UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GODBERSEN-SMITH CONSTRUCTION COMPANY
d/b/a/ GOMACO CORPORATION,
Petitioner,

v.

GUNTERT & ZIMMERMAN CONST. DIV., INC.,
Patent Owner.

Case PGR2024-00026
Patent No. 11,772,723

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

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I. Introduction

The parties previously litigated four IPRs to conclusion, with the Board finding all challenged claims unpatentable and the Federal Circuit summarily affirming the Board's decisions. The patent challenged in this PGR contains similar claims as the patents in the prior IPRs, and many of G&Z's arguments are identical to those raised in prior proceedings. The Board correctly rejected those arguments in the earlier cases, and it correctly rejected them here, too. Moreover, earlier this year, the Acting Director rejected G&Z's PGR-eligibility arguments, and G&Z has cited no new evidence or argument that would justify seeking Director Review on the same issue for a second time. The Director should deny review.

II. The '723 Patent Is PGR Eligible

A. The Board's Non-Appealable Institution Decision in IPR2021-00135 Does Not Override the Board's Federal-Circuit-Affirmed Final Written Decision in IPR2021-00136

G&Z vigorously fought IPR2021-00136, where Gomaco successfully challenged G&Z's U.S. Patent No. 9,908,571. After a full trial, the Board concluded that the challenged claims were obvious and found that claim 8 of the '571 patent was a post-AIA claim having an effective filing date of June 14, 2017. IPR2021-00136, Paper 61 at 10-11. The Federal Circuit affirmed. *Guntert & Zimmerman Const. Div., Inc., v. Godbersen-Smith Const. Co. dba Gomaco Corp.*, No. 2022-1835, 2024 WL 193079 (Jan. 18, 2024).

Meanwhile, G&Z obtained the patent at issue in this PGR (U.S. Patent No. 11,772,723), which claims priority to the post-AIA '571 patent. Because the challenged '723 patent claims priority to a post-AIA patent, it too is a post-AIA patent that is subject to post-grant review. America Invents Act, Pub. L. No. 112-29, § 3(n)(1), 125 Stat. 284, 293 (2011).

Nonetheless, before institution here, G&Z argued that the Board should disregard its Federal-Circuit-affirmed Final Written Decision in favor of the Institution Decision in IPR2021-00135. Paper 8 (POPR) at 5-7; Paper 10 (Patent Owner's Preliminary Sur-Reply) at 1-4. G&Z contends that the Board found the '571 patent to be entitled to an earlier priority date, and that this non-appealable finding on a limited record collaterally estops Gomaco from demonstrating PGR eligibility and insulates the '571 patent from PGR. The Board correctly rejected this argument in its Institution Decision. Paper 11 at 7-13. G&Z sought Director Review, but the Acting Director denied G&Z's request. Paper 14 (G&Z's request for Director Review of the Institution Decision); Paper 15 (order denying Director Review).

With no new information or a change in law that would justify altering the Board's and Acting Director's decisions, G&Z again raised this issue in its Patent Owner's Response and at the oral hearing. Paper 18 (Patent Owner's Response) at 4-8; Paper 47 (Oral Hearing Transcript) at 50:9-58:9. The Board once again rejected G&Z's argument in its Final Written Decision. Paper 48 (FWD) at 8-14.

G&Z now raises the issue for a fourth time—and for the second time on Director Review. But the operative facts governing collateral estoppel have not changed from when the Acting Director rejected G&Z's identical argument. Here, G&Z relies on the same facts, same arguments, and even the same case law as it did in its prior request for Director Review. *Compare* Paper 51 at 3-10, *with* Paper 14 (G&Z's request for Director Review of the Board's Institution Decision). Repeatedly asking the Director to address the same issue is an abuse of the Director Review process. It unnecessarily burdens the Director and the parties, and the Director should not incentivize others to do the same by entertaining G&Z's request.

Even if the Director analyzes the request, G&Z's collateral estoppel arguments remain legally flawed. Any findings adverse to Gomaco in the Board's IPR2021-00135 Institution Decision cannot give rise to collateral estoppel because non-appealable decisions, like institution decisions, cannot give rise to estoppel. 35 U.S.C. § 314(d) ("No Appeal.—The determination by the Director whether to institute an inter partes review under this section shall be final and nonappealable.").

