Trials@uspto.gov
571-272-7822

Paper 9
Entered: March 3, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAPLEBEAR INC. D/B/A INSTACART
Petitioner,

v.

CONSUMERON, LLC,
Patent Owner.

IPR2022-01359
Patent 9,202,191 B2

Before CARL M. DEFRANCO JR., ROBERT L. KINDER, and MICHAEL A. VALEK, *Administrative Patent Judges*.

VALEK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Maplebear Inc. ("Petitioner") filed a Petition (Paper 1, "Pet."), seeking *inter partes* review of claims 1, 3, 4, and 6–15 of U.S. Patent No. 9,202,191 B2 (Ex. 1001, "the '191 patent"). Consumeron, LLC ("Patent Owner") filed a Preliminary Response. Paper 6 ("Prelim. Resp."). Considering the arguments and evidence of record, we determine that the Petition demonstrates "a reasonable likelihood that [P]etitioner would prevail with respect to at least 1 of the claims challenged in the petition." 35 U.S.C. § 314(a). Accordingly, we institute an *inter partes* review.

II. BACKGROUND

A. Real Parties in Interest

The parties identify themselves as the only real parties-in-interest. Pet. 77; Paper 3, 1.

B. Related Matters

The parties identify *Consumeron, LLC v. Maplebear Inc. d/b/a Instacart*, No. 1:21-cv-01147 (D. Del.), referred to herein as "the Delaware litigation," as a related matter involving the '191 patent. Pet. 76; Paper 3, 1.

Although not identified in the parties' notices, the following proceedings involve the same parties and challenge patents related to the '191 patent: IPR2022-01356, IPR2022-01357, and IPR2022-01358.

C. The '067 Patent

The '191 patent issued on December 1, 2015, and claims priority to a series of applications the earliest of which was filed on August 26, 2009. Ex. 1001, codes (45), (60).

The '191 patent describes "[a] system and method for remote acquisition and delivery of goods" that includes a server in communication

with customer computers or devices and a mobile delivery system also referred to as a mobile delivery agent system ("MDAS"). Ex. 1001, Abstr., 1:66–2:8. Figure 1 of the '191 patent, reproduced below, "is a schematic diagram of the remote acquisition and delivery system of the present invention." *Id.* at 2:44–45.

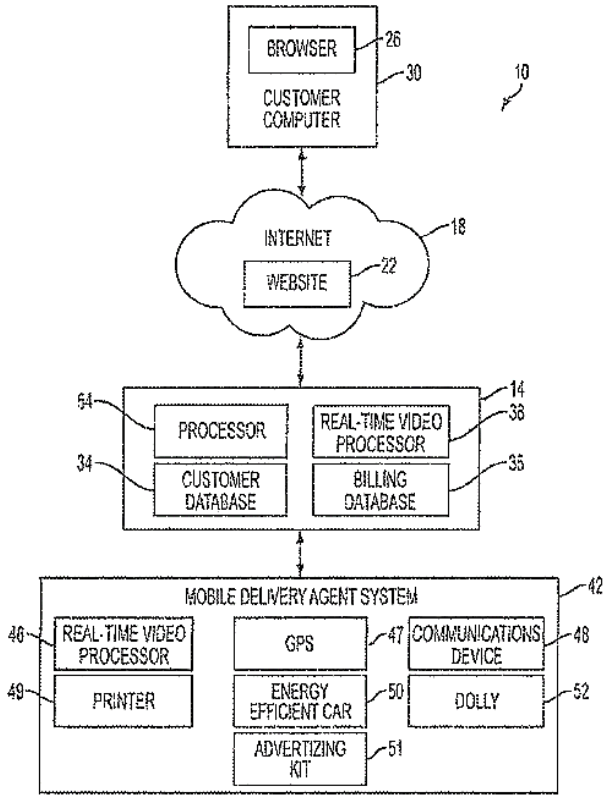

FIG. 1

Figure 1 depicts a customer computer 30 accessing a service provider's server 14 over the internet. *Id.* at 2:56–60. Server 14 communicates with plurality of mobile delivery agent systems such as MDAS 42 in Figure 1. *Id.* at 3:12–17. MDAS 42 includes a real-time video processor 46, global positioning system (GPS) 47, and a communications device 48. *Id.*

The Specification explains that a customer may contact the service provider through the system depicted in Figure 1 and receive information

regarding delivery agents in the vicinity of a store where they would like to purchase a product. Ex. 1001, 4:24–37. After the delivery agent is selected, "a customer shopping or acquisition request and profile is sent to the delivery agent . . . and a communications link is established between the customer and the selected delivery agent . . . such as through a telephone or internet connection" using communications device 48 in MDAS 42. *Id.* at 5:20–25. The delivery agent then travels to the store, finds the desired product, and "the customer has the option of inspecting the product in real-time." *Id.* at 6:34–56. "If the customer chooses to inspect the product, the customer will communicate instructions to the delivery agent . . . and the delivery agent will utilize real-time video device 46 to transmit real-time data to customer computer 30." *Id.* at 6:56–59. The customer then "approves or rejects acquisition of the inspected product." *Id.* at 6:66–67. If the product is approved, the delivery agent acquires the product for the customer and delivers the product based on the customer's delivery instructions. *Id.* at 7:8–15.

> According to the Specification,
>
> > Real-time video device 46 is preferably utilized throughout the transaction to show the location of the delivery agent as the agent is driving to a desired purchase location, to show the product at the purchase location, and to verify delivery of the product to the customer at the designated delivery location. Preferably, video footage is stored on server 14 and can be accessed for delivery agent evaluation, for liability and public safety purposes, for delivery agent history or dispute resolution purposes, for example.

Ex. 1001, 8:5–13.

D. Challenged Claims

The Petition challenges claims 1, 3, 4, and 6–15. Claim 1 is illustrative and reproduced below with the same bracketed annotations the Petition includes to identify particular limitations.

