, and the Chap Lap Kok Airport in Hong Kong.

Today G&Z is renowned for its continued innovations in the slipform paver industry. These innovations gained significant industry praise and led the USPTO to grant several patents covering various aspects of its multi-track slipform pavers. This case involves G&Z’s innovative SmartLeg and AccuSteer technologies, which G&Z first incorporated on its concrete pavers in 2010. The image below illustrates a rear view of an exemplary G&Z slipform paver. Swing legs positioned

on each side of the paver connect the various crawler tracks to the frame. Each swing leg includes a jacking column that adjusts the vertical position of the crawler track with respect to the frame as well as a rotary power drive that adjusts the angle of the crawler track with respect to the frame. G&Z's design provides a number of benefits, including the ability to steer the machine without manual involvement.



Ex. 2002 at 1 (annotated).

Following the rollout of G&Z's novel design, contractors around the world saw the incredible value of G&Z's patented SmartLeg/AccuSteer technology. In fact, G&Z saw countless customers abandon their slipform pavers long before the end of their useful life cycles and replace them with G&Z's SmartLeg/AccuSteer slipform paver machines. For G&Z's customers, the SmartLeg/AccuSteer technology dramatically improved productivity because it made possible, for the

first time ever, to move the crawler track position on a concrete slipform paver “on the fly” and keep the crawler track position straight ahead to avoid obstacles in the track path. Previously, repositioning the crawler tracks took hours or up to half a day, and it could take a full day just to get the paver machine ready to transport. With SmartLeg/AccuSteer technology, these tasks were reduced to minutes and, worst case, less than 30 minutes.

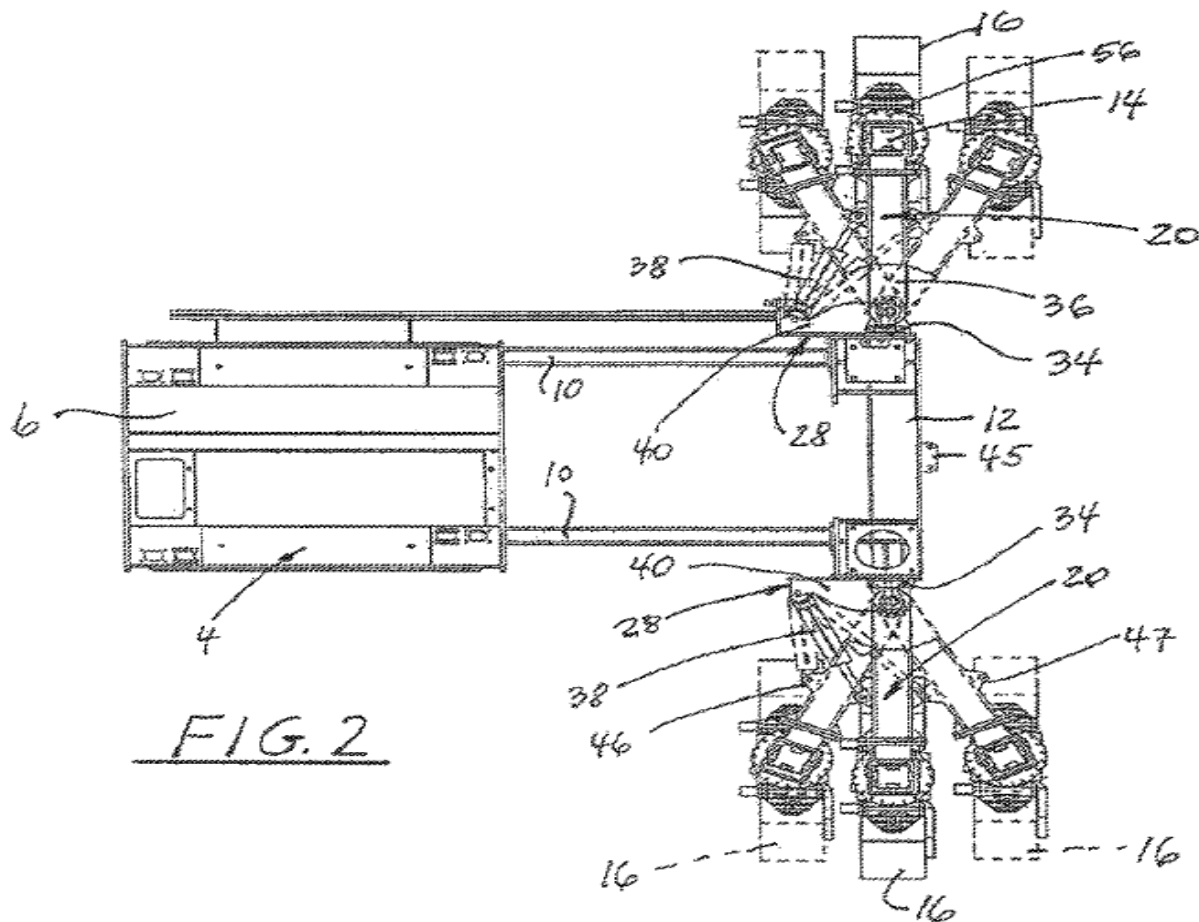
The success of G&Z's technology has also led its only significant competitor in the United States, Gomaco Corp., (“Petitioner” or “Gomaco”) to copy G&Z's patented technology. As shown below, Gomaco released slipform pavers with the same swing legs and slew drives and is almost an identical copy of G&Z's machines:



Ex. 2003 at 7 (annotated). Unfortunately, Gomaco's copying forced G&Z to seek an injunction prohibiting Gomaco from piggybacking off of G&Z's extensive investments in research and development.

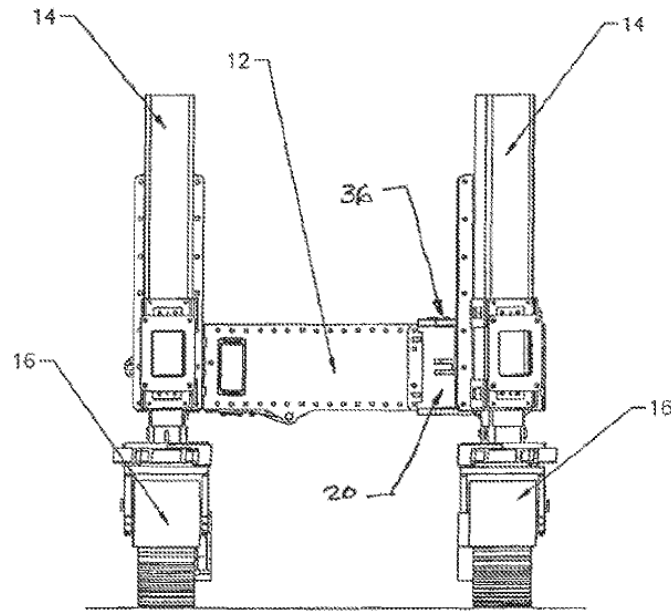
III. OVERVIEW OF THE '571 PATENT

G&Z's '571 Patent discloses a specialized swing leg assembly that significantly increases the efficiency and effectiveness of slipform pavers. See '571 Patent, Abstract; *id.* at 6:28-7:21. Figure 2 of the '571 Patent shows a partial overhead view of a slipform paver with pivotable bolster swing legs 20 connected to crawler tracks 16, which move the slipform paver:



Id. at FIG. 2. Each bolster swing leg includes a jacking column 14, which raises and lowers the crawler track relative to the paver's frame. *Id.* at 8:45-57; *id.* at

9:23-25. Figure 6C illustrates a lateral view of the slipform paver bolster swing leg 20 and crawler track 16:



Id. at FIG. 6C.

