

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.

Case No. IPR2023-00468
Patent No. 9,043,131

**PETITIONERS' OPPOSITION TO PATENT OWNER'S MOTION TO
SUBMIT SUPPLEMENTAL INFORMATION UNDER 37 C.F.R. § 42.123**

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	METROM’s MOTION SHOULD BE DENIED	3
A.	Petitioners Were Not Required to Address Secondary Considerations in Petitions, and Metrom’s Motion is Premature	3
B.	Metrom’s Motion Fails as To Exhibits 2030 & 2031	3
C.	Metrom’s Motion Fails as To Exhibits 2032 – 2036	5
D.	Petitioners Would Be Unfairly Prejudiced if the Motion is Granted	7
III.	CONCLUSION.....	8

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>Gen. Access Sols., Ltd. v. Sprint Spectrum L.P.</i> , 811 F. App'x 654 (Fed. Cir. 2020)	4
<i>Halliburton Energy Servs., Inc. v. US Well Servs., LLC</i> , IPR2021-01316, Paper 44, 40-41 (Feb. 17, 2023)	3
<i>Polycom, Inc. v. directPacket Research, Inc.</i> , IPR2019-01235, Paper 56, 3-4 (Sept. 14, 2020)	8
<i>SAS Inst., Inc. v. Iancu</i> , 138 S. Ct. 1348 (2018)	1
<i>Sonos, Inc. v. Implicit, LLC</i> , IPR2018-00766, Paper 34, 4-6 (May 8, 2019)	7, 8
<i>United States v. Arthrex, Inc.</i> , 141 S. Ct. 1970 (2021)	1
<i>ZUP, LLC v. Nash Manuf., Inc.</i> , 896 F.3d 1365 (Fed. Cir. 2018)	3
Other Authorities	
37 C.F.R. §42.123(b)	1, 3, 5

I. INTRODUCTION

Petitioners respond to Patent Owner’s (“Metrom” or “PO”) motion to submit supplemental information purportedly concerning commercial success and copying. Paper 37 (“Mot.”). A motion for the late submission of information under 37 C.F.R. §42.123(b) “must show” both (1) “why the supplemental information reasonably could not have been obtained earlier” **and** (2) “that consideration of the supplemental information would be in the interests-of-justice.” As shown below, Metrom has not come close to making the requisite showings for any of the proposed exhibits.

First, the purported foundation for the bulk of the motion—that the proposed new exhibits’ “significance became clear only when the credibility and foundation for PO’s declarants’ testimony was attacked during cross examination”—is baseless. Mot., 5. Congress created *inter partes* review to “allow[] private parties to challenge previously issued patent claims ***in an adversarial process*** before the Patent Office that mimics civil litigation.” *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1352 (2018); *see also United States v. Arthrex, Inc.*, 141 S. Ct. 1970, 1977 (2021) (same). Because cross-examination and challenging contentions and evidence is fundamental in any adversary process, Metrom cannot now—at this late stage—supplement the record based on the entirely foreseeable “intervening event” of Petitioners challenging and testing the basis of testimony and credibility of Metrom’s witnesses during cross-

examination. *Id.* This alone is enough to deny Metrom’s motion as an unjustified overreach.

Metrom’s motion fails for additional reasons. Metrom fails to specifically explain the relevance of each proposed exhibit and thus fails to meet its burden. Further, admitting any of them now would unfairly prejudice Petitioners because Petitioners will have no reasonable opportunity to respond. For EX2030-EX2031, Metrom fails to establish any reasoned or non-speculative basis that they are relevant or how they would bear on the pending petitions. *See, e.g.,* Mot., 1 (“***If*** Petitioners attack PO’s objective indicia of non-obviousness and/or introduce evidence in its Reply Brief, PO would have no right to file any rebuttal evidence supporting its sur-reply”). And for EX2032-EX2036, Metrom *admits* these materials were in its possession or available to it *since 2018*, before it first raised issues of alleged secondary considerations of non-obviousness, but Metrom chose not to include them in its POR.¹ Finally, as shown below, many of Metrom’s unsupported and conclusory arguments were already carefully considered and rejected by the Board in its August 2, 2023 (Paper 18), decision denying Metrom’s motion for additional discovery, for which Metrom did not seek reconsideration and circumstances have not changed. Metrom’s motion thus fares no better, and the Board should deny it.

¹ Further, Metrom concedes its motion as to EX2037 is premature. Mot., 3 n.2.

