UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., EVENTBRITE INC., STARWOOD HOTELS & RESORTS WORLDWIDE, INC., EXPEDIA, INC., FANDANGO, LLC, HOTELS.COM, L.P., HOTEL TONIGHT, INC., HOTWIRE, INC., KAYAK SOFTWARE CORP., OPENTABLE, INC., ORBITZ, LLC, PAPA JOHN'S USA, INC., STUBHUB, INC., TICKETMASTER, LLC, LIVE NATION ENTERTAINMENT, INC., TRAVELOCITY.COM LP, WANDERSPOT LLC, AGILYSYS, INC., DOMINO'S PIZZA, INC., DOMINO'S PIZZA, LLC, HILTON RESORTS CORPORATION, HILTON WORLDWIDE, INC., HILTON INTERNATIONAL CO., MOBO SYSTEMS, INC., PIZZA HUT OF AMERICA, INC., PIZZA HUT, INC., and USABLENET, INC.,
Petitioner,

v.

AMERANTH, INC.
Patent Owner.

Case No. CBM2015-00082[1]
Patent 6,871,325 B1

Submitted Electronically via the Patent Review Processing System

PATENT OWNER'S REQUEST FOR REHEARING OF INSTITUTION DECISIONS

I. INTRODUCTION.

Patent Owner Ameranth, Inc., per 37 CFR § 42.71, respectfully requests rehearing of the portion of the Board's Institution Decisions in CBM2015-00082 (Paper 13) and CBM2015-00097 (Paper 12)[2], in which the Board instituted a covered business method (CBM) patent review as to claims 11-13 and 15 of U.S. Patent No. 6,871,325 (the '325 Patent), on the ground of 35 U.S.C. § 103 over U.S. Patent No. 5,948,040 ("DeLorme").[3]

Ameranth respectfully requests that the Board reconsider these Institution Decisions, and modify them to reach the necessary conclusion that no trial should be instituted as to claims 11, 12, and 15 of the '325 Patent, due to the following three overlooked and/or misapprehended matters:

1) The Institution Decisions incorrectly instituted a trial on independent claim 12 of the '325 Patent on the ground of 35 U.S.C. § 103 over DeLorme, even though **Petitioners provided no evidence or argument against the patentability of claim 12; in fact petitioners did not even challenge claim 12 vis-à-vis DeLorme**, but rather only challenged claims 11, 13, and 15 vis-à-vis DeLorme.

[2] The Board granted a Motion for Joinder and consolidated the two proceedings in CBM2015-00082. (Institution Decision, CBM2015-00097, Paper 12, at 5-6.) Accordingly, this Request for Rehearing of both Institution Decisions is filed solely in the consolidated CBM2015-00082.
[3] In the same decisions, the Board declined to institute a covered business method patent review on the grounds of claims 11, 13, and 15 under 35 U.S.C. § 103 over Inkpen, Nokia, and Digestor, claim 12 under 35 U.S.C. § 103 over Inkpen, Nokia, Digestor, and Flake, and claims 11–13 and 15 under 35 U.S.C. § 103 over Blinn and Inkpen.

(Petition in CBM 2015-00082, Paper 1, at pp. 9 and 52-63; Petition in CBM 2015-00097, Paper 2, at pp. 9, 52-63.)

2) The Institution Decisions incorrectly instituted a trial on dependent claim 15 of the '325 Patent (which depends from any or all of independent claims 11-13) on the ground of 35 U.S.C. § 103 over DeLorme, because the decision to institute trial on dependent claim 15 relied on the purported analysis of independent claim 12, which, as noted above, Petitioners did not even challenge. Dependent claim 15 claims a more limited scope than each of independent claims 11-13, and is thus allowable if any of those independent claims are allowable.

3) The Institution Decisions incorrectly instituted a trial on claim 11 of the '325 Patent on the ground of 35 U.S.C. § 103 over DeLorme, yet with no analysis of the unique patentability of claim 11. As the petitioners themselves admitted, and the Board concurred with and held (see p. 13 of the Institution Decision in CBM2015-00082, Paper 13), the "relates to orders" restriction (last clause of claim 11) means "we are **persuaded by Petitioner** that **ordering** relates to **ordering a restaurant meal**". (*Id.*, emphasis added.) DeLorme, a travel-reservation system, does not teach "ordering a restaurant meal", and neither did the Petitioners provide any evidence of, nor did the Board find in its Institution Decisions, that DeLorme teaches ordering a **restaurant meal**. It doesn't.

II. STATEMENT OF PRECISE RELIEF REQUESTED.

Patent Owner respectfully requests that the Board rehear and reconsider its Institution Decisions in CBM 2015-00082 and in CBM2015-00097, and modify those Institution Decisions to hold that trial shall not be instituted on claims 11, 12, and 15 of the '325 Patent.

III. THE RELIEF REQUESTED SHOULD BE GRANTED.

The Board's Institution Decisions on CBM2015-00082 and CBM2015-00097 should be modified because the Board "misapprehended and/or overlooked" the three issues set forth above, and discussed further below, which, when properly considered, compel the necessary conclusion that no trial should be instituted as to claims 11, 12, and 15 of the '325 Patent.

A. Relevant applicable statutes and regulations.

A request for rehearing must identify specifically all matters the party believes were misapprehended or overlooked, and the place where each matter was addressed previously in a motion, an opposition, or a reply. 37 C.F.R. § 42.71(d).

Additionally, several requirements of the America Invents Act (AIA) and the implementing regulations are directly relevant to this request for reconsideration. A petitioner in a Covered Business Method (CBM) patent proceeding bears the burden of proving that it is entitled to the requested relief, 37 C.F.R. § 42.20(c), and demonstrating that there is a reasonable likelihood that at least one of the

claims challenged in the petition is unpatentable, 35 U.S.C. § 314(a). That burden always remains with the Petitioner, and never shifts. *Dynamic Drinkware, LLC v. National Graphics, Inc.*, No. 2015-1214, slip op. at 7 (Fed. Cir. Sept. 4, 2015).

Critically, the petition must specify where each element of the claim is found in the "prior art" patents or printed publications relied upon. See 37 C.F.R. § 42.104(b)(4). And, a petition must identify "specific portions of the evidence that support the challenge," 37 C.F.R. § 42.104(b)(5), and include "a detailed explanation of the significance of the evidence," 37 C.F.R. § 42.22(a)(2).

B. Trial should not be instituted on claim 12 of the '325 Patent on the ground of 35 U.S.C. § 103 over DeLorme, because the Board overlooked that Petitioners presented no invalidity evidence against, and did not even challenge, claim 12 vis-à-vis DeLorme.

Both Petitions at issue, CBM2015-00082 and CBM2015-00097, requested that the Board institute trial per 35 U.S.C. § 103 over DeLorme as to only claims 11, 13, and 15 of the '325 Patent – **not** claim 12. (Petition in CBM 2015-00082, Paper 1, at pp. 9 and 52-63; Petition in CBM 2015-00097, Paper 2, at pp. 9, 52-63.) Significantly, Petitioners did not even ask for trial to be instituted on claim 12 under 35 U.S.C. § 103 over DeLorme, and Petitioners did not present any argument or evidence regarding claim 12's purported unpatentability under § 103 over DeLorme, including against the "waitlisting" functionality of claim 12. In fact, the Board specifically sought clarification as to this issue from Petitioner, in a

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