At the time of the invention, in early 2010, slipform pavers with both three and four crawler tracks were already well known in the art. *See id.* at 1:53-67; *id.* at 2:65-3:4. Thus, while the exemplary embodiment discussed in the '571 Patent has four crawler tracks (*see id.* at FIG. 1 (illustrating a four-track paver machine configuration)) the specification of *Guntert* explicitly discloses mounting the inventive swing legs on known slipform pavers having only three tracks. *Guntert* at ¶ [0004]. Indeed, *Guntert* states that in such configurations the crawlers can be relocated “to the front and rear of the tractor center module,” as claimed in the

'571 Patent. *See id.*; *see also* '571 Patent at Claim 1 (reciting “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”) (emphasis added).

The '571 Patent also discloses transducers that relay movement data for each single bolster swing leg to a processor or onboard computer, which resolves the direction and orientation of the bolster swing legs. '571 Patent at 6:28-37; *id.* at 12:32-59; *id.* at 16:38-47; *id.* at 20:34-43; *see also id.* at FIG. 12A (Figure 12A with angular transducers identified as 78); *id.* at 6:15-20 (onboard computer or other processor receives outputs from the transducers and generates a signal to pivot the crawler track relative to the jacking column to keep the crawler tracks oriented in the paving direction when the orientation of the bolster swing leg changes and keeps all the crawler tracks' orientations synchronized). The orientation of the swing legs is changed via a rotary power drive placed between the jacking column and the crawler track. *Id.* at 6:9-65.

The '571 Patent solved problems with existing slipform paver machines, including removing the need to manually maneuver the bolster swing legs during concrete paving and transportation of the paver machines, which is a time-consuming and expensive process. *Id.* at 7:1-21; *see also id.* at 6:45-49 (specialized bolster swing leg assembly permits the crawler track positions to be relocated without any manual mechanical or electronic adjustments); *see also, e.g.,*

id. at 5:30-33 (previous approach does not permit moving the paver from one site to another quickly and efficiently).

The inventive bolster swing leg assembly also ensures that paver can be narrowed for moving over ordinary highways to a new paving site of varying width dimensions (such as a bridge) or maneuvering the paver around a site that is tightly confined. *Id.* at 7:10-21. The maneuverability due to the bolster swing leg assembly permits this bulky, heavy equipment to quickly avoid obstacles in the path of each bolster swing leg or crawler track, while maintaining a consistent paving direction and surface for the concrete, by synchronizing the movement between the relative angles of each crawler track and bolster swing leg as they pass the obstacle. *Id.* at 2:65-3:4, 6:9-23, 15:59-16:15, 16:38-42.

IV. PROSECUTION HISTORY

During prosecution of the application which matured into the '571 Patent, Applicant added two new independent claims that require “forward bolster connected to the forward end of the center module” and an “aft bolster connected to the aft end of the center module.” Ex. 1004 at 99 and 103-104. Petitioner suggests that the claim features relate to new matter. Petition at 8-9.

Petitioner's contention is incorrect and misleading. Petitioner ignores that, during prosecution of the '571 Patent application, Applicant relied on *Guntert's* disclosure, particularly paragraph 4, for written description support of these claim

features. *See* Ex. 1004 at 107; *see also* *Guntert* ¶ [0004]. As such, the '571 Patent's claim features of forward and aft bolsters connected to the forward and aft ends are not new matter because they are based on the disclosures of the parent application, *Guntert*. Thus, the prosecution demonstrates that the Petition is meritless.

V. CLAIM CONSTRUCTION

A. Legal Standard

Under *Phillips*, patent claims are interpreted in light of the intrinsic evidence, including the specification and file history, and “the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 1317 (Fed. Cir. 2005) (citations omitted); *see also* 83 Fed. Reg. 51340, 51341 (Oct. 11, 2018) (adopting *Phillips* standard for AIA proceedings before the Board).

B. Patent Owner's Proposed Construction

1. “mechanically coupled” (Claims 1, 8, 11, and 13)

The Board should not construe the term “mechanically coupled” at this juncture because it is not necessary to resolve the parties' dispute over the priority date of the '571 Patent. *See, e.g., Sandoz Inc. v. AbbVie Biotech. Ltd.*, No.

IPR2017-01987, 2018 WL 1230583, at *5 (P.T.A.B. Mar. 9, 2018) (“[B]ecause neither of those phrases requires construction for us to resolve the instant dispute, we decline to construe them) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”)).

Should the Board institute trial, Patent Owner reserves the right to advocate for constructions of this and any other claim term in its Patent Owner Response.

VI. THE BOARD SHOULD DENY INSTITUTION BECAUSE *GUNTERT* IS NOT PRIOR ART

The Board should deny institution of *inter partes* review because the ’571 Patent is entitled to claim priority to *Guntert*, thereby disqualifying *Guntert* as prior art. As demonstrated below, each application in the priority chain of the ’571 Patent includes written description support for the Challenged Claims pursuant to 35 U.S.C. § 112, and every other requirement for a valid priority claim under 35 U.S.C. § 120 has been met.

Under § 120, there are four requirements for an application to obtain the benefit of an earlier filing date of a previously filed application: (1) the invention in the application must be disclosed in the original application pursuant to 35 U.S.C. § 112; (2) the application must be filed while the previously filed application is still pending; (3) there must be a common inventor between both applications; and (4) there must be a specific reference to the earlier filed

application. There is no dispute that the '571 Patent and each application in the priority chain satisfies the second, third, and fourth requirements of § 120, and Petitioner's challenge of the first requirement is completely without merit.

The Challenged Claims enjoy priority to Guntert because “the disclosure of [*Guntert*] relied upon reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc); *see also Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002) (expressing that the standard for satisfying the written description requirement is whether the disclosure “allow[s] one skilled in the art to visualize or recognize the identity of the subject matter purportedly described.”) (citation omitted). As explained in detail below, the *Guntert* provides more than adequate support for the Challenged Claims and allows one skilled in the art to recognize that the inventors had possession of each claim feature, including:

- “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 molded form;”
- “a conveyor arranged to deliver semi-solid concrete to a hopper;”

- “a laterally telescoping leg, configured to extend from the center module in a direction perpendicular to the forward end;” and
- “a linear position transducer between the laterally telescoping leg and the forward bolster.”

A. The claim features of “a forward bolster connected to the forward end of the center module” (Claim 1) and “an aft bolster connected to the aft end of the center module” (Claim 1) are entitled to the priority date of *Guntert*

In its Petition, Gomaco challenges the following claim elements from Claim 1 as purportedly lacking written description support from *Guntert*. These elements are:

- “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.”

Petition at 9. However, even a cursory review of *Guntert* demonstrates that the claim features are fully supported.

1. *Guntert* provides written description support for forward and aft bolsters connected to the center module.

