

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

**BAYERISCHE MOTOREN WERKE AKTIENGESELLSCHAFT & BMW
OF NORTH AMERICA, LLC,**
Petitioners

v.

PAICE LLC & THE ABELL FOUNDATION, INC.
Patent Owners

Inter Partes Review No.: IPR2020-01386

U.S. Patent No. 7,237,634

PETITIONERS' REQUEST FOR ORAL ARGUMENT

Pursuant to the Board's Scheduling Order dated February 5, 2021 (Paper 14), Petitioners Bayerische Motoren Werke Aktiengesellschaft & BMW of North America, LLC ("BMW") respectfully request oral argument in the above-identified proceeding, currently scheduled for November 9, 2021.

In view of the essentially identical claim limitations, and the substantially similar arguments concerning those limitations, at issue in the Nii-based Grounds (Grounds 1, 4-9), Graf-based Grounds (Grounds 3, 4-9), and Ma-based Grounds (Grounds 7, 10-14) in this IPR that were in IPR2020-00994 concerning U.S. Patent No. 7,104,347 (Nii: Grounds 3a and 3b; Graf: Grounds 1a and 2a; Ma: Grounds 1b and 2b), in which oral argument has already taken place, BMW proposes limiting each side to 30 minutes for oral argument. *See* PTAB Consolidated Trial Practice Guide (November 2019), at 81-82 (Though the "Board expects to ordinarily provide for an hour of argument per side for a single proceeding," a party "may request...less time depending on the circumstances."). This provides the parties sufficient time to address the remaining Quigley-based Grounds 2 and 4-9 that were not at issue in IPR2020-00994, as well as to make any additional points and answer any remaining questions the Board may have regarding the Nii-, Graf-, and Ma-based Grounds.

Pursuant to 37 C.F.R. § 42.70(a), and without waiving the right to raise any additional issues not listed below, BMW requests that the oral hearing be on the following issues:

1. Any issues raised in BMW's Petition and Reply, including whether any of the challenged claims of U.S. Patent No. 7,237,634 are unpatentable over one or more of the asserted Grounds;
 2. Any issues raised in the Board's Institution Decision (Paper 13);
 3. Any issues raised by Patent Owners Paice, LLC and The Abell Foundation, Inc. ("Paice") in these proceedings, including the Patent Owner Response and Patent Owner Sur-Reply in this proceeding;
 4. Any other issues raised by BMW, Paice, or the Board during these proceedings;
 5. Any Motions to Exclude Evidence filed by BMW or Paice;
 6. Any other motions or filings pending before this Board;
 7. Any additional issues raised by Paice in its Request for Oral Argument;
- and
8. Any additional issues raised by this Board or Paice at Oral Argument.

Petitioners' Request for Oral Argument, IPR2020-01386
U.S. Patent No. 7,237,634

Respectfully submitted,

Dated: September 28, 2021

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Certificate of Service

Pursuant to 37 C.F.R. § 42.6(e)(4), I certify that the foregoing Petitioners' Request for Oral Argument was served on September 28, 2021 via electronic mail on the following counsel of record for Patent Owners:

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