

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.

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

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

Under 37 C.F.R. § 42.123(b) and the Board's Authorization dated November 27, 2023, Patent Owner Metrom Rail (PO) moves for leave to file Proposed Exhibits 2030-36, attached, as supplemental information relevant to the objective indicia of non-obviousness of commercial success and copying. The Petition did not argue or provide evidence on any objective indicia of non-obviousness. PO's motion for additional discovery on objective indicia of non-obviousness from all Petitioners, including Piper, was denied. Paper No. 13, July 11, 2023. PO introduced evidence and argument regarding objective indicia of non-obviousness in its Response, Paper No. 22, September 15, 2023. The evidence included declarations submitted by Messrs. Kurt Gunther and James Marchi regarding copying of PO's Aura System by Piper. Petitioners completed depositions of PO's declarants on November 30, 2023.

Petitioners examination of PO's declarant Kurt Gunther attacked the basis for PO's claim reads and nexus between the claims and the commercial success of Petitioner Piper's product and questioned how much access Petitioner Piper's engineer and executive David Garcia had to PO's products and technical information. The questioning suggests that Petitioners' Reply will attack the credibility of PO's declarants and introduce for the first time, new evidence regarding objective indicia of non-obviousness. 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. *See* Paper 11 at

6. In the interest of justice, PO should be allowed to introduce the following supplemental information which was not available at the time of PO's Response or whose relevance was not apparent because Petitioners had taken no position on, much less challenged, any objective indicia of non-obviousness – a tactical choice made by Petitioners in the Petition and again when the Petitioners resisted any discovery of secondary considerations or objective indicia of non-obviousness.

I. Overview of the Evidence and Relevance to the Issues

These proposed exhibits were provided to Petitioners on November 15 and 17. The documents are all authored or witnessed by Petitioner Piper or Piper's employee David Garcia:

- Exhibits 2030-31 were collected on October 26 at the 2023 "NextGen Train Control" conference. Exhibit 2037, Gunther Tr. at 94, 114, 193-97. These are Piper's sales collateral and evidence commercial success and copying.
- Exhibits 2032-33 are e-mails dated October 12, 2018, from David Garcia to Himanshu Patel, copying PO's employees, with attached slides for a joint Parsons-Metrom presentation at the 2018 NextGen Train Control conference and are evidence of Piper employee David Garcia's access to the Aura System and the trust and confidence Metrom had in him.

- Exhibit 2034 is a photograph of a speaking panel at the 2018 NextGen Train Control conference, showing David Garcia and PO employee Sara Woitel together for a joint presentation. Exhibit 2037, Gunther Tr. at 114, 159-63, 193-97.
- Exhibit 2035 is a photograph of David Garcia speaking at the 2018 NextGen Train Control conference.
- Exhibit 2036 is a certified transcript and still excerpts¹ from a video of David Garcia speaking at the 2018 NextGen Train Control Conference, presenting the slides represented in Exhibits 2032 and 2033.
- Exhibit 2037 is the deposition transcript of PO declarant² Kurt Gunther.

II. The Cross-Examination of Metrom's employee Kurt Gunther

Patent Owner Metrom's Response lays out argument and evidence for objective indicia of non-obviousness. Response, Part V. That evidence included specific evidence of copying, including charts comparing Metrom's Aura system to Piper's later-in-time commercial "Helix" system using publicly available information (Ex. 2021) and a recitation of Petitioner's access to Metrom's system

¹ The original video file is too large for electronic filing but was served on Petitioners and remains in the custody of Patent Owner.

² PO has sought confirmation that Petitioners will file its deposition transcripts with the Reply, and will file a separate motion to supplement if they do not.

via David Garcia. (Ex. 2009). Petitioners challenged these facts in its cross examinations, but to date have produced no countervailing evidence. *See e.g.*, Exhibit 2037, Gunther Tr. at 157, 161, 167-69.

