

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2014-00194
Patent 8,118,221 B2

PATENT OWNER'S LIST OF PROPOSED MOTIONS

The Patent Trial and Appeal Board ("Board") has scheduled an initial conference call for Tuesday, May 5, 2015 at 2 PM. Pursuant to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012), Patent Owner submits the following list of proposed motions it is currently considering filing. This list is provided without prejudice to Patent Owner's right to seek authorization to file additional motions or to decide not to file the motions listed.

I. Motion for Routine Discovery

Patent Owner proposes to file a motion for routine discovery under 37 CFR 42.51(b)(1)(iii) to obtain documents from Petitioner related to any allegations by Petitioner (1) that any of Petitioner's products do not infringe any of the challenged claims and (2) that acceptable non-infringing alternatives exist to the challenged claims, including at least any expert report filed by Petitioner or on behalf of Petitioner in the on-going litigation with Patent Owner in Case No. 6:13-cv-448, *Smartflash LLC and SmartFlash Tehnologies Limited v. Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Samsung Telecommunications America, LLC, HTC Corporation, HTC America, Inc., Exedea, Inc., and Game Circus LLC*. Any such documents would be inconsistent with Petitioner's arguments that the challenged claims result in preemption as asserted by the Petition and should have been served with the Petition.

II. Motion for Stay of the Proceedings

Patent Owner presently proposes to file a Motion to Stay the proceedings in light of the District Court's ruling in favor of Patent Owner on patentability under 35 U.S.C. 101 in response to Petitioner's Motion for Summary Judgment in Case No. 6:13-cv-448, *Smartflash LLC and SmartFlash Tehnologies Limited v. Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Samsung Telecommunications America, LLC, HTC Corporation, HTC America, Inc., Exedeia, Inc., and Game Circus LLC*.

In addition, Patent Owner notes that Petitioner has recently filed requests for rehearing in CBM2014-00200 and -00204. Should Patent Owner not file a Motion to Stay the proceedings in light of the District Court's ruling in favor of Patent Owner on patentability under 35 U.S.C. 101, Patent Owner proposes to file a Motion to extend the due dates of the present proceedings by a time sufficient to allow the Board to rule on the requests for rehearing and coordinate the schedules of the present proceeding and CBM2014-00200 and -00204, should they be instituted, in order to allow for a single deposition of Petitioner's declarant, Dr. Bloom.

III. Additional Topics for Discussion at Initial Conference Call

A. Coordination of Other Proceedings

Patent Owner notes that the scheduled oral argument dates of (a) CBM2014-00190, -00192, -00193, -00194 and -00199 and (b) CBM2015-00015 through -00018 are currently set as October 29, 2015 and November 9, 2015, respectively. The proceedings for CBM2015-00015 through -00018 were instituted less than a month ago, and Patent Owner may seek in those proceedings to have the schedule of the present proceeding coordinated therewith.

B. Coordination of Deposition Transcripts

Petitioner has filed a declaration in this proceeding and in multiple other proceedings by the same declarant, Dr. Bloom. Patent Owner seeks the Board's permission (as it did in earlier CBM proceedings on patents in the same patent family) to allow a single deposition to be taken of the declarant (and future

Case CBM2014-00194
Patent 8,118,221 B2

declarants) such that a single deposition transcript can be used in all proceedings
(albeit filed separately in each proceeding).

Dated: May 1, 2015

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