

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DELL, INC.
Petitioner

v.

DISPOSITION SERVICES, LLC
Patent Owner

Case CBM2013-00040
Patent 5,424,944

PATENT OWNER DISPOSITION SERVICES, LLC'S
PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
U.S. Patent & Trademark Office
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35 U.S.C. § 3241

List of Exhibits

Exhibit No.	Description
2001	Statutory Disclaimer of Claim 7 of the '944 Patent
2002	157 Cong. Rec. S1053 (daily ed. March 1, 2011) (statement by Sen. Schumer)
2003	Report on the America Invents Act by the House Committee on the Judiciary to H.R. Rep. No. 112-98, Part 1 at p. 54 (2011)
2004	157 Cong. Rec. S1360-94 (March 8, 2011)
2005	S.866, Patent Quality Improvement Act of 2013, Summary (authored by the Congressional Research Service)

I. STATEMENT OF PRECISE RELIEF REQUESTED

In accordance with 37 C.F.R. § 42.207(a), Patent Owner, Disposition Services, LLC, submits this Preliminary Response to Petitioner’s Petition for Covered Business Method (CBM) patent review (“the Petition”). Patent Owner respectfully requests that the Patent Trial and Appeal Board (“PTAB”) deny the Petition for review of Claims 1-23 of U.S. Patent No. 5,424,944 (“the ’944 patent”) under § 18 of the America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) on the grounds that the ’944 patent is not a CBM patent, and is unrelated to the practice, management or administration of a financial product or service. For at least the reasons set forth below, the PTAB must elect not to institute post-grant review under 35 U.S.C. § 324.

II. PETITIONER LACKS STANDING BECAUSE THE ’944 PATENT IS NOT A COVERED BUSINESS METHOD PATENT

Section 18 of the AIA provides for the creation of a transitional program for reviewing covered business method patents. Section 18 limits reviews to persons or their privies that have been sued or charged with infringement of a “covered business method patent.” Notably, this does not include patents for “technological inventions.” AIA §§ 18(a)(1)(B), 18(d)(1); *see* 37 C.F.R. § 42.302.

Patent Owner respectfully submits that, in violation of 37 C.F.R. § 42.304(a), Petitioner has failed to demonstrate that the ’944 patent is a covered

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