

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 CBM2014-00200
Patent 8,336,772 B2

Before JENNIFER S. BISK, RAMA G. ELLURU, GREGG I.
ANDERSON, MATTHEW R. CLEMENTS, and PETER P. CHEN,
Administrative Patent Judges.

ANDERSON, *Administrative Patent Judge.*

DECISION
Petitioners' Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Samsung Electronics America, Inc. and Samsung Electronics Co. Ltd. (“Petitioner”) request rehearing (Paper 10, “Req. Reh’g”) of the Board’s Decision (Paper 9, “Dec.”) denying covered business method patent review of claims 5, 10, 14, 26, and 32 (“challenged claims”) of US Patent 8,336,772 B2 (’772 patent). In its Corrected Petition (Paper 4, “Pet.”), Petitioner alleged the challenged claims were all anticipated by Ginter (Ex. 1023) under 35 U.S.C. § 102. Pet. 4, 26–80.

In the Decision, the Board concluded Petitioner did not present sufficient evidence that Ginter disclosed “use rules” as recited in claims 25 and 30. Thus, Ginter does not anticipate challenged claims 26 and 32, which depend from claims 25 and 30. Claim 25 specifically recites the “use rules” limitation as follows:

code to read use status data and *use rules* from said non-volatile memory pertaining to said second selected one or more items of retrieved multimedia content; and

code to evaluate said use status data and *use rules* to determine whether access is permitted to said second selected one or more items of retrieved multimedia content. Emphasis added.

Ex. 1001, 30:27–34. In the Decision, we construed “use rule” as a rule specifying a condition under which access to content is permitted. Dec. 7.

The Board also concluded that Petitioner did not present sufficient evidence to support Petitioner’s contention that Ginter discloses “code to request identifier data identifying one or more items of multimedia content stored in the non-volatile memory” as recited in claim 1. Dec. 13–14. The

challenged claims all include the “code to request identifier data” limitation. *Id.* at 13–15.

As a result of the conclusions summarized above, the Board did not institute covered business method patent review of any of the challenged claims. Dec. 17. Petitioner requests reconsideration of our determination that Ginter does not disclose either of the following two limitations: (1) “use rules” (Req. Reh’g 3–6); and (2) “code to request identifier data” (Req. Reh’g 7–10).

Petitioner contends the grounds asserted in the Petition “were denied due to misapprehension or oversight of uncited Petition content that addressed features said to distinguish claims 5, 10, 14, 26, and 32 from Ginter.” Req. Reh’g 2. As to the “use rules” limitation, Petitioner alleges the Board “failed to address” pages 16–26 of the Petition. *Id.* at 4. Concerning the “code to request identifier data” limitation, Petitioner argues the Board overlooked explicit disclosure in Ginter cited in the Petition. *Id.* at 8.

II. ANALYSIS

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). The request for rehearing must identify, specifically, all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

A. Alleged Misapprehension or Oversight Relating to “use rules”

Petitioner presumes that the failure of the Decision to cite to or specifically address pages 16–26 of the Petition is the equivalent of “misapprehension or oversight.” Req. Reh’g 3–4. The Board, however, is not required to comb through the Petition and comment on every portion that

might have relevance to the decision. What is required is that the Petition “must specify where each element of the claim is found in the prior art.” 37 C.F.R. § 42.304(b)(4).

With the preceding in mind, the allegedly overlooked pages 16–26 of the Petition are all in a section under the heading “Overview of Ginter.” Pet. 16. The entire section lacks reference to any claim of the ’772 patent. Nothing in the overview section specifies where Ginter discloses any element of any specific claim. Thus, the overview section does not comply with what is required under 37 C.F.R. § 42.304(b)(4).

Beginning at page 26 of the Petition, under the heading “Ginter Anticipates claims 5, 10, 14, 26, and 32,” the Petition does attempt to point out where each claim element is allegedly present in Ginter. The anticipation section analyzes the challenged claims on an element-by-element basis, as required under our rules. Pet. 26–80. Pages 70–73 of the Petition address the “use rules” limitation of claim 25. Page 79 addresses summarily claim 30’s “use rules” limitation by referring to the analysis of claim 25. The Request for Rehearing acknowledges that the Decision focused exclusively on these pages. Req. Reh’g 3 (citing Dec. 16). Petitioner does not contend that we overlooked or misapprehended this portion of the Petition, which complied with our rules.

Even were we to consider the overview section on a substantive basis, our Decision would not change. Petitioner argues in the Request for rehearing that “access limits” described in the overview section specify a condition on which access to content is permitted, thus meeting our

construction of “use rules.” Req. Reh’g 5–6 (citing Pet. 25–27¹). The discussion on pages 25–27 relates to the “billing method MDE and budget method UDE being used to specify and enforce a condition under which access to content is permitted.” *Id.* This same argument was made in the anticipation section of the Petition and analyzed in the Decision. Dec. 16² (citing Pet. 71). Repeating arguments previously made does not establish a basis for rehearing.

B. Alleged Misapprehension or Oversight Relating to “code to request user identifier data”

Petitioner alleges the Board overlooked citations in the Petition to disclosure in Ginter of the “code to request identifier data” limitation. Req. Reh’g 8. Petitioner first cites to an annotated version of Figure 72D of Ginter and related argument from the Petition. *Id.* at 9 (citing Pet. 36). Petitioner acknowledges the Decision specifically discusses Figure 72D and accompanying disclosure in Ginter. What “may have been overlooked,” according to Petitioner, is the caption of Figure 72D, i.e., “YOU HAVE REQUESTED THESE PROPERTIES.” *Id.* Petitioner next contends we did not cite two relevant portions of Ginter that it alleges disclose the “code to request identifier limitation,” including: (1) “the user may begin manipulating and directing their user interface software to browse through a

¹ Page 27 is in the anticipation section, not the overview section. Nothing on page 27 discusses “access limits” disclosed by Ginter.

² “Petitioner does not explain sufficiently, however, why a price list (billing method map MDE) and/or limitations on information content usage (budget method UDE), for example, discloses, teaches, or suggests a rule specifying a condition under which access to content is permitted.” Dec. 16.

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