UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

SITNET, LLC,
Patent Owner.

IPR2024-00529
Patent 8,332,454 B1

Before NEIL T. POWELL, KARA L. SZPONDOWSKI, and STEPHEN E. BELISLE, *Administrative Patent Judges*.

POWELL, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE

PATENT OWNER'S MOTION TO AMEND

37 C.F.R. § 42.121(e)

I. INTRODUCTION

On September 11, 2024, we instituted trial as to claims 1–20 of U.S. Patent No. 8,332,454 B1 ("the '454 patent"). Paper 9. After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of claim 10. Paper 13 ("Motion" or "Mot."). Petitioner filed an opposition on February 26, 2025. Paper 18 ("Opposition" or "Opp.").

In the Motion, Patent Owner requested that we provide preliminary guidance concerning the Motion in accordance with 37 C.F.R. § 42.121(a)(1)(ii). Mot. 1; *see* 37 C.F.R. § 42.121(e)(1); *see also Rules Governing Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board*, 89 Fed. Reg. 76,421 (Sept. 18, 2024) ("Final Rule"). We have considered Patent Owner's Motion and Petitioner's Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review and whether Petitioner establishes a reasonable likelihood that the substitute claims are unpatentable. 37 C.F.R. § 42.121(e)(1), (2); *see also* 35 U.S.C. § 316(d) (statutory requirements for a motion to amend); 37 C.F.R. § 42.121(a)(2), (a)(3), (b) (regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend). The reasonable likelihood standard this Preliminary Guidance applies is different than the preponderance of the evidence standard applied when ultimately deciding the Motion. *Compare* 37 C.F.R. § 42.121(e)(1) *with* § 42.121(d). Finally, this preliminary guidance is not a

"decision" for purposes of rehearing under 37 C.F.R. § 42.71(d). 37 C.F.R. § 42.121(e)(2).

For purposes of this Preliminary Guidance, we focus on the proposed substitute claims, and specifically on the amendments proposed in the Motion. *See* 37 C.F.R. § 42.121(e)(1); Final Rule, 89 Fed. Reg. at 76,425. We do not address the patentability of the originally challenged claims. *See id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties' other substantive papers on the underlying merits of Petitioner's challenges. We emphasize that the views expressed in this Preliminary Guidance are subject to change upon consideration of the complete record, including any revision to the Motion filed by Patent Owner. Thus, this Preliminary Guidance is not binding on the Board when rendering a final written decision or any other subsequent decision in this proceeding. 37 C.F.R. § 42.121(e)(2); *see Medytox, Inc. v. Galderma S.A.*, 71 F.4th 990, 1000 (Fed. Cir. 2023).

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

Patent Owner bears the ultimate burden to show that its motion to amend complies with the requirements of 35 U.S.C. § 316(d)(1), (3) and 37 C.F.R. § 42.121(a)(2), (a)(3), (b)(1), and (b)(2). 37 C.F.R. § 42.121(d)(1). For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend. *See* 37 C.F.R. § 42.121(e)(1).

1. Reasonable Number of Substitute Claims

A motion to amend must propose a reasonable number of substitute claims. 35 U.S.C. § 316(d)(1)(B); 37 C.F.R. § 42.121(a)(3). Patent Owner proposes to

substitute original claims 10–19 with substitute claims 21–30. Mot. 1. Patent Owner has shown that it proposes a reasonable number of substitute claims by proposing only one substitute claim for each of the originally challenged claims. Mot. 3; *see also* 37 C.F.R. § 42.121(a)(3) ("The presumption is that only one substitute claim would be needed to replace each challenged claim, and it may be rebutted by a demonstration of need"). Petitioner does not argue otherwise. *See* Opp.

2. Respond to Ground of Unpatentability

A motion to amend must respond to a ground of unpatentability involved in the proceeding. 37 C.F.R. § 42.121(a)(2)(i). Patent Owner responds to the grounds of unpatentability in the Petition by asserting that the newly added limitations in proposed substitute claim 21 distinguish the claim from the disclosures of Amidon (Ex. 1005) and over the combination of Wong (Ex. 1006) and Gogic (Ex. 1007). *See* Mot. 12–22. Petitioner does not argue that the Motion fails to respond to a ground of unpatentability. *See* Opp.

