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Paper 28, CBM2015-00015
Paper 28, CBM2015-00016
Paper 27, CBM2015-00017
Paper 20, CBM2015-00018
Entered: May 13, 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)
CBM2015-00017 (Patent 8,061,598 B2)
CBM2015-00018 (Patent 7,942,317 B2)¹

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

ELLURU, *Administrative Patent Judge.*

ORDER

¹ This order addresses issues that are the same in all identified cases. We exercise our discretion to issue one order to be filed in each case. The parties, however, are not authorized to use this style heading in subsequent papers, except the filing of the transcript for this teleconference.

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An initial teleconference was held in these cases on May 11, 2015, among respective counsel for Petitioner Apple, Inc. (“Apple”), Patent Owner Smartflash LLC (“Smartflash”), and Judges Elluru, Bisk, Plenzler, and Clements. A court reporter transcribed the teleconference at the request of Smartflash. Apple and Smartflash submitted lists of proposed motions. Papers 26 and 27.²

As noted, Apple already has authorization to file motions for *pro hac vice* admission. Paper 7.

Patent Owner requested authorization to file a motion for “routine discovery” under 37 C.F.R. § 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 challenge claims.” Paper 27. Smartflash argued that such documents are inconsistent with Apple’s argument that the claims provide relative preemption sufficient to invoke a finding of non-statutory subject matter under 35 U.S.C. § 101. *Id.* We decided that Apple’s alleged evidence of non-infringement and non-infringing alternatives in the district court is not inconsistent with Apple’s assertion in these cases that the challenged claims are unpatentable under 35 U.S.C. § 101.

As Apple stated, the question of whether the challenged claims preempt a field under the § 101 analysis is a question of “relative” preemption. Limiting an abstract idea to a particular technological

² Paper numbers refer to papers in CBM2015-00015.

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environment, specific field of use, or adding token post-solution activity does not make an abstract concept patentable. *See Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat'l Ass'n*, 776 F.3d 1343, 1348 (Fed. Cir. 2014) (holding that using a scanner and a computer at most limits the abstract idea of recognizing and storing information from hard copy documents to a particular technological environment and is insufficient to save a claim from unpatentability under § 101); *Parker v. Flook*, 437 U.S. 584, 590 (1978) (“A competent draftsman could attach some form of post-solution activity to almost any mathematical formula . . .”), 593 (allowing determination of patent-eligibility to depend on draftsman’s art would not serve the principles underlying the prohibition against patents for abstract ideas). Smartflash did not point us to any authority that an accused infringer who pleads in the alternative that the challenged claims are unpatentable under § 101, a question of law, is taking an inconsistent position with its non-infringement position. In addition, to the extent that Apple’s assertion of non-infringement in district court is inconsistent with its assertion in these cases that the challenged claims are unpatentable under § 101, we determine that Smartflash is in possession of the relevant evidence of the alleged inconsistency. Specifically, Smartflash has the evidence that Apple took such allegedly inconsistent positions. We are not persuaded that the details of Apple’s non-infringement positions shed light on the § 101 issue.

The parties next informed us that they reached an agreement as to extending Due Dates 1 and 2. The parties shall file a stipulation indicating the new dates for Due Dates 1 and 2.

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Lastly, the parties agreed to take a single deposition of any declarant in all related cases such that a single deposition transcript can be used in all related proceedings, but filed separately in each proceeding. We are amenable to that agreement.

It is:

ORDERED that Smartflash shall file the transcript of the present teleconference in each of the cases identified above;

FURTHER ORDERED that Smartflash is not authorized to file a motion to compel routine discovery; and

FURHTER ORDERED that the parties shall file a stipulation in each of these cases indicating the new dates for Due Dates 1 and 2.

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