

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORD MOTOR COMPANY
Petitioner,

v.

PAICE LLC & ABELL FOUNDATION, INC.
Patent Owner.

U.S. Patent No. 8,214,097 to Severinsky et al.

IPR Case No.: IPR2015-00799

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

On May 20, 2016 Patent Owner filed its Motion for Observations on the Cross Examination of Dr. Jeffrey Stein. (“POM,” Paper No.23). Petitioner respectfully submits the following responses to each of Patent Owner’s observations.

A. Observation 1

This observation is improper as it raises a new issue regarding whether claims 7 and 8 provide written description support for the *at least 500 volts* limitation—an issue that was not included in Patent Owner’s Response, Paper No. 14 or the accompanying Declaration of Mr. Hannemann, Paper No. 1 Ex. 2904. Observations are not “an opportunity to raise new issues.” 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.

Patent Owner’s observation also mischaracterizes Dr. Stein’s testimony and is not relevant because the cited deposition testimony and the paragraphs from Dr. Stein’s Reply Declaration are not inconsistent. Specifically, Paice’s observation improperly asserts that “Dr. Stein testified that claim 7 of U.S. Patent No. 5,343,970 (“the ‘970 patent”) discloses a battery providing a maximum current of

75 amperes to the electric motor.” Dr. Stein’s testimony is as follows: “I would say that I haven't studied this claim, as I've already said, and I don't know how to interpret some of these claim terms, since they haven't been in dispute. And I could answer the question that a battery which was providing -- that was connected to a motor that was providing 75 amperes, that the voltage corresponding to a battery, some battery, connected to some motor outside the context of this claim would have a voltage associated with it, that voltage that would be providing-- of that battery providing that 75 amperes to a motor would have a corresponding voltage that my students and I would call voltage under load. Whether that's relevant to this particular claim I don't know.” (Stein Deposition Tr., 32:25-33:12.)

This Observation also mischaracterizes Dr. Stein’s testimony regarding claim 8. Paice improperly asserts that Dr. Stein testified that “claim 8 (which depends from claim 7) states that the **corresponding voltage** is between 500 to 1500 volts” (boldface added.) Regarding the relationship of claims 7 and 8 and whether Severinsky ‘970 patent discloses 500 to 1500 volts under load, Dr. Stein testified as follows: “I don't know. I'd have to study this and have the claim construction to help me understand what we mean by this claim. I did not prepare for this for this declaration-- for this deposition.” (Stein Tr., Ex. 2908, 33:25-33:3.) This deposition testimony is consistent with paragraphs 64-68 of the Reply Declaration, where Dr. Stein responds to paragraphs 51-60 of the Hannemann

Declaration, which are limited to the disclosure in column 19 of the '970 patent and not claims 7 and 8.

B. Observation 2

Like Observation 1, this observation is improper as it raises a new issue regarding whether claims 7 and 8 provide written description support for the *at least 500 volts* limitation—an issue that was not included in Patent Owner's Response, Paper No. 14 or the accompanying Declaration of Mr. Hannemann, Paper No. 14, Ex. 2904. Observations are not “an opportunity to raise new issues.” 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.

Patent Owner's observation also mischaracterizes Dr. Stein's testimony and is not relevant because the cited deposition testimony and the paragraphs from Dr. Stein's Reply Declaration are not inconsistent. Regarding the relationship of claims 7 and 8 and whether Severinsky '970 patent discloses 500 to 1500 volts under load, Dr. Stein testified as follows: “I don't know. I'd have to study this and have the claim construction to help me understand what we mean by this claim. I did not prepare for this for this declaration -- for this deposition.” (Stein Tr., Ex. 2908, 33:25-33:3.) This deposition testimony is consistent with paragraphs 64-68 of the

Reply Declaration, where Dr. Stein responds to paragraphs 51-60 of the Hannemann Declaration, which are limited to the disclosure in column 19 of the '970 patent and not claims 7 and 8.

C. Observation 3

Similar to Observations 1 and 2, Patent Owner's observation is not relevant because the cited deposition testimony is unrelated to paragraphs 25-31 of the Reply Declaration. Rather, Dr. Stein testified that "The document says what it does, it says this approximate three-fold increase in the operating voltage [but] does not define what it means by operating voltage." Specifically, Dr. Stein's testified that "it's really unclear what these voltage numbers are that they're talking about" in the '743 Application's disclosure regarding operating voltages of "e.g. 800-1200 V." He goes on to state "normally when we talk about the voltage in a particular hybrid vehicle, the only voltage that's sort of inherent and constant is the nominal voltage." Rather than contradicting paragraphs 25-31 of his Reply declaration, Dr. Stein's deposition testimony confirms why the disclosure of 800-1200 Volts cannot be deemed a voltage under load.

D. Observation 4

Like Observation 3, Observation 4 is not relevant because the cited

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