

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY
Petitioner

v.

PAICE LLC & THE ABELL FOUNDATION
Patent Owner

Case IPR2014-00884
Patent 7,104,347

**PATENT OWNER'S
RESPONSE TO PETITION**

TABLE OF CONTENTS

I. INTRODUCTION 1

II. CLAIM CONSTRUCTION 6

 A. The District Courts’ Construction 7

 B. The Board should revise its construction of “setpoint (SP)” 8

 1. “Setpoint” marks a transition between operating modes 9

 2. “Setpoint” is not “predetermined” and is not limited to torque values 12

 C. The Board should construe “monitor patterns of vehicle operation over time” to mean “the controller tracks and records the driver’s repeated driving operations over time.” 13

III. INTRODUCTION TO THE PRIOR ART 17

IV. THE ’347 PATENT IS NOT OBVIOUS OVER CARACENI 18

 A. Caraceni does not disclose or suggest the use of a “setpoint” to turn on and operate the engine as required by claim 1. 19

 1. Caraceni discloses a control system that requires the driver to select “electric mode.” 19

 2. The use of a “setpoint” is not explicitly or inherently disclosed by Caraceni 23

 B. Caraceni does not disclose or suggest the use of “road load” as required by claim 7. 32

 C. Caraceni does not disclose or suggest the “controller” of claim 1 that “starts and operates” the engine to charge the battery. 38

D. Caraceni does not disclose or suggest a “battery” of claim 1 that “provid[es] current” to a “first electric motor.”40

V. THE ’347 PATENT IS NOT OBVIOUS OVER TABATA ’201 OR TABATA ’541 44

A. Tabata ’201 and Tabata ’541 do not disclose or suggest the use of “road load” or “setpoint” as required by claim 23. 44

B. Tabata ’201 and Tabata ’541 do not disclose or suggest the battery charging limitation of claim 23.51

C. Tabata ’201 and Tabata ’541 do not disclose a “controller” that “monitor[s] patterns of vehicle operation over time” as required by claim 24.56

VI. CONCLUSION.....60

TABLE OF AUTHORITIES

Page(s)

Cases

Cases

Allergan, Inc. v. Barr Labs., Inc., 501 F. App'x 965, 973 (Fed. Cir. 2013)..... 54
Ex Parte Levy, 17 U.S.P.Q.2d 1461, 1990 WL 354577 at *3 (P.T.O. Oct. 16, 1990) 26
Fresenius USA, Inc. v. Baxter Int'l, Inc., 582 F.3d 1288, 1300 (Fed. Cir. 2009) 54
Fuji Photo Film Co. v. Int'l Trade Comm'n, 386 F.3d 1095 (Fed. Cir. 2004) 12
In re Abbott Diabetes Care Inc., 696 F.3d 1142 (Fed. Cir. 2012)..... 8
In re Abbott Diabetes Care Inc., 696 F.3d 1142, 1149 (Fed. Cir. 2012) 8
In re Rijckaert, 9 F.3d 1531, 1534 (Fed. Cir. 1993)..... 25, 27
In re Robertson, 169 F.3d 743, 745 (Fed. Cir. 1999) 26
In re Vaidyanathan, 381 Fed. Appx. 985 (Fed. Cir. 2010) 8
Koito Mfg. Co. v. Turn-Key-Tech, LLC, 381 F.3d 1142, 1152 (Fed. Cir. 2004) 54
Motorola Mobility, LLC v. Int'l Trade Comm'n, 737 F.3d 1345, 1350 (Fed. Cir. 2013) 26
Paice LLC v. Hyundai Motor Co., No. CIV. WDQ-12-0499, 2014 WL 3725652 (D. Md. July 24, 2014) 8
PAR Pharm., Inc. v. TWI Pharm., Inc., 773 F.3d 1186, 1195-96 (Fed. Cir. 2014) 25, 27
Sata GmbH & Co., v. Anest Iwata Corp., 2013 WL 5970199 (June 25, 2013 Patent Tr. & App. Bd.) 34
W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 1555 (Fed. Cir. 1983)..... 26

Other Authorities

MPEP § 2141.02..... 26

UPDATED LIST OF EXHIBITS

Patent Owner Exhibit Number	Exhibit Description
PAICE Ex. 2201	Arbitration Agreement between Paice LLC and Ford Motor Company
PAICE Ex. 2202	Memorandum Opinion, U.S. District Court for the District of Maryland, U.S. District Judge William D. Quarles, Jr.
PAICE Ex. 2203	Declaration in support of <i>pro hac vice</i> motion
PAICE Ex. 2204	Bosch Automotive Handbook, 4th Edition (excerpts)
PAICE Ex. 2205	MULTIPLA - IN BRIEF - Press Releases - Fiat Chrysler Automobiles
PAICE Ex. 2206	MULTIPLA - ENGINES - Press Releases - Fiat Chrysler Automobiles
PAICE Ex. 2207	Ford Complaint
PAICE Ex. 2208	Letter from Paice to Ford (Nov. 24, 2014)
PAICE Ex. 2209	Griffith Hack white paper
PAICE Ex. 2210	The Oxford Essential Dictionary, American Ed. (1998) (excerpt)
PAICE Ex. 2211	Introduction to Automotive Powertrains (excerpts)
PAICE Ex. 2212	Gregory Davis deposition transcript (Feb. 25, 2015)
PAICE Ex. 2213	Gregory Davis deposition transcript (Jan. 13, 2015)
PAICE Ex. 2214	Davis, G. W., Hodges, G. L., and Madeka, F. C., "The Development and Performance of the AMPHIBIAN Hybrid Electric Vehicle," SAE Technical Publication 940337, 1994.
PAICE Ex. 2215	Declaration of Neil Hannemann

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.