

PUBLIC – REDACTED VERSION

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 & THE ABELL FOUNDATION, INC.  
Patent Owner

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Case IPR2014-00571  
Patent 7,104,347

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**Patent Owner's Preliminary Response to  
Petition for *Inter Partes* Review of U.S. Patent  
No. 7,104,347**

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**TABLE OF AUTHORITIES**

**CASES**

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**OTHER**

*Inter Partes Review*, Inter Partes Disputes (last visited July 11, 2014),  
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Patent Owner Preliminary Response

Case IPR2014-00571  
Attorney Docket No: 36351-00111P1

**EXHIBITS**

<b>Exhibit Number</b>	<b>Exhibit Name</b>
2001	Arbitration Agreement between Paice LLC and Ford Motor Company

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