

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORELOGIC, INC.
Petitioner,

v.

BOUNDARY SOLUTIONS, INC.,
Patent Owner.

Case CBM2016-00016
Patent 7,092,957 B2

Before LYNNE E. PETTIGREW, PETER P. CHEN, and
RICHARD H. MARSCHALL, *Administrative Patent Judges*.

CHEN, *Administrative Patent Judge*.

DECISION

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

I. INTRODUCTION

Petitioner CoreLogic, Inc. (“CoreLogic”) filed a Petition (Paper 2, “Pet.”) to institute a covered business method (“CBM”) patent review of claims 1–19 of U.S. Patent No. 7,092,957 B2 (Ex. 1001, “the ’957 patent”), owned by Boundary Solutions, Inc. (“BSI”). BSI filed a Preliminary

Response (Paper 7, “Prelim. Resp.”). BSI also filed a disclaimer of claims 13, 16, 17, and 18. Ex. 2003.

We have jurisdiction under 35 U.S.C. § 324. For the reasons that follow, the information presented in the Petition does not establish that the ’957 patent qualifies as a covered business method patent for purposes of § 18(d)(1) of the Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112–29, 125 Stat. 284, 331 (2011). Accordingly, we decline to institute a covered business method patent review of claims 1–19 of the ’957 patent. *See* 35 U.S.C. § 324(a).

II. BACKGROUND

A. *Related Proceedings*

The parties state that BSI has asserted the ’957 patent against CoreLogic in *Boundary Solutions, Inc. v. CoreLogic, Inc.*, No. 5:14-cv-00761 (N.D. Cal.) (filed Feb. 19, 2014). Pet. 59; Paper 5 (Patent Owner’s Mandatory Notices). BSI also has asserted related U.S. Patent No. 7,499,946 (“the ’946 patent”) and U.S. Patent No. 8,065,352 (“the ’352 patent”) in that proceeding. Pet. 59; Paper 5. The ’946 patent and the ’352 patent are the subject of *inter partes* reviews in Cases IPR2015-00226, and in IPR2015-00219 and IPR2015-00228, respectively, based on petitions filed by CoreLogic. In Case IPR2015-00225, we did not institute an *inter partes* review because the information presented in the petition did not establish a reasonable likelihood that CoreLogic would prevail. *CoreLogic, Inc. v. Boundary Solutions, Inc.*, Case IPR2015-00225 (PTAB May 21,

2015) (Paper 7). We recently issued final decisions in Cases IPR2015-00219, IPR2015-00222, and IPR2015-00228.

B. The '957 Patent

The '957 patent relates generally to Geographic Information Systems (“GIS”) and, in particular, to a National Online Parcel-Level Map Data Portal (“NPDP”) that provides online delivery of parcel-level map data. Ex. 1001, Abstract, 1:17–26. The '957 patent describes the NPDP as an electronic repository for parcel-level maps and linked attribute data acquired from public and private entities. *Id.* at 2:32–44. Databases from different jurisdictions are assembled and stored in a standard format, with each jurisdictional database placed in an individual directory. *Id.* at 4:3–5, 7:21–30. The system normalizes information to a single universal spatial protocol. *Id.* at 3:16–19, 7:33–54. Parcel-level information includes parcel boundaries and geocodes linked using a parcel identifier to a non-graphic database containing property tax records. *Id.* at 1:49–53, 4:1–11, 8:13–24.

The '957 patent describes retrieving a parcel-level map based on the address of a parcel requested by an end user. *Id.* at 1:54–57, 4:47–51. The system searches a jurisdictional lookup table to identify the jurisdiction in which the requested parcel is located. *Id.* at 8:25–30. The system searches the non-graphic database for that jurisdiction for a record matching the address, and uses the parcel identifier for that record to access a graphic database containing the selected parcel. *Id.* at 3:41–58. The system can display the selected parcel and surrounding parcels, with the selected parcel

shown as a highlighted polygon. *Id.* at 4:56–58. The system can also display the parcel’s linked data (e.g., tax record). *Id.* at 4:58–59.

The ’957 patent describes a business revenue model that “begins with the establishment by the NPDP service provider of a publicized parcel-level map data web site with links to a tax record database.” *Id.* at 13:20–23. For example, the model contemplates generating revenue through various subscription agreements. *Id.* at 13:65–15:43. The ’957 patent also describes providing access to the database for free. *See id.* at 2:58, 14:11–15, 14:41–45, 16:8–12.

