

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HUM INDUSTRIAL TECHNOLOGY, INC.  
*Petitioner*

v.

AMSTED RAIL COMPANY, INC.  
*Patent Owner*

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

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

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**PETITIONER'S SUR-REPLY IN OPPOSITION TO PATENT OWNER'S  
REVISED MOTION TO AMEND**

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**EXHIBIT INDEX**

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| 1003        | Expert Declaration of Steven Ricca                                                                                                |
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| <b>Ex #</b> | <b>Exhibit Description</b>                                                                                                                |
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| 1022        | International Heavy Haul Association 2007 Conference Proceedings ( <i>Not Filed</i> )                                                     |
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| 1024        | U.S. Patent No. 6,539,293 to Bächtiger et al. (“Bächtiger”)                                                                               |
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Petitioner submits this Sur-Reply in response to Patent Owner's Reply (Paper 43 ("RMTA Reply")) and in opposition to Patent Owner's Revised Motion to Amend (Paper 35 ("RMTA")).

**I. SUBSTITUTE CLAIMS 34–58 LACK WRITTEN DESCRIPTION**

Pursuant to 35 U.S.C. § 316(d)(3) and 37 C.F.R. § 42.121(d)(1), Patent Owner bears the burden of showing, by a preponderance of the evidence, that its substitute claims are supported by written description in the original specification. Whether the substitute claims present new matter (i.e., lack written description support) is a threshold question that must be satisfied before the amended claims can be entered into an IPR proceeding. *Aqua Prod., Inc. v. Matal*, 872 F.3d 1290, 1304 (Fed. Cir. 2017). To satisfy Patent Owner's burden of persuasion, written description support for each substitute claim must be clearly identified in the Motion to Amend. *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 at 7–8 (P.T.A.B. Feb. 25, 2019) (precedential) ("[T]he Board requires that a motion to amend set forth written description support in the originally filed disclosure of the subject patent for each proposed substitute claim....").

Here, as explained in Petitioner's Opposition to the Motion to Amend (Paper 41) ("Opposition") and discussed in further detail below, Patent Owner has not carried its burden of persuasion with respect to substitute claims 34–58. The Board should therefore deny the Revised Motion to Amend on this basis.

**A. Claims 34 and 42: “mounted to a sidewall of a bearing adapter”**

With respect to the limitation “mounted on a sidewall of a bearing adapter” in claim 23, Patent Owner argues that “Figures 3 and 3A, when viewed on their own, do not in any way limit the sensor device to only a temperature sensor.” RMTA Reply at 3. As a general principle, Patent Owner is correct that “drawings alone *may* be sufficient to provide the ‘written description of the invention’ required by § 112, first paragraph.” *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1564 (Fed. Cir. 1991) (emphasis in original). But Patent Owner cites no authority for the proposition that drawings may be interpreted in a manner that ignores express, written language in the specification that explains what is depicted.

Here, a PHOSITA would understand that Figures 3 and 3A disclose precisely what the specification of the ’223 Patent *says* they disclose: “a temperature sensing mote 10 of the type described above mounted to a bearing adapter.” EX1001, 5:31–34. No other type of sensor other than a temperature sensor is described with respect to this embodiment; no alternative types of sensors are depicted, or even suggested, anywhere in the text or in the figures themselves.

**B. Petitioner has applied the correct standards for evaluating the written description requirement.**

The remainder of Patent Owner’s arguments allege that Petitioner has applied an incorrect standard for evaluating the written description requirement.

Patent Owner is correct that the written description requirement does not require *in haec verba* support in the specification. However, “[a]lthough the exact terms need not be used *in haec verba*, the specification must contain an equivalent description of the claimed subject matter.” *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (internal quotation omitted). *See also Flash-Control, LLC v. Intel Corp.*, No. 2020-2141, 2021 WL 2944592, at \*3 (Fed. Cir. July 14, 2021) (“While the written description requirement does not require that the specification recite the claimed invention in any particular way, pointing to an ‘amalgam of disclosures’ from which an artisan could have created the claimed invention does not satisfy this requirement.” (quoting *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1349 (Fed. Cir. 2013)); accord *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010).

Patent Owner makes two fundamental errors in its arguments regarding written description. First, Patent Owner repeatedly refers to concepts that a PHOSITA would allegedly have understood, but which are not actually recited or described anywhere in the specification. Patent Owner’s arguments regarding the “housing” limitation of claim 34 and the “numeric values” limitations in claims 34 and 42, for example, assert that a PHOSITA could have extrapolated from a limited number of examples to recognize that the inventors were in possession of a larger, undisclosed genus that is now claimed. *See* RMTA Reply, 5–6.

Written description support, however, “does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed.” *Lockwood*, 107 F.3d at 1571–72. *See also Ariad*, 598 F.3d at 1352 (“it is the specification itself that must demonstrate possession”). “One shows that one is ‘in possession’ of *the invention* by describing *the invention*, with all its claimed limitations, not that which makes it obvious.” *Lockwood*, 107 F.3d at 1572 (emphasis in original). Patent Owner has not made this showing.