3. Scope of Amended Claims

A motion to amend may not enlarge the scope of the claims of the patent. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). Patent Owner's Motion does not enlarge the scope of the claims of the patent because the Motion only adds narrowing limitations. *See* Mot., 4, App. A. Petitioner does not argue otherwise. *See* Opp.

4. New Matter

A motion to amend may not introduce new subject matter. 35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii). Patent Owner's Motion identifies where each limitation in the proposed substitute claims has support in U.S. Patent App.

No. 13/274,712 (the "'712 application"), which is the application from which the '454 patent issued. *See* Mot. 7–12 (citing Ex. 1002, *passim*); *see also* Ex. 1001, code (21). Petitioner does not argue that the '712 application fails to provide written description support for the proposed substitute claims. *See* Opp.

B. Unpatentability Arguments by Petitioner

Petitioner bears the ultimate burden to show that any proposed substitute claims are unpatentable. 37 C.F.R. § 42.121(d)(2). For the reasons discussed below, at this stage of the proceeding, and based on the current record,[1] it appears that Petitioner has shown a reasonable likelihood that proposed substitute claims 21–30 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

1. Claim Construction

i. *"event node"*

Patent Owner points to disclosure (Mot. 16) in the '454 patent describing that "[e]ach node is capable of communicating in a peer-to-peer fashion with other nodes in the NDSN" and that "an event node in an NDSN [] propagates up-to-date information on the situation" (Ex. 1001, 7:48–51, 15:1–2). Although Patent Owner does not expressly propose a claim construction for the term "event node" in the proposed substitute claims, based on the disclosure highlighted above, Patent Owner asserts that "an event node is [a] node communicating information regarding a situation in a peer-to-peer fashion." Mot. 16.

[1] We express no view on the patentability of original claims 10–19 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in Patent Owner's Motion to Amend.

To the extent Patent Owner does propose a claim construction for the term "event node" in the proposed substitute claims[2], Petitioner argues that Patent Owner "improperly imports optional limitations from the specification," and "is inconsistent with other embodiments in the specification and its own expert's testimony." Opp. 2 (citing Ex. 1001, 7:42–51, 19:52–20:19, 21:53–64, 30:36–38; Ex. 1020, 25:19–28:19, 32:17–33:7; Ex. 2009 ¶ 34).

At this stage of the proceeding, we decline to adopt a construction for the term "event node" in the proposed substitute claims that requires peer-to-peer communication functionality. As noted above, the '454 patent describes that "[e]ach node is capable of communicating in a peer-to-peer fashion with other nodes in the NDSN." Ex. 1001, 15:1–2. But nothing in this portion of the '454 patent relates specifically to an event node. *See id* at 15:1–9. In fact, elsewhere in the '454 patent it is disclosed that "[i]n one embodiment, the SitNet can be formed in the absence of an event node, such as in a de-centralized (peer-to-peer) architecture." *Id.* at 7:61–63. Here, the '454 patent appears to indicate that event nodes are employed in embodiments with centralized, rather than peer-to-peer architectures. Accordingly, requiring peer-to-peer communication functionality for the "event node" in the proposed substitute claims contradicts, or at least fails to find support in, the Specification of the '454 patent.

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[2] Petitioner alleges that Patent Owner relies in the Motion on a claim construction provided in Patent Owner's Response (Opp. 1–2), which proposes, in reference to originally challenged claims 1 and 20, that an "event node" is "a node within an NDSN providing up-to-date information regarding an event or situation via peer-to-peer communication with other nodes" (Paper 14 (Patent Owner's Response), 6). As Patent Owner does not propose a construction that includes the "providing up-to-date information" functionality in this Motion, we do not address that feature here.

For purposes of this Preliminary Guidance, the claim language itself is sufficient for assessing Petitioner's unpatentability grounds in the Opposition, and there is no need for an explicit construction of the term "event node." Namely, in proposed substitute claim 21, an "event node" is an entity "in the multi-dimensional personal information network" that is "hosted by an event node server," where the functionality of the event node is defined insofar as the "first device" can "establish[] a link with the event node" and "receive[] information about the situation from the event node." We turn to Petitioner's grounds of unpatentability with this understanding in mind.

