UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2014-00106[1]
Patent 8,033,458 B2

DECLARATION OF JONATHAN KATZ, PH.D. IN SUPPORT OF PATENT OWNER'S RESPONSE TO PETITION

[1] Case CBM2014-00107 has been consolidated with the instant proceeding.

I, Jonathan Katz, hereby declare:

1. I am currently a Professor in the Department of Computer Science at the University of Maryland where, among other things, I teach classes in the area of cybersecurity, conduct research in this field, and supervise graduate-student research. I am also currently the Director of the Maryland Cybersecurity Center (MC2), as part of which I interact regularly with the cybersecurity industry and oversee faculty conducting research in various sub-fields of cybersecurity including cryptography, network security, and mobile-phone security. I received my Ph.D. (with distinction) in Computer Science from Columbia University in 2002.

2. My curriculum vitae is attached hereto as Appendix A, and the list of cases in which I have been an expert in the last five years is attached hereto as Appendix B. I additionally have experience in computer programming.

3. I have been retained by Smartflash LLC to provide an expert opinion in CBM2014-00102, -00106, -00108 and -00112.

4. I have reviewed the material shown in Appendix C in preparing this declaration.

I. Grounds for Review

5. I understand that on September 30, 2014 the Patent and Trial Appeal Board (PTAB) of the U.S. Patent and Trademark Office (USPTO) issued a Decision to institute a Covered Business Method (CBM) Review of U.S. Patent No. 8,033,458 (the '458 patent). Decision at 1. The PTAB further consolidated the proceedings of CBM2014-00106 and CBM2014-00107 into the current proceeding. Decision at 26.

6. I understand that the PTAB only instituted a review of claim 1. I understand that the PTAB held that the Petition (hereinafter "the 00106 Petition") in CBM2014-00106 had shown that it was more likely than not that claim 1 was unpatentable, pursuant to 35 U.S.C. § 103, over the combination of U.S. Patent No. 5,530,235 ("Stefik '235") and U.S. Patent No. 5,629,980 ("Stefik '980"). Decision at 26. I understand that the PTAB also held that the Petition (hereinafter "the 00107 Petition") in CBM2014-00107 had shown that it was more likely than not that claim 1 was unpatentable, pursuant to 35 U.S.C. § 103, over U.S. Patent No. 5,915,019 ("Ginter"). Decision at 26. I also understand that the 00106 and 00107 Petitions raised a number of other grounds of unpatentability, but that the "trial is limited to the grounds identified above." Decision at 26. My opinions in this declaration are limited to the instituted grounds.

II. Legal Standards

7. It has been explained to me that the standard for patentability under 35 U.S.C. § 103 is that of "obviousness" and that obviousness is a question of law based on underlying factual findings, including: (1) the scope and content of the prior art; (2) the differences between the claims and the prior art; (3) the level of ordinary skill in the art; and (4) objective considerations of nonobviousness. I further understand that examples of objective considerations of nonobviousness (or "secondary considerations") include: (1) the invention's commercial success, (2) long felt but unresolved needs, (3) the failure of others, (4) skepticism by experts, (5) praise by others, (6) teaching away by others, (7) recognition of a problem, and (8) copying of the invention by competitors.

8. I also understand that the PTAB uses the "preponderance of the evidence" standard, such that a Petition must show that any claim asserted to be unpatenable is proven to be unpatentable by a "preponderance of the evidence." I take that to mean that the 00106 and 00107 Petitions must prove that it is more likely than not that claim 1 is unpatentable.

9. I understand that the factors considered in determining the ordinary level of skill in the art include the level of education and experience of

persons working in the field; the types of problems encountered in the field; and the sophistication of the technology. I believe that one of ordinary skill in the art would have had a bachelor's degree in electrical engineering or its equivalent, or at least 5 years of experience in manufacturing or engineering, with significant exposure to the digital content distribution and/or e-commerce industries.

10. Based on my industry, research, and teaching experience, and based on my review of the state of the art at the time of the filing of the patent, I believe that I would qualify as an expert in the area of data storage and access systems such that I am qualified to opine on what those of ordinary skill in the art would have understood at the time of the filing of the patent and what he/she would or would not have been motivated to do.

11. Petitioner has alleged that "payment data" should be construed to mean "data representing payment made for requested content data" and is distinct from "access control data." See, for example, 000107 Petition at 24. However, I believe that "payment data" in the context of the '458 patent should be interpreted to mean "data that can be used to make payment for content." I understand that in interpreting "payment data" (and all the other terms of the patent), the PTAB uses a "broadest reasonable interpretation" standard. I have done so in coming to the opinions set forth herein.

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