UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2015-00018
Patent 7,942,317 B2

PATENT OWNER'S OBJECTIONS TO ADMISSIBILITY OF EVIDENCE

Smartflash - Exhibit 2102

Pursuant to 37 C.F.R. § 42.64, Patent Owner hereby objects to the admissibility of certain evidence submitted with Petitioner's petition ("the 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 Petition cites to Exhibit 1202 for the sole purpose of showing Patent Owner's characterization of the '317 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." Petition at 13 (citing Ex. 1202 ¶ 17). Petitioner's expert, Anthony J. Wechselberger's Declaration, Exhibit 1217, ("Wechselberger Declaration") does not cite to Exhibit 1202. Petitioner does not need to cite to Exhibit 1202 to characterize what the '317 Patent relates to when Exhibit 1201, the actual '317 Patent, is in evidence. Under Fed. R. Evid. 1004, other evidence of the content of a writing (here the '317 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 '317 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 '317 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 (U.S. Patent No. 5,940,805)("Kopp")

Exhibit 1204 (U.S. Patent No. 4,999,806)("Chernow")

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

Exhibit 1206 (U.S. Patent No. 4,337,483)("Guillou")

Exhibit 1209 (U.S. Patent No. 5,103,392)("Mori")

Exhibit 1210 (U.S. Patent No. 5,530,235)("Stefik '235")

Exhibit 1211 (U.S. Patent No. 5,629,980)("Stefik '980")

Exhibit 1212 (U.S. Patent No. 5,915,019)("Ginter")

Exhibit 1213 (European Patent Application, Publication No. EP0809221A2)("Poggio")

Exhibit 1214 (PCT Application Publication No. WO 99/43136)("Rydbeck")

Exhibit 1215 (JP Publication No. H11-164058A (translation))("Sato")

Exhibit 1216 (Eberhard von Faber, Robert Hammelrath, and Franz-Peter Heider, "The Secure Distribution of Digital Contents," IEEE (1997))("von Faber")

Exhibit 1219 (U.S. Patent No. 4,878,245)("Bradley")

Exhibit 1221 (U.S. Patent No. 5,925,127)("Ahmad")

Patent Owner objects to Exhibits 1203, 1204, 1205, 1206, 1209, 1210, 1211, 1212, 1213, 1214, 1215, 1216, 1219, and 1221 ("the Non-asserted Reference Exhibits") on relevance grounds because the Petitioner did not assert these references as alleged invalidating prior art in its Petition in this case. Moreover, the PTAB's April 10, 2015 *Decision – Institution of Covered Business Method Patent Review 37 C.F.R. § 42.208* ("PTAB Decision") instituted covered business method review only on the ground that claim 18 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.

Exhibit 1217 (Declaration of Anthony J. Wechselberger In Support of Apple Inc.'s Petition for Covered Business Method Patent Review)

Patent Owner objects to Exhibit 1217, 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 27-59 (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 60-89 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.

In addition, the Patent Owner objects to Exhibit 1217 under 37 CFR § 42.65 in its entirety as it does not set forth the relative evidentiary weight (e.g., substantial evidence versus preponderance of the evidence) Mr. Wechselberger used in arriving at his conclusions.

The Wechselberger Declaration is further objected to in all instances where any paragraph relies upon an exhibit that specifically is objected to herein for the reasons set forth in those specific objections. Further, any paragraph in the Wechselberger Declaration that relies

upon any exhibit not relied upon by the PTAB to institute this proceeding is further objected to (under Fed. R. Evid. 401) as not being relevant and therefore being inadmissible (under Fed. R. Evid. 402).

Dated: April 24, 2015

/ Michael R. Casey /

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