

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
U.S. Patent No. 10,196,101

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

EXHIBIT No.	DESCRIPTION
Exhibit-2001	Memorandum Opinion and Order, <i>Guntert & Zimmerman Constr. Div., Inc. v. Gomaco Corp.</i> , No. 20-cv-4007-CJW-KEM, Dkt. No. 82 (N.D. Iowa Jan. 13, 2021)
Exhibit-2002	Guntert & Zimmerman webpage, "Product Range", dated February 11, 2021, available at https://www.guntert.com/products.html .
Exhibit-2003	Gomaco webpage, dated February 15, 2021, available at https://www.gomaco.com .

I. INTRODUCTION

The Board should deny the Petition because U.S. Patent No. 10,196,101 (Ex. 1001, the “101 Patent”) because Gomaco Corp., (“Gomaco” or “Petitioner”) alleges infirmities under 35 U.S.C. § 112 that the Board cannot adjudicate. Specifically, Gomaco alleges that no reference in the '101 Patent's priority chain provides written description support for Claims 4-7 and 15-19 (“the Challenged Claims”), a ground not available in *inter partes* review proceedings. *See* 35 U.S.C. § 311(b). Nevertheless, the subject matter of the challenged claims are supported by each reference in its priority chain, so Gomaco's sole ground fails for citing references that are not prior art. Guntert & Zimmerman Const. Div., Inc. (“G&Z” or “Patent Owner”) requests that the Board deny institution.

Gomaco's argument that there is insufficient written description for the “calculating” and “storing” limitations of Claims 4 and 15 are meritless. U.S. Patent Publ. No. 2011/0236129 to *Guntert et al.* (“*Guntert*” or “Ex. 1028”), and every application in the 101 Patent's priority chain, describes in detail how a feedback loop in the onboard computer receives signals indicating the angular position of a swing leg, calculates the offset, or “difference,” between the angular position and a preset or desired position, initiates the change, and then repeats the process as necessary. *See Guntert* at ¶¶ [0017], [0052]. Because the offset is calculated as an offset from the original angular position, a person of ordinary skill

in the art (“POSITA”) understands that the preset or desired position is stored in the onboard computer so that the process can be repeated when “the angular orientation of the crawler tracks becomes misaligned from the desired paving direction of the machine.” *Id.* at ¶ [0052].

The Board should also deny institution because Ex. 1029 (“*Dorsett*”) is non-analogous art. *Dorsett*'s disclosure of a load dump haul machine (*e.g.*, mining machine) with an attached bucket that is moved to a predetermined position is neither in the same field of endeavor as the '101 Patent nor reasonably pertinent to the particular problem faced by the inventors.

The Board should also exercise its discretion to deny institution under § 325(d). *Guntert* was considered by the Patent Office during prosecution of U.S. Patent Appl. No. 16/013,864 (Ex. 1004, the “'101 Prosecution History”), which matured into the '101 Patent. The Patent Office also considered the patentability of the Challenged Claims over multiple patents stemming from *Guntert* during prosecution. In fact in the parallel district action, the Court suggested that an obviousness combination based on *Guntert* would be “frivolous” because it has already been considered by the Patent Office. Ex. 2001 at 10.

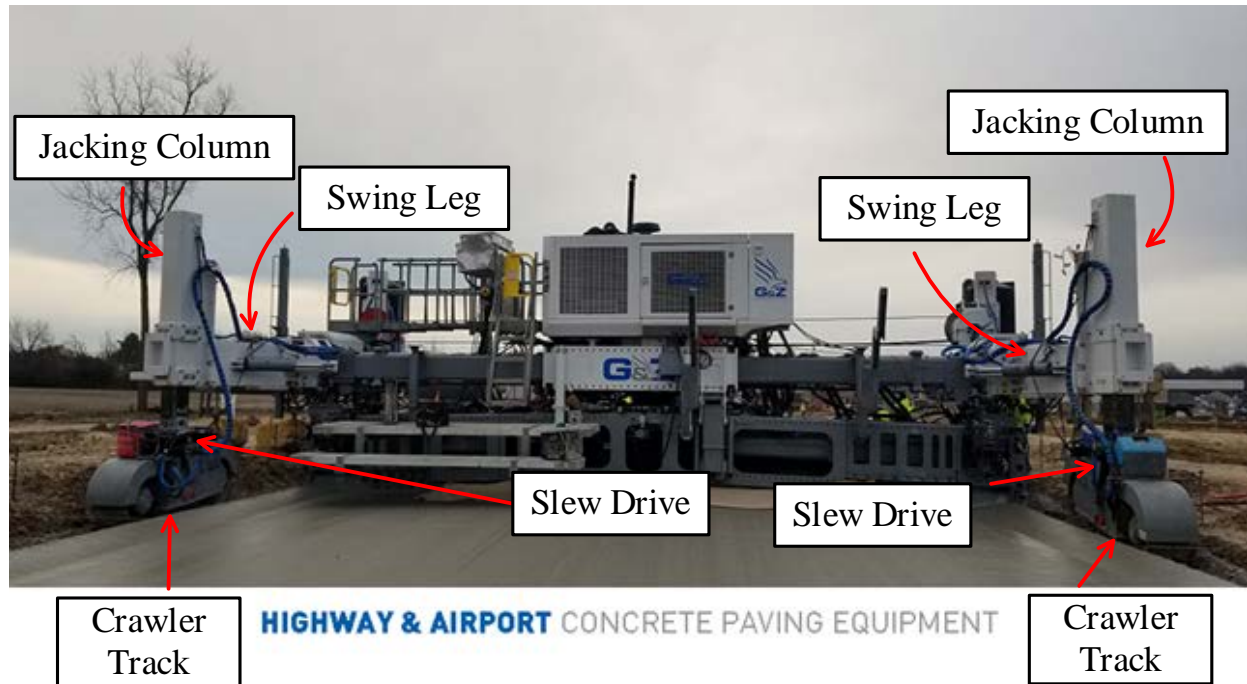
Although there are a variety of reasons why the '101 Patent is valid over Gomaco's asserted prior art references, this Preliminary Response focuses on only limited reasons why *inter partes* review (“IPR”) should not be instituted. *See*

Travelocity.com L.P. v. Conos Techs., LLC, Case CBM2014-00082, Paper 12 at 10 (P.T.A.B. Oct. 16, 2014) (“[N]othing may be gleaned from the Patent Owner’s challenge or failure to challenge the grounds of unpatentability for any particular reason.”). The deficiencies of the Petition noted herein, however, are sufficient for the Board to find that Gomaco has not met its burden to demonstrate a reasonable likelihood that it would prevail in showing unpatentability of any of the challenged claims.

