

**UNITED STATES PATENT AND TRADEMARK OFFICE**

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**BEFORE THE PATENT TRIAL AND APPEAL BOARD**

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APPLE INC.,  
Petitioner,

v.

SMARTFLASH LLC,  
Patent Owner.

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Case CBM2015-00016  
Patent 8,033,458 B2

**PATENT OWNER'S OBJECTIONS TO ADMISSIBILITY OF EVIDENCE**

Smartflash - Exhibit 2100

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 '458 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 12 (citing Ex. 1202 ¶ 17). Petitioner's expert, Anthony J. Wechselberger's Declaration, Exhibit 1220, ("Wechselberger Declaration") does not cite to Exhibit 1202. Petitioner does not need to cite to Exhibit 1202 to characterize what the '458 Patent relates to when Exhibit 1201, the actual '458 Patent, is in evidence. Under Fed. R. Evid. 1004, other evidence of the content of a writing (here the '458 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 '458 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 '458 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 1208 (Russell Housley and Jan Dolphin, “Metering: A Pre-pay Technique,” Storage and Retrieval for Image and Video Databases V, Conference Volume 3022, 527 (January 15, 1997))**

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 Exhibit 1208. Patent Owner objects to Exhibit 1208 on relevance grounds. Exhibit 1208 does not appear to make a fact of consequence in determining this action more or less probable than it would be without Exhibit 1208. As such, Exhibit 1208 does not pass the test for relevant evidence under Fed. R. Evid. 401. Being irrelevant evidence, Exhibit 1208 is not admissible. Fed. R. Evid. 402.

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

**Exhibit 1207 (U.S. Patent No. 5,675,734)(“Hair”)**

**Exhibit 1209 (U.S. Patent No. 4,878,245)(“Bradley”)**

**Exhibit 1211 (U.S. Patent No. 4,337,483)(“Guillou”)**

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

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

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

**Exhibit 1219 (Eberhard von Faber, Robert Hammelrath, and Franz-Peter Heider, “The Secure Distribution of Digital Contents,” IEEE (1997))(“von Faber”)**

**Exhibit 1226 (U.S. Patent No. 7,725,375)(“Shepherd”)**

**Exhibit 1227 (International Publication No. WO 95/34857)(“Smith”)**

Patent Owner objects to Exhibits 1206, 1207, 1209, 1211, 1212, 1216, 1217, 1219, 1226, and 1227 (“the Non-asserted Reference Exhibits”) on relevance grounds because the Petitioner

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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 claims 1, 6, 8, and 10 are patent ineligible under 35 U.S.C. § 101 and that claim 11 is indefinite under 35 U.S.C. § 112, second paragraph, issues unrelated to the prior art. 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.

**Exhibit 1203** (U.S. Patent No. 5,925,127)(“Ahmad”)

**Exhibit 1205** (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 1215** (U.S. Patent No. 5,915,019)(“Ginter”)

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

Patent Owner objects to Exhibits 1203, 1205, 1213, 1214, 1215, and 1218 (“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 1220 (Declaration of Anthony J. Wechselberger In Support of Apple Inc.'s Petition for Covered Business Method Patent Review)**

Patent Owner objects to Exhibit 1220, 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 and indefiniteness under 35 U.S.C. § 112, second paragraph. As such, paragraphs 24-71 (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.

Paragraphs 24-26 and 72-75 are objected to because they deal with the issue of indefiniteness and the Wechselberger Declaration does not prove that Mr. Wechselberger is an expert whose testimony is relevant to the issue. While Mr. Wechselberger may opine that he was “one of ordinary skill in the art,” he does not, however, state that he is an expert in the types of methods and systems defined by the challenged claims nor does he provide proof that he is an expert. Thus, Mr. Wechselberger has not proven that his opinions are proper expert opinions upon which the PTAB can rely as opposed to inadmissible lay opinions. Fed. R. Evid. 701 and 702. Thus, those portions of the Wechselberger Declaration are objected to under Fed. R. Evid. 602 as lacking foundation.

Paragraphs 76-105 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 relevant, under Fed. R. Evid. 602 as lacking foundation, and under Fed. R. Evid. 701 and 702 as providing legal opinions on which the lay witness is not competent to testify. Being irrelevant evidence, those paragraphs are not admissible. Fed. R. Evid. 402.

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