

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 &  
BMW OF NORTH AMERICA, LLC**  
Petitioners

v.

**PAICE LLC & THE ABELL FOUNDATION, INC.**  
Patent Owners

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*Inter Partes* Review No.: IPR2020-01299

U.S. Patent No. 8,630,761

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**PETITIONERS' RESPONSE IDENTIFYING ISSUES RAISED IN THE  
PATENT OWNER RESPONSE OR THE INSTITUTION DECISION TO  
WHICH THE EVIDENCE AND/OR ARGUMENTS IDENTIFIED BY  
PATENT OWNERS RESPONDS**

Pursuant to the Board's authorization of July 14, 2021, Petitioners hereby respond to PO's identification of arguments and/or evidence that it believes are beyond the proper scope of the Reply.

As already detailed in Section III.C of BMW's Reply, Petitioner's Reply arguments, "Graf '703" (BMW1090) and Dr. Davis's reply declaration (BMW1088) at ¶¶82-87 directly respond to the issues raised in the Institution Decision whether Graf provides any "explicit disclosure as to how the driving style of performance or economy modes is determined in Figure 2," and whether "any monitoring of a driver's operation [] result[s] in an input to block 2, where the determination of the driving style is made, or that Graf derives an expected pattern of operation by monitoring operation of the vehicle." ID, 35.<sup>1</sup> Petitioner's Reply specifically responded to those issues, including by specifying where the Petition and Dr. Davis originally cited to Graf's disclosure identifying EP 0,576,703 (Graf '703 / BMW1090) as a known implementation example of how the "driver type" classification—*used by block 2*—is made. Reply, 27, citing BMW1020, 5:36-42; Pet., 64; BMW1008, ¶350.

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<sup>1</sup> The Trial Practice Guide, (p. 73) states: "[I]n response to issues arising from the Supreme Court's decision in *SAS* (138 S. Ct. at 1358), the Board will permit the petitioner, in its reply brief, to address issues discussed in the institution decision.... A party also may submit rebuttal evidence in support of its reply."

Petitioner's Reply, Ex. 1090, and Dr. Davis's reply declaration at ¶¶82-87,  
are thus in direct response to the issues raised in the ID indicated above.<sup>2</sup>

Dated: July 28, 2021

Respectfully submitted,

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<sup>2</sup> PO's statement indicates that it will be filing a Sur-Reply. PO will be able to respond to the substance of Petitioners' arguments and evidence in that document.

**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6(e)(4), I certify that the foregoing  
PETITIONERS' RESPONSE IDENTIFYING ISSUES RAISED IN THE  
PATENT OWNER RESPONSE OR THE INSTITUTION DECISION TO  
WHICH THE EVIDENCE AND/OR ARGUMENTS IDENTIFIED BY PATENT  
OWNERS RESPONDS was served electronically by filing this document through  
the PTAB E2E system, as well as by e-mailing copies to the following address for  
counsel of record for Patent Owners:

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Dated: July 28, 2021

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