Filed on behalf of Pi-Net International, Inc.

By: Bryan Boyle and Lawrence B. Goodwin

Carr & Ferrell LLP Lawrence B. Goodwin, P.C. 120 Constitution Drive 525 East 86<sup>th</sup> Street, Suite 5H

Menlo Park, CA 94025 New York, NY 10028 Tel: (650) 812-3400 Tel: (212) 988-1076 Fax: (650) 812-3444 Fax: (646) 619-4161

### UNITED STATES PATENT AND TRADEMARK OFFICE

\_\_\_\_

### BEFORE THE PATENT TRIAL AND APPEAL BOARD

\_\_\_\_

SAP AMERICA, INC.
Petitioner

v.

PI-NET INTERNATIONAL, INC.
Patent Owner

\_\_\_\_\_

CASE CBM2013-00013 Patent 8,037,158

PATENT OWNER'S RESPONSE TO THE PETITION

Mail Stop "PATENT BOARD"

Patent Trial and Appeal Board U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450



## **Table of Contents**

I.	Intro	Introduction		
II.	Objections to Grounds for Eligibility for Covered Business Method			
	Patent Review			
II	Patent Owner's Response to 35 U.S.C. § 101 Issues			
IV.	The Claims of the '158 Patent and their Construction			
	A.	Web application	18	
	B.	Service network atop the World Wide Web	24	
	C.	Web user input device	27	
	D.	Utilizing a routed transactional data structure that is both complete and non-deferred	28	
	E.	The routing occurring in response to the subsequent signals	37	
	F.	Object Routing	38	
	G.	Distributed on-line service information bases	42	
	H.	Virtual Information Store	42	
	I.	Point Of Service Application	44	
V.	Grounds Under Section 103			
	A.	Obviousness in General	57	
	B.	The Prior Art, Alone Or In Combination, Does Not Include Elements Of Claims 1-3 And 11, As Properly Construed	58	
	C.	Hindsight Combination of Lawlor and Computerworld	63	
VI.	Clair	aims 1 – 6 and 11 Are Not Indefinite60		
VII.	Conclusion 6			
CER'	TIFIC	ATION OF SERVICE (37 CFR 42.6(e), 42.105(a))	70	



### TABLE OF AUTHORITIES

## Cases

American Piledriving Equipment, Inc. v. Geoquip, Inc., 637 F.3d 1324, 1331 (Fed. Cir. 2011)30
Bicon, Inc. v. Straumann Co., 441 F.3d 945, 950 (Fed. Cir. 2006) 16, 32, 44, 61
CLS Bank Intern. v. Alice Corp. Pty. Ltd., 685 F. 3d 1341 (Fed. Cir. 2012)17
Datamize, LLC v. Plumtree Software, Inc., 417 F.3d 1342, 1347 (Fed.Cir.2005)69
Haemonetics Corp. v. Baxter Healthcare Corp., 607 F. 3d 776, 783 (Fed. Cir. 2010)
Halliburton Energy Services, Inc. v. MI LLC, 514 F. 3d 1244, 1250 (Fed. Cir.         2008)
Hearing Components, Inc. v. Shure Inc., 600 F. 3d 1357, 1366 (Fed. Cir. 2010)70
Perkin-Elmer Corp. v. Westinghouse Elec. Corp., 822 F.2d 1528, 1532–33 (Fed. Cir. 1987).       16, 17, 32, 61
Phillips v. AWH Corp., 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc)29
Power-One, Inc. v. Artesyn Technologies, Inc., 599 F. 3d 1343, 1350 (Fed. Cir.         2010)
Renishaw PLC v. Marposs Societa' per Azioni, 158 F.3d 1243, 1248 (Fed. Cir. 1998)
<i>Star Scientific, Inc. v. R.J. Reynolds Tobacco Co.</i> , 655 F.3d 1364, 1373 (Fed. Cir. 2011)70
U.S. Surgical Corp., 103 F.3d at 1568
Unique Concepts, Inc. v. Brown, 939 F.2d 1558, 1562 (Fed. Cir. 1991 16, 32, 61
Statutes
35 U.S.C. § 1019



# CASE CBM2013-00013 Patent 8,037,158

35 U.S.C. § 103	1
35 USC § 112 (b)	1, 70, 71
37 C. F. R. §§ 42.120 and 42.300(a)	1, 9
Regulations	
77 Fed. Reg. 48734 at 48739	10



## **LIST OF EXHIBITS**

Exhibit No.	Description
Exhibit 1002	'158 Prosecution History, Amendment of December 27, 2010 at page 11 and the whole document (previously filed)
PI-NET 2008	Prosecution History for U.S. Patent No. 5,778,178 (previously filed)
PI-NET 2009	Excerpts From Prosecution History of U.S. Patent No. 8,037,158, Previously Submitted (C.A. No. 12-355-RGA) (previously filed)
PI-NET 2010	Bardash Decl. of April 1, 2013, Para. 46 and whole document, Previously Submitted (C.A. No. 12-355-RGA) (previously filed)
PI-NET 2012	(http://www.uspto.gov/web/patents/classification/uspc705/sched705.htm)
PI-NET 2013	(http://www.uspto.gov/web/patents/classification/uspc709/defs709.htm)
PI-NET 2014	http://www.webopedia.com/TERM/V/virtual.html
PI-NET 2015	(http://en.wikipedia.org/wiki/Data_structure)
PI-NET 2016	http://www.webopedia.com/DidYouKnow/Internet/2002/ Web_vs_Internet.asp
PI-NET 2017	Easttom Declaration of November 25, 2013, Pi-Net International, Inc. v. JP Morgan Chase & Co, No. 1:12-cv-00282 (D. Del) Previously Submitted
PI-NET 2018	(http://en.wikipedia.org/wiki/Web_application)
PI-NET 2019	"Web Applications - What is a Web Application" (http://webtrends.about.com/od/webapplications/ a/web_application.htm)
PI-NET 2020	Prosecution History of Parent 8,108,492 Patent



# DOCKET

# 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.

