

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
US Patent No. 9,365,223

Before JAMES P. CALVE, KEVIN W. CHERRY, and MICHAEL L. WOODS,
Administrative Patent Judges.

PETITIONER'S OBJECTIONS TO EVIDENCE

Pursuant to 37 C.F.R. § 42.64(b)(1), Petitioner Hum Industrial Technology, Inc. (“Petitioner”) provides the following objections to evidence submitted in connection with Patent Owner’s Response (Paper 20) and Patent Owner’s Motion to Amend and Request for Preliminary Guidance (Paper 21) filed by Patent Owner Amsted Rail Company, Inc. (“Patent Owner”).

Exhibits 2010 and 2161—Expert Declaration of Dr. Michael Shamos: Petitioner objects to the admissibility of Exhibits 2010 and 2161 under FRE 701–703, because they contain opinions that are conclusory, that do not disclose supporting facts or data, that are based on unreliable facts, data, or methods, and that include testimony outside the scope of Dr. Shamos’ specialized knowledge (to the extent Dr. Shamos has any such knowledge) that will not assist the trier of fact.

Petitioner further objects to Exhibits 2010 and 2161 as containing opinions that are irrelevant, confusing, and present the danger of unfair prejudice under FRE 401–403. Specifically, Petitioner objects to Exhibits 2010 and 2161 as lacking sound evidentiary basis, biased, vague, misleading, confusing the issues, and as more prejudicial than probative under FRE 403. Petitioner also objects to Exhibits 2010 and 2161 to the extent Dr. Shamos offers opinions on conception and reduction to practice, in an attempt to “swear behind” a prior art reference, without independent corroboration of the proffered testimony. Petitioner further objects to any paragraph in Exhibits 2010 and 2161 that relies upon an exhibit objected to herein, for the

reasons set forth in those objections.

Petitioner objects to select paragraphs of Dr. Shamos' declaration as described below:

¶¶ 29-31, 37, 39-40, 42-48, 71-73, 76-81, 89-91, Appendix A: Petitioner objects to these paragraphs under FRE 701–703 as expert testimony not based on sufficient facts or data, and not the product of reliable principles and methods. Petitioner further objects to these paragraphs under FRE 401–403 on the grounds of relevance and as more prejudicial than probative.

¶¶ 12, 14, 16-22, 32, 36, 49-55, 57-70, 82, 84, 85, 87, 88, 92, 93, Appendix A: Petitioner objects to these paragraphs as containing improper legal conclusions. Petitioner further objects to these paragraphs under FRE 701–703 as expert testimony not based on sufficient facts or data, and not the product of reliable principles and methods. Petitioner further objects to these paragraphs under FRE 401–403 on the grounds of relevance and as more prejudicial than probative.

Petitioner further objects to any portion of Appendix A that relies upon an exhibit objected to herein, for the reasons set forth in those objections. The fact that Petitioner has not objected to certain paragraphs or portions of Exhibits 2010 and 2161 provides no indication that Petitioner agrees to the positions asserted therein.

Exhibit 2011—Internet Archive Capture of <https://www.merriam-webster.com/dictionary/level>: Petitioner objects to Exhibit 2011 as lacking

authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for this document or attempt to authenticate it. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE 803).

Petitioner also objects to Exhibit 2011 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibit 2012—Internet Archive Capture of <https://www.merriam-webster.com/dictionary/fault>: Petitioner objects to Exhibit 2012 as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for this document or attempt to authenticate it. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE 803).

Petitioner also objects to Exhibit 2012 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibits 2013 and 2160—Declaration of Andrew Martin: Petitioner objects to these exhibits (all paragraphs) on the grounds that Mr. Martin is a named inventor of the patent at issue and is not an unbiased person of ordinary skill in the art, and thus cannot provide expert testimony regarding the patent at issue and instituted prior art references. (FRE 702/703). Petitioner also objects to these exhibits to the extent Mr. Martin’s declaration is that of a lay person improperly being presented as expert testimony. (FRE 701-703). Because Mr. Martin is a named inventor of the patent at issue, Petitioner further objects to Exhibits 2013 and 2160 on the grounds of relevance (FRE 402) and as more prejudicial than probative (FRE 403). Petitioner further objects to any paragraphs in Exhibits 2013 and 2160 that rely upon an exhibit objected to herein, for the reasons set forth in those objections.