II. HISTORY OF GUNTERT & ZIMMERMAN CONST. DIV., INC.

G&Z is an innovative, family owned company spanning three generations. G&Z was founded in 1942 and contributed to the war effort, building floating crane barges, landing crafts, steel tugboats, and inter-island supply vessels for the U.S. Navy and U.S. Army Transportation Corp. After the war, G&Z focused on the design and fabrication of canal construction equipment, supplying its first set of canal machines in 1946 which were used in many major projects, including the Grand Coulee Dam project in Washington and the Delta Mendota Canal Project in California. In 1956, G&Z placed its canal lining equipment onto crawler tacks and built the first viable crawler track-mounted concrete slipform paver for highway and airfield paving with automatic line and grade control. These machines built the Orly airfield in Paris, Dallas-Fort Worth Airport, the shuttle landing strip at Cape Kennedy, and the Chap Lap Kok Airport in Hong Kong.

Today G&Z is renowned for its continued innovations in the slipform paver industry. These innovations gained significant industry praise and led the USPTO to grant several patents covering various aspects of its multi-track slipform pavers. This case involves G&Z's innovative SmartLeg and AccuSteer technologies, which G&Z first incorporated on its concrete pavers in 2010. The image below illustrates a rear view of an exemplary G&Z slipform paver. Swing legs positioned on each side of the paver connect the various crawler tracks to the frame. Each swing leg includes a jacking column that adjusts the vertical position of the crawler track with respect to the frame as well as a rotary power drive that adjusts the angle of the crawler track with respect to the frame. G&Z's design provides a number of benefits, including the ability to change each crawler track's position in reference to the machine frame from a preset position "on the fly" while keeping the crawler track orientated with the direction of travel, *e.g.*, the paving direction, without manual adjustments.



Ex. 2002 at 1 (annotated).

Following the rollout of G&Z's novel design, contractors around the world saw the incredible value of G&Z's patented SmartLeg/AccuSteer technology. In fact, G&Z saw countless customers abandon their slipform pavers long before the end of their useful life cycles and replace them with G&Z's SmartLeg/AccuSteer slipform paver machines. For G&Z's customers, the SmartLeg/AccuSteer technology dramatically improved productivity because it made possible, for the first time ever, to move the crawler track position on a concrete slipform paver "on the fly" and keep the crawler track position straight ahead to avoid obstacles in the track path. Previously, repositioning the crawler tracks took hours or up to half a day. To get a paver machine ready for transport it could take up to a full day. With SmartLeg/AccuSteer technology, these tasks were reduced to minutes and, worst

case, less than 30 minutes. These non-productive activities reduced a contractor's available paving time.

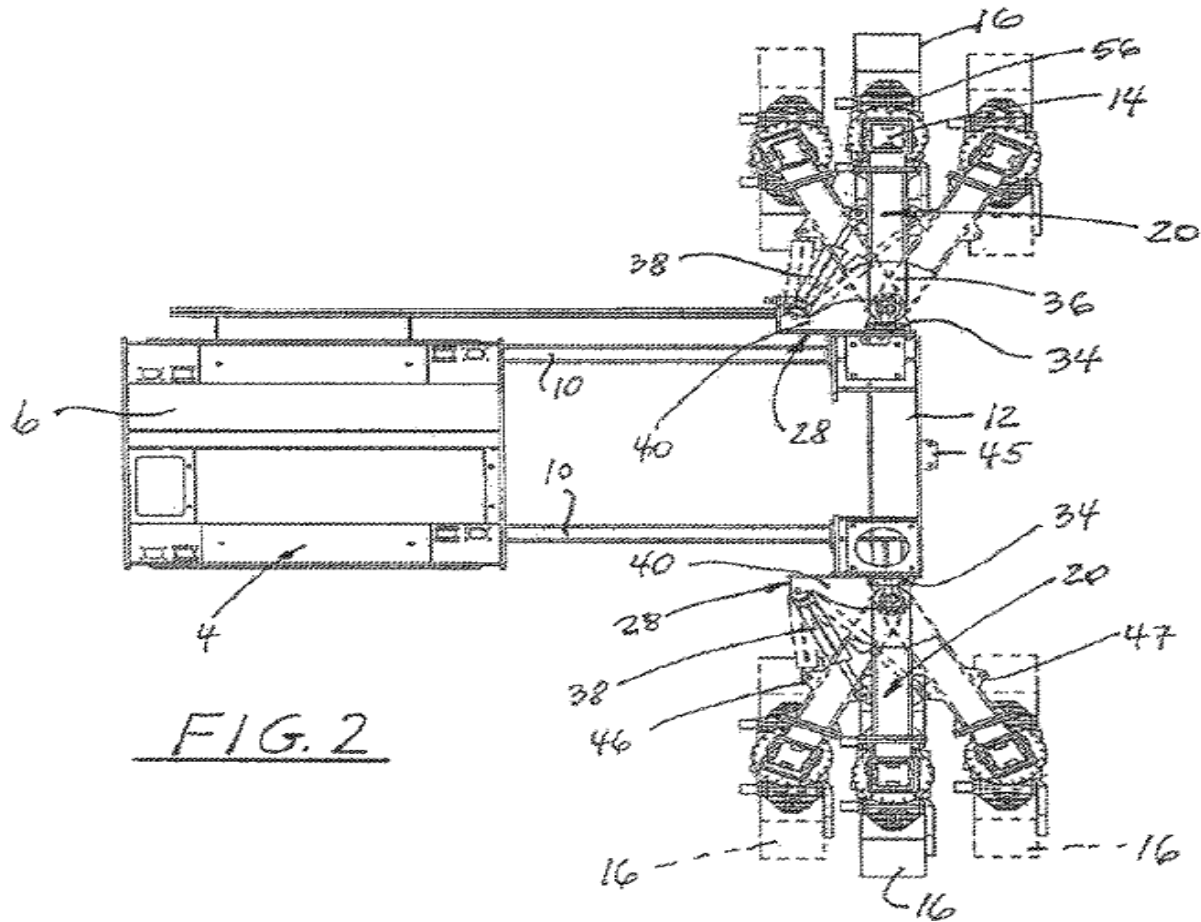
The success of G&Z's technology has also led its only significant competitor in the United States, Gomaco to copy G&Z's patented technology. As shown below, Gomaco released slipform pavers with the same swing legs and slew drives and is almost an identical copy of G&Z's machines:



Ex. 2003 at 7 (annotated). Unfortunately, Gomaco's copying forced G&Z to seek an injunction prohibiting Gomaco from piggybacking off of G&Z's extensive investments in research and development.

