

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.

IPR2024-00835 (Patent 11,535,318 B2)
PGR2024-00026 (Patent 11,772,723 B2)

Record of Oral Hearing
Held: August 20, 2025

Before ANNETTE R. REIMERS, HYUN J. JUNG, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

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The above-entitled matter came on for hearing Wednesday,
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Trademark Office, 600 Dulany Street, Alexandria, Virginia.

P-R-O-C-E-E-D-I-N-G-S

12:59 p.m.

JUDGE JUNG: Good afternoon. Please take your seats. I'm Judge Jung. With me are Judge Reimers on my right-hand side, and Judge Ippolito on my left-hand side. This is the oral argument for IPR2024-00835 and PGR2024-00026. In these proceedings, Petitioner, Gomaco, challenges all claims of U.S. Patent numbers 11,535,318, and 11,772,723. Both of those patents are owned by Guntert & Zimmerman. Starting with Petitioner's counsel, followed by Patent Owner's counsel, please state your names for the record.

MR. STACH: Thank you, Your Honor. Jason Stach on behalf of Petitioner. With me is David Mroz and Luke McCamon and Sonja Sahlsten, who are also part of the team.

JUDGE JUNG: Welcome to all of you.

MR. HANNAH: Good afternoon, Your Honors. James Hannah on behalf of G&Z. With me is Jeffrey Price, we're part of Herbert Smith Freehill Kramer, and also in attendance is Ron Guntert who is the CEO of G&Z.

JUDGE JUNG: Welcome to all of you as well. As we stated in our hearing order, each side has 30 minutes of total argument time for each proceeding. You can still reserve rebuttal time, but no more than half of your total argument time. To make the best use of our time together, for the IPR, I would like the parties to address Patent Owner's proposed interpretations, Petitioner's challenges if we adopted Patent Owner's proposed interpretations, and then finally nexus between the challenged

1 claims and Patent Owner's asserted secondary considerations. And with any
2 time remaining, you may discuss any other topic that you desire.

3 For the post-grant review, I'd like the parties to review eligibility for
4 post-grant review, and then the written description challenge, and then
5 similar topics for the obviousness challenges. With that said, have the
6 parties decided which proceeding they want to argue first? Mr. Stach?

7 MR. STACH: Your Honor, my understanding is that we will do the
8 IPR first.

9 MR. HANNAH: That would be our preference as well.

10 JUDGE JUNG: Okay. And, Mr. Stach, I noticed you have some
11 confidential information on your slides. I just want to verify, do you still see
12 a need to discuss any confidential information?

13 MR. STACH: No, Your Honor. If your questions do not raise it, I do
14 not plan to get into that today.

15 JUDGE JUNG: Okay, thank you Mr. Stach. And I'll also note that
16 Petitioner has objected to Slides 33 through 36, 38 and 40 of Patent Owner's
17 demonstratives in the IPR, and objected to Slides 30 and 35 through 38 of
18 Patent Owner's demonstratives in the PGR. Now, last couple of reminders,
19 please refer to demonstratives, papers, and exhibits by page or slide number,
20 and this proceeding is being streamed for the public for them to watch and
21 hear us. With that said, Mr. Stach, you may proceed when you're ready.

22 MR. STACH: Thank you, Your Honor. I plan to discuss the
23 secondary considerations arguments, while my colleague will address the
24 other points which I believe we raised. So I will turn it over to my
25 colleague, David Mroz.

1 JUDGE JUNG: Okay. One more thing. I saw some slides about
2 background and introductory material, you can skip those and just dive right
3 into your substantive arguments.

4 MR. MROZ: Understood Your Honor, thank you. Good afternoon,
5 Your Honors, and may it please the Board. I'm going to jump right to slide
6 8, which is the claim construction position, and our claim construction
7 arguments in response to G&Z's claim construction position. G&Z argues
8 that the claims in the '318 Patent are confined to on-the-fly steering designs
9 and embodiments. Yet, no claim in the '318 Patent has on-the-fly steering
10 limitation, claim language, no language at all requiring on-the-fly steering.
11 So there can be a machine that meetings the limitations of the claim, of any
12 claim in the '318 Patent that has an on-the-fly steering capability or has no
13 on-the-fly steering capability, but you can also have a machine that meets
14 the limitations of the claim that does have an on-the-fly steering capability.
15 It's an unclaimed limitation, it's not material to the analysis.

16 The point is, that because on-the-fly steering is unclaimed, it should
17 not impact the prior art that applies in the obviousness analysis. G&Z
18 contends that the preamble of Claim 1 confines the claim to on-the-fly
19 steering because of its description of a paving direction in laying concrete
20 while driving that pavement direction. G&Z argues that because the tracks
21 are on the ground during that paving process, you have to have the
22 subsequent limitation or the subsequent functionality of the claim applied
23 during that time. The problem with G&Z's argument, and the reason G&Z
24 is wrong is because it reads out an embodiment in the patent, a critical

1 embodiment. And to understand why, you have to understand the paving
2 direction orientation and the transport mode orientation.

3 So in the paving direction, we're driving one way, and in the transport
4 mode we're driving 90 degrees, perpendicular direction. So, the paving
5 direction is -- if you're driving the paving direction, you cannot be driving in
6 the transport direction, as G&Z's expert admits. So once we start there, their
7 argument falls apart, because Claim 4 depends from Claim 1 by virtue of
8 Claim 2. And it recites a swing leg that is configured to be disengaged from
9 at least one hinge bracket and the swing leg when the swing leg is positioned
10 in a transport orientation. So in Claim 4 we have a swing leg that is under
11 no actuator control, and the machine that is in a transport mode. G&Z's
12 argument can't be correct because Claim 1, if Claim 1 always required a
13 paving direction, it can never be in transport mode.

14 JUDGE JUNG: So, Mr. Mroz, you're saying that that paving
15 direction and transport direction are -- transport position is a species of
16 paving direction, they're not mutually exclusive?

17 MR. MROZ: No, they are mutually exclusive.

18 JUDGE JUNG: Then wouldn't that make these claims -- that would
19 cause a problem with these claims, is that correct? You can't have both a
20 paving direction in the preamble and then a transport position in another
21 dependent claim.

22 MR. MROZ: Exactly. The problem with these claims for G&Z is
23 that G&Z, under their construction, is trying to limit Claim 1 to a paving
24 direction only. It's trying to get the crawler tracks on the ground, because
25 then it wants to say, all these other limitations that fall after have to be done

1 on the ground as well. But that's not what Claim 1 requires, and we know
2 that because Claim 1 and Claim 4 -- in Claim 4 I should say, requires
3 something totally different than what G&Z describes for Claim 1. It requires
4 this transport mode, which G&Z's expert says is not the paving direction. It
5 is a different, mutually exclusive direction. The paving direction and the
6 transport direction cannot be the same, by their expert's own admission. So
7 because of that, the claims cannot be confined to moving forward in the
8 paving direction only.

9 In fact, you can have a situation in these claims where the machine is
10 stopped and the swing leg is lifted and pivoting in the air. Nothing's
11 stopping the claim from covering that embodiment either. When you read
12 the actual claim language that is relevant under G&Z's claim construction, it
13 looks a lot like the language in the claims of the '749 Patent that the Board
14 found unpatentable in the prior proceeding. And we have these claims here
15 in Slide 9. As you remember, the Board found these claims covered -- well,
16 they found these claims covered embodiments where the swing legs were
17 pivoted in the air, just like we're saying the claims can cover now.

18 So, one more point about the swing leg assembly in Claim 1, the
19 claim is directed to a swing leg assembly configured to be coupled to a
20 machine. So the claim can be met by a swing leg that's not even attached to
21 the machine. We can drop a swing leg here in the middle of the floor and
22 that could arguably read on the claims. It doesn't have to be attached to the
23 machine because of all the configured to language that's used throughout the
24 claim. This confirms that the direction of the machine and the way it's
25 moving, it's not material to the analysis under claim construction at all for

1 the '318 Patent. You know why they're trying to do that, they're trying to
2 get around the prior art. It's just, the claim language does not support that.

3 Moving on to the prior art -- and Your Honor, just for the planning
4 purposes, I'm going to try to go about 10 minutes, Mr. Stach's going to try
5 to go about 10 minutes, and we're going to leave 10 minutes for rebuttal, but
6 if you want to keep either of us for longer or shorter, we'll let you guide that.

7 JUDGE JUNG: Thank you.

8 MR. MROZ: For the power drive limitation, that's what, or the slew
9 drive limitation I should say, that's where G&Z places -- well, after you get
10 past the on-the-fly steering point, their only other point of distinction is
11 where you put the slew drive and how it operates. And in the IPR on the
12 '749 Patent, Gomaco presented the same base combination that it presents
13 now, which is the CIII Rio combination. We applied Rio's slew drive and
14 it's sensed, actually. Well, we applied Rio's slew drive and its sensor
15 driven control system to the CIII machine and explained why these
16 modifications would have been obvious. And more specifically, regarding
17 the slew drive in the prior proceeding, we argue that it would have been
18 obvious to connect Rio's rotary drive on one side to the bottom of the
19 jacking column, and then on the other side, to the top of the crawler track
20 apparatus. And then because of that design, it follows, and we argued, that
21 the crawler track rotates relative to the components in the jacking column,
22 which are all rotationally fixed.

23 The Board found it was obvious to arrive at this design, in the '749
24 proceeding. The Board concluded, and this is a quote, and this is on Slide
25 21, "we find that Rio does not limit the position of rotary actuator 44, which

1 steers the crawler track, to the top of its lifting column. Rio expressly
2 discloses that rotary actuator 44 can be located on lifting column 46 along
3 axis 48. This express disclosure would include positioning actuator 44 and
4 lifting column 46 at the bottom of the column.” The Board went on to state,
5 or to conclude, positioning the actuator at the bottom of CIII jacking column
6 would simplify the jacking column’s design, because, the guide tubes would
7 no longer need to rotate relative to the outer cylinder. That’s on pages 74
8 and 75 of IPR -- of the final written decision in IPR2020-01698.

9 These findings about the CIII Rio combination are what G&Z is
10 trying to undo by relitigating the motivation to combine. The Board found it
11 would have been obvious to combine CIII and Rio and to do so in the exact
12 way that Gomaco proposed. That is to have the rotary drive sandwiched in
13 the way I described, and the rotational movement the way I described, the
14 relative rotational movement. And once you get to that place, with
15 Gomaco’s prior art combination, G&Z’s arguments fail. Gomaco presents
16 the same obviousness combination it presented before, and that combination
17 reads directly on the claims in the ’318 Patent as well, which while they use
18 different language, substantively require that same design that we proposed
19 in the prior proceeding, and that we propose now.

20 I’d like to address another point that G&Z raises throughout its briefs,
21 or papers, I should say, and it’s the argument that a person of skill in the art
22 wouldn’t combine the CIII and Rio, because Rio and CIII use turn buckles.
23 We argued in the last proceeding the turn buckle point, we argue it again
24 now. And the Board already concluded, as I said, that a person of skill in the
25 art would have combined CIII and Rio, despite these arguments in the past.

1 And I want to add to this now, what we mentioned in our papers this
2 proceeding, that turn buckles are often used on road construction machines.
3 They're used to lock things in place. They are often replaced on road
4 construction machines with hydraulic actuators. They're used in prior art,
5 Rio, CIII. They're used in G&Z's patent.

6 So G&Z's own patent, we discussed this in our reply brief on page 20,
7 it says further, if desired for example for cost reasons, hydraulic actuators
8 can be replaced with turn buckles. And that is at column 10, lines 3 through
9 9 in the '318 Patent. So, the point I wanted to make here is that turn buckles
10 and hydraulic actuators aren't mutually exclusive in these machines.
11 They're routinely used. They're routinely used interchangeably. If you
12 want to lock something, you can use a turn buckle. If you want to have
13 something move, you can use a hydraulic actuator. But on top of that, Rio's
14 even better, because Rio explains that if you want to use a hydraulic
15 actuator, there's an anti-swing mechanism that locks -- you use a hydraulic
16 actuator to lock the swing leg, that you can then release to do the pivoting
17 and the coordinated steering.

18 So I bring this up because that argument they make is wrong. It
19 doesn't survive Rio, it doesn't survive what a person of skill in the art would
20 think, and they use it throughout their briefs. I think they emphasize it more
21 in this proceeding than the last proceeding, which is why I wanted to address
22 it more specifically. And unless Your Honor has some questions at this
23 time, I'll pass the --

1 JUDGE JUNG: Just one last question. If we adopted an
2 interpretation that required on-the-fly steering, does CIII and Rio reach that
3 embodiment?

4 MR. MROZ: It does. So, CIII and Rio, so I'm going to point you to
5 the Rio disclosure. Give me one second. Okay. So, there's a finding from
6 the Board, I want to make sure we cover this. There was a finding from the
7 Board in the final written decision of the '749 Patent, page 59, that said Rio
8 discloses that sufficient torque can be generated to rotate the crawler track
9 both when engaged with the ground and raised off the ground. So in Rio, we
10 have the coordinated steering and pivoting that happens when the leg is off
11 the ground. We also know that Rio has on the ground capability of using a
12 rotary actuator or slew drive to steer the crawler track. And a person of skill
13 in the art reading that would know that Rio can do on-the-fly steering, it
14 would be obvious to do that. And have Dr. Singhose explaining, this is
15 Exhibit 2008, pages 11122 through 11225. He testifies that Rio discloses
16 that you can steer the crawler track, back and forth which you're driving.
17 He then testifies that Rio doesn't specifically say that, you can also swing
18 the arm. But the controller there is sitting there ready to do it. If you give a
19 command, it will try to do it.

