

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,

Petitioner,

v.

SMARTFLASH LLC,

Patent Owner.

Case CBM2015-00032

Patent 8,336,772

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S LIST OF EXHIBITS

Exhibit Number	Exhibit Description
2001	Congressional Record - House, June 23, 2011, H4480-4505
2002	Congressional Record - Senate, Sep. 8, 2011, S5402-5443
2003-2043	Reserved
2044	Declaration of Anthony Wechselberger in CBM2014-00110
2045	Declaration of Anthony Wechselberger in CBM2014-00111
2046	Patent Owner's Preliminary Response in CBM2014-00110
2047	Patent Owner's Preliminary Response in CBM2014-00111

Pursuant to 37 C.F.R. § 42.107, Smartflash LLC (“Patent Owner”) files this preliminary response to the corrected petition, setting forth reasons why no new covered business method review of U.S. Patent 8,336,772 should be instituted as requested by Apple, Inc. (“Apple” or “Petitioner”). Arguments presented herein are presented without prejudice to presenting additional arguments in a later response should the Board institute a CBM review.

I. INTRODUCTION

Petitioner Apple seeks covered business method (CBM) review of claims 14, 19, and 22 of U.S. Patent No. 8,336,772 (“the ‘772 Patent”). Paper 5 at 1 (“Corrected Petition”). Apple challenges claims 14, 19, and 22 on 35 U.S.C. §101 statutory subject matter grounds and § 103 obviousness grounds. Corrected Petition at 1, 16.

On April 3, 2014, Apple filed two earlier petitions, in CBM2014-00110 and -00111, also seeking CBM review of claims 14, 19, and 22 of the ‘772 Patent on § 103 obviousness grounds. The PTAB denied review of claims 14, 19, and 22 (among others) on § 103 obviousness grounds in both instances. *Apple Inc. v. Smartflash LLC*, Case CBM2014-00110 Paper 7, *Decision Denying Institution of Covered Business Method Patent Review* at 3, 19 (PTAB September 30, 2014) and Case CBM2014-00111, Paper 7, *Decision Denying Institution of Covered Business Method Patent Review* at 3, 21 (PTAB September 30, 2014).

Here, Apple re-raises its obviousness challenge to claims 14, 19, and 22, relying on five pieces of prior art: four of which (Stefik '235, Stefik '980, Poggio, and Sato) are the same prior art raised in both CBM2014-00110 and -00111; and one of which (Subler) is “additional prior art” Apple “now identifies” “in light of the Board’s Decision.” Corrected Petition at 2. Apple does not allege that Subler, a U.S. Patent issued in 1997, was not known or not available to it when it filed its earlier petitions.

The Board should again deny review of claims 14, 19, and 22 on Apple’s § 103 obviousness grounds because the Corrected Petition “raises substantially the same prior art or arguments previously presented” and rejected by the Board in CBM2014-00110 and -00111. See, *Unilever, Inc. v. The Proctor & Gamble Company*, Case IPR2014-00506, Paper 17 at 6 (PTAB July 7, 2014)(Decision, Denying Institution of *Inter Partes* Review)(quoting 35 U.S.C. § 325(d)). In fact, in the face of serial petitions by other Petitioners, the Board has already held that the Board’s “resources are better spent addressing matters other than [a Petitioner’s] second attempt to raise a plurality of duplicative grounds against the same patent claims.” *Conopco, Inc. dba Unilever v. The Proctor & Gamble Company*, Case IPR2014-00628, Paper 21 at 21 (PTAB October 20, 2014)(Decision, Declining Institution of *Inter Partes* Review).

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