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

PATENT OWNER'S
REQUEST FOR REHEARING,
RENEWED REQUEST FOR LEAVE TO FILE MOTION TO TERMINATE,
AND CONDITIONAL REQUEST FOR ORAL HEARING

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I. INTRODUCTION AND STATEMENT OF PRECISE RELIEF REQUESTED

Patent Owner Smartflash LLC hereby requests rehearing pursuant to 37 C.F.R. § 42.71(d) of certain aspects the Board's November 4, 2015 *Order – Conduct of the Proceedings 37 C.F.R. § 42.5*. CBM2015-00015, Paper 49. Patent Owner also hereby renews its request for leave to file a Motion to Terminate CBM2015-00015 instituted on claim 1 of U.S. Patent 8,118,221 ("the '221 Patent"), in light of Petitioner Apple's 35 U.S.C. § 325(e)(1) estoppel confirmed by the Board. CBM2015-00015, Paper 49 at 4-5, 7-8. Finally, in the event that the Board does not permit rehearing and/or does not grant Patent Owner leave to file a Motion to Terminate, Patent Owner requests that it be granted an oral hearing in CBM2015-00015.

II. STATEMENT OF REASONS FOR THE RELIEF REQUESTED

On petitions filed by Apple Inc., the Board instituted Covered Business Method review on 35 U.S.C. § 101 grounds of claim 1 only of the '221 Patent in CBM2015-00015 (CBM2015-00015, Paper 23 at 21-22), on claims 1, 6, 8, and 10 in CBM2015-00016[1] (CBM2015-0016, Paper 23 at 26) and on claim 18 only of the '317 Patent in CBM2015-00018 (CBM2015-00018, Paper 15 at 14).

[1] The Board also instituted review of claim 11 under 35 U.S.C. §112, second paragraph in CBM2015-00016.

Also on petitions filed by Apple Inc., on September 25, 2015 the Board issued final written decisions, pursuant to 35 U.S.C. § 328(a), finding certain claims invalid on 35 U.S.C. § 103 grounds in CBM2014-00102 (claims 1, 2, and 11-14 of the '221 Patent (CBM2014-00102, Paper 52 at 43)); CBM2014-00106 (claim 1 of the '458 Patent, (CBM2014-00106, Paper 52 at 31)); and CBM2014-00112 (claims 1, 6-8, 12, 13, 16, and 18 of the '317 Patent (CBM2014-00112, Paper 48 at 29)).

Thus, for claim 1 of the '221 Patent in CBM2015-00015, claim 1 of the '458 Patent in CBM2015-00016, and claim 18 of the '317 Patent in CBM2015-00018, as of September 25, 2015 Apple was a petitioner in CBM proceedings on claims for which the Board had issued a final written decision under 35 U.S.C. § 328(a) in CBM2014-00102, -00106, and -00112 on petitions brought by Apple.

By Order dated October 9, 2015, the Board requested briefing on whether Apple was estopped from arguing the § 101 unpatentability of claim 1 of the '221 Patent in CBM2015-00015 and claim 1 of the '458 Patent in CBM2015-00016 in then-upcoming hearings on November 9, 2015. CBM2015-00015, Paper 42; CBM2015-00016, Paper 42. The Board did not request briefing on the estoppel impact of the final written decision in CBM2014-00112 as to claim 18 in CBM2015-00018.

The parties submitted briefs in response to the Board's October 9, 2015 Order. Smartflash argued that Apple was estopped from maintaining its CBMs pursuant to 35 U.S.C. § 325(e)(1) and requested leave to file a Motion to Terminate CBM2015-00015 and CBM2015-00016 as to claim 1. CBM2015-00015, Paper 45 at 1-2; CBM2015-00016, Paper 46 at 1-2.

By Order dated November 4, 2015, the Board agreed with Smartflash's estoppel position, determining that:

> § 325(e)(1) is applicable to Apple with respect to claim 1 of the '221 [in CBM2015-00015] patent and claim 1 of the '458 patent [in CBM2015-00016]. Apple was the petitioner in CBM2014-00102, which resulted in a final written decision with respect to claim 1 of the '221 patent and in CBM2014-00106, which resulted in a final written decision with respect to claim 1 of the '458 patent. CBM2014-00102, Paper 52, 43; CBM2014-00106, Paper 52, 31. Thus, pursuant to § 325(e)(1), Apple cannot "request or maintain" a proceeding before the Office with respect to these claims "on any ground" that Apple "raised or reasonably could have raised" during CBM2014-00102 and CBM2014-00106.

CBM2015-00015, Paper 49 at 3; CBM2015-00016, Paper 50 at 3; CBM2015-00018, Paper 37 at 3. The Board further determined that:

> Apple "reasonably could have raised" a § 101 challenge to claim 1 of the '221 patent and claim 1 of the '458 patent. Thus, § 325(e)(1) is applicable to these claims.

Id. at 4. Moreover, the Board found that:

> Apple also was the petitioner in CBM2014-00112 that resulted in a final written decision with respect to the

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