5

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Racz et al.	S	Attorney Docket No.:
United States Patent No.: 8,061,598	S	104677-5008-81.
Formerly Application No.: 13/012,541	S	Customer No. 28120
Issue Date: November 22, 2011	S	
Filing Date: January 24, 2011	S	Petitioner: Apple Inc.
Former Group Art Unit: 2887	S	
Former Examiner: Thien M. Le	6	

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. 8,061,598 PURSUANT TO 35 U.S.C. § 321, 37 C.F.R. § 42.304



TABLE OF CONTENTS

I.	INTI	RODU	CTION	1
II.	OVE	ERVIE	W OF FIELD OF THE CLAIMED INVENTION	6
III.	PET	ITION	IER HAS STANDING	12
	Α.	The '	598 Patent Is a Covered Business Method Patent	12
		1.	Exemplary Claim 7 Is Financial In Nature	13
		2.	Claim 7 Does Not Cover A Technological Invention	17
	В.		ed Matters and Mandatory Notice Information; Petitioner Is a la In Interest Sued for and Charged With Infringement	
IV.	SHO	WINC	D EXPLANATION OF REASONS FOR RELIEF REQUEST G IT IS MORE LIKELY THAN NOT THAT AT LEAST ON HALLENGED CLAIMS IS UNPATENTABLE	ΙΕ
	Α.		n Construction	
	В.		Challenged Claims Are Unpatentable Under § 101	
		1.	Claims Are Directed To Abstract Ideas	
		2.	Claims Do Not Disclose An "Inventive Concept" That Is "Significantly More" Than an Abstract Idea	33
		3.	Field Of Use Limitations Cannot Transform Abstract Ideas Into Patent Eligible Inventions	33
		4.	Generic Computer Implementation Cannot Transform Abstract Ideas Into Patent Eligible Inventions	34
		5.	The Functional Nature Of The Challenged Claims Confirms preemption and Patent Ineligibility	39
		6.	Machine-or-Transformation Test Also Confirms Patent Ineligibility	41
	C.	The C	Challenged Claims Are Unpatentable Under § 103	41
		1.	Overview of Stefik	41
		2.	Motivation to Combine Stefik with Ahmad	45
		3.	Motivation to Combine Stefik with Ahmad and Kopp	47
		4.	Claims 1, 2, 15, and 31 are Obvious in Light of Stefik in View of Ahmad (Ground 2); Claims 1, 2, 15, and 31 are Obvious in Light of Stefik in View of Ahmad and Kopp (Ground 3)	48



Covered	d Busine	ess M	ethod	Pate:	nt Rev	iew
U	Inited St	ates I	Patent	No.	8,061,	598

CONCLUSION.....79 V.



EXHIBIT LI	EXHIBIT LIST		
1201	U.S. Patent No. 8,061,598		
1202	Plaintiffs' First Amended Complaint		
1203	U.S. Patent No. 5,925,127		
1204	U.S. Patent No. 5,940,805		
1205	Russell Housley and Jan Dolphin, "Metering: A Pre-pay Technique," Storage and Retrieval for Image and Video Data- bases V, Conference Volume 3022, 527 (January 15, 1997)		
1206	U.S. Patent No. 4,999,806		
1207	U.S. Patent No. 5,675,734		
1208	U.S. Patent No. 4,878,245		
1209	U.S. Patent No. 7,334,720		
1210	U.S. Patent No. 7,942,317		
1211	U.S. Patent No. 5,103,392		
1212	U.S. Patent No. 5,530,235		
1213	U.S. Patent No. 5,629,980		
1214	U.S. Patent No. 5,915,019		
1215	European Patent Application, Publication No. EP0809221A2		
1216	International Publication No. WO 99/43136		
1217	JP Patent Application Publication No. H11-164058 (translation)		
1218	Eberhard von Faber, Robert Hammelrath, and Frank-Peter Heider, "The Secure Distribution of Digital Contents," IEEE (1997)		
1219	Declaration of Anthony J. Wechselberger In Support of Apple Inc.'s Petition for Covered Business Method Patent Review		



Covered Business Method Patent Review United States Patent No. 8,061,598

EXHIBIT LI	ST
1220	U.S. Patent No. 8,033,458
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	Claim Construction Memorandum Opinion from <i>Smartflash</i> LLC v. Apple Inc., No. 6:13cv447 (Dkt. 229)
1224	File History for U.S. Patent No. 8,061,598
1225	U.S. Patent No. 4,337,483
1226	U.S. Patent No. 7,725,375
1227	International Publication No. WO 95/34857



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.