> 1. [1.0] A system for remote acquisition and delivery of one or more goods based on an acquisition request from a customer through an interactive interface for processing the acquisition request comprising:
>
> [1.1] a customer computer having a user interface;
>
> [1.2] at least one server in communication with a wide area network;
>
> [1.3.a] a plurality of mobile delivery agent systems in communication with the at least one server,[1.3.b] each of the plurality of delivery agent systems being configured for use with a respective purchasing and delivery agent for a shopping event and including:
>
> [1.4.a] a real-time video device configured to send one or more images in real-time to the customer from the respective agent,[1.4.b] wherein the real-time video device is configured to enable the customer to be provided with progress information via real-time imaging of the one or more images from the respective agent through the customer computer during performance of the acquisition request, including viewing the one or more goods from a pick-up site for the one or more goods;
>
> [1.5] a communications device configured to establish direct communication between the customer and the respective agent to enable the customer to provide a communicated approval for the agent to immediately purchase the one or more goods viewed by the customer in connection with completing the acquisition request:
>
> [1.6] a global positioning system configured to provide location data to the at least one server; and
>
> [1.7.a] a selectable widget for a website configured to retrieve data submitted by at least one of the mobile delivery agent systems to the at least one server[1.7.b] and generate a view of the one or more goods at the pick-up site associated

> with a third party vendor together with at least the data submitted to the at least one server by the mobile delivery agent system.

Ex. 1001, 9:44–10:13.

Independent claims 11 and 14 are directed to a system with elements similar to those in claim 1, but with some elements recited in means-plus-function form. Claim 14 is reproduced below with the same bracketed annotations used in the Petition.

> 14. [14.0] A system for remote acquisition and delivery of one or more goods based on an acquisition request from a customer through an interactive interface for processing the acquisition request comprising:
>
> [14.1] a customer computer having a user interface and configured to establish a local communication link between the customer and a mobile agent for purposes of the acquisition request;
>
> [14.2] a mobile agent system configured for use by the mobile agent for a shopping event established based on the acquisition request, said mobile agent system including:
>
> [14.3.a] means for sending one or more images in real-time to the customer from the mobile agent though the local communication link and providing the customer with progress information via real-time imaging of the one or more images from the mobile agent to the customer computer during performance of the acquisition request,[14.3.b] including viewing the one or more goods from a pick-up site for the one or more goods during the shopping event;
>
> [14.4] communication means, establishing direct communication between the customer and the mobile agent, for communicating approval by the customer to the mobile agent in connection with completing the acquisition request;
>
> [14.5] a global positioning system configured to provide location data though the local communication link; and
>
> [14.6.a] a selectable widget for a vendor website configured to retrieve data submitted by at least one of the mobile delivery agent systems through the local communication

> link[14.6.b] and generate a view of the one or more goods at the pick-up site associated with a third party vendor together with at least the data submitted through the local communication link by the mobile delivery agent system.

Ex. 1001, 11:27–12:25.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Claim(s) Challenged	35 U.S.C. §[1]	Reference(s)/Basis
1, 3, 4, 6–10, 14, 15	103(a)	Park,[2] Kim,[3] Williams[4]
11–13	103(a)	Park, Kim, Williams, Hileman[5]

Petitioner further relies on the declaration of Dr. Henry Houh (Ex. 1003).

Before turning to our analysis of these grounds, we address Patent Owner's arguments that, notwithstanding the merits of Petitioner's grounds, we should exercise discretion to deny institution under 35 U.S.C. §§ 314(a) and 325(d).

III. DISCRETION UNDER 35 U.S.C. § 314(a)

Patent Owner argues the Board should exercise discretion to deny institution under *Fintiv*[6] "due to the advanced state of the parallel District

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[1] The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) ("AIA"), included revisions to 35 U.S.C. § 103 that became effective after the filing of the applications to which the '191 patent claims priority. Therefore, we apply the pre-AIA version of the statute.
[2] WO 01/11523 A1, published Feb. 15, 2001 (Ex. 1005) ("Park").
[3] KR2003-0085802, published Nov. 7, 2003 (Ex. 1007). The Petition relies on a certified translation of this Korean language reference (Ex. 1006), which we refer to herein as "Kim."
[4] WO 2008/052013 A2, published May 2, 2008 (Ex. 1008) ("Williams").
[5] US 2003/0040944 A1, published Feb. 27, 2003 (Ex. 1009) ("Hileman").
[6] *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (Mar. 20, 2020) (precedential) ("*Fintiv*").

Court proceeding." *See* Prelim. Resp. 4–15. Petitioner contends that the *Fintiv* factors do not favor discretionary denial here. *See* Pet. 71–74. After considering the parties' arguments and the circumstances of this case, we decline to exercise discretion to deny institution under 35 U.S.C. § 314(a). In particular, Petitioner has stipulated that if *inter partes* review is instituted it will not pursue the invalidity grounds raised in the Petition or any other ground that reasonably could have been raised in the Delaware litigation. Ex. 1033, 1. The Director has provided guidance stating that, when such a stipulation is presented, the PTAB will not discretionarily deny institution in view of the parallel litigation. *See* Ex. 1013, 3, 7.[7] That guidance applies here.

IV. DISCRETION UNDER 35 U.S.C. § 325(d)

Patent Owner argues the Board should exercise discretion to deny institution under 35 U.S.C. § 325(d) because "Park and Kim are substantially the same as U.S. Patent No. 7,505,929 and continuation U.S. Patent Publ. No. 2009/0099972 ('the '972 publication') to Angert considered by the Examiner during prosecution."[8] Prelim. Resp. 60. Patent Owner further asserts that "Petitioner has not demonstrated any error in the Examiner's consideration of that cumulative art." *Id.* at 61.

