

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAMSUNG ELECTRONICS AMERICA, INC. AND
SAMSUNG ELECTRONICS CO., LTD.,
Petitioner

v.

SMARTFLASH LLC,
Patent Owner

Case CBM2015-00059
Patent 8,336,772

**PETITIONER'S MOTION FOR JOINDER
UNDER 35 U.S.C. § 325(c) AND 27 C.F.R. § 42.222(b) OR, IN THE
ALTERNATIVE, FOR COORDINATION OF SCHEDULE, AND
REQUEST FOR SHORTENED RESPONSE TIME FOR
PATENT OWNER'S PRELIMINARY RESPONSE**

I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b), Samsung Electronics America, Inc. and Samsung Electronics Co., Ltd. (“Petitioner” or “Samsung”) hereby move for joinder of any proceeding resulting from its new Petition for Covered Business Method Patent Review (“CBM”) of United States Patent No. 8,336,772 (“the ’772 patent”)— filed concurrently with this Motion— with the earlier-filed but not-yet instituted CBMs for the ’772 patent, CBM2014-00200 and -00204, which involve the same parties. In the alternative, if the Board does not grant joinder, Petitioner requests that the Board coordinate the schedules of each proceeding such that, at minimum, the oral arguments (if requested) occur at the same time, facilitating entry of concurrent Final Written Decisions.

In conjunction with this request for joinder or coordination, Petitioner respectfully requests that the Board specify a shortened response period of four (4) to six (6) weeks (until February 12th or 26th) in which Patent Owner Smartflash LLC (“Patent Owner”) may file a Preliminary Response to the new Petition. Given the relationship of issues presented by this new Petition and those raised by Apple in co-pending proceedings which challenge the same claims under 35 U.S.C. § 101, as well as the relationship between issues presented by this new Petition and those raised by Samsung in its earlier Petitions which provide art grounds relied upon within the new Petition, the proposal for a shortened response

period does not impose an undue burden on Patent Owner. Rather, given its need to have already considered subject-matter eligibility responsive to the Apple petitions filed November 25, 2014, and its need to have already considered the overlapping nature of prior art when considering Samsung's previous Petitions filed September 26, 2014, the proposed response periods should be more than adequate for Patent Owner to furnish a Preliminary Response. Moreover, in establishing a deadline of February 12th or 26th, the Board will provide itself with more time before institution decisions are due for CBM2014-00200 and -00204 to consider any additional information furnished by Patent Owner in its Preliminary Responses to the new Petition, if any are raised.

Alternatively, if the Board declines to establish the proposed response deadline for the Preliminary Response, Petitioner nevertheless maintains its motion for joinder, and simply notes that the Board is under no obligation to coordinate its institution decision (or joinder decision) in the instant Petition with the institution decisions due in CBM2014-00200 and -00204.¹

¹ In CBM2014-00200 and -00204, Patent Owner filed its Preliminary Responses on January 6, 2015 and the Board's subsequent institution decisions and scheduling orders will, thus, be due no later than April 6, 2015, pursuant to 35 U.S.C. § 324(c).

II. STATEMENT OF MATERIAL FACTS

1. On September 26, 2014, Petitioner filed two petitions for CBM review of the '772 patent for claims 5, 10, 14, 26, 32. *See generally* CBM2014-00200 and -00204, Paper 4. These two petitions for CBM review challenged claims 5, 10, 14, 26, 32 of the '772 patent only on grounds pursuant to 35 U.S.C. §§ 102 and 103.

2. On October 6, 2014, Petitioner's two previous petitions for CBM review of the '772 patent (i.e., CBM2014-00200 and -00204) were accorded filing dates, and a due date of January 6, 2015 was set for Patent Owner's Preliminary Response. *See* CBM2014-00200 and -00204, Paper 3.

3. On November 25, 2014, Apple Inc. filed three petitions for CBM review of the '772 patent: CBM2015-00031, -00032, and -00033. As a whole, these three petitions asserted grounds of unpatentability of claims 1, 5, 8, 10, 14, 19, 22, 25, 26, 30, and 32 of the '772 patent (a superset of the claims challenged by Petitioner) under each of 35 U.S.C. §§ 101, 102, and 103.

4. On January 6, 2015, Patent Owner filed its Preliminary Responses in CBM2014-00200 and -00204. Accordingly, the deadline for the Board to issue institution decisions in each of CBM2014-00200 and -00204 does not expire until April 6, 2015.

5. As of the date Petitioner is concurrently filing its new Petition for Covered Business Method Patent Review ("CBM") of United States Patent No.

8,336,772 and this motion, the Board has not yet issued institution decisions in CBM2014-00200 or -00204.

6. Petitioner's new Petition for Covered Business Method Patent Review ("CBM") of United States Patent No. 8,336,772 challenges claims 5, 10, 14, 26, 32 of the '772 patent only on grounds pursuant to 35 U.S.C. § 101. In other words, Petitioner's new Petition for CBM challenges the same claims as Petitioner's two previous petitions for CBM review of the '772 patent (i.e., CBM2014-00200 and -00204), and while the new Petition challenges are pursuant to different statutory grounds, they rely upon prior art advanced in its earlier CBM filings.

III. **DISCUSSION**

The requested joinder will serve to secure the just, speedy, and inexpensive resolution of these proceedings. Under 35 U.S.C. § 325(c):

If more than 1 petition for a post-grant [or covered business method] review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant review under section 324, the Director may consolidate such reviews into a single post-grant [or covered business method] review.

In addition, 37 C.F.R. § 42.222(b) provides that "[j]oinder may be requested by a patent owner or petitioner. Any request for joinder must be filed, as a motion under § 42.22, no later than one month after the institution date of any post-grant

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