

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

SMARTFLASH LLC,

Patent Owner.

Case CBM2015-00123
Patent 8,033,458 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, Paper 2, (“Petition”). Patent Owner’s objections are based on the Federal Rules of Evidence and the Board Rules and are set forth with particularity below.

Exhibits 1002 and 1037

Patent Owner objects to the admissibility of Exhibits 1002 and 1037 on grounds that they are cumulative evidence and irrelevant. The Petition cites to Exhibits 1002 for the sole purpose of showing Patent Owner’s characterization of the ‘458 Patent as “generally cover[ing] a portable data carrier for storing data and managing access to the data via payment information and/or use status rules” and “also generally cover[ing] a computer network ... that serves data and manages access to data by, for example, validating payment information.” Petition at 26 (citing Ex. 1002 ¶ 17). The Petition cites to Exhibit 1037 for the sole purpose of showing the inventor’s trial testimony describing the inventions. *Id.* (citing Ex. 1037 at 4). Petitioner’s expert, John P. J. Kelly, Exhibit 1020, (“Kelly Declaration”) does not cite to Exhibits 1002 or 1037. Petitioner does not need to cite to Exhibits 1002 and 1037 to characterize what the ‘458 Patent relates to when Exhibit 1001, the actual ‘458 Patent, is in evidence. Under FRE 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. Exhibits 1002 and 1037 are also objected to under FRE 403 as cumulative of Exhibit 1001.

Patent Owner’s characterization of the ‘458 Patent is not relevant to any of the issues here. Being irrelevant evidence, Exhibits 1002 and 1037 are not admissible per FRE 402.

Exhibit 1008

Patent Owner objects to the admissibility of Exhibit 1008 on grounds that it is hearsay under FRE 801 and thus inadmissible under FRE 802. Patent Owner also objects to the admissibility of Exhibit 1008 on grounds that its purported authentication does not meet the requisites of FRE 901.

Exhibit 1024

Neither the Petition, nor the Kelly Declaration (Ex. 1020), nor the PTAB’s November 10, 2015 *Decision – Institution of Covered Business Method Patent Review 37 C.F.R. § 42.208* (“PTAB Decision”) cite Exhibit 1024. As such, this exhibit does not appear to make a fact of consequence in determining this action more or less probable than it would be without the exhibit. As such, Exhibit 1024 does not pass the test for relevant evidence under FRE 401 and is thus not admissible per FRE 402.

Exhibits 1003, 1005, 1006, 1007, 1009, 1011, 1012, 1013, 1014, 1015, 1016, 1017, 1018, 1019, 1026, 1027, 1028, 1029, 1030, 1031, 1032, 1034, 1035, and 1036

Neither the Petition nor the Kelly Declaration cite Exhibits 1003, 1005, 1006, 1007, 1009, 1011, 1012, 1013, 1014, 1015, 1016, 1017, 1018, 1019, 1026, 1027, 1028, 1029, 1030, 1031, 1032, 1034, 1035, and 1036 as potentially invalidating prior art, either alone or in combination with any other reference. The PTAB Decision did not base any of its analysis on Exhibits 1003, 1005, 1006, 1007, 1009, 1011, 1012, 1013, 1014, 1015, 1016, 1017, 1018, 1019, 1026, 1027, 1028, 1029, 1030, 1031, 1032, 1034, 1035, and 1036. Thus, these exhibits do not appear to make *a fact of consequence in determining this action* more or less probable than it would be without these exhibits. As such, Exhibits 1003, 1005, 1006, 1007, 1009, 1011, 1012, 1013, 1014, 1015, 1016, 1017, 1018, 1019, 1026, 1027, 1028, 1029, 1030, 1031, 1032, 1034, 1035, and 1036 do not pass the test for relevant evidence under FRE 401 and are thus not admissible per FRE 402.

Exhibit 1020

Patent Owner objects to Exhibit 1020, the Kelly Declaration, in its entirety as the Kelly Declaration does not demonstrate that Mr. Kelly is an expert whose testimony is relevant to the issue of patent eligibility under 35 U.S.C. § 101 or patentability under 35 U.S.C. § 112 ¶ 2, the only issues on which this CBM was

instituted. Mr. Kelly has not shown that his opinions are proper expert opinions upon which the PTAB can rely as opposed to inadmissible lay opinions. FRE 701 and 702.

The Kelly Declaration is further objected to to the extent that any paragraph relies upon an exhibit that is objected to herein for the reasons set forth in those objections. Any paragraph in the Kelly Declaration that relies upon any exhibit not relied upon by the PTAB to institute this proceeding is further objected to as not being relevant and therefore being inadmissible under FRE 401 and 402.

Exhibit 1033

Exhibit 1033 is the April 8-9, 2015 Deposition Transcript of Jonathan Katz, Patent Owner's expert in CBM2014-00102/106/108/112. Patent Owner did not proffer Dr. Katz as an expert in this case. As such, Patent Owner objects to Exhibit 1033 under FRE 401 on relevance grounds and it is not admissible per FRE 402. Patent Owner further objects on grounds that it is hearsay under FRE 801 and thus inadmissible under FRE 802.

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