

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Hulst et al.	§	Attorney Docket No.:
United States Patent No.: 8,033,458	§	104677-5008-814
Formerly Application No.: 12/943,847	§	Customer No. 28120
Issue Date: October 11, 2011	§	
Filing Date: November 10, 2010	§	Petitioner: Apple Inc.
Former Group Art Unit: 2887	§	
Former Examiner: Thien M. Le	§	

For: Data Storage and Access Systems

MAIL STOP PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
Post Office Box 1450
Alexandria, Virginia 22313-1450

**PETITION FOR COVERED BUSINESS METHOD PATENT REVIEW OF
UNITED STATES PATENT NO. 8,033,458 PURSUANT TO 35 U.S.C. § 321,
37 C.F.R. § 42.304**

TABLE OF CONTENTS

I.	INTRODUCTION.....	1
II.	OVERVIEW OF FIELD OF THE CLAIMED INVENTION	6
III.	PETITIONER HAS STANDING	11
	A. The '458 Patent Is a Covered Business Method Patent.....	11
	1. Exemplary Claim 1 Is Financial In Nature	12
	2. Claim 1 Does Not Cover A Technological Invention	15
	B. Related Matters and Mandatory Notice Information; Petitioner Is a Real Party In Interest Sued for and Charged With Infringement	20
IV.	DETAILED EXPLANATION OF REASONS FOR RELIEF REQUESTED, SHOWING IT IS MORE LIKELY THAN NOT THAT AT LEAST ONE CHALLENGED CLAIMS IS UNPATENTABLE	21
	A. Claim Construction.....	21
	B. The Challenged Claims are Unpatentable Under § 101	26
	1. Claims Are Directed To Abstract Ideas	27
	2. Claims Do Not Disclose An “Inventive Concept” That Is “Significantly More” Than An abstract Idea	30
	3. Field Of Use Limitations Cannot Transform Abstract Ideas Into Patent Eligible Inventions.....	31
	4. Generic Computer Implementation Cannot Transform Ab- stract Ideas Into Patent Eligible Inventions.....	31
	5. The Functional Nature Of The Challenged Claims Con- firms Preemption and Patent Ineligibility	37
	6. Machine-or-Transformation Test Confirms Patent Ineligi- bility.....	39
	C. Claims 6, 8, 10, and 11 Are Unpatentable Under §103.....	40
	1. Overview of Stefik	40
	2. Motivation to Combine Stefik with Ahmad	45
	3. Motivation to Combine Stefik with Ahmad and Kopp	47
	4. Motivation to Combine Stefik with Ahmad and Sato.....	49

5.	Motivation to Combine Stefik with Ahmad, and Ginter.....	50
6.	Claims 6 and 8 are Obvious in Light of Stefik in View of Ahmad (Ground 2); Claims 6 and 8 are Obvious in Light of Stefik in View of Ahmad and Kopp (Ground 3); Claims 6 and 8 are Obvious in Light of Stefik in View of Ahmad and Sato (Ground 4); Claims 6 and 8 are Obvious in Light of Stefik in View of Ahmad, Kopp, and Sato (Ground 5); Claims 10 and 11 are Obvious in Light of Stefik in View of Ahmad and Ginter (Ground 6); Claims 10 and 11 are Obvious in Light of Stefik in View of Ahmad, Kopp, and Ginter (Ground 7).....	53
D.	Claim 11 is indefinite under §112(b).....	78
V.	CONCLUSION.....	79

EXHIBIT LIST	
1201	U.S. Patent No. 8,033,458
1202	Plaintiffs' First Amended Complaint
1203	U.S. Patent No. 5,925,127
1204	File History for U.S. Patent No. 8,033,458
1205	U.S. Patent No. 5,940,805
1206	U.S. Patent No. 4,999,806
1207	U.S. Patent No. 5,675,734
1208	Russell Housley and Jan Dolphin, "Metering: A Pre-pay Technique," Storage and Retrieval for Image and Video Databases V, Conference Volume 3022, 527 (January 15, 1997)
1209	U.S. Patent No. 4,878,245
1210	U.S. Patent No. 7,334,720
1211	U.S. Patent No. 4,337,483
1212	U.S. Patent No. 5,103,392
1213	U.S. Patent No. 5,530,235
1214	U.S. Patent No. 5,629,980
1215	U.S. Patent No. 5,915,019
1216	European Patent Application, Publication No. EP0809221A2
1217	International Publication No. WO 99/43136
1218	JP Patent Application Publication No. H11-164058 (translation)
1219	Eberhard von Faber, Robert Hammelrath, and Franz-Peter Heider, "The Secure Distribution of Digital Contents," IEEE (1997)

EXHIBIT LIST	
1220	Declaration of Anthony J. Wechselberger In Support of Apple Inc.'s Petition for Covered Business Method Patent Review
1221	Declaration of Michael P. Duffey In Support of Apple Inc.'s Petition for Covered Business Method Patent Review
1222	Declaration of Megan F. Raymond In Support of Apple Inc.'s Petition for Covered Business Method Patent Review
1223	U.S. Patent No. 8,118,221
1224	File History for U.S. Patent No. 8,061,598
1225	Claim Construction Memorandum Opinion from Smartflash LLC v. Apple Inc., No. 6:13cv447 (Dkt. 229)
1226	U.S. Patent No. 7,725,375

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.