

Filed on behalf of:

**Patent Owner SightSound Technologies, LLC**

By: David R. Marsh, Ph.D.  
Kristan L. Lansbery, Ph.D.  
ARNOLD & PORTER LLP  
555 12th Street, N.W.  
Washington, DC 20004  
Tel: (202) 942-5068  
Fax: (202) 942-5999

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

APPLE INC.,

*Petitioner,*

v.

SIGHTSOUND TECHNOLOGIES, LLC,

*Patent Owner.*

---

Case CBM2013-00023  
Patent 5,966,440

---

**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**

## TABLE OF CONTENTS

	Page
<b>I. INTRODUCTION</b> .....	1
<b>II. ARGUMENT</b> .....	1
<b>A. Mr. Snell is Qualified to Opine Under F.R.E. 702</b> .....	1
<b>B. Mr. Snell’s Opinions on Nexus Are Supported by Facts and Data</b> .....	5
<b>C. Mr. Snell Validly Opined That ITMS Is “Co-Extensive” With the Claims and That the Claims Drove Commercial Success</b> .....	8
<b>D. Mr. Snell’s Opinions Rely Upon the “Second Party” Construction Adopted by the Board</b> .....	9
<b>E. Mr. Snell’s Opinions That Certain CompuSonics References Fail to Meet the Financial Requirements of the Challenged Claims Rely Upon the District Court’s Constructions of “Selling Electronically” and “Charging a Fee” Which Were Adopted by the Board</b> .....	13
<b>III. CONCLUSION</b> .....	14

## **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. 2353 ¶ 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.<sup>1</sup> If Petitioner believed otherwise, it is surprising that Petitioner chose not

---

<sup>1</sup> 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. 4413 (Robbin Decl.) ¶ 9; *see* Ex. 2377 (Robbin Dep.) at 14:22-23 (testifying Robbin graduated from high school in 1987))

Footnote continued on next page

to ask Mr. Snell a single question during his deposition about his opinions on the CompuSonics references. *See* Ex. 4366.

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

---

Footnote continued from previous page

and what persons of ordinary skill “often discussed and recognized” (Ex. 4414 (Kenswil Decl.) ¶ 52). *See* Paper 64 (Patent Owner’s Motion to Exclude).

# 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.