

CBM2014-00106  
Patent 8,033,458 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner

v.

SMARTFLASH LLC,  
Patent Owner

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Case CBM2014-00106<sup>1</sup>  
Patent 8,033,458 B2

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

**PETITIONER'S REPLY IN SUPPORT OF ITS  
MOTION TO STRIKE PORTIONS OF THE DEPOSITION TRANSCRIPT  
OF ANTHONY WECHSELBERGER CONCERNING PETITIONER'S  
PRODUCTS AND FOR COSTS**

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<sup>1</sup> Case CBM2014-00107 has been consolidated with the instant proceeding.

### TABLE OF ABBREVIATIONS

<b>Abbreviation</b>	<b>Description</b>
PO	Patent Owner
Mot. or Motion	Petitioner's Motion to Strike Portions of the Deposition Transcript of Anthony Wechselberger Concerning Petitioner's Products and for Costs (Paper 20)
Opp.	Patent Owner's Opposition to Petitioner's Motion to Strike Portions of the Deposition Transcript of Anthony Wechselberger Concerning Petitioner's Products and for Costs (Paper 22)
Pap.	Paper in CBM2014-00106

\*\*All emphasis added unless otherwise indicated

Petitioner hereby replies in support of its Motion to Strike (Pap. 20) (“Mot.”), and in response to Patent Owner’s (“PO”) Opposition (“Opp.”) (Pap. 22).

## **I. STATEMENT/RESPONSE TO STATEMENT OF MATERIAL FACTS**

Petitioner’s Statement is in Motion at 1-7. As to PO’s Statement: 1. Admitted.

## **II. THE TESTIMONY AT ISSUE WAS OUTSIDE THE PROPER SCOPE**

PO does not argue that Mr. Wechselberger’s testimony, in the declarations on which he was deposed, provided any opinions on the operation of Petitioner’s products or on any purported secondary indicia of non-obviousness supposedly related to commercial success. These were nonetheless the admitted subjects of PO’s unabashedly improper questioning, which should be stricken from the record, and for which costs should be awarded. Nor does PO offer the Board any excuse for seeking, without authorization, additional discovery<sup>2</sup> on supposed practicing of the patent and “commercial success”—a particularly glaring transgression when the Board had previously denied such discovery, finding PO *lacked any threshold evidence that such considerations are present* in this case, *see, e.g.*, Pap. 14 at 3; Pap. 19 at 3; *Malico, Inc. v. Cooler Master USA Inc.*, No. 2013-1680, 2014 WL 6376903, at \*7 (Fed. Cir. Nov. 17, 2014) (“evi-

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<sup>2</sup> Contrary to PO’s claim (Opp. 6-7), “Routine Discovery” of a declarant is limited to the scope of his declaration. §§ 42.51(b)(1)(ii) (“Routine Discovery” includes “Cross examination of affidavit testimony”), 42.53(d)(5)(ii) (“For cross-examination testimony, the scope of the examination is limited to the scope of the direct testimony.”).

dence of secondary considerations of nonobviousness must always, *when present*, be considered in the obviousness analysis”), and when this was called to PO’s attention during the deposition, but PO nonetheless continued its improper questioning. Ex. 1030 356:23-357:11.<sup>3</sup>

Instead, PO argues that any time any witness testifies at the PTAB about obviousness, he is subject to questioning at deposition—without authorization or any showing of nexus or other threshold evidence—on the supposed infringement of a petitioner’s products, including details of their operation. *E.g.*, Opp. at 2-4 (“Mr. Wechselberger provided his opinion on the obviousness of at least one challenged claim”). Indeed, PO goes further to argue a technical expert may be questioned and then criticized for suggesting another type of expert might more appropriately opine about the precise number of sales that triggers “commercial success,” when this was never raised in the deponent’s declaration. *See* Opp. 4-5 (“*how many apps would have to be sold in your opinion...?*”).<sup>4</sup> Mr. Wechselberger opined about no purported secondary con-

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<sup>3</sup> PO’s suggestion that its questions regarding the operation of Petitioner’s products and “commercial success” issues were proper because of Mr. Wechselberger’s background statements about his areas of expertise (Opp. 5-6) is illogical, and simply underscores the baselessness of its position.

<sup>4</sup> *See also* Ex. 1030 371:20-373:16 (supposed inability to answer stemmed from incompleteness of questions).

siderations; PO has offered no threshold evidence that any are present to begin with; and its questioning—an admitted fishing expedition *in search of* such threshold evidence (*e.g.*, Opp. at 5 (“a number of Patent Owner’s questions were related to the nexus”; “Patent Owner’s period for discovery is not yet over, so Patent Owner also can prove nexus through other witnesses”)<sup>5</sup>—was wholly improper. Endorsing it would render Rule 42.53(d)(ii) meaningless, improperly expand any PTAB proceeding involving obviousness into a trial-within-a-trial on supposed infringement by petitioners with commercial products, and thwart Congress’ goal in the AIA to provide, in PTAB proceedings, a timely, efficient, and inexpensive alternative to litigation for resolving disputes about the validity of a challenged patent. *See, e.g.*, 147 Cong. Rec. 1363-1364 (daily ed. Mar. 8, 2011). PO’s open flouting of the rules and guidance of the Board should not be permitted, and the transcript of this improper, out-of-scope questioning<sup>6</sup> should be stricken from the record.

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<sup>5</sup> Tellingly, that discovery period is now closed, and PO has offered no evidence or arguments of secondary indicia in its Preliminary Response (Pap. 6), Response (Pap. 23), or accompanying testimony (*see, e.g.*, Ex. 2029)—further confirming that, in addition to being outside the scope of Mr. Wechselberger’s testimony, secondary indicia are not even presented here. *Malico*, 2014 WL 6376903, at \*7.

<sup>6</sup> PO’s feigned confusion aside (Opp. 7), no “guess[ing]” is required about what testimony should be struck: the entirety of the testimony cited in the Motion (Ex. 1030

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