

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN EXPRESS CO., AMERICAN EXPRESS TRAVEL CO.,
EXPEDIA, INC., ORBITZ WORLDWIDE, INC., PRICELINE.COM INC.,
TRAVELOCITY.COM LP, YAHOO! INC., HOTELS.COM LP,
HOTELS.COM GP, LLC, HOTWIRE, INC.,
Petitioner,

v.

HARVEY LUNENFELD,
Patent Owner.

Case CBM2014-00050
Patent 8,239,451 B1

Before MIRIAM L. QUINN, KARL D. EASTHOM, and
FRANCES L. IPPOLITO, *Administrative Patent Judges*.

IPPOLITO, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 328(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

American Express Company et al. (collectively, “Petitioner”) filed a Petition requesting a covered business method patent review of claims 1, 5, 15, 21, 31, and 35 (“the challenged claims”) of U.S. Patent No. 8,239,451 B1 (“the ’451 patent”) pursuant to section 18(a) of the Leahy-Smith America Invents Act (“AIA”).¹ Paper 1 (“Pet.”). Patent Owner filed a Preliminary Response. Paper 16 (“Prelim. Resp.”). On June 18, 2014, we instituted this proceeding as to claims 1, 5, 15, 21, 31, and 35 on two grounds of unpatentability, 35 U.S.C. §§ 101, 103. Paper 17 (“Dec. to Inst.”).

After institution of trial, Patent Owner filed a Patent Owner Response (Paper 33 (“PO Resp.”)) and a contingent Motion to Amend (Paper 34, (“Mot. to Amend”)). Petitioner filed a Reply (Paper 37 (“Pet. Reply”)) and an Opposition to Patent Owner’s Motion to Amend (Paper 38 (“Opp. to Mot. to Amend”)). Patent Owner then filed a Reply to Petitioner’s Opposition to its Motion to Amend. Paper 40 (“PO Reply”). Oral hearing was held on February 24, 2015. A transcript of the hearing is in the record. Paper 50 (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This is a Final Written Decision under 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 1, 5, 15, 21, 31, and 35 are unpatentable under §§ 101 and 103, and we deny Patent Owner’s Motion to Amend.

¹ Pub. L. 112-29, 125 Stat. 284, 329 (2011).

A. Related Matters

Petitioner represents that the '451 patent is involved in district court proceedings as follows:

MetaSearch Sys., LLC v. Am. Express Co., No. 1:12-cv-01225-LPS (D. Del. filed Sept. 28, 2012);

MetaSearch Sys., LLC v. TravelZoo Inc., No. 1:12-cv-01222-LPS (D. Del. filed Sept. 28, 2012);

MetaSearch Sys., LLC v. Yahoo! Inc., No. 1:12-cv-01223-LPS (D. Del. filed Sept. 28, 2012);

MetaSearch Sys., LLC v. KAYAK Software Corp., No. 1:12-cv-01224-LPS (D. Del. filed Sept. 28, 2012);

MetaSearch Sys., LLC v. Bookit.com Inc., No. 1:12-cv-01226-LPS (D. Del. filed Sept. 28, 2012);

MetaSearch Sys., LLC v. Expedia Inc., No. 1:12-cv-01188-LPS (D. Del. filed Sept. 21, 2012);

MetaSearch Sys., LLC v. Orbitz Worldwide, Inc., No. 1:12-cv-01190-LPS (D. Del. filed Sept. 21, 2012);

MetaSearch Sys., LLC v. Priceline.com Inc., No. 1:12-cv-01191-LPS (D. Del. filed Sept. 21, 2012); and

MetaSearch Sys., LLC v. Travelocity.com, LP, No. 1:12-cv-01189-LPS (D. Del. filed Sept. 21, 2012).

See Pet. 1 (citing Ex. 1050 (Order staying district court proceedings pending CBM2014-00050 and CBM2014-00001)). Patent Owner also indicates that Harvey Lunenfeld owns the '451 patent, and Metasearch Systems, LLC is the real party-in-interest "as it is the exclusive licensee of the '451 patent."

