

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2015-00015
Patent 8,118,221 B2

PATENT OWNER'S OBJECTIONS TO ADMISSIBILITY OF EVIDENCE

Pursuant to 37 C.F.R. § 42.64, Patent Owner hereby objects to the admissibility of certain evidence submitted with Petitioner's petition ("the Corrected 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 1202 (Plaintiff's First Amended Complaint)

Patent Owner objects to the admissibility of Exhibit 1202 on grounds that it is cumulative evidence and irrelevant. The Corrected Petition cites to Exhibit 1202 for the sole purpose of showing Patent Owner's characterization of the '221 Patent as covering "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." Corrected Petition at 11 (citing Ex. 1202 ¶ 17). Petitioner's expert, Anthony J. Wechselberger's Declaration, Exhibit 1221, ("Wechselberger Declaration") does not cite to Exhibit 1202. Petitioner does not need to cite to Exhibit 1202 to characterize what the '221 Patent relates to when Exhibit 1201, the actual '221 Patent, is in evidence. Under Fed. R. Evid. 1004, other evidence of the content of a writing (here the '221 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 '221 Patent is in evidence and is the subject of the trial. The PTAB should also exclude Exhibit 1202 under Fed. R. Evid. 403 as cumulative of Exhibit 1201.

Moreover, Patent Owner's characterization of the '221 Patent in its First Amended Complaint is not relevant to any of the issues here. Being irrelevant evidence, Exhibit 1202 is not admissible. Fed. R. Evid. 402.

Exhibit 1203 (File History for U.S. Patent No. 8,061,598)

Exhibit 1204 (File History for U.S. Patent No. 8,336,772)

Exhibit 1227 (File History for U.S. Patent No. 7,334,720)

Exhibit 1228 (File History for U.S. Patent No. 7,942,317)

Exhibit 1229 (File History for U.S. Patent No. 8,033,458)

Neither the Corrected Petition, nor the Wechselberger Declaration, nor the PTAB's April 10, 2015 *Decision – Institution of Covered Business Method Patent Review and Denying Motion for Joinder* 37 C.F.R. § 42.208, 37 C.F.R. § 42.222(b) ("PTAB Decision") cite to Exhibits 1203, 1204, 1227, 1228, or 1229 ("the Uncited Exhibits"). Patent Owner objects to the Uncited Exhibits on relevance grounds. The Uncited Exhibits do not appear to make a fact of consequence in determining this action more or less probable than it would be without the Uncited Exhibits. As such, the Uncited Exhibits do not pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, the Uncited Exhibits are not admissible. Fed. R. Evid. 402.

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Exhibit 1205 (U.S. Patent No. 5,675,734)(“Hair”)

Exhibit 1206 (U.S. Patent No. 4,999,806)(“Chernow”)

Exhibit 1207 (U.S. Patent No. 4,878,245)(“Bradley”)

Exhibit 1212 (U.S. Patent No. 5,103,392)(“Mori”)

Exhibit 1215 (U.S. Patent No. 5,915,019)(“Ginter”)

Exhibit 1217 (PCT Application Publication No. WO 99/43136)(“Rydbeck”)

Exhibit 1218 (JP Publication No. H11-164058A (translation))(“Sato”)

Exhibit 1220 (Eberhard von Faber, Robert Hammelrath, and Franz-Peter Heider, “The Secure Distribution of Digital Contents,” IEEE (1997))(“von Faber”)

Exhibit 1231 (U.S. Patent No. 4,337,483)(“Guillou”)

Exhibit 1232 (U.S. Patent No. 7,725,375)(“Shepherd”)

Exhibit 1233 (U.S. Patent No. 5,925,127)(“Ahmad”)

Patent Owner objects to Exhibits 1205, 1206, 1207, 1212, 1215, 1217, 1218, 1220, 1231, 1232, and 1233 (“the Non-asserted Reference Exhibits”) on relevance grounds because the Petitioner did not assert these references as alleged invalidating prior art in its Corrected Petition in this case. Moreover, the PTAB Decision instituted covered business method review only on the ground that claim 1 is patent ineligible under 35 U.S.C. § 101, a purely legal issue. As such, the Non-asserted Reference Exhibits fail the test for relevant evidence because nothing in the Non-asserted Reference Exhibits makes a fact of consequence in determining this action more or less probable than it would be without the Non-asserted Reference Exhibits. Fed. R. Evid. 401(b). Being irrelevant evidence, the Non-asserted Reference Exhibits are not admissible. Fed. R. Evid. 402.

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Exhibit 1210 (U.S. Patent No. 5,940,805) (“Kopp”)

Exhibit 1213 (U.S. Patent No. 5,530,235) (“Stefik ‘235”)

Exhibit 1214 (U.S. Patent No. 5,629,980) (“Stefik ‘980”)

Exhibit 1216 (European Patent Application, Publication No. EP0809221A2) (“Poggio”)

Exhibit 1219 (International Publication No. WO 95/34857) (“Smith”)

Patent Owner objects to Exhibits 1210, 1213, 1214, 1216, and 1219 (“the Alleged Prior Art Exhibits”) on relevance grounds because the PTAB Decision did not adopt any of the proposed invalidity grounds based on the Alleged Prior Art Exhibits. The Alleged Prior Art Exhibits therefore fail the test for relevant evidence because nothing in the Alleged Prior Art Exhibits makes a fact of consequence in determining this action more or less probable than it would be without the Alleged Prior Art Exhibits. Fed. R. Evid. 401(b). Being irrelevant evidence, the Alleged Prior Art Exhibits are not admissible. Fed. R. Evid. 402.

Exhibit 1221 (Declaration of Anthony J. Wechselberger In Support of Apple Inc.’s Petition for Covered Business Method Patent Review)

Patent Owner objects to Exhibit 1221, the Wechselberger Declaration, in its entirety under Fed. R. Evid. 401 because the trial as instituted is limited to patentability under 35 U.S.C. § 101. As such, paragraphs 23-79 (and any other portion of the Wechselberger Declaration that is directed to patentability under 35 U.S.C. §§ 102/103) are not relevant to the instituted proceeding. Fed. R. Evid. 401. Being irrelevant evidence, those paragraphs are not admissible. Fed. R. Evid. 402.

Furthermore, paragraphs 80-113 are objected to because they deal with the strictly legal issue of statutory subject matter for which Mr. Wechselberger is not an expert. Thus, those portions of the Wechselberger Declaration are objected to under Fed. R. Evid. 401 as not

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