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

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

TABLE OF CONTENTS

Page

INTRODUCTION

Patent Owner's Motion To Exclude ("Motion", Paper 24) relies almost entirely on arguments that the Board has already rejected in the context of proceedings on the same patent and related patents. Patent Owner presents no persuasive reason for the Board to deviate from its prior rulings on these same issues. The Board may, in its discretion, assign the appropriate weight to the evidence presented. Patent Owner's Motion should be denied.

I. THE BOARD SHOULD NOT EXCLUDE EXHIBIT 1002

Patent Owner argues that Exhibit 1002, the declaration of Dr. Tygar, should be excluded because (i) statutory subject matter eligibility is a question of law (Mot. at 2); (ii) Patent Owner contends that Dr. Tygar applied an unreliable methodology (Mot. at 2-6); and (iii) Dr. Tygar did not recite an "evidentiary standard" in his declaration (Mot. at 6-8). None of these arguments justifies excluding Exhibit 1002.

A. The Board May Consider Expert Declarations On Subject Matter Eligibility

Patent Owner incorrectly contends that, because statutory subject matter eligibility is a question of law, expert testimony on this issue is irrelevant. (Mot. at 1-2.) The Board has already rejected Patent Owner's argument in related proceedings. *Apple Inc. v. Smartflash LLC*, CBM2015-00028, Paper 44 at 30-31.

Patent Owner presents no reason for the Board to rule differently here.

The question of subject matter eligibility may be informed by underlying facts. *See Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1340-41 (Fed. Cir. 2013) (patent eligibility determinations "may contain underlying factual issues"); *Versata Development Group, Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1334 (Fed. Cir. 2015) ("The PTAB specifically examined this issue and credited the testimony of SAP's expert over Versata's expert to determine that the additionally claimed steps of storing, retrieving, sorting, eliminating and receiving were 'well-known, routine, and conventional steps.'"). Patent Owner does not dispute that Dr. Tygar is a person of skill in the art who is qualified to testify on relevant underlying facts, including, for example, the state of the prior art and the knowledge of a person of skill in the art. (*See* Exhibit 1002 at ¶¶ 19-25, 60-65.) As the Board has already held, such testimony is relevant, and Patent Owner's Motion should be denied.

B. Dr. Tygar's Methodology Is Reliable

Dr. Tygar applied the methodology required under Section 101 law. *E.g.*, Ex. 1002 ¶¶ 54-55. Patent Owner asserts that an expert must identify a "false positive rate," analyze abstract concepts not advanced by either party, and read court decisions in order to offer opinions relevant to a Section 101 analysis. (Mot. at 3-5.) Patent Owner cites no authority that supports these contentions, and the

Board rejected similar arguments advanced by Patent Owner in related proceedings. *See Apple Inc. v. Smartflash LLC*, CBM2015-00028, Paper No. 44 at 29 (Patent Owner's argument that the expert's methodology was flawed went to the Board's "discretion to determine the appropriate weight to be accorded" to the expert testimony). Patent Owner's arguments at best go to the weight the Board should give to Dr. Tygar's testimony.

Dr. Tygar is not a lawyer and did not provide a legal opinion. Rather, he provided a factual opinion based on his analysis of the '221 patent, informed by his technical expertise and over 34 years of experience in the field (*see, e.g.*, Ex. 1002 ¶¶ 7-13). Dr. Tygar's testimony is entitled to weight, especially in comparison to Patent Owner's bare attorney argument. *See, e.g.*, *Versata*, 793 F.3d at 1334 (affirming Board's reliance on expert testimony that computer-based limitations were well-known); *Corning Inc. v. DSM IP Assets B.V.*, IPR2013-00048, Paper No. 15 at 22 ("[I]n the face of [petitioner's] expert testimony. . . we are not persuaded by this conclusory attorney argument."). The same reasoning applies here.

C. Dr. Tygar's Declaration Is Not Required To Recite An Evidentiary Standard

Patent Owner argues that Dr. Tygar's declaration should be excluded because Dr. Tygar did not recite an evidentiary standard. (Mot. at 7.) The Board

DOCKET ALARM

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts

Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research

With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips

Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS
Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS
Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS
Sync your system to PACER to automate legal marketing.