

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2015-00123
Patent 8,033,458 B2

Before JENNIFER S. BISK, RAMA G. ELLURU,
JEREMY M. PLENZLER, and MATTHEW R. CLEMENTS,
Administrative Patent Judges.

PLENZLER, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

INTRODUCTION

A. Background

Apple Inc. (“Petitioner”), filed a Petition to institute covered business method patent review of claims 2–5, 7, 9, and 12 of U.S. Patent No. 8,033,458 B2 (Ex. 1001, “the ’458 patent”) pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”). Paper 2 (“Pet.”).¹ Smartflash LLC (“Patent Owner”) filed a Preliminary Response. Paper 5 (“Prelim. Resp.”). On November 10, 2015, we instituted a covered business method patent review (Paper 7, “Institution Decision” or “Inst. Dec.”) based upon Petitioner’s assertion that claims 2–5, 7, 9, and 12 (“the challenged claims”) are directed to patent ineligible subject matter under 35 U.S.C. § 101 and that claims 3–5 are indefinite under 35 U.S.C. § 112, second paragraph. Inst. Dec. 23.

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 17, “PO Resp.”) and Petitioner filed a Reply (Paper 21, “Pet. Reply”) to Patent Owner’s Response.

Patent Owner, with authorization, filed a Notice of Supplemental Authority. Paper 28 (“Notice”). Petitioner filed a Response to Patent Owner’s Notice. Paper 29 (“Notice Resp.”).

We held a joint hearing of this case and several other related cases on July 18, 2016. Paper 30 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(c). This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has shown by a preponderance of the evidence that claims 2–5, 7, 9, and 12 of the ’458

¹ Pub. L. No. 112–29, 125 Stat. 284, 296–07 (2011).

patent are directed to patent ineligible subject matter under 35 U.S.C. § 101 and that claims 3–5 of the '458 patent are indefinite under 35 U.S.C. § 112, second paragraph.

B. Related Matters

The parties indicate that the '458 patent is the subject of the following district court cases: *Smartflash LLC v. Apple Inc.*, Case No. 6:13-cv-447 (E.D. Tex.); and *Smartflash LLC et al. v. Apple Inc.*, Case No. 6:15-cv-00145 (E.D. Tex.). Pet. 34; Paper 4, 4–5. The parties also indicate that the '458 patent is the subject of a number of other district court cases, to which Petitioner is not a party. Pet. 34; Paper 4, 4.

We have issued three previous Final Written Decisions in reviews challenging the '458 patent. In CBM2014-00106, we found claim 1 unpatentable under 35 U.S.C. § 103. *Apple Inc. v. Smartflash LLC*, Case CBM2014-00106, (PTAB Sept. 25, 2015) (Paper 52). In CBM2015-00016, we found claims 6, 8, and 10 unpatentable under 35 U.S.C. § 101 and claim 11 unpatentable under 35 U.S.C. § 112, second paragraph.² *Apple Inc. v. Smartflash LLC*, Case CBM2015-00016, (PTAB March 29, 2016) (Paper 56). In CBM2014-00192, we found claim 11 unpatentable under 35 U.S.C. § 101. *Samsung Electronics America, Inc., Samsung Electronics Co., Ltd., Samsung Telecommunications America, LLC, and Apple Inc. v. Smartflash LLC*, CBM2014-00192, (March 30, 2016) (Paper 45).

² Trial was terminated with respect to the ground challenging claim 1 under 35 U.S.C. § 101 in view of our decision in CBM2014-00106 finding that claim unpatentable under 35 U.S.C. § 103.

C. The '458 Patent

The '458 patent relates to “a portable data carrier for storing and paying for data and to computer systems for providing access to data to be stored,” and the “corresponding methods and computer programs.” Ex. 1001, 1:21–25. Owners of proprietary data, especially audio recordings, have an urgent need to address the prevalence of “data pirates” who make proprietary data available over the internet without authorization. *Id.* at 1:29–55. The '458 patent describes providing portable data storage together with a means for conditioning access to that data upon validated payment. *Id.* at 1:59–2:11. This combination allows data owners to make their data available over the internet without fear of data pirates. *Id.* at 2:11–15.

As described, the portable data storage device is connected to a terminal for internet access. *Id.* at 1:59–67. The terminal reads payment information, validates that information, and downloads data into the portable storage device from a data supplier. *Id.* The data on the portable storage device can be retrieved and output from a mobile device. *Id.* at 2:1–5.

The '458 patent makes clear that the actual implementation of these components is not critical and they may be implemented in many ways. *See, e.g., id.* at 25:49–52 (“The skilled person will understand that many variants to the system are possible and the invention is not limited to the described embodiments.”).

D. Challenged Claims

The claims under review are claims 2–5, 7, 9, and 12 of the '458 patent. Inst. Dec. 23. Of the challenged claims, claims 3, 4, and 5 are independent. Claim 2 depends from independent claim 1 (held unpatentable under § 103 in CBM2014-00106). Claims 7, 9, and 12 depend from

independent claim 6 (held unpatentable under § 101 in CBM2015-00016).

Independent claims 3, 4, and 5 are illustrative and recite the following:

3. A portable data carrier, comprising:
 - an interface for reading and writing data from and to the carrier;
 - non-volatile data memory, coupled to the interface, for storing data on the carrier;
 - non-volatile payment data memory, coupled to the interface, for providing payment data to an external device;
 - a program store storing code implementable by a processor;
 - a processor, coupled to the content data memory, the payment data memory, the interface and to the program store for implementing code in the program store;
 - non-volatile use record memory, coupled to the processor, for storing a record of access made to the data memory and code to update the use record memory in response to external access made to the data memory; and
 - non-volatile use rule memory, coupled to the processor, for storing data use rules, and wherein the code comprises code for storing at least one data item in the data memory and at least one corresponding use rule in the use rule memory and code to provide external access to the data item in accordance with the use rule, wherein the code further comprises code to output payment data from the payment data memory to the interface and code to provide external access to the data memory.

Ex. 1001, 26:10–35.

4. A portable data carrier, comprising:
 - an interface for reading and writing data from and to the carrier;
 - non-volatile data memory, coupled to the interface, for storing data on the carrier;
 - non-volatile payment data memory, coupled to the interface, for providing payment data to an external device;

a program store storing code implementable by a processor; and

a processor, coupled to the content data memory, the payment data memory, the interface and to the program store for implementing code in the program store;

wherein the portable data carrier is configured for storing supplementary data in said data memory, and further comprising code to output the supplementary data from the interface in addition to the stored data, in response to an external request to read the data memory, and

wherein the code comprises code to output payment data from the payment data memory to the interface and code to provide external access to the data memory.

