

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WESTINGHOUSE AIR BRAKE TECHNOLOGIES CORPORATION,
Petitioner,

v.

SIEMENS MOBILITY, INC.,
Patent Owner.

Case IPR2017-01263
Patent 6,996,461 B2

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

GOODSON, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

The Petition in this case asserted three proposed grounds of unpatentability:

| | References | Basis | Claims Challenged |
|----|--|-------|---|
| 1. | Petit ¹ and Blesener ² | § 103 | 1, 4–6, 14, 16, 17, 19, 28, 32, 35, 42–44, and 48 |
| 2. | RSAC ³ and Blesener | § 103 | 1, 4–6, 14, 16, 17, 19, 28, 32, 35, 42–44, and 48 |
| 3. | RSAC, Blesener, and Petit | § 103 | 1, 4–6, 14, 16, 17, 19, 28, 32, 35, 42–44, and 48 |

See Paper 2, 11.

In our initial Decision on Institution, we determined that Petitioner demonstrated a reasonable likelihood of prevailing in its challenge to claims 1, 4, 14, 16, 19, 28, 42–44, and 44 based on the combination of RSAC, Blesener, and Petit. Paper 10, 24–35. We further determined that Petitioner had not demonstrated a reasonable likelihood of prevailing as to the other claims challenged in Ground 3, or as to the challenges in Grounds 1 and 2. *Id.* at 15–35. In accordance with the Board’s practice at that time, we instituted an *inter partes* review only as to claims 1, 4, 14, 16, 19, 28, 42–44, and 44 based on the combination of Ground 3. *Id.* at 35. Subsequently, pursuant to the holding in *SAS Inst., Inc. v. Iancu*, 2018 WL 1914661, at *10 (U.S. Apr. 24, 2018), we modified our institution decision to institute on all

¹ U.S. Patent No. 5,092,544, issued Mar. 3, 1992, Ex. 1008.

² Int’l Pub. No. WO 02/091013 A2, published Nov. 14, 2002, Ex. 1007.

³ Railroad Safety Advisory Committee, *Implementation of Positive Train Control Systems*, Ex. 1005.

of the challenged claims and all of the grounds presented in the Petition. Paper 21, 2. We also authorized supplemental briefing to permit the parties to address the additional grounds. Paper 23, 3–6.

In Petitioner’s Reply, Petitioner argued that the Board correctly denied institution on Ground 2. Paper 33, 34–36. At the hearing on August 17, 2018, Patent Owner indicated that the Board could permissibly treat Ground 2 as abandoned in view of Petitioner’s Reply.⁴ Petitioner initially stated that it was not abandoning Ground 2, but during the rebuttal portion of its argument, Petitioner indicated that it would be willing to stipulate to a withdrawal of Ground 2 from the Petition.

We authorize the parties to file a Joint Motion to Limit the Petition to withdraw Ground 2 from consideration. In view of the advanced stage of this proceeding, the Joint Motion must be filed by within five business days of the entry date of this Order. In the absence of a Joint Motion by the specified deadline, the panel will proceed to issue a Final Decision with respect to all grounds.

In consideration of the foregoing, it is hereby:

ORDERED that the parties are authorized to file a Joint Motion to Limit the Petition within five business days of the entry date of this Order.

⁴ The transcript for the hearing is not yet available. The summary in this Order of the parties’ statements during the hearing is based on the panel’s recollection.

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