UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FORD MOTOR COMPANY
Petitioner

v.

PAICE LLC & ABELL FOUNDATION, INC.
Patent Owner

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Case IPR2014-00570
Patent No. 8,214,097

REQUEST FOR REHEARING OF NON-INSTITUTED GROUNDS

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I. INTRODUCTION

Ford thanks the Board for instituting trial on ground 6 (Severinsky '970 in view of Anderson), but for claim 38, ground 7 (Severinsky '970 in view of Anderson and Yamaguchi), and ground 8 (Severinsky '970 in view of Anderson, Yamaguchi, and Katsuno). However, Ford respectfully requests rehearing of the decision to not institute trial on ground 2 (Caraceni), ground 3 (Caraceni in view of Boberg), ground 4 (Caraceni in view of Boberg and Yamaguchi), or ground 5 (Caraceni in view of Boberg, Yamaguchi, and Katsuno) based on Ford's alleged failure to "… articulate reasonably how the implicit teaching of a stoichiometric ratio by Caraceni and Boberg is meaningfully distinctive from the express teaching of this same limitation by Severinsky and Anderson." Decision, paper 10, p. 11.

II. THE DECISION TO NOT CONSIDER GROUNDS 2–5 DURING THE TRIAL CONSTITUTES AN ABUSE OF DISCRETION UNDER 37 C.F.R. § 42.108

An abuse of discretion exists if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *Arnold Partnership v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004). In this request for rehearing, the relevant factors include whether the non-instituted grounds are indeed redundant, as well as the requirement for a just, speedy, and inexpensive trial. 37 C.F.R. § 42.1(b); *see also*, § 42.208(a).

A. 35 U.S.C. § 314(a) requires that the Board consider all proposed grounds when the petition presents a reasonable likelihood of prevailing as to at least one claim

The petition presented a reasonable likelihood of prevailing as to claims 30, 31, 35, 36, and 39. Accordingly, Ford met the threshold requirements for instituting review of all challenged claims based on all grounds.

Ford understands that the Board must consider "the economy, the integrity of the patent system, the efficient administration of the Office, and the ability of the Office to timely complete proceedings instituted." 35 U.S.C. § 316(b). Per this requirement, refusing to review the '097 patent based on all grounds is inefficient because the patent owner, Ford, and the district court may need to consider these same grounds again, without the just, speedy, and inexpensive results allowed by *inter partes* review. The Board should therefore review claims 30, 31, 35, 36, and 39, based on all proposed grounds in the interest of efficient administration of the patent system.

B. The Board misinterpreted or overlooked the teachings of Caraceni when deciding that Caraceni was not "meaningfully distinctive" from the teachings of Severinsky '970 in combination with Anderson

The petition demonstrated that Caraceni was not redundant of Severinsky '970 and Anderson because it presents different information in a different way than the combination of Severinsky '970 and Anderson. Petition, paper 1, pp. 36–37 and 58–60. Accordingly, Caraceni alone or in combination with Boberg is not

redundant of Severinsky '970 and Anderson, and Caraceni is thus meaningfully distinct from Severinsky '970 and Anderson. *Liberty Mutual Ins. Co. v. Progressive Casualty Ins. Co.*, CBM2012-00003, Paper No. 7 at 2. The decision misinterpreted or overlooked these teachings. Accordingly, the finding that "Ford … does not articulate reasonably how the implicit teaching of a stoichiometric ratio by Caraceni and Boberg is meaningfully distinctive from the express teaching of this same limitation by Severinsky and Anderson" is not supported by substantial evidence. Decision, paper 10, p. 11.

C. Failure to institute trial on grounds 2–5 is unjust

Ford is cognizant of the burden on the Board to speedily resolve many more review petitions than expected. Accordingly, Ford does not request rehearing of every non-instituted ground. Ford only requests rehearing of non-instituted grounds 2–5, and whether the decision not to institute these grounds was "just." 37 C.F.R. § 42.1(b).

It would be unjust to simply institute trial on grounds 6–8 when Ford has specifically identified non-redundant teachings in the prior art in connection with grounds 2–5, and explained why those teachings are neither redundant as applied to particular limitations of the claims, nor redundant of grounds 6–8. Petition, paper 1, pp. 58–60.

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