UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SMARTFLASH LLC,
Patent Owner

Case CBM2015-00016
Patent 8,033,458 B2

Before the Honorable JENNIFER S. BISK, RAMA G. ELLURU, JEREMY M. PLENZLER, and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

PETITIONER APPLE INC.'S OBJECTIONS TO PATENT OWNER SMARTFLASH LLC'S EXHIBITS

Pursuant to 37 C.F.R. § 42.64(b)(1), the undersigned, on behalf of and acting in a representative capacity for Petitioner Apple Inc. ("Petitioner"), hereby submits the following objections to Patent Owner Smartflash, LLC's ("Patent Owner") Exhibits 2049, 2050, 2058, and 2073, and any reference thereto/reliance thereon, without limitation. Petitioner's objections below apply the Federal Rules of Evidence ("F.R.E.") as required by 37 C.F.R § 42.62.

These objections address evidentiary deficiencies in the new material submitted by Patent Owner on June 24, 2015.

The following objections apply to Exhibits 2049, 2050, 2058, and 2073 as they are actually presented by Patent Owner, in the context of Patent Owner's June 24, 2015 Patent Owner's Response (Paper 33) and not in the context of any other substantive argument on the merits of the instituted grounds in this proceeding. Petitioner expressly objects to any other purported use of these Exhibits, including as substantive evidence in this proceeding, which would be untimely and improper under the applicable rules, and Petitioner expressly asserts, reserves and does not waive any other objections that would be applicable in such a context.

I. Objections to Exhibits 2049, 2050, and 2058, And Any Reference to/Reliance Thereon

Evidence objected to: Exhibits 2049 ("Report and Recommendation (on Defendants' 101 SJ Motions)"), 2050 ("Order Adopting Report and Recommendation (on Defendants' 101 SJ Motions)"), and 2058 ("Memorandum Opinion and Order (on Defendants' Motions for Stay Pending the Outcome of CBMs)").

Grounds for objection: F.R.E. 401 ("Test for Relevant Evidence"); F.R.E. 402 ("General Admissibility of Relevant Evidence"); F.R.E. 403 ("Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons"); and 37 C.F.R. § 42.61 ("Admissibility").

Apple objects to the use of Exhibits 2049, 2050, and 2058 under F.R.E. 401, 402, and 403, and 37 C.F.R. § 42.61. Patent Owner's Response relies on Exhibits 2049, 2050, and 2058 to urge the Board to adopt the District Court's non-final findings and ruling on patent eligibility (on fewer than all claims instituted on § 101 grounds in this proceeding) instead of independently determining the eligibility of the instituted claims. *See*, *e.g.*, Paper 33 at 2, 12-13, 18-19, 22, 27-28. However, the District Court's non-final findings and ruling on patent eligibility are not binding on the Board. *See SAP Am., Inc. v. Versata Dev. Grp., Inc.*, No. CBM2012-00001, Paper 36 at 19-20 (P.T.A.B. Jan. 9, 2013). Further, the District Court's Orders were based on claim constructions that differ from the Board's constructions in this proceeding and do not control here, *see*, *e.g.*, Paper 9 at 20-21; Paper 23 at 11-12, and the Board applies a preponderance of the evidence standard. *Cf. Rockstar Consortium US LP, Inc. v. Samsung Elecs. Co., Ltd.*, Nos. 2:13-cv-894, 2:13-cv-900, 2014 WL 1998053, at *3 (E.D. Tex. May 15, 2014) (Gilstrap, J.). In addition, the District Court's denial of a stay in the litigation has no bearing on the patentability of the instituted claims. Accordingly, these Exhibits do not appear to make any fact of consequence in determining this action more or less probable than it would be without them and are thus irrelevant and not admissible (F.R.E. 401, 402); permitting reference to/reliance on these documents in any future submissions of Patent Owner would also be impermissible, misleading,

irrelevant, and unfairly prejudicial to Petitioner (F.R.E. 402, 403); and to the extent Patent Owner attempts to rely on or submit these aforementioned Exhibits in the future as evidence in support of new substantive positions, doing so would be untimely, in violation of the applicable rules governing this proceeding, and unfairly prejudicial to Apple (F.R.E. 403).

II. Objections to Exhibit 2073, And Any Reference to/Reliance Thereon

Evidence objected to: Exhibits 2073 ("Apple's Preliminary Claim Constructions and Extrinsic Evidence").

Grounds for objection: F.R.E. 401 ("Test for Relevant Evidence"); F.R.E. 402 ("General Admissibility of Relevant Evidence"); F.R.E. 403 ("Excluding Relevant Evidence for Prejudice, Confusion, Waste of Time, or Other Reasons"); 37 C.F.R. § 42.61 ("Admissibility"); F.R.E. 901 ("Authenticating or Identifying Evidence"); F.R.E. 1002 ("Requirement of the Original"); and F.R.E. 1003 ("Admissibility of Duplicates").

Apple objects to the use of Exhibit 2073 under F.R.E. 901, 1002, 1003, and 37 C.F.R. § 42.61 because Patent Owner fails to provide the authentication required for the document. Although Exhibit 2070 ("Declaration of Emily E. Toohey in Support of Patent Owner's Response") claims that "Exhibit 2073 is a true and correct copy of Apple's Preliminary Claim Constructions and Extrinsic Evidence filed in *Smartflash, LLC, et al. v. Apple Inc., et al.*, Case No. 6:13-CV-

447 (E.D. Tex.) that [was] downloaded from PACER on June 19, 2015" (Exhibit 2070 ¶ 7), Exhibit 2073 does not include the District Court's stamped header or otherwise indicate that it was "filed" such that it can be "downloaded from PACER."

Apple further objects to the use of Exhibit 2073 under F.R.E. 401, 402, and 403, and 37 C.F.R. § 42.61 because Patent Owner's Response does not substantively cite to this Exhibit. Apple further objects to the use of Exhibit 2073 under F.R.E. 401, 402, and 403, and 37 C.F.R. § 42.61 to the extent Patent Owner intended to rely on Exhibit 2073 to support its argument that Apple's contention that claim 11 is indefinite "contradicts Apple's claim construction position in District Court in which Apple offered a single definition for 'use rule' and 'use rule data.'" Paper 33 at 3; *see also id*. at 28-29. That Apple may have proposed the same definition in litigation for the terms "use rule" and "use rule data"—which was ultimately rejected by the District Court—under a *different standard*, *see In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364, 1369 (Fed. Cir. 2004); MPEP § 2111, has no relevance to this proceeding. Indeed, as noted in its Petition, Apple expressly reserved the right to argue different claim constructions in litigation because the standard for claim construction at the PTO is different than that used in litigation. Paper 9 at 20. Accordingly, this Exhibit does not appear to make any fact of consequence in determining this action more or less probable than

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