IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent of:	Hulst et al.	Attorney Docket No.: 104677-5008-826
U.S. Patent No.:	8,033,458	
Issue Date:	October 11, 2011	
Appl. Serial No.:	12/943,847	
Filing Date:	November 10, 2010	
Title:	DATA STORAGE AND ACCESS SYSTEMS	

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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. 8,033,458 ("the '458 Patent") ("Apple Petition") with pending Covered Business Method review, CBM2014-00192 ("Samsung CBM"), which was instituted by the Board on April 2, 2015. CBM2014-00192, Pap. 7.

Joinder is appropriate because it will promote efficient resolution of the validity of the '458 Patent, as the timely Apple Petition involves the same '458 patent, same claim 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. Notably, while Apple previously filed a petition directed at the same claim on § 101 grounds, Apple's petition was not instituted on the claim challenged here because the Board had already instituted Samsung's CBM the week before. Apple thus seeks to join the Samsung proceedings so that, if necessary, Apple can ensure that the proceedings on this claim

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

continues in the event Samsung seeks to terminate them based on settlement or other factors.

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 claim 11 of the '458 patent under two grounds of unpatentability. CBM2014-00192, Pap. 2.

B. The Patent Owner, listed as Smartflash LLC ("Smartflash" or "Patent Owner"), submitted a Preliminary Response on January 6, 2015. CBM2014-00192, Pap. 5.

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 Claim 11 is directed to patent ineligible subject matter under 35 U.S.C. § 101. CBM2014-00192, Pap. 7.

D. Apple's own earlier petition for review of Claim 11 on § 101 grounds—although granted on other claims—was denied as to Claim 11 on April 10, 2015 in light of the institution of trial on that claim in CBM2014-00192. *See* CBM2015-00016, Pap. 23, at 20.

E. The Apple Petition that accompanies the present Motion for Joinder was filed within 20 days of the decision noted above in CBM2015-00016, and includes only this same ground of unpatentability that was instituted in the Samsung CBM for the '458 patent (CBM2014-00192).

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)).

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