

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

GOOGLE INC.,  
Petitioner,

v.

ALFONSO CIOFFI, MEGAN ELIZABETH ROZMAN,  
MELANIE ANN ROZMAN, AND MORGAN LEE ROZMAN,  
Patent Owners.

---

Case CBM2017-00010  
Patent RE43,528

---

PATENT OWNER PRELIMINARY RESPONSE

**Table of Contents**

I. INTRODUCTION .....1

II. BACKGROUND .....3

    a. Related Matters.....3

    b. Concurrent District Court Litigation.....4

    c. Description in the '528 Reissue .....5

    d. Prosecution History of the '528 Reissue.....10

    e. Challenged Independent Claims of the '528 Reissue .....10

III. OVERVIEW OF THE PETITION .....13

IV. CONSTRUCTION OF TERMS.....14

V. THE BOARD SHOULD DENY INSTITUTION BECAUSE THE '528 REISSUE DOES NOT QUALIFY AS A "COVER BUSINESS METHOD PATENT" .....16

    a. Financial Product or Service .....17

        i. None of the Challenged Claims are financial in nature.....18

        ii. The Petitioner fails to carry its burden to establish that at least one of the Challenged Claims is financial in nature.....21

    b. Technological Invention Exception .....25

        i. The Petitioner Fails to Establish that the Claimed Subject Matter of the '528 Reissue as a Whole Does Not Recite a Technical Feature that Is New and Unobvious.....26

        ii. The Petitioner Fails to Establish that the Claimed Subject Matter of the '528 Reissue Patent as a Whole Does Not Recite a Technical Feature that Solves a Technological Problem Using a Technological Solution .....31

VI. THE BOARD SHOULD EXERCISE ITS DISCRETION AND DENY INSTITUTION .....34

VII. CONCLUSION.....37

**Table of Authorities**

**Cases**

*Alice Corp. Pty Ltd. v. CLS Bank Int’l*,  
134 S. Ct. 2347 (2014)..... 29, 34

*Cuozzo Speed Techs., LLC v. Lee*,  
136 S. Ct. 2131 (2016).....35

*Enfish, LLC v. Microsoft Corp.*,  
822 F.3d 1327, 118 U.S.P.Q.2d 1684 (Fed. Cir. 2016)..... 29, 34

*Facebook, Inc. v. Skky, LLC*,  
CBM2016-00091, paper 7, slip op. (P.T.A.B. Nov. 23, 2016) .....17

*Fairchild Semiconductor Corp. v. In-Depth Test LLC*,  
CBM2015-00060, paper 11, slip op. (P.T.A.B. Aug. 3, 2015) ..... 16, 18

*FedEx Corp. v. Ronald A. Katz Tech. Licensing, L.P.*,  
CBM2015-00053, paper 9, slip op. (P.T.A.B. June 29, 2015)..... 16, 18

*Google, Inc. v. LocatioNet Sys. Ltd.*,  
CBM2016-00062, paper 7, slip op. (P.T.AB. Oct. 25, 2016) .....23

*In re CSB-System Int’l, Inc.*,  
832 F.3d 1335 (Fed. Cir. 2016) .....15

*In re Cuozzo Speed Techs., LLC.*,  
793 F.3d 1268 (Fed. Cir. 2015) .....35

*Kayak Software Corp. v. Int’l Bus. Machs. Corp.*,  
CBM2016-00077, paper 15, slip op. (P.T.A.B. Dec. 15, 2016)..... 23, 25

*Plaid Techs., Inc. v. Yodlee, Inc.*,  
CBM2016-00082, paper 8, slip op. (P.T.A.B. Oct. 6, 2016) ..... 18, 24

*The U.S. Postal Service v. Return Mail, Inc.*,  
CBM2014-00116, paper 24, slip op. (P.T.A.B. Feb. 20, 2015) .....35

*United Servs. Automobile Assoc. v. Asghari-Kamrani*,  
CBM2016-00064, paper 14, slip op. (P.T.A.B. Sep. 21, 2016) .....17

CBM2017-00010

Patent RE43,528

*Unwired Planet, LLC v. Google, Inc.*,

\_\_ F.3d \_\_\_, 2015-1812, slip op. (Fed. Cir. Nov. 21, 2016)..... 17, 18, 22

**Statutes**

35 U.S.C. § 101 .....14

35 U.S.C. § 112.....14

35 U.S.C. § 251 .....13

Leahy-Smith America Invents Act (“AIA”) § 18(d)(1) .....1, 16

**Rules**

37 C.F.R. § 42.207 .....1

37 C.F.R. § 42.220 .....3, 14

37 C.F.R. § 42.301 .....1, 25

37 C.F.R. § 42.304 .....16

37 C.F.R. § 42.65 .....30

77 Fed. Reg. 48734 (Aug. 14, 2012).....35

77 Fed. Reg. 48756 (Aug. 14, 2012)..... 14, 29, 37

**Exhibit List**

<b>Exhibit No.</b>	<b>Exhibit Description</b>
2001	Declaration of H.E. Dunsmore in Support of Patent Owner's Preliminary Response
2002	Declaration of Eric Benisek in Support of Patent Owner's Preliminary Response
2003	United States Court of Appeals for the Federal Circuit, Median Disposition Time for Cases Decided by Merits Panels

# 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.