



Safet Metjahic

Partner

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Safet Metjahic, a partner in Ice Miller's Intellectual Property Practice Group, is a skilled advisor and practitioner who delivers innovative legal solutions to clients ranging from technology start-ups to industry leaders, including established Fortune 100 companies. He routinely advises and guides clients in bet-the-company matters and in navigating, managing and mitigating intellectual property (IP) and commercial technology-related risks and opportunities. He applies lessons learned from his many years of litigation experience in private practice and more than 16 years of service at the U.S. Patent and Trademark Office (USPTO) as a patent examiner, master-level primary examiner and supervisory patent examiner in multiple industry sectors.

Safet focuses his practice on working with clients at all stages of the business cycle to develop, protect, manage, commercialize and, when needed, enforce or defend intellectual property rights. His practice includes developing filing strategies and drafting, prosecuting, enforcing and defending intellectual property assets (including patents, copyrights, trademarks and trade secrets) in a wide range of industries and technologies. Safet performs patent infringement, validity and enforceability investigations as part of investment, acquisition, venture and technology clearance studies. He also performs due diligence investigations of IP assets to evaluate and assess intellectual property protection and defense postures and how best to leverage or monetize intellectual property assets.

Safet is experienced in negotiating and preparing commercial agreements involving complex technologies and supply/delivery chains. He routinely negotiates and drafts a wide range of technology-related agreements, including licensing, collaboration, joint-development, partnership, purchase/sale, manufacturing, services and complex supply chain agreements.

Prior to entering private practice, Safet accrued more than 16 years of experience at the USPTO, including ten years as a supervisory patent examiner, where he trained and supervised patent examiners in a variety of technologies. Safet was the examiner on 2,777 granted U.S. patents, covering classes of technologies such as measuring & testing (Classes 73 and 324), television (Class 348), image projectors and lithography (Class 353), optics (Classes 356 and 359), facsimile and static presentation processing (Class 358), multiplex communications (Class 370), pulse or digital communication (Class 375), telephonic communications (Class 379), cryptography (Class 380), telecommunications (Class 455), and data processing (Class 707),

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among others. During his tenure, he also trained and led teams of patent examiners in the handling of all aspects of post-grant reexamination.

Education

- The City College of New York (B.E., 1989)
 - Electrical Engineering
- Syracuse University, Maxwell School of Business (2000)
 - Certificate in Public Management
- American University Washington College of Law (J.D., 2004)

Admissions

- District of Columbia
- New York
- United States District Court - Eastern District of New York
- United States District Court - Northern District of New York
- United States District Court - Southern District of New York
- United States District Court - Western District of New York
- United States Patent and Trademark Office

Professional Affiliations

- Chair, IEEE North Jersey Legal Affairs Committee
- American Intellectual Property Association (AIPAA)
- International Association of Engineers (IAE)

Awards & Honors

- Bronze Medal for Superior Federal Service, U.S. Patent and Trademark Office
- U.S. Patent and Trademark Office Master Level in Television Technologies

Key Matters

Reported and Representative Cases

- *Trudell Medical International v. PARI Respiratory Equipment, Inc., et al.*, (Nebulizer Devices)
- *WIAV Solutions LLC v. PALM, Inc., et al.* (Cellular Telephone Devices)
- *Illinois Tool Works Inc. d/b/a CFC International Corp. v. Waytek Corp.* (Laminate Products and Processes therefor)
- *Siemens Medical Solutions USA, Inc. v. EP MedSystems, Inc.* (Ultrasound Catheters)
- *Disa Industries A/S v. Thyssenkrupp Waupaca, Inc.* (Sand Molding Machines)
- *Enpat, Inc. v. Siemens Energy & Automation, Inc.*, (Active Front End Controller for AC-DC Conversion)

Representative Transactions

- Freedom to Operate, Validity, Infringement and Enforceability Studies and Opinions in: aircraft systems and technologies; automotive components; building structures and components; business methods; camera systems and technologies; catheter systems and technologies; computer display technologies; computer input/output devices and technologies; database and file management systems; endoscope systems; gaming systems and technologies; graphic user interface systems and methodologies; medical systems and devices; microprocessor technologies; oil and gas systems and methodologies; telecommunications; television; unmanned aerial vehicle (UAV) launchers; unmanned vehicles (including aerial, land and sea); waste management systems and methodologies.

Success Stories

USPTO Director Squires De-institutes IPR After Post-Institution Patent Claim Disclaimer

U.S. Patent and Trademark Office Director John Squires [vacated institution of inter partes review proceeding IPR2025-01047 on Tuesday](#), finding that efficiency considerations prevailed after patent owner National Steel Car Limited disclaimed one independent claim, that formed the basis of the Patent Trial and Appeal Board (PTAB) institution decision, as well as the claims depending from the disclaimed independent claim. Five independent claims and their dependent claims remain in the patent and are being asserted in a corresponding infringement action in the District of Delaware.

The Legal Basis: Disclaimed Claims Are Treated as If They Never Existed

The order noted that under Federal Circuit precedent, once claims are disclaimed, *“the patent is viewed as though the disclaimed claims had never existed in the patent.”* *“Under these circumstances,”* Squires wrote, *“maintaining this IPR is an inefficient use of Office resources.”* The order therefore vacated the institution decision and denied institution.

Why This Decision Matters: Post-Institution Disclaimer as a De-Institution Tool

Prior to Tuesday’s decision, post-institution disclaimer had not been viewed as an effective tool for obtaining de-institution of an IPR. The Director’s order shows that under his leadership, post-institution disclaimer will be considered as part of discretionary considerations and opens up a new avenue for patent owners.

