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Paper 18
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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)
IPR2023-00470 (Patent 8,812,227 B2)[1]

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

CALVE, *Administrative Patent Judge.*

DECISION
Denying Patent Owner's Motion for Additional Discovery
37 C.F.R. § 42.51(b)(2)

[1] We exercise our discretion to issue one order to be entered in both cases. The parties are not authorized to use this style heading for subsequent papers without Board preapproval.

INTRODUCTION

On July 11, 2023, the Board granted Patent Owner's request to file a motion for additional discovery under 37 C.F.R. § 42.51(b)(2) in each of the above-captioned proceedings. IPR2023-00468, Paper 13; IPR2023-00470, Paper 14 (collectively, the "Order"). The Order authorized Patent Owner to file a motion seeking additional discovery regarding commercial success of Petitioner's Helix product, copying, and industry praise. Order 3.

On July 18, 2023, Patent Owner filed a motion seeking additional discovery from Petitioner in each proceeding. IPR2023-00468, Paper 14; IPR2023-00470, Paper 15 (collectively, the "Motion"). Patent Owner seeks documents regarding Petitioner's Helix collision avoidance system. Motion 1, App. A (Requests for Production Nos. 1–5). On July 25, 2023, Petitioner filed an opposition to each motion. IPR2023-00468, Paper 15; IPR2023-00470, Paper 16 (collectively, the "Opposition").

For the reasons discussed below, we deny Patent Owner's motion for additional discovery under § 42.51(b)(2).

ANALYSIS

As the moving party, Patent Owner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. §§ 42.20(c) and 42.51(b)(2). In an *inter partes* review, a party seeking additional discovery beyond what is permitted expressly by rule must show "that such additional discovery is in the interests of justice." § 42.51(b)(2)(i); *see also* 35 U.S.C. § 316(a)(5)(B) ("discovery shall be limited to . . . what is otherwise necessary in the interest of justice"). To meet its burden, Patent Owner must explain with specificity the discovery requested and why the items corresponding to each request are in the interests of justice. *Id.*

The Board considers the following factors in determining whether additional discovery in an *inter partes* review is in the interests of justice: (1) more than a possibility and mere allegation that something useful will be discovered; (2) seeking a party's litigation positions and underlying basis therefore; (3) ability to generate equivalent information by other means; (4) easily understandable instructions; and (5) requests that are not overly burdensome to answer. *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR 2012-00001, Paper 26 at 6–7 (Mar. 5, 2013). Based on our analysis, Patent Owner's discovery requests in the Motion do not satisfy these factors.

Production Request No. 1

Request for Production No. 1 seeks "documents sufficient to show the structure, function and operation of the Helix collision avoidance system." Motion, App. A, i. Patent Owner asserts that "[t]hese documents will reveal details regarding Helix that will demonstrate that it was developed by copying Metrom's AURA System" (*id.* at 3) and "Metrom seeks documents that pertain to . . . Petitioner's access to and copying of Metrom's AURA design which embodies the 131 and 227 Patents" (*id.* at 1).

"Copying requires duplication of features of the patentee's work based on access to that work, lest all infringement be mistakenly treated as copying." *Institut Pasteur & Universite Pierre Et Marie Curie v. Focarino*, 738 F.3d 1337, 1347–48 (Fed. Cir. 2013). "Evidence of copying may include internal documents, direct evidence such as photos of patented features or disassembly of products, or access and similarity to a patented product." *Liqwd, Inc. v. L'Oreal USA, Inc.*, 941 F.3d 1133, 1137 (Fed. Cir. 2019) (citing *Iron Grip Barbell Co. v. USA Sports, Inc.*, 392 F.3d 1317, 1325 (Fed. Cir. 2004)).

Under *Garmin* factor 1, it is not clear how "documents sufficient to show the structure, function and operation of the Helix collision avoidance system" (Motion, App. A, i) are relevant to show that the Helix system was developed by copying Metrom's AURA system as Patent Owner contends (*id.* at 1, 2, 3). Patent Owner has not demonstrated more than a possibility (or even an allegation) that evidence of Petitioner copying Metrom's AURA system will be discovered from documents showing the structure, function, and operation of a Helix collision avoidance system. *Id.* at 3. A conclusory assertion that "[t]hese documents will reveal details regarding Helix that will demonstrate that it was developed by copying Metrom's AURA System" (*id.* at 3) is not persuasive evidence to show copying or to support this request.

