UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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SAMSUNG ELECTRONICS AMERICA, INC. and
SAMSUNG ELECTRONICS CO., LTD.,
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

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Case CBM2014-00204
Patent 8,336,772 B2

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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
Petitioner's 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 U.S. Patent 8,336,772 B2 ("the '772 patent").

In its Corrected Petition (Paper 4, "Pet."), Petitioner alleged the challenged claims were all either anticipated by Gruse (Ex. 1006) or would have been obvious over Gruse combined with other prior art. Pet. 3. Petitioner alleged Gruse was prior art under 35 U.S.C. § 102(a) because the date of its publication is before the earliest filing date to which the challenged claims are entitled. Pet. 17–21. Specifically, Petitioner alleged the '772 patent was not entitled to the filing date of a prior-filed UK Application No. 9925227.2 (Ex. 1008, "the GB Application"). *Id.*

In the Decision, the Board concluded Petitioner did not show sufficiently that claim 1 is not entitled to the benefit of the filing date of the GB Application. Dec. 17. The Board also concluded that the grounds asserted against all the challenged claims depended upon whether or not Gruse is prior art under 35 U.S.C. § 102(a). *Id.* at 17–18. Accordingly, the Petition was denied as to all challenged claims. *Id.*

In the Request for Rehearing, Petitioner contends we "misapprehended the written description requirement and consequently overlooked the importance of gaps (identified in the Petition) between the GB Application and these claim elements." Req. Reh'g 1.

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).

In the Decision, we determined that the limitation "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" (the "user selection limitation") found written description support in the GB Application. Dec. 15–16. Petitioner contends our conclusion was wrong and that the "Petition demonstrates that the GB Application fails to provide written description support for this limitation." Req. Reh'g 4–7.

In support of its contention, Petitioner first cites to portions of the Petition that "demonstrate that the GB Application fails to provide written support" for the user selection limitation. *Id.* at 4 (citing Pet. 19–21), 5 (citing Pet. 19–21), 5–6 n.1 (citing Pet. 20), 6 (citing Pet. 19–21). Petitioner also cites to portions of the Declaration of Dr. Jeffrey A. Bloom as supporting its argument. *Id.* at 6–7 (citing Ex. 1003 ¶¶ 116–119). Based on the preceding, Petitioner alleges the Petition demonstrated "gaps" between the claims and the GB Application, which have an importance that was overlooked "due to misapprehension of the written description requirement."

Id. at 1, 4. Petitioner cites the Federal Circuit's opinion in the *Ariad*[1] case for the law regarding the written description requirement. *Id.* at 2, 6, 7, 8.

Our Decision addressed all of the arguments Petitioner now cites as a basis for rehearing, including the alleged "gaps" between the GB Application and the argued limitations of claim 1 (Dec. 14–17 (citing Pet. 19–21)), and the Bloom Declaration paragraphs cited by Petitioner (*id.* at 17 n.11). The Decision applied the standard set forth in *Ariad*, determining that the GB Application "reasonably conveys to those skilled in the art that the inventor had possession" of the claimed subject matter, i.e., claim 1's user selection limitation. *Id.* at 15–16 (citing *Ariad,* 598 F.3d at 1351). The Decision also applied *Ariad* to the other limitation of claim 1[2] argued in the Petition, which is not raised specifically in the Request for Rehearing. *Id.* at 16–17.

We are not persuaded that we overlooked the importance of any of the argued "gaps." We compared the GB Application disclosure to each limitation of claim 1 identified by Petitioner in light of *Ariad*. Indeed, Petitioner does not argue that we omitted discussing any limitation it argued, rather that we should have determined that the "gaps" were of greater significance. The Request for Rehearing next restates an argument made in the Petition, that the GB Application addresses "access control responsive to validation, not to any code 'responsive to said user selection of said at least

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[1] *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010) (en banc).

[2] The Petition also argued the claim 1 limitation ". . . responsive to said code to control access permitting access to said at least one selected item of multimedia content" lacked written description support in the GB Application. Pet. 21.

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.'" Req. Reh'g 5 (citing Pet. 21). We were not persuaded by this argument in the first instance. Dec. 15–16.[3] Petitioner further argues that our reliance on *Ariad's* "reasonably conveys" standard is an acknowledgement that passages of the GB Application cited in the Decision lack adequate written description support. *Id.* at 6. Petitioner also argues that we "appear" to have misapprehended *Ariad* by "injecting an inference into the disclosure proffered by the priority document in order to fill a gap between that disclosure and the Challenged Claims." Req. Reh'g 8 (citing *Ariad*, 598 F.3d at 1352). Petitioner suggests that we used an obviousness analysis, which *Ariad* states does not satisfy the written description requirement. *Id.* Lastly, Petitioner cites to other portions of *Ariad* for the proposition that written description must be shown in the disclosure and that the determination is an objective inquiry based on what is disclosed in the "four corners of the specification from the perspective of a person of ordinary skill in the art." Req. Reh'g 7–8 (citing *Ariad*, 598 F.3d at 1351, 1353).

Ariad clearly states that "reasonably conveys" is the written description standard, the standard we applied in determining whether the GB Application provides written description support for the challenged claims.

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[3] We determined the GB Application's disclosure of "*restricting access to the downloaded data (i.e., user selected data)* based upon checked and validated payment data" reasonably conveyed, under *Ariad*, "*transmitting payment data to the payment validation system in response to the user selected data,*" as recited in claim 1. Dec. 15–16 (citing *Ariad*, 598 F.3d at 1351) (emphases added).

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