Several of G&Z's cited authorities discuss this exception. For example, the cited Restatement (Second) of Judgments identifies several "exceptions to the general rule of issue preclusion," the first being that preclusion does not apply where "[t]he party against whom preclusion is sought could not, as a matter of law, have obtained review of the judgment in the initial action." Restatement (Second) of

Judgments § 28(1) (1982). The Federal Circuit endorsed this exception in another case relied on by G&Z, *Jackson Jordan, Inc. v. Plasser American Corporation*, 747 F.2d 1567, 1577-78 (Fed. Cir. 1984). There, the court found that when a party could not have appealed, their adversary "could not invoke an estoppel" against them. And the Federal Circuit continues to apply this exception.

Last year, the court found that it lacked jurisdiction to hear an appeal of a claim construction issue. *Mantissa Corp. v. First Fin. Corp.*, No. 2022-1963, 2024 WL 607717, *5-6 (Fed. Cir. Feb. 14, 2024). It then explained that, "[b]ecause we lack authority to rule on the issue, the parties **would not be collaterally estopped** from contesting the issue in the other cases that adopted the district court's claim construction." *Id.*, *6 n.3 (emphasis added). Likewise, because the Federal Circuit lacked authority to rule on any appeal Gomaco might have filed from the IPR2021-00135 Institution Decision, that decision cannot have preclusive effect.

The same is true if Gomaco had sought a writ of mandamus, which is not available except in extraordinary circumstances. *See Thryv v. Click-to-Call*, 590 U.S. 45, 54 n.6 (2020). In particular, mandamus review is limited to colorable constitutional claims and a narrow class of statutory challenges that do not apply here. *See, e.g.*, *In re Motorola Sols., Inc.*, 159 F.4th 30, 36 (Fed. Cir. 2025) ("[M]andamus is ordinarily unavailable for review of institution decisions . . . [with] possible exceptions for 'colorable constitutional claims,' . . . and certain statutory

challenges."); *Mylan Lab'ys Ltd. v. Janssen Pharm., N.V.*, 989 F.3d 1375, 1379 (Fed. Cir. 2021) ("[T]here is no reviewability of the Director's exercise of his discretion to deny institution except for colorable constitutional claims."). Run-of-the-mill priority decisions, like the one G&Z relies on in IPR2021-00135, are not subject to mandamus review, and G&Z cites no authority to support its argument that mandamus was available here. *See* Paper 51 at 5-6.

Because an extraordinary writ like mandamus was not available, it cannot support a finding of collateral estoppel. Holding otherwise would trigger a flood of mandamus petitions hoping to avoid collateral estoppel from institution denials, which would place an unnecessary burden on the Federal Circuit and the Office in deciding and responding to these petitions.

Collateral estoppel also does not apply here because the parties did not litigate and the Board did not decide in IPR2021-00135 whether the "laterally telescoping leg" and "linear position transducer" limitations of claim 8 of the '571 patent lack written description support in any priority document. Instead, in the IPR2021-00135 Petition, Gomaco spent 15 pages detailing how the challenged claims lacked an earlier priority date because the forward and aft "bolster" limitations were not supported. IPR2021-00135 Paper 1 at 8-22. To show that these problems with the bolster limitations were not isolated issues, at the end of this extended argument, Gomaco provided a passing reference to other limitations that were also not

supported, including the "laterally telescoping leg" and "linear position transducer" of claim 8. *Id.* at 23. Gomaco did not analyze those additional features in the Petition.

The Board understood that Gomaco had narrowly focused its arguments on the bolster limitations, stating that "[t]he primary dispute is whether the '096 application adequately discloses 'a forward bolster connected to the forward end of the center module' and 'an aft bolster connected to the aft end of the center module,' as recited in claim 1." IPR2021-00135, Paper 11 at 11. The Board then recognized that Gomaco's passing references to other claim limitations were not sufficient to "raise a meaningful challenge" and declined to further analyze them. *Id.* at 11-12 (quoting *Novartis AG v. Torrent Pharms.*, 853 F.3d 1316, 1326 n.2 (Fed. Cir. 2017)). While the Board did state that for purposes of institution it was finding written description support for the non-bolster limitations, it did so expressly due to the "absence of any explanation from Petitioner," not because the issues had been litigated, analyzed, and decided. *Id.* at 12.