> In *Iron Grip Barbell*, we stated that "copying requires the replication of a *specific product*." *Id.* (emphasis added). In that case, however, we emphasized that a "competing product that arguably fa[l]ls within the scope of a patent" is not necessarily evidence of copying. *Id.* This is to avoid collapsing the separate infringement and copying inquiries into a single analysis. *See id.* ("Otherwise every infringement suit would automatically confirm the nonobviousness of the patent."). As such, we held that if the only evidence of copying was a competitor's abandonment of one product design and subsequent adoption of a design similar to that of a patented product after issuance of the patent, that did "not establish that [the competitor] engaged in copying." *Id.* In other words, more is needed than merely showing that similarity exists between the patent and the competitor's accused product.

Liqwd, 941 F.3d at 1137.

Patent Owner has not explained how documents pertaining to the structure, function, and operation of the Helix product show the AURA system as an embodiment of the claims or Petitioner's awareness, study, disassembly, or copying of the AURA system to develop the Helix system.

Patent Owner provides no evidence that the AURA system embodies the claimed invention (has a nexus thereto) beyond asserting, "AURA is covered by U.S. Patent Nos. 8,812,227 (the '227 Patent') and 9,043,131 (the '131 Patent')." Mot. 1. We have reviewed paragraphs 7, 9, 11, and 12 of the Complaint (Ex. 1010) cited by Patent Owner as evidence that the AURA collision avoidance system solved a collision problem but do not find any evidence of a nexus between these attributes of the AURA and the claimed invention that Petitioner is accused of infringing with the Helix. We agree with Petitioner that Patent Owner has not established a nexus between the AURA and claimed invention to support copying of the claimed invention based on alleged copying of unspecified aspects of AURA. Opposition 3–4.

> As first recognized in *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, a patentee is entitled to a rebuttable presumption of nexus between the asserted evidence of secondary considerations and a patent claim if the patentee shows that the asserted evidence is tied to a specific product and that the product "is the invention disclosed and claimed." 851 F.2d at 1392 (emphasis added). That is, presuming nexus is appropriate "when the patentee shows that the asserted objective evidence is tied to a specific product and that product 'embodies the claimed features, and is coextensive with them.'" *Polaris Indus., Inc. v. Arctic Cat, Inc.*, 882 F.3d 1056, 1072 (Fed. Cir. 2018) (quoting *Brown & Williamson Tobacco Corp. v. Philip Morris Inc.*, 229 F.3d 1120, 1130 (Fed. Cir. 2000)).

Fox Factory, Inc. v. SRAM, LLC, 944 F.3d 1366, 1373 (Fed. Cir. 2019).

Petitioner also asserts that "'Helix' is a marketing term and does not indicate any particular product, system, or configuration." Opposition 2 ("Metrom's requests are so broad and untargeted that they implicate nearly the entirety of Piper's highly confidential business operations, much of which has nothing to do with the subject matter of Metrom's patents.").

Such a broad, unfocused request fails under *Garmin* factor 1 and fails under *Garmin* factor 5 because it is an overly broad and burdensome request for potentially all documents for a Helix system that Petitioner estimates could take many days, be very costly, and "implicate nearly the entirety of Piper's highly confidential business operations." Opposition 1–2.

Under *Garmin* factor 3, Patent Owner obtained sufficient equivalent information regarding the structure, function, and operation of the Helix from public information to prepare "a detailed claim chart for claim 1 showing infringement based on public information about Helix." Motion 4 (asserting that the 131/227 Patent Claim Charts submitted as Exhibit 2002 demonstrates Helix is coextensive with at least claim 1 of those patents).

Under *Garmin* factor 4, Production Request No. 1 is so broad and unfocused as to be not easily understood or implemented by Petitioner, particularly given the potential scope of the Helix system. *See* Ex. 1043.

Based on our analysis of the *Garmin* factors, we find that granting Request for Production No. 1 would not be in the interests of justice.

