

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

Petitioners,

v.

SMARTFLASH LLC,

Patent Owner.

Case CBM2014-00199

Patent 8,118,221 B2

PATENT OWNER'S MOTION TO TERMINATE

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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
2025-2054	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
2057	Redacted Public Version of the Deposition Transcript of Jeffrey A. Bloom dated May 20, 2015 Pursuant to Order, Paper 25.
2058-2097	Reserved
2098	Patent Owner's Objections to Admissibility of Evidence
2099-2116	Reserved
2117	<i>Smartflash LLC v. Apple Inc.</i> , Order, Cases 16-1435, -1445, 1446, 1447 (Fed. Cir. March 4, 2016)

I. INTRODUCTION AND STATEMENT OF PRECISE RELIEF REQUESTED

Patent Owner Smartflash LLC hereby moves to terminate this Covered Business Method Review (“CBM Review”) of U.S. Patent 8,118,221 (“the ‘221 Patent”) as moot. Smartflash was authorized to file this motion during a March 17, 2016 conference call with the Board. Paper 44 at 3.

By Final Written Decision in CBM2014-00102 dated September 25, 2015 the Board determined claims 2 and 11 of the ‘221 Patent to be unpatentable under 35 U.S.C. § 103. *Apple Inc. v. Smartflash LLC*, CBM2014-00102, Final Written Decision, Paper 52 at 43 (PTAB September 25, 2015). In this CBM Review of the ‘221 Patent, the Board instituted review of claims 2 and 11 under 35 U.S.C. § 102 as anticipated by Ginter. *Samsung Electronics America, Inc., et al., v. Smartflash LLC*, CBM2014-00199, Decision - Institution of Covered Business Method Patent Review 37 C.F.R. § 42.208, Paper 9 at 13 (PTAB March 30, 2015).

On March 4, 2016, pursuant to Fed. R. App. P. 42 (b), the United States Court of Appeals for the Federal Circuit dismissed Smartflash LLC’s appeal of the Board’s decision in CBM2014-00102 that claims 2 and 11 of the ‘221 Patent were unpatentable. Thus, claims 2 and 11 of the ‘221 Patent have been finally adjudicated to be unpatentable. The only issue here in CBM2014-00199 is the patentability of claims 2 and 11 of the ‘221 Patent, which is now moot. The Board

should therefore terminate trial on claims 2 and 11 of the '221 Patent without rendering a Final Written Decision pursuant to 37 C.F.R. § 42.72.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On a petition filed by Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd., the Board instituted Covered Business Method review of claims 2 and 11 of the '221 Patent on 35 U.S.C. § 102 grounds as anticipated by Ginter. CBM2014-00199, Paper 9 at 13.

On a petition filed by Apple Inc., on September 25, 2015 the Board issued a Final Written Decision pursuant to 35 U.S.C. § 328(a) finding claims 1, 2, and 11-14 of the '221 Patent invalid on 35 U.S.C. § 103 grounds in CBM2014-00102. CBM2014-00102, Paper 52 at 43.

On March 4, 2016, pursuant to Fed. R. App. P. 42 (b), the United States Court of Appeals for the Federal Circuit dismissed Smartflash LLC's appeal of the Board's decisions in CBM2014-00102 that claims 2 and 11 of the '221 Patent are unpatentable. Exhibit 2117, *Smartflash LLC v. Apple Inc.*, Order, Cases 16-1435, -1445, 1446, 1447 (Fed. Cir. March 4, 2016).

Thus, claims 2 and 11 of the '221 Patent have been finally adjudicated to be unpatentable. The issue of the patentability of claims 2 and 11 here is moot. The Board has authority under 37 C.F.R. § 42.72 to terminate this trial without rendering a Final Written Decision. Termination in this circumstance is consistent

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