C. Illustrative Claim

Claims 1–19 are the subject of the Petition, and claims 13 and 16–18 have since been disclaimed by Patent Owner. Claim 1 is independent. Claim 1 is reproduced as follows.

1. An interactive computer implemented method for retrieving geographic parcel boundary polygon maps and associated parcel attribute data linked to a non-graphic database, wherein the data is acquired electronically, comprising:
 - a. activating a computer terminal connected to a computer network;
 - b. accessing an applications program for access to the data;
 - c. accessing a data entry screen and entering a parcel attribute to call up the parcel selected;
 - d. subsequently accessing a national parcel map database comprising multiple jurisdictional databases which have been normalized to a common data protocol;
 - e. searching a jurisdiction look up table associated with the national parcel map database, said look up table indexed for identification of the pertinent jurisdictional database, whereby a numerical jurisdictional identifier for the selected jurisdiction is

located, and the identified jurisdictional database thereafter accessed; and,

f. thereafter displaying on screen a parcel boundary polygon map, along with surrounding parcel boundary polygons, the default scale of the displayed map selected to fill the computer display screen with parcel boundaries within a selected distance around the subject parcel, the selected parcel boundary polygon highlighted, defining both the location and boundary of the parcel, and associated attribute data for the highlighted parcel displayed..

Ex. 1001, 16:14–42.

D. Asserted Grounds of Unpatentability

CoreLogic asserts that claims 1–19 of the '957 patent are unpatentable under 35 U.S.C. § 101. Pet. 33–59.

III. DISCUSSION

A threshold question is whether the '957 patent is a “covered business method patent,” as defined by the AIA. CoreLogic bears the burden of persuasion that the '957 patent is a covered business method patent. *See* 37 C.F.R. § 42.304(a). For the reasons discussed below, we determine CoreLogic has made an insufficient showing that the '957 patent is a “covered business method patent.”

The AIA defines “covered business method patent” as “a patent that claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions.” AIA § 18(d)(1); *see also* 37 C.F.R. § 42.301(a). The legislative history of the AIA “explains that the definition of covered business method patent was drafted to encompass patents ‘claiming activities that are financial in nature, incidental to a financial activity or

complementary to a financial activity.” Transitional Program for Covered Business Method Patents—Definitions of Covered Business Method Patent and Technological Invention; Final Rule, 77 Fed. Reg. 48,374, 48,735 (Aug. 14, 2012) (“CBM Final Rules”) (quoting 157 Cong. Rec. S5432 (daily ed. Sept. 8, 2011)); *see also Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d 1331, 1338 (Fed. Cir. 2016). To determine whether a patent is eligible for a covered business method patent review, the focus is on the claims. AIA § 18(d)(1) (“a patent that *claims* . . .” (emphasis added)); 37 C.F.R. § 42.301(a) (same); CBM Final Rules, 77 Fed. Reg. at 48,736 (comment 4) (“[T]he definition set forth in § 42.301(a) . . . is based on what the patent claims.”). A patent need have only one claim directed to a covered business method to be eligible for review. CBM Final Rules, 77 Fed. Reg. at 48,736 (comment 8) (“A patent having one or more claims directed to a covered business method is a covered business method patent for purposes of the review, even if the patent includes additional claims.”).

CoreLogic contends that the ’957 patent is a covered business method patent because “[a]t least claim 1 of the ’957 patent claims data processing or other operations that are financial in nature or, at a minimum, incidental or complementary to a financial activity.” Pet. 7. CoreLogic also relies on dependent claims 13 and 16–18, and argues that those claims “explicitly limit the claims to financial applications.” *Id.* at 9; *see also id.* at 11 (alleging that claims 16–18 cover “subject matter incidental or complementary to a financial activity”). As noted above, however, BSI disclaimed claims 13 and 16–18 at the same time it filed its Preliminary Response. *See* Ex. 2003. “A statutory disclaimer under 35 U.S.C. § 253 has the effect of canceling the claims from the patent and the patent is viewed as

though the disclaimed claims had never existed in the patent.” *Guinn v. Kopf*, 96 F.3d 1419, 1422 (Fed. Cir. 1996). We agree with other panels that have considered this issue under similar facts and concluded that the disclaimed claims should not be consulted when determining whether the patent is a covered business method patent under AIA §18(d)(1).¹