Id. at 26:36–55.

5. A portable data carrier, comprising:

an interface for reading and writing data from and to the carrier;

non-volatile data memory, coupled to the interface, for storing data on the carrier;

non-volatile payment data memory, coupled to the interface, for providing payment data to an external device;

a program store storing code implementable by a processor;

a processor, coupled to the content data memory, the payment data memory, the interface and to the program store for implementing code in the program store; and

synthesis code to receive a first portion of data from the interface and to combine the first portion with a second portion of data stored in the data memory and to store the result in the data memory

wherein the code comprises code to output payment data from the payment data memory to the interface and code to provide external access to the data memory.

Id. at 26:56–27:7.

ANALYSIS

A. Claim Construction

In a covered business method patent review, claim terms are given their broadest reasonable interpretation in light of the specification in which they appear and the understanding of others skilled in the relevant art. *See* 37 C.F.R. § 42.300(b). Applying that standard, we interpret the claim terms of the '458 patent according to their ordinary and customary meaning in the context of the patent's written description. *See In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007). For purposes of this Decision, we need not construe expressly any claim term.

B. Statutory Subject Matter

Petitioner challenges claims 2–5, 7, 9, and 12 as directed to patent-ineligible subject matter under 35 U.S.C. § 101. Pet. 41–71. Petitioner asserts that the challenged claims are directed to an abstract idea without additional elements that transform it into a patent-eligible application of that idea (*id.* at 42–67), triggers preemption concerns (*id.* at 67–70), and fails the machine-or-transformation test (*id.* at 70–71). Petitioner provides a declaration from John P.J. Kelly, Ph.D. to support its challenges.³ Ex. 1020 (“the Kelly Declaration”). Patent Owner argues that the challenged claims are statutory because they are “rooted in computer technology in order to

³ In its Response, Patent Owner argues that this declaration should be given little or no weight. PO Resp. 5–16. Because Patent Owner has filed a Motion to Exclude (Paper 24) that includes a request to exclude Dr. Kelly's Declaration in its entirety, or in the alternative, portions of the declaration based on essentially the same argument, we address Patent Owner's argument as part of our analysis of the motion to exclude, below.

overcome a problem specifically arising in the realm of computer networks,” that of “data content piracy.” PO Resp. 1–2.

1. Abstract Idea

Under 35 U.S.C. § 101, we must first identify whether an invention fits within one of the four statutorily provided categories of patent-eligibility: “processes, machines, manufactures, and compositions of matter.” *Ulramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 713–714 (Fed. Cir. 2014). Here, each of the challenged claims recites a “machine,” i.e., a “portable data carrier” (claims 2–5) or a “data access device” (claims 7, 9, and 12), under § 101. Section 101, however, “contains an important implicit exception to subject matter eligibility: Laws of nature, natural phenomena, and abstract ideas are not patentable.” *Alice Corp. Pty. Ltd. v. CLS Bank Int’l.*, 134 S. Ct. 2347, 2354 (2014) (citing *Assoc. for Molecular Pathology v. Myriad Genetics, Inc.*, 133 S. Ct. 2107, 2116 (2013) (internal quotation marks and brackets omitted)). In *Alice*, the Supreme Court reiterated the framework set forth previously in *Mayo Collaborative Services v. Prometheus Laboratories*, 132 S. Ct. 1289, 1293 (2012) “for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of these concepts.” *Alice*, 134 S. Ct. at 2355. The first step in the analysis is to “determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.*

According to the Federal Circuit, “determining whether the section 101 exception for abstract ideas applies involves distinguishing between patents that *claim the building blocks of human ingenuity*—and therefore risk broad pre-emption of basic ideas—and patents that integrate those building blocks into something more, enough to transform them into specific

patent-eligible inventions.” *Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1332 (Fed. Cir. 2015) (emphasis added); *accord id.* at 1333–34 (“It is a *building block*, a *basic conceptual framework* for organizing information” (emphasis added)). This is similar to the Supreme Court’s formulation in *Bilski v. Kappos*, 561 U.S. 593, 611 (2010) (emphasis added), noting that the concept of risk hedging is “a *fundamental economic practice* long prevalent in our system of commerce.” *See also buySAFE, Inc. v. Google, Inc.*, 765 F.3d 1350, 1353–54 (Fed. Cir. 2014) (stating that patent claims related to “long-familiar commercial transactions” and relationships (i.e., business methods), no matter how “narrow” or “particular,” are directed to abstract ideas as a matter of law). As a further example, the “concept of ‘offer based pricing’ is similar to other ‘fundamental economic concepts’ found to be abstract ideas by the Supreme Court and [the Federal Circuit].” *OIP Techs., Inc. v. Amazon.com, Inc.*, 788 F.3d 1359, 1362 (Fed. Cir. 2015) (citations omitted).

Petitioner argues that the challenged claims are directed to the abstract idea of “payment for and/or controlling access to data based on payment or rules.” Pet. 42. We are persuaded that the challenged claims are drawn to a patent-ineligible abstract idea. Specifically, the challenged claims are directed to performing the fundamental economic practice of paying for and/or conditioning and controlling access to content. For example, claim 3 recites “code for storing at least one data item in the data memory and at least one corresponding use rule in the use rule memory and code to provide external access to the data item in accordance with the use rule.” Claim 4 recites “code to output the supplementary data from the interface in addition to the stored data, in response to an external request to read the data

memory” and “code to output payment data from the payment data memory to the interface and code to provide external access to the data memory.”

Claim 5 recites “code to output payment data from the payment data memory to the interface and code to provide external access to the data memory.”

As discussed above, the ’458 patent discusses addressing recording industry concerns of data pirates offering unauthorized access to widely available compressed audio recordings. Ex. 1001, 1:20–55. The ’458 patent proposes to solve this problem by restricting access to data on a device based upon satisfaction of use rules linked to payment data. *Id.* at 9:7–25. The ’458 patent makes clear that the heart of the claimed subject matter is restricting access to stored data based on supplier-defined access rules and payment data. *Id.* at Abstract, 1:59–2:15.

Although the Specification refers to data piracy on the Internet, the challenged claims are not limited to the Internet. The underlying concept of the challenged claims, particularly when viewed in light of the Specification, is paying for and/or controlling access to content, based on, for example, payment or rules, as Petitioner contends. As discussed further below, this is a fundamental economic practice long in existence in commerce. *See Bilski*, 561 U.S. at 611.

