

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

SMARTFLASH LLC,  
Patent Owner.

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Case CBM2014-00104  
Patent 7,334,720 B2

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

ELLURU, *Administrative Patent Judge.*

DECISION

Denying Institution of Covered Business Method Patent Review  
*37 C.F.R. § 42.208*

## INTRODUCTION

### *A. Background*

Petitioner, Apple Inc. (“Apple”), filed a Petition (Paper 6, “Pet.”) to institute a covered business method patent review of claims 1, 3, 11, and 13–15 (“the challenged claims”) of US Patent No. 7,334,720 B2 (Ex. 1001, “the ’720 patent”) pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”). Patent Owner, Smartflash LLC (“Smartflash”), filed a Preliminary Response (Paper 7, “Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 324, which provides that a covered business method patent review may not be instituted “unless . . . it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” Pub. L. No. 112-29, 125 Stat. 284, 329 (2011).

### *B. Asserted Grounds*

Apple contends that the challenged claims are unpatentable under 35 U.S.C. §§ 102 and/or 103 based on the following grounds (Pet. 22, 43–80).

References	Basis	Claims Challenged
Stefik ’235 <sup>1</sup> and Stefik ’980 <sup>2</sup>	§ 102 <sup>3</sup>	1, 3, 11, 13, and 14
Stefik ’235 and Stefik ’980	§ 103	1, 3, 11, 13, and 14

<sup>1</sup> US Patent No. 5,530,235 (Ex. 1013) (“Stefik ’235”).

<sup>2</sup> US Patent No. 5,629,980 (Ex. 1014) (“Stefik ’980”).

<sup>3</sup> Petitioner refers to Stefik ’235 and Stefik ’980 collectively as “Stefik” and argues that they should be considered as a single reference for anticipation purposes because, according to Petitioner, Stefik ’235 incorporates Stefik ’980 by reference. Pet. 28–29, n.13. Patent Owner disagrees. Prelim. Resp. 13–15. We do not reach this issue because even when considered as one reference, we determine that Stefik ’235 and Stefik ’980 do not teach all the recited claim limitations in the same form and order as listed in the claims.

References	Basis	Claims Challenged
Stefik '235, Stefik '980, and Poggio <sup>4</sup>	§ 103	3, 11, and 13–15
Stefik '235, Stefik '980, Poggio, and Sato <sup>5</sup>	§ 103	3, 11, and 13–15
Stefik '235, Stefik '980, and Sato	§ 103	1, 3, 11, and 13–15
Stefik '235, Stefik '980, and Maari <sup>6</sup>	§ 103	1
Stefik '235, Stefik '980, Maari, and Sato	§ 103	1

Petitioner also provides a declaration from Anthony J. Wechselberger.<sup>7</sup> Ex. 1021.

After considering the Petition and Preliminary Response, we determine that the '720 patent is a covered business method patent. We further determine, however, that Apple has not demonstrated that it is more likely than not that at least one of the challenged claims is unpatentable.

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<sup>4</sup> European Patent Application, Publication No. EP 0 809 221 A2 (translation), published November 26, 1997 (Ex. 1016, “Poggio”).

<sup>5</sup> JP Patent Application Publication No. H11-164058 (including translation), published June 18, 1999 (Ex. 1018, “Sato”).

<sup>6</sup> JP Patent Application Publication No. H10-269289 (including translation), published October 9, 1998 (Ex. 1019, “Maari”).

<sup>7</sup> On this record, we are not persuaded by Patent Owner’s argument that we should disregard the Wechselberger Declaration. *See* Prelim. Resp. 16–18. Patent Owner identifies purported omissions from the Declaration, but offers no evidence that Mr. Wechselberger used incorrect criteria, failed to consider evidence, or is not an expert in the appropriate field. *Id.*

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Therefore, we deny institution of a covered business method patent review of claims 1, 3, 11, and 13–15 of the '720 patent.

*C. Related Matters*

The parties indicate that Smartflash has sued Apple for infringement of the '720 patent and identify the following district court case: *Smartflash LLC v. Apple Inc.*, Case No. 6:13-cv-447 (E.D. Tex.). Pet. 21; Papers 5, Related Matter, 8, Updated Mandatory Notice Information. The parties also indicate that the '720 patent is the subject of a second case, to which Apple is not a party: *Smartflash LLC v. Samsung*, Case No. 6:13-cv-448 (E.D. Tex.). *Id.*

Apple filed a concurrent petition for covered business method patent review of the '720 patent: CBM2014-00105.<sup>8</sup> In addition, Apple filed ten other Petitions for covered business method patent review challenging claims of patents owned by Smartflash and disclosing similar subject matter: CBM2014-00102; CBM2014-00103; CBM2014-00106; CBM2014-00107; CBM2014-00108, CBM2014-00109; CBM2014-00110; CBM2014-00111; CBM2014-00112; and CBM2014-00113.

*D. The '720 Patent*

The '720 patent relates to “a portable data carrier for storing and paying for data and to computer systems for providing access to data to be

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<sup>8</sup> Patent Owner argues that the multiple petitions filed against the '720 patent violate the page limit requirement of 37 C.F.R. § 42.24(a)(iii), but does not cite any authority to support its position. Prelim. Resp. 11–12. The page limit for petitions requesting covered business method patent review is 80 pages (37 C.F.R. § 42.24(a)(iii)), and each of the '104 and '105 Petitions meets that requirement.

stored” and the “corresponding methods and computer programs.”

Ex. 1001, 1:6–10. 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 1:15–41. The ’720 patent describes providing portable data storage together with a means for conditioning access to that data upon validated payment. *Id.* at 1:46–62. According to the ’720 patent, this combination of the payment validation means with the data storage means allows data owners to make their data available over the Internet without fear of data pirates. *Id.* at 1:62–2:3.

As described, the portable data storage device is connected to a terminal for internet access. *Id.* at 1:46–55. 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 1:56–59. The ’720 patent makes clear that the actual implementation of these components is not critical and may be implemented in many ways. *See, e.g., id.* at 26:13–16 (“The skilled person will understand that many variants to the system are possible and the invention is not limited to the described embodiments.”).

#### *E. Challenged Claims*

Petitioner challenges claims 1, 3, 11, and 13–15 of the ’720 patent. Claims 1, 3, and 14 are independent. Claims 11 and 13 depend from claim 3 and claim 15 depends from claim 14. Claims 1 and 3 are illustrative of the claims at issue and recite the following.

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