

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIMPSON STRONG-TIE COMPANY INC.,
Petitioner

v.

COLUMBIA INSURANCE COMPANY,
Patent Owner

Case PGR2024-00050
U.S. Patent No. 11,920,339

JOINT MOTION TO TERMINATE POST-GRANT REVIEW

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
P.O. Box 1450
Alexandria, VA 22313

PETITIONER’S UPDATED EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,920,339 to Brekke et al. (“the Patent-at-Issue”)
1002	Prosecution History of the Patent-at-Issue
1003	Declaration of W. Andrew Fennell in Support of Petition for Post-Grant Review of U.S. Patent No. 11,920,339
1004	GB Patent App. Pub. No. 2,451,853A (Cullen)
1005	U.S. Patent No. 9,394,680 to Bundy et al. (“Bundy”)
1006	U.S. Patent No. 4,827,684 to Allan (“Allan”)
1007	Japanese Design Patent No. D1213894 to Yamaguchi (Yamaguchi) with attached certified English-language translation
1008	Japanese Application No. 19991014482 to Tsukamoto (“Tsukamoto”)
1009	U.S. Patent No. 4,696,113 to Rice (“Rice”)
1010	U.S. Patent App. Pub. No., 2011/0047806 to Harrison (“Harrison”)
1011	GB Patent App. Pub. No. 2,433,522 to Robinson (“Robinson”)
1012	“Technical Bulletin: Top Flange Joist Hangers Installed on Walls Over Wood Structural Patent Sheathing or Drywall”, Simpson Strong-Tie Company, Inc., published August 2013.
1013	U.S. Patent No. 4,196,556 to Russo (“Russo”)
1014	U.S. Patent No. 9,151,058 to Leathe (“Leathe”)
1015	U.S. Publication No. 2001/0054270 to Rice (“Rice”)

Exhibit No.	Description
1016	<i>Fire-Rated Assemblies in Commercial Construction</i> (“ <i>The Purple Book</i> ”), National Gypsum Properties, LLC (November 5, 2013)
1017	<i>GA-600-2012 Fire Resistance Design Manual, 20th Ed.</i> , Gypsum Association (June 2012).
1018	<i>2012 International Building Code</i> , International Code Council, June 2011 (“IBC-2012”)
1019	WoodWorks, Four-story Wood-frame Structure over Podium Slab (2010) (“WoodWorks”).
1020	ASTM C1396 Standard Specification for Gypsum Board (2001).
1021	U.S. Patent Application Publication No. 2012/0219785 to Yu et al. (“Yu”).
1022	U.S. Patent No. 3,601,428 to Gilb
1023	U.S. Patent No. 3,633,950 to Gilb
1024	U.S. Patent No. 3,752,512 to Gilb
1025	U.S. Patent No. 4,480,941 to Gilb
1026	EP Patent No. 0210744 B1 to Adams (“Adams”)
1027	U.S. Patent Application Pub. No. 2008/0134620 to Contasti (“Contasti”)
1028	<i>Curriculum Vitae</i> of Andrew Fennell
1029	Ferguson, Drywall: Professional Techniques for Great Results, Taunton Press, 2012
1030	U.S. Patent No. 4,261,155 to Gilb (“Gilb’155”)

Exhibit No.	Description
1031	“Mass Timber and Wood Framing,” Architectural Record Magazine, McGraw Hill Construction, November 2012, pp. 165-169 (“ArchRecord”)
1032	U.S. Patent No. 4,714,372 to Commins (“Commins”)
1033	ASTM C840 Standard Specification for Application and Finishing of Gypsum Board (2001)
1034	2012 International Building Code
1035	Definitions of “plate” and “bounding,” Merriam Webster’s Collegiate Dictionary, Tenth Edition, Merriam-Webster, Inc., 1993
1036	U.S. Patent App. Pub. No. 2005/0155307 to Timony (“Timony”)
1037	U.S. Patent Provisional App. No. 61/922,531 to Brekke et al. (’339 Prov”)
1038	The Gypsum Construction Handbook, Sixth Edition, USG Corporation, Published by John Wiley & Sons, Inc. 2009
1039	Declaration of Sylvia D. Hall-Ellis, Ph.D.
1040	Curriculum Vitae of Sylvia D. Hall-Ellis, Ph.D.
1041	Wayback Machine Screenshot of Architectural Record website (November 12, 2012)
1042	Wayback Machine Screenshot of Architectural Record Continuing Education Website (January 23, 2013)
1043	Wayback Machine Screenshot of Wikipedia Architectural Record Entry (December 5, 2012)
1044	Declaration of Joseph V. Mauch in support of Motion for <i>Pro Hac Vice</i> Admission

