

By: Christopher W. Kennerly (Qualtrics-OpinionLab-CBM@paulhastings.com)  
Naveen Modi (Qualtrics-OpinionLab-CBM@paulhastings.com)  
Timothy P. Cremen (Qualtrics-OpinionLab-CBM@paulhastings.com)  
Paul Hastings LLP

UNITED STATES PATENT AND TRADEMARK OFFICE

---

BEFORE THE PATENT TRIAL AND APPEAL BOARD

---

QUALTRICS, LLC

Petitioner

v.

OPINIONLAB, INC.

Patent Owner

---

Case CBM2016-00003

Patent 8,041,805

---

**PATENT OWNER'S PRELIMINARY RESPONSE**

## TABLE OF CONTENTS

	Page
I.	INTRODUCTION.....1
II.	THE '805 PATENT.....3
III.	THE BOARD FOUND THE CHALLENGED CLAIMS PATENTABLE OVER QUALTRICS' PREVIOUS <i>PETITION FOR IPR</i> .....7
A.	The Board Denied Outright Two of the Three Grounds of Petitioner's Previous <i>Petition for IPR</i> .....7
B.	The Board Determined that Petitioner Failed to Prove that Its Third Ground Rendered Any Challenged Claims Unpatentable .....9
IV.	THE '805 PATENT IS NOT ELIGIBLE FOR REVIEW UNDER § 18 OF THE AIA .....10
A.	The '805 Patent Is Not a Covered Business Method Patent .....12
1.	The Claims of the '805 Patent Are Not Directed to a "Financial Product or Service" .....12
2.	The '805 Patent Is Not Directed to a "Financial Product or Service" Merely Because the Disclosed Techniques "Can Be Applied to Commercial Transactions" Or Utilized to "Improve The Effectiveness of the Web" .....16
3.	The '805 Patent Is Not Directed to a "Financial Product or Service" Merely Because Extrinsic Evidence Indicates the Usefulness of the Claimed Invention to an Investor.....22
B.	The '805 Patent Is Directed to a "Technological Invention" .....24
1.	Considered as a Whole, the '805 Patent Claims Recite Novel and Unobvious Technological Features.....25
2.	Considered as a Whole, the '805 Patent Claims Provide a Technical Solution To a Technical Problem.....29
V.	THE CLAIMS OF THE '805 PATENT ARE PATENT- ELIGIBLE UNDER SECTION 101 .....33
A.	The Statute—35 U.S.C. § 101.....33
B.	<i>DDR Holdings</i> Confirms that the Claims of the '805 Patent Are Patent-Eligible .....34

**TABLE OF CONTENTS**  
**(continued)**

	<b>Page</b>
C. Petitioner Cannot Establish that the Claims of the '805 Patent Are Directed to An Abstract Idea.....	39
D. The Claims of the '805 Patent Recite An Inventive Concept that Ensures the Claims Are More Than An Abstract Idea Itself .....	43
VI. CONCLUSION .....	49

..

## TABLE OF AUTHORITIES

	Page(s)
<b>CASES</b>	
<i>Alice Corp. v. CLS Bank</i> , 134 S. Ct. 2347 (2014).....	<i>passim</i>
<i>Apple Inc., v. ContentGuard Holdings, Inc.</i> , CBM2015-00046, Paper No. 12 (PTAB June 3, 2015).....	26, 28, 29
<i>Bilski v. Kappos</i> , 561 U.S. 593 (2010).....	39
<i>Bloomberg LP v. Quest Licensing Corp.</i> , CBM2014-00205, Paper No. 16 (PTAB Apr. 7, 2015).....	11, 28, 29
<i>Content Extraction and Transmission LLC v. Wells Fargo Bank, Nat. Ass'n</i> , 776 F.3d 1343 (Fed. Cir. 2014) .....	34
<i>DDR Holdings, LLC v. Hotels.com, L.P.</i> , 773 F.3d 1245 (Fed. Cir. 2014) .....	<i>passim</i>
<i>Epsilon Data Mgmt., LLC v. RPost Comm'ns Ltd.</i> , CBM2014-00017, Paper No. 21 (PTAB Apr. 22, 2014).....	27, 28
<i>J.P. Morgan Chase &amp; Co. v. Intellectual Ventures II LLC</i> , CBM2014-00160, Paper No. 11 (PTAB Jan. 29, 2015).....	<i>passim</i>
<i>Mayo v. Prometheus Labs.</i> , 132 S. Ct. 1289 (2011).....	<i>passim</i>
<i>Par Pharm., Inc. v. Jazz Pharm., Inc.</i> , CBM2014-00149, Paper No. 12 (PTAB Jan. 13, 2015).....	21
<i>PNC Bank et al. v. Parus Holdings, Inc.</i> , CBM2015-00109, Paper No. 10 (PTAB Nov. 9, 2015) .....	12, 15, 22
<i>Roxane Labs. Inc. v. Jazz Pharm., Inc.</i> , CBM2014-00161, Paper No. 16 (PTAB Feb. 9, 2015) .....	12, 23

**TABLE OF AUTHORITIES**  
**(continued)**

	<b>Page(s)</b>
<i>Sega of Am., Inc. v. Uniloc USA, Inc.</i> , CBM2014-00183, Paper No. 11 (PTAB Mar. 10, 2015) .....	15, 16
<i>ServiceNow, Inc. v. BMC Software, Inc.</i> , CBM2015-00107, Paper No. 12 (PTAB Sept. 11, 2015) .....	20, 21, 23
<i>ServiceNow, Inc. v. Hewlett-Packard, Co.</i> , CBM2015-00108, Paper No. 10 (PTAB October 7, 2015) .....	<i>passim</i>
<i>Sony Corp. of Am. v. Network-1 Tech., Inc.</i> , CBM2015-00078, Paper No. 7 (PTAB July 1, 2015) .....	10, 12, 23

**STATUTES**

35 U.S.C. § 101 .....	<i>passim</i>
35 U.S.C. § 315(e) .....	2
35 U.S.C. § 323 .....	1

**OTHER AUTHORITIES**

37 C.F.R. § 42.107(b) .....	1
37 C.F.R. § 42.301(a) .....	2, 11
37 C.F.R. § 42.301(b) .....	<i>passim</i>
157 Cong. Rec. S5441 (daily ed. Sept. 8, 2011) .....	18
AIA § 18 .....	<i>passim</i>

# 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.