

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 OPPOSITION TO PATENT OWNER'S
MOTION TO EXCLUDE**

TABLE OF CONTENTS

	Page
I. ARGUMENT.....	1
A. Patent Owner’s Motion to Exclude is Improper.	1
B. Exhibits 1026 and 1027 and the Arguments Relating Thereto are Timely and Relevant.	2
C. Exhibit 1025 Properly Relies on Exhibits 1026 and 1027.....	6
II. CONCLUSION.....	7

TABLE OF AUTHORITIES

	Page
Cases	
<i>Advanced Display Sys., Inc. v. Kent State Univ.</i> , 212 F.3d 1272 (Fed. Cir. 2000)	5, 6
<i>Belden Inc. v. Berk-Tek LLC</i> , 805 F.3d 1064 (Fed. Cir. 2015)	6
<i>Callaway Golf Co. v. Acushnet Co.</i> , 576 F.3d 1331 (Fed. Cir. 2009)	5
<i>Dexcom, Inc. v. AgaMatrix, Inc.</i> , IPR2016-01679, Paper 53 (PTAB Feb. 28, 2018).	5
<i>Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.</i> , 821 F.3d 1359 (Fed. Cir. 2016)	2, 3
<i>Laboratoire Francais du Fractionnement et des Biotechnologies S.A. v. Novo Nordisk Healthcare AG.</i> , IPR2017-00028, Paper 109 (PTAB Apr. 13, 2022)	2, 3
<i>Rembrandt Diagnostics, LP v. Alere, Inc.</i> , 76 F.4th 1376 (Fed. Cir. 2023)	2, 3
<i>Wildcat Licensing WI LLC v. Atlas Copco Tools & Assembly Sys. LLC</i> , No. 2022-1304, 2024 WL 89395 (Fed. Cir. Jan. 9, 2024)	3
Other Authorities	
Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019).....	1, 4

EXHIBIT LIST

Ex #	Exhibit Description
1025	Expert Declaration of Steven Ricca in Support of Petitioner's Reply
1026	MSP430F1611 Manual (Texas Instruments)
1027	MSP430FG4618 Manual (Texas Instruments)

Petitioner submits this paper in opposition to Patent Owner's Motion to Exclude (Paper 32). For the reasons explained below, Exhibits 1025, 1026, and 1027 are proper and should not be excluded.

I. ARGUMENT

A. Patent Owner's Motion to Exclude is Improper.

As a threshold issue, a motion to exclude is not the proper vehicle for Patent Owner's arguments. A motion to exclude should not "address arguments or evidence that a party believes exceeds the proper scope of reply..." Patent Trial and Appeal Board Consolidated Trial Practice Guide at 79 (Nov. 2019). Here, one of the two bases for Patent Owner's Motion to Exclude is that Exhibits 1026 and 1027 were untimely and raised new issues in Petitioner's Reply to Patent Owner's Response. The Board's Trial Practice Guide outlines two options in this scenario—a motion to strike or a request for further briefing "to address the merits of any newly-raised arguments or evidence." *Id.* at 80 (Nov. 2019). Patent Owner did not utilize either of these options and now improperly moves to exclude the exhibits.

Patent Owner's second basis to exclude Exhibits 1026 and 1027 relates to the *weight* to be given to this evidence. This is not a proper basis to exclude evidence. *Id.* at 79. Here, Patent Owner's arguments that Petitioner mischaracterizes evidence and that certain evidence conflicts with previous expert declarations (both disputed by Petitioner) go to the weight of the evidence and are thus not proper subjects for a

motion to exclude. The Board should deny Patent Owner's Motion to Exclude for these reasons alone.

