

IN THE UNITED STATES PATENT TRIAL AND APPEAL BOARD

In re *Post-Grant Review* of:)
)
U.S. Patent No. 6,826,548) U.S. Class: 705/401
)
Issued: Nov. 30, 2004)
)
Inventors: Ralph M. HUNGERPILLER)
Ronald C. CAGLE)
)
Application No.: 10/057,608)
)
Filed: Jan. 24, 2002)
) FILED ELECTRONICALLY
For: SYSTEM AND METHOD FOR) PER 37 C.F.R. § 42.6(b)(1)
PROCESSING RETURN MAIL)

Mail Stop *Patent Board*
Patent Trial and Appeal Board
USPTO
P.O. Box 1450
Alexandria, VA 22313-1450

**PETITION FOR POST-GRANT REVIEW UNDER 35 U.S.C. § 321 AND
§ 18 OF THE LEAHY-SMITH AMERICA INVENTS ACT**

TABLE OF CONTENTS

I.	PRELIMINARY STATEMENT	1
II.	BACKGROUND.....	3
	A. The '548 Patent	3
	B. Prosecution History.....	4
III.	GROUND FOR STANDING.....	5
	A. At Least One Challenged Claim Is Unpatentable.....	5
	B. The '548 Patent Is a Covered Business Method Patent.....	5
	1. Claims 39 Recites Covered Business Method.....	5
	2. Claims 39–44 Do Not Claim Any Novel or Unobvious “Technological Invention”	8
	C. Patent Owner Sued Petitioner for Infringement of the '548 Patent.....	10
	D. Fees Under 37 C.F.R. § 42.15(b)	10
IV.	MANDATORY NOTICES	11
	A. Real Party-In-Interest.....	11
	B. Related Matters.....	11
	C. Lead and Back-up Counsel Service Information	11
V.	STATEMENT OF PRECISE RELIEF REQUESTED FOR EACH CLAIM CHALLENGED.....	12
	A. Claims on Which Petitioner Requests Review	12
	B. Grounds of Challenge Under 35 U.S.C. § 282(b)(2), (3) & 35 U.S.C. § 324(b)	12
	C. Claim Construction.....	13
VI.	CLAIMS 39–44 OF THE '548 PATENT RECITE ONLY NON- STATUTORY SUBJECT MATTER.....	17

A.	Claim 39 Is Unpatentable Under 35 U.S.C. § 101	19
1.	Claim 39 Recites an Abstract Idea with Only Insignificant Extra-Solution Technology	19
2.	Claim 39 Fails the Machine-or-Transformation Test.....	20
B.	Computer-Readable Medium Claim 40 Embodies Claim 39 and Is Thus Likewise Unpatentable.....	22
C.	System Claim 41 Parrots Claim 39 and Is Thus Likewise Invalid.....	23
D.	Claim 42 Adds Only Conventional Non-Technological Steps.....	25
E.	Dependent Claims 43 and 44 Add Nothing Patent-Eligible.....	26
VII.	CLAIMS 39–44 ARE UNPATENTABLE UNDER § 102 AND § 103.....	27
A.	Claims 39-44 Are Not Entitled to any Priority Date Earlier Than January 24, 2002.....	27
B.	The Patent Owner Admits that Many Features of Claims 39-44 Were Known in the Prior Art.....	30
C.	Level of Ordinary Skill in the Art.....	31
D.	<i>Park</i> Anticipates Claims 39-44	32
1.	<i>Park</i> Anticipates Claim 39.....	32
2.	<i>Park</i> Anticipates Claim 40.....	34
3.	<i>Park</i> Anticipates Claim 41.....	37
4.	<i>Park</i> Anticipates Claim 42.....	39
5.	<i>Park</i> Anticipates Claim 43.....	41
6.	<i>Park</i> Anticipates Claim 44.....	42
E.	Address Change Service System (“1997 ACS”) Anticipates Claims 39-44	42
1.	1997 ACS Anticipates Claim 39	45

2.	<i>1997 ACS</i> Anticipates Claim 40	47
3.	<i>1997 ACS</i> Anticipates Claim 41	48
4.	<i>1997 ACS</i> Anticipates Claim 42	49
5.	<i>1997 ACS</i> Anticipates Claim 43	52
6.	<i>1997 ACS</i> Anticipates Claim 44	52
F.	<i>Uhl</i> Anticipates Claims 39 – 41	53
1.	<i>Uhl</i> Anticipates Claim 39.....	53
2.	Claim 39 Is Obvious over <i>Uhl</i> in View of <i>Krause</i>	54
3.	Claim 39 Is Obvious over <i>Uhl</i> in View of <i>1997 ACS</i>	55
4.	<i>Uhl</i> Anticipates Claim 40.....	56
5.	Claim 40 Is Obvious over <i>Uhl</i> in view of <i>Krause</i>	57
6.	Claim 40 Is Obvious Over <i>Uhl</i> in View of <i>1997 ACS</i>	58
7.	<i>Uhl</i> Anticipates Claim 41.....	59
G.	Claim 42 Is Obvious Over <i>Uhl</i> in View of <i>Jatkowski</i>	60
H.	Claim 42 Is Obvious Over <i>Uhl</i> in View <i>Jatkowski</i> and Further in View of <i>1997 ACS</i>	63
I.	Claim 43 Is Obvious.....	64
1.	Claim 43 Is Obvious Over <i>Uhl</i> in View of <i>Jatkowski</i>	64
2.	Claim 43 Is Obvious Over <i>Uhl</i> in View of <i>Jatkowski</i> and Further in View of <i>1997 ACS</i>	64
J.	Claim 44 Is Obvious.....	65
1.	Claim 44 Is Obvious Over <i>Uhl</i> in View of <i>Jatkowski</i>	65
2.	Claim 44 Is Obvious Over <i>Uhl</i> in View of <i>Jatkowski</i> and Further in View of <i>1997 ACS</i>	65

...

VIII. Amendments During the Reexamination Impermissibly Broadened Claims 39-44.....	66
A. Impermissible Broadening of Method Claim 39.....	68
B. Impermissible Broadening of the Computer-Readable-Medium Claim 40.....	70
C. Impermissible Broadening of the System Claim 41	72
D. Impermissible Broadening of the Method Claim 42.....	73
E. Impermissible Broadening of Dependent Claims 43 and 44	74
IX. CONCLUSION.....	74

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.