

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' MOTION TO EXCLUDE

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c), Petitioners Siemens Mobility, Inc., Ground Transportation Systems USA, Inc., Humatics Corp., and Piper Networks, Inc. (collectively, "Petitioners") move to exclude certain expert testimony in the declaration of Carl Conti (Exhibit 2012) proffered by Patent Owner Metrom Rail, LLC ("Metrom").

Mr. Conti has failed to provide sufficient support for several opinions proffered in his expert declaration, including when expressly asked to do so during his deposition. *See, e.g.*, EX1053, 150:2-151:19. For example, Mr. Conti admitted that he did not have any experience with ultra-wideband ("UWB") systems, let alone expertise. *Id.*, 48:13-24. Mr. Conti also admitted that several of his opinions on "UWB at the time of the invention," EX2012, ¶ 41, *see also id.*, ¶¶ 42-50, were only based on his own lack of awareness. EX1053, 113:19-115:5, 133:15-134:23. Mr. Conti further admitted that his opinions on the use of UWB communication systems in the rail industry were based solely on information that he learned during his work on this case, and thus are not the product of his own prior knowledge or expertise. Similarly, sufficient evidence has not been provided to show that Mr. Conti has personal knowledge to support his opinions in paragraphs 41-50 or 69-72 of his declaration. Petitioners thus move to exclude paragraphs 41-50 and 69-72 of Mr. Conti's declaration as inadmissible under Fed. R. Evid. 602, 702, and 703, and 37 C.F.R. § 42.65(a).

I. Testimony from Mr. Conti that Lacks Proper Support Should Be Excluded

A. Legal Standard

Expert testimony is only admissible from “[a] witness who is qualified as an expert by knowledge, skill, experience, training, or education,” and even then only if, *inter alia*, “the testimony is *based on sufficient facts or data*.” Fed. R. Evid. 702 (emphasis added); *see also* 37 C.F.R. § 42.65 (a) (“Expert testimony that does not disclose the underlying facts or data on which the opinion is based is entitled to little or no weight.”).

The Board must determine “at the outset” whether an expert witness’s opinions are admissible. *Daubert v. Merrell Dow Pharms., Inc.*, 509 U.S. 579, 592 (1993); *see also* Fed. R. Evid. 104(a). As “the proponent” of Mr. Conti’s testimony, Metrom “has the burden of establishing that the pertinent admissibility requirements are met by a preponderance of the evidence.” Fed. R. Evid. 702 at cmt. n. (2000 Amendment) (citing *Bourjaily v. United States*, 483 U.S. 171 (1987)); *see also, e.g., Extreme Networks, Inc. v. Enterasys Networks, Inc.*, 395 F. App’x 709, 714 (Fed. Cir. 2010). Metrom has not met its burden with regard to the particular opinions proffered by Mr. Conti that Petitioners challenge here.

In particular, if a witness does not base his or her opinion “on facts or data in the case that the expert has been made aware of or personally observed” as required under Fed. R. Evid. 703, he is essentially testifying as a fact witness and

Fed. R. Evid. 602 applies. Under Fed. R. Evid. 602, a witness may only testify to a matter if “evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter.” As is discussed below, neither Metrom nor Mr. Conti himself has provided sufficient evidence of Mr. Conti’s personal knowledge to support the opinions in paragraphs 41-50 or 69-72 of his declaration.

B. The Opinions in Paragraphs 41-50 Lack Proper Support

Mr. Conti has proffered testimony regarding the use of UWB communication systems in the rail industry prior to the alleged invention of the ’227 Patent. EX2012, ¶¶ 41-50. He admitted, however, that he did not have any experience with UWB systems:

Q. Mr. Conti, do you have any experience in UWB systems?

A. Well, I have experience in rail transit signalling systems, but I've not included UWB in any designs that I've done or considered it.

Q. Have you done any studies about UWB apart from this case?

A. No.

Q. Had you ever worked on any UWB systems in the rail industry or any other industry prior to your work on this case?

A. No.

EX1053, 48:13-24. Mr. Conti also fails to provide sufficient factual support for his opinions on “UWB at the time of the invention.” EX2012, ¶ 41, *see also id.*, ¶¶ 42-50. Mr. Conti admitted during his deposition that his paragraphs regarding the history of UWB were based on information that he “newly learned as part of [his]

work for this case,” rather than his own knowledge or expertise. EX1053, 116:11-20.

