

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.

IPR2023-00468 (Patent 9,043,131 B2)
IPR2023-00470 (Patent 8,812,227 B2)¹

Before NEIL T. POWELL and IFTIKHAR AHMED, *Administrative Patent Judges*.

PER CURIAM.

ORDER
Setting Oral Argument
37 C.F.R. § 42.70

¹ This Order addresses issues that are the same in each of the above-referenced proceedings. The parties are not permitted to use this caption unless authorized by the Board.

Siemens Mobility, Inc., Ground Transportation Systems USA Inc., Humatics Corp., and Piper Networks, Inc. (collectively, “Petitioner”) and Metrom Rail, LLC (“Patent Owner”) each request an oral hearing pursuant to 37 C.F.R. § 42.70 in the above-captioned proceedings. *See* IPR2023-00468, Papers 50, 51; IPR2023-00470, Papers 51, 52. Petitioner and Patent Owner both request a combined hearing and sixty minutes per side to argue their positions in a combined hearing. *See* IPR2023-00468, Paper 50, 3; Paper 51, 2; IPR2023-00470, Paper 51, 3; Paper 52, 2. Upon consideration, the requests for an oral hearing are *granted*.

Subsequent to requesting an oral hearing, Patent Owner filed a Legal Experience and Advancement Program (“LEAP”) request. IPR2023-00468, Paper 56; IPR2023-00470, Paper 59. That request has been *granted*, and Patent Owner will, therefore, have an additional fifteen (15) minutes of time to present arguments. IPR2023-00468, Paper 56; IPR2023-00470, Paper 59.

ORAL ARGUMENT

A. Time and Format

Oral arguments will commence at 3:00pm CT on March 28, 2024, in person at:

The Southern University Law Center
2 Roosevelt Steptoe Drive
Baton Rouge, Louisiana 70813

The hearing will be part of a special PTAB/TTAB Stadium Tour program. The parties are welcome to attend the entire program and do not need to register for the program.

Petitioner will have sixty (60) minutes of total time to present arguments, and Patent Owner will have seventy five (75) minutes of total

time to present arguments. Petitioner will proceed first to present its case with regard to the challenged claims and grounds set forth in the Petition because it is the party with the burden of proof and persuasion. Thereafter, Patent Owner may respond to Petitioner's case. Petitioner and Patent Owner may reserve some, but no more than half, of the allotted time for rebuttal and sur-rebuttal, respectively. The parties are reminded that arguments made during rebuttal and sur-rebuttal periods must be responsive to arguments the opposing party made in its immediately preceding presentation. The parties also are reminded that during the hearing, the parties "may only present arguments relied upon in the papers previously submitted." Patent Trial and Appeal Board Consolidated Trial Practice Guide ("CTPG") 86 (Nov. 2019).²

The parties may request a pre-hearing conference in advance of the hearing. *See id.* at 82. "The purpose of the pre-hearing conference is to afford the parties the opportunity to preview (but not argue) the issues to be discussed at the hearing, and to seek the Board's guidance as to particular issues that the panel would like addressed by the parties." *Id.* If either party desires a pre-hearing conference, the parties should jointly contact the Board at Trials@uspto.gov at least seven (7) business days before the hearing date to request a conference call for that purpose.

Members of the public will be attending this hearing. The parties are directed to contact the Board at least five (5) days in advance of the hearing if there are any concerns about disclosing confidential information. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

B. Demonstratives

As set forth in 37 C.F.R. § 42.70(b), demonstratives shall be served on opposing counsel and filed no later than three (3) business days before the hearing.

Demonstratives are not a mechanism for making new arguments. Demonstratives also are not evidence, and will not be relied upon as evidence. Rather, demonstratives are visual aids to a party's oral presentation regarding arguments and evidence previously presented and discussed in the papers. Accordingly, demonstratives shall be clearly marked with the words "DEMONSTRATIVE EXHIBIT – NOT EVIDENCE" in the footer. *See Dell Inc. v. Acceleron, LLC*, 884 F.3d 1364, 1369 (Fed. Cir. 2018) (holding that the Board is obligated under its own regulations to dismiss untimely argument "raised for the first time during oral argument"). "[N]o new evidence may be presented at the oral argument." CTPG 85; *see also St. Jude Med., Cardiology Div., Inc. v. The Bd. of Regents of the Univ. of Mich.*, IPR2013-00041, Paper 65, 2–3 (PTAB Jan. 27, 2014) (explaining that "new" evidence includes evidence already of record but not previously discussed in any paper of record).

