

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BENTLEY MOTORS LIMITED
and
BENTLEY MOTORS, INC.

Petitioner

v.

JAGUAR LAND ROVER LIMITED
Patent Owner

U.S. Patent No. RE46,828

IPR2019-01539

**PETITIONER BENTLEY'S RANKING AND EXPLANATION FOR TWO
PETITIONS CHALLENGING U.S. PATENT NO. RE46,828**

I. INTRODUCTION

Pursuant to the July 2019 Trial Practice Guide Update (“Update”), Petitioners Bentley Motors Limited and Bentley Motors, Inc. (“Petitioner”) rank, and explain the need to file, two Petitions challenging certain claims in Jaguar Land Rover’s (“Patent Owner”) U.S. Patent No. RE46,828 (“the ’828 patent”).

II. RANKING OF PETITIONS

Petitioner ranks the two Petitions challenging claims 21, 24, 30, 32-34, 37, 39, 41-43, 45, and 46 of the ’828 patent as follows:

| Rank | Petition | Grounds |
|-------------|----------------------------------|--|
| 1 | IPR2019-01502 (“-1502 Petition”) | Grounds 1-6: Claims 21, 24, 30, 32-34, 37, 39, 41-43, 45, and 46 Obvious over the Porsche 959 Art in combination with various references. |
| 2 | IPR2019-01539 (“-1539 Petition”) | Grounds 1-5: Claims 21, 24, 30, 32-34, 37, 39, 41-43, 45, and 46 Obvious over GB ’580 and the Lancer Art in combination with various references. |

III. EXPLANATION FOR TWO PETITIONS

A. Disputed Claim Construction and Thirteen Lengthy Claims with Multiple Invalidating References Not Considered by the Examiner

The ’828 patent claims a control system for a conventional motor vehicle with multiple driving modes. The driver selects a driving mode based on the driving surface and the vehicle configures various subsystems in response (e.g.

suspension, transmission, brakes). Within each driving mode the controller configures integrated subsystems to be suitable for different types of terrain.

Patent Owner's reissue declaration stated the "error to be corrected is the omission of a claim directed to a vehicle control system having driving modes that include *at least two off-road modes* and an on-road mode." Ex. 1021, Page 425. (emphasis added). During reissue, Petitioner provided Patent Owner with a copy of one of the primary invalidating references in the -1502 Petition—the Porsche 959 Driver's Manual (Ex. 1003)—yet Patent Owner did not disclose it to the Examiner. The reference discloses driver selection of two off-road driving modes based on the driving surface. Patent Owner asserted, however, that the reference does not disclose two "off-road modes" when properly construed. Petitioner has addressed Patent Owner's presumed claim construction argument in the -1502 Petition.

The -1539 Petition relies on GB '580 in combination with the Lancer Art (Exs. 1017, 1048, 1059, 1060), because the Lancer Art incontrovertibly discloses driver selection of two off-road modes based on two driving surfaces (gravel and snow). GB '580 was the primary reference relied upon in the corresponding European prosecution, which rejected Applicant's application. Patent Owner cited the January 2001 Lancer Press Information (Ex. 1017) to the Patent Office during reissue, but the Examiner never relied on it to reject the claims. Ex. 1021, Pages

423-463, 609-634. Petitioner has located *dated library copies* of automobile magazines published prior to April 2002 in Japan that discuss the Lancer’s drivetrain system in detail. Those articles have certified translations into English with publication dates of May 13, 2001 and October 27, 2001. Exs. 1059, 1060.

Patent Owner has asserted infringement of thirteen claims from the ’828 patent against Petitioner and real parties in interest. The challenged claims are lengthy and recite limitations that invoke multiple vehicle subsystems. The claims implicate at least the following subsystems: brakes, suspension, transmission, throttle control, and powertrain. Petitioner submits that two petitions are necessary to address each of the implicated vehicle subsystems because none of the prior art combinations relied on in the Petitions was ever considered by the Examiner.

B. “Reasonably Could Have Raised” Estoppel

35 U.S.C. § 315(e)(2) provides:

The petitioner in an inter partes review . . . that results in a final written decision under section 318(a) . . . may not assert in either a civil action arising in whole or in part under section 1338 of title 28 . . . that the claim is invalid on any ground that the petitioner raised *or reasonably could have raised* during that inter parties review. (emphasis added).

Post *SAS Institute*,¹ “reasonably could have raised” estoppel is being aggressively asserted in, and accepted by, the district courts. “[T]he majority of District Courts have determined that IPR estoppel applies to any prior art that

¹ *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018).

reasonably could have been raised, even if not actually raised in the IPR proceeding.” *Novartis Pharms. Corp. v. Par Pharm. Inc.*, Civil Action No. 14-1289-RGA, 2019 U.S. Dist. LEXIS 62489, at *6 (D. Del. April 11, 2019) (citing *Bio-Rad Labs., Inc. v. 10X Genomics, Inc.*, 322 F. Supp. 3d 537, 541 (D. Del. 2018)); see also *Am Tech. Ceramics Corp. v. Presidio Components, Inc.*, 2019 WL 365709, at *2, 4-5 (E.D.N.Y. Jan. 30, 2019); *Milwaukee Electric Tool Corp. v. Snap-On Inc.*, 271 F. Supp. 3d 990, 1029-30 (E.D. Wisc. 2017); *Network-I Techs., Inc. v. Alcatel-Lucent USA, Inc.*, No. 6:11-cv-00492-RWS, 2017 U.S. Dist. LEXIS 178857, at *6-7 (E.D. Tex. Oct. 27, 2017); *Sionyx v. Hamamatsu Photonics K.K.*, 330 F. Supp. 3d 574, 601-02 (D. Mass Aug. 30, 2018). Therefore, it is incumbent upon Petitioner to provide the Board with all of the well-grounded bases for finding the challenged ’828 claims unpatentable, or run the risk of being estopped in district court. See *Intex Recreation Corp. v. Team Worldwide Corp.*, IPR2018-00874, Paper 14, 11-12 (PTAB October 29, 2018) (“[Reasonably could have raised estoppel] forces a petitioner to decide the breadth of the challenge to bring given the risk that certain grounds may not be brought in a parallel civil action. Accordingly, the statute contemplates that a petitioner may decide that the appropriate breadth of a challenge warrants multiple petitions.”). Petitioner needs more than the allotted 14,000 words in one petition to present a thorough analysis of each ground in this case. See *id.* at 12 (“This approach [5 petitions] allowed

Petitioners to present a more thorough analysis for each of its 14 asserted grounds as compared to what a single petition would allow.”)

IV. DIFFERENCES BETWEEN THE PETITIONS

The -1502 and -1539 Petitions rely on different prior art combinations, none of which were considered by the Examiner, to demonstrate unpatentability of the '828 claims. The Porsche 959 Art (-1502 Petition) teaches selection of multiple on and off-road driving modes based on different driving surfaces (claim 30) and ordered driving mode selection (claim 32). The additional references disclose the recited subsystem configurations: suspension subsystem with adjustable ride height (claims 33, 34, 41 and 42); electronic throttle control subsystem (claims 37 and 39); transmission subsystem with plurality of transmission ratios (claim 45); speed control subsystem for hill descent (claim 46); and traction control and brake subsystems (claims 21, 24, and 43). The -1539 Petition, in contrast, relies on the combination of GB '580 and the Lancer Art, regardless of Patent Owner's "off-road mode" claim construction argument.

Petitioner requests that the Board institute both petitions "if it identifies one petition that satisfies petitioner's burden under 35 U.S.C. § 314(a)." Update, 27.

Date: August 23, 2019

Respectfully Submitted,

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