

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAYERISCHE MOTOREN WERKE, AKTIENGESELLSCHAFT &
BMW OF NORTH AMERICA, LLC,
Petitioner,

v.

PAICE LLC & THE ABELL FOUNDATION, INC.,
Patent Owner.

IPR2020-00994
Patent 7,104,347 B2

Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
37 C.F.R. § 42.5

A conference call was held on September 30, 2020 between Judges Peslak, Medley, and Deshpande and counsel for Petitioner and Patent Owner. A court reporter transcribed the call.

During the call, Petitioner requested leave to file a Reply to the Patent Owner Preliminary Response to address arguments raised by Patent Owner that we should exercise our discretion to deny institution under 35 U.S.C. § 314(a). Patent Owner opposed the request but requested that, if we grant Petitioner's request, Patent Owner be allowed to file a Sur-Reply.

After consideration of the arguments of the parties and for good cause shown,

It is:

ORDERED that Petitioner may file a seven-page Reply brief limited to legal argument responding to the discretionary denial issues raised in the Patent Owner Response no later than October 7, 2020;

FURTHER ORDERED that Patent Owner may thereafter file a seven-page Sur-Reply brief limited to legal argument no later than October 14, 2020;

FURTHER ORDERED that neither party is authorized to file any evidence in connection with the aforementioned briefs; and

FURTHER ORDERED that Petitioner shall file a copy of the court reporter's transcript of the conference call when it becomes available.

IPR2020-00994
Patent 7,104,347 B2

FOR PETITIONER:

Jeffrey D. Sanok
Vincent J. Galluzzo
Scott L. Bittman
Jacob Z. Zambrzycki
CROWELL & MORING LLP
jsanok@crowell.com
vgalluzzo@crowell.com
sbittman@crowell.com
jzambrzycki@crowell.com

FOR PATENT OWNER:

Ruffin B. Cordell
Indranil Mukerji
Brian J. Livedalen
FISH & RICHARDSON P.C.
cordell@fr.com
mukerji@fr.com
livedalen@fr.com
IPR36351-0004IP1@fr.com
PTABInbound@fr.com