

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2014-00108¹
Patent 8,061,598

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

¹ Case CBM2014-00109 has been consolidated with the instant proceeding.

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I. Statement of Precise Relief Requested

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c), Patent Owner Smartflash LLC moves to exclude Exhibits 1002, 1003, 1004, 1005, 1006, 1007, 1008, 1012, 1016, 1017, 1018, 1019, 1020, 1021, 1022, 1028, and 1029. To the extent that Exhibits 1101 – 1120 and 1122 – 1129 from CBM2014-00109, which was consolidated with this action, are considered to be in the record in this action, Patent Owner moves to exclude them as duplicative of their corresponding exhibits from CBM2014-00108. Patent Owner also moves to exclude Exhibit 1121 and portions of Exhibit 1031.

II. Patent Owner Smartflash Timely Objected to Petitioner's Exhibits

Patent Owner Smartflash LLC timely objected to CBM2014-00108 Exhibits 1002, 1003, 1004, 1005, 1006, 1007, 1008, 1012, 1016, 1017, 1018, 1019, 1020, 1021, 1022, 1028, and 1029, as well as CBM2014-00109 Exhibits 1101 – 1120, 1122 – 1129 and 1121. Exhibit 2053. Patent Owner lodged objections to Exhibit 1031 during the deposition of Dr. Jonathan Katz.

III. Argument

Pursuant to 37 C.F.R. § 42.64(c), the Federal Rules of Evidence apply in Covered Business Method Review proceedings.

A. Exhibit 1002 is Inadmissible Other Evidence of the Content of a Writing, Irrelevant, and Cumulative.

Patent Owner moves to exclude Exhibit 1002, (Plaintiff's First Amended Complaint) on grounds that it is: inadmissible other evidence of the content of a writing under FRE 1004; inadmissible under FRE 402 because it fails the test for relevance set forth in FRE 401; and, even if relevant, is cumulative evidence under FRE 403.

The Petition cites to Exhibit 1002 for the sole purpose of showing Patent Owner's description of the subject matter of U.S. Patent 8,061,598 ("the '598 Patent") as "cover[ing] a portable data carrier for storing data and managing access to the data via payment information and/or use status rules" and "cover[ing] a computer network ... that serves data and manages access to data by, for example, validating payment information." Petition at 15 (citing Ex. 1002 ¶ 17). Petitioner does not need to cite to Exhibit 1002 to show the subject matter of the '598 Patent, however, because Exhibit 1001, the actual '598 Patent, is in evidence without objection. Under FRE 1004, other evidence of the content of a writing (here the '598 Patent) is admissible if the original is lost, cannot be obtained, has not been produced, or the writing is not closely related to a controlling issue. None of those conditions apply here, given that the '598 Patent is in evidence and is the subject of the trial.

Patent Owner's description of the '598 Patent in Exhibit 1002 is not relevant to any of the issues here. Petitioner's expert, Anthony J. Wechselberger's Declaration, Exhibit 1021, ("first Wechselberger Declaration") does not cite to Exhibit 1002. The Board's September 30, 2014 *Decision – Institution of Covered Business Method Patent Review 37 C.F.R. § 42.208* ("PTAB Decision"), Paper 8, does not cite to Exhibit 1002. Exhibit 1002 does not appear to make a fact of consequence in determining this action more or less probable than it would be without Exhibit 1002. As such, Exhibit 1002 does not pass the test for relevant evidence under FRE 401 and is not admissible per FRE 402.

Even if Exhibit 1002 was found to be relevant, it should also be excluded under FRE 403 as cumulative of Exhibit 1001.

B. Exhibits 1003, 1004, 1005, 1019, 1022, 1028, and 1029 are Uncited and thus are Irrelevant.

Neither the Petition, nor the Wechselberger Declaration, nor the PTAB Decision cite to Exhibit 1003 (File History for U.S. Patent No. 8,033,458), Exhibit 1004 (File History for U.S. Patent No. 8,118,221), Exhibit 1005 (File History for U.S. Patent No. 8,336,772), Exhibit 1019 (JP Patent Application Publication No. H10-269289 (translation), Exhibit 1022 (U.S. Patent No. 5,754,654), Exhibit 1028 (File History for U.S. Patent No. 7,334,720), or Exhibit 1029 (File History for U.S. Patent No. 7,942,317)("the Uncited Exhibits"). The Uncited Exhibits do not

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