

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

SMARTFLASH LLC,

Patent Owner.

Case CBM2015-00133
Patent 8,336,772 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 2, (“Petition”). Patent Owner’s objections are based on the Federal Rules of Evidence and the Board Rules and are set forth with particularity below.

Exhibits 1002 and 1043

Patent Owner objects to the admissibility of Exhibits 1002 and 1043 on grounds that they are cumulative evidence and irrelevant. The Petition cites to Exhibits 1002 for the sole purpose of showing Patent Owner’s characterization of the ‘772 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” and “also generally cover[ing] a computer network ... that serves data and manages access to data by, for example, validating payment information.” Petition at 26 (citing Ex. 1002 ¶ 17). The Petition cites to Exhibit 1043 for the sole purpose of showing the inventor’s trial testimony describing the inventions. *Id.* (citing Ex. 1043 at 4). Petitioner’s expert, John P. J. Kelly, Exhibit 1019, (“Kelly Declaration”) does not cite to Exhibits 1002 or 1043. Petitioner does not need to cite to Exhibits 1002 and 1043 to characterize what the ‘772 Patent relates to when Exhibit 1001, the actual ‘772 Patent, is in evidence. Under FRE 1004, other evidence of the content of a writing (here the ‘772 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 ‘772 Patent is in evidence and is the subject of the trial. Exhibits 1002 and 1043 are also objected to under FRE 403 as cumulative of Exhibit 1001.

Patent Owner’s characterization of the ‘772 Patent is not relevant to any of the issues here. Being irrelevant evidence, Exhibits 1002 and 1043 are not admissible per FRE 402.

Exhibits 1024, 1029, 1030, 1033, and 1035

Neither the Petition, nor the Kelly Declaration (Ex. 1019), nor the PTAB’s November 16, 2015 *Decision – Institution of Covered Business Method Patent Review 37 C.F.R. § 42.208*, Paper 7 (“PTAB Decision”) cites Exhibits 1024, 1029, 1030, 1033, or 1035. As such, these exhibits do not appear to make a fact of consequence in determining this action more or less probable than it would be without them. As such, Exhibits 1024, 1029, 1030, 1033, and 1035 do not pass the test for relevant evidence under FRE 401 and are thus not admissible per FRE 402.

Exhibits 1003, 1004, 1005, 1006, 1007, 1008, 1011, 1012, 1013, 1014, 1015, 1016, 1017, 1018, 1025, 1026, 1027, 1028, 1036, 1038, 1040, 1041, 1042, 1044, and 1045

Neither the Petition nor the Kelly Declaration cites Exhibits 1003, 1004, 1005, 1006, 1007, 1008, 1011, 1012, 1013, 1014, 1015, 1016, 1017, 1018, 1025, 1026, 1027, 1028, 1036, 1038, 1040, 1041, 1042, 1044, or 1045 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 1003, 1004, 1005, 1006, 1007, 1008, 1011, 1012, 1013, 1014, 1015, 1016, 1017, 1018, 1025, 1026, 1027, 1028, 1036, 1038, 1040, 1041, 1042, 1044, or 1045. 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 1003, 1004, 1005, 1006, 1007, 1008, 1011, 1012, 1013, 1014, 1015, 1016, 1017, 1018, 1025, 1026, 1027, 1028, 1036, 1038, 1040, 1041, 1042, 1044, and 1045 do not pass the test for relevant evidence under FRE 401 and are thus not admissible per FRE 402.

Exhibit 1019

Patent Owner objects to Exhibit 1019, the Kelly Declaration, in its entirety as the Kelly Declaration does not demonstrate that Dr. Kelly 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. Dr. Kelly 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 Kelly Declaration does not demonstrate that the methods used by Dr. Kelly 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 Kelly Declaration does not show how Dr. Kelly's methods used in formulating his opinion on § 101 patent eligibility are reliable and repeatable, given that Dr. Kelly does not provide any analysis of any subject matter deemed to be § 101 eligible under his methodology. As such, the Kelly Declaration is inadmissible.

The Kelly 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 Kelly 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.

Exhibit 1037

Patent Owner objects to the admissibility of Exhibit 1037 on grounds that it is hearsay under FRE 801 and thus inadmissible under FRE 802. Patent Owner

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.