Whether or not Mr. Martin is a person of ordinary skill in the art, Petitioner objects to select paragraphs of this declaration as described below:

¶¶ 7-24, 26-51, 53: Petitioner objects to these paragraphs on the grounds of hearsay, and to the extent Patent Owner relies on these paragraphs and exhibits cited therein are offered for the truth of the matter asserted (FRE 803).

¶¶ 6, 53: Petitioner objects to these paragraphs as containing improper legal conclusions. Petitioner further objects to these paragraphs under FRE 401–403 on the grounds of relevance and as more prejudicial than probative. Petitioner also objects to these exhibits to the extent it is testimony of a lay person improperly being

presented as expert testimony. (FRE 701-703).

The fact that Petitioner has not objected to certain paragraphs or portions of Exhibits 2013 and 2160 provides no indication that Petitioner agrees to the positions asserted therein.

Exhibit 2014—Declaration of Jay Monaco: Petitioner objects to this exhibit (all paragraphs) on the grounds that Mr. Monaco is not a person of ordinary skill in the art, and thus cannot provide expert testimony regarding the patent at issue and instituted prior art references. (FRE 702/703). Petitioner further objects to the exhibit on the grounds of relevance (FRE 402) and as more prejudicial than probative (FRE 403).

Whether or not Mr. Monaco is a person of ordinary skill in the art, Petitioner objects to select paragraphs of this declaration as described below:

¶¶ 4, 5-22: Petitioner objects to these paragraphs as containing improper legal conclusions. Petitioner further objects to these paragraphs under FRE 401–403 on the grounds of relevance and as more prejudicial than probative and to the extent the exhibits cited in Exhibit 2014 are being relied on for the truth of the matter asserted (FRE 803).

Exhibits 2015-2016, 2019-2028, 2030-2034, 2036-2044, 2046-2047, 2049-2050, 2052, 2054-2079, 2081-2089, 2091, 2093-2103, 2105-2111, 2113-2115, 2117-2124, 2126-2154, 2162-2164, 2166-2167: Petitioner objects to these exhibits

as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for these emails. Moreover, Petitioner objects to these exhibits on the grounds of hearsay (FRE 803). Petitioner also objects to these exhibits on the grounds that Patent Owner relies on these exhibits for the truth of the matter asserted (FRE 803).

Petitioner also objects to these exhibits as untimely. These documents were available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibit 2017—IONX Information from the Edge: Petitioner objects to Exhibit 2017 as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for this document. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE 803).

Petitioner also objects to Exhibit 2017 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibit 2018—Metadata for IONX Information from the Edge Ex. 2017:

Petitioner objects to Exhibit 2018 as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for this document. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE 803).

Petitioner also objects to Exhibit 2018 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibits 2029, 2035, 2045, 2048, 2053, 2080, 2112, 2165—ARX Engineering Emails: Petitioner objects to these exhibits as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for these exhibits. Moreover, Petitioner objects to these exhibits on the grounds of hearsay (FRE 803). Petitioner also objects to these exhibits on the grounds that Patent Owner relies on these exhibits for the truth of the matter asserted (FRE 803).

Petitioner also objects to these exhibits as untimely. These documents were available to Patent Owner prior to filing its Preliminary Response and could have

been filed with the Preliminary Response at the time of filing.

Exhibits 2051, 2104, 2116, 2125—Meeting Invites: Petitioner objects to Exhibits 2051, 2104, 2116, 2125 as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for these exhibits. Moreover, Petitioner objects to these exhibits on the grounds of hearsay (FRE 803). Petitioner also objects to these exhibits on the grounds that Patent Owner relies on these exhibits for the truth of the matter asserted (FRE 803).

Petitioner also objects to these exhibits as untimely. These documents were available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibit 2090—Metadata for Ex. 2047: Petitioner objects to Exhibit 2090 as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for this document or attempt to authenticate it. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE 803).

