

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION**

REPAIRIFY, INC., and)	
)	
Plaintiff,)	Case No. 6:21-cv-00819-ADA-DTG
)	
v.)	
)	
KEYSTONE AUTOMOTIVE)	JURY TRIAL DEMANDED
INDUSTRIES, INC. d/b/a ELITEK)	
VEHICLE SERVICES, and DOES 1)	
through 20, inclusive,)	
)	
Defendants.)	

**DEFENDANT’S OPPOSED MOTION FOR SUMMARY JUDGMENT OF
UNENFORCEABILITY OF U.S. PATENT NO. 10,528,334**

I. INTRODUCTION

Pursuant to Federal Rule of Civil Procedure 56, Defendant Keystone Automotive Industries, Inc. (“Elitek”) respectfully moves for summary judgment that U.S. Patent No. 10,528,334 (the “’334 Patent”) is unenforceable. At the pre-trial conference, this Court granted-in-part Elitek’s Motion to Dismiss (Dkt. No. 55), finding that Repairify did not own U.S. Patent No. 9,684,500 (the “’500 Patent”) when the Complaint was filed. Furthermore, Repairify has not produced any documents evidencing assignment of the ’500 Patent. *See* Dkt. No. 55 at 7-8; Keener Decl. at ¶ 4. The Court’s ruling also implicitly found that Repairify owned the ’334 Patent at the time of the Complaint. Keener Decl. at ¶ 5, Ex. A at 21:1–3.¹ But the ’334 Patent is subject to a terminal disclaimer, rendering it unenforceable. The terminal disclaimer reads:

The owner hereby agrees that any patent so granted on the instant application [the ’334 Patent] shall be enforceable only for and during such period that it and the prior patent [the ’500 Patent] are commonly owned.

Ex. B. The divided ownership of the ’500 and ’334 Patents renders the ’334 Patent unenforceable.

II. The Terminal Disclaimer Renders the ’334 Patent Unenforceable.²

Terminal disclaimers render a patent unenforceable when the disclaimed patent is not commonly owned with the prior patent. *See, e.g., Email Link Corp. v. Treasure Island, LLC*, 2012 WL 4482576, at *4 (D. Nev. Sept. 25, 2012); *Enovsys LLC v. Nextel Commc’ns, Inc.*, 2008 WL 8773518, at *1 (C.D. Cal. Feb. 26, 2008) (citing MPEP 706.02(1)(2)(I) (2008)).

This Court’s ruling, combined with the absence of any evidence of a post-filing transfer, establishes that Repairify has **never** owned the ’500 Patent, and until that defect is remedied, the

¹ Unless otherwise indicated, citations are to the exhibits attached to the Keener Declaration.

² Courts are split on whether this is an issue of standing or enforceability. *Integrity Worldwide, Inc. v. Rapid-EPS Ltd.*, 3:17-cv-00055-ADA, 2021 WL 3130082 *4 (W.D. Tex. July 22, 2021). Either way, Repairify has no right to enforce the ’334 Patent.

'334 Patent is unenforceable. *See Email Link*, 2012 WL 4482576, at *3 (“[B]inding Federal Circuit precedent . . . holds that if the ownership of a disclaimed patent is separated from the prior patent, the disclaimed patent is not enforceable.”) (citing *Merck & Co. Inc. v. U.S. Int’l Trade Comm’n*, 774 F.2d 483, 485 (Fed. Cir. 1985)); *Voda v. Medtronic, Inc.*, 2011 WL 10820070, at *2 (W.D. Okla. Aug. 17, 2011) (“[P]laintiff must not only own all three patents **for** the period he seeks enforcement of the [patent-at-issue], he must also own all three patents **during** the period he files suit to do so.”) (emphasis in original). As there is no dispute that the '334 Patent is not commonly owned with the '500 Patent, summary judgment is appropriate. *See* Fed. R. Civ. P. 56(a).

