

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SIMPSON STRONG-TIE COMPANY INC.,  
Petitioner,

v.

COLUMBIA INSURANCE COMPANY,  
Patent Owner.

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PGR2024-00050  
Patent 11,920,339 B2

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Before JEFFREY N. FREDMAN, NEIL T. POWELL, and  
STEPHEN E. BELISLE, *Administrative Patent Judges*.

FREDMAN, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 C.F.R. §§ 42.5, 42.51(b), 42.54

The parties requested a conference call to discuss Patent Owner's proposed motion for discovery. *See* Ex. 3001 (March 26, 2025 email from Patent Owner's counsel, John R. Schroeder). According to the email requesting a conference call, Patent Owner sought authorization to file a motion for discovery "for permission to use the documents and materials that are already in the possession of Patent Owner's counsel, but currently restricted from being used by Patent Owner in this proceeding as the documents and materials were obtained subject to a protective order." *Id.* The email indicated that Petitioner opposed Patent Owner's request and that should Patent Owner's request be granted, "Petitioner will file a Motion to Seal and a jointly proposed protective order, as well as likely request a similar Motion for additional discovery during the course of the proceeding to present rebuttal evidence." *Id.*

The requested conference call was held on March 31, 2025. No court reporter was present in the conference call. During the conference, Patent Owner explained that even though documents and materials Patent Owner seeks to use in this proceeding have already been obtained from Petitioner in the co-pending district court litigation, a protective order by the district court restricts Patent Owner from using them in this proceeding. Patent Owner asserted that it is trying to work with the district court in obtaining permission to use them in this proceeding, but Patent Owner expressed a concern that the timing of the district court's permission is uncertain.

Petitioner did not dispute that the documents and materials produced in the co-pending district court litigation would be subject to the district court's protective order. Petitioner asserted that Patent Owner has not been forthcoming about specifying which documents, out of Petitioner's

voluminous production in the district court litigation, Patent Owner seeks to use in this proceeding. Petitioner asserted that Patent Owner is seeking blanket permission from the Board to use any documents and materials that are subject to the district court's protective order.

After considering Patent Owner's arguments and Petitioner's responses during the conference, we urge the parties to file a joint motion to the district court requesting a modification of the district court's protective order authorizing the limited use of identified specific relevant and protected documents for use in the PTAB proceeding.

Concurrently, we also grant Patent Owner's request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) as requested in Patent Owner's March 26, 2025 email. *See* Ex. 3001. Patent Owner's motion is limited to seven pages of argument and must be filed within 7 business days of this Order. If Patent Owner files a motion for additional discovery, we ask that a copy of the district court's protective order at issue be filed concurrently as an exhibit in this proceeding.

Petitioner may file an opposition to Patent Owner's motion. Petitioner's opposition is limited to seven pages of argument and must be filed within 7 business days of being served with Patent Owner's motion. No reply to the opposition is authorized at this time.

Additionally, if the parties file documents or information subject to motion(s) to seal, a proposed protective order to be applied to documents or information sought to be the subject of the motion(s) to seal shall be filed in this proceeding. The parties may agree to adopt the Default Protective Order set forth in the Consolidated Trial Practice Guide. *See* Consolidated Trial

Practice Guide<sup>1</sup> at 117–122. Alternatively, the parties may propose modifications to the Default Protective Order, such as a protective order entered by the district court. *See id.* at 115–116. Regardless, any proposed protective order in this case shall not be less protective of documents and information than the district court’s protective order as amended.

## ORDER

It is hereby:

ORDERED that the parties jointly seek from the district court modification of the district court’s protective order and permission to use in this proceeding documents and information subject to the district court’s protective order;

FURTHER ORDERED that Patent Owner’s request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b) is *granted*;

FURTHER ORDERED that Patent Owner’s motion is limited to seven pages of argument and must be filed within 7 business days of this Order;

FURTHER ORDERED that, if Patent Owner files a motion for additional discovery, a copy of the district court’s protective order shall be filed concurrently as an exhibit;

FURTHER ORDERED that Petitioner may file an opposition limited to seven pages of argument within 7 business days of being served with Patent Owner’s motion; and

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<sup>1</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

FURTHER ORDERED that, if the parties file documents subject to motion(s) to seal, a proposed protective order to be entered in this proceeding shall be filed in this proceeding.

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