

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*

Patent No. 9,365,223  
Issue Date: June 14, 2016  
Title: SYSTEM AND METHOD FOR MONITORING  
RAILCAR PERFORMANCE

---

*Inter Partes* Review No. IPR2023-00538

---

**PETITIONER HUM INDUSTRIAL TECHNOLOGY, INC.'S  
MOTION TO CORRECT TYPOGRAPHICAL ERRORS  
IN THE PETITION UNDER 37 C.F.R. § 42.104(c)**

**EXHIBIT INDEX**

| <b>Ex #</b> | <b>Exhibit Description</b>                                                                                                        |
|-------------|-----------------------------------------------------------------------------------------------------------------------------------|
| 1001        | U.S. Patent No. 9,365,223 (“the ’223 patent”)                                                                                     |
| 1002        | Prosecution History of the ’223 Patent                                                                                            |
| 1003        | Expert Declaration of Steven Ricca                                                                                                |
| 1004        | <i>Curriculum Vitae</i> for Steven Ricca                                                                                          |
| 1005        | U.S. Patent Publication No. 2007/0152107 A1 to LeFebvre et al. (“LeFebvre”)                                                       |
| 1006        | U.S. Patent Publication No. 2011/0282540 A1 to Armitage et al. (“Armitage”)                                                       |
| 1007        | U.S. Patent Publication No. 2007/0208841 A1 to Barone et al. (“Barone”)                                                           |
| 1008        | U.S. Patent No. 5,633,628 to Denny et al. (“Denny”)                                                                               |
| 1009        | U.S. Patent No. 4,282,754 to Provasnik (“Provasnik”)                                                                              |
| 1010        | U.S. Patent No. 6,487,478 to Azzaro et al. (“Azzaro”)                                                                             |
| 1011        | Amsted Rail Company, Inc.’s Complaint filed against Hum Industrial Technology, Inc. (ECF No. 1) filed on April 18, 2022           |
| 1012        | Waiver of the Service of Summons upon Hum Industrial Technology, Inc. (ECF No. 4) dated June 14, 2022                             |
| 1013        | U.S. Provisional Application No. 61/661,661 (“the ’661 Provisional”)                                                              |
| 1014        | U.S. Patent Application No. 12/861,713 (“the ’713 Application”)                                                                   |
| 1015        | U.S. Patent No. U.S. 7,688,218 to LeFebvre et al. (“LeFebvre ’218”)                                                               |
| 1016        | Third Generation On-Board Monitoring and Control System Based on Controller Area Network Technology Dr. John Donelson III, et al. |
| 1017        | Defendants' Stipulation of Invalidity Contentions                                                                                 |
| 1018        | <u>Proposed Corrected Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,365,223 (Redline)</u>                          |
| 1019        | <u>Proposed Corrected Petition for <i>Inter Partes</i> Review of U.S. Patent No. 9,365,223</u>                                    |

Petitioner Hum Industrial Technology, Inc. (“Petitioner”) files this motion respectfully requesting correction of a clerical mistake in the Petition filed in this proceeding.

## **I. FACTS RELEVANT TO THIS MOTION**

1. On January 30, 2023, Petitioner filed its Petition for *Inter Partes* Review of U.S. Patent No. 9,365,223 (the “’223 Patent”). Paper 1, Petition.
2. Ground 1 of the Petition challenges claims 2–10, 18, 20, 21, 23, and 25–32 as obvious over US 2007/0152107 A1 to LeFebvre et al. (“LeFebvre”).
3. Ground 4 of the Petition challenges claims 2, 3, 5, 7, 13–18, 20–22, 26–28, and 32 as obvious over US 2011/0282540 A1 to Armitage et al. (“Armitage”).
4. Ground 5 of the Petition challenges claims 4, 6, 8, 9, 10, 23, 25, and 29–31 as obvious over Armitage in view of LeFebvre.
5. The Petition includes a clerical error. Specifically, the limitation “software, stored in said memory and executed by said processor, said software performing the functions of collecting data from said sensor at periodic intervals” was inadvertently omitted from claim 5 as it appears in the Listing of Claims.
6. For ease of reference throughout the Petition, the Listing of Claims includes a sequential label for each limitation. The inadvertently omitted limitation should have appeared *between* limitations 5(f) and 5(g) in the Listing of Claims.
7. The error in the Listing of Claims was also carried through into the Grounds,

which do not address the missing limitation of claim 5. As a further consequence, claims 5 and 7 were mistakenly listed under Ground 4 rather than Ground 5. The listed limitations of claim 5 are fully addressed by Armitage (Ground 4). But the omitted limitation is addressed only by Armitage in view of LeFebvre (Ground 5).

8. Claims 5 and 8 are identical in scope, and the limitation inadvertently omitted from claim 5 is fully addressed in the Petition with respect to claim 8.

9. Petitioner notified Patent Owner of the clerical error on February 16, 2023.

## **II. RELIEF REQUESTED**

Petitioner respectfully requests that it be allowed to correct its Petition by:

- (1) correcting the Listing of Claims to accurately recite the text of claim 5;
- (2) adding a cross-reference within the discussion of claim 5 to the existing discussion of the corresponding limitation in claim 8 in Ground 1;
- (3) moving the discussion of claim 5 and its dependent claims from Ground 4 to Ground 5,<sup>1</sup> and adding a cross-reference within the discussion of claim 5 to the existing discussion of the corresponding limitation in claim 8 in Ground 5; and

---

<sup>1</sup> During the March 27 conference call, the Board inquired about dependent claim 7. Petitioner now recognizes that because claims 7, 13-18, 20-22, and 32 depend from claim 5, they must also move to Ground 5. Other than moving their location within the Petition, no other corrections to these claims are proposed or required.

