

PTAB and TTAB Proceedings Hosted by BPLA and Suffolk University Law School

PTAB Report

Author: Michael Clancy, Juris Doctor Candidate 2017

On April 4, 2017, the BPLA and Suffolk University Law School's Intellectual Property Concentration co-hosted live proceedings of the Trademark Trial & Appeal Board ("TTAB") and the Patent Trial & Appeal Board ("PTAB").

PTAB Proceeding

Petition for Inter Partes Review ("IPR") of U.S. Patent No. 8,510,045 ("the '045 Patent"). Petitioner, Texas Association of REALTORS®, and Patent Owner, IP3 Series 100 of Allied Security Trust I, presented oral argument before Administrative Patent Judges Thomas Giannetti, Justin Arbes and Robert Kinder. Petitioner presented arguments with regard to the unpatentability of claims 1-28 of the '045 Patent and deficiencies in the Patent Owner's motion to amend to add proposed substitute claims 29-31.

The Invention

The invention claimed in the '045 Patent is a method and system for displaying points of interest (POIs) on a digital map. More particularly, the invention relates to mapping on electronic devices (such as smart phones and handheld computing devices like iPhones and Droids, or GPS navigation devices such as Magellan and Garmin that display a digital map and combining search results (i.e., a query resulting in one or more POIs) with an arbitrary region of a digital map selected by a user. (POIs, for example, can be coffee shops, restaurants, movie theaters, businesses or attractions that someone is searching for). In one embodiment, the mapping application may display a route over a dozen streets from point A to point B, making the "selected region" the dozen streets comprising the route. The user may then manipulate the selected route-based-region and display only POIs contained within the newly-defined region resulting from the user's manipulation.

Oral Arguments

The Petitioner argued that the '045 Patent's claims were well known in the prior art by the teachings of O'Clair, Tadman, Reed, Rasmussen, Pop and Frost. The O'Clair Patent describes searching for points-of-interest and displaying those points-of-interest on a digital map. While Tadman describes user-defined destination search areas which may take the form of polygons, and returning search results located within those polygons, Rasmussen discloses user interface features and image tiling pertinent to some of the other claims and Popp describes an "interactive media display system" which includes "a touch-sensitive display surface configured to display a geographic map and receive a gesture input generated by a user on the touch-sensitive display surface while the geographic map is displayed" to "defin[e] a selected geographic area on the geographic map." The Petitioner argued that the combined teachings in the O'Clair and Reed patents as well as four published applications render the claims of the '045 Patent obvious.

The Patent Owner rebutted the prior art arguments by claiming that the '045 Patent differentiates itself from O'Clair and Tadman by allowing the user to conduct "one or more search results

whose geographic coordinates are within the user defined geographic region” while O’Clair provides for “ranked identified businesses.” Furthermore, the Patent Owner relied on an argument made in support of their proposed amended claims 29-31 to limit the scope of the ‘045 Patent by providing that a user search delimits the region of a digital map while the prior art does not.