[7] Interim Procedure for Discretionary Denials in AIA Post-grant Proceedings with Parallel District Court Litigation (USPTO June 21, 2022) 3, available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.
[8] Patent Owner refers to these references collectively as "Angert," citing the '972 publication (Ex. 2013) for its assertions regarding their disclosure. *See* Prelim. Resp. 60–61.

A. Legal Standard

Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on prior art or arguments previously presented to the Office. The statute states, in pertinent part, "[i]n determining whether to institute . . . , the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office." 35 U.S.C. § 325(d).

The question of whether the petition presents art or arguments that are "the same or substantially the same" as art or arguments previously presented to the Office is a factual inquiry, which may be resolved by reference to the factors set forth in *Becton, Dickinson*.[9] The precedential section of that decision sets forth the following non-exclusive factors ("*BD* Factors") for consideration:

> (a) the similarities and material differences between the asserted art and the prior art involved during examination;
>
> (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
>
> (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
>
> (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
>
> (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and

[9] *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR 2017-01586, Paper 8 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) ("*Becton, Dickinson*").

> (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson, 17–18.

Advanced Bionics[10] sets out a two-part framework for analyzing these factors. In the first part, we consider factors (a), (b), and (d) to determine whether the art and arguments presented in the petition are the same or substantially the same as those previously presented to the Office. *Advanced Bionics*, 8–10. "If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office," then we move on to the second part of the analysis to determine "whether the petitioner has demonstrated a material error by the Office" in view of factors (c), (e), and (f). *Id.*

B. Advanced Bionics Part One

It is undisputed that the references in the two asserted grounds were not previously considered by the Office. Pet. 74; *see* Prelim. Resp. 59–61 (urging only that Park and Kim are cumulative of Angert). Nevertheless, Patent Owner asserts that Park and Kim are substantially the same as Angert because

> paragraph 54 of Angert discloses "[d]elivery vehicle 50 may also include a camera 509 to provide video or still images of the locale around the vehicle 50 to server 20, which can relay the images to clients." Like both Park and Kim, Angert's images are only captured after the product was already purchased, and they are transmitted to a server for later download. Further, like

[10] *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) ("*Advanced Bionics*").

> Park, Angert only discloses providing images of the environment during delivery.

Prelim. Resp. 60–61 (citing Ex. 2013 ¶¶ 34, 46, 54).

Patent Owner's argument is not persuasive. Even assuming the Examiner considered the particular disclosures Patent Owner cites in Angert, Petitioner has sufficiently shown that Park and Kim provide additional teachings that are material to the challenged claims. For example, the Petition relies on Park's teaching that the delivery agent has a mobile digital camera that provides the customer with a "live video feed of the delivery of their order" that they can "interactively view, in real-time." *See, e.g.*, Pet. 18, 34–35 (quoting Ex. 1005, 4:27–32, 48:18–20). Moreover, the Petition relies on Kim's teaching that in addition to providing images of the delivery, a delivery agent can utilize a digital camera in mobile communication terminal to send images of the product to the customer so they "can confirm whether the product ordered is identical to the product being delivered." *Id*. at 19 (citing Ex. 1006, 1–2). As explained in our analysis of Ground 1 below, such teachings are material to Petitioner's patentability challenges. We see no corollary to these teachings in Angert nor does Patent Owner otherwise identify any similar teachings or arguments the Examiner previously considered. *See generally* Prelim. Resp. 44–46.

For these reasons, the Petition does not present the same or substantially the same art or arguments as that previously presented to the Office. Because the first part of the *Advanced Bionics* framework has not been met, we decline to exercise discretion to deny institution under 35 U.S.C. § 325(d).

V. ANALYSIS OF THE ASSERTED GROUNDS

A. Legal Standards

A claim is unpatentable for obviousness if, to one of ordinary skill in the pertinent art, "the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains." 35 U.S.C. § 103; *see also KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of ordinary skill in the art; and (4) when in evidence, objective evidence of nonobviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

> Petitioner contends a person of ordinary skill in the art ("POSITA") in August 2009 (the earliest alleged priority date) would have been someone knowledgeable and familiar with the electronic commerce arts that are pertinent to the '191 patent. That person would have a bachelor's degree in electrical engineering, computer engineering, computer science, or equivalent training, and approximately two years of experience working in the field of electronic commerce. Lack of work experience can be remedied by additional education, and vice versa.

Pet. 13 (citing Ex. 1003 ¶ 24). Patent Owner offers a similar description of a POSITA. Prelim. Resp. 19.

At this stage, we find Petitioner's description of the level of ordinary skill in the art to be sufficiently supported by the record and apply it for

purposes of this Decision. Moreover, we do not perceive any meaningful difference between the parties' respective descriptions of the level of ordinary skill in the art.

C. Claim Construction

In an *inter partes* review, claim terms "shall be construed using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent." 37 C.F.R. § 42.100(b).

i. "mobile delivery agent system" and "mobile agent system"[11]

The parties agree that "mobile delivery agent system" is a "coined term" with no established ordinary meaning in the art. *See* Pet. 14; Prelim. Resp. 20. Petitioner notes that in the Delaware litigation, Patent Owner proposed the following construction for these terms:

> one or more mobile computing devices having image capturing and communications capability which can (1) receive product data over the Internet from a remote server, where the product data corresponds to a customer request, and (2) provide to the customer an image of a product in real-time as well as acquisition and delivery information of the product.

Pet. 14 (quoting Ex. 1027, 2). The Petition "applies Patent Owner's district court construction," but also notes that the "unpatentability dispute in this

[11] Claim 14 refers to a "mobile agent system" in element 14.2 and a "mobile delivery agent system" in element 14.6. The parties appear to agree that these refer to the same thing and that the construction should be the same for both terms. *See* Pet. 14; Prelim. Resp. 20 (proposing same construction for "mobile delivery agent system" and "mobile agent system").

proceeding can be resolved without an explicit construction" because the prior art teaches the recited components, i.e., a real-time video device, means for sending one or more images in real-time, a communications device or means, and a global positioning system. *Id.* at 15. Patent Owner likewise contends that we should apply the construction it proposed in the Delaware litigation.[12] Prelim. Resp. 20.

