

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

IPPOLITO, *Administrative Patent Judge*.

DECISION
Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

I. INTRODUCTION

Petitioner American Express Company, American Express Travel Company, Expedia, Inc., Orbitz Worldwide, Inc., Priceline.com Inc., Travelocity.com LP, Yahoo.com LP, Yahoo! Inc., Hotels.com LP, Hotels.com GP, LLC, Hotwire, Inc. (collectively, “Petitioner”) filed a Petition to institute 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 (“the ’451 patent”) pursuant to 35 U.S.C. §§ 321-322. (Paper 1, “Pet.”). Patent Owner Harvey Lunenfeld (“Patent Owner”) filed a Preliminary Response (Paper 16, “Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 324. The standard for instituting a covered business method review is set forth in 35 U.S.C. § 324(a):

THRESHOLD—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

We are persuaded that the ’451 patent is a covered business method patent. Further, upon consideration of the Petition and Preliminary Response, we also are persuaded that it is more likely than not that Petitioner would prevail on the assertion that the challenged claims of the ’451 patent are unpatentable on the grounds authorized and discussed below.

A. *Petitioner’s Standing*

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. et al., 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 Incorporated, 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 does not challenge Petitioner's representation. *See* Paper 13, 2. 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.

B. The '451 Patent (Ex. 1001)

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, col. 111, l. 64 – col. 112, l. 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 col. 111, ll. 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 col. 112, ll. 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 col. 3, l. 65-col. 4, l. 2; *see id.* at col. 113, ll. 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 col. 114, ll. 50-64.

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

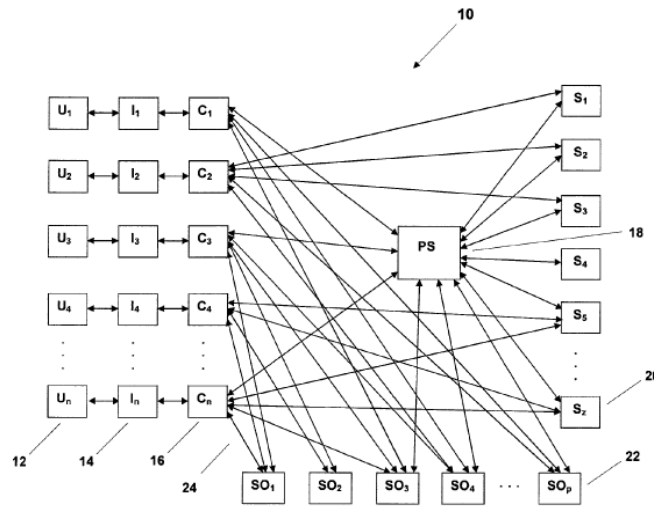


FIG. 1

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 col. 20, ll. 57-60. User requests are communicated from user interfaces 14 to clients 16. *Id.* at col. 20, ll. 60-62. Clients communicate the user requests to servers such as server PS 18. *Id.* at col. 21, ll. 36-38. If the request is communicated to server PS 18, then server PS 18 may communicate it to servers 20. *Id.* at col. 22, ll. 8-11. Servers 20 reply to server PS 18 and communicate responses associated with the user requests to server PS 18. *Id.* at col. 22, ll. 18-21. Server PS 18 then communicates the responses to clients 16, which then communicate responses to user interfaces 14. *Id.* at col. 22, ll. 39-44. Users review the responses (e.g., search results) at the user interfaces. *Id.* at col. 22, ll. 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

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