III. Under Rule 123(b), the Supplemental Information should be considered

A. The exhibits could not have been submitted earlier

1. Exhibits 2030 and 2031

These two exhibits were first obtained by PO from Piper's sales table at the 2023 NextGen Train Control conference on October 26, 2023. Exhibit 2037, Gunther Tr. at 114, 193-97. These exhibits, particularly Exhibit 2031, contain additional information about Piper's "Helix" collision avoidance system (CAS) beyond that in similar sales material on Piper's website and evidence the commercial success of Piper's Helix CAS. Compare Exhibit 2020 (Piper Web Page showing the "Helix" system) with the conference flyer, Exhibit 2031. Exhibits 2030 and 2031 are precisely the type of material that Petitioners refused to produce in July and Petitioners cannot complain about it now after concealing it from Patent Owner for months.

2. Exhibits 2032-36

Even when a patent owner is aware of evidence before filing its reply, the Board has allowed the late filing of the evidence when "Patent Owner's Motion was precipitated by an intervening event." *Hyperbranch Medical Technology, Inc. v.*

Incept LLC, IPR2016-01836, Paper 58 at 7. Although these exhibits were in PO's possession before institution, their significance became clear only when the credibility and foundation for PO's declarants' testimony was attacked during cross examination – “the intervening event”, making them proper rebuttal evidence. *Id.* PO simply could not “reasonably” deduce Petitioners' challenges and all of its supporting arguments in advance. In such circumstances, the Board has permitted parties to file supplemental information. *See e.g., General Elec. Co. v. United Techs. Corp.*, IPR2018-01442, Paper 33, 6 (PTAB Oct. 10, 2019) (“It is reasonable that Patent Owner should not have to deduce Petitioner's challenges and all of its supporting arguments before they develop during the course of a proceeding, without a chance to respond in some fashion.”); *see also Hyperbranch*, IPR2016-01836, Paper 58 at 7 (finding PO's “explanation . . . sufficient to meet the requirement of § 42.123(b) that the supplemental information reasonably could not have been obtained earlier” when an “intervening event . . . served to enlighten Patent Owner as to the particular relevance of” the supplemental information.”). These exhibits were promptly forwarded to Petitioners when it became clear from Petitioners cross examination what Petitioners would likely argue in Reply.

B. Consideration of the exhibits is in the interests of justice

Exhibit 2030 is probative evidence of the commercial success of Piper's Helix CAS. Exhibit 2030 touts the commercial success of Piper's Helix CAS. See Ex. 2030 ("Amtrak selected Piper's innovative Limits Compliance and Collision Avoidance System (LCCAS) to protect and monitor their Maintenance of Way (MOW) vehicles to ensure safe operation"). Exhibit 2031 is probative evidence of the nexus of the Helix CAS and the asserted claims. *See also* Exs. 2020, 2022.

PO also asserts that Piper copied PO's AURA CAS when it developed its Helix CAS and this copying is a secondary consideration of non-obviousness. "Evidence of access and substantial similarity is evidence of copying." *Medtronic, Inc. v. Teleflex Innovations S.a.r.l.*, 70 F.4th 1331, 1340 (Fed. Cir. 2023); *see also Cable Elec. Prods., Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1027 (Fed. Cir. 1985) ("Access in combination with similarity can create a strong inference of copying.") (overruled on other grounds). Exhibits 2032-37 are supplemental information supporting PO's claim that Piper through its employee, David Garcia, had significant and continued access to PO's AURA CAS. See Exs. 2032-33 and 2036. Specifically, with reference to Ex. 2036, at the Nextgen Train Control Conference, Mr. Garcia shared the dais with PO's employee Ms. Woitel and discussed features of PO's AURA system which evidence the level of access Mr. Garcia enjoyed.

The Metrom ultra wideband solution utilizes coherent signal processing which negates the effect of noise on the signal as shown on these diagrams. . . . Then on the right, you'll see the Metrom rail signal which is transmitted 256 times in integrative or coherent processing. This allows for distance gain -- distance gains and allows them to maintain ranging -- ranging accuracy.

Ex. 2036 at 2:18-3:6. Mr. Garcia also praised PO's AURA CAS, another indicia of non-obviousness. Ex. 2036 at 3:7-11 ("So ultra wideband has been in service for over six years in the harsh, freight outdoor environments in Canada. So ultra wideband also works well outdoors in dense urban environments, and in underground tunnel environments.").