After the Petition and Preliminary Response were filed, the Delaware court issued a claim construction order and opinion, adopting a construction of "mobile delivery agent system" and "mobile agent system" different from that argued by either party. *See* Ex. 1034; Ex. 1035 (claim construction order and opinion). The Delaware court's construction of these terms is "a mobile system that includes at least a device to capture video or still images and a device set up to communicate with a remote server." Ex. 1034, 1. The Delaware court arrived at this construction after a thorough analysis of the intrinsic record, which led it to reject some aspects from both parties' proposed constructions. *See* Ex. 1035, 13–17.

At this stage, we agree with and apply the same construction of "mobile delivery agent system" and "mobile agent system" as the Delaware

[12] Patent Owner asserts the Petition should be denied because Petitioner applies Patent Owner's proposed construction, rather than the construction Petitioner proposed in the Delaware litigation. Prelim. Resp. 19–20. We do not agree that the Petition should be denied for this reason. *See, e.g.*, *Allen Medical Sys., Inc. v. Mizuho Orthopedic Sys., Inc.*, IPR2022-00919, Paper 12, 15–18 (Nov. 2, 2022); *10X Genomics, Inc. v. Bio-Rad Labs., Inc.*, IPR2020-00087, Paper 9, 16–17 (April 27, 2020); *Western Digital v. Spex Techs.*, IPR2018-0084, Paper 14, 11 (April 25, 2018) (allowing Petitioner to apply Patent Owner's proposed construction from a related proceeding even though it differed from Petitioner's own proposal).

court, i.e., "a mobile system that includes at least a device to capture video or still images and a device set up to communicate with a remote server."[13] To the extent either party believes this construction is incorrect and should not apply in this proceeding, they may brief the issue in their subsequent papers at trial. In doing so, we encourage the parties to identify the particular aspect(s) of the construction they disagree with, explain why and how it matters to the grounds presented in the Petition, and provide argument with citations to any evidence of record supporting their claim construction. Moreover, while Petitioner may address this construction to the extent it differs from that applied in the Petition, this is not an invitation for Petitioner to propose an entirely new construction for these terms.

ii. "real-time"

The Delaware court held that "real-time" has its ordinary meaning, which is "data that is passed along as it is gathered." Ex. 1034, 2. That construction is consistent with the usage of the term in the Specification and the parties' proposals in this proceeding. Prelim. Resp. 22–23 (same construction); *see* Pet. 13 (asserting that "the terms of the Challenged Claims

[13] While we apply a different construction than that applied in the Petition and urged by Patent Owner, it does not affect the outcome of this decision. As explained below, we would also find that Petitioner has met the burden for institution under Patent Owner's proposed MDAS construction.

should be given their ordinary and customary meaning"). Accordingly, we apply the same construction of "real-time" in this decision. [14]

iii. means-plus-function terms

The parties identify four terms, two in claim 11 and two in claim 14, that they agree should be construed as means-plus-function terms according to 35 U.S.C. § 112 ¶ 6. *See* Pet. 15–18; Prelim. Resp. 23–30.

The Delaware court construed these four terms as follows:

Claim Term	Delaware court's construction
"communication means for *processing the acquisition request from the customer and establishing direct communication between the customer and the selected delivery agent during both the acquisition and delivery of the one or more goods to the customer*" (claim 11)	**Function**: emphasized text **Structure**: server 14, communications device 48, and a customer device capable of establishing communication with the delivery agent
"communication means*, establishing direct communication between the customer and the mobile agent, for communicating approval by the customer to the mobile agent in connection with completing the acquisition request*" (claim 14)	**Function**: emphasized text **Structure**: real-time video device 46, communications device 48, and customer computer 30
"real-time video means for *sending at least one image to the customer through the communication means and transmitting real-time data to the display for the customer to view the one or more goods and the respective agent's progress during performance of the acquisition request*" (claim 11)	**Function**: emphasized text **Structure**: server 14, real-time video device 46, communications device 48, and customer computer 30

[14] We address Patent Owner's argument that this construction "require[s] that the data is transmitted to a customer rather than a server for later download by the customer" (Prelim. Resp. 22) in Section V.E. below.

"means for *sending one or more images in real-time to the customer from the mobile agent through the local communication and providing the customer with progress information via real-time imaging of the one or more images from the mobile agent to the customer computer during performance of the acquisition request, including viewing the one or more goods from a pick-up site for the one or more goods during a shopping event*" (claim 14)	**Function**: emphasized text **Structure**: real-time video device 46, communications device 48, and a communication link capable of connecting the customer and agent

Ex. 1034, 2. For ease of reference, we refer to the first two terms above as the "communication means" terms and the second two as the "real-time means" terms.

In this proceeding, Petitioner and Patent Owner agree that the communication means and real-time means terms have the function identified in the Delaware court's construction, but they propose somewhat different corresponding structures. *See* Pet. 15–18; Prelim. Resp. 23–30. For example, the parties identify MDAS 42 as part or all of the structure for the real-time means terms,[15] whereas the Delaware court's construction identifies components of the MDAS (e.g., communications device 48 and real-time video device 46). *Compare* Pet. 16–18; Prelim. Resp. 27–30, *with* Ex. 1034, 2. In addition, Patent Owner argues that server 14 and customer computer 30 are not part of the structure for the "real-time video means" of claim 11, whereas Petitioner's proposal and the Delaware court's construction include those elements. *Compare* Prelim. Resp. 27–28, *with*

[15] For the "communication means" terms, the parties identify the structure as the "server 14 and communications device 48." Pet. 16–18; Prelim. Resp. 23–24.

