

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 8,336,772 B2

PATENT OWNER'S OPPOSITION TO 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

I. INTRODUCTION

Patent Owner hereby opposes 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.

Petitioner seeks to join CBM2015-00132 with covered business method review cases CBM2015-00031 and -00032 filed by Apple Inc. Motion, Paper 10 at 1.

The Board should deny the Motion for Joinder because (i) it is too late for the proposed joinder to provide the purported efficiencies Petitioner suggests; (ii) the cases are sufficiently different in terms of proffered exhibits and witnesses to gain any advantage by joinder; and (iii) the Board should exercise its discretion under 35 U.S.C. § 325(d) and decline to institute a covered business method patent review of claims 1, 5, 9, 10, 14, 21, and 22 of U.S. Patent 8,336,772 on 35 U.S.C. § 101 grounds in CBM2015-00132 because it has already instituted covered business method review on the same grounds of claims 1, 5, 10, 14, and 22, as well as on claims 8 and 19, from which claims 9 and 22 depend, in CBM2015-00031 and -00032.

II. RESPONSE TO STATEMENT OF MATERIAL FACTS

1 – 4. Admitted.

III. STATEMENT OF MATERIAL FACTS

1. There has been no Institution Decision issued in CBM2015-00132.

2. Under Petitioner's proposed "Post-Joinder Schedule" (Motion for Joinder, Paper 10 at 14), the proposed date for Patent Owner's Preliminary Response to Google's Petition in CBM2015-00132 is July 13, 2015, 16 days before this Opposition is due, and has already passed.

3. There is no overlap in witnesses proffered by Google in CBM2015-00132 (Dr. Justin Douglas Tygar) with witnesses proffered by Apple in CBM2015-00031 and -00032 (Mr. Anthony J. Wechselberger).

4. In support of its §101 petition, Google relies on Exhibits 1006- 1009 generally relating to electronic publishing, and Exhibits 1023 – 1024 covering wide ranging topics including the history of libraries in the Western world and the first toll roads. Those Exhibits, as well as others, are not in CBM2015-00031 and -00032.

IV. ARGUMENT

A. It Is Too Late For The Proposed Joinder To Provide The Purported Efficiencies Petitioner Suggests.

Petitioner claims that "[j]oinder will promote efficient resolution of the question at issue in all of the related proceedings: whether the challenged claims of ... the '772 patent are unpatentable for failing to claim patent eligible subject matter under 35 U.S.C. § 101." Motion, Paper 10 at 1. Any efficiencies that *might*

have existed at the time that CBM2015-00031 and -00032 were instituted on May 28, 2015, however, were squandered by Petitioner waiting until the very last allowable day (June 29, 2015) to file its Motion for Joinder. In the meantime, CBM2015-00031 and -00032 have proceeded through Patent Owner discovery to the point of Patent Owner's Response being filed on July 29, 2015. In in CBM2015-00132 the *preliminary* response is not due until September 4, 2015.

Petitioner Google posits that “[j]oinder will have minimal impact on the trial schedule for the existing review, because Google’s petition is substantially similar to the petitions in the Apple CBMs”. Motion, Paper 10 at 8. Review of the petitions, however, reveals that the Apple and Google rely on different exhibits and different witnesses. Simply comparing the Exhibit Lists shows this.

Petitioner’s proposed schedule is impractical. Under Petitioner’s proposed “Post-Joinder Schedule” (Motion for Joinder, Paper 10 at 14), the proposed date for Patent Owner’s Preliminary Response to Google’s Petition in CBM2015-00132 is July 13, 2015, 16 days before this Opposition is due, and has already passed. Google proposes that Patent Owner’s response be due on August 28, 2015. As noted, there has been no institution decision and thus no discovery conducted by Patent Owner. Google has proffered a witness declaration from Dr. Justin Douglas Tygar. This witness does not overlap with Apple’s witness. Patent Owner has a right to depose this witness. 37 CFR § 42.53. Clearly Google’s proposed schedule

whereby Patent Owner would depose Google's witness and prepare a substantive Patent Owner's Response by August 28, 2015 in a case that has not even been instituted is not reasonable.¹

CBM2015-00031 and -00032 are too far advanced to shoe horn CBM2015-00132 into the same schedule.

B. The CBM2015-00132 and CBM2015-00031 and -00032 Cases Are Sufficiently Different Such That There Is No Advantage To Joinder.

In arguing for joinder, Google states "Google's petition is substantially similar to the petitions in the Apple CBMs." Motion, Paper 10 at 8. While both petitions make the same purely legal argument – that the patent claims are directed to ineligible subject matter, the CBM2015-00132 and CBM2015-00031/-00032 petitions are sufficiently different in terms of proffered exhibits and witnesses that they will not gain any advantage by joinder.

In support of its §101 petition, Google relies on Exhibits 1006- 1009 generally relating to electronic publishing, and Exhibits 1023 – 1024 covering

¹ Meanwhile, in CBM2015-00059, Petitioner Samsung is proposing that its petition be joined with CBM2015-00031, -00032, and -00033 and proffered a schedule whereby Patent Owner would depose two unique Samsung witnesses and prepare a substantive Patent Owner's Response by August 12, 2015. CBM2015-00059, Motion for Joinder, Paper 11 at 14.

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