B. Exhibits 1026 and 1027 and the Arguments Relating Thereto are Timely and Relevant.

If the Board considers Patent Owner's Motion to Exclude, Exhibits 1026 and 1027 directly rebut Patent Owner's Response and involve the same prior art references and the same legal argument set forth in the Petition. In the Petition, Ground 1 states certain claims are unpatentable as obvious under 103(a) in view of Armitage and Barone. Petitioner argued in detail that Barone teaches digital (software) filtering and that a PHOSITA would be motivated to include the filter taught by Barone with Armitage because filtering has certain advantages. Paper 1 at 25-29, 37-38. Patent Owner argued in its Response that there is "no disclosure in Barone that corresponds to a digital filter or a software filter." Paper 15 at 17. Petitioner's Reply directly rebuts Patent Owner's arguments by producing additional evidence that two microcontrollers specifically disclosed in Barone, in paragraphs and figures discussed in the Petition, include a digital filter controlled by software. Not only are Exhibits 1026 and 1027 presented in direct rebuttal to Patent Owner's Response, but they simply support Petitioner's argument regarding the disclosure of the same prior art asserted in the Petition.

The Federal Circuit has held a reply is proper "if it is responsive and simply expands on previously raised arguments." *Rembrandt Diagnostics, LP v. Alere*,

Inc., 76 F.4th 1376, 1384 (Fed. Cir. 2023). Responsive rebuttal evidence is offered

“to explain, repel, counteract, or disprove the evidence of the adverse party.” *Id.*

And, “the very nature of the reply and sur-reply briefs are to respond (whether to

refute, rebut, explain, discredit, and so on) to prior raised arguments.” *Id.* In

Rembrandt Diagnostics, the Federal Circuit held the use of previously unidentified

disclosures from the prior art was a legitimate reply to the Patent Owner’s

arguments and the Board’s observations because the “reply argument involves the

same legal ground based on the same prior art references and the same legal

argument—the motivation to remove Tydings’s wicking material and reverse its

orientation.” *Id.* at 1385. Similarly, in *Wildcat Licensing*, the Federal Circuit held

“reply briefs did not introduce evidence involving a new theory, but merely

confirmed Atlas’ assertions in its petitions concerning the functionality of a hall

effect sensor.” *Wildcat Licensing WI LLC v. Atlas Copco Tools & Assembly Sys.*

LLC, No. 2022-1304, 2024 WL 89395, at *3 (Fed. Cir. Jan. 9, 2024) (further

holding “Atlas’ citation to new prior art references was made in response to

Wildcat’s arguments on that point, to show ‘the knowledge that a skilled artisan

would bring to bear’ in reading the same aspects of the same references that were

the focus of the petition.”) (citation omitted). These recent examples from the

Federal Circuit are similar to the instant case where the disclosures of Barone were

explained in more detail in the Reply as a direct rebuttal to Patent Owner’s

assertion that Barone did not disclose digital or software filtering.

Patent Owner makes several erroneous arguments regarding relevance of Exhibits 1026 and 1027 while improperly making arguments on the merits of the case. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 79 (Nov. 2019) (“A motion to exclude is not a vehicle for addressing the weight to be given evidence—arguments regarding weight should appear only in the merits documents”). *Rembrandt Diagnostics* and *Wildcat Licensing* are clear that responsive arguments are allowed in reply and are thus relevant. As discussed in Petitioner’s Reply to Patent Owner’s Response, Exhibits 1026 and 1027 support the fact that Barone’s filtering is not limited to analog/electronic signals. This evidence directly refutes Patent Owner’s Response and further explains the legal arguments contained in the Petition to rebut Patent Owner’s mischaracterization of Barone’s disclosure.

Finally, cases cited by Patent Owner to support its position that Exhibits 1026 and 1027 should be excluded are inapposite. In *Laboratoire Francais du Fractionnement et des Biotechnologies S.A. v. Novo Nordisk Healthcare AG*, the Petition had a bare bones analysis of anticipation that strongly contrasts with the greater level of detail in the Petition in this case. IPR2017-00028, Paper 109, at 17 (PTAB Apr. 13, 2022) (“With regard to the Tolo anticipation challenge, Petitioner stated only the following in the Petition: Regarding claim 1, Example 1 of Tolo