III. The Court Cannot Ignore the Terminal Disclaimer.

Repairify asserts that even if the '500 and '334 Patents were not co-owned, the '334 Patent is enforceable because if Repairify did not own the '500 Patent, then the terminal disclaimer should not have been allowed, and the Court should ignore it. Keener Decl. at ¶ 7. However, a terminal disclaimer is a binding promise not to enforce the patent under specific circumstances. *See In re Dinsmore*, 757 F.3d 1343, 1347 (Fed. Cir. 2014) (finding the promise that “the patent will not be enforced except when owned by the owner of the [prior patent]” is “clear on its face” and “can readily be given effect”); *see also* 37 CFR § 1.321(b) (“Such terminal disclaimer is binding upon the grantee and its [] assigns.”). Second, the terminal disclaimer was the only grounds for overcoming a double patenting rejection. Exs. C at 3–4; D at 1–2. Absent the terminal disclaimer, the '334 Patent would not have issued. *See* Ex. E; *Miller v. Eagle Mfg. Co.*, 151 U.S. 186, 197 (1894) (“well-settled rule that two valid patents for the same invention cannot be granted”).

IV. The Court’s Decision as to the '500 Patent Should Not Be Reconsidered.

Repairify also asserts the Court should reconsider its ruling on Elitek’s Motion to Dismiss. Keener Decl. at ¶ 7. Implicitly, Repairify acknowledges the terminal disclaimer prevents

enforcement of the '334 Patent as the Court also dismissed the '500 Patent on summary judgment of no infringement, meaning reconsideration of the Court's Order as to ownership of the '500 Patent has no impact on the trial except that it eliminates the '334 terminal disclaimer problem. (Dkt. No. 169).

Repairify asserts the Court did not properly consider the Bankruptcy Order. But this Court questioned Repairify on the order for nearly 10 minutes and came to a decision that was not a "manifest error of fact or law." Ex. A at 11:11–14:18; *see Finalrod IP, LLC v. John Crane*, No. 7:15-cv-00097-ADA, 2019 WL 13074181, at *1 (W.D. Tex. July 18, 2019). Repairify followed up with four additional arguments: (1) intestacy law can transfer patents; (2) courts can transfer patents; (3) the bankruptcy order was a transfer of assets; and (4) ruling the '500 Patent ownerless amounts to an unlawful taking. Keener Decl. ¶ 11; Ex. F. Regarding (1), patents are granted to patentee and their *heirs and assignees* (35 U.S.C. § 154(a)(1)). Elitek's motion was based on the lack of assignment. Regarding (2) and (3), the Bankruptcy Order approves the APA, which is a promise to assign, not an assignment; ruling otherwise not only violates *Abraxis* but renders the APA requirement for patent assignments to be delivered at closing and the '313 Patent Assignment meaningless. *Res judicata* is inapplicable as the bankruptcy court never addressed ownership of the '500 Patent. Moreover, *In re O'Dwyer* shows a motion to reopen bankruptcy is the proper way to address property that was mistakenly not transferred. 611 Fed. App'x. 195, 197 (5th Cir. 2015). Regarding (4), the Court's decision is not an unlawful taking; Repairify's own failure to obtain a written assignment was not government action forcing Repairify to give up its property.

V. CONCLUSION

For the foregoing reasons, Elitek respectfully requests that the Court enter summary judgment that the '334 Patent is unenforceable for all time periods relevant to the instant matter.

Dated: June 3, 2024

Respectfully submitted,

By: Jason J. Keener

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the above and foregoing document has been served on all counsel of record via the Court's ECF system.

/s/ Alyssa Allegretti _____

Alyssa Allegretti

CERTIFICATE OF CONFERENCE

The undersigned hereby certifies that the parties met and conferred with respect to this motion. No agreement was reached between the parties as Plaintiff indicated that it opposed this.

/s/ Jason J. Keener _____

Jason J. Keener

Exhibit A

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IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF TEXAS
WACO DIVISION

REPAIRIFY, INC. *
* May 23, 2024
VS. *
* CIVIL ACTION NO. W:21-CV-819
KEYSTONE AUTOMOTIVE *
INDUSTRIES, INC., *
ET AL *

BEFORE THE HONORABLE ALAN D ALBRIGHT
PRETRIAL CONFERENCE

APPEARANCES:

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Proceedings recorded by mechanical stenography,
transcript produced by computer-aided transcription.

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08:55 1 (Hearing begins.)

08:55 2 THE BAILIFF: All rise.

08:55 3 THE COURT: Good morning, everyone. You
08:55 4 may be seated.

