

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 COMPANY¹

Petitioner,

v.

MAXIM INTEGRATED PRODUCTS, INC.

Patent Owner.

Case No. CBM2015-00102

Patent No. 6,237,095

Petitioners' Reply to Patent Owner's Preliminary Response

¹ On June 26, 2015, the Board granted a joint motion filed by Maxim and Navy Federal Credit Union ("NFCU") to terminate the proceeding with respect to NFCU pursuant to 35 U.S.C. § 327(a). Paper 10.

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I. INTRODUCTION

Patent Owner's disclaimer² of dependent claim 7 does not render the remaining claims ineligible for covered business method review ("CBMR"). The Petition shows the claims of the '095 Patent qualify for CBMR because the apparatus recited in the claims enables "money and other valuable data [to] be securely passed electronically." Petition at 13 (quoting Ex. 1001, Abstract). While Patent Owner's disclaimer renders dependent claim 7 unenforceable, it cannot erase the *subject matter* of dependent claim 7, which remains illustrative of the financial nature of non-disclaimed independent claim 1. As the Petition explains, claim 1 covers an apparatus comprising data for monetary amounts even without dependent claim 7; namely, claim 1's "first data object" and "second data object," which each cover monetary amounts as described in the specification. *See id.* The disclaimer does not wipe out the financial embodiments covered by the non-disclaimed claims, as shown in the Petition at pp. 13-14. Nor does the disclaimer prevent the Board from also considering the 30-plus lawsuits asserting non-disclaimed claims against financial products and services in determining CBMR eligibility.

² This Reply is limited to the disclaimer issue pursuant to Board correspondence.

Petitioners also oppose the other arguments in the Preliminary Response.

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