

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner

v.

SMARTFLASH LLC,
Patent Owner

Case CBM2015-00015
Patent 8,118,221 B2

**PETITIONER'S MOTION FOR JOINDER
UNDER 35 U.S.C. § 325(c) AND 27 C.F.R. § 42.222(b) OR, IN THE
ALTERNATIVE, FOR COORDINATION OF SCHEDULE, AND
REQUEST FOR SHORTENED RESPONSE TIME FOR
PATENT OWNER'S PRELIMINARY RESPONSE**

I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b), and as discussed during the Initial Conference Call with the Board on October 29, 2014 in CBM2014-00102 (“October 29 Call”), Petitioner Apple Inc. (“Petitioner”) hereby moves for joinder of the limited grounds raised in its new Petition for Covered Business Method Patent Review (“CBM”) of United States Patent No. 8,118,221 (“the ’221 patent”)—filed concurrently with this Motion—with the already-instituted CBMs for the ’221 patent, *Apple Inc. v. Smartflash LLC*, CBM2014-00102 and -00103, which involve the same parties and have been consolidated as CBM2014-00102. In the alternative, if the Board does not grant joinder, Petitioner requests that the Board coordinate the schedules of each proceeding such that, at minimum, the oral arguments (if requested) occur at the same time, facilitating entry of concurrent Final Written Decisions.

In conjunction with this request for joinder or, alternatively, coordination, Petitioner respectfully requests that the Board specify a shortened response period of six (6) weeks (until December 11, 2014) in which Patent Owner Smartflash LLC (“Patent Owner”) may file a Preliminary Response to the Petition. As confirmed with the Board during the October 29 Call, Petitioner will shortly submit a proposed schedule for coordinating these proceedings after conferring with counsel for Patent Owner Smartflash LLC (“Patent Owner”) to determine whether agreement on a proposed schedule can be reached between the parties.

II. STATEMENT OF MATERIAL FACTS

1. On March 28, 2014, Petitioner filed two petitions for CBM review of the '221 patent for claims 1, 2, 11-14, and 32. *See* CBM2014-00102 and -00103, Paper 2.

2. On September 30, 2014 the Board instituted trial in both of those proceedings on claims 1, 2, and 11-14 for grounds under 35 U.S.C. § 103, and consolidated the CBMs. *Id.*, Paper 8 at 24-25.

3. The primary prior art relied on for the grounds instituted in CBM2014-00102 is Stefik, including in light of Poggio (Ex. 1016).¹ *Id.* at 24. The primary prior art reference for the grounds instituted in CBM2014-00103 is Ginter (Ex. 1215). *Id.*

4. The same patent, Petitioner, and Patent Owner are involved in the already-instituted CBMs (now consolidated as CBM2014-00102) and the new Petition filed concurrently with this Motion, and it is Petitioner's understanding that the same counsel for each party from the already-instituted CBMs will represent Petitioner and Patent Owner in the new Petition proceedings.

5. The new Petition challenges on prior art grounds one claim—claim 32—that Petitioner had challenged in the earlier petitions, but that was not instituted for trial. *See id.* at 17-24.

¹ As discussed in the Petition, "Stefik" refers to two documents that Petitioner submits should be considered a single reference—Stefik '980 (Ex. 1214) and Stefik '235 (Ex. 1213), which incorporates Stefik '980 by reference.

6. In particular, the new Petition asserts grounds based on 35 U.S.C. § 103 for claim 32 using a combination of Stefik and Poggio (which were cited in combination by Petitioner and instituted for trial in CBM2014-00102) with the addition of two new references, Kopp (Ex. 1210) and Smith (Ex. 1219). (One prior art ground in the Petition is based on Stefik in view of Poggio and Kopp; the other ground simply adds Smith to this combination.)

7. The new Petition also asserts one ground of invalidity based on 35 U.S.C. § 101 for claim 32, as well as for claims 1, 2 and 11 that have been instituted for trial in CBM2014-00102.

8. Petitioner relies in its new Petition on a supporting declaration from the same expert who submitted a declaration in the already-instituted CBMs.

III. DISCUSSION

The requested joinder will serve to secure the just, speedy, and inexpensive resolution of these proceedings. Under 35 U.S.C. § 325(c):

If more than 1 petition for a post-grant [or covered business method] review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant [or covered business method] review.

In addition, 37 C.F.R. § 42.222(b) provides that “[j]oinder may be requested by a pa-

tent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any post-grant [or covered business method] review for which joinder is requested.” This Motion is timely under § 42.222(b) because Petitioner is filing it within one month after the September 30, 2014 institution date for the already-instituted CBMs.

The Board has further provided that a motion for joinder should: (1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule of the existing proceeding; and (4) address specifically how briefing and discovery may be simplified. *See, e.g., Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013). Analysis of these factors here warrants the Board’s use of its discretion to grant the requested joinder.

The existence of several similarities between the already-instituted CBMs (consolidated as CBM2014-00102) and the new Petition supports application of joinder. The same patent, parties, and counsel are involved in both proceedings. The same expert for Petitioner is involved in both proceedings—and, presumably, Patent Owner may use a common expert in both proceedings. Overlapping claims are at issue in both proceedings—on grounds for § 103 in the already-instituted CBMs and for § 101 in the new Petition. Patent Owner has already responded to, and the Board has already analyzed for institution, two prior petitions challenging every claim now at issue

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.