III. OVERVIEW OF THE '101 PATENT

G&Z's '101 Patent discloses a specialized swing leg assembly that significantly increases the efficiency and effectiveness of slipform pavers. *See* '101 Patent at Abstract; *id.* at 6:33-7:26. Figure 2 of the '101 Patent shows a partial overhead view of a slipform paver with pivotable bolster swing legs 20 connected to crawler tracks 16, which move the slipform paver:



Id. at FIG. 2. Each bolster swing leg includes a jacking column 14, which raises and lowers the crawler track relative to the paver's frame. *Id.* at 8:51-63; *id.* at 9:28-30.

The '101 Patent also describes transducers that relay movement data for each single bolster swing leg to an onboard computer or processor (hereinafter "the onboard computer"), which resolves the direction and orientation of the bolster swing legs. *See* '101 Patent at 6:33-42; *id.* at 12:35-62; *see also id.* at FIG. 5 (Figure 5 with angular transducers identified as 78); *id.* at 6:20-25 (onboard computer receives outputs from the transducers and generates a signal to pivot the

crawler track relative to the jacking column to keep the crawler tracks oriented in the paving direction when the orientation of the bolster swing leg changes and keeps all the crawler tracks' orientations synchronized). The orientation of the crawler track is changed via a rotary power drive placed between the jacking column and the crawler track. *See id.* at 6:14-62.

The '101 Patent further explains that the onboard computer and transducers form a feedback loop control system to keep each crawler track and swing leg in a desired or preset positions. '101 Patent at Abstract; *id.* at 6:33-46. The feedback loop control system connects an actuator of the bolster swing leg, the power drive of the crawler track, and the onboard computer maintains the swing leg and crawler tracks at preset or desired values. *See, e.g., id.; see also id.* at 12:41-62. Specifically, if the bolster swing leg deviates from its preset or desired value, the bolster swing leg is repositioned to maintain the preset or desired value, and, if necessary, adjustments to the crawler track orientation are also made. *Id.*

The '101 Patent solved problems with existing slipform paver machines, including removing the need to manually maneuver the bolster swing legs during concrete paving and transportation of the paver machines, which is a time-consuming and expensive process. *Id.* at 6:63-7:26; *see also id.* at 6:50-54 (specialized bolster swing leg assembly permits the crawler track positions to be relocated without any manual mechanical or electronic adjustments); *see also, e.g.,*

id. at 5:35-38 (previous approach does not permit moving the paver from one site to another quickly and efficiently).

The inventive bolster swing leg assembly also ensures that paver can be narrowed for moving over ordinary highways to a new paving site of varying width dimensions (such as a bridge) or maneuvering the paver around a site that is tightly confined. *Id.* at 7:15-26. The maneuverability due to the bolster swing leg assembly permits this bulky, heavy equipment to quickly avoid obstacles in the path of each bolster swing leg or crawler track, while maintaining a consistent paving direction and surface for the concrete, by synchronizing the movement between the relative angles of each crawler track and bolster swing leg as they pass the obstacle. *Id.* at 3:3-9; *id.* at 6:14-28.

IV. CLAIM CONSTRUCTION

A. Legal Standard

Under *Phillips*, patent claims are interpreted in light of the intrinsic evidence, including the specification and file history, and “the ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313, 1317 (Fed. Cir. 2005) (citations omitted); *see also* 83 Fed. Reg.

51340, 51341 (Oct. 11, 2018) (adopting *Phillips* standard for AIA proceedings before the Board).

B. G&Z's Proposed Constructions

While G&Z notes that construction of terms in the Challenged Claims may be appropriate if the Board chooses to institute *inter partes* review, such constructions are not necessary at this juncture, because no construction is necessary to resolve the parties' dispute over whether *Guntert* provides written description for the Challenged Claims. *See, e.g., Sandoz Inc. v. AbbVie Biotech. Ltd.*, No. IPR2017-01987, 2018 WL 1230583, at *5 (P.T.A.B. Mar. 9, 2018) (“[B]ecause neither of those phrases requires construction for us to resolve the instant dispute, we decline to construe them) (citing *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“only those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”)).

Should the Board institute trial, G&Z reserves the right to advocate for constructions of this and any other claim term in its Patent Owner Response.

V. REASONS WHY THE BOARD SHOULD NOT INSTITUTE REVIEW

A. Gomaco Improperly Challenges the Patentability of the '101 Patent Under 35 U.S.C. § 112

Gomaco's Petition should be rejected under 35 U.S.C. § 311(b) because Gomaco raises a written description challenge under 35 U.S.C. § 112, which

violates the AIA. Specifically, Gomaco's purported ground of unpatentability is predicated on a determination that the Challenged Claims are not entitled to *Guntert's* filing date because its specification—and no specification in the '101 Patent's priority chain—allegedly does not provide written description support for the Challenged Claims.¹

Critically, this is not a situation where Gomaco is asking the Board to determine the priority date because of an allegation that the claims are directed to new matter introduced in a continuation-in-part. Rather, Gomaco asserts that the subject matter of the challenged claims “appeared for the first time in the claims of the application leading to the '101 patent itself.” Petition at 6. Thus, Gomaco's request for a “priority” determination is nothing more than a back-door, prohibited written description challenge. Allowing a petitioner to evade the requirements of Section 311(b) by setting forth a written description attack under the guise of a “priority” determination contravenes the statute and intent of Congress in limiting IPRs to only challenges based on Sections 102 and 103.

¹ As explained *infra* in Section V.B, the '101 Patent is entitled to claim priority to *Guntert's* filing date, because it meets all of the requirements under 35 U.S.C. § 120.

