

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT and
BMW OF NORTH AMERICA, LLC,
Petitioners,

v.

PAICE LLC and THE ABELL FOUNDATION, INC.,
Patent Owners.

Case IPR2020-00994
Patent 7,104,347

PATENT OWNERS' NOTICE OF APPEAL

Pursuant to 35 U.S.C. §§ 142 and 37 C.F.R. § 90.2(a), Patent Owner, Paice LLC and the Abell Foundation, Inc., hereby appeal to the United States Court of Appeals for the Federal Circuit from the Patent Trial and Appeal Board's ("Board") Final Written Decision entered on November 10, 2021 (Paper 48), and from all other underlying orders, decisions, rulings and opinions that are adverse to Patent Owner including, without limitation, those within the Decision on Institution of Inter Partes Review entered on November 19, 2020 (Paper 19).

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Patent Owner indicates that the issues on appeal include, but are not limited to:

- (1) the Board's decision that challenged claims 2, 11, 17, 24, 33, and 38 were unpatentable under 35 U.S.C. §103(a) as being obvious in view of the cited prior art;
- (2) the Board's interpretation of the limitation "monitor[s] patterns of vehicle operation over time and varies said setpoint SP accordingly" found in claims 2 and 24.
- (3) the Board's reliance on conclusory and insufficient expert testimony;
- (4) the Board's interpretation of the prior art;
- (5) the Board's legal errors in undertaking the aforementioned obviousness analyses;
- (6) the Board's findings that conflict with the evidence of record or are that are otherwise not supported by substantial evidence.

(7) the Board's failure to consider the evidence of record fully and properly;

and

(8) any findings or determinations supporting or related to the
aforementioned issues as well as other issues decided adversely to Patent
Owner in any order, decisions, rulings, or opinions.

Simultaneous with this submission, a copy of the Notice of Appeal is being
filed electronically with the Patent Trial and Appeal Board. In addition, a copy of
this Notice of Appeal, along with the required docketing fees, are being
electronically filed with the Clerk's Office for the United States Court of Appeals
for the Federal Circuit.

Respectfully submitted,

Date: January 10, 2022

/Brian J. Livedalen/
Brian J. Livedalen, Reg. No. 67,450

Attorney for Patent Owner

CERTIFICATE OF SERVICE

Pursuant to 37 CFR §§ 42.6(e)(4), the undersigned certifies that on January 10, 2022, a complete and entire copy of this Patent Owner's Notice of Appeal was provided via email to the Petitioner by serving the correspondence email addresses of record as follows:

Jeffrey D. Sanok
Vincent J. Galluzzo
Crowell & Moring LLP
Intellectual Property Group
1001 Pennsylvania Avenue, N.W.
Washington, DC 20004-2595

Scott L. Bittman
Jacob Z. Zambrzycki
Crowell & Moring LLP
Intellectual Property Group
590 Madison Avenue, 20th Floor
New York, NY 10022-2544

Email: jsanok@crowell.com
Email: vgalluzzo@crowell.com
Email: sbittman@crowell.com
Email: jzambrzycki@crowell.com

/Kristyn Waldhauser/
Kristyn Waldhauser
Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis MN 55402
(612) 638-5731

I hereby certify that, in addition to being filed electronically through the Board's E2E System, the original version of the foregoing Notice of Appeal, was filed by hand on January 10, 2022, with the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
Madison Building East, 1 OB20
600 Dulany Street
Alexandria, VA 22314-5793

I hereby certify that on January 10, 2022, a true and correct copy of the foregoing Notice of Appeal, along with a copy of the Final Written Decision, was filed electronically with the Clerk's Office of the United States Court of Appeals for the Federal Circuit, at the following address:

United States Court of Appeals for the Federal Circuit
717 Madison Place, N.W., Suite 401
Washington, DC 20005

/Brian J. Livedalen/

Brian J. Livedalen, Reg. No. 67,450
Fish & Richardson P.C.
60 South Sixth Street, Suite 3200
Minneapolis, MN 55402
(612) 335-5070