Guntert provides written description for forward and aft bolsters connected to the center module because *Guntert*’s “words, structures, figures, diagrams, [and] formulas” would be understood as describing these claim features—evidenced by *Guntert*’s specification as well as Petitioner’s own expert. *See Crown Operations*

Int'l, Ltd. v. Solutia Inc., 289 F.3d 1367, 1376 (Fed. Cir. 2002) (quoting *Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 1021 (Fed. Cir. 2002) (internal quotations omitted)). *Guntert* teaches that a “bolster swing leg” is a swing leg that is mounted to a bolster. *See, e.g., Guntert* ¶¶ [0036]–[0038]; *id.* at FIG. 6C. *Guntert*'s teaching also discloses where to mount such bolster swing legs, “directly to the front and rear of the tractor center module,” and this results in precisely the same arrangement claimed in the '571 Patent. *See e.g., id.* at ¶ [0004].

Specifically, paragraph 4 of *Guntert* describes that:

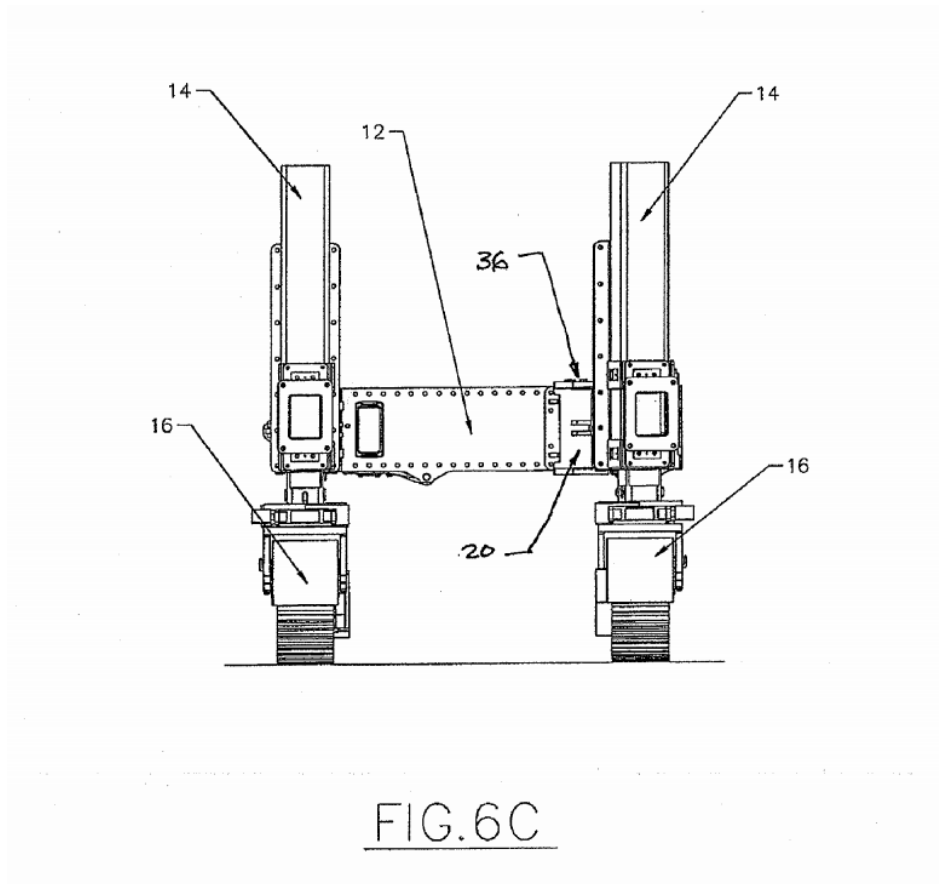
The tractor normally has four crawler tracks, but can also have only three, each mounted to a jacking column, supporting and propelling the frame during use of the paver in the paving direction. The jacking columns are carried on the bolsters, or on bolster swing legs connected to the fore and aft ends 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.

Id. (emphasis added). Thus, the 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.

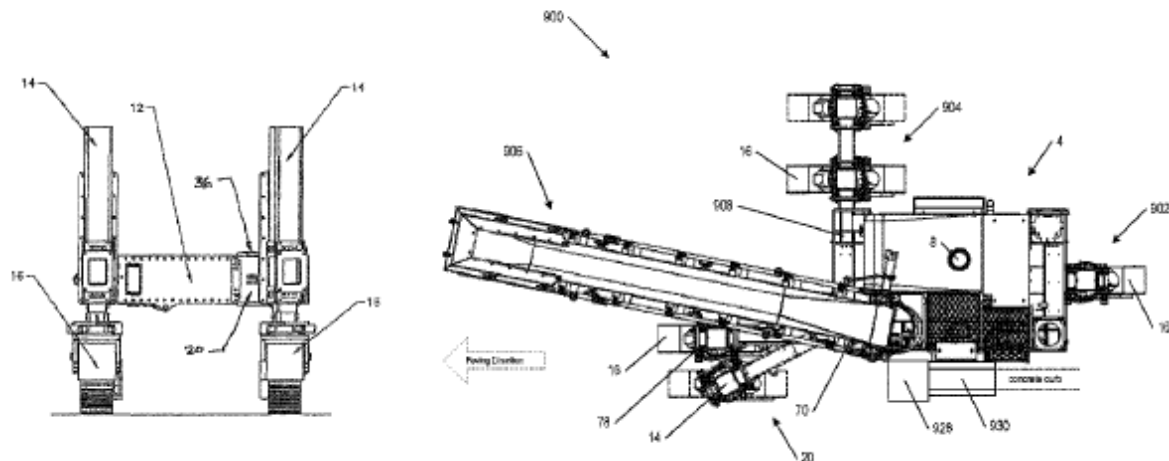
Petitioner's contention to the contrary is erroneous. *See, e.g.*, Petition at 18-20. Petitioner suggests that the “[b]olster swing leg” does not refer to an apparatus where the bolster and swing leg components have been combined.” *Id.* at 18. This argument is a red herring. The specification and figures that disclose that the term “bolster swing leg” refers a swing leg mounted on a bolster. For example, *Guntert* explicitly describes that “the ends of box beams 22 [which the swing leg is typically formed as] the adjacent bolster end surface 34 have connector plates 36” (*Guntert* at ¶ [0038]) that pivotally engage the pivot shaft 24 of the hinge bracket, which is secured to the bolster 12, such to form the apparatus known as the bolster swing leg 20. *Id.* at ¶¶ [0036]–[0038].