This sort of “priority” challenge—a mere cloak for a written description attack—is not statutorily cognizable because Petitioner requests the Board to determine substantive Section 112 arguments that Congress did not authorize the Board to perform. It certainly does not follow that the Board may exceed its statutorily limited authority and cancel a claim under Section 112 whenever a petitioner cloaks its Section 112 attack under a “priority” determination:

[N]or does our interpretation enable the agency to act outside its statutory limits by, for example, canceling a patent claim for “indefiniteness under § 112” in *inter partes* review. Such “shenanigans” may be properly reviewable in the context of § 319 and under the Administrative Procedure Act, which enables reviewing courts to “set aside agency action” that is “contrary to constitutional right,” “in excess of statutory jurisdiction,” or “arbitrary [and] capricious.”

See Cuozzo Speed Techs. LLC v. Lee, 136 S. Ct. 2131, 2141-42 (2016) (citations omitted).

It is clear that the statutory provisions do not permit the Board to institute *inter partes* review of claims particularly when a “priority” determination cloaks a Section 112 attack, because the Board’s ultimate decision would be predicated upon Section 112, not the statutory authorized grounds under Sections 102 or 103. *See* 35 U.S.C. § 311(b). The proper course of action for the Board to follow when

presented with this type of “priority” determination is to decline to institute the IPR. *Cf. Samsung Elecs. Am. v. Prisia Eng’g Corp.*, 948 F.3d 1342, 1353 (Fed. Cir. 2020) (“Congress viewed a challenge based on indefiniteness to be distinct from a challenge based on sections 102 and 103. As such, the proper course for the Board to follow, if it cannot ascertain the scope of a claim with reasonable certainty for purposes of assessing patentability, is to decline to institute the IPR....”).

For at least the foregoing reasons, the Board should decline to institute the IPR because Gomaco’s back-door effort to challenge validity under Section 112 is not legally cognizable as it is in violation of the AIA.

B. *Guntert* is Not Prior Art

The Board should also deny institution of *inter partes* review because *Guntert* is not prior art.

Under § 120, there are four requirements for an application to obtain the benefit of an earlier filing date of a previously filed application: (1) the invention in the application must be disclosed in the original application pursuant to 35 U.S.C. § 112; (2) the application must be filed while the previously filed application is still pending; (3) there must be a common inventor between both applications; and (4) there must be a specific reference to the earlier filed application. There is no dispute that the ’101 Patent and each application in the

priority chain satisfies the second, third, and fourth requirements of § 120, and Gomaco's challenge of the first requirement is meritless.

The Challenged Claims enjoy priority to *Guntert* because “the disclosure of [*Guntert*] relied upon reasonably conveys to those skilled in the art that the inventor[s] had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc); *see also Enzo Biochem, Inc. v. Gen-Probe Inc.*, 323 F.3d 956, 968 (Fed. Cir. 2002) (expressing that the standard for satisfying the written description requirement is whether the disclosure “allow[s] one skilled in the art to visualize or recognize the identity of the subject matter purportedly described.”) (citation omitted).

Guntert provides more than adequate support for the Challenged Claims, and allows one skilled in the art to recognize that the inventors had possession of the following claim elements:

- **(Element 4f)** “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”;
- **(Element 15d)** “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

- **(Elements 4b and 15e)** “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”

'101 Patent at Claims 4, 15.

The terms recited in the above calculating and storing limitations are understood in the context of the independent claims. Specifically, Independent Claims 1 and 11 recite “a first angular position transducer configured to emit a *first signal which is indicative of an angular orientation of the crawler track*” and “a second angular position transducer configured to emit a *second signal which is indicative of an angular orientation of the swing leg*.” *Id.* at Claims 1, 11 (emphasis added). Thus, the terms of “the first signal” and “stored first signal” are indicative of the angular orientations of the crawler track. While the terms of “second signal” and “stored second signal” are indicative of the angular orientations of the swing leg.

1. Guntert provides written description support for the calculating limitation.

Guntert teaches that the swing leg's and crawler track's preset or desired angles correspond to the desired paving direction of the slipform paver machine. *See, e.g., Guntert* at ¶¶ [0017], [0052]. To maintain alignment of each swing leg and crawler track with the desired paving direction, *Guntert* explains that the onboard computer *calculates how much the angle has changed* between the preset

and current angles for both the swing leg and crawler track. *See, e.g., id.* at ¶¶ [0017], [0046]-[0052]. If any difference is detected, the onboard computer drives the swing leg or crawler track back to the preset angle. These calculated differences represent, for each swing leg, the difference between the stored first and second signals and the first and second signals, respectively, received from the transducers as claimed.

In more detail, *Guntert* describes maintaining each swing leg at the preset, or desired, angle, and that the onboard computer and transducers form a feedback loop control system to monitor the current angle of the swing. *See, e.g., id.* at ¶¶ [0046]-[0052]. That is, the onboard computer receives from the transducer the current angle of the swing leg, and determines if there is a difference between the current measured angle and the stored preset or desired angle. *Id.* If there is a difference, the swing leg is driven back to the preset or desired angle. *See, e.g., id.* at ¶ [0017]; *see also, e.g., id.* at FIG. 1 (illustrating the paving direction 18); *id.* at FIG. 2 (schematic illustrating the different swing leg angular orientations and the middle swing leg orientation parallel to the paving direction). This process is repeated each time the current angle is changed. *See, e.g., id.* at ¶ [0052].

Guntert teaches a similar process for maintaining each crawler track. Specifically, the onboard computer receives from a transducer the current angle of the crawler track, and through calculations determines if there is a difference

between the current angle and the preset or desired angle. *See, e.g., id.* at ¶¶ [0046]-[0052]. If there is a difference, the crawler track is driven back to the desired paving direction. *See, e.g., id.* at ¶¶ [0017], [0052]. Exemplary embodiments from *Guntert* show that the crawler track realigns with the paving direction when the onboard computer calculates and determines that the current angle has to be changed to reset the crawler track to the desired paving direction. *See, e.g., id.* at ¶¶ [0043], [0052].

Accordingly, *Guntert's* disclosure calculating the angular difference between the measured position and the desired position discloses “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,” as claimed.

2. *Guntert* provides written description support for the storing limitation.

Guntert teaches that the crawler track's and the swing leg's angular orientation values are stored, as these values correspond to the desired paving direction. *See, e.g., Guntert* at ¶¶ [0017], [0046]-[0052].

