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 STRIKE

TABLE OF AUTHORITIES

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I. INTRODUCTION

Petitioners oppose Patent Owner's ("Metrom") unfounded motion to strike Exhibit 1060.[1] The exhibit is proper reply evidence responsive to the Patent Owner Response ("POR").

Exhibit 1060 is U.S. Patent No. 6,480,766, which issued on November 12, 2002, and discloses using track databases to determine the position of trains on a track. Petitioners submitted Exhibit 1060 to rebut Metrom's factually inaccurate contention that track databases did not exist at the time of the purported invention, and as such it is proper reply evidence. Contrary to Metrom's arguments, Exhibit 1060 was not offered as "new" prior art to be combined with references Petitioners relied on in the Petition, nor was it meant to "fill gaps in the prior art not covered by the Petition." Paper 47, 2.

Metrom has failed to proffer any supportable justification for striking Exhibit 1060, let alone the "exceptional remedy" of striking two pages of the

[1] Metrom originally requested leave to move to strike Petitioners' Exhibit 1055 as well, but its motion only addresses Exhibit 1060.

Reply.[2] *See* Consolidated Trial Practice Guide (November 2019) at 80-81. The Board should therefore deny Metrom's motion.

II. METROM FAILS TO PRESENT ANY SUPPORTABLE BASIS FOR STRIKING EXHIBIT 1060

A. Exhibit 1060 Is Offered to Rebut Metrom's Incorrect POR Argument, Not to Expand Ground 2A

Petitioner's Reply uses Exhibit 1060 to directly refute Metrom and its declarant Carl Conti's factually inaccurate contention that track databases did not exist at the time of the patented invention. Paper 43 ("Reply"), 20-21. Contrary to Metrom's arguments, it is not being offered to expand Petitioners' Ground 2A arguments or the prior art on which Petitioners rely. Paper 47, 5-6.

The claims addressed in Ground 2A do not recite a track database. Petitioner's expert, Scott Andrews, pointed to the existence of track databases at the time of the alleged invention, which were within the general knowledge of a POSITA, in support of his opinion that a POSITA would have been motivated to combine Grisham's UWB with Nixon's GPS to be able to determine when trains that are close to one another are actually on different tracks, and therefore are not at risk of colliding:

[2] Metrom asks the Board to disregard pages 20-21 of the Reply, Paper 47 at 2, even though Exhibit 1060 is cited in support of only a single sentence. Reply, 21.

> **Q.** So if you know the GPS location of two different trains, how do you know that they're on two different tracks?
>
> **A.** Well, two different ways. One of them is that many of these applications talk about having a track database, so you know what the track -- where the tracks are. The other way is simply to look at the trajectory of multiple GPS fixes over time and you can see what the path of that train is geographically and you can see what the path of the other one is, and you know that those two paths don't cross.

EX2007 (Dep. of S. Andrews), 115:10-20.

In the POR, Metrom attempted to discredit Mr. Andrews's opinion with a declaration of its expert, Mr. Conti: "During his deposition, Mr. Andrews suggested use of a 'track database.' Ex. 2007 at 115:13-23. None of the references suggests using a track database and in my personal experience no such track database existed at the time of the invention." EX2012, ¶72 n.3. In response, Petitioners cited to Exhibit 1060 to directly refute Metrom's argument: "Metrom and Mr. Conti are wrong to contend that 'no such track database existed at the time of the invention.' EX2012, ¶72 n.3. Track databases were disclosed by (at least) 2002. EX1060, 4:42-63, 5:38-43." Reply, 21.

Clearly, Petitioners' reliance on Exhibit 1060 is not a "disguised attempt to change Ground 2A" or an effort to backfill deficiencies in Petitioners' prior art combinations, as Metrom inaccurately contends. Paper 47, 5-6. The record shows that Exhibit 1060 (and the associated text in the Reply) "directly respond to [an]

issue raised by Patent Owner," so Exhibit 1060 is proper reply evidence. *See BMW v. Paice LLC*, IPR2020-00994, Paper 48 at *18-19 (PTAB Nov. 10, 2021).

Metrom cites to *Unified Patents* and *Intelligent Bio-Systems* in support of its motion, but neither case supports striking Exhibit 1060. In *Unified Patents*, the petitioner argued in its reply that a POSITA would have recognized an advantage of combining two particular references, citing to its petition. *Unified Patents Inc. v. Divx, LLC*, IPR2019-01379, 2021 WL 451027, at *14 (PTAB Feb. 8, 2021). However, the Board found that because the argument did not actually appear on the pages of the petition cited to, it was an untimely new argument. *Id.* Likewise, in *Intelligent Bio-Systems*, the petitioner argued in its reply that it would have been obvious to consider conditions other than those described in a given prior art reference, contrary to what it had argued in its petition. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). Not surprisingly, the Board found this argument to be a new invalidity ground, and therefore not allowable. *Id.* Thus, in both cases, the petitioners presented untimely new arguments in their replies. *See Unified Patents*, 2021 WL 451027, at *14; *Intelligent Bio-Sys.*, 821 F.3d at 1369. Here, by contrast, Petitioners proffered Exhibit 1060 to expressly rebut a factually inaccurate argument that Metrom presented in the POR, thereby presenting an argument that is consistent with (and not "contrary to") arguments presented in the Petition.

B. The Fact that Exhibit 1060 Also Supports *Prima Facie* Obviousness Does Not Render It Objectionable

Metrom repeatedly contends that Exhibit 1060 does not rebut Metrom's arguments concerning alleged evidence of secondary considerations of non-obviousness, but instead supports Petitioners' *prima facie* obviousness case. Paper 47, 2, 7. That is not how Petitioners are using Exhibit 1060; but even if Metrom's interpretation of Exhibit 1060's relevance is credited, that still would not be a proper basis for striking the exhibit because it directly responds to an issue raised by Patent Owner. *BMW*, Paper 48 at *18-19.

C. Exhibit 1060 Was Not "Supplemental Information" that Required Leave to Submit

Contrary to Metrom's argument, Paper 47 at 6-7, there was no need for Petitioners to seek leave to submit Exhibit 1060 as "supplemental information" pursuant to 37 C.F.R. § 42.123. Rather, as explained above, the exhibit was provided to rebut Metrom and Mr. Conti's factually inaccurate contention that track databases did not exist at the time of the purported invention. Thus, Metrom's complaint that Petitioners never sought "leave to add art to its case," *id.* at 7, is of no moment. In any event, Metrom has the opportunity to address Exhibit 1060 in its Sur-Reply. *Infineum USA L.P. v. Chevron Oronite Co.*, No. 2020-1333, 2022 WL 3147683, at *5 (Fed. Cir. Aug. 8, 2022) (finding Board's reliance on reply evidence proper because patent owner "had ample notice and opportunity to respond to [it]").

III. CONCLUSION

For the foregoing reasons, Metrom's motion to strike should be denied.

Dated: January 16, 2024

By: */s/ Mark M. Supko*

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on January 16, 2024, a true and correct copy of the foregoing Petitioners' Opposition to Patent Owner's Motion to Strike was served by electronic mail on the following email address:

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Dated: January 16, 2024

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