

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.,

Petitioners,

v.

METROM RAIL, LLC

Patent Owner.

Inter Partes Review No. IPR2023-00468
Patent 9,043,131

PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

I. Introduction

Patent Owner Metrom Rail, LLC (“Metrom”) requests additional document discovery from Petitioners. The five document requests, Appendix A, cover the structure, function, and operation of the Helix collision avoidance system (“Helix”); basic sales information, and promotional statements in marketing collateral and specific sales efforts in this concentrated industry.

Metrom introduced the innovative “AURA” collision avoidance system in 2012 for railroad maintenance of way (“MOW”) vehicles. *See* Complaint, Exhibit 1010 at ¶¶ 7, 9, 12. Metrom’s AURA system solved the collision problem faced by MOW vehicles by equipping each unit with a radio that can accurately determine the range of the MOW vehicle ahead and warns the operator of the upcoming vehicle – and even trigger the brakes – if the operator does not act promptly. *Id.* at ¶ 11. AURA is covered by U.S. Patent Nos. 8,812,227 (the “227 Patent”) and 9,043,131 (the “131 Patent”), the patents under review in IPRs 2023-00468 and -00470.

Petitioner Piper Networks, Inc. (“Piper”) developed a collision avoidance system called Helix and markets and sells that system alone or with other Petitioners. Helix reads on numerous claims of the 131 and 227 Patents. Metrom seeks documents that pertain to (1) Petitioner’s access to and copying of Metrom’s AURA design which embodies the 131 and 227 Patents, (2) the commercial success of Helix, and (3) praise for the patented system in sales pitches to heavy rail or

commuter rail operators. Patent Owner provides detailed infringement allegations that establish the requisite nexus at least to the threshold needed to show the additional discovery here is appropriate, making the requested materials relevant to objective evidence of non-obviousness.

II. Granting Metrom's Motion Is In The Interests Of Justice And Is Warranted In View Of The Relevant Factors

The Board may grant additional discovery where “necessary in the interest of justice.” 37 C.F.R. § 42.51(b)(2)(i). These IPR proceedings rest on obviousness. Metrom seeks evidence related to at least three objective indicia of non-obviousness: (1) copying of Metrom's AURA System, (2) commercial success, and (3) praise by Petitioners of the patented system. Metrom should be entitled to obtain that evidence from Petitioners. “Whether before the Board or a court, consideration of objective indicia is part of the whole obviousness analysis” and “may often be the most probative and cogent evidence of non-obviousness in the record.” *Intri-Plex Techs., Inc., v. Saint-Gobain Perf. Plastics Rencol Ltd.*, IPR2014-00309, Paper No. 83 at 35 (PTAB Mar. 23, 2014) (citations omitted). The Board often allows additional discovery where, as here, the request is for specific documents relating to secondary considerations from a related litigation, along with reasoning why the documents would be useful. *See Baker Hughes Inc. v. Liquidpower Specialty Prods., Inc.*, IPR2016-01901, Paper 29 (PTAB Sept. 18, 2017). In assessing whether to grant

additional discovery, the Board applies a five factor “necessary in the interest of justice” standard. *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, Case No. IPR2012-00001, slip op. at 6–7 (PTAB, Mar. 5, 2013) (Paper 26). The *Garmin* factors support granting Metrom’s motion.

A. There is more than a possibility that the requested discovery will yield useful information

This first *Garmin* factor strongly favors Metrom. Metrom seeks a limited set of documents specifically relevant to three objective indicia of non-obviousness. First, Metrom requests documents sufficient to show the structure, function, and operation of Helix (RFP No. 1). These documents will reveal details regarding Helix that will demonstrate that it was developed by copying Metrom’s AURA System. Metrom has also asked for marketing and sales collateral distributed to customers or potential customers of Helix (RFP No. 4) and any presentations made to customers or potential customers of Helix (RFP No. 5). Such documents will provide relevant and useful information demonstrating that Helix was developed after and copied from Metrom’s AURA System, and show Petitioner’s praise for patented features and criticism of the prior art. Because these documents are directly related to copying and industry praise, they are evidence of non-obviousness.