Figure 6C from *Guntert* demonstrates that bolster swing leg 20 includes bolster 12 connected to the swing leg via connector plates 36:



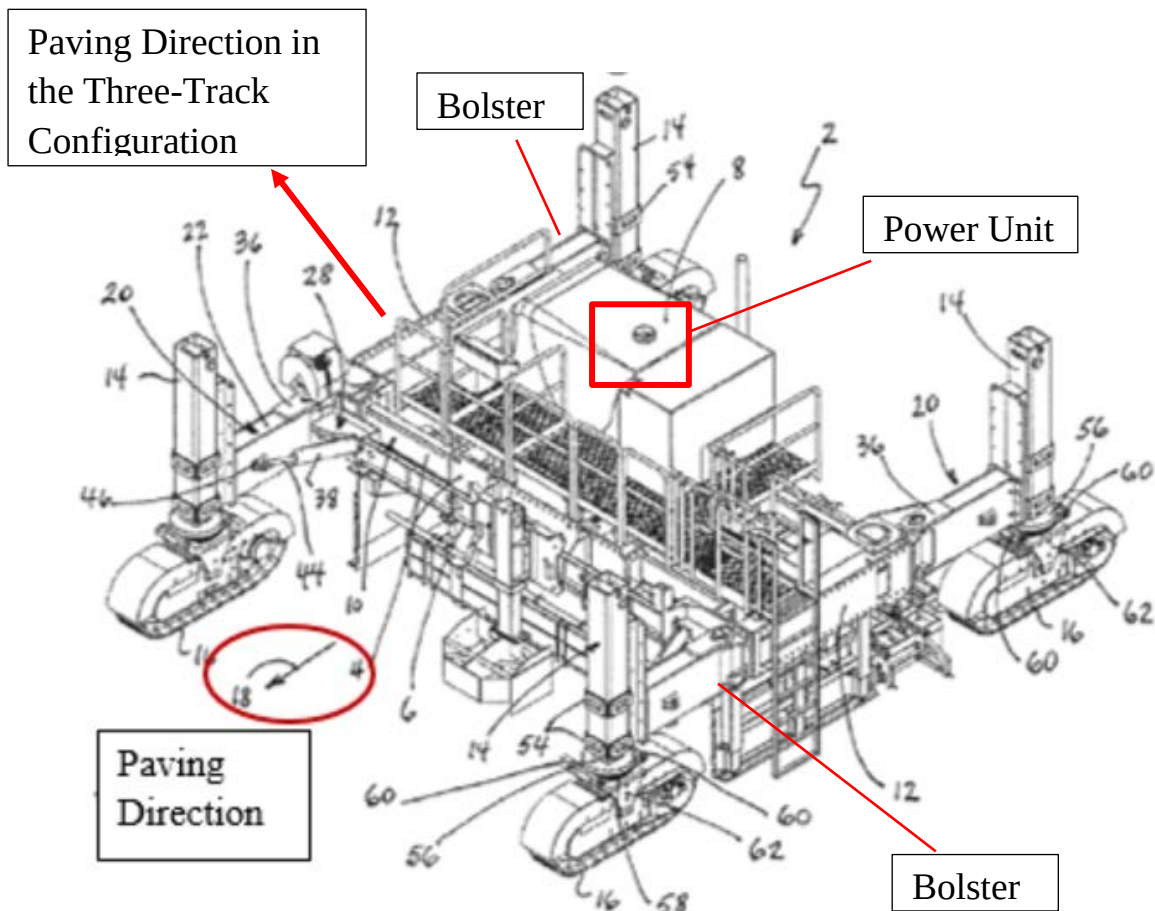
Guntert at FIG. 6C; *see also id.* at FIG. 6.

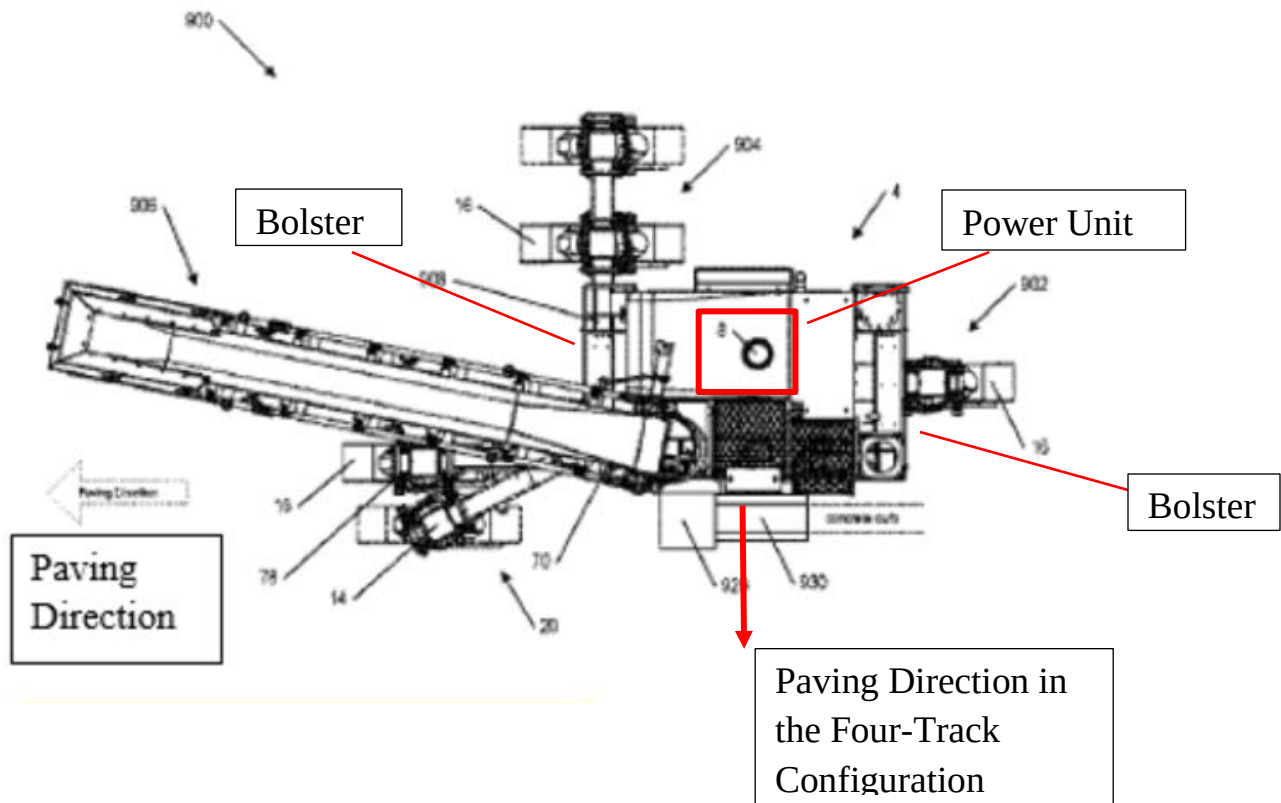
Importantly, the '571 Patent uses Figure 6C to illustrate that the bolster swing leg 20 is used in the three-track paver configuration, as illustrated below:



'571 Patent (face) (illustrating FIGS. 6C (left) and 9 (right)).

The identification of the bolsters either as “side bolsters” or “front/aft bolsters” is dependent upon the paving direction of the machine. The figures from the '571 Patent shown below depict the paving direction 18 of the four-track paver and the three-track configuration:





‘571 Patent at FIG. 1 (top) (annotated); *id.* at FIG. 9 (bottom) (annotated).

The figures reproduced above show that the power unit is located on the center module and is orientated in the same relative position in both configurations, with the bolsters being found on opposing ends of the power unit in both illustrations. While the orientation of the bolsters on the frame is unchanged, the identification of the bolsters on the opposing ends of the power unit is premised upon the paving direction of the paver. Stated otherwise, 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 orientated and aligned with the paving direction.

