

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.

IPR2023-00439
Patent 10,179,595 B2

Before JAMES P. CALVE, HYUN J. JUNG, and NEIL T. POWELL,
Administrative Patent Judges.

POWELL, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. BACKGROUND

Siemens Mobility, Inc., Ground Transportation Systems USA, Inc., Humatics Corp., and Piper Networks, Inc. (collectively, “Petitioner”) filed a Petition for *inter partes* review of claims 1–30 of U.S. Patent No. 10,179,595 B2 (Ex. 1001, “the ’595 patent”). Paper 5 (“Pet.”). Metrom Rail, LLC (“Patent Owner”) filed a Preliminary Response. Paper 9 (“Prelim. Resp.”).

We have authority to determine whether to institute an *inter partes* review. 35 U.S.C. § 314(b); 37 C.F.R. § 42.4(a) (2020). For the reasons explained below, we do not institute an *inter partes* review.

B. RELATED PROCEEDINGS

The parties note that the ’595 patent has been asserted in *Metrom Rail, LLC v. Siemens Mobility, Inc.*, 22-cv-00049-RGA (D. Del.). Pet. xv; Paper 7, 3. The parties also note that the ’595 patent, U.S. Patent Application No. 17/981,142, and U.S. Patent Nos. 11,492,027, 10,336,353, 10,896,589, 10,737,709, and 10,926,783 all claim the benefit of provisional application No. 62/177,683. Pet. xiv; Paper 7, 2–3. Additionally, Patent Owner notes that “IPR2023-00452, IPR2023-00460, IPR2023-00468, and IPR2023-00470 all involve the same parties as this IPR.” Paper 7, 3.

C. THE ’595 PATENT

The ’595 patent is titled “WORKER PROTECTION SYSTEM.” Ex. 1001, code (54). The ’595 patent issued from U.S. Patent Application No. 15/078,427 on January 15, 2019. *Id.* at codes (21), (45). The ’595 patent’s Abstract describes worker protection systems and methods as follows:

Systems and methods are provided for worker protection. The worker protection systems comprise a plurality of alert devices, comprising one or more wearable personal alert devices, each worn by a person (e.g., worker), and one or more companion alert devices that broadcast alerts or signals triggering alerts. The companion alert devices comprise vehicle-mounted alert devices, configured for operation on vehicles (e.g., trains), and wayside detection units, configured for placement on or near paths of the vehicles. The wayside detection units may be operable to autonomously detect and track the vehicles.

Id. at code (57).

D. EVIDENCE

Petitioner relies on the following evidence:

- (1) U.S. Patent Application Publication No. 2012/0296562 A1, published Nov. 22, 2012 (Ex. 1006, “Carlson”).
- (2) International Publication No. WO 2013/056244 A1, published Apr. 18, 2013 (Ex. 1007 “Cross”).
- (3) U.S. Patent Application Publication No. 2007/0241888 A1, published Oct. 18, 2007 (Ex. 1009, “Mantovani”).
- (4) U.S. Patent Application Publication No. 2008/0170533 A1, published July 17, 2008 (Ex. 1010, “Cyzs”).
- (5) German Publication No. DE 10 2008 020 700 A1, published Nov. 5, 2009 (Ex. 1011 with English translation at Ex. 1012, “Meyer”).
- (6) U.S. Patent Application Publication No. 2009/0243397 A1, published Oct. 1, 2009 (Ex. 1014, “Cook”).
- (7) U.S. Patent No. 5,907,294, issued May 25, 1999 (Ex. 1016, “Welte”).
- (8) Declaration of Michael S. Braasch, Ph.D. (Ex. 1003).

E. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner challenges the patentability of claims 1–30 of the ’595 patent on the following grounds (Pet. 2):

Claim(s) Challenged	35 U.S.C. §¹	Reference(s)
1, 7–15, 19–25	102(a)(1), 103	Cross
2–5	103	Cross, Mantovani
6	103	Cross, Cyzs
16, 17, 26	103	Cross, Meyer
14, 18	103	Cross, Cook
27–30	103	Cross, Meyer, Welte
21–25	102(a)(1)	Carlson

II. ANALYSIS

Petitioner argues that the ’595 patent’s claims 1, 7–15, and 19–25 are anticipated by and/or would have been obvious over Cross. Pet. 9–33. Petitioner asserts that each of claims 2–6, 14, 16–18, and 21–30 would have been obvious over Cross in combination with one or more of Mantovani, Cyzs, Meyer, Cook, and Welte. *Id.* at 33–63. Petitioner also contends that claims 21–25 are anticipated by Carlson. *Id.* at 63–80.

Although “strongly disagree[ing] with” the arguments in the Petition, Patent Owner avers that it has disclaimed claims 1–30 of the ’595 patent to

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Because the application from which the ’595 patent issued was filed after that date, with no benefit claim prior to that date, the AIA versions of §§ 102 and 103 apply.

conserve resources. Prelim. Resp. 1. As evidence that it has disclaimed claims 1–30, Patent Owner has entered into this proceeding’s record Exhibit 2001 (hereafter, “Disclaimer” or “Discl.”). *Id.* Patent Owner avers that it filed its Disclaimer on April 18, 2023. *Id.* According to Patent Owner, “because all challenged claims of the 595 patent have been disclaimed, the Petition to institute *inter partes* review of claims 1-30 of the 595 patent should be denied.” *Id.* at 3.

As set forth in 37 C.F.R. § 42.107(e), Patent Owner “may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent. No *inter partes* review will be instituted based on disclaimed claims.” Thus, we shall not institute an *inter partes* review in this proceeding if Patent Owner has met the requirements of Rule 1.321(a) and disclaimed all challenged claims of the ’595 patent.

Consistent with Patent Owner’s assertion, Office records reflect that Patent Owner filed its Disclaimer on April 18, 2023. Additionally, Patent Owner’s Disclaimer complies with Rule 1.321(a). Patent Owner’s Disclaimer is signed by “James Marchi, Chief Executive Officer” of “Metrom Rail, LLC.” Discl. 1. This meets Rule 1.321(a)(1)’s requirement that a disclaimer “[b]e signed by the patentee, or an attorney or agent of record.” Identifying the patent number as “10,179,595,” Patent Owner’s Disclaimer states “I hereby disclaim . . . complete claims . . . 1-30.” Discl. 1. This meets Rule 1.321(a)(2)’s requirement that a disclaimer “[i]dentify the patent and complete claim or claims, or term being disclaimed.” Patent Owner’s Disclaimer also states that “[t]he extent of my interest in said patent is . . . 100% Patent Owner (Reel 047644/Frame

0261).” Discl. 1. This meets Rule 1.321(a)(3)’s requirement that a disclaimer “[s]tate the present extent of patentee’s ownership interest in the patent.” Additionally, Patent Owner’s Disclaimer authorizes the Director to charge any required fees to Patent Owner’s deposit account. Discl. 1. This meets Rule 1.321(a)(4)’s requirement that a disclaimer “[b]e accompanied by the fee set forth in § 1.20(d).”

Additionally, by disclaiming claims 1–30 of the ’595 patent, Patent Owner does disclaim all challenged claims of the ’595 patent. Accordingly, we cannot institute an *inter partes* review of the ’595 patent. *See Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 (PTAB July 6, 2017) (precedential).

III. ORDER

For the reasons given, it is:

ORDERED that the Petition is *denied* as to all challenged claims of the ’595 patent and no trial is instituted.

IPR2023-00439
Patent 10,179,595 B2

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