

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF MISSOURI**

AMSTED RAIL COMPANY, INC.,	)	
	)	
Plaintiff,	)	
	)	
v.	)	Case No. 4:22-cv-00445-AGF
	)	
HUM INDUSTRIAL TECHNOLOGY,	)	JURY TRIAL DEMANDED
INC., and BRENT WILSON,	)	
	)	
Defendants.	)	

STIPULATION REGARDING INVALIDITY CONTENTIONS

Defendants Hum Industrial Technology, Inc. (hereinafter “Hum”) and Dr. Brent Wilson (hereinafter “Dr. Wilson”) (collectively “Defendants”) submit this stipulation of invalidity contentions.

Hum is challenging certain claims of U.S. Patent No. 9,365,223 (the “’223 Patent”) in *Inter Partes Review* petition IPR2023-00538. The Petition asserts the following grounds of invalidity:

- (1) Claims 2–10, 18, 20, 21, 23, and 25–32 of the ’223 Patent are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Publication No. 2007/0152107 A1 to LeFebvre et al. (“LeFebvre”).
- (2) Claims 13–17, 22, and 24 of the ’223 Patent are unpatentable under 35 U.S.C. § 103(a) over LeFebvre in view of U.S. Patent Publication No. 2007/0208841 A1 to Barone et al. (“Barone”).
- (3) Claims 1 and 24 of the ’223 Patent are unpatentable under 35 U.S.C. § 103(a) over LeFebvre in view of U.S. Patent No. 5,633,628 to Denny et al. (“Denny”) and U.S.

Patent No. 4,282,754 to Provasnik (“Provasnik”).

(4) Claims 2, 3, 5, 7, 13–18, 20–22, 26–28, and 32 of the ’223 Patent are unpatentable under 35 U.S.C. § 103(a) over U.S. Patent Publication No. 2011/0282540 A1 to Armitage et al. (“Armitage”).

(5) Claims 4, 6, 8, 9, 10, 23, 25, and 29–31 of the ’223 Patent are unpatentable under 35 U.S.C. § 103(a) over Armitage in view of LeFebvre.

(6) Claims 1 and 24 of the ’223 Patent are unpatentable under 35 U.S.C. § 103(a) over Armitage in view of LeFebvre, Denny, and Provasnik.

Hum is challenging certain claims of U.S. Patent No. 9,981,673 (the “’673 Patent”) in *Inter Partes Review* petition IPR2023-00539. The Petition asserts the following grounds of invalidity:

(1) Claims 1–7, 10–18, and 20–22 of the ’673 Patent are unpatentable under 35 U.S.C. § 103(a) over LeFebvre.

(2) Claims 8 and 9 of the ’673 Patent are unpatentable under 35 U.S.C. § 103(a) over LeFebvre in view of Barone.

(3) Claims 1, 2, 4, 6–11, and 13 of the ’673 Patent are unpatentable under 35 U.S.C. § 103(a) over Armitage.

(4) Claims 3, 5, 12–18, and 20–22 of the ’673 Patent are unpatentable under 35 U.S.C. § 103(a) over Armitage in view of LeFebvre.

Hum is challenging certain claims of U.S. Patent No. 10,137,915 (the “’915 Patent”) in *Inter Partes Review* petition IPR2023-00540. The Petition asserts the following grounds of invalidity:

- (1) Claims 1, 22, 24-25, 27-30, 36, and 37 of the '915 Patent are unpatentable under 35 U.S.C. § 103(a) in view of Armitage and Barone.
- (2) Claim 21 of the '915 Patent is unpatentable under 35 U.S.C. § 103(a) in view of Armitage, Barone, and LeFebvre.
- (3) Claims 23 and 26 of the '915 Patent are unpatentable under 35 U.S.C. § 103(a) in view of Armitage, Barone, and U.S. Patent No. 7,706,213 to Winfree et al. ("Winfree").
- (4) Claims 1, 21-22, 25, 27-30, 36, and 37 of the '915 Patent are unpatentable under 35 U.S.C. § 103(a) in view of LeFebvre and Barone.
- (5) Claims 24 and 37 of the '915 Patent are unpatentable under 35 U.S.C. § 103(a) over LeFebvre in view of Barone and Armitage.
- (6) Claims 23 and 26 of the '915 Patent are unpatentable under 35 U.S.C. § 103(a) over LeFebvre in view of Barone and Winfree.

In each Petition identified above, Hum identified Defendant Brent Wilson as a real party in interest subject to 37 C.F.R. § 42.8(b)(1).

Defendants hereby stipulate that if the Patent Trial and Appeal Board institutes IPR on Petition No. IPR2023-00538, Petition No. IPR2023-00539, or Petition No. IPR2023-00540, then Defendants will not pursue in this case the specific grounds identified above in connection with the referenced patent(s) and claim(s) as originally issued on the instituted *inter parties* review petition, or on any other ground for a given patent for which the Board institutes, that was raised or could have been reasonably raised in an IPR.

This stipulation is not intended, and should not be construed, to limit Defendants' ability to assert invalidity of the asserted claims of the '223 Patent, '673 Patent, or '915 Patent in this case on any other ground, regardless of whether *inter parties* review is instituted. Likewise, this

stipulation is not intended, and should not be construed, to limit Defendants' ability to use the asserted prior art references for any purpose other than invalidity under §§ 102 or 103, regardless of whether *inter parties* review is instituted.

Dated: January 30, 2023

Respectfully Submitted

/s/ Eric J. Rakestraw

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