Exhibit No.	Description
1045	Declaration of Lindsay A. van Keulen in support of Motion for <i>Pro Hac Vice</i> Admission
1046	Declaration of Erick C. Howard in support of Motion for <i>Pro Hac Vice</i> Admission
1047	Declaration of Sam Hensen
1048	Declaration of Tom Evans
1049	Michael Nelson Deposition Transcript
1050	Ryan Holmes Deposition Transcript
1051	Mike Alley Deposition Transcript
1052	Richard Kazckowski Deposition Transcript
1053	Dwight Duncan Deposition Transcript
1054	Thomas Irmiter Deposition Transcript
1055	Paul Tucker Deposition Transcript
1056	Chris Horwitz Deposition Transcript
1057	Matt Church Deposition Transcript
1058	Andrea Baranyk Deposition Transcript
1059	“outward” definition, <i>Merriam-Webster Dictionary</i>
1060	“close” definition, <i>Merriam-Webster Dictionary</i>
1061	“conformance” definition, <i>Merriam-Webster Dictionary</i>
1062	U.S. Patent No. 4,464,877 to Gebhardt et al. (“Gebhardt”)
1063	U.S. Patent App. Pub. No. 2012/0219785 to Yu et al. (“Yu”)
1064	U.S. Patent No. 10,024,049 to Brekke et al. (’049 patent)

Exhibit No.	Description
1065	U.S. Patent No. 11,649,626 to Brekke et al. ('626 patent)
1066	<i>Simpson Strong-Tie Company, Inc. Columbia Insurance Co., PGR2023-00047, Final Written Decision, Paper 14 (P.T.A.B. Feb. 28, 2025).</i>
1067	<i>Simpson Strong-Tie Company, Inc. Columbia Insurance Co., PGR2021-00109, Final Written Decision, Paper 73 (P.T.A.B. Mar. 15, 2023).</i>
1068	Supplemental Declaration of W. Andrew Fennell
1069	<i>Intentionally Left Blank</i>
1070	<i>Intentionally Left Blank</i>
1071	Japanese Design Patent No. D1226744 to Kanai (Kanai) with attached certified English-language translation
1072	Wayback Machine Screenshot of Gypsum Association Website showing Fire Resistance Design Manual (GA-600-12) (November 12, 2012)
1073	Simpson Email (SST0012139) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1074	Simpson Email (SST0037770) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1075	Simpson Email (SST0087068) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1076	Simpson Email (SST0087225) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1077	Simpson Email (SST0087439) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1078	U.S. Patent No. 8,789,341 to Shepard

Exhibit No.	Description
1079	Simpson Photos of Prototype Joist Hangers (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1080	Simpson Email: forwarding IIC Complaint (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1081	U.S. Gypsum Company, “Pre Dry-In construction: The Evolution of Construction Starts From Within,” White Paper (2014)
1082	Simpson Email (SST0012140) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1083	Simpson Email (SST0012141) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1084	Simpson Email (SST0087474) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1085	Simpson Email (SST0037834) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1086	<i>Simpson Strong-Tie Company, Inc. Columbia Insurance Co., PGR2021-00109, Patent Owner’s Response, Paper 45 (P.T.A.B. Jun. 9, 2022).</i>
1087	<i>Simpson Strong-Tie Company, Inc. Columbia Insurance Co., PGR2019-00063, Patent Owner’s Response, Paper 27 (P.T.A.B. Jun. 4, 2020).</i>
1088	Patent Owner’s Response to Office Action mailed July 17, 2017 of U.S. Application No. 14/555,049 (the ’049 patent)
1089	Simpson Email (SST0086165) (PROTECTIVE ORDER MATERIAL - ATTORNEY EYES ONLY)
1090	Settlement Agreement (CONFIDENTIAL)

I. STATEMENT OF RELIEF REQUESTED

Petitioner Simpson Strong-Tie Company Inc. (“Simpson” or “Petitioner”) and Patent Owner Columbia Insurance Company (“Columbia” or “Patent Owner”) have entered into a confidential settlement agreement that resolves all underlying disputes between Petitioner and Patent Owner with respect to U.S. Patent No. 11,920,339 (“the ’339 patent”). A copy of the parties’ settlement agreement is being filed with this motion as Exhibit 1090 (the “Settlement Agreement”). The parties are concurrently filing a separate request that the Settlement Agreement be treated as business confidential information and be kept separate from the files of the involved patent, pursuant to 37 C.F.R. § 42.74(c).

