UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_\_

BEFORE THE PATENT TRIAL AND APPEAL BOARD

\_\_\_\_

PNC BANK, N.A., JP MORGAN CHASE & CO. AND JP MORGAN CHASE BANK, N.A. Petitioner

V.

MAXIM INTEGRATED PRODUCTS, INC.
Patent Owner

\_\_\_\_\_

Case CBM2014-00039 Patent 5,949,880

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



### **TABLE OF CONTENTS**

I. II	NTR	ODUCTION	1				
II. U	NDI	ER 35 U.S.C. § 325(A)(1) AND AMERICA INVENTS ACT					
	§ 1	8(A)(1), INSTITUTION OF REVIEW IS BARRED BY PNC'S					
		IOR CIVIL ACTION.	3				
	A.	PNC Previously "Filed A Civil Action Challenging The Validity Of A Claim C Patent."					
	В.	For Purposes Of 35 U.S.C. § 325(a)(1), A CBM Patent Review Is A "Post-Gran Review."	8				
		<ol> <li>The Plain Meaning Of AIA § 18(a)(1) Requires CBM Patent Reviews To Employ The Standards And Procedures Of Post-Grant Reviews</li> <li>Legislative History Confirms That CBM Patent Review Functions Like F</li> </ol>	10 Post-				
		Grant Review	То				
	C.	Regulations Cannot Narrow The § 325(a)(1) Bar.	20				
	D.	The Inclusion Of The JP Morgan Entities As "Petitioner" In Addition To PNC	Does				
		Not Change The Applicability of The 35 U.S.C. § 325(a)(1) Statutory Bar  1. <i>PNC's Prior Action Satisfies § 325(a)(1)'s Requirement That "The</i>	25				
		Petitioner" Have Filed A Prior Action Challenging The Patent	26				
		2. PNC's Status As "Real Party In Interest" Is An Independently Sufficient					
		Reason For PNC's Prior Action To Raise The § 325(a)(1) Bar Again	st All				
		Entities Forming Petitioner	28				
III.		INSTITUTION OF REVIEW WERE NOT CATEGORICALLY					
	BARRED UNDER 35 U.S.C. § 325, REVIEW STILL SHOULD NOT						
	BE	INITIATED UNDER EITHER 35 U.S.C. § 324 OR § 325	35				
	A.	The Petition Makes No Showing Of Ineligible Subject Matter	37				
		1. The Claims Do Not Merely Recite An Abstract Idea	38				
		2. The "Machine-Or-Transformation" Test Is Satisfied	41				
		3. Recent Case Law Confirms Petitioner's Failure Of Proof	43				
		4. The dependent claims' additional limitations only reinforce the patent-					
		eligibility of the claimed subject matter.					
	B.	The Same Or Substantially The Same Arguments Were Previously Presented T Office.					



## Case CBM2014-00039 Patent 5,949,880 Attorney Docket No. 131209-002USCBM

	1.	The Office Has Previously Been Presented With The Arg	ument That Nakano
		Invalidates These Claims	51
	2.	The Office Has Also Previously Been Presented With The	e Argument That The
		Claims Are Ineligible Subject Matter	52
	3.	The Board Should "Reject The Petition" In Its Entirety U	Inder 35 U.S.C.
		§ 325(d).	55
IV.	CONCL	USION	59



### **TABLE OF AUTHORITIES**

ra	ige(s)
COURT DECISIONS	
Andrus v. Glover Construction Co., 446 U.S. 608 (1980)	2, 13
Bilski v. Kappos, 130 S. Ct. 3218 (2010)	38, 39
Conte v. Justice, 996 F.2d 1398, 1402 (2d Cir. 1993) ); cf. Watts v. Swiss Bank Corp., 27 N. 270, 278 (1970)	
Cook v. Principi, 318 F.3d 1334 (Fed. Cir. 2002)	0, 13
CyberSource Corp. v. Retail Decisions, Inc., 654 F.3d 1366 (Fed. Cir. 2011)	12, 46
Dealertrack, Inc. v. Huber, 674 F.3d 1315 (2012)	42
Diamond v. Diehr, 450 U.S. 175 (1981)	16, 47
Fireman's Fund Ins. Co. v. England, 313 F.3d 1344 (Fed. Cir. 2002)	16
Ford Motor Co. v. United States, 715 F.3d 906 (Fed. Cir. 2013)	19
Hillman v. Marietta, 569 U.S. 133 S. Ct. 1943 (2013)	13



111 F.3d 1569 (Fed. Cir. 1997)	10
K Mart Corp. v. Cartier, 486 U.S. 281 (1988)	23
Law v. Siegel, 571 U.S, S. Ct, 2014 U.S. LEXIS 1784 (Mar. 4, 2014)	10, 11, 13
Mayo Collaborative Servs. v. Prometheus Labs., Inc., 132 S. Ct. 1289 (2012)	39, 40
Milam v. Director, Office of Worker's Comp. Progs., 874 F.2d 223 (4th Cir. 1989)	13
Mills Music, Inc. v. Snyder, 469 U.S. 153 (1985)	9
TRW Inc. v. Andrews, 534 U.S. 19 (2001)	11, 12
Ultramercial, Inc. v. Hulu, LLC, 722 F.3d 1335 (Fed. Cir. 2013), pet. for cert. filed sub nom, Wild Tange v. Ultramercial, LLC, No. 13-255 (Aug. 23, 2013)39, 41, 42, 43, 4	
Versata Dev. Gp. v. Rea, 2013 WL 4014649 (E.D. Va. Aug. 7, 2013), appeal filed, No. 14-1145 Cir. Dec. 2, 2013)	•
Watts v. Swiss Bank Corp., 27 N Y 2d 270, 278 (1970)	34



# DOCKET

# 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.

