UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,

Petitioner,

v.

SMARTFLASH LLC,

Patent Owner.

Case CBM2015-00126
Patent 8,118,221 B2

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

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I. Statement of Precise Relief Requested

Pursuant to 37 C.F.R. §§ 42.62 and 42.64(c), Patent Owner Smartflash LLC moves to exclude Exhibits 1002, 1004, 1005, 1006, 1007, 1008, 1009, 1014, 1015 1022, 1023, and 1024.

II. Patent Owner Smartflash Timely Objected to Petitioner's Exhibits

Patent Owner Smartflash LLC timely objected to CBM2015-00126 Exhibits 1002, 1004, 1005, 1006, 1007, 1008, 1009, 1014, 1015 1022, 1023, and 1024 by filing Patent Owner's Objections to Admissibility of Evidence. Paper 10.

III. Argument

Pursuant to 37 C.F.R. § 42.64(c), the Federal Rules of Evidence apply in Covered Business Method Review ("CBM") proceedings.

A. Exhibit 1002 Lacks Foundation, is Unreliable, and Relies on Irrelevant Exhibits

Patent Owner moves to exclude Exhibit 1002, Declaration of Dr. Justin Douglas Tygar Regarding the '221 Patent ("Tygar Declaration"), in its entirety as the Tygar Declaration does not demonstrate that Dr. Tygar is an expert whose testimony is relevant to the issue of patent eligibility under 35 U.S.C. § 101, the only issue on which this CBM was instituted. Whether claims are directed to statutory subject matter is "an issue of law." Institution Decision, CBM2015-00129, Paper 8, page 18. When asked if he intended any of his opinions in this matter to be considered legal opinions, Dr. Tygar responded "absolutely not."

Exhibit 2105, Tygar Deposition at 7:4-7. Thus, Dr. Tygar's opinions on whether claims of the '221 Patent are directed to statutory subject matter, a question of law, are irrelevant, and his Declaration should be excluded.

Moreover, given that patent eligibility under § 101 is a purely legal issue, opinions such as those rendered by Dr. Tygar on the ultimate question of patent eligibility in ¶¶ 54-67 of his declaration constitute testimony on United States patent law or patent examination practice. Such testimony is inadmissible under 37 C.F.R. § 42.65 ("testimony on United States patent law or patent examination practice will not be admitted").

Further, Dr. Tygar has not shown that his opinions are proper expert opinions upon which the PTAB can rely. There is no assurance that Dr. Tygar's methodologies used to render his opinions in this case are reliable as required by FRE 702. In *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S.Ct. 2786, 509 U.S. 579 (1993), the Supreme Court set forth standards for the admissibility of expert testimony. The Supreme Court noted that:

> Faced with a proffer of expert scientific testimony … the trial judge must determine at the outset, pursuant to Rule 104(a), whether the expert is proposing to testify to (1) scientific knowledge that (2) will assist the trier of fact to understand or determine a fact in issue. ***This entails a preliminary assessment of whether the reasoning or methodology underlying the testimony is scientifically***

> ***valid and of whether that reasoning or methodology properly can be applied to the facts in issue.*** We are confident that federal judges possess the capacity to undertake this review. Many factors will bear on the inquiry, and we do not presume to set out a definitive checklist or test. But some general observations are appropriate. ***Ordinarily, a key question to be answered in determining whether a theory or technique is scientific knowledge that will assist the trier of fact will be whether it can be (and has been) tested***.

Daubert v. Merrell Dow Pharmaceuticals, Inc., 113 S.Ct. 2786, 2796, 509 U.S. 579, 592-93 (1993) (emphasis added).

Dr. Tygar did not employ any scientifically valid reasoning or methodology in reaching his opinions. In fact, when asked given what his methodology was, what his "false-positive rate would be for analyzing patents under 101," Dr. Tygar responded that "to measure false-positive, one has to have ground truth, and I am not aware of any generally accepted ground truth of -- [f]or these sorts of questions. Courts can differ in their opinion." Exhibit 2105, Tygar Deposition at 15:5-13. He further testified that "to define false-negative as to define false-positive, one needs ground truth, and I'm not aware of any generally accepted ground truth for 101 questions." *Id.* at 16:23-17:1. This is an admission that Dr. Tygar does not know, or cannot apply, the standards for evaluating patent

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