Filed on behalf of SAP America, Inc.
By: Michael Q. Lee
Lori A. Gordon
Sterne, Kessler, Goldstein & Fox PLLC
1100 New York Avenue, NW
Washington, D.C.
Tel: (202) 371-2600
Fax: (202) 371-2540

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.
Petitioner,

v.

PI-NET INTERNATIONAL, INC.
Patent Owner.

Patent 8,037,158

PETITION FOR COVERED BUSINESS METHOD REVIEW OF CLAIMS 4-6, 9 AND 10 OF U.S. PATENT NO. 8,037,158

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

TABLE OF CONTENTS

I. MANDATORY NOTICES (37 C.F.R. § 42.8(A)(1)) 1

II. GROUNDS FOR STANDING (37 C.F.R. § 42.304(A)). 3

A. THE PTAB PREVIOUSLY HELD THE '158 PATENT ELIGIBLE FOR COVERED BUSINESS METHOD REVIEW 4
a) Claims 4-6, 9 and 10 are Directed to a Covered Business Method. 4
b) Claims 4-6, 9 and 10 are Not Directed to a "Technological Invention." 6
B. PETITIONER HAS STANDING TO PETITION FOR REVIEW, AND PETITIONER IS NOT ESTOPPED (37 C.F.R. § 42.302) 9

III. IDENTIFICATION OF CHALLENGE 10

A. STATUTORY GROUNDS FOR THE CHALLENGE 10
B. CITATION OF PRIOR ART 11
C. THE CLAIMS OF THE '158 PATENT AND THEIR CONSTRUCTION 12

IV. GROUNDS UNDER SECTION 101 15

A. GROUND 1: CLAIMS 9 AND 10 ARE INVALID FOR FAILING TO RECITE STATUTORY SUBJECT MATTER UNDER 35 U.S.C. § 101 15
a) Claim 1 15
b) Claims 9 and 10 17

V. GROUNDS UNDER SECTION 103 17

A. LEVEL OF ORDINARY SKILL IN THE ART 17
B. GROUNDS BASED ON LAWLOR 18
a) Ground 2: Lawlor, Computerworld And CORBA1 Render Claims 4-6 Unpatentable 18
(1) Lawlor and Computerworld render claim 1 unpatentable 18
(a) Lawlor and Computerworld teach "a method for performing a real time Web transaction from a Web application over a digital network atop the Web" 18
(b) Lawlor and Computerworld teach "providing a Web page for display on a computer system coupled to an input device" 19
(c) Lawlor and Computerworld teach "providing a point-of-service application as a selection within the Web page, wherein the point-of-service application provides access to both a checking and savings account, the point-of-service application operating in a service network atop the World Wide Web"20
(d) Lawlor teaches "accepting a first signal from the Web user input device to select the point-of-service application" 23
(e) Lawlor teaches "accepting subsequent signals from the Web user input device" 24
(f) Lawlor and Computerworld render obvious "transferring funds from the checking account to the savings account in real-time utilizing a routed transactional data structure that is both complete and non-deferred, in addition to being specific to the point-of-service application, the routing occurring in response to the subsequent signals" 24
(i) Lawlor teaches "transferring funds from the checking account to the savings account in real time" 25
(ii) Lawlor teaches "utilizing a routed transactional data structure that is both complete and non-deferred, in addition to being specific to the point-of-service application, the routing occurring in response to the subsequent signals" 26
(2) Lawlor, Computerworld, and CORBA1 render claim 4 unpatentable 27
(a) Object Routing 28
(b) Web Application 34
(3) Lawlor, Computerworld, and CORBA1 render claim 5 unpatentable 35
(4) Lawlor, Computerworld, and CORBA1 render claim 6 unpatentable 38
b) Ground 3: Lawlor, Computerworld, CORBA1 and SNMP render claims 5 and 6 unpatentable 40
(1) Claim 5 40
(2) Claim 6 42
c) Ground 4: Lawlor, Computerworld, and CORBA2 render claims 4-6 Unpatentable 43