Accordingly, the parties jointly move the Board to terminate this post-grant review (PGR) proceeding in its entirety, without rendering a final written decision. The Board authorized the parties to file this joint motion to terminate on November 24, 2025.

II. STATEMENT OF FACTS

On November 25, 2025, Petitioner and Patent Owner entered into a confidential Settlement Agreement. *See* EX1090 (Confidential). Under the terms of the Settlement Agreement, Petitioner and Patent Owner agreed to jointly seek termination of this proceeding.

III. ARGUMENT

37 C.F.R. § 42.72 provides that “[t]he Board may terminate a trial without rendering a final written decision, where appropriate, including where the trial is consolidated with another proceeding or pursuant to a joint request under 35 U.S.C. 317(a) or 327(a).” Termination of the present post-grant review proceeding in its entirety is in the interest of justice.

A. The Board Should Terminate this PGR in its Entirety

Good cause exists to terminate this proceeding. Petitioner and Patent Owner have settled their dispute regarding the ’339 patent, including both this proceeding and Patent Owner’s assertion of the ’339 patent in the related district court litigation, *Columbia Ins. Co. et al. v. Simpson Strong-Tie Co. Inc.*, 5:24-cv-01652.

Public policy favors terminating the present post-grant review proceeding. The federal courts have expressed a strong interest in encouraging settlement in litigation. *See, e.g., Bergh v. Dept. of Trans.*, 794 F.2d 1575, 1577 (Fed. Cir. 1986) (“The law favors settlement of cases.”), *cert. denied*, 479 U.S. 950 (1986). The Board’s Trial Practice Guide stresses that “[t]here are strong public policy reasons to favor settlement between the parties to a proceeding.” Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 46,768 (Aug. 14, 2012).

Additionally, termination of the proceeding at this stage, in view of the Settlement Agreement, is appropriate. The USPTO can conserve significant

administrative and judicial resources by terminating the proceeding now, removing the need for the Board to render a final written decision. The Board has terminated entire proceedings based on joint motions to terminate, even after the merits had been fully briefed and oral argument had occurred. *See Apex Med. Corp. v. Resmed Ltd.*, IPR2013-00512, Paper 39, at 2-3 (P.T.A.B. Sept. 12, 2014) (granting joint motion to terminate after the parties had fully briefed the matter because the Board “has not yet decided the merits of this proceeding, and the record is not yet closed.”); *Lam Research Corp. v. Flamm*, IPR2015-01764, Paper 27, at 5 (P.T.A.B. Dec. 15, 2016) (granting motion to terminate after all briefing and oral argument when statutory deadline for rendering final written decision is within two months of motion).

Finally, because the Board has not decided the merits of the proceeding, the expected normal course is to terminate the proceeding upon settlement. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,768 (Aug. 14, 2012) (“The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.”).

B. Written Agreement

The parties represent that their entire agreement in connection with the termination of this proceeding is embodied in the Settlement Agreement, which has been made in writing. There are no collateral agreements or understandings

made in connection with, or in contemplation of, the termination of this post-grant review.

A true and correct copy of the Settlement Agreement is filed herewith as Exhibit 1090. The Settlement Agreement has been filed for access by the “Parties and Board Only” due to the highly sensitive business confidential information it contains. The parties desire that the Settlement Agreement be maintained as business confidential information under 35 U.S.C. § 327(b) and 37 C.F.R. § 42.74(c), and a separate joint request for such is being filed concurrently.

IV. CONCLUSION

Petitioner and Patent Owner respectfully request that the Board grant the parties' Joint Motion to Terminate this proceeding in its entirety.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned certifies that true and correct copies of the foregoing
**JOINT MOTION TO TERMINATE POST-GRANT REVIEW and EXHIBIT
1090 (CONFIDENTIAL)** were served in their entireties electronically via e-mail
on December 1, 2025, on the following counsel for Patent Owner:

Kurt F. James (Lead Counsel) kurt.james@stinson.com
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Respectfully submitted,

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