Petitioner also objects to Exhibit 2090 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibit 2092—WSN Assembly: Petitioner objects to Exhibit 2092 as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for this document or attempt to authenticate it. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE 803).

Petitioner also objects to Exhibit 2092 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibit 2155—Boomerang Info Sheet: Petitioner objects to Exhibit 2155 as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for this document or attempt to authenticate it. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE

803).

Petitioner also objects to Exhibit 2155 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibit 2156—Hum Company Overview: Petitioner objects to Exhibit 2156 as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for this document or attempt to authenticate it. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE 803).

Petitioner also objects to Exhibit 2156 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibit 2157— Exhibit 15 to Declaration of Ryan Miller¹: Petitioner

¹ Petitioner notes that Exhibit 2157 is not included in Patent Owner’s list of exhibits for IPR2023-00538, nor was it submitted with Patent Owner’s November 3, 2023 filings. However, it is referenced in Mr. Miller’s Declaration submitted with Patent Owner’s Response (Exhibit 2170), so Petitioner has included objections to Exhibit 2157 from related IPR2023-00539.

objects to Exhibit 2157 under FRE 401–403 on the grounds of relevance and as more prejudicial than probative, insofar as it is a filing from the related District Court litigation, and it is not relevant to the current matter. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE 803).

Petitioner also objects to Exhibit 2157 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

Exhibit 2158— Expert Declaration of Dr. Michael Shamos (Motion to Amend): Petitioner objects to the admissibility of Exhibit 2158 under FRE 701–703, because it contains opinions that are conclusory, that do not disclose supporting facts or data, that are based on unreliable facts, data, or methods, and that include testimony outside the scope of Dr. Shamos’ specialized knowledge (to the extent Dr. Shamos has any such knowledge) that will not assist the trier of fact.

Petitioner further objects to Exhibit 2158 as containing opinions that are irrelevant, confusing, and present the danger of unfair prejudice under FRE 401–403. Specifically, Petitioner objects to Exhibit 2158 as lacking sound evidentiary basis, biased, vague, misleading, confusing the issues, and is more prejudicial than probative under FRE 403. Petitioner also objects to Exhibit 2158 to the extent Dr.

Shamos offers opinions on conception and reduction to practice, in an attempt to “swear behind” a prior art reference, without independent corroboration of the proffered testimony. Petitioner further objects to any paragraph in Exhibit 2158 that relies upon an exhibit objected to herein, for the reasons set forth in those objections.

Petitioner objects to select paragraphs of Dr. Shamos’ declaration as described below:

¶¶ 11, 17 (Sections II.A-CC), 18, 21-25, 27-32: Petitioner objects to these paragraphs as containing improper legal conclusions. Petitioner further objects to these paragraphs under FRE 701–703 as expert testimony not based on sufficient facts or data, and not the product of reliable principles and methods. Petitioner further objects to these paragraphs under FRE 401–403 on the grounds of relevance and as more prejudicial than probative.

The fact that Petitioner has not objected to certain paragraphs of Exhibit 2158 provides no indication that Petitioner agrees to the positions asserted therein.

Exhibit 2168—Metadata for Ex. 2092: Petitioner objects to Exhibit 2168 as lacking authentication as required under FRE 901-902. FRE 901 requires that the “proponent must produce evidence sufficient to support a finding that the item is what the proponent claims it is.” Petitioner provides no evidentiary foundation for this document or attempt to authenticate it. Moreover, Petitioner objects to this exhibit on the grounds of hearsay (FRE 803). Petitioner also objects to this exhibit

on the grounds that Patent Owner relies on it for the truth of the matter asserted (FRE 803).

Petitioner also objects to Exhibit 2168 as untimely. The document was available to Patent Owner prior to filing its Preliminary Response and could have been filed with the Preliminary Response at the time of filing.

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Respectfully submitted,

Dated: November 13, 2023

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CERTIFICATE OF SERVICE

I hereby certify that on this 13th day of November, 2023, the foregoing was served via electronic mail to the attorneys of record for the '223 Patent at the following address:

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