Paper 13, 2. Related U.S. Patent No. 8,326,924 B1, which claims continuity to

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the '451 patent, is involved in a covered business method patent review designated CBM2014-00001. Ex. 1050 ¶ 3

B. The '451 Patent

The '451 patent, titled “Metasearch Engine for Ordering Items Returned in Travel Related Search Results Using Multiple Queries on at Least One Host Comprising a Plurality of Server Devices,” issued on August 7, 2012, based on U.S. Patent Application No. 13/436,957.

The '451 patent is directed to a method and system for client-server multitasking or metasearching. Ex. 1001, 111:64–112:6. One embodiment described in the '451 patent employs a metasearch engine, which the '451 patent describes as “a search engine that sends user requests to several other search engines, servers, clients, and/or databases, and other suitable systems and/or devices, groups, sorts, and returns the results from each one.” *Id.* at 111:58–63. The described system may “search or metasearch a plurality of queries or keyword phrases of a plurality of sites,” and receive, place, and process orders from users “based upon selections from the returned grouped and sorted results.” *Id.* at 112:30–39. The '451 patent adds that users of the described metasearch system should be able to place orders, such as purchases, and other types of orders either directly or through servers or sites on the network. *Id.* at 3:65–4:2; *see id.* at 113:1–4. The '451 patent further teaches that substantially any item can be ordered or purchased using the disclosed metasearch system, including an airline ticket. *Id.* at 114:50–64.

Figure 1 of the '451 patent (reproduced below) illustrates client-server metasearch system 10 on network 24. Ex. 1001, 20:47–53.

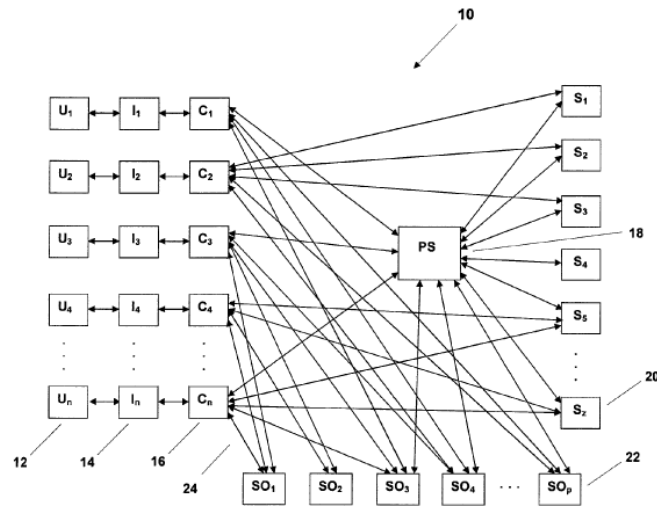


FIG. 1

Figure 1 depicts client-server metasearch system 10 having requestors or users 12, user interfaces 14, clients 16, server PS 18, servers 20, and optional servers 22. *Id.* In operation, each user 12 enters user inputs or requests into user interfaces 14. *Id.* at 20:57–60. User requests are communicated from user interfaces 14 to clients 16. *Id.* at 20:60–62. Clients communicate the user requests to servers such as server PS 18. *Id.* at 21:36–38. If the request is communicated to server PS 18, then server PS 18 may communicate it to servers 20. *Id.* at 22:8–11. Servers 20 reply to server PS 18 and communicate responses associated with the user requests to server PS 18. *Id.* at 22:18–21. Server PS 18 then communicates the responses to clients 16, which then communicate responses to user interfaces 14. *Id.* at 22:39–44. Users review the responses (e.g., search results) at the user interfaces. *Id.* at 22:49–52.

In some cases, server PS 18 (or clients 16) may parse, process, format, sort, group, or organize the responses into “corresponding service and/or information responses” acceptable to clients 16 and user interfaces 14.

Ex. 1001, 22:27–35. These organized responses may incorporate links and

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