Importantly, in the three-track paver configuration, the paver is moved forward in a paving direction that is perpendicular to that of the four-track paver configuration. Because of this, the bolsters are forward and aft bolsters rather than side bolsters, and those bolsters are aligned and orientated with the three-track paver's paving direction. Conversely, with the four-track paver configuration, the bolsters are identified as lateral bolsters that are aligned and orientated with the four-track's paving direction. To that end, a 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. *See generally Guntert* at ¶ [0004]; *see also In re Hayes Microcomputer Prods., Inc. Patent Litig.*, 982 F.2d 1527, 1534 (Fed. Cir. 1992) (finding § 112 support for “when one skilled in the relevant art would understand what is intended and know how to carry it out.”). In fact, as discussed above, Dr. Singhose admits to such understanding—*Guntert* describes a three-track paver configuration with forward and aft bolsters. Ex. 1002 (“Singhose Decl.”) at ¶ 63 (citing *Guntert* at ¶ [0004]); *see also* Singhose Decl. at ¶ 47.

Further, during prosecution of the '012 Application, Applicant relied on the same paragraph 4 disclosure, identified above, for providing written description support for the claimed three-track paver machine that includes the claim features of forward and aft bolsters. *See* Ex. 1004 (“'571 Prosecution History”) at 107; *see*

also '571 Patent at Claim 1. Applicant's reliance on the disclosure—which describes three crawler tracks that are each mounted on a jacking column that is carried on a bolster, or bolster swing leg—demonstrates that *Guntert* supports the claim features of “forward bolster” and “aft bolster” connected to a center module.

The Petition also fails to set forth probative evidence that a POSITA would **not** have recognized written description for the forward and aft bolsters in from *Guntert*. *See, e.g., Alcon Research Ltd. v. Barr Labs., Inc.*, 745 F.3d 1180, 1191-92 (Fed. Cir. 2014) (“Critically, Barr adduced no evidence . . . that was probative of whether an ordinarily skilled artisan would not have understood from the disclosures of Alcon's . . . patents that the patentees invented, or possessed, the methods of the asserted claims. Without that evidence, there was no basis on which to find a lack of adequate written description.”). Instead, the evidence Petitioner does set forth demonstrates that one skilled in the art would understand from the *Guntert* disclosure that the inventors possessed forward and aft bolsters connected to the center module. *See* Singhose Decl. at ¶ 63 (citing *Guntert* at ¶ [0004]); *see also* Singhose Decl. at ¶ 47.

2. Gomaco's expert admits that *Guntert* provides written description support for the challenged claims.

Gomaco's own expert, Dr. Singhose, admits that *Guntert* discloses a three-track paver configuration having forward and aft bolsters thereby providing written description support for the Challenged Claims. *See* Singhose Decl. at ¶ 63

(admitting that Guntert “*itself teaches that pavers can be so configured*” “*to implement three jacking columns and crawler tracks*” attached to “*the front bolster . . . [and] the aft bolster*”) (emphasis added) (citing *Guntert* at ¶ [0004]).

Dr. Singhose's, reliance on paragraph 4 of *Guntert* to conclude that the claim features of the “forward bolster” and “aft bolster” are connected to the center module are present in three-track paver configuration cannot be downplayed. As discussed above, Applicant relied upon this same disclosure cited by Dr. Singhose during prosecution of the '571 Patent for the claim features required to achieve a three-track paver configuration.

Dr. Singhose further declares that the attachment of swing legs to forward and aft bolsters of the paver's center module are well-known in the art, and he cites to references that disclose the three-track paver with swing legs mounted to forward and aft bolsters connected to the center module. Singhose Decl. at ¶¶ 63-64. In fact, Dr. Singhose avers that “*a POSITA would have known* from *CIII*” (*id.* at ¶ 64 (emphasis added)) to mount swing legs to forward and aft bolsters of the center module because it would ensure that “the paver could be configured for different paving tasks without risking the stability of the paver.” *Id.*

With respect to paver tasks, Dr. Singhose acknowledges that three-track paver configuration requires forward and aft bolster swing legs because the paving operation is different from that of the four-track configuration (with side bolsters

swing legs), as concrete is formed from attachments on the side of the machine to pave curbs and gutters in contrast to being formed from attachments underneath the four-track paver machine. *See id.* at ¶¶ 47, 62.. Thus, Dr. Singhose was led to the same conclusion as the Examiner when presented with the same claim elements and written description evidence to support them which is: that the challenged claim elements of “one forward bolster connected to the forward end of the center module” and “one aft bolster connected to the aft end of the center module” are supported by the specification of Guntert.

3. *Guntert* also leads one skilled in the art understand the three-track paver configuration with forward and aft bolsters recited in the challenged claims.

In addition to the explicit disclosure of mounting bolster swing legs to the front and back of a paving platform, the Challenged Claims are supported by *Guntert* under the Federal Circuit's decision in *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049 (Fed. Cir. 2020). In *Immunex*, the Federal Circuit held that the specification “need not re-describe known prior art concepts.” *Id.* at 1064 (citing *Capon v. Eshhar*, 418 F.3d 1349, 1357 (Fed. Cir. 2005) (“The ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge.”); *Zoltek Corp. v. United States*, 815 F.3d 1302, 1308 (Fed. Cir. 2016) (“The written description need not include information that is already known and available to the experienced public.”) (citations and internal quotations

omitted)). Simply put, *Immunex* governs that written description is provided by a specification that leads a skilled artisan to the particular disclosure—the specification does not need to re-describe well-known prior art concepts.

Immunex, 964 F.3d at 1064.

As explained above, one skilled in the art understands that *Guntert*'s description of three-track paver configuration requires forward and aft bolsters. *Guntert* at ¶ [0004]. Indeed, Dr. Singhose reads *Guntert* with this understanding. Singhose Decl. at ¶ 63 (*Guntert* “***itself teaches that pavers can be so configured***” “***to implement three jacking columns and crawler tracks***” attached to “***the front bolster . . . [and] the aft bolster***”) (emphasis added) (citing *Guntert* at ¶ [0004]). In view of the above, Dr. Singhose unequivocally confirms it is well-known in the art that the swing legs of the three-track paver are mounted to the forward or aft bolster of the center module—forming the “bolster swing leg” and that a POSITA would understand *Guntert* as demonstrating possession of these features. Petitioner's argument to the contrary—that paragraph 4 of *Guntert* should be read to mean that the swing leg is attached directly to the center module, not the bolster (see Petition at 20)—is nonsensical and inconsistent with the three-track pavers well known in the art at the time of the invention.

Indeed, Dr. Singhose's logic aligns with *Immunex* and demonstrates that the specification does not need to re-describe in detail the conventional three-track

paver configuration with forward and aft bolsters connected to the center module of a slipform paver. *See Immunex*, 964 F.3d at 1064; *see also Zoltek*, 815 F.3d at 1308 (“The written description need not include information that is already known and available to the experienced public.”) (citations and internal quotations omitted); *Boston Sci. Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1366 (Fed. Cir. 2011) (“[A] patentee may rely on information that is ‘well-known in the art’ for purposes of meeting the written description requirement.”) (citations omitted)).

For at least the foregoing reasons, *Guntert* reasonably conveys to one skilled in the art that the inventors had possession of the claim features of “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” no later than *Guntert*’s filing date.

B. The claim features of “a molded form” (Claim 1) and “a conveyor arranged to deliver semi-solid concrete to a hopper” (Claim 14) are entitled to the priority date of *Guntert*.

In its Petition, Gomaco also challenges the following claim elements from Claim 1 and Claim 14 as purportedly lacking written description support from *Guntert*. These elements are:

- “a molded form”; and
- “a conveyor arranged to deliver semi-solid concrete to a hopper.”

