IN THE UNITED STATES PATENT TRIAL AND APPEAL BOARD

In re <i>Post-Grant Review</i> of:)
U.S. Patent No. 5,949,880) U.S. Class: 380/24
Issued: Sept. 7, 1999)
Inventors: Stephen M. Curry et al.)
Application No. 09/950,559)
Filed: Nov. 26, 1997))) EHED ELECTRONICALLY
For: TRANSFER OF VALUABLE INFORMATION BETWEEN A SECURE MODULE AND) FILED ELECTRONICALLY) PER 37 C.F.R. § 42.6(b)(1))
ANOTHER MODULE)

Mail Stop Patent Board

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

<u>PETITION FOR POST-GRANT REVIEW UNDER 35 U.S.C. § 321 AND</u> § 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., JP Morgan Chase & Co., and JP Morgan Chase Bank, N.A. (collectively, "Petitioner") hereby request post-grant review of claims 1-4 of U.S. Patent No. 5,949,880 ("the '880 patent"), attached as Petition Exhibit 1001), purportedly now 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 STATEMENT					
II.	MANDATORY NOTICES					
	Α.	Real Party-in-Interest				
	В.	Related Matters	3			
	C.	Lead and Back-Up Counsel and Service Information	5			
III.	GRO	OUNDS FOR STANDING	6			
	Α.	Background	6			
		1. The '880 Patent	6			
		2. Prosecution History	8			
	В.	At Least One Challenged Claim Is Unpatentable				
	C.	The '880 Patent Is a Covered Business Method Patent				
	D.	Claims 1-4 are Not Directed to a "Technological Invention"				
		The '880 Patent does Not Claim a Novel and Unobvious Technological Feature	11			
		2. The Patent does Not Solve a Technical Problem using a Technological Solution.	12			
	Е.	Petitioner has been Sued for Infringement of the '880 Patent and is Not Estopped				
Γ		TATEMENT OF PRECISE RELIEF REQUESTED FOR CHALLENGED	13			
	Α.	A. Claims for which Review Is Requested				
	В.	Statutory Grounds of Challenge13				
	C.	Claim Construction1				



		1.	Broadest Reasonable Interpretation	13
V.	CLA	IMS 1	-4 OF THE '880 PATENT ARE UNPATENTABLE	16
	Α.	Clair	ns 1-4 Are Invalid Under 35 U.S.C. § 101	16
		1.	The '880 Patent is Unpatentably Abstract	17
		2.	The Challenged Claims Recite Generic, Conventional, and Routine Technology	17
		3.	Considered as a Whole, the Patent Claims are Directed to an Abstract Idea that Preempts Practical Applications	21
		4.	The '880 Claims Fail the Machine or Transformation Test	28
	В.	Clair	ns 1-4 Are Invalid Under 35 U.S.C. § 102	33
		1.	Akiyama anticipates the challenged claims	33
		2.	Ishiguro anticipates the challenged claims	41
		3.	Nakano anticipates the challenged claims	46
	C.	Clai	ms 1-4 Are Invalid Under 35 U.S.C. § 103	65
		1.	Nakano in combination with Akiyama renders the challenged claims obvious.	65
VI.	CON	ICLU	SION	68



TABLE OF AUTHORITIES

Cases Page(s)
Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada, 771 F. Supp. 2d 1054 (E.D. Mo. 2011)
Bancorp Servs., L.L.C. v. Sun Life Assur. Co. of Canada, 687 F.3d 1266 (Fed. Cir. 2012)
<i>In re Bilski</i> , 545 F.3d. 943 (Fed. Cir. 2008)
Bilski v. Kappos, 130 S. Ct. 3218 (2010)
Cardpool, Inc. v. Plastic Jungle, Inc., No. C 12-04182, 2013 U.S. Dist. LEXIS 9280 (N.D. Cal. Jan. 22, 2013)30
Ex parte Cherkas, No. 2009-011287, 2010 WL 4219765 (B.P.A.I. Oct. 25, 2010)27
CyberSource Corp. v. Retail Decisions, Inc., 654 F.3d 1366 (Fed. Cir. 2011)
Dealertrack, Inc. v. Huber, 674 F.3d 1315,1333 (Fed. Cir. 2012)passin
Dealertrack, Inc. v. Huber, No. 2:06-cv-02335-AG-FMO, slip op. (C.D. Cal. Sept. 27, 2008)31
Diamond v. Diehr, 450 U.S. 175 (1981)20, 25, 26, 33
Fort Props., Inc. v. Am. Master Lease LLC, 671 F.3d 1317 (Fed. Cir. 2012)
Gottschalk v. Benson, 409 U.S. 63 (1972)23, 24, 25, 31
In re Grams, 888 F 2d 835 (Fed. Cir. 1989) 23, 27, 30



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.

