Filed on behalf of:

Patent Owner SightSound Technologies, LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

SIGHTSOUND TECHNOLOGIES, LLC,

Patent Owner.

Case CBM2013-00020
Patent 5,191,573

PATENT OWNER'S MOTION FOR OBSERVATIONS ON CROSS-EXAMINATION

I. Observations Regarding CompuSonics

Observation #1. In exhibit 2175, on pages 23:11-20 and 33:24-34:16, Dr. Kelly testified that he had no personal knowledge of CompuSonics' products or materials and that his understanding of CompuSonics' activities, including any demonstrations, was "based solely on the record to date." Dr. Kelly further testified on pages 29:1-5 and 34:18-21 that he never reviewed the Declaration of John P. Stautner (Ex. 2121), CompuSonics' first employee and President of CompuSonics Video Corporation. This testimony is relevant to Dr. Kelly's invalidity analyses in paragraphs 32-40 and appendix C of his first declaration (Ex. 4132) and paragraphs 4-27 and 82-83 of his second declaration (Ex. 4262). The testimony is relevant because it demonstrates that Dr. Kelly disregarded probative evidence and did not have the complete record before him when formulating his opinions regarding CompuSonics.

Observation #2. In exhibit 2175, on pages 25:2-22, 27:12-14, and 28:9-21, Dr. Kelly testified that, for purposes of his anticipation and obviousness opinions, the "CompuSonics system" includes "everything" such as publications, hardware, sales demonstrations, and even Mr. Schwartz's deposition (Ex. 2124). Dr. Kelly further testified on pages 141:5-17 that his analyses have always consisted of all such materials and never a subset of the whole. This testimony is relevant to (1) Petitioner's reliance on a so-called "CompuSonics system" for its invalidity contentions throughout the current proceeding, as demonstrated in its Petition (Paper 6) on pages 33-55 and its Reply (Paper 52) on page 5, and (2) Dr. Kelly's invalidity analyses in paragraphs 32-40

and appendix C of his first declaration (Ex. 4132) and paragraphs 4-27 and 82-83 of his second declaration (Ex. 4262). The testimony is relevant because it demonstrates that Petitioner and Dr. Kelly applied an erroneous standard in determining whether the claims at issue in the current proceeding are invalid.

II. Observations Regarding the Second Memory

Observation #3. In exhibit 2175, on pages 45:7-15, Dr. Kelly testified that he is not familiar with the patent law doctrines of disavowal and disclaimer. Dr. Kelly further testified on page 56:8-25, in the context of whether the specification influenced the claims at issue in the current proceeding, that certain portions of text from the '573 patent specification are "broader than the -- than the challenged claims certainly." This testimony is relevant to Dr. Kelly's opinions in paragraphs 4-13 of his second declaration (Ex. 4262). The testimony is relevant because it demonstrates that Dr. Kelly applied an erroneous standard (one in which he did not properly consider the specification of the '573 patent) in determining whether the term "second memory" is limited to non-removable media.

Observation #4. In exhibit 2175, on pages 49:5-12 and 51:5-13, Dr. Kelly testified that "it is an objective of the inventor that it's a further objective to -- to provide a new way of storing and retrieving digital audio music." *See also* Ex. 2175 at 56:8-25. Dr. Kelly further testified on pages 58:24-59:6 that three inefficiencies described by the '573 patent—"materials," "size," and "retrieval"—"are the result of the -- of this being basically hardware units." This testimony is relevant to (1) Patent

Owner's argument in its Response (Paper 41) on pages 25-28 that the second memory is limited to non-removable media, and (2) Dr. Kelly's opinions in paragraphs 4-13 of his second declaration (Ex. 4262). The testimony is relevant because it undermines Dr. Kelly's opinion that the second memory is not limited to non-removable media.

III. Observations Regarding Non-Obviousness

Observation #5. In exhibit 2176, on pages 95:17-20 and 98:21-99:12, Mr. Robbin testified that he was a co-inventor of U.S. Patent No. 7,797,242 (the "'242 patent"), relating to "network-based purchase and distribution of media," with a provisional filing date of April 25, 2003, which is "around the time that [Petitioner] did [iTMS]." Mr. Robbin further testified on pages 105:23-106:7 that the patent application sets forth as claim 1 "[a] method for purchasing access to a media item over a network" with parts (a) through (d), which are listed below:

> A method for purchasing access to a media item over a network, said method comprising: (a) receiving, over the network, a buy request from a user requesting to buy a particular media item, the buy request being initiated by the user through a single graphical user interface action by the user once an identifier for the particular media item is displayed on a display screen for the user, and the buy request including an account identifier for the user; (b) initiating payment for the particular media item being purchased in response to the buy request being received, the payment being processed using information previously stored in a user account associated with the user; (c) determining media access information pertaining to the particular media item; and (d) sending,

over the network, the media access information to a user machine of the user, the media access information thereafter being used by the user machine to access the particular media item.

See Ex. 9 of Robbin Dep. (Ex. 2176). This testimony is relevant to Patent Owner's argument in its Response (Paper 41) on pages 59-66 that the claims at issue in this proceeding were not obvious to a person of ordinary skill in the art. The testimony is relevant because it demonstrates that Petitioner Apple Inc. ("Petitioner") sought similar patent claims in 2003 to what it now contends was obvious in 1988.

Observation #6. In exhibit 2176, on pages 70:19-71:6, Mr. Robbin testified that he signed an inventor's oath for the application that led to the '242 patent (and which has the same docket number as the application with claim 1 as set forth above) stating that he is an inventor of the subject matter that is claimed and for which a patent is sought and that, to his knowledge, he has never signed a patent application stating that he believed himself to be the first inventor of subject matter that was in the prior art. This testimony is relevant to Patent Owner's argument in its Response (Paper 41) on pages 59-66 that the claims at issue in this proceeding were not obvious to a person of ordinary skill in the art. The testimony is relevant because it demonstrates that Mr. Robbin did not believe, in 2003, that the subject matter of claim 1, which is similar to the claims at issue in this proceeding, was in the prior art.

Observation #7. In exhibit 2176, on pages 111:9-21 and 109:2-110:10, Mr. Robbin testified that he did not see anything in the Background of the Invention

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