

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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MERIDIANLINK, INC  
Petitioner

v.

DH HOLDINGS, LLC  
Patent Owner,

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Case CBM2013-00008  
Patent 6,438,526

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Before, MICHAEL W. KIM, THOMAS L. GIANNETTI, and  
BRIAN J. McNAMARA, *Administrative Patent Judges*.

McNAMARA, *Administrative Patent Judge*.

ORDER  
*Conduct of the Proceedings*  
37C.F.R. § 42.5

On June 24, 2013, the Board instituted a Covered Business Method Review of U.S. Patent 6,438,526 ('526 Patent). Paper No. 20. The grounds for institution were unpatentability of claims 1-8 under 35 U.S.C. § 101, unpatentability of claims 1-8 under 35 U.S.C § 103 as obvious over the combination of U.S. Patent No. 5,940,812 (Tengel), U.S. Patent No. 5,844,544 (Geller) and U.S. Patent No. 5,293,301 (Carroll), and unpatentability of claims 1-8 under 35 U.S.C § 103 as obvious over the combination of Tengal, HomeOwners On-Line Mortgage website (HomeOwners), and the E-Loan Online Mortgage Website (E-Loan).

Tengel, which is common to all the grounds instituted under 35 U.S.C. § 103, was filed on August 19, 1997, prior to the filing dates of both the provisional application and regular application that led to issuance of the '526 Patent. However, Tengal did not issue until August 17, 1999, which is after the filing dates of both the provisional application and regular application that led to issuance of the '526 Patent. Neither the Petition nor the Patent Owner's Preliminary Response recognized that Tengal does not support a ground to challenge patentability under AIA § 18(a)(1)(C), given its filing and issue dates relative to those of the '526 Patent. AIA § 18(a)(1)(C) requires that a challenge to a claim in a covered business method patent be supported by prior art that is (i) described by pre-AIA 35 U.S.C. § 102(a) or (ii) (I) that discloses the invention more than 1 year before the date of application for patent in the United States and (II) would be described by pre-AIA 35 U.S.C. § 102(a) if the disclosure had been made by another before the invention thereof by the applicant for patent. Although Tengal is prior art under 35 U.S.C. § 102(e), it does not meet the criteria to support a challenge under AIA § 18(a)(1)(C).

Because a Covered Business Method Patent Review had been instituted based in part on Tengal, the Board initiated a telephone conference and asked the

parties to advise the Board whether they wanted to proceed on all grounds of institution, including those based on Tengel, or to proceed only on the grounds under 35 U.S.C. § 101. Specifically, Patent Owner was asked to advise the Board whether they would agree that the issue of obviousness over Tengel could be included in the proceeding notwithstanding the provisions of § 18(a)(1)(C), *supra*. Petitioner indicated that it was ready to proceed on all grounds. Patent Owner expressed a preference for proceeding only under 35 U.S.C. § 101. In view of the parties preferences, and the fact that AIA § 18(a)(1)(C) would normally preclude instituting review under 35 U.S.C. § 103 given these circumstances, we exercise our discretion in determining that the Covered Business Method Review will proceed only on the grounds asserted under 35 U.S.C. § 101. This is not a final decision on the grounds under 35 U.S.C. § 103.

In view of the reduced number of issues and the nature of the grounds under 35 U.S.C. § 101, the Board is also issuing a revised scheduling order.

In consideration of the above, it is

**ORDERED** that the Petition For Covered Business Method Review remains **GRANTED** and that the order instituting trial (Paper 20) is hereby amended to limit the trial to the grounds asserted under 35 U.S.C. § 101 only. A Covered Business Method Patent Review is not authorized on any other grounds.

**FURTHER ORDERED** that the Scheduling Order issued on June 24, 2013 (Paper No. 21) is superseded by the Revised Scheduling Order (Paper No. 25) issued contemporaneously with this Order. The Revised Scheduling Order will govern the trial schedule going forward.

Case CBM2013-00008

Patent 6,438,526

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