

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

**PATENT OWNER'S OPPOSITION TO
PETITIONERS' MOTION TO EXCLUDE**

Mr. Conti has far more relevant railroad safety industry experience than Petitioners' expert. Compare Exhibit 2012, Conti CV, at 52-54 with Exhibit 1004, Anderson CV. Petitioners' complaints go to weight, not admissibility, and the challenged paragraphs should not be excluded.

I. MR. CONTI'S OPINIONS ON THE OBVIOUSNESS OF CLAIMS 1, 11, AND 14 SHOULD NOT BE EXCLUDED.

Citing no case that is even remotely factually similar to this one, Petitioners broadly seek to exclude all of Mr. Conti's direct testimony on claims 1, 11, and 14 (Exhibit 2012, ¶¶ 41-50). That testimony included supporting opinions on long felt need (¶¶ 42, 49) and skepticism in the art (¶¶ 43-48). The closest authority cited in support is a nonprecedential and unpublished Federal Circuit Opinion that affirmed exclusion of an expert without the minimum qualifications to qualify as a POSITA in the relevant art, a rule of decision that would exclude Petitioners' expert Mr. Anderson. Mr. Conti's qualifications as and opinions on who the Person of Ordinary Skill in the Art (POSITA) is, are not challenged by the motion. Exhibit 2012, ¶¶ 35-40, see also ¶¶ 4-15 (describing Mr. Conti's relevant experience and training).

A. Mr. Conti's testimony regarding long felt need is supported both by his personal knowledge under Rule 602 and is proper under Rule 702

Mr. Conti's declaration adequately laid out his specialized knowledge, *supra*, the facts and data that his opinions are based on, Exhibit 2012, ¶ 16 (table of material

considered); *see also* Exhibit 1053 at Tr. 80:1-6 (“looked at all the patents”), 81:7-21 (Prior art relied on by Anderson); the principles and methods that his testimony is based on, Exhibit 2012 ¶¶ 22-30, and his application of those principles to the issue, ¶¶ 41-50. Petitioners seek to exclude the opinion but do not challenge the sound nature of the analysis under 35 U.S.C. § 103 and Rule 702.

“Long felt need” means that the problem the invention solves has been present in the industry for a long period without a solution. Mr. Conti was qualified as a percipient industry participant to comment on this. In addition to his declaration, additional foundation for his conclusions are found at Exhibit 1053 at Tr. 14:20-15:8; 24:18-26:22; 52:19-53:10; 54:6-56:16; 80:1-6; 81:7-21 (Prior art relied on by Anderson); 154:7-155:9; 155:14-156:21; 157:11-159:6; 159:20-161:3; 161:24-162:14. The selected deposition passages cited by Petitioners do not undercut this testimony. That despite both personal knowledge of the industry and a review of literature, Mr. Conti was unaware of any UWB based collision avoidance or localization implementation in the railway setting supports, rather than undercuts, his opinion. Exhibit 1053, Tr. 48:13-24 (cited and quoted by Petitioners’ Motion).

B. Mr. Conti's testimony regarding skepticism in the art is supported both by his personal knowledge under Rule 602 and is proper under Rule 702

The foundation cited in part I.A., *supra*, is also supportive of Mr. Conti's opinions on skepticism in the art, ¶¶ 43-48. Again, Petitioners' criticism of Mr. Conti's lack of knowledge regarding UWB projects specifically supports, rather than detracts, from his opinions. Exhibit 1053, Tr. 154:7-155:9; 155:14-156:21; 157:11-159:6; 159:20-161:3; 161:24-162:14; 166:21-168:18. Petitioners also omit from their motion Mr. Conti's testimony where he put his research regarding UWB in context. *Id.* at Tr. 126:5-127:2; 128:3-129:8.

C. Mr. Conti's testimony regarding the ultimate conclusion of non-obviousness on claims 1, 11, and 14 should not be excluded.

Mr. Conti is qualified as a POSITA, applied the correct legal standard, and had a more than sufficient factual basis for his opinion including his own percipient industry experience. *See also* Parts I.A and B, *supra*. ¶¶ 41-50 of Mr. Conti's declaration should not be excluded.

II. MR. CONTI'S STATEMENTS IN PARAGRAPHS 71-74 REGARDING GROUND 2A SHOULD NOT BE EXCLUDED

Petitioners point to nothing in these statements that is factually incorrect or inconsistent with historical truth despite every opportunity to do so in Petitioners' Reply. Instead, they only attack Mr. Conti's opinion as lacking adequate personal

knowledge. But the lack of personal experience by a POSITA in the industry with GPS and UWB proves the point Mr. Conti was making. Mr. Conti, an expert in railroad safety and familiar with the design constraints in this area and at the time of the invention, did an investigation that coupled with his experience, resulted in his conclusion that the proposed combination goes against the conventional thinking of a POSITA. Exhibit 2012, ¶ 75. Petitioners cite no evidence that his conclusion on the motivation to combine for this ground are incorrect, and this finding is corroborated by both Dr. Cooklev, who is without question an authority on wireless communications generally, and Mr. Gunther. Exhibit 1051, Tr. 13:13-14:5; Exhibit 1052, Tr. 140:17-142:23.

III. CONCLUSION

Petitioners complaints go to weight, not admissibility. Petitioners posited no rebuttal evidence to contradict Patent Owner's multiple declarants testimony on the objective indicators of non-obviousness. The reasonable inference regarding why those declarations are not rebutted is because they are true and accurate. *See Barnett v. United States*, 6 Cl. Ct. 631, 671 (Ct. Cl. 1984). The motion should be denied.

Patent Owner's Opposition to Motion to Exclude
U.S. Patent No. 8,812,227

Respectfully submitted,

Date: March 8, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies that on March 8, 2024, a copy of **Patent Owner's Opposition to Petitioners' Motion to Exclude** was served via email to the Petitioners' counsel at:

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