Mr. Conti also testifies that “[t]he railroad industry has long had a need to prevent collisions,” and he was “not aware of any system for preventing collisions between [maintenance of way (“MOW”)] vehicles other than work rules based on maintaining visual spacing between MOW vehicles.” EX2012, ¶ 42. However, during his deposition, Mr. Conti admitted that his statements in paragraph 42 were based only on his personal lack of awareness of such systems, and thus did not reflect the knowledge of the “railroad industry” as a whole, or of a POSITA in that field. EX1053, 113:19-115:5 (“Q. And that’s based on your – your personal awareness? You’re not opining, for example, that there was no such use of that technology in the industry? A. Yeah, that’s correct.”). Similarly, Mr. Conti admitted that his contention that UWB was not being discussed in the industry prior to the alleged invention of the ’227 Patent was merely an extrapolation based on Mr. Conti’s own lack of prior experience with UWB. *Id.*, 133:15-134:23. As described above, Mr. Conti’s prior experience with UWB systems is non-existent, so his personal opinions on this subject are meaningless. *Id.*, 48:13-24.

Mr. Conti’s lack of personal knowledge is also shown in paragraph 50. Mr. Conti opines that “for MOW specifically, there had been the failure of every other UWB/RADAR communications system so far to go to market.” EX2012, ¶ 50.

Mr. Conti admitted in his deposition, however, that he did not personally know of *any* UWB/RADAR communications systems to go to market by 2012, let alone systems that went to market and failed. EX1053, 150:2-151:19. Mr. Conti also opines that “the largest practical opportunity to implement a new collision avoidance system in the industry did not use UWB or any other form of terrestrial radio for location/ranging determinations.” EX2012, ¶ 50. Mr. Conti, however, could not even explain what he meant by “terrestrial radio,” admitting: “I can’t tell you what bounds – what that word – what the boundaries of what that word – what that means, ‘terrestrial radio.’” EX1053, 153:17-24. This lack of understanding regarding the meaning of a term in his own declaration underscores the lack of support for his opinions.

Without sufficient facts or data to support his opinions, Mr. Conti’s testimony on the above matters is nothing more than speculation. Such speculative and conclusory “expert” opinions are inadmissible. *See* Fed. R. Evid. 702(b) at cmt. n. (2000 Amendment) (“Rule 702 calls for a quantitative rather than qualitative analysis. The amendment requires that expert testimony be based on sufficient underlying ‘facts or data.’”); *see also* 37 C.F.R. § 42.65(a). Nor can Patent Owner properly rely on Fed. R. Evid. 602 to render the foregoing testimony admissible given Mr. Conti’s admissions regarding his lack of personal knowledge supporting his opinions. *See* Fed. R. Evid. 602.

C. The Opinions in Paragraphs 69-72 Lack Proper Support

Mr. Conti opines on the efficacy of using GPS in combination with UWB. EX2012, ¶¶ 69-72. He fails to provide, however, any factual support for these opinions. *See id.* For example, Mr. Conti testifies that because “signals from GPS satellites have very low power levels (-130 dBm or -160 dBW) near the surface of the earth, potential interference from UWB to GPS receivers (and corresponding GPS-based systems such as aeronautical safety-critical flight systems) was a serious concern.” *Id.*, ¶ 69. But he cites no support for this assertion, nor the assertion that “UWB radio transmissions would have interfered with GPS reception resulting in an error-prone not error free collision warning system.” *Id.*, ¶ 71.

As discussed above, Mr. Conti admitted that he did not have any experience with UWB systems and that his opinions on the use of UWB communication systems in the rail industry were based solely on information that he learned during his work on this case and not based on his own prior knowledge or expertise. EX1053, 48:13-24, 116:11-20. Mr. Conti does not have experience or expertise to support his opinions on UWB, so he also does not have experience or expertise to support his opinions on the interaction of UWB with GPS. For the same reasons discussed for paragraphs 41-50, Mr. Conti's opinions on these matters are

inadmissible. *See* Fed. R. Evid. 702(b) at cmt. n; *see also* 37 C.F.R. § 42.65 (a), Fed. R. Evid. 602.

II. Petitioners Have Preserved Their Objections

On September 15, 2023, Metrom filed Exhibit 2012 in support of its Patent Owner's Response. *See* Paper 23. On September 22, 2023, Petitioners timely filed their objections to Metrom's response evidence, including objections to Exhibit 2012. *See* Paper 25 at 3-4. Consistent with this motion, Petitioners' objections to Exhibit 2012 were based on Fed. R. Evid. 602 and 702-703, as well as 37 C.F.R. § 42.65(a), and applied to paragraphs 41-50 and 69-72. *Id.*

III. Conclusion

For the foregoing reasons, the Board should exclude ¶¶ 41-50 and 69-72 of Exhibit 2012 under Fed. R. Evid. 602, 702, and 703, and 37 C.F.R. § 42.65(a).

Dated: March 1, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 1, 2024, a true and correct copy of the foregoing Petitioners' Motion to Exclude was served by electronic mail on the following email address:

MetromIPR@mcandrews-ip.com

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