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

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

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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. Guenthner*, 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 1202

Ex. 1202 does not contain a "highly relevant admission" (Paper 43 at 2), but instead says nothing more than the patent itself in Ex. 1201 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. 1202 therefore is inadmissible other evidence of the content of

a writing under FRE 1004, cumulative under FRE 403, and irrelevant under FRE 401, 402.

B. Petitioner Does Not Oppose Exclusion of Exhibit 1208

Petitioner concedes that Ex. 1208 was not relied on and does not oppose its exclusion. Paper 43 at 3, n.1.

C. The Board Should Exclude Exhibits 1206, 1207, 1209, 1211, 1212, 1216, 1217, 1219, 1226, and 1227

Ex. 1206, 1207, 1209, 1211, 1212, 1216, 1217, 1219, 1226, and 1227 are not alleged to be invalidating prior art. These exhibits are not relevant and not admissible. FRE 401, 402.

D. The Board Should Exclude Exhibits 1203, 1205, 1213, 1214, 1215, and 1218

Exhibits 1203, 1205, 1213, 1214, 1215, and 1218 were originally alleged to be invalidating prior art under 35 U.S.C. § 103 (Paper 23 at 3), but CBM review in this case was instituted on claims 1, 6, 8, and 10 of the '458 Patent on 35 U.S.C. § 101 grounds and on claim 11 on 35 U.S.C. § 112 grounds only. No other grounds were authorized. Paper 23 at 26. These exhibits therefore should no longer be in evidence. FRE 401, 402.

E. The Board Should Exclude Exhibit 1220

The Board cannot assess under FRE 702 whether Mr. Wechselberger's opinion testimony is "based on sufficient facts or data," 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 (substantial evidence or preponderance of the evidence) against which he measured the quantum of evidence in arriving at his opinions. As such, there is no basis to admit his expert testimony.[1]

III. CONCLUSION

Patent Owner respectfully requests that the Board exclude the exhibits.

Dated: October 22, 2015

/ Michael R. Casey /

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[1] Patent Owner acknowledges that FRE 602 is inapplicable to expert witnesses (Pap. 43 at 8). However, Mr. Wechselberger never states that he is an expert in the types of methods and systems defined by the challenged claims.

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