

CBM2015-00133  
Patent 8,336,772 B2

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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APPLE INC. and GOOGLE, INC.,  
Petitioners

v.

SMARTFLASH LLC,  
Patent Owner

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Case CBM2015-00133<sup>1</sup>  
Patent 8,336,772

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Before the Honorable JENNIFER S. BISK, RAMA G. ELLURU, GREGG I.  
ANDERSON, and MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

**PETITIONER'S RESPONSE TO PATENT OWNER'S NOTICE OF  
SUPPLEMENTAL AUTHORITY**

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<sup>1</sup> The challenge to claims 9 and 21 based on 35 U.S.C. § 101 in CBM2015-00132 has been consolidated with this proceeding.

The cases cited in PO's Notice (Pap. 33) support Petitioner, not PO.<sup>2</sup> These decisions confirm, under the analysis required by, *e.g.*, *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014), that the Claims are patent-ineligible. The Claims are directed to "economic or other tasks for which a computer is used in its ordinary capacity," not a "specific improvement to the way computers operate." *See Enfish, LLC v. Microsoft Corp.*, \_\_\_ F.3d \_\_\_, No. 2015-1244, 2016 WL 2756255, at \*5 (Fed. Cir. May 12, 2016). And the Board does not face the "limited record" of a motion to dismiss "construed in favor of the nonmovant" as in *BAS-COM Global Internet Services, Inc. v. AT&T Mobility, LLC.*, \_\_\_ F.3d \_\_\_, No. 2015-1763, 2016 WL 3514158, at \*6-8 (Fed. Cir. June 27, 2016). To the contrary, the detailed record here confirms the Claims do not improve "the performance of the computer system itself," and provide no inventive concept. *Id.* at \*7-8.

1. Unlike *Enfish*'s claims to "a specific improvement to the way computers operate," these Claims are indisputably directed to "economic or other tasks for which a computer is used in its ordinary capacity." *Enfish*, 2016 WL 2756255, at \*5. They merely recite "general-purpose computer components [that were] added post-hoc to a fundamental economic practice," *id.* at \*8, as this Board found in deciding that related claims were "directed to performing the fundamental economic

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<sup>2</sup> Unless noted, all emphasis is added, and abbreviations are those from Paper 25 ("Reply").

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practice of [conditioning and] controlling access to content [based on payment].”

*See, e.g.*, 00017FWD at 7-8; 00016FWD/00194FWD/00193FWD at 8; CBM2014-00190, Pap.47 (“00190FWD”) at 8; CBM2015-00028, Pap. 44 (“00028FWD”) at 8; CBM2015-00029, Pap. 43 (“00029FWD”) at 9; *see also* 00192FWD at 8; CBM2015-00031, Pap. 45 (“00031FWD”) at 12; CBM2015-00032, Pap. 46 (“00032FWD”) at 13-14; CBM2015-00033, Pap. 40 (“00033FWD”) at 13; Notice 3 (PO admitting Claims directed to “digital commerce”).

PO’s reliance on generic components underscores this point. *See* Notice 2-3. While PO argues its generic hardware and software “carry out their functions in a specific manner” (*see id.* 3), it does not and cannot state its Claims are “directed to an improvement *in the functioning of a computer.*” *Cf. Enfish*, 2016 WL 2756255, at \*7. Rather, PO’s Claims are like “the claims at issue in *Alice* and *Versata*,” “simply adding conventional computer components to well-known business practices.” *Id.*

Indeed, in *In re TLI Communications LLC Patent Litigation*, No. 2015-1372, 2016 WL 2865693 (Fed. Cir. May 17, 2016), the Federal Circuit similarly distinguished *Enfish* on the ground that the *TLI* claims, like the Claims here, “are directed to the use of conventional or generic technology.” *TLI*, 2016 WL 2865693, at \*3. Just as in *TLI*, the Claims here “perform[] generic computer functions such as storing, receiving, and extracting data” using “physical components” (*e.g.*, wire-

less interface, non-volatile memory, processor, display) that “behave exactly as expected according to their ordinary use” and “merely provide a generic environment in which to carry out the abstract idea” of controlling access to content based on payment and/or rules. *Id.* at \*3, \*4, \*7; *see also* Paper 25 (“Opp. to Mot. to Exclude”) at 7-8.

Unlike *Enfish*’s summary judgment inferences, here the full record—including PO’s admissions (*see, e.g.*, Reply 6, 10, 12) and Petitioner’s unrebutted expert testimony about what was routine and conventional (*see, e.g.*, Reply 11-12, 15, 19-21; Ex. 1019 §§ VI, VII; Ex. 1013 9:34-42)—indisputably confirms the Claims offer no “specific asserted improvement in computer capabilities,” such as *Enfish*’s “innovative” means for configuring memory with a self-referential table. *See Enfish*, 2016 WL 2756255, at \*3, \*5. Instead they are directed to the abstract idea of controlling access to content based on payment/rules “for which computers are invoked merely as a tool.” *Id.* at \*5.

2. In *BASCOM*, pointing to *DDR*’s “technical solution to a problem unique to the Internet,” the court accepted *BASCOM*’s allegations that its “specific method of filtering Internet content”—which “associate[d] individual accounts with their own filtering scheme and elements while locating the filtering system on an ISP server”—claimed “a technology-based solution (not an abstract-idea-based solution implemented with generic technical components in a conventional way) to

filter content on the Internet that overcomes existing problems with other Internet filtering systems,” and “represent[ed] a ‘software-based invention[ ] that *improve[s] the performance of the computer system itself.*’” *BASCOM*, 2016 WL 3514158, at \*6, \*7. “[T]aking the allegations of the complaint to be true” on this “limited record,” the Court found the claims improved ““an existing technological process.”” *Id.* at \*4, \*6, \*7.

Here, PO has not shown and cannot show the Claims are “a technology-based solution” ““that improve[s] the performance of the computer system itself”” as in *BASCOM*. *Id.* at \*7. While PO argues its Claims, by storing payment data and content data on a handheld multimedia terminal, are ““improv[ing] an existing technological process”” (*see* Notice 5), PO has failed to rebut Petitioner’s showing that this neither was inventive nor improved “the performance of the computer system itself.” *BASCOM*, 2016 WL 3514158, at \*7; Ex. 1019 §§ VI, VII (citing prior art). Unlike *BASCOM*’s claims, which were directed to improvements in filtering technology, PO’s Claims are drawn to carrying out existing economic transactions using existing and generic components in a conventional way that provides no inventive concept. The problem is a *business problem* (data piracy) (*see, e.g.*, Dec11), and as the Board already found in related proceedings any solution here is “not rooted in specific computer technology” and does not “override[] the routine and conventional use of the recited devices and functions.” *See, e.g.*,

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