

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.: IPR2020-00994

U.S. Patent No. 7,104,347 K2

PETITIONERS' MOTION TO EXCLUDE

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c), Petitioners move to exclude Exhibits 2016, 2018, 2020, 2022-2025, and 2028.

Exhibit 2016, the Declaration of Mahdi Shahbakhti, Ph.D. (“Shahbakhti Declaration” or “Shahbakhti Decl.”), is inadmissible under Federal Rules 402 and 702. Shahbakhti’s testimony is not reliable because he lacks the requisite technical expertise to provide what he purports to be his opinions in Exhibit 2016. Shahbakhti showcased his lack of expertise at his deposition, where he was unable to answer straightforward questions without first spending several minutes—sometimes as much as 8 - 10 minutes—word-searching what was written for him in his declaration only to read that back as his answer.

Shahbakhti’s opinions are also not reliable because they are not based on sufficient facts or data that are relevant to this case, including Exhibits 2018, 2020, 2022-2025, and 2028. Those exhibits post-date the ’347 Patent’s earliest priority date by anywhere from a few years to *two decades*, are not relevant to any ground upon which this trial was instituted, and do not pass the admissibility threshold of Federal Rule 402.

I. FACTUAL BACKGROUND

A. Petitioners’ Timely Objections

On February 11, 2021, Patent Owners (“PO”) filed their Patent Owner Response (Paper 22, “POR”), along with Exhibits 2016, 2018, 2020, 2022-2025

and 2028. Petitioners timely filed their objections to these exhibits on February 19, 2021. (*See* Paper 24.) There, Petitioners objected to Exhibit 2016 because Shahbakhti

(a) lacks the knowledge, skill, experience, training, or education to testify as an expert in a manner that is helpful to the Board; (b) provides opinions that are not based on sufficient facts or data, or ones that he has been made aware of or personally observed; (c) has not applied reliable principles and methods; and (d) has not reliably applied such principles and methods to the facts of the case,

all of which violates Federal Rules 402 and 702, and because Shahbakhti “fails to identify with particularity the underlying facts or data on which his opinions are based” in violation of 37 C.F.R. § 42.65(a). (Paper 24 at 1.) Exhibit 2016 was also objectionable “to the extent it relies on or incorporates inadmissible exhibits to which the Petitioners object herein,” such as Exhibits 2018, 2020, 2022-2025 and 2028. *Id.*

Petitioners objected to each of Exhibits 2018, 2020, 2022-2025 and 2028 as not being relevant under Federal Rule of Evidence 402 because each exhibit was dated “significantly after the September 14, 1998 priority date of the '347 Patent, which is the date that Shahbakhti states that he is using for gauging the skill of the art.” (*Id.* at 2-4 (citing Ex. 2016, ¶ 29).)

Petitioners now move to exclude Exhibits 2016, 2018, 2020, 2022-2025, and 2028 consistent with those objections.

B. Shahbakhti's Opinions and the Irrelevant Documents on Which He Relied

The '347 Patent claims priority to provisional application No. 60/100,095, filed on September 14, 1998. (BMW1001 at (60).) Shahbakhti relies on that date as the earliest priority date of the '347 Patent. (Ex. 2016, ¶¶ 29-30.) Yet Shahbakhti admitted that he had *no industry experience whatsoever* in September of 1998. (BMW1109 at 13:17-19.)¹ In fact, he had not even obtained a bachelor's degree at that time. (*Id.* at 13:6-12.) He would not get one until two years later, in 2000. (*Id.* at 13:13-16.) Therefore, contemporaneously, Shahbakhti was not close to meeting his own definition of a person of ordinary skill at that time, which requires "*at least a Bachelor's of Science degree in electrical engineering or mechanical engineering and at least three years of technical experience...*" (Ex. 2016, ¶ 29.) (emphasis added.) While he has since achieved that threshold degree and

¹ BMW1109, which is being submitted with this Motion, is identical to previously submitted BMW1089, the May 6, 2021 Deposition Transcript of Shahbakhti in this case, except that BMW1109 additionally contains time-stamps corresponding to the testimony contained therein.

experience, his testimony in this case makes clear that he is unable to testify accurately from the perspective of a POSITA back then.

Shahbakhti struggled to answer straightforward questions posed to him during his depositions without repeatedly taking lengthy delays—including delays of 8, 9, and 10 minutes before answering—to first search if something was written for him on the point in his declaration. (*E.g.*, BMW1109 at 22:4-19 (5-minute pause before answering a question about the scope of the Board's claim construction); *id.* at 31:15-21 (4-minute pause before answering whether speed is a variable that can help adjust a setpoint); *id.* at 98:12-23 (9-minute pause before answering a question about the requirements of Claim 11); *id.* at 101:24-102:18 (9-minute pause before answering whether he analyzed Claims 11 and 33 to require certain details not recited in those claims); *id.* at 105:6-12 (6-minute pause before answering whether Claim 38 requires a two-way clutch); *id.* at 114:15-115:5 (5-minute pause before answering whether a one-way clutch is a particular type of non-slipping clutch); *id.* at 131:5-13 (3-minute pause before answering whether Severinsky '970 alters the control scheme of prior art hybrid vehicles); *id.* at 137:8-138:23 (3-minute pause before answering whether Nii is concerned with enhancing the efficiency of a hybrid vehicle); *id.* at 145:15-25 (10-minute pause before answering whether Nii is monitoring patters of vehicle operation over time as required by the claims).

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