As detailed above, *Guntert* explains that the onboard computer employs a feedback loop control system to determine any difference between the preset or desired angle and the current angle, and where the process is repeated each time “the angular position of the swing leg is changed, or when the for other reasons the

angular orientation of the crawler tracks becomes misaligned from the desired paving direction of the machine.” *Id.* at ¶ [0052]. Thus, it follows that for the preset or desired values—corresponding to the desired paving direction of the slipform paving machine—to be used in calculations, the onboard computer must store and memorize these values. *See, e.g., id.* at ¶¶ [0046]-[0052]; *see also, e.g., In re Hayes Microcomputer Prods., Inc. Patent Litig.*, 982 F.2d 1527, 1534 (Fed. Cir. 1992) (“One skilled in the art would know how to program a microprocessor to perform the necessary steps described in the specification. Thus, an inventor is not required to describe every detail of his invention.”) (original emphasis omitted).

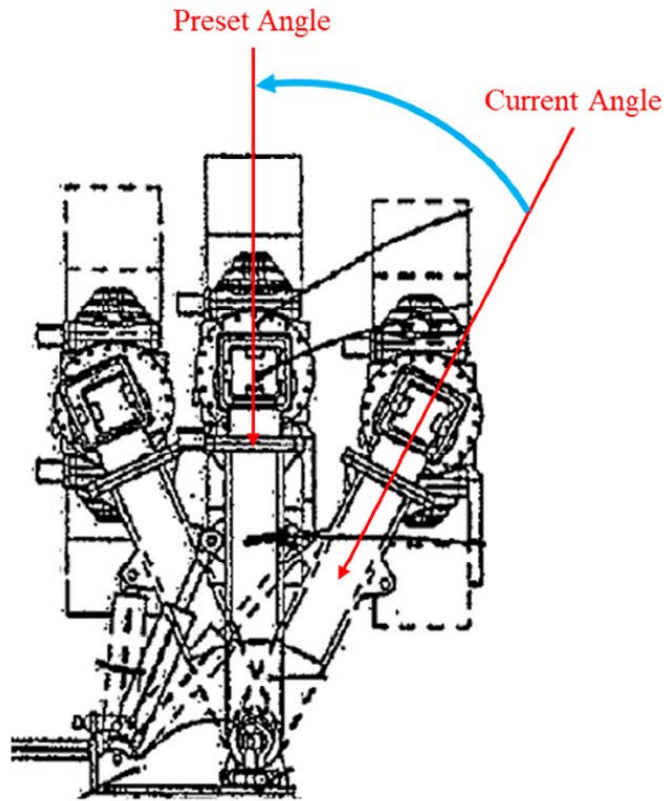
3. Gomaco’s expert admits that *Guntert* provides written description support for the calculating and storing limitations.

Gomaco’s expert, Dr. Singhose, admits that *Guntert* allows one skilled in the art to recognize the calculating and storing limitations. *See Enzo Biochem.*, 323 F.3d at 968. In fact, Dr. Singhose acknowledges that one skilled in the art would not only understand from *Guntert* how the preset or desired values are created, but also know that these values are stored and used by the onboard computer to calculate the angular difference between the measured angle and the preset or desired angle. *See Ex. 1002* (“Singhose Decl.”) at ¶¶ 45-46, 49 (internal citations omitted). These admissions are sufficient for the Board to find adequate written

description for the calculating and storing elements discussed above. *See In re Hayes*, 982 F.2d at 1534 (finding § 112 support for “when one skilled in the relevant art would understand what is intended and know how to carry it out.”).

Dr. Singhose acknowledges that *Guntert* teaches an onboard computer having a feedback control system process that maintains the swing leg at a fixed, preset angle. Singhose Decl. at ¶ 45 (citing *Guntert* at ¶ [0017]). Dr. Singhose also acknowledges that one skilled in the art would understand that the feedback loop system requires that a preset or desired value is used to calculate an error value, *e.g.*, the difference between the preset angle and a current angle. *Id.* (“***A POSITA would understand*** that the control system would accomplish this by using the preset angle and the current angle (which is emitted from the second angular position transducer) [T]he feedback loop will drive the swing leg toward the preset angle . . . this ‘difference’ is often called an error value.”) (emphasis added).

The illustration below depicts Dr. Singhose's understanding of FIG. 2 from *Guntert*. According to Dr. Singhose, FIG. 2 represents differing angular orientations of the swing leg that correspond to the preset angle and current angle:



Id. at ¶ 45 (citing *Guntert* at FIG. 2 (annotation in Singhose Decl.)). Based on Dr. Singhose's understanding of *Guntert*, the preset value must be stored and memorized by the onboard computer such to calculate the error value and drive the swing leg back to the desired paving direction. Certainly, to perform these calculations *Guntert*'s onboard computer must inherently include some sort of memory storage (*e.g.*, RAM, register, and/or cache). *See, e.g., id.* at ¶ 45; *Guntert* at ¶ [0017]; *Guntert* at FIG. 5 (illustrating the onboard computer 82).

Dr. Singhose also recognizes that *Guntert* discloses a similar process for the each crawler track. *See* Singhose Decl. at ¶ 46 (quoting *Guntert* at ¶ [0043]). Dr. Singhose opines that, like the preset or desired values for the swing leg, one skilled

in the art would likewise understand that there is also a desired preset value for “the crawler track to which the feedback loop drives the crawler track toward by monitoring the current position of the track, as identified by the first angular transducer.” *Id.* By Dr. Singhose’s admission, therefore the preset or desired value for the crawler track is stored and memorized by the onboard computer to calculate the error value, which, again, simply represents the difference between the stored preset or desired value and the current value.

Furthermore, Dr. Singhose recognizes from *Guntert* how the preset or desired values are created and thereby stored and used in calculations. As described above, Dr. Singhose understands from *Guntert* that the onboard computer employs the feedback loop control system to implement a technique that calculates error values. *Id.* at ¶¶ 45-46, 49. With this understanding, Dr. Singhose opines:

A potential use of this type of technique would be to store a desirable configuration for future use. *If an operator moved the swing leg and track to a desirable position that needed to be reused on occasion, then they could choose to memorize or store that configuration. The machine would read the current values from the sensors/transducers (the first and second signals) and store them in memory to remember the precise location of the track and swing leg. This would allow those*

positions to be recalled at a later time. In that case, if the swing leg had moved away from the saved position, *the feedback loop would calculate the difference between the stored/memorized swing leg angle (first stored signal) and the current swing leg angle from the sensor (first signal and the current swing leg angle from the sensor (first signal)).* The system would then drive that error or difference toward zero until the current swing leg angle from the sensor (first signal) matched the stored/memorized swing leg angle. A similar process could also be used for the track angle.