20 So the point is, you have, you're on the ground with Rio with a rotary
21 actuator slew drive, if you run the same control program that you run when
22 it's up in the air, you have the mechanism to design that, to do that. A
23 person of ordinary skill in the art would know that you can change the
24 torques, whatever you need to do, it would be obvious to make those
25 changes. As their witness from the last proceeding, Dr. Nelson said, it's just

1 a matter of math that a person of ordinary skill in the art would do. And you
2 remember Dr. Nelson himself testified was using his skills in smaller design
3 products to apply them to larger products, and he said the math is the same
4 when you're doing that.

5 JUDGE JUNG: Thank you.

6 MR. MROZ: Thank you.

7 MR. STACH: Thank you, Your Honors, and may it please the Board.
8 So, focusing on nexus as you mentioned, G&Z contends that Gomaco failed
9 to rebut G&Z's arguments of nexus. And to some degree, looking back at
10 our Reply, I can see why they make the argument. It's a very short section
11 called nexus, however, if you look at each of the individual secondary
12 considerations and the sections there, we do address nexus in each one of
13 those. And so, for example if you look at praise on page 23 of our Reply,
14 we talk about how they have cited to Exhibit 2014. And how in that exhibit,
15 it actually talks about features other than the SmartLeg and AccuSteer
16 features, it talks about TeleEnds and VariWidth and NoLine and so forth.
17 And the Board had already looked at this exhibit in the prior '749
18 proceeding, and had concluded that because there are these other unclaimed
19 features that are touted as significant, they're marketed sort of with equal
20 billing as these other features, that the Board had found that it somewhat
21 limits the nexus to the claimed invention.

22 So, this is all in our Reply. We did something similar here with
23 copying in our Reply at 22, we said there's no nexus, because a lot of these
24 allegedly copied features are not present in the claims. Things that they had
25 identified about frame widening, a paving kit, a front tie bar inserter, a

1 dowel bar inserter attachment, these are unclaimed features that they're
2 trying to rely on. And there's just no nexus then to the claims, because they
3 are unclaimed.

4 For long felt need, we had talked in our Reply on pages 18 to 19 that
5 there was no nexus there, because the claims do not cover the on-the-fly
6 embodiment that they're talking about, but even if it had, you cannot rely on
7 advantages that were already in the prior art as a basis for establishing
8 secondary considerations and using that as the nexus. And so we made that
9 argument regarding long felt need. We said essentially the same thing for
10 skepticism on pages 19 to 20 in our Reply, and then for commercial success,
11 we saw in the prior case -- that's actually very similar to praise, where there
12 are a number of additional features on these machines that may have driven
13 the sales of those machines. G&Z hasn't really isolated and shown that the
14 success was related to what they're calling the on-the-fly steering feature.

15 And the Board made specific findings in the '749 case related to
16 nexus because of those additional features. And obviously, we also on top
17 of that have argued collateral estoppel. There are estoppel implications. I
18 think, collateral estoppel I think applies broadly to secondary considerations,
19 but maybe most strongly to commercial success and to copying, because in
20 those instances I know G&Z is arguing that well, the claims are different
21 here. And I think if you look at the arguments for commercial success and
22 then for copying, for copying for example, the question is, did Gomaco copy
23 a G&Z machine? That's really, it's less tied to the claims. It really is the
24 same question here as they litigated before, and so that's why we think
25 estoppel applies there.

1 Same deal with commercial success. They're really raising -- it's
2 virtually identical. Same chart. I mean, you're probably familiar, having
3 looked back at it, it's the same exact market chart and so forth. Although
4 here, the evidence is even weaker than in the prior case, the '749 Patent,
5 because some of the evidence that they presented on commercial success, in
6 the prior case they presented as declarations, and here they present the exact
7 same documents, they have the perjury attestations, they have the signatures
8 of the witnesses, but they don't provide the witnesses. They say well, we're
9 submitting them as reports now, not as declarations. So, if anything, even
10 though maybe the same exhibits are in the case, it's actually even weaker
11 now because there's no witness backing up some of the things that they're
12 saying. So, I don't know, does that address your questions on nexus, Your
13 Honor?

14 JUDGE JUNG: Yes. I'm just kind of curious, because the nexus
15 evidence here is slightly different from the prior case, I wanted to see if you
16 thought that that changed secondary considerations at all from your point of
17 view. But it seems like, I think, it makes hardly any difference at all.

18 MR. STACH: That is definitely my argument. I don't think it
19 matters, the differences. And there's more similarities than there are
20 differences, and then we'll talk about it maybe more in the PGR, but it's
21 even more deficient there, the arguments are even thinner that G&Z raised.
22 But for the most part, their case is essentially the same, and there's not a
23 single new document.

24 For example, on copying, you know, in the prior case we had lots of
25 development documents about how did Gomaco develop this invention?

1 And the Board found it was the product of routine engineering processes.
2 And there was quite a lot of information in that case, and here, there's far
3 less of that information. Really, their case is actually thinner in a lot of
4 ways. You mentioned it's a little bit different, and I know they're trying to
5 take another swing at it and hoping there's no collateral estoppel, they're
6 trying to take a different approach than the one that had failed in the past,
7 but we don't think that -- I mean, I think collateral estoppel exists to bar this
8 re-litigation point. But the things that they've changed don't really move the
9 needle at all in this issue.

10 JUDGE JUNG: Okay, on the topic of collateral estoppel, you would
11 agree that whether we apply collateral estoppel or whether we go through
12 the analysis, it's probably better that we just do the analysis and maybe
13 forgo application of collateral estoppel, because there could be some
14 problems with actually applying collateral estoppel to this case.

15 MR. STACH: I understand, Your Honor. I guess -- yeah, if I were to
16 envision an ideal final written decision, I would like to see collateral
17 estoppel be mentioned at least for some of the elements. Certainly copying,
18 commercial success. There are other areas that I know we've argued as well
19 that I think it applies. I would love to see that partly because, as you know
20 from the last cases, there's no continuations that we're talking about today
21 with you all. They have other continuations potentially pending. It would
22 be -- I don't want to have Groundhog Day with later continuations, so I do
23 think a collateral estoppel finding is warranted and would be helpful, at least
24 in very specific areas, if not for everything. But then separately, but even if
25 we didn't apply collateral estoppel, here is the analysis. And it very much

1 mirrors the analysis from the '749 at that point, I believe, and that's what, in
2 my view, an ideal final written decision would look like.

3 JUDGE JUNG: Thank you, Mr. Stach. That's all I have. Do you
4 want to reserve the rest of your time for rebuttal, or are there other topics
5 you want to address?

6 MR. STACH: I guess the -- just two quick points. One is that in the
7 IPR, the Holley declaration was not of record, it was never submitted, and
8 they do mention it in their Sur-reply for the first time, but they knew
9 apparently, they're not allowed to submit new evidence with the sur-reply.
10 The Board's rules prohibit that, unless it's a deposition transcript of a cross
11 examination of a reply declarant. So what they did instead is, they cited it
12 for the very first time in their Sur-reply, but they just cited back to the '749
13 IPR and made arguments based on it. And so we think that's not an
14 appropriate use of a sur-reply, it's an end run around the Board's rules, we
15 think.

16 And they did something similar with the transcript from the '749, one
17 of the arguments there. That same issue applies, but more than anything on
18 that one, they're trying to say that I admitted that the need arose in the early
19 2000s for this technology, but when you look at what I actually said, I
20 mentioned the year 2009 twice in that discussion, and I said Rio was ahead
21 of its time in 2005, because the need -- the words I said, it wasn't until 2009
22 that people even really started caring about this. That was in the exhibit that
23 they cited. So, I don't think it was appropriate that they cited it for the first
24 time in the Sur-reply, but even more so, I take issue with the characterization

1 of that, and so I figured I'd mention that. So with that, unless you have
2 questions about either of those things, I would --

3 JUDGE IPPOLITO: Counsel, I just have one point of clarification.
4 So as you were talking about collateral estoppel you mentioned
5 continuations in other cases, and I just wanted to make sure I understand
6 your position. Are you saying that our discussion of collateral estoppel --
7 that your position is that our discussion of collateral estoppel needs to be
8 expansive? I understood from your briefing that it was specific to this one
9 patent at issue in our case, but from what you just said it sounds like you
10 would want it to apply broader. I just want to make sure I understand what
11 the ask is.

12 MR. STACH: Thank you, Your Honor. No, I do not intend for it to
13 be broad, in any broader pronouncement than the patents at issue in this
14 case. I just think there could be a deterrent effect. If there is a finding of
15 collateral estoppel, that you had your chance on copying, for example, we
16 don't need our client's name dragged through the mud, and yet a third
17 proceeding on something they should be estopped on. If there were a
18 finding of estoppel in this case, it might have a beneficial, from our
19 perspective, effect on, if there is a next case, it may narrow the issues as we
20 think is appropriate under the law. But no, we're not asking for a broad
21 pronouncement, we're asking for a very specific one that's related to this
22 case.

23 JUDGE IPPOLITO: All right, thank you. It looks like, from where
24 I'm sitting, that you've got seven and a half minutes left for rebuttal.

25 MR. STACH: Thank you, Your Honor. That makes sense to me.

1 MR. HANNAH: Just give me one second, if you don't mind.

2 JUDGE JUNG: No problem.

3 MR. HANNAH: All right. Thank you, Your Honors. May it please
4 the Board, James Hannah on behalf of G&Z. First of all, I would like to say
5 thank you. Thank you for your attention to these matters. These patents
6 mean a lot to my client, Mr. Guntert here. G&Z is long recognized as an
7 innovator in the space, and as you probably have gathered based on the
8 evidence, innovation is tough to come by in this space. And we count on
9 having this IP to protect his innovations, so that the industry can advance.
10 So I thank you for your consideration in looking at these issues.

11 So, jumping right into the arguments and addressing Your Honors --

12 JUDGE IPPOLITO: Counsel? Can I just stop you and ask if you
13 wanted to reserve time for rebuttal?

14 MR. HANNAH: Oh, I'm sorry. I'll do ten minutes as well. Thank
15 you.

16 JUDGE IPPOLITO: Okay, thank you.

17 MR. HANNAH: So, I'm on Slide 3. And your Honors that are
18 remote, can you see the slides as I project them? Okay. But I'll try to say
19 the numbers --

20 JUDGE IPPOLITO: Yeah, you should say the slide number because
21 that won't be in our transcript otherwise.

22 MR. HANNAH: Yeah, I'll try my best. That's probably one of the
23 things that I struggle with. But anyway, jumping straight into the arguments
24 here. So, you know, we have Commander III and Rio are the two main
25 references, and in terms of the arguments, there is no suggestion that you

1 have a rotary coupled -- a slew drive that's coupled to both a fixed jacking
2 column and the crawler track. And that is one of the constructions, as Your
3 Honor said, and we'll come into the support for that. But based on the
4 record, and as I'm sure you reviewed, that is largely undisputed. We didn't
5 even really see any rebuttal to that construction in their Reply, saying that
6 the slew drive has to be connected both to the jacking column, and it has to
7 be connected to the crawler track, and the jacking column has to be fixed.

8 That knocks out the prior art right there, based on the claim
9 construction, because CIII, you rotate the jacking column. You have to.
10 Rio, you rotate the jacking column. All of the state-of-the-art references that
11 they point to either have a rotation of the jacking column, they don't have
12 swing legs, so they don't even have a jacking column. So none of the prior
13 art has that fixed jacking column, and I think that when you look back
14 through the record you're going to see that they don't even really address
15 that issue in their papers. Your Honor?

16 JUDGE JUNG: I just wanted to make sure I understand your
17 argument, because it seems like Petitioner's proposed combinations would
18 get you there. You would have a slew drive somewhere along the jacking
19 column, and in particular it'd be at the bottom of the jacking column, and
20 then it would then in turn connect to the crawler track, which would then
21 make the crawler track rotate independently of the jacking column. But it
22 seems like you're concentrating too much on Rio and not on the actual
23 proposed combinations, so is there something I'm missing in your argument.

24 MR. HANNAH: Sure. So, for the proposed combination you're still
25 going to have a rotating jacking column, right? CIII, even you if you

1 combine it, rotates the jacking column. So if you put some type of actuator
2 along the axis, wherever you want to put it, what the state of the art taught
3 you was, you need to have enough torque to turn a crawler track. In order to
4 do that, you turn the piece of the jacking column. And what we showed with
5 that was PM 102, right? Now, Petitioner completely ignored this evidence
6 in their Reply. Completely ignored it. And we point that out in our Sur-
7 reply. Remember. PM 102, that is the machine that Rio was based off of.
8 You could not turn the crawler track while it was on the ground. The only
9 embodiment of this real-world experience to turn it was with wheels. You
10 had to have a wheel to turn it, to have a sufficient torque. So even if you
11 combined that with CIII, that's teaching you to turn the jacking column in
12 order to turn any type of crawler track. So, that's the point there Your
13 Honor. That's why they had to point to the state of the art.