Patent Owner argues that claims 2–5, 7, 9, and 12 are “directed to machines,” not abstract ideas. PO Resp. 19–27. Patent Owner, however, cites no controlling authority to support the proposition that subject matter is patent-eligible as long as it is directed to “machines with specialized physical components.” PO Resp. 27. As Petitioner correctly points out (Pet. Reply 3), that argument is contradicted by well-established precedent:

There is no dispute that a computer is a tangible system (in § 101 terms, a “machine”), or that many computer-implemented claims are formally addressed to patent-eligible subject matter. But if that were the end of the § 101 inquiry, an applicant could claim any principle of the physical or social sciences by reciting a computer system configured to implement the relevant concept. Such a result would make the determination of patent eligibility “depend simply on the draftman’s art,” ... thereby eviscerating the rule that “... abstract ideas are not patentable.”

Alice Corp. Pty. Ltd. v. CLS Bank Int’l, 134 S. Ct. 2347, 2358–59 (2014) (internal citations omitted).

Patent Owner also argues that the challenged claims are like those found not to be directed to an abstract idea in *Google Inc. v. Network-1 Technologies, Inc.*, CBM2015-00113, and in *Hulu, LLC v. iMTX Strategic, LLC*, CBM2015-00147. PO Resp. 23–27. These decisions are non-precedential and distinguishable. In CBM2015-00113, the panel’s determination turned on a step requiring “correlating, by the computer system using a non-exhaustive, near neighbor search, the first electronic media work with [an or the first] electronic media work identifier” and on the Petitioner’s formulation of the alleged abstract idea. *Google Inc. v. Network-1 Technologies, Inc.*, CBM2015-00113, Paper 7 (Oct. 19, 2015), 13. Patent Owner argues that the challenged claims are like those at issue in CBM2015-00113 because they “require[] storage or use of data correlated with some other data (payment data, use status data, and/or use rules data).” PO Resp. 24. As the panel in CBM2015-00113 explained, however, the claims at issue there required “particular types of searching processes”—i.e., “a non-exhaustive, near neighbor search”—that are different than the abstract idea alleged by Petitioner. CBM2015-00113, Paper 7 at 12–13. In this case, none of the challenged claims recite a *specific* search process by

which use rules would be correlated with content data items. For example, claim 1 (from which challenged claims 2–5 depend), recites “code for storing at least one data time in the data memory and at least one corresponding use rule in the use rule memory and code to provide external access to the data item in accordance with the user rule.” With respect to CBM2015-00147, Patent Owner mischaracterizes the Institution Decision. PO Resp. 24–25. The panel’s determination in that case was based on step two, not step one, of the *Mayo/Alice* test. *Hulu, LLC v. iMTX Strategic, LLC*, CBM2015-00147, Paper 14 (Nov. 30, 2015), 14 (“As in *DDR*, we are persuaded that, however the abstract idea is characterized, the ’854 patent claims do not meet the second prong of the *Mayo/Alice* test.”).

Patent Owner’s Notice of Supplemental Authority also does not alter our determination. Patent Owner argues that the challenged claims are “directed to an improvement to computer functionality.” Notice 1 (quoting *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1336 (Fed. Cir. 2016)). The challenged claims, according to Patent Owner, are “directed to specific organization of data and defined sequences of transaction steps with distinct advantages over alternatives” (*id.* at 2) and, therefore, “like those in *Enfish*, ‘are directed to a *specific implementation of a solution* to a problem’ in Internet digital commerce” (*id.* at 3). Unlike the self-referential table at issue in *Enfish*, however, the challenged claims do not purport to be an improvement to the way computers operate. Instead, they “merely implement an old practice in a new environment.” *FairWarning IP, LLC v. Iatric Systems, Inc.*, No. 2015-1985, slip op. 7 (Fed. Cir. Oct. 11, 2016). Petitioner argues, and we agree, that the challenged claims, like those in *In re TLI Communications LLC Patent Litigation*, 823 F.3d 607 (Fed. Cir.

2016), “perform[] generic computer functions such as storing, receiving, and extracting data” using “physical components” that “behave exactly as expected according to their ordinary use” and “merely provide a generic environment in which to carry out the abstract idea” of controlling access to content based on payment and/or rules. Notice Resp. 2–3 (quoting *In re TLI Communications LLC Patent Litigation*, 823 F.3d at 612–15). The limitations of the challenged claims—e.g., “code to provide external access,” “code to output payment data,” “code to update,” “code for storing,” “code to write,” “code to select,” “code to receive,” “code to retrieve and output”—are so general that they

do no more than describe a desired function or outcome, without providing any limiting detail that confines the claim to a particular solution to an identified problem. The purely functional nature of the claim confirms that it is directed to an abstract idea, not to a concrete embodiment of that idea.

Affinity Labs of Texas, LLC v. Amazon.com Inc., No. 2015-2080, slip op. 7 (Fed. Cir. Sept. 23, 2016) (citation omitted).

We are, thus, persuaded, based on the Specification and the language of the challenged claims, that claims 2–5, 7, 9, and 12 of the ’458 patent are directed to an abstract idea. *See Alice*, 134 S. Ct. at 2356 (holding that the concept of intermediated settlement at issue in *Alice* was an abstract idea); *Accenture Global Servs., GmbH v. Guidewire Software, Inc.*, 728 F.3d 1336, 1344 (Fed. Cir. 2013) (holding the abstract idea at the heart of a system claim to be “generating tasks [based on] rules . . . to be completed upon the occurrence of an event”).

2. *Inventive Concept*

“A claim that recites an abstract idea must include ‘additional features’ to ensure ‘that the [claim] is more than a drafting effort designed to monopolize the [abstract idea].’” *Alice*, 134 S. Ct. at 2357 (quoting *Mayo*, 132 S. Ct. at 1297). “This requires more than simply stating an abstract idea while adding the words ‘apply it’ or ‘apply it with a computer.’ Similarly, the prohibition on patenting an ineligible concept cannot be circumvented by limiting the use of an ineligible concept to a particular technological environment.” *Versata*, 793 F.3d at 1332 (citations omitted). Moreover, the mere recitation of generic computer components performing conventional functions is not enough. *See Alice*, 134 S. Ct. at 2360 (“Nearly every computer will include a ‘communications controller’ and ‘data storage unit’ capable of performing the basic calculation, storage, and transmission functions required by the method claims.”).