Furthermore, because of the strict prohibition against the presentation of new evidence or arguments at a hearing, it is strongly recommended that each demonstrative include a citation to a paper in the record, which allows the Board to easily ascertain whether a given demonstrative contains "new" argument or evidence or, instead, contains only that which is developed in the existing record.

Due to the nature of the Board's consideration of demonstratives and the opportunity afforded for the parties to reach an agreement without

involving the Board, the Board does not anticipate that objections to demonstratives are likely to be sustained. Nevertheless, to the extent that a party objects to the propriety of any demonstrative, the parties shall meet and confer in good faith to resolve any objections to demonstratives prior to filing the objections with the Board. If such objections cannot be resolved, the parties may file any objections to demonstratives with the Board no later than two (2) business days before the hearing. The objections shall identify with particularity which portions of the demonstratives are subject to objection (and should include a copy of the objected-to portions) and include a one (1) sentence statement of the reason for each objection. No argument or further explanation is permitted. The Board will consider any objections, and may reserve ruling on the objections.³ Any objection to demonstratives that is not timely presented will be considered waived.

Finally, the parties are reminded that each presenter should identify clearly and specifically each paper (e.g., by slide or screen number for a demonstrative) referenced during the hearing to ensure the clarity and accuracy of the court reporter's transcript.

C. Presenting Counsel

The Board generally expects lead counsel for each party to be present at the hearing. *See* CTPG 11. Any counsel of record may present the party's argument.

As always, all practitioners appearing before the Board must demonstrate the highest professional standards. The Board expects all practitioners to have a command of the factual record, the applicable law,

³ If time permits, the Board may schedule a conference call with the parties to discuss any filed objections.

and Board procedures, as well as the authority to commit the party they represent.

D. Legal Experience and Advancement Program

The Board has established LEAP to encourage advocates with less legal experience to argue before the Board to develop their skills. The Board defines a LEAP practitioner as a patent agent or attorney having three (3) or fewer substantive oral arguments in any federal tribunal, including PTAB.⁴

As noted above, Patent Owner's request for participation in the Board's LEAP program has been granted. IPR2023-00468, Paper 56; IPR2023-00470, Paper 59. Petitioner is also encouraged to participate. Any party may request that a qualifying LEAP practitioner participate in the program and conduct at least a portion of the party's oral argument. The Board will grant up to fifteen (15) minutes of additional argument time to that party, depending on the length of the proceeding and the PTAB's hearing schedule. A party should submit a request, no later than at least five (5) business days before the oral hearing, by email to the Board at PTABHearings@uspto.gov.⁵

⁴ Whether an argument is "substantive" for purposes of determining whether an advocate qualifies as a LEAP practitioner will be made on a case-by-case basis with considerations to include, for example, the amount of time that the practitioner argued, the circumstances of the argument, and whether the argument concerned the merits or ancillary issues.

⁵ Additionally, a LEAP Verification Form shall be submitted by the LEAP practitioner, confirming eligibility for the program. A combined LEAP Practitioner Request for Oral Hearing Participation and Verification Form is available on the LEAP website, www.uspto.gov/leap.

The LEAP practitioner may conduct the entire oral argument or may share time with other counsel, provided that the LEAP practitioner is offered a meaningful and substantive opportunity to argue before the Board. The party has the discretion as to the type and quantity of oral argument that will be conducted by the LEAP practitioner.⁶ Moreover, whether the LEAP practitioner conducts the argument in whole or in part, the Board will permit more experienced counsel to provide some assistance to the LEAP practitioner, if necessary, during oral argument, and to clarify any statements on the record before the conclusion of the oral argument. Importantly, the Board does not draw any inference about the importance of a particular issue or issues, or the merits of the party's arguments regarding that issue, from the party's decision to have (or not to have) a LEAP practitioner argue.

In instances where an advocate does not meet the LEAP eligibility requirements due to the number of "substantive" oral hearing arguments, but nonetheless has a basis for considering themselves to be in the category of advocates that this program is intended to assist, the Board encourages argument by such advocates during oral hearings. Even though additional argument time will not be provided when the advocate does not qualify for LEAP, a party may share argument time among counsel and the Board will permit the more experienced counsel to provide some assistance, if necessary, during oral argument, and to clarify any statements on the record before the conclusion of the oral argument.

⁶ Examples of the issues that a LEAP practitioner may argue include claim construction argument(s), motion(s) to exclude evidence, or patentability argument(s) including, e.g., analyses of prior art or objective indicia of non-obviousness.

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ORDER

Accordingly, it is

ORDERED that an in-person oral hearing, conducted pursuant to the procedures outlined above, will commence at 3:00pm CT on March 28, 2024, at the Southern University Law Center, Baton Rouge, Louisiana.

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