14 JUDGE JUNG: Well. Mr. Hannah, given what Rio teaches and what
15 102 teaches, Petitioner's combination is still to put that rotary actuator at the
16 bottom of the jacking column, and their argument is that one of ordinary
17 skill could figure out how much force that would require and how big a
18 rotary actuator you would need to accomplish that, the rotation of the
19 crawler track. So it seems like your argument is kind of missing the point of
20 the proposed combination.

21 MR. HANNAH: Well, what they point to is Whitaker, right?
22 Whitaker, using your example, is going to be toward the bottom, but it still
23 rotates the jacking column. There's no suggestion in the art that you're
24 going to keep that fixed, and that's part of the innovation that Mr. Guntert
25 came up with. This advancement in the industry was that we can actually

1 keep the jacking column fixed and just rotate the crawler track, versus the
2 man hours we spent to jack up these two heavy machines and turn it. So
3 when we're talking about the combination, you have to look at all aspects.

4 JUDGE JUNG: Counsel, I'd like you to expand on that point. That
5 last point about when you put the rotary actuator at the bottom of the jacking
6 column, you're still rotating part of the jacking column. Why is that?

7 MR. HANNAH: Because you need the torque in order to do it.
8 That's what the prior art teaches you. In order to have sufficient torque, you
9 need to be able to rotate the bottom tube of the jacking column. And this is
10 as discussed in the record, some of the problems that G&Z had to overcome
11 is that they had these huge torque forces, and that's why nobody was doing
12 the slew drive on the bottom, was because it didn't have --

13 JUDGE JUNG: Let me just refocus your argument.

14 MR. HANNAH: Sure.

15 JUDGE JUNG: I understand the position is that the rotary actuator
16 has to rotate the bottom portion of the jacking column, but their combination
17 is to put the rotary actuator at the very bottom of the jacking column. So
18 how is that still rotating the bottom of the jacking column?

19 MR. HANNAH: Because you still have the fixed connection between
20 the air tube that's going into the crawler track. And none of the prior art
21 says that you separate those two. That's the point. You look through all
22 those references, the only thing that we have is their expert, the say so of
23 their expert, which we know that general knowledge is not cutting it these
24 days. And so, that's the only thing that we have to point to. Nothing in the

1 references say that you can separate those and fix the jacking column on the
2 bottom.

3 And then, Your Honor, I just want to highlight that everyone agreed,
4 POSITA, for these proceedings, you have to have industry experience. You
5 can't ignore -- you can't just take the paper copies of Rio or CIII and ignore
6 what's done in the field. And by ignoring that evidence all together, it's
7 their burden to prove that that evidence is not reliable or shouldn't be used,
8 but they've ignored it all together, so it's left unrebutted.

9 JUDGE JUNG: But your arguments are really directed at reasonable
10 expectation of success, not the actual combination itself, it sounds like.

11 MR. HANNAH: I think it's both. I think it's both a reasonable
12 expectation that it would work, that's just having the knowledge -- I like
13 what we said in our Sur-reply. In our Sur-reply, we stated that it's not only
14 the knowledge that you have in the skill in the art, but it's going to be all of
15 the relative industry experience that you have that goes along with that. And
16 I think that's really important, is that when you have a case involving heavy
17 machinery pavers, you need to look at what's actually being done in the
18 field, boots on the ground, and how people are trying to overcome these
19 certain problems. And this is one of the issues that they overcome.

20 The other thing is, to your point is, these references, the state of the
21 art, the, state of the art, they don't address -- they're from a different field
22 and address a different purpose all together. We point that out in our
23 briefing. They're not about having these large machines that would have to
24 -- that before didn't move. They went straight. If you wanted to move
25 them, it took days, it took a full day to move it. Now, you can move those

1 machines. Well guess what? All the machines in the market are able to
2 move now, after G&Z came out with that. If you don't have a machine that
3 can move, you're not going to sell it. You're simply not going to sell the
4 machine because now this is the state of the art, after we came out with it.
5 And that goes to the secondary considerations and everything else.

6 So that's for the fixed jacking column, and when you look at the
7 evidence you're going to see that there's no evidence of the fixed jacking
8 column no matter how you do the combination. It's only the testimony of
9 their expert and the general knowledge, which doesn't cut it these days. The
10 second is, the on-the-fly steering. The patents, the claims, were amended
11 from the '749, and now contain specific limitations that have the processor
12 that is going to be configured to have certain signals, that is going to react,
13 and it goes to a second angular rotation versus just going straight and trying
14 to maintain the direction. Also specifically calls out that this machine is
15 moving.

16 And now, you asked counsel, well what about Claim 4, and are those
17 mutually exclusive? I can tell you that you can't transport -- I mean, you
18 can and do pave in the transport direction. I confirmed that with Mr. Guntert
19 as he said it, because I turned around and said, based on my understanding,
20 you can absolutely pave in the transport direction, and they do it all the time.
21 So, Claim 1 and Claim 4 are not mutually exclusive, and not with the
22 transport mode. So, having on-the-fly, Rio and CIII absolutely do not teach
23 having moving in the paving direction under load. CIII specifically says,
24 you've got to raise it up, right?

1 JUDGE JUNG: Mr. Hannah? I just want you to address a specific
2 point, that when the paving machine is in the transport position, it could also
3 be not on-the-fly, right? You could also steer it while it's not on-the-fly in
4 the transport position.

5 MR. HANNAH: Can I steer if it's not on-the-fly? I think in Claim 1
6 --

7 JUDGE JUNG: Actually, rotate the crawler track when it's not on-
8 the-fly in the transport position.

9 MR. HANNAH: I mean, can you in general? I think, I mean, I think
10 in general there's descriptions of that in the Specification, but as we get to,
11 Claim 1 is limited to on-the-fly. You have to --

12 JUDGE JUNG: Petitioner's point is, the transport position can be
13 interpreted to include the embodiment where you rotate the crawler track
14 when it's not under load and it's not on-the-fly, then the paving direction
15 would also include an embodiment that's not on-the-fly.

16 MR. HANNAH: But that doesn't take away from what Claim 1
17 requires. Claim 1 requires a specified function, because this says configured
18 to, and you have to be able to do it under load, on-the-fly. That's what
19 Claim 1 requires. If you look at Claim 4, it says that you have a hydraulic
20 actuator that can be disengaged, that is configured to be disengaged, but that
21 doesn't take away from the fact that you have to have a paving machine that
22 can be configured, that can be -- if you move on-the-fly and under load.
23 Claim 4 can't take away from Claim 1, and that's what it sounds like they're
24 trying to do. You still have to have the limitations in Claim 1.

25 JUDGE JUNG: I'm going to try to ask this a different way.

1 MR. HANNAH: Sure.

2 JUDGE JUNG: We agree that the claims include an embodiment that
3 includes the on-the-fly steering. Why does it also exclude embodiments that
4 are not on-the-fly?

5 MR. HANNAH: Because if it's on-the-fly and configured to go and
6 steer on-the-fly, then you have to, in order to infringe, as we actually pointed
7 out, you have to have a machine to do that, that does that. And that's what
8 the prior art has to show. And so, if you have a machine that had to be
9 picked up and couldn't move on-the-fly, you don't infringe Claim 1. And so
10 that's why it excludes --

11 JUDGE JUNG: What language of the claim would exclude the
12 embodiments that are not on-the-fly? What description in the Specification
13 would exclude embodiments that are not on-the-fly?

14 MR. HANNAH: Sure. So for Claim 1, I would point to the fact that
15 it says that it's configured -- and I'm looking at Slide 5 now, which is the
16 claim language of the '318. And what it says is, you have a paving machine
17 that's configured to move in a paving direction, right? And then you have a
18 series of limitations about how that machine is going to be, what it's
19 configured to do, so it has to have that operation, that ability to do that.

20 And then we get into the, what the processor is. We point this out in
21 our briefing as well. It says that it has a processor configured to receive
22 these signals and determine a change of the first angular orientation based on
23 the first signal. If it's not moving, it can't determine what the change in the
24 signal is. It has to be done under load. And then in response to that change,
25 it determines a target second angular orientation. If it's just -- if you pick it

1 up and you don't do anything with it, it's not moving in a paving direction,
2 it's not targeting its target second angular orientation. And then, you have to
3 send the control signal to the slew drive to cause it to go to that second target
4 orientation, angular orientation. And so that's telling you, to one of skill in
5 the art, that it's moving. As you're going, you're seeing an obstacle that's in
6 your paving direction, and you're moving around it. So, I think all these
7 limitations are really directed to this on-the-fly. And I think it gets even --

8 JUDGE REIMERS: So, Counsel, I have a question. So, that
9 limitation there in Claim 1, particularly the sending a control signal to the
10 slew drive in order to cause the second angular orientation of the crawler
11 track to rotate to the target second angular orientation, is your position that
12 that particular limitation would be an indication of the on-the-fly that you're
13 talking about?

14 MR. HANNAH: Yes, absolutely. In conjunction with the preamble,
15 which is saying that this is a paving machine that's directed to moving in a
16 particular direction. And so all of these -- I mean, it doesn't make sense to
17 have a machine that's standing still that you pick up and I'm determining
18 different angles. It's talking about moving in the direction, determining the
19 angles and trying to go around these different obstacles. And that's what --
20 Your Honor asked specifically, where's that in the Specification? We had
21 pages of that in our briefing, especially in our Patent Owner Response. But
22 even a couple of those, you know, are here on Slide 12, where it talks about
23 how it's oriented in going into a paving direction, and that's when you
24 determine the angular orientation of the swing legs and the crawler track.
25 And we continue on.

1 Also, this was distinguished in the prosecution history of a related
2 patent. As you probably saw, the '020 Patent, which is the '811 application,
3 just preceded the '318, and you know, the Petitioner takes issue with this
4 saying oh, this is related to the rotating, the rotation. I just want to point
5 your attention to this last line, and this is Slide 14, it says, such immovable-
6 during use bolted/pinned structures and time-consuming efforts required to
7 reposition jacking columns of such a paving machine is in part what the
8 presently claimed invention specifically overcomes. I mean, it says it. And
9 so, it says that these immovable bolted/pinned structures -- and that's exactly
10 what CIII is, by the way. An immovable, bolted, pinned structure. And so, I
11 would say not only the Specification but also the prosecution history
12 supports that.

13 JUDGE JUNG: Mr. Hannah, I just want to ask a quick hypothetical.
14 We have the claimed machine, it's paving, and then it runs into an obstacle,
15 so the crew decides to take lunch. And when they come back from lunch,
16 before they start the machine back up, they just adjust the crawler track so
17 it'll start moving around the obstacles, and then they start eh machine. And
18 they start moving around the obstacle int eh paving direction again. Is that,
19 number one, on-the-fly, and number two, does that exclude it from the
20 claim?

21 MR. HANNAH: I would say that's absolutely not on-the-fly. First of
22 all, it'd take an entire day to do it.

23 (Simultaneous speaking.)

24 MR. HANNAH: -- right. Not just lunch, it should take an entire day
25 for them to move and pin, and un-pin and the machine and all that.

1 JUDGE JUNG: Using your claimed rotary actuator.

2 MR. HANNAH: I'm sorry?

3 JUDGE JUNG: Using your claimed rotary actuator.

4 MR. HANNAH: So, but you still have to pick it up. Pick up the
5 machine is the thing that --

6 JUDGE JUNG: But you just told me you don't have to pick it up, you
7 can just turn it on-the-fly, right?

8 Mr. HANNAH: Oh, I thought you said that you left lunch -- so
9 maybe I'm missing the hypothetical.

10 JUDGE JUNG: Your claimed machine, this S600, for example.
11 You're paving in one direction, you see an obstacle, so the crew decides to
12 take lunch, and when they come back they adjust the crawler tracks to avoid
13 the obstacle. They start the machine back up and start paving again.

14 MR. HANNAH: So maybe what I'm missing is, you're saying you're
15 shutting down the machine? Then I would say that's not on-the-fly.
16 Because that to me, is if you shut down the machine, then you're not able to
17 adjust the crawler track and do things like that. Like that goes back to taking
18 the half day, day, to actually pick up and move and unlock and do all the
19 stuff before.

20 JUDGE JUNG: At that point, is the machine, the claimed invention
21 no longer covered by the claim?

22 MR. HANNAH: I would say that machine that's being shut down in
23 order to move around an obstacle is not covered by the claim because it's
24 not moving in a paving direction and detecting those angles and moving on-
25 the-fly.

1 JUDGE JUNG: Okay. Thank you, Mr. Hannah.

2 MR. HANNAH: I know I'm going a little bit into my rebuttal here,
3 but --

4 JUDGE IPPOLITO: Counsel?

5 MR. HANNAH: Oh, go ahead.

6 JUDGE IPPOLITO: Yeah, Counsel, I think I need a little point of
7 clarification. So your response to the hypothetical also sort of highlights one
8 of the questions I have had with this claim and your position, which is that
9 on-the-fly means a specific thing to you. It seems like there is a duration
10 component, there's a movement component and a specific way of moving,
11 and I'm looking at the language and it says the processor is configured to do
12 something. So, if the processor is configured to do something but it doesn't
13 necessarily do that in one iteration, are you saying that then the entire device
14 does not then fall within the claim scope?

