

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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WESTINGHOUSE AIR BRAKE TECHNOLOGIES CORPORATION  
(d/b/a WABTEC CORPORATION),  
Petitioner,

v.

SIEMENS INDUSTRY, INC.,  
Patent Owner.

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Case IPR2017-00650  
Patent 7,742,850 B2

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Before KRISTEN L. DROESCH, MEREDITH C. PETRAVICK, and  
TIMOTHY J. GOODSON, *Administrative Patent Judges*.

GOODSON, *Administrative Patent Judge*.

DECISION  
Denying Request for Rehearing  
*37 C.F.R. § 42.71*

## I. INTRODUCTION

On August 18, 2017, Petitioner filed a Request for Rehearing (Paper 13, “Req. Reh’g”) of our Decision Denying Institution (Paper 12, “Dec.”), which denied institution of *inter partes* review of claims 1–14 of U.S. Patent No. 7,742,850 B2 (Ex. 1001, “the ’850 patent”).

For the reasons set forth below, the request for rehearing is *denied*.

## II. LEGAL STANDARD

Under the rules governing requests for rehearing on a decision whether to institute a trial, the decision is reviewed for an abuse of discretion. 37 C.F.R. § 42.71(c). “The burden of showing a decision should be modified lies with the party challenging the decision.” 37 C.F.R. § 42.71(d). Further, “[t]he request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

## III. ANALYSIS

Petitioner argues that rehearing should be granted for five reasons. We address each of the five arguments in turn.

First, Petitioner argues that we overlooked its evidence of a motivation to combine and improperly limited the motivation to combine analysis to the problem recited in the ’850 patent. Req. Reh’g 4–7. This argument misapprehends the analysis in the Decision Denying Institution. The Petition presented argument regarding motivation to combine Curtis and Collins at pages 34–39. In its arguments regarding other asserted grounds, the Petition refers back to this section for the motivation to combine Curtis and Collins. *See* Pet. 63, 74, 78.

In our Decision Denying Institution, we determined that Petitioner’s “asserted motivations do not provide a sufficient reason supported by rational underpinnings for combining the references in the claimed manner.” Dec. 13. We considered, and found unpersuasive, Petitioner’s argument that “[t]he similarity in architecture and capability would have motivated those of skill in the art to consider Curtis with Collins.” *See* Pet. 35; Dec. 13. We considered Petitioner’s arguments based on Rosencrance (*see* Pet. 35–37), but we found those arguments unpersuasive as well. *See* Dec. 13–15. Next, we considered Petitioner’s argument that combining certain elements of Curtis with certain features of Collins would yield a system that has the features of the claimed invention, but we found that argument also did not provide a sufficient reason to combine. *See* Pet. 38–39; Dec. 16. Addressing Petitioner’s final argument regarding motivation, we stated as follows:

Finally, Petitioner argues that “[i]t was known that a need existed to track EOT units, and to know where the last car of a train is located. The combined disclosure of *Curtis* and *Collins* teach a system that is capable of solving the problem addressed in the ’850 Patent.” Pet. 39 (citing Ex. 1002 ¶ 107). Petitioner’s analysis suggests improper hindsight because it begins with the problem addressed in the ’850 patent and considers whether the combined references are capable of solving that problem. Yet “an invention can often be the recognition of a problem itself.” *Leo Pharmaceutical Prods., Ltd. v. Rea*, 726 F.3d 1346, 1353 (Fed. Cir. 2013) (citing *Cardiac Pacemakers, Inc. v. St. Jude Med., Inc.*, 381 F.3d 1371, 1377 (Fed. Cir. 2004)). Here, as summarized above, the problem addressed by the ’850 patent is locating EOT units that have been removed from cars and left on the wayside for later collection. *See* Ex. 1001, 1:43–56. Petitioner does not point to, and we do not find, any recognition in the cited references of this particular problem. Further, Patent Owner argues, plausibly, that the proposed combination could

not solve this problem because Collins's wayside monitoring station eavesdrops on communications between EOT and HOT, such that the monitoring station would be unable to locate an EOT unit that is not communicatively linked with an HOT. Prelim. Resp. 27 (Ex. 1006 ¶ 41).

Dec. 16–17.

As indicated in this summary, the Decision Denying Institution did not overlook Petitioner's arguments regarding motivation to combine, as Petitioner contends in the Request for Rehearing. *See* Req. Reh'g 6. Further, the Decision Denying Institution did not "limit[ the] motivation to combine inquiry to the specific problem faced by the inventors of the '850 Patent" nor did it "require Petitioner to find the particular problem of the '850 Patent recited in the prior art references," as contended in the Request for Rehearing. *Id.* at 6, 7. Rather, the Decision Denying Institution pointed out that Petitioner's final argument regarding motivation was suggestive of hindsight because it began with the problem that the '850 patent purported to solve and then considered whether the combined references were capable of solving that problem. *Id.* at 16–17. Reliance on the disclosure of the patent being challenged for an obviousness argument is an indication of improper hindsight. "The inventor's own path itself never leads to a conclusion of obviousness; that is hindsight." *Otsuka Pharm. Co. v. Sandoz, Inc.*, 678 F.3d 1280, 1296 (Fed. Cir. 2012).

Petitioner's second argument for rehearing is that we overlooked the declaration of Petitioner's expert, Mr. Steven Ditmeyer. *Id.* at 7–9. We disagree. We noted Petitioner's reliance on Mr. Ditmeyer's declaration in discussing Petitioner's asserted motivations. *See* Dec. 13, 16. And as summarized above, we explained why the motivation arguments Petitioner presented, including the arguments relying on Mr. Ditmeyer's testimony for

support, were unpersuasive in demonstrating a reason to combine the references in the claimed manner. *See id.* at 12–17. That we found Petitioner’s motivation arguments insufficient does not mean that we overlooked or “cast[] aside [Mr. Ditmeyer’s] opinion as if it had not been submitted at all,” as Petitioner contends. Req. Reh’g. 8.

Third, Petitioner contends that we overlooked evidence of motivation to combine Curtis and Collins provided in Rosencrance. *Id.* at 9–12. In the Petition, Petitioner argued that Rosencrance demonstrates that incorporating GPS into train cars for tracking purposes was known, and that because railcars can be separated from locomotives, it is better to incorporate tracking technology on railcars. Pet. 35 (citing Ex. 1007, 24). Because incorporating GPS into EOT units provides greater accuracy in EOT unit monitoring, Petitioner contended that a motivation exists for combining GPS messages between the EOT and HOT (as in Curtis) with monitoring stations (as in Collins). *Id.* at 36 (citing Ex. 1002 ¶ 105). In our Decision Denying Institution, we determined that Petitioner’s analysis did not sufficiently explain why Rosencrance would have motivated one with ordinary skill in the art to combine Curtis and Collins in the claimed manner:

Rosencrance describes that GPS systems being developed for monitoring railcars were viewed as alternative, competing technologies to existing AEI systems in which tags on railcars and locomotives send information to AEI readers placed at major railroad intersections. *See* Ex. 1007, 24. Collins’s network connecting wayside monitoring unit 1 and central station 16 appears to be an example of an AEI system such as Rosencrance refers to insofar as it is a land-based network in which wayside monitoring unit 1 is positioned proximate to railroad tracks, preferably “along a heavily traveled corridor to detect signals emitted by EOT 204 passing nearby.” Ex. 1006 ¶¶ 58–59, Fig. 4.

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