IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Hulst et al.	Attorney Docket No.: 104677-5008-824
U.S. Patent No.:	7,334,720	
Issue Date:	February 26, 2008	
Appl. Serial No.:	11/336,758	
Filing Date:	January 19, 2006	
Title:	DATA STORAGE AND ACCESS SYSTEMS	

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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MOTION FOR JOINDER
UNDER 35 U.S.C. § 325(c) AND 37 C.F.R. §§ 42.22 AND 42.222(b) AND
REQUEST FOR SHORTENED RESPONSE TIME FOR
PATENT OWNER'S PRELIMINARY RESPONSE

I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Apple Inc. ("Petitioner" or "Apple") respectfully requests joinder pursuant to 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222(b) of the concurrently filed Petition for Covered Business Method Review of U.S. Patent No. 7,334,720 ("the '720 Patent") ("Apple Petition") with pending Covered Business Method review, CBM2014-00190 ("Samsung CBM"), which was instituted by the Board on April 2, 2015. CBM2014-00190, Pap. 9.

Joinder is appropriate because it will promote efficient resolution of the validity of the '720 Patent, as the timely Apple Petition involves the same '720 patent, same claims at issue, and same § 101 grounds instituted in the Samsung CBM, while relying on the same arguments and evidentiary record.[1] No new grounds of unpatentability are asserted in the petition, and there will be at most a minimal impact on the trial schedule for the existing review; further, Apple identifies in Section III.D, below, procedures the Board may adopt to simplify briefing and discovery. Apple seeks to join the Samsung proceedings so that, if necessary, Apple can ensure that the proceedings on these claims continue in the event Samsung seeks to terminate them based on settlement or other factors.

[1] Apple's Exhibits are identical to their corresponding Samsung Exhibits, but have been re-stamped as "Apple" exhibits.

In conjunction with this request for joinder, Petitioner respectfully requests that, to the extent Patent Owner Smartflash LLC ("Smartflash" or "Patent Owner") determines to file a Preliminary Response despite the fact that the Apple Petition presents identical arguments, the Board specify a shortened response period of at most two (2) weeks (to May 14, 2015) . Petitioner has also requested a call with the Board to discuss scheduling for these proceedings, including the time for briefing on this Motion.

Petitioner also informed counsel for Patent Owner of its intent to seek joinder, and Patent Owner has indicated that it opposes.

II. STATEMENT OF MATERIAL FACTS

A. On September 26, 2014, petitioners Samsung Electronics America, Inc., Samsung Electronics Co., Ltd., and Samsung Telecommunications America, LLC ("Samsung") requested Covered Business Method review of claims 13 and 14 of the '720 patent under two grounds of unpatentability. CBM2014-00190, Pap. 2 (original), Pap. 4 (corrected).

B. The Patent Owner, listed as Smartflash LLC ("Smartflash" or "Patent Owner"), submitted a Preliminary Response on January 6, 2015. CBM2014-00190, Pap. 7.

C. In a decision dated April 2, 2015, the Board instituted Covered Business Method review on one of the two requested grounds, i.e., that Claims 13 and

14 are directed to patent ineligible subject matter under 35 U.S.C. § 101. CBM2014-00190, Pap. 9.

D. The Apple Petition that accompanies the present Motion for Joinder includes only this same ground of unpatentability that was instituted in the Samsung CBM for the '720 patent (CBM2014-00190).

E. Apple currently has pending a petition for review on § 101 grounds of Claims 3 and 13-15, which was according a filing date of November 24, 2014. CBM 2014-00029, Pap. 3; *see also id.*, Pap. 1 (original), Pap. 5 (corrected).

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

The Leahy-Smith America Invents Act ("AIA") permits joinder of Covered Business Method review ("CBM") proceedings. The statutory provision governing joinder of *post-grant* review proceedings (applicable to CBMs under AIA § 18(a)(1)) is 35 U.S.C. § 325(c), which reads as follows:

> (c) JOINDER.-- If more than 1 petition for a post-grant 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 review.

37 C.F.R. § 42.222(a) provides that, "[w]here another matter involving the patent is before the Office, the Board may during the pendency of the post-grant review enter any appropriate order regarding the additional matter including providing

for the stay, transfer, consolidation, or termination of any such matter." "The Board will determine whether to grant joinder on a case-by-case basis, taking into account the particular facts of each case, substantive and procedural issues, and other considerations." IPR2013-00385, Pap. 17 at 3 (citing 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl)). "The Board's rules for AIA proceedings 'shall be construed to secure the just, speedy, and inexpensive resolution of every proceeding.'" CBM2014-00115, Pap. 8 at 19 (citing 37 C.F.R. § 42.1(b); 77 Fed. Reg. at 48,758). And the Board should "also take into account the policy preference for joining a party that does not present new issues that might complicate or delay an existing proceeding." *See* IPR2013-00385, Pap. 17 at 10 (citing 157 CONG. REC. S1376 (daily ed. Mar. 8, 2011) (statement of Sen. Kyl) ("[Sections 315(c) and 325(c) allow joinder of inter partes and post-grant reviews.] The Office anticipates that joinder will be allowed as of right – if an inter partes review is instituted on the basis of a petition, for example, a party that files an *identical petition* will be joined to that proceeding, and thus allowed to file its own briefs and make its own arguments.") (emphasis added)).

The Board has identified a Representative Order, IPR2013-0004 Paper 15, regarding motions for joinder, which directs a movant to: (1) "explain the reasons why joinder is appropriate," (2) "identify any new ground of unpatentability being raised" in the petition, (3) explain how the impact on the schedule and costs of the current proceedings will be minimized, and (4) "specifically address how briefing

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