15 MR. HANNAH: I think what it is, is the configured to language is
16 something that's known. And you have to demonstrate that it has the
17 purposeful design that achieves the specific function, and it's not just mere
18 capability. So by having the configured to language for the processor and
19 for what the machine has to do, that has to have a purposeful design to
20 achieve the specified function of moving around these obstacles. And so, if
21 you had a machine that you could move around an obstacle and not invoke
22 these different angular, you know, detecting of these different angles and
23 things of that nature, and maybe it had the mere capability of doing it, then I
24 think that that falls outside. I think that it has to have -- like I said, the
25 purposeful design, and it has to achieve a specified function. That's what

1 configured to means, and that's generally understood, you know, in patent
2 law.

3 JUDGE REIMERS: Right, and I would agree with that, Counsel.
4 Getting to Judge Ippolito's question, I too had the same thing of, what it is
5 that you're interpreting to be on-the-fly. That's why I asked you about that
6 particular limitation in Claim 1, of sending the control signal. Because then
7 it says, in order to cause the second angular orientation of the crawler track
8 to rotate. So, causing something to rotate, is that what you mean by on-the-
9 fly? The ability to do that is indicative of being on-the-fly? That's what I'm
10 trying to understand, because obviously on-the-fly is not in the claim. So,
11 I'm trying to understand what it is, what you mean by that.

12 MR. HANNAH: One hundred percent, that's exactly what it is.
13 That's absolutely part of it, and that's what I was saying, in conjunction with
14 this moving in the paving direction. So it's moving in a paving direction,
15 you have a control signal that causes it to do a second angular orientation, to
16 go around an obstacle, for an instance, and so that's on-the-fly. As you're
17 moving in the paving direction you're giving these control signals. And
18 that's why, to the extent I'm fully understanding the hypothetical, if you go
19 on lunch and you move the machine and do all this, that's not on-the-fly,
20 because you're not causing it to go to a second orientation while it's moving
21 in the paving direction. Because the hypothetical said to shut down the
22 machine. And so -- but yes, that is one of, and it's very specific saying that
23 it causes the machine and the crawler track to do that.

24 I'm running a little bit out of time here, so I just want to address a
25 couple of issues specifically with regard to both of these claim constructions

1 and how they apply to the prior art. I think we already hit the jacking
2 column, the fixed jacking column. We state on Slide 19 that the CIII and
3 Rio only disclose the rotation and there's actually nothing in the art that
4 would satisfy that or help that with regard to any state of the art. The next
5 one I wanted to point to, and then we have several arguments about the
6 hindsight bias, but you can look at our briefing for that.

7 But for the on-the-fly, I think it is relevant to point out that the only
8 elements, the only art that they point to, right, for the on-the-fly saying that
9 it's part of the state of the art, because that's the only thing they can point to.
10 CIII can't do it, because you've got to pick it up and move it, Rio can't do it,
11 because it has an anti-arm swing, that you can't move the thing. So they had
12 to say okay, state-of-the-art. The only thing they point to is page 15, on
13 page 15 of their Reply, footnote 2. And they say our expert admitted that
14 cranes, people-movers, and agriculture equipment were analogous art.

15 I would like -- you know, I would encourage you to look at what he
16 actually said. If you look in the record, and what our experts said, just above
17 their quotation, in 22 to 29:1, and this is Exhibit 1184, he specifically says
18 he's been part of tons of design reviews. And he has never, ever had
19 someone look to a crane when they're trying to see for design choices for
20 farm equipment, or farm equipment to a crane, and things of that nature. So
21 what did counsel do? They pivoted, and they said okay, what would you tell
22 your students to do? Well, first of all, students are not one of skill in the art.
23 So that whole line of questioning goes away. Whatever he said about what
24 he would tell his students to do is irrelevant.

1 If you look after that quotation, then he goes, I'd even tell my students
2 to look at chairs, because the hypothetical he gave him was not about
3 analogous art and whether it performed a specified function, it was about
4 what would you tell your students to do in general? And as a professor,
5 that's what he said. You eliminate that quotation, that page 15, footnote 2,
6 they have zero argument about analogous art. And that makes sense. I
7 mean, what are we doing here when we're looking at cranes, people-movers,
8 and agriculture equipment for trying to solve problems with paver
9 machines? One of skill in the art using common sense, even, you're not
10 going to be looking at these completely different things that are from
11 different fields and have different purposes.

12 And finally, I want to touch a little bit on the nexus. I'll try to save
13 three minutes for my rebuttal. But in terms of the nexus, I think counsel
14 already said it for me. They ignored it. They ignored it in their Reply, they
15 didn't even address it. It was un rebutted. And then trying to point to
16 copying and long felt need and all these other things. We had a specific
17 section on it. We addressed exactly what nexus required. We filed a claim
18 chart on it, and then it was ignored. And so them pointing to other portions,
19 I don't think satisfies what's required under the rules in order to prove
20 nexus. And then based on that and based on the on-the-fly and how these
21 positions, all the secondary considerations come into effect, including the
22 copying, which was done in a different context, because in the last
23 procedure, they said you didn't show that they actually had access to the
24 show, the 2015 show. We proved that we saw that. We had the praise that
25 are specific to the embodiments now. And so all of that now comes back

1 into account. So with that, I'm going to try and save my last couple minutes
2 for rebuttal, unless you have questions.

3 JUDGE JUNG: You may proceed.

4 MR. MROZ: Thank you, Your Honor. Going to Slide 8 first to
5 address the claim construction argument. First, that it was improper to add
6 thoughts from a witness in the gallery about what a paving direction is and
7 what transport direction is. Let's look at what their expert said. He said --
8 and this is Exhibit 1184, the Bryden deposition transcript, page 147, line 21
9 through 148:20. He was asked about this issue, about paving mode versus
10 transport mode. He was asked about Figures 8A through 8E, which is where
11 in the patent it describes the transition from paving mode to transport mode.
12 He talked about that a lot. And he concluded by saying, whenever the
13 machine is in the transport position it is not driving in the paving direction.
14 So that's the first point.

15 The second point is, for their argument to be right, and even if you
16 could pave in transport mode as they describe in their patent, for their
17 argument to hold up it would have to pave that way all the time. Because if
18 it doesn't pave that way all the time, and you wanted to use transport mode
19 as it's intended, to get a machine onto a truck or onto a trailer, you would
20 have to allow for that functionality. You would have to allow Claim 1 to
21 cover that functionality in order to allow the full scope of Claim 4 to be
22 practiced. And this new argument doesn't do that. It would read out the true
23 purpose and the claimed meaning of Claim 4, even if you could have some
24 scenarios where you could pave in transport mode.

1 Next point is the on-the-fly steering point. I'd like to direct the Board
2 to the admissions from the expert, from G&Z's expert, Dr. Bryden, on this.
3 He analyzed several prior art references in his deposition, starting with
4 Littman. He admitted that Littman essentially has an on-the-fly steering
5 design. He said it has a computer, and I'm not going to read his testimony
6 here word for word, this is Slides 34 through 35, and this is from Exhibit --
7 the quotes on these slides are from Exhibit 1184, around pages 88 through
8 94. And he admits that the way Littman works is, you have a crawler track
9 on the ground and the swing leg pivots, after you turn the crawler track
10 perpendicular to the swing leg, and it drives the crawler track and it moves
11 the swing leg. That's on-the-fly steering. This is in the state-of-the-art
12 reference.

13 Another state-of-the-art reference is the Skotnikov reference, which
14 Dr. Bryden testified about in the PGR. But the testimony is relevant in this
15 proceeding as well, because in the Skotnikov reference he flat-out said, and
16 this is at Slide 36, Exhibit 1185, pages 54, line 2 through 56, line 21. He
17 flat-out said that the arms, this is in the middle, the arms and the wheels get
18 out of alignment with the field, you can adjust them on the fly. That's a
19 quote, adjust them on the fly without operator input. That is their witness
20 saying the prior art has on-the-fly steering capabilities.

21 And the reason I bring that up is because we are not supplying our on-
22 the-fly steering argument or any type of limitation, which is there isn't one,
23 but if there was one, we are supplying it with a state of the art. Rio and CIII
24 provide that. As Dr. Singhose said, CIII in combination with the Rio
25 disclosures renders that limitation obvious. So the base references alone do

1 the work, but to the extent there's any confusion of what a person of
2 ordinary skill in the art would think, it's very easy to understand what the
3 person of ordinary skill in the art would think when you look at the state-of-
4 the-art evidence. And particularly this very powerful state of the art
5 evidence that Dr. Bryden, G&Z's own witness provided.

6 Regarding the at the bottom point that we talked about earlier, I'm
7 going to move to Slide 29. Sorry, that's Slide 27. And I think we figured
8 out why they were amending the claims the way they did in prosecution. I
9 think they were trying to get around references like Miller, where there
10 wasn't that sandwich connection, the Miller reference that we relied on the
11 first time as state of the art. And our combination, as you pointed out Your
12 Honors, it doesn't have -- we're not a Miller design. Our design is a true
13 sandwich design, we talked about earlier. And we have an additional state
14 of the art reference that supplements that as well, and that's on Slide 27 here,
15 that's the GT-3200 reference, Exhibit 1010 at page 3. And there's a rotary
16 drive down here at the bottom.

17 And let's see what Dr. Bryden said about that. He was asked, this is
18 Slide 28, Exhibit 1184, pages 128:24 through 130:21 and 134:17 through
19 135 line 5. He was asked, so the crawler track is rotating in response to the
20 rotary drive? Uh-huh, yes. And nothing above the rotary drive is rotating?
21 Right. So, he admits that we have that design in the state of the art where
22 nothing above a crawler track is rotating by virtue of the rotary drive being
23 connected between the two.

24 Okay, so that brings me to the analogous art point. I just ask the
25 Board to read the full testimony of Dr. Bryden here. He was talking at a

1 very high level of generality whenever he was describing the issue that my
2 colleague was talking about earlier. I then redirected in his deposition to a
3 more specific analysis, which is say you want to design a swing leg
4 assembly? That's when the floodgates opened, and he said oh well if I know
5 I want to design the swing leg assembly, then I would look here, then I
6 would look there, I would look there. So just read that testimony if you
7 don't mind, Your Honors, and with an appreciation for the level of analysis
8 he was working though. And once he got to the analysis where, the part
9 where he said the goal is to design a swing leg, then he said that's where you
10 go look at cranes, you look at whatever, you look at chairs.

11 I want to quickly note for the record, the PM102 is not one of our
12 references that we're relying on as prior art in this case. We're relying on
13 Rio, and Rio has likely many disclosures beyond what are in that machine,
14 which we haven't analyzed that machine, Rio has the disclosures that it has.
15 The PM102 disclosures are not relevant to this proceeding, they're a
16 distraction from what Rio truly discloses.

17 The last point, for Claim 1, I don't see any way Claim 1 can be read to
18 preclude a design where a swing leg is in the air pivoting, just like the first
19 proceeding. And that's why these claims are just like the claims from the
20 first round of IPRs. Like I said earlier, you could just drop a swing leg here
21 on the floor, and because of all the configured to language, the claim could
22 read on that, on that swing leg. With that, I will see if -- there's like two
23 seconds left. I think that brings it to a close. Thank you, Your Honors.

24 MR. HANNAH: All right. I'll try to not talk too fast, but fast enough
25 to get it in under three minutes. A couple of things. I'm on Slide 21, and I

1 think that this is important, and this kind of goes to the theme here, that none
2 of the state-of-the-art references suggest rotary coupling a crawler track to a
3 fixed jacking column to achieve the coordinated adjustment of the swing
4 leg/track while moving under mode. And that's what is required by the
5 claims, and that's kind of the limitations that we were pointing to.

6 If you look at, you know, we just looked at what counsel pointed to in
7 terms of our expert saying, I tell my students to look at chairs. He wasn't
8 talking about analogous prior art. We all know that. We call that a sound
9 bite, try to get a sound bite and take it out of context. He was talking about
10 what his students, I'm going to tell them to look at everything, they're my
11 students, they're not one of skill in the art designing paving machines. And
12 one thing that stood out to me when I looked through the record and I looked
13 through, obviously, the final written decision of the '749, there's a statement
14 in there, and it's on page 22. And the Board there, they said that we find
15 that innovation in the field of endeavor is not rapid nor overly sophisticated.
16 And I read that, and I read it a couple of times. Why isn't innovation rapid
17 in this field? Because it takes guts to innovate.

18 If a contractor buys one of G&Z's machines or anybody's machines,
19 and if they lay 50 miles of concrete and they have to rip it up, they're
20 bankrupt, done. Banks now are having contractors mortgage their houses
21 and using those as collateral for their jobs. That means they're going to use
22 machines that they've used before, that they don't change. G&Z is the one
23 that is coming out and they're breaking that mold, and they're coming up
24 with new innovations in the industry that become what they rely upon.

1 And then the second statement says that it's not overly sophisticated.
2 Yeah, it's not quantum physics, I'll give you that, but it is sophisticated.
3 You have to look at how machines work in the field. You can't ignore what
4 the machine actually looks like that they drew the patent for. You have to
5 take all that into account in order to understand this field and what someone
6 of skill in the art is actually going to do. And it comes back to my point that
7 I made earlier, is that once G&Z came up with this idea to steer under load
8 and to take that initiative and be brave, frankly, in the industry, to come up
9 with that technology and change paving machines from 1977, you now have
10 a standard in the industry that everybody's copying, and that's what we see
11 in the evidence here. So thank you again for your time, and I appreciate it.
12 Unless you have any questions, I can sit down.

