UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

META PLATFORMS, INC.,
Petitioner,

v.

SITNET, LLC,
Patent Owner.

IPR2024-00530
Patent 9,877,345 B2

Before THU A. DANG, NEIL T. POWELL, and
KARA L. SZPONDOWSKI, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE

PATENT OWNER'S MOTION TO AMEND

37 C.F.R. § 42.121(e)

I. INTRODUCTION

On September 10, 2024, we instituted trial as to claims 1–16 of U.S. Patent No. 9,877,345 B2 ("the '345 patent"). Paper 9. After institution, Patent Owner filed a Motion to Amend that is contingent on the patentability of claims 1, 8, and 13. Paper 13 ("Motion" or "Mot."). Petitioner filed an opposition on February 25, 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 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. 4; *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 asserted in the Petition by presenting arguments explaining why the newly added limitations in proposed substitute claims 17, 24, and 29 define over the prior art in those grounds. *See* Mot. 18–21. Petitioner does not argue otherwise. *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., 5–6, 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. 14/861,340 (the "'340 application"), which is the application from which the '345 patent issued. *See* Mot. 9–17 (citing Ex. 1002, *passim*); *see also* Ex. 1001,

code (21). Petitioner does not argue that the ’340 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 17–32 are unpatentable. *See* 37 C.F.R. § 42.121(e)(1).

1. Claim Construction

i. *“event node”*

Although “[t]he District Court determined that the term ‘event node’ needed no construction,’” Patent Owner asserts that the Specification “provides a definition for an event node.” Mot. 18. Specifically, Patent Owner points to disclosure in the ’345 patent “that a ‘situation or event itself may also be associated with a node on the SitNet, ***known as event node*** for the SitNet… that propagates up-to-date information on the situation to PIA [Personal Information Aggregators] of the NDSN [N-dimensional social network] connected to the event node,’” and that “[e]ach node is capable of communicating in a peer-to-peer fashion with other nodes in the NDSN, and thus is a user’s point of connection to the NDSN.” *Id.* (citing Ex. 1001, 7:52–66, 15:26–28). Based on this disclosure, Patent Owner asserts that “an event node is a node within an NDSN providing up-to-date

[1] We express no view on the patentability of original claims 1–16 in this Preliminary Guidance. Instead, we focus on limitations added to those claims in the Patent Owner’s Motion to Amend.

information regarding an event or situation via peer-to-peer communication with other nodes." *Id.*

Petitioner argues that "these additional limitations are not present in the amendments and therefore should not be interpreted to be required by the claims," and that "even SitNet's declarant has rejected such limitations, indicating instead that an event node is simply a data structure or 'object with attributes that defines [an] event.'" Opp. 2 (quoting Ex. 1027, 33:2–7, 41:17–20).

At this stage of the proceeding, we decline to adopt Patent Owner's construction for the term "event node" in the proposed substitute claims. Some of the disclosure in the '345 patent that Patent Owner alleges provides a definition of the term "event node" merely describes exemplary functionality of event nodes. Mot. 18 (citing Ex. 1001, 7:52–66). Specifically, the '345 patent provides that "[f]or example, an entity, such as a trusted provider of information (e.g., a news source such as CNN or weather.com), establishes an event node in an NDSN that propagates up-to-date information on the situation to PIAs of the NDSN connected to that event node." Ex. 1001, 7:61–66. But proposed substitute claim 17, for example, is directed to receiving information from participants and aggregating this information, rather than propagating information. Accordingly, the "providing up-to-date information" part of Patent Owner's proposed claim construction (Mot. 18) appears to require a limitation from the Specification of the '345 patent with little relevance to the claimed embodiment.

Another portion of the '345 disclosure Patent Owner relies upon for its claim construction (Mot. 18) provides, as noted above, that "[e]ach node is capable of communicating in a peer-to-peer fashion with other nodes in the NDSN" (Ex. 1001, 15:26–27). But nothing in this portion of the '345 patent relates specifically to an event node. *See* Ex. 1001, 15:26–34. In fact, elsewhere in the

’345 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 8:9–12. Here, the ’345 patent appears to indicate that event nodes are employed in embodiments with centralized, rather than peer-to-peer architectures. Accordingly, the “peer-to-peer communication with other nodes” part of Patent Owner’s proposed claim construction contradicts, or at least fails to find support in, the Specification of the ’345 patent.

