UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SMARTFLASH LLC,
Patent Owner

Case CBM2014-00102[1]
Patent 8,118,221 B2

Before the Honorable JENNIFER S. BISK, RAMA G. ELLURU, JEREMY M. PLENZLER, and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

PETITIONER'S MOTION TO STRIKE PORTIONS OF THE DEPOSITION TRANSCRIPT OF ANTHONY WECHSELBERGER CONCERNING PETITIONER'S PRODUCTS AND FOR COSTS

Pursuant to 37 C.F.R. § 42.22, and as authorized in the Board's December 12, 2014 Order (Paper 20), Petitioner Apple Inc. ("Petitioner") hereby moves to strike the portions of the deposition transcript of Anthony Wechselberger (Apple's expert witness) involving questioning by Patent Owner's counsel outside the scope of Mr. Wechselberger's declaration—including, in particular, questions and answers about the operation of Petitioner's products and related secondary considerations—and

[1] Case CBM2014-00103 has been consolidated with the instant proceeding.

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seeks an award of the associated costs of the deposition and of this Motion. Specifically with respect to the transcript, Petitioner seeks to strike the following portions:

- 12/11/2014 Wechselberger Dep. 358:1-378:4. *See* Ex. 1030.[2]

I. INTRODUCTION & RELIEF REQUESTED

The above Wechselberger transcript citations contain questions and answers outside the scope of Mr. Wechselberger's declaration and thus outside the scope of proper deposition discovery in this matter—including questions and answers directed to Petitioner's products. Mr. Wechselberger's declaration (*i.e.*, his direct witness

[2] Ex. 1030 contains excerpts from the Wechselberger transcript that, in addition to the portions Petitioner seeks to strike on pages 358-378, also includes pages 334-357 so that the Board may consider, if it wishes, the context leading to the portions of the deposition that Petitioner seeks to strike from the record, including the transcription of the December 11 conference call with the Board. Pages 358:1-378:4—the portions Petitioner seeks to strike—were originally prepared as a separate transcript marked as "Redacted" based on potential concerns about confidentiality of the testimony that was expected to be elicited. However, based on the testimony actually elicited, Petitioner has determined that this portion of the transcript need not be filed under seal.

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testimony) that was submitted with the Petition in this proceeding[3] contained *no* testimony whatsoever as to Petitioner's products—much less as to the operation of Petitioner's products or any commercial success of the products. The Board's rules explicitly state that, "[f]or cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony." 37 C.F.R. § 42.53(d)(5)(ii). The questions and answers on cross-examination at Mr. Wechselberger's deposition directed to Petitioner's products or related secondary considerations were outside the scope of Mr. Wechselberger's direct testimony and were therefore improper. Accordingly, and as discussed further below, Petitioner respectfully requests that the Board strike the above-identified portions of the Wechselberger transcript and award the requested costs to Petitioner.

II. STATEMENT OF MATERIAL FACTS

1. On November 7, 2014, a teleconference was held between the Board and the parties. Patent Owner Smartflash LLC ("Patent Owner") requested

[3] Petitioner submitted a declaration from Mr. Wechselberger in each of proceedings CBM2014-00102, -00106, -00108, and -00112, and his deposition that is the subject of this Motion was taken for purposes of discovery for all of these proceedings collectively. His declarations in the other proceedings also contained no testimony regarding Petitioner's products. Accordingly, Petitioner is concurrently filing a similar Motion in each proceeding, as authorized by the Board in Paper 20.

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authorization to file a motion for additional discovery on Petitioner's products. Patent Owner sought this discovery as purportedly relevant to showing secondary considerations for the patent-at-issue—particularly, commercial success based on Patent Owner's allegation that these products read on (*i.e.*, infringe) the challenged claims. *See* Paper 14 at 3.

2. In opposition to the requested authorization, Petitioner asserted, *inter alia*, that Patent Owner's request would necessarily result in a "trial within a trial" to determine allegations of infringement for purposes of addressing secondary considerations based on Petitioner's products. Petitioner also asserted that Patent Owner has not made a threshold showing of nexus between the challenged claims and alleged commercial success. Paper 14 at 3.

3. The Board denied Patent Owner's request for authorization to move for additional discovery, explaining, *inter alia*, that "Patent Owner has not made a threshold showing as to infringement or nexus with commercial success." Paper 14 at 3.

4. On December 10 and 11, 2014, Patent Owner deposed Petitioner's expert witness, Anthony Wechselberger, for this proceeding as well as for CBM2014-00106, -00108, and -00112. During the deposition, on December 11, at Petitioner's request, a teleconference was held between the Board and the parties to address Petitioner's objections to the scope of the questioning of Mr. Wechselberger.

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Petitioner requested that Patent Owner be ordered not to ask questions related to the operation of Petitioner's products because (1) such questions were clearly outside the scope of the proceedings, (2) Mr. Wechselberger had not opined on the operation of Petitioner's products in his declaration, and (3) secondary considerations had not been placed at issue in the proceeding. Paper 20 at 2.

5. During the teleconference, Patent Owner argued that it should be allowed to ask questions about the operation of Petitioner's products and alleged that (1) the challenged claims read on those products, (2) Mr. Wechselberger had submitted expert reports on Petitioner's products in the related, pending district court litigation, and (3) the operation of Petitioner's products is relevant to commercial success. Paper 20 at 2.

6. The Board did not immediately order Patent Owner to discontinue asking Mr. Wechselberger questions about Petitioner's products, but indicated during the call and memorialized in a subsequent order (Paper 20) that Petitioner was authorized to file a Motion to Strike (*i.e.*, the instant Motion). The Board stated that the Motion to Strike could point to the pertinent questions and answers in the Wechselberger transcript relating to Petitioner's products and explain why they are outside the proper scope of this proceeding. The Board explained that it "is extremely reluctant to broaden the scope of the instant proceedings significantly and delay the trial schedule by permitting discovery into the operation of Petitioner's

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