

Trials@uspto.gov CBM2015-00121, Paper 26; CBM2015-00123, Paper 26;
Tel: 571-272-7822 CBM2015-00124, Paper 26; CBM2015-00126, Paper 26;
CBM2015-00127, Paper 26; CBM2015-00130, Paper 28;
CBM2015-00131, Paper 28; CBM2015-00133, Paper 31
Entered: June 28, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC. and GOOGLE, INC.,¹
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

Cases

CBM2015-00121 (Patent 8,794,516),
CBM2015-00123 (Patent 8,033,458)
CBM2015-00124 (Patent 7,942,317)
CBM2015-00126, CBM2015-00130 (Patent 8,118,221)
CBM2015-00127 (Patent 7,334,720)
CBM2015-00131 (Patent 8,061,598)
CBM2015-00133² (Patent 8,336,772)

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

CLEMENTS, *Administrative Patent Judge*.

ORDER
Request for Oral Argument

¹ Google is a Petitioner in CBM2015-00126 and in CBM2015-00133.

² Google's challenge to claims 9 and 21 based on 35 U.S.C. § 101 in CBM2015-00132 has been consolidated with this proceeding.

CBM2015-00121 (Patent 8,794,516); CBM2015-00123 (Patent 8,033,458); CBM2015-00124 (Patent 7,942,317); CBM2015-00126 (Patent 8,118,221); CBM2014-00127 (Patent 7,334,720); CBM2015-00130 (Patent 8,118,221); CBM2015-00131 (Patent 8,061,598); CBM2015-00133 (Patent 8,336,772)

Apple Inc. (“Apple”) and Smartflash LLC (“Smartflash” or “Patent Owner”) have each requested an oral hearing for covered business method patent review proceedings CBM2015-00121, CBM2015-00123, CBM2015-00124, CBM2015-00127, CBM2015-00130, CBM2015-00131, and CBM2015-00133 pursuant to 37 C.F.R. § 42.70. Papers 22, 23.³ Also, Smartflash requested an oral hearing for covered business method patent review proceedings CBM2015-00126. We grant the requests. The hearing will commence at 1 pm Eastern Time on Wednesday, July 18, 2016, on the ninth floor of Madison Building East, 600 Dulany Street, Alexandria, VA.

Petitioner⁴ and Patent Owner will each have 1 hour of total time to present arguments on all eight cases.⁵ The parties are free to divide the time among the eight cases as they choose, and must make clear at all times for purposes of the transcript, the case(s) which they are discussing. Petitioner bears the ultimate burden of proof that Patent Owner’s claims at issue in this review are unpatentable. Petitioner will, therefore, begin by presenting its case regarding the challenged claims and grounds for which the Board instituted trial in the proceeding. Patent Owner will then respond to Petitioner’s arguments. Petitioner may reserve time to reply to arguments presented by Patent Owner. There is no motion to amend pending in any of the subject proceedings.

³ Paper numbers refer to papers in CBM2015-00123.

⁴ “Petitioner” includes Google, who is sole Petitioner in CBM2015-00126.

⁵ Patent Owner requested two hours per side. Paper 22. Petitioner requested one hour per side. Paper 23.

CBM2015-00121 (Patent 8,794,516); CBM2015-00123 (Patent 8,033,458); CBM2015-00124 (Patent 7,942,317); CBM2015-00126 (Patent 8,118,221); CBM2014-00127 (Patent 7,334,720); CBM2015-00130 (Patent 8,118,221); CBM2015-00131 (Patent 8,061,598); CBM2015-00133 (Patent 8,336,772)

The hearing will be open to the public for in-person attendance that will be accommodated on a first-come, first-served basis. The Board will provide a court reporter for the hearing, and the reporter's transcript will constitute the official record of the hearing.

