

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MERCEDES-BENZ USA, LLC  
And MERCEDES-BENZ U.S. INTERNATIONAL INC.  
Petitioner,

v.

VELOCITY PATENT, LLC,  
Patent Owner.

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Case IPR2014-01247  
Patent 5,954,781

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**PATENT OWNER'S PRELIMINARY RESPONSE**

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## PRELIMINARY RESPONSE

Petitioner Mercedes-Benz USA, LLC and Mercedes-Benz U.S. International, Inc. (“Petitioners”) have petitioned for *inter partes* review of independent claim 31 and its dependent claim 32 of U.S. Patent No. 5,954,781 (“the ‘781 patent”) (“the Petition”). Velocity Patent, LLC (the “Patent Owner”) submits that the Petition must be denied as a matter of law. Prior to the submission of the Petition, the United States Patent and Trademark Office initiated *ex parte* reexamination of, *inter alia*, Claims 31 and 32 of the ‘781 patent (Control No. 90/013,252). On [Insert Date], in response to an Office Action, the Patent Owner amended independent claim 31 and, by virtue of its dependency, claim 32. (Ex. 1.) Accordingly, the claims challenged by Petitioners no longer exist, rendering the requested *inter partes* review impermissible. *See Juniper Networks, Inc. v. Linex Technologies, Inc.*, Case IPR 2014-00595, Paper 19 (September 26, 2014) (“Because [the] claims ... of the [] patent, as challenged in the Petition, no longer exist, the Petition to institute an *inter partes* review of these claims is denied.”).

In the interest of a clear record, Patent Owner disagrees with the overwhelming majority of the positions advocated by the Petitioners, but will not detail those reasons here since the Petition must be denied. As an

example, in an *inter partes* review, claims must be given their broadest reasonable construction in light of the specification. 37 C.F.R. § 42.100(b). Contrary to that clear requirement, Petitioners propose to improperly limit the scope of certain claim elements to an embodiment disclosed in the specification. See, e.g., *Arlington Indus., Inc. v. Bridgeport Fittings, Inc.*, 345 F.3d 1318, 1331-32 (Fed. Cir. 2003) (holding that attempt to “read in limitations from the specification” was “erroneous”). Patent Owner reserves the right to respond to positions advanced by Petitioners in another forum.

### **CONCLUSION**

For the foregoing reasons, Patent Owner respectfully requests that Petition be denied.