Petition at 23. These elements, likewise, are fully supported in *Guntert*.

1. *Guntert* provides written description support for a molded form and conveyor arranged to deliver semi-solid concrete to a hopper.

As demonstrated below, the inventors also had possession of the claim features “a molded form” and “a conveyor arranged to deliver semi-solid concrete to a hopper” and correctly claim priority to *Guntert*.

One skilled in the art would recognize that *Guntert* discloses the claim feature of “a molded form,” as *Guntert* describes paving kits that attach to the paver and, shape (mold) and finish a layer of concrete over underlying ground. See *Guntert* at ¶¶ [0002]–[0003]. *Guntert* describes that paving kits include molds (the claimed “molded form”) that are suspended from the machine and shape the concrete in a finished form. *Id.* at ¶ [0002]. Furthermore, *Guntert* goes on to teach that “[d]uring this process, the tractor-attached paving kit spreads the semi-solid concrete, . . . levels and vibrates it into a semi-liquid state, then confines and finishes the concrete back into a semi-solid slab with an upwardly exposed and finished surface.” *Id.* at ¶ [0003]. This reasonably conveys to one skilled in the art that the claim feature of “a molded form” is disclosed by *Guntert*. See *Indivior Inc. v. Dr. Reddy's Labs., S.A.*, 930 F.3d 1325, 1349 (Fed. Cir. 2019) (finding that “[t]he specification need not recite the claimed invention *in haec verba*” so long as the specification reasonably conveys the claimed feature to a skilled artisan) (citation omitted).

In the same vein, paragraph 3 of *Guntert* disclose “a conveyor arranged to deliver semi-solid concrete to a hopper” (Claim 14) to one skilled in the art. Paragraph 3 describes paving kits “for conveying and spreading concrete” that also can be attached to the paver. *See Guntert* at ¶ [0003]. A skilled artisan would understand that the paving kit—which performs the task of conveying and spreading concrete—includes a conveyor and hopper to accomplish these tasks. *See, e.g., Indivior*, 930 F.3d at 1349 (“[t]he specification need not recite the claimed invention *in haec verba*”).

For at least these reasons, *Guntert* reasonably conveys to one skilled in the art that the inventors of the Challenged Claims had possession of the claim features of “a molded form” (Claim 1) and “a conveyor arranged to deliver semi-solid concrete to a hopper” (Claim 14) no later than *Guntert*’s filing date.

2. Gomaco’s expert admits that *Guntert* provides written description support for the challenged claims.

Indeed, Dr. Singhose acknowledges that *Guntert* discloses the challenged claim limitation of Independent Claim 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:”

Guntert discloses “[a] paving machine which is configured to move in a paving direction for spreading, leveling and

finishing concrete [(“laying concrete”)] ***into a form having a generally upwardly exposed, finished concrete surface*** and terminating in lateral concrete sides.” Guntert, Abstract; *see also id.*, ¶¶[0002]-[0003], [0035], Claim 1. ***Guntert discloses that “sideforms mounted on each side of the slipform paving kit shape and confine the sides of the slab during the slipform paving process.” Id.***, ¶[0003].

Singhose Decl. at ¶ 66 (emphasis added). Thus, Dr. Singhose finds support for “a molded form” in the same paragraphs discussed above because he readily admits that *Guntert* discloses these limitations.

Furthermore, Dr. Singhose recognizes that when using the paving kits described in *Guntert*, a POSITA would know that when paving tall barriers with a molded form, a conveyor delivering concrete to an elevated hopper would be required and well understood. *Id.* at ¶ 110. Thus, support for “a conveyor arranged to deliver semi-solid concrete to a hopper” is understood by a POSITA from *Guntert*’s disclosure of “[o]ther kits . . . attached to the[] tractors such as kits for ***conveying and spreading concrete*** and trimming and spreading base materials. *Guntert* at ¶ [0003]; *Immunex*, 964 F.3d at 1064 (written description is provided by a specification that leads a skilled artisan to the particular disclosure—the specification does not need to re-describe well-known prior art concepts).

For at least the foregoing reasons, *Guntert* reasonably conveys to one skilled in the art that the inventors had possession of the claim features of “a molded form” and “a conveyor arranged to deliver semi-solid concrete to a hopper” no later than *Guntert*'s filing date.

C. The claim feature of “a laterally telescoping leg, configured to extend from the center module in a direction perpendicular to the forward end” (Claim 8) is entitled to the priority date of *Guntert*.

In its Petition, Gomaco also challenges the claim element from Claim 8 as purportedly lacking written description support from *Guntert*. This element is:

- “a laterally telescoping leg, configured to extend from the center module in a direction perpendicular to the forward end.”

Petition at 23. This element, likewise, is fully supported in *Guntert*.

1. *Guntert* provides written description support for a laterally telescoping leg, configured to extend from the center module in a direction perpendicular to the forward end.

Guntert discloses “a laterally telescoping leg, configured to extend from the center module in a direction perpendicular to the forward end.” Particularly, paragraph 65 of *Guntert* describes laterally telescoping cross beams that are extendable and retractable. *Guntert* at ¶ [0065]. *Guntert* goes on to incorporate by reference U.S. Patent Appl. 12/703,101 entitled “Slipform Paving Machine With Adjustable Length Tractor Frame,” which matured into U.S. Patent No. 8,118,518 (Ex. 2004, the “’518 Patent”) to describe the specific features. See *Guntert* at

¶ [0065]; Ex. 2004; *Paice LLC v. Ford Motor Co.*, 881 F.3d 894 (Fed. Cir. 2018) (finding incorporation by reference proper where the patentee describes the invention with particularity); *see also Advanced Display Sys. Inc. v. Kent State Univ.*, 212 F.3d 1272, 1283 (Fed. Cir. 2000) (“The standard of one reasonably skilled in the art should be used to determine whether the host document describes the material to be incorporated by reference with sufficient particularity.”).

The ‘518 Patent describes that a laterally telescoping beam includes a bolster that has at least one jacking column with a crawler track attached to the bottom of the jacking column that move laterally outwardly from the center module. ‘518 Patent at Abstract; *id.* at 1:54-61; *id.* at 6:40-50; *id.* at FIGS. 4 and 5. Specifically, the ‘518 Patent describes that:

When it is necessary to increase the span of the paving machine in order to lay down a wider concrete strip, ***bolsters 12 and the crawlers 16 carried by them are moved laterally outwardly*** to the positions shown in FIGS. 4 and 5 ***While support beams 10 are moved away (or towards) the center module with crawlers 16***, the weight and resulting friction of the center module resting on support blocks 40, as well as the perpendicular orientation of crawlers 16 on the other bolster 12, maintain the entire tractor frame stationary, ***thus making it easier to telescope the support beams 10.***

Id. at 6:40-67 (emphasis added); *see also id.* at FIGS. 4 and 5.

The '518 Patent explains that the bolster 12 and crawler track (connected to the bolster by the jacking column) are laterally telescoped—that is moved laterally outward from the center module—via the telescopic support beams 10:

The bolsters that connect the jacking column with the crawlers of the paver are connected to the platform with telescopic extension arms or support beams which can be retracted into the center module, *to reduce the length of the paver (in a direction perpendicular to the normal paving direction), or extend it outwardly from the center module, to increase the width for paving.*

Id. at 1:54-60 (emphasis added); *see also id.* at 6:40-67. The '518 Patent describes a laterally telescoping leg that extends and retracts from the center module.