Petitioner argues that “the [challenged c]laims’ ‘additional features’ recite only well-known, routine, and conventional computer components and activities, which is insufficient to establish an inventive concept.” Pet. Reply 6. We are persuaded that claims 2–5, 7, 9, and 12 of the ’458 patent do not add an inventive concept sufficient to ensure that the patent in practice amounts to significantly more than a patent on the abstract idea itself. *Alice*, 134 S. Ct. at 2355; *see also Accenture Global Servs.*, 728 F.3d at 1344 (holding claims directed to the abstract idea of “generating tasks [based on] rules . . . to be completed upon the occurrence of an event” to be unpatentable even when applied in a computer environment and within the insurance industry). Specifically, we agree with and adopt the rationale articulated in the Petition that the additional elements of the challenged

claims are either field of use limitations and/or generic features of a computer that do not bring the challenged claims within § 101 patent eligibility. Pet. 50–67.

a. Technical Elements

Petitioner argues that the challenged claims are unpatentable because they “are directed only to an abstract idea with nothing more than ‘well-understood, routine, conventional activity’ added.” Pet. 50 (citations omitted). Patent Owner disagrees, arguing that the challenged claims are patentable because they recite “specific ways of using distinct memories, data types, and use rules that amount to significantly more than the underlying abstract idea.” PO Resp. 49–50 (quoting Ex. 2049, 19). We agree with Petitioner for the following reasons.

The ’458 patent treats as well-known all potentially technical aspects of the challenged claims, which simply require generic computer components (e.g., interfaces, memory, program store, and processor). *See* Pet. Reply 5–6 (citing Ex. 1001, 4:4–13, 11:28–29, 12:29–32, 16:46–50, 18:7–17). With respect to the “portable data carrier” recited in claims 2–5, for example, the Specification states it may be a generic device such as “a standard smart card.” Ex. 1001, 11:27–29; *see also id.* at 14:25–29 (“[I]ikewise data stores 136, 138 and 140 may comprise a single physical data store or may be distributed over a plurality of physical devices and may even be at physically remote locations from processors 128-134 and coupled to these processors via internet 142”), Fig. 6. As for the “SIM portion” recited in claim 2, the ’458 patent explains that “mobile phone SIM (Subscriber Identity Module) card[s] ... already include a user identification

means, to allow user billing through the phone network operator.” *Id.* at 4:10–13.

Further, the claimed computer code performs generic computer functions, such as outputting data, providing access to memory and data, updating memory, storing data, receiving and evaluating data, accessing data, and selecting data. *See* Pet. 53–56. The recitation of these generic computer functions is insufficient to confer specificity. *See Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343, 1347 (Fed. Cir. 2014) (“The concept of data collection, recognition, and storage is undisputedly well-known. Indeed, humans have always performed these functions.”).

Moreover, we are not persuaded that claims 2–5, 7, 9, and 12 “recite specific ways of using distinct memories, data types, and use rules that amount to significantly more than” paying for and/or controlling access to content. *See* PO Resp. 49 (quoting Ex. 2049, 1–4). The challenged claims generically recite several memories, including “data memory,” “payment data memory,” “a program store,” “use record memory,” “use rule memory,” and “content data memory,” and generically recite several data types, including “data,” “payment data,” “use status data,” “use rules data,” and “code.” We are not persuaded that the recitation of these memories and data types, by itself, amounts to significantly more than the underlying abstract idea. Patent Owner does not point to any inventive concept in the ’458 patent related to the way these memories or data types are constructed or used. In fact, the ’458 patent simply discloses these memories and data types with no description of the underlying implementation or programming. *See Content Extraction and Transmission LLC*, 776 F.3d at 1347 (“The

concept of data collection, recognition, and storage is undisputedly well-known. Indeed, humans have always performed these functions.”). This recitation of generic computer memories and data types, being used in the conventional manner, is insufficient to confer the specificity required to elevate the nature of the claim into a patent-eligible application. *Alice*, 134 S. Ct. at 2355 (quoting *Mayo*, 132 S. Ct. at 1294) (“We have described step two of this analysis as 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 on the [ineligible concept] itself.’”) (brackets in original); *Affinity Labs*, No. 2015-2080, slip op. 10–11 (“The claims do not go beyond ‘stating [the relevant] functions in general terms, without limiting them to technical means for performing the functions that are arguably an advance over conventional computer and network technology.’”).

In addition, because the recited elements can be implemented on a general purpose computer, the challenged claims do not cover a “particular machine.” Pet. 70; see *Bilski*, 561 U.S. at 604–05 (stating that machine-or-transformation test remains “a useful and important clue” for determining whether an invention is patent eligible). And the challenged claims do not transform an article into a different state or thing. Pet. 70–71.

Thus, we determine, the potentially technical elements of the challenged claims are nothing more than “generic computer implementations” and perform functions that are “purely conventional.” *Alice*, 134 S. Ct. at 2358–59; *Mayo*, 132 S. Ct. at 1294.

b. DDR Holdings

Relying on the Federal Circuit’s decision in *DDR Holdings*, Patent Owner asserts that the challenged claims are directed to statutory subject matter because the claimed solution is “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” PO Resp. 1–2 (quoting *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014)). Patent Owner contends that

By using a system that combines on the data carrier both the digital content and the use rules/use status data, access control to the digital content can be continuously enforced prior to access to the digital content. By comparison, unlike a system that uses use rules/use status data as claimed, when a DVD was physically rented for a rental period, there was no mechanism to write partial use status data to the DVD when only part of the DVD had been accessed (e.g., to track whether a renter had “finished with” the DVD yet).

Id. at 18.

Petitioner responds that the challenged claims are distinguishable from the claims in *DDR Holdings*. Pet. Reply 12–17. The *DDR Holdings* patent is directed at retaining website visitors when clicking on an advertisement hyperlink within a host website. 773 F.3d at 1257. Conventionally, clicking on an advertisement hyperlink would transport a visitor from the host’s website to a third party website. *Id.* The Federal Circuit distinguished this Internet-centric problem over “the ‘brick and mortar’ context” because “[t]here is . . . no possibility that by walking up to [a kiosk in a warehouse store], the customer will be suddenly and completely transported outside the warehouse store and relocated to a separate physical venue associated with the third party.” *Id.* at 1258. The Federal Circuit

further determined that the *DDR Holdings* claims specify “how interactions with the Internet are manipulated to yield a desired result—a result that overrides the routine and conventional sequence of events ordinarily triggered by the click of a hyperlink.” *Id.* The unconventional result in *DDR Holdings* is the website visitor is retained on the host website, but is still able to purchase a product from a third-party merchant. *Id.* at 1257–58. The limitation referred to by the Federal Circuit in *DDR Holdings* recites “using the data retrieved, automatically generate and transmit to the web browser a second web page that displays: (A) information associated with the commerce object associated with the link that has been activated, and (B) the plurality of visually perceptible elements visually corresponding to the source page.” *Id.* at 1250. Importantly, the Federal Circuit identified this limitation as differentiating the *DDR Holdings* claims from those held to be unpatentable in *Ultramercial*, which “broadly and generically claim ‘use of the Internet’ to perform an abstract business practice (with insignificant added activity).” *Id.* at 1258.

