

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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HUM INDUSTRIAL TECHNOLOGY, INC.

*Petitioner*

v.

AMSTED RAIL COMPANY, INC.

*Patent Owner*

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Case IPR2023-00540

Patent No. 10,137,915

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**PATENT OWNER'S REPLY IN SUPPORT OF ITS  
MOTION TO EXCLUDE**

Patent Owner submits this reply paper in response to Petitioner's Opposition to Patent Owner's Motion to Exclude (Paper 36).

**I. PETITIONER'S BELATED SUBMISSION OF EX1026 AND EX1027 CONSTITUTES NEW EVIDENCE**

Petitioner incorrectly characterizes the bases for Patent Owner's Motion to Exclude EX1026 and EX1027 as merely "exceeding the scope of reply" and "going to the weight of the evidence" in its attempt to minimize the prejudicial effect that the allowance of these exhibits would create. Paper 36, p. 1. These exhibits are in fact new evidence and introduce new argument in reply, that could have been presented earlier, and they are used by Petitioner to make out a *prima facie* case of unpatentability. They are not "exceeding the scope of reply" – they are *outside* of the allowable scope of reply because the proper scope was in the Petition.

Petitioner made an assertion in its Petition -- that Barone itself discloses a digital or software filter and could be relied on as evidence for its obviousness assertions -- that it later realized was incorrect and in fact absent from the cited disclosures of Barone. It is noteworthy that Petitioner chose to rely *solely* on the language of Barone for this assertion in its Petition – not EX1026 and EX1027. Petition at 25-29, 37-38. Indeed, the Petition spends significant time quoting specific language from the specification of Barone, and even goes so far as to claim that "Barone *explicitly discloses* filtering data." Paper 1 at 27-29. Moreover,

Barone does not incorporate EX1026 and EX1027 by reference (not likely an unintentional omission given that Barone did in fact explicitly incorporate other references and products in its bibliography) nor does it even discuss the data sheets comprising these exhibits. The assertions made in the Petition, therefore, rely *only* on the language in Barone – *not* on cited references within Barone. Upon realization that Barone itself did not support its *prima facie* claim of unpatentability, Petitioner produced new and different evidence to support its initial assertion. In other words, Petitioner reattempted to demonstrate its claim through the use of different evidence only after realizing that it failed the first time. Petitioner’s shifting argumentation is not permitted. This was new evidence that should have been introduced in the Petition.

EX1026 and EX1027 also do not “directly rebut Patent Owner’s arguments [that there is no disclosure in Barone that corresponds to a digital filter or a software filter] by producing additional evidence”, because there was no original evidence to support its *prima facie* claim of unpatentability based on Barone to be *added to*. Paper 36 at p.2. Petitioner’s reliance on the Federal Circuit caselaw outlined in pages 2-3 of its Opposition to Motion to Exclude is misguided. The late introduction of and reliance on EX1026 and EX1027 are not “simply expanding on previously raised arguments” (*Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1384 (Fed. Cir. 2023)) or “explaining, repelling, counteracting, or disproving the evidence of the

adverse party” (*Id.*), nor are they “based on the same prior art references and the same legal argument” (*Wildcat Licensing WI LLC v. Atlas Copco Tools & Assembly Sys. LLC*, No. 2022-1304, 2024 WL 89395, at \*3 (Fed. Cir. Jan. 9, 2024)) – they are completely different prior art references from any reference asserted in the Petition, and they are being used because of a failed legal argument in the Petition (that Barone discloses particular facts that can be relied upon as evidence of obviousness), thus creating a new argument (that those facts are disclosed elsewhere, in a different reference/exhibit). Paper 36 at p. 2-3.