II. METROM’S MOTION SHOULD BE DENIED

A. Petitioners Were Not Required to Address Secondary Considerations in Petitions, and Metrom’s Motion is Premature

The IPR Petitions at issue were accorded filing dates of January 13, 2023. The Petitions were not required to raise non-existent purported secondary considerations because PO bears the initial production burden for secondary considerations. *ZUP, LLC v. Nash Manuf., Inc.*, 896 F.3d 1365, 1373-74 (Fed. Cir. 2018).

Metrom filed its PORs on September 15, 2023, raising alleged secondary considerations in support of non-obviousness with declarations and exhibits. Depositions of Metrom’s declarants began in October and concluded on November 30. Petitioners’ replies are due December 15, 2023, at which time they may address such alleged secondary considerations. *See, e.g., Halliburton Energy Servs., Inc. v. US Well Servs., LLC*, IPR2021-01316, Paper 44, 40-41 (Feb. 17, 2023) (rejecting *per se* rule that petitioner must address secondary considerations in the petition, even if known beforehand, because “Patent Owner bears the burden on the nexus inquiry”). As such, Metrom’s contentions that the new exhibits are needed to address Petitioners’ forthcoming replies are both premature and speculative, and should be denied.

B. Metrom’s Motion Fails as To Exhibits 2030 & 2031

Metrom fails to establish that it should be permitted to submit proffered EX2030 and EX2031 in the “interests-of-justice.” 37 C.F.R. §42.123(b).

Specifically, Metrom fails to identify what “additional evidence” makes these exhibits relevant or non-cumulative to the Piper materials that have already been submitted. *See* Mot., 4 (providing no explanation and merely suggesting that Petitioners and Board “[c]ompare” these exhibits to materials already submitted).

At most, Metrom contends that EX2030 and EX2031 are relevant to the commercial success of Piper’s Helix. But the Board already has ascertained—and Metrom has not rebutted—that “Helix comprises more than just vehicle mounted modules and is sold with many components and in many potential configurations” and thus “comprise[s] more than the vehicle mounted modules of [the claims].” Paper 18, 6-8. The Board stated that Helix is “an advanced, multi-sensor” system that includes a litany of unclaimed features such that “any sales data for Helix systems may reflect the commercial success of features *other than* vehicle mounted modules recited in claim of the ’131 or ’227 patent.” *Id.*, 8 (emphasis added); *see also id.*, 10. While Metrom states that EX2031 is “probative evidence of the nexus of the Helix CAS and the asserted claims,” it offers no analysis of *how* EX2031 establishes the lacking nexus. Mot., 6.

The Board’s prior determinations regarding Helix—of which Metrom did not move for reconsideration and which Metrom does not squarely address with this motion—are just as applicable now as before, particularly without any specific argument from Metrom supporting its requests. *See Gen. Access Sols., Ltd. v. Sprint*

Spectrum L.P., 811 F. App’x 654, 657 (Fed. Cir. 2020) (Board should not “be forced to ‘play archeologist with the record’ and search for arguments that might have been made outside of the parties’ briefing”) (quoting PTAB Rules of Practice, 77 Fed. Reg. 48,617 (Aug. 14, 2012)). As before, “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.” Paper 18, 9. Thus, as before, there is no showing that EX2030 or EX2031 are relevant to purported commercial success of the claimed systems. *Id.*, 11. As such, Metrom’s motion should be denied as Metrom makes no showing that the exhibits are non-cumulative to the materials already of record.

C. Metrom’s Motion Fails as To Exhibits 2032 – 2036

Metrom concedes that proffered EX2032-EX2036 were in its possession in 2018, and thus fails to establish that they “could not have been obtained earlier.” 37 C.F.R. §42.123(b); Mot., 5 (“[T]hese exhibits were in PO’s possession before institution...”). Metrom also failed to establish that they should be submitted in the “interests-of-justice.” 37 C.F.R. §42.123(b). Either failure is dispositive.

