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Paper 42
Entered: October 9, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,
v.
SMARTFLASH LLC,
Patent Owner.

CBM2015-00015 (Patent 8,118,221 B2)
CBM2015-00016 (Patent 8,033,458 B2)

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

BISK, *Administrative Patent Judge*.

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

On October 2, 2015, we issued an order for a consolidated hearing on November 9, 2015, including a first session that covers the proceedings listed above, CBM2015-00015 and CBM2015-00016, along with CBM2015-00017 and CBM2015-00018, and a second session that covers CBM2014-00192, CBM2014-00193, CBM2014-00194, and CBM2014-00199. CBM2015-00015, CBM2014-00194, and CBM2014-00199 involve U.S. Patent No. 8,118,221 B2 ("the '221 patent"). CBM2015-00016 and CBM2014-000192 involve U.S Patent No. 8,033,458 B2 ("the '458 patent").

The claim under review in CBM2015-00015 is claim 1 of the '221 patent and the claims under review in CBM2015-00016 are claims 1, 6, 8, 10, and 11 of the '458 patent. CBM2015-00015, Paper 23 ("Dec."), 21–22; CBM2015-00016, Paper 23. The patentability of these claims is the subject of the oral hearing for these cases.

CBM2015-00015 is based on a petition brought by Apple. On September 25, 2015, we issued a final written decision in CBM2014-00102 concluding that claims 1, 2, and 11–14 of the '221 patent are unpatentable. CBM2014-00102, Paper 52, 43. CBM2014-00102 also was based on a petition brought by Apple. CBM2015-00016 is also based on a petition brought by Apple. On September 25, 2015, we issued a final written decision in CBM2014-00106 concluding that claim 1 of the '458 patent is unpatentable. CBM2014-00106, Paper 52, 31. CBM2014-00106 also was based on a petition brought by Apple.

35 U.S.C. § 325(e)(1) states:

> 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 reasonable could have raised ruing that post-grant review.

Based on this statutory language, we request briefing by the parties regarding whether Apple is estopped from arguing claim 1 of the '221 patent and claim 1 of the '458 patent at the November 9 hearing. If a party's position is that Apple is not estopped from arguing with respect to those claims, the briefing should address whether there are any restrictions on our use of Apple's arguments at the November 9 hearing in our final written decision in CBM2015-00015 or CBM2015-00016. Thus, we order Apple and Smartflash to file separate briefs, not exceeding seven pages, no later than October 21, 2015 describing their positions on these issues.

ORDER

Accordingly, it is:

ORDERED that Apple and Smartflash are each ordered to file a brief, not exceeding seven pages, as described above, no later than October 21, 2015.

CBM2015-00015 (Patent 8,118,221 B2)
CBM2015-00016 (Patent 8,033,458 B2)

PETITIONER:

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