

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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Robert Bosch LLC and Daimler AG,  
Petitioners,

v.

Orbital Engine Company Pty Limited,  
Patent Owner

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Case No. IPR2015-01258  
U.S. Patent No. 5,655,365

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**JOINT NOTICE TO THE BOARD REGARDING  
THE BERNHARDT EXHIBIT**

Pursuant to the Board’s Authorization For Petitioner to File a Motion to Submit Supplemental Information 37 C.F.R. § 42.123 dated March 31, 2016 (“the Board’s Authorization”), Petitioners Robert Bosch LLC and Daimler AG and Patent Owner Orbital Engine Company Pty Limited (collectively “the Parties”) submit to the Board this Joint Notice<sup>1</sup> regarding Exhibit 1002 (“the Bernhardt Exhibit”) as submitted with the Petition.

The Board ordered the parties to “meet and confer in good faith to discuss Patent Owner’s objections to the Bernhardt Exhibits in light of the supplemental evidence and to discuss any potential resolution of the issue of admissibility of the Bernhardt Exhibits.” Board’s Authorization at 2-3. Pursuant to the Board’s order, the Parties met and conferred on April 5, 2016, and have reached an agreement regarding the Bernhardt Exhibit.

In particular, Patent Owner agrees to withdraw its authenticity objections to the Bernhardt Exhibit under FRE 901 and 902 and its hearsay objections to the Bernhardt Exhibit under FRE 801-807, as asserted in Patent Owner’s First

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<sup>1</sup> The last paragraph of the Board’s Authorization indicates that “each party” shall file papers relating to any agreement, however, in light of the preceding paragraph inviting “the parties” to file “a paper” relating to any agreement, the Parties are submitting this Joint Notice.

Objections to Evidence Pursuant to 37 C.F.R. § 42.64, dated January 13, 2016

(Paper 14). Patent Owner also agrees that it will not submit in the IPR2015-01258 proceeding any arguments challenging the admissibility of the Bernhardt Exhibit in a motion to exclude, at the Oral Hearing, or at any other time in the IPR2015-01258 proceeding, including in any appeal of a final written decision.

Patent Owner does not waive its right to object to the admissibility of the Bernhardt Exhibit in any other proceedings before the USPTO, a federal district court, or any other adjudicative body.

Dated: April 8, 2016

By: /Aaron L. Parker/  
Aaron L. Parker, Reg. No. 50,785  
Backup Counsel for Petitioners

/David M. Magee/  
David M. Magee, Reg. No. 51,892  
Counsel for Patent Owner

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing **JOINT NOTICE TO THE BOARD REGARDING THE BERNHARDT EXHIBIT** was served on April 8, 2016, via email directed to counsel of record for the Patent Owner at the following:

David Magee  
mageed@pepperlaw.com

Andrew Schultz  
schultza@pepperlaw.com

Dated: April 8, 2016

/Lisa C. Hines/  
Lisa C. Hines  
Litigation Clerk

FINNEGAN, HENDERSON, FARABOW,  
GARRETT & DUNNER, LLP