

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

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**GOOGLE INC.**  
Petitioner,

v.

**SMARTFLASH LLC**  
Patent Owner.

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

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**PETITIONER GOOGLE INC.'S REPLY IN SUPPORT OF ITS MOTION  
FOR JOINDER UNDER 35 U.S.C. § 325(C) AND 37 C.F.R. § 42.222**

*Mail Stop "Patent Board"*  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

With respect to Google’s Motion for Joinder, the Board should enter an order consistent with the Board’s precedents across CBM review proceedings related to the Smartflash family of patents. Specifically, with respect to claims that were challenged by Google based on § 101 but are now subject to other CBM review proceedings based on § 101 (claims 1, 5, 10, 14, and 22 of the ’772 patent), the Board should grant Google’s motion to join the already pending proceedings (on the same schedule and on the basis of the same arguments and evidence as the pending proceedings). With respect to claims that are challenged by Google based on § 101 and that have never previously been challenged by any petitioner on that ground (claims 9 and 21 of the ’772 patent), the Board should institute CBM review in these proceedings for the reasons stated in Google’s petition.

**I. GOOGLE’S CHALLENGE TO CLAIMS 1, 5, 10, 14, AND 22 SHOULD BE CONSOLIDATED WITH THE APPLE CBM PROCEEDINGS**

With respect to the claims of the ’772 patent that are challenged both by Google in its May 8, 2015 petition and by Apple in the Apple CBM proceedings,<sup>1</sup> Google’s Motion for Joinder requested one of two forms of relief (following any institution decision): (i) joinder of Google’s arguments and evidence to the Apple CBM proceedings or (ii) joinder of Google to Apple’s arguments and evidence in

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<sup>1</sup> Claims 1, 5, and 10 are challenged by Apple in CBM2015-00031. Claims 14 and 22 are challenged by Apple in CBM2015-00032.

the Apple CBM proceedings. After Google filed its Motion, the Board issued a decision regarding an analogous motion for joinder filed by Samsung. *Samsung Elecs. Am., Inc. v. Smartflash LLC*, No. CBM2015-00059, Pap. 13 at 6-7 (Aug. 5, 2015). In light of the Board's decision to join Samsung to Apple's arguments and evidence in the Apple CBM proceedings, Google reiterates its request for analogous relief here.

Nothing in Smartflash's Opposition to Google's Motion counsels against joining Google to Apple's arguments and evidence in the Apple CBM proceedings. For example, Smartflash argues that joinder is impractical as a matter of scheduling (Opp. at 2-4), but joining Google to Apple's arguments and evidence does not require any departure from the Scheduling Order issued in the Apple CBM proceedings. *See Samsung*, CBM2015-00059, Pap. 13 at 6. Similarly, Smartflash argues that joinder is inappropriate because Google and Apple have relied on different exhibits and witnesses in making their respective challenges (Opp. at 4-5), but this consideration is irrelevant with respect to simply joining Google to *Apple's* arguments and evidence. *See Samsung*, CBM2015-00059, Pap. 13 at 6. Indeed, for all of the reasons that the Board consolidated Samsung's and Apple's proceedings "based on the same schedule, evidence, and argument

proffered in the Apple CBM proceedings,” *id.* at 5-7, the Board should do the same here for Google’s challenges to claims 1, 5, 10, 14 and 22 of the ’772 patent.<sup>2</sup>

**II. SMARTFLASH’S REQUEST THAT THE BOARD DECLINE TO INSTITUTE CBM REVIEW OF CLAIMS 1, 5, 10, 14, AND 22 SHOULD BE DENIED**

In its Opposition to Google’s Motion, Smartflash contends that Google’s petition challenging claims 1, 5, 10, 14, and 22 of the ’772 patent should be denied outright under 35 U.S.C. § 325(d), solely because CBM review of the same claims has now been instituted in the context of the Apple CBM proceedings. (Opp. at 5-6.) But the Board is “not required to deny a petition merely because the same or substantially the same . . . arguments previously were considered in another proceeding.” *Chicago Mercantile Exch., Inc. v. 5th Market, Inc.*, No. CBM2015-00061, Pap. 9, at 39-40 (July 16, 2015). And the Board should not deny such a petition under circumstances where, as here, (i) CBM review of the challenged claims should be instituted on the merits of Google’s petition and (ii) a newly instituted CBM review can immediately be consolidated with the “schedule, evidence, and argument” of an earlier proceeding. *See Samsung*, CBM2015-00059, Pap. 13 at 7.

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<sup>2</sup> Similar procedures to those ordered in *Samsung*, CBM2015-00059, Pap. 13 at 9-10, (regarding, for example, consolidated filings) should also be ordered here.

### **III. GOOGLE’S CHALLENGE TO CLAIMS 9 AND 21 SHOULD BE INSTITUTED AND PROCEED SEPARATELY FROM THE APPLE CBM PROCEEDINGS**

In its petition, Google challenged claims 9 and 21 of the ’772 patent on the basis that the subject matter of those claims is patent ineligible under § 101. No other petitioner has challenged those claims on that ground, and there are no instituted proceedings in which those claims are at issue.<sup>3</sup> Nonetheless, in its Opposition to Google’s Motion, Smartflash contends that Google’s challenge to claims 9 and 21 should be denied under 35 U.S.C. § 325(d), merely because the Board instituted CBM review of *other* claims from the ’772 patent in the Apple CBM proceedings. (Opp. at 6.) The Board should not decline to institute CBM review of claims 9 and 21 on that basis.

To the contrary, the fact that the Board has already instituted CBM review of claim 8 of the ’772 patent (from which claim 9 depends) and claim 19 of the ’772 patent (from which claim 21 depends) only *supports* Google’s petition for CBM review of claims 9 and 21. In its decisions instituting CBM review of independent claims 8 and 19, the Board found that claims 8 and 19 are “more likely than not . . .

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<sup>3</sup> Smartflash asserted claims 9 and 21 against Google in *Smartflash LLC v. Google Inc.*, No. 14-cv-435 (E.D. Tex.), which is currently stayed pending resolution of these proceedings (Dkt. 179 at 46); Smartflash does not appear to have asserted claims 9 and 21 in its litigation against either Apple or Samsung.

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