

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
Patent No. 10,137,915

**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 larger than Petitioner indicated in the conference call with the Board. *See* Ex. 1020 at 8. Petitioner has 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 acknowledges that LeFebvre was cited and considered during examination but asserts that Armitage was not presented to the Office because it was “cited in an IDS but not considered at any length.” *See* Petition at 17. This is false and ignores binding Board precedent.

Contrary to Petitioner's bald arguments, Armitage was expressly cited ***by the***

Examiner in a Notice of References Cited that accompanied the Non-Final Office Action. *See* Ex. 1002 at 519 (citing Armitage). Citation on this Notice by the Examiner is strong evidence that the Examiner analyzed Armitage and identified it as “relevant and material.” *Alarm.com Inc. v. Vivint, Inc.*, IPR2022-00728, Paper 6 at 20 (PTAB Nov. 1, 2022). Petitioner does not in any way explain why that is not sufficient to satisfy *Advanced Bionics* prong 1 (it is) nor does Petitioner even attempt to establish that the Office materially erred in allowing the claims over this citation of Armitage **by the Examiner** (it cannot).

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 instead denigrates the Examiner’s examination of LeFebvre and argues that Armitage was not presented to the Office simply because it was not cited in a rejection. *See* Paper 7 at 3-5. Petitioner is wrong on both counts. A prosecution history still weighs in favor of denying institution under § 325(d) if the same

reference 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). Therefore, *Advanced Bionics* prong 1 is met. Petitioner must establish material error.

II. PETITIONER DOES NOT ESTABLISH MATERIAL ERROR

Petitioner apparently argues that the Examiner erred in allowing the claims after Patent Owner inserted subject matter deemed allowable into the independent claims. *See* Reply at 3. Specifically, Petitioner argues that the Examiner did not conduct “additional prior art searches” following Patent Owner’s amendment. *See* Petition at 10, 18; Reply at 3 (stating the Examiner “never applied any prior art teaching to this ‘filtering’ limitation...”). This is at best misleading and irrelevant if not entirely false. Petitioner fails to mention that the Examiner reviewed its previous search, which included searches on filtering limitations **twice** following Patent Owner’s amendment: once before issuing the May 10, 2018 Notice of Allowance and again before issuing the September 6, 2018 Notice of Allowance. *See* Ex. 1002 at 556-58; 640-43. The second of these Notices followed a Request for Continued Examination filed by the Patent Owner to allow the Examiner to consider new references submitted in an IDS and allowing the claims. *Id.* at 562-569.

Petitioner also argues that the Office “materially erred by overlooking Armitage’s specific teachings of the “filtering” limitations. However, Petitioner still

points to no evidence of record that the asserted art is not cumulative of the references already presented to and considered by the Office. Petitioner relies only on the fact that Barone was not before the Office. *See* Reply at 3-4. In contrast, Patent Owner provided numerous specific citations to references of record that shared the teachings of Armitage and Barone. POPR at 9-11. All Petitioner does is provide conclusory attorney argument that “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.” Reply at 4 n.1. Furthermore, Patent Owner provides no declaration evidence explaining how a POSA would understand the references presented to the Office. Establishing material error is Petitioner’s burden. Unsupported attorney argument is not sufficient to meet that burden. All Petitioner points to are contested factual assertions made in its Petition grounds, which in any case do not establish a reasonable likelihood of success on the merits. *See* POPR at 27-44.

Petitioners’ expert declaration is not enough; the declaration parrots arguments in the Petition and the expert fails to support his testimony with objective evidence. *See* POPR at 14-19. The entirety of Petitioner’s discussion of §325(d) in the Petition and Reply is mere attorney argument and is entitled to little weight. *Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01529, Paper 16 at 20 (PTAB Mar. 21, 2023). This is insufficient to meet its burden to show material error. Since it cannot

and has not established 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.”).

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 14-19. 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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