

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

On December 12, 2023, Patent Owner (“Metrom”) filed its second motion to submit supplemental information, this one seeking to introduce into the trial the deposition transcripts of Metrom witnesses Kurt Gunther and James Marchi, which Metrom marked as Exhibits 2037 and 2038, respectively. *See* Paper 42, 1. That motion is now moot because Petitioners filed those same transcripts as Exhibits 1052 and 1054, respectively, when Petitioners filed their Reply to Patent Owner’s Response on December 15, 2023. *See* Paper 44, vi.

Mr. Gunther and Mr. Marchi submitted declarations in support of Patent Owner’s Response. Petitioners subsequently deposed Mr. Gunther and Mr. Marchi. Metrom’s motion alleges Petitioners intended to “conceal” their deposition testimony from the Board. Paper 42, 1. Petitioners had no such intent. Instead, Petitioners anticipated submitting the complete deposition transcripts as part of Petitioners’ Reply, which is standard practice in IPR trials. Metrom’s motion was premature and a waste of the parties’ resources (and the Board’s time).

That said and for avoidance of doubt, by filing Exhibits 1052 and 1054, Petitioners did not waive any objections Petitioners raised at Mr. Gunther’s and Mr. Marchi’s depositions, nor did Petitioners waive their right to object to and move to strike any improper use of these exhibits by Metrom in its forthcoming Sur-Reply. For example, Petitioners reserve the right to move to strike any testimony from Mr. Gunther or Mr. Marchi that Metrom cites in its Sur-Reply that advance new

arguments that Metrom could have raised in Patent Owner’s Response, but elected not to. *See* PTAB Trial Practice Guide at 73-74 (Nov. 2019) (“Sur-replies should only respond to arguments made in reply briefs” and so a “sur-reply that raises a new issue or belatedly presents evidence may not be considered.”). However, unlike Metrom, Petitioners will wait and see whether Metrom violates the Board’s rules.

Dated: December 19, 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 19, 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 19, 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