

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,  
Petitioner,

v.

PAICE LLC & THE ABELL FOUNDATION, INC.,  
Patent Owner.

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IPR2020-00994 (Patent 7,104,347 B2)  
IPR2020-01299 (Patent 8,630,761 B2)  
IPR2020-01386 (Patent 7,237,634 B2<sup>1</sup>)

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Before SALLY C. MEDLEY, KALYAN K. DESHPANDE, and  
ARTHUR M. PESLAK, *Administrative Patent Judges*.

PESLAK, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 C.F.R. § 42.5

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<sup>1</sup> The parties are not authorized to use this caption in any subsequent filings.

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A conference call was held on March 5, 2021 between Judges Medley, Deshpande, and Peslak and counsel for Petitioner and Patent Owner to discuss Patent Owner's March 1, 2021 email to the Board. Ex. 3001. In that email, Patent Owner requested that the Scheduling Orders entered in each of the three cases be substantially modified in order to have one consolidated oral hearing on September 1, 2021 for all three cases. *Id.* Petitioner opposed the request.

Patent Owner requested a consolidated oral hearing in order to “to conserve party and Board resources.” Ex. 3001. Petitioner argued that the savings in resources would be minimal because each case involves a different patent with different claims necessitating, *inter alia*, multiple depositions of the parties' declarants. For the following reasons, we deny Patent Owner's request to modify any of the current Scheduling Orders.

First, we agree with Petitioner that any savings in Board or party resources by having one consolidated hearing is minimal at best. With respect to Board resources, because three separate patents with different claims are involved in these cases, the Board must separately analyze the evidence in each case and issue three final written decisions. Patent Owner did not assert in the email or during the telephone conference that the actual time consumed by attending one hearing would be any less than the time consumed by attending a separate hearing on each patent. The savings in Board resources by having one hearing is therefore *de minimis* and does not constitute good cause to revise the Scheduling Orders.

Second, we entered the Scheduling Order in IPR2020-00994 over three months ago on November 19, 2020. IPR2020-00994, Paper 20. Patent Owner filed its Response to the Petition on February 11, 2021 in accordance

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with the Scheduling Order without any mention of a request to modify the Scheduling Order. *Id.*, Paper 22. The oral hearing for IPR2020-00994, if requested by the parties, is scheduled for August 19, 2021 some two weeks prior to Patent Owner's proposed September 1, 2021 date. *Id.* Paper 20, 11. Delaying the oral hearing at this late date would inconvenience the Board and impact our ability to orderly process and issue our Final Written Decision by the statutory deadline of November 19, 2021. Any potential savings in either Board or party resources does not outweigh the inconvenience to the Board if we were to modify the schedule.

Accordingly, it is:

ORDERED that Patent Owner's request to modify the Scheduling Orders in IPR2020-00994, IPR2020-01299, and IPR2020-01386 is *denied*; and

FURTHER ORDERED that the Scheduling Orders previously entered in IPR2020-00994, IPR2020-01299, and IPR2020-01386 remain in full force and effect.

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