

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC. and GOOGLE, INC.,
Petitioner,

v.

SMARTFLASH LLC,
Patent Owner.

Case CBM2015-00133¹
Patent 8,336,772 B2

Before JENNIFER S. BISK, RAMA G. ELLURU,
JEREMY M. PLENZLER, and GREGG I. ANDERSON,
Administrative Patent Judges.

PLENZLER, *Administrative Patent Judge.*

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

¹ Google's challenge to claims 9 and 21 based on 35 U.S.C. § 101 in CBM2015-00132 was consolidated with this proceeding. Paper 10.

INTRODUCTION

Apple Inc. (“Apple”), filed a Petition to institute covered business method patent review of claims 2–4, 6, 7, 9, 11–13, 15–18, 20, 21, 23, 24, 27–29, 31, and 33–36 of U.S. Patent No. 8,336,772 B2 (Ex. 1001, “the ’772 patent”) pursuant to § 18 of the Leahy-Smith America Invents Act (“AIA”). Paper 2 (“Pet.”).² On November 16, 2015, we instituted a covered business method patent review (Paper 7, “Institution Decision” or “Inst. Dec.”) based upon Apple’s assertion that claims 2–4, 6, 7, 9, 11–13, 15–18, 20, 21, 23, 24, 27–29, 31, and 33–36 (“the challenged claims”) are directed to patent ineligible subject matter under 35 U.S.C. § 101. Inst. Dec. 22.

On May 8, 2015, Google Inc. (“Google”) filed a corrected Petition requesting covered business method patent review of claims 1, 5, 9, 10, 14, 21, and 22 of the ’772 patent on the ground that they are directed to patent ineligible subject matter under 35 U.S.C. § 101. *Google Inc. v. Smartflash LLC*, Case CBM2015-00132 (Paper 6, “Google Petition”). On June 29, 2015, Google filed a Motion for Joinder (CBM2015-00132, Paper 10) seeking to consolidate its challenge with earlier-filed petitions for covered business method patent reviews of the ’772 patent in *Apple Inc. v. Smartflash LLC*, Cases CBM2015-00031 and CBM2015-00032, which were instituted on May 28, 2015. *See Apple Inc. v. Smartflash, LLC*, Case CBM2015-00031, slip. op. at 19–20 (PTAB May 28, 2015) (Paper 11) (instituting review of claims 1, 5, 8, and 10 of the ’772 patent under 35 U.S.C. § 101); and *Apple Inc. v. Smartflash, LLC*, Case CBM2015-00032, slip. op. at 18–19 (PTAB May 28, 2015) (Paper 11) (instituting review of

² Pub. L. No. 112–29, 125 Stat. 284, 296–07 (2011).

claims 14, 19, and 22 of the '772 patent under 35 U.S.C. § 101). On December 1, 2015, we granted Google's Petition and consolidated its challenge to claims 1, 5, 9, and 10 with CBM2015-00031 and consolidated its challenge to claims 14, 21, and 22 with CBM2015-00032. *Google Inc. v. Smartflash LLC*, Case CBM2015- 00132 (Paper 14). Subsequently, we granted an unopposed request by Apple and Google (collectively, "Petitioner") to consolidate Google's challenge to claims 9 and 21 with CBM2015-00133, instead of with CBM2015-00031 and CBM2015-00032, respectively. Paper 10.

Subsequent to institution, Smartflash LLC ("Patent Owner") filed a Patent Owner Response (Paper 21, "PO Resp.") and Petitioner filed a Reply (Paper 25, "Pet. Reply") to Patent Owner's Response. Patent Owner, with authorization, filed a Notice of Supplemental Authority. Paper 33 ("Notice"). Petitioner filed a Response to Patent Owner's Notice. Paper 34 ("Notice Resp.").

In our Final Decision, we determined Petitioner had established, by a preponderance of the evidence, that claims 2–4, 6, 7, 9, 11–13, 15–18, 20, 21, 23, 24, 27–29, 31, and 33–36 of the '772 patent are directed to patent ineligible subject matter under 35 U.S.C. § 101. Paper 38 ("Final Dec."), 3, 34. Patent Owner requests rehearing of the Final Decision with respect to patent ineligibility of the challenged claims under § 101. Paper 39 ("Request" or "Req. Reh'g"). Having considered Patent Owner's Request, we decline to modify our Final Decision.