Thus, Patent Owner has not shown support for its proposed claim construction 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.” Mot. 18. For purposes of this Preliminary Guidance, the proposed substitute claims themselves provide sufficient context for understanding the meaning of “event node” for assessing Petitioner’s unpatentability grounds in the Opposition. Proposed substitute claim 17, for example, provides that the “event node” is an entity that is “hosted by an event node server” and is capable of “presenting a roll call query” and “receiving . . . a status response from one or more of the participants.” 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. 2–3. 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,” particularly because “[p]resenting a ‘roll call query’ to geographically proximate participants and then receiving and aggregating status responses from those participants are operations that can be performed in the human mind.” *Id.* at 7. Further, Petitioner contends that “[u]nder

Step 2A, Prong Two, this judicial exception is not integrated into a practical application" because "forming a network to gather status responses from a social network may link the judicial exception to a technical field but does not add any 'meaningful limitation to the claim' . . . ." *Id.* at 7–8. Accordingly, Petitioner contends that "the [substitute] claims are directed to an abstract idea (i.e., obtaining status responses from social network participants and compiling those responses into a list)." *Id.* at 8.

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. 8 ("The '345 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.'"), 9 ("The specification explains that its situational network and 'N-dimensional social network' are all implemented using 'available hardware and technologies generally known in the art.'"), 10 ("The components for performing [the claimed] functions, moreover, are arranged in a conventional architecture . . . ."). Petitioner notes that "[t]he district court concluded that the formation of a situational network created '"plausible factual disputes" over inventiveness,' which precluded a finding of patent ineligibility at the motion-to-dismiss stage." *Id.* at 10 (citing Ex. 1032, 7–9). But, Petitioner argues, "no so such factual disputes exist here," based on testimony from Patent Owner's expert. *Id.* (citing Ex. 1027, 25:14–18, 27:14–17, 57:22–58:5).

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").[2] 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, and the current record does not show that the abstract idea is integrated into a practical application. *See* Opp. 3–8. Further, the current record does not show that the proposed substitute claims contain an inventive concept. *See id.* at 8–10. 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 proposed substitute claims 17–32 would have been obvious based on newly asserted grounds that parallel the originally asserted

[2] The Office's current eligibility guidance may also be found in the most recent update to the Manual of Patent Examination Procedure ("MPEP") § 2106 (9th ed. rev. 01.2024, rev. Nov. 2024). *See* MPEP §§ 2103 through 2106.07(c). "All USPTO personnel are, as a matter of internal agency management, expected to follow the guidance." 84 Fed. Reg. at 51.

grounds in the Petition, but with the addition of either Issa[3] (Ex. 1029) or Kraft[4] (Ex. 1030). *See* Opp. 13–25. In particular, Petitioner contends that proposed substitute claims 17, 19–24, 26–29, 31, and 32 would have been obvious over Gage (Ex. 1005) and Issa (New Ground 1), and that proposed substitute claims 18, 25, and 30 would have been obvious over Gage, Issa, and Mitchell (Ex. 1013) (New Ground 2). *Id.* at 11–18. Alternatively, Petitioner contends that proposed substitute claims 17, 19, 20, 22–24, 26–29, and 31 would have been obvious over Shida (Ex. 1006) and Kraft (New Ground 3), and that proposed substitute claims 18, 21, 25, 30, and 32 would have been obvious over Shida, Kraft, and Sinha (Ex. 1007) (New Ground 4).

Proposed substitute independent claim 17 recites "forming a situational network related to the occurrence of the situation by <u>establishing an event node hosted by an event server within a N-dimensional social network and connecting the event node to a plurality of existing nodes within the N-dimensional social network, said plurality of existing nodes corresponding</u> with a plurality of participant devices . . . ." (Mot., App. A (underlining highlighting newly added limitations)). Further, in claim 17, the newly introduced "<u>event node</u>" is involved in the subsequent steps of "presenting a roll call query <u>by the event node</u> to each of the plurality of <u>existing nodes corresponding with the plurality</u> [of] participant devices<u>, said roll call query</u> soliciting a reply related to a status of the participant," and "receiving <u>at the event node</u> a status response from one or more of the participants." *Id.* Proposed substitute independent claims 24 and 29 recite similar newly added limitations. *See id.*

[3] US 7,730,216 B1, issued June 1, 2010.
[4] US 7,747,648 B1, issued June 29, 2010.

For New Ground 1, Petitioner contends that although "Gage describes forming the situational network within a network of existing nodes, Gage does not explicitly disclose an event node connecting an 'N-dimensional social network.'" Opp. 12. Petitioner contends that Issa cures Gage's deficiency with respect to the newly added limitations in claim 17. *Id.* Petitioner relies on the same contentions for proposed substitute independent claims 24 and 29. *See id.* 17.

Specifically, Petitioner asserts that Issa's framework in which an aggregation node facilitates the aggregation and sharing of content with respect to connected social network nodes, in combination with Gage, teaches the newly added limitations. *See* Opp. 12–15 (citing Ex. 1028 ¶¶ 43–52; Ex. 1029, Title, Abstract, 1:28–53, 2:57–3:39, 4:1–8, 8:60–9:20, 12:33–14:15, 14:27–15:23, 15:55–16:23, Fig. 5; Ex. 1005 ¶¶ 9, 19, 40–45).