13 JUDGE JUNG: I have no questions. Thank you both for your
14 presentation. We will take a short break. I see 2:10 on the clock on the
15 wall, so we'll reconvene at 2:20, based on the clock on the wall and then
16 start up with the PGR.

17 (Whereupon, the above-entitled matter went off the record at 2:08
18 p.m. and resumed at 2:19 p.m.)

19 JUDGE JUNG: Thank you. Please be seated. I'm just verifying
20 everyone is ready. Mr. Stach, are you ready?

21 MR. STACH: Yes Your Honor.

22 JUDGE JUNG: And Mr. Hannah, are you also ready?

23 MR. HANNAH: Yes. Jeffrey Price will be giving the argument for
24 this one. Thank you.

1 JUDGE JUNG: All right, this is the oral hearing for PGR2024-00026.
2 Mr. Stach, you may proceed when you're ready.

3 MR. STACH: Thank you, Your Honor. I will follow the Board's
4 guidance about the topics of interest, but if you have any other questions
5 please let me know. But I'd like to start with the PGR eligibility question.
6 I'm referring now to Slide 3, we identified two ways that the '723 Patent is
7 PGR eligible in our Petition. One of them focused on the Board's prior
8 finding regarding a claim in a related patent, the '571 Patent. The other
9 related to written description, and both of those independently support PGR
10 eligibility. The Board had authorized additional briefing on that pre-
11 institution, and preliminarily concluded that there is PGR eligibility. And
12 then G&Z sought director review, which the director then denied.

13 Now, bring us to today. There's really nothing new, there are no new
14 facts about the earlier cases. Those are still the same. There's no
15 intervening change in law. We think, at least my perception of it is that they
16 put this in the Patent Owner's Response to preserve it for appeal, potentially,
17 because it is essentially the same argument, but I guess I would just say that
18 for the same reasons that have previously been found, we think that the
19 Board should find that the patent is PGR eligible.

20 JUDGE JUNG: And just to confirm, all we need is one claim, just
21 Claim 8, and that provides eligibility for post grant review. It doesn't matter
22 that there are other claims that may not provide that eligibility, but as long as
23 you have one claim, that's all that's required.

24 MR. STACH: Yes, that's correct, and that it doesn't even need to be
25 in this patent, it can be in the chain of priority, and that's why we relied on

1 Claim 8 of the '571 Patent. It is in the chain of priority, and therefore,
2 because that is an AIA claim, it makes all of the claims in the '723 Patent
3 PGR eligible.

4 JUDGE JUNG: And I was not able to find anything with similar facts
5 with this case, but were you able to find any previous Board determination
6 with a similar sort of facts with one patent? A set of claims where one claim
7 provided PGR eligibility, but the others didn't?

8 MR. STACH: No, not a split like that. I do think that the AIA -- I
9 can't quote chapter and verse, but my understanding is there are cases
10 talking about how if at any time you even had a claim that was subject to the
11 AIA, that you would then still be in PGR land, you would be subject to the
12 AIA, even if that claim were later cancelled in certain circumstances. So it's
13 pretty extreme -- it's a low bar to cross, and obviously here we think that it's
14 clearly met.

15 JUDGE JUNG: Okay, thank you. No other questions about this
16 particular topic.

17 MR. STACH: Thank you, Your Honor. When it comes to the written
18 description argument, the claim language is -- I'm on Slide 7 now of our
19 PGR demonstratives, claims recite a first angular position transducer that is,
20 disposed on the modular frame or the swing leg. And G&Z primarily
21 presents two arguments. One, they argue that the hinge bracket is part of the
22 frame and so it should essentially be treated as the frame, but nowhere does
23 the patent disclose this. In fact, if we go to Slide 12, the patent actually talks
24 about the hinge bracket as a second, significant intervening component. In
25 fact, it says we do not want to attach to the frame, we are improving upon

1 that in some way with this hinge bracket, and we get some additional
2 benefits. For example, and this language is what we've underlined on the
3 screen, about how it eliminates the need to tie the swing leg into the tractor
4 frame for holding the swing leg, and the crawler track secured to it in a fixed
5 position during paving.

6 So, this is a significant alternative, as the patent describes it, to
7 attaching directly to the frame. And that's how one of ordinary skill reading
8 these passages would have understood it. And if you look at how G&Z's
9 expert, Dr. Bryden, talks about this in paragraph 70 of his declaration, he
10 says, rather than being introduced as a separate component between the
11 modular frame and swing legs, it is introduced as the component through
12 which each swing leg is coupled to the frame. So he's saying it's not
13 introduced as this separate intervening component, but when you look at
14 Slide 13, for example, where you have Claim 2 of the '749 Patent, it pretty
15 much has the exact language that their expert said is not in the patent. But
16 this is how G&Z's patent family and how the disclosure, how one of
17 ordinary skill would have understood. The claim literally says that the hinge
18 bracket is interposed between the swing leg and the surface of the modular
19 frame.

20 So, we think that it should not be treated as if it is the frame, but even
21 if you were to find that the hinge bracket is effectively part of the frame, that
22 still doesn't get -- that only gets halfway there for this claim, for the written
23 description. You also need to then find that there's disclosure of positioning
24 the transducer on the swing leg, and that's absent here, as well. And

1 obviousness is just not enough. The second argument -- I'm sorry, do you
2 have a question?

3 JUDGE JUNG: Oh no, go ahead.

4 MR. STACH: G&Z's second argument is about the "disposed on"
5 language, and how another path forward for them is to argue that you can be
6 disposed indirectly on and still meet the language of the claims. And if you
7 look at the way that G&Z has argued about the paving machines, in their
8 Patent Owner's Response on page 42, they said there's really six major
9 components to these machines. And they enumerate them, and they list
10 them out. And if you have machines that have so few major components
11 and you start to say that something's indirectly connected to something else,
12 where do you draw the line then? Essentially everything is connected to
13 everything else at that point, and you sort of lose meaning. It almost reads
14 that entirely out of the claim, if disposed on can mean any indirect
15 connection, because everything is essentially indirectly connected to
16 everything else on these machines.

17 JUDGE JUNG: I'd like to ask about that point. So it seems like from
18 the Patent Owner's point of view there's no real outer bounds of disposed
19 on, but if you have to say that there was some kind of outer bound to the
20 language "disposed on," what would the outer bound be?

21 MR. STACH: So for purposes of this proceeding, I don't know that
22 we have to define the entire outer bounds, but what I would say on that is
23 that whatever indirect -- so, let's say you want to say that it can have some
24 form of indirect connection. We know from the patent Specification that
25 that indirect connection cannot be through a hinge bracket, because the

1 hinge bracket is the modification, it's the distinction that they talk about as
2 being different from the frame. We would be sort of overriding that entire
3 disclosure that one of ordinary skill in the art would have looked at and
4 relied on in interpreting these claims.

5 And so, whatever disposed on, even if indirectly, is permissible,
6 maybe there's a layer of paint, or you know, that kind of is what they get at
7 when they talked to our expert. You know, he's sitting on the chair and he's
8 got his pants on, and that's between, as he's sitting on the chair. Maybe
9 there are some, you know, insignificant things that could be in between, but
10 we know from their Specification that that thing cannot be a hinge bracket.
11 The hinge bracket is actually a significant intervening component. It's
12 separately claimed. We see it in Claim 2 of the '749 Patent on the
13 demonstrative on the screen, and so it cannot reach that. And the Board
14 needs only construe the claims to resolve the dispute between the parties, it
15 does not need to define the outer bounds for eternity here. And I think if you
16 only go that far, I think it resolves in our favor.

17 JUDGE JUNG: Okay. So according to your arguments, an indication
18 of where "disposed on" should end would be something that's separately
19 recited in the claim, and if the Specification seems to describe it separately
20 as a major component? Not something that's indirectly, a minor component
21 that could be indirectly in the way of being disposed on?

22 MR. STACH: I think the answer is yes to that, Your Honor. That's
23 my understanding. Here we have a significant major component that is
24 disclosed to be different, and supposedly an improvement on the frame, and

1 so we can't say that they are one and the same, or that the indirect
2 connection through that should still be within the scope of the claims.

3 JUDGE JUNG: Okay. Thank you.

4 MR. STACH: That's all I had on those two points. I can talk a little
5 about secondary considerations while I'm up here, Your Honors, if you have
6 questions about that, or I can hand it off to my colleague. I know you
7 mentioned the obviousness was the third point that you were most interested
8 in.

9 JUDGE JUNG: You could also address nexus if you have time.

10 MR. STACH: Yes, Your Honor. One of the things that stood out to
11 me about the PGR relative to the IPR is that G&Z's showing of nexus, its
12 attempt to show nexus is actually much more deficient here, I would say,
13 than even its attempt in the IPR. We don't think they've shown it in the IPR
14 for the reasons that we discussed previously, but here they primarily just say
15 that there's a nexus. They talk about it in their Patent Owner's Response.
16 It's about two pages of their Response, pages 46 to 48, portions on the
17 beginning and ending pages. But a lot of that section talks about long felt
18 need, other secondary considerations. There's not really an explanation of
19 how this machine, the S600, allegedly embodies this, or the feature provides
20 a nexus. And if we look, for example, at the IPR, they did provide about 15
21 pages of claim chart, and I don't think they got where they wanted to end up
22 in the IPR, but there's at least an attempt at showing, and it seems like an
23 acknowledgement, that when you are trying to show nexus, you do have to
24 do more than just say we have on-the-fly steering and that's enough. So, I
25 think that the nexus here as G&Z has argued it is much more deficient in

1 many ways than in the IPR, but of course, you know, for purposes of our
2 case, in both cases we don't think there's a nexus.

3 I'm happy to address any other questions on that, but if not I'll turn it
4 over to my colleague.

5 JUDGE JUNG: I have no further questions, Mr. Stach.

6 MR. STACH: Thank you, Your Honors.

7 MR. MROZ: Thank you, Your Honor. David Mroz on behalf of
8 Gomaco. I'm going to go right to Slide 35 to address claim construction.
9 G&Z argues that Claims 1, 6, and 7 in the '723 Patent have on-the-fly
10 steering limitations. I'm more confused now than I ever am about what an
11 on-the-fly steering limitation means in their view, so I'd just like to focus on
12 the claim language again, I think it's the best place to go.

13 For Claim 1, G&Z bases its argument that this claim is confined to on-
14 the-fly steering based on language saying that the slew drive is capable of
15 steering the crawler track under load without lifting the crawler track. So as
16 best we understand it, G&Z reads this claim to cover a design where the
17 hydraulic actuator pivots -- well, where the swing leg pivots while the slew
18 drive steers the crawler track while under load and while the machine is
19 moving forward. That's how we think they're interpreting this provision, or
20 this claim limitation, but in reality, Claim 1 doesn't require this
21 functionality.

22 So first, this functionality can be met just by a machine that's driving
23 down the road, not moving the swing leg at all, by a machine that has a
24 locked swing leg. And we have examples in the patent, we have examples
25 in Rio, and we've argued in the Petition and PGR Petition, pages 82 to 83

1 for example. We talk about in the claimed analysis how Rio's steering
2 capabilities under load can happen when you're driving regularly, and the
3 Board concluded that last time. So there's no requirement that the swing
4 arm be moving, the swing leg be moving, while performing the steering
5 functionality that I just described in Claim 1.

6 Next, the limitation requiring this feature, this functionality, steering
7 the crawler track under load without lifting the crawler track, it can also be
8 satisfied when the machine is completely stopped. It could be not only
9 stopped, but where the swing leg is locked in place. So I will refer you to our
10 Reply brief for that, pages 11 through 13. There we talk about a design
11 where in G&Z's patents the crawler track rotates 90 degrees while the
12 machine is just sitting still and on the ground, before it goes to move into
13 transport mode.

14 JUDGE JUNG: I just want to make clear, your argument is based on
15 the language "capable of."

16 MR. MROZ: Yes.

17 JUDGE JUNG: It's just on a truck being transported, it's still capable
18 of steering the crawler track. But if that language is missing, then do you
19 think that would cover a slew gear drive that only operates to steer or only
20 operates while you're actually using the paving machine and you're laying
21 down asphalt?

22 MR. MROZ: In Claim 1 I still think we would have not on-the-fly
23 steering as they define it, because we could still cover a machine that's just
24 driving without pivoting the swing leg. So even if it's capable of, even if
25 you remove that "capable of" language and you're driving and steering, just

1 with a swing leg locked, you satisfy that claim. Same with the point about
2 when you're just sitting still. Even if you remove the "capable of" language,
3 if you're sitting still and you do what the patent describes, which is you
4 simply twist, rotate your crawler track 90 degrees without moving the swing
5 leg, that would satisfy this claim even without the "capable of" language, in
6 my view.

7 For Claim 7, moving on to Slide 36, this is the controller limitation,
8 similar to one that Judge Reimers described earlier in the '318 Patent. And
9 these controller functionalities can be performed, again, while the crawler
10 track is either on or off the ground, while the machine is moving forward or
11 stopped. So this limitation is similar to the ones in the '749 Patent where the
12 Board found that they can be satisfied by a crawler track that is being
13 pivoted while in the air. And this is where the "capable of" language comes
14 in for this claim, because you can have a machine that can operate, is
15 "capable of" doing this functionality while it's in the air, but it's also
16 "capable of" performing the other functionalities while the crawler track is
17 on the ground. So that "capable of" language in this situation is very
18 important.

