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

PATENT OWNER'S UPDATED MANDATORY NOTICES PURSUANT TO 37 C.F.R. §42.8(b)

Amsted Rail Company, Inc. ("Patent Owner") provides the following mandatory notices pursuant to 37 C.F.R. §42.8:

I. Real Party-in-Interest under 37 C.F.R. § 42.8(b)(1)

Amsted Rail Company, Inc., a Delaware corporation having its principal place of business in Chicago, IL, is the Patent Owner and a real party-in-interest in this proceeding. Amsted Digital Solutions, Inc. and IONX LLC are also real parties-in-interest but are not parties to these proceedings or to the district court proceedings.

II. Related Matters under 37 C.F.R. § 42.8(b)(2)

A. U.S. District Court for the Eastern District of Missouri

Patent Owner has asserted U.S. Patent No. 9,365,223 (the "'223 Patent") (see Ex. 1001) in *Amsted Rail Company, Inc. v. Hum Industrial Technology, Inc. et al*, No. 4:22-cv-00445-AGF (E.D. Mo.) (the "Litigation").

B. The U.S. Patent and Trademark Office

The cover page of the '223 Patent states that the application from which the '223 Patent issued, U.S. Patent Application No. 13/842,427 (the "'427 Appl."), was filed on May 15, 2013 and was a continuation of U.S. Patent Application No. 12/861,713 (the "'713 Appl."), filed on August 23, 2010, now U.S. Patent No. 9,026,281. The '427 Appl. also claim the benefit of U.S. Provisional Patent Application No. 61/661,661, filed on June 19, 2012.

Petitioner has also filed the following Petitions for Inter Partes Review of two other patents owned by Patent Owner and asserted in the Litigation:

- *Hum Industrial Tech., Inc. v. Amsted Rail Co., Inc.*, IPR2023-00539, challenging claims of U.S. Patent No. 9,981,673; and
- *Hum Industrial Tech., Inc. v. Amsted Rail Co., Inc.*, IPR2023-00540, challenging claims of U.S. Patent No. 10,137,915.

III. Lead and Back-up Counsel under 37 C.F.R. § 42.8(b)(3)

A. Lead Counsel

Patent Owner identifies and designates the following as lead counsel:

Lead Counsel:

Jeff E. Schwartz
Reg. No. 39,019
Fox Rothschild LLP
2020 K Street N.W., Suite 500
Washington, DC 20006
Tel: 202.696.1470
Fax: 202.461.3102
Email: jeschwartz@foxrothschild.com

A Power of Attorney for lead counsel is submitted with this Mandatory Notice.

B. Back-up Counsel

Patent Owner identifies and designates the following as back-up counsel:

<u>Back-up Counsel</u>:

Gary A. Hecht
Reg. No. 36,826
Fox Rothschild LLP
2000 Market Street, 20th Floor
Philadelphia, PA 19103-3222
Tel: 215.299.2416
Fax: 215.299.2150
Email: ghecht@foxrothschild.com

Ryan North Miller
Reg. No. 68,262
Fox Rothschild LLP
2000 Market Street, 20th Floor
Philadelphia, PA 19103-3222
Tel: 215.299.2901
Fax: 215.299.2150
Email: rmiller@foxrothschild.com

Chetan Chandra
Reg. No. 77,571
Fox Rothschild LLP
2020 K Street N.W., Suite 500
Washington, DC 20006
Tel: 202.461.3106
Fax: 202.461.3102
Email: cchandra@foxrothschild.com

A Power of Attorney for back-up counsel is submitted with this Mandatory Notice.

IV. Service Information under 37 C.F.R. § 42.8(b)(4)

Patent Owner consents to service of all documents via electronic mail. Please address all correspondence to lead and back-up counsel as listed above.

Respectfully submitted,

By: /Jeff E. Schwartz/

Dated: October 9, 2024

Jeff E. Schwartz
Reg. No. 39,019
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 9th day of October, 2024, a copy of

PATENT OWNER'S UPDATED MANDATORY NOTICES

was served by electronic mail on Petitioner's counsel, lead and back-up, as follows:

Lead Counsel
Eric J. Rakestraw, Reg. No. 68,740
PTAB-ERakestraw@huschblackwell.com

Back-up Counsel
Daisy Manning, Reg. No. 66,369
PTAB-DManning@huschblackwell.com

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

By: / Ryan N. Miller /
Ryan N. Miller
Reg. No. 68,262
Counsel for Patent Owner
Amsted Rail Company, Inc.

Dated: October 9, 2024