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' REPLY IN SUPPORT OF THEIR MOTION TO EXCLUDE

Metrom does not identify sufficient factual support for Mr. Conti's opinions regarding the use of UWB communication systems in the rail industry prior to the alleged invention of the '227 Patent. Mr. Conti's personal lack of awareness cannot serve as sufficient support for his opinions, as required under Fed. R. Evid. 602, 702, and 703, and 37 C.F.R. § 42.65(a), particularly when he admitted that he did not have *any* experience with UWB systems.

I. Mr. Conti's Opinions in Paragraphs 41-50 Lack Proper Support

Mr. Conti's opinions in Paragraphs 41-50 are not properly supported under Rule 602 and 702.[1] *See also* 37 C.F.R. § 42.65(a). Metrom alleges that some of Mr. Conti's opinions relate to long felt need, but Metrom admits that "'long felt need' means that the problem the invention solves has been present ***in the industry*** for a long period without a solution.'" Paper 57 at 2 (emphasis added). Mr. Conti testified that he was not basing his opinions on what was actually known in the industry before the alleged invention of the '227 Patent, but rather only on his "personal awareness." EX1053, 113:19-115:5; *see also id.*, 133:15-134:23 ("Q. It didn't come up in your personal experience? A. That's all I can speak to."). This

[1] Metrom alleges that Mr. Conti's challenged opinions are supported under both Rule 602 and 702. Petitioners disagree as described herein, but if Mr. Conti's challenged opinions are only supported by Rule 602, they are not expert opinions.

deficiency similarly results in a lack of sufficient factual support for Mr. Conti's opinions that Metrom alleges relate to skepticism. *See* Paper 57 at 3.

Metrom tries to identify factual support with long lists of citations to Mr. Conti's deposition testimony, which occurred after he provided his opinions, but all of the cited testimony is inapposite. *See id.* at 2-3. Much of this testimony describe Mr. Conti's prior work (EX1053, 14:20-15:8, 24:18-26:22, 52:19-53:10, 54:6-56:16), which he admits did not relate to UWB systems (*id.*, 48:13-24). Others comprise Mr. Conti's non-responsive answers when asked to identify so much as one demonstration where UWB technology was shown to be unsuccessful. *Id.*, 154:7-155:9, 155:14-156:21, 157:11-159:6, 159:20-161:3, 161:24-162:14, 166:21-168:18. Mr. Conti admitted, 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. *Id.*, 150:2-151:19.

Mr. Conti's alleged "research regarding UWB" as a paid consultant in this proceeding also does not provide sufficient factual support for his opinions. *See* Paper 57 at 3. The supposed "research" involved reading an article published in 2022 that he admitted supported the use of UWB, instead of teaching away from it. EX1053, 131:23-134:2. Mr. Conti's admission is also consistent with prior art showing that UWB was successfully used in railroad collision avoidance systems before Metrom's alleged invention. *See* EX1006, Figs. 19, 21, 22:45-49, 23:36-40;

EX1029, 1:64-2:8; EX1039, 1-4. Mr. Conti's personal lack of awareness of preexisting UWB systems fails to support an "expert" opinion regarding the state of the industry as a whole.

In a transparent effort to divert attention from the lack of objective support for Mr. Conti's opinions, Metrom tries to impugn the opinions of Petitioner's expert, Scott Andrews, based on the same misplaced arguments about the level of ordinary skill in the art the Board rejected in the Institution Decision. Paper 57 at 1; *see also* Paper 11, 9-12. The only issue before the Board now is whether there is sufficient support for *Mr. Conti's* challenged opinions, and there is not. Similarly, Metrom tries to argue that Petitioners did not rebut testimony regarding secondary considerations, but Petitioners properly rebutted the testimony in their reply. Paper 57 at 4; *see also* Paper 44, 3-11. This is nothing like *Barnett v. United States*, where the plaintiffs argued the scope of their invention to the Patent Office but did not call an inventor as a witness at trial to explain the true scope. 6 Cl. Ct. 631, 670 (Ct. Cl. 1984). The parties' arguments regarding the merits of secondary considerations do not provide support for Mr. Conti's challenged opinions.

II. Mr. Conti's Opinions in Paragraphs 69-72 Lack Proper Support

Mr. Conti's lack of personal experience with combinations of GPS and UWB makes him unqualified to offer an "expert" opinion regarding the efficacy of using GPS with UWB, and Metrom fails to cite any support for his opinions. *See*

Paper 57 at 4. If Mr. Conti did not have personal experience of UWB in railroad collision systems generally, as he admitted (EX1053, 48:13-24), then he plainly could not have personal experience with the narrower topic of UWB in combination with GPS in the context of railroad collision avoidance systems.

Nor can the declarations of Dr. Cooklev and Mr. Gunther provide sufficient factual support for Mr. Conti's opinions. *See* Paper 57 at 4. To the contrary, Mr. Conti did not cite to either declarant as support for his opinions. Indeed, Mr. Conti admitted during his deposition that he did not read Dr. Cooklev's declaration, and he did not know what opinions Dr. Cooklev provided in this case. EX1053, 189:20-190:3.

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).

In the event the Board determines that Mr. Conti's testimony should not be excluded, Petitioners, in the alternative, submit that his testimony is entitled to little or no weight because of its conclusory, unsupported nature. *See Surgalign Spine Techs. Inc. v. LifeNet Health*, IPR2019-00569, Final Written Decision, Paper 73, 15-16 (Aug. 26, 2020).

Dated: March 15, 2024

By: */s/ Joshua H. James*

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on March 15, 2024, a true and correct copy of the foregoing Petitioners' Reply in Support of Their Motion to Exclude was served by electronic mail on the following email address:

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Dated: March 15, 2024

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