Id. at ¶ 49 (emphasis added); *see also id.* at ¶ 67 (“Guntert monitors two position signals related to its monitored structural members (a swing leg pivot signal and a track rotation signal) . . . **A POSITA would have understood** that . . . those signals in Guntert could be stored to memorize any particular location of the swing leg and crawler track.”) (emphasis added) (citations omitted).

Dr. Singhose’s above opinions show that one skilled in the art would understand from *Guntert* how to carry out the claim limitations of calculating and storing—indeed, one skilled in the art recognizes from *Guntert* how the preset or desired values are created. *Id.* at ¶ 49 (“If an operator moved the swing leg and track to a desirable position that needed to be reused on occasion, **then they could choose to memorize or store that configuration. The machine would read the current values from the sensors/transducers (the first and second signals) and**

store them in memory.”) (emphasis added); *see also In re Hayes*, 982 F.2d at 1534 (“One skilled in the art would know how to program a microprocessor to perform the necessary steps *described in the specification*. Thus, an inventor is not required to describe every detail of his invention.” (emphasis in original)).

In view of the above, Gomaco fails to set forth probative evidence that a POSITA would *not* have recognized written description for the calculating and storing limitations. *See, e.g., Alcon Research Ltd. v. Barr Labs., Inc.*, 745 F.3d 1180, 1191-92 (Fed. Cir. 2014) (“Critically, Barr adduced no evidence . . . that was probative of whether an ordinarily skilled artisan would not have understood from the disclosures of Alcon’s . . . patents that the patentees invented, or possessed, the methods of the asserted claims. Without that evidence, there was no basis on which to find a lack of adequate written description.”). Instead, the evidence Gomaco does set forth demonstrates that one skilled in the art would understand from the *Guntert* disclosure that the inventors possessed the storing and calculating limitations. *See* Singhose Decl. at ¶¶ 45-46, 49 (citing *Guntert* at ¶¶ [0017], [0043]); *see also id.* at ¶ 63.

For at least the foregoing reasons, *Guntert* reasonably conveys to one skilled in the art that the inventors had possession of the Challenged Claims no later than *Guntert*’s filing date. Because *Guntert* satisfies the written description

requirement, the '101 Patent is entitled to claim priority to *Guntert*. *Guntert* is therefore not prior art. The Petition should be denied.

C. *Dorsett* is Not Analogous Art

The Board should also deny the Petition because *Dorsett* is not analogous art. *In re Klein*, 647 F.3d 1343, 1348 (Fed. Cir. 2011) (“A reference qualifies as prior art for an obviousness determination under § 103 only when it is analogous to the claimed invention.”) (citations omitted). A reference is analogous to a claimed invention if: (1) the reference is from the same “field of endeavor” as the claimed invention, or (2) the reference is “reasonably pertinent to the particular problem with which the inventor is involved.” *Id.* (citation omitted). *Dorsett* does not satisfy either of these prongs.

1. *Dorsett* is not in the same field of endeavor as the claimed invention.

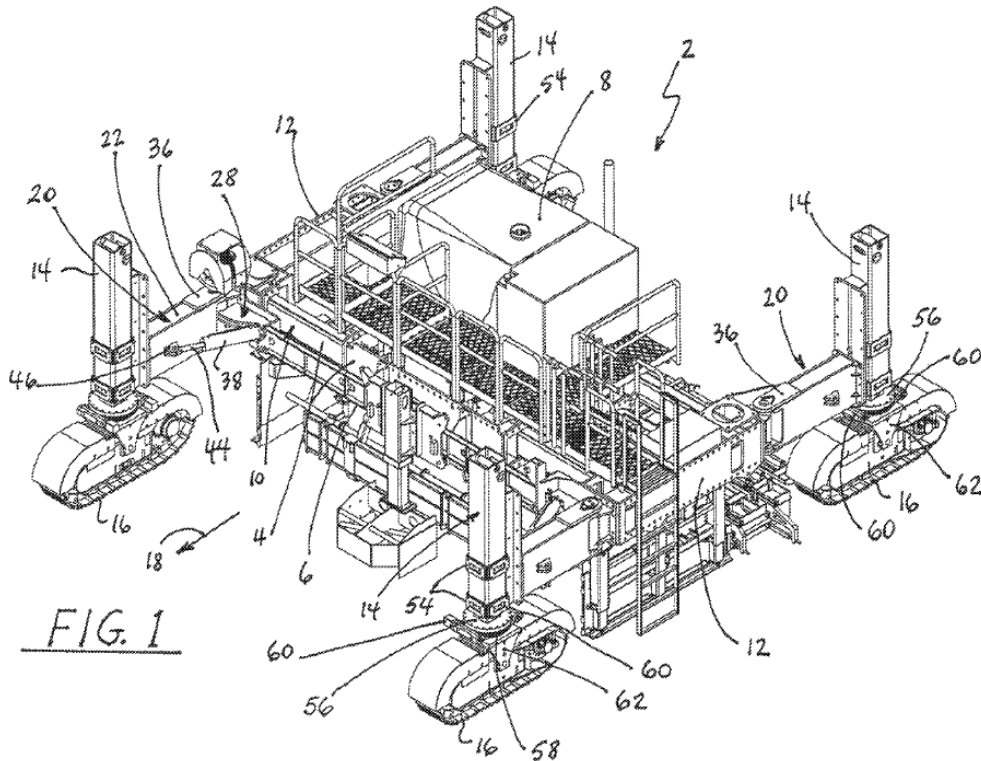
Gomaco admits that *Dorsett* is within the field of construction machinery, which is not the field of endeavor of the '101 Patent. Petition at 31.

The Board determines an invention's field of endeavor “by reference to explanations of the invention's subject matter in the patent application, including embodiments, function, and structure of the claimed invention.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004) (citing *In re Wood*, 599 F.2d 1032, 1036 (C.C.P.A. 1979) (confining the field of endeavor to the scope explicitly specified

in the background of the invention.)). Applying this rubric, the '101 Patent belongs to the field of slipform paver machines.

