UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC., Petitioner

v.

SMARTFLASH LLC, Patent Owner

Case CBM2015-00123 Patent 8,033,458

Before the Honorable JENNIFER S. BISK, RAMA G. ELLURU, JEREMY M. PLENZLER, and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE



TABLE OF CONTENTS

I.	INTF	INTRODUCTION						
II.	THE CHALLENGED CLAIMS ARE NOT § 101 PATENT ELIGIBLE							
	A.	Mayo Step 1: PO Fails To Rebut Apple's Showing That The Challenged Claims Are Directed To An Abstract Idea						
	B.	Mayo Step 2: PO Fails To Rebut Apple's Showing That The Challenged Claims Have No Inventive Concept						
		1. PO Fails To Identify Any Inventive Concept						
		2.	The <i>DDR</i> Claims Are Not Analogous To The Challenged Claims					
			a)	The Challenged Claims Neither Address an Internet-Specific Problem Nor Effect <i>DDR</i> 's "Override"	12			
			b)	The Challenged Claims Do Not "Parallel" the <i>DDR</i> Claims	14			
		3.		Challenged Claims Are Analogous To Those Held gible	15			
	C.	PO's	Preen	nption Arguments Are Misplaced	17			
III.	CLAIMS 3-5 ARE INDEFINITE UNDER 35 U.S.C. § 112, ¶ 2							
IV.	PO'S OTHER ARGUMENTS ARE IRRELEVANT TO THE MERITS							
	A.	Dr. Kelly's Unrebutted Expert Opinions Are Reliable And Entitled To Significant Weight2						
	В.	PO's Arguments Regarding The Board's Ability To Review The Challenged Claims Are Unfounded						
		1.	Nor'	ner The Constitution, The '458 Patent's Prosecution, The AIA Prohibits The Board From Considering § Here	22			
		2.		-Final District Court § 101 Determinations Are	23			



CBM2015-00123 Patent 8,033,458 B2

C.	The '458 Patent Is A Covered Business Method Patent				
	1.	The Federal Circuit Has Already Rejected PO's Proposed Interpretation Of Covered Business Method Patents	24		
	2.	The Board Correctly Determined That The '458 Patent Does Not Cover A Technological Invention	25		



TABLE OF AUTHORITIES

	Page(s)
CASES	
Accenture Global Servs., GmbH v. Guidewire Software, Inc., 728 F.3d 1336 (Fed. Cir. 2013)	passim
Alice Corp. Pty. Ltd. v. CLS Bank Int'l, 134 S. Ct. 2347 (2014)	passim
Ariosa Diagnostics, Inc. v. Sequenom, Inc., 788 F.3d 1371 (Fed. Cir. 2015)	, 18, 21, 23
Arrhythmia Research Tech., Inc. v. Corazonix Corp., 958 F.2d 1053 (Fed. Cir. 1992)	21, 24
Bancorp Servs., L.L.C. v. Sun Life Assurance Co. of Can., 687 F.3d 1266 (Fed. Cir. 2012)	3, 6, 15, 18
buySAFE, Inc. v. Google, Inc., 765 F.3d 1350 (Fed. Cir. 2014)	9, 16
Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat'l Ass 776 F.3d 1343 (Fed. Cir. 2014)	
CyberSource Corp. v. Retail Decisions, Inc., 654 F.3d 1366 (Fed. Cir. 2011)	3
DDR Holdings, LLC v. Hotels.com, L.P., 773 F.3d 1245 (Fed. Cir. 2014)	passim
Diamond v. Diehr, 450 U.S. 175 (1981)	18
Digitech Image Techs., LLC v. Elecs. for Imaging, Inc., 758 F.3d 1344 (Fed. Cir. 2014)	8
Enzo Biochem, Inc. v. Gen-Probe, Inc., 424 F 3d 1276 (Fed. Cir. 2005)	22.



CBM2015-00123 Patent 8,033,458 B2

Ethicon, Inc. v. Quigg, 849 F.2d 1422 (Fed. Cir. 1988)23	, 24
Fresenius USA, Inc. v. Baxter Int'l, Inc., 721 F.3d 1330 (Fed. Cir. 2013)	23
Gottschalk v. Benson, 409 U.S. 63 (1972)	13
Intellectual Ventures I LLC v. Capital One Bank (USA), 792 F.3d 1363 (Fed. Cir. 2015)pas	ssim
Internet Patents Corp. v. Active Network, Inc., 790 F.3d 1343 (Fed. Cir. 2015)	3, 8
Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364 (Fed. Cir. 2003)	20
Mayo Collaborative Servs. v. Prometheus Labs., Inc., 132 S. Ct. 1289 (2012)pas	ssim
McCormick Harvesting Mach. Co. v. Aultman, 169 U.S. 606 (1898)	22
MCM Portfolio LLC v. Hewlett-Packard Co., No. 15-1091, 2015 WL 7755665 (Fed. Cir. Dec. 2, 2015)2	., 22
Mortgage Grader, Inc. v. First Choice Loan Servs. Inc., 811 F.3d 1314 (Fed. Cir. 2016)	16
OIP Techs., Inc. v. Amazon.com, Inc., 788 F.3d 1359 (Fed. Cir. 2015)pas	ssim
SightSound Techs., LLC v. Apple Inc., Nos. 15-1159, -1160, slip op. (Fed. Cir. Dec. 15, 2015)	24
SmartGene, Inc. v. Advanced Biological Labs., SA, 555 F. App'x 950 (Fed. Cir. 2014)	6
Suffolk Techs., LLC v. AOL Inc., 752 F 3d 1358 (Fed. Cir. 2014)	22.



DOCKET

Explore Litigation Insights



Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time** alerts and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.

