

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the *Inter Partes* Review of:

U.S. Patent No. RE40,526

Filed: June 14, 2005

Issued: September 30, 2008

Inventor(s): Doktor, Karol

Assignee: Financial Systems

Technology (Intellectual Property) Pty.
Ltd.

Trial Number: To Be Assigned

Attorney Docket No:

Title: DATA PROCESSING SYSTEM AND METHOD FOR RETRIEVING AND [SIC] ENTITY SPECIFIED IN A SEARCH PATH RECORD FROM A RELATIONAL DATABASE Panel: To Be Assigned

Mail Stop *Inter Partes* Review

Commissions for Patents

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Alexandria, VA 22313-1450

DECLARATION OF JOEL MERKIN

I, Joel Merkin, do hereby declare as follows:

1. I am an attorney at the law firm of Kirkland & Ellis LLP, 300 N. LaSalle, Chicago, Illinois 60654, and serve as counsel for Petitioner International Business Machines, Corp. (“IBM”). I submit this declaration in support of IBM’s Petition for *Inter Partes* Review of U.S. Patent No. RE40,526 (“Petition”). I am over twenty-one years of age and not under any legal disability. I have personal knowledge of the following facts and, if called as a witness, could and would testify competently thereto.
2. Attached hereto as Exhibit 1005 is a true and correct copy of U.S. Patent No. RE40,526 (“the ’526 Patent”).
3. Attached hereto as Exhibit 1006 is a true and correct copy of IBM Database 2 SQL Reference (4th ed., May 1987).
4. Attached hereto as Exhibit 1007 is a true and correct copy of U.S. Patent No. 5,276,870 to Shan, *et al.*
5. Attached hereto as Exhibit 1008 is a true and correct copy of U.S. Patent No. 5,201,047 to Maki, *et al.*
6. Attached hereto as Exhibit 1009 is a true and correct copy of U.S. Patent No. 4,893,232 to Shimaoka, *et al.*
7. Attached hereto as Exhibit 1010 is a true and correct copy of excerpts from Korth and Silberschatz, Database System Concepts (McGraw-Hill 1986).

8. Attached hereto as Exhibit 1011 is a true and correct copy of a Local Patent Rule 4.3 Joint Claim Construction and Pre-Hearing Statement, Pleading and Exhibit A of FST's Proposed Constructions, *FST v. Oracle*, Case No. 2:08-cv-371 (E.D. Tex.)
9. Attached hereto as Exhibit 1012 is a true and correct copy of a FST's Opening Claim Construction Brief, *FST v. Oracle*, Case No. 2:08-cv-371 (E.D. Tex.).
10. Attached hereto as Exhibit 1013 is a true and correct copy of FST's Reply in Support of its Opening Claim Construction Brief, *FST v. Oracle*, Case No. 2:08-cv-371 (E.D. Tex.).
11. Attached hereto as Exhibit 1014 is a true and correct copy of a Transcript of the October 7, 2010 Claim Construction Hearing, *FST v. Oracle*, Case No. 2:08-cv-371 (E.D. Tex.).
12. Attached hereto as Exhibit 1015 is a true and correct copy of FST's Local Patent Rule 4.1 Identification of Claim Terms to be Construed and Proposed Constructions, Pleading and Exhibit A of FST's Proposed Claim Constructions, *FST v. IBM*, Case No. 1:11-cv-08729 (N.D. Ill.).
13. Attached hereto as Exhibit 1016 is a true and correct copy of excerpts from FST's Local Patent Rule 3.1 Final Infringement Contentions, *FST v. IBM*, Case No. 1:11-cv-08729 (N.D. Ill.).

14. Attached hereto as Exhibit 1017 is a true and correct copy of U.S. Patent Appl. No. 08/439,013 (“the ’013 Application”).
15. Attached hereto as Exhibit 1018 is a true and correct copy of excerpts from the file history of the ’013 Application: May 11, 1995 Preliminary Amendment.
16. Attached hereto as Exhibit 1019 is a true and correct copy of excerpts from the file history of the ’013 Application: August 24, 1995 Office Action.
17. Attached hereto as Exhibit 1020 is a true and correct copy of excerpts from the file history of the ’013 Application: February 26, 1996 Amendment.
18. Attached hereto as Exhibit 1021 is a true and correct copy of excerpts from the file history of the ’013 Application: May 2, 1996 Office Action.
19. Attached hereto as Exhibit 1022 is a true and correct copy of excerpts from the file history of the ’013 Application: August 7, 1996 Amendment.
20. Attached hereto as Exhibit 1023 is a true and correct copy of excerpts from the file history of the ’013 Application: August 20, 1996 Office Action.
21. Attached hereto as Exhibit 1024 is a true and correct copy of U.S. Patent No. 5,617,567.
22. Attached hereto as Exhibit 1025 is a true and correct copy of U.S. Reissue Appl. No. 11/152,833 (“the ’833 Reissue Application”).

23. Attached hereto as Exhibit 1026 is a true and correct copy of Reexamination Request No. 90/007,705 (“the ‘705 Reexamination”).
24. Attached hereto as Exhibit 1027 is a true and correct copy of excerpts from the file history of the ’705 Reexamination: September 30, 2005 Statement Granting Reexamination.
25. Attached hereto as Exhibit 1028 is a true and correct copy of excerpts from the file history of the ’705 Reexamination: December 6, 2005 Decision Merging ’833 Reissue Application and ’705 Reexamination.
26. Attached hereto as Exhibit 1029 is a true and correct copy of excerpts from the file history of the ’705 Reexamination: July 17, 2007 Office Action.
27. Attached hereto as Exhibit 1030 is a true and correct copy of excerpts from the file history of the ’705 Reexamination: February 22, 2008 Notice of Allowability.
28. Attached hereto as Exhibit 1031 is a true and correct copy of Reexamination Request No. 90/008,965 (“the ‘965 Reexamination”).
29. Attached hereto as Exhibit 1032 is a true and correct copy of excerpts from the file history of the ’965 Reexamination: March 14, 2008 Decision Denying Reexamination.
30. Attached hereto as Exhibit 1033 is a true and correct copy of excerpts from the file history of the ’965 Reexamination: September 23, 2010 Statement.

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