2. Patent Ineligibility

Petitioner contends that the proposed substitute claims are patent ineligible under 35 U.S.C. § 101. *See* Opp. 3–11. Specifically, Petitioner contends that "[u]nder Step 2A, Prong One, the substitute claims describe a mental process as well as a method of organizing human activity," for example, "'receiving information about the situation' [which] can be performed in the human mind." *Id.* at 8. Petitioner provides other, more comprehensive, formulations of the abstract idea or ideas recited in proposed substitute claim 21, including "*collecting* data . . . , *transmitting* a response to that data . . . , and *providing a result*," as well as "the manipulation of data—i.e., establishing a link based on a received and acknowledged invitation"—and "receiv[ing] more 'information' after 'establishing' the link." *Id.* at 4–6. Further, Petitioner contends that "[u]nder Step 2A, Prong Two, this judicial exception is not integrated into a practical application" because "the generic distribution of information over a social network may link the judicial exception to a technical field but does not add any 'meaningful limitation to the claim.'" *Id.* at 8. Accordingly, Petitioner contends

that the proposed substitute claims are "directed to an abstract idea (i.e., establishing a connection in response to an invitation)." *Id.*

Petitioner also contends that no claim elements, alone or in combination, employ more than conventional technology in implementing the abstract idea, and thus, there is no inventive concept in the proposed substitute claims. *See, e.g.*, Opp. 9 ("The '454 patent does not describe any unusual or unconventional manner for receiving and transmitting the claimed data, and, in any event, 'sending' and 'receiving' data over a network is 'not even arguably inventive.'"; "The patent[] explain[s], moreover, that the entities sending and receiving the data can use 'devices generally known to those skilled in the art,' such as 'cell phones, PDA's, personal computers, network servers, PVR's,' or 'in-vehicle and portable navigation systems.'" (citing Ex. 1001, 4:26–30); "The specification explains that the claimed 'link[s]' in a 'multi-dimensional personal information network' are implemented using 'available hardware and technologies generally known in the art.'" (citing Ex. 1001, 15:17–25)), 10 ("The claim limitations also do not provide an inventive concept when considered as an ordered combination because the claimed steps represent an intuitive and conventional process."). Petitioner notes that although "[t]he district court concluded that the formation of a projection [(which is recited in proposed substitute claim 21)] created '"plausible factual disputes" over inventiveness,' which precluded a finding of patent ineligibility at the motion-to-dismiss stage," "no such factual disputes exist here." *Id.* at 10 (citing Ex. 1023, 7; Ex. 1020, 25:14–18, 27:14–17, 43:6–11).

The Patent Office has published revised guidance concerning the application of § 101—USPTO's 2019 Revised Patent Subject Matter Eligibility Guidance, 84

Fed. Reg. 50 (Jan. 7, 2019) ("2019 Revised Guidance").[3] Under the 2019 Revised Guidance, we must first evaluate whether a claim recites a judicial exception in Step 2A, Prong One, including determining whether claim limitations fall within certain groupings of abstract ideas. 84 Fed. Reg. 50, 54. Abstract ideas include mathematical concepts, certain methods of organizing human activity, and mental processes. *Id.* at 52. If a claim recites a judicial exception, such as an abstract idea, we then proceed to Step 2A, Prong Two, where we "evaluate whether the claim as a whole integrates the recited judicial exception into a practical application of the exception." *Id.* at 54; *see also id.* at 54–55. If the claim does not integrate the judicial exception into a practical application, we proceed to Step 2B of the 2019 Revised Guidance, where we evaluate whether the claim provides an inventive concept. *Id.* at 56.

Petitioner has identified an abstract idea recited in the proposed substitute claims (i.e., establishing a connection in response to an invitation), and the current record does not show that the abstract idea is integrated into a practical application. *See* Opp. 4–8. Further, the current record does not show that the proposed substitute claims contain an inventive concept. *See id.* at 9–11. Accordingly, we determine, at this stage, that Petitioner's contentions highlighted above show a reasonable likelihood that the proposed substitute claims are patent ineligible.

3. Obviousness

Petitioner contends that the proposed substitute claims would have been obvious based on two of the originally asserted grounds in the Petition, namely,

[3] The Office's current eligibility guidance may also be found in the most recent update to the Manual of Patent Examination Procedure ("MPEP") (9th ed. rev. 01.2024 Nov. 2024). *See* MPEP § 2106. "All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance." 84 Fed. Reg. at 51.