This is similar to a case G&Z relied on, *Voter Verified, Inc. v. Election Systems and Software LLC*, 887 F.3d 1376, 1383 (Fed. Cir. 2018). In that case, the court held that an issue was not actually litigated—and therefore no estoppel attached—where, as here, the issue "was in fact barely considered" and "the court did not evaluate the question." *Id.* (citing Restatement (Second) of Judgments § 27, cmt. e (1982)). Indeed, when seeking to avoid having collateral estoppel apply to itself, G&Z argues

that a failure to meaningfully raise an issue means that no estoppel attaches. *See* Paper 51 at 7-9 (citing cases). But G&Z argues the exact opposite—without any explanation for why a different result should apply—when attempting to have estoppel apply to Gomaco. The law does not support applying collateral estoppel to Gomaco, and the non-appealable IPR2021-00135 Institution Decision does not preclude Gomaco from arguing PGR eligibility.

With this background, it is understandable why the Board stated in the Final Written Decision that "[t]he parties in IPR2021-00135 . . . did not present arguments specifically for claim 8." Paper 48 (FWD) at 14. There, the focus of the priority challenge was on the bolster limitations in claim 1, not the additional features in dependent claim 8. IPR2021-00135 Paper 1 (Petition) at 8-23; Ex. 2001 at 18-23. While G&Z contends that *it* raised issues regarding claim 8 and that the Board resolved those issues in G&Z's favor (Paper 51 at 3-4), G&Z neglects to mention that the basis for the Board's decision was "the absence of any explanation from Petitioner," not because the issue was fully litigated and decided in G&Z's favor. Thus, as the Board correctly explained in the Final Written Decision here, "[t]he Decision Denying Institution [in IPR2021-00135] did not reach whether the subject matter of claim 8 had support in the application asserted to be prior art to claim 1 and did not determine explicitly what was claim 8's effective filing date." Paper 48 at 12. This correct finding does not warrant vacatur or reversal.

B. The Board Did Not Rely on Collateral Estoppel Regarding IPR2021-00136, But Even if It Had, It Would Have Been Correct

G&Z argues that the "Board improperly accorded collateral estoppel effect to the -00136 Decision without establishing that the decision meets the standard for collateral estoppel." Paper 51 at 7. But the Board expressly stated that it was **not applying collateral estoppel** to that decision. Paper 48 (FWD) at 13 ("Based on the full record, we do not need to reach the issue of whether collateral estoppel applies to Petitioner's arguments . . . ."). G&Z's argument is a straw man that does not address the Board's rationale, and the Director should reject it on this basis alone.

G&Z is also incorrect that "there is no other open issue that could support a finding that the '723 Patent is eligible for PGR" except collateral estoppel. Paper 51 at 9. To the contrary, in the Petition, Gomaco directed the Board not only to its Federal-Circuit-affirmed Final Written Decision, but also (1) identified the language in '571 patent claim 8 that Gomaco contends is "lacking support in all pre-AIA priority applications" (*i.e.*, "a laterally telescoping leg" and "linear position transducer"), and (2) identified specific "new subject matter" added in the application that led to the '571 patent. Paper 1 at 119 (citing the '571 patent in Ex. 1035 at 17:33-18:25 and 23:48-24:3).

The Board was free to adopt its prior analysis regarding these arguments, and it expressly did so by explaining that, "**[a]s previously determined**, 'at least claim

8 of the ’571 patent has an effective filing date of June 14, 2017.’” Paper 48 (FWD) at 13 (emphasis added). It then cited its prior analysis contained in the Final Written Decision in IPR2021-00136. *Id.* Because the Board continued to find its prior rationale persuasive, it found the ’723 patent to be PGR eligible. This was not the Board applying collateral estoppel, but merely agreeing with arguments Gomaco made in the Petition that happened to also be addressed in a prior decision.

Even if the Board had applied collateral estoppel and even if it was the only basis for the Board’s decision (both of which are not true), G&Z’s failure to dispute the priority date for ’571 patent claim 8 in IPR2021-00136 does not preclude applying collateral estoppel. *See, e.g.*, *Google LLC v. Parus Holdings, Inc.*, IPR2022-00279, Paper 16 at 18-19 (PTAB Sept. 18, 2023). In IPR2021-00136, the issue about the priority date for ’571 patent claim 8 is identical to the one presented here; Gomaco raised the issue and the Board decided it in Gomaco’s favor after G&Z had a full and fair opportunity to litigate the issue; and the resolution was essential to the judgment because the Dahm prior-art reference was only prior art if claim 8 lacked an early priority date. Thus, the Board’s decision, which the Federal Circuit affirmed, meets every requirement for applying collateral estoppel.

