

Filed on behalf of:

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

SIGHTSOUND TECHNOLOGIES, LLC,

Patent Owner.

Case CBM2013-00020

Patent 5,191,573

**PATENT OWNER SIGHTSOUND TECHNOLOGIES, LLC'S
OPPOSITION TO PETITIONER APPLE INC.'S MOTION
TO EXCLUDE UNDER 37 C.F.R. §§ 42.62 and 42.64**

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I. INTRODUCTION

Patent Owner SightSound Technologies, LLC (“Patent Owner”) hereby submits this opposition to Petitioner Apple Inc.’s Motion to Exclude Under 37 C.F.R. §§ 42.62 and 42.64 (“Mot.”). Petitioner Apple Inc.’s (“Petitioner”) Motion opens with a lengthy discussion of the admissibility and weight to be accorded expert testimony, in essence conceding that there is no basis to exclude the opinions of Mr. Snell. Yet, Petitioner then proceeds to criticize a few discrete aspects of Mr. Snell’s written and oral testimony, criticism contrived only through Petitioner’s fatal misstatements of law and contorted and selective presentation of Mr. Snell’s actual testimony, and seeks to use its arguments as a basis to exclude wide swaths of Mr. Snell’s opinions. For the reasons stated herein, Petitioner’s Motion fails to undermine either the admissibility or the weight that the Board should accord Mr. Snell’s opinions.

II. ARGUMENT

A. Mr. Snell is Qualified to Opine Under F.R.E. 702

Mr. Snell is qualified to provide the opinions found in Sections VII-IX of his report. Mr. Snell has decades of engineering experience, specializing in design and analysis of microelectronics, software, and systems for recording, playing, synthesis, processing, and transferring electronic media over electronic networks. Ex. 2153 ¶ 3. In 1976, Mr. Snell founded and was the first editor of COMPUTER MUSIC JOURNAL, an academic journal on the application of a number of disciplines

such as computer science, signal processing mathematics, and electronics to the composition, recording, editing, and processing of music, and has published several books on such topics. *Id.* ¶ 6. It is undisputed that he is a person of skill in the art and qualified to analyze the non-obviousness of the claims, their application to the iTunes Music Store (“ITMS”), whether ITMS is co-extensive with and embodies the claims, and whether there is a nexus between the invention and the commercial success of ITMS.

Remarkably, Petitioner argues that Mr. Snell is not qualified to render the opinions contained in Section VII of his report, which concern obviousness in view of CompuSonics. Here, the proper analysis is whether the claimed invention would have been obvious to one of ordinary skill after consideration of all the facts. 35 U.S.C. § 103. As an undisputed person of such skill with expertise in music, recording, electronic media, and digital audio processing, Mr. Snell is qualified.¹ If Petitioner believed otherwise, it is surprising that Petitioner chose not

¹ Petitioner’s challenge to Mr. Snell’s non-obviousness opinion is particularly surprising given that Petitioner offers opinions from individuals who were admittedly *not* persons of ordinary skill in the art in 1988 on issues such as what ideas were “prevalent in the industry” (Ex. 4255 (Robbin Decl.) ¶ 9; *see* Ex. 2176 (Robbin Dep.) at 14:22-23 (testifying Robbin graduated from high school in 1987))

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to ask Mr. Snell a single question during his deposition about his opinions on the CompuSonics references. *See* Ex. 4165.

Petitioner also attacks Mr. Snell’s credentials to provide the opinions in Section IX of his report regarding commercial success, claiming Mr. Snell cannot appropriately analyze “the variables that help explain why SightSound’s electronic store failed while [ITMS] succeeded.” Mot. at 4-5. In fact, throughout its Motion, Petitioner relies on the erroneous premise that the relevant inquiry for commercial success is a comparison between Patent Owner’s online store and ITMS, and wrongly assumes that Mr. Snell must prove that various features of ITMS that Petitioner has identified do *not* explain its success. This is not the law.

As the Federal Circuit makes clear, the relevant inquiry is whether there is a nexus between the patented invention and a commercially successful product. “A prima facie case of nexus is generally made out when the patentee shows both that there is commercial success, and that the thing (product or method) that is commercially successful is the invention disclosed and claimed in the patent.”

Demaco Corp. v. F. Von Langsdorff Licensing Ltd., 851 F.2d 1387, 1392 (Fed. Cir. 1988). When the commercially successful product is coextensive with the asserted

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and what persons of ordinary skill “often discussed and recognized” (Ex. 4256 (Kenswil Decl.) ¶ 52). *See* Paper 68 (Patent Owner’s Motion to Exclude).

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