We are mindful that other Board decisions have evaluated compliance with CBM standing requirements at the time of filing, but those cases are distinguishable² and not binding here. Any suggestion in those cases that a decision on institution should address the disclaimed claims because they existed at the time the petition was filed is inconsistent with Federal Circuit precedent instructing us to treat the claims as if they never existed, and our Rules forbidding institution “based on disclaimed claims.” *Guinn*, 96 F.3d at 1422; 37 CFR § 42.207(e) (“No post-grant review will be instituted based on disclaimed claims.”); *see also Google Inc. v. SimpleAir, Inc.*, CBM2015-00019, slip op. at 5–6 (PTAB Aug. 19, 2015) (Paper 15) (Order Denying Request for Rehearing) (rejecting petitioner’s argument that disclaimed claim should be considered because it existed at the time the petition was

¹ *See, e.g., AT&T Mobility LLC v. Intellectual Ventures II LLC*, CBM2015-00185, slip op. at 9–10 (PTAB May 4, 2016) (Paper 10); *Great West Casualty Co. v. Intellectual Ventures II LLC*, CBM2015-00171, slip op. at 7–9 (PTAB Feb. 9, 2016) (Paper 10); *Google Inc. v. SimpleAir, Inc.*, CBM2015-00019, slip op. at 14–15 (PTAB May 19, 2014) (Paper 11).

² In *Travelers Lloyds of Texas Ins. Co. v. Integrated Claims Sys., LLC*, CBM2014-00187, slip op. at 7, 8 n.1 (PTAB Mar. 30, 2016) (Paper 31), the Patent Owner attempted to *cancel* a claim *after* institution, not disclaim a claim prior to institution. In *J.P. Morgan Chase & Co. v. Intellectual Ventures II LLC*, CBM2014-00157, slip op. at 9 (PTAB Jan. 12, 2016) (Paper 40), the Patent Owner’s disclaimer occurred *after* institution, not prior to institution.

filed). We therefore do not consider disclaimed claims 13 and 16–18 in our analysis.

CoreLogic advances two arguments in support of this contention. First, CoreLogic argues that the Specification “confirms that this claim is directed to processing data as part of a financial process” because the Specification describes a “financial process in which subscribers pay to gain access to parcel boundary data using the claimed method.” *Id.* at 9. According to CoreLogic, the ’957 patent “is explicit that the purpose of the claimed method is to provide data in exchange for money.” *Id.* at 10. CoreLogic states that claim 1 “is directed to searching a set of parcel maps for a selected property and the properties that surround it using polygons,” and asserts that the Specification provides examples where the map data can be used in “state, federal and local environmental assessments and compliance.” *Id.* at 10 (quoting Ex. 1001, 6:14–42). CoreLogic further relies on the Specification’s discussion of different ways to use the map data to generate revenue, and argues that these revenue models underscore the financial activities covered by the claimed methods. *Id.* at 11–13.

Second, CoreLogic contends that the Specification describes using the maps retrieved in the claimed method “for business purposes and financial activities.” Pet. 13–16. According to CoreLogic, “[d]etermining real estate parcel boundaries is a fundamental business practice used by various companies,” including “title companies, insurance providers, and land developers.” *Id.* at 13–14. CoreLogic contends that selling subscriptions to these businesses in exchange for access to parcel data “is akin to allowing

customers to order products,” activities that the Board has described as financial activity. *Id.* at 15.

BSI contends that the '957 patent is not a CBM patent because it does not claim a financial product or service. Prelim. Resp. 8. BSI argues that the CBM analysis must remain focused on the claims, and that without any financial term in the claims, the Specification can demonstrate that the claim is financial in nature only in limited circumstances not at issue here. *Id.* at 11–12. According to BSI, the fact that the Specification discloses that the claimed “invention can be used in connection with a financial product does not mean that it is a CBM Patent.” *Id.* at 13.

BSI distinguishes cases relied on by CoreLogic, pointing out that unlike those cases, “no claim of the '957 patent that relates to the marketing or sale of any product.” *Id.* at 18. BSI relies on several cases concluding that the “financial prong” was not met in allegedly similar circumstances, including *Qualtrics, LLC v. OpinionLab, Inc.*, CBM2015-00164 (Feb. 3, 2016) (Paper 8). Prelim. Resp. at 21–23. According to BSI, *Qualtrics* properly focused on the claim language rather than “exemplary” embodiments in the Specification, and rejected arguments similar to CoreLogic’s arguments here. *Id.* at 21–22. BSI portrays CoreLogic’s repeated references to the Specification as insufficient because of the “missing nexus” to language in the claims. *Id.* at 26. BSI counters CoreLogic’s assertion that the “purpose of the claimed method is to provide data in exchange for money” by pointing out that the Specification

“discusses using the claimed process in transactions for pay and for free.”
Id. at 28.

