

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 IPR2023-00538
Patent No. 9,365,223

**PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

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Petitioner's reply does not present any arguments that could not have been raised in the Petition. Furthermore, the scope of the Reply is much larger than Petitioner indicated in the conference call with the Board. *See* Ex. 1020 at 8, 10. Instead Petitioner has improperly used its reply to expand on arguments it already made in the Petition, circumventing the Board's rules regarding word limits. The Reply should be accorded little if any weight in the institution decision. Petitioner was on notice, nearly three months prior to filing the Petition, that Patent Owner claimed the filing date of the '223 patent's CIP parent, the '713 Application (Ex. 1014) as the effective filing date of at least claim 2. *See e.g., Amsted Rail Co. Inc. v. Hum Industrial Technology Inc.*, No. 4:22-cv-00445-AGF, Doc. No. 45-1 at 5 (E.D. Mo. filed Dec. 29, 2022). Patent Owner also gave specific citations to evidence to establish written description support for the claimed limitations of at least claim 2. Petitioner simply ignored this evidence in the Petition.

I. PETITIONER'S FAILED ITS BURDEN TO ESTABLISH THAT ARMITAGE IS PRIOR ART

At no point in its reply does Petitioner even mention the legal standard under which adequate written description is determined. Patent Owner need only show that the specification of the '713 Application "describe[s] an invention understandable to that skilled artisan and show that the inventor actually invented the invention claimed." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir.

2010) (en banc). Additionally, “the level of detail required to satisfy the written description requirement varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Id.* “[T]he prior application need not describe the claimed subject matter in exactly the same terms as used in the claims” but “must simply indicate to persons skilled in the art that as of the earlier date the applicant had invented what is now claimed.” *Eiselstein v. Frank*, 52 F.3d 1035, 1038 (Fed. Cir. 1995).

Here, the challenged ’223 patent (Ex. 1001) is a continuation-in-part of the earlier ’713 application (Ex. 1014) which in turn incorporates by reference the disclosure of U.S. Patent 7,688,218 (Ex. 1015). Written description is determined through “an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art.” *Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1063 (Fed. Cir. 2020) (citing *Ariad*, 598 F.3d at 1351). The four corners of the specification of the ’223 patent include the disclosures of the ’713 application and the ’218 patent incorporated within it. *Paice LLC*, 881 F.3d at 910. Written description support for claims 2 and 23 is found in the combined disclosure of the ’713 application. See Paper 11 at 15-23; Ex. 2001 at ¶¶34-40, App. A.

It is undisputed that the ’713 Application, with the incorporated disclosure of the ’218 Patent, discloses 1) a monitoring device in the form of an instrumented adapter pad that includes a temperature sensor and 2) a monitoring device in the

form of a strain gauge having a housing. The '713 Application expressly notes that the CMU “can also communicate with, control and/or monitor other devices on the railcar” and incorporates the “device and system” of the '218 Patent as an example. Ex. 1014 at ¶27. The '713 Application further explains that “suitable components” may be contained within the disclosed monitoring device and that “infinite variations are possible depending on the configuration desired.” *Id.* at ¶44. Finally, the '713 Application explicitly notes that it describes “certain embodiments” but “is not intended to limit [them] in any way.” *Id.* at ¶45. This disclosure is more than sufficient to inform an ordinarily skilled artisan, well aware of prior art monitoring technology, that the inventors possessed any number of monitoring devices capable of monitoring operational characteristics of a railcar, including a device with a housing and a temperature sensor, as they are disclosed in the '713 Application. *See Union Oil Co. of Cal. v. Atl. Richfield Co.*, 208 F.3d 989, 997 (Fed. Cir. 2000) (“The written description requirement does not require the applicant ‘to describe exactly the subject matter claimed, [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.’”)

Petitioner admits that the '218 Patent does, in fact, disclose a temperature sensor, effectively conceding that all the limitations of claim 2 are, in fact, present in the disclosure of the '713 Application notwithstanding its patently false statement that “the '713 Application does not disclose a temperature sensor at all.” Reply at 3;

see also Paice LLC v. Ford Motor Co., 881 F.3d 894, 906 (Fed. Cir. 2018) (“the material [incorporated by reference] is effectively part of the host document as if it were explicitly contained therein”). Petitioner now improperly presses a new argument that the ’713 Application’s disclosure is “an amalgam of disclosures plucked selectively from the [parent] application’ ... that does not satisfy the written description requirement.” Paper 12 at 2 (quoting *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1349 (Fed. Cir. 2013)). This is not the case.

