

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Racz et al.	§	Attorney Docket No.:
United States Patent No.: 8,061,598	§	104677-5008-829
Formerly Application No.: 13/012,541	§	Customer No. 28120
Issue Date: November 22, 2011	§	
Filing Date: January 24, 2011	§	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. 8,061,598 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.	OVERVIEW OF CHALLENGED CLAIMS.....	18
IV.	PETITIONER HAS STANDING	23
A.	The '598 Patent Is A Covered Business Method Patent	23
1.	Exemplary Claim 8 Is Financial In Nature	25
2.	Claim 8 Does Not Cover A Technological Invention	30
(a)	Claim 8 Does Not Recite A Technological Feature That Is Novel And Unobvious	30
(b)	Claim 8 Does Not Solve A Technical Problem Using A Technical Solution.....	34
B.	Related Matters And Mandatory Notice Information; Petitioner Is A Real Party In Interest Sued For And Charged With Infringement.....	37
V.	DETAILED EXPLANATION OF REASONS FOR RELIEF REQUESTED, SHOWING IT IS MORE LIKELY THAN NOT THAT AT LEAST ONE CHALLENGED CLAIM IS UNPATENTABLE	38
A.	Claim Construction.....	40
B.	Challenged Claims Are Unpatentable Under § 101	43
1.	Challenged Claims Are Directed To Abstract Ideas.....	45
2.	Challenged Claims Do Not Disclose An “Inventive Concept” That Is “Significantly More” Than An Abstract Idea	53
(a)	Field Of Use Limitations Cannot Create Patent Eligibility	54
(b)	Generic Computer Implementation Cannot Transform Abstract Ideas Into Patent Eligible Inventions.....	55
(i)	Generic Computer Functions Cannot Transform Abstract Ideas Into Patent Eligible Inventions	56

(ii)	Generic Computer Hardware Cannot Transform Abstract Ideas Into Patent Eligible Inventions	59
(iii)	Challenged Claims Are Analogous To Those Found Patent-Ineligible In Alice	63
(iv)	Challenged Claims Are Analogous To Those Found Patent-Ineligible In Accenture.....	73
(c)	Functional Nature Of The Challenged Claims Confirms Preemption And Patent Ineligibility	76
(d)	Machine-or-Transformation Test Also Confirms Patent Ineligibility.....	78
VI.	CONCLUSION.....	79

EXHIBIT LIST	
1001	U.S. Patent No. 8,061,598
1002	Plaintiffs' First Amended Complaint
1003	U.S. Patent No. 5,925,127
1004	U.S. Patent No. 5,940,805
1005	August 2014 Emails Titled "RE: Smartflash: Meet and Confer Regarding Further Claim/Prior Art Limits."
1006	U.S. Patent No. 4,999,806
1007	U.S. Patent No. 5,675,734
1008	U.S. Patent No. 4,878,245
1009	U.S. Patent No. 7,334,720
1010	U.S. Patent No. 7,942,317
1011	U.S. Patent No. 5,103,392
1012	U.S. Patent No. 5,530,235
1013	U.S. Patent No. 5,629,980
1014	U.S. Patent No. 5,915,019
1015	European Patent Application, Publication No. EP0809221A2
1016	International Publication No. WO 99/43136
1017	JP Patent Application Publication No. H11-164058 (translation)

EXHIBIT LIST	
1018	Eberhard von Faber, Robert Hammelrath, and Frank-Peter Heider, "The Secure Distribution of Digital Contents," IEEE (1997)
1019	Declaration of John P. J. Kelly In Support of Apple Inc.'s Petition for Covered Business Method Patent Review
1020	U.S. Patent No. 8,033,458
1021	Declaration of Michael P. Duffey In Support of Apple Inc.'s Petition for Covered Business Method Patent Review
1022	Declaration of Megan F. Raymond In Support of Apple Inc.'s Petition for Covered Business Method Patent Review
1023	Claim Construction Memorandum Opinion from <i>Smartflash LLC v. Apple Inc.</i> , No. 6:13cv447 (Dkt. 229)
1024	File History for U.S. Patent No. 8,061,598
1025	U.S. Patent No. 4,337,483
1026	U.S. Patent No. 7,725,375
1027	International Publication No. WO 95/34857
1028	U.S. Patent No. 5,970,479
1029	U.S. Patent No. 5,646,992
1030	Apr. 8-9, 2015 Deposition Transcript of Jonathan Katz, CBM2014-00102/106/108/112
1031	J. Taylor, "DVD-Video: Multimedia for the Masses," IEEE Multimedia, Vol. 6, No. 3, July-September 1999, pp. 86-92
1032	U.S. Patent No. 5,903,721

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.