

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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METASEARCH SYSTEMS LLC'S REPLY IN SUPPORT OF ITS  
CONTINGENT MOTION TO AMEND UNDER 37 C.F.R. § 42.121

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Patent Trial and Appeal Board  
U.S. Patent and Trademark  
Office P.O. Box 1450  
Alexandria, VA 22313-1450

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## I. INTRODUCTION

Metasearch's contingent motion to amend the claims should be granted because Petitioners' have not raised any viable reason why the amended claims should not be allowed. Rather, Petitioners distract the Board with issues that are unsupported in law or fact. The proposed amended claims satisfy all requirements under Title 35, and should be entered if original claims 2 and 6 are found unpatentable.

## II. ARGUMENT

Petitioners assert that the amended claims are indefinite, lack enablement, are directed at an abstract idea, and are obvious in view of Knowledge Broker. Each unsupported ground is refuted below.

### A. The Amended Claims Provide Reasonable Certainty To One of Skill In the Art As to The Scope of the Claims.

Petitioners take two terms of the claims out of context in an attempt to create ambiguity where it does not exist. First, Petitioners argue that the term "travel related" is ambiguous because people may differ on what is considered a "travel related" item. However, Petitioners improperly ask the Board to require absolute precision in the claims. Such a stark requirement has been rejected by the Supreme Court because of the inherent imprecision in language. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 134 S.Ct. 2120, 2128-2130 (2014). Indeed, Petitioners' purported expert does not opine that the amended claims are ambiguous, but only what his

conclusions are as to whether the terms are “travel related” items. Dr. Carbonell, Patent Owner’s expert and one of skill in the art (which Petitioners do not challenge that Dr. Carbonell is one of skill in the art), confirms that one of skill in the art would know with reasonable certainty the scope of the amended claims. Ex. 2042, at ¶¶ 2-8.

Petitioners’ argument regarding when the previous search occurs is misleading. The amended claims require that the previous search results be stored in the database. Ex. 2018 and 2019. The claims do not restrict when the prior search occurred, only that the previous search results be stored in the database. Petitioners’ attempt to create an issue based on when the search occurred has nothing to do with the claims. One of skill would understand that the claims’ scope is limited to those situations wherein the previous search results are stored in a database, regardless of when the search occurred.

**B. The Amended Claims Are Enabled and Particularly Described in the 2000 Application from which the ’924 Patent Claims Priority.**

The amended claims are enabled and described with more than sufficient specificity in the 2000 application from which the ’924 patent claims priority. The claim chart provided in the Motion to Amend provides specific citations to the 2000 application (Ex. 2016) for each claim element. These citations provide one of skill in the art sufficient disclosure to implement the claimed inventions and sufficient detail that the Patent

Owner was in possession of the claimed inventions in 2000. Ex. 2042, ¶¶ 9-17.

Petitioners do not offer any expert testimony to refute this fact. Rather, Petitioners misconstrue the testimony of Patent Owner's experts. Patent Owner's experts referred to unique challenges in handling structured, semistructured, and unstructured data, but the experts did not testify that such challenges were not overcome by the disclosure in the 2000 application. Indeed, Petitioners do not cite any such testimony

Lastly, Petitioners make the unfounded argument that the claims require the use of the stored results in lieu of a current search results. The amended claims do not have such limitation. Ex. 2018 and 2019. Rather, the claims require that the previously stored results be combined with the present search results and then this combination is provided to the user. Ex. 2018 at (f) and (g) and 2019 at (f) and (g). The use of the term "cache" in the Motion was simply shorthand to refer to the database that stored the previous search results. It did not limit the scope of the claims in a manner that is inconsistent with the plain language of the amended claims.

**C. The Amended Claims Are Directed At Patent-Eligible Subject Matter.**

The amended claims are directed at a comprehensive system for searching for items from multiple unique hosts, one being a database with previous search results, and processing orders for such items. Petitioners'

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