UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE PATENT TRIAL AND APPEAL BOARD FORD MOTOR COMPANY

Petitioner

V.

PAICE LLC & THE ABELL FOUNDATION, INC.
Patent Owner

Case IPR2015-00799 Patent 7,237,634

Patent Owner's Preliminary Response to Petition for *Inter Partes* Review of U.S. Patent No. 7,237,634



TABLE OF CONTENTS

1.	INTR	RODUCTION1				
II.	PROG	CEDURAL BACKGROUND2				
III.	THE '634 PATENT					
	A.	Back	ground of the '634 patent	3		
IV.	ARGUMENT			6		
	A.	The Board should exercise its discretion to reject Ford's eleventh exercise its discretion its discretion to reject Ford's eleventh exercise its discretion its				
		1.	The Petition is Ford's eleventh shot at the '634 patent	.10		
		2. same	Ford advances the exact same prior art and substantially the arguments	.14		
		3.	Estoppel considerations support rejecting Ford's Petition	.16		
	B.	The P	Petition is procedurally improper	.19		
		1.	The Petition improperly incorporates by reference	.19		
		2.	The Petition creates an overly voluminous record	.21		
	C.		nd 1 is deficient because the '455 PCT Application is not prior the "500 volts," or "150 amperes" claims			
		1. Sever	The '634 patent properly incorporates the disclosure of the rinsky '970 specification	.23		
		2. claim	Severinsky '970 contains sufficient disclose to support the limitations	.28		
		3. voltag	The '634 patent alone provides support for the current and ge limitations	.36		



	4.	There is no "new matter" admission in the CIP Applications	44
	5.	These issues have not been decided by the Board	45
		The '455 PCT Application is not prior art to the "maximum nt" or "maximum voltage" limitations	
V	CONCLUS	ION	47



TABLE OF AUTHORITIES

Page(s)

Cases

Apple, Inc., v. ContentGuard Holdings, Inc., IPR2015-00356, Paper 9 (PTAB June 26, 2015)	23
Application of Wertheim, 541 F.2d 257, 265 (C.C.P.A. 1976)	38
ASUSTeK Computer Inc. v. Exotablet, Ltd., IPR2015-00041, Paper 6 (PTAB Apr. 23, 2015)	9
Bilstad v. Wakalopulos, 386 F.3d 1116 (2004)	passim
Butamax Advanced Biofuels LLC v. Gevo, Inc., IPR2014-00581, Paper 8 (PTAB Oct. 14, 2014)	8
Callaway Golf Co. v. Acushnet Co., 576 F.3d 1331 (Fed. Cir. 2009)	27
Cisco v. C-Cation Technologies, IPR2014-00454, Paper 12 (PTAB Aug. 29, 2014)	20
Conopco, Inc. dba Unilever v. Procter & Gamble Company, IPR2014-00628, Paper 23 (PTAB March 20, 2015)	9, 10
CustomPlay, LLC v. ClearPlay, Inc., IPR2014-00783, Paper 9 (PTAB Nov. 7, 2014)	17
eBay Inc. v. MoneyCat Ltd., CBM2015-00008, Paper 9 (PTAB May 1, 2015)	17
Fidelity National v. DataTreasury, IPR2014-00491, Paper 9 (PTAB Aug. 13,	20
Hollmer v. Harari, 681 F.3d 1351 (Fed. Cir. 2012)	27



MaxLinear, Inc. v. Cresta Technology Corp., IPR2015-00591, Paper 9 (PTAB June 15, 2015)	.3
Micro Motion, Inc. v. Invensys Systems, Inc., IPR2014-0393, Paper 16 (PTAB Aug. 4, 2014)2	20
Ralston Purina Co. v. Far-Mar-Co, Inc., 772 F.2d 1570 (1985)33, 3	34
Samsung Elecs. Co. v. Rembrandt Wireless Technologies, LP, IPR2015-00555, Paper 20 (PTAB June 19, 2015)	.9
Shaw Industries Group, Inc. v. Automated Creel Sys., Inc., IPR2013-00584, Paper 16 (PTAB Dec. 21, 2013)	20
Tempur Sealy Int'l Inc. v. Select Comfort Corp., IPR2014-01419, Paper 7 (PTAB Feb. 17, 2015)	20
Travelocity.com L.P. v. Cronos Techs., LLC, CBM2015-00047, Paper 7 (PTAB June 15, 2015)	.4
Unified Patents, Inc. v. PersonalWeb, LLC, IPR2014-00702, Paper 13 (PTAB Jul. 24, 2014)	9
Unilever, Inc., v. The Proctor & Gamble Co., IPR2014-00506, Paper 17 (PTAB July 7, 2014)1	.7
Union Oil Co. of California v. Atl. Richfield Co., 208 F.3d 989 (Fed. Cir. 2000)	88
Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555 (Fed. Cir. 1991)	ŀ5
Zenon Environmental, Inc. v. United States Filter Corp., 506 F.3rd 1370, 1380-82 (Fed. Cir. 2007)2	27
Ex Parte Zooey C. Chu, APL 2001-0959, 2003 WL 22282257 (BPAI, 2003)	l4
Statutes	
35 U.S.C. § 313	. 1



DOCKET

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.

