

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

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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*.

EASTHOM, *Administrative Patent Judge*.

ORDER  
Conduct of the Proceeding  
37 C.F.R. § 42.5

The panel held an initial conference call in the above proceeding on April 10, 2014, between respective counsel for Petitioner and Patent Owner, and Judges Blankenship, Easthom, and Benoit. The following subjects were discussed during the conference:

Scheduling Order

The parties may seek to alter the Scheduling Order. The parties are reminded that, without obtaining prior authorization from the Board, they may stipulate to different dates for DATES 1-3, as provided in the Scheduling Order, by filing an appropriate notice with the Board. The parties may not stipulate to any other changes to the Scheduling Order.

Motions

Prior to the conference, Petitioner and Patent Owner each filed a list of proposed motions.

Petitioner requested to file a motion to correct a typographical error in the name of a listed real party-in-interest. Patent Owner does not object. Petitioner is authorized to file the motion.

Patent Owner indicated that it may file a motion to amend. A motion to amend must explain in detail how any proposed substitute claim obviates the grounds of unpatentability authorized in this proceeding, and identify where the corresponding written description support in the original disclosure can be found for each claim added. If the motion to amend includes a proposed substitution of claims beyond a one-for-one substitution, the motion must explain why more than a one-for-one substitution of claims is necessary. For further guidance regarding these requirements, Patent

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Owner is directed to several decisions concerning motions to amend: *Nichia Corporation v. Emcore Corporation*, IPR2012-00005, Paper 27 (June 3, 2013); *Idle Free Systems, Inc. v. Bergstrom, Inc.*, IPR2012-00027, Paper 26 (June 11, 2013), Paper 66 (January 7, 2014); *ZTE Corp. v. ContentGuard Holdings*, IPR2013-00136, Paper 33 (November 7, 2013); *InvenSense, Inc. v. STMicroelectronics, Inc.*, IPR2013-00241, Paper 21 (January 9, 2014); and *Toyota Motor Corp. v. American Vehicular Sciences LLC*, IPR2013-00423, Paper 27 (March 7, 2014).

Patent Owner has met the requirement to confer with the Board before filing a motion to amend. 37 C.F.R. § 42.221(a). However, to the extent that questions arise later, we encourage Patent Owner to contact the Board to arrange a conference call.

Patent Owner also anticipates filing a motion to exclude evidence. Patent Owner briefly explained the nature of the evidence that Patent Owner may move to exclude. Patent Owner served Petitioner with its objection. Petitioner intends to respond.

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference to obtain authorization to file the motion.

*Protective Order*

The parties may confer and decide to seek entry of the Board's default protective order.

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It is hereby ORDERED that the Petitioner is authorized to file a motion to correct a typographical error in the name of a real party-in-interest.

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