III. The Board Considered the Motivation-to-Combine Arguments That G&Z Alleges Were Overlooked

Throughout this PGR, G&Z asserted two primary arguments in response to

Gomaco's modification of CIII with Rio: (1) one would not have coupled Rio's rotary actuator between the bottom of CIII's jacking column and the top of the crawler track to rotate the crawler track relative to the jacking column (Paper 18 (POR) at 17-28); and (2) one would not have used Rio's control system, which pivoted its swing leg in coordination with rotating its crawler track, on the CIII machine while CIII's crawler track was under load (*id.* at 28-46). G&Z referred to this second argument as "on-the-fly" steering. *See, e.g.*, *id.* at 29, 34, 40.

Regarding the first argument, the Board considered G&Z's positions throughout the Final Written Decision, including on numerous pages other than pages 47-50. Paper 48 (FWD) at 34-35, 37-38, 45-48. It ultimately found, however, that Rio's rotary-actuator-positioning disclosures, along with other evidence, including admissions by G&Z's expert and state-of-the-art evidence showing rotary drives positioned between jacking columns and crawler tracks, proved obviousness. Paper 48 at 36, 38-39, 43-51. G&Z's argument that the Board only addressed the "rotary actuator issue" on pages 47-50 of the FWD is wrong. Paper 51 at 10.

Regarding G&Z's on-the-fly steering argument, the Board similarly summarized G&Z's positions throughout the Final Written Decision. Paper 48 at 48, 52-53, 76-78, 82-83, 85, 87-88, 90-92. But the Board again found the relevant claim limitations obvious in view of Rio as applied to CIII and Tax. *Id.* at 51-59, 75-93. G&Z incorrectly represents that the Board did not consider pages 11-14 of its Sur-

Reply in its analysis. *See* Paper 51 at 10. The Board expressly referred to pages in this range when discussing on-the-fly steering. Paper 48 at 35-36, 47-48,

G&Z also mischaracterizes the record on Rio's anti-swing device. Paper 51 at 11. Gomaco argued that a skilled artisan would have replaced the locking pins and turnbuckles on CIII's swing leg with Rio's anti-swing device because the anti-swing device allowed for automated control of the swing leg such that it could automatically toggle between a locked state and a state where it was free to pivot. Paper 1 at 38, 54; Paper 26 (Reply) at 20. Contrary to G&Z's assertions, Gomaco asserted this position in its Petition, and it never changed. The Board considered G&Z's responsive arguments several times, and even cited to the allegedly overlooked pages 11-14 of G&Z's Sur-Reply in multiple instances. *See, e.g.*, Paper 1 at 47-48, 51, 76, 78-79, 83, 85. It ultimately found for Gomaco and provided sound reasoning in doing so. *See, e.g.*, Paper 48 at 50-51, 56-58, 78-80, 84-88.

IV. The Board Correctly Rejected G&Z's Secondary Considerations Arguments

A. The Board Correctly Found that G&Z Did Not Carry Its Burden of Proving that Its Claims Were Limited to "On-the-Fly Steering," Negating the Alleged Nexus for Every Secondary Consideration, Including Long-Felt Need

In prior proceedings on related patents, the Board rejected G&Z's secondary considerations arguments, and the Federal Circuit summarily affirmed in the decision discussed above in Section II.A. Here, G&Z presented nearly identical

arguments, except in many instances G&Z's proof was even more deficient than it was in the prior proceedings. Regarding the required nexus, for example, while G&Z attempted to provide claim charts and testimony demonstrating that one of its pavers was covered by the claims in the prior proceedings, it provided essentially no showing of nexus here. The nexus section of G&Z's Patent Owner's Response was about two pages long and mostly quoted G&Z's self-serving marketing literature. Paper 18 (POR) at 46-48. G&Z's Sur-Reply was similarly deficient, providing only a single paragraph regarding nexus, which inaccurately contended that Gomaco "only musters a conclusory denial" regarding nexus, despite the numerous arguments in Gomaco's Reply showing there was no nexus for the secondary considerations. *See* Paper 33 (Sur-Reply) at 19; Paper 26 (Reply) at 22-29.

The Board reviewed and cited the relevant passages of G&Z's papers and agreed that G&Z "does not argue how the claims are limited to a 'paving machine that could reposition its swing legs and crawler tracks while moving and under load,'" as G&Z alleged. Paper 48 (FWD) at 64 (citing Paper 18 (POR) at 47-51 and Paper 33 (Sur-Reply) at 19-22). Because G&Z failed to demonstrate that its evidence was tied to claimed features as opposed to unclaimed features, the Board correctly found that G&Z did not carry its burden of demonstrating a nexus. The Director should reject G&Z's attempt to spin this as an unresolved claim construction issue as opposed to a failure of proof on nexus.