We agree that the challenged claims are distinguishable from the claims at issue in *DDR Holdings*. As an initial matter, we are not persuaded by Patent Owner’s argument that the challenged claims are “rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks”—that of “data content piracy”—(PO Resp. 1–2), and address “technological problems created by the nature of digital content and the Internet” (*id.* at 31). Data piracy exists in contexts other than the Internet. *See* Pet. Reply 12–13 (identifying other contexts in which data piracy is a problem). For example, data piracy was a problem with compact discs. *Id.* at 13 (citing Ex. 1001, 5:9–12 (“where the data carrier

stores . . . music, the purchase outright option may be equivalent to the purchase of a compact disc (CD), preferably with some form of content copy protection such as digital watermarking”). Further, whatever the problem, the solution provided by the challenged claims is not rooted in specific computer technology, but is based on the abstract idea of controlling access to content (copyrighted media) by conditioning access on a rule/payment. *See* Pet. Reply 16 (citing *Ultramercial*, 772 F.3d at 712); *id.* at 12–13 (citing Ex. 1020 ¶¶ 42, 52, 76).

Even accepting Patent Owner’s assertion that the challenged claims address data piracy on the Internet (PO Resp. 32–33), we are not persuaded that they do so by achieving a result that overrides the routine and conventional use of the recited devices and functions. In fact, the differences between the challenged claims and the claims at issue in *DDR Holdings* are made clear by comparing the challenged claims of the ’458 patent to claim 19 of the patent at issue in *DDR Holdings*. Patent Owner compares the limitation highlighted by the Federal Circuit in *DDR Holdings* with those in the challenged claims. *See* PO Resp. 33–50. There is no language in the challenged claims, however, or the Specification of the ’458 patent, that demonstrates that the generic computer components function in an unconventional manner or employ sufficiently specific programming. For example, Patent Owner maps claim 5’s “synthesis code to receive a first portion of data from the interface and to combine the first portion with a second portion of data stored in the data memory and to store the result in the data memory” to the limitation highlighted by the Federal Circuit in *DDR Holdings*. This limitation, like all the other limitations of the challenged claims, is “specified at a high level of generality,” which the

Federal Circuit has found to be “insufficient to supply an ‘inventive concept.’” *Ultramercial*, 772 F.3d at 716. This limitation merely relies on conventional devices and computer processes operating in their “normal, expected manner.” *OIP Techs.*, 788 F.3d at 1363 (citing *DDR Holdings*, 773 F.3d at 1258–59).

Similar to the challenged claims, the claims at issue in *Ultramercial* were directed to distributing media products. Whereas the challenged claims control access to content based on payment and/or a use rule or use status data, the *Ultramercial* claims control access based on viewing an advertisement. 772 F.3d at 712. Similar to the claims in *Ultramercial*, the majority of limitations in the challenged claims comprise this abstract concept of controlling access to content. *See id.* at 715. Adding routine additional hardware, such as “interfaces,” “memory,” “program store,” and a “processor,” and routine additional steps such as receiving and outputting data does not transform an otherwise abstract idea into patent-eligible subject matter. *See id.* at 716 (“Adding routine additional steps such as updating an activity log, requiring a request from the consumer to view the ad, restrictions on public access, and use of the Internet does not transform an otherwise abstract idea into patent-eligible subject matter.”).

We are, therefore, persuaded that the challenged claims are closer to the claims at issue in *Ultramercial* than to those at issue in *DDR Holdings*.

c. *Bascom*

Patent Owner’s Notice of Supplemental Authority does not alter our determination. Patent Owner characterized the Federal Circuit’s decision in *BASCOM Global Internet Services, Inc. v. AT&T Mobility, LLC.*, 827 F.3d 1341, 1350 (Fed. Cir. 2016) as follows:

[The Federal Circuit] concluded at step two that the claims did not “merely recite the abstract idea of filtering content along with the requirement to perform it on the Internet, or to perform it on a set of generic computer components.” *Id.* at *6-*7. The patent claimed “installation of a filtering tool at a specific location . . . with customizable filtering features specific to each end user.” *Id.* at *6. That design provided specific benefits over alternatives; it was not “conventional or generic.” *Id.*

Notice 4. Relying on *Bascom*, Patent Owner contends that its claims “‘recite a specific, discrete implementation’ – concrete devices, systems, and methods – for purchasing, downloading, storing, and conditioning access to digital content.” *Id.* (citation omitted). Patent Owner argues that the challenged claims, like those in *Bascom*, involve known components “‘arranged in a non-conventional and non-generic way,’” namely by requiring “a handheld multimedia terminal to store *both* payment data *and* multimedia content data – thus ‘improv[ing] an existing technological process.’” *Id.* at 5 (quoting *Bascom*, 827 F.3d at 1351).

As Petitioner argues, even if every challenged claim required storing both payment data and multimedia content data on a handheld media terminal, Patent Owner still would not have rebutted Petitioner’s showing that doing so was neither inventive nor improved “the performance of the computer system itself.” Notice Resp. 4 (quoting *Bascom*, 827 F.3d at 1351). The concept of storing two different types of information in the same place or on the same device is an age old practice, as we discuss in the next section. *See infra*; *see also* Pet. 31 (citing Ex. 1016); Ex. 1016, 10:24–30 (describing “a rental product . . . formatted to include a time bomb or other disabling device which will disable the product at the end of the rental period.”); *see also* Pet. 12–15 (citing Ex. 1014); Ex. 1014, Abstract

(describing “[a] system for controlling use and distribution of digital works . . . the owner of a digital work attaches usage rights to that work.”). As a result, the challenged claims do not achieve a result that overrides the routine and conventional use of the recited devices and functions. Rather, each of the challenged claims is “an abstract-idea-based solution implemented with generic technical components in a conventional way,” making it patent ineligible. *See BASCOM*, 827 F.3d at 1351.

d. Patent Owner’s Alleged Inventive Concept

To the extent Patent Owner argues the challenged claims include an “inventive concept” because of the specific combination of elements in the challenged claims, we disagree. Specifically, Patent Owner refers to the following disclosure from the ’458 patent: “[b]y combining digital rights management with content data storage using a single carrier, the stored content data becomes mobile and can be accessed anywhere while retaining control over the stored data for the data content provider or data copyright owner.” PO Resp. 18 (quoting Ex. 1001, 5:29–33). Referring to this disclosure, Patent Owner argues that “[b]y using a system that combines on the data carrier the digital content and the use rules/use status data, access control to the digital content can be continuously enforced prior to access to the digital content.” *Id.* Patent Owner concludes that

By comparison, unlike a system that uses use rules/use status data as claimed, when a DVD was physically rented for a rental period, there was no mechanism to write partial use status data to the DVD when only part of the DVD had been accessed (e.g., to track whether a renter had “finished with” the DVD yet).

