

Case CBM2015-00129
Patent 7,942,317 B2

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

**PETITIONER'S STATEMENT OF NON-OPPOSITION
TO PATENT OWNER'S MOTION TO TERMINATE**

EXHIBIT LIST

Google Exhibit No.	Description
1001	U.S. Patent No. 7,942,317 to Racz et al. (“the ’317 patent”)
1002	Declaration of Dr. Justin Douglas Tygar Regarding the ’317 Patent
1003	Curriculum Vitae of Dr. Justin Douglas Tygar
1004	PCT Publication No. WO 99/07121 (“Fetik”)
1005	U.S. Patent No. 5,790,423 to Lau et al. (“the ’423 patent”)
1006	<i>SOFTBOOK PRESS—Secure Information Delivery to a Distributed Workforce</i> , CIO Magazine, Aug. 1, 1999
1007	Kevin Maney, <i>Electronic Books to Hit the Shelves</i> , New Straits Times (Computimes), Aug. 24, 1998
1008	Liquid Audio, <i>Music on the Net—A Topographic Tour of the Online Music World</i> (1997)
1009	<i>Liquid Audio Indie 1000 Program</i> , http://www.liquidaudio.com (archived Feb. 11, 1998)
1010	Reserved
1011	Report and Recommendation Regarding Claim Construction, <i>Smartflash LLC v. Samsung Elecs. Co.</i> , No. 6:13-cv-448, Dkt. 274 (E.D. Tex. Sept. 24, 2014)
1012	Plaintiffs Smartflash LLC’s and Smartflash Technologies Limited’s Opening Claim Construction Brief, <i>Smartflash LLC v. Samsung Elecs. Co.</i> , No. 6:13-cv-448, Dkt. 175 (E.D. Tex. June 13, 2014)
1013	Reserved
1014	A.M. Turing, <i>On Computable Numbers, with an Application to the Entscheidungsproblem</i> , Proceedings of the London Mathematical Society, Vol. 42:2, pp. 230-265 (Nov. 12, 1936)
1015	Plaintiffs’ Original Complaint for Patent Infringement, <i>Smartflash LLC v. Apple Inc.</i> , No. 6:13-cv-447, Dkt. 1 (E.D. Tex. May 29, 2013)

Google Exhibit No.	Description
1016	U.S. Patent No. 7,942,317 Claim Chart—Google, Exhibit 12 to Plaintiffs Smartflash LLC and Smartflash Technologies Limited’s P.R. 3-1 and 3-2 Disclosure of Asserted Claims and Infringement Contentions, <i>Smartflash LLC v. Google Inc.</i> , No. 6:14-cv-435 (E.D. Tex. Aug. 22, 2014) (excerpted)
1017	U.S. Patent No. 8,118,221 to Racz et al. (“the ’221 patent”)
1018	U.S. Patent No. 8,336,772 to Racz et al. (“the ’772 patent”)
1019	U.S. Patent No. 8,033,458 to Hulst et al. (“the ’458 patent”)
1020	U.S. Patent No. 8,061,598 to Racz et al. (“the ’598 patent”)
1021	U.S. Patent No. 7,334,720 to Hulst et al. (“the ’720 patent”)
1022	Roger A. Cunningham et al., <i>The Law of Property</i> (2d ed. 1993) (excerpted)
1023	Michael H. Harris, <i>History of Libraries in the Western World</i> (4th ed. 1999) (excerpted)
1024	David Broderick, <i>The First Toll Roads—Ireland’s Turnpike Roads 1729-1858</i> (2002) (excerpted)
1025	Proposed Protective Order
1026	Declaration of Charles K. Verhoeven in Support of Google’s Unopposed Motion for <i>Pro Hac Vice</i> Admission
1027	Declaration of Melissa J. Baily in Support of Google’s Unopposed Motion for <i>Pro Hac Vice</i> Admission
1028	Declaration of Kevin A. Smith in Support of Google’s Unopposed Motion for <i>Pro Hac Vice</i> Admission

On April 15, 2016, Patent Owner filed an authorized Motion To Terminate the instant Covered Business Method Review of claims 7 and 12 of U.S. Patent 7,942,317 (“the ’317 Patent”). CBM2015-00192, Pap. 22. Petitioner does not oppose Patent Owner’s Motion.

On September 25, 2015, the Board held claims 7 and 12 of the ’317 Patent unpatentable under 35 U.S.C. § 103. *Apple Inc. v. Smartflash LLC*, CBM2014-00112, Final Written Decision, Paper 48 at 29. On November 25, 2015, Patent Owner appealed the Board’s Final Written Decision. On March 4, 2016, pursuant to Fed. R. App. P. 42 (b), the United States Court of Appeals for the Federal Circuit dismissed Patent Owner’s appeal. The Board’s determination that Claims 7 and 12 of the ’317 Patent are unpatentable is thus final, and the issue of their patentability in this proceeding is moot. Accordingly, Petitioner does not oppose Patent Owner’s Motion To Terminate.

Dated: April 18, 2016

Respectfully submitted,

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