

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD**

GOOGLE INC.
Petitioner,

v.

SMARTFLASH LLC
Patent Owner.

Case CBM2015-00132
Patent No. 8,336,772 B2

**PETITIONER GOOGLE INC.'S MOTION FOR JOINDER UNDER 35
U.S.C. § 325(C) AND 37 C.F.R. § 42.222 AND REQUEST FOR
SHORTENED RESPONSE TIME FOR PATENT OWNER'S
PRELIMINARY RESPONSE**

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U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I. RELIEF REQUESTED

Pursuant to 35 U.S.C. § 325(c) and 37 C.F.R. § 42.222, Petitioner Google Inc. (“Google”) respectfully requests joinder of the above-captioned covered business method review (“Google CBM”) with pending covered business method reviews *Apple Inc. v. Smartflash LLC*, CBM2015-00031, and *Apple Inc. v. Smartflash LLC*, CBM2015-00032, (together, “Apple CBMs”), which were instituted on May 28, 2015. Joinder will promote efficient resolution of the question at issue in all of the related proceedings: whether the challenged claims of U.S. Patent No. 8,336,772 (the “’772 patent”) are unpatentable for failing to claim patent eligible subject matter under 35 U.S.C. § 101. Joinder will not prejudice any of the participating parties, should not impact the overall time for resolving the Apple CBMs, and will require, at most, extension of a single deadline in those proceedings.

In order to facilitate joinder, Google also respectfully requests that the deadline for Patent Owner’s preliminary response to Google’s petition be accelerated. Such an accelerated response date will not be unduly prejudicial to Patent Owner because (i) Patent Owner has already prepared several preliminary and post-institution responses to Section 101 challenges to claims of the ’772 patent and related patents and (ii) the Board has already instituted Apple’s CBMs on the same ground as the one asserted in Google’s petition.

II. STATEMENT OF MATERIAL FACTS

1. On May 8, 2015, Google petitioned for covered business method review of claims 1, 5, 9, 10, 14, 21, and 22 of the '772 patent on the ground that the subject matter of those claims is unpatentable under 35 U.S.C. § 101. *Google Inc. v. Smartflash LLC*, CBM2015-00132, Pap. 7. Google's petition relies in part on the declaration of Dr. Justin Douglas Tygar. *Id.*

2. Patent Owner's preliminary response to Google's petition is currently due September 4, 2015. *Google*, CBM2015-00132, Pap. 9 at 1.

3. On May 28, 2015, the Board instituted covered business method review of claims 1, 5, 8, 10, 14, 19 and 22 of the '772 patent in response to Apple's petitions, which assert that the subject matter of those claims is unpatentable under 35 U.S.C. § 101 and which rely in part on the declaration of Mr. Anthony J. Wechselberger. *Apple*, CBM2015-00031, Pap. 11 (claims 1, 5, 8, and 10); *Apple*, CBM2015-00032, Pap. 11 (claims 14, 19, and 22). The Board's institution decisions cover all claims challenged in Google's petition save claim 9, which depends on already instituted claim 8, and claim 21, which depends on already instituted claim 19. *Id.* Both claims 9 and 21 recite the same additional limitation: "wherein said data carrier is integrated into the data access terminal, and wherein said data carrier comprises flash memory." *Google*, CBM2015-00132, Ex. 1001.

In its institution decisions, the Board found that (i) the challenged claims "are more

likely than not drawn to a patent-ineligible abstract idea,” (ii) the “potentially technical additions to the claims” are all “purely conventional,” and (iii) the challenged claims do not “add an inventive concept sufficient to ensure that the patent in practice amounts to significantly more than a patent on the abstract idea itself.” *Apple*, CBM2015-00031, Pap. 10 at 12-15; *Apple*, CBM2015-00032, Pap. 11 at 11-14.

4. Patent Owner’s responses to Apple’s petitions are currently due July 29, 2015. *Apple*, CBM2015-00031, Pap. 12 at 6; *Apple*, CBM2015-00032, Pap. 12 at 6.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

“The AIA permits joinder of like review proceedings.” *Trulia, Inc. v. Zillow, Inc.*, CBM2014-00115, Pap. 8 at 18, 2014 WL 4219513, at *10 (May 1, 2014). Under 35 U.S.C. § 325(c):

If more than 1 petition for a post-grant [or covered business method] review under this chapter is properly filed against the same patent and the Director determines that more than 1 of these petitions warrants the institution of a post-grant [or covered business method] review under section 324, the Director may consolidate such reviews into a single post-grant [or covered business method] review.¹

¹ Pursuant to AIA § 18(a)(1), the standards and procedures governing post-grant review also govern covered business method review. *See also Trulia*,

See also 37 C.F.R. § 42.222(a) (“Where another matter involving the patent is before the Office, the Board may during the pendency of the post-grant [or covered business method] review enter any appropriate order regarding the additional matter including providing for the . . . consolidation . . . of any such matter.”).

The Board determines whether to grant joinder on a case-by-case basis, “taking into account the particular facts of each case, substantive and procedural issues, and other considerations.” *Dell Inc. v. Network-1 Security Solutions, Inc.*, IPR2013-00385, Pap. 17 at 3, 2013 WL 5947712, at *2 (July 29, 2013). The Board has instructed that a motion for joinder should: “(1) set forth the reasons why joinder is appropriate; (2) identify any new grounds of unpatentability asserted in the petition; (3) explain what impact (if any) joinder would have on the trial schedule for the existing review; and (4) address specifically how briefing and discovery may be simplified.” *Sony Corp. v. Yissum Research Development Co.*, IPR2013-00219, Pap. 15 at 3, 2013 WL 5970153, at *2 (Sept. 24, 2013) (citing *Kyocera Corp. v. Softview LLC*, IPR2013-00004, Pap. 15 at 4 (Apr. 24, 2013)). All of these considerations weigh in favor of joinder.

CBM2014-00115, Pap. 8 at 18, 2014 WL 4219513, at *10 (“The statutory provision governing joinder of covered business method patent review proceedings is 35 U.S.C. § 325(c).”).

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