

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BAYERISCHE MOTOREN WERKE, AKTIENGESELLSCHAFT &
BMW OF NORTH AMERICA, LLC,
Petitioner,

v.

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

IPR2020-01386
Patent 7,237,634 B2

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

In the Patent Owner Preliminary Response (Paper 8), Patent Owner requests that we exercise our discretion under 35 U.S.C. § 314(a) to deny institution because this is the 27th Petition filed against the '634 patent. Paper 8, 8; Paper 1, 76. It appears from the record that 17 of the 38 challenged claims have been previously challenged. Paper 1, 5. Under these circumstances, the Board would benefit from further briefing on the issue of discretionary denial under 35 U.S.C. § 314 (a).

It is:

ORDERED that Petitioner may file a seven-page Reply brief limited to legal argument responding to the discretionary denial issues raised in the Patent Owner Preliminary Response no later than December 9, 2020;

FURTHER ORDERED that Patent Owner may thereafter file a seven-page Sur-Reply brief limited to legal argument responding to Petitioner's Reply no later than December 16, 2020; and

FURTHER ORDERED that neither party is authorized to file any evidence in connection with the aforementioned briefs.

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