

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

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

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Case IPR2020-01299  
Patent 8,630,761

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**PATENT OWNERS' IDENTIFICATION OF NEW EVIDENCE AND  
ARGUMENTS BEYOND THE PROPER SCOPE OF PETITIONERS'  
REPLY**

### EXHIBIT LIST

Exhibit Number	Description
2001	BMW's Opening Claim Construction Brief from <i>Paice LLC and the Abell Foundation v. Bayerische Motoren Werke Aktiengesellschaft and BMW of North America, LLC</i> , Civil Action No. 19-CV-3348-SAG, filed August 7, 2020
2002	Docket Navigator Statistics – Top Patents by Number of IPRs
2003	Printout of <a href="http://www.paicehybrid.com/licensing-agreements/">http://www.paicehybrid.com/licensing-agreements/</a>
2004	Scheduling Order [Docket No. 36] from <i>Paice LLC and the Abell Foundation v. Bayerische Motoren Werke 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 <i>Paice LLC and the Abell Foundation v. Bayerische Motoren Werke Aktiengesellschaft and BMW of North America, LLC</i> , Civil Action No. 19-CV-3348-SAG, served August 7, 2020
2007	<i>Markman</i> Order from <i>Paice LLC and the Abell Foundation v. Bayerische Motoren Werke Aktiengesellschaft and BMW of North America, LLC</i> , 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 and the Abell Foundation v. Bayerische Motoren Werke Aktiengesellschaft and BMW of North America, LLC</i> , Civil Action No. 19-CV-3348-SAG, filed August 7, 2020

## **I. Introduction**

Pursuant to the Board's authorization of July 14, 2021, Patent Owners identify the following arguments and/or evidence filed with the Petitioner Reply that is beyond the proper scope of the Reply.<sup>1</sup>

### **A. New Arguments and Evidence Regarding Graf (Ground 3)**

Ex. 1090 is new evidence not presented in BMW's Petition. BMW's reply relies on Ex. 1090 (a translation of foreign patent EP 0,576,703) to argue that Graf discloses "wherein said controller derives a predicted near-term pattern of operation of said hybrid vehicle by monitoring operation of said hybrid vehicle." Reply, 26-28. Graf explicitly references Ex. 1090 in its specification, but BMW did not submit Ex. 1090 or make any arguments concerning its disclosure or relevance to Graf in its Petition.

BMW's arguments at Section III.C of its reply focus primarily on the disclosure of Ex. 1090, which was not included in BMW's Petition. BMW's reliance on Ex. 1090 to supplement the disclosure of Graf included in the Petition is new argument. Likewise, paragraphs 82-87 of Dr. Davis's reply declaration (Ex.

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<sup>1</sup> Patent Owners reserve the right to address in their Sur-reply other new/improper arguments and evidence contained in BMW's Reply.

1088) consist of new opinions relying on Ex. 1090 to supplement his opinions about Graf's disclosure.

Respectfully submitted,

Date: July 21, 2021

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