19 For Claim 6, which I think is where they may focus their argument, it
20 states, Claim 6 states that the swing leg is configured to relocate the jacking
21 column with the crawler track while moving and under load. Now, this is
22 the first time in the claim language where I think they attribute some kind of
23 functionality to the crawler track when it's on the ground, right? So I still
24 don't know if this is on-the-fly steering, though, the way they defined it.
25 This is where the issue gets a little confusing. I think it's really important to

1 focus on the claim language. So the limitation at the bottom does require
2 steering while the crawler track is under load, but not in the way G&Z
3 contends.

4 So let me go further on that point. G&Z contends that Claim 6
5 requires a hydraulic actuator to pivot the swing leg and move the jacking
6 column to a new location. So the actuator is on the swing leg. G&Z's
7 position is that Claim 6 does not cover designs where a swing leg is not
8 actuated by a hydraulic actuator or anything at all. It's floating, for example,
9 or unpinned, and then jacking column has then relocated in response to the
10 crawler track driving to a new location. This argument is wrong for three
11 reasons, G&Z's claim construction argument.

12 The first is, the claim language itself says the swing leg is configured
13 to relocate the jacking column, the important part, with the crawler track.
14 You can use the crawler track in this claim to relocate the jacking column by
15 driving the crawler track to motor. In fact, that is exactly how the patent
16 describes this in Slide 37 here, where I show Figures 8A through 8E, as the
17 machine transitions from paving orientation to transport orientation. In this
18 situation, the patent is clear that during the transition, the hydraulic actuators
19 are unpinned from the swing legs, and the crawler tracks drive the jacking
20 column from the paving orientation to the transport orientation. The swing
21 leg is not being actuated during this process, and G&Z's interpretation of
22 Claim 6 excludes that embodiment. That is why it's wrong under the law.

23 And to kind of put the nail in the coffin on this point, Dr. Bryden
24 testified about transport mode. He explained what transport mode was, just
25 as I described a moment ago. This is Exhibit 1185 on page 8, line 10,

1 through page 10 through 9, and Slide 38. And I'm going to go to Slide 39
2 and reference Dr. Bryden's testimony from Exhibit 1185, which is page 13,
3 lines 9 through 24. He was asked, that example we just described, I'm not
4 quoting anymore, which was the transport mode orientation? Is that
5 example we just described removing the swing leg in the transport mode
6 covered by Claim 6? Answer, yes. Why is that? Answer, we have the
7 swing leg, we have the crawler track that's on the ground, and it's bearing
8 the full load of the machine. Question, okay, so when we're talking about
9 this last part, the swing leg configured to relocate the jacking column with
10 the crawler track while moving under load, what is moving under load?
11 Answer, so we have the crawler track and the swing leg both moving.

12 So, there doesn't appear to be any dispute, at least from G&Z's own
13 expert and our position about G&Z's flawed legal arguments in Claim 6
14 cover embodiments where a swing leg relocates the jacking column by using
15 the crawler track driving along -- in other words, the claim has to cover an
16 embodiment where the swing leg is not actuated and the crawler track is
17 driving the swing leg to a new position.

18 Now, the reason this matters is because the Tax prior art has that type
19 of design where they're driving the crawler track to move the swing leg.
20 They're using the crawler track to have the swing leg move the jacking
21 column, I should say. And this Tax component works really well, or Tax
22 prior art works really well with Rio, because Rio, in the combination we
23 have, you're using Rio's actuator, Rio has that anti-swing component on it.
24 You can lock the Rio machine, the Rio actuator, if you want, or you can
25 unlock it automatically and let it float, or let it operate, I should say. So, Tax

1 when viewed with Rio in Ground 2, it makes a lot of sense, the combination
2 that we're proposing. But as I mentioned earlier in the '318 Patent
3 argument, Rio alone does the job for on-the-fly steering.

4 I'm running short on time, wanted to see if the Board, if Your Honors
5 had any more questions. If not, I'll reserve the rest.

6 JUDGE JUNG: I have no questions.

7 MR. MROZ: Thank you, Your Honors.

8 JUDGE JUNG: You have nine minutes left.

9 MR. PRICE: Okay, good afternoon, Your Honors, and may it please
10 the Board. I am Jeff Price on behalf of G&Z. Going to go ahead and start
11 with the PGR eligibility issues. So the '723 Patent is not PGR eligible for a
12 number of reasons. There was discussion during the opening presentation
13 about Claim 8 of the '571 Patent, so I'm going to start there, because I think
14 it's really important that we get the facts right and the law right in order to
15 make sure that we get the right decision.

16 We have two conflicting decisions about the written description for
17 Claim 8 of the '571 Patent. In the prior 00135 proceeding, where the issue
18 was actually litigated, right, Petitioner raised the issue, Patent Owner pointed
19 out exactly where in the priority documents. There was disclosure for the
20 telescoping legs and the various features that Gomaco challenged. That
21 decision is entitled to collateral estoppel. It satisfies all four requirements
22 for collateral estoppel. The issue is identical. The parties had a full and fair
23 opportunity to litigate the issue. That goes to aspects of collateral estoppel
24 are conceded.

1 Gomaco raises two issues with collateral estoppel about the '135
2 decision. They say the issue was not actually litigated because it was too
3 feebly presented. That's not a defense to collateral estoppel. As long as it's
4 raised, you can have a collateral estoppel finding even if it's found that the
5 person raising the issue did not meet their burden to carry the day on that
6 issue. But the other thing that that means is that, if it really was too feebly
7 presented in that '135 case, it was also too feebly presented in the '136 case
8 for collateral estoppel to attach, right?

9 So this idea that you can just go back to the '136 case where the
10 priority date for the '571 was adjudicated and apply, and just take that
11 finding and apply it here, that is collateral estoppel, and you can't do that for
12 the '136 decision. It wasn't actually litigated in that case. In that case,
13 Patent Owner didn't say anything about that written description issue. There
14 were a ton of other arguments Patent Owner raised, but the law is very clear
15 that collateral estoppel cannot attach, an issue is not actually litigated if we
16 didn't pass on it. If we didn't touch it, if it was admitted by -- if it was a
17 default finding and that's what we have here, then collateral estoppel cannot
18 attach. So if there is a collateral estoppel, it's to the one where Claim 8 of
19 the '571 Patent was found to have priority back to the earliest pre-AIA
20 applications.

21 The other issue that they raised with collateral estoppel in the '135 is
22 whether or not an institution decision is final judgement that can give rise to
23 collateral estoppel. And it is. Gomaco focuses their arguments on the
24 appealability of the decision, but as we know from *Jackson Jordan*, we
25 know from their statement, that appealability is not the cornerstone. It is

1 reviewability, and the statement is very clear that reviewability includes the
2 ability to raise a mandamus. So, there is collateral estoppel here. It attaches
3 from the '135 decision, it means that Claim 8 of the '571 Patent is entitled to
4 a pre-AIA effective filing date, and that should be the end of that issue.

5 The other problem here is, Petitioner didn't raise this issue in the
6 Petition. They didn't actually raise the written description issue for Claim 8
7 of the '571 Patent in the Petition. All of their dealings rely on the previous
8 finding. We have the evidence in the record showing exactly where that
9 limitation of the '571 Patent exists in the record. There's written
10 description, we know that it was decided in the '135 case where it was
11 actually litigated. So, does the panel have any --

12 JUDGE JUNG: Mr. Price?

13 MR. PRICE: Yeah.

14 JUDGE JUNG: Just to make sure we're all on the same page, you
15 agree that all it takes is one claim for us to have eligibility for post grant
16 review? Just one claim, anywhere in the priority chain.

17 MR. PRICE: I agree. Only one claim -- yes. I don't dispute that, but
18 what I do dispute is that it's proper to give either preclusive effect to that
19 '136 decision, and you know, even if Your Honors don't want to decide this
20 on collateral estoppel, the record evidence shows that there is written
21 description there. So if you're going to go ahead and re-decide this issue
22 and you're not going to apply collateral estoppel, which I think would be an
23 error, then you should find written description for Claim 8 of the '571
24 Patent, and that's it.

1 JUDGE JUNG: Is there anything that prevents us from re-analyzing
2 this issue, in your mind?

3 MR. PRICE: There is, Your Honor. It's the fact that they didn't raise
4 it. So really, for you to pass on an issue, it has to be squarely raised in the
5 petition, and this wasn't. So we would argue that this isn't even an issue
6 that's properly before the board, because it was not raised in the Petition.
7 However, the evidence is in the record, the arguments are in the record, you
8 can find, if you so choose, that there is written description for Claim 8 of the
9 '571 Patent.

10 JUDGE JUNG: And the Patent Owner is not disputing the results of
11 the analysis in the previous '135 and '136 proceedings?

12 MR. PRICE: Well, we certainly don't dispute the findings in the '135
13 proceeding, because we made the argument there and it was found
14 persuasive, that Claim 8 of the '571 Patent was found to have an effective
15 filing date that was pre-AIA. So, we don't disagree with the analysis there.
16 In the '136 case where it wasn't actually decided, if you go back and look at
17 it, it was really, the decision was made on the fact that it was an issue that
18 was raised and we didn't address it.

19 JUDGE JUNG: Okay, but the arguments in front of us are not really
20 directed to the panel in the '136 somehow coming out wrong in its analysis?

21 MR. PRICE: Well, I think the panel in the '136 case did come out
22 wrong for the reasons that it said in the '135 case.

23 JUDGE JUNG: Did you actually raise those arguments here? I might
24 have missed it.

1 MR. PRICE: Well I mean, we argue that there is written description
2 for these limitations, which is contrary to what the Board found in the '136,
3 consistent with what they found in the '135.

4 JUDGE JUNG: Because I understood your arguments to be mostly
5 directed to collateral estoppel, whether it applies or not to these decisions.

6 MR. PRICE: I agree, but we --

7 JUDGE JUNG: I didn't understand those arguments to also say that,
8 to go further and say the analysis of the '136 was incorrect, but is that a
9 misunderstanding on my part?

10 MR. PRICE: Well, okay. So yeah, I mean there are two things. We
11 do think the issue, the decision in the '136 was incorrect, and if the Board
12 had actually had the arguments of record, had actually gone back and looked
13 at the issue like they did in the '135 case, then they would have come to a
14 different conclusion. They can come to a different conclusion here, and
15 collateral estoppel means that you have to give preclusive effect to the '135
16 and can't give it to the '136.

17 JUDGE JUNG: Okay, let's just talk about the result of the '135.
18 What did the '135 analyze, was it just Claim 1 in your mind?

19 MR. PRICE: No. So, here's the issue. In the '135, the limitation was
20 part of the independent claim. In the '136, it was in the dependent claim.
21 That was one of the reasons that it wasn't --

22 JUDGE JUNG: Independent or dependent claim?

23 MR. PRICE: It was in the dependent claim.

24 JUDGE JUNG: Dependent Claim 8, right? In the '136?

1 MR. PRICE: Right. So, our arguments in the '136 were all about
2 dependent claims. We didn't contest this, but that means that collateral
3 estoppel also can't attach because it wasn't actually litigated.

4 JUDGE JUNG: Okay. You realize you have -- our analysis on the
5 PGR eligibility was on Claim 8, right? So, do you have any arguments
6 specific to Claim 8? Why is the analysis for Claim 8 incorrect?

7 MR. PRICE: The analysis for Claim 8 is incorrect in the '136 one,
8 because it wasn't -- if you go back and look at that decision, it was very
9 terse, right? It says, Petitioner says that these limitations were first
10 introduced in a CIP, and it was the same argument that was made in the
11 '135. Identical. This same feebly presented argument. It was presented the
12 same way, in both cases. It's wrong because there is written description for
13 those limitations, and that's in the Sur-reply at 5, and Exhibit 2004, where
14 those arguments were made. They were found persuasive in the '135. So,
15 you know, if there's a question about where you should look for best
16 treatment of this argument, it's in the '135 where it was actually litigated.
17 And we're taking the same position here. And again, this was not an issue
18 that was squarely raised in the Petition.

19 JUDGE JUNG: So your view is that the '135 reached dependent
20 Claim 8?

21 MR. PRICE: No, no, no, reached the same exact issue, which was the
22 written description of --

23 JUDGE JUNG: Okay. I kind of understand your position, but you
24 know, this analysis is claim by claim. I can't just say the analysis for Claim
25 1 in '135 automatically should apply to Claim 8 in the '136, of the same

1 patent, because it's a claim-by-claim analysis. Or in this case, limitation by
2 limitation analysis.

3 MR. PRICE: Right, so, yes.

4 JUDGE JUNG: Do you accept that I can't automatically apply the
5 analysis for Claim 1 to Claim 8, or do you disagree with that?

6 MR. PRICE: I disagree because -- I disagree one, because of
7 collateral estoppel. It's the same issue, right? And that's what we look at,
8 we look for identity of issues. So, under collateral estoppel, which we think
9 certainly applies, this issue was already litigated.

