

PETITION FOR POST-GRANT REVIEW OF
U.S. PATENT NO. 8,326,924

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Covered Business Method Post-Grant Review of:

U.S. Patent No: 8,326,924

Issued: December 4, 2012

Applicant: Harvey Lunenfeld

Filed: August 1, 2012

Title: METASEARCH ENGINE FOR ORDERING AT LEAST ONE ITEM RETURNED IN SEARCH RESULTS USING AT LEAST ONE QUERY ON MULTIPLE UNIQUE HOSTS AND FOR DISPLAYING ASSOCIATED ADVERTISING

U.S. Class:

Group Art Unit:

Conf. No.:

Petition filed: Oct. 1, 2013

FILED ELECTRONICALLY PER
37 C.F.R. § 42.6(B)(1)

**PETITION FOR POST-GRANT REVIEW OF
A COVERED BUSINESS METHOD UNDER 35 U.S.C. § 321 AND AIA, § 18**

MAIL STOP *PATENT BOARD*
PATENT TRIAL AND APPEAL BOARD
U.S. Patent and Trademark Office
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450

TABLE OF CONTENTS

I.	PRELIMINARY STATEMENT	1
A.	Background: Marketing Via Metasearch Web Sites Circa 1996-98	3
B.	The '924 Patent.....	10
II.	GROUNDS FOR STANDING.....	16
A.	At Least One Challenged Claim Is Unpatentable.....	16
B.	Petitioners Have Been Sued For Infringement Of The '924 Patent And Are Not Estopped.....	16
C.	Claims 1-12 Are Directed To A Covered Business Method	17
D.	Claims 1-12 Are Not Directed To A “Technological Invention”	21
III.	STATEMENT OF PRECISE RELIEF REQUESTED FOR EACH CLAIM CHALLENGED	26
A.	Claims For Which Review Is Requested	26
B.	Statutory Grounds Of Challenge	26
C.	Person Having Ordinary Skill In The Art In 2000-2012.....	26
D.	Claim Construction	27
1.	Broadest Reasonable Interpretation (BRI).....	27
IV.	CLAIMS 1-12 OF THE '924 PATENT ARE UNPATENTABLE	35
A.	Claims 1-12 Are Unpatentable Under 35 U.S.C. § 101	35
1.	Introduction.....	35
2.	The Supreme Court Guideposts Show That These Claims Are Unpatentable Under Sec. 101	36
B.	Benson.....	36
C.	Flook	37
D.	Diehr	38

PETITION FOR POST-GRANT REVIEW OF
U.S. PATENT NO. 8,326,924

E.	Bilski	39
F.	Prometheus.....	40
1.	These Claims Fail The Particular-Machine-or-Transformation “Test”	42
a)	The Claimed Methods Are Not Tied To A Particular Machine	42
b)	The Claimed Methods Do Not Transform An Article.....	45
G.	Claims 1-12 Are Unpatentable Under 35 U.S.C. § 103, Over Lunenfeld PCT And Lunenfeld 2000 App. In View Of Mamma.com	45
1.	Lunenfeld PCT Is <i>Prima Facie</i> Prior Art Under Sec. 102(b)...	46
2.	Lunenfeld 2000 App. Is <i>Prima Facie</i> Prior Art Under Sec. 102(b).....	46
3.	Claims 1-12 Are Obvious Over Lunenfeld PCT And Lunenfeld 2000 App. In View Of Mamma.com.....	47
a)	Lunenfeld PCT And Lunenfeld 2000 App. In View Of Mamma.com Renders Claim 1 Obvious.....	47
b)	The Remaining Claims Are Obvious For the Same Reasons	50
4.	Patent Owner Will Have The Burden Of Showing Entitlement To A 2001 Effective Filing Date To Avoid This Art.....	52
5.	The Claims Are Not Entitled to a 2001 Filing Date	54
a)	Claims Sometimes Are Unpatentable Over Disclosures That Fail to Support The Same Claim Under Sec. 112 ...	71
V.	CLAIMS 1-12 ARE UNPATENTABLE UNDER 35 U.S.C. § 103, OVER KNOWLEDGE BROKER IN VIEW OF MAMMA.COM.....	72
VI.	CONCLUSION.....	80

TABLE OF AUTHORITIES

Page(s)

Cases

Agilent Techs., Inc. v. Affymetrix, Inc.,
567 F.3d 1366 (Fed. Cir. 2009) 54, 60

Alza Corp. v. Andrx Pharm., LLC,
603 F.3d 935 (Fed. Cir. 2010)55

Anascape, Ltd. v. Nintendo of Am., Inc.,
601 F.3d 1333 (Fed. Cir. 2010)70

Ariad Pharms, Inc. v. Eli Lilly & Co.,
598 F.3d 1336 (Fed. Cir. 2010) (en banc) 55, 67, 68

Atlantic Research Mktg. Sys., Inc. v. Troy,
659 F.3d 1345 (Fed. Cir. 2011)55

Bilski v. Kappos,
130 S. Ct. 3218 (2010)..... passim

Bruckelmyer v. Ground Heaters, Inc.,
445 F.3d 1374 (Fed. Cir. 2006)47

Chester v. Miller,
906 F.2d 1574 (Fed. Cir. 1990)71

Chiron Corp. v. Genentech, Inc.,
363 F.3d 1247 (Fed. Cir. 2004)65

CRS Advanced Tech., Inc. v. Frontline Tech., Inc.,
CBM2012-00005 (filed Sept. 21, 2012).....18

Dawson v. Dawson,
710 F.3d 1347 (Fed. Cir. 2013)67

Diamond v. Diehr,
450 U.S. 175 (1981) 38, 39

Gottschalk v. Benson,
409 U.S. 63 (1972) 36, 37

PETITION FOR POST-GRANT REVIEW OF
U.S. PATENT NO. 8,326,924

Hyatt v. Boone,
146 F.3d 1348 (Fed. Cir. 1998)55

In re Bilski, 545 F.3d 943 (Fed. Cir. 2008) (en banc),
aff'd, *Bilski v. Kappos*, 130 S. Ct. 3218 (2012)..... 42, 43

In re Curry,
84 USPQ2d 1272 (BPAI 2005)51

In re Flook, 559 F.2d 21 (CCPA 1977),
rev'd sub nom. Parker v. Flook, 437 U.S. 584 (1978)38

In re Lukach,
442 F.2d 967 (CCPA 1971).....72

In re NTP,
654 F.3d 1268 (Fed. Cir. 2011)53

In re Wyer,
655 F.2d 221 (CCPA 1981).....47

KJC Corp. v. Kinetic Concepts, Inc.,
223 F.3d 1351 (Fed. Cir. 2000)30

Lockwood v. American Airlines, Inc.,
107 F.3d 1565 (Fed. Cir. 1997)55

Magsil Corp. v. Hitachi Global Storage Tech., Inc.,
687 F.3d 1377 (Fed. Cir. 2012) 56, 62, 63, 64

Mayo Collaborative Serv. v. Prometheus Labs., Inc.,
132 S. Ct. 1289 (2012)..... passim

Novozymes A/S v. Dupont Nutrition Biosciences APS,
2013 WL 3779376 (Fed. Cir. 2013)60

Parker v. Flook,
437 U.S. 584 (1978) 37, 38, 41

Phillips v. AWH Corp.,
415 F.3d 1303 (Fed. Cir. 2005) (en banc)26

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.