

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' SUR-REPLY

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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 http://www.paicehybrid.com/licensing-agreements/
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

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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

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I. INTRODUCTION

In lieu of addressing the salient issues that go to patentability of the Challenged Claims of the '761 patent, BMW's reply improperly shifts the goal posts by ignoring key claim limitations and the obviousness framework.

First, it is undisputed that the Challenged Claims derive an *expected* pattern of operation, *i.e.*, a pattern of operation that the vehicle is going to follow in the future (as opposed to past vehicle behavior). BMW admits "the Challenged Claims require that the vehicle's controller monitor operation of the particular vehicle and use that data to predict future operational patterns and alter vehicle operation accordingly." Reply, 3 None of the prior art, however, derives an *expected pattern* of vehicle operation. At best, they derive a single data point such as average distance or average power. BMW cannot remedy the prior art's shortcomings by stripping the word "pattern" of its meaning. The word "pattern" is not a generic placeholder, or nonce term as BMW submits.

Second, BMW remains unable to explain *how* or *why* a POSA could combine the prior art. BMW assumes that its combinations miraculously result in "the optimization of the controller settings to be reflective of actual driving conditions and the increase in fuel efficiency." Reply, 1. Yet, BMW remains unable to explain how the teachings of any of the secondary references would actually improve Severinsky. To the contrary, BMW admits that using patterns of

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