

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, STACEY G. WHITE, and IFTIKHAR AHMED,
Administrative Patent Judges.

AHMED, *Administrative Patent Judge.*

ORDER
Granting Patent Owner's Motion to
Submit Supplemental Information
37 C.F.R. § 42.123

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.

DISCUSSION

Metrom Rail, LLC (“Patent Owner”) moves to submit supplemental information under 37 C.F.R. § 42.123. *See* IPR2023-00468, Paper 37; IPR2023-00470, Paper 38 (“Motion” or “Mot.”). Siemens Mobility, Inc.; Ground Transportation Systems USA, Inc.; Humatics Corp.; and Piper Networks, Inc. (collectively, “Petitioner”) have filed an Opposition to the Motion. *See* IPR2023-00468, Paper 38; IPR2023-00470, Paper 41 (“Opp.”).

We heard arguments from the parties on March 28, 2024, and for the reasons set forth below, *granted* the Motion.

1. Patent Owner’s Argument

Patent Owner seeks to submit as supplemental information Exhibits 2030–2036. Mot. 1. Patent Owner asserts that it introduced evidence and argument regarding objective indicia of non-obviousness in its Patent Owner Response, including declarations from Kurt Gunther and James Marchi regarding commercial success of Patent Owner’s Aura System and copying of the system by Petitioner. *Id.* According to Patent Owner, Petitioner’s examination of Mr. Gunther related to Patent Owner’s assertions of commercial success and access that David Garcia, an executive of petitioner Piper Networks, Inc. (“Piper”) had to Patent Owner’s product and technical information. *Id.*

Patent Owner asserts that Exhibits 2030 and 2031 were collected on October 26, 2023 at the NextGen Train Control conference and are Piper’s sales collateral and evidence commercial success and copying. *Id.* at 2. Exhibits 2032 and 2033 are emails dated October 12, 2018, from David Garcia with attached slides for a presentation at the 2018 NextGen Train Control conference and are evidence of Piper employee David Garcia’s

access to the Aura System. *Id.* Exhibits 2034 and 2035 are photographs from that conference, and Exhibit 2036 is a transcript and more photographs of Mr. Garcia’s presentation at the conference. *Id.* at 3.

As to Exhibit 2030 and 2031, Patent Owner argues that sales material on Piper’s Helix collision avoidance system is evidence of commercial success that was recently obtained and of the type that Petitioner previously declined to produce in this proceeding. *Id.* at 4. As to Exhibit 2032–2036, Patent Owner argues that although these exhibits were in Patent Owner’s possession before institution, their significance became clear only when the credibility and foundation for Patent Owner’s declarants’ testimony was attacked, and these exhibits were promptly forwarded to Petitioner. *Id.* at 4–5 (citing *General Elec. Co. v. United Techs. Corp.*, IPR2018-01442, Paper 33 at 6 (PTAB Oct. 10, 2019); *Hyperbranch Medical Tech., Inc. v. Incept LLC*, IPR2016-01836, Paper 58 at 7 (PTAB Oct. 10, 2019)).

Patent owner argues that consideration of these exhibits is in the interests of justice. *Id.* at 6. Patent Owner asserts that Exhibits 2030 and 2031 are probative evidence of the commercial success of Piper’s Helix system and of the nexus of that system to the asserted claims. *Id.* Patent Owner argues that Exhibits 2032–2036 support Patent Owner’s claim that Piper, through its employee, David Garcia, had significant and continued access to Patent Owner’s Aura system. *Id.* at 6–7.

Lastly, Patent Owner contends that there is no prejudice to Petitioner since these are Petitioner’s documents or information that Petitioner was aware of and that submission of these documents would not impact the trial schedule. *Id.* at 8.

2. *Petitioner's Argument*

Petitioner responds that that cross-examination is fundamental in any adversary process and Patent Owner cannot be allowed to supplement the record based on entirely foreseeable cross-examination of Patent Owner's witnesses. Opp. 1–2. Petitioner contends that it was not required to raise secondary considerations arguments in the petitions because Patent Owner bears the initial production burden for secondary considerations. *Id.* at 3.

As to Exhibits 2030 and 2031, Petitioner contends that Patent Owner fails to identify what additional evidence makes these exhibits relevant or non-cumulative to the Piper materials that have already been submitted and that Patent Owner offers no analysis of how these exhibits establish nexus given the Board's prior finding that Helix comprises more than just vehicle mounted modules. *Id.* at 3–4 (citing Paper 18 at 6–8).² Petitioner argues that there is no showing that these exhibits are relevant to the purported commercial success of the claimed systems and, as such, Patent Owner's motion should be denied. *Id.* at 5.

As to Exhibits 2032–2036, Petitioner contends that Patent Owner fails to establish that these could not have been obtained earlier or that they should be submitted in the interests of justice. *Id.* Petitioner argues that there simply is no intervening event sufficient to support Patent Owner's request for the late submission of information that was already in its possession or known to it since 2018 and whose relevance, if any, was known when Patent Owner argued secondary-considerations in its Patent Owner Response. *Id.* at 5–6. Petitioner further argue that Patent Owner

² Although we refer to filings in IPR2023-00468, similar filings have also been made in IPR2023-00470.

fails to identify any specific information about features that were allegedly copied that were not already publicly disclosed in its published patent applications. *Id.* at 6–7.

