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Paper 59
Entered: March 18, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,[1]
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2015-00015
Patent 8,118,221 B2

Before JENNIFER S. BISK, RAMA G. ELLURU, JEREMY M. PLENZLER, and MATTHEW R. CLEMENTS, *Administrative Patent Judges.*

BISK, *Administrative Patent Judge*.

DECISION
Motion to Terminate
37 C.F.R. § 42.72

[1] Apple has been dismissed as a Petitioner. Paper 49, 8.

On April 10, 2015, we instituted a transitional covered business method patent review (Paper 23, "Institution Decision" or "Inst. Dec.") based upon Apple's assertion that claim 1 ("the challenged claim") is directed to patent ineligible subject matter under 35 U.S.C. § 101. Inst. Dec. 21. We subsequently dismissed Apple as a petitioner in this trial (Paper 49, 8) because Apple was the petitioner in CBM2014-00102 that resulted in a final written decision with respect to claim 1, the same claim challenged in this trial. *Id*. at 7; *see* 35 U.S.C. 325(e)(1) ("The petitioner in a post-grant review of a claim in a patent under this chapter that results in a final written decision under section 328(a), or the real party in interest or privy of the petitioner, may not request or maintain a proceeding before the Office with respect to that claim on any ground that the petitioner raised or reasonably could have raised during that post-grant review."). Thus, we determined that under 35 U.S.C. § 325(e)(1), Apple is estopped from participating further in this trial. *Id*. at 2–7.

Nonetheless, we decided to proceed to a Final Written Decision because § 325(e)(1) speaks to actions that may not be undertaken by Petitioner (or its real party in interest or privy). Paper 49, 5–6. On March 15, 2016, however, Patent Owner filed an authorized motion to terminate this proceeding stating that "[o]n March 4, 2016, pursuant to Fed. R. App. P. 42(b), the United States Court of Appeals for the Federal Circuit dismissed [Patent Owner's] appeal of [the final written decision in CBM2014-00102 determining] that claim 1 of the '221 Patent is unpatentable." Paper 58, 3.

We are persuaded that the particular facts of this proceeding now counsel termination. 37 C.F.R. § 42.72. Claim 1 of the '221 patent has been finally cancelled and any decision we might reach in this proceeding

regarding the patentability of this claim would be moot and purely advisory. We do not see how the just, speedy, and inexpensive resolution of every proceeding (37 C.F.R. § 42.1(b)) would be secured by rendering a final written decision in this case.

ORDER

Accordingly it is

ORDERED that Patent Owner's motion to terminate this proceeding is *granted*; and

FURTHER ORDERED that CBM2015-00015 is terminated.

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