

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 MOTION TO EXCLUDE

I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.64 and the Federal Rules of Evidence, Patent Owner Amsted Rail Company, Inc. (“PO”) moves to exclude Exhibit 1034 (Armitage Provisional). Petitioner Hum Industrial Technology, Inc. (“Petitioner”) relies on Exhibit 1034 on page 10 of its Reply (Paper 26, EX1034). PO timely objected to this exhibit on sufficiently particularized grounds (*see* Paper 29, 5).

Exhibit 1034 is a provisional application that should have been filed with Petitioner’s case-in-chief because Petitioner was aware of PO’s claim to an earlier priority date and relied on the provisional filing date in its Petition (Paper 1, 5, n.1), yet chose to deny the Board and PO the provisional application until its Reply. *See* Paper 26, 10.

II. ARGUMENT

Petitioner declared in the Petition that “Armitage claims, and is entitled to, a provisional application filing date of May 11, 2010.” Paper 1, 5, n.1. This claim was intentional, as Petitioner was aware from discovery served in the related District Court Proceeding, *Amsted Rail Company, Inc. v. Hum Industrial Technology, Inc. et al*, Case No. 4:22-cv-00445-AGF (United States District Court for the Eastern District of Missouri), that PO expressly claimed an earlier priority date for certain claims of the ‘223 Patent. Yet Petitioner did not provide the required evidence for this assertion, resulting in an unreasonable and prejudicial deficiency which deprives

PO of its opportunity to submit affirmative evidence.

The Supreme Court has explained that a petition “guide[s] the life of the litigation,” and the petitioner's contentions “define the scope of the litigation all the way from institution to conclusion.” 138 S.Ct. 1348, 1351, 1357 (2018). That is why 35 USC § 312(a)(3), governing petitions, requires that: “the petition identifies, in writing and with particularity, each claim challenged, the grounds on which the challenge to each claim is based, *and the evidence that supports the grounds* for the challenge to each claim, including-- (A) *copies of patents and printed publications that the petitioner relies upon* in support of the petition” (emphasis added). It also makes sense that 35 USC § 42.63 requires that “[A]ll evidence must be filed in the form of an exhibit,” and 35 USC §42.51 states that “any exhibit cited in a paper ... must be served with the citing paper or testimony.” Petitioner has done none of this. Instead, it waited nearly a year, until it filed its Reply, to file the Armitage provisional as evidence.

Petitioner will likely rely on *Dynamic Drinkware*’s burden shifting approach, but that reliance will be misplaced. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F. 3d 1375, 1379-80 (Fed. Cir. 2015). The Court in *Dynamic Drinkware* was concerned with shifting burdens of production and is clear that Petitioner bears the ultimate burden of persuasion regarding issues of invalidity. *Id.* However, shifting burdens regarding the production of evidence does not relieve Petitioner of

the requirement to provide its supporting evidence for statements made *in the Petition* with the filing of the Petition – statements that were made intentionally to support its asserted prima facie case of unpatentability, rather than merely as a “conclusory assertion”. *Dynamic Drinkware*, 800 F.3d at 1381. “Examples of indications that a new issue has been raised in a reply include new evidence necessary to make out a prima facie case for the patentability or unpatentability of an original or proposed substitute claim, and new evidence that could have been presented in a prior filing.” Office Patent Trial Practice Guide, 77 FR 48756-01. By waiting until its Reply to enter Exhibit 1034 into evidence, Petitioner denied PO any ability to produce *any* evidence on Armitage’s entitlement to its provisional date. Instead, PO’s only opportunity to respond to Petitioner’s argument regarding Exhibit 1034 was in its Sur-Reply, where Board rules prohibit PO from presenting any evidence. *See* 37 C.F.R. § 42.23(b); Consolidated Trial Practice Guide 73-74.

It is a fundamental concept that the entire IPR process is “a system that is predicated on a petition followed by a trial in which the petitioner bears the burden of proof... [and] the Board must base its decision on arguments that were advanced by a party, and *to which the opposing party was given a chance to respond.*” *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (emphasis added). It is unfair to consider Petitioner’s belated evidence that supports its assertions of prima facie unpatentability, while precluding PO by rule from

presenting evidence in response. Petitioner’s untimely presentation of Exhibit 1034 should not be condoned and the Board should exclude Exhibit 1034. *See Dexcom, Inc. v. AgaMatrix, Inc.*, IPR2016-01679, Paper 53, at 51 (PTAB Feb. 28, 2018) (“[I]t would violate the Administrative Procedures Act (“APA”)’s requirement for notice and opportunity to respond, if we were to rely upon ... evidence to show that [a claim limitation] was taught or suggested by the prior art, when that evidence was first submitted and relied upon in Petitioner’s Reply.”).

Exhibit 1034 should be excluded.

Respectfully submitted,

Dated: May 17, 2024

By: /Ryan N. Miller/
Ryan N. Miller
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Counsel for Patent Owner
Amsted Rail Company, Inc.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §42.6(e), I certify that on this 17th day of May, 2024, I served a copy of PATENT OWNER'S MOTION TO EXCLUDE by electronic mail on Petitioner's counsel, lead and back-up, as follows:

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

Dated: May 17, 2024

By: / Ryan N. Miller /

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