

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 IPR2023-00540
US Patent No. 10,137,915

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

**PETITIONER'S REPLY TO PATENT OWNER'S
PRELIMINARY RESPONSE**

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35 U.S.C. § 102 3

35 U.S.C. § 325(d) 1, 2, 4

I. The Board Frequently Declines To Exercise Its Discretion To Deny Institution Under § 325(d) When A Reference Is Only Cited In An IDS

Petitioner does not dispute that “[p]reviously presented art includes ... art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS).” *Advanced Bionics LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 7-8 (PTAB Feb 13, 2020). Petitioner, however, disputes this warrants denial of institution under § 325(d) when, as is the case here with respect to Armitage, there is no evidence in the prosecution history of the extent to which the examiner considered the reference, that the examiner applied the reference against the claims, or that the examiner considered the particular disclosures of the reference presented in a petition. *See, e.g., Vizio, Inc. v. Nichia Corp.*, IPR2017-00551, Paper 9 at 7–8 (PTAB July 7, 2017).

“The Board frequently holds that a reference that ‘was neither applied against the claims nor discussed by the Examiner’ does not weigh in favor of exercising the Board's discretion under § 325(d) to deny a petition.” *Amazon.com, Inc. v. M2M Sols. LLC*, IPR2019-01204, Paper 14 at 16 (PTAB. Jan. 23, 2020); *see also Apotex Inc. v. UCB Biopharma, SPRL*, IPR2019-00400, Paper 17 at 25 (PTAB July 15, 2019). “When a reference was not the basis of rejection, the Board has found that this weighs ‘strongly against exercising our discretion to deny institution.’” *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ., Ltd.*, IPR2022-01283, Paper 12 at 13-14 (PTAB

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Feb. 22, 2023) (quoting *CODE200, UAB et al. v. Bright Data Ltd.*, IPR2022-00353, Paper 8 at 10 (PTAB July 1, 2022)); *see also Navistar, Inc. v. Fatigue Fracture Tech, LLC*, IPR2018-00853, Paper 13 at 16-17 (PTAB Sept. 12, 2018) (same).

None of the cases cited by Patent Owner stand for the proposition that the Board will exercise its discretion under § 325(d) merely because a reference was cited in an IDS. Rather, the Board considered the prior art and arguments under the *Advanced Bionics* framework and the *Becton Dickinson* factors. *See, e.g., Palo Alto Networks, Inc. v. Centripetal Networks, Inc.*, IPR2021-01156, Paper 10 at 10-16 (PTAB Jan. 24, 2022) (reference considered in IPRs of grandparent and great grandparent and no material error by Examiner); *Microsoft Corp. v. Koninklijke Philips N.V.*, IPR2018-00279, Paper 11 at 14-15 (PTAB June 8, 2018) (reference used in rejection of related patent claims and challenged patent subject to terminal disclaimer over related patent); *Fellowes, Inc. v. Treefrog Devs., Inc.*, IPR2020-01509, Paper 11 at 17 (PTAB Feb. 22, 2021) (finding “significant weaknesses, in many, if not all, of the proposed grounds”); *BMW of N. Am., LLC v. Stragent, LLC*, IPR2021-00419, Paper 14 at 15 (PTAB July 19, 2021) (“the evidence indicates a greater degree of consideration and evaluation here than the scenario where a reference is merely listed on an IDS.”).

II. THE PETITION PRESENTS NEW PRIOR ART AND ARGUMENTS NOT PREVIOUSLY CONSIDERED BY THE EXAMINER

The '915 Patent was allowed after the independent claims were amended to

include “one or more filters configured to filter at least a portion of the accelerations.” Paper 1 at 10. The Examiner, however, never applied any prior art teaching this “filtering” limitation to the claims. Instead, in a first Office Action, the Examiner rejected all independent claims under § 102 in view of LeFebvre but stated claims 51-53 and 55—each of which claimed various, specific filtering limitations—would be allowable if rewritten in independent form. EX1002 at 183-184, 517. In response, the applicant did *not* redraft claims 51-53 and 55 in independent form, but rather added the far broader “filtering” limitation to the independent claims that, unlike claims 51-53 and 55, does not require any specific type of filter. *Id.* at 527, 531, 537, 541-542. In allowing the amended claims, the Examiner never addressed (1) the broader “filtering” limitation; (2) why the prior art of record failed to teach the broader “filtering” limitation; or (3) why it would not have been obvious to modify LeFebvre to include the well-known concept of filtering data to remove unwanted data and/or amplify relevant data. *Id.* at 550-551.

A. Armitage Grounds 1-3

Armitage was cited in an IDS but it was never materially considered by the Examiner or applied against the claims. Paper 1 at 16. Nor was Armitage considered in combination with Barone or any other reference teaching the “filtering” limitation. *Id.* at 10, 16-17. Thus, Grounds 1-3 of the Petition present a challenge to the claims that is not based on substantially the same art or arguments previously presented to

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the Examiner.¹ *See Cisco Systems*, IPR2022-01283, Paper 12 at 13 (declining to exercise discretion under § 325(d) and not proceeding to second prong of *Advanced Bionics* because although the Petition relied one reference used in a rejection and a second listed in an IDS, the combination also applied a third reference not before the Examiner); *see also PEAG LLC v. Varta Microbattery GmbH*, IPR2020-01214, Paper 8 at 9-10 (PTAB Jan. 6, 2021) (reference listed on IDS not considered in combination asserted in Petition and no evidence Examiner substantively considered the same). This weighs strongly against discretionary denial under *Becton* factor (c).

The Examiner also materially erred by overlooking Armitage's specific teachings of the "filtering" limitations. *See* Paper 1 at 23-25. "According to *Advanced Bionics*, 'material error may include misapprehending or overlooking specific teachings of the relevant prior art where those teachings impact patentability of the challenged claims.'" *DISH Network LLC v. Sound View Innovations, LLC*, IPR2020-01041, Paper 13 at 18 (PTAB Jan. 19, 2021); *Caterpillar Inc. v. Wirtgen America, Inc.*, IPR2022-01277, Paper 9 at 33-39 (PTAB Jan 31, 2023) (material error for examiner to not apply reference cited in IDS that provided missing

¹ Patent Owner argues other IDS prior art teaches the "filtering" limitation (Paper 6 at 7, 10), but there is no evidence this art was applied to the claims, that it teaches the filtering limitation, or is substantially similar to art presented in the Petition.

limitation). The Petition also relies on the expert testimony of Steven Ricca—which was not before the Examiner—to explain why a PHOSITA would understand Armitage teaches the “filtering” limitation and would have alternatively been motivated to modify Armitage to include Barone’s data filtering. *Becton* factors (e) and (f) therefore also weigh against denial.

B. LeFebvre Grounds 4-6

Contrary to Patent Owner’s arguments, the file history does not indicate the Examiner applied LeFebvre to the amended independent claims including the broader “filtering” limitation. Instead, the file history indicates the Examiner only applied LeFebvre to the specific types of filters in claims 51-53 and 55. Accordingly, not only did the Examiner fail to consider LeFebvre in combination with any other prior art as presented in the Petition, he also materially erred by overlooking LeFebvre’s teaching of the broader “filtering” limitation. *DISH Network*, IPR2020-01041, Paper 13 at 18. And, like the Armitage grounds, the Petition relies on the expert testimony of Steven Ricca to explain why a PHOSITA would understand LeFebvre does, in fact, teach the broad “filtering” limitation and would have alternatively been motivated to modify LeFebvre to include the data filtering of Barone. *Becton* factors (e) and (f) therefore also weigh against discretionary denial.

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CERTIFICATE OF SERVICE

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