IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor: Racz et al.§United States Patent No.: 8,336,772§Formerly Application No.: 13/212,047§Issue Date: December 25, 2012§Filing Date: August 17, 2011§Former Group Art Unit: 2887§Former Examiner: Thien M. Le§

Attorney Docket No.: 104677-5008-830 Customer No. 28120

Petitioner: Apple Inc.

For: Data Storage and Access Systems

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PETITION FOR COVERED BUSINESS METHOD PATENT REVIEW OF UNITED STATES PATENT NO. 8,336,772 PURSUANT TO 35 U.S.C. § 321, 37 C.F.R. § 42.304

TABLE OF CONTENTS

Page

I.	INTRODUCTION1					
II.	OVERVIEW OF FIELD OF THE CLAIMED INVENTION					
III.	OVI	OVERVIEW OF CHALLENGED CLAIMS				
IV.	PETITIONER HAS STANDING					
	А.	The	'772 Pat	tent Is A Covered Business Method ("CBM") Patent24		
		1.	Exem	plary Claim 12 Is Financial In Nature25		
		2.	Claim	12 Does Not Cover A Technological Invention		
			(a)	Claim 12 Does Not Recite A Technological Feature That Is Novel and Unobvious29		
			(b)	Claim 12 Does Not Solve A Technical Problem Using A Technical Solution		
	В.			ters And Mandatory Notice Information; Petitioner Is A Interest Sued For And Charged With Infringement		
V.	REC	QUEST	ſED, SH	LANATION OF REASONS FOR RELIEF IOWING IT IS MORE LIKELY THAN NOT THAT CHALLENGED CLAIM IS UNPATENTABLE		
	А.	Clair	m Const	ruction		
	В.	The	Challen	ged Claims Are Unpatentable Under § 10141		
		1.	The (Challenged Claims Are Directed To Abstract Ideas		
Concept" That Is "Si			Conce	Challenged Claims Do Not Disclose An "Inventive ept" That Is "Significantly More" Than An Abstract 50		
			(a)	Field Of Use Limitations Cannot Create Patent Eligibility51		
			(b)	Generic Computer Implementation Cannot Transform Abstract Ideas Into Patent Eligible Inventions		
				(i) Generic Computer Functions Cannot Transform Abstract Ideas Into Patent Eligible Inventions54		

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		(ii) Generic Computer Hardware Cannot Transform Abstract Ideas Into Patent Eligible Inventions	
		(iii) Challenged Claims Are Analogous To Those Found Patent-Ineligible In Alice	61
		(iv) Challenged Claims Are Analogous To Those Found Patent-Ineligible In Accenture	74
	(c)	Functional Nature Confirms Preemption and Ineligibility	76
	(d)	Machine-Or-Transformation Test Also Confirms Patent Ineligibility	78
VI. CONC	LUSION		79

EXHIBIT LIST			
1001	U.S. Patent No. 8,336,772		
1002	Plaintiffs' First Amended Complaint		
1003	U.S. Patent No. 5,925,127		
1004	U.S. Patent No. 5,940,805		
1005	J. Taylor, "DVD-Video: Multimedia for the Masses," IEEE Multimedia, Vol. 6, No. 3, July-September 1999, pp. 86-92		
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	File History for U.S. Patent No. 8,336,772		
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 (transla- tion)		
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 Pe- tition for Covered Business Method Patent Review		

EXHIBIT LIS	ST
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 Smartflash LLC v. Apple Inc., 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	JP Patent Application Publication No. H10-269289 (transla- tion)
1029	File History for U.S. Patent No. 7,942,317
1030	File History for U.S. Patent No. 8,033,458
1031	U.S. Patent No. 8,061,598
1032	U.S. Patent No. 8,118,221
1033	File History for U.S. Patent No. 8,118,221
1034	U.S. Patent No. 7,334,720
1035	File History for U.S. Patent No. 7,334,720
1036	U.S. Patent No. 5,646,992
1037	August 2014 Emails Titled "RE: Smartflash: Meet and Confer Regarding Further Claim/Prior Art Limits."
1038	International Publication No. WO99/13398
1039	Apr. 8-9, 2015 Deposition Transcript of Jonathan Katz,

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