Production Request Nos. 2 and 3

Request for Production No. 2 seeks "documents sufficient to show sales of the Helix collision avoidance system, including customer, date, quantity, and price, from 2019 to date." Motion, App. A, i. Request for Production No. 3 seeks "each Real Party in Interest's contract for a 'Helix' system." *Id.* Patent Owner argues, "documents showing sales information for Helix (RFP No. 2) and contracts for collision avoidance systems (RFP No. 3) . . . concern the commercial success of Helix specifically and the patented system generally and are also evidence of non-obviousness." *Id.* at 3–4.

Under *Garmin* factor 1, Patent Owner has not shown that sales for Helix (RFP No. 2) and collision avoidance systems contracts (RFP No. 3) will demonstrate commercial success. Motion 3–4. Even if Claim Charts for Helix show a nexus to claim 1 of both patents, Patent Owner has not shown that Helix systems are vehicle mounted modules rather than systems that comprise vehicle mounted modules as one of many components. Thus, Patent Owner has not shown that sales of Helix systems are commensurate with the claimed vehicle mounted modules such that sales of Helix systems reflect commercial success of the claimed system rather than commercial success of other unclaimed features and components.

"'When a patentee can demonstrate commercial success, usually shown by significant sales in a relevant market, and that the successful product is the invention disclosed and claimed in the patent, it is presumed that the commercial success is due to the patented invention.'" *Chemours Co. FC, LLC v. Daikin Indus., Ltd.*, 4 F.4th 1370, 1378 (Fed. Cir. 2021) (quoting *J.T. Eaton & Co. v. Atl. Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997)); *see ABT Sys., LLC v. Emerson Elec. Co.*, 797 F.3d 1350, 1361 (Fed. Cir. 2015) ("The record is thus lacking evidence that the alleged success of Emerson's product in the market was driven by any novel aspect of the claimed invention."); *see also Alcon Research, Ltd. v. Apotex Inc.*, 687 F.3d 1362, 1371 (Fed. Cir. 2012) (commercial success was shown by claimed 0.1% concentration w/v olopatadine formulation used in Patanol® whose sales reached $2 billion in ten years and 70% market share).

As discussed below, record evidence provided by the parties indicates that the Helix comprises more than just vehicle mounted modules and is sold with many components and in many potential configurations.

Patent Owner's First Amended Complaint (Ex. 1042), filed April 26, 2022, included Exhibit K (Ex. 1043), which is "a true and correct copy of another Piper sales sheet taken from Piper's web site describing Piper's 'Helix' collision avoidance and worker protection offering." Ex. 1042, 18.

Exhibit 1043 describes Helix™ as an advanced, multi-sensor Limits Compliance & Collision Avoidance System (LCCAS) that includes (1) GPS RTK high precision position and speed calculation for limits compliance and time synchronization to communicate maintenance of way (MoW) location and vehicle work limits with sub-meter accuracy, (2) ultra wideband (UWB) for localization in complex junctions and yards delivers continuous position data relative to nearby MoW vehicles and personnel with in-cab operator alerts to promote collision avoidance, (3) TrackSight™ LiDAR for obstacle detection and redundant position and speed calculations that compares real-time imaging to an onboard database and constantly surveys tracks using a detailed model of the territory to independently calculate the vehicle's position, (4) onboard inertial measurement unit (IMU) to provide operational telemetry data to alert operators instantly to collisions, (5) high definition HD cameras to deliver live video from each vehicle, (6) iDAR, UWB technology and positioning technologies, (7) advanced infrastructure management (AIM) to integrate third party dispatch systems for remote monitoring and managing of Helix-equipped vehicles, and (8) employee-in-charge tablet interface to monitor vehicles and limits in real-time. Ex. 1043, 2–3. This material indicates Helix systems comprise more than the vehicle mounted modules of claim 1. Therefore, any sales data for Helix systems may reflect the commercial success of features other than vehicle mounted modules recited in claim 1 of the '131 or '227 patents.

