

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

PATENT OWNER'S RESPONSE

TABLE OF CONTENTS

PATENT OWNER’S LIST OF EXHIBITS	iii
I. INTRODUCTION	1
II. STATEMENT OF MATERIAL FACTS	3
III. THE BLOOM DECLARATION SHOULD BE GIVEN LITTLE OR NO WEIGHT	3
A. No Evidentiary Standard Is Disclosed in the Bloom Declaration.....	3
B. Dr. Bloom Is Not a Disinterested Party	4
IV. OVERVIEW OF U.S. PATENT NO. 8,118,221	6
A. Overview of the Technology of the Patent	6
B. Claim Construction	9
V. THE CLAIMS ARE DIRECTED TO STATUTORY SUBJECT MATTER.....	11
A. The Two-Part Test for Statutory Subject Matter	11
B. The Claims Are Statutory Under the Second Step of <i>Mayo</i> and <i>Alice</i>	11
1. Claim 32	14
2. Claims 2 and 11.....	20
C. The Claims Do Not Result in Inappropriate Preemption.....	25
1. Preemption under <i>DDR Holdings</i>	25
2. Preemption under <i>Mayo</i> and <i>Alice</i>	28
3. Non-Infringing Alternatives Show a Lack of Preemption.....	30
D. Evidence Relied Upon by the Bloom Declaration Is Not from the Appropriate Timeframe.....	35

VI. PETITIONER HAS ALREADY LOST A CHALLENGE TO THE CLAIMS ON THE SAME STATUTORY GROUNDS IN ITS LITIGATION WITH PATENT OWNER36

VII. THE USPTO IS ESTOPPED FROM REVISITING THE ISSUE OF WHETHER THE CLAIMS ARE DIRECTED TO STATUTORY SUBJECT MATTER.....37

VIII. CONCLUSION.....38

PATENT OWNER'S LIST OF EXHIBITS

Exhibit Number	Exhibit Description
2001	Congressional Record - House, June 23, 2011, H4480-4505
2002	Congressional Record - Senate, Sep. 8, 2011, S5402-5443
2003-2023	Reserved
2024	Samsung's Motion To Stay Litigation Pending CBM Review
2025-2048	Reserved
2049	Report and Recommendation (on Defendants' Motions for Summary Judgment of Invalidity Pursuant to 35 U.S.C. 101), from <i>Smartflash LLC et al. v. Apple, Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.) and <i>Smartflash LLC et al. v. Samsung Electronics Co. Ltd, et al.</i> , Case No. 6:13-CV-448 (E.D. Tex.), dated Jan. 21, 2015
2050	Order adopting Report and Recommendation (on Defendants' Motions for Summary Judgment of Invalidity Pursuant to 35 U.S.C. 101), from <i>Smartflash LLC et al. v. Apple, Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.) and <i>Smartflash LLC et al. v. Samsung Electronics Co. Ltd, et al.</i> , Case No. 6:13-CV-448 (E.D. Tex.), dated Feb. 13, 2015
2051-2054	Reserved
2055	Deposition Transcript of Jeffrey A. Bloom dated May 19, 2015

2056	Non-Confidential Portion of Deposition Transcript of Jeffrey A. Bloom dated May 20, 2015
2057	Confidential Portion of Deposition Transcript of Jeffrey A. Bloom dated May 20, 2015
2058	Memorandum Opinion and Order (on Defendants' Motions for Stay Pending the Outcome CBMs) from <i>Smartflash LLC et al. v. Apple, Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.), <i>Smartflash LLC et al. v. Samsung Electronics Co. Ltd, et al.</i> , Case No. 6:13-CV-448 (E.D. Tex.), <i>Smartflash LLC et al. v. Google, Inc., et al.</i> , Case No. 6:14-CV-435 (E.D. Tex.), and <i>Smartflash LLC et al. v. Amazon, Inc., et al.</i> , Case No. 6:14-CV-992 (E.D. Tex.) dated May 29, 2015
2059-2062	Reserved
2063	Civil Docket Report from <i>Smartflash LLC et al. v. Samsung Electronics Co. Ltd, et al.</i> , Case No. 6:13-CV-448 (E.D. Tex.)
2064-2066	Reserved
2067	Declaration of Emily E. Toohey in Support of Patent Owner's Response

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.