

IN THE UNITED STATES PATENT TRIAL AND APPEAL BOARD

In re *Post-Grant Review* of:)
)
U.S. Patent No. 5,940,510) U.S. Class: 380/25
)
Issued: August 17, 1999)
)
Inventors: Stephen M. Curry et al.)
)
Application No. 08/594,975)
)
Filed: January 31, 1996)
) FILED ELECTRONICALLY
For: TRANSFER OF VALUABLE) PER 37 C.F.R. § 42.6(b)(1)
INFORMATION BETWEEN)
A SECURE MODULE AND)
ANOTHER MODULE)

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

**PETITION FOR POST-GRANT REVIEW UNDER 35 U.S.C. § 321 AND
§ 18 OF THE LEAHY-SMITH AMERICA INVENTS ACT**

Pursuant to 35 U.S.C. § 321 and § 18 of the Leahy-Smith America Invents Act (“AIA”) and pursuant to 37 C.F.R. § 42.300 *et seq.*, PNC Bank, N.A. (“PNC”), JP Morgan Chase & Co., and JP Morgan Chase Bank, N.A. (“JP Morgan”) (collectively, “Petitioner”) hereby requests post-grant review of claims 1, 3, 5, and 6 of U.S. Patent No. 5,940,510 (“the ’510 patent,” attached as Petition Exhibit 1001), now purportedly assigned to Maxim Integrated Products, Inc. (“Maxim”).

An electronic payment in the amount of \$30,000.00 for the post-grant review fee specified by 37 C.F.R. § 42.15(b)(1)—comprising the \$12,000.00 request fee and \$18,000.00 post-institution fee—is being paid at the time of filing this petition. If there are any additional fees due in connection with the filing of this paper, please charge the required fees to our deposit account no. 06-0916.

TABLE OF CONTENTS

I. PRELIMINARY STATEMENT1

II. MANDATORY NOTICES2

 A. Real Party-in-Interest.....2

 B. Related Matters.....2

 C. Lead and Back-Up Counsel and Service Information5

III. OVERVIEW OF THE '510 PATENT AND ITS PROSECUTION HISTORY5

 A. Specification5

 B. Challenged Claims8

 C. Prosecution History.....10

IV. GROUNDS FOR STANDING.....11

 A. At Least One Challenged Claim Is Unpatentable.....11

 B. The '510 Patent is a Covered Business Method Patent.....12

 C. Claims 1, 3, 5, and 6 are Not Directed to a “Technological Invention”13

 D. Petitioner has been Sued for Infringement of the '510 Patent and is Not Estopped16

V. STATEMENT OF PRECISE RELIEF REQUESTED FOR EACH CLAIM CHALLENGED16

 A. Claims for which Review is Requested.....16

 B. Statutory Grounds of Challenge.....16

 C. Claim Construction17

 1. Broadest Reasonable Interpretation.....17

VI. CLAIMS 1, 3, 5, AND 6 OF THE '510 PATENT ARE UNPATENTABLE	21
A. Claims 1, 3, 5, and 6 are Invalid Under 35 U.S.C. § 103	21
1. The combination of <i>Cremin</i> and <i>Tamada</i> renders the challenged claims obvious	21
2. The combination of <i>Cremin</i> , <i>Tamada</i> , and <i>Schneier</i> renders claims 5 and 6 obvious	37
3. The combination of <i>Rosen</i> and <i>Tamada</i> renders the challenged claims obvious	38
B. Claims 1, 3, 5, and 6 Are Invalid Under 35 U.S.C. § 101	50
1. The '510 Patent Claims are Directed to an Abstract Idea	50
2. The '510 Patent Claims do not Recite “Significantly More” than the Abstract Idea	51
VII. CONCLUSION.....	52

TABLE OF AUTHORITIES

	Page(s)
FEDERAL CASES	
<i>Bilski v. Kappos</i> , 130 S. Ct. 3218 (2010)	50
<i>CyberSource Corp. v. Retail Decisions, Inc.</i> , 654 F.3d 1366 (Fed. Cir. 2011)	51
<i>Gottschalk v. Benson</i> , 409 U.S. 63 (1972)	52
<i>In re Bilski</i> , 545 F.3d 943 (Fed. Cir. 2008) (Rader, J., dissenting)	50
<i>In re Maxim Integrated Prods., Inc.</i> , Case No. 2:12-mc-00244, MDL No. 2354 (“Maxim MDL”)	2
<i>Maxim Integrated Prods., Inc. v. JP Morgan Chase & Co.</i> , Case No. 2:12-cv-01641-JFC (W.D. Pa.)	2
<i>Mayo Collaborative Servs. v. Prometheus Labs., Inc.</i> , 132 S. Ct. 1289 (2012)	50, 51, 52
<i>Parker v. Flook</i> , 437 U.S. 584 (1978)	51
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc)	17
<i>PNC Fin. Servs. Grp., Inc. v. Maxim Integrated Prods., Inc.</i> , Case No. 2:12-cv-00089-JFC (W.D. Pa.)	2
FEDERAL STATUTES	
A.I.A. § 18	16, 53
35 U.S.C. § 101	passim
35 U.S.C. § 102	4, 53
35 U.S.C. § 103	passim

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.