

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' REPLY IN SUPPORT  
OF THEIR MOTION TO EXCLUDE**

Here and in IPR2020-00994, it is not possible to discern whether the opinions contained in Dr. Shahbakhti's declaration are from the perspective of a skilled artisan in 1998 (which they are required to be) or from such a person much later in time. Although PO defends Dr. Shahbakhti's *present* qualifications,<sup>1</sup> it is unable to provide any cogent explanation for his inability to identify contemporaneous art or any other evidence to support that his opinions are from the relevant time period regarding which he lacks any personal expertise, and about which he had difficulty answering questions at his depositions. 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**

Contrary to PO's attempts at distraction (Opp., 1-10), 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

---

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

relevant field. Rather, Petitioners dispute the basis for Dr. Shahbakhti's opinions as to the perspective of a POSA *prior to the September 14, 1998 date of the alleged inventions*. Namely, Dr. Shahbakhti indisputably lacked experience rising to the level of a POSA at the relevant time (or for several years thereafter), and was unable to provide evidence contemporaneous to the filing date of the '634 Patent that would bolster his otherwise unsupported testimony regarding the state of the art at that time.<sup>2</sup>

---

<sup>2</sup> As Petitioners set forth in IPR2020-00994, Dr. Shahbakhti further demonstrated his lack of qualifications regarding the relevant time period during his depositions. *E.g.*, IPR2020-00994, Paper 42, 1-4. As his videotaped deposition makes clear, Dr. Shahbakhti's repeated prolonged pauses were not reflective of his being "careful" or "thoughtful" in his answers, as PO contends (Opp., 10 n.2), but rather of his 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. (IPR2020-00994, Paper 42, 1-4). *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.

(continued...)

While PO attempts to defend Dr. Shahbakhti by arguing that his list of “materials considered identifies 37 references, the vast majority of which predate the critical date” (Opp., 9), those references were mostly the ones cited by Petitioners, and in large part related to challenged claims and limitations whose unpatentability neither PO nor Dr. Shahbakhti disputes. As for the 10 references that Dr. Shahbakhti cited and actually relied on for his opinions regarding the relevant time period, only 3 did, in fact, predate the '634 Patent's alleged priority date, with the others coming nowhere close (Mot., 4-5), notwithstanding PO's half-hearted protestations to the contrary (Opp., 9).

Petitioners have no “vendetta” (Opp., 2) against Dr. Shahbakhti nor take umbrage with his *present* qualifications. Instead, Petitioners take issue with his opining as to matters viewed from the perspective of a POSA *at the time of the alleged inventions* because Dr. Shahbakhti lacks contemporaneous experience regarding that period and has failed to tether his corresponding opinions to any other contemporaneous evidence. As such, it is impossible to distinguish which of his opinions, if any, can be properly ascribed to how a POSA would have viewed

---

June 3, 2015) (warning that “evasive answers may result in the witness being disallowed as an expert”).

the issues in dispute *prior to the date of the alleged inventions*. Accordingly, Exhibit 2016 should be excluded as unreliable.

## II. Exhibits 2018, 2020, 2022-2024, 2028 and 2033 Should Be Excluded

Petitioners acknowledge (Mot., 4) that it *can* be appropriate to use post-filing evidence “in a supportive role.” (Opp., 14 (quoting *Yeda Research v. Mylan Pharms., Inc.*, 906 F.3d 1031, 1041 (Fed. Cir. 2018)).) But the post-filing Exhibits here constitute the majority of PO’s evidence and are not corroborated with any evidence that would show that the supposed “typical structure of a turbocharged engine control system” (Opp., 13 (citing Ex. 2028)), “packaging limitations for turbochargers” (*id.* (citing Ex. 2023)), or myriad other components, systems, etc. existing at the time of these post-filing Exhibits *are representative of those known at the relevant time*.<sup>3</sup> It is PO’s burden to come forward with such corroboration, and not BMW’s to provide evidence rebutting it in the first instance, as PO erroneously suggests (Opp., 14), in the absence of such corroboration. These

---

<sup>3</sup> PO also cites to Exhibit 2025 in its Opposition as supposedly providing an “example of mechanics of a common free wheel unit” (Opp., 13) but—apart from that too-late-in-time Exhibit also not being corroborated with any other evidence to show that it is representative of what was known at the relevant time—issues related to a free wheel unit were only in dispute in IPR2020-00994, not here.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.