

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

Inter Partes Review No. IPR2023-00460
Patent No. 10,737,709

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

Exhibit #	Description
2001	Disclaimer in Patent Under 37 C.F.R. 1.21(a), filed April 18, 2023, in U.S. Patent No. 10,737,709; 2 pages

I. INTRODUCTION

Patent Owner Metrom Rail, LLC (“Patent Owner”) submits this preliminary response to the Petition filed on January 9, 2023. (Paper No. 5 (“Petition”)) by Siemens Mobility, Inc., et al. (“Petitioners”) requesting *inter partes* review of claims 1-20 (the “Challenged Claims”) of U.S. Pat. No. 10,737,709 (the “709 Patent”).

II. PATENT OWNER’S STATUTORY DISCLAIMER UNDER 37 C.F.R. § 1.321(a)

While Patent Owner strongly disagrees with Petitioners’ contentions as set out in the Petition, Patent Owner has statutorily disclaimed claims 1-20 pursuant to 35 U.S.C. § 253(a) to conserve its resources as well as those of the Board, and to allow more efficient resolution of the parties’ remaining disputes in pending litigation between the parties, which do not relate to the 709 Patent. Patent Owner’s statutory disclaimer was effected in compliance with 37 C.F.R. § 1.321(a) by submission of an appropriate Form PTO/SB/43 (Disclaimer in Patent under 37 CFR 1.321(a)) on April 18, 2023, a copy of which is attached as Exhibit 2001.

The present statutory disclaimer does not constitute an admission or acquiescence by Patent Owner with regard to any contention in the Petition. Patent Owner therefore respectfully requests that the Board deny the Petition consistent with the Board’s binding precedent rather than construe the disclaimer as a request

for adverse judgment.

III. APPLICABLE LEGAL PRINCIPLES

Binding Board precedent precludes institution of a review proceeding where all challenged claims are disclaimed pre-institution. *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 at 2-3 (July 6, 2017) (precedential) (“Because all claims challenged by GE have been disclaimed under 35 U.S.C. § 253(a) in compliance with 37 C.F.R. § 1.321(a), no *inter partes* review is instituted in this proceeding.”); *see also* 37 C.F.R. § 42.107(e) (“No *inter partes* review will be instituted based on disclaimed claims.”); Consolidated Trial Practice Guide, November 2019 at 52 (“Where no challenged claims remain, the Board would terminate the proceeding.”).

Disclaimed claims are treated as if they never existed, and the Board cannot exercise jurisdiction over disclaimed claims at the pre-institution stage. *Pfizer, Inc. v. UniQure Biopharma B.V.*, IPR2020-00388, Paper 52 at 3 (Mar. 25, 2021) (citing 37 C.F.R. § 42.107(e); *Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-01248, Paper 7 at 2 n.1, 9–10 (Feb. 7, 2019)); *Gen. Elec. Co. v. United Techs.*, IPR2017-00491, Paper 9 at 2-3 (precedential); *see also* *Rekor Systems Inc. v. Vigilant Solutions, LLC*, IPR2020-01584, Paper 9 at 5-6 (Dec. 23, 2020); *Am.Honda Motor Co., Inc. v. Intellectual Ventures II LLC*, Case IPR2018-00350, Paper 12 at 4-5.

Here, Patent Owner disagrees with Petitioners’ arguments set forth in the

Petition and makes the present disclaimer without prejudice to Patent Owner's ability to rebut such arguments (including characterizing and distinguishing the prior-art references cited in the Petition) in any forum. Nevertheless, in the interest of judicial and economic efficiency, Patent Owner has filed the attached statutory disclaimer. Accordingly, the Board should deny the Petition consistent with the Board's binding precedent.

IV. CONCLUSION

Because "[n]o *inter partes* review will be instituted based on disclaimed claims," 37 C.F.R. § 42.107(e), and because all challenged claims of the 709 patent have been disclaimed, the Petition to institute *inter partes* review of claims 1-20 of the 709 patent should be denied.

Dated: April 19, 2023

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CERTIFICATE OF SERVICE

I hereby certify that the Patent Owner Preliminary Response to Petition for *Inter Partes* Review Pursuant to 35 U.S.C. § 42.107 in connection with *Inter Partes* Review Case IPR2023-00460 was served on this 19th day of April, 2023 by electronic mail to the following:

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned attorney for the Patent Owner declares that this Patent Owner Preliminary Response has a total of 535 words, according to Microsoft Word® word count tool, excluding the parts of the Response exempted by 37 C.F.R. § 42.24(a)(1).

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