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' REQUEST FOR ORAL ARGUMENT



Proceeding No. IPR2020-01299

Attorney Docket No. 36351-0017IP1

Pursuant to 37 C.F.R. § 42.70(a) and the Scheduling Order (Paper 11), Paice

LLC and the Abell Foundation, Inc. (Patent Owners) submit this Request for Oral

Argument on all of the instituted grounds of unpatentability of U.S. Patent No.

8,630,761. Patent Owners request (without waiving consideration of any issue not

listed below) to address the grounds on which the IPR was instituted and any

additional issues on which the Board seeks clarification. Patent Owners request 60

minutes for each side to present arguments collectively for this proceeding. Due to

the substantial overlap in issues and prior art, Patent Owners respectfully request

that the Board refrain from issuing its Final Written Decision in IPR2020-00994

until after the oral argument in this proceeding as well as the oral argument in

IPR2020-01386 scheduled for November 9, 2021.

To the extent the oral argument, which will be held October 19, 2021, is

scheduled as an in-person hearing, Patent Owners request to use video equipment

to display exhibits, including the use of a projector/screen for a PowerPoint display

or the like.

Respectfully submitted,

Dated: September 7, 2021

/Brian J. Livedalen/

Brian J. Livedalen, Reg. No. 67,450

Attorney for Patent Owner

Fish & Richardson P.C.

Telephone: (612) 337-2569

Facsimile: (612) 288-9696



Find authenticated court documents without watermarks at docketalarm.com.

## **CERTIFICATE OF SERVICE**

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on September 7, 2021, a complete and entire copy of this Patent Owner's Request for Oral Argument was provided via email, to the Petitioner by serving the email correspondence addresses of record as follows:

Jeffrey D. Sanok
Vincent J. Galluzzo
Crowell & Moring LLP
Intellectual Property Group
1001 Pennsylvania Avenue, N.W.
Washington, DC 20004-2595

Scott L. Bittman
Jacob Z. Zambrzycki
Crowell & Moring LLP
Intellectual Property Group
590 Madison Avenue, 20<sup>th</sup> Floor
New York, NW 10022-2544

## Email:

jsanok@crowell.com vgalluzzo@crowell.com sbittman@crowell.com jzambrzycki@crowell.com

/Kristyn Waldhauser/
Kristyn Waldhauser
Fish & Richardson P.C.
3200 RBC Plaza
60 South Sixth Street
Minneapolis, MN 55402
(612) 638-5731