Id.

As Petitioner notes, the concept of continuously enforced access control to digital content is not recited in the challenged claims. Pet. Reply 7 n.2. Moreover, the concept of storing two different types of information in the same place or on the same device is an age old practice. For example, storing names and phone numbers (two different types of information) in the same place, such as a book, or on a storage device, such as a memory device was known. The concept was known and Patent Owner has not persuaded us that applying the concept to these two specific types of information results in the claim reciting an inventive concept. Furthermore, as discussed above, the prior art discloses products that could store both the content and conditions for providing access to the content. To the extent Patent Owner argues that the challenged claims cover storing, on the same device, both content and a *particular* type of condition for providing access to content or information necessary to apply that condition (e.g., continuous enforcement of access to the digital content and purchase of additional content (PO Resp. 18)), we do not agree that this, by itself, is sufficient to elevate the challenged claims to patent-eligible subject matter. Because the concept of combining the content and conditions for providing access to the content on the same device was known, claiming a particular type of condition does not make the claim patent eligible under § 101.

e. Preemption

The Petition states that the “broad functional coverage [of the challenged claims] firmly triggers preemption concerns.” Pet. 68. Patent Owner responds that the challenged claims do not result in inappropriate preemption. PO Resp. 57–62. According to Patent Owner, the challenged claims do not result in inappropriate preemption because they contain

elements not required to practice the abstract idea. *Id.* at 57; *see also id.* at 61–62 (“the [challenged] claims do not tie up or prevent the use of the purported abstract idea. . . because . . . there are an infinite number of ways of paying for and controlling access to content using a processor and a program store other than what is claimed”). Patent Owner also asserts that the existence of a large number of non-infringing alternatives shows that the challenged claims do not raise preemption concerns. *Id.* at 57–62. Finally, Patent Owner also asserts that our analysis ignores PTAB precedent. *Id.* at 58–60.

Patent Owner’s preemption argument does not alter our § 101 analysis. The Supreme Court has described the “pre-emption concern” as “undergird[ing] [its] § 101 jurisprudence.” *Alice*, 134 S. Ct. at 2358. The concern “is a relative one: how much future innovation is foreclosed relative to the contribution of the inventor.” *Mayo*, 132 S. Ct. at 1303. “While preemption may signal patent ineligible subject matter, the absence of complete preemption does not demonstrate patent eligibility.” *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). Importantly, the preemption concern is addressed by the two-part test considered above. *See id.* After all, every patent “forecloses . . . future invention” to some extent, *Mayo*, 132 S. Ct. at 1292, and, conversely, every claim limitation beyond those that recite the abstract idea limits the scope of the preemption. *See Ariosa*, 788 F.3d at 1379 (“The Supreme Court has made clear that the principle of preemption is the basis for the judicial exception to patentability. . . . For this reason, questions on preemption are inherent in and resolved by the § 101 analysis.”).

The two-part test elucidated in *Alice* and *Mayo* does not require us to anticipate the number, feasibility, or adequacy of non-infringing alternatives to gauge a patented invention's preemptive effect in order to determine whether a claim is patent-eligible under § 101. *See* Pet. Reply 17–18 (arguing that Patent Owner's position regarding non-infringement and existence of non-infringing alternatives to the challenged claims are immaterial to the patent eligibility inquiry).

The relevant precedents simply direct us to ask whether the claim involves one of the patent-ineligible categories, and, if so, whether additional limitations contain an “inventive concept” that is “sufficient to ensure that the claim in practice amounts to ‘significantly more’ than a patent on an ineligible concept.” *DDR Holdings*, 773 F.3d at 1255. This is the basis for the rule that the unpatentability of abstract ideas “cannot be circumvented by attempting to limit the use of the formula to a particular technological environment,” despite the fact that doing so reduces the amount of innovation that would be preempted. *Diamond v. Diehr*, 450 U.S. 175, 191 (1981); *see also Alice*, 134 S. Ct. at 2358; *Mayo*, 132 S. Ct. at 1303; *Bilski*, 561 U.S. at 612; *Parker v. Flook*, 437 U.S. 584, 593 (1978). The Federal Circuit spelled this out, stating that “[w]here a patent's claims are deemed only to disclose patent ineligible subject matter under the *Mayo* framework, as they are in this case, preemption concerns are fully addressed and made moot.” *Ariosa*, 788 F.3d at 1379.

As described above, after applying this two-part test, we are persuaded that the challenged claims are drawn to an abstract idea and do not add an inventive concept sufficient to ensure that the patent in practice amounts to significantly more than a patent on the abstract idea itself. The

alleged existence of a large number of non-infringing, and, thus, non-preemptive alternatives does not alter this conclusion because the question of preemption is inherent in, and resolved by, this inquiry.

f. Patent Owner's Remaining Arguments

Patent Owner also asserts that (1) Petitioner has already lost a Motion for Summary Judgment of Invalidity under § 101 in its related district court litigation (“the “co-pending litigation”) with Patent Owner (PO Resp. 62–63); (2) the Office is estopped from revisiting the issue of § 101, which was inherently reviewed during examination (*id.* at 63); (3) invalidating patent claims via Covered Business Method patent review is unconstitutional (*id.* at 64–66); and (4) section 101 is not a ground on which a Covered Business Method patent review may be instituted (*id.* at 66–68). For the following reasons, we are not persuaded by these arguments.

As a preliminary matter, Patent Owner does not provide any authority that precludes us from deciding the issue of patent eligibility under § 101 in the context of the present AIA proceeding, even where a non-final district court ruling on § 101 exists. *See Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 721 F.3d 1330, 1340–42 (Fed. Cir. 2013). As a result, we are not persuaded that the district court decisions referred to by Patent Owner preclude our determination of the patentability of the challenged claims under § 101.

Patent Owner also does not provide any authority for its assertion that “[t]he question of whether the instituted claims are directed to statutory subject matter has already been adjudicated by the USPTO, and the USPTO is estopped from allowing the issues to be raised in the present proceeding.” PO Resp. 63.