Pet. 16–17; Ex. 1034, 2. Moreover, the Delaware court's construction includes a customer device in the structure of the "communication means" of claim 11, which is not found in the parties' proposals. *Compare* Ex. 1034, 2, *with* Pet. 16; Prelim. Resp. 23–24.

At this stage, we need not resolve what we perceive to be relatively minor differences in the proposed structure for these terms because Petitioner has met the burden for institution under both the parties' proposals and the Delaware court's construction. Indeed, on the current record, it is not clear whether any of these differences matter to the patentability challenges in the Petition. *See Realtime Data, LLC v. Iancu*, 912 F.3d 1368, 1375 (Fed. Cir. 2019) ("The Board is required to construe 'only those terms that . . . are in controversy, and only to the extent necessary to resolve the controversy.'") (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). With that in mind, we encourage the parties to streamline their arguments at trial to focus on those disputes, if any, that affect the grounds presented in the Petition. In particular, if either party believes an argument turns on the structure we adopt for one of these terms, it should specifically explain why that is the case and provide argument with citation to the Specification and record demonstrating that the Board should apply their construction of the structure instead of the Delaware court's construction.

iv. other terms

Neither party identifies any other claim term for construction. We agree that no additional claim construction is necessary at this stage of the proceeding. *See Realtime Data*, 912 F.3d at 1375.

D. References Relied Upon

i. Park

Park is a publication of a PCT application filed August 4, 2000, and published February 15, 2001. Ex. 1005, codes (22), (43). Petitioner asserts that Park qualifies as prior art under 35 U.S.C. § 102(b). Pet. 19.

Park discloses a system and method for real-time ordering and delivery of locally available products. Ex. 1005, code (54). Park teaches that customers in predefined geographical regions can access its system over the Internet using a website to order products, including perishable food items, that will then be delivered within a specified delivery window. *Id.* at Abstr., 1:11–16. According to Park, this is "a real-time network-based order and delivery system that will allow customers to interactively view, in real-time, the progress of his order, from reception and compilation to delivery through the route taken by the delivery agent." *Id.* at 4:27–32.

Figure 1 of Park is a system block diagram and reproduced below.

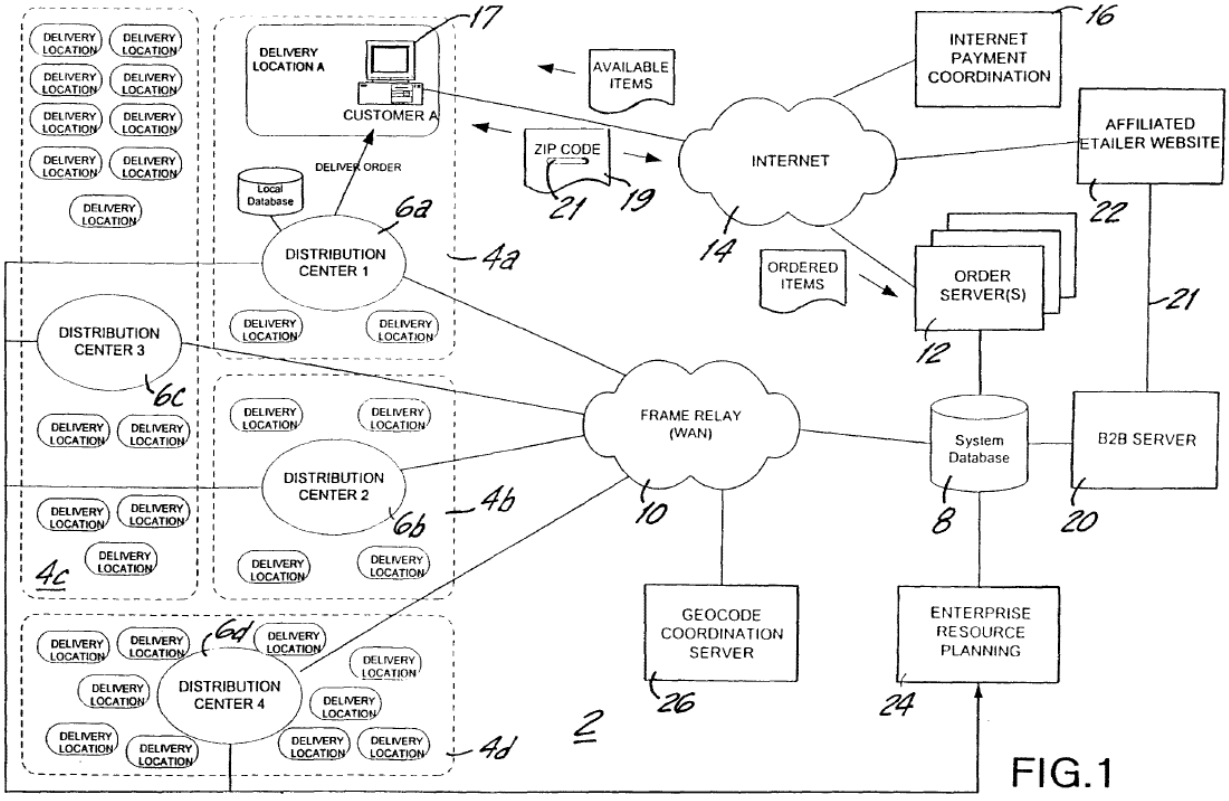


Figure 1 of Park shows a customer at delivery location A using their computer (17) to connect through the Internet (14) to order server(s) (12) to view information about products available through a distribution center associated with the customer's zip code. *Id.* at 14:26–15:10, 20:14–21:2. Park teaches that the customer may place an order for their desired product and pay "with a checkout methodology." *Id.* at 3:13–19, 14:16–24.