(4) updating the Table of Contents, Table of Authorities, and internal cross-references to reflect any resulting changes to section headings or page numbering.

A redlined Corrected Petition that identifies the proposed corrections has been filed as EX1018. The proposed revision is organized in a way that maintains existing headings and section numbering to the extent possible.

### **III. THE PROPOSED CORRECTIONS ARE CLERICAL IN NATURE**

The proposed changes are necessary to correct a non-substantive, clerical error that was not identified prior to filing. Petitioner promptly sought to correct its mistake after discovering it shortly after the Petition was filed. *See* 37 C.F.R. § 42.104(c). (“A motion may be filed that seeks to correct a clerical or typographical mistake in the petition.”). Rule 104(c) “is remedial in nature and is therefore entitled to a liberal interpretation.” *ABB Inc. v. ROY-G-BIV Corp.*, IPR2013-00063, slip op. at 7 (PTAB Jan. 16, 2013) (Paper 21).

The proposed changes do not add any new substantive analysis or argument to the Petition. Petitioner seeks to add cross-references within the discussion of claim 5 to the existing discussion of identical limitations in claim 8. As noted above, claim 8 is *identical* in scope to claim 5. Patent Owner will have to address *exactly the same arguments* even if the Petition is not corrected. And if the Petition is corrected, Petitioner’s challenge of claim 5 will rise or fall based upon the substantive arguments that were present in the Petition on the date it was filed.

Likewise, moving the discussion of claim 5 and its dependents from Ground 4 to Ground 5 does not add or alter any of the substantive arguments raised in the Petition. Claim 8—which, again, is *identical* in scope to claim 5—is already addressed in Ground 5, which is based upon a combination of Armitage and LeFebvre. The motivation to combine Armitage and LeFebvre, already discussed with respect to claim 8, is equally applicable to claim 5. Patent Owner will have to address the arguments present in Ground 5 even if the Petition is not corrected.

The Board addressed similar circumstances in *Unified Patents v. Universal Secure Registry LLC*, which involved certain claims that were mistakenly placed within the wrong Ground in the Petition. IPR2018-00067, Paper 11 (PTAB March 14, 2018). Here, as in *Unified Patents*, “[t]he change Petitioner seeks does not modify the mappings of the claims to the art in any way.” *Id.* at 3. Rather, the proposed corrections are “related only to the location of certain discussion within the Petition and not the content of that discussion.” *Id.* at 4. Accordingly, as in *Unified Patents*, the error is clerical in nature and can be corrected under § 104(c). *Id.* at 5. See also *Merck Sharp & Dohme Corp v. Ono Pharmaceutical Co., Ltd. et al.*, IPR2016-01217, Paper 10 (PTAB Oct. 3, 2016) (allowing correction of petition to move inadvertent listings of challenged claims from one ground to another).

#### **IV. THE REQUESTED RELIEF PROMOTES JUDICIAL EFFICIENCY**

The '223 Patent is the subject of a lawsuit currently pending in the Eastern

District of Missouri. EX1011. One day after filing the present Petition, Petitioner filed related proceedings IPR2023-00539 and IPR2023-00540, which are directed to closely related patents that have been asserted in the same lawsuit. The same primary references (LeFebvre and Armitage) have been asserted in all three IPRs, and Petitioner expects all three proceedings to raise similar or identical issues.

The one-year anniversary of service of the Complaint in the related litigation is June 14, 2023. EX1012. Petitioner could therefore move to withdraw the current Petition and file a new one that includes the proposed corrections. That option, however, would needlessly tax Board resources and result in duplicative filings. It would also prevent the three related IPRs from proceeding on the same timeline. And allowing correction, particularly at this early stage, would not meaningfully prejudice Patent Owner. Under these circumstances, “avoiding the need for Petitioner to file a new petition and instead permitting Petitioner to file the proposed Corrected Petition will best effect efficiency in [these] proceedings.”

*Unified Patents*, IPR2018-00067, Paper 11 at 5. *See also Netapp, Inc. v.*

*Intellectual Ventures II LLC*, IPR2017-00276, Paper 12 at 3 (PTAB May 5, 2017).

## **V. CONCLUSION**

Petitioner respectfully requests that the Board apply the proposed corrections to Petitioner’s Petition for *Inter Partes* Review. Petitioner certifies the corrections will not cause the Petition to exceed the word count limit of 37 C.F.R. § 42.24.

**CERTIFICATE OF SERVICE**

I hereby certify that on this 31st day of March, 2023, I caused the foregoing to be served via electronic mail to the attorneys of record for the Patent Owner at the following address:

Jeff E. Schwartz  
Reg. No. 39,019  
P. Marshall Ticer  
Reg. No. 74,653  
Fox Rothschild LLP  
2020 K Street N.W., Suite 500  
Washington, DC 20006  
Email: [jeschwartz@foxrothschild.com](mailto:jeschwartz@foxrothschild.com)  
[mticer@foxrothschild.com](mailto:mticer@foxrothschild.com)

Gary A. Hecht  
Reg. No. 36,826  
Ryan North Miller  
Reg. No. 68,262  
Fox Rothschild LLP  
2000 Market Street, 20th Floor  
Philadelphia, PA 19103-3222  
Email: [ghecht@foxrothschild.com](mailto:ghecht@foxrothschild.com)  
[rmiller@foxrothschild.com](mailto:rmiller@foxrothschild.com)

By: /Eric J. Rakestraw/  
Eric J. Rakestraw, Reg. No. 68,740  
Lead Counsel for Petitioner