

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 K2

PETITIONERS' MOTION TO EXCLUDE

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c), and consistent with their motion to exclude largely the same evidence in IPR2020-00994, Petitioners move to exclude Exhibits 2016, 2018, 2020, 2022-2024, 2028, and 2033.¹ Each of Exhibits 2018, 2020, 2022-2024, 2028 and 2033 post-dates the '634 Patent's alleged priority date by several years, some by decades. As such, each should be excluded as irrelevant under Federal Rule of Evidence 402. Any opinions in Dr. Shahbakhti's declaration (Exhibit 2016) that rely on these Exhibits should likewise be excluded because they are not based on sufficient facts or data that are relevant to this case, are not relevant to any ground upon which this trial was instituted, and do not pass the admissibility threshold of Federal Rule 402.

Furthermore, the opinions in Dr. Shahbakhti's declaration (Ex. 2016) regarding what a POSITA would have known or how a POSITA would have viewed the prior art at the time of the purported inventions are substantially identical to the ones he offered regarding those respective subjects in IPR2020-00994. Accordingly, should the Board exclude Dr. Shahbakhti's opinions in IPR2020-00994, including because he was unable to answer straightforward questions without first spending several minutes—sometimes as many as 8-10

¹ Petitioners' Motion in IPR2020-00994 did not move to exclude Ex. 2033 and additionally moved to exclude Ex. 2025, not included here.

minutes—word-searching what was written for him in his declaration only to read that back as his answer, the Board should likewise exclude those same opinions here. *See* IPR2020-00994, Paper 39 at 3-9.

Regardless of the amount of time he took to answer deposition questions, though, Dr. Shahbakhti is not qualified, and has not otherwise become qualified, to testify regarding issues viewed from the perspective of a POSITA prior to the September 14, 1998 critical date. It is undisputed that Dr. Shahbakhti did not have the necessary qualifications in 1998 (and did not gain those qualifications until several years later). While an expert need not necessarily have qualified as a POSITA at the time of the invention to be qualified as an expert to testify in an IPR, proper expert testimony *must be supported by something from the critical period to back-fill the expert's lack of personal knowledge and experience*. Rather than study up on contemporaneous literature, talk to persons who were industry experts at the time, or do *anything else* to substantiate his opinions regarding the knowledge and perspective of a POSITA in 1998, Dr. Shahbakhti simply cites to documents that post-date the critical date by *as much as two decades*. Having nothing to link the propriety of his opinions to the critical date, Dr. Shahbakhti cannot competently testify in this case, and his opinion should be excluded.

I. PETITIONERS' TIMELY OBJECTIONS

On May 3, 2021, Patent Owners ("PO") filed their Patent Owner Response (Paper 20, "POR"), along with Exhibits 2016, 2018, 2020, 2022-2024, 2028, and 2033. Petitioners timely filed their objections to these exhibits on May 10, 2021. (See Paper 21.) There, Petitioners objected to Exhibit 2016 because Dr. 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 Dr. 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 21 at 1.) Exhibit 2016 was also objectionable "to the extent it relies on or incorporates inadmissible exhibits," such as Exhibits 2018, 2020, 2022-2024, 2028, and 2033. *Id.*

Petitioners objected to each of Exhibits 2018, 2020, 2022-2024, 2028, and 2033 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 '634 Patent, which is the date that Dr. 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, 2022-2024, 2028, and 2033 consistent with those objections.

II. Non-Prior Art Exhibits 2018, 2020, 2022-2024, 2028, and 2033, and Dr. Shahbakhti's Opinions in Exhibit 2016 that Rely on These Exhibits, Should Be Excluded Under Federal Rule of Evidence 402

Federal Rule of Evidence 402 bluntly proscribes “[i]rrelevant evidence” as “not admissible.” Fed. R. Evid. 402. It is well established that one “must look at the state of the art *at the time the invention was made* to find a motivation” to combine prior art references. *Daiichi Sankyo Co. v. Matrix Labs., Ltd.*, 619 F.3d 1346, 1354 (Fed. Cir. 2010) (emphasis added). Thus, evidence “issued after the invention date” is “of limited relevance” to the question of motivation to combine, for example. *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 424 F.3d 1293, 1324 (Fed. Cir. 2005).

While Petitioners recognize that it can be appropriate to use post-filing evidence to show the state of the art existing around the time of the patent's filing date, an expert should not rely solely—or even mostly—on such post-filing evidence; there must be something that ties an expert's testimony to the critical date, whether it be personal knowledge or citation to contemporaneous industry publications. Yet only three of the ten (just 30%) exhibits on which Dr. Shahbakhti relies predate the '634 Patent's alleged priority date. (Exs. 2019, 2021, 2033.) The

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