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By ECF & Email to Failla_NYSDChambers@nysd.uscourts.gov
Honorable Katherine Polk Failla
United States District Judge
United States District Court for the Southern District of New York
40 Foley Square, Room 2103
New York, New York 10007

Re: *Railware, Inc. v. National Railroad Passenger Corporation dba Amtrak*, 1:22-cv-05013 (KPF)
Response to Railware's Letter Motion for Pre-Motion Discovery Conference

Dear Judge Failla,

We represent Amtrak in the above-referenced litigation. We oppose Railware's Letter Motion seeking to compel Amtrak to produce certain documents (ECF 122). As to the status of document discovery: to date, Amtrak has produced over 7,500 documents (almost 150,000 pages), including *inter alia*, technical, budget, and development documents, usage data, documents relating to compliance with FRA regulations, prior art, and the like. Railware has produced only 208 documents, only 18 of which are internal Railware documents; the remainder are publicly available. Given the latter and other on-going Railware discovery deficiencies, Amtrak will shortly file a letter seeking to compel discovery.

I. Documents relating to "EEPS"

Railware contends that the "Enhanced Employee Protection System ('EEPS')" is covered by the patents asserted in this case, and that Amtrak's accused AMTEC system implements EEPS. *See, e.g.*, Amended Complaint, ECF 11, at ¶¶ 2; 4; 12; 15; 17; 24; 28; 49. EEPS is a functional, generic term used in the industry to identify a ***technology***, not a specific vendor of that technology as Railware claims. For example, the FRA Safety Advisory cited in the Amended Complaint states: "FRA recommends that railroads adopt one or more ***electronic technologies*** that may serve to fill the technology gap. Examples of ***such technology*** already in use include the following systems: ***Enhanced Employee Protection System***." 79 FR 70268, at 70269 (emphasis added); *see also* ECF 11, at ¶ 23 (citing the same). The Advisory describes the ***technology*** as providing a code to the roadway worker in charge (RWIC) that must be provided back to the dispatcher so the dispatcher cannot remove the blocking mechanism without the knowledge and agreement of the RWIC. *See id.* In opposing Amtrak's Motion to Dismiss, Railware characterized the technology as: "… generating a unique code for each block placed by the dispatcher, sending that unique code to a railway worker, and permitting the dispatcher to remove the block only upon receiving the unique code from the railway worker." *See* ECF 31, at 3.

Despite the clarity of what is being accused in this case, Railware now contends that "Railware has no way of knowing what, exactly, Amtrak considers to be 'EEPS.'" ECF 122, 1. This is non-sensical and contrary to Railware's infringement contentions referencing EEPS and would mean Railware does not know what it accused in 2022 and now. At the meet-and-confer, Amtrak confirmed that EEPS meant the underlying technology described in the Asserted Patents, the FRA

regulation, and described in Railware's above opposition. Railware cannot now feign ignorance as to Amtrak's scope and relevance objection, and the Court should not credit its arguments.

Amtrak's AMTEC system is a proprietary system with numerous features, the majority of which are unrelated to the accused EEPS feature in this case. ECF 40, ¶¶448-449. Thus, Amtrak objected to the relevance and breadth of Railware's requests seeking all documents on the AMTEC system because they were unrelated to the functionality allegedly covered by Railware's patents and asserted in this litigation, *i.e.*, EEPS. For example, Request No. 10 requests:

> Technical Documents referring and/or relating to the Accused Products, including, but not limited to, block diagrams, schematics, technical reference manuals, data books, data sheets, development documents, presentations, training materials….

This request extends to ***every*** technical document that "refer[s]" or "relat[es]" to AMTEC, irrespective of whether it relates to EEPS, the accused functionality. This is unduly burdensome for Amtrak to search for and produce every single page involving AMTEC and its numerous features—i.e., information unrelated to the Patents-in-Suit or EEPS. Railware is only entitled to discovery that "is relevant to any party's claim or defense and proportional to the needs of the case." Fed. R. Civ. P. 26(b). Railware bears the burden of proving that discovery into ***non-accused*** features and functionality of a multi-feature system are relevant and proportional here, a proposition that it did not and cannot satisfy. Thus, Railware's request should be denied.

As to the ARINC system, Amtrak has repeatedly informed Railware that EEPS was never implemented in ARINC. *See, e.g.,* Answer, ECF 40 at ¶ 55; *see also* Ex. A (sworn response to Interrogatory No. 1); *see also, e.g.*, Ex. B (email to Railware's counsel). Moreover, Railware's argument that Amtrak's assertion is "without any evidence" is wrong. *See, e.g.*, Ex. A; Ex. C [redacted] [1] Railware's on-going accusations against Amtrak's purported use of ARINC are baseless.