08:55 5 DEPUTY CLERK: Court calls Case
08:55 6 6:21-CV-819, Repairify, Incorporated versus Keystone
08:55 7 Automotive Industries, Incorporated, et al. Case
08:55 8 called for a pretrial conference.

08:55 9 THE COURT: Announcements from counsel,
08:55 10 please.

08:55 11 MR. FINDLAY: Good morning, Your Honor.
08:55 12 Eric Findlay on behalf of the plaintiff Repairify.
08:55 13 Also with me, Mr. Arthur Wellman, Mr. Vijay Toke, and
08:55 14 Mr. Nick Woloszczuk. Good morning.

08:55 15 THE COURT: Mr. Shelton.

08:55 16 MR. SHELTON: Good morning, Your Honor.
08:55 17 Barry Shelton, Winston & Strawn, LLP. It's great to
08:55 18 see you and all of your staff, Your Honor.

08:55 19 THE COURT: You only had to drive in from
08:55 20 Lakeway today and not to Waco.

08:55 21 MR. SHELTON: Yes, Your Honor. It's a
08:55 22 little shorter than driving to Waco.

08:55 23 THE COURT: Of course Mr. Siegmund had to
08:55 24 drive down from Waco. So it's...

08:55 25 MR. SHELTON: Kind of a mixed bag there.

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08:55 1 I'd like to introduce Barry Irwin from
08:55 2 Irwin IP LLP, lead counsel. Next to him is Alex
08:56 3 Bennett. Next to him is Joe Saltiel. Next to him is
4 Emad Mahou.

08:56 5 And then on the other side of the table
08:56 6 Jason Keener, and the man who needs no introduction,
08:56 7 Mark Siegmund.

08:56 8 Thank you, Your Honor. We're ready to
08:56 9 proceed.

08:56 10 THE COURT: Okay. Give me one second.
08:56 11 The first issue I have to take up, motion to dismiss
08:56 12 Counts 2 and 3. I'll hear from the defendant on that,
08:56 13 please.

08:56 14 MR. KEENER: Your Honor, we have some
08:56 15 slides. Can we hand those up to you?

08:56 16 THE COURT: Sure.

08:57 17 MR. KEENER: May it please the Court,
08:57 18 Jason Keener for defendants Elitek.

08:57 19 Elitek moves to dismiss Counts 2 and 3
08:57 20 due to Repairify's lack of standing. Repairify cannot
08:57 21 meet its burden to show it had ownership of either the
08:57 22 '500 or '334 patents at the time they filed the
08:57 23 complaint.

08:57 24 As a background, here is the relevant
08:57 25 timeline. The Court will see the '313 patent was both

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09:06 1 So there's -- there's plenty of evidence
09:06 2 in that assignment to allow the Court to look to the
09:06 3 extrinsic evidence both surrounding the recorded patent
09:06 4 assignment and the --

09:06 5 THE COURT: Perhaps you could focus on
09:06 6 the defendant's argument that the APA is a promise to
09:06 7 assign or a future obligation to assign the patent.

09:06 8 MR. WOLOSZCZUK: So I don't -- I don't
09:06 9 believe that's accurate given, you know, the clear --
09:07 10 the clear intent.

09:07 11 THE COURT: Well, I'm looking at the
09:07 12 language. Why don't we focus on the language? "Seller
09:07 13 shall sell and assign at the closing," "at the closing,
09:07 14 seller shall deliver or cause," "on the closing date,"
09:07 15 blah, blah, blah.

09:07 16 I mean, why don't we focus on the
09:07 17 language?

09:07 18 MR. WOLOSZCZUK: Yes, Your Honor.

09:07 19 THE COURT: And if I wasn't clear -- I
09:07 20 can't remember -- I was speaking about the '500 patent
09:07 21 there because we'll get to the others.

09:07 22 MR. WOLOSZCZUK: Right. Well, I believe
09:07 23 I said earlier the --

09:07 24 Sorry. Trying to operate here. I
09:07 25 grabbed a mouse that doesn't belong to my computer.

