

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

BLANKENSHIP, *Administrative Patent Judge*.

FINAL WRITTEN DECISION  
*35 U.S.C. § 328(a) and 37 C.F.R. § 42.73*

## I. BACKGROUND

On October 1, 2013, American Express Company, et al. (collectively, “Petitioner”) filed a petition requesting a review of U.S. Patent No. 8,326,924 B1 (“the ’924 patent”) under the transitional program for covered business method patents,<sup>1</sup> asserting that claims 1–12 are directed to unpatentable subject matter under 35 U.S.C. §§ 101 and 103(a). *See* Paper 20, Corrected Petition (“Petition” or “Pet.”). The parties filed a joint motion, which the Board granted, to withdraw Petitioner’s challenge of all claims except for claims 2, 6, and 8. Patent Owner filed a preliminary response on January 3, 2014. *See* Paper 26 (“Prelim. Resp.”). We determined that Petitioner sufficiently demonstrated it was more likely than not that the challenged claims were unpatentable, and we instituted a trial on March 20, 2014. Paper 29, Decision to Institute (“Decision”).

Patent Owner filed a patent owner response on July 15, 2014. *See* Paper 45 (“PO Resp.”). Petitioner filed a reply to the patent owner response on September 11, 2014. *See* Paper 52 (“Pet. Reply”). Patent Owner filed a motion to amend the patent on July 15, 2014. *See* Paper 46 (“Mot. to Amend”). Petitioner filed an opposition to Patent Owner’s motion to amend on September 11, 2014. *See* Paper 51 (“Opp. to Mot. to Amend”). Patent Owner filed a reply to the opposition on October 2, 2014 (Paper 57). Patent Owner filed a motion for observation on cross-examination on September 16, 2014. *See* Paper 60 (“Mot. for Observ.”). Petitioner filed a response to Patent Owner’s motion for observation on October 23, 2014. *See* Paper 61 (“Resp. to Mot. for Observ.”) Each of Patent Owner and Petitioner requested an oral hearing under 37 C.F.R.

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<sup>1</sup> Pursuant to Section 18 of the Leahy-Smith America Invents Act (“AIA”) (Pub. L. No. 112-29, 125 Stat. 284 (2011)).

§ 42.70(a). Paper 63; Paper 64. The oral hearing was held on December 5, 2014. A transcript of the hearing is in the record. Paper 69, Record of Oral Hearing (“Tr.”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This is a final written decision under 35 U.S.C. § 328(a) and 37 C.F.R. § 42.73. For the reasons that follow, we determine that Petitioner has demonstrated by a preponderance of the evidence that claims 2, 6, and 8 are unpatentable, and we deny Patent Owner’s motion to amend.

*A. Instituted Grounds*

The Board instituted trial as to claims 2, 6, and 8 of the ’924 patent on the following grounds of unpatentability.

(1) Claims 2, 6, and 8 are directed to non-statutory subject matter under 35 U.S.C. § 101; and

(2) Claims 2, 6, and 8 would have been obvious under 35 U.S.C. § 103(a) over the following printed publications:

Mamma.com Web site captured by Internet Archives (May 5, 1998). (Ex. 1005) (“Mamma.com”)

Uwe M. Borghoff et al., *Constraint-based Information Gathering for a Network Publication System*, PROC. PAAM ’96, Apr. 22-24, 1996 (Ex. 1006)

Uwe M. Borghoff et al., *Agent-Based Document Retrieval for the European Physicists: A Project Overview*, PROC. 2ND INT’L CONF. ON THE

PRACTICAL APPLICATION OF INTELLIGENT AGENTS & MULTI-AGENT TECH.  
(PAAM '97), Apr. 21-23, 1997 (Ex. 1007).<sup>2</sup>

*B. Related Matters*

In compliance with 37 C.F.R. § 42.302(a), Petitioner certifies that it has been sued for infringement of the '924 patent. Pet. 1. The '924 patent is involved in the following U.S. District Court proceedings: *MetaSearch Sys., LLC v. Am. Express Co.*, No. 1:12-cv-01225-LPS (D. Del. filed Sept. 28, 2012); *MetaSearch Sys., LLC v. Expedia Inc.*, No. 1:12-cv-01188-LPS (D. Del. filed Sept. 21, 2012); *MetaSearch Sys., LLC v. Orbitz Worldwide, Inc.*, No. 1:12-cv-01190-LPS (D. Del. filed Sept. 21, 2012); *MetaSearch Sys., LLC v. Priceline.com Inc.*, No. 1:12-cv-01191-LPS (D. Del. filed Sept. 21, 2012); *MetaSearch Sys., LLC v. Travelocity.com, LP*, No. 1:12-cv-01189-LPS (D. Del. filed Sept. 21, 2012); *MetaSearch Sys., LLC v. TravelZoo Inc.*, No. 1:12-cv-01222-LPS (D. Del. filed Sept. 28, 2012); *MetaSearch Sys., LLC v. Yahoo! Inc.*, No. 1:12-cv-01223-LPS (D. Del. filed Sept. 28, 2012); *MetaSearch Sys., LLC v. Kayak Software Corp.*, No. 1:12-cv-01224-LPS (D. Del. filed Sept. 28, 2012); and *MetaSearch Sys., LLC v. Bookit.com Inc.*, No. 1:12-cv-01226-LPS (D. Del. filed Sept. 28, 2012). Paper 18, 2. U.S. Patent No. 8,239,451 B1, which issued from a parent application of the '924 patent, is the subject of Case CBM2014-00050 (PTAB 2013).

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<sup>2</sup> Consistent with the parties' references to the evidence, we refer to the Borghoff articles, collectively, as "Knowledge Broker" or "the Knowledge Broker references."

*C. The '924 Patent*

The '924 patent describes a method for metasearching<sup>3</sup> on the Internet that includes causing an advertisement associated with the search to be displayed along with the results of the search. Ex. 1001, Abstract.

Claim 2 is illustrative of the claims and is reproduced below.

2. A process for metasearching on the Internet, wherein the steps of the process are performed by a metasearch engine executing on a hardware device, the process comprising the steps of:

(a) receiving a Hypertext Transfer Protocol request from a client device for the metasearch engine to send at least one search query to a plurality of unique hosts that provide access to information to be searched, wherein the Hypertext Transfer Protocol request from the client device is associated with at least one travel related item that may be ordered from a plurality of travel related items that may be ordered;

(b) sending the at least one search query to the plurality of unique hosts in response to the Hypertext Transfer Protocol request received from the client device;

(c) receiving search results from the plurality of unique hosts in response to the at least one search query sent to the plurality of unique hosts;

(d) incorporating the received search results into a results list and incorporating the results list into a response;

(e) causing at least one advertisement associated with the at least one item that may be ordered to be displayed in the response;

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<sup>3</sup> A discussion of “metasearching” appears in our claim interpretation section, *infra*.

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