In addition, we decline to consider Patent Owner’s constitutional challenge as, generally, “administrative agencies do not have jurisdiction to decide the constitutionality of congressional enactments.” *See Riggin v. Office of Senate Fair Employment Practices*, 61 F.3d 1563, 1569 (Fed. Cir. 1995); *see also Harjo v. Pro-Football, Inc.*, 50 USPQ2d 1705 (TTAB 1999) (“[T]he Board has no authority . . . to declare provisions of the Trademark Act unconstitutional.”); *Amanda Blackhorse, Marcus Briggs-Cloud, Philip Gover, Jullian Pappan and Courtney Tsoitigh v. Pro-Football, Inc.*, 111 USPQ2d 1080 (TTAB 2014); *but see American Express Co. v. Lunenfeld*, Case CBM2014-00050, slip. op. at 9–10 (PTAB May 22, 2015) (Paper 51) (“for the reasons articulated in *Patlex*, we conclude that covered business method patent reviews, like reexamination proceedings, comply with the Seventh Amendment”).

As to Patent Owner’s remaining argument, Patent Owner concedes that the Federal Circuit, in *Versata*, found that “the PTAB acted within the scope of its authority delineated by Congress in permitting a § 101 challenge under AIA § 18.” PO Resp. 66 n.4 (quoting *Versata Dev. Grp.*, 793 F.3d at 1330). We conclude that our review of the issue of § 101 here is proper.

g. Conclusion

For all of the foregoing reasons, we are persuaded that Petitioner has established, by a preponderance of the evidence, that the challenged claims of the ’458 patent are unpatentable under 35 U.S.C. § 101.

C. Indefiniteness

Petitioner contends that claims 3–5 are unpatentable under 35 U.S.C. § 112, second paragraph as indefinite. Pet. 71–75. Petitioner’s basis for this challenge is that “the code” recited in each of claims 3–5 “lacks a clear or

definite antecedent basis” (Pet. 71–73), and “the content data memory” recited in each of claims 3–5 also “lack[s] a clear or definite antecedent basis” (*id.* at 74–75)⁴. Patent Owner responds that “[c]laims 3–5 are definite as they ‘afford clear notice of what is claimed, thereby apprising the public of what is still open to them.’” PO Resp. 68 (quoting *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S. Ct. 2102, 2128–29 (2014)).

Claims 3–5 each refer to “the code” after two instances of code are introduced in the claims. Patent Owner contends that “there is an unambiguous recitation of ‘code’ stored in the program store such that ‘the code’ clearly could only mean ‘the code stored in the program store.’” PO Resp. 69. As noted above, however, the claims each recite a second, and distinct, “code” in addition to that recited in the “program store storing code” limitation referenced by Patent Owner. For example, claim 3 also recites “non-volatile use record memory . . . for storing . . . code to update the use record memory.”

Patent Owner contends that

to attempt to interpret “the code” as being a specific type of code (e.g., “code to update the use record memory” in claim 3) would cause “code to output payment data from the payment data memory to the interface and code to provide external access to the data memory” to have functions inconsistent with the specific type of code (e.g., whose function is update the use record memory, not output payment data from the payment data

⁴ Patent Owner additionally addresses Petitioner’s indefiniteness challenge for claims 3–5 based on the “content data memory” limitation in its Response. *See* PO Resp. 70. We did not institute trial on that basis. *See* Ins. Dec. 23 (“we are not persuaded that one skilled in the art would not have readily understood that ‘the content data memory’ is intended to refer back to the ‘non-volatile data memory . . . for storing data on the carrier’ recited in each of claims 3–5.”).

memory to the interface or provide external access to the data memory).

Id. Patent Owner does not address specifically the similar code limitations in claims 4 and 5. Patent Owner's contentions are the exact same as those set forth in its Preliminary Response. *See* Prelim. Resp. 41–42.

As explained in our Institution Decision, and not addressed further in Patent Owner's Response, [t]he lack of antecedent basis for “the code” introduces ambiguity into the claims. It is unclear whether “the code” recited in claims 3–5 refers back to the code in the program store or to the other instances of code recited in those claims. We are persuaded that the phrase “the code” recited in claims 3–5 does not inform those skilled in the art about the scope of the invention with reasonable certainty and, therefore, is more likely than not indefinite under 35 U.S.C § 112, ¶ 2. *In re Packard*, 751 F.3d 1307, 1311 (Fed. Cir. 2014) (affirming Board's conclusion, in context of *ex parte* appeal, that claims were indefinite “on grounds that they ‘contain[] words or phrases whose meaning is unclear.’”). Patent Owner fails to identify anything further in the specification or prosecution history that would inform those skilled in the art about the scope of the invention with reasonable certainty.

On this record, Petitioner has established, by a preponderance of the evidence, that claims 3–5 are indefinite under 35 U.S.C. § 112, second paragraph.

D. Patent Owner's Motion to Exclude

Patent Owner filed a Motion to Exclude (Paper 24, “Motion”), Petitioner filed an Opposition to Patent Owner's Motion (Paper 25, “Opp.”), and Patent Owner filed a Reply in support of its Motion (Paper 27). Patent Owner seeks to exclude Exhibits 1002, 1003, 1005–1007, 1011–1020, and

1026–1037.⁵ Mot. 1. As movant, Patent Owner has the burden of proof to establish that it is entitled to the requested relief. *See* 37 C.F.R. § 42.20(c). For the reasons stated below, Patent Owner’s Motion to Exclude is *denied*.

1. Exhibit 1002 and 1037

Patent Owner seeks to exclude Exhibit 1002—the First Amended Complaint filed by Patent Owner in the co-pending litigation—and Exhibit 1037—Trial Transcript of *Smartflash LLC v. Apple Inc.*, 6:13-cv-447 (E.D. Tex.) for February 16, 2015—as inadmissible other evidence of the content of a writing (FRE 1004), irrelevant (FRE 401), and cumulative (FRE 403). Mot. 1–4; Paper 29, 1–3. Specifically, Patent Owner argues that the Petition does not need to cite Patent Owner’s characterization of the ’458 patent in the complaint because the ’458 patent itself is in evidence. Mot. 4. Moreover, according to Patent Owner, its characterization of the ’458 patent is irrelevant and, even if relevant, cumulative to the ’458 patent itself. *Id.* at 2–3.

We are persuaded that Exhibits 1002 and 1037 are offered not for the truth of the matter asserted (i.e., the content of the ’458 patent), but as evidence of how Patent Owner has characterized the ’458 patent. Thus, Patent Owner has not persuaded us that Exhibits 1002 and 1037 are evidence of the content of a writing or that they are cumulative to the ’458 patent. Furthermore, Patent Owner has not persuaded us that Exhibits 1002 and 1037 are irrelevant, at least because its characterization of the ’458 patent in prior proceedings is relevant to the credibility of its characterization of the ’458 patent in this proceeding. Patent Owner contends that Exhibits 1002

⁵ Patent Owner also lists Exhibits 1008, 1009, and 1024 (Mot. 1, 12–13), but does not provide any arguments with respect to those exhibits.

and 1037 do not contradict its characterization of the '458 patent in this proceeding such that the credibility of Patent Owner's characterization is an issue. Mot. 3. This argument misses the point because the credibility of Patent Owner's characterization is for the Board to weigh after deciding the threshold issue of admissibility. As Petitioner notes (Opp. 2), Patent Owner's characterization of the '458 patent in prior proceedings is relevant to Patent Owner's contention in this proceeding that the '458 patent does not satisfy the "financial in nature" requirement for a covered business method patent review (PO Resp. 70–75; Prelim. Resp. 49–53).

