

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC. and
SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

and

Apple Inc.,
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

Cases

CBM2014-00194¹, CBM2014-00199 (Patent 8,118,221)

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

ELLURU, *Administrative Patent Judge*.

ORDER

Conduct of the Proceedings
37 C.F.R. § 42.5

¹ CBM2015-00117 (Patent 8,118,221 B2) has been consolidated with this proceeding. Apple has been dismissed as a Petitioner from CBM2014-00194 with respect to the review of claims 2 and 11. Paper 46, 8.

CBM2014-00194 (Patent 8,118,221)

CBM2014-00199 (Patent 8,118,221)

On March 17, 2016, a teleconference was held between counsel for Petitioner Samsung Electronics America, Inc. and Samsung Electronics, Co., Ltd. and Patent Owner Smartflash LLC., and Judges Jennifer Bisk, Rama Elluru, and Jeremy Plenzler. The teleconference was transcribed at the request of Patent Owner.

In CBM2014-00194, we instituted a review of claims 2, 11 and 32 of U.S. Patent No. 8,118,221 (“the ’221 patent”). In CBM2014-00199, we instituted a review of claims 2 and 11 of the ’221 patent. We held the teleconference with the parties because claims 2 and 11, among other claims, were determined to be unpatentable in a Final Written Decision issued in CBM2014-00102, a decision which Patent Owner appealed to the Court of Appeals for the Federal Circuit. The Federal Circuit, however, has since dismissed this appeal. *See* CBM2015-00015, Ex. 2117; CBM2015-00015, Paper 58, 1. We, thus, asked for Petitioner’s and Patent Owner’s positions as to whether our review of the patentability of claims 2 and 11 in CBM2014-00194 and CBM2014-00199 is mooted by the dismissal of the appeal of the Final Written Decision in CBM2014-00102, and whether either party was seeking authorization to file a motion to terminate CBM2014-00194 and CBM2014-00199.

Petitioner indicated that it was not seeking authorization to file a motion to terminate these cases because there was a public interest in our issuing Final Written Decisions in these proceedings. Petitioner, however, also stated that it would not oppose a motion to terminate these proceedings by Patent Owner. In addition, Petitioner stated that a motion for adverse judgment by Patent Owner pursuant to 37 C.F.R. § 42.73 might be appropriate.

CBM2014-00194 (Patent 8,118,221)

CBM2014-00199 (Patent 8,118,221)

Patent Owner stated that it was seeking authorization to file a motion to terminate these proceedings and that it was not seeking a motion for adverse judgment.

Because we have previously determined in a Final Written Decision that claims 2 and 11 of the '221 patent are unpatentable, and the appeal of that determination has been dismissed, we granted Patent Owner authorization to file a motion to terminate these proceedings. Petitioner stated that it would not oppose the motion. Petitioner agreed to file its motion to terminate by March 18, 2016, or to let the Board know that it could not meet that deadline by the same date.

It is:

ORDERED that Patent Owner's request for authorization to file a motion to terminate CBM2014-00194 and CBM2014-00199 is granted;

FURTHER ORDERED that Patent Owner's motion to terminate shall be filed no later than March 18, 2016; and

FURTHER ORDERED that Patent Owner shall file the transcript of the March 17, 2016, in the records of CBM2014-00194 and CBM2014-00199.

CBM2014-00194 (Patent 8,118,221)

CBM2014-00199 (Patent 8,118,221)

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