

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 IPR2020-01386
Patent 7,237,634

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

EXHIBIT LIST

Exhibit No.	Description
PAICE 2001	Patent Owners' Preliminary Response to Petition for IPR in IPR2015-0722 Dated August 10, 2015
PAICE 2002	Patent Owner's Preliminary Response to Petition in IPR2015-00787 dated August 10, 2015
PAICE 2003	Patent Owner's Preliminary Response to Petition in IPR2015-00791 dated August 10, 2015
PAICE 2004	Statutory Disclaimer
PAICE 2005	Reserved
PAICE 2006	Response to Interrogatory 27, BMW Responses to PAICE 1st Set of Interrogatories [1-28] dated May 6, 2020
PAICE 2007	Paice/Toyota Complaint dated June 8, 2004
PAICE 2008	Paice/Toyota Amended Complaint dated July 3, 2007
PAICE 2009	Scheduling Order [Docket No. 36] from 1:19-cv-03348-SAG (USDC-DMD) dated February 25, 2020
PAICE 2010	Docket Navigator Statistics – Top Patents by Number of IPRs
PAICE 2011	Ex. J to BMW Invalidity Contentions dated June 8, 2020
PAICE 2012	Reserved
PAICE 2013	IPR2017-00232 Petition dated November 14, 2016
PAICE 2014	UK Patent Application GB 2,318,105 Cover Page
PAICE 2015	Printout of http://www.paicehybrid.com/licensing-agreements/
PAICE 2016	Declaration of Mahdi Shahbakhti, Ph.D.
PAICE 2017	Curriculum Vitae of Mahdi Shahbakhti, Ph.D.
PAICE 2018	Bosch Gasoline-engine Management
PAICE 2019	Selected Pages From John Heywood, Internal Combustion Engines Fundamentals
PAICE 2020	Selected Pages From Merhdad Ehsani et al, Modern Electric, Hybrid Electric, and Fuel Cell Vehicles
PAICE 2021	Matthew Cuddy et al., Analysis of the Fuel Economy Benefit of Drivetrain Hybridization
PAICE 2022	Selected Pages From Draft Technical Assessment Report: Midterm Evaluation of Light-Duty Vehicle Greenhouse Gas Emission Standards and Corporate Average Fuel Economy Standards for Model Years 2022-2025
PAICE 2023	Selected Pages From Assessment of Fuel Economy of Fuel Economy Technologies for Light Duty Vehicles

PAICE 2024	Selected Pages From Richard Stone, Introduction to Internal Combustion Engines
PAICE 2025	Reserved
PAICE 2026	Reserved
PAICE 2027	Reserved
PAICE 2028	Guzzella et al., Introduction to Modeling Control of Internal Combustion Engine Systems
PAICE 2029	Reserved
PAICE 2030	Reserved
PAICE 2031	Reserved
PAICE 2032	Reserved
PAICE 2033	Guzzella et al., Vehicle Propulsion Systems
PAICE 2034	Bumby, J.R. et al., "Optimisation and control of a hybrid electric car," IEE PROCEEDINGS, Vol. 134, Pt. D, No. 6 (Nov. 1987), 373-87 ("Bumby II")

I. Introduction

Pursuant to the Board's Authorization of August 10, 2021, Patent Owners identify the following arguments and/or evidence filed with the Petitioner Reply that is beyond the proper scope of the Reply.¹

A. New Arguments and Evidence Regarding Graf (Grounds 3, 4-9)

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 "monitoring patterns of vehicle operation over time." Reply, 22-24.

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 IV 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 99-103 of Dr. Davis's reply declaration (Ex. 1088) consist of new opinions relying on Ex. 1090 to supplement his opinions about Graf's disclosure.

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

B. New Arguments and Evidence Regarding Severinsky (Grounds 1-9)

BMW's assertions that "Severinsky's speed-based thresholds correlate to torque-based thresholds" and "'speed thresholds' are also torque thresholds by their very nature" (Reply, 11) are new arguments. BMW's Petition relied on speed thresholds (Petition, 22), but did not explain any relationship between "speed thresholds" and "torque thresholds." Likewise, paragraphs 7-26 of Dr. Davis's reply declaration (Ex. 1088) consist of new opinions making the same argument about the purported relationship between "speed thresholds" and "torque thresholds." In addition, Dr. Davis relies on Bumby II (Ex. 1015), an SAE paper (Ex. 1091), and the Ehsani textbook (Ex. 1092) in attempt to support this argument. Ex. 1088, ¶¶ 14-22. Neither BMW nor Dr. Davis reference or discuss Ex. 1015, Ex. 1091, or Ex. 1092 in support of these grounds in BMW's Petition.

Respectfully submitted,

Date: August 17, 2021

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