

IN THE
**United States Patent and
Trademark Office**
Before the Patent Trial and Appeal Board

EBAY INC. and PAYPAL, INC.,
Petitioner,

v.

XPRT VENTURES, LL
Patent Owner.

CBM2017-00025 (Patent No. 7,627,528 B2)

**PATENT OWNER'S RESPONSE TO THE
PETITIONER'S PETITION**
(37 C.F.R. Section 42.220)

Dated: October 23, 2017

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TABLE OF AUTHORITIES

CASES:

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<i>Board of Trustees of the Leland Stanford Junior University v. Roche Molecular Systems, Inc.</i> , 131 S.Ct. 2188 (2011)	9
<i>Cammeyer v. Newton</i> , 94 U.S. (4 Otto) 225 (1876)	7
<i>Cleveland v. United States</i> , 531 U.S. 12 (2000).....	6
<i>Commodity Futures Trading Comm’n v. Schor</i> , 478 U.S. 833 (1986)	<i>passim</i>
<i>Consolidated Fruit-Jar Co. v. Wright</i> , 94 U.S. (4 Otto) 92 (1876)	6
<i>Crowell v. Benson</i> , 285 U.S. 22 (1932)	<i>passim</i>
<i>Crozier v. Fried, Krupp Aktiengesellschaft</i> , 224 U.S. 290 (1912)	7
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<i>Enfish, LLC v. Microsoft Corporation</i> , (Fed. Cir. 2016).....	3, 4
<i>Evans v. Jordan</i> , 8 Fed. Cas. 872 (C.C.D.Va. 1813)	8
<i>General Motors Corp. v. Romein</i> , 503 U.S. 181 (1992).....	21

<i>Hartford-Empire Co. v. United States</i> , 323 U.S. 386 (1945).....	7
<i>Horne v. Department of Agriculture</i> , 135 S. Ct. 2419 (2015).....	7
<i>In re Baxter Int'l, Inc.</i> , 678 F.3d 1357 (Fed. Cir. 2012).....	18
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<i>J.E.M. Ag Supply, Inc. v. Pioneer Hi-Bred Int'l, Inc.</i> , 534 U.S. 124 (2001).....	11
<i>James v. Campbell</i> , 104 U.S. 356 (1881).....	7
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<i>Mazer v. Stein</i> , 347 U.S. 201 (1954).....	11
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<i>McCormick Harvesting Mach. Co. v.</i> <i>C. Aultman & Co.</i> , 169 U.S. 606 (1898).....	7
<i>McKeever v. United States</i> , 14 Ct. Cl. 396 (1878).....	9
<i>Microsoft Corp. v. i4i Ltd.</i> , 564 U.S. 91 (2011).....	7

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