

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC.,  
Petitioner,

v.

SMARTFLASH LLC,  
Patent Owner.

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Case CBM2015-00018

Patent 7,942,317 B2

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**PATENT OWNER'S MOTION TO TERMINATE**

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## PATENT OWNER'S LIST OF EXHIBITS

Exhibit Number	Exhibit Description
2001-2003	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
2069-2071	Reserved
2072	Declaration of Emily E. Toohey in Support of Patent Owner's Response
2073	Reserved
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.)
2075-2101	Reserved
2102	Objections to Admissibility of Evidence
2103-2116	Reserved
2117	<i>Smartflash LLC v. Apple Inc.</i> , Order, Cases 16-1435, -1445, 1446, 1447 (Fed. Cir. March 4, 2016)

## I. INTRODUCTION AND STATEMENT OF PRECISE RELIEF REQUESTED

Patent Owner Smartflash LLC hereby moves to terminate this Covered Business Method Review (“CBM Review”) of claim 18 of U.S. Patent 7,942,317 (“the ‘317 Patent”) as moot. On March 10, 2016, the PTAB authorized (via an e-mail from Maria Vignone, PTAB Paralegal Operations Manager) Smartflash to file this motion by March 16, 2016.

By Final Written Decision in CBM2014-00112 dated September 25, 2015 the Board determined claim 18 of the ‘317 Patent to be unpatentable under 35 U.S.C. § 103. *Apple Inc. v. Smartflash LLC*, CBM2014-00112, Final Written Decision, Paper 48 at 29 (PTAB September 25, 2015). In this CBM Review of claim 18 of the ‘317 Patent under 35 U.S.C. § 101, by Order dated November 4, 2015, the Board determined that the estoppel provision of 35 U.S.C. § 325(e)(1) is applicable to Apple and dismissed Apple as a party. *Apple Inc. v. Smartflash LLC*, CBM2015-00018, Order, Paper 37 at 3, 8 (PTAB November 4, 2015). On March 4, 2016, pursuant to Fed. R. App. P. 42 (b), the United States Court of Appeals for the Federal Circuit dismissed Smartflash LLC’s appeal of the Board’s decision in CBM2014-00112 that claim 18 of the ‘317 Patent was unpatentable. Thus, claim 18 of the ‘317 Patent has been finally adjudicated to be unpatentable. The only issue here in CBM2015-00018 is the eligibility of claim 18 of the ‘317 Patent,

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