Petitioners will likely challenge the sufficiency of PO's secondary consideration evidence, including Mr. Garcia's access, and proffer competing evidence. It is the province of the Board as "the fact-finder . . . to determine the probative value of [PO's] evidence of secondary considerations for rebutting the prima facie case of obviousness." *Pro-Mold & Tool Co., Inc. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1574 (Fed. Cir. 1996). Exhibits 2030-36 provide the Board with a more complete record to make this determination. The Board has found that submission of new exhibits is in the interests of justice when the exhibits allow for a more complete record and when the submissions will not delay the trial schedule. *See Sony Interactive Entertainment, LLC. v. Intellectual Pixels Ltd.*, IPR2020-01248, Paper 28 at 5 ("allowing Patent Owner to submit the New Exhibits with its

Sur-reply is in the interests of justice as it allow for a more complete record and will not delay the trial schedule.”). *Cf. Ultratec, Inc. v. Captioncall, LLC*, 872 F.3d 1267, 1273 (Fed. Cir. 2017). There is no prejudice to Petitioners since these are their documents or information their employees were well aware of and Petitioners intentionally withheld it at the beginning of this proceeding. There is no impact on the trial schedule since Metrom notified Petitioners of its intent to use this evidence well before the due date for Petitioner’s Reply.

Patent Owner Requests leave to file Exhibits 2030-36.

Respectfully submitted,

McAndrews, Held & Malloy, Ltd.

Dated: December 1, 2023

/Gregory C. Schodde/

Gregory C. Schodde

Reg. No. 36,668

McAndrews, Held & Malloy, Ltd.

500 West Madison Street, 34th Floor

Chicago, Illinois 60661

(312) 775-8000

CERTIFICATE OF SERVICE

I certify that the Patent Owner's MOTION TO SUBMIT SUPPLEMENTAL INFORMATION under 37 C.F.R. § 42.123 and proposed exhibits 2030-2037 were served on December 1, 2023 by e-mail to:

Lead Counsel	Back-up Counsel
Howard Wisnia, Reg. No. 37,502 Wisinia P.C. 12636 High Bluff Dr., Suite 400 San Diego, CA 92130	Gregory S. Nieberg, Reg. No. 57,063 Nathan R. Speed (pro hac vice application forthcoming) WOLF GREENFIELD & SACKS, P.C. 600 Atlantic Ave. Boston, MA 02210 Counsel for Petitioner Humatics Corp. Thatcher A. Rahmeier, Reg. No. 65,734 FAEGRE DRINKER BIDDLE & REATH LLP 222 Delaware Avenue, Suite 1410 Wilmington, Delaware 19801 Zachary D. Kachmer, Reg. No. 75,414 FAEGRE DRINKER BIDDLE & REATH LLP 1144 15th Street, Suite 3400 Denver, Colorado 80202 Counsel for Petitioner Ground Transportation Systems USA Inc. Vincent J. Galluzzo, Reg. No. 67,830 Mark M. Supko (pro hac vice application forthcoming) Kassidy L. Schmitz, Reg. No. 77,449 CROWELL & MORING LLP

Patent Owner Metrom Rail, LLC's Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123

	1001 Pennsylvania Avenue NW Washington, DC 20004 Joshua H. James, Reg. No. 72,568 Crowell & Moring LLP 455 N Cityfront Plaza Dr., Suite 3600 Chicago, IL 60611 Counsel for Petitioner Siemens Mobility Inc. Nicole S. Cunningham (pro hac vice application forthcoming) Steven A. Moore, Reg. No. 55,462 DORITY & MANNING, P.A. 2869 Historic Decatur Rd. San Diego, CA 92106 USA Counsel for Petitioner Piper Networks, Inc.
Service Information:	Email: Howard@wisnialaw.com nspeed@wolfgreenfield.com gnieberg-ptab@wolfgreenfield.com vgalluzzo@crowell.com msupko@crowell.com jjames@crowell.com kschmitz@crowell.com thatcher.rahmeier@faegredrinker.com zach.kachmer@faegredrinker.com smoore@dority-manning.com ncunningham@dority-manning.com

Dated: December 1, 2023

/Gregory C. Schodde/

Gregory C. Schodde
Reg. No. 36,668

IPR2023-00468

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McAndrews, Held & Malloy, Ltd.
500 West Madison Street, 34th Floor
Chicago, Illinois 60661
(312) 775-8000