Accordingly, we decline to exclude Exhibits 1002 and 1037.

2. *Exhibits 1003, 1005–1007, 1009, 1011–1019, 1026–1032, and 1034–1036*

Patent Owner seeks to exclude Exhibits 1003, 1005–1007, 1009, 1011–1019, 1026–1032, and 1034–1036 as irrelevant under FRE 401 and 402 because they are not alleged to be invalidating prior art, and our Decision to Institute did not base any of its analysis on them. Mot. 4–5; Paper 27, 2–3.

Petitioner counters that all of these exhibits are relevant to our § 101 analysis because they establish the state of the art and show whether the challenged claims contain an inventive concept. Opp. 4–5. Petitioner further contends that the Petition and Kelly Declaration rely on these prior art exhibits to show, for example, that the elements disclosed by the challenged claims were well known, routine, and conventional. *Id.* at 5.

Patent Owner argues that whether limitations of the challenged claims were well-known, routine, and conventional is only relevant after finding that a claim is directed to an abstract idea, which is not necessary in this case

because the claims are not directed to an abstract idea. Mot. 6–7. Petitioner argues that “[i]t would be nonsensical to exclude the Prior Art Exhibits before the Board determines whether it needs to perform the second step of the Mayo analysis, as PO urges,” and that the claims are directed to an abstract idea. Opp. 6.

For the reasons stated by Petitioner, Patent Owner has not persuaded us that these exhibits are irrelevant under FRE 401 and 402. These exhibits are relevant to the state of the art—whether the technical limitations of the challenged claims were well-known, routine, and conventional—and thus, to our § 101 analysis. Moreover, Dr. Kelly attests that he reviewed these exhibits in reaching the opinions he expressed in this case (*see, e.g.*, Ex. 1020 ¶ 9) and many of these exhibits are cited in the Petition’s discussion of the § 101 challenge (*see* Pet. 45, 58–65). Patent Owner, thus, has not persuaded us that they are irrelevant under FRE 401 and 402.

Accordingly, we decline to exclude Exhibits 1003, 1005–1007, 1009, 1011–1019, 1026–1032, and 1034–1036.

3. Exhibit 1020

Patent Owner moves to exclude Exhibit 1020, the Kelly Declaration, on grounds that it is directed to questions of law and is unreliable because it fails to meet the reliability requirements of 37 C.F.R. § 42.65(a) and FRE 702. Mot. 7–12; Paper 27, 3–4. Specifically, Patent Owner contends that the declaration is directed to statutory subject matter, which is inadmissible under 37 C.F.R. § 42.65(a), and there is no assurance that his testimony is reliable, as required by FRE 702, because Dr. Kelly (1) did not employ scientifically valid reasoning or methodology because he could not provide a false positive rate (i.e., finding a claim to be ineligible when it was eligible)

or false negative rate; (2) did nothing to test the method he used to ensure it was repeatable and reliable; (3) could not define abstract idea; (4) looked for an inventive concept over the prior art rather than over the abstract idea itself; and (5) does not state the relative evidentiary weight (e.g., substantial evidence versus preponderance of the evidence) used in arriving at his conclusions. Mot. 7–12. Thus, Patent Owner concludes that we cannot assess, under FRE 702, whether Dr. Kelly’s testimony is “based on sufficient facts or data,” is “the product of reliable principles and methods,” or “reliably applie[s] the principles and methods to the facts of the case.” Paper 27, 3.

Petitioner argues that (1) Dr. Kelly’s opinions relate to factual issues that underlie the § 101 inquiry and there is no dispute that he is competent to opine on those issues (2) there is no support for Patent Owner’s argument that experts need to review legal opinions to determine a false positive or negative rate; and (3) Dr. Kelly performed the correct inquiry, which is whether the claims provide an inventive concept despite being directed to an abstract idea. Opp. 8–11 (citation omitted).

Patent Owner has not articulated a persuasive reason for excluding Dr. Kelly’s Declaration. Because Exhibit 1020 relates to the underlying factual issues related to patent eligibility, we are not persuaded that it is irrelevant under FRE 401 and 402. It is within our discretion to determine the appropriate weight to be accorded to the evidence presented, including the weight accorded to expert opinion, based on the disclosure of the underlying facts or data upon which the opinion is based. Our discretion includes determining whether the expert testimony is the product of reliable

principles and methods and whether the expert has reliably applied the principles and methods to the facts of the case. *See* FRE 702.

Accordingly, we decline to exclude Exhibit 1020 in its entirety or any paragraph therein.

4. Exhibit 1033

Patent Owner moves to exclude Exhibit 1033, the April 8–9, 2015, deposition transcript of Dr. Jonathan Katz, Patent Owner’s expert in CBM2014-00102, CBM2014-00106, CBM2014-00108, and CBM2014-00112, on the grounds that it is irrelevant hearsay. Mot. 12; Paper 27, 4. Petitioner argues that this testimony is not hearsay because it is a party admission under FRE 801(d)(2)(C) and 801(d)(2)(D), and because, even if hearsay, it is subject to the residual hearsay exception under FRE 807. Opp. 12–15. Patent Owner argues that Dr. Katz’s admissions as to what was in the prior art are irrelevant to a § 101 analysis because “[s]omething can be in the prior art for §§ 102 and/or 103 purposes but not be well-known, routine, and conventional.” Paper 27, 4.

We agree with Petitioner that Dr. Katz’s testimony is not hearsay because it was offered against an opposing party, is one that Patent Owner adopted or believed to be true, and was made by a person, Dr. Katz, whom Patent Owner authorized to make a statement on the subject. FRE 801(d)(2)(C), 801(d)(2)(D). We are, therefore, not persuaded that this testimony should be excluded.

ORDER

Accordingly, it is:

ORDERED that claims 2–5, 7, 9, and 12 of the ’458 patent are determined to be *unpatentable* under 35 U.S.C. § 101;

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FURTHER ORDERED that claims 3–5 of the '458 patent are determined to be *unpatentable* under 35 U.S.C. § 112, second paragraph;

FURTHER ORDERED that Patent Owner's motion to exclude is *denied*; and

FURTHER ORDERED that, because this is a final written decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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