Petitioner reasons that one of ordinary skill in the art "would have been motivated to combine Gage and Issa to provide a more-efficient process for obtaining and aggregating status indicator responses and providing those aggregated responses to better inform relief workers." *Id.* at 15 (citing Ex. 1028 ¶ 34; Ex. 1005 ¶¶ 7, 11, 21). Alternatively, Petitioner argues that one "would have been motivated to implement Issa's aggregation node and social-network interactions with Gage's disaster response system to quickly and efficiently notify friends and family." *Id.* at 16 (citing Ex. 1028 ¶ 35; Ex. 1029, 13:40–59; Ex. 1005, Abstract, ¶¶ 2, 6–8, 19, 20, 23, 37, 38). Moreover, Petitioner argues that one "would have also known how to combine Gage and Issa and would have recognized that implementing Issa would have amounted to a predictable variation of Gage." *Id.* (citing Ex. 1028 ¶ 37). New Ground 2 does not address any substantive newly added limitations. *See id.* at 17–18.

For New Ground 3, Petitioner contends that "Shida describes forming a situational network related to the occurrence of a situation," for example, where "Shida's center server forms a situational network when establishing connections with subscribers who are geographically proximate to a disaster." Opp. 18–19 (citing Ex. 1006 ¶¶ 8, 27, 30, 38, 39, 46, 56, Fig. 1). According to Petitioner, although "Shida describes node functionality, it does not explicitly disclose a node framework." *Id.* at 19. Petitioner contends that Kraft cures Shida's deficiency with respect to the newly added limitations in claim 17. *Id.* at 19 (citing Ex. 1028 ¶¶ 61–70). Petitioner relies on the same contentions for proposed substitute independent claims 24 and 29. *See id.* 24.

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 natural disaster, that is implemented as a data structure. Opp. 19–20 (citing Ex. 1028 ¶¶ 64–65; Ex. 1030, 2:35–41, 3:18–24, 8:26–31, 8:35–44, 9:65–66, 10:25–30). Petitioner argues that this so-called "node framework [in Kraft] as implemented with Shida renders obvious the claimed forming of a situational network by establishing an event node." *Id.* at 21 (citing Ex. 1028 ¶¶ 66–68). In particular, Petitioner proposes that "[t]he Shida-Kraft combination would host such an event node on a server, such as Shida's center server as implemented with Kraft's functionality," and that the combination "teaches connecting an event node to a plurality of existing nodes in an N-dimensional social network." *Id.* (citing Ex. 1028 ¶ 67; Ex. 1006 ¶¶ 27, 38, 47; Ex. 1030, 4:64–5:12, 7:39–58).

Petitioner reasons that one of ordinary skill in the art "would have been motivated to combine Shida and Kraft to provide an efficient way to continuously gather and update information related to the disaster to further aid in confirming

the safety of affected individuals." *Id.* at 22 (citing Ex. 1028 ¶¶ 57–60, 69–70). In addition, Petitioner argues that one "would have recognized that Kraft's node framework and entity models—including an entity model corresponding to a 'natural disaster' event node—would have provided an efficient way of gathering, organizing, and updating received responses along with media content from individuals impacted by a disaster." *Id.* at 23 (citing Ex. 1028 ¶¶ 58–59; Ex. 1030, 2:29–31, 2:43–46, 9:65–66, 11:58–63). Finally, Petitioner argues that one "would have also known how to combine Shida and Kraft and would have recognized that implementing Kraft would have amounted to a predictable variation of Shida." *Id.* (citing Ex. 1028 ¶ 60). New Ground 4 does not address any substantive newly added limitations. *See id.* at 24.

We determine, at this stage, that Petitioner's contentions highlighted above, which are supported by expert testimony, show a reasonable likelihood that the combinations asserted in the new grounds teach the newly added limitations in proposed substitute claims 17, 24, and 29, particularly in view of the addition of Issa and Kraft to the grounds asserted in the Petition. Petitioner's contentions further show a reasonable likelihood that it would have been obvious to combine Issa with Gage, and to combine Kraft with Shida.

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 Specht
David Haars
STERNE, KESSLER, GOLDSTEIN & FOX PLLC
jtuminar-ptab@sternekessler.com
mspecht-ptab@sternekessler.com
dhaars-ptab@sternekessler.com

FOR PATENT OWNER:

David Hecht
James Zak
HECHT PARTNERS LLP
dhecht@hechtpartners.com
jzak@hechtpartners.com