The order is then sent to an order dispatching system at a distribution center (e.g., Distribution Center 1 in Figure 1) associated with the customer's zip code. Ex. 1005, 15:21–24. Figure 2 of a Park is reproduced below and "illustrates the process flow at each distribution center for fulfilling and delivering the items ordered." *Id.* at 16:9–11.

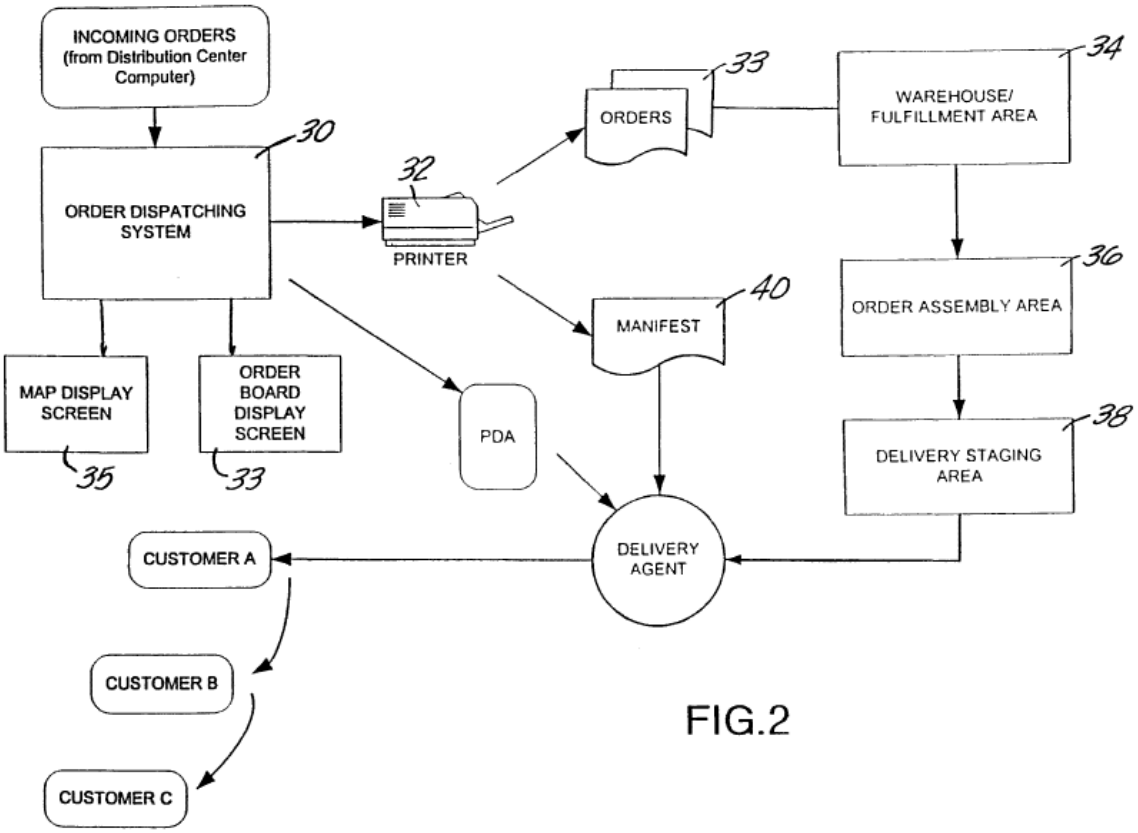


FIG.2

As shown in Figure 2 of Park, incoming orders are received by order dispatching system (30). An order ticket (33) is printed and used to assemble the order for delivery by a delivery agent. *See id*. 16:11–31.

Park teaches that the system can use GPS to examine a delivery agent's current position and "generate[] an optimal set of routes for the agents to follow" that "may be transmitted to [the] handheld or mobile computing devices of the agents mapping out the route to be taken" to deliver particular orders. Ex. 1005, 29:6–30:8. The agent's mobile computing device allow them "to receive delivery information and new routing instructions" from the dispatching system. *Id.* at 47:4–9. The mobile computing device may also "have input means to provide comments related to the delivery . . . transmitting means to provide real-time status to the delivery and ordering system, and position means such as a global position

indicator system for determining the physical location of the agent with respect to the route." *Id.* at 47:16–23.

Park explains that information regarding the agent's location "may be provided to the customer" such that the customer can "view the current location of their delivery and . . . see the progress made on a map provided by the web server." Ex. 1005, 47:32–48:3. In addition, Park teaches that "[t]he delivery agent in the field will be provided with a mobile digital camera which will be capable of transmitting digital video through a third party network back to the web server," which "will then present the video over the Internet." *Id.* at 48:12–16. Park further teaches that this equipment is "used to provide online customers with a 'first person' view of the delivery of their order" via a "live video feed" from the agent's mobile digital camera. *Id.* at 48:10–12, 48:19–20; *see also id.* at 49:9–11 (explaining that the video "would be paused" during actual delivery of the order to preserve customer privacy). According to Park, "[t]his information, combined with online information regarding the progress of the rider . . . would provide the most advanced order tracking information available today." *Id.* at 49:13–17.

ii. Kim

Kim is a Korean patent application bearing a November 7, 2003 publication date. Ex. 1006, (code 43). Petitioner asserts that Kim qualifies as prior art under 35 U.S.C. § 102(b). Pet. 19.

