UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2014-00112[1]
Patent 7,942,317 B2

PATENT OWNER'S OBJECTIONS TO ADMISSIBILITY OF EVIDENCE

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

Pursuant to 37 C.F.R. § 42.64, Patent Owner hereby objects to the admissibility of certain evidence submitted with Petitioner's petition ("the Petition"). Patent Owner's objections are based on the Federal Rules of Evidence and the Board Rules and are set forth with particularity below.

Exhibit 1002 (Plaintiff's First Amended Complaint)

Patent Owner objects to the admissibility of Exhibit 1002 on grounds that it is cumulative evidence and irrelevant. The Petition cites to Exhibit 1002 for the sole purpose of showing Patent Owner's characterization of the '317 Patent as relating to "a portable data carrier for storing data and managing access to the data via payment information and/or use status rules" and covering a computer network that "serves data and manages access to data by, for example, validating payment information." Petition at 10 (citing Ex. 1002 ¶ 17). Petitioner's expert, Anthony J. Wechselberger's Declaration, Exhibit 1021, ("Wechselberger Declaration") does not cite to Exhibit 1002. Petitioner does not need to cite to Exhibit 1002 to characterize what the '317 Patent relates to when Exhibit 1001, the actual '317 Patent, is in evidence. Under Fed. R. Evid. 1004, other evidence of the content of a writing (here the '317 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 apply given that the '317 Patent is in evidence and is the subject of the trial. The PTAB should also exclude Exhibit 1002 under Fed. R. Evid. 403 as cumulative of Exhibit 1001.

Moreover, Patent Owner's characterization of the '317 Patent in its First Amended Complaint is not relevant to any of the issues here. Being irrelevant evidence, Exhibit 1002 is not admissible. Fed. R. Evid. 402.

Exhibit 1004 (File History for U.S. Patent No. 8,118,221)

Neither the Petition, nor the Wechselberger Declaration, nor the PTAB's September 30, 2014 *Decision – Institution of Covered Business Method Patent Review 37 C.F.R. § 42.208* ("PTAB Decision") cites to Exhibit 1004. Exhibit 1004 does not appear to make a fact of consequence in determining this action more or less probable than it would be without Exhibit 1004. As such, Exhibit 1004 does not pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, Exhibit 1004 is not admissible. Fed. R. Evid. 402.

Exhibit 1005 (File History for U.S. Patent No. 8,336,772)

Neither the Petition, nor the Wechselberger Declaration, nor the PTAB Decision cites to Exhibit 1005. Exhibit 1005 does not appear to make a fact of consequence in determining this action more or less probable than it would be without Exhibit 1005. As such, Exhibit 1005 does not pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, Exhibit 1005 is not admissible. Fed. R. Evid. 402.

Exhibit 1006 (U.S. Patent No. 4,999,806)

Neither the Petition nor the Wechselberger Declaration cites Exhibit 1006 as potentially invalidating prior art, either alone or in combination with any other reference. The PTAB Decision did not base any of its analysis on Exhibit 1006. Thus, Exhibit 1006 does not appear to make *a fact of consequence in determining this action* more or less probable than it would be without Exhibit 1006. As such, Exhibit 1006 does not pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, Exhibit 1006 is not admissible. Fed. R. Evid. 402.

Exhibit 1007 (U.S. Patent No. 5,675,734)

Neither the Petition nor the Wechselberger Declaration cites Exhibit 1007 as potentially invalidating prior art, either alone or in combination with any other reference. The PTAB Decision did not base any of its analysis on Exhibit 1007. Exhibit 1007 does not appear to make *a fact of consequence in determining this action* more or less probable than it would be without Exhibit 1007. As such, Exhibit 1007 does not pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, Exhibit 1007 is not admissible. Fed. R. Evid. 402.

Exhibit 1008 (U.S. Patent No. 4,878,245)

Neither the Petition nor the Wechselberger Declaration cites Exhibit 1008 as potentially invalidating prior art, either alone or in combination with any other reference. The PTAB Decision did not base any of its analysis on Exhibit 1008. Thus, Exhibit 1008 does not appear to make *a fact of consequence in determining this action* more or less probable than it would be without Exhibit 1008. As such, Exhibit 1008 does not pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, Exhibit 1008 is not admissible. Fed. R. Evid. 402.

Exhibit 1009 (U.S. Patent No. 5,754,654)

Neither the Petition, nor the Wechselberger Declaration, nor the PTAB Decision cites to Exhibit 1009. In fact, Wechselberger Declaration does not even list Exhibit 1009 in its list of "Materials Reviewed and Relied Upon." Wechselberger Declaration, Exhibit 1021, Appendix C p. 46. Exhibit 1009 does not appear to make a fact of consequence in determining this action more or less probable than it would be without Exhibit 1009. As such, Exhibit 1009 does not

pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, Exhibit 1009 is not admissible. Fed. R. Evid. 402.

Exhibit 1012 (U.S. Patent No. 5,103,392)

Neither the Petition nor the Wechselberger Declaration cites Exhibit 1012 as potentially invalidating prior art, either alone or in combination with any other reference. The PTAB Decision did not base any of its analysis on Exhibit 1012. Thus, Exhibit 1012 does not appear to make *a fact of consequence in determining this action* more or less probable than it would be without Exhibit 1012. As such, Exhibit 1012 does not pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, Exhibit 1012 is not admissible. Fed. R. Evid. 402.

Exhibit 1016 (European Patent Application, Publication No. EP0809221A2)

The PTAB Decision did not adopt any of the proposed invalidity grounds based on Exhibit 1016. Thus, Exhibit 1016 does not appear to make *a fact of consequence in determining this action* more or less probable than it would be without Exhibit 1016. As such, Exhibit 1016 does not pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, Exhibit 1016 is not admissible. Fed. R. Evid. 402.

Exhibit 1017 (PCT Application Publication No. WO 99/43136)

Neither the Petition nor the Wechselberger Declaration cites Exhibit 1017 as potentially invalidating prior art, either alone or in combination with any other reference. The PTAB Decision did not base any of its analysis on Exhibit 1017. Thus, Exhibit 1017 does not appear to make *a fact of consequence in determining this action* more or less probable than it would be

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