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09:07 1 -- that the -- that the APA references
09:08 2 the application number of the '187. I understand it
09:08 3 doesn't -- it doesn't include the -- necessarily
09:08 4 include the language assigning at that time. However,
09:08 5 it does very clearly throughout the document indicate
09:08 6 that that is what the purpose of the APA is to do, is
09:08 7 to --

09:08 8 THE COURT: I don't think -- I don't
09:08 9 think it does very clearly anywhere. The language
09:08 10 indicates clearly to me that it is a promise to assign,
09:08 11 and I'm waiting for you to show me where in the APA
09:08 12 that that's wrong.

09:09 13 Let me be clear. Show me where in the
09:09 14 APA you rebut the language that I just quoted to you
09:09 15 from the APA that it is a promise to assign.

09:09 16 MR. WOLOSZCZUK: Well, I would say that
09:09 17 the language in Section 2.7 defines transferred assets,
09:09 18 and again, it's kind of a complicated chain.

09:09 19 THE COURT: Well, I don't -- I don't have
09:09 20 that. If you could maybe show it to me, that'd be
09:09 21 great.

09:09 22 MR. WOLOSZCZUK: Sorry. Yes, Your Honor.
09:09 23 Just one moment.

09:09 24 The asset purchase agreement is
09:09 25 at ECF 56-3. I'm just turning to the pages now, Your

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1 Honor.

2 (Clarification by Reporter.)

09:10 3 MR. WOLOSZCZUK: Sorry. The asset
09:10 4 purchase agreement is at ECF 56-3, and if the Court
09:10 5 will bear with me, I'm turning to -- turning to the
09:10 6 section now.

09:10 7 I'm sorry. The chain is a little bit
09:11 8 more complicated than that. Starting -- it's at 56-3,
09:12 9 Section 2.7, that says that:

09:12 10 A closing that's going to be deemed
09:12 11 effective in all right, title, and interest of seller
09:12 12 in and to the transferred assets will be considered to
09:12 13 have passed to the buyer --

09:12 14 THE COURT: I think the defendants would
09:12 15 embrace what you just read at the closing. I think
09:12 16 that's the point. I mean, I'm not -- I don't want to
09:12 17 speak for the defense, but I don't see them disagreeing
09:12 18 with what you just read, that that is the point that I
09:12 19 think they're trying to make.

09:12 20 MR. WOLOSZCZUK: Well, yes, Your Honor,
09:12 21 but the -- but the closing was effective -- I don't
09:12 22 know the exact day in front of me -- but shortly after
09:12 23 the bankruptcy court entered -- entered the order
09:12 24 approving -- approving the asset purchase agreement and
09:12 25 approving the bankruptcy.

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09:13 1 So again, if the -- if the transferred
09:13 2 assets were -- were passed at the time of the
09:13 3 bankruptcy court entering the order, I would submit
09:13 4 that that is -- that is when the assignment became
09:13 5 effective.

09:13 6 THE COURT: Where was the obligation to
09:13 7 assign the '500 patent? When was it -- where and when
09:13 8 was it executed?

09:13 9 MR. WOLOSZCZUK: Separate and apart from
09:13 10 the APA?

09:13 11 THE COURT: Yes.

09:13 12 MR. WOLOSZCZUK: There's not a separate
09:13 13 document apart from the APA that assigns the '500
09:13 14 patent. At the time of the APA, the '187 application
09:14 15 was in prosecution, and it is mentioned as -- it's in
09:14 16 the seller's disclosure schedule, which is Section 3.9
09:14 17 A(i), which lists the registered intellectual property
09:14 18 rights, and it specifically lists the '187 application.

09:14 19 THE COURT: Do you agree that if -- let
09:14 20 me make sure I get the numbers right here. So the '334
09:14 21 is the grandchild patent, correct?

09:14 22 MR. WOLOSZCZUK: Correct, Your Honor.

09:14 23 THE COURT: Okay. Assuming that I were
09:14 24 to hold that the '500 patent was not properly assigned
09:14 25 and the motion to dismiss should be granted with

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09:26 1 THE COURT: The Court is going to grant
09:26 2 the motion to dismiss with respect to the '500 patent,
09:26 3 and is going to deny with respect to the '334 patent.

09:26 4 The next issue I have is a motion for
09:26 5 summary judgment of noninfringement. Although I don't
09:27 6 know if -- it appears that part of the summary judgment
09:27 7 has to do with the '500 patent, which I don't know we
09:27 8 need to -- I need to take up based on what I just
09:27 9 ruled, but I'll let you -- I'll invite you to comment
09:27 10 on that.

