

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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

Case IPR2021-00235
Patent No. 10,196,101

PETITIONER’S NOTICE REGARDING MULTIPLE PETITIONS¹

¹ Petitioner is filing a substantively identical document in IPR2021-00234.

GOMACO is concurrently filing two petitions against the '101 patent (IPR2021-00234 and IPR2021-00235). These two petitions are necessary because of a priority date dispute, which is one of the circumstances the Board has recognized as warranting two petitions. Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 59 (“the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, . . . when there is a dispute about priority date requiring arguments under multiple prior art references”).

The Petition in IPR2021-00234 demonstrates unpatentability for all of the '101 patent's claims based on prior art that predates even the earliest claimed priority date on the face of the '101 patent. The Petition in IPR2021-00235, in contrast, demonstrates that a subset the '101 patent's claims (claims 4-7 and 15-19) are not entitled to their earliest claimed priority date because there is no written description support in any prior related application for at least the following limitations, which appear directly or indirectly (via dependency) in every challenged claim:

Claim 4 - “storing the first signal and second signal from each swing leg assembly and thereby updating the respective stored first signal and the respective stored second signal for each respective swing leg assembly”;

Claim 4 - “calculating the difference between the first signal and second signal, and the stored first signal and stored second signals respectively, for each respective swing leg assembly”;

Claim 15 - “storing the first signal and second signal from each swing leg assembly as the respective stored first signal and the respective stored second signal for each respective swing leg assembly”; and

Claim 15 - “calculating the difference between the first signal and second signal, and the stored first signal and stored second signals respectively.”

For this reason, as explained in the Petition in IPR2021-00235, claims 4-7 and 15-19 should be limited to an effective filing date of June 20, 2018, which is the date Patent Owner filed the application that directly issued as the '101 patent. Accordingly, every proposed ground in that Petition relies on intervening art that includes one of Patent Owner's own earlier publications, Guntert (U.S. Patent Application Publication No. 2011/0236129), and Dorsett (U.S. Patent No. 9,873,318).

In similar circumstances, where petitions are based on differing priority dates, the Board has considered and instituted both petitions. In *Medtronic, Inc. v. Teleflex Innovations S.A.R.L.*, for example, the Board instituted a second petition that presented a priority challenge. IPR2020-00136, Paper 20 at 39 (P.T.A.B. June 26, 2020). In doing so, the Board stated that, “[g]iven the possibility that we may

determine that [intervening art] does not qualify as prior art after fully considering Patent Owner's priority date arguments, we determine that Petitioner provides a sufficient explanation as to why it was necessary to rely upon the obviousness challenges presented here as an alternative basis for unpatentability. Indeed, this is precisely one of the circumstances recognized in our Trial Practice Guide 'in which more than one petition may be necessary.'" *Id.*

The Board also found that the challenges presented in the two petitions were not excessive or duplicative because "the prior art and issues to be decided do not significantly overlap with each other." *Id.* at 40. The same is true here, where there are no overlapping references between the two petitions.

In addition, in the district court, Patent Owner has asserted five patents against Petitioner, including the '101 patent. Petitioner previously challenged four of those patents in IPR2020-01698 (challenging U.S. Patent No. 10,029,749), IPR2021-00050 (challenging U.S. Patent No. 9,708,020), IPR2021-00135 and -00136 (both challenging U.S. Patent No. 9,908,571, but with one relying on a priority challenge for all claims), and IPR2021-00161 (challenging U.S. Patent No. 10,053,167). The same Swisher, Rio, Widdrington, and Guntert references that GOMACO relies on in its challenges to the '101 patent appear in one or more of those prior petitions. Accordingly, by the time the Board decides whether to institute GOMACO's two petitions against the '101 patent, the Board and Patent

Owner will already be familiar with most of the references relied on in IPR2021-00234 and IPR2021-00235. Only secondary references Berger and Dorsett are new. These overlapping aspects with proceedings on different but related patents substantially reduces the burden on the Board and Patent Owner of instituting both the IPR2021-00234 and IPR2021-00235 Petitions.

GOMACO respectfully requests that the Board institute both IPR2021-00234 and IPR2021-00235, as it did in the *Medtronic* case discussed above. *See also 10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00088, Paper 8 at 47 (P.T.A.B. Apr. 27, 2020) (“To avoid institution of two parallel petitions, Patent Owner could have agreed not to dispute Petitioner’s contention that the [intervening] references are prior art to the [challenged] patent, thereby eliminating Petitioner’s alleged difference between the [two] Petitions. . . . Because Patent Owner did not do so, Petitioner’s alleged difference is sufficient to justify institution of two parallel petitions challenging the ’722 Patent.”). However, if the Board decides to institute only a single petition against the ’101 patent, GOMACO requests that the Board institute IPR2021-00234 instead of IPR2021-00235.

Respectfully Submitted,

Date: November 25, 2020

By: /Jason Stach/
Jason Stach, Reg. No. 54,464

CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing **Petitioner's Notice Regarding Multiple Petitions**, was served on November 25, 2020 by FedEx Priority Overnight at the following address of record for the subject patent:

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