

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

PTAB Docket No. CBM2014-00204
Patent 8,336,772 B2

**Petitioner's Request for Rehearing Under
37 C.F.R. § 42.71(d)**

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I. INTRODUCTION

In declining to institute this Petition's grounds, the Board found the primary prior art reference (Gruse) unqualified as prior art against the '772 Patent. That is, contrary to arguments that were presented in the Petition, the Board awarded the '772 Patent with priority that was proclaimed on its face, and thereby disqualified Gruse as prior art. Petitioner respectfully submits that this determination was the product of misapprehension or oversight.

In more detail, the Institution Decision states that "Petitioner has [not] shown sufficiently that claim 1 is not entitled to the benefit of the GB application's filing date," due specifically to lack of showing of insufficient support for "code responsive to said user selection of said at least one selected item of multimedia content to transmit payment data relating to payment for said at least one selected item of multimedia content via said wireless interface for validation by a payment validation system," as incorporated into claims 5, 10, 14, 26, and 32 ("Challenged Claims"). *See* Institution Decision at 14-17.

Petitioner respectfully submits that, in reaching these conclusions, the Institution Decision misapprehended the written description requirement and consequently overlooked the importance of gaps (identified in the Petition) between the GB Application and these claim elements. Indeed, the Institution

Decision appears to have improperly injected an inference into the disclosure proffered by the priority document in order to fill gaps between that disclosure and the Challenged Claims. *See, e.g.*, Institution Decision at 15-16 (“The GB application further describes restricting access to the downloaded data (i.e. user selected data) based upon checked and validated payment data, *which reasonably conveys . . .* transmitting payment data to the payment validation system in response to the user selected data”) (emphasis added).

For a claim in a later-filed application to be entitled to the filing date of an earlier application, the earlier application must comply with the written description requirement of 35 U.S.C. § 112 ¶ 1. *See, e.g., Tronzo v. Biomet, Inc.*, 156 F.3d 1154 (Fed. Cir. 1998). As the Federal Circuit has explained “a description that merely renders the invention obvious does not satisfy the requirement.” *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (*en banc*). Rather, “the hallmark of written description is *disclosure . . . the test requires an objective inquiry into the four corners of the specification . . .* the specification must describe an invention understandable to [the] skilled artisan and show that the inventor actually invented the invention claimed.” *Id.* at 1351 (emphases added).

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