UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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AMERICAN EXPRESS COMPANY, AMERICAN EXPRESS TRAVEL
COMPANY, INC., EXPEDIA, INC., HOTELS.COM LP, HOTELS.COM
GP, LLC, HOTWIRE, INC., ORBITZ WORLDWIDE, INC.,
PRICELINE.COM, INC., TRAVELOCITY.COM LP, and YAHOO! INC.
Petitioner

v.

METASEARCH SYSTEMS, LLC
Patent Owner
_____

Case CBM2014-00001
Patent 8,326,924 B1
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Before HOWARD B. BLANKENSHIP, KARL D. EASTHOM, and
BARBARA A. BENOIT, *Administrative Patent Judges.*

BLANKENSHIP, *Administrative Patent Judge.*

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

CBM2014-00001
Patent 8,326,924 B1

SUMMARY

Petitioner American Express Company et al. filed a petition seeking a covered business method ("CBM") patent review of Patent Owner MetaSearch Systems, LLC's U.S. Patent No. 8,326,924 ("the '924 patent") (Ex. 1001) pursuant to Section 18 of the Leahy-Smith America Invents Act ("AIA").[1] The Petition (Paper 20; "Pet.") challenges all claims (1-12) of the '924 patent as unpatentable under 35 U.S.C. §§ 101 and 103(a). The parties have filed a joint motion to withdraw the Petition's request for trial as to all claims except for claims 2, 6, and 8. Patent Owner filed a preliminary response opposing institution of the review. Paper 26 ("Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 324.

The standard for instituting a covered business method patent review is set forth in 35 U.S.C. § 324(a), which provides as follows:

> 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 determine that the '924 patent is a covered business method patent. Petitioner has demonstrated that it is more likely than not that claims 2, 6, and 8 are unpatentable under 35 U.S.C. § 101 as directed to non-statutory subject matter and are, in addition, unpatentable under 35 U.S.C. § 103(a). Therefore, we institute a covered business method patent review for claims 2, 6, and 8 of the '924 patent based upon Petitioner's challenge.

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[1] Pub. L. No. 112-29, 125 Stat. 284 (2011).

JOINT MOTION

The parties have filed a joint motion, authorized by the Board, to withdraw the Petition's request for trial as to all claims except for claims 2, 6, and 8. Papers 24, 25.[2] When instituting post-grant (or CBM patent) review, the Board may authorize the review to proceed on all or some of the challenged claims and on all or some of the grounds of unpatentability asserted for each claim. 37 C.F.R. §§ 42.208(a), 42.300(a).

The joint motion was filed before any preliminary response was due from Patent Owner. The Preliminary Response addresses only claims 2, 6, and 8. The Board had not instituted trial and had not entered a final decision at the time of the motion. In view of the present circumstances, we *grant* the joint motion to withdraw Petitioner's challenge of all claims except for claims 2, 6, and 8. Accordingly, our review of Petitioner's challenge to patentability will be limited to those claims.

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[2] The joint motion captions fewer than the ten real parties-in-interest captioned in this Decision and identified in the Petition at page 1 and in the Mandatory Notice (Paper 2). We presume that the parties are identified properly in this Decision's caption. Petitioner is encouraged to file an updated mandatory notice if necessary. *See* 35 U.S.C. § 322(a)(2) ("the petition identifies all real parties in interest"); 37 C.F.R. § 42.8 (identity of each real party-in-interest must be filed within 21 days of a change of the information).

THE CHALLENGED PATENT

The '924 patent describes a method for metasearching[3] on the Internet that includes causing an advertisement associated with the search to be displayed along with the results of the search. Ex. 1001, Abstract.

Illustrative Claim

2. A process for metasearching on the Internet, wherein the steps of the process are performed by a metasearch engine executing on a hardware device, the process comprising the steps of:

(a) receiving a Hypertext Transfer Protocol request from a client device for the metasearch engine to send at least one search query to a plurality of unique hosts that provide access to information to be searched, wherein the Hypertext Transfer Protocol request from the client device is associated with at least one travel related item that may be ordered from a plurality of travel related items that may be ordered;

(b) sending the at least one search query to the plurality of unique hosts in response to the Hypertext Transfer Protocol request received from the client device;

(c) receiving search results from the plurality of unique hosts in response to the at least one search query sent to the plurality of unique hosts;

(d) incorporating the received search results into a results list and incorporating the results list into a response;

(e) causing at least one advertisement associated with the at least one item that may be ordered to be displayed in the response;

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[3] A discussion of "metasearching" appears in our claim interpretation section, *infra*.

(f) communicating the response from the metasearch engine to the client device;

(g) receiving another Hypertext Transfer Protocol request from the client device for placing an order for the at least one item;

(h) processing the order.

COVERED BUSINESS METHOD PATENT

Related Litigation

In compliance with 37 C.F.R. § 42.302(a), Petitioner certifies that it has been sued for infringement of the '924 patent. Pet. 1. Patent Owner does not challenge the certification. An identified related case that involves the '924 patent is *MetaSearch Systems, LLC v. American Express Co.,* No. 1:12-cv-01225-LPS (D. Del. filed Sept. 28, 2012).

*Used in the Practice, Administration, or Management
of Financial Products or Services*

A covered business method patent "claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions." AIA § 18(d)(1). The legislative history of the AIA "explains that the definition of covered business method patent was drafted to encompass patents 'claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.'" 77 Fed. Reg. 48,735 (Aug. 14, 2012) (quoting 157 CONG. REC. S5432 (daily ed. Sept. 8, 2011) (statement of Sen. Schumer)).

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