

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZF NORTH AMERICA, INC., ZF ACTIVE SAFETY US INC.,
Petitioners

v.

STONERIDGE CONTROL DEVICES, INC.,
Patent Owner

Patent No. 7,021,415

Inter Partes Review No.: IPR2023-00273

**PETITIONER'S REPLY TO THE PATENT OWNER'S
PRELIMINARY RESPONSE**

TABLE OF AUTHORITIES

Cases

<i>Apple, Inc. v. Gesture Tech. Partners, LLC</i> , IPR2021-00922, Paper 26 (PTAB Nov. 28, 2022)	1, 2
<i>Cuozzo Speed Techs., LLC v. Lee</i> , 136 S. Ct. 2131 (2016)	3
<i>Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC</i> , 138 S. Ct. 1365 (2018)	3
<i>Sony Corp. v. Iancu</i> , 924 F.3d 1235 (Fed. Cir. 2019)	2
<i>Unified Patents, LLC v. Gesture Tech. Partners, LLC</i> , IPR2021-00917, Paper 31 (PTAB. Nov. 21, 2022)	1
<i>Unified Patents, LLC v. Robocast, Inc.</i> , IPR2022-01125, Paper 13 (PTAB. Jan. 20, 2023)	1, 2, 3
<i>Wasica Fin. GmbH v. Cont'l Auto. Sys., Inc.</i> , 853 F.3d 1272, 1279 (Fed. Cir. 2017)	2

Statutes

35 U.S.C. § 311(b)	2
35 U.S.C. § 311(c)	2
35 U.S.C. § 315	2

Regulations

37 C.F.R. § 42.6(e)	1
37 CFR § 42.100(b)	2

Other Authorities

<i>Changes to the Claim Construction Standard for Interpreting Claims in Trial Proceedings Before the Patent Trial and Appeal Board</i> , 83 Fed. Reg. 51341 (Oct. 11, 2018)	2
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EXHIBITS

Previously filed:

- Ex. 1001: U.S. Patent No. 7,021,415 (“the ’415 Patent”)
- Ex. 1002: Expert Declaration of Dr. Bruno Lequesne
- Ex. 1003: Curriculum Vitae of Dr. Bruno Lequesne
- Ex. 1004: Certified File History of the ’415 Patent
- Ex. 1005: European Patent No. EP 1578633
- Ex. 1006: European Patent No. EP 1578633 opposition proceedings
- Ex. 1007: Certified translation of German Patent No. DE 19732168 (“Poertzgen”)
- Ex. 1008: German Patent No. DE 19732168
- Ex. 1009: U.S. Patent No. 6,179,097 (“Schumann”)
- Ex. 1010: U.S. Patent No. 6,098,948 (“Boucheret”)
- Ex. 1011: U.S. Patent No. 6,390,247 (“Drennen”)
- Ex. 1012: Certified translation of PCT Publication No. WO 00/61962 (“Weiler”)
- Ex. 1013: PCT Publication No. WO 00/61962
- Ex. 1014: *An Introduction to Modern Vehicle Design*, Happian-Smith, Julian (2001)
- Ex. 1015: *Gear Types & Manufacturing*, Stock Drive Products/Sterling Instrument
- Ex. 1016: *Gears and Gear Drives*, Motion System Design, A145-A160 (2001)
- Ex. 1017: *Dudley's Gear Handbook*, Townsend, Dennis P. (1991)
- Ex. 1018: U.S. Patent No. 1,971,417

Ex. 1019: Declaration of Dr. Carrie Gardner authenticating Exs. 1014,
1016, and 1017

Filed herewith:

Ex. 1020: April 12, 2023 Authorization from Board to File Reply to POPR

Pursuant to the Board’s April 12, 2023 authorization (Ex. 1020), Petitioner hereby respectfully submits this Reply to the Patent Owner’s Preliminary Response (POPR).

