

UNITED STATES INTERNATIONAL TRADE COMMISSION
WASHINGTON, D.C. 20436

Before The Honorable David P. Shaw
Administrative Law Judge

In the Matter of

CERTAIN HYBRID ELECTRIC
VEHICLES AND COMPONENTS
THEREOF

Investigation No. 337-TA-1042

**COMPLAINANTS' MOTION FOR LEAVE TO FILE A REPLY
BRIEF IN SUPPORT OF COMPLAINANTS' MOTION FOR
SUMMARY DETERMINATION OF ESTOPPEL**

Complainants Paice LLC and Abell Foundation seek leave from the Administrative Law Judge to file the attached Reply In Support of Complainants' Motion for Summary Determination of Estoppel (Mtn. Dkt. No. 1042-034). A copy of Complainants' proposed reply is attached hereto as Exhibit A. Good cause exists to grant this motion in order to allow Complainants to respond to Respondent's arguments that the estoppel provision of 35 U.S.C. § 315(e) does not apply.

Ground Rule 5.e Certification

In accordance with Ground Rule 5.e, Complainants certify that they made reasonable, good-faith efforts to resolve the issues raised in this motion with counsel for Respondent at least two business days before filing the instant motion, on September 20, 2017. Counsel for Respondent did not indicate whether or not Respondent would oppose this motion.

Respectfully submitted,

Dated: September 22, 2017

FISH & RICHARDSON P.C.

By: /s/ Brian J. Livedalen

Ruffin B. Cordell

Indranil Mukerji

Ahmed J. Davis

Ralph A. Phillips

Thomas S. Fusco

Brian J. Livedalen

Daniel A. Tishman

Laura C. Whitworth

FISH & RICHARDSON P.C.

901 15th Street NW, 7th Floor

Washington, D.C. 20005

Telephone: (202) 783-5070

Facsimile: (202) 783-2331

*Counsel for Complainants Paice LLC and
Abell Foundation, Inc.*

EXHIBIT A

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**COMPLAINANTS' REPLY TO FORD'S
OPPOSITION TO COMPLAINANTS' MOTION FOR
SUMMARY DETERMINATION OF ESTOPPEL (MTN. DKT. NO. 1042-034)**

Ford's opposition impermissibly deviates from the estoppel provision that applies at the issuance of a final written decision by the PTAB. Ford's arguments are based on common law estoppel, which encompasses a different standard for estoppel. Ford chose to litigate validity at the PTAB and cannot now escape the "strengthened estoppel standard" enacted in the America Invents Act. *See* 157 Cong. Rec. S952 (daily ed. Feb. 28, 2011) (statement of Sen. Grassley).

Ford does not dispute the facts presented in Complainants' initial brief—the PTAB has issued final written decisions on Ford's *inter partes* review petitions challenging claims that Ford seeks to challenge again using the same art (or other art that Ford knew about when it filed its petitions) now before the ITC. This issue is ripe for summary determination. Under the plain meaning of the estoppel provision, Ford is barred from bringing a second invalidity challenge on these grounds for claims 24 and 28 of the '347 patent; claim 3 of the '388 patent; and claims 25, 240, 278, 290, and 292 of the '634 patent. These serial challenges are the exact type of litigation tactic Congress intended to eliminate in implementing post-grant procedures.

ARGUMENT

Ford's attacks on the validity of Complainants' patents are simply a repetition or repackaging of references that Ford already brought before the PTAB. Ford chose to litigate the validity of these claims before the PTAB and cannot ignore the consequences of its litigation strategy. Section 315 provides a clear and unequivocal bar on invalidity challenges based on grounds brought before the PTAB or grounds Ford reasonably could have brought based on references already at its disposal in one or more of the twenty-five petitions filed against Complainants' patents.

A. Ford Ignores the Basic Language of the Estoppel Provision

Ford argues that estoppel is inapplicable where the outcome of an IPR is adverse to the patent holder, and/or where the ultimate outcome remains uncertain due to pending appeal or remand. *See* Respondent's Opp. to Complainants' MSD of Estoppel ("Respondents' Opp.") at Section III(A), (B), and (D). The outcome and/or finality of the final written decision is, however, irrelevant to the application of the estoppel provision of section 315(e). The statute does not contemplate and is completely silent as to the *result* of the *inter partes* review. Section 315(e)(2) clearly states the key event for estoppel to apply is a final written decision.

35 U.S.C. § 315(e)(2) provides:

The petitioner in an *inter partes* review of a claim in a patent under this chapter ***that results in a final written decision*** under section 318(a), or the real party in interest or privy of the petitioner, may not assert either in a civil action arising in whole or in part under section 1338 of title 28 or in a proceeding before the International Trade Commission under section 337 of the Tariff Act of 1930 that the claim is invalid on any ground that the petitioner raised or reasonably could have raised during that *inter partes* review.

(emphasis added). There is no mention of the outcome of the review as a triggering requirement for estoppel to apply. Indeed, the only requirement under the statute is the issuance of a final

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