Petitioner contends that the addition of such materials at this late stage also would unfairly prejudice Petitioner since Patent Owner’s declarants have already been deposed and Petitioner’s Reply was due shortly after filing of the Motion. *Id.* at 7 (citing *Sonos, Inc. v. Implicit, LLC*, IPR2018-00766, Paper 34 at 4–6 (May 8, 2019)). According to Petitioner, Petitioner would have no opportunity to respond to these new materials if Patent Owner is allowed to use these new materials in its Sur-reply, constituting clear prejudice. *Id.* at 8 (citing *Polycom, Inc. v. directPacket Research, Inc.*, IPR2019-01235, Paper 56 at 3–4 (Sept. 14, 2020)).

3. *Our Analysis*

Patent Owner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). Because Patent Owner seeks to submit supplemental information more than one-month after institution of trial, the following Rule also governs:

(b) Late submission of supplemental information. A party seeking to submit supplemental information more than one month after the date the trial is instituted, must request authorization to file a motion to submit the information. The motion to submit supplemental information must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice.

37 C.F.R. § 42.123(b).

Accordingly, Patent Owner bears the burden of showing (1) “why the supplemental information reasonably could not have been obtained earlier” and (2) “that consideration of the supplemental information would be in the

interests-of-justice.” *Id.* On this record and in the particular circumstances of this proceeding, we determine that Patent Owner has met its burden.

We determine that Patent Owner’s explanation in this particular case is sufficient to meet the requirement of § 42.123(b) that Exhibits 2030 and 2031 reasonably could not have been obtained earlier given that they were obtained from a conference in October 2023. Petitioner’s reliance on our earlier statements related to the Helix system is misplaced since, there, we evaluated whether Patent Owner had met its burden on its broad requests for additional discovery. *See* Paper 18 at 6–8 ((citing *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR 2012-00001, Paper 26 at 6–7 (Mar. 5, 2013)). In contrast, here, we simply look to whether the supplemental information reasonably could not have been obtained earlier and whether its consideration is in the interests of justice. We find those requirements easily met as to Exhibits 2030 and 2031.

Patent Owner also persuasively argues that even though it had access to Exhibits 2032–2036 earlier, Patent Owner failed to appreciate that Petitioner would challenge whether Petitioner had access to Patent Owner’s technology. Although we agree with Petitioner that Patent Owner should have been aware that Petitioner would challenge Patent Owner’s declarants’ credibility and respond to Patent Owner’s secondary consideration arguments, we do not find it entirely unreasonable that Patent Owner did not submit evidence relating to Petitioner’s access to Patent Owner’s technology *specifically* through Mr. Garcia. *See General Elec.*, Paper 33 at 6 (“It is reasonable that Patent Owner should not have to deduce Petitioner’s challenges and all of its supporting arguments before they develop during the course of a proceeding, without a chance to respond in some fashion.”).

Further, allowing the parties to present a more complete record on objective indicia of non-obviousness is in the interests of justice.

Moreover, we see little prejudice to Petitioner from the submission of this supplemental information. These exhibits were served on Petitioner on November 15 and November 17, and Petitioner filed its Reply on December 15—*a month* after the exhibits were served and *two weeks* after the Motion was filed. *See* Mot. 2, 10; Paper 39 at 1; Paper 43. Petitioner could have sought further relief from us if it considered it necessary to respond to Patent Owner’s proposed submission. *See, e.g.*, Paper 11 at 8 (allowing parties to stipulate a different date for Petitioner’s reply). Furthermore, the proposed materials either belong to Petitioner or relate to Mr. Garcia, who is Piper’s employee, and are therefore materials that Petitioner was aware of. And Petitioner had ample opportunity to submit any rebuttal evidence related to these materials with its Reply.

Prior Board decisions that Petitioner relies upon are easily distinguishable. In *Polycom*, Patent Owner’s request, made a month *after* Petitioner’s Reply had been filed, related to materials that had been referenced both in the Petition and in the Patent Owner’s Response and could have been filed with the Patent Owner Response. *See Polycom*, Paper 56 at 1–2. Similarly, in *Sonos*, Patent Owner’s request came *after* Petitioner’s Reply had been filed and would require reopening discovery to potentially allow Petitioner to take two depositions of non-party witnesses. *See Sonos*, Paper 34 at 4–5.

We are therefore persuaded that allowing Patent Owner to submit the requested supplemental information is in the interests of justice as it allows for a more complete record and will not delay the trial schedule. We therefore *grant* Patent Owner’s motion.

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

Following our decision granting Patent Owner's Motion, Petitioner did not seek to reopen discovery but requested that it be allowed to submit a Supplemental Reply addressing Patent Owner's arguments based on the supplemental information. We *grant* Petitioner a five-page Supplemental Reply limited to addressing Exhibits 2030–2036 and any related arguments made in Patent Owner's Sur-Reply (Paper 49). Petitioner may not submit testimonial or other evidence without prior leave from the Board.

ORDER

It is:

ORDERED that Patent Owner's Motion to Submit Supplemental Information (IPR2023-00468, Paper 37; IPR2023-00470, Paper 38) is *granted*;

FURTHER ORDERED that Exhibits 2030–2036 are entered into the record of this proceeding;

FURTHER ORDERED that Petitioner is authorized to file a Supplemental Reply addressing Patent Owner's arguments related to Exhibits 2030–2036 in Patent Owner's Sur-reply; and

FURTHER ORDERED that Petitioner's Supplemental Reply may be no longer than five pages, and filed no later than April 12, 2024.

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