The POPR argues that the Board lacks jurisdiction to conduct IPRs with respect to expired patents. POPR at 41-43. However, none of the cases cited in the POPR supports this proposition. Indeed, cases that do address this specific issue *uniformly* hold that IPRs may be conducted with respect to expired patents. *See Apple, Inc. v. Gesture Tech. Partners, LLC*, IPR2021-00922, Paper 26 at 25-27 (PTAB Nov. 28, 2022)) (“[I]nter partes review covers expired patents.”); *Unified Patents, LLC v. Gesture Tech. Partners, LLC*, IPR2021-00917, Paper 31 at 41-43 (PTAB. Nov. 21, 2022) (same); *Unified Patents, LLC v. Robocast, Inc.*, IPR2022-01125, Paper 13 at 6-9 (PTAB. Jan. 20, 2023) (“[E]xpired patents are properly considered to be within our jurisdiction”). In so holding, each of these cases expressly rejected the argument made in the POPR.¹

¹ Patent Owner appears to have copied arguments verbatim from those cases, without notifying the Board of the rejection of those arguments. *Compare* POPR at 41-42 to *Apple*, IPR2021-00922, Paper 8 at 1-2; *Unified Patents*, IPR2021-00917, Paper 13 at 1-2; *Robocast*, IPR2022-01125, Paper 9 at 8-9.

As noted by these previous panels, “the statutes governing *inter partes* review do not limit them to non-expired patents.” *Apple*, IPR2021-00922, Paper 26 at 26 (citing 35 U.S.C. §§ 311(b), (c), and 315 and noting their lack of any limitations with respect to patent expiration). The Rules, likewise “have also made clear that *inter partes* review covers expired patents.” *Id.* (citing 37 CFR § 42.100(b) (2012) and 83 Fed. Reg. 51341 (Oct. 11, 2018), referencing IPR claim construction standards for expired and soon-to-be expired patents).² And, as noted by the Board, the “Federal Circuit has ... affirmed the Board’s determination with respect to expired claims in *inter partes* review.” *Robocast*, IPR2022-01125, Paper 13 at 8 (citing *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1279 (Fed. Cir. 2017) (affirming IPRs that held expired claims unpatentable)). *See also Sony Corp. v. Iancu*, 924 F.3d 1235, 1239 (Fed. Cir. 2019) (“During [IPR] proceedings, claims of an expired patent are construed”).

The Board has also recognized that the case cited in the POPR, *Oil States Energy Servs., LLC v. Greene's Energy Grp., LLC*, actually *supports* jurisdiction over expired patents, by confirming that “[i]nter partes review is ‘a second look at

² That IPRs allow for amendment of unexpired claims does not logically suggest that IPRs are unavailable for expired patents, any more than the application of BRI to unexpired claims precluded applying the *Phillips* standard to expired claims.

an earlier administrative grant of a patent.”” *Robocast*, IPR2022-01125, Paper 13 at 7; *Oil States*, 138 S. Ct. 1365, 1373-74 (2018) (quoting *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2144 (2016)). At a minimum, *Oil States* does not limit IPRs to unexpired patents. *Robocast*, IPR2022-01125, Paper 13 at 7-8 (“even if PO is correct that the Supreme Court has not specifically addressed whether the Board has jurisdiction over expired patents, that fact does not warrant discounting the logical consequences of what the Supreme Court has decided.”).

Moreover, the benefits of IPRs, namely, providing an efficient venue having particular expertise in which the patentability of patent claims can be determined as an alternative to, *e.g.*, Federal District Courts, applies equally to all patents, not just the unexpired ones. There is no sound policy reason for allowing an IPR of a patent that will expire one day after the final written decision is issued, but not for an expired patent. A contrary holding would simply encourage gamesmanship, where holders of weak patents would simply wait until shortly after expiration to sue on their patents.

BANNER & WITCOFF, LTD.

Dated: April 17, 2023

By: /John R. Hutchins/

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CERTIFICATE OF SERVICE

The undersigned certifies service on the Petitioner, pursuant to 37 C.F.R. § 42.6(e), by electronic (e-mail) delivery of a true copy of the foregoing PETITIONER'S REPLY TO THE PATENT OWNER'S PRELIMINARY RESPONSE, to lead and back-up counsel of record for Petitioner as follows:

Timothy J. Murphy
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Dated: April 17, 2023

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