

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2015-00121
Patent 8,794,516 B2

Before JENNIFER S. BISK, RAMA G. ELLURU, and GREGG I.
ANDERSON, *Administrative Patent Judges*.

ANDERSON, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

INTRODUCTION

Apple Inc. (“Petitioner”), filed a Petition to institute covered business method patent review of claims 1–28 of U.S. Patent No. 8,794,516 B2 (Ex. 1001, “the ’516 patent”) pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”). Paper 2 (“Pet.”).¹ Smartflash LLC (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). On November 10, 2015, we instituted a covered business method patent review (Paper 8, “Institution Decision” or “Inst. Dec.”) based upon Petitioner’s assertion that claims 1–28 (“the challenged claims”) are directed to patent ineligible subject matter under 35 U.S.C. § 101. Inst. Dec. 24.

Subsequent to institution, Patent Owner filed a Patent Owner Response (Paper 17, “PO Resp.”) and Petitioner filed a Reply (Paper 21, “Pet. Reply”) to Patent Owner’s Response. Patent Owner, with authorization, filed a Notice of Supplemental Authority. Paper 29 (“Notice”). Petitioner filed a Response to Patent Owner’s Notice. Paper 30 (“Notice Resp.”).

In our Final Decision, we determined Petitioner had established, by a preponderance of the evidence, that claims 1–28 of the ’516 patent are directed to patent ineligible subject matter under 35 U.S.C. § 101. Paper 32 (“Final Dec.”), 2, 35. Patent Owner requests rehearing of the Final Decision with respect to patent ineligibility of the challenged claims under § 101. Paper 33 (“Request” or “Req. Reh’g”). Having considered Patent Owner’s Request, we decline to modify our Final Decision.

¹ Pub. L. No. 112–29, 125 Stat. 284, 296–07 (2011).

STANDARD OF REVIEW

In covered business method review, the petitioner has the burden of showing unpatentability by a preponderance of the evidence. 35 U.S.C. § 326(e). The standard of review for rehearing requests is set forth in 37 C.F.R. § 42.71(d), which states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

ANALYSIS

Patent Owner's Request is based on a disagreement with our determination that the challenged claims are directed to patent-ineligible subject matter. Req. Reh'g 4.

In its Request, Patent Owner initially presents arguments directed to alleged similarities between the challenged claims and those at issue in *DDR Holdings*², *Enfish*³, and *Bascom*⁴. Req. Reh'g 5–11. Those cases were each addressed in the Patent Owner Response or Patent Owner's Notice, as well as in our Final Decision. As noted above, our rules require that the requesting party “*specifically* identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. 42.71(d) (emphasis added). In its Request, however, Patent Owner does not

² *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).

³ *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016).

⁴ *BASCOM Global Internet Services, Inc. v. AT&T Mobility, LLC*, 827 F.3d 1341 (Fed. Cir. 2016).

identify any specific matter that we previously allegedly misapprehended or overlooked. Although Patent Owner repeatedly states that “the Board misapprehends Smartflash’s argument” (*see, e.g.*, Req. Reh’g 5, 10), it offers no explanation as to how we misapprehended or overlooked any particular “matter [that] was previously addressed in a motion, an opposition, or a reply.” In fact, Patent Owner does not sufficiently cite to its papers when alleging an argument with respect to these decisions was misapprehended. *See id.* at 5–11. Rather than providing a proper request for rehearing, addressing particular matters that we previously misapprehended or overlooked, Patent Owner’s Request provides new briefing by expounding on argument already made.

To the extent portions of the Request are supported by Patent Owner’s argument in the Patent Owner Response or in Patent Owner’s Notice, we considered those arguments in our Final Decision, as Patent Owner acknowledges. *See, e.g.*, Req. Reh’g 5, 7, 9 (noting that “[t]he Board rejected Smartflash’s argument” with respect to each of *DDR Holdings*, *Enfish*, and *Bascom*). The only paper cited by Patent Owner is our Final Decision, which, as noted above, addresses Patent Owner’s arguments related to *DDR Holdings* (Final Dec. 18–21), *Enfish* (*id.* at 12), and *Bascom* (*id.* at 23–24). Patent Owner’s Request is simply based on disagreement with our Final Decision, which is not a proper basis for rehearing.

Patent Owner also presents new arguments directed to alleged similarities between the challenged claims and those addressed in *McRO*⁵

⁵ *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016).

and *Amdocs*⁶, which were issued after Patent Owner’s Notice was filed. Req. Reh’g 11–15. Patent Owner alleges that we overlooked the Federal Circuit’s decisions in *McRO* and *Amdocs*. *Id.* at 2. The decisions in those cases issued before our Final Decision and, although not specifically referenced, were considered when we determined that the challenged claims are patent-ineligible.

When addressing *McRO*, Patent Owner does little, if anything, to analogize those claims to the challenged claims, other than summarizing the discussion in *McRO* (*id.* at 11–13), and concluding that

Because the challenged claims are a technological improvement over the then-existing systems and methods, and limit transfer and retrieval of content based on payment validation in a process specifically designed to achieve an improved technological result in conventional industry practice, the challenged claims are not directed to an abstract idea.

Id. at 13 (citing Ex. 1001, 26:35–37 (claim 1), 28:3–9 (claim 14)). But *McRO* does not stand for the general proposition that payment validation to achieve an improved technological result, alone, removes claims from the realm of abstract ideas. In *McRO*, the Court explained that “the claimed improvement [was] allowing computers to produce ‘accurate and realistic lip synchronization and facial expressions in animated characters’ that previously could only be produced by human animators.” *McRO*, 837 F.3d at 1313 (citation omitted). The Court explained that the claimed rules in *McRO* transformed a traditionally *subjective* process performed by human artists into a mathematically *automated* process executed on computers (i.e., the processes were fundamentally different). *Id.* at 1314. The Court

⁶ *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016).

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