For at least the foregoing reasons, *Guntert* reasonably conveys to one skilled in the art that the inventors had possession of the claim features of “a laterally telescopic leg configured to extend from the center module in a direction perpendicular to the forward end” (Claim 8) no later than *Guntert*'s filing date.

D. The claim feature of “a linear position transducer between the laterally telescoping leg and the forward bolster” (Claim 8) is entitled to the priority date of *Guntert*.

In its Petition, Gomaco also challenges the claim element from Claim 8 as purportedly lacking written description support from *Guntert*. This element is:

- “a linear position transducer between the laterally telescoping leg and the forward bolster.”

Petition at 23. This element, likewise, is fully supported in *Guntert*.

1. *Guntert* provides written description support for a linear position transducer between the laterally telescoping leg and the forward bolster.

Guntert also discloses “a linear position transducer between the laterally telescoping leg and the forward bolster.” In particular, *Guntert* describes a telescoping leg, a forward bolster and an on-board computer processor that receives outputs from transducers in order to keep all the crawler tracks’ orientations synchronized. See §§VI.A & VI.C, *supra*; ’571 Patent at 6:15-20. As such, one skilled in the art would understand from the specification that when utilizing a paver in the three-track configuration, a linear transducer between the forward bolster and laterally telescoping leg is required to provide the onboard computer processor with the correct placement of the crawler track. *In re Hayes*, 982 F.2d at 1534 (finding § 112 support for “when one skilled in the relevant art would understand what is intended and know how to carry it out.”). This allows one to synchronize the orientation of all crawler tracks and make proper steering adjustments to the machine to account for the unique layout of the finished product.

Thus, in order to provide the onboard computer processor with the necessary information for synchronization, a skilled artisan would understand *Guntert* to disclose a linear transducer between the forward bolster and laterally telescoping

leg. For at least the foregoing reasons, *Guntert* reasonably conveys to one skilled in the art that the inventors had possession of the claim features of “a linear position transducer between the laterally telescoping leg and the forward bolster” (Claim 8) no later than *Guntert*'s filing date.

In view of the foregoing reasons, *Guntert* provides sufficient written description support for the features in the Challenged Claims. The '571 Patent is entitled to claim priority to *Guntert*. Therefore, *Guntert* is not prior art. Nor is Ex. 1030 (“*Dahm*”) prior art, as *Dahm* issued from an application filed on June 9, 2014. The Petition should be denied.

VII. THE BOARD SHOULD DENY THE PETITION UNDER SECTION 325(D)

Under 35 U.S.C. § 325(d), the Board should exercise discretion to deny institution where the petition seeks to have the Board second guess issues of patentability that the Patent Office addressed before issuing the '571 Patent. In this case, the Office already considered the patentability of the Challenged Claims over *Guntert*, as well as art that is substantially the same as *CIII* (art relied on in the obviousness ground).

Under Section 325(d) the Board uses the following two-part framework to determine whether to deny institution of a petition for *inter partes* review: (1) whether the petition presents the same or substantially the same art or arguments as presented previously to the Patent Office; and (2) if either condition of the first

prong is satisfied, then whether the petitioner has demonstrated that the Patent Office made a material error to the patentability of the challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, No.

IPR2019-01469, 2020 WL 740292, at *3 (P.T.A.B. Feb. 13, 2020) (precedential).

Because the same or substantially the same prior art was already considered by the Office, and Petitioner has made no attempt to demonstrate material error, the Board should deny institution.

A. The Patent Office has Already Considered *Guntert* and Substantially the Same Art as *CIII* Cited in the Petition.

The Board evaluates *Becton Dickinson* Factors (a), (b), and (d) to determine whether the petition presents the same or substantially the same art or arguments as presented previously to the Patent Office. *See, e.g. id.*, at *4. Significantly, the district court provides meaningful guidance on this issue and suggests that the Petition, which rely on *CIII* and the *Guntert*, may be frivolous because the Patent Office already considered *Guntert*. Ex. 2001 at 10. The district court's analysis is directly on point because during original prosecution of the '571 Patent, the examiner considered the same art as the *Guntert* asserted here. *Id.* In addition, the Patent Office considered substantially the same art as *CIII*, which Petitioner relies on for an obviousness combination with *Guntert*. Petitioner fails to demonstrate that the examiner materially erred regarding the patentability of the Challenged Claims when considering the same subject matter during prosecution.

Becton Dickinson Factors“(a) the similarities and material differences between the asserted art and the prior art involved during examination” and “(b) the cumulative nature of the asserted art and the prior art evaluated during examination” weigh in favor of denying institution. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, Paper 8 at 17 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). Notably, during prosecution of the '012 Application (which matured into the '571 Patent), the examiner considered U.S. Patent No. 8,459,898 to *Guntert et al.* (the “'898 *Guntert* Patent”) that issued from *Guntert*. *Guntert* asserted here is the same as the '898 *Guntert* Patent that was considered by the examiner during prosecution. Indeed, they are each a published version of the same patent application.

Petitioner acknowledges this, while also (in vain) attempting to discredit the disclosure of the same reference and subject matter:

The patent that issued from *Guntert* (U.S. Patent No. 8,459,898) is part of the '571 Patent's chain of priority and was included in a List of References Cited, Ex. 1004, 86, but it was not relied on in any rejection, let alone applied to the claims with CIII, as asserted in this Petition.

Petition at 24. Petitioner, however, ignores pertinent facts, as well as the Board's informative decision in *Cultec, Inc. v. Stormtech LLC*, Case IPR2017-00777, Paper 7 at 7–13 (P.T.A.B. Aug. 22, 2017) (informative), where the Board denied

institution under §325(d) based upon the disclosure of prior art references that were ***considered by the examiner***:

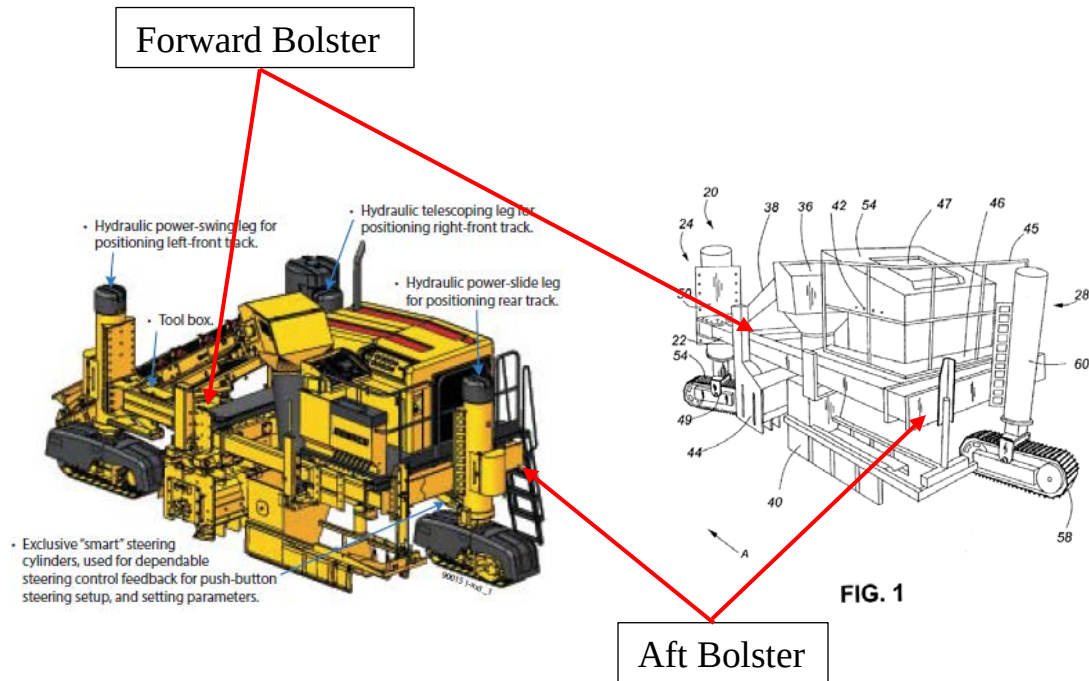
As stated on the signed form, the Examiner's signature "indicates all documents listed above have been considered." *Id.* Additionally, typed on the bottom of the form is the statement "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /B.F.F./." *Id.* No references were lined through. "B.F.F." appears to be the initials of the Examiner.