**II. PETITIONER FAILS TO DEMONSTRATE THAT EX1026 AND EX1027, AND THE ARGUMENTS RELATING THERETO, ARE RELEVANT**

Petitioner also fails to address the critical fact that the circuits in EX1026 and EX1027 do not operate in any way on digital data, and accordingly are not appropriate exhibits to be considered as evidence of whether Barone discloses digital filtering or what a POSITA might understand about digital filtering. Petitioner’s entire argument that the exhibits, and the arguments relating thereto, are relevant revolves around its discussion of Ground 1 stating that certain claims are unpatentable as obvious under 103(a) in view of *Armitage and Barone*. But this proves the point – Ground 1 did not assert the claims as obvious in view of any prior art **to be combined with EX1026 and EX1027**, nor did it allude to any assertion that these exhibits provide the foundation for the requisite knowledge of a POSITA. This

is because they *do not operate on digital data*, and are therefore irrelevant. Accordingly, Patent Owner is not “improperly making arguments on the merits of the case” or merely “addressing weight to be given this evidence” by pointing out that the exhibits are both new and irrelevant, and not probative of obviousness – in essence there is no question of weight because the exhibits were not in the petition and therefore deserve *no* weight.

### **III. EX1025 RELIES ON IMPROPER EVIDENCE AND SHOULD ALSO BE EXCLUDED**

As Patent Owner mentioned in its Motion, “nearly the entirety of Ricca’s reply arguments for Claims 25 and 28 relate to EX1026, EX1027 and the Texas Instrument microcontrollers. (EX1025, ¶¶20-27). These arguments were not in Ricca’s Declaration in Support of Petition for *Inter Parties Review*. (EX1003)”. Petitioner does not appear to dispute this, and instead argues that since the Board’s Trial Practice Guide allows for rebuttal evidence in support of a party’s reply and new expert declarations, the Board should also allow this evidence – but this disregards the fact that, as explained above, these exhibits do not constitute “rebuttal evidence”. Petitioner redundantly also asserts that allowing the exhibits does not violate the APA because the rebuttal evidence in Petitioner’s reply is proper. But the fundamental problem is that Exhibits 1026 and 1027 constitute new evidence that should have been filed with the Petition. Allowing new evidence, as well as

evidence and arguments for which it provides support, based on irrelevant and untimely filed exhibits is not proper, goes against reason and would both prejudice Patent Owner and infringe on its due process rights.

To the extent the Board credits Petitioner's arguments on the propriety of the this Motion, the Board may also treat this Motion to Exclude as a Motion to Strike. *See Laboratoire Francais Du Fractionnement Et Des Biotechnologies S.A., v. Novo Nordisk Healthcare Ag*, IPR2017-00028, Paper 109, at 11-12 (PTAB April 13, 2022) (treating a similar motion as a Motion to Strike). In this situation, Patent Owner requests that the Board consider that Petitioner waited nearly a year to file this improper evidence, and that Petitioner had an opportunity to respond to these arguments and therefore will not be prejudiced. *See Id.* Patent Owner, on the other hand, will be unfairly and prejudicially deprived of its fundamental opportunity to submit an affirmative defense.

#### **IV. CONCLUSION**

For the reasons described above PO respectfully requests that the Board exclude: (1) EX1026; (2) EX1027; (3) EX1025, ¶¶20-27, 33-34 relating to EX1026, EX1027 and the Texas Instrument microcontrollers; and (4) Petitioner's arguments in its Reply relating to EX1026, EX1027, the Texas Instrument microcontrollers, and its expert's discussion thereof, Paper 18, 15-20.

Respectfully submitted,

Dated: May 31, 2024

By: /Ryan N. Miller/  
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## **CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. §42.6(e), I certify that on this 31st day of May, 2024, a copy of PATENT OWNER'S REPLY TO PETITIONER'S OPPOSITION TO MOTION TO EXCLUDE by electronic mail on Petitioner's counsel, lead and back-up, as follows:

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Counsel for Petitioner has consented to service of all documents via electronic email. *See* Petition, Paper 1 at 2.

Dated: May 31, 2024

By: / Ryan N. Miller /

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