

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

|                                      |   |                        |
|--------------------------------------|---|------------------------|
| Inventor: Hulst et al.               | § | Attorney Docket No.:   |
| United States Patent No.: 8,033,458  | § | 104677-5008-807        |
| Formerly Application No.: 12/943,847 | § | Customer No. 28120     |
| Issue Date: October 11, 2011         | § |                        |
| Filing Date: November 10, 2010       | § | Petitioner: Apple Inc. |
| Former Group Art Unit: 2887          | § |                        |
| Former Examiner: Thien M. Le         | § |                        |

For: Data Storage and Access Systems

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**PETITION FOR COVERED BUSINESS METHOD PATENT REVIEW OF  
UNITED STATES PATENT NO. 8,033,458 PURSUANT TO 35 U.S.C. § 321,  
37 C.F.R. § 42.304**

## TABLE OF CONTENTS

|      |  |    |
|------|--|----|
| I.   | INTRODUCTION.....  | 1  |
| II.  | OVERVIEW OF FIELD OF THE CLAIMED INVENTION .....   | 4  |
| III. | PETITIONER HAS STANDING.....   | 12 |
|      | A. The '458 Patent Is a Covered Business Method Patent.....  | 12 |
|      | 1. Exemplary Claim 1 Is Financial In Nature .....  | 13 |
|      | 2. Claim 1 Does Not Cover A Technological Invention .....  | 15 |
|      | B. Related Matters; Petitioner Is a Real Party In Interest Sued for and<br>Charged With Infringement .....   | 20 |
| IV.  | DETAILED EXPLANATION OF REASONS FOR RELIEF REQUESTED,<br>SHOWING IT IS MORE LIKELY THAN NOT THAT AT LEAST ONE<br>OF THE CHALLENGED CLAIMS IS UNPATENTABLE.....   | 21 |
|      | A. Claim Construction.....   | 22 |
|      | B. The Challenged Claims Are Invalid Under §§ 102 and/or 103.....  | 27 |
|      | 1. Overview of Stefik .....  | 27 |
|      | 2. Motivation to Combine Stefik with Sato.....   | 31 |
|      | 3. Motivation to Combine Stefik with Poggio .....  | 34 |
|      | 4. Motivation to Combine Stefik with Rydbeck .....   | 37 |
|      | 5. Claims 6-8, 10, and 11 are Anticipated by Stefik (Ground 1);<br>Claims 1, 6-8, 10, and 11 are Obvious in Light of Stefik<br>(Ground 2); Claims 1, 6-8, 10, and 11 are Obvious in Light<br>of Stefik in View of Sato (Ground 3); Claims 1, 6-8, 10, and<br>11 are Obvious in Light of Stefik in View of Poggio<br>(Ground 4); Claims 1, 6-8, 10, and 11 are Obvious in Light<br>of Stefik in View of Poggio and Sato (Ground 5); Claim 1 is<br>Obvious in Light of Stefik in View of Poggio and Rydbeck<br>(Ground 6). ..... | 38 |
| V.   | CONCLUSION.....  | 78 |

| <b>EXHIBIT LIST</b> |   |
|---------------------|---|
| 1001                | U.S. Patent No. 8,033,458   |
| 1002                | Plaintiffs' First Amended Complaint   |
| 1003                | U.S. Patent No. 8,061,598   |
| 1004                | File History for U.S. Patent No. 8,033,458  |
| 1005                | File History for U.S. Patent No. 8,118,221  |
| 1006                | U.S. Patent No. 4,999,806   |
| 1007                | U.S. Patent No. 5,675,734   |
| 1008                | File History for U.S. Patent No. 8,336,772  |
| 1009                | U.S. Patent No. 4,878,245   |
| 1010                | U.S. Patent No. 7,334,720   |
| 1011                | U.S. Patent No. 7,942,317   |
| 1012                | U.S. Patent No. 5,103,392   |
| 1013                | U.S. Patent No. 5,530,235   |
| 1014                | U.S. Patent No. 5,629,980   |
| 1015                | U.S. Patent No. 5,915,019   |
| 1016                | European Patent Application, Publication No. EP0809221A2  |
| 1017                | PCT Application Publication No. WO 99/43136   |
| 1018                | JP Patent Application Publication No. H11-164058 (translation)  |
| 1019                | JP Patent Application Publication No. H10-269289 (translation)  |
| 1020                | Eberhard von Faber, Robert Hammelrath, and Franz-Peter Heider, "The Secure Distribution of Digital Contents," IEEE (1997) |

| <b>EXHIBIT LIST</b> |   |
|---------------------|---|
| 1021                | Declaration of Anthony J. Wechselberger In Support of Apple Inc.'s Petition for Covered Business Method Patent Review |
| 1022                | U.S. Patent No. 5,754,654   |
| 1023                | Declaration of Michael P. Duffey In Support of Apple Inc.'s Petition for Covered Business Method Patent Review        |
| 1024                | Declaration of Flora D. Elias-Mique In Support of Apple Inc.'s Petition for Covered Business Method Patent Review     |
| 1025                | U.S. Patent No. 8,118,221   |
| 1026                | U.S. Patent No. 8,336,772   |
| 1027                | File History for U.S. Patent No. 7,334,720  |
| 1028                | File History for U.S. Patent No. 7,942,317  |
| 1029                | File History for U.S. Patent No. 8,061,598  |

## I. INTRODUCTION

Pursuant to 35 U.S.C. § 321 and 37 C.F.R. § 42.304, the undersigned, on behalf of and acting in a representative capacity for petitioner, Apple Inc. (“Petitioner” and the real party in interest), hereby petitions for review under the transitional program for covered business method patents of claims 1, 6-8, 10, and 11 (“the challenged claims”) of U.S. Patent No. 8,033,458 (“the ’458 Patent”), issued to Smartflash Technologies Limited and currently assigned to Smartflash LLC (“Smartflash,” also referred to as “Applicant,” “Patent Owner,” or “Patentee”). Petitioner hereby asserts that it is more likely than not that at least one of the challenged claims is unpatentable for the reasons set forth herein and respectfully requests review of, and judgment against, claims 1, 6-8, 10 and 11 as invalid under 35 U.S.C. §§ 102 and/or 103.<sup>1</sup>

As discussed in Section III.B, *infra*, Petitioner has concurrently filed a Petition seeking covered business method review of the ’458 Patent, requesting judgment against these same claims based on different prior art references. Petitioner notes that the Director, pursuant to Rule 325(c), may determine at the proper time that merger of these proceedings, or at minimum coordination of proceedings involving the same patent, is appropriate.

The challenged claims of the ’458 Patent merely recite “[d]ata storage and ac-

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<sup>1</sup> Petitioner is demonstrating, in pending litigation, that these claims are invalid for numerous additional reasons. All emphasis herein added unless otherwise noted.

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