Kim explains that websites display images and videos of products for customers to order and have delivered. Ex. 1006, 2. "However, when purchasing products from such websites, customers often end up receiving products which are not identical to the products ordered as they made the

purchases simply based on the images or videos presented by the websites." *Id.*

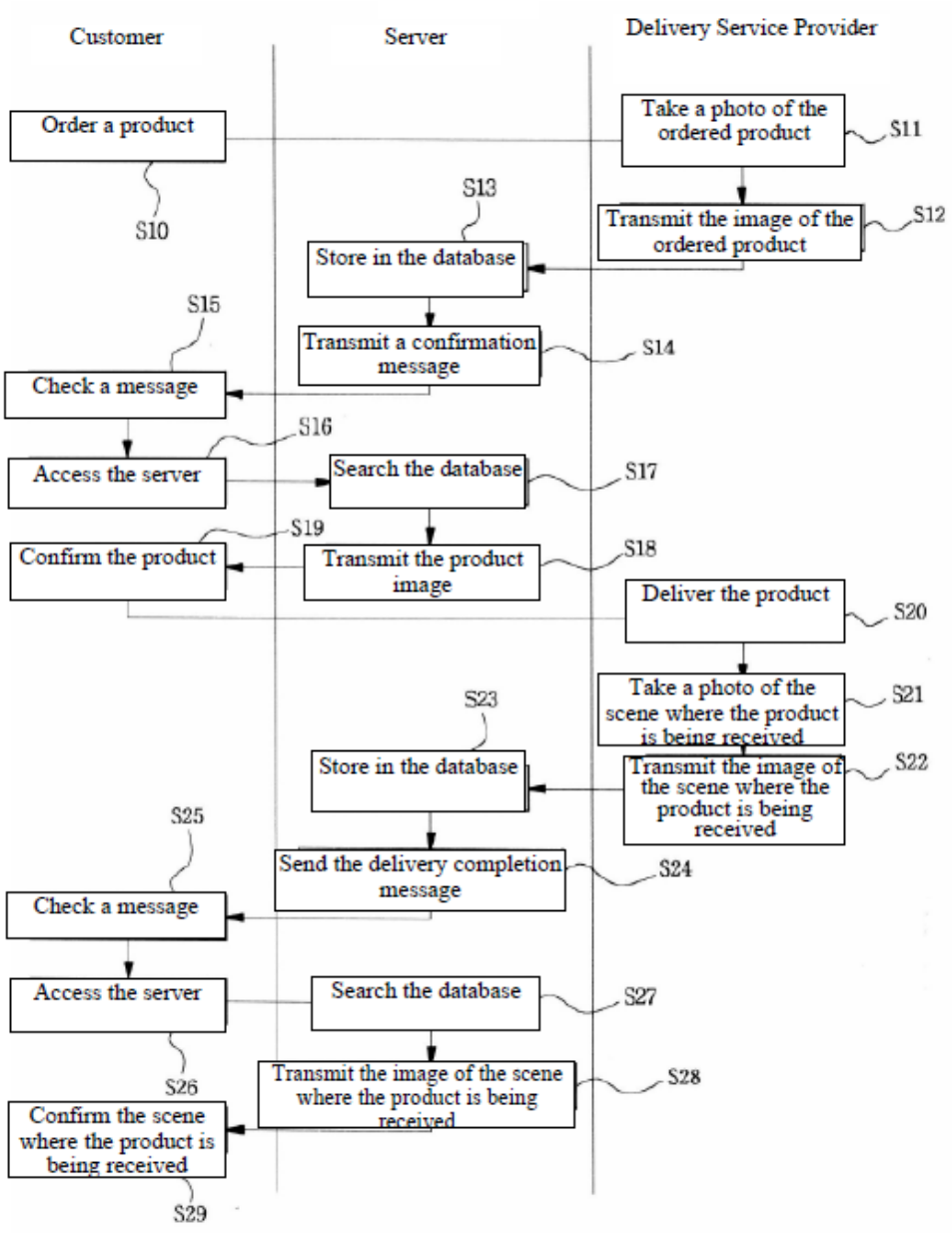
To address this problem, Kim discloses a system and method "designed to confirm product delivery through images by utilizing a mobile communication terminal equipped with a digital camera." Ex. 1006, Abstr. Kim teaches that

> [u]pon receiving an order of a product from a customer . . . a delivery service provider uses his/her mobile communication terminal equipped with a digital camera to capture an image of the product ordered by the customer and transmits it to a server. Subsequently, the server transmits a confirmation message to the customer to inform that the order has been received and then transmits the image of the ordered product to the customer who has checked the message so that the customer can confirm whether the product ordered is identical to the product being delivered.

Id. According to Kim, the system and method utilize the digital camera to take the images and "send the images to the customer real-time so that the product ordered or a scene in which the product is being received can be confirmed." *Id.* at 2.

Figure 2 of Kim, reproduced below, is a flowchart illustrating an embodiment of Kim's method. Ex. 1006, 1.

FIG. 2



As depicted in Figure 2 of Kim, a customer orders a product (S10) prompting the delivery service provider to take a photo of the ordered product (S11) "by using his/her own mobile communication terminal . . . equipped with a digital camera." *Id.* at 4. That image is transmitted to a server, stored in a database (S13), and the server then transmits a confirmation message to the customer (S14). *Id.* "Subsequently the customer

checks the message on the received order (S15) which arrived at his/her own mobile communication terminal . . . and accesses (S16) the server . . . to confirm the image or video of the ordered product by using his/her own mobile communication terminal." *Id.* This causes the image or video to be transmitted to the customer's mobile communication terminal (S17 and S18), which "displays the image or video received as such (S19) to confirm the product." *Id.* "Thereafter, the delivery service provider delivers the product (S20) ordered and confirmed by the customer." *Id.*

iii. Williams

Williams is a publication of a PCT application filed August 4, 2000, and published May 2, 2008. Ex. 1008, codes (22), (43). Petitioner asserts that Williams qualifies as prior art under 35 U.S.C. § 102(b). Pet. 19. Williams discloses methods for rendering an embeddable widget that is rendered by a server to "dynamically display[] multimedia content" and allow user action on a website. Ex. 1008, Abstr., 3:2–6, 3:17. Williams explains that "[c]onventional widgets are generally embeddable, portable applications that often run without access to a user's file system." *Id.* at 2:17–18. According to Williams,

Although electronic commerce and social transactions are possible via the World Wide Web, there are drawbacks. Many social and electronic commerce transactions involve many-to-many relationships. Such relationships are not well supported by current electronic commerce and social media platforms. In addition, the ability of tools, such as widgets, to reflect individual users' tastes may be limited. Consequently, users' ability to engage in social, commercial, and other transactions including sharing of multimedia content may be limited.

