

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ASKELADDEN L.L.C.,
Petitioner,

v.

NEXTCARD, LLC,
Patent Owner.

Case IPR2017-00105
Patent 7,552,080

PATENT OWNER PRELIMINARY RESPONSE

Mail Stop Patent Board
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-14

TABLE OF CONTENTS

I. INTRODUCTION	1
II. OVERVIEW OF THE '080 PATENT	1
III. SUMMARY OF GROUNDS FOR REVIEW	2
IV. CLAIM CONSTRUCTION	2
V. PETITIONER HAS NOT ESTABLISHED A REASONABLE LIKELIHOOD OF PREVAILING	7
A. The Board Should Deny Institution on Ground 1 Because Petitioner Has Not Established That Tengel, Walker I, and Nabors, in Combination, Meet All the Limitations of each of Claims 1 to 6 and 9 to 11.	8
1. <i>Tengel Does Not Disclose Any of Elements A, C, D, E</i>	10
2. <i>Nabors Does Not Disclose Limitations B, C, D, or E</i>	12
3. <i>Walker I Does Not Disclose Limitations A, C, D and E</i>	12
4. <i>The Combination of Tengel, Walker I, and Nabors Does Not Teach Element D</i> 13	
B. The Board Should Deny Institution on Ground 2 Because Petitioner Has Not Established That Tengel, Walker I, Nabors, and Walker II, in Combination, Render Claim 7 Obvious.....	16
C. The Board Should Deny Institution on Ground 2 Because Petitioner Has Not Established That Tengel, Walker I, Nabors, and Watson, in Combination, Render Claim 8.	16
VI. CONCLUSION	Error! Bookmark not defined.

I. INTRODUCTION

NextCard LLC (“NextCard” or “Patent Owner”) submits this preliminary response to the petition (Paper 1, the “Petition”) filed on October 19, 2016, by Askeladden LLC (“Petitioner”) and challenging claims of U.S. Patent No. 7,552,080 (Ex. 1001, “the ’080 patent”). The Board should deny institution because Petitioner has not established a reasonable likelihood of prevailing as to any of the independent claims and, therefore, because Petitioner applies same evidence and reasoning to the dependent claims, as to all the claims.

II. OVERVIEW OF THE ’080 PATENT

The ’080 patent describes and claims a computer implemented method, system and computer program product for determining and transmitting to an applicant offers based on the terms required by requested terms and applicant’s preferred terms. The specification describes several different ways the program determines which terms are preferred. The system, which is embodied by one or more computers running software, receives over a network a plurality of terms requested by the applicant, wherein at least one of the requested terms is indicated by the applicant as preferred over at least another one of the requested terms. It then determines with one or more computers a set of offers for the applicant. If the set of offers includes at least one offer that meets all the requested terms, the system

selects from among the set of offers at least one offer that meets all the requested terms. If the set of offers does not include at least one offer that meets all the requested terms, but includes at least one offer that meets at least one of the preferred requested terms, the systems selects from among the set of offers at least one offer that meets the at least one of the preferred requested terms. Otherwise, the system does not select an offer from the set of offers. The system then transmits any offers selected from the set of offers to the applicant.

III. SUMMARY OF GROUNDS FOR REVIEW

The Petition asserts three grounds of alleged unpatentability:

- Ground 1: Claims 1-6, and 9-11 are obvious under 35 USC § 103 over US 5,940,812 (“Tengel”) (Exhibit 1006), US 7,552,080 (“Walker I”) (Exhibit 1007), and US 7,236,983 (“Nabors”) (Exhibit 1008).
- Ground 2: Claim 7 is obvious under 35 USC § 103 over Tengel, Walker I, Nabors, and US 5,970,478 (“Walker II”) (Exhibit 1010).
- Ground 3: Claim 8 is allegedly obvious under 35 USC §103 over Tengel, Walker I, Nabors, and US 8,271,379 (“Watson”) (Exhibit 1011).

IV. CLAIM CONSTRUCTION

Patent Owner does not take issue with the following interpretations offered by
Petitioner:

- “terms requested by the applicant” and “the requested terms” both mean “terms specified by the applicant.”
- “desired changes to those terms” (claim 7) means “desired changes to the terms of the current card of the applicant.”
- “the requested term” (claim 9) means “at least one of the plurality of terms requested by the applicant.”

Patent Owner, however, disagrees with Petitioner’s contention that several conditional statements in the independent claims must be treated as optional elements that are not required to be shown under the broadest reasonable interpretation. (Petition at 7). The conditional statements or limitations in claim 1 are:

- “if the set of offers includes at least one offer that meets all of the requested terms, selecting with the one or more computer from among the set of offers at least one offer that meets all of the requested terms;
- “if the set of offers does not include at least one offer that meets all of the

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.