

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' REPLY IN SUPPORT OF MOTION TO EXCLUDE

Dr. Shahbakhti has demonstrated himself unqualified to testify regarding any issues viewed from the perspective of a POSA *at the time of the alleged invention in the '347 Patent*. Although PO defends Dr. Shahbakhti's *present* qualifications,¹ it is unable to provide any cogent explanation for the numerous examples of his inability to answer basic questions without first pausing and searching through his report for several minutes, and even then, often answering in a nonresponsive manner. His unqualified opinions, and the post-priority date documents with which he seeks to bootstrap them, should be excluded.

I. Dr. Shahbakhti's Opinions Should Be Excluded

Dr. Shahbakhti most readily demonstrated his lack of qualifications to testify regarding the relevant time period during his depositions. (Mot., 4-6.) PO seeks to defend Dr. Shahbakhti's repeated prolonged pauses, often followed by nonresponsive answers, by arguing that “[o]ne would think that it would be desirable for an expert to be careful and thoughtful before providing an answer.” (Opp., 9.) But the videotaped deposition—which Petitioners encourage the Board to watch (*see* BMW1101)—makes clear that Dr. Shahbakhti was not being

¹ While PO cites three IPRs decisions in which Dr. Shahbakhti's opinions were credited, none of those IPRs concerned the period at issue here. IPR2019-00011 (May 7, 2007 priority date); IPR2019-00014 and IPR2019-00012 (Feb. 16, 2009).

“careful” and “thoughtful;” he was using the computer’s search tool to word-search for certain words he chose from counsel’s question, then reading what was written for him in his Declaration to try to make sense of it all, due to his lack of relevant knowledge and qualifications. While PO argues “it is neither surprising nor unusual that an expert would take their time to answer,” Petitioners are confident that if the Board views the video, it will find Dr. Shahbakhti’s behavior both surprising and unusual.

Tellingly, PO barely attempts to defend Dr. Shahbakhti’s behavior, suggesting instead that Petitioners’ questions were somehow tricky, unexpected, or otherwise called for a legal conclusion. For example, PO complains that Dr. Shahbakhti was asked his opinion regarding what was covered within the scope of the challenged claims (Opp., 9-12), but the scope of the claims and whether the prior art’s disclosures falls within it is not an attempt at a “gotcha moment[.]” (*id.*, 12), but rather the central issue in this, and most any, IPR. And many of Petitioners’ questions were even more straight-forward than that. Indeed, even PO does not attempt to explain why it took Dr. Shahbakhti *over 20 minutes* to confirm he does not contest that Nii discloses “monitoring a driver’s repeated driving operations over time” (*see* BMW1109, 140:15-148:7),

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24	Do you agree that Nii discloses	02:47
25	monitoring a driver's repeated driving	02:47
26	operations over time, or is that something you	02:47
27	contest?	02:47
	* * *	
15	travel pattern recognition means. So it is	03:09
16	clear that is monitoring the data. And then	03:09
17	that can be sent out. This was monitoring the	03:09
18	data during the time of the trip. Let's say if	03:09

9 minutes before answering if claim 11 requires eliminating turbo lag (98:12-23),

12	Q. Do the claims require that turbo lag	12:30
13	be eliminated by the control system claimed in,	12:30
14	or the hybrid vehicle claimed in Claim 11?	12:30
15	MR. LIVEDALEN: Objection, calls	12:30
16	for a legal conclusion.	12:30
17	A. So to answer your questions, I want	12:39

8 minutes before answering how he analyzed two claims (101:24-102:18),

24	Q. So when you analyzed Claims 11 and 33	12:45
25	in this case, the claims that relate to the	12:45
26	turbocharger, did you analyze the claims to	12:45
27	require that the turbocharger and the electric	12:46
28	motor work together in turbocharged mode 6?	12:46
29	MR. LIVEDALEN: Objection,	12:46
30	misstates testimony.	12:46
31	A. So looking at Claim 11, just reading	12:54

5 minutes to say if a one-way clutch is a type of non-slipping clutch (114:15-115:5),

15	Q. Dr. Shahbakhti, would you agree with	01:34
16	me that a one-way clutch is a particular type	01:34
17	of nonslipping clutch?	01:34
18	A. So let's take a look at the diagram	01:39
19	that I included for paragraph 195. So	01:39

or 6 minutes before answering if claim 38 requires a two-way clutch (105:6-12),

6	Q. Okay. Does Claim 38 require a	01:01
7	two-way clutch?	01:01
8	MR. LIVEDALEN: Objection, calls	01:01
9	for a legal conclusion.	01:01
10	A. So to answer this question, I want to	01:07
11	point out to some places in my declaration.	01:07

PO has no cogent explanation for these or the numerous other examples of Dr. Shahbakhti's inability to answer Petitioners' straight-forward questioning *about his "own" analysis as stated in "his" Declaration* in a responsive manner (or sometimes at all), even after his abnormal delays. (Mot., 4-6.) His opinions should therefore be excluded. *See Roper v. Kawasaki Heavy Indus., Ltd.*, No. 13-cv-03661, 2015 WL 11236553 (N.D. Ga. June 29, 2015) (excluding testimony of expert who was unable to give precise answers); *Chico's Fas, Inc. v. Clair*, No. 13-cv-792, 2015 WL 3496003, at *3 (M.D. Fla. June 3, 2015) (warning that "evasive answers may result in the witness being disallowed as an expert").

Contrary to PO's attempts at distraction (Opp., 1-9), Petitioners are not challenging Dr. Shahbakhti's qualifications to opine regarding the present state of the art, or disputing the *general* authority that an expert need not necessarily have qualified as a POSA at the time of the invention to be qualified as an expert in the relevant field. Rather, Petitioners dispute Dr. Shahbakhti's qualifications to opine regarding issues viewed from the perspective of a POSA prior to the September 14,

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