

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

SMARTFLASH LLC,

Patent Owner.

Case CBM2015-00018

Patent 7,942,317 B2

PATENT OWNER'S RESPONSE

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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.)

I. INTRODUCTION

Covered business method review was instituted for U.S. Patent 7,942,317 (“the ‘317 Patent”) claim 18 as being directed to patent-ineligible subject matter under 35 U.S.C. § 101. *Decision - Institution of Covered Business Method Patent Review 37 C.F.R. § 42.208*, Paper 15 at 13 (PTAB April 10, 2015).

Claim 18 of the ‘317 Patent is directed to statutory subject matter because it claims 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, claim 18 of the ‘317 Patent addresses the problem of data content piracy on the Internet by providing for legitimate acquisition of content data by transmitting requested data to the requester after receiving payment data from the requester, and in connection with reading payment distribution information from a data store. Ex. 1201, ‘317 Patent at 28:24-33.

As demonstrated below, claim 18 of the ‘317 Patent does not result in inappropriate preemption of the “idea of paying for data” (Petition, Paper 1 at 4) or the “idea of paying for and controlling access to content” (Ex. 1217, Declaration of Anthony J. Wechselberger (hereinafter “the Wechselberger Declaration”) at ¶ 66). Nor is there any evidence that a disproportionate amount of future innovation is foreclosed by claim 18 of the ‘317 Patent.

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