As discussed above, a nexus can be presumed "when the patentee shows that the asserted objective evidence is tied to a specific product and that product 'embodies the claimed features, and is coextensive with them.'" *Polaris*, 882 F.3d at 1072. On the other hand, "'[w]hen the thing that is commercially successful is not coextensive with the patented invention—for example, if the patented invention is only a component of a commercially successful machine or process,' the patentee is not entitled to a presumption of nexus." *Fox Factory Factory*, 944 F.3d at 1373 (quoting *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988)).

The discovery requests define "Helix collision avoidance system" as "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." Mot., App. A, i. *Garmin* factors 4 and 5 disfavor overbroad instructions/requests that exceed what is relevant to commercial success. Patent Owner has not shown that sales of the Helix are commensurate with claim 1 or that the features in claim 1 drive sales of Helix systems. Thus, there is no showing that sales figures of Helix systems are relevant to sales of the system claimed in the '131 and '227 patents.

Petitioner identifies the cost of complying with such requests as taking more than 60 days and costing $179,000 or more. Opposition 1–2.

Under *Garmin* factor 3, Patent Owner can generate information regarding its sales of AURA products covered by the '131 and '227 patents to show commercial success.

Based on our analysis of the *Garmin* factors, we find that granting Request for Production Nos. 2 and 3 would not be in the interests of justice.

Production Request Nos. 4 and 5

Request for Production No. 4 seeks "a copy of each item of marketing or sales collateral distributed to customers or potential customers that mentions the 'Helix' system." Motion, App. A, ii. Request for Production No. 5 seeks "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." *Id.* Patent Owner argues that these 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" and "are directly related to copying and industry praise." Motion 3.

Under *Garmin* factor 1, Patent Owner has not shown more than a possibility or mere allegation that something useful will be discovered for similar reasons as discussed above, namely, the Helix system uses so many features beyond those recited in claim 1 of both patents and, as our decision instituting an *inter partes* review indicates, those features are in the prior art. *E.g.*, *Ormco Corp. v. Align Tech., Inc.*, 463 F.3d 1299, 1312 (Fed. Cir. 2006) ("[I]f the commercial success is due to an unclaimed feature of the device, the commercial success is irrelevant. So too if the feature that creates the commercial success was known in the prior art, the success is not pertinent."); *see also* IPR2023-00468, Paper 10; IPR2023-00470, Paper 11.

Under *Garmin* factor 3, Patent Owner has not shown why it cannot obtain evidence of industry praise for its products. *See* Ex. 1042, 6 (Metrom technology selected for "Genuis" award by Metro Transit Authority). Nor has Patent Owner shown that publicly-available information is inadequate.

Under *Garmin* factors 4 and 5, such broad requests are burdensome as they seek a broad range of information without any showing that success of any Helix systems is driven by, and commensurate in scope with, the '131 and '227 patent claims rather than features other than those claimed in both patents. Thus, any industry praise for, or touting of benefits of, such features that are not claimed in either patent are not relevant to non-obviousness of the claimed invention in those patents.

In *Baker Hughes Inc. v. Liquidpower Specialty Prods., Inc.*, IPR2016-01901, Paper 29 (PTAB Sept. 18, 2017), the Board was persuaded to allow additional discovery because "Petitioner submitted a list identifying and describing the documents it seeks to disclose to the Board" and explaining why information in those documents undermined Patent Owner's allegations of long-felt but unsolved need for its patented product. *Baker Hughes*, Paper 29, 2–4. Here, Patent Owner has made no similar showing. Nor has Patent Owner even attempted to use information available to support its request such as marketing information available on Petitioners' websites. *See* Ex. 1042 (First Amended Complaint) 18–19 (listing exhibits showing Petitioners' sales sheets, brochures, and press releases taken from their websites to include "another Piper sales sheet taken from Piper's web site describing Piper's 'Helix' collision avoidance and worker protection offering."); Ex. 1043 (claim chart comparing Piper Helix™ sales materials from a website to claim 1 of the '131 in IPR2023-00468 and '227 patent in IPR2023-00470).

Based on our analysis of the *Garmin* factors, we find that granting Request for Production Nos. 4 and 5 would not be in the interests of justice.

ORDER

In consideration of the foregoing, it is:

ORDERED that Patent Owner's Motion for Additional Discovery under 37 C.F.R. § 42.51(b)(2) is DENIED.

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