

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

HUM INDUSTRIAL TECHNOLOGY, INC.,
Petitioner,

v.

AMSTED RAIL COMPANY, INC.,
Patent Owner.

Case No. IPR2023-00538
Patent No. 9,365,223

**PATENT OWNER'S MANDATORY NOTICES
PURSUANT TO 37 C.F.R. §42.8(b)**

Amsted Rail Company, Inc. (“Patent Owner”) provides the following mandatory notices pursuant to 37 C.F.R. §42.8:

I. Real Party-in-Interest under 37 C.F.R. § 42.8(b)(1)

Amsted Rail Company, Inc., a Delaware corporation having its principal place of business in Chicago, IL, is the Patent Owner and a real party-in-interest in this proceeding. Amsted Digital Solutions, Inc. and IONX LLC are also real parties-in-interest but are not parties to these proceedings or to the district court proceedings.

II. Related Matters under 37 C.F.R. § 42.8(b)(2)

A. U.S. District Court for the Eastern District of Missouri

Patent Owner has asserted U.S. Patent No. 9,365,223 (the “’223 Patent”) (see Ex. 1001) in *Amsted Rail Company, Inc. v. Hum Industrial Technology, Inc. et al*, No. 4:22-cv-00445-AGF (E.D. Mo.) (the “Litigation”).

B. The U.S. Patent and Trademark Office

The cover page of the ’223 Patent states that the application from which the ’223 Patent issued, U.S. Patent Application No. 13/842,427 (the “’427 Appl.”), was filed on March 15, 2013 and is a continuation-in-part of U.S. Patent Application No. 12/861,713 (the “’713 Appl.”) filed on Aug. 23, 2010, now U.S. Patent No. 9,026,281. The ’427 Appl. also claims the benefit of U.S. Provisional Patent Application No. 61/661,661 filed on June 19, 2012.

Petitioner has also filed the following Petitions for Inter Partes Review of two other patents owned by Patent Owner and asserted in the Litigation:

- *Hum Industrial Tech., Inc. v. Amsted Rail Co., Inc.*, IPR2023-00539, challenging claims of U.S. Patent No. 9,981,673; and
- *Hum Industrial Tech., Inc. v. Amsted Rail Co., Inc.*, IPR2023-00540, challenging claims of U.S. Patent No. 10,137,915.

A continuation of the '427 Appl., claiming priority to the '713 Appl., was filed on May 18, 2016 as U.S. Patent Application No. 15/158,018 (the "'018 Appl."), and is now U.S. Patent No. 9,981,673.

A continuation of the '018 Appl., claiming priority to the '427 Appl. and the '427 Appl. was filed on April 30, 2018 as U.S. Patent Application No. 15/967,090, and is now abandoned.

III. Lead and Back-up Counsel under 37 C.F.R. § 42.8(b)(3)

A. Lead Counsel

Patent Owner identifies and designates the following as lead counsel:

Lead Counsel:

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A Power of Attorney for lead counsel is submitted with this Mandatory Notice.

B. Back-up Counsel

Patent Owner identifies and designates the following as back-up counsel:

Back-up Counsel:

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A Power of Attorney for back-up counsel is submitted with this Mandatory Notice.

IV. Service Information under 37 C.F.R. § 42.8(b)(4)

Patent Owner consents to service of all documents via electronic mail. Please address all correspondence to lead and back-up counsel as listed above.

Respectfully submitted,

Dated: February 21, 2023	By: <u>/Jeff E. Schwartz/</u> Jeff E. Schwartz Reg. No. 39,019 Counsel for Patent Owner Amsted Rail Company, Inc.
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I certify that on this 21st day of February, 2023,
a copy of

PATENT OWNER’S MANDATORY NOTICES

was served by electronic mail on Petitioner’s counsel, lead and back-up, as follows:

Lead Counsel

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Counsel for Petitioner has consented to service of all documents via electronic
email. *See* Petition, Paper 1 at 2.

Dated: February 21, 2023

By: / Ryan N. Miller /

Ryan N. Miller
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Counsel for Patent Owner
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