

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRULIA, INC.
Petitioner

v.

ZILLOW, INC.
Patent Owner

Case CBM2013-00056
Patent 7,970,674

Before JAMESON LEE, JOSIAH C. COCKS, and MICHAEL W. KIM,
Administrative Patent Judges.

LEE, *Administrative Patent Judge.*

Order
Conduct of Proceedings
37 C.F.R. § 42.05

Introduction

On April 7, 2014, a telephone conference call was held between respective counsel for the parties and Judges Lee, Cocks, and Kim. The subject matter of the call was the grounds instituted for trial in this proceeding, that are based on 35 U.S.C. § 102(e) or 35 U.S.C. § 102(e)/103.

Discussion

Trial was instituted on March 10, 2013. Paper 13. Some of the grounds instituted for trial are based on prior art reference or references which are prior art under 35 U.S.C. § 102(e). Such prior art, however, does not meet the criteria for supporting a challenge under Section 18(a)(1)(C) of the Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284, 330 (2011) (“AIA”).

Specifically, the prior art at issue are Patent 7,130,810 (“Foster”); Patent 7,120,599 (“Keyes”); and Patent 7,219,078 (“Lamont”). The involved grounds are (1) claims 2, 5, 15-18, and 40 under 35 U.S.C. § 102(e) as anticipated by Foster; (2) claims 19-24 under 35 U.S.C. § 103 as unpatentable over Foster, Keyes, and Charles A. Calhoun, *Property Valuation Methods and Data in the United States*, Housing Finance International Journal 16.2 (2001)(“Calhoun”); (3) claims 2, 5, and 15-18 under 35 U.S.C. § 102(e) as anticipated by Lamont; and (4) claims 19 and 21-24 under 35 U.S.C. § 103 as unpatentable over Lamont, Foster, Keyes, and Calhoun.

Counsel for Petitioner does not dispute that references which are prior art under 35 U.S.C. § 102(e) do not meet the criteria for supporting a challenge under Section 18(a)(1)(C) of the AIA. But counsel for Petitioner points out that for each of Foster, Keyes, and Lamont, there is a corresponding published application with essentially identical content, which can serve as prior art under 35 U.S.C. § 102(b). Specifically, for Foster, the corresponding published application is US Pub.

2004/0073508; for Keyes, the corresponding published application is US Pub. 2001/0044766; and for Lamont, the corresponding published application is US Pub. 2003/0046099.

We pointed out that the Board cannot in this proceeding proceed with the grounds instituted on the basis of Foster, Keyes, or Lamont and noted that Petitioner can consider filing another petition relying on the above-noted published applications corresponding to Foster, Keyes, and Lamont. Counsel for Petitioner indicated that Petitioner would like to proceed in this case with the statement of the grounds modified to rely on the published applications. Counsel for Patent Owner indicated that if the Board decides that it has the authority to modify the grounds for trial to replace Foster, Keyes, and Lamont with each corresponding published applications, Patent Owner would not oppose such a change.

Counsel for Patent Owner further indicated that if such a change were made, Patent Owner has several requests, including one requiring the Petitioner to provide a paper that maps out how each citation to Foster, Keyes, and Lamont converts to a citation to the corresponding published applications and one precluding Petitioner from relying on the claims of the published applications.

After considering the positions of the parties, we concluded that if the parties both desire to replace the grounds based on Foster, Keyes, and Lamont with grounds based on the published applications and have the new grounds included in this trial, we will not effect that result simply by changing the patents for the publications and the § 102(e) grounds for the § 102(b) grounds. Petitioner, however, can file another petition, including only prior art grounds based in whole or in part on the publications corresponding to Foster, Keyes, and Lamont that are identical in wording, but for the identification of the references, to those grounds instituted for trial in this proceeding that are based in whole or in part on Foster,

Keyes, and Lamont. Together with the filing of such a petition, Petitioner would file a request for joinder for this proceeding and indicate that joinder is not opposed by Patent Owner. In order to facilitate joinder, Patent Owner would agree to forego the opportunity of a preliminary response. The Board could institute trial on the grounds based on the corresponding publications, which substantively would be the same as the grounds we instituted in this proceeding based on Foster, Keyes, and Lamont and then have the new proceeding joined with this proceeding.

We indicated that such a course of action can be considered only if both parties desire it. In the absence of such agreement between the parties, we would remove from this proceeding the grounds relying in any part on Foster, Keyes, or Lamont. We further noted that under 37 C.F.R. § 42.222(b), Petitioner has only one month from the date of institution of trial in this proceeding to request a joinder with this proceeding. We indicated to the parties that that one-month period expires on April 10, 2014, and that in the special circumstances of this case, if the parties jointly request a waiver of the one-month period and if there is not a substantial delay beyond the one-month period, we would be willing to consider a waiver of the rule imposing the one-month period for filing a request for joinder.

At the end of the conference call, counsel for the parties indicated that they will continue to discuss the above-noted options. Also, counsel for Patent Owner expressed that he needs to discuss the option with Patent Owner to obtain necessary approval.

Order

It is

ORDERED that the parties will continue to discuss the option discussed during the conference call held on April 7, 2014, and then inform the Board, by way of a conference call, whether an agreement has been reached with regard to a course of action concerning grounds based on Foster, Keyes, and Lamont.

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