

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

SMARTFLASH LLC,

Patent Owner.

Case CBM2014-00106¹

Patent 8,033,458

PATENT OWNER'S RESPONSE TO PETITION

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

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I. INTRODUCTION

The present proceeding is a consolidated proceeding for Cases CBM2014-00106 and CBM2014-00107. The only granted ground for unpatentability raised in the Petition in CBM2014-00106 (hereinafter “the 00106 Petition”) was for claim 1 under 35 U.S.C. § 103 over U.S. Patent No. 5,530,235 (“Stefik ‘235”) and U.S. Patent No. 5,629,980 (“Stefik ‘980”). The PTAB denied the remaining grounds. Decision at 26.

The only granted ground for unpatentability raised in the Petition in CBM2014-00107 (hereinafter “the 00107 Petition”) was for claim 1 under 35 U.S.C. § 103 over U.S. Patent No. 5,915,019 (“Ginter”). The PTAB denied the remaining grounds. Decision at 22.

In support of this Patent Owner’s Response, reference will be made to concurrently filed Exhibit 2029, Declaration of Jonathan Katz, Ph.D. (hereinafter “the Katz Declaration”). Reference will also be made herein to (1) Exhibit 1021, DECLARATION OF ANTHONY J. WECHSELBERGER IN SUPPORT OF APPLE INC.’S PETITION FOR COVERED BUSINESS METHOD PATENT REVIEW OF UNITED STATES PATENT NO. 8,033,458 PURSUANT TO 35 U.S.C. § 321, 37 C.F.R. § 42.304, filed in CBM2014-00106 (hereinafter “the 00106 Wechselberger Declaration”), and (2) Exhibit 1121, DECLARATION OF ANTHONY J. WECHSELBERGER IN SUPPORT OF APPLE INC.’S PETITION

FOR COVERED BUSINESS METHOD PATENT REVIEW OF UNITED STATES PATENT NO. 8,033,458 PURSUANT TO 35 U.S.C. § 321, 37 C.F.R. § 42.304, filed in CBM2014-00107 (hereinafter “the 00107 Wechselberger Declaration”).

Reference will also be made herein to Exhibit 2025 which is a concatenation of Mr. Wechselberger’s Deposition transcript beginning on December 10, 2014 and continuing to December 11, 2014. Pages 1-236 of Exhibit 2025 are for December 10, 2014, the first day of his two-day deposition for the combined proceedings of CBM2014-00102, -00106, -00108 and -00112. Pages 239-403 of Exhibit 2025 are for December 11, 2014. On December 11, 2014, a conference call was held with the PTAB to resolve an issue relating to testimony sought by Patent Owner’s counsel, and pages 339-356 are a transcription of the conference call. Because of the possibility of needing to redact a portion of the transcript in light of the conference call, transcript pages 358-378 are found on pages 364-384 of Exhibit 2025, starting with their own caption pages. However, ultimately, Petitioner did not request that any part of the transcript be redacted. See Paper 20, page 2, footnote 2. The remaining portion of Mr. Wechselberger’s transcript is pages 379-396 found on pages 386-403 of Exhibit 2025. For consistency, all references to Exhibit 2025 are made with respect to the page numbers at the bottom of the exhibit which are Preceded by the word “Page,” not the transcript

page numbers in the upper-right corner of the page. References herein may be made in the form of (1) “nnn:xx-yy” which is intended to mean page “nnn”, lines “xx” to “yy” or (2) “mmm:xx - nnn:yy” which is intended to mean page “mmm”, line “xx” to page “nnn”, line “yy”.

II. STATEMENT OF MATERIAL FACTS

1. The 00106 Wechselberger Declaration does not state that Mr. Wechselberger’s opinions presented therein were based on a “preponderance of the evidence” standard.

2. The 00107 Wechselberger Declaration does not state that Mr. Wechselberger’s opinions presented therein were based on a “preponderance of the evidence” standard.

3. Exhibit 2007 is a document from Apple Inc. dated September 19, 2012 entitled *In-App Purchase Programming Guide* (to which its Exhibit label has been added).

4. Exhibit 2008 is a document from Apple Inc. dated September 18, 2013 entitled *In-App Purchase Programming Guide* (to which its Exhibit label has been added).

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