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
RELATED SERVICES 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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**PETITIONER'S REPLY TO
PATENT OWNER'S RESPONSE TO PETITION**

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I. INTRODUCTION

Patent Owner's Response does not overcome the *prima facie* case for invalidity established by Petitioner. Patent Owner's Response fails to address the claims as written, mischaracterizes the prior art, and advances irrelevant arguments. Accordingly, the Board should find the challenged claims unpatentable under 35 U.S.C. §§ 101 and 103.

II. PATENT OWNER DEFENDS IMAGINED CLAIMS

Patent Owner imagines patent claims with multiple limitations not actually required by the challenged claims. Patent Owner does not seek a BRI requiring these supposed limitations, or try to justify such a BRI. Instead, it merely presents patentability arguments that assume such limitations are in the claims—and dreams up advantages supposedly attributable to these imagined claim limitations. That these imagined limitations are nowhere in the claims was confirmed in the cross examination of Dr. Carbonell, Patent Owner's expert. Time and again, Dr. Carbonell readily conceded that a feature Patent Owner assumes is in the claim, is not required by the claim. Two examples illustrate. First, no challenged claim requires purchasing or e-commerce, but Patent Owner's Response (hereinafter "PO's Response" or "POR") defends the claims by referring to purchasing more than 30 times and e-commerce more than 40 times. Second, no claim requires searching heterogeneous information sources, but PO's Response more than 25

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times refers to this as a supposedly key element of the allegedly claimed invention.

Dr. Carbonell admitted that claim 2 did not require these two features or any of the following features (and his conclusions apply equally to claims 6 and 8)— each of which PO's Response discusses as if required by the claims:

Specific Hardware: Contrary to PO's Response (pp. 1 & 51), the claims do not require the metasearch engine to be "specific hardware components" or a "computer component." On the contrary, the metasearch engine is information that executes on a hardware device, and a computer does not execute on a hardware device. (Ex. 1041 at 66:16-68:8.) The specification further explains the "hardware" is not anything "specific," and has no limits beyond whatever is "suitable." (E.g., Ex. 2001 at 97:33-53; 98:7-27.)

Specific Host: Contrary to PO's Response (pp. 11-13, 39, 43, 52 & 60), the claims do not require any of the plural hosts to be a Web site, or a search engine, or an e-commerce site, or a database, or "populated by a spidering process." (Ex. 1041 at 81:13-83:25.) Rather, the claims require only that a host "provide access to information to be searched."

Specific Information: Contrary to PO's Response (pp. 10-14, 37, 42, 44, 49, 51-53 & 62), the claims do not require that the "information" accessible at the hosts be "structured," "semistructured," unstructured, or "heterogeneous" (Ex. 1041 at 83:20-84:18; 86:1-16), or "dynamic," "current, up-to-date, and complete,"

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