

Trials@uspto.gov Paper 6 (CBM2015-00015), Paper 14 (CBM2014-00102)
Tel: 571-272-7822 Paper 6 (CBM2015-00016), Paper 14 (CBM2014-00106)
Paper 6 (CBM2015-00017), Paper 14 (CBM2014-00108)
Paper 4 (CBM2015-00018), Paper 13 (CBM2014-00112)
Entered: November 13, 2014

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

CBM2015-00015, CBM2014-00102 (Patent 8,118,221 B2)
CBM2015-00016, CBM2014-00106 (Patent 8,033,458 B2)
CBM2015-00017, CBM2014-00108 (Patent 8,061,598 B2)
CBM2015-00018, CBM2014-00112 (Patent 7,942,317 B2)¹

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

ELLURU, *Administrative Patent Judge.*

ORDER

¹ This order addresses issues that are the same in all identified cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers.

CBM2015-00015, CBM2014-00102 (Patent 8,118,221 B2)
CBM2015-00016, CBM2014-00106 (Patent 8,033,458 B2)
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A teleconference was held on Friday, November 7, 2014, among Steven Baughman and Ching-Lee Fukuda, representing Petitioner; Michael Casey and Scott Davidson, representing Patent Owner; and Judges Bisk, Elluru, Plenzler, and Clements.

Both Petitioner and Patent Owner requested the teleconference. Petitioner filed three petitions, CBM2015-00015, CBM2015-00016, and CBM2015-00017 (“the 2015 set of petitions”), concurrently with motions for joinder or coordination of schedules with CBM2014-00102, CBM2014-00106, and CBM2014-00108 (“the 2014 set of petitions”). Petitioner also filed CBM2015-00018 (part of the 2015 set of petitions), which challenges the same patent as CBM2014-00112, without a motion for joinder, but Petitioner represented that it would like to coordinate the schedule of these two cases as well. Petitioner requested that we shorten the due dates for the Patent Owner Preliminary Response in CBM2015-00015, CBM2015-00016, CBM2015-00017, and CBM2015-00018, to which Patent Owner objected.

The 2015 set of petitions assert substantially overlapping arguments and prior art as asserted in the 2014 set of petitions, as well as challenges pursuant to 35 U.S.C. § 101, which raise purely legal issues. Given that we may need to coordinate schedules should we institute trials in the 2015 set of petitions, we expedited the due date for the Patent Owner Preliminary Responses in CBM2015-00015, CBM2015-00016, CBM2015-00017, and CBM2015-00018 to December 15, 2014. We also indicated that we would extend the due date for the Patent Owner Responses in CBM2014-00102, CBM2014-00106, CBM2014-00108, and CBM2014-00112. The extended due date for these cases will be determined in due course.

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Patent Owner requested authorization to file a motion for additional discovery on Apple's products, servers for "iTunes" and "App Store." Patent Owner asserted that it would like to show that Apple's products are covered by its claims, and thus, that the discovery sought relates to commercial success. Patent Owner, however, stated that it has "very little" evidence that certain products read on the claims. Petitioner responded that Patent Owner seeks very broad categories of discovery, the related district court case is addressing the infringement allegations, there has been 6 million pages of documents produced in that case, and if we were to grapple with the infringement issue then we would have a "trial within a trial" with respect to infringement. Petitioner also alleged that Patent Owner has not met a threshold showing of nexus between the claims and the alleged commercial success of Apple's products. We denied Patent Owner's request for authorization to file a motion for additional discovery given that Patent Owner has not made a threshold showing as to infringement or nexus with commercial success.

It is:

ORDERED that the due date for the Patent Owner Preliminary Response in CBM2015-00015, CBM2015-00016, CBM2016-00017, and CBM2015-00018 is December 15, 2014; and

FURTHER ORDERED that Patent Owner is not authorized to file a motion for additional discovery.

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CBM2015-00018, CBM2014-00112 (Patent 7,942,317 B2)

PETITIONER:

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