

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 RESPONSE

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PATENT OWNER'S LIST OF EXHIBITS

Exhibit Number	Exhibit Description
2001	Reserved
2002	Redline Showing "Corrected Petition" Compared to Original Petition in CBM2015-00016
2003	Reserved
2004	Congressional Record - House, June 23, 2011, H4480-4505
2005	Congressional Record - Senate, Sep. 8, 2011, S5402-5443
2006-2048	Reserved
2049	Report and Recommendation (on Defendants' Motions for Summary Judgment of Invalidity Pursuant to 35 U.S.C. § 101), from <i>Smartflash LLC, et al. v. Apple Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.) and <i>Smartflash LLC, et al. v. Samsung Electronics Co. Ltd, et al.</i> , Case No. 6:13-CV-448 (E.D. Tex.), dated Jan. 21, 2015
2050	Order adopting Report and Recommendation (on Defendants' Motions for Summary Judgment of Invalidity Pursuant to 35 U.S.C. § 101), from <i>Smartflash LLC, et al. v. Apple Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.) and <i>Smartflash LLC, et al. v. Samsung Electronics Co. Ltd, et al.</i> , Case No. 6:13-CV-448 (E.D. Tex.), dated Feb. 13, 2015
2051-2057	Reserved

2058	Memorandum Opinion and Order (on Defendants' Motions for Stay Pending the Outcome of CBMs) from <i>Smartflash LLC, et al. v. Apple Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.), <i>Smartflash LLC, et al. v. Samsung Electronics Co. Ltd, et al.</i> , Case No. 6:13-CV-448 (E.D. Tex.), <i>Smartflash LLC, et al. v. Google, Inc., et al.</i> , Case No. 6:14-CV-435 (E.D. Tex.), and <i>Smartflash LLC, et al. v. Amazon, Inc., et al.</i> , Case No. 6:14-CV-992 (E.D. Tex.) dated May 29, 2015
2059-2067	Reserved
2068	Deposition Transcript of Anthony J. Wechselberger dated May 28, 2015
2069	Reserved
2070	Declaration of Emily E. Toohey in Support of Patent Owner's Response
2071-2072	Reserved
2073	Apple's Preliminary Claim Constructions and Extrinsic Evidence filed in <i>Smartflash LLC, et al. v. Apple Inc., et al.</i> , Case No. 6:13-cv-447-MHS-KNM (E.D. Tex.)
2074	Civil Docket Report from <i>Smartflash LLC, et al. v. Apple Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.)

I. INTRODUCTION

Covered business method review was instituted for U.S. Patent 8,033,458 (“the ‘458 Patent”) claims 1, 6, 8, and 10 as being directed to patent-ineligible subject matter under 35 U.S.C. § 101; and claim 11 as being indefinite under 35 U.S.C. § 112, second paragraph. *Decision - Institution of Covered Business Method Patent Review and Denying Motion for Joinder* 37 C.F.R. § 42.208 37 C.F.R. § 42.222(b), Paper 23 at 26 (PTAB April 10, 2015).

Claims 1, 6, 8, and 10 of the ‘458 Patent are directed to statutory subject matter because they claim a solution “necessarily rooted in computer technology in order to overcome a problem specifically arising in the realm of computer networks.” *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245, 1257 (Fed. Cir. 2014). In particular, claims 1, 6, 8, and 10 of the ‘458 Patent address the problem of data content piracy on the Internet “[b]y combining digital rights management with content data storage using a single carrier” such that “the stored content data becomes mobile and can be accessed anywhere while retaining control over the stored data for the data content provider or data copyright owner.” Ex. 1201, ‘458 Patent at 5:29-33. In other words, claims 1, 6, 8, and 10 of the ‘458 Patent are directed to a system that combines on the data carrier both the digital content and the use rules/use status data, so that access control to the digital content can be continuously enforced prior to each access to the digital content.

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