

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC
Petitioner,

v.

INVENTOR HOLDINGS, LLC
Patent Owner.

Case CBM2014-00002
Patent 5,884,270

Before BRYAN F. MOORE, TRENTON A. WARD, and
MIRIAM L. QUINN, *Administrative Patent Judges*.

QUINN, Administrative Patent Judge.

DECISION

Institution of Covered Business Method Patent Review
37 C.F.R. § 42.208

I. INTRODUCTION

Petitioner Google Inc. filed a Petition to institute a covered business method patent review of claims 1-2, 5, 10-11, 23-24, 27, and 32-33 (“the challenged claims”) of U.S. Patent No. 5,884,270 (“the ’270 patent”) pursuant to 35 U.S.C. § 321-322. (Paper 7, “Pet.”). Patent Owner Inventor Holdings, LLC¹ filed a preliminary response (Paper 15, “Prelim. Resp.”).

We have jurisdiction under 35 U.S.C. § 324. The standard for instituting a covered business method review is set forth in 35 U.S.C. § 324(a):

THRESHOLD—The Director may not authorize a post-grant review to be instituted unless the Director determines that the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.

We determine that the ’270 patent is a covered business method patent. Further, upon consideration of the Petition and Preliminary Response, we determine that it is more likely than not that Petitioner will prevail on its assertion that the challenged claims of the ’270 patent are unpatentable on the grounds authorized and discussed below.

A. *Petitioner’s Standing*

Petitioner asserts that it has been sued for infringement of the ’270 patent by Patent Owner in the United States District Court for the District of

¹ Assignee of Record for U.S. Patent No. 5,884,270 changed from Walker Digital, LLC to Inventor Holdings, LLC on December 17, 2013.

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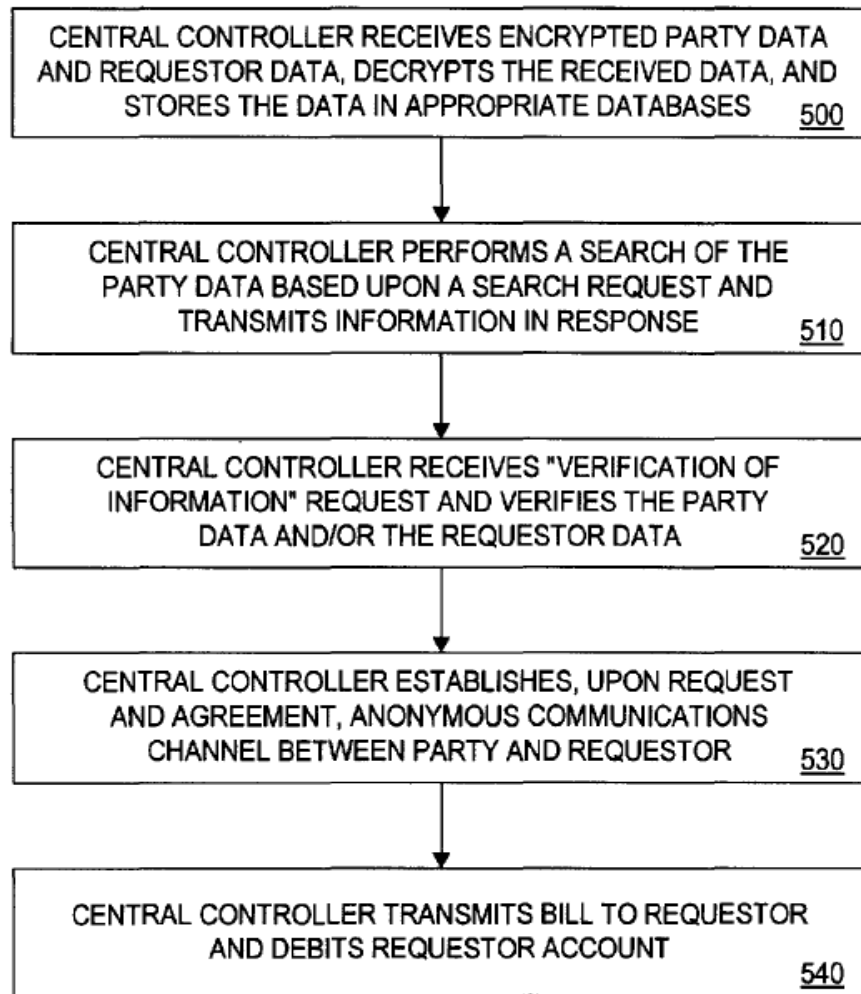
Delaware in *Walker Digital, LLC v. Google Inc.*, No. 1:11-cv-00318-LPS
(D. Del.). Pet. 2, 14.

B. The '270 Patent (Ex. 1001)

The '270 patent, titled “Method and System for Facilitating an Employment Search Incorporating User-Controlled Anonymous Communications,” issued on March 16, 1999, based on U.S. Patent Application No. 08/704,314, filed on September 6, 1996.

The '270 patent is directed to a communications method and system incorporating a central database of information supplied by one or more parties and managed by a central administrator, where all parties to the system can manage and control the release of information involving their identities. Ex. 1001, col. 4, ll. 17-22. One embodiment described in the '270 patent employs an anonymous communication system that may be used to allow an employer (a requestor) to communicate with prospective candidates (the parties) whose backgrounds satisfy employment criteria provided by the employer without revealing the identity of the candidates. *Id.* at col. 6, ll. 10-24. The described system may identify a dozen candidates from resumes stored in the central database, and may release information about those candidates only as authorized, without the company knowing the candidate's identity. *Id.* at col. 6, ll. 32-39.

The '270 patent describes one aspect of the operation of the system with respect to Figure 5, reproduced below.



In particular, Figure 5 depicts a flow diagram describing that a central controller, at step 510, searches party data in response to a search request. *Id.* at col. 15, ll. 64-67. An anonymous communication channel between the party and requestor is established upon request and agreement. *Id.* at col. 18, ll. 29-31. In one embodiment concerning dating services, when the communications channel opens, the requestor and the party can exchange adequate information about themselves to decide whether to agree to a date without subjecting themselves to any risk if either should decide not to agree

to the date. *Id.* at col. 22, ll. 4-9. The central controller also may collect payment from the requestor, and may transmit payments to parties for allowing the central controller to maintain party data. *Id.* at col. 18, l. 61- col. 19, l. 4.

C. *Related Matters*

The '270 patent is the subject matter of district court litigation in *Walker Digital, LLC v. Google Inc.*, No. 1:11-cv-00318-LPS (D. Del.) and *Walker Digital, LLC v. Criterion Capital Partners LLC et al.*, 1-11-cv-00340 (D. Del.). Paper 13, 2.

D. *Exemplary Claim*

Of the challenged claims, claims 1 and 23 are independent claims. Claim 1 of the '270 patent, reproduced below, is representative of the challenged claims.

1. A method for operating a computer system to facilitate an exchange of identities between two anonymous parties, comprising the steps of:

receiving from a first party first data including an identity of said first party;

receiving from said first party at least two first-party rules for releasing said first data including a rule for releasing said identity of said first party;

receiving from a second party a search request comprising at least one search criterion;

receiving from said second party second data including an identity of said second party;

receiving from said second party at least two second-party rules for releasing said second data including a rule for releasing said identity of said second party;

processing said search request to determine if said first data satisfies said search criterion; and if said first data satisfies

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