Second, Patent Owner fails to recognize that it “cannot show written description support by picking and choosing claim elements from different embodiments that are never linked together in the specification.” *NeuroDerm Ltd. V. AbbVie Inc.*, PGR2022-00040, Paper 77 at 31 (P.T.A.B., Oct. 31, 2023) (citing *Flash-Control*, 2021 WL 2944592, at \*4. Instead, the claims must be supported “as an integrated whole rather than as a collection of independent limitations.” *Novozymes A/S*, 723 F.3d at 1349.

Here, Patent Owner picks and chooses from disclosures spanning columns 2, 8, and 11 of the specification in an attempt to support the “land-based remote

station/unit” elements of claims 34 and 42. *See* RMTA Reply, 6.<sup>1</sup> More generally, Patent Owner’s arguments address each claim limitation in isolation, and do not address how the specification provides support for entire claim “as an integrated whole”—that is, there is no evidence that claims 34 and 42 disclose the challenged limitations *in combination with* the other recited elements of these claims. Patent Owner has therefore failed to carry its burden to show that substitute claims 34–58 are supported by written description in the original specification of the ’223 Patent.

## **II. SUBSTITUTE CLAIMS 34–58 ARE INVALID UNDER 35 U.S.C. § 112**

### **A. Indefiniteness**

With respect to the “numeric values” limitations in claims 34 and 42, Petitioner notes that its expert, Mr. Ricca, properly testified that a PHOSITA would not be able to determine the scope of these claims with reasonable certainty. EX1035, ¶¶ 9, 27, 28. Notably, while Patent Owner argues that a PHOSITA could determine the meaning of these terms based upon the examples provided in the specification (RMTA Reply at 7–8; *see also id.* at 5), neither Patent Owner nor its expert have attempted to explain what the alleged meaning *is*.

With respect to the “non-flexible material” limitation of claim 34, the Board

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<sup>1</sup> Even if combined, these passages fail to disclose a system wherein *both* the CMU *and* a “land-based remote unit” perform the claimed steps. *See* Opposition, 5–6.

has consistently found that functional terms (i.e., “non-flexible,” “resistant to environmental damage”) are indefinite in the absence of language in the specification that clearly delineates materials that fall within the scope of the claim from those that do not. The ’223 Patent provides no such disclosure. *See, e.g., Ex Parte Bennett*, No. 2014-008859, 2016 WL 4549043, at \*5 (P.T.A.B. Aug. 24, 2016) (affirming an examiner’s rejection of “non-flexible material” as indefinite because the “phrases ‘flexible’ and ‘non-flexible’ are relative terms that require some sort of quantification in order to be limiting”); *Ex Parte Baker*, No. 2010-001513, 2012 WL 2573005, at \*3 (B.P.A.I. June 29, 2012) (holding the term “flexible and non-rigid” as indefinite where the specification failed to define “the requisite amount of flexibility”).<sup>2</sup>

## **B. Enablement**

While enablement must be viewed from the perspective of a PHOSITA, “[i]t is the specification, not the knowledge of one skilled in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement.”

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<sup>2</sup> As discussed below with respect to the prior art, Patent Owner argues that a housing comprising “a housing jacket formed of a rigid material, preferably metal, and a housing cover formed of plastic material” *does not* satisfy this limitation. RMTA Reply, 12.

*Genentech, Inc. v. Novo Nordisk A/S*, 108 F.3d 1361, 1366 (Fed. Cir. 1997). Patent Owner cannot use a PHOSITA's alleged knowledge to fill gaps in its specification and enable the very same features it relies upon to *distinguish* the prior art.

Additionally, as the Supreme Court recently held in *Amgen Inc. v. Sanofi*, 598 U.S. 594 (2023), the specification must enable the full scope of the claims:

If a patent claims an entire class of processes, machines, manufactures, or compositions of matter, the patent's specification must enable a person skilled in the art to make and use the entire class. In other words, the specification must enable the full scope of the invention as defined by its claims. The more one claims, the more one must enable.

*Amgen*, 598 U.S. at 610. Here, although the '223 Patent includes a table disclosing a number of exemplary heuristics, that disclosure alone is not sufficient to enable the broad scope of the substitute claims. Instead, the specification must “reliably enable a person skilled in the art to make and use *all* of what is claimed, not merely a subset.” *Id.* at 611 (emphasis added). As previously explained, the '223 Patent does not meet this standard. *See generally* Opposition, 8–10.

The pre-*Amgen* Federal Circuit cases cited by Patent Owner are not to the contrary. The *Johns Hopkins* and *Invitrogen Corp.* panels both recognized that “[t]o be enabling, the specification of a patent must teach those skilled in the art

how to make and use the **full scope** of the claimed invention without undue experimentation.” *Johns Hopkins Univ. v. CellPro, Inc.*, 152 F.3d 1342, 1359 (Fed. Cir. 1998) (quoting *Genentech*, 108 F.3d 1361 at 1365) (emphasis added); *accord Invitrogen Corp. v. Clontech Lab'ys, Inc.*, 429 F.3d 1052, 1070 (Fed. Cir. 2005) (quoting the same passage of *Genentech*).<sup>3</sup>

### III. SUBSTITUTE CLAIMS 33-61 ARE INVALID UNDER 35 U.S.C. § 103

Patent Owner raises four arguments that substitute claims 33–61 are not obvious over the prior art, each of which is addressed below.