09:27 11 MR. SHELTON: May I approach, Your Honor?

09:27 12 THE COURT: Of course.

09:27 13 MR. SALTIEL: May it please the Court.

09:27 14 THE COURT: Yes, sir.

09:27 15 MR. SALTIEL: Joseph Saltiel on behalf of
16 defendant Elitek.

09:27 17 To address your question, our arguments
09:27 18 are applicable to all the patents at issue. So the
09:27 19 fact that the '500 -- that won't change my presentation
09:27 20 for today.

09:27 21 THE COURT: Okay.

09:28 22 MR. SALTIEL: Elitek has filed for
09:28 23 summary judgment of noninfringement for several
09:28 24 reasons. But here today, I want to focus the Court on
09:28 25 the first two issues that were raised on the briefing.

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1 UNITED STATES DISTRICT COURT)
2 WESTERN DISTRICT OF TEXAS)

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I, Kristie M. Davis, Official Court Reporter for the United States District Court, Western District of Texas, do certify that the foregoing is a correct transcript from the record of proceedings in the above-entitled matter.

I certify that the transcript fees and format comply with those prescribed by the Court and Judicial Conference of the United States.

Certified to by me this 24th day of May 2024.

/s/ Kristie M. Davis
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Official Court Reporter
PO Box 20994
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11:36

Exhibit B

Doc Code: DIST.E.FILE**Document Description: Electronic Terminal Disclaimer - Filed**U.S. Patent and Trademark Office
Department of Commerce

Electronic Petition Request	TERMINAL DISCLAIMER TO OBIVIATE A DOUBLE PATENTING REJECTION OVER A "PRIOR" PATENT
Application Number	15619743
Filing Date	12-Jun-2017
First Named Inventor	LONNIE MARGOL
Attorney Docket Number	87186.000019
Title of Invention	REMOTE VEHICLE PROGRAMMING SYSTEM AND METHOD

Filing of terminal disclaimer does not obviate requirement for response under 37 CFR 1.111 to outstanding Office Action

This electronic Terminal Disclaimer is not being used for a Joint Research Agreement.

Owner	Percent Interest
REPAIRIFY, INC.	100%

The owner(s) with percent interest listed above in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of the full statutory term of prior patent number(s)

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as the term of said prior patent is presently shortened by any terminal disclaimer. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of the term of any patent granted on the instant application that would extend to the expiration date of the full statutory term of the prior patent, "as the term of said prior patent is presently shortened by any terminal disclaimer," in the event that said prior patent later:

- expires for failure to pay a maintenance fee;
- is held unenforceable;
- is found invalid by a court of competent jurisdiction;
- is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321;
- has all claims canceled by a reexamination certificate;
- is reissued; or
- is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Terminal disclaimer fee under 37 CFR 1.20(d) is included with Electronic Terminal Disclaimer request.

I certify, in accordance with 37 CFR 1.4(d)(4), that the terminal disclaimer fee under 37 CFR 1.20(d) required for this terminal disclaimer has already been paid in the above-identified application.

Applicant claims the following fee status:

- Small Entity
- Micro Entity
- Regular Undiscounted

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

THIS PORTION MUST BE COMPLETED BY THE SIGNATORY OR SIGNATORIES

I certify, in accordance with 37 CFR 1.4(d)(4) that I am:

- An attorney or agent registered to practice before the Patent and Trademark Office who is of record in this application
 Registration Number 63176
- A sole inventor
- A joint inventor; I certify that I am authorized to sign this submission on behalf of all of the inventors as evidenced by the power of attorney in the application
- A joint inventor; all of whom are signing this request

Signature	/Steven L. Wood/
Name	Steven L. Wood

*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).
 Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

Exhibit C

REMARKS

The Non-Final Office Action mailed February 4, 2019 has been received and carefully considered. Claims 10-21 are pending in the application. Claims 1-9 were previously cancelled without waiver or disclaimer. Claims 10-21 stand rejected. Entry of the amendments to the claims and reconsideration of the outstanding rejections in the present application are requested based on the following remarks.¹ No new matter has been added.

