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 REPLY IN SUPPORT OF ITS MOTION TO EXCLUDE UNDER 37 C.F.R. §§ 42.62 AND 42.64

FILED UNDER SEAL

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PO	Patent Owner
iTMS	iTunes Store / iTunes Music Store
Pet. Rep.	CBM2013-00023, paper 49.
Mot.	CBM2013-00023, paper 67.
Opp.	CBM2013-00023, paper 75.

Note: All emphasis herein added unless otherwise stated.

I. PO Does Not Dispute That Mr. Snell Failed To Investigate Facts Unquestionably Relevant to Mr. Snell's User Interfaces Opinion

PO *does not dispute* that Mr. Snell did nothing to investigate the features of the SightSound.com electronic store user interface other than look at old screen shots, had not looked even at those in connection with these proceedings, and could not discern what happened when a user clicked on the buttons shown. *See, e.g.*, EX4366 126:9-128:11, 177:4-178:24; EXS4368-69 (Dep. Exs. 9-10); Mot. 6. PO also *does not dispute* that Mr. Snell did not know whether SightSound.com had features comparable to any of the many iTMS features not accused, or that he admitted he had no basis for opining as to whether any of those features was important to consumers, and thus commercial success. EX4366 163:11-186:3, 196:5-207:22, 208:19-212:17, 213:14-214:14; EX4370-72 (Depo. Exs. 11-13); Mot. 6-7. PO's lack of dispute is particularly glaring given *PO's burden* to prove nexus. *See, e.g.*, Pet. Rep. 10-11. Given his lack of factual basis and lack of *any* commercial expertise,[1] Mr. Snell's opinion that the user interfaces of SightSound.com and the iTMS are only insignificantly different—directly contrary to undisputed facts *he never investigated or considered*—should be excluded.

II. PO Offers No Support for Mr. Snell's "Co-Extensive" Opinion, and Misapprehends the Cited Federal Circuit Caselaw

[1] *See, e.g.*, IPR2013-00004, Paper 53; *Xpertuniverse, Inc. v. Cisco Sys., Inc.*, 2013 U.S. Dist. LEXIS 31327, *11 (D. Del. Mar. 7, 2013) (excluding opinions of technical expert on, *e.g.*, commercial success for lack of proper qualifications).

PO's response ignores the critical point that Mr. Snell did not understand the meaning of "co-extensive"—rendering baseless his opinions on that issue. Though repeatedly asked, Mr. Snell *could not answer* whether, "If a given product has a variety of features that are not claimed in the given patent claim but the product practices the patent claim, is that product co-extensive with that claim?" EX4366 35:5-39:11. PO's only explanation for Mr. Snell's total failure to investigate or analyze additional features of iTMS is that *Demaco* somehow excuses PO from considering unclaimed features. *See, e.g.*, Opp. 4, 8. Not so. *Demaco* holds a patentee must show "a legally sufficient relationship" where, as here, the patented invention is "only a component":

> When the thing that is commercially successful *is not coextensive with the patented invention*—for example, *if the patented invention is only a component of a commercially successful machine or process*—the *patentee must show prima facie a legally sufficient relationship* between that which is patented and that which is sold.

See, e.g., *Demaco Corp v. F. Von Langsdorff Licensing, Ltd.*, 851 F.2d 1387, 1392 (Fed. Cir. 1988). PO has made no such showing of a "legally sufficient relationship," nor could it, *having ignored every other feature of iTMS* apart from those accused by PO.

In snipping out a later *Demaco* statement that a patentee need not prove that "commercial success is not due to factors other than the patented invention" (Opp. 4), PO ignores the point of that passage: "It is sufficient to show that the commercial success *was of the patented invention itself*." *Demaco* at 1394. And these "other" factors are not, as PO implies, *additional features not accused of practicing the alleged invention*, but "ex-

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