We agree with BSI. CoreLogic does not explain adequately how any of the claims of the '957 patent recite a method or apparatus “for performing data processing or other operations used in the practice, administration, or management of a financial product or service.” AIA § 18(d)(1); *see also* 37 C.F.R. § 42.301(a). CoreLogic focuses on claim 1, but fails to identify any limitation in claim 1 or any other claim that relates to a financial activity in any way. Claim 1 claims a “method for retrieving geographic parcel boundary polygon maps and associated parcel attribute data,” which has applicability to retrieving and displaying map data, not financial products and services. CoreLogic suggests that the “transmitting” step of claim 1 “can be used” by various entities in a business context, but does not argue, let alone establish, that the claim terms on their face are financial in nature. *See* Pet. 1.

CoreLogic asserts that the Specification of the '957 patent describes several methods of generating revenue using the claimed methods, and that numerous businesses may pay for access to map data generated using the claimed method. Pet. 10–16. CoreLogic’s reliance on these portions of the Specification is unavailing. First, CoreLogic fails to address how these disclosures relate directly to, or meaningfully informs our analysis of, the language of the claims. For example, CoreLogic does not direct us to any claims or claim limitations that require users to pay for access to the map database or use of the claimed methods. Second, CoreLogic fails to address portions of the Specification that indicate the claimed invention can be used “for free,” i.e., without any generation of revenue or financial aspect at all.

See Ex. 1001, 2:58 (“These end users may access for free”), 14:11–15 (“Another public-private alliance option is to offer the free use of the NPDP server to such data sponsors in addition to or in lieu of their revenue share.”), 14:41–45 (“[C]ommodity service subscriber end users (customers) can have access to the NPDP at no charge.”), 16:8–12 (“It is also contemplated that other independent public and private data sponsors could be provided with links as part of the NPDP display which end users could access on a free or fee basis.”). Given that the Specification contemplates use of the claimed inventions for free, it is not apparent that the “purpose of the claimed method is to provide data in exchange for money,” as CoreLogic suggests. Pet. 10.

At most, CoreLogic has established that the claimed methods could be used to generate revenue in a number of ways, even though the language of the claims does not require any exchange of money or other financially related step. Under these circumstances, we conclude that the “financial prong” has not been met. Numerous Board decisions have taken a similar approach in situations where the Specification refers to potential financial applications for the claimed inventions but the claim language does not expressly indicate a financial context.³ In *Qualtrics, LLC v. OpinionLab*,

³ *See, e.g., ServiceNow, Inc. v. Hewlett-Packard, Co.*, Case CBM2015–00108, slip op. at 15–16 (PTAB Oct. 8, 2015) (Paper 10) (reasoning that, although “at least one illustrative embodiment [was] directed to applications of the claimed system in financial systems,” the patent’s claims “are of general utility”); *Google Inc. v. SimpleAir, Inc.*, CBM2015-00019, slip op. at 11–12 (PTAB May 19, 2015) (Paper 11) (finding petitioner’s citation to allegedly financial aspects of the invention in the Specification insufficient because petitioner failed to explain any relationship between cited portions of Specification and claim language); *Salesforce.com, Inc. v. Applications in*

Inc., CBM2015-00164 (Feb. 3, 2016) (Paper 8), for example, the claims were “devoid of any terms that reasonably could be argued as having any particular relation to a financial product or service,” but the Specification discussed using a claimed survey “for marketing and valuation of a website.” *Id.* at 5–6. The Board found that the examples in the Specification were merely exemplary, and that the Specification also spoke in broader terms. *Id.* at 6–7. The Board also rejected the Petitioner’s argument that the “specification’s disclosure of charging a fee . . . moves the claimed invention into the realm of a financial product or service”:

First and foremost, the claims say nothing about charging a fee for the survey report—they merely require “software . . . for reporting to the website owner.” There is no mention of a fee. Moreover, the specification makes clear that “[i]n a preferred embodiment,” the software is configured to provide the report “for free.”