Case No. IPR2023-00540

US Patent No. 10,137,915

relates to human IFN- α instead of rFVIIa. Nevertheless, Tolo anticipates claim 1 because Tolo discloses all limitations in a manner that a POSITA would immediately recognize and acknowledge as an anticipatory embodiment.”). In *Dexcom, Inc. v. AgaMatrix, Inc.*, the Petitioner introduced additional prior art references in its reply. IPR2016-01679, Paper 53, at 49-51 (PTAB Feb. 28, 2018). Here, Exhibits 1026 and 1027 are not additional prior art references, they serve to rebut Patent Owner’s arguments regarding the disclosure in Barone, which was included in the Petition. In *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, the reply included an entirely new argument for motivation to combine. 821 F.3d 1359, 1369-70 (Fed. Cir. 2016). Here, Petitioner’s motivation to combine argument is the same in the Petition and Reply as explained above.

Patent Owner further relies on two cases to support its argument that the microcontrollers described in Exhibits 1026 and 1027 are not “incorporated by reference in Barone”. See *Callaway Golf Co. v. Acushnet Co.*, 576 F.3d 1331, 1346 (Fed. Cir. 2009); *Advanced Display Sys., Inc. v. Kent State Univ.*, 212 F.3d 1272, 1282 (Fed. Cir. 2000). But in these cases anticipation, not obviousness, was at issue. Thus, these cases do not apply to the instant scenario because the issue here is not whether the disclosure is within the four corners of a single reference, but whether a PHOSITA would understand that Barone teaches digital and software filters based, in part, on its utilization of the microcontrollers utilized in Barone’s

C. Exhibit 1025 Properly Relies on Exhibits 1026 and 1027.

As shown above, Exhibits 1026 and 1027 are timely and relevant. Thus, Exhibit 1025 properly relies on them and should not be excluded. The Board's Trial Practice Guide allows for rebuttal evidence in support of a party's reply, including new expert declarations. *See* Patent Trial and Appeal Board Consolidated Trial Practice Guide at 73 (Nov. 2019).

Patent Owner's additional arguments that it would be prejudiced, have its due process rights violated, and that the APA would be violated ignore the readily available options for responding to new reply declarations. The Board's Trial Practice Guide goes on to say, "[i]f a party submits a new expert declaration with its reply, the opposing party may cross-examine the expert, move to exclude the declaration, and comment on the declaration and cross-examination in any sur-reply." *Id.* (citing *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1081-82 (Fed. Cir. 2015)). Patent Owner had multiple avenues to respond to the expert declaration in Exhibit 1025, which shows it was not prejudiced and its due process rights would not be violated by denial of the Patent Owner's Motion to Exclude. In fact, Patent Owner never deposed Petitioner's expert once in these proceedings. Further, Exhibit 1025 does not violate the APA because the rebuttal evidence in Petitioner's

Case No. IPR2023-00540

US Patent No. 10,137,915

Reply is proper, and Patent Owner had meaningful opportunities to respond.

II. CONCLUSION

For the reasons stated herein, Petitioner respectfully requests that Exhibits 1025, 1026, and 1027 not be excluded.

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

Dated: May 24, 2024

Respectfully submitted,

By: /Daisy Manning/
Eric J. Rakestraw, Reg. No. 68,740
Daisy Manning, Reg. No. 66,369
HUSCH BLACKWELL LLP
8001 Forsyth Boulevard, Suite 1500
St. Louis, MO 63105
(314) 480-1500 Telephone
(314) 480-1505 Facsimile
PTAB-ERakestraw@huschblackwell.com
PTAB-DManning@huschblackwell.com

Attorneys for Petitioner

CERTIFICATE OF SERVICE

I hereby certify that on this 24th day of May, 2024, the foregoing was served via electronic mail to the attorneys of record for the '915 Patent at the following address:

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	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
P. Marshall Ticer Reg. No. 74,653 Fox Rothschild LLP 2020 K Street N.W., Suite 500 Washington, DC 20006 Tel: 202.794.1237 Fax: 202.461.3102 Email: mticer@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

By: /Daisy Manning/
Daisy Manning, Reg. No. 66,369
Counsel for Petitioner