

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 Owners.

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Case IPR2014-00579  
Patent 7,104,347

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**PATENT OWNER'S REPLY IN SUPPORT OF ITS  
MOTION TO EXCLUDE**

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## I. INTRODUCTION

Ford cannot dispute that its reply contains new evidence that is necessary to make out a prima facie case of unpatentability. Thus, Ford in its opposition resorts to an array of tangential arguments designed to distract from the merits of Paice’s motion. As Ford has failed to justify the inclusion of new evidence in its reply, Paice respectfully requests the exclusion of Ford’s improper reply evidence.

## II. FORD’S REPLY EVIDENCE IS OUTSIDE THE SCOPE OF FORD’S PETITION

Ford’s argument that its reply evidence was submitted in response to Paice’s Patent Owner’s Response fails to rebut Paice’s principle complaint—that Ford submitted new evidence that is necessary to make out a prima facie case of unpatentability. The Trial Practice Guide makes clear that “[t]he submission of new evidence that (i) is necessary to make out a prima facie case of unpatentability” indicates that “a new issue has been improperly raised in the reply.” Office Patent Trial Practice Guide, 77 Fed. Reg. 157, 48767 (Aug. 14, 2012). Ford tellingly does not contend that it made out a prima facie case of unpatentability in its petition.

Ford’s own characterization of its petition reveals the inadequacy of its original invalidity assertion. Ford claims that it argued in the first instance that “the Bumby references’ 216 Volt “*battery*” *could be* connected to and provide current to the disclosed “starter motor” (*i.e.* the claimed “*first electric motor*”).

(Petition 34-35; Ex. 1108 at ¶¶259-265.)” Opposition at 3 (emphasis added). But Ford is certainly aware that establishing that the 216 Volt “battery” *could be* connected to and provide current to the starter motor is not adequate to demonstrate a prima facie case of obviousness. Moreover, Ford’s above citation to pages 34-35 of its petition only confirms that Ford presented no evidence or argument in its petition that the Bumby references disclose providing current from the battery to the conventional starter motor or that such a configuration would be obvious. Such arguments are absent from the pages on which Ford relies.

Other key omissions show that Ford failed to present a prima facie case of obviousness in the first instance. For example, Ford does not dispute that Dr. Davis’s argument that it was obvious to connect generic motors to generic power sources was purely conclusory and did not address why it would be obvious to connect the 12 volt conventional starter motor in the Bumby references to the high voltage (216 volt) hybrid traction battery. Instead, Ford offers up an excuse—that it could not anticipate the arguments made in Paice’s Patent Owner’s Response. Such an argument is a red herring and should be ignored. Paice merely identified holes in Dr. Davis’s opinion that were the natural result of Dr. Davis’s superficial analysis, which failed to consider the details of the specific conventional starter motor and high voltage battery.

That Paice pointed out the deficiencies noted above in its Patent Owner's Response should not give Ford carte blanche to throw in new evidence and arguments by way of a reply declaration that fall clearly outside the scope of Ford's original petition and accompanying declaration. To allow Ford to shoehorn such belated evidence into the record by way of a reply declaration would substantially prejudice Paice. Paice cannot respond to these new arguments and is effectively left helpless to defend against arguments that Ford should have made in the first instance. Ford should not be rewarded for using Paice's Patent Owner Response as a roadmap to fill in the very holes that Paice pointed out.

### **III. PAICE'S MOTION IS PROCEDURALLY PROPER**

Paice's instant motion to exclude is proper and conforms to both the Board's rules and Trial Practice Guide. The Trial Practice Guide states, "[a] party wishing to challenge the admissibility of evidence must object timely to the evidence at the point it is offered and then preserve the objection by filing a motion to exclude the evidence." Office Patent Trial Practice Guide, 77 Fed. Reg. 157, 48767 (Aug. 14, 2012) (citing 37 C.F.R. § 42.64(a), (b)(1), and (c)). Paice did just that. Paice objected to the evidence at issue as "outside the permitted scope of the reply" (Ex. 2113 at 2) and filed the instant motion to preserve its objection. The Board rules explicitly recognize that i) replies cannot introduce new evidence and new arguments per 37 C.F.R. § 42.23 and that ii) evidence submitted via a reply in

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