Amidon (Ex. 1005) alone, and the combination of Wong (Ex. 1006) and Gogic (Ex. 1007). *See* Opp. 11–17, 22–24. Additionally, Petitioner contends that the proposed substitute claims would have been obvious based on the addition of Kraft[4] (Ex. 1022) to either of these two originally asserted grounds. *See id.* at 17–22, 24–25. In particular, Petitioner contends that proposed substitute claims 21–28 and 30 would have been obvious over Amidon, or, alternatively, over Amidon and Kraft. *See id.* at 11–22. Petitioner further contends that proposed substitute claims 21–29 would have been obvious over Wong and Gogic, or, alternatively, over Wong, Gogic, and Kraft. *See id.* at 22–25.

Proposed substitute independent claim 21 recites

> (a) receiving, by a first device corresponding to a node in a multi-dimensional personal information network, an invitation to establish a link with an event node <u>in the multi-dimensional personal information network, said event node hosted by an event node</u> server . . .
>
> (b) transmitting a response accepting the invitation to establish a link with the event node <u>hosted by the event node</u> server;
>
> (c) establishing a link with the event node <u>hosted by the event node</u> server; and
>
> (d) receiving information about the situation from the event node <u>hosted by the event node</u> server.

Mot., App. A (underlining highlighting newly added limitations)).

i. Amidon

Petitioner contends that Amidon teaches the newly added limitations. *See* Opp. 11–17. Specifically, Petitioner points to the Petition, which addressed limitations in originally challenged claims 1 and 20 that are similar to the newly

[4] US 7,747,648 B1, issued June 29, 2010.

added limitations in proposed substitute claim 21. *Id.* at 11 (citing Pet. 10–29, 36–37, 43–44). Petitioner provides additional explanation in the Opposition regarding proposed substitute claim 21, supported by expert testimony. *See id.* at 11–17.

Patent Owner acknowledges that "[t]he inclusion of an 'event node' brings claim 21 in line with independent claims 1 and 20" (Mot. 12), and presents arguments focusing on Amidon's alleged failure to teach an "event node" (*see id.* at 12–19).

In our Institution Decision, we determined that there was a reasonable likelihood that Amidon teaches an "event node." Paper 9, 13–16. For similar reasons to those provided in the Institution Decision, on the current record we determine there is a reasonable likelihood that Amidon teaches the newly added limitations in proposed substitute claim 21.

ii. Amidon and Kraft

With respect to the newly asserted combination of Amidon and Kraft, Petitioner contends that, to the extent necessary, Kraft cures any deficiency of Amidon regarding the newly added limitations in the proposed substitute claims. *See* Opp. 17–22. Specifically, Petitioner asserts that Kraft discloses a world model that may include features of a conventional social network and may contain a node representing an event, such as a mayoral election, that is implemented as a data structure. *Id.* at 18–20 (citing Ex. 1021 ¶¶ 63–66; Ex. 1022, 2:35–41, 2:67–3:2, 3:18–24, 3:52–55, 6:54–57, 8:26–31, 8:35–44, 9:33–36, 10:25–30).

Based on these teachings, Petitioner argues that in the combination of Kraft with Amidon, one of ordinary skill in the art "would have been motivated to establish and include an 'event node' as a participant within a conference," where, in the example of a mayoral election, "a conference amongst users would include

an entity representing the election" and "the information contained within the election entity (e.g., 'text or media content,' . . .) could be queried by and returned to users within the conference, just as messages between individuals would be exchanged." Opp. 20–21 (citing Ex. 1005, 8:49–55, 22:41–47; Ex. 1022, 3:18–24).

Petitioner reasons that one of ordinary skill in the art "would have been motivated to combine Kraft's techniques with Amidon to allow users to obtain up-to-date information regarding an event from within a conference." Opp. 20 (citing Ex. 1021 ¶ 67). In addition, Petitioner asserts that one "would have had a reasonable expectation of success, encountering no technical hurdles, in storing entities representing events in Amidon's social network data stores." *Id.* at 21–22 (citing Ex. 1021 ¶ 69).

