

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.

IPR2020-01698 (Patent 10,029,749 B2)
IPR2021-00050 (Patent 9,708,020 B2)
IPR2021-00135 (Patent 9,908,571)
IPR2021-00136 (Patent 9,908,571)
IPR2021-00161 (Patent 10,053,167)
IPR2021-00234 (Patent 10,196,101)
IPR2021-00235 (Patent 10,196,101)

Before JOHN P. PINKERTON, TIMOTHY J. GOODSON, and
JAMES J. MAYBERRY, *Administrative Patent Judges*.

PINKERTON, *Administrative Patent Judge*.

ORDER¹
Conduct of the Proceeding
37 C.F.R. §§ 42.5, 42.20(d)

¹ This Order addresses issues that are the same in certain of the listed cases. We do not authorize the parties to use this style heading for any subsequent papers at this time.

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BACKGROUND

On March 25, 2021, we held a conference call with counsel for the parties in regard to three requests by Petitioner. First, Petitioner seeks authorization to file a five-page pre-institution reply to Patent Owner's Preliminary Responses in IPR2020-00136 and IPR2021-00234 directed to the confidential documents filed in those proceedings by Patent Owner as Exhibits 2002, 2003, and 2011. Second, Petitioner seeks authorization to file a four-page pre-institution reply in IPR2021-00135, IPR2021-00161, and IPR2021-00235 to address (1) the Magistrate Judge's January 13, 2021 stay order, which is filed as Exhibit 2001 in those proceedings, and (2) whether Patent Owner accurately quoted Petitioner's expert. In addition, Petitioner requests authorization to file the district court's October 14, 2020 Order denying Patent Owner's motion for a preliminary injunction. Third, Petitioner seeks authorization to file as an exhibit in all of the above-referenced proceedings the district court's February 22, 2021 Order overruling Patent Owner's objections to the Magistrate Judge's stay order.

ANALYSIS

With respect to the first request, Patent Owner would consent to the parties filing the same briefs as submitted in IPR2020-01698 and IPR2021-00050, but opposes any additional briefing because that would provide Petitioner a "second-bite" at the apple after viewing Patent Owner's sur-reply briefs in IPR2020-01698 and IPR2021-00050. Petitioner responds that the relevant aspects of the records in IPR2020-00136 and IPR2021-00234

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are not the same as in IPR2020-01698 and IPR2021-00050, so it would not make sense to file the same set of briefs across these proceedings. We grant Petitioner's first request because we determine that the panel would benefit from further briefing on the confidential documents. We also determine that the briefing should not be limited to the previously filed briefs.

With respect to the second request, Patent Owner opposes the filing of the replies because a desire to respond to alleged misstatements in a preliminary response is generally not regarded as good cause for a pre-institution reply, and Patent Owner argues it correctly quoted Petitioner's expert. Patent Owner also opposes filing the Order denying the preliminary injunction on the ground it is not relevant. We deny Petitioner's second request, except that to further complete the record in these proceedings, we authorize Petitioner to file the district court's October 14, 2020 Order.

With respect to the third request, Patent Owner opposes filing the district court's February 22, 2021 Order overruling Patent Owner's objections to the Magistrate Judge's stay order because it is not relevant to the issues in these proceedings. To further complete the record in these proceedings, we authorize Petitioner to file the district court's February 22, 2021 Order.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's request to file a five-page Reply to Patent Owner's Preliminary Responses in IPR2020-00136 and IPR2021-00234

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directed to the confidential documents filed in those proceedings by Patent Owner as Exhibits 2002, 2003, and 2011 is *granted*;

FURTHER ORDERED that Petitioner's Reply shall be filed on or before April 2, 2021, and is not limited to the previous briefing in IPR2020-01698 and IPR2021-00050;

FURTHER ORDERED that Patent Owner is authorized to file a five-page Sur-reply, limited to responding to Petitioner's Reply, on or before April 9, 2021;

FURTHER ORDERED that Petitioner's request to file a copy of the district court's October 14, 2020 Order denying Patent Owner's motion for a preliminary injunction as an exhibit in IPR2021-00135, IPR2021-00161, and IPR2021-00235 is *granted*; and

FURTHER ORDERED that Petitioner's request to file a copy of the district court's February 22, 2021 Order overruling Patent Owner's objections to the Magistrate Judge's stay order as an exhibit in IPR2020-01698, IPR2021-00050, IPR2021-00135, IPR2021-00136, IPR2021-00161, IPR2021-00234, and IPR2021-00235 is *granted*.

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