Under 37 C.F.R. § 42.70(b), demonstrative exhibits must be served at least five (5) business days before the hearing. The parties are directed to *St. Jude Medical, Cardiology Division, Inc. v. The Board of Regents of the University of Michigan*, Case IPR2013-00041 (PTAB Jan. 27, 2014) (Paper 65), regarding the appropriate content of demonstrative exhibits. The Board expects that the parties will meet and confer in good faith to resolve any objections to demonstrative exhibits, but if such objections cannot be resolved the parties may file any objections to demonstratives with the Board at least two business days before the hearing. The objections should identify with particularity which portions of the demonstrative exhibits are subject to objection, include a copy of the objected-to portions, and include a one-sentence statement of the reason for each objection. No argument or further explanation is permitted. The Board will consider any objections and schedule a conference call if deemed necessary. Otherwise, the Board will reserve ruling on the objections. Any objection to demonstrative exhibits that is not timely presented will be considered waived.

The parties also shall provide the demonstrative exhibits to the Board at least *two* business days prior to the hearing by emailing them to Trials@uspto.gov. Despite the requirement in § 42.70(b) for parties to file demonstratives, the parties shall *not* file any demonstrative exhibits in this

CBM2015-00121 (Patent 8,794,516); CBM2015-00123 (Patent 8,033,458); CBM2015-00124 (Patent 7,942,317); CBM2015-00126 (Patent 8,118,221); CBM2014-00127 (Patent 7,334,720); CBM2015-00130 (Patent 8,118,221); CBM2015-00131 (Patent 8,061,598); CBM2015-00133 (Patent 8,336,772)

case without prior authorization from the Board. A hard copy of the demonstratives should be provided to the court reporter at the hearing.

The parties also should note that at least one member of the panel will be attending the hearing electronically from a remote location, and that if a demonstrative is not made fully available or visible to the judge participating in the hearing remotely, that demonstrative will not be considered. If the parties have questions as to whether demonstrative exhibits would be sufficiently visible and available to all of the judges, the parties are invited to contact the Board at (571) 272-9797. The parties are also reminded that the presenter must identify clearly and specifically each demonstrative exhibit (e.g., by slide or screen number) referenced during the hearing to ensure the clarity and accuracy of the reporter's transcript and the ability of the judge participating in the hearing remotely to closely follow the presenter's arguments.

The Board expects lead counsel for each party to be present in person at the oral hearing. However, lead or backup counsel may present the party's argument. If either party anticipates that its lead counsel will not be attending the oral argument, the parties should initiate a joint telephone conference with the Board no later than two business days prior to the oral hearing to discuss the matter.

Questions regarding specific audio-visual equipment should be directed to the Board at (571) 272-9797. Requests for audio-visual equipment are to be made five (5) days in advance of the hearing date. The request is to be sent to Trials@uspto.gov. If the request is not received timely, the equipment may not be available on the day of the hearing.

CBM2015-00121 (Patent 8,794,516); CBM2015-00123 (Patent 8,033,458);
CBM2015-00124 (Patent 7,942,317); CBM2015-00126 (Patent 8,118,221);
CBM2014-00127 (Patent 7,334,720); CBM2015-00130 (Patent 8,118,221);
CBM2015-00131 (Patent 8,061,598); CBM2015-00133 (Patent 8,336,772)

For PETITIONER APPLE INC.:

J. Steven Baughman
James R. Batchelder
Megan F. Raymond
ROPES & GRAY LLP
steven.baughman@ropesgray.com
james.batchelder@ropesgray.com
megan.raymond@ropesgray.com

For PETITIONER GOOGLE, INC.:

Andrew M. Holmes
Raymond N. Nimrod
QUINN EMANUEL URQUHART & SULLIVAN, LLP
QE-SF-PTAB-Service@quinnemanuel.com
raynimrod@quinnemanuel.com

For PATENT OWNER:

Michael R. Casey
DAVIDSON BERQUIST JACKSON & GOWDEY LLP
smartflash-cbm@dbjg.com

Wayne Helge
whelge@davidsonberquist.com