

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC.

Petitioner

v.

SMARTFLASH LLC

Patent Owner

Case CBM2014-00112¹

Patent 7,942,317

PATENT OWNER'S RESPONSE TO PETITION

¹ Case CBM2014-00113 has been consolidated with the instant proceeding.

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I. INTRODUCTION

The present proceeding is a consolidated proceeding for Cases CBM2014-00112 and CBM2014-00113. The Petition in CBM2014-00112 (hereinafter “the 00112 Petition”) raised three Grounds for Unpatentability of claims 1, 6-8, 12-14, 16 and 18. Decision at 3. The first ground was unpatentability under 35 U.S.C. § 102 over U.S. Patent No. 5,530,235 (“Stefik ‘235”) and U.S. Patent No. 5,629,980 (“Stefik ‘980”). The second ground was unpatentability under 35 U.S.C. § 103 over Stefik ‘235 and Stefik ‘980. The third ground was unpatentability under 35 U.S.C. § 103 over Stefik ‘235, Stefik ‘980 and EP0809221A2 (“Poggio”). The PTAB denied the first ground, granted the second ground (except for claim 14) and denied on the third ground. Decision at 22.

The Petition in CBM2014-00113 (hereinafter “the 00113 Petition”) similarly raised three Grounds for Unpatentability. Decision at 3. The first ground was unpatentability of claims 1, 6-8, 12-14, 16 and 18 under 35 U.S.C. § 103 over U.S. Patent No. 5,915,019 (“Ginter”). The second ground was unpatentability of claims 1, 6-8, 12-14, 16 and 18 under 35 U.S.C. § 103 over Ginter and Poggio. The third ground was unpatentability of claims 12-14 under 35 U.S.C. § 103 over Ginter, Stefik ‘235, and Stefik ‘980. The PTAB granted the first ground (except for claim 14) and denied on the second and third grounds. Decision at 22.

In support of this Patent Owner's Response, reference will be made to concurrently filed Exhibit 2031, Declaration of Jonathan Katz, Ph.D. (hereinafter "the Katz Declaration"), Exhibit 1021. Reference will also be made herein to (1) DECLARATION OF ANTHONY J. WECHSELBERGER IN SUPPORT OF APPLE INC.'S PETITION FOR COVERED BUSINESS METHOD PATENT REVIEW OF UNITED STATES PATENT NO. 7,942,317 PURSUANT TO 35 U.S.C. § 321, 37 C.F.R. § 42.304, filed in CBM2014-00112 (hereinafter "the 00112 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. 7,942,317 PURSUANT TO 35 U.S.C. § 321, 37 C.F.R. § 42.304, filed in CBM2014-00113 (hereinafter "the 00113 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 19, 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 00112 Wechselberger Declaration does not state that Mr. Wechselberger’s opinions presented therein were based on a “preponderance of the evidence” standard.

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