As a threshold matter, Metrom’s argument that the relevance “was not apparent because Petitioners had taken no position on, much less challenged, any objective indicia of non-obviousness,” strains credulity. This argument ignores both the fundamental nature of cross-examination in an adversary proceeding and that, as is routine, Metrom did not raise purported secondary considerations of non-

obviousness until it filed its Response to the Petitions. Mot., 2. There simply is no “intervening event” sufficient to support Metrom’s request for the late submission of information that was already in its possession or known to it since 2018 and whose relevance (if any) were known when Metrom injected secondary-considerations arguments into the proceedings. Mot., 4. Unsurprisingly, no case Metrom cites supports its argument that a petitioner’s questioning of alleged evidence can be an “intervening event” that supports supplemental evidence. *See* Mot., 5 (*General Elec.* (permitting supplemental evidence to rebut position raised for the first time on reply as to the level of ordinary skill in the art, but also allowing a supplemental reply by petitioner); *Hyperbranch* (“intervening event” was filing of expert report in district court that “could not have been obtained earlier”)). Indeed, it would be an absurd outcome if simply questioning a PO’s purported evidence of secondary considerations during deposition opens the door for additional, existing evidence that PO chose not to use in its affirmative response.

For EX2032-EX2036, Metrom merely states in conclusory fashion that they are “supplemental information supporting PO’s claim that Piper through its employee, David Garcia, had significant and continued access to PO’s AURA CAS.” Mot., 6. But, again, Metrom possessed these exhibits years before asserting copying in its Responses. And Metrom fails to identify any specific information about

features that were allegedly copied that were not already publicly disclosed in its published patents applications.²

Out of all of EX2032-EX2036, Metrom provides specific citation to only Ex. 2036. But the cited portion has no relation to the challenged claim limitations and, therefore, has no bearing on whether Mr. Garcia had access sufficient to allow him to copy the *claimed* system. *See* Mot., 7. Metrom’s request to add such materials at this late stage to “allow for a more complete record” should be denied. Mot. 7.

D. Petitioners Would Be Unfairly Prejudiced if the Motion is Granted

The addition of such materials at this late stage also would unfairly prejudice Petitioners, which is not in the interests-of-justice. Metrom first alleged secondary considerations in its PORs, citing to supporting declarations. Petitioners deposed these declarants, which concluded on November 30, only days before this motion was filed and shortly before Petitioners’ replies are due on December 15. Metrom should not be permitted to supplement the record at this time so it has free rein to use these new materials in its sur-reply, to which Petitioners will have no response. *Sonos, Inc. v. Implicit, LLC*, IPR2018-00766, Paper 34, 4-6 (May 8, 2019) (denying motion to submit supplemental information that “would require reopening discovery

² Metrom’s allegations also are implausible because Mr. Garcia only joined Piper in 2020, well after the MTA project at issue in the district court litigation. EX1042.

to potentially allow [p]etitioner to take two depositions” and may “entail a supplemental reply with a supplemental sur-reply,” which “is contrary to [the Board’s] objective to secure the just, speedy, and inexpensive resolution” of IPRs).

Indeed, Metrom admits these improper motivations when it complains it will “have no right to file any rebuttal evidence supporting its sur-reply.” Mot., 2. Metrom thus seeks to supplement the record now to force Petitioners into a Catch-22—*either* attempt to guess the particulars of Metrom’s arguments and preemptively address them in Petitioners’ Replies, thereby definitively opening the door for Metrom to use the exhibits in its sur-reply *or* disregard the exhibits in Petitioners’ limited Reply briefing at the risk that Metrom’s motion is granted. In both cases, Petitioners would have no opportunity to respond or depose Metrom’s witnesses on the new materials. Such a lose-lose situation for Petitioners should not be permitted and constitutes unfair gamesmanship and clear prejudice, particularly in view of Metrom’s failure, explained above, to adequately support its motion with explanation as to how and why the proposed exhibits are necessary and non-cumulative. *See Sonos*, Paper 34, 4-6; *Polycom, Inc. v. directPacket Research, Inc.*, IPR2019-01235, Paper 56, 3-4 (Sept. 14, 2020).

III. CONCLUSION

For the foregoing reasons, Metrom’s motion to submit supplemental information should be denied and the proposed exhibits expunged from the record.

Dated: December 8, 2023

By: /Vincent J. Galluzzo/
Vincent J. Galluzzo (Reg. No. 67,830)
CROWELL & MORING LLP
1001 Pennsylvania Avenue NW
Washington, DC 20004
(202) 624-2781

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on December 8, 2023, a true and correct copy of the foregoing Petitioners' Response to Patent Owner's Motion To Submit Supplemental Information Under 37 C.F.R. § 42.123 was served by electronic mail on the following email address:

MetromIPR@mcandrews-ip.com

Dated: December 8, 2023

By: /Vincent J. Galluzzo/
Vincent J. Galluzzo (Reg. No. 67,830)
CROWELL & MORING LLP
1001 Pennsylvania Avenue NW
Washington, DC 20004
(202) 624-2781