

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,

Petitioner,

v.

SMARTFLASH LLC,

Patent Owner.

Case CBM2015-00129

Patent 7,942,317 B2

PATENT OWNER'S MOTION TO TERMINATE

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PATENT OWNER'S LIST OF EXHIBITS

Exhibit Number	Exhibit Description
2001	Congressional Record - House, June 23, 2011, H4480-4505
2002	Congressional Record - Senate, Sep. 8, 2011, S5402-5443
2003-2048	Reserved
2049	Report and Recommendation (on Defendants' Motions for Summary Judgment of Invalidity Pursuant to 35 U.S.C. 101), from <i>Smartflash LLC et al. v. Apple, Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.) and <i>Smartflash LLC et al. v. Samsung Electronics Co. Ltd, et al.</i> , Case No. 6:13-CV-448 (E.D. Tex.), dated Jan. 21, 2015
2050	Order adopting Report and Recommendation (on Defendants' Motions for Summary Judgment of Invalidity Pursuant to 35 U.S.C. 101), from <i>Smartflash LLC et al. v. Apple, Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.) and <i>Smartflash LLC et al. v. Samsung Electronics Co. Ltd, et al.</i> , Case No. 6:13-CV-448 (E.D. Tex.), dated Feb. 13, 2015
2051-2067	Reserved
2068	Transcript of Deposition of Anthony J. Wechselberger dated May 28, 2015 taken in CBM2015-00015, -00016, -00017 and -00018
2069-2074	Reserved
2075	Order (on Defendants' Renewed Motion for Judgment as a

Exhibit Number	Exhibit Description
	Matter of Law on the Issue of § 101 under Rule 50(b)); Dkt. # 585; from <i>Smartflash LLC, et al. v. Apple Inc., et al.</i> , Case No. 6:13-CV-447 (E.D. Tex.) dated July 8, 2015.
2076	Transcript of Deposition of Anthony J. Wechselberger dated July 22, 2015 taken in CBM2015-00028, -00029, -00031, -00032 and -00033
2077-2091	Reserved
2092	Declaration of Emily E. Toohey in Support of Patent Owner's Preliminary Response
2093-2104	Reserved
2105	Transcript of Deposition of Justin Douglas Tygar, Ph.D. dated January 19, 2016 taken in CBM2015-00126 and -00129
2106	Reserved
2107	Declaration of Emily E. Toohey in Support of Patent Owner's Response
2108-2116	Reserved
2117	<i>Smartflash LLC v. Apple Inc.</i> , Order, Cases 16-1435, -1445, 1446, 1447 (Fed. Cir. March 4, 2016)

I. INTRODUCTION AND STATEMENT OF PRECISE RELIEF REQUESTED

Patent Owner Smartflash LLC hereby moves to terminate this Covered Business Method Review (“CBM Review”) of claims 7 and 12 of U.S. Patent 7,942,317 (“the ‘317 Patent”) as moot. Smartflash was authorized to file this motion April 14, 2016.

This CBM Review was instituted only as to claims 7 and 12 as being directed to patent ineligible subject matter under 35 U.S.C. § 101. CBM2015-00129, Paper 8 at 22. By Final Written Decision in CBM2014-00112 dated September 25, 2015, the Board determined claims 7 and 12 of the ‘317 Patent to be unpatentable under 35 U.S.C. § 103. *Apple Inc. v. Smartflash LLC*, CBM2014-00112, Final Written Decision, Paper 48 at 29 (PTAB September 25, 2015). On March 4, 2016, pursuant to Fed. R. App. P. 42 (b), the United States Court of Appeals for the Federal Circuit dismissed Smartflash LLC’s appeal of the Board’s decision in CBM2014-00112 that claims 7 and 12 of the ‘317 Patent are unpatentable. Thus, claims 7 and 12 of the ‘317 Patent have been finally adjudicated to be unpatentable. The only issue here in CBM2015-00129 is the eligibility of claims 7 and 12 of the ‘317 Patent, which is now moot. The Board should therefore terminate this trial without rendering a Final Written Decision pursuant to 37 C.F.R. § 42.72.

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