Paper No. 16

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. IPR2023-00470
Patent No. 8,812,227

PETITIONERS' OPPOSITION TO MOTION FOR ADDITIONAL DISCOVERY

Metrom seeks a Board-sanctioned fishing expedition into a broad swath of a competitor's business that does not relate in any way to the subject matter of Metrom's patents. Metrom's proposed discovery requests are a transparent attempt at avoiding the District Court's stay of discovery (and all other proceedings). The requests simply are not "in the interests of justice," and Metrom cannot meet the "strict" test to receive that discovery. 37 C.F.R. § 42.51(b)(2)(i); *Symantec Corp. v. Finjan, Inc.*, IPR2015-01545, Paper 9, at 4 (PTAB Dec. 11, 2015). The Board should deny Metrom's motion.

I. METROM'S REQUESTS ARE OVERLY BURDENSOME (*GARMIN* FACTOR 5)

Metrom's discovery requests are overly burdensome and will cause great stress to the short trial schedule allowed in IPRs for two leading reasons.

First, Metrom does not seek "documents relating to secondary considerations from a related litigation" as it claims (at 2) because there have been no documents exchanged in that litigation. The case involving Petitioner Piper (the subject of the discovery requests) has been stayed in its entirety pending the outcome of this IPR, and that stay was stipulated before discovery began. Unlike Metrom's cited *Baker Hughes* case (where reproduction of previously produced evidence was sought) or *Arris Group* case (where only a single, specific agreement was requested), here, Piper would have to review all of its records, screen potentially relevant documents

for privilege and confidentiality, and start up a document production system to comply. Piper and its counsel estimate that responding to Metrom's discovery requests could take more than 60 days and cost $179,000, or more. (Ex. 1041 at ¶3).

Second, Metrom's requests broadly seek documents relating to the entire "structure, function and operation" of Helix (RFP No. 1), not just the portion that Metrom alleges relates to its patents. But "Helix" is a marketing term and does not indicate any particular product, system, or configuration. (Ex. 1041 at ¶2). Thus, 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. *See Wolfspeed, Inc. v. Cao Lighting, Inc.*, No. IPR2022-00847, Paper 26, at 4-5 (PTAB Dec. 21, 2022) (rejecting similar requests). Metrom's request for sales information (RFP Nos. 2-3) should also be rejected because "raw sales numbers have little value in determining commercial success." *Id.* at 7. And Metrom fails to even attempt to justify RFP No. 3, which seeks identification of Piper's customers. Metrom's other requests are likewise overbroad because they seek irrelevant information about every "marketing or sales collateral," "pitch deck," and "presentation" made by Piper about Helix (RFP Nos. 4-5), which also would implicate nearly all of Piper's marketing documents, irrespective of their relation to the subject matter of Metrom's patents. Piper would have to review essentially *all* its documents across its entire business to comply with

any of Metrom's requests for discovery (Ex. 1041 at ¶2). The Board rejected similar requests in *Bestway (USA), Inc. v. Intex Marketing Ltd.*, No. IPR2020-01405, Paper 30, at 11 (PTAB Apr. 23, 2021), and should again here.

II. METROM HAS NOT PROVIDED "MORE THAN A POSSIBILITY AND MERE ALLEGATION" (*GARMIN* FACTOR 1)

Metrom casts a wide net for discovery but provides very little to justify its extraordinary request. Metrom's motion and accompanying "claim chart" Exhibit 2002[1] are the first time that Metrom has set forth *any* infringement allegation against "Helix," having only vaguely referred to Helix in its recent amended litigation pleadings. (*E.g.*, Ex. 1042 at 18; Ex. 1043). The claim chart is bare and conclusory, comparing detailed claim requirements with excerpts from marketing materials that state little more than that it is purportedly a "multi-sensor" device (Ex. 2002 at 2), has an "operator display" (*id.* at 3), and collects "ranging data" from UWB sensors (*id.* at 6). Metrom's patent claims require more detail than that.

Metrom has not made "a threshold showing of nexus between the claimed invention and the evidence sought." *Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*,

[1] Metrom's claim chart is irrelevant attorney argument, improperly incorporated by reference in violation of 37 C.F.R. § 42.6(a)(3). *See Boston Scientific Neuromodulation Corp. v. Nevro Corp.*, 813 F. App'x 572, 582-83 (Fed. Cir. 2020) (upholding the Board's exclusion of claim charts like Metrom's here).

No. No. IPR2012-00001, Paper 26, at 6 (PTAB Mar. 5, 2013) (precedential). Metrom's infringement-type allegations are not enough. It is not sufficient that a product or its use merely be within the scope of a claim; a presumption of nexus requires a showing that the product not only practices the claim but is *coextensive* with the claim such that the that the product "*is* the invention disclosed and claimed." *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1377 (Fed. Cir. 2020) (citation omitted). Moreover, the Piper marketing materials highlight Piper's own "patent-pending, Solid State LiDAR technology" (Ex. 1043 at 2), which undercuts any coextensiveness. *See Fox Factory*, 944 F.3d at 1377-78 ("Where a product embodies claims from two patents, a presumption of nexus can be appropriate only if the claims of both patents generally cover the same invention.").

Unlike *WBIP* cited by Metrom (at 4), where the patent owner provided extensive evidence at a jury trial to show that the products embodied the claimed invention and the objective evidence related to those products, Metrom only provides a few conclusory sentences (at 4) and a vague claim chart to support its threadbare claim that "Helix is coextensive" with the patent claims. *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1330 (Fed. Cir. 2016). Metrom needed to provide more.

At base, Metrom seeks discovery regarding commercial success, copying, and industry praise without evidence of a single "Helix" sale, Piper (or anyone else) copying any Metrom product, or a single industry statement about "Helix." All

Metrom has is speculation that *something* productive will result, though Metrom cannot detail what. The Board should not permit Metrom's overreach.

III. METROM HAS AN "ABILITY TO GENERATE EQUIVALENT INFORMATION BY OTHER MEANS" (*GARMIN* FACTOR 3)

Metrom represented to the Board on the July 10 conference call that it plans to rely on its own products' commercial success and industry praise. Metrom avoids this point in its Motion and only argues (at 5) it cannot get the precise information it seeks from Petitioners anywhere else. But the inquiry is whether Metrom would be "unable to generate *equivalent* information without the need for discovery," *Bestway*, Paper 30, at 9-10, and Metrom's own information is equivalent, would require no undue burden to Petitioners, and could just as well support secondary considerations of non-obviousness of the Metrom patents. Metrom does not need any information from Petitioners to make the arguments on non-obviousness it plans to make. Moreover, like the patent owner in *Bestway*, Metrom "is a participant in the . . . industry, and presumably has access to industry publications and the ability to perform a competitive market analysis." *Id.* at 10. Such information is *equivalent* to what it seeks from Petitioners. Metrom needs nothing more.

IV. CONCLUSION

Metrom's motion for additional discovery should be denied. If granted, however, Petitioner Piper reserves the right to request a Protective Order be entered in accordance with 37 C.F.R. § 42.55.

Respectfully submitted,

Dated: July 25, 2023

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on July 25, 2023, a true and correct copy of the foregoing Petitioners' Opposition to Motion for Additional Discovery was served by electronic mail on the following email address:

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Respectfully submitted,

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