Metrom has also requested documents showing sales information for Helix (RFP No. 2) and contracts for collision avoidance systems (RFP No. 3). The

documents concern the commercial success of Helix specifically and the patented system generally and are also evidence of non-obviousness.

A party seeking additional discovery only needs to set forth a threshold amount of evidence showing beyond speculation that something useful will be discovered. *See Arris Grp., Inc. v. C-Cation Tech., LLC.*, Case No. IPR2014-00746, Paper No. 15 at 2-3 (PTAB Jul. 24, 2014). That threshold is met here - there would not be a dispute if Petitioners had not copied, marketed, and sold Metrom's system to the MTA and others. The threshold showing exists that the requested discovery is "favorable in substantive value to a contention of the party moving for discovery." *Garmin Int'l, Inc.*, Case No. IPR2012-00001, slip op. at 7 (Paper 26). Further, because Helix is coextensive with at least claim 1 of the 131 Patent, there is a presumed nexus between the commercial success of Helix and the claimed inventions. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329 (Fed. Cir. 2016). Metrom has provided a detailed claim chart for claim 1 showing infringement based on public information about Helix. *See* Ex. 2002 (131 Patent Claim Chart); *see also* Complaint, Exhibit 1010 at ¶87 (claims 1-2, 7-10, 12-14, 17, and 19). Nexus is also shown because the claims are directed to the collision avoidance system, not a mere component of the products sold. This satisfies the threshold showing that the requested discovery would show objective evidence of non-obviousness.

B. Metrom does not seek Petitioner's litigation positions

The second *Garmin* factor also favors Metrom. None of the requested information relates to Petitioner's litigation positions or their underlying basis.

C. Metrom can obtain the requested discovery only through Petitioner

This third *Garmin* factor also favors Metrom. No discovery is available from the litigation, market information is not available, the customer pool is small and not required to make public commercial details of their transactions, and the devices themselves are not generally available. This motion is Metrom's only way to obtain and use the information requested. *See* 35 U.S.C. § 316(a)(5); 37 C.F.R. § 42.51(b)(2).

D. Metrom's requests are easily understandable and not overly burdensome

These factors favor Metrom because it has identified specific categories of documents for production. Documents "sufficient to show" basic information about the accused Helix System, summary sales data, and "pitch deck" presentations and contracts with the small number of customers in this market are readily identifiable.

III. CONCLUSION

Metrom requests that the Board authorize the additional discovery described in Appendix A.

Respectfully submitted,

Dated: July 18, 2023

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CERTIFICATE OF SERVICE

The undersigned certifies that on July 18, 2023, a copy of Patent Owner's Motion for Additional Discovery was served via email to the Petitioners' counsel at:

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Appendix A

Patent Owner Metrom Rail, LLC (“Metrom”) requests that Petitioners Siemens Mobility, Inc., Ground Transportation Systems USA, Inc., Humatics Corp., and Piper Networks, Inc. (“Petitioners”) produce these documents within one week of the order granting the motion for additional discovery.

Definitions

1. “Helix collision avoidance system” is the “Helix” system described by Petitioner Piper, or a similar system not colorably different from the “Helix” system in any aspect material to the patent challenged in this proceeding.

2. “MTA” is the New York Metropolitan Transit Agency or any of its subdivisions, including New York City Transit.

Requests for Production

Request for Production No. 1: Produce documents sufficient to show the structure, function and operation of the Helix collision avoidance system.

Request for Production No. 2: Produce documents sufficient to show sales of the Helix collision avoidance system, including customer, date, quantity, and price, from 2019 to date.

Request for Production No. 3: Produce each Real Party in Interest’s contract for a “Helix” system.

Request for Production No. 4: Produce a copy of each item of marketing or sales collateral distributed to customers or potential customers that mentions the “Helix” system.

Request for Production No. 5: Produce a copy of each “pitch deck” or similar presentation, such as “PowerPoint” or similar presentations, made to customers or potential customers of the “Helix” system, including the MTA.