

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 REPLY IN SUPPORT OF
MOTION TO EXCLUDE EVIDENCE**

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I. INTRODUCTION

Patent Owner understands that “the Board, sitting as a non-jury tribunal with administrative expertise, is well-positioned to determine and assign appropriate weight to the evidence presented in this trial, without resorting to formal exclusion that might later be held reversible error.” *Liberty Mutual Insurance Co. v. Progressive Casualty Insurance Co.*, CBM2012-00002, Paper 66, Final Written Decision (PTAB January 23, 2014)(citing *S.E.C. v. Guenthner*, 395 F. Supp. 2d 835, 842 n.3 (D. Neb. 2005)). At the same time, the Federal Rules of Evidence apply (37 CFR § 42.62(a)) and it is within the Board’s authority to manage the record by ruling on the admissibility of evidence based on the trial as instituted so that in the event of an appeal under 35 U.S.C. § 142, a proper record exists that can be transmitted to the United States Court of Appeals for the Federal Circuit pursuant to 35 U.S.C. § 143.

II. ARGUMENT

A. The Board Should Exclude Exhibit 1002

The Board cannot assess under FRE 702 whether Dr. Tygar’s opinion testimony is “based on sufficient facts or data,” is “the product of reliable principles and methods,” or if Dr. Tygar “reliably applied the principles and methods to the facts of the case,” or assess under *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 113 S.Ct. 2786, 509 U.S. 579 (1993) whether the reasoning or methodology underlying Dr. Tygar’s testimony is scientifically valid and

whether that reasoning or methodology properly can be applied to the facts in issue given that Dr. Tygar i) disavowed being qualified to give a legal opinion; ii) could not explain why his approach in formulating his opinions used a scientifically valid reasoning or methodology; iii) did nothing to test his result; iv) did not consider any other possible abstract ideas and v) acknowledged on cross examination a potentially different “starting point for an abstract idea” and that “it’s possible that if I started at another place, I may or may not have reached a conclusion;” and vi) does not disclose the underlying facts on which his opinions are based.

B. The Board Should Exclude Exhibits 1004 - 1009, 1014, 1022, and 1023

Exhibits 1004 - 1009, 1014, 1022, and 1023 were not alleged to be invalidating prior art and should be excluded. Petitioner asserts that the exhibits are “offered to show the state of the art.” Paper 25 at 5. But when determining whether there is an “inventive concept” the relevant analysis is whether there is an “inventive concept” over the *abstract idea* (if one is found) and not whether there is an “inventive concept” over the *prior art*. *Alice Corp. Pty. Ltd. v. CLS Bank Intern.*, 134 S.Ct. 2347, 2355 (2014) (*Mayo* step-two analysis is “a search for an ‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to *significantly more than a patent upon the [abstract idea] itself*’”(emphasis added). Focusing the § 101 analysis on the prior art to show purported well-known, routine, and conventional claim

elements is precisely what the Federal Circuit criticized the district court for in *Bascom Global Internet Services, Inc. v. AT&T Mobility LLC*, Case no. 2015-1763 (Fed. Cir. June 27, 2016), Slip op. at 15 (“The district court’s analysis in this case . . . looks similar to an obviousness analysis under 35 U.S.C. § 103 . . . The inventive concept inquiry *requires more than recognizing that each claim element, by itself, was known in the art.* As is the case here, an inventive concept can be found in the non-conventional and non-generic arrangement of known, conventional pieces.”)(emphasis added). The exhibits are not relevant to a § 101 analysis and should be excluded under FRE 401 and 402.

C. The Board Should Exclude Exhibit 1015

Exhibit 1015 is not relevant. The Board’s reasoning in other cases that a PO’s characterization of the patent, or the PO’s credibility in doing so, is relevant to the analysis of whether a patent qualifies CBM review under the AIA is contrary to *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1340 (Fed. Cir. March 1, 2016)(“[AIA] directs us to examine *the claims* when deciding whether a patent is a CBM patent”) and therefore irrelevant under FRE 401, 402. Petitioner argues that “*Blue Calypso* did not . . . concern the admissibility or relevance of a patentee’s characterization of its patent claims and did not hold that the patentee’s characterization of the patent claims is irrelevant.” Paper 25 at 10. Petitioner misses the point. The *Blue Calypso* Court did not need to recite all the things that

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