

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

---

Before the Honorable MICHAEL P. TIERNEY, JUSTIN T. ARBES, and  
GEORGIANNA W. BRADEN,  
*Administrative Patent Judges.*

**PETITIONER APPLE INC.'S OPPOSITION TO  
PATENT OWNER'S MOTION TO EXCLUDE UNDER 37 C.F.R. § 42.64(c)**

By: Attorneys/Agents For Petitioner

J. Steven Baughman, Lead Counsel  
Registration No. 47,414  
Ching-Lee Fukuda, Back-up Counsel  
Registration No. 44,334  
James R. Batchelder, Back-up Counsel  
*Pro Hac Vice* Granted

ROPES & GRAY  
Prudential Tower  
800 Boylston Street  
Boston, Massachusetts 02199-3600  
(202) 508-4606 (Telephone)  
(617) 235-9492 (Fax)

## TABLE OF CONTENTS

I.	The Board Should Not Exclude Exhibit 4413 ¶¶ 7 and 9 .....	2
II.	The Board Should Not Exclude Exhibit 4416.....	4
III.	The Board Should Not Exclude Exhibits 4410-11 .....	5
IV.	The Board Should Not Exclude Disputed Excerpts of Exhibit 4414 .....	6
V.	The Board Should Not Exclude Exhibit 4420.....	11
VI.	The Board Should Not Exclude Exhibits 4421-4459 .....	15

In response to Patent Owner's Motion to Exclude ("Mot.", Paper 64), Petitioner<sup>1</sup> respectfully submits that the Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to the evidence presented in this trial, without resorting to formal exclusion that might later be held reversible error. *See, e.g., S.E.C. v. Guenther*, 395 F. Supp. 2d 835, 842 n. 3 (D. Neb. 2005); *Builders Steel Co. v. Comm'r of Internal Revenue*, 179 F.2d 377, 379 (8th Cir. 1950) (vacating Tax Court decision for exclusion of competent, material evidence); *Donnelly Garment Co. v. NLRB*, 123 F.2d 215, 224 (8th Cir. 1941) (finding NLRB's refusal to receive testimonial evidence was denial of due process). *See also, e.g., Samuel H. Moss, Inc. v. F.T.C.*, 148 F.2d 378, 380 (2d Cir. 1945), *cert. denied*, 326 U.S. 734 (1945) ("Even in criminal trials to a jury it is better, nine times out of ten, to admit, than to exclude, evidence and in such proceedings as these the only conceivable interest that can suffer by admitting any evidence is the time lost, which is seldom as much as that inevitably lost by idle bickering about irrelevancy or incompetence"). Even under the strict application of the Rules of Evidence and arguments regarding the proper scope of rebuttal that SightSound urges here, however, *cf.* 77 Fed. Reg. 48,612, 48,616 (Aug. 14, 2012, Rules of Practice) ("42.5(a) and (b) permit administrative patent judges wide latitude in administering the proceedings to balance the ideal of precise rules against the need for flexibility to achieve reasonably fast, inexpensive, and fair proceedings"),

---

<sup>1</sup> All emphases added; abbreviations are as in the Reply ("Pet. Rep.", Paper 49).

Petitioner's evidence is entirely proper (rebutting, *e.g.*, Patent Owner's attempts to assert "secondary considerations" of non-obviousness in its Response (Paper 38), while Patent Owner's ("PO's") objections are baseless, and, indeed, appear in various instances to be an unauthorized attempt to sur-reply. *See, e.g.*, Mot. 7 (arguing allocation of burdens); 77 Fed. Reg. 48756 (Aug. 14, 2012, Trial Practice Guide), 48767 ("A motion to exclude must explain why the evidence is not *admissible* (*e.g.*, relevance or hearsay) but *may not be used to challenge the sufficiency of the evidence* to prove a particular fact").

### **I. The Board Should Not Exclude Exhibit 4413 ¶¶ 7 and 9**

PO objects to two limited aspects of Jeffrey Robbin's declaration: (1) the phrase in Paragraph 9 referring to "the idea—prevalent in the industry since the mid-1980s—that it would be desirable to sell music and video files over computer networks," and (2) Paragraph 7 regarding the fact that iTunes and iTMS include many technological features developed by Apple, and that Apple has been granted patents on many inventions relating to iTMS. Mot. 2-3. PO is wrong on both counts.

First, PO provides no support for its assertion that Mr. Robbin's age in the mid-1980s precludes him from offering personal knowledge about the idea of selling music and videos over computer networks. The fact that Mr. Robbin can trace this knowledge back to when he was in high school does not preclude him testifying to this effect. EX4413 ¶ 1 (facts based on personal knowledge). *Nor is this the slightest bit surprising*, as young people had good reason to be interested in and learn about the different ways of obtaining music and movies. Apparently recognizing this, PO—which

could easily have asked Mr. Robbin the basis for this statement during his deposition—chose not to. Instead, PO asked narrow questions directed to whether the *specification of an Apple patent* stated that this idea was prevalent since the mid-1980s, to which Mr. Robbin responded that “the idea was around – certainly much older than that....” EX2733 111:9-112:3 . Not liking what it heard, PO attempted to “strike” that answer and moved on. *Id.* 112:4-9.

As to Paragraph 7, Petitioner is not offering Mr. Robbin’s statements as expert testimony, but rather as fact testimony based on (1) Mr. Robbin’s personal knowledge of the technological features of the iTunes client and iTMS as one of the leaders of the development team for iTunes and iTMS, and (2) his personal knowledge of some of the patents granted to Apple for inventions relating to iTMS, for which he is a named inventor. EX4413 ¶¶ 4, 6, 7. PO’s criticism that Mr. Robbin did not offer claim charts to substantiate this paragraph is inapt. To rely on iTMS’s success as a secondary consideration of non-obviousness, *it was PO’s burden* to show that iTMS is covered by the challenged patent and to show the required nexus between the success of iTMS and any supposedly novel claimed features. *Kyocera Corp. v. Softview, LLC*, IPR2013-00007, Paper 51 at 32 (“to establish a proper nexus, the patent owner must offer proof that the sales were a direct result of the unique characteristics of the claimed invention”); *see also In re Huang*, 100 F.3d 135, 140 (Fed. Cir. 1996) (“nexus is required between the sales and the merits of the claimed invention.”). Yet *PO’s own submissions are devoid of that basic evidence*: they lack any claim chart, and PO does not

# 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.