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

(1) Claim 1 43
(2) Claim 4 43
(a) Object Routing 43
(b) Web Application 47
(3) Claim 5 48
(4) Claim 6 52
d) Ground 5: Lawlor, Computerworld, CORBA2 and SNMP render claims 5 and 6 unpatentable 53
e) Rationale for Combining Lawlor, Computerworld, Corba standard and SNMP 53
(1) Lawlor and Computerworld 53
(a) Nature of the Problem to be Solved 53
(b) Combination of Prior Art Elements 54
(2) Rationale for Modifying Lawlor and Computerworld with the CORBA standard 56
(3) Rationale for Modifying Lawlor, Computerworld, the Corba standard with SNMP 57
C. GROUNDS BASED ON STANFORD FEDERAL CREDIT UNION (SFCU) 59
a) Ground 6: SFCU, Electronic Banking and CORBA1 render claims 4-6 unpatentable 59
(1) SFCU and Electronic Banking render claim 1 unpatentable 59
(a) SFCU teaches "a method for performing a real time Web transaction from a Web application over a digital network atop the Web" 59
(b) SFCU teaches "providing a Web page for display on a computer system coupled to an input device" 60
(c) SFCU renders obvious "providing a point-of-service application as a selection within the Web page, wherein the point-of-service application provides access to both a checking and savings account, the point-of-service application operating in a service network atop the World Wide Web" 60
(d) SFCU renders obvious "accepting a first signal from the Web user input device to select the point-of-service application" 62
(e) SFCU renders obvious "accepting subsequent signals from the Web user input device" 63
(f) SFCU and Electronic Banking teaches "transferring funds from the checking account to the savings account in real-time utilizing a routed transactional data structure that is both complete and non-deferred, in addition to being specific to the point-of-service application, the routing occurring in response to the subsequent signals" 64
(i) SFCU teaches "transferring funds from the checking account to the savings account" 64
(ii) SFCU and Electronic Banking teach "utilizing a routed transactional data structure that is both complete and non-deferred, in addition to being specific to the point-of-service application, the routing occurring in response to the subsequent signals" 65
(2) SFCU, Electronic Banking, and CORBA1 render claim 4 unpatentable 67
(3) SFCU, Electronic Banking, and CORBA1 render claim 5 unpatentable 69
(4) SFCU, Electronic Banking, and CORBA1 render claim 6 unpatentable 69
b) Ground 7: SFCU, Electronic Banking, CORBA1 and SNMP render claims 5 and 6 unpatentable 70
(1) Claim 5 70
(2) Claim 6 71
c) Ground 8: SFCU, Electronic Banking, and CORBA2 render claims 4-6 unpatentable 72
(1) Claim 1 72
(2) Claim 4 73
(3) Claim 5 74
(4) Claim 6 74
d) Ground 9: SFCU, Electronic Banking, CORBA2 and SNMP render claims 5 and 6 unpatentable 75
e) Rationale for Combining SFCU, Electronic Banking, CORBA and SNMP 76
(1) SFCU and Electronic Banking 76
(a) Nature of the Problem to be Solved 76
(b) Combination of Prior Art Elements 77
(2) Rationale for Modifying SFCU and Electronic Banking with the CORBA standard 78
(3) Rationale for Modifying SFCU, Electronic Banking, the CORBA standard with SNMP 78
VI. CONCLUSION 80

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

On March 22, 2013, Petitioner SAP America, Inc. ("SAP") petitioned the United States Patent Office to institute a post-grant review of claims 1-6 and 11 of U.S. Patent No. 8,037,158 to Lakshmi Arunachalam ("the '158 patent"). On September 19, 2013, the Patent Trial And Appeal Board instituted a covered business method review of the '158 patent as Case No. CBM2013-00013 (CBM2013-00013, Paper No. 15).

Here, Petitioner SAP petitions the United States Patent Office to institute a second post-grant review of the '158 patent, this time of claims 4-6, 9 and 10 (collectively, the "challenged claims" or "claims under review"). A copy of the '158 patent is provided as SAP 1001.

Accompanying this petition is a request for joinder of this trial with CBM2013-00013 under § 42.222.

I. Mandatory Notices (37 C.F.R. § 42.8(a)(1))

Real Party In Interest: The real party-in-interest of Petitioner is SAP America.

Related Matters: The following current proceedings may affect or be affected by a decision in this proceeding:

In the United States Patent and Trademark Office: *Covered Business Method* review CBM2013-00013 (U.S. Patent No. 8,037,158); *Inter Partes Review*

DOCKET ALARM Find authenticated court documents without watermarks at docketalarm.com.

IPR2013-00194 (U.S. Patent No. 8,108,492); and *Inter Partes Review* IPR2013-00195 (U.S. Patent No. 5,987,500).

U.S. Patent No. 8,037,158 is involved in the following current proceedings that may affect or be affected by a decision in this proceeding:

In the District of Delaware: *Pi-Net International, Inc* v. *Citizens Financial Group, Inc.* (No. 1:12-cv-00355); *Bank of America, N.A. and Merrill Lynch, Pierce, Fenner & Smith, Inc.* (No. 1:12-cv-00280); *JP Morgan Chase & Co.* (No. 1:12-cv-00282); *Capital One Financial Corporation et al.* (No. 1:12-cv-00356); *Sovereign Bank, N.A.* (No. 1:12-cv-00354); *UBS Financial Services* (No. 1:12-cv-00353); *Wilmington Trust Company et al.* (No. 1:12-cv-00281); and *WSFS Financial Corporation et al.* (No. 1:12-cv-00352).

In the Central District of California: *Pi-Net International, Inc. v. 1st Valley Credit Union* (No. 5:12-cv-01989); *Cal Poly Federal Credit Union* (No. 2:12-cv-09703); *In-Land Valley Federal Credit Union* (No. 5:12-cv-01990); *Media City Community Credit Union* (No. 2:12-cv-09699); and *South Bay Credit Union*, (No. 2:12-cv-09705).

In the Northern District of California: *Pi-Net International, Inc. v. Commonwealth Central Credit Union* (No. 5:12-cv-05730); *My Credit Union* (No. 3:12-cv-05733); and *San Jose Credit Union* (No. 4:12-cv-05732).

DOCKET ALARM
Find authenticated court documents without watermarks at docketalarm.com.

DOCKET ALARM

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.