Background: PTAB Institution & the Delaware Infringement Action

In December 2025, the PTAB found a reasonable likelihood that petitioner FreightCar America, Inc. would prevail regarding independent claim 24 in U.S. Patent No. 8,132,515. However, the PTAB “questioned whether” or stated that FreightCar America “does not appear to show” unpatentability for the other challenged independent claims (claims 1, 7, 18, 20, and 32) and related dependent claims.

After institution, FreightCar America requested a stay of proceedings in the corresponding Delaware infringement action. That stay was denied in March, citing the institution decision and characterizing the PTAB’s comments as a *“strong hint”* and finding that there was *“a rare situation where in granting review . . . the PTAB seemed to go out of its way to communicate that aside from one asserted claim . . . the PTAB did not think there was a reasonable likelihood that the remainder of the patent’s claims would ultimately be found invalid.”*

National Steel Car Counsel Comments on Decision

[Robert Keeler](#), Ice Miller counsel for National Steel Car in the IPR and corresponding district court litigation, commented *“this is a very positive development for patent owners. National Steel Car believed in the patentability of all its claims and so the decision to disclaim any claims was not made lightly. Ultimately, however, that decision was made to help ensure the infringement case moved forward. Not only was the disclaimer critical to the de-institution of the IPR, it also factored into the District Court decision not to stay the infringement action.”*

Patents & Cases at Issue

The patent at issue in district court and at the PTAB are:

- U.S. Patent No. 8,132,515, which is the subject of IPR2025-01047 at the PTAB;
- U.S. Patent No. 8,166,892, which is the subject of IPR2025-01046 at the PTAB.

Counsel of Record

National Steel Car is represented at the PTAB and in the district court case by [Robert Keeler](#), [Safet Metjahic](#), [Ken Sheehan](#), and [Kevin Adams](#) of Ice Miller LLP. National Steel Car is also represented by Andrew Russell, Emily DiBenedetto, and Lindsey Gellar of Shaw Keller LLP in the district court case.

FreightCar America is represented at the PTAB by Philip Nelson, Ted Cannon, and Justin Gillett of Knobbe Martens Olson & Bear. FreightCar America is represented in the district court by Brian Horne, Sean Murray, and Justin Gillett of Knobbe Martens Olson & Bear, and by John C. Phillips, Jr. and David Bilson of Phillips, McLaughlin & Hall, P.A.

The cases are *FreightCar America, Inc. v. National Steel Car Limited*, case number IPR2025-01047, at the Patent Trial and Appeal Board, and *National Steel Car Limited v. FreightCar America, Inc. et al.*, case number 1:24-cv-00594, in the U.S. District Court for the District of Delaware.

[Contact our team.](#)

Ice Miller Supports Client on “Colossal” Biosciences Advancement

A recent scientific breakthrough by an Ice Miller client has garnered headlines and captured the public’s imagination. Colossal Biosciences (Colossal), the world’s first de-extinction company, based in Texas, has pushed science a giant step forward through their success in creating a global-first iPSC (induced pluripotent stem cells) from Asian elephant, the closest living cousin of the now extinct woolly mammoth. These iPSC cells can be edited to give mammoth-like traits and allow for the creation of eggs, sperm, and embryos that could then be implanted into an artificial womb to generate an animal. This iPSC advancement could also ultimately help scientists understand Asian elephant’s resistance to cancer and could provide deeper insight into the biology of the pachyderm—with a goal of one day creating a species resembling the woolly mammoth.

Founded in 2021, Colossal is primarily focused on conservation efforts and de-extinction, a process of gene engineering technology that rebuilds and reintroduces the DNA of extinct animals once inhabiting the earth. Through this work, Colossal is heavily involved in environmental research and sustainability, driven toward reintroducing and reinvigorating a lost ancestry and climate into our biosphere.

Ice Miller’s equally dedicated team has supported Colossal with its patent prosecution and counseling work since 2022, including filing patent applications for technologies leading to the iPSC breakthrough.

Ice Miller Partner [TaeSoo Sean Kim](#) spearheads the Life Sciences Patent Prosecution and IP Licensing team that represents Colossal, with Partner [Fabian Koenigbauer](#) and Senior Patent Agent [Andrew Baraniak](#) serving as co-leads on the efforts. The client team is further supported by [Weihong Hsing](#), [Safet Metjahic](#), [Jacqueline Lesser](#), and [Michael Graham](#).

Ice Miller Represents EVE Energy in a \$3B Joint Venture for Battery Cell Production in the U.S.

Ice Miller is representing EVE Energy Co., Ltd. (EVE), a global lithium battery company, in a joint venture with Accelera by Cummins, Daimler Truck and PACCAR to build a manufacturing plant in the United States, which is expected to have a range of \$2 to \$3 billion in total investment. This strategic joint venture will manufacture battery cells for commercial vehicles to help transition into clean energy.

Ice Miller Business Group partners Sean Kim and Edward Braum represent EVE as external counsel, with Sean as lead counsel responsible for overseeing the structuring and negotiation of the transaction. The deal team also includes Simone Park, Huidi Shu, Cody Laska, Josh Borean, Daniel Corsaro, Safet Metjahic, Ming He, Anthony Aaron, Dale Stackhouse, Grace Dahm, John Pence, and Mike Flint.

The location of the manufacturing plant is to be determined.

Thought Leadership

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