10 JUDGE JUNG: Does collateral estoppel apply to different claims?

11 MR. PRICE: Collateral estoppel only asks whether the issue is
12 identical. It can definitely be --

13 JUDGE JUNG: Is this identical, if it's different claims?

14 MR. PRICE: Yeah, absolutely. And the Federal Circuit routinely
15 applies collateral estoppel to claims that are not patentably distinct across
16 different patents. The question is whether or not the issue is identical, and
17 they can see that. Gomaco sees that. It is an identity of issues, that's not
18 one of their arguments about why collateral estoppel can't apply from the
19 '135 decision.

20 JUDGE JUNG: Okay.

21 MR. PRICE: Are there any other questions about that one?

22 JUDGE JUNG: I don't have any.

23 MR. PRICE: So I want to touch briefly on the AIA, the PGR
24 eligibility from the alleged written description defect. First of all, Petitioner
25 didn't rely on the written description, the alleged written description defect

1 to show PGR eligibility. That was not an argument they made. They made
2 that first time in the Reply. They only relied on the previous finding about
3 Claim 8 of the '571 Patent. So, then the issue here is whether or not that
4 alleged written description defect, the position of the angular position
5 transducer transforms the '723 Patent itself into an AIA patent.

6 And the answer is no. The answer is no for two different reasons. So,
7 the MPEP section 2159.02 is very clear about this. If an amendment is
8 added during prosecution, it doesn't change the status of that application.
9 You can imagine a ton of really big problems, like you would have here, if
10 you actually had one of these amendments that added a new matter during
11 the prosecution of one patent. Then all of a sudden, maybe three other
12 patents before, four other patents after, all now examined under the wrong
13 statute, right? That's a problem, and that's what 2159.02 deals with, right?
14 An amendment added during prosecution doesn't change the effective filing
15 date of the claims, doesn't change it from a pre-AIA patent to an AIA patent.

16 And the only point of contention that they have is there was one non-
17 precedential Board decision, the *Flex Logic* decision, where it said well,
18 MPEP 2159 doesn't apply to issued patents, it's only applications. But, the
19 reasoning -- first of all, it's non-precedential. Their reasoning doesn't make
20 sense, right? You don't want to have this situation where, you know, you're
21 introducing new matter into a claim that then is going to change the way that
22 the rest of your patent filing should be examined.

23 The other problem is, it's inconsistent with the statute, the effective
24 filing date statute in 35 U.S.C. § 100, which says you can only have an
25 effective filing date that is the filing date of an application. If I introduce

1 new matter into an application via an amendment two years after the filing
2 date, the effective filing date is not the date that the amendment was made.
3 It can't be, by statute. It can only be the actual filing date. So if you're
4 reading MPEP 2159 with that in mind, then you can't have this situation
5 where the effective filing date is something else, right? So, if you read 2159
6 then in that context, you look at the application as filed to determine whether
7 or not the application is an AIA, pre-AIA. Therefore, the amendment
8 doesn't change the AIA status. So any questions on that one before I move
9 on to the actual written description?

10 JUDGE JUNG: I have no questions.

11 MR. PRICE: Okay. I think there's a little bit of confusion about the
12 written description issue for the angular position transducer. There's a lot of
13 focus on the details of one preferred embodiment, right, where it actually
14 shows the transducer in a can on a very specific part of the pivot connection
15 between the frame and the swing leg. But, that's not -- that one narrow
16 embodiment is not all the '723 Patent discloses about this location. So here
17 we have the disclosure that says the angular position transducer is at the
18 pivot connection for the swing leg, at the hinge bracket.

19 So what does this mean? It means that you have a transducer at the
20 pivot connection. It doesn't have to be at some specific location at the pivot
21 connection. And by the way, we have a ton of evidence from both experts
22 that say, if you have an angular position transducer at the pivot connection, a
23 person of ordinary skill in the art knows that you put it on one component or
24 the other, because you're just measuring the relative angles between those
25 two components. So, when we say we have an angular position transducer at

1 a pivot connection between the module frame and the swing leg, then we
2 know that it could be on either one, right? Because it's really just a design
3 choice about which part of the pivot connection it goes on. And like I said,
4 it's not specific. We're not specific. We're not saying that the invention is
5 only limited to putting it on one specific part of the pivot connection.

6 JUDGE JUNG: Mr. Price?

7 MR. PRICE: Yeah?

8 JUDGE JUNG: Would you agree that there's really no express
9 description or no figure that shows an angular position transducer directly on
10 a module frame or directly on a swing leg?

11 MR. PRICE: So no, I don't agree, but I do agree that it depends on
12 what you mean by disposed on.

13 JUDGE JUNG: Disposed of directly on.

14 MR. PRICE: Well, okay, so, no, I don't agree with that either because
15 I think if you read the claims, the hinge bracket is part of the --

16 JUDGE JUNG: Not the claims.

17 MR. PRICE: If we look at the claims --

18 JUDGE JUNG: Is there a description somewhere where it shows or
19 tells me that the angular position transducer is directly on the module frame
20 or directly on the swing leg?

21 MR. PRICE: Well we would say yes. One, it certainly shows it on
22 the swing leg, and I think that's one thing that my partner over here said,
23 there's no description of it all on the swing leg, but if you look at the -- and
24 I'll try to pull it up here while we're talking. If you actually -- I'm not going
25 to be able to, unfortunately. If you take a look at the picture, right, where is

1 the transducer itself? It's on this pivot pin. That's part of the swing leg,
2 right? That's the part of the swing leg that sits in the receptacle of the hinge
3 bracket.

4 JUDGE JUNG: Is that part of the swing leg, or is that part of the
5 hinge bracket?

6 MR. PRICE: Well, it rotates with respect to the hinge bracket, and
7 it's fixed with respect to the swing leg. So certainly, if it's part of one or the
8 other, it's part of the swing leg, because it's completely rotationally fixed
9 with -- that's how it works, right? I think it's also directly disposed on the
10 frame, because we think that the hinge bracket is part of the module frame.
11 And we looked at the claims, we said hey look, if you look at the claims, you
12 know, it's translating --

13 JUDGE JUNG: Mr. Price. Sorry to interrupt, but the hinge bracket is
14 part of the module frame? Why? Why is that?

15 MR. PRICE: Well, it's completely fixed with respect to the module
16 frame. So, it's this thing that's bolted on to the bolster, right, it doesn't say
17 it's bolted onto the frame, it says it's bolted onto the bolster, which is
18 certainly part of the frame.

19 JUDGE JUNG: If it was bolted on the frame, would it be part of the
20 frame, or considered the frame?

21 MR. PRICE: The bolster is part of the frame, the hinge bracket is part
22 of the frame, they're all part of the main part of the machine, right? And
23 then the swing leg is what comes on and gets attached to it. So, even if we
24 think that the hinge bracket is a separate component, disposed on doesn't
25 mean directly disposed on. The key thing that we have to think about, and

1 just think about this as a matter of logic, is what are we trying to do? We're
2 trying to measure the angle between the swing leg and the frame, because
3 that's what you're keying all of these decisions off of. So -- and the hinge
4 bracket is just completely connected to the frame. Like, it doesn't move
5 with respect to it. Therefore, it's, the hinge bracket is also disposed on the
6 frame.

7 JUDGE JUNG: Is it also connected to the swing leg?

8 MR. PRICE: A part, sort of the pin --

9 JUDGE JUNG: So is it also part of the --

10 MR. PRICE: The referenced pin would then be certainly connected to
11 the swing leg, because that's going to be on the other part of that pivot
12 connection.

13 JUDGE JUNG: So is it also part of the swing leg? Like for example,
14 when the hinge bracket was bolted onto the frame it was part of the frame,
15 but if it's also connected to the swing leg, is it also part of the swing leg?

16 MR. PRICE: So, again, this then comes back to that a person of
17 ordinary skill in the art knows that you can put it on one piece or the other,
18 right, in order to effectuate this thing. And here we have a broad
19 description, it's just at the pivot connection, it doesn't demand that it's on
20 one or the other, but it's going to be on one or the other. Any further
21 questions on the written description?

22 JUDGE JUNG: Yeah. Interpretation of the "disposed on" argument.
23 So, how many components can be in between before it's no longer disposed
24 on?

25 MR. PRICE: Look, I think certainly it's disposed on here, because

1 you have the bolster of the frame, you have the hinge bracket, and they're
2 completely fixed to one another. This is a lot like, your butt and your pants.
3 They're right next to each other. So, if I'm sitting on the chair, I'm sitting
4 on the chair even if my pants are in the way. In the same way, you know, if
5 you disposed on the hinge bracket, there's no moving parts, there's nothing
6 really separating the hinge bracket from the frame. So, if you're disposed on
7 the hinge bracket, you're disposed on the frame.

8 JUDGE JUNG: And it makes no difference that the hinge bracket is
9 separately recited and separately described?

10 MR. PRICE: I don't think so. I don't think so, Your Honor, because
11 again we're talking about, these things are just sandwiched right together,
12 and they're completely bolted together. They're essentially effectively one
13 piece. So if you're on one, you're on the other, right? That's how I would
14 answer that question.

15 JUDGE JUNG: One final question. The parties agreed to a level of
16 ordinary skill in the art. It seems like such a person, when they read the
17 description and see the figures and you tell them that the angular position
18 transducer is either on the frame or the swing leg they would say no, the
19 description only says it's on the hinge bracket. The claim also says it's only
20 on the hinge bracket.

21 MR. PRICE: Right. So, again, we have both experts saying that it's
22 within the skill of one in the art, a person of ordinary skill in the art under
23 that definition, that you know that at a pivot connection, it's on one part or
24 the other. That's just how these things work, right? So a person of ordinary
25 skill in the art coming to the '723 Patent comes with that knowledge. So,

1 comes with the knowledge that if it's at the pivot connection it's on one part
2 or the other, and that's exactly what the claims say.

3 JUDGE JUNG: Sorry Mr. Price, you have about six and a half
4 minutes.

5 MR. PRICE: I'll do my best. So, I do want to get to the on --
6 independent Claims 1, 6, and 7 all require on-the-fly steering. My friend
7 said he was very confused about what our position about what on-the-fly
8 steering is. He shouldn't be. We said it throughout the POR and the Sur-
9 reply. It's a coordinated steering of both the swing leg and the crawler track.
10 And that's what gets you all the benefits, and that's what we get in Claim 1.
11 So my friend said, you know, in Claim 1 there's no language about this.
12 That's what the transducers and the signals that are recited in Claim 1 are all
13 about, not to mention the fact that --

14 JUDGE REIMERS: Counsel, I have a question on that. Wouldn't
15 your position be, though, when we look specifically at Claim 7, which has
16 very similar language to what we were discussing with the IPR that we just
17 discussed, the thing in order to cause the second angular orientation,
18 wouldn't that be where the online relocation would take place? Couldn't
19 Claim 1 then be interpreted -- because we're looking at Claim 7 to further
20 limit Claim 1, correct? So, we're talking about the causing in Claim 7,
21 where we say similar to what we discussed in the IPR, said send a control
22 signal to the slew drive in order to cause the second angular orientation to
23 the crawler track to rotate to the target second angular orientation. That's
24 very similar to what we saw in the IPR. So, couldn't we, or couldn't Claim
25 1, for example, be interpreted to be not on-the-fly, because Claim 7 is further

1 limiting Claim 1 to more or less limit it or further limit Claim 1 to include
2 on-the-fly?

3 MR. PRICE: Your Honor, I think that's a very good question, and I
4 think certainly Claim 7, there should be no question that that's about on-the-
5 fly steering, right? Claim 1, you go back and it's talking all about steering
6 the paving machine under load, that's explicitly recited in Claim 1 of the
7 '723. It's not in the '318. So, you know, you have the ability to steer the
8 slew drive under load in Claim 1, you have the signals from the angular
9 position transducers, you have the second angular position transducer all
10 about sending that output signal. The one thing I do want to note here, is
11 that the measurement that you do with that first angular position transducer,
12 that's the one that does the swing leg to the frame, that doesn't change if
13 you're not moving, okay? You don't get a change in that first angular
14 position transducer unless you're moving, right? So then we have the
15 limitation about it being steered under load here. Certainly Claim 7 goes
16 into a lot more detail about how all of that works.

17 Claim 6 I think also is very, very clear about it being about the on-the-
18 fly steering embodiment. My friend was talking about Claim 6 was about
19 the transport mode. It's not. So, this is talking about the paving machine
20 moving under load. They're at most talking about the swing leg moving
21 under load while the machine is stationary, because that's how you're
22 moving into the transport position. So, certainly Claim 6, we're talking
23 about actually moving the jacking column with the crawler track under load.

24 So, the other thing is, we talked about whether or not -- we're talking
25 about the coordinated steering of both of the jacking column, the swing leg,

1 and the crawler track. He said well no, you can actually just let that thing
2 fly, but again, that's not getting you the right feedback mechanism between
3 the angular position transducer, and you're certainly not getting coordinated
4 actuation.

5 I want to get -- I do want to talk about the state-of-the-art evidence.
6 The state-of-the-art evidence is not about driving pavers, it's about driving
7 these other kinds of machines. State of the art is supposed to be about how
8 you interpret the actual prior art. If they actually wanted to come through
9 and cite Skotnikov and all of these other smaller, lightweight machines in
10 order to show on-the-fly steering, they could have made an obviousness
11 argument about that. Instead, they pointed to it as state-of-the-art evidence.
12 It doesn't tell you what you're going to do with CIII and Rio.

