

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)

## I. INTRODUCTION

Patent Owner hereby opposes Petitioner's Motion for Joinder Under 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b).

This is Petitioner's second Motion for Joinder in this matter. The first Motion sought to join any proceeding resulting from its CBM2015-00059 petition with CBM2014-00200 and -00204. Paper 3 at 2. That Motion was rendered moot when the Patent Trial and Appeal Board ("PTAB") denied institution of covered business method review in those two cases. CBM2014-00200, Paper 9, *Decision, Denying Institution of Covered Business Method Patent Review 37 C.F.R. § 42.208*, (PTAB March 30, 2015); CBM2014-00204, Paper 9, *Decision, Denying Institution of Covered Business Method Patent Review 37 C.F.R. § 42.208*, (PTAB March 30, 2015).

Now Petitioner seeks to join CBM2015-00059 with covered business method review cases CBM2015-00031, -00032, and -00033 filed by Apple Inc. Motion, Paper 11 at 1.

The Board should deny the Motion for Joinder because (i) it is too late for the proposed joinder to provide the purported efficiencies Petitioner suggests; (ii) the cases are sufficiently different in terms of proffered exhibits and witnesses to gain any advantage by joinder; and (iii) the Board should exercise its discretion under 35 U.S.C. § 325(d) and decline to institute a covered business method patent

review of claims 5, 10, 14, 26, and 32 of U.S. Patent 8,336,772 on 35 U.S.C. § 101 grounds in CBM2015-00059 because it has already instituted covered business method review of those claims on the same grounds in CBM2015-00031, -00032, and -00033.

## **II. RESPONSE TO STATEMENT OF MATERIAL FACTS**

1 – 5. Admitted.

6. Patent Owner admits that “the claims challenged in the Samsung Petition [in CBM2015-00059] are ... a subset of the claims challenged in each of the three Apple CBM Proceedings [CBM2015-00031, -00032, and -00033]. Patent Owner denies that this “mak[es] it possible to comprehensively join grounds proposed by Samsung with grounds proposed by Apple.”

7. Admitted.

## **III. STATEMENT OF MATERIAL FACTS**

1. There has been no Institution Decision issued in CBM2015-00059.

2. Under Petitioner’s Proposal for Schedule with Joinder (Motion for Joinder, Paper 11 at 14), the proposed date for Patent Owner’s Response to Samsung’s Petition in CBM2015-00059 is July 29, 2015, the date this Opposition is due.

3. There is no overlap in witnesses proffered by Samsung in CBM2015-00059 (Dr. Jeffery Bloom and Mr. Steven Blumenfeld) with witnesses

proffered by Apple in CBM2015-00031, -00032, and -00033 (Mr. Anthony J. Wechselberger).

4. In support of its §101 petition, Samsung relies on Exhibits 1039-1047. Those Exhibits are not in CBM2015-00031, -00032, and -00033.

5. Petitioner Samsung already sought review of claims 5, 10, 14, 26, and 32 on § 101 grounds in CBM2014-00204.

6. The PTAB did not institute review of claims 5, 10, 14, 26, and 32 on § 101 grounds in CBM2014-00204.

#### IV. ARGUMENT

##### A. **It Is Too Late For The Proposed Joinder To Provide The Purported Efficiencies Petitioner Suggests.**

Petitioner claims that “[j]oinder is appropriate because ... it will promote efficient resolution of the validity of the ‘772 Patent.” Motion, Paper 11 at 1. Any efficiencies that *might have* existed at the time the CBM2015-00031, -00032, and -00033 were instituted on May 28, 2015, however, were squandered by Petitioner waiting until the very last allowable day (June 29, 2015) to file its Motion for Joinder. In the meantime, CBM2015-00031, -00032, and -00033 have proceeded through Patent Owner discovery to the point of Patent Owner’s Response being filed on July 29, 2015. Meanwhile, CBM2015-00059 has not had a decision on institution.

Petitioner Samsung posits that “[b]ecause grounds of unpatentability under § 101 are directed to legal issues, there is necessarily less discovery involved than would normally be involved with regard to grounds of unpatentability under §§ 102 and 103, which are directed to a larger factual inquiry.” Motion, Paper 11 at 9. While this is true in theory, it is belied by the fact that Samsung’s petition, limited only to the § 101 issue, is 66 pages, includes 65 Exhibits, and has supporting declarations from two witnesses. If CBM2015-00059 is instituted, there is a need for Patent Owner discovery.

Moreover, Petitioner’s proposed schedule is impractical. Under Petitioner’s Proposal for Schedule with Joinder (Motion for Joinder, Paper 11 at 14), the proposed date for Patent Owner’s Response to Samsung’s Petition in CBM2015-00059 is July 29, 2015, the date this Opposition is due. While Samsung proposes “reasonable accommodations” of providing “additional supplemental responses addressing peculiarities of the Samsung Petition” to be filed August 12, 2015, that is impractical. As noted, there has been no institution decision and thus no discovery conducted by Patent Owner. Also as noted, Samsung proffered two witness declarations from Dr. Jeffery Bloom and Mr. Steven Blumenfeld. These witnesses do not overlap with Apple’s witnesses. Patent Owner has a right to depose these witnesses. 37 CFR § 42.53. Clearly Samsung’s “reasonable

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