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Paper 13
Entered: July 11, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SIEMENS MOBILITY, INC.,
GROUND TRANSPORTATION SYSTEMS USA INC.,
HUMATICS CORP., and PIPER NETWORKS, INC.,
Petitioner,

v.

METROM RAIL, LLC,
Patent Owner.

IPR2023-00468
Patent 9,043,131 B2

Before JAMES P. CALVE, HYUN J. JUNG, and NEIL T. POWELL, *Administrative Patent Judges.*

CALVE, *Administrative Patent Judge*.

ORDER
Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51

On July 10, 2023, Patent Owner sent an email to the Board requesting a conference call to obtain authorization to file a motion seeking additional discovery of secondary considerations. Patent Owner indicated that the parties had conferred regarding the request and that Petitioner opposed the motion. We granted Patent Owner's request for a conference.

On July 10, 2023, we held a conference call to discuss Patent Owner's request for authorization to file a motion seeking additional discovery of secondary considerations. At the conference, we explained that Patent Owner as the moving party must show that additional discovery is necessary in the interests of justices. *See* 37 C.F.R. § 41.52(b)(2). We explained that our analysis in granting the motion is guided by factors set forth in *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001 (PTAB Mar. 5, 2013) (Paper 26) (precedential); *see also Consolidated Trial Practice Guide*, Nov. 2019, at 24–28.[1]

During the conference call, Patent Owner indicated a desire to serve document production requests seeking information relating to commercial success of Petitioner's Helix product, copying of the claimed invention, and industry praise.

Petitioner argued that Patent Owner already has information regarding the commercial success of Patent Owner's products that are covered by the challenged claims and can obtain information from other means regarding commercial success of Petitioner's products. Petitioner also asserted that responding to the requests would be overly burdensome to answer.

[1] Available at https://www.uspto.gov/TrialPracticeGuideConsolidated

ORDER

In consideration of the foregoing, it is:

ORDERED that Patent Owner's request for authorization to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) is granted. Patent Owner's motion is limited to five pages and is due by July 18, 2023. Patent Owner's motion is limited to alleged commercial success of the Helix product of Petitioner, alleged copying by Petitioner, and industry praise and will include Patent Owner's proposed discovery requests appended to the motion. Petitioner's opposition also is limited to five pages and is due by July 25, 2023.

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