The four corners of the ’713 application includes the entirety of the ’218 patent and both monitoring device embodiments as well as clear intent to not limit the embodiments only to what is explicitly disclosed. This is not a case where the claims functionally recite a broad genus without describing the species which make up the genus, like *Novozymes*. 723 F.3d at 1348. The ’713 Application does not require a Ph.D. in biochemistry to understand it. The ’223 patent claims sensor devices and systems for monitoring operational characteristics of a railcar. The level of ordinary skill proposed by both parties merely requires a bachelors degree. *See* Petition at 14-15; POPR at 28. Petitioner’s own caselaw states that the level of detail required “varies depending on the nature and scope of the claims and on the complexity and predictability of the relevant technology.” *Ariad*, 598 F.3d at 1351. All Patent Owner has to show is that the disclosure of the ’713 application, as of its filing date and with all appropriately incorporated material included within it, would

inform a POSA that the inventors had possession of a railcar monitoring device with a housing and a temperature sensor. The embodiments disclosed in the '713 application provide this written description. *See Union Oil Co.*, 208 F.3d at 997.

II. THE BOARD SHOULD DENY THE PETITION PURSUANT TO §325(d)

The Board has unequivocally stated in a precedential decision that “art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent” is art that has been previously presented to the Office. *Advanced Bionics, LLC v. Med-El Electromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 at 7-8 (Feb. 13, 2020) (precedential). Further, upon a showing that the art relied upon in a petition was previously presented to the Office, “the Board’s decisions generally have required a showing that the Office erred in evaluating the art or arguments.” *Id.* at 8. Petitioner ignored this reality entirely in the Petition and belatedly acknowledged it in Reply only to continue to rely on non-precedential decisions that either predated the precedential designation of *Advanced Bionics* or were decided under markedly different circumstances to this proceeding. *See Amazon.com, Inc. v. M2M Sols. LLC*, IPR2019-01204, Paper 14 at 3, 16 (PTAB. Jan. 23, 2020) (decided before *Advanced Bionics* was designated precedential and following **seven** prior IPR proceedings, some of which were decided against patent owner, and where the IDS in question

contained “a few hundred references”); *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ., Ltd.*, IPR2022-01283, Paper 12 at 13-14 (PTAB Feb. 22, 2023) (analyzing a combination where one of the references was not cited to the office and where a previous IPR proceeding was instituted over the same arguments).

Here, **every** reference asserted in grounds against all independent claims except claim 1¹ was previously presented to the Office. The burden is on Petitioner to establish material error. *Advanced Bionics*, Paper 6 at 8 (“if [prong 1] is satisfied, [the petitioner must demonstrate] that the Office erred in a manner material to the patentability of challenged claims”). Patent Owner’s argument is simply that each of the primary references were, in fact, before the Office, were considered, the Examiner allowed the claims over them, and Petitioner has not established error. *See* POPR at 3-10. While §325(d) is permissive and does not require the Board to deny or grant institution, it is also beyond doubt that “a rejection applying a reference that is later relied upon by a petitioner is not a prerequisite to a finding that such reference was already presented to the Office under §325(d).” *Boragen, Inc. v. Syngenta Participations AG*, IPR2020-00124, Paper 16 at 21-22 (PTAB May 5, 2020) (finding references submitted by a patent applicant “early in the prosecution” of the challenged patent “were presented during prosecution” for purposes of *Advanced*

¹ The challenges to claim 1 are deficient on the merits. *See* POPR at 49-50, 59-60.

Bionics prong 1). Petitioner unequivocally stated that “**None** of the references relied upon in this petition...were cited during prosecution of the ’427 Application.” Petition at 7. Petitioner now apparently disavows this statement and argues, for the first time in reply, that the Office committed material error in allowing the challenged claims. Thus, Petitioner concedes that *Advanced Bionics* prong 1 is met.

Petitioner presents no declaration testimony regarding how a POSA would read Baker and Searle to support a finding of a material error, instead relying solely on the contested factual assertions raised in the Petition. See Paper 12 at 6-7; see also POPR at 31-46, 53-58; Ex. 2002 at ¶¶ 59-84, 97-110 (discussing various claim features not found in Lefebvre and Armitage). The entirety of Petitioner’s discussion of §325(d) in the Petition and Reply is mere attorney argument and is entitled to little, if any, weight. *Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01529, Paper 16 at 20 (PTAB Mar. 21, 2023). That attorney argument is not sufficient to establish material error. Petitioner has not met its burden. Denial under §325(d) is therefore appropriate. *Advanced Bionics*, Paper 6 at 8-9 (“If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.”).

III. CONCLUSION

For the reasons described above, the Board should decline to institute *inter partes* review.

Respectfully submitted,

Dated: June 19, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on this 19th day of June, 2023, a copy of the foregoing was served by electronic mail on Petitioner's counsel, lead and back-up, as follows:

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