

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC. and
SAMSUNG ELECTRONICS CO. LTD,

Petitioner,

v.

SMARTFLASH LLC,

Patent Owner.

Case CBM2014-00199

Patent 8,118,221 B2

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

TABLE OF CONTENTS

I.	Statement of Precise Relief Requested.....	1
II.	Patent Owner Smartflash Timely Objected to Petitioner’s Exhibits.....	1
III.	Argument	1
	A. Exhibit 1003 Is Inadmissible.....	1
	1. Exhibit 1003 Lacks Foundation And Is Unreliable	1
	2. Exhibit 1003 Paragraphs 104-112 Constitute Inadmissible Expert Testimony On United States Patent Law And Patent Examination.....	5
IV.	Conclusion	5

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 Exhibit 1003.

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

Patent Owner Smartflash LLC timely objected to CBM2014-00199 Exhibit 1003 by serving Patent Owner's Objections to Admissibility of Evidence on April 13, 2015. Exhibit 2098.

III. Argument

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

A. Exhibit 1003 Is Inadmissible

1. Exhibit 1003 Lacks Foundation And Is Unreliable

Petitioner relies on Exhibit 1003 on pages 4, 6-8, 10, 12, 13, 15, 17-20, 22-29, 31, 33-39, and 41-52 of the Corrected Petition (Paper 4) and pages 2, 3, 5, 11, and 15 of Petitioner's Reply (Paper 28). Patent Owner moves to exclude Exhibit 1003, Declaration of Dr. Jeffrey A. Bloom ("Bloom Declaration"), on grounds that it lacks foundation and is unreliable because it fails to meet the foundation and reliability requirements of 37 CFR § 42.65(a) and FRE 702.

37 CFR § 42.65(a) provides:

§ 42.65 Expert testimony; tests and data.

(a) *Expert testimony that does not disclose the underlying facts or data on which the opinion is based*

is entitled to little or no weight. Testimony on United States patent law or patent examination practice will not be admitted.

37 CFR § 42.65(a) (emphasis added). FRE 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.

Patent Owner moves to exclude the Bloom Declaration because it does not disclose the underlying facts or data on which the opinions contained are based as required by 37 CFR § 42.65(a), given that it does not state the relative evidentiary weight (e.g., substantial evidence versus preponderance of the evidence) used by Dr. Bloom in arriving at his conclusions. “A finding is supported by substantial evidence if a reasonable mind might accept the evidence to support the finding.” *Q. I. Press Controls, B.V. v. Lee*, 752 F.3d 1371, 1378-1379 (Fed. Cir. 2014)(citing *Consol. Edison Co. v. NLRB*, 305 U.S. 197, 229, 59 S. Ct. 206, 83 L. Ed. 126 (1938)). Proof by a “preponderance of the evidence” means “that it is more likely

than not.” See, *O2 Micro Int'l Ltd. v. Beyond Innovation Tech. Co.*, 449 Fed. Appx. 923, 928 (Fed. Cir. 2011).

Petitioner has cited, and likely will cite again, *Vibrant Media v. General Electric Company*, IPR2013-00172, Paper 50 at 42, for the proposition that an expert need not expressly set forth the evidentiary standard used in formulating opinions. See, Petitioner’s Reply to Patent Owner’s Response, Paper 28, at 1-3. In particular, Petitioner will likely rely on the Board’s conclusion in *Vibrant Media* that “it is within [the Board’s] discretion to assign the appropriate weight to be accorded to evidence based on whether the expert testimony discloses the underlying facts or data on which the opinion is based.” Petitioner’s Reply, Paper 28 at 2 (citing *Vibrant Media*, Paper 50 at 42). The Board’s conclusion in *Vibrant Media*, however, ignores that under FRE 702, the admissibility of expert testimony requires a finding not only that “the testimony is based on sufficient facts or data” (FRE 702(b)), but also that “the testimony is the product of reliable principles and methods” (FRE 702(c)) and that “the expert has reliably applied the principles and methods to the facts of the case” (FRE 702(d)).

Here, the Board cannot assess under FRE 702 whether Dr. Bloom’s opinion testimony is “based on sufficient facts or data,” is “the product of reliable principles and methods,” or if Dr. Bloom “reliably applied the principles and methods to the facts of the case” given that Dr. Bloom did not disclose the standard

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.