13 CIII and Rio, finally, it doesn't disclose the actually slew drive
14 limitations in terms of the actual arrangement. Again, we're talking about a
15 lot of state-of-the-art evidence. Not one shows a slew drive being used to
16 rotate a crawler track with respect to the entire jacking column. My friends
17 just admitted that Miller doesn't teach the right sandwich arrangement.
18 Littman has it inside, nothing in the state of the art or the prior art has
19 anything that looks anything like our arrangement. And I'm going to reserve
20 the last 50 seconds for rebuttal.

21 JUDGE JUNG: All right. I know this patent is important for your
22 client. I'll give you another three minutes for rebuttal, and I'll add three
23 minutes to Petitioner's time.

24 MR. PRICE: Thank you, Your Honor.

25 JUDGE JUNG: You may proceed, Mr. Stach.

1 MR. STACH: Thank you, Your Honor. Couple points on PGR
2 eligibility question. All of these arguments that you've heard today are
3 things that G&Z already raised with the director. Director denied review.
4 There's nothing new here today. I would also point out that the '136
5 decision that they said can be reevaluated, that went actually up to the
6 Federal Circuit and was affirmed, and there was a ground in that case that
7 was specific, it was the Dahm reference, was brought in specifically for
8 Claim 8. That reference was not prior art unless the Federal Circuit agreed
9 that Claim 8 was not entitled to the earliest filing date, if it was in fact an
10 AIA claim like the Board had found.

11 So this is something that has already been passed on, and it's not
12 ancillary. It was essential to the judgement that the Federal Circuit could not
13 have ruled the way they did. Granted, it is a Rule 36, they didn't give their
14 reasoning for everything, but we do know that they had to agree with that
15 point, because otherwise Dahm was not going to be prior art, and they
16 couldn't sustain it. So, I do think that that's not something that is really
17 open for new reinterpretation at this point, the way Mr. Price said.

18 Also just point out as well that on the reviewability question,
19 mandamus is very limited in what can be considered. In fact, the Federal
20 Circuit has said in the cases of denial at institution, the only mandamus that
21 you could legitimately raise is if you raised constitutional questions. And
22 that's obviously not what we have here. This was a denial of institution
23 based on a claim construction question, and we can get into the differences
24 in the proceedings, but there was actually different claim language that was
25 even evaluated in the '135 versus the '136. And so this is not a situation

1 where we could have legitimately gone to the Federal Circuit if we had
2 wanted to. I mean, anyone can file -- I could file a paper called an appeal,
3 but the no appeal statute says that that is not effective, right? Same deal
4 with mandamus. When the Federal Circuit has said you have a very narrow
5 limited set of circumstances, I could file something that's called a
6 mandamus petition, but they would reject it outright, because it doesn't fit
7 what they've said mandamus petitions are for. So there's not actually
8 reviewability here by mandamus the way that they're saying.

9 And then regarding the MPEP provision that they cite. Obviously, we
10 did cite a case that they say is non-precedential and so forth, but the MPEP
11 actually presumes that the Examiner is not going to allow in new matter in
12 claims via amendment later on. And it specifically says that the new matter
13 is required to be cancelled from the written description, and the claims
14 directed to the new matter are rejected under 35 U.S.C. § 112(a). So, the
15 presumption in the MPEP statement is that the Examiner is playing goalie
16 and is not going to allow these things in in the first place. And so, when you
17 look at it from that perspective, it fits perfectly in with the AIA in that there
18 should never be new matter introduced in claims that then issue. There
19 might be attempts to do that, but they should never issue. And in this case,
20 we think it did issue, and they are only entitled to the filing date, then. At
21 the earliest, it would be the filing date of the '723 application, probably
22 should actually go to when the claims were filed, but it doesn't really matter.
23 In either case, it becomes an AIA patent.

24 The other point I would make then on just written description, unless
25 Your Honors have any other questions on PGR eligibility?

1 JUDGE JUNG: I don't have any questions.

2 MR. STACH: All right. Written description. This is their Slide 10 in
3 their demonstratives, and Mr. Price was talking about how there is this
4 disclosure at a pivot connection for the swing leg, and you might notice in
5 their briefing, in the papers, they summarize this as, that it's at the pivot
6 connection between the swing leg and the frame. And it's kind of like in the
7 top left corner, between the frame and swing leg, that the transducer is
8 disposed on either the frame or the swing leg. So, they're treating this
9 disclosure as if it applies to the frame and the swing leg, but when you look
10 at what they actually highlighted, and this is from the patent, it says that it's
11 at the pivot connection for the swing leg at the hinge bracket. It literally
12 says the hinge bracket, not the frame.

13 And I understand that they've shifted some of the language and they
14 claim that it's one in the same, effectively, if the hinge bracket is part of the
15 frame, but we think that's incorrect for the reasons I previously discussed.
16 So, I think that's all I have. Mr. Mroz, did you have any rebuttal? Do Your
17 Honors have any other questions for me?

18 JUDGE JUNG: No I don't.

19 MR. STACH: Thank you.

20 MR. MROZ: So briefly, Your Honors, with respect to the Claim 1
21 and 7 point that we were discussing earlier, the '723 Patent, just like the
22 other patents that were subject to the IPRs in the first round a couple years
23 ago, the '723 Patent has embodiments where this control system, the smart
24 leg or the swing leg pivoting and steering of the crawler track, that occurs in
25 coordinated fashion when both the crawler track is off the ground and when

1 the crawler track is on the ground. And the Board relied on the off-the-
2 ground embodiment in large part in the last set of IPRs, because the claims
3 could cover that type of embodiment. They could also cover an on-the-
4 ground embodiment, right? that they weren't restricted to that, as the Board
5 found, and that is what opened the claims up to the prior art, more so than
6 they would have been had it been restricted to on-the-fly steering capability
7 that G&Z alleges.

8 Here, we have a similar situation where this controller limitation in
9 Claim 7 can be performed with the same control system, whether the
10 machine is off the ground and on the ground. It's the same control system,
11 the same components. Nothing changes. The same sensors, the same rotary
12 actuator, slew drives, the same linear actuator that pivots the swing leg. And
13 that doesn't change when you're on the ground or off the ground.

14 So the question is, is there something in Claim 1 that makes this
15 happen on the ground? And the answer is no. And that's because of this
16 language you talked about earlier, Your Honor, the "configured to" language
17 in Claim 7. Where it says, wherein the processor is configured to receive the
18 first and second signals. And then in Claim 1, this language here, for the
19 slew gear drive, the wherein clause down near the bottom. The second to
20 last limitation, where it says wherein the slew gear drive is capable of
21 steering the crawler track under the load without lifting the crawler track.
22 So where that leaves us is, we could have a machine that is driving along the
23 road that is satisfying the steering limitation in Claim 1 without a pivoting
24 swing leg, but still has a processor and a control system capable of operating
25 in the way that Claim 7 says. But it doesn't have to actually be executing

1 that operation, because it just has to be capable of operating that way. Sorry,
2 configured to operate that way.

3 Likewise, or similarly, we could have a situation where the machine
4 has the leg off the ground, in Claim 7, and it's operating it in conjunction
5 with what Claim 7 says, coordinating is steering and pivoting. But the
6 crawler track, or the machine, is not driving. The crawler track is not on the
7 ground because it just has to be capable of steering the crawler track. So it
8 remains capable of steering while it's in the air, suspended. So that language
9 of "capable of" and "configured to" broadens these claims significantly, to
10 allow them to operate different ways at different times. There's no temporal
11 restriction, which is why we can have these different functionalities coming
12 in, operating at different times, that makes them not have this on-the-fly
13 steering restriction that they so desperately want in the claims.

14 And the last point, Your Honor, regarding the state of the art. I'll just
15 leave you with the admissions by Dr. Bryden on Littman. They admit this
16 crown jewel feature that they've relied on throughout these proceedings, this
17 on-the-fly steering feature. Their own expert admits it's in the prior art. He
18 admits it's in Littman, he admits it's in Skotnikov. He even called it on-the-
19 fly, without operator input. So, that's very strong evidence to support our
20 position that a person of skill in the art would in fact read CIII and Rio in a
21 way that discloses the limitation, the on-the-fly steering limitation that they
22 allege in this case, whatever that may be. But definitely the one in the
23 claims. Any questions, Your Honors?

24 JUDGE JUNG: Just one question. Littman is actually not part of
25 your proposed combination, correct?

1 MR. MROZ: Correct. It's the state of the art.

2 JUDGE JUNG: How should we use this? How does this fit into our
3 analysis?

4 MR. MROZ: Sure.

5 JUDGE JUNG: When we just look at your proposed combination?

6 MR. MROZ: Sure. So it's the same way that the other state of the art
7 evidence is, and the same way that the Board relied on the state-of-the-art
8 last time. So we have our CIII and Rio combination, and we have that
9 rendering obvious all limitations in the claims for this patent, and that
10 includes the feature -- to the extent there's an on-the-fly steering limitation
11 in this limitation in Claim 6, it renders that obvious. And it renders that
12 obvious because as the Board said, Rio has this coordinated control system
13 that looks just like Claim 7 in this patent, and then Rio also says you have,
14 as the Board concluded, you can deal with the torque and a person of skill in
15 the art would know how to address the torque and make it work on the
16 ground as well. So, Rio itself in combination with CIII renders this claim
17 limitation obvious. Nothing else is needed.

18 But, to the extent they say a person of skill in the art wouldn't do that
19 -- that's what they're arguing. We have the state-of-the-art evidence to back
20 this up and show, with the evidence in the record, to show that yes, it
21 actually would, because a person of skill in the art did do this. They did it in
22 Littman, they did it in Skotnikov. And their expert admitted that these
23 features were known before the priority date of these patents, because he
24 knew they were known in these references.

25 JUDGE JUNG: Thank you, Mr. Mroz. I have no further questions.

1 MR. MROZ: Thank you, Your Honors.

2 MR. PRICE: Okay, a couple things, Your Honor. One major
3 correction I want to make about something I said during my opening
4 remarks. For the '135 case, the argument was actually about Claim 8 of the
5 '571. So those arguments showing written description for those limitations
6 were about Claim 8 of the '571 Patent, they were not for an independent
7 claim. Same issue, same claim, two different decisions. Not raised in the
8 Petition. Collateral estoppel applies to ours, not theirs.

9 So then moving on to the MPEP question about whether or not the
10 written description issue can give rise. My friend is absolutely right, the
11 Examiner should catch this stuff. And if the -- but, the key part is that a
12 written description defect does not affect the effective filing date of the
13 claims, which is all you care about when you want to know if it's an AIA
14 patent or not. The claim very well may be invalid under 112, it doesn't
15 change the AIA status of the patent or the application that led to the patent.

16 Your Honors asked for a picture of the transducer and where it was on
17 the hinge bracket. So, we can look at Figure 5. So, the transducer is number
18 78, and what you see is it's right on top of this cylindrical thing, and that
19 cylindrical thing is the piece of the swing leg that's captured within the
20 hinge bracket and moves. So, certainly on the swing leg. We think that a
21 person of ordinary skill in the art understands that if you just switched the
22 orientation, and you have the little lever on that moves, if you put it upside
23 down, then you have it disposed actually on the hinge bracket, and that
24 means it's disposed on the module frame, because that's the actual angle that
25 you care about, is the angle between the frame and the swing leg.

1 I think, then moving on to the on-the-fly steering embodiments, I
2 think my friend's arguments about Claim 1 and Claim 6, they don't hold
3 water because both of them say you're doing this stuff under load, while the
4 thing is on the ground. You can try to --

5 JUDGE JUNG: Let me just make sure you're addressing the correct
6 point. The language is "capable of" or "configured to." That seems to
7 include embodiments more than just on-the-fly.

8 MR. PRICE: Well no, it requires that you be capable of doing those
9 things. So, therefore, prior art that only teaches doing it one way doesn't
10 satisfy the claim, because the claim requires that you are doing this under
11 load, that it be capable of doing it under load, right? So whether or not the
12 machine is also capable of doing something in a different way, the claims
13 require -- and this is different from the '749 case. The claims themselves
14 require that you are steering under load.

15 JUDGE JUNG: It seems like this claim would read on, for example,
16 the S600, sitting on the back of a semi being transported to the work site, it's
17 still capable of, right?

18 MR. PRICE: As long as it's capable of. But what's not capable of it
19 is CIII and Rio. They are not capable of coordinated steering of the swing
20 leg and the crawler track under load. Look, we're claiming a paving
21 machine.

22 JUDGE JUNG: Does that also apply to their proposed combination?

23 MR. PRICE: That also applies to their proposed combination, yes.
24 And it specifically applies to the proposed combination because in CIII and
25 Rio, those legs are locked, right? Now, there are -- and I see I'm over my

1 time, but you know, the state of the art -- and this is really important.
2 They're not alleging an obviousness combination with these other
3 references. And state of the art is supposed to be about how a person of
4 ordinary skill in the art would read one of the references. It doesn't tell you
5 what you're going to do with a big slip form paver.

6 JUDGE JUNG: Okay, thank you Mr. Price.

7 MR. PRICE: Thank you. Your Honors, do you have any other
8 questions?

9 JUDGE JUNG: No. Okay, thank you both for your presentations; it
10 was very helpful. Your cases are submitted, and we are adjourned.

11 (Whereupon, the above-entitled matter went off the record at 3:28
12 p.m.)

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