

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 IPR2020-01299
Patent 8,630,761

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 January 3, 2022 (Paper 35), 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 January 15, 2021 (Paper 10).

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 1-12 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 "pattern of operation of said hybrid vehicle" and "a predicted near-term pattern of operation of said hybrid vehicle" found in claim 1 and "pattern of operation of said hybrid vehicle" and "predicts a near-term pattern of operation of said hybrid vehicle" found in claim 7.
- (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: March 4, 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 March 4, 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:

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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 March 4, 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 March 4, 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
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