In *Circuit Check Inc. v. QXQ Inc.*, 795 F.3d 1331 (Fed. Cir. 2015), the Federal Circuit found that substantial evidence supported the jury's finding that the claims were nonobvious because the disputed prior art was non-analogous and thus not within the scope of the prior art. *Id.* at 1335. Specifically, the Federal Circuit concluded that the patent confined the field of the invention to "circuit board testers and test fixtures used in the manufacture of electronics" and that the disputed prior art—relating to "rock carvings, engraved signage, and Prussian Blue"—is not within the field of circuit board testers and test figures. *Id.*

Likewise, the '101 Patent confines its field of art to slipform paving machines, which *Dorsett* is not part of. Particularly, the '101 Patent confines the field of art to "[a]utomatically adjusting swing leg[s]" for slipform paver machines that spread, level, and finish concrete. '101 Patent at Title; *id.* at Abstract; *see also id.* at 1:25-29. Every embodiment in the '101 Patent specification is directed to quickly and effectively adjusting the swing legs and crawler tracks found on slipform paver machines. *See, e.g., id.* at 6:33-7:26; *id.* at 11:38-12:62. Figure 1 of the '101 Patent illustrates a slipform paver machine with pivotable bolster swing legs 20 connected to jacking columns 14, and crawler tracks 16:



Id. at FIG. 1; *see also id.* at 9:28-35.

In contrast, *Dorsett* is directed to mining machines, such as a load haul dump machine, “*commonly used in underground mining environments.*” *Dorsett* at 10:49-50 (emphasis added); *see also id.* at 1:14-19; *id.* at 15:24-34. Figure 22 of *Dorsett* illustrates the load haul dump machine that includes a bucket 202 supported by one or more arms 204:

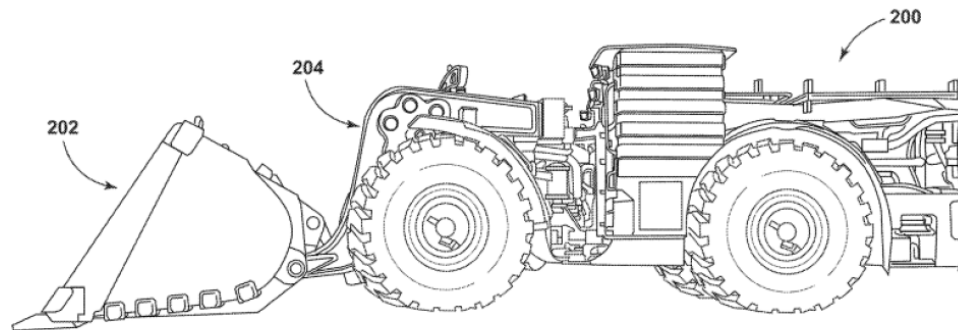


FIG. 22

Dorsett at FIG. 22. As is apparent from the above illustration, *Dorsett's* load haul dump machine does not relate to a slipform paver machine nor include a slipform paver machine's essential structure of bolster swing legs, jacking columns, and crawler tracks.

Recognizing the significant differences between the '101 Patent's slipform paver machine and *Dorsett's* load haul dump machine, Gomaco attempts to broaden the '101 Patent's relatively-narrow field of endeavor to encompass any type of construction machinery. Petition at 31. In doing so, Gomaco unwittingly admits that *Dorsett* does not fall squarely within the same field of the '101 Patent's endeavor that relates to slipform paver machines, not broadly to construction machinery.

Apart from Gomaco's concession that *Dorsett* is not in the same field as the '101 Patent, there also can be no doubt that a load haul dump machine with a

bucket used in mining applications is far afield from slipform paver machines with automatically adjusting swing legs used to spread, level, and finish concrete. For at least these reasons, *Dorsett* is not in the same field as the '101 Patent.

2. *Dorsett* is not reasonably pertinent to the particular problem which the inventors of the '101 Patent are involved.

Gomaco frames its “addressed similar problems” argument under the guise that both the '101 Patent and *Dorsett* eliminated costly and time-consuming hardships in construction by automating positions of the construction machinery. *See* Petition at 31. But when the curtains are pulled back, the fallacy of Gomaco's argument is fully exposed as *Dorsett's* mining machine disclosure is not reasonably pertinent to the particular problem that the inventors of the '101 Patent faced.

The inventors of the '101 Patent developed a swing leg design for slipform paver machines that allows for swing leg adjustments to be made “on the fly” without the need to incur costly work stoppages each time a swing leg needs adjusting. '101 Patent at 12:63-67; *id.* at 15:65-16:11. Simply put, the '101 Patent overcame problems in the slipform paving industry by describing and claiming swing leg assemblies that can be automatically adjusted “on the fly.” *Id.* at 15:65-16:11.

Dorsett, on the other hand, is directed to load haul dump machines (*e.g.*, mining machines), and particularly to moving a bucket attached to the load haul dump machine to predetermined positions. *See, e.g., Dorsett* at 3:8-39. *Dorsett* discloses that an actuator automatically moves the bucket to a predetermined carry position. *See, e.g., id.* at 3:8-39; *id.* at 16:2-16. Indeed, moving a bucket to a predetermined carry position is not reasonably pertinent to the particular problem to which the inventors were involved in solving. *See, e.g., Tinnus Enters., LLC v. Telebrands Corp.*, 846 F.3d 1190, 1207 (Fed. Cir. 2017) (stating that there is no reason to combine references when the references were not reasonably pertinent to the problem facing the inventor but were instead directed to solving other problems).

Dorsett is not directed toward the same problem the inventors were trying to solve, namely a swing leg that can be automatically adjusted on the fly to resolve the cost and time incurred in having to manually adjust the swing legs of the slipform paver machine. That is, *Dorsett's* subject matter would not have logically commended itself to an inventor's attention in considering the problem addressed by the inventors of the '101 Patent.

Because *Dorsett* is directed to solving a different problem than that of the '101 Patent, *Dorsett* fails to qualify as prior art for an obviousness combination. *Tinnus Enters.*, 846 F.3d at 1207. For at least this reason, Ground 1 fails.

D. The Board Should Deny the Petition Under Section 325(D)

Under 35 U.S.C. § 325(d), the Board should exercise discretion to deny institution where the petition seeks to have the Board second guess issues of patentability that the Patent Office addressed before issuing the '101 Patent. In this case, the Office already considered the patentability of the Challenged Claims over *Guntert*.

Under Section 325(d) the Board uses the following two-part framework to determine whether to deny institution of a petition for *inter partes* review: (1) whether the petition presents the same or substantially the same art or arguments as presented previously to the Patent Office; and (2) if either condition of the first prong is satisfied, then whether the Gomaco has demonstrated that the Patent Office made a material error to the patentability of the challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, No.

