UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SMARTFLASH LLC,
Patent Owner

Case CBM2015-00124
Patent 7,942,317

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") Exhibit 2105, 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 served by Patent Owner on February 17, 2016.

The following objections apply to Exhibit 2105 as it is actually presented by Patent Owner, in the context of Patent Owner's February 17, 2016 Patent Owner's Response (Paper 17) 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 this Exhibit, 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 Exhibit 2105 And Any Reference to/Reliance Thereon

Evidence objected to: Exhibit 2105 ("Transcript of Deposition of Justin Douglas Tygar, Ph.D. dated January 19, 2016 taken in CBM2015-00126 and -00129").

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").

Petitioner objects to the use of Exhibit 2105 under F.R.E. 401, 402, and 403, and 37 C.F.R. § 42.61 as the cited testimony (*see, e.g.*, Paper 17 at 20-21, 43, 50) is not relevant to the issues in the present proceeding. Apple's expert in this proceeding is Dr. John Kelly. Exhibit 2105, however, appears to be a transcript

from the deposition of Dr. Justin D. Tygar, who is not an expert for Apple in this proceeding, and appears instead to have served as an expert for Google Inc.—who is not a party to this proceeding—in other CBM proceedings (*i.e.*, CBM2015-00126, -00129)—and is cited in connection with arguments about patent eligibility of system claims. *See Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347, 2360 (2014) ("[T]he system claims are no different from the method claims in substance . . . . This Court has long warned … against interpreting § 101 in ways that make patent eligibility depend simply on the draftsman's art.") (internal quotations omitted); Paper 17 at 20-21. Exhibit 2105 is further cited in connection with arguments about preemption and/or non-infringing alternatives, neither of which is the proper inquiry under the *Mayo* test for patent eligibility. *See Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015); *see also OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362-63 (Fed. Cir. 2015) ("[T]hat the claims do not preempt all price optimization or may be limited to price optimization in the e-commerce setting do not make them any less abstract."); *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715-16 (Fed. Cir. 2014) (rejecting claims as patent ineligible despite (vacated) prior opinion stating there were "myriad ways to accomplish th[e] abstract concept that do not infringe the[] claims," (722 F.3d 1335, 1353 (Fed. Cir. 2013) (vacated))); *Bancorp Servs., LLC v. Sun Life Assurance Co. of Can.*, 687 F.3d 1266, 1280 (Fed. Cir. 2012) ("Sun Life's

alternative assertion of noninfringement does not detract from its affirmative defense of invalidity under § 101."); *Apple Inc. v. Smartflash LLC,* CBM2015-00015, Pap. 28 at 2 ("[E]vidence of non-infringement and non-infringing alternatives … is not inconsistent with Apple's assertion ... that the challenged claims are unpatentable."); Paper 17 at 43, 50.

Additionally, admission of that evidence would be doubly improper because Apple is not a party to CBM2015-00126 and CBM2015-00129 and was not given the opportunity to attend the deposition of Dr. Justin D. Tygar. Moreover, for these reasons, Apple further reserves the right to raise additional objections not already stated on the record in that deposition, including objections to form and relevance in connection with the questions in the cited portions of the transcript.

Apple hereby expressly repeats and reserves all of the objections stated on the record in that deposition (Exhibit 2105) as well as the deposition of Dr. John Kelly (Exhibit 2108), and affirmatively maintains all such objections.

Accordingly, this Exhibit does 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 this document in any future submissions of Patent Owner would also be impermissible, misleading, irrelevant, and unfairly prejudicial to Petitioner (F.R.E. 402, 403).

Respectfully submitted, February 24, 2016

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