Id. at 9–10. *Cultec* instructs that it is not necessary for the examiner to have discussed the identified art in an office action during prosecution; the examiner's consideration of the art is sufficient—this point is particularly relevant here where the reference of record is the exact same disclosure as the patent being challenged in *inter partes* review. Indeed, sufficiency rests on the logic that the examiner is charged with considering the best references for the pending claims. *See, e.g.*, 37 C.F.R. § 1.104(c)(2) (stating that, "the Examiner must cite the best references at his or her command"). As such, analyzing the references considered by the examiner during prosecution, the *Cultec* Board determined that the art asserted in the IPR grounds were substantially the same, thus the Board exercised its discretion under §325(d) to deny institution. *Cultec*, Paper 7 at 13.

Not only did the examiner consider the '898 *Guntert* Patent—the same as, and thus necessarily cumulative to, *Guntert*—but also considered substantially the

same art as *CIII*, also presented in the Petition. To begin, the examiner considered four references during prosecution of the '571 Patent, all of which are assigned to Gomaco, and notably the *CIII* machine (which the *CIII* is a manual for) is marked with the patents. *See, e.g.*, '571 Prosecution History at 86 (referencing U.S. Patent Publ. No. 2017/0106902 that issued as U.S. Patent No. 10,005,489; U.S. Patent Publ. No. 2016/0244096 issued as U.S. Patent No. 9,764,762; U.S. Patent No. 9,663,162; and U.S. Patent No. 9,180,909); Ex. 2010 at 24. Collectively, these references describe multiple aspects of the *CIII* machine, in particular: forward and aft ends of the machine frame; telescoping structures used for width changes; and the use of sensors on linear actuators. *See, e.g.*, Ex. 2005; Ex. 2006; Ex. 2007; Ex. 2008.

Furthermore, U.S. Patent No. 6,890,123 to *Piccoli* (Ex. 2009, the "*Piccoli* Patent"), which was considered by the examiner during prosecution, is substantially similar to the *CIII* three-track machine as it concerns a three-track paving machine that uses hydraulic steering cylinders (linear actuators) and telescoping leg, all controlled by a network of sensors. *See* '571 Prosecution History at 86, 95, 111. The figures reproduced below demonstrate the substantial similarities between the *CIII* three-track machine (left) and the *Piccoli* Patent's machine (right), as both machines are in a three-track paver configuration having forward and aft bolsters:



Ex. 2010 at 10 (Gomaco's *CIII* three-track machine (left)) (annotated); Ex. 2009 at FIG. 1 (*Piccoli* Patent's three-track machine (right)) (annotated). The above figures also demonstrate that the *CIII* machine is substantially similar to, and cumulative of, the *Piccoli* Patent's three-track machine that was considered by the examiner during prosecution. The *CIII* machine and the *Piccoli* Patent share at least the following features: (1) three-track paver configuration; (2) forward and aft bolsters; and; (3) legs attached to the forward or aft bolster. Because of the similarities and cumulative nature of the asserted art here and the art involved during examination, the first prong of the *Becton Dickinson* test is satisfied.

B. Petitioner has Not Alleged or Shown Material Error.

Turning to the second prong, *Becton Dickinson* Factor (c) concerns “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” *Becton, Dickinson*, Paper 8 at 17 (precedential as to § III.C.5, first paragraph).

The examiner issued a double patenting rejection over U.S. 9,708,020 (“’020 *Guntert* Patent”), which also falls within G&Z’s patent family and claims priority to *Guntert*. ’571 Prosecution History at 82-84, 91-93. Accordingly, the examiner extensively considered *Guntert* in the double patenting rejection as the ’020 Patent claims priority to *Guntert*. Significantly, the examiner did not issue any 35 U.S.C. §§ 102 or 103 rejections following the Applicant’s addition of new claims, thus, the examiner did not believe that either the ’020 *Guntert* Patent or the ’898 *Guntert* Patent qualified as prior art for an anticipation or obviousness determination. In other words, the examiner did not find that Applicant’s claims were obvious or anticipated on any statutory grounds by any earlier *Guntert* patent family member – obviousness-type double patenting is a non-statutory ground based on public policy, not based on 102 art. Furthermore, the record shows that the examiner accepted Patent Owner’s amended claims and found them to be patentable over the substantially the same references put forth in the Petition.

Importantly, even if the record of the Patent Office's previous consideration of the art is not well developed or silent, the "[P]etitioner may show the Office erred by overlooking factors (e) and (f)." *Advanced Bionics*, 2020 WL 740292, at *4. Nowhere does Petitioner show that the examiner overlooked any issues. If anything was overlooked it was by the Petitioner, not the examiner. In fact, Petitioner failed to recognize that the examiner considered the *Piccoli* Patent, which discloses a three-track machine that is substantially the same as the *CIII* machine, and the '898 *Guntert* Patent that shares the same specification with *Guntert*. Persuasive indeed is the examiner's consideration of the '898 *Guntert* Patent and the *Piccoli* Patent during prosecution, and the ultimate issuance of the '571 Patent over those references. Petitioner fails to demonstrate that the Patent Office made a material error as to the patentability of the Challenged Claims.

For at least these reasons, the Board should exercise its discretion under Section 325(d) to deny institution.

VIII. CONCLUSION

Petitioner has not established a reasonable likelihood that it will prevail in establishing that Claims 1-15 of the '571 Patent are invalid. Patent Owner accordingly requests that the Board deny institution of *inter partes* review of the '571 Patent.

Respectfully submitted,

Dated: February 25, 2021

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(Case No. IPR2021-00135)

Attorneys for Patent Owner

CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24.

The paper includes 8,002 words, excluding the parts of the paper exempted by § 42.24(a).

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

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the PTAB End 2 End system constitutes electronic service, service was made on the Petitioner as detailed below:

<i>Date of service</i>	February 25, 2021
<i>Manner of service</i>	Electronic Filing with the Board
<i>Documents served</i>	PATENT OWNER'S PRELIMINARY RESPONSE AND EXHIBITS 2001 THROUGH 2010
<i>Persons Served</i>	Jason E. Stach Luke J. McCammon David K. Mroz Sonja W. Sahlsten Robert K. High

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