G&Z also incorrectly contends that "Gomaco argu[ed] that only Claim 6 is limited to on-the-fly steering." Paper 51 at 12. But Gomaco never argued this. Instead, Gomaco acknowledged that G&Z "seeks to confine Claim 6 to its limited definition of on-the-fly-steering," but that "GOMACO **disagrees that the claim is so limited**." Paper 26 (Petitioner's Reply) at 14 (emphasis added). As Gomaco explained in its Reply, G&Z's own expert contradicted G&Z's argument that claim 6 is limited to "on-the-fly steering," including admitting that claim 6 covers situations where the machine frame is stationary and not moving forward under load. Paper 26 (Reply) at 19-20 (citing Ex. 1185 at 8:10-13:24, 59:3-63:7).

B. The Board Correctly Rejected G&Z's Copying Arguments with the Same Language It Used in Prior Decisions that Were Affirmed by the Federal Circuit

In prior cases, the Board evaluated G&Z's copying evidence alongside testimony from Gomaco's Vice President of Engineering and Research & Development, as well as Gomaco's internal development documents for the machine that G&Z contends Gomaco copied from G&Z. IPR2020-01698, Paper 80 at 88-91. It concluded that Gomaco's "selection of a slew drive was the product of routine engineering processes," not copying. *Id.* at 90. It then stated that, although using a slew drive "may support an inference of copying, the totality of the evidence does not support copying." *Id.* at 91. The Board repeated this identical statement in the Final Written Decision in this PGR. Paper 48 (FWD) at 68. In this context, it is no

mystery why the Board found G&Z's evidence lacking and correctly found that G&Z's "evidence of copying is entitled to little weight." *Id.* The Federal Circuit summarily affirmed the Board's prior decisions containing this same conclusion. In addition, the Board correctly found that G&Z had not demonstrated a nexus between the claims and its alleged secondary considerations, as discussed above in Section IV.A. There is no reason for the Director to disturb the Board's findings here.

C. The Board Correctly Weighed G&Z's Witness Testimony Regarding Industry Praise

G&Z first alleges that the Board erred in not giving significant weight to G&Z's evidence of industry praise because the Board discounted G&Z's evidence of copying. Paper 51 at 14. But the Board correctly discounted this evidence for the reasons discussed above in Section IV.B.

G&Z then argues that the Board ignored "praise from industry professionals merely because it did *not* come from competitors." Paper 51 at 14 (emphasis in original). But the Board did not ignore this evidence entirely. It merely recognized that because it did not come from competitors, it was not "the most compelling evidence." Paper 48 (FWD) at 70. Moreover, G&Z's cited declarations focus on high-level functionality (e.g., maneuverability) that was already present in the prior art. As the Board recognized in other contexts, nearly every feature G&Z and its declarants mentioned was already present on Gomaco's own prior-art CIII machine.

See id. at 68 ("[M]ost of the similarities identified represent features found on CIII.").

And G&Z once again does not demonstrate a nexus between the alleged praise and the claimed technology. It links the alleged praise to its "SmartLeg/AccuSteer" technology, which it "contends corresponds to the on-the-fly steering embodiment covered by the claims." Paper 48 (FWD) at 69. But as discussed in Section IV.A, the Board correctly found that G&Z had not demonstrated how the claims are limited to "on-the-fly steering" as G&Z has used that term. *Id.* at 64. Thus, there was no basis for the Board to accord significant weight to G&Z's cited testimony.

V. Conclusion

For these reasons, the Director should deny G&Z's request for Director Review. If the Director believes that any of Board's rationales are unclear, the appropriate remedy is to remand with instructions to provide further explanation, not to reverse.

Respectfully submitted,

Dated: December 23, 2025

By: /Jason Stach/
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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST was served on December 23, 2025. The parties have agreed that filing through the PTAB's P-TACTS system constitutes electronic service on Patent Owner, and Petitioner filed the document via the PTAB's P-TACTS system. Accordingly, Petitioner electronically served Patent Owner's counsel of record, including James Hannah, Jeffrey H. Price, and Jenna Fuller.

Dated: December 23, 2025

By: /Daniel E. Doku/
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