

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 IPR2023-00539
Patent No. 9,981,673

**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 broader than Petitioner indicated in the conference call with the Board. *See* Ex. 1020 at 8. Petitioner has thus 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.

I. ADVANCED BIONICS PRONG 1 IS SATISFIED

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 Bionics* prong 1). Petitioner stated in the Petition that “**None** of the references relied upon in this petition ... were cited in a rejection during prosecution of the ’673 [sic] Application.” Petition at 7. Petitioner apparently believes that a reference must be cited in a rejection to justify denial under §325(d). Petitioner maintains this position

in Reply and it is contrary to Board precedent and practice. *See Boragen*, Paper 16 at 21-22.

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 legal requirement entirely in the Petition and in Reply, instead denigrating the Examiner and arguing that LeFebvre and Armitage are not cumulative to Baker and Searle. *See* Paper 7 at 2-5. What Petitioner does not do in its reply is respond to Patent Owner’s argument that each of the references applied against the independent claims by the Petition were, in fact, before the Office, were considered by the Examiner, and were allowed over the very art relied upon by the Petition. The Petitioner has not established error. *See* POPR at 13-24.

Petitioner’s arguments on cumulativeness are irrelevant attorney argument unsupported by any evidence or declaration testimony and should be given no weight. *See* Reply at 2-5. Petitioner places emphasis on the fact that Ground 1 of the

petition relies on Lefebvre alone and that “a single reference argument is not ‘substantially the same’ as a multiple-reference combination.” *See Id.* at 3 (citing *Samsung Elecs. Co., Ltd. v. Collect, LLC*, IPR2020-00477, Paper 14 at 15 (PTAB Aug. 5, 2020)). This is a red herring. The references asserted by the petitioner in *Samsung* “were never cited or considered during examination” of the challenged patent. *See Samsung*, Paper 14 at 12. Here, it is **undisputed** that Lefebvre was put before the Office and that the Office considered it for purposes of *Advanced Bionics* prong 1. *See Ex. 1002* at 143, 403 (citing LeFebvre), 146, 406 (citing Armitage), 445, 448 (confirming consideration because neither the LeFebvre nor Armitage reference cites are lined through). Patent Owner did more than merely notify the Office of the existence of LeFebvre, Patent Owner directly informed the Examiner that LeFebvre was a “document of particular relevance” according to the USPTO through its submission of the USPTO’s International Search Report dated April 2015. POPR at 16; *Ex. 1002* at 384-88.

Petitioner’s conclusory statements regarding cumulativeness of references relied on in the Petition are incorrect unsupported attorney argument that is inadequate to carry their burden of showing material error. As noted above Petitioner’s argument on the supposed lack of evidence of the Office’s consideration of LeFebvre and Armitage is not supported by Board’s designated precedential decisions. A reference still weighs in favor of denying institution under § 325(d) if

it was “considered” by the Examiner any time during prosecution, even in an IDS. *See, e.g., Advanced Bionics*, Paper 6 at 7-8 (stating that previously presented art includes art cited in an IDS). In addition, the Prosecution History further evidences the Examiner was aware of and specifically considered the Armitage and Lefebvre references because each was used by the Examiner as a basis to locate relevant prior art during prosecution. *See* POPR at 16; Ex. 1002 at 132, 134, 470, 481 (using both LeFebvre and Armitage as part of “search query”). Therefore, *Advanced Bionics* prong 1 is met. Petitioner must establish material error, which it has not and cannot.

II. PETITIONER DOES NOT EVEN ATTEMPT TO ESTABLISH MATERIAL ERROR

Petitioner never argues in the Reply that the Office committed material error much less provide any evidence of such error. Instead, Petitioner argues that LeFebvre and Armitage are not cumulative to Baker and Searle. Petitioner also spends an inordinate amount of time denigrating the efforts of the Examiner during prosecution. However, they do not once argue that the Examiners consideration of Patent Owner’s IDS submissions was in error. Not once. 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 2-5; *see also* POPR at 33-51, 56-60;

Ex. 2002 at ¶¶ 52-95, 112-119 (discussing various claim features not found in Lefebvre and Armitage).

Furthermore, the Petition does not present any evidence that warrants reconsideration of the same prior art. Petitioners' conclusory expert declaration is not enough; the declaration parrots arguments in the Petition and the expert fails to support his testimony with any objective evidence. See POPR at 27-31. Since it cannot establish material error, Petitioner has not met its burden. Discretionary denial under §325(d) is therefore entirely 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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