Id. at 7. Similarly here, the ’957 patent Specification mentions charging fees and generating revenue, but the claims never mention, much less require,

Internet Time LLC, CBM2014-00162, slip op. at 9–10 (PTAB Feb. 2, 2015) (Paper 11) (“Petitioner’s contentions based on the written description alone do not show that the ’111 patent *claims* a method or apparatus ‘for performing data processing or other operations used in the practice, administration, or management of a financial product or service’ or *claims* an activity that is ‘financial in nature, incidental to a financial activity or complementary to a financial activity.’”); *Par Pharm. Inc. et al. v. Jazz Pharm., Inc.*, CBM2014-00149, slip op. at 10–13 (PTAB Jan. 13, 2015) (Paper 12) (finding that references in the Specification to insurance coverage and a patient’s ability to pay for a prescription did not render claim relating to a method for controlling access to a prescription drug a financial product or service); *PNC Fin. Servs. Group, Inc. v. Intellectual Ventures I LLC*, CBM2014-00032, slip op. at 11–16 (PTAB May 22, 2014) (Paper 13) (concluding that any financial aspect described in the Specification amounts to a non-limiting example).

any of these steps, and the Specification repeatedly states that the claimed method could be used without charging any fee. *See* Ex. 1001, 2:58, 14:11–15, 14:41–45, 16:8–12.

We are mindful of the instruction that “‘financial product or service’ should be interpreted broadly.” 77 Fed. Reg. 48,374, 48,735 (Aug. 14, 2012). “Broadly,” however, does not mean we must interpret “financial product or service” to encompass any claimed invention that might be used to generate revenue when the Specification describes the methods of generating revenue. If the mere ability to make money selling a claimed invention, or providing access to a claimed method, were sufficient, the “financial product or service” requirement would be rendered nugatory. We decline to read the statute so broadly. Moreover, in cases finding the “financial product or service” requirement met, the language of the claims at issue typically refers to the financial aspect of the invention. *See Versata Dev. Grp., Inc. v. SAP Am., Inc.*, 793 F.3d 1306, 1312 (Fed. Cir. 2015) (claiming “method for determining a price”); *SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1315–16 (Fed. Cir. 2015) (claiming, in part, “providing a credit card number of the second party . . . so the second party is charged money”); *Blue Calypso, LLC v. Groupon, Inc.*, 815 F.3d at 1340 (finding that the claims “have an express financial component in the form of a subsidy, or financial inducement”).

We are aware of prior Board decisions finding the “financial products or services” requirement met even in the face of claim language that does not expressly mention financial activity, based on analysis of the

Specification.⁴ These cases turn on their particular facts as well as the claim language and Specifications at issue, and are not binding on us here. *See Blue Calypso*, 815 F.3d at 1340 (rejecting argument that “the Board has acted in an arbitrary and capricious manner through an ‘unpredictable application’ of the CBM definition” and noting that each case focuses on the claim language at issue). We do not interpret these cases as requiring a finding that the “financial product or service” requirement is met whenever a Specification refers to a financial use for a claimed invention.

We conclude that neither the claim language nor the Specification supports CoreLogic’s contention that the ’957 patent “claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service” or claims “activities that are financial in nature, incidental to a financial activity or complementary to a financial activity.”

IV. CONCLUSION

For the foregoing reasons, based on the present record and particular facts of this case, we determine that the information presented in the Petition does not establish that the ’957 patent qualifies as a covered business method patent under § 18 of the AIA.

⁴ *See, e.g., Motorola Mobility LLC v. Intellectual Ventures I LLC*, CBM2015-00004, slip op. at 20–25 (PTAB March 21, 2016) (Paper 33) (noting that the Specification expressly refers to “financial planning and portfolio management” and filing tax returns); *Epicor Software Corp. v. Protegrity Corp.*, CBM2015-00006, slip op. at 19–21 (PTAB April 18, 2016) (Paper 54) (noting that the Specification expressly refers to the field of banking, which is a financial activity).

Case CBM2016-00016
Patent 7,092,957 B2

ORDER

Accordingly, it is

ORDERED that a covered business patent method review is not instituted for claims 1–19 of the '957 patent.

FOR PETITIONER:

Erika H. Arner
Justin E. Loffredo
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
justin.loffredo@finnegan.com
erika.arnier@finnegan.com

FOR PATENT OWNER:

Lawrence Edelman
THE LAW OFFICE OF LAWRENCE EDELMAN
lawrence.edelman@comcast.net

Bruce J. Wecker
HAUSFELD LLP
bwecker@hausfeld.com