

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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BRANCH BANKING AND TRUST COMPANY  
Petitioner

v.

MAXIM INTEGRATED PRODUCTS, INC.  
Patent Owner

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Case CBM2013-00059  
Patent 5,949,880

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**PATENT OWNER MAXIM INTEGRATED PRODUCTS, INC.'S  
PRELIMINARY RESPONSE TO PETITION FOR COVERED BUSINESS  
METHOD PATENT REVIEW OF UNITED STATES PATENT NO.  
5,949,880 PURSUANT TO 35 U.S.C. § 321, 37 C.F.R. § 42.304**

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<b>EXHIBIT LIST</b>	
Exhibit 2001	Branch Banking and Trust Company's Complaint (EFC No. 1), <i>Branch Banking &amp; Trust Co. v. Maxim Integrated Prods., Inc.</i> , No. 2:12-cv-00945 (W.D. Pa.)
Exhibit 2002	Memorandum Of Law In Support Of Defendant USPTO Director's Motion To Dismiss, <i>Versata Dev. Group v. Rea</i> , No. 1:13-cv-00328-GBL-IDD (E.D. Va. May 16, 2013)
Exhibit 2003	Elizabeth Laughton, "Can a declaratory judgment plaintiff file a CBM petition?," Finnegan—America Invents Act (Jun. 18, 2013)
Exhibit 2004	Special Master's Report And Recommendation Re: Claim Construction, <i>In re Maxim Integrated Prods., Inc.</i> , MDL No. 2354 (W.D. Pa. Oct. 9, 2013)
Exhibit 2005	Memorandum Opinion, MDL No. 2354 (W.D. Pa. Dec. 17, 2013)
Exhibit 2006	Order, MDL No. 2354 (W.D. Pa. Dec. 17, 2013)
Exhibit 2007	Lori Gordon, "IP: The power of the covered business method review—The AIA provides an effective new tool for companies accused of infringement of financial patents," <i>Inside Counsel</i> (Jan. 1, 2013)

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Pursuant to 35 U.S.C. § 323, America Invents Act of 2011 (“AIA”) § 18(a)(1), and 37 C.F.R. §§ 42.207-208, the undersigned, on behalf of and acting in a representative capacity for patent owner, Maxim Integrated Products, Inc. (“Patent Owner” or “Maxim”), submits the following Preliminary Response to the Petition for covered business method patent review filed in the above-captioned proceeding by Petitioner Branch Banking And Trust Company (“BB&T”) against United States Patent No. 5,949,880 (“the ’880 patent” or “the Patent”).

## **I. INTRODUCTION**

As a matter of law, this case cannot proceed. Because Petitioners filed a declaratory judgment action in federal court seeking to invalidate the Patent on June 18, 2012, months before it filed its petition challenging the same Patent in the case at hand, the Board is statutorily barred from instituting review by 35 U.S.C. § 325(a)(1). That provision states that a post-grant review may not be instituted if a civil action challenging the validity of the patent has previously been filed. AIA § 18, in turn, makes clear that covered business method patent reviews shall be

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