

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TEXAS ASSOCIATION OF REALTORS,
Petitioner,

v.

UBER TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2016-00615
Patent 8,510,045 B2

Before JUSTIN T. ARBES, THOMAS L. GIANNETTI, and
ROBERT L. KINDER, *Administrative Patent Judges*.

KINDER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION
35 U.S.C. § 318(a); 37 C.F.R. § 42.73

ORDER DENYING MOTION TO AMEND
37 C.F.R. § 42.121

Texas Association of REALTORS (“Petitioner”) filed a Petition pursuant to 35 U.S.C. §§ 311–319 to institute an *inter partes* review of claims 1–28 (all claims) of U.S. Patent No. 8,510,045 B2, issued on August 13, 2013 (Ex. 1001, “the ’045 patent”). Paper 1 (“Pet.”). POI Search Solutions LLC filed a Preliminary Response. Paper 9 (“Prelim. Resp.”). Applying the standard set forth in 35 U.S.C. § 314(a), we instituted an *inter partes* review of all challenged claims. Paper 10 (“Dec. on Inst.”).

On September 9, 2016, counsel for POI Search Solutions LLC, informed the Board that IP3, Series 100 of Allied Security Trust I (“IP3”) had acquired the ’045 patent. Paper 14, 2. IP3 filed updated mandatory notices reflecting the change of ownership and designating new lead and backup counsel. Paper 15, 2–3.

During the trial, IP3 filed a Patent Owner Response (Paper 26, “PO Resp.”), and Petitioner filed a Reply to the Patent Owner Response (Paper 34, “Pet. Reply”). IP3’s fully briefed Motion to Amend also is pending. Paper 25 (“Mot. to Amend”); Paper 33 (“Opp. to Mot. to Amend”); Paper 36 (“Reply to Mot. to Amend”). An oral hearing was held on April 4, 2017, and a copy of the transcript has been made part of the record. Paper 42 (“Tr.”).

Subsequently, on July 20, 2017, counsel for Uber Technologies, Inc. informed the Board that Uber had acquired the ’045 patent through an assignment executed on June 16, 2017 and recorded with the Office on July

4, 2017. *See* Paper 46 (Decision Granting Motion to Substitute Counsel), Paper 47 (Mandatory Notices).¹

We have jurisdiction under 35 U.S.C. § 6(b). This Decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of the claims on which we instituted trial. Based on the record before us, we determine that Petitioner has shown, by a preponderance of the evidence, that claims 1–28 of the ’045 patent are unpatentable under 35 U.S.C. § 103(a). We also *deny* Patent Owner’s Motion to Amend.

I. BACKGROUND

A. *The ’045 Patent*

The ’045 patent describes a method for “displaying points-of-interest (‘POIs’) on a digital map.” Ex. 1001, Abstract. The ’045 patent discloses a user selecting an arbitrary region on a digital map (displayed on an electronic device, such as a smart phone) and displaying POIs on the digital map that are within the geographic confines of the arbitrary region. *Id.* at 1:15–19. POIs may include businesses, such as coffee shops, gas stations, or other attractions. *Id.* at 1:58–65. Along with selecting an arbitrary region, the user can enter a search query to allow retrieval of various POIs by the mapping application. *Id.* at 1:63–66. The ’045 patent describes retrieving POIs based on the search query, dimensions of the map, and any other logic used by the mapping application. *Id.* at 1:66–2:1. In one embodiment, a

¹ Because ownership of the ’045 patent changed over the course of this proceeding, we use the generic designation “Patent Owner” throughout this Decision for ease of reference.

filtered subset of POIs may be displayed within the geographic confines of the user's selected region. *Id.* at 2:1–5.

B. Illustrative Claim

Claim 1 of the '045 patent recites:

1. A method of displaying points-of-interest (“POI”s) on a digital map, comprising:

displaying a digital map within a given view and at a given scale, on a graphical display of an electronic device;

receiving user input containing a search query;

providing one or more search results associated with the search query, the search results containing geographic coordinates;

receiving user input defining a geographic region within the digital map, wherein the geographic region is defined from within the current view and current scale of the digital map, and wherein the geographic region is represented by a polygon;

determining the one or more search results whose geographic coordinates are within the user defined geographic region; and

displaying the determined one or more search results as one or more graphics on the digital map; wherein the one or more graphics represent one or more POIs.

Ex. 1001, 11:64–12:16.

C. Related Proceedings

Petitioner and Patent Owner identify two related, but dismissed, litigations in the U.S. District Court for the Eastern District of Texas involving the '045 patent:

POI Search Solutions LLC v. Keller Williams Realty, Inc., 2-15-cv-00144 (E.D. Tex.); and *POI Search Solutions LLC v. Fathom Realty, LLC*, 2-15-cv-00143 (E.D. Tex.). Pet. 59; Paper 8, 2.

D. Real Party-in-Interest

In accordance with 35 U.S.C. § 312(a)(2) and 37 C.F.R. § 42.8(b)(1), Petitioner identifies Texas Association of REALTORS (“TAR”) as the real party-in-interest in this proceeding. Pet. 59.

Patent Owner argues that the Petition fails to identify all real parties-in-interest, but does not include substantive arguments in its Patent Owner Response. PO Resp. 15–16. Rather, pursuant to our authorization, Patent Owner filed a Motion to Terminate *Inter Partes* Review for failure of Petitioner to name all real parties-in-interest pursuant to 35 U.S.C. § 312(a)(2). Paper 30. TAR filed an Opposition to Patent Owner’s Motion (Paper 28), and Patent Owner filed a Reply to TAR’s Opposition (Paper 31). After consideration of the party’s positions, we issued a Decision on January 17, 2017, denying Patent Owner’s Motion to Terminate. Paper 32. Patent Owner has not produced any new evidence or argument that would impact our Decision denying Patent Owner’s Motion to Terminate. *See* PO Resp. 15–16. Therefore, we maintain our previous determination, for the reasons set forth in the Decision (Paper 32).

E. Prior Art

The pending grounds of unpatentability in the instant *inter partes* review are based on the following prior art:

U.S. Patent No. 7,373,246 B2, issued May 13, 2008 (Ex. 1003, “O’Clair”);

U.S. Patent Application Publication No. 2010/0094548 A1, filed July 9, 2009, published April 15, 2010 (Ex. 1004, “Tadman”);

U.S. Patent Application Publication No. 2009/0153492 A1, filed December 13, 2007, published June 18, 2009 (Ex. 1005, “Popp”);

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