

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 B2

**PATENT OWNER'S REPLY IN SUPPORT OF
MOTION TO EXCLUDE EVIDENCE**

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

TABLE OF CONTENTS

I. INTRODUCTION1

II. ARGUMENT.....1

 A. The Board Should Exclude Exhibit 1002.....1

 B. The Board Should Exclude Exhibits 1004 - 1005, 1009, 1019,2
 And 1027 - 10292

 C. The Board Should Exclude Exhibits 1006, 1007, 1012, 1017, and
 10202

 D. The Board Should Exclude Exhibit 1016 and 1018.....3

 E. The Board Should Exclude Exhibit 1021.....3

 F. The Board Should Exclude Requested Portions of Exhibit 10314

 G. The Board Should Exclude Exhibits 1101-1129.....5

III. CONCLUSION.....5

I. INTRODUCTION

Patent Owner understands that “the Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to the evidence presented in this trial, without resorting to formal exclusion that might later be held reversible error.” *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM2012-00002, Paper 66, Final Written Decision (PTAB January 23, 2014)(citing *S.E.C. v. Guenther*, 395 F. Supp. 2d 835, 842 n.3 (D. Neb. 2005)). At the same time, the Federal Rules of Evidence apply (37 CFR § 42.62(a)) and it is within the Board’s authority to manage the record by ruling on the admissibility of evidence based on the trial as instituted so that in the event of an appeal under 35 U.S.C. § 142, a proper record exists that can be transmitted to the United States Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. § 143.

II. ARGUMENT

A. The Board Should Exclude Exhibit 1002

Ex. 1002 does not contain a “highly relevant admission” (Paper 42 at 2), but instead says nothing more than the patent itself in Ex. 1001 at 1:20-23 (“This invention ... relates to a portable data carrier for storing and paying for data...”) and 1:64-66 (“reading payment information,” “validating the payment

information”). Ex. 1002 is inadmissible other evidence of the content of a writing under FRE 1004, cumulative under FRE 403, and irrelevant under FRE 401, 402.

B. The Board Should Exclude Exhibits 1004 - 1005, 1009, 1019, And 1027 - 1029

Ex. 1004 - 1005, 1009, 1019, and 1027 – 1029 are not cited in any substantive way. The exhibits were merely listed in “Materials Reviewed and Relied Upon” by Mr. Wechselberger. Pap. 42 at 3. These exhibits are not relevant and not admissible. FRE 401, 402.

C. The Board Should Exclude Exhibits 1006, 1007, 1012, 1017, and 1020

CBM review in this case was instituted on 35 U.S.C. § 103 grounds based on: the combination of Stefik ’235 and Stefik ’980; and separately, Ginter. All other grounds were denied. Pap. 7, at 22. Patent Owner does not dispute that “as part of the obviousness analysis, the prior art must be viewed in the context of what was generally known in the art at the time of the invention” (Pap. 42 at 3-4 (citing *In re Taylor Made Golf Co.*, 589 F. App’x 967, 971 (Fed. Cir. 2014))), but none of these exhibits or their teachings are cited in Petitioner’s invalidity allegations for “what was generally known in the art” to meet a claim limitation. In contrast to *Taylor Made*, there is no missing claim limitation in Petitioner’s references that Petitioner alleges is satisfied by general knowledge possessed by one skilled in the art, like “press fitting” was in *Taylor Made*. Here, neither the Petition nor the Wechselberger declaration rely on Ex. 1006, 1007, 1012, 1017, or

1020 to fill in with “general knowledge” any aspect of a claim limitation. They should not be in evidence. FRE 401, 402.

D. The Board Should Exclude Exhibit 1016 and 1018

Petitioner asserts that Ex. 1016 and 1018, references for which the Board did not adopt Petitioner’s proposed invalidity grounds, are “evidence of the state of the art and a POSITA’s knowledge” (Pap.42 at 5) like Ex. 1006, 1007, 1012, 1017, and 1020, discussed above. The Board did not accept Ex. 1016 or 1018 as invalidating prior art. They are irrelevant and inadmissible like Ex. 1006, 1007, 1012, 1017, and 1020.

E. The Board Should Exclude Exhibit 1021

The Board cannot assess whether Mr. Wechselberger’s opinion testimony under FRE 702 is “the product of reliable principles and methods” or if Mr. Wechselberger “reliably applied the principles and methods to the facts of the case” given that Mr. Wechselberger did not disclose the standard against which he measured the quantum of prior art evidence (substantial evidence or preponderance of the evidence) in arriving at his opinions. As such, there is no basis to admit his expert testimony.² Patent Owner’s *lack of objection* in the litigation to the “*offer of*

² Patent Owner acknowledges that FRE 602 is inapplicable to expert witnesses (Pap. 42 at 5). However, Mr. Wechselberger never states that he is an expert in the types of methods and systems defined by the challenged claims.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.