

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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PGR2019-00063  
Patent 10,316,510 B2

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Before SCOTT A. DANIELS, NEIL T. POWELL, and  
STEPHEN E. BELISLE, *Administrative Patent Judges*.

BELISLE, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
Denying Authorization to File Motion to Strike Petitioner's Reply  
*37 C.F.R. § 42.5*

In an October 6, 2020, email to the Board, Columbia Insurance Company (“Patent Owner”) requested authorization to file a motion to strike at least certain arguments in the Reply to Patent Owner’s Response (Paper 32, “Reply”) of Simpson Strong-Tie Company Inc. (“Petitioner”). Petitioner opposes the request. The panel held a conference call with the parties on October 15, 2020, to consider Patent Owner’s request. For the reasons discussed during the conference call, we denied Patent Owner’s request. This Order further details our reasoning.

First, our Consolidated Trial Practice Guide (“Consolidated Practice Guide”)<sup>1</sup> states: “Generally, authorization to file a motion to strike should be requested *within one week* of the allegedly improper submission. The Board will consider such requests on a case-by-case basis.” Consolidated Practice Guide at 81 (emphasis added). Although Petitioner filed its Reply on August 27, 2020, Patent Owner did not request a conference call to request leave to file a motion to strike until October 6, 2020—about *six weeks* later, and proposed dates for the conference call beginning with October 12, 2020, only *after* Patent Owner filed its Sur-Reply to Petitioner’s Reply on October 8, 2020. During the conference call, Patent Owner did not present sufficient reason for this substantial delay in requesting authorization to file a motion to strike.

Second, “striking the entirety or a portion of a party’s brief is an exceptional remedy that the Board expects will be granted rarely,” but doing so may be appropriate where, for example, it is “beyond dispute” that an issue raised therein is new. Consolidated Trial Practice Guide at 80–81

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<sup>1</sup> Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>; see also 84 Fed. Reg. 64,280 (Nov. 21, 2019).

("[W]here a reply clearly relies on a new theory not included in prior briefing, and where addressing this new theory during oral hearing would prejudice the opposing party, striking the portion of the brief containing that theory may be appropriate."). Here, Patent Owner alleges:

[T]he Reply raised the following new arguments that could have been presented in the Petition:

- That the embossments 102 of the Gilb '155 hanger would prevent the sheathing from laying flush with face 4', thus allowing the gusset-like member 9 to extend out the other side of the sheathing.
- Arguing in contradiction to its "isometric renderings of the Tsukamoto combination hanger," that top flange 3A and back flange 3D "share at least a point, if not more."
- Arguing with respect to the Gilb '155 combination, "one sheet of sheathing would be narrower than the other due to the tapering of flanges 52."
- Arguing with respect to the Tsukamoto combination, that "a POSITA could simply make two cuts around the extension portions, such that the inner space covering the back flanges would be filled."

Email from Patent Owner's Counsel, John R. Schroeder, to Board, dated Oct. 6, 2020 (citations omitted). Petitioner argues that its Reply, including the substance therein relating to the above-challenged arguments, responds to arguments raised in Patent Owner's Response, as permitted by 37 C.F.R. § 42.23(b). Having reviewed Petitioner's Reply in view of Patent Owner's above-noted concerns, we cannot find that the Reply clearly or indisputably presents new arguments or theories as urged by Patent Owner.

Accordingly, we decline to exercise our discretion to authorize Patent Owner to file a motion to strike Petitioner's Reply, in whole or in part.

PGR2019-00063  
Patent 10,316,510 B2

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner's request for authorization to file a Motion to Strike Petitioner's Reply (in whole or in part) is *denied*.

For PETITIONER:

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