

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAMSUNG ELECTRONICS AMERICA, INC., and  
SAMSUNG ELECTRONICS CO., LTD.,

Petitioner,

v.

SMARTFLASH LLC,

Patent Owner

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Case CBM2015-00059

Patent 8,336,772 B2

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PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION FOR  
JOINDER UNDER 35 U.S.C. § 325(c) AND 37 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

Patent Owner hereby responds to PETITIONER'S MOTION FOR JOINDER UNDER 35 U.S.C. § 325(c) AND 37 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. In summary, Patent Owner submits that the Petition should be denied, rendering this Motion moot, as the Patent Owner will set out more fully in its Preliminary Response. However, should the Petition be granted in this case and in at least one of CBM2014-00200 and -00204, Patent Owner respectfully submits that a scheduling order should be set such that the schedule of the granted Petition in either CBM2014-00200 and/or -00204 be coordinated with this case, rather than the other way around. Patent Owner further opposes the Request for Shortened Response Time for Patent Owner's Preliminary Response as the first requested date (February 12, 2015) has already passed, and the second requested date (February 26, 2015) is in just over a week.

I. RESPONSE TO STATEMENT OF MATERIAL FACTS

1. The first sentence is admitted. The second sentence is denied as Paper 4 is not the Petition filed on September 26, 2014. The third sentence is denied.

See Paper 2, page 3 of Petition in CBM2014-00204.

2.-5. Admitted.

6. The first sentence is admitted. The second sentence is denied in light of Patent Owner's understanding of the phrase "while the new Petition challenges are pursuant to different statutory grounds, they rely upon prior art advanced in its earlier CBM filings." To the extent that this is intended to mean the same references are utilized in the present case as are used in CBM2014-00200 and -00204, such an assertion is incorrect. Exhibit 1039 is the last exhibit used or reserved in CBM2014-00200 and -00204. Therefore, for example, Exhibits 1040-1047 and 1064 are not from CBM2014-00200 and -00204.

## II. STATEMENT OF MATERIAL FACTS

7. The first due date (February 12, 2015) proposed by Petitioner for Patent Owner's Preliminary Response has already passed. See Motion, page 2.

8. The second due date (February 26, 2015) proposed by Petitioner for Patent Owner's Preliminary Response is only 8 days away from the filing date of this Opposition. See Motion, page 2.

9. A corrected Notice of Filing Date Accorded to Petition was not mailed until 8 days ago. See Paper 6.

10. In the month since the filing of the Petition, Petitioner has not sought a conference call with Patent Owner and the PTAB to discuss the shortened response time for Patent Owner's Preliminary Response.

11. Exhibits 1040-1047 and 1064 are not cited in CBM2014-00200.
12. Exhibits 1040-1047 and 1064 are not cited in CBM2014-00204.
13. Page 3 of the Petition in CBM2014-00204 states “Samsung requests a CBM review of the Challenged Claims on the grounds set forth in the table shown below, and requests that each of the Challenged Claims be found unpatentable.”
14. The table of page 3 of the Petition in CBM2014-00204 lists as its first entry “Ground 1 5, 10, 14, 26, 32 § 101”.
15. Page 3 of the Corrected Petition in CBM2014-00204 states “Samsung requests a CBM review of the Challenged Claims on the grounds set forth in the table shown below, and requests that each of the Challenged Claims be found unpatentable.”
16. The table of page 3 of the Corrected Petition in CBM2014-00204 lists as its first entry “Ground 1 5, 10, 14, 26, 32 § 101”.

### III. JOINDER AND/OR SCHEDULE COORDINATION

Patent Owner submits that the Petition should be denied, rendering this Motion moot, as the Patent Owner will set out more fully in its Preliminary Response. However, for the purposes of this Opposition, it is noted that Petitioner cannot show that the Petition meets the second prong of the analysis set out in *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (Apr. 24, 2013), as

cited by the Petition. Page 6 of the Petition cites *Kyocera* as requiring that the Motion for Joinder “identify any new grounds of unpatentability asserted in the petition.” In its analysis of the second prong of *Kyocera*, the Petition alleges that “Petitioner has not previously ... raised a ground of unpatentability under § 101 with regard to these claims.” Petition at 8. Similarly, the Petition alleges “Petitioner’s new Petition raises a different ground of unpatentability than was raised in Petitioner’s previous two Petitions.” Petition at 8-9. Such assertions are inconsistent with the facts.

As seen in page 3 of the Petition and the Corrected Petition in CBM2014-00204, Petitioner already raised the issue of unpatentability under § 101. CBM2014-00204, Papers 2 and 4, page 3. See Statement of Material Facts 13-16. Likewise, the PRPS system shows that patentability under § 101 was raised in CBM2014-00204. The only issue is whether Petitioner presented any *evidence* to support its previous allegation of unpatentability under 35 U.S.C. § 101. It did not, so there is no basis for instituting this “second bite at the apple” proceeding, let alone joining it or coordinating its schedule with a proceeding of at least one earlier filed Petition.

However, should the Petition be granted in this case and in at least one of CBM2014-00200 and -00204, Patent Owner respectfully submits that a scheduling order should be set such that the schedule of the granted Petition in CBM2014-

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