Interview Summary

Applicant wishes to thank the Examiner for the courtesies extended during the phone interview on May 6, 2019. In accordance with MPEP § 713.04, Applicant is providing this Interview Summary. The Interview Summary includes the information listed in subsections (A) - (H) of MPEP § 713.04 under corresponding subsections herein:

(A) Exhibit. Not applicable.

(B) Claims Discussed. The status of the claims of record was discussed.

(C) Prior Art. Not applicable.

(D) Proposed Amendments. Applicant and Examiner discussed proposed amendments to clarify the claimed embodiments in view of the § 112 rejection.

(E) Arguments. The Examiner stated that the amendments should overcome the § 112 rejection. The arguments are as presented in this response.

(F) Other Pertinent Matters. None.

(G) Results or Outcome of Interview. No agreement was reached.

(H) Interview by Electronic Mail. Not applicable.

Double Patenting Rejection

On page 3 of the Office Action, **claims 10-21 stand rejected on the ground of nonstatutory double patenting** as allegedly being unpatentable over claims 1-10 of U.S. Pat. No. 9,684,500. Applicant respectfully disagrees. However, **in an effort to advance prosecution,**

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to assertions by the Examiner in the Office Action or certain requirements that may be applicable to such rejections (e.g., assertions regarding dependent claims, whether a reference constitutes prior art, whether references are legally combinable for obviousness purposes) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

Applicant is submitting herewith the appropriate terminal disclaimer. Applicant respectfully requests withdrawal of the rejection.

Claim Rejections under 35 U.S.C. § 112(b)

On page 4 of the Office Action, claims 10-21 stand rejected under 35 U.S.C. § 112(b) as allegedly being indefinite. Specifically, the claims are alleged to be hybrid claims reciting both an apparatus and method steps. Applicant respectfully disagrees. However, in an effort to advance prosecution, Applicant has amended the claims as indicated above. Applicant respectfully requests withdrawal of this rejection.

Allowable Subject Matter

Applicant thanks the Examiner for the indication of allowable subject matter in claims 10-21 contingent upon overcoming the above described rejections.

CONCLUSION

In view of the foregoing amendments and arguments, it is respectfully submitted that this application is now in condition for allowance. If the Examiner believes that prosecution and allowance of the application will be expedited through an interview, whether in-person or telephonic, the Examiner is invited to telephone the undersigned with any suggestions leading to the favorable disposition of the application.

It is believed that no fees are due for filing this Amendment. However, the Director is hereby authorized to treat any current or future reply, requiring a petition for an extension of time for its timely submission as incorporating a petition for extension of time for the appropriate length of time. Applicant also authorizes the Director to charge all required fees, fees under 37 C.F.R. §1.17, and all required extension of time fees, to the undersigned's Deposit Account No. 50-0206.

Respectfully submitted,

HUNTON ANDREWS KURTH LLP

Date: May 6, 2019

By: /Steven L. Wood/
Steven L. Wood
Registration No. 63,176

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Exhibit D



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
15/619,743	06/12/2017	LONNIE E. MARGOL	87186.000019	7091
21967	7590	02/04/2019	EXAMINER	
Hunton Andrews Kurth LLP Intellectual Property Department 2200 Pennsylvania Avenue, N.W. Washington, DC 20037			NGUYEN, NGA X	
			ART UNIT	PAPER NUMBER
			3662	
			MAIL DATE	DELIVERY MODE
			02/04/2019	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of Pre-AIA or AIA Status

1. The present application is being examined under the pre-AIA first to invent provisions.

- Claims 10-21 are pending examination. Wherein, claims 1-9 are cancelled status.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on nonstatutory double patenting provided the reference application or patent either is shown to be commonly owned with the examined application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement. See

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MPEP § 717.02 for applications subject to examination under the first inventor to file provisions of the AIA as explained in MPEP § 2159. See MPEP §§ 706.02(I)(1) - 706.02(I)(3) for applications not subject to examination under the first inventor to file provisions of the AIA. A terminal disclaimer must be signed in compliance with 37 CFR 1.321(b).

