

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 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 3 (“Petition”). Patent Owner’s objections are based on the Federal Rules of Evidence and the Board Rules and are set forth with particularity below.

Exhibit 1002

Patent Owner objects to Exhibit 1002, the Declaration of Dr. Justin Douglas Tygar (“Tygar Declaration”), in its entirety as the Tygar Declaration does not state the relative evidentiary weight (e.g., substantial evidence versus preponderance of the evidence) that Dr. Tygar used in arriving at his conclusions. The Board cannot assess under FRE 702 whether Dr. Tygar’s opinion testimony is “the product of reliable principles and methods” or if Dr. Tygar “reliably applied the principles and methods to the facts of the case” given that Dr. Tygar did not disclose the standard against which he measured the evidence in arriving at his opinions.

Additionally, 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. Institution Decision, Paper 8 at 19. Dr. Tygar 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 Tygar Declaration does not demonstrate that the methods used by Dr. Tygar in formulating his opinions are reliable and repeatable as required by *Daubert v. Merrell Dow Pharmaceuticals, Inc.*, 509 US 579 (1993) and/or FRE 702. The Tygar Declaration does not show how Dr. Tygar's methods used in formulating his opinion on § 101 patent eligibility are reliable and repeatable, given that Dr. Tygar does not provide any analysis of any subject matter deemed to be § 101 eligible under his methodology. As such, the Tygar Declaration is inadmissible.

The Tygar 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 Tygar 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.

Exhibits 1004, 1005, 1006, 1007, 1008, 1009, 1014, 1022, 1023, and 1024

Neither the Petition nor the Tygar Declaration cites Exhibits 1004, 1005, 1006, 1007, 1008, 1009, 1014, 1022, 1023, or 1024 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 1004, 1005, 1006, 1007, 1008, 1009, 1014, 1022, 1023, or 1024. 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 1004, 1005, 1006, 1007, 1008, 1009, 1014, 1022, 1023, and 1024 do not pass the test for relevant evidence under FRE 401 and are thus not admissible per FRE 402.

Exhibits 1022, 1023, and 1024 are further objected to on relevancy grounds because their subject matter (land leases, libraries, and toll roads, respectively) are not relevant to the technological solution to internet piracy set forth in the ‘221 Patent. Failing the test for relevant evidence under FRE 401, these Exhibits are not admissible per FRE 402.

Exhibit 1015

Patent Owner objects to the admissibility of Exhibit 1015 on grounds that it is cumulative evidence and irrelevant. The Petition cites to Exhibits 1015 for the sole purpose of showing Patent Owner’s characterization of the ‘221 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.” Petition at 7 (citing Ex. 1015 ¶ 1). Petitioner’s expert, Dr. Tygar (Ex. 1002) does not cite to Exhibit 1015. Petitioner does not need to cite to Exhibit 1015 to characterize what the ‘221 Patent relates to when Exhibit 1001, the actual ‘221 Patent, is in evidence. Under FRE 1004, other evidence of the content of a writing (here the ‘221 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 '221 Patent is in evidence and is the subject of the trial. Exhibit 1015 is also objected to under FRE 403 as cumulative of Exhibit 1001.

Patent Owner's characterization of the '221 Patent is not relevant to any of the issues here. Being irrelevant evidence, Exhibit 1015 is not admissible per FRE 402.

Dated: December 1, 2015

/ Michael R. Casey /

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