STANDARD OF REVIEW

In covered business method review, the petitioner has the burden of showing unpatentability by a preponderance of the evidence. 35 U.S.C. § 326(e). The standard of review for rehearing requests is set forth in 37 C.F.R. § 42.71(d), which states:

The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

ANALYSIS

Patent Owner's Request is based on a disagreement with our determination that the challenged claims are directed to patent-ineligible subject matter. Req. Reh'g 3.

In its Request, Patent Owner initially presents arguments directed to alleged similarities between the challenged claims and those at issue in *DDR Holdings*³, *Enfish*⁴, and *Bascom*⁵. *Id.* at 5–11. Those cases were each addressed in the Patent Owner Response or Patent Owner's Notice, as well as in our Final Decision. As noted above, our rules require that the requesting party “*specifically* identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” 37 C.F.R. 42.71(d) (emphasis added). In its Request, however, Patent Owner does not

³ *DDR Holdings, LLC v. Hotels.com, L.P.*, 773 F.3d 1245 (Fed. Cir. 2014).

⁴ *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327 (Fed. Cir. 2016).

⁵ *BASCOM Global Internet Services, Inc. v. AT&T Mobility, LLC*, 827 F.3d 1341 (Fed. Cir. 2016).

identify any specific matter that we misapprehended or overlooked.

Although Patent Owner repeatedly states that “the Board misapprehends Smartflash’s argument” (*see, e.g.*, Req. Reh’g 5, 10), it offers no explanation as to how we misapprehended or overlooked any particular “matter [that] was previously addressed in a motion, an opposition, or a reply.” In fact, Patent Owner does not cite to its papers even once when alleging an argument was misapprehended with respect to these cases. *See id.* at 5–11. Rather than providing a proper request for rehearing, addressing particular matters that we previously allegedly misapprehended or overlooked, Patent Owner’s Request provides new briefing by expounding on argument already made.

To the extent portions of the Request are supported by Patent Owner’s argument in the Patent Owner Response or in Patent Owner’s Notice, we considered those arguments in our Final Decision, as Patent Owner acknowledges. *See, e.g.*, Req. Reh’g 5, 7, 9 (noting that the Board rejected Smartflash’s argument with respect to each of *DDR Holdings*, *Enfish*, and *Bascom*). The only paper cited by Patent Owner is our Final Decision, which, as noted above, addresses Patent Owner’s arguments related to *DDR Holdings* (Final Dec. 18–22), *Enfish* (*id.* at 12), and *Bascom* (*id.* at 22–23). Patent Owner’s Request is simply based on disagreement with our Final Decision, which is not a proper basis for rehearing.

Patent Owner also presents new arguments directed to alleged similarities between the challenged claims and those addressed in *McRO*⁶

⁶ *McRO, Inc. v. Bandai Namco Games Am. Inc.*, 837 F.3d 1299 (Fed. Cir. 2016).

and *Amdocs*⁷, which were issued after Patent Owner’s Notice was filed. Req. Reh’g 11–15. Patent Owner alleges that we overlooked the Federal Circuit’s decisions in *McRO* and *Amdocs*. *Id.* at 2. The decisions in those cases issued before our Final Decision and, although not specifically referenced, were considered when we determined that the challenged claims are patent-ineligible.

When addressing *McRO*, Patent Owner does little, if anything, to analogize those claims to the challenged claims, other than summarizing the discussion in *McRO* (*id.* at 11–12), and concluding that

[b]ecause the challenged claims are a technological improvement over the then-existing systems and methods, and limit transfer and retrieval of multimedia content based on payment validation in a process specifically designed to achieve an improved technological result in conventional industry practice, the challenged claims are not directed to an abstract idea.

Id. at 13 (citing Ex. 1001, 26:35–37 (claim 1)). But *McRO* does not stand for the general proposition that use of rules or conditions to achieve an improved technological result, alone, removes claims from the realm of abstract ideas. In *McRO*, the Court explained that “the claimed improvement [was] allowing computers to produce ‘accurate and realistic lip synchronization and facial expressions in animated characters’ that previously could only be produced by human animators.” *Id.* at 1313 (citation omitted). The Court explained that the claimed rules in *McRO* transformed a traditionally *subjective* process performed by human artists into a mathematically *automated* process executed on computers (i.e., the processes were fundamentally different). *Id.* at 1314. The Court explained

⁷ *Amdocs (Israel) Ltd. v. Openet Telecom, Inc.*, 841 F.3d 1288 (Fed. Cir. 2016).

that “it [was] the incorporation of the claimed rules, not the use of the computer, that ‘improved [the] existing technological process’ by allowing the automation of further tasks.” *Id.* at 1314 (alteration in original) (quoting *Alice Corp. Pty. Ltd. v. CLS Bank Int’l.*, 134 S. Ct. 2347, 2358 (2014)). The Court distinguished this from situations “where the claimed computer-automated process and the prior method were carried out in the same way.” *Id.* (citing *Parker v. Flook*, 437 U.S. 584, 585–86 (1978); *Bilski v. Kappos*, 561 U.S. 593, 611 (2010); *Alice*, 134 S. Ct. at 2356)).