The USPTO Internet website contains terminal disclaimer forms which may be used. Please visit www.uspto.gov/patent/patents-forms. The filing date of the application in which the form is filed determines what form (e.g., PTO/SB/25, PTO/SB/26, PTO/AIA/25, or PTO/AIA/26) should be used. A web-based eTerminal Disclaimer may be filled out completely online using web-screens. An eTerminal Disclaimer that meets all requirements is auto-processed and approved immediately upon submission. For more information about eTerminal Disclaimers, refer to www.uspto.gov/patents/process/file/efs/guidance/eTD-info-I.jsp.

3. **Claims 10-21 are rejected on the ground of nonstatutory double patenting as being unpatentable over claims 1-10 of U.S. Patent No. 9684500.** Although the claims at issue are not identical, they are not patentably distinct from each other because claim 1, e.g., is generic to all that is recited in Claim 1, e.g., of the US Patent No. 9684500. In other words, Claim 1, e.g., of the US Patent No. 9684500 fully encompasses the subject matter of claim 1 and therefore anticipated.

Specifically, because the “first interface”, “second interface”, “third interface” & “fourth interface” of Claim 1 of US Paten 7978134 are species of the generic category defined by the current application’s claim 1 recites “communication device ...establishing a bi-directional communication link”.

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Claims 11-15 & 17-21 are anticipated in the Patent Claims 3-8 respectively

Claim Rejections - 35 USC § 112

4. The following is a quotation of 35 U.S.C. 112(b):

(b) CONCLUSION.—The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the inventor or a joint inventor regards as the invention.

The following is a quotation of 35 U.S.C. 112 (pre-AIA), second paragraph:
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 10-21 are rejected under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the inventor or a joint inventor, or for pre-AIA the applicant regards as the invention.

Claim 10, e.g., cites, “a method for remotely programming a subsystem of a subject vehicle, comprising: a first communication device located ...” which is indefinite because it claims both an apparatus and method steps. (See *MPEP 2173.05 (p) (II)*, “*Product and Process in the Same Claim*”).

Claims 16 have the same issue as claim 10 above.

Claims 11-15 & 17-21 are depend upon the rejected claims.

Allowable Subject Matter

6. Claims 10-21 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112(b) or 35 U.S.C. 112 (pre-AIA), 2nd paragraph and the Double Patenting, set forth in this Office action.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NGA X NGUYEN whose telephone number is (571)272-5217. The examiner can normally be reached on M-F 5:30AM - 2:30PM.

Examiner interviews are available via telephone, in-person, and video conferencing using a USPTO supplied web-based collaboration tool. To schedule an interview, applicant is encouraged to use the USPTO Automated Interview Request (AIR) at <http://www.uspto.gov/interviewpractice>.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JELANI SMITH can be reached on 571-270-3969. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

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USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NGA X NGUYEN/
Primary Examiner, Art Unit 3662

Exhibit E

<i>Applicant-Initiated Interview Summary</i>	Application No. 15/619,743	Applicant(s) MARGOL et al.		
	Examiner NGA X NGUYEN	Art Unit 3662	AIA (First Inventor to File) Status No	Page 1 of 1
<p>All participants (applicant, applicants representative, PTO personnel):</p> <p>1. NGA X NGUYEN (Primary Examiner); Telephonic 2. Steven Wood (Attorney); Telephonic</p> <p>Date of Interview: <u>06 May 2019</u></p> <p>Amendment proposed: Applicant proposed to amend claim 10 apparently to overcome the current 112 Rejection.</p> <p>Brief Description of the main topic(s) of discussion: Examiner agrees to withdraw the 112 Rejection based on the proposed amendment. Applicant will file a Terminal Disclaimer for overcome the Double Patent Rejection, and allow the case. Examiner agrees since the current Office Action indicates allowable objection.</p> <hr/> <p style="text-align: center;">Issues Discussed:</p> <p>Proposed Amendments: See the attachment.</p>				
/NGA X NGUYEN/ Primary Examiner, Art Unit 3662				
<p>Applicant is reminded that a complete written statement as to the substance of the interview must be made of record in the application file. It is the applicants responsibility to provide the written statement, unless the interview was initiated by the Examiner and the Examiner has indicated that a written summary will be provided. See MPEP 713.04</p> <p>Please further see: MPEP 713.04 Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews, paragraph (b) 37 CFR § 1.2 Business to be transacted in writing</p>				

Applicant recordation instructions: The formal written reply to the last Office action must include the substance of the interview. (See MPEP section 713.04). If a reply to the last Office action has already been filed, applicant is given a non-extendable period of the longer of one month or thirty days from this interview date, or the mailing date of this interview summary form, whichever is later, to file a statement of the substance of the interview.