First, there is no contradiction inherent in arguing that claims are both indefinite and obvious. The Federal Circuit has expressly recognized that “[t]he questions [of obviousness and indefiniteness] are different,” and that indefiniteness does not “imply that [a claim] is incapable of being compared to prior art to determine if one of its alternatives is anticipated or would have been obvious on the grounds asserted.” *Cochlear Bone Anchored Sols. AB v. Oticon Med. AB*, 958

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<sup>3</sup> Patent Owner also cites *EMI Grp. N. Am., Inc. v. Cypress Semiconductor Corp.*, 268 F.3d 1342 (Fed. Cir. 2001), which discusses “inoperable or impossible” claim limitations. *Id.* at 1348. While it may be true that “**the party alleging inoperability** must show that each disclosed embodiment in the patents was impossible or not enabled,” no question of inoperability has been raised in this case. *Id.* at 1349.

F.3d 1348, 1360 (Fed. Cir. 2020). Here, Petitioner has shown that the prior art discloses the same features that Patent Owner relies upon for written description support in the specification of the '223 Patent, as well as the features that Patent Owner has alleged to be absent from the prior art. *See* RMTA, 24–25.

Second, Patent Owner argues that Petitioner has failed to provide evidence of a motivation to combine the asserted references. RMTA Reply, 10–11. A motivation to combine prior art references “may be found in many different places and forms, and it need not be expressly stated in the references at all.” *Janssen Pharms., Inc. v. Teva Pharms. USA, Inc.*, 97 F.4th 915, 929 (Fed. Cir. 2024) (internal citations omitted). Motivation “may be found explicitly or implicitly in market forces; design incentives; the interrelated teachings of multiple patents; any need or problem known in the field of endeavor at the time of invention and addressed by the patent; and the background knowledge, creativity, and common sense of the person of ordinary skill.” *Id.* (quoting *Adapt Pharma Operations Ltd. v. Teva Pharms. USA, Inc.*, 25 F.4th 1354, 1365 (Fed. Cir. 2022) (cleaned up)). Here, Petitioner’s expert, Mr. Ricca, testified in detail regarding the factors that would have motivated a PHOSITA to combine the references with respect to each challenged claim. *See, e.g.*, EX1035, ¶¶ 47, 49, 62, 75, 80–82, 89.

Third, Patent Owner argues that Brandmeier is not analogous art. RMTA Reply, 11–12. Prior art is analogous if it satisfies either of the following tests: (1)

“the art is from the same field of endeavor, regardless of the problem addressed” or, (2) “if the reference is not within the field of the inventor's endeavor, [it] is reasonably pertinent to the particular problem with which the inventor is involved.” *Donner Tech., LLC v. Pro Stage Gear, LLC*, 979 F.3d 1353, 1359 (Fed. Cir. 2020). Brandmeier satisfies both tests for analogous art. Brandmeier—like the ’223 Patent—describes a sensor device comprising a housing that attaches to the outside surface of a vehicle. *See* EX1031, (57) Abstract, ¶ [0027], claims 11–12. Brandmeier is therefore directed to the same field of endeavor as the ’673 Patent and is analogous art under test (1). With respect to test (2), the rigid housing disclosed by Brandmeier is reasonably pertinent to the sensor devices and systems disclosed in the ’223 Patent. Mr. Ricca testified that “Brandmeier provides evidence of what a PHOSITA would have understood, which is that rigid sensor device housings and their benefits were known in the art,” EX1035, ¶ 40, and that “a PHOSITA would have understood the obvious fact that rigid housings are useful to protect electronics within the housing from physical impacts, which are commonplace events on the outside of a railcar.” *Id.*, ¶ 50.

Finally, Patent Owner argues that Brandmeier fails to disclose “a nonflexible housing that is resistant to environmental damage” as required by claim 34. RMTA Reply, 12. Brandmeier’s housing comprises a housing jacket made from a rigid material, preferably a metal, and a housing cover made from plastic. EX1031,

¶ [0027]; *see also id.*, claim 11. It is not clear which aspect of the claim limitation is allegedly missing from Brandmeier.

In any event, as noted above, Petitioner’s expert testified that a PHOSITA would have been aware of many other housings, similar to the one disclosed by Brandmeier, and that the advantages of using such a housing to protect a sensor device mounted on the outside of a railcar would have been obvious. EX1035, ¶¶ 40, 50–51. In other words, the benefits of using a non-flexible, durable housing would have been both obvious and predictable. *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 416 (2007) (“[W]hen a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.”).

#### **IV. CONCLUSION**

Petitioner respectfully requests that the Board deny the Revised Motion to Amend.

Case No. IPR2023-00538

Patent No. 9,365,223

Respectfully submitted,

Dated: May 31, 2024

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 31<sup>st</sup> day of May, 2024, the foregoing was served via electronic mail to the attorneys of record for the '223 Patent at the following address:

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