We determine, at this stage, that Petitioner's contentions highlighted above, which are supported by expert testimony, show a reasonable likelihood that Kraft, in combination with Amidon, teaches the newly added limitations in independent proposed substitute claim 21. Petitioner's contentions further show a reasonable likelihood that it would have been obvious to combine Kraft with Amidon.

iii. Wong and Gogic

Petitioner contends that Wong and Gogic collectively teach the newly added limitations. *See* Opp. 22–24. Specifically, Petitioner points to the Petition, which addressed limitations in originally challenged claims 1 and 20 that are similar to the newly added limitations in proposed substitute claim 21. *Id.* at 22 (citing Pet. 45–59, 64–65, 69–71). Petitioner provides additional explanation in the Opposition regarding proposed substitute claim 21, supported by expert testimony. *See id.* at 22–24.

Patent Owner presents arguments focusing on the alleged failure of the combination of Wong and Gogic to teach an "event node" or an "event node server." *See* Mot. 19–22.

In our Institution Decision, we determined that there was a reasonable likelihood that the combination of Wong and Gogic teaches an "event node" and an "event node server." Paper 9, 21–23. For similar reasons to those provided in the Institution Decision, on the current record we determine there is a reasonable likelihood that the combination of Wong and Gogic teaches the newly added limitations in proposed substitute claim 21.

iv. Wong, Gogic, and Kraft

For the newly asserted combination of Wong, Gogic, and Kraft, Petitioner refers to the discussion in the Opposition provided for the combination of Kraft with Amidon to show that, to the extent Wong and Gogic fall short, "Kraft includes such an express teaching of an 'event node.'" Opp. 24. Petitioner reasons that one of ordinary skill in the art "would have been motivated to include Kraft's event node in Wong based on Wong's express suggestion to include additional types of nodes," and that "Kraft also expressly teaches the 'event' may be a 'natural disaster,' similar to Gogic's teachings that an ad-hoc communication group is formed '[d]uring emergency situations.'" *Id.* at 25 (citing Ex. 1021 ¶¶ 89–90; Ex. 1006 ¶¶ 21–22, 26–27, Figs. 5, 6; Ex. 1007, 4:20–24; Ex. 1022, 9:65–66). Moreover, Petitioner argues that one "would have recognized a new node (i.e., an event node) related to the identified event or condition (i.e., a situation) would be useful in Wong's social network to facilitate communication amongst an ad-hoc communication group related to the event or condition . . . as taught by Kraft." *Id.* (citing Ex. 1003 ¶¶ 177–178; Ex. 1021 ¶ 90).

We determine, at this stage, that Petitioner's contentions highlighted above, which are supported by expert testimony, show a reasonable likelihood that Kraft, in combination with Wong and Gogic, teaches the newly added limitations in independent proposed substitute claim 21. Petitioner's contentions further show a reasonable likelihood that it would have been obvious to combine Kraft with Wong and Gogic.

III.CONCLUSION

This concludes our Preliminary Guidance. Patent Owner has the option to reply to this Preliminary Guidance *or* to file a revised MTA by DUE DATE 3. 37 C.F.R. § 42.121(e)(3), (f); Paper 10. Patent Owner's reply or revised MTA may only respond to this Preliminary Guidance or Petitioner's Opposition and may be accompanied by new evidence (including declarations). 37 C.F.R. § 42.121(e)(3). Petitioner has the option to file a sur-reply responsive to this Preliminary Guidance, Patent Owner's reply, or Patent Owner's revised MTA but may not present new evidence in any case. 37 C.F.R. § 42.121(e)(3). Petitioner may also file a reply to the preliminary guidance in the case Patent Owner does not file a reply or revised MTA. 37 C.F.R. § 42.121(e)(4).

In addition, Patent Owner is reminded that amendments of the challenged claims may also be pursued in a separate reissue or reexamination proceeding before, during, or after an AIA trial proceeding, including subsequent to the issuance of the Final Written Decision. We draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. *See* 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner

of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. § 42.8(a)(3), (b)(2).

FOR PETITIONER:

Jonathan Tuminaro
Michael D. Specht
Jennifer Meyer Chagnon
David W. Haars
Steven M. Pappas
Timothy L. Tang
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
mspecht-PTAB@sternekessler.com
mspecht-PTAB@sternekessler.com
jchagnon-PTAB@sternekessler.com
dhaars-PTAB@sternekessler.com
spappas-PTAB@sternekessler.com
ttang-PTAB@sternekessler.com

FOR PATENT OWNER:

David L. Hecht
James Zak
HECHT PARTNERS LLP
dhecht@hechtpartners.com
jzak@hechtpartners.com
hp-sitnet@hechtpartners.com