Paper No.	_
Filed: October 26,	2015

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD
OCEAN TOMO, LLC,

Petitioner

v.

PATENTRATINGS, LLC,

Patent Owner

Case CBM2015-00157

U.S. Patent No. 9,075,849

**Patent Owner's Preliminary Response** 



## TABLE OF CONTENTS

I.	PRE	LIMIN	NARY STATEMENT	1
II.	PET MEI	ITION ETS TI	OULD NOT BE INSTITUTED BECAUSE THE I FAILS TO DEMONSTRATE THAT PETITIONER HE ELIGIBILITY REQUIREMENTS OF 37 C.F.R. § TO PURSUE CBM REVIEW OF THE '849 PATENT	3
	Α.	"Sue	Petition Fails to Establish that Petitioner Has Been ed for Infringement" or "Charged with Infringement" of 849 Patent	5
		1.	Petitioner Mischaracterizes the Underlying Business Relationship with PatentRatings and Fails to Mention That the "PR Patents" Are Licensed to Petitioner "Royalty-Free"	6
		2.	Petitioner Mischaracterizes PatentRatings' Amended Counterclaim, Which Does Not Constitute a Charge of Infringement of the '849 Patent	8
		3.	Petitioner Mischaracterizes PatentRatings' Discovery Requests, Which Do Not Constitute a Charge of Infringement of the '849 Patent	11
	В.	Case	Petition Fails to Establish that a "Real and Substantial or Controversy" Exists Regarding Infringement of the Patent	13
		1.	Petitioner's Reliance on <i>MedImmune</i> Is Misplaced; Unlike in <i>MedImmune</i> , There Is No Case or Controversy Regarding Infringement of Any Patent, Let Alone the '849 Patent	13
		2.	Petitioner's Pending Declaratory Judgment Action in District Court Does Not Establish CBM Standing Because That Action Is Not Based on Alleged Infringement or Non-Infringement the '849 Patent	18



III.	EVE	EN ASSUMING PETITIONER COULD DEMONSTRATE IT	
	MEE	ETS THE ELIGIBILITY REQUIREMENTS OF 37 C.F.R. §	
	42.30	02(A), TRIAL SHOULD NOT BE INSTITUTED BECAUSE	
		E PETITION FAILS TO ESTABLISH THAT THE '849	
	PAT	ENT IS A COVERED BUSINESS METHOD PATENT	21
	Α.	The Claims of the '849 Patent Recite Context-Neutral	
		Elements Directed to Technologies Common across	
		Business Enterprises Having No Particular Relation to	
		Financial Products or Services	23
	В.	The Petition Improperly Relies on Examples from the	
		Specification to Establish that the Claims of the '849 Patent	
		are Complementary to a Financial Activity	27
IV.	THE	E PETITION FAILS TO SATISFY THE THRESHOLD	
	REQ	QUIREMENTS FOR INSTITUTION ON § 101 GROUNDS	31
	Α.	Petitioner Cannot Show It Is "More Likely Than Not" To	
		Prevail on § 101 Grounds When the Office Duly Considered	
		§ 101 Post-Alice and Found the Claims Patent Eligible Less	
		Than Four Months Ago	32
	В.	The Petition Relies on Impermissible Testimonial Evidence	
		to Conclude the Challenged Claims are Directed to Patent-	
		Ineligible Subject Matter Under § 101	35
	C.	Petitioner's § 101 Analysis Is Deficient Because the Petition	
		Fails to Analyze the Challenged Claims as a Whole	38
V	CON	NCLUSION	<b>4</b> 1



### **TABLE OF AUTHORITIES**

	Page(s)
Cases	
Alice Corp. Pty. Ltd. v. CLS Bank International, 134 S. Ct. 2347 (2014)	3, 38, 40
buySAFE, Inc. v. Google, Inc., 765 F.3d 1350 (Fed. Cir. 2014)	34
Cat Tech LLC v. TubeMaster, Inc., 528 F.3d 871 (Fed. Cir. 2008)	17
DDR Holdings LLC v. Hotels.Com LP, 773 F.3d 1245 (Fed. Cir. 2014)	33, 34
Digitech Image Techs., LLC v. Elecs. for Imaging, Inc., 758 F.3d 1344 (Fed. Cir. 2014)	34
Gen-Probe Inc. v. Vysis, Inc., 359 F.3d 1376 (Fed. Cir. 2004)	15
Lujan v. Defenders of Wildlife, 504 U.S. 555 (1992)	18
Matthews Intern. Corp. v. Biosafe Engineering, LLC, 695 F. 3d 1322 (Fed. Cir. 2012)	17
MedImmune, Inc. v. Genentech, Inc., 549 U.S. 118 (2007)	13, 14, 15, 16
Planet Bingo, LLC v. VKGS, LLC, 576 Fed. App'x 1005 (Fed. Cir. 2014)	34
Public Serv. Comm'n v. Wycoff Co., 344 U.S. 237 (1952)	17
Sandoz, Inc. v. Amgen Inc., 773 F. 3d 1274 (Fed. Cir. 2014)	17



Streck, Inc. v. Research & Diagnostic Systems, 665 F. 3d 1269 (Fed. Cir. 2012)	14
Texas v. United States, 523 U.S. 296 (1998)	17
Ultramercial, Inc. v. Hulu, LLC, 772 F.3d 709 (Fed. Cir. 2014).	33, 34
Statutes	
28 U.S.C. §§ 2201-2202	19
35 U.S.C. § 101	passim
35 U.S.C. § 322	32, 41
35 U.S.C. § 324	31
AIA § 18	passim
Rules	
37 C.F.R. § 42.22(a)(2)	32
37 C.F.R. § 42.302(a)	passim
37 C.F.R. § 42.304(a)	3, 21
37 C.F.R. § 42.304(b)(4)	32
37 C.F.R. § 42.65	35, 38, 39
Other Authorities	
77 Fed. Reg. 48620 (Aug. 14, 2012)	32
77 Fed. Reg. 48756 (Aug. 14, 2012)	21
79 Fed. Reg. 74618 (Dec. 16, 2014)	34
157 Cong. Rec. S5402 (daily ed. Sept. 8, 2011)	22
157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011)	22



# DOCKET A L A R M

# 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.