IPR2019-01469, 2020 WL 740292, at *3 (P.T.A.B. Feb. 13, 2020) (precedential).

Because the same or substantially the same prior art was already considered by the Office, and Gomaco has made no attempt to demonstrate material error, the Board should deny institution.

1. The Patent Office has already considered *Guntert*.

The Board evaluates *Becton Dickinson* Factors (a), (b), and (d) to determine whether the petition presents the same or substantially the same art or arguments as

presented previously to the Patent Office. *See, e.g. id.*, at *4. Significantly, the district court provides meaningful guidance on this issue and suggests that the Petition, which relies on *Guntert* and *Dorsett*, may be frivolous because the Patent Office already considered *Guntert*. Ex. 2001 at 10. The district court's analysis is directly on point because during original prosecution of the '101 Patent, the examiner considered *Guntert*. *Id.* Gomaco fails to demonstrate that the examiner materially erred regarding the patentability of the Challenged Claims when considering the same subject matter during prosecution.

Becton Dickinson Factors “(a) the similarities and material differences between the asserted art and the prior art involved during examination” and “(b) the cumulative nature of the asserted art and the prior art evaluated during examination” weigh in favor of denying institution. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, Case IPR2017-01586, Paper 8 at 17 (P.T.A.B. Dec. 15, 2017) (precedential as to § III.C.5, first paragraph). Notably, during prosecution of the '864 Application (which matured into the '101 Patent), the examiner considered *Guntert*. *See* '101 Prosecution History at 97.

Gomaco acknowledges this, while also (in vain) attempting to discredit the disclosure of the same reference and subject matter. Petition at 15-16. Gomaco, however, ignores pertinent facts, as well as the Board's informative decision in *Cultec, Inc. v. Stormtech LLC*, Case IPR2017-00777, Paper 7 at 7–13 (P.T.A.B.

Aug. 22, 2017) (informative), where the Board denied institution under §325(d) based upon the disclosure of prior art references that were *considered by the examiner*:

As stated on the signed form, the Examiner's signature "indicates all documents listed above have been considered." *Id.* Additionally, typed on the bottom of the form is the statement "ALL REFERENCES CONSIDERED EXCEPT WHERE LINED THROUGH. /B.F.F/." *Id.* No references were lined through. "B.F.F." appears to be the initials of the Examiner.

Id. at 9–10. *Cultec* instructs that it is not necessary for the examiner to have discussed the identified art in an office action during prosecution; the examiner's consideration of the art is sufficient—this point is particularly relevant here where the reference of record is the exact same disclosure as the patent being challenged in *inter partes* review. Indeed, sufficiency rests on the logic that the examiner is charged with considering the best references for the pending claims. *See, e.g.*, 37 C.F.R. § 1.104(c)(2) (stating that, "the Examiner must cite the best references at his or her command"). As such, analyzing the references considered by the examiner during prosecution, the *Cultec* Board determined that the art asserted in the IPR grounds were substantially the same, thus the Board exercised its discretion under §325(d) to deny institution. *Cultec*, Paper 7 at 13.

Because *Guntert* was already considered by the examiner is during examination, the first prong of the *Becton Dickinson* test is satisfied.

2. Gomaco has not alleged or shown material error.

Turning to the second prong, *Becton Dickinson* Factor (c) concerns “the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.” *Becton, Dickinson*, Paper 8 at 17 (precedential as to § III.C.5, first paragraph).

The examiner issued a double patenting rejection over U.S. 10,029,749 (“’749 *Guntert* Patent”), which also falls within G&Z’s patent family and claims priority to *Guntert*. See ’101 Prosecution History at 91-92. Accordingly, the examiner extensively considered *Guntert* in the double patenting rejection as the ’749 *Guntert* Patent claims priority to *Guntert*, which Applicant overcame by filing a terminal disclaimer. *Id.* at 92, 102-08. This is highly probative as it shows that the examiner did not consider *Guntert* prior art and apply it in any 35 U.S.C. §§ 102 or 103 rejections. In fact, the examiner did not issue any Section 102 or 103 rejections following the Applicant’s addition of new claims, thus, the examiner did not believe that either the ’749 *Guntert* Patent qualified as prior art for an anticipation or obviousness determination. In other words, the examiner did not find that Applicant’s claims were obvious or anticipated on any statutory grounds

by any earlier *Guntert* patent family member—obviousness-type double patenting is a non-statutory ground based on public policy, not based on 102 art.

Importantly, even if the record of the Patent Office's previous consideration of the art is not well developed or silent, the "[P]etitioner may show the Office erred by overlooking factors (e) and (f)." *Advanced Bionics*, 2020 WL 740292, at *4. Nowhere, however, does Gomaco show that the examiner overlooked any issues. Nor could Gomaco when the examiner considered *Guntert* and the '749 *Guntert* Patent, and ultimately issued the '101 Patent over *Guntert* and the '749 *Guntert* Patent. Thus, Gomaco fails to demonstrate that the Patent Office made a material error as to the patentability of the Challenged Claims.

For at least these reasons, the Board should exercise its discretion under Section 325(d) to deny institution.

VI. CONCLUSION

Gomaco has not established a reasonable likelihood that it will prevail in establishing that Claims 4-7 and 15-19 of the '101 Patent are invalid. G&Z accordingly requests that the Board deny institution of *inter partes* review of the '101 Patent.

Patent Owner's Preliminary Response
IPR2021-00235 (U.S. Patent No. 10,196,101)

Respectfully submitted,

Dated: March 15, 2021

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CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

This paper complies with the type-volume limitation of 37 C.F.R. § 42.24.

The paper includes 7,043 words, excluding the parts of the paper exempted by § 42.24(a).

This paper also complies with the typeface requirements of 37 C.F.R. § 42.6(a)(ii) and the type style requirements of § 42.6(a)(iii)&(iv).

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the PTAB End 2 End system constitutes electronic service, service was made on the Gomaco as detailed below:

<i>Date of service</i>	March 15, 2021
<i>Manner of service</i>	Electronic Filing with the Board
<i>Documents served</i>	PATENT OWNER'S PRELIMINARY RESPONSE AND EXHIBITS 2001 THROUGH 2003
<i>Persons Served</i>	Finnegan, Henderson, Farabow, Garrett & Dunner, LLP: Jason E. Stach Luke J. McCammon David K. Mroz Abhay A. Watwe Sonja W. Sahlsten Robert K. High

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