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

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

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Rules

37 C.F.R. § 42.123(b) 1

Under 37 C.F.R. § 42.123(b) and the Board's Authorization dated December 5, 2023, Patent Owner Metrom Rail (PO) moves for leave to file Proposed Exhibits 2037-38 as supplemental information relevant to objective indicia of non-obviousness.

The proposed exhibits are deposition transcripts of PO's declarants noticed and taken by Petitioners. The depositions showed that the declarants were credible and that their declarations (Exs. 2008 and 2009) are true, accurate, and reliable. Apparently, for that reason Petitioners oppose their introduction. Petitioners support a "heads, I win, tails, you lose" system in which a party taking a deposition can introduce their cross examination if it is helpful to them but conceal an unhelpful cross examination from the Board if it goes badly. PO's motion to submit Proposed Exhibits 2037 and 2038 as supplemental information should be granted.

I. Overview of the Evidence and Relevance to the Issues

These proposed exhibits are depositions of PO's Declarants that were *taken by Petitioners* on November 15 and 30.

- Proposed Exhibit 2037 is the deposition transcript of PO declarant Kurt Gunther.
- Proposed Exhibit 2038 is the deposition transcript of PO declarant James Marchi.

II. The Cross-Examination of Metrom's employees Kurt Gunther and James Marchi

Patent Owner Metrom's Response lays out argument and evidence for objective indicia of non-obviousness. PO 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 *via* David Garcia. (Ex. 2009). Petitioners challenged these facts in its cross examinations, but to date have produced no countervailing evidence. *See e.g.*, Prop. Exhibit 2037, Gunther Tr. at 157, 161, 167-69.

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

A. The testimony in Proposed Exhibits 2037 and 2038 relates to the claims

With the Patent Owner Response, PO submitted the declarations of Messrs. Kurt Gunther and James Marchi regarding objective indicia of non-obviousness, including without limitation (1) copying of PO's Aura System by Petitioner Piper and (2) the commercial success of PO's AURA System. The direct testimony of Messrs. Gunther and Marchi relates to a claim for which trial has been instituted as

they are related to objective indicia of non-obviousness. Their depositions[1] were completed on November 15 and 30, and support their original testimony on those same issues.

For example, PO asserts that Petitioner 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 2037 and 2038 are supplemental information that supports PO's claim that Piper through its employee, David Garcia, had significant and continued access to PO's AURA CAS.

Exhibits 2037 and 2038 are relevant.

B. The exhibits could not have been submitted earlier under Rule 123(b)

The depositions of Messrs. Gunther and Marchi were taken on November 15 and 30, respectively. *See* Prop. Ex. 2037, 2038. They could not have been reasonably

[1] Petitioners cross examination of Mr. Gunther spans roughly 187 pages; Mr. Marchi 135. Both were videotaped at Petitioners' request. The Petitioners presumably did not expend that level of effort asking about irrelevancies.

obtained earlier, as they did not exist during PO's discovery period. *See Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017) (finding trial testimony unavailable under Rule 123(b) because it did not exist during the PO's discovery period); *see also Axonics Modulation Techs., Inc. v. Medtronic, Inc.*, IPR2020-00678, -00680, -00712, Paper 31 at 7 (P.T.A.B. May 14, 2021) ("Patent Owner's arguments sufficiently show that the cross-examination testimony of [its declarant] could not have been obtained earlier (by virtue of it being cross-examination testimony)").

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

Petitioners' examination of PO's declarant Kurt Gunther, for example, 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. Prop. Ex. 2037 at 168-71. Petitioners' examination of PO's declarant Marchi questioned, *inter alia,* customer demand and the triangulation of Metrom, Parsons, and Piper *via* David Garcia. Prop. Ex. 2038 at 90, 97.

In the interests of justice, PO should be allowed to introduce the Gunther and Marchi deposition transcripts as supplemental information, as (1) they were not available at the time of PO's Response and (2) their 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.

The above-referenced questioning suggests that Petitioners' Reply will attack the credibility of PO's declarants and introduce 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, PO would have no right to file any rebuttal evidence supporting its sur-reply. *See* 37 CFR 42.23(b); *Axonics*, IPR2020-00678, -00680, -00712, Paper 31 at 5 (P.T.A.B. May 14, 2021); *see also* IPR2023-00468, Paper 11 at 6.

Nevertheless, if Petitioners challenge the sufficiency of PO's secondary consideration evidence on Reply, PO should be permitted to rely on competing evidence on Sur-reply. 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 2037 and 2038 provide the Board with a complete record to make this determination and a basis for

evaluating the credibility of the declarants and foundation for the objective indicators of non-obviousness.

The Board has routinely relied on deposition testimony relevant to the issues—and has found that the interests of justice require submission of deposition testimony—to maintain a complete record of IPR proceedings. *See Axonics*, IPR2020-00678, -00680, -00712, Paper 31 at 5-8 (P.T.A.B. May 14, 2021). The *Axonics* opinion is instructive, as it involves a similar effort by a petitioner to avoid the introduction of unfavorable deposition testimony. *See id.* at 7-8; *see also Ultratec,* 872 F.3d at 1272 (finding both requirements of Rule 123(b) met for declarants' allegedly inconsistent trial testimony). Similarly, the Board has found that submission of new exhibits is in the interests of justice when the exhibits allow for a 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 ("[A]llowing Patent Owner to submit the New Exhibits with its Sur-reply is in the interests of justice as it allow[s] for a more complete record and will not delay the trial schedule."). Here, there is no impact on the trial schedule because PO notified Petitioners of its intent to use this evidence well before the due date for Petitioners' Reply, much less the Sur-reply.

IV. Submission of the Supplemental Information will not prejudice Petitioners

While a lack of prejudice is not required, introducing the deposition transcripts of Messrs. Gunther and Marchi would not prejudice Petitioners. Petitioners noticed and took the depositions and chose the questions to ask. Petitioners were entitled to cross and re-cross the witnesses. They have had every opportunity to address the testimony of Gunther and Marchi in preparing their Reply and cannot complain about factual answers to questions they asked or re-direct within the scope of their cross. Petitioners have taken the extraordinary step of not introducing the cross-examination that they took, and trying to stop PO from introducing that evidence.

V. Conclusion

Patent Owner Requests leave to file Exhibits 2037 and 2038 as supplemental information.

Respectfully submitted,

McAndrews, Held & Malloy, Ltd.

Dated: December 12, 2023

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CERTIFICATE OF SERVICE

I certify that the Patent Owner's MOTION TO SUBMIT SUPPLEMENTAL INFORMATION under 37 C.F.R. § 42.123 and proposed exhibit 2038 were served on December 12, 2023 by e-mail to:

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