II. Documents relating to Accidents, Injuries, and Deaths (RFP Nos. 3, 26, 30-32, 53)

This issue is not ripe for consideration because ***Amtrak promised to investigate a reasonable scope to these requests***, but Railware unilaterally believed a couple of weeks was unreasonable; this is despite Railware's own dilatory investigation and discovery deficiencies noted above. By filing its Letter Motion, Railware reneged on negotiating an agreeable scope, and is pursuing the full scope of the requests. But Railware's injury/death related requests are neither relevant nor proportional to the needs of the case.[2] They seek ***every*** injury or death of a track worker, regardless of whether an incident was related to the safety feature allegedly claimed in the Asserted Patents

[1] Without admitting relevance or proportionality, Amtrak has produced other documents showing ARINC was not implemented: contracts, statements of work, tech proposals, presentations, project charters, meeting minutes, and emails regarding the decision not to implement ARINC.

[2] Some of this information is equally available to Railware as it is Amtrak, as it is contained on the FRA's public databases. https://safetydata.fra.dot.gov/OfficeofSafety/default.aspx. Concerningly, Railware simply has not done its own investigation.

and allegedly infringing product, and some requests are not even limited in time. For example, RFP No. 3 seeks ***any*** injury of a track worker (*e.g.*, a worker stubbing his toe) dating back to Amtrak's creation (1970). On these scope and temporal grounds alone Railware's requests violate Rule 26(b), and are grounds for denial. In any event, Amtrak is continuing its investigating and is willing to negotiate on a reasonable scope.

Moreover, Railware does not license its systems with respect to any accident history, cost-savings, etc., nor does Amtrak. So these items are irrelevant for the hypothetical negotiation, contrary to Railware's assertion. Also, any documents relating to what Amtrak has settled lawsuits and other claims for, including through worker's compensation, is never admissible to establish the amount of a claim under Fed. R. Evid. 408, and is not the value of the Asserted Patents as Your Honor recognized. *See* 2024-02-14 Tr. at 32:18-33:23.[3] Railware's motion to compel should be denied.

III. RFP No. 45

RFP 45 requests all documents "referring and/or relating to" each of Railware, Dispatch X, EEPS, or "similar technology." *See* ECF 122-1 at 48-49. Amtrak objected based on the breadth and proportionality of this request, as well as failing to "describe with reasonable particularity each document or category of documents requested." *See id*. Amtrak noted during the meet-and-confer and in follow-up correspondence that Amtrak is not objecting to reasonably searching for documents relating to EEPS and has explained to Railware's counsel:

> [W]e have been searching for such documents, to the extent they are relevant, not unduly burdensome, and proportional to the needs of the case. For example, we've been searching for and producing technical documents relating to EEPS (*see, e.g.,* RFP Nos. 1, 6, 7, 10, 11); usage pertaining to EEPS (*see, e.g.*, RFP No. 2), implementation of EEPS (*see, e.g.*, RFP Nos. 4, 14), etc. We've produced project charters, technical documents, operations manual, blocking data, budgets, etc. all relating to EEPS. What we said on the call is that we object to the breadth of the requests calling for ***all documents "referring and/or relating to***" EEPS, without some further limitation.

Ex. B, McCarthy Apr. 20, 2024 email. Rule 34(b)(1)(A) requires that the request "must describe with reasonable particularity each item or category of items to be inspected." Document requests for "all documents" "relating to" or "referring to" a particular subject are overbroad, lacks particularity, are not proportional to the needs of the case, and amount to little more than a fishing expedition. *See, e.g.*, *Michael Kors, L.L.C. v. Su Yan Ye*, No. 1:18-CV-2684 (KHP), 2019 WL 1517552, at *3 (S.D.N.Y. Apr. 8, 2019) (citing *Henry v. Morgan's Hotel Grp., Inc.*, 2016 WL 303114 at *2 (S.D.N.Y. Jan. 25, 2016) (collecting cases)); *see also, e.g.*, *Rojas v. Bosch Solar Energy Corp.*, No. 18-cv-05841 BLF (NC), 2020 WL 8617414, at *2 (N.D. Cal. Aug. 28, 2020). As with Section I above, it is unduly burdensome to require Amtrak to search for and produce every single page referencing EEPS, as Railware demands. Railware's request to compel on its additional catch-all request for "all documents" "referring or relating to" "EEPS" should be denied.

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[3] Contrary to Railware's suggestion, the issue of relevance was not decided at the February 14th hearing, nor in any ruling that Railware could seek broad, irrelevant discovery into those issues.

VENABLE LLP

Respectfully Submitted,

/s/ Ralph A. Dengler
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