

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

COMPASS BANK, AMERICAN EXPRESS COMPANY, AMERICAN
EXPRESS TRAVEL RELATED SERVICES COMPANY, INC.,
DISCOVER FINANCIAL SERVICES, DISCOVER BANK, DISCOVER
PRODUCTS INC., NAVY FEDERAL CREDIT UNION, AND STATE
FARM MUTUAL AUTOMOBILE INSURANCE COMPANY

Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.

Patent Owner.

Case No. To Be Assigned
Patent No. 6,105,013

**PETITION FOR COVERED BUSINESS METHOD PATENT REVIEW
UNDER 35 U.S.C. §§ 321-329 AND § 18 OF THE LEAHY-SMITH
AMERICA INVENTS ACT**

TABLE OF CONTENTS

	Page
TABLE OF CONTENTS.....	i
TABLE OF AUTHORITIES.....	iii
LIST OF EXHIBITS.....	vi
I. MANDATORY NOTICES (37 C.F.R. § 42.8(a)(1)).....	1
A. Real Party-In-Interest (37 C.F.R. § 42.8(b)(1)).....	1
B. Related Matters (37 C.F.R. § 42.8(b)(2)).....	1
C. Lead and Backup Counsel (37 C.F.R. § 42.8(b)(3)) and Service Information (37 C.F.R. § 42.8(b)(4)).....	4
II. FEES (37 C.F.R. § 42.203).....	4
III. INTRODUCTION TO THE 013 PATENT	4
A. Overview of the 013 Patent	4
B. 013 Patent Prosecution History Summary.....	6
IV. REQUIREMENTS FOR CBM REVIEW UNDER 37 C.F.R. § 42.304	7
A. Grounds for Standing (37 C.F.R. § 42.304(a))	7
1. Eligibility Requirements of 37 C.F.R. § 42.302	8
2. Timing Requirements of 37 C.F.R. § 42.303	8
3. The 013 Patent is a Covered Business Method Patent	8
a. The Challenged Claims Are Directed to a “Financial Product or Service”.....	10
b. The Challenged Claims Are Not Directed to a “Technological Invention”	14
(i) The Patent Does Not Recite a Technological Feature That is Novel and Unobvious.....	14
(ii) The Patent Does Not Solve a Technical Problem Using a Technical Solution	18
B. Citation of Prior Art.....	19
C. Claims and Statutory Grounds (37 C.F.R. §§ 42.304(b)(1) & (b)(2))	20
D. Claim Construction (37 C.F.R. § 42.304(b)(3))	21
E. Person of Ordinary Skill in the Art.....	28
F. Unpatentability of the Construed Claims (37 C.F.R. § 42.304(b)(4)).....	28
G. Supporting Evidence (37 C.F.R. § 42.304(b)(5)).....	28
V. AT LEAST ONE CLAIM OF THE 013 PATENT IS UNPATENTABLE	29
A. Prior art.....	29
1. Sudia (Ex. 1005)	29

2.	Hawkes (Ex. 1006)	32
3.	Axelson (Ex. 1007).....	35
4.	Lancaster (Ex. 1008).....	35
5.	Lee (Ex. 1009).....	36
B.	Ground I: Sudia Renders Obvious Claims 1-4, 6-12, 14-16 Under 35 U.S.C. § 103	36
C.	Ground II: Hawkes Renders Obvious Claims 1-4, 6-12, 14-16 Under 35 U.S.C. § 103.....	55
D.	Ground III: Claim 5 is Obvious Under 35 U.S.C. § 103 in View of Sudia or Hawkes Alone or in Combination with One or More of Axelson or Lancaster.....	73
E.	Ground IV: Claim 13 is Obvious Under 35 U.S.C. § 103 in View of Sudia and/or Hawkes in Combination with Lee	77
VI.	CONCLUSION.....	79

TABLE OF AUTHORITIES

	Page(s)
CASES	
<i>Agilysys, Inc. v. Ameranth, Inc.</i> , CBM2014-14, Paper 19	12, 13
<i>Apple Inc. v. SightSound Techs., LLC</i> , CBM2013-20, Paper 14	11
<i>Bloomberg Inc. v. Markets-Alert PTY Ltd.</i> , CBM2013- 5, Paper 18	18
<i>CRS Advanced Techs., Inc. v. Frontline Techs., Inc.</i> , CBM2012-5, Paper 17.....	11, 12, 15
<i>Experian Mktg. Solutions, Inc. v. RPost Commc'n Ltd.</i> , CBM2014-10, Paper 20	13
<i>Google, Inc. v. Inventor Holdings, LLC</i> , CBM2014-2, Paper 16.....	10
<i>In re Cuozzo Speed Techs., LLC</i> , No. 2014-1301, 2015 WL 448667 (Fed. Cir. Feb. 4, 2015).....	21
<i>In re Translogic Tech., Inc.</i> , 504 F.3d 1249 (Fed. Cir. 2007)	21
<i>In re: Maxim Integrated Prods., Inc.</i> MDL No. 2354, Misc. No. 12-244-JFC (W.D. Pa.).....	1
<i>JP Morgan Chase & Co. and JP Morgan Chase Bank, N.A. v. Maxim</i> , CBM2014-179, Paper 1	3
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005) (en banc)	21
<i>PNC Fin. Servs. Grp., Inc. v. Intellectual Ventures I LLC</i> , CBM2014-32, Paper 13	13
<i>SAP Am., Inc. v. Versata Dev. Grp., Inc.</i> , CBM2012-1, Paper 36.....	11

<i>Volusion, Inc., v. Versata Software, Inc.,</i> CBM2013-18, Paper 8.....	11
---	----

STATUTES

35 U.S.C. § 102(b).....	20, 32, 35, 36
35 U.S.C. § 102(e)	19, 29
35 U.S.C. § 103.....	passim
35 U.S.C. § 321(c)	8
35 U.S.C. § 324(a)	29
35 U.S.C. § 325(a)(1)	7
35 U.S.C. § 325(e)(1)	7
35 U.S.C. § 328(a)	7

OTHER AUTHORITIES

37 C.F.R. § 42.8(a)(1)	1
37 C.F.R. § 42.8(b)(1).....	1
37 C.F.R. § 42.8(b)(2).....	1
37 C.F.R. § 42.8(b)(3).....	4
37 C.F.R. § 42.8(b)(4).....	4
37 C.F.R. § 42.15(b)	4
37 C.F.R. § 42.203	4
37 C.F.R. § 42.300(b)	21
37 C.F.R. § 42.301(a).....	10
37 C.F.R. § 42.301(b)	14, 18
37 C.F.R. § 42.302	7, 8
37 C.F.R. § 42.303	8

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.