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

PATENT OWNER'S OPPOSITION TO PETITIONER APPLE INC.'S MOTION TO EXCLUDE UNDER 37 C.F.R. §§ 42.62 AND 42.64

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

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I. Introduction

Patent Owner Smartflash, LLC opposes Petitioner Apple Inc.'s Motion to Exclude, which seeks to exclude Exhibit 2029 (Declaration of Jonathan Katz, Ph.D. in Support of Patent Owner's Response to Petition), and any reference to or reliance on Dr. Katz's declaration in Patent Owner's Response (Paper 23). Motion to Exclude, Paper 39, at 3.

Petitioner's Motion to Exclude should be denied because Dr. Katz qualifies as an expert and his declaration testimony meets the requisites of FRE 702. Petitioner's attack on Dr. Katz's qualifications as an expert is unwarranted. Petitioner's attack relies on deposition excerpts in which Petitioner examined Dr. Katz with ambiguously broad questions and/or on subject matter that was unrelated to the specific opinions he rendered about the application of the prior art references to the patent claims under review in this proceeding. Trying to discredit Dr. Katz, Petitioner strings together a litany of things that Dr. Katz was "not sure" about at his deposition, but that does not change or undermine Dr. Katz's declaration about instances in which the Petition incorrectly alleges the existence of claim elements in the prior art references upon which this review was instituted.

II. Dr. Katz's Declaration Should Not Be Excluded

A. Dr. Katz Qualifies as an Expert Whose Testimony is Admissible.

Federal Rule of Evidence 702 provides:

RULE 702. TESTIMONY BY EXPERT WITNESSES

> A witness who is qualified as an expert by knowledge, skill, experience, training, or education may testify in the form of an opinion or otherwise if:
>
> (a) The expert's scientific, technical, or other specialized knowledge will help the trier of fact to understand the evidence or to determine a fact in issue;
>
> (b) The testimony is based on sufficient facts or data;
>
> (c) The testimony is the product of reliable principles and methods; and
>
> (d) The expert has reliably applied the principles and methods to the facts of the case.

FRE 702.

The technology at issue in this proceeding generally relates to data storage and access systems, including portable data carriers for storing and paying for data and to computer systems for providing access to that data. Ex. 1001 at 00020, 1:20-25. Dr. Katz earned a Ph.D. (with distinction) in Computer Science from Columbia University, has been a professor at University of Maryland since 2002, and has been working in the cybersecurity field since at least May 1999 (Ex. 2029 at 18-19). He is qualified as an expert by knowledge, skill, experience, training, and education. As is clear from Dr. Katz's declaration, he has reviewed the state of the art at the time of patent application filing, the patent claims at issue, the prior art references on which this proceeding was instituted, and he analyzed how Petitioner applies the references to the elements of the claims at issue. Ex. 2029 ¶¶ 10-28. As such, Dr. Katz's testimony is based on sufficient facts or data, is the product of reliable principles and methods, and Dr. Katz has reliably applied the

principles and methods to the facts of the case. Here, Dr. Katz's declaration succinctly points out areas in which the Petition incorrectly alleges the existence of claim elements in the prior art references on which this covered business method review was instituted. As such, Dr. Katz's declaration testimony will help the Board understand the technical evidence and determine the facts regarding patentability of the claims under review. Dr. Katz's testimony is admissible under FRE 702.

Dr. Katz is qualified to testify about what a person of ordinary skill in the art ("POSITA") would have known at the priority date, even if he did not meet the definition at the time. There is no requirement that Dr. Katz had to be a POSITA at the priority date. *Therasense, Inc. v. Becton, Dickinson & Co.*, 593 F.3d 1289, 1321 (Fed. Cir. 2010)("Although [the expert] did not possess [the POSITA] qualifications in 1983 (the invention date of the … patent), this fact would not disqualify him from giving a competent opinion in 1995 as to what a hypothetical person of ordinary skill would have known in 1983"). Here, at the time Dr. Katz rendered his opinions, his qualifications met his POSITA definition. This is distinguishable from *Extreme Networks*, cited by Petitioner, in which the expert did not meet the POSITA definition at the time of rendering her opinion. *Extreme Networks, Inc. v. Enterasys Networks, Inc.*, 395 Fed. Appx. 709, 715 (Fed. Cir. 2010)(expert opined that POSITA had Bachelor of Computer Science or computer

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