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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U.S. Patent No. 7,104,347 to Severinsky et al.

IPR Case No.: IPR2014-00884

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**PETITIONER'S RESPONSE TO PATENT OWNER'S
MOTION FOR OBSERVATIONS ON CROSS EXAMINATION**

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I. Patent Owner's motion for observation is improper and should be dismissed

A "motion for observation on cross-examination is a mechanism to draw the Board's attention to relevant cross-examination testimony of a reply witness." *Medtronic Inc. v. Nuvasive, Inc.*, IPR2013-00506, Paper 31 at 3. The Board has been clear that the observations must be nothing more than a "concise statement of the relevance of precisely identified testimony to a precisely identified argument or portion of an exhibit." *Medtronic, Inc. v. Nuvasive, Inc.*, IPR2013-00506, Paper 37 at 2. Observations are not allowed to include arguments, and are not "an opportunity to raise new issues, to re-argue issues, or to pursue objections." PTAB Trial Practice Guide, 77 F.R. 157, 48768 §L; IPR2013-00506, Paper 37 at 2. If even one observation is found to have violated these rules, the Board may dismiss and not consider the Patent Owner's entire motion for observation. *See* IPR2013-00506, Paper 37 at 2-4 ("the entire motion… may be dismissed and not considered if there is even one excessively long or argumentative observation"); *see also* CBM2013-00017, Paper 36 at 4.

On June 10, 2015, Patent Owner filed its Motion for Observations on Cross Examination of Dr. Gregory Davis. (Paper No. 29.) Petitioner believes that one or more of the Patent Owner's observations are improper as they are argumentative, include new issues not previously raised, and/or re-argue prior issues and pursue objections. Accordingly, Petitioner requests that the Board deny Patent Owner's

motion.

II.   Response To Patent Owner's Observations

Notwithstanding the above general objections, Petitioner respectfully submits the following responses.

Observation 1.   This observation improperly cites portions from over 15 pages of Dr. Davis' deposition testimony and is therefore not a "concise statement of the relevance of precisely identified testimony to a precisely identified argument." (IPR2013-00506, Paper 37 at 2-4.) Dr. Davis' deposition testimony is also not relevant because Dr. Davis' initial testimony was in response to Paice's question regarding the legal "understanding of the doctrine of inherency." (Ex. 2212 at 153:14-15) In contrast, Dr. Davis' reply testimony states that he was not "trying to attach any legal type of legal significance" to the word "inherent," but was using the word "inherent" according to his "non-legal definition." (Ex. 2217 at 11:16-12:5, 17:12-18:3; *see* also Ex. 1248 (Davis Reply Declaration) at ¶¶6-7.)

Observation 2.   Dr. Davis' deposition testimony is not relevant because it does not show that his reply testimony is "relying on the alleged possible. . . rather than the actual disclosure of Caraceni." Observation 2 selectively cites only the first sentence, but Dr. Davis full reply testimony states that a POSA would have understood an engine performance map (efficiency map) would have existed and been used by Caraceni. (Ex. 2217 28:9-29:5.) Dr. Davis also disagreed with Paice

that "Caraceni . . . does not disclose that an engine performance map stores calibration data within the vehicle controller for determining torque values where the engine should not be operated." (Ex. 2217 at 29:11-30:1, *see also* 31:19-34:16.) In response to Paice's question whether Caraceni "explicitly discloses the engine performance map," Dr. Davis testified that a POSA would understand "that's the only way to make those decisions about where those torque levels are so you know where to operate the engine and how much torque you want the engine to provide." (Ex. 2217 at 37:14-38:25.)

Observation 3. Dr. Davis' testimony is not relevant because it does not show his opinions are conclusory and unsupported by the evidence. Dr. Davis testified: "There's support throughout, as I've kind of pointed to bits and pieces here and there where they're talking about minimizing fuel consumption, minimizing emissions, achieving the highest fuel economy." (Ex. 2217 at 39:10-17; *see also* Ex. 1248 at ¶¶8-17.) Dr. Davis also testified that a POSA would understand "when reading the [Caraceni] reference as a whole. . . that they're using the engine fuel performance map in order to base their decisions about when and how to operate the engine." (Ex. 2217 at 40:19-25; *see* also 37:14-38:25.)

Observation 4. Dr. Davis' complete Reply Declaration does not contradict his reply testimony. Dr. Davis' Reply Declaration explains that Caraceni "will first try to recharge the batteries by entering the 'recharge mode'. . . [and] if

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