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' RESPONSE

DOCKET

TABLE OF CONTENTS

I. INTRODUCTION
II. TECHNOLOGY OVERVIEW5
A. The '761 Patent and File History5
B. Overview of Severinsky's Parallel Hybrid vs. Nii's Series Hybrid10
III. CLAIM CONSTRUCTION15
IV. BMW'S GROUNDS FAIL TO DEMONSTRATE OBVIOUSNESS22
 A. Ground 1 Based on Severinsky in View of Quigley Is Deficient (Claims 1-12)
 Severinsky in view of Quigley fails to teach or suggest "deriv[ing] a predicted near-term pattern of operation of said hybrid vehicle" (Claim 1)22
2. No reason to combine Severinsky and Quigley
 Severinsky in view of Quigley fails to teach or suggest "wherein said derived predicted pattern of operation comprises at least one repetitive pattern of operation of said hybrid vehicle." (Claims 2 and 8)
 Severinsky in view of Quigley fails to teach or suggest "wherein said controller monitors variation in road load experienced by said hybrid vehicle and compares patterns of variation in road load experienced from day to day in order to identify said repetitive patterns of operation of said hybrid vehicle." (Claims 4 and 10)
B. Ground 2 Based on Severinsky in View of Nii Is Deficient (Claims 1-12)44
 Severinsky in view of Nii fails to teach or suggest "deriv[ing] a predicted near-term pattern of operation of said hybrid vehicle"44
2. No reason to combine Severinsky and Nii48

3. Severinsky in view of Nii fails to teach or suggest "wherein said derived predicted pattern of operation comprises at least one repetitive pattern of
operation of said hybrid vehicle." (Claims 2 and 8)59
4. Severinsky in view of Nii fails to teach or suggest "wherein said controller monitors variation in road load experienced by said hybrid vehicle and compares patterns of variation in road load experienced from day to day in order to identify said repetitive patterns of operation of said hybrid vehicle." (Claims 4 and 10)
C. Ground 3 Based on Severinsky in View of Graf Is Deficient (Claims 1-2, 5- 8, 11-12)
1. Severinsky in view of Graf fails to teach or suggest "deriv[ing] a predicted near-term pattern of operation of said hybrid vehicle"62
V. CONCLUSION

EXHIBIT LIST

Exhibit Number	Description
2001	BMW's Opening Claim Construction Brief from <i>Paice LLC</i> and the Abell Foundation v. Bayerische Motoren Werke Aktiengesellschaft and BMW of North AmericA, LLC, Civil Action No. 19-CV-3348-SAG, filed August 7, 2020
2002	Docket Navigator Statistics – Top Patents by Number of IPRs
2003	Printout of http://www.paicehybrid.com/licensing- agreements/
2004	Scheduling Order [Docket No. 36] from <i>Paice LLC and the</i> <i>Abell Foundation v. Bayerische Motoren Werke</i> <i>Aktiengesellschaft and BMW of North America, LLC</i> , Civil Action No. 1:19-cv-03348-SAG (USDC-DMD) dated February 25, 2020
2005	Ex. P to BMW Invalidity Contentions dated June 8, 2020
2006	BMW's Responsive Claim Construction Statement from Paice LLC and the Abell Foundation v. Bayerische Motoren Werke Aktiengesellschaft and BMW of North America, LLC, Civil Action No. 19-CV-3348-SAG, served August 7, 2020
2007	Markman Order from Paice LLC and the Abell Foundation v. Bayerische Motoren Werke Aktiengesellschaft and BMW of North America, LLC, Civil Action No. 19-CV-3348- SAG, filed October 26, 2020
2008-2015	Reserved
2016	Declaration of Mahdi Shahbakhti, Ph.D.
2017	Curriculum Vitae of Mahdi Shahbakhti, Ph.D.
2018-2019	Reserved
2020	Selected Pages From Merhdad Ehsani et al, Modern Electric, Hybrid Electric, and Fuel Cell Vehicles
2021	Reserved

• • •

2022-2028	Reserved
2029	Oxford Dictionary
2030	The Illustrated Dictionary of Electronics
2031	Encarta World English Dictionary
2032	Handbook of Air Pollution From Internal Combustion Engines
2033	Guzzella et al., Vehicle Propulsion Systems
2034	Deposition Transcript of Gregory Davis, Ph.D.
2035	BMW's Reply Claim Construction Brief from <i>Paice LLC</i> and the Abell Foundation v. Bayerische Motoren Werke Aktiengesellschaft and BMW of North AmericA, LLC, Civil Action No. 19-CV-3348-SAG, filed August 7, 2020

DOCKET A L A R M



Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.