

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TRULIA, INC.
Petitioner

v.

ZILLOW, INC.
Patent Owner

Case CBM2013-00056¹
Patent 7,970,674

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

LEE, *Administrative Patent Judge.*

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

¹ Case CBM2014-00115 has been joined with this proceeding.

Introduction

In a telephone conference held on April 7, 2014, we informed counsel for each party that the grounds instituted for trial, based in any part on Foster (Patent 7,130,810), Keyes (Patent 7,120,599), or Lamont (Patent 7,219,078), cannot be maintained because all three patents are prior art under 35 U.S.C. § 102(e) and thus do 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, 329 (2011) (“AIA”). Paper 19. All three patents, however, have corresponding published applications which constitute prior art under 35 U.S.C. § 102(b). *Id.*

We considered, but declined to substitute the published applications for the associated patents, in order to convert the non-maintainable grounds under 35 U.S.C. § 102(e) and § 102(e)/103 to maintainable grounds under 35 U.S.C. § 102(b) and § 102(b)/103. Paper 19. Instead, the parties agreed that Petitioner would file a new petition for covered business method patent review, including only the grounds based on the corresponding published applications, and a motion to join that new proceeding with this proceeding, and that Patent Owner would not oppose the joinder motion. Paper 21.

On April 10, 2014, Petitioner filed the new petition and that new proceeding is CBM2014-00115. Also on April 10, 2014, Petitioner filed a motion for joinder in CBM2014-00115, to join that proceeding with CBM2013-00056. That motion is unopposed by Patent Owner. We have instituted trial in CBM2014-00115 and granted Petitioner’s motion for joinder, in a concurrent paper.

Discussion

By this communication, we summarize and make clear what grounds of unpatentability are pending in this joined proceeding of CBM2013-00056 and CBM2014-00115, and address issues with papers, exhibits, and the schedule.

A. Grounds Withdrawn

The institution of trial on the basis of the following grounds are vacated and they are considered withdrawn and no longer pending in this joined proceeding:

(1) claims 2, 5, 15-18, and 40 under 35 U.S.C. § 102(e) as anticipated by Foster (Patent 7,130,810);

(2) claims 19-24 under 35 U.S.C. § 103 as unpatentable over Foster (Patent 7,130,810), Keyes (Patent 7,120,599), 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 (Patent 7,219,078); and

(4) claims 19 and 21-24 under 35 U.S.C. § 103 as unpatentable over Lamont (Patent 7,219,078), Foster (Patent 7,130,810), Keyes (Patent 7,120,599), and Calhoun.

B. Grounds Added

The following grounds on the basis of which trial is instituted in CBM2014-00115 are included in this joined proceeding:

(1) claims 2, 5, 15-18, and 40 under 35 U.S.C. § 102(b) as anticipated by Foster (U.S. Application Publication 2004/0073508);

(2) claims 19-24 under 35 U.S.C. § 103 as unpatentable over Foster (U.S. Application Publication 2004/0073508), Keyes (U.S. Application Publication 2001/0044766), 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(b) as anticipated by Lamont (U.S. Application Publication 2003/0046099); and

(4) claims 19 and 21-24 under 35 U.S.C. § 103 as unpatentable over Lamont (U.S. Application Publication 2003/0046099), Foster (U.S. Application Publication 2004/0073508), Keyes (U.S. Application Publication 2001/0044766, and Calhoun.

C. Identification of References

For future papers to be filed in this joined proceeding, the parties shall follow this usage for the terms “Foster,” “Lamont,” and “Keyes” when they are used alone without any modifier: “Foster” identifies and refers to U.S. Application Publication 2004/0073508; “Lamont” identifies and refers to U.S. Application Publication 2003/0046099; and “Keyes” identifies and refers to U.S. Application Publication 2001/0044766.

D. Scheduling Order

A revised scheduling order is issued in a separate and concurrent paper for this joined proceeding, which supersedes the scheduling order issued in CBM2013-00056 on March 10, 2014 (Paper 14).

E. Exhibits

Petitioner has five business days from the date of this communication to file in this joined proceeding those exhibits filed in CBM2014-00115 but not of record in CBM2013-00056, identifying them with the same exhibit numbers as used in CBM2014-00115, and also file an updated exhibit list pursuant to 37 C.F.R. § 42.63(e).

Order

It is

ORDERED that all future papers for the joined proceeding of CBM2014-00115 and CBM2013-00056 are to be filed only in CBM2013-00056, and that no more paper shall be filed in CBM2014-00115;

FURTHER ORDERED that the various grounds instituted for trial, as identified in Section A above are vacated and withdrawn such that they are no longer pending in this joined proceeding;

FURTHER ORDERED that the various grounds as identified in Section B above, on the basis of which trial has been instituted in CBM2014-00115, are included for trial in this joined proceeding;

FURTHER ORDERED that the scheduling order issued on March 10, 2014 (Paper 14) is superseded by the revised scheduling order issued in a concurrent paper;

FURTHER ORDERED that Petitioner shall file, within five business days of the date of this communication, those exhibits filed in CBM2014-00115 but not previously of record in CBM2013-00056, identifying them with the same exhibit numbers as used in CBM2014-00115, and also file an updated exhibit list pursuant to 37 C.F.R. § 42.63(e);

FURTHER ORDERED that in future papers filed in this joined proceeding, “Foster” refers to U.S. Application Publication 2004/0073508; “Lamont” refers to U.S. Application Publication 2003/0046099; “Keyes” refers to U.S. Application Publication 2001/0044766”;

FURTHER ORDERED that for this joined proceeding, the parties shall use the same caption as that used for this communication; and

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