

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the *Inter Partes* Review of:

U.S. Patent No. RE40,520

Filed: June 14, 2005

Issued: September 23, 2008

Inventor(s): Doktor, Karol

Assignee: Financial Systems

Technology (Intellectual Property) Pty.
Ltd.

Title: EASILY EXPANDABLE DATA Panel: To Be Assigned
PROCESSING SYSTEM AND
METHOD

Trial Number: To Be Assigned

Attorney Docket No:

Mail Stop *Inter Partes* Review
Commissions for Patents
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**SUBMISSION PURSUANT TO 35 U.S.C. § 301 AND 37 C.F.R. § 1.501 IN
SUPPORT OF PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. RE40,520**

Pursuant to 35 U.S.C. § 301 and 37 C.F.R. § 1.501, International Business Machines Corporation (“IBM”) offers this Submission Pursuant to 35 U.S.C. § 301 and 37 C.F.R. § 1.501 in Support of Petition for *Inter Partes* Review of U.S. Patent No. RE40,520 (“Submission”) regarding: (1) prior art that bears on the patentability of claims 10–13 and 15–16 of U.S. Patent No. RE40,520 (“the ’520 Patent”); and (2) statements that the patent owner, Financial Systems Technology (Intellectual Property) Pty. Ltd. (“FST”) has filed with this Office and in Federal court proceedings regarding the scope of claims 10–13 and 15–16 of the ’520 Patent. IBM files this Submission in connection with, and as Exhibit 1003 to, its Petition for *Inter Partes* Review Under 37 C.F.R. § 42.100 of U.S. Patent No. RE40,520 (“Petition”).

I. PRIOR ART BEARING ON THE PATENTABILITY OF CLAIMS 10-13 AND 15-16 OF U.S. PATENT NO. RE40,520

Pursuant to 35 U.S.C. § 301(a)(1) and 37 C.F.R. § 1.501(a)(1), IBM identifies the following prior art that it believes bears on the patentability of claims 10–13 and 15–16 of the ’520 Patent:

- James P. Davis, *et al.*, EDICT - An Enhanced Relational Data Dictionary: Architecture and Example (“Davis”) (Ex. 1006)¹

¹ All exhibit numbers given herein reference the Appendix of Exhibits attached to the Petition.

- Stephanie Cammarata, *et al.*, Extending a Relational Database with Deferred Referential Integrity Checking and Intelligent Joins (“Cammarata”) (Ex. 1007)
- U.S. Patent No. 4,868,733 to Fujisawa, *et al.* (“Fujisawa”) (Ex. 1008)
- U.S. Patent No. 5,206,951 to Khoyi, *et al.* (“Khoyi”) (Ex. 1009)

As required by 37 C.F.R. § 1.501(b)(1), the pertinence of this prior art to claims 10–13 and 15–16 of the ’520 Patent is explained in Section V of the Petition, and in particular, the manner of applying this prior art to claims 10–13 and 15–16 of the ’520 Patent may be found in the claim-by-claim analysis of Section V.E of the Petition.

II. STATEMENTS ABOUT THE SCOPE OF CLAIMS 10–13 AND 15–16 OF U.S. PATENT NO. RE40,520 FILED IN A PROCEEDING BEFORE A FEDERAL COURT OR THE OFFICE

Pursuant to 35 U.S.C. § 301(a)(2) and 37 C.F.R. § 1.501(a)(2), IBM identifies the following statements made by FST in which FST took a position on the scope of claims 10–13 and 15–16 of the ’520 Patent and that were filed in a proceeding before a Federal court or this Office.

***FST v. IBM* Claim Constructions and Infringement Contentions**

FST directly took a position on the scope of claims 10–13 and 15–16 of the ’520 Patent when it made statements in its currently pending litigation against IBM about how certain claim terms that appear in those claims should be construed.

(Ex. 1010, FST's Local Patent Rule 4.1 Identification of Claim Terms to be Construed and Proposed Constructions.) Additionally, FST implicitly took a position on the scope of claims 10–13 and 15–16 of the '520 Patent when it made statements about how the accused IBM products allegedly infringe those claims. (Ex. 1032, FST's Local Patent Rule 3.1 Final Infringement Contentions for the '520 Patent.) As required by 37 C.F.R. § 1.501(a)(3), IBM identifies the following:

37 C.F.R. § 1.501(a)(3)(i), Forum: FST filed these statements during the district court litigation captioned *Financial Systems Technology (Intellectual Property) Pty. Ltd. and Financial Systems Technology Pty. Ltd. v. International Business Machines Corporation*, Case No. 1:11-cv-08729 (U.S. District Court for the Northern District of Illinois, Eastern Division).

37 C.F.R. § 1.501(a)(3)(ii), Specific Documents: FST made these statements about the scope of claims 10–13 and 15–16 of the '520 Patent in the following documents: (1) Local Patent Rule 4.1 Identification of Claim Terms to be Construed and Proposed Constructions (Ex. 1010); and (2) FST's Local Patent Rule 3.1 Final Infringement Contentions for the '520 Patent (Ex. 1032).

37 C.F.R. § 1.501(a)(3)(iii), How Statement is a Position on the Scope of Any Claim: In proposing how the district court should construe certain terms that appear in claims 10-13 and 15-16 of the '520 Patent, FST was taking a direct

position about the scope of those claims. (*See* Ex. 1010.) FST's infringement contentions are an implicit statement about the scope of those claims. By saying that certain features or functionalities of the IBM accused products allegedly infringe a limitation of claims 10-13 and 15-16, FST is stating that the scope of that claim limitation is such that it would encompass that feature or functionality. (*See* Ex. 1032.)

An explanation of the pertinence of these statements and how to apply them to claims 10–13 and 15–16 of the '520 Patent, as required by 37 C.F.R. § 1.501(b)(1), may be found in Section IV.C of the Petition.

FST v. Oracle Claim Constructions

FST also took a position on the scope of claims 10–13 and 15–16 of the '520 Patent when it made statements in a prior district court proceeding about how certain claim terms that appear in those claims should be construed. (Ex. 1011, Local Patent Rule 4.3 Joint Claim Construction and Pre-Hearing Statement.) As required by 37 C.F.R. § 1.501(a)(3), IBM identifies the following:

37 C.F.R. § 1.501(a)(3)(i), Forum: FST filed these statements during the district court litigation captioned *Financial Systems Technology (Intellectual Property) Pty. Ltd. and Financial Systems Technology Pty. Ltd. v. Oracle Corporation*, Case No. 2:08-cv-371 (U.S. District Court for the Eastern District of Texas, Marshall Division).

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