As explained in our Final Decision, the challenged claims “merely implement an old practice in a new environment.” Final Dec. 12–13 (quoting *FairWarning IP, LLC v. Iatric Systems, Inc.*, 839 F.3d 1089, 1094 (Fed. Cir. 2016)). The challenged claims are similar to the claims found ineligible in *FairWarning*, which the Court distinguished from those at issue *McRO*. *FairWarning*, 839 F.3d at 1094–95. In *FairWarning*, the Court explained that “[t]he claimed rules ask . . . the same questions . . . that humans in analogous situations . . . have asked for decades, if not centuries” and that it is the “incorporation of a computer, *not* the claimed rule, that purportedly ‘improve[s] [the] existing technological process.’” *Id.* at 1095 (citing *Alice*, 134 S. Ct. at 2358). This is similar to the challenged claims, where the “payment validation data” in claim 2, for example, is merely a condition for “enabl[ing] access to . . . multimedia content” that the ’772 patent explains “will normally be dependent upon payments made for data stored on the data carrier” (i.e., allowing access when the data has been purchased). Ex. 1001, 9:28–30.

With respect to *Amdocs*, after generally summarizing that case, Patent Owner concludes that “the challenged claims of the ’772 Patent are like the

eligible claim in *Amdocs* because they solve a problem unique to computer networks . . . and use an unconventional technological approach.” Req. Reh’g 15 (citing PO Resp. 55)⁸. We disagree.

In *Amdocs*, the Court held that “[claim 1] is eligible under step two because it contains a sufficient ‘inventive concept.’” *Amdocs*, 841 F.3d at 1300. The claim at issue recited “computer code for using the accounting information with which the first network accounting record is correlated to enhance the first network accounting record.” *Id.* The Court explained that the “claim entails an unconventional technological solution (enhancing data in a distributed fashion) to a technological problem (massive record flows which previously required massive databases).” *Id.* The Court noted that, although the solution requires generic computer components, “the claim’s enhancing limitation necessarily requires that these generic components operate in an unconventional manner to achieve an improvement in computer functionality.” *Id.* at 1300–1301. When determining that the claim was patent-eligible, the Court explained that the “enhancing limitation necessarily involves the arguably generic gatherers, network devices, and other components working in an unconventional distributed fashion to solve a particular technological problem.” *Id.* at 1301. The Court distinguished the claim from the claim held unpatentable in *Content Extraction & Transmission LLC v. Wells Fargo Bank, Nat’l Ass’n*, 776 F.3d 1343 (Fed. Cir. 2014) on the grounds that the “enhancing limitation . . . necessarily incorporates the invention’s distributed architecture—an architecture providing a technological solution to a technological problem,” which

⁸ This is the only instance where one of Patent Owner’s papers is cited in the Request.

“provides the requisite ‘something more’ than the performance of ‘well-understood, routine, [and] conventional activities previously known to the industry.’” *Id.* (citations omitted).

We are not persuaded that we misapprehended *Amdocs*. As noted in our Final Decision, “[t]he ’772 patent treats as well-known all potentially technical aspects of the challenged claims, which simply require generic computer components.” Final Dec. 15. Unlike the generic components at issue in *Amdocs*, the generic components recited in claims 2–4, 6, 7, 9, 11–13, 15–18, 20, 21, 23, 24, 27–29, 31, and 33–36 of the ’772 patent do not operate in an unconventional manner to achieve an improvement in computer functionality. See Final Dec. 20–24. Claims 2–5, 7, 9, and 12 of the ’772 patent simply recite generic memories and data types with no description of the underlying implementation or programming.

Accordingly, Patent Owner’s Request does not apprise us of sufficient reason to modify our Final Decision.

ORDER

Accordingly, it is:

ORDERED that Patent Owner’s Request is *denied*.

CBM2015-00133
Patent 8,336,772 B2

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