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.

Inter Partes Review No. IPR2023-00470
Patent 8,812,227

MOTION TO STRIKE

I. INTRODUCTION

The Board granted Patent Owner permission to file this Motion to Strike by e-mail dated January 2, 2024. The motion is timely since permission to bring this motion was requested within five days of service of the offending papers. Patent Owner requests that the Board strike Petitioners' Exhibit 1060 and disregard the related portions of Petitioners Reply, Paper 43 at 20-21 in IPR 2023-00468 and Paper 44 at 18-19 in IPR 2023-00470 ("Reply Papers").

The exhibit is a patent cited to support attorney argument regarding the scope and content of the prior art. *Id.* (citing Exhibit 1060, U.S. Patent No. 6,480,766). The Petition asserts obviousness as the basis for all counts. Exhibit 1060 is used to fill gaps in the prior art not covered by the Petition, and is thus supplemental information that supports the Petitioner's *prima facie* case for obviousness, not rebuttal to Patent Owner's evidence regarding objective indicia of non-obviousness.

Petitioners may urge that their failure to seek leave to supplement the art the Petition relies on be excused as permissible Reply to Patent Owner's showing of objective indicia of non-obviousness. But that is not what the exhibit is cited for. It is held out as showing the content of the prior art supporting Ground 2A, not as countering a secondary consideration such as copying, commercial success, long felt need, skepticism, or industry praise. Just showing that a feature was known in the art is no reply to a secondary considerations case – if it was, there is no end to the

art that could be added to by a Petitioner in reply. "Only God works from nothing. Man must work with old elements." Howard T. Markey, *Why Not the Statute?*, 65 J. PAT. OFF. SOc'Y 331, 334 (1983). Petitioner chose the art from which its obviousness case would be assembled in the Petition and did not seek any relief to expand it. That is the landscape against which the obviousness arguments must be evaluated. Considering Exhibit 1060 for what it teaches as prior art violates the Board's rules and effectively allows Petitioners to add new grounds in Reply without ever seeking leave. Allowing this would encourage Petitioners in any IPR where the Patent Owner raises objective indicia of non-obviousness to shift the prior art landscape in reply.

II. BACKGROUND

The only basis for invalidity raised by Petitioners is obviousness – Petitioners do not contend that any claim is anticipated. Early in this case, Patent Owner sought discovery of secondary considerations and was rebuffed. Paper No 15, '468 IPR; Paper No. 16, '470 IPR. Nevertheless, the Patent Owners Response contains a robust case of non-obviousness based on the objective indicia of non-obviousness. Petitioners' Reply contains an assortment of exhibits that are relied on for attorney argument but are not connected to any declarant who can be cross examined. Exhibit 1060 stands out as being cited solely in support of attorney argument regarding what the prior art shows, in support of Ground 2A:

> "Track databases were disclosed by (at least) 2002."

Reply Paper at 19 (Citing Exhibit 1060 at 4:42-63, 5:38-43).

III. RELEVANT LEGAL PRINCIPLES

A. The Scope and Content of the Prior Art is Fundamental to a 35 U.S.C. § 103 Obviousness Case

> A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

35 U.S.C. § 103(a). Thus, statutory requirements for a petition relying on obviousness include stating what constitutes the prior art and what the ordinary skill level is.

B. A Reply Brief Cannot Include New Evidence

"Petitioner may not submit new evidence or argument in reply that it could have presented earlier, e.g. to make out a prima facie case of unpatentability." PTAB Consolidated Trial Practice Guide (November 2019) at 73–75.

> It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify "with particularity" the "evidence that supports the grounds for the challenge to each claim."

Intelligent Bio-Systems, Inc. v. Illumina Cambridge Lted., 821 F.3d 1359, 1369 (Fed. Cir. 2016) (quoting 35 U.S.C. § 312(a)(3)). There is a procedure available if the Petitioner seeks to add evidence to its record, a motion for filing "supplemental information" under 37 C.F.R. § 42.123. That provision allows the Petitioner to request leave to file the information by motion; Petitioner did not attempt to follow that procedure here.

IV. ARGUMENTS

A. The challenged Exhibit is offered on a *prima facie* issue – the scope and content of the prior art

The Exhibit 1060 is offered to show the content of the prior art in support of Ground 2A. Exhibit 1060 backfills Petitioners' analysis in support of the ground and is being relied on as an additional reference to address a deficiency in their *prima facie* case of obviousness. Ground 2A relates to the alleged obviousness of claims 7-9, 17 and 19 in view of Grisham and Nixon. The Petition contends that "a POSITA would have been motivated to supplement the range of Grisham's UWB-based collision-avoidance system including by looking to complementary technologies, such as the GPS units of Nixon" (Pet. at 35) because "using GPS location data to track the paths of the trains would allow the system to determine if those paths intersected at any point in the future, and thereby would assure a more robust and error free collision warning system." Pet. at 35.

During his cross examination, Petitioners' declarant, Mr. Andrews, testified that GPS locations by themselves were insufficient to determine if two trains were on the same track and one would need a track database. Ex. 2007 at 117. However, Mr. Andrews conceded there is no disclosure "of a track database in Nixon." Ex. 2007 at 116:10-12. In particular, as evidenced from the Reply Papers, Petitioner relies on Exhibit 1060 to support the assertion of its expert at his deposition that the use of a track database would remedy the deficiencies in the use of GPS for determining train location. *Id*. However, this "argument does not appear . . . [in] the Petition and is therefore an untimely new argument presented in the Reply." *Unified Patents Inc. v. Divx, LLC*, 2021 WL 451027, at *14 (Patent Tr. & App. Bd. Feb. 8, 2021). Petitioners use of Exhibit 1060 is a disguised attempt to change Ground 2A to now argue that the challenged claims are obvious in view of Grisham and Nixon in further view of Hawthorne, Exhibit 1060. This is improper. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.,* 821 F.3d 1359, 1369 (Fed. Cir. 2016) ("It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify 'with particularity' the' evidence that supports the grounds for the challenge to each claim.' ")

Even if Petitioner could not have appreciated this flaw in its analysis until the examination of its expert, there was no excuse for not disclosing this additional evidence under the Rule 123 procedure before submitting it with its Reply.

B. Exhibit 1060 is not rebuttal to an objective indicator of non-obviousness

Exhibit 1060 is not rebuttal to any argument regarding secondary considerations. If anything, it shows that the industry failed to make the claimed combination despite this additional element along with all the other art cited in support of ground 2A. Exhibit 1060 is used for supporting the *prima facie* obviousness case only; that is improper under the Board's rules.

C. Exhibit 1060 Was Available to Petitioners Before the Petition was filed, much less the Reply

Petitioners could have sought leave to supplement with Exhibit 1060 months ago. At best, the Reply suggests that the Exhibit fills a gap exposed during the cross examination of Petitioners' expert. But that examination was conducted before Patent Owner had even filed a Response. There is no excuse for why Petitioners would wait until after it filed a Reply to seek leave to add art to its case and still has not done so well after Patent Owner indicated it would would move to strike.

V. CONCLUSION

Patent Owner respectfully requests that the Board strike Exhibit 1060 and the related portion of the Reply.

Respectfully submitted,

Date: January 9, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that on January 9, 2024, a copy of Patent Owner's Motion to Strike was served via email to the Petitioners' counsel at:

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