Examiner recordation instructions: Examiners must summarize the substance of any interview of record. A complete and proper recordation of the substance of an interview should include the items listed in MPEP 713.04 for complete and proper recordation including the identification of the general thrust of each argument or issue discussed, a general indication of any other pertinent matters discussed regarding patentability and the general results or outcome of the interview, to include an indication as to whether or not agreement was reached on the issues raised.

Exhibit F

RE: 6:21-cv-00819; Repairify, Inc. v. Keystone Automotive Industries- Rule 60 motion for relief from order re Elitek's motion to dismiss

Vijay Toke <vtoke@prangerlaw.com>

Thu 5/30/2024 7:36 PM

To: Jason Keener <jkeener@irwinip.com>

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//EXTERNAL//

Dear Jason,

Following up on our meet and confer call on Tuesday about our proposed motion for relief from Judge Albright's order granting Elitek's motion to dismiss Counts II and III of the operative complaint, our grounds are as follows:

- Transfer of ownership of patents need not be only by written assignment; operation of law can also successfully transfer patent ownership. *See, e.g., Azakawa v. Link New Technology Intern. Inc.*, 520 F.3d 1354, 1358 (Fed. Cir. 2008)(holding that assignment is not the only way to transfer patent ownership and that operation law, there Japanese intestacy law, could transfer patent ownership)
- In the patent context bankruptcy courts and courts of equity have the power to order assignment of legal title from the original owner to the receiver or trustee according to the requirements of the patent statutes, thus vesting the receiver or trustee with the right to bring suit for infringement. *Morrow v. Microsoft Corp.*, 499 F.3d 1332, 1337 (Fed. Cir. 2007).
- The Middle District of Florida's final sale order effected a final and effective transfer of AES's patent assets. *St. Pierre v. Dyer*, 208 F.3d 394, 399 (2d Cir. 2000)(a final judgment of a United States Bankruptcy Court is *res judicata* as to all matters properly before it that are necessary to that final judgment and that were or could have been litigated in the proceeding.); *TM Patents, L.P. v. Intl. Business Machines Corp.*, 121 F.Supp.2d 349, 360 (S.D.N.Y., Nov. 13, 2000); *In re O'Dwyer*, 611 Fed.Appx. 195, 199 (5th Cir. 2015)(sale order constitutes final transfer of debtor bankruptcy estate to bona fide purchaser for value that cannot be reviewed on appeal if not stayed).

- Ignoring the Middle District of Florida's final sale order's transfer of assets to Repairify renders the '500 a valid and subsisting patent with no owner, or at least not an owner with enforceable rights in a patent it lawfully purchased in a bankruptcy court and that the bankruptcy court ratified and effected. That amounts to an unlawful taking without due process. See, e.g., *See, e.g., Johnson & Johnson, Inc. v. Wallace A. Erickson & Co.*, 627 F.2d 57, (7th Cir. 1980)(observing patents are property right of which an owner cannot be deprived without due process of law and holding that a court's forcing a patent owner to seek reissuance of a patent prior to adjudication on the merits of the patent's validity would constitute an unlawful taking).

Please let us know if based on these points and authorities Elitek will agree that the motion to grant its motion to dismiss should be reversed, and that Counts II and III of the complaint should be added back into the case. If not, we propose the same briefing schedule set by the Court for your '334 MSJ. Please let us know if you agree with that briefing timeline. Thank you.

Best,

Vijay

Vijay K. Toke
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From: Jason Keener <jkeener@irwinip.com>

Sent: Wednesday, May 29, 2024 12:31 PM

To: Nick Woloszczuk <nwoloszczuk@prangerlaw.com>; Vijay Toke <vtoke@prangerlaw.com>; Arthur Wellman <AWellman@prangerlaw.com>

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Subject: Re: 6:21-cv-00819; Repairify, Inc. v. Keystone Automotive Industries-'334 Patent

[CAUTION: EXTERNAL EMAIL]