

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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 No. CBM2014-00001
Patent Number 8,326,924 B1

Before the Honorable HOWARD B. BLANKENSHIP, KARL D. EASTHOM, and
BARBARA A. BENOIT, *Administrative Patent Judges*.

**SECOND DECLARATION OF DR. JAIME CARBONELL
IN SUPPORT OF PATENT OWNER METASEARCH SYSTEMS, LLC'S
REPLY IN SUPPORT OF ITS MOTION TO AMEND THE CLAIMS**

SECOND DECLARATION OF DR. JAIME CARBONELL

1. I offer this declaration in support of Patent Owner's Reply in Support of Its Motion to Amend the Claims of U.S. Patent No. 8,326,924 (the "'924 patent"). I first opine that the disclosure in the '073 patent specification and the 2000 application from which the '924 patent claims priority demonstrate that the Patent Owner was in possession of the claimed invention in the 2000 application. I also opine that the claims provide with reasonable certainty the scope of the claimed inventions. I next opine that these disclosures enable one of skill in the art to practice the full scope of the claims.

The Amended Claims Provide Reasonable Certainty As To Their Scope

2. I understand that a patent specification must conclude with one or more claims particularly pointing out and distinctly claiming the subject matter that the applicant regards as his invention. Claims are indefinite if they do not reasonably apprise those skilled in the relevant art of the applicant's intended scope of the invention when read in light of the specification

3. I understand a claim is indefinite if it contains words or phrases whose meanings are unclear when read in light of the specification. Lack of proper antecedent basis results in a "zone of uncertainty" as to construction, and renders the claim insolubly ambiguous or without reasonable certainty.

4. I further understand that a claim is considered indefinite if it does not reasonably apprise those skilled in the art of its scope. I understand that absolute precision is not necessary in the claims, and that the claims need only provide reasonable certainty. I understand that the claims are to be read in view of the

specification and prosecution history when determining if the claims provide reasonable certainty.

5. The amended claims provide reasonable certainty as to the scope of the claims when viewed in light of the specification and prosecution history. Some of the claims in the '924 patent have a classification limitation as to what items are being searched by the user, while others do not. Ex. 1001, claim 1 compared with claim 2. These limitations inform one of skill in the art that using the claimed method may constitute infringement of some claims when the items sought are travel related. On the other hand, some claims are not limited to travel related items. This difference in claims suggests to one of skill that travel related items are a subset of items that may be searched by the user.

6. The '924 patent specification contains several examples of travel related items that may be searched by a user. See, e.g., Ex. 1001 Col. 4, ll. 3-29; Col. 8, ll. 29-55; Col. 114, ll. 50-69. In light of these examples and the knowledge of one of ordinary skill in the art, one of skill would know with reasonable certainty the scope of the claims. While there may be items that people of reasonable minds may disagree are travel related items, in the context of the amended claims, there is sufficient disclosure to provide reasonable certainty as to the items that would be considered travel related. In particular, items such as airline tickets, hotel rooms, rental cars, get-away vacation packages and so on are clearly "travel related." I note that absolute certainty is not required, which further supports my opinion.

7. One of skill would understand that travel related items are a category of items that may be searched for by the user. Likewise, the '924 patent discloses that financial products may be another category of items that could be searched. The use of categorical labels for items rather than listing individual items does not render the scope of the claims uncertain.

8. I also observe that Petitioners did not raise this issue in their petition despite being able to do so under the rules governing covered business method review. This claim element of travel related items is found in the original claims and was not added in the amended claims. Thus, Petitioners could have raised this argument as a ground to allegedly invalidate the challenged claims, but chose not to.

The Amended Claims Satisfy the Written Description Requirement

9. I understand that a patent claim is invalid for lack of written description under 35 U.S.C. § 112 ¶ 1 if the specification does not “contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same.” I also understand that the written description must include every feature or limitation of the claimed invention.

10. I understand that the written description must convey clearly to those skilled in the art, that, as of the priority date sought, the inventor was in possession of the invention claimed

11. I understand that, in conducting a written description analysis:
- a. The written description analysis is based on an objective inquiry into the four corners of the specification
 - b. This inquiry into the specification is done from the perspective of one of ordinary skill in the art.
 - c. The written description requirement does not require any particular form of disclosure, and support may be based on a combination of figures and disclosures throughout the specification.
 - d. The specification need not recite the claimed invention *in haec verba, i.e.*, it need not use the same words, phrasings or presentation style as the claims.
 - e. A description that merely renders the invention obvious does not satisfy the written description requirement.
 - f. The level of detail required to satisfy the written description requirement depends on (i) the nature and scope of the claims and (ii) the complexity and predictability of the relevant technology.
 - g. Factors to be taken under consideration include the existing knowledge in the particular field, the extent and content of the prior art, the maturity of the science or technology, and the predictability of the aspect at issue.

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