

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2015-00016
Patent 8,033,458 B2

PATENT OWNER'S LIST OF PROPOSED MOTIONS

The Patent Trial and Appeal Board ("Board") has scheduled an initial conference call for Tuesday, May 11, 2015 at 2 PM. Pursuant to the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48765-66 (Aug. 14, 2012), Patent Owner submits the following list of proposed motions it is currently considering filing. This list is provided without prejudice to Patent Owner's right to seek authorization to file additional motions or to decide not to file the motions listed.

I. Motion for Routine Discovery

Patent Owner proposes to file a motion for routine discovery under 37 CFR 42.51(b)(1)(iii) to obtain at least one document from Petitioner related to any allegations by Petitioner (1) that any of Petitioner's products do not infringe any of the challenged claims and (2) that acceptable non-infringing alternatives exist to the challenged claims, including at least Mr. Wechselberger's report on non-infringement and non-infringing alternatives from the litigation with Patent Owner in Case No. 6:13-cv-447, *Smartflash LLC and SmartFlash Technologies Limited v. Apple Inc., Robot Entertainment, Inc., Kingsisle Entertainment, Inc., and Game Circus LLC* ("the Apple litigation). Any such document would be inconsistent with Petitioner's arguments that the claims provide relative preemption sufficient to invoke a finding of non-statutory subject matter under 35 USC 101.

By way of background, in the Apple litigation, the District Court held a Dispositive Motions Hearing on December 2, 2014 for which there is an unsealed transcript of a portion of the hearing. A portion of the hearing related to a report by Mr. Wechselberger, Petitioner's expert in both the litigation and this proceeding, on non-infringing alternatives to the claims, but the report itself is sealed such that Patent Owner's counsel in this proceeding do not have access to it. As established in the unsealed transcript, during the hearing, Patent Owner's counsel discussed the general nature of at least four alternatives proposed in Mr. Wechselberger's report, but the specific details of the report were not provided. The proposed alternatives discussed in the transcript include (1) providing content to a user on credit and performing payment validation at a later time, (2) manually inputting payment distribution information rather than reading it from a data store, (3) preloading a number of popular apps instead of downloading them from an application store, and (4) playing previously downloaded content on only when there is an active Internet connection.

II. Motion for Extension of the Due Dates of the Proceedings

If Patent Owner is unsuccessful in negotiating an extension of due dates 1 and 2 with Petitioner, Patent Owner intends to seek a modification of the schedule to accommodate the fact that due date 1 (for the Patent Owner response) is

Case CBM2015-00016
Patent 8,033,458 B2

currently set as June 10, 2015, the day after the hearing in the first round cases (CBM2014-00102, -00106, -00108 and -00112) by the same Petitioner.

III. Coordination of Deposition Transcripts

Petitioner has filed a declaration in this proceeding and in multiple other proceedings by the same declarant, Mr. Wechselberger. Patent Owner seeks the Board's permission (as it did in earlier CBM proceedings on patents in the same patent family) to allow a single deposition to be taken of the declarant (and future declarants) such that a single deposition transcript can be used in all proceedings (albeit filed separately in each proceeding).

Dated: May 7, 2015

/ Michael R. Casey /

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that this PATENT OWNER'S LIST OF PROPOSED MOTIONS in CBM2015-00016 was served today, May 7, 2015, by agreement of the parties by emailing a copy to counsel for the Petitioner as follows:

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