Id. at 2:25–31. Williams explains that its widgets are intended to address these needs and "facilitate[e] commercial transactions via the Internet." *Id.* at 2:32–33.

iv. Hileman

Hileman is a United States patent application published on February 27, 2003. Ex. 1009, code (43). Petitioner asserts that Hileman qualifies as prior art under 35 U.S.C. § 102(b). Pet. 19.

Hileman discloses an on-demand transportation system that includes a server in communication with a user and a vehicle. Ex. 1009, Abstr. "The user provides the server with transportation request information, and requests transportation options from the server." *Id.* Hileman teaches that the server evaluates the transportation request and "determines transportation options, including available routes of travel (times, paths, etc.) and the charges associated with the various available routes of travel." *Id.* According to Hileman, the server then notifies the user of the options and associated costs and, after the "user selects one of the transportation options," books the requested transportation. *Id.*

E. Ground 1: obviousness over Park, Kim, and Williams

Petitioner contends claims 1, 3, 4, 6–10, 14, and 15 would have been obvious over Park, Kim, and Williams. *See* Pet. 19–60. Beginning with claim 1, the Petition asserts that Park teaches or suggests most of the elements of claim 1. *See id.* at 30–46. Petitioner acknowledges that Park "is silent as to allowing a customer to confirm the product before delivery." *Id.* at 24. Thus, for elements 1.4a, 1.4.b, and 1.5, Petitioner relies on Kim's teaching that "a delivery service provider uses his/her mobile

communication terminal equipped with a digital camera to capture an image of the product ordered by the customer" and "send the images to the customer," who then confirms the order by sending a direct communication back to the delivery service provider's terminal. *Id.* at 36–42 (quoting and citing Ex. 1006, Abstr., 3, Fig. 2).

For the widget recited in elements 1.7.a and 1.7.b, Petitioner relies on Williams's teachings "that it is well known to use widgets to retrieve and present information over the Internet." Pet. 44–46. More specifically, Petitioner contends that "Williams teaches a widget that retrieves and 'displays multimedia content' such as the image/video and status information taught by Park and Kim." *Id.* at 46.

Petitioner articulates reasons why a POSITA would have been motivated to combine the references and would have had a reasonable expectation of success in doing so. Pet. 22–30. More specifically, Petitioner contends a POSITA would have been "motivated to incorporate Kim's customer confirmation technique into Park because doing so would address a well-known problem in the art," i.e., "customers ordering products over the Internet often receive goods that are not identical to the products ordered." *Id*. at 22–23. According to Petitioner, a POSITA would have had a reasonable expectation of success in making the combination given the "close overlap" between the references as well as the fact "that Kim's technique requires a mobile communication terminal with a digital camera, which are components Park's delivery agents already carry." *Id.* at 25–26. Petitioner supports these assertions with testimony from its declarant and other evidence. *See generally id.* at 22–27.

Petitioner further contends that it would have been obvious to display Park and Kim's real-time images and video content to a customer using a widget as taught in Williams "because it was well-known and desirable to use web-based widgets to embed multimedia functionality into websites." *Id.* at 27. According to Petitioner, widgets were known to be a "simple, easily deployable functional item" that can be accessed through a web browser in a "relatively small area of a display." *Id.* at 28 (citing Ex. 1003 ¶¶ 73-74; Ex. 1019 ¶¶ 159–60; Ex. 1020, 1:21–25). Thus, urges Petitioner, using a widget to present Park's view of the current location of the delivery agent "is nothing more than a combination of familiar elements according to known methods that yields predictable" and beneficial results. *Id.* 29–30.

Petitioner's showing for independent claim 14 is based on the same combination of references and in large part relies on the same arguments and evidence Petitioner provides for claim 1. *See* Pet. 55–59. For the real-time means in element 14.3.a, Petitioner contends that the wireless mobile computing devices, which include a digital camera and transmitting means, and the web server for presenting live video over the Internet perform the recited function and are "at least equivalent structure" to that in the Specification. *Id.* at 57–58. For the communication means in element 14.4, Petitioner identifies Park's wireless mobile computing device, the client computer and Kim's mobile communication terminal as "at least equivalent structure" that performs the recited function. *Id.* at 58. Petitioner further relies on Figure 2 of Kim as evidence that the communication confirming the order occurs over a "local communication link" as recited in element 14.1.

Petitioner's showing is sufficient to establish a reasonable likelihood

that it will prevail in demonstrating that claims 1 and 14 are obvious over Park, Kim, and Williams. Patent Owner's arguments against institution in the Preliminary Response are unavailing on the current record. We address those arguments below.

As an initial matter, Patent Owner argues the "Petition should be denied because [it] relies upon the unreliable and improperly certified translation of the Kim reference for every Challenged Claim." Prelim. Resp. 15. According to Patent Owner, "the Certificate of Translation neither identifies the person who performed the translation nor details their qualifications" and there are "several errors in the translation ranging from a failure to maintain proper syntax . . . to changing Kim's mobile terminal from one 'equipped with' a camera to one having an 'embedded' camera." *Id.* (citing Ex. 2008 ¶¶ 2–5 (declaration of Patent Owner's translator)).

We do not agree that the Petition should be denied for these reasons. Our rules require that "[w]hen a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation must be filed with the document." 37 C.F.R. § 42.63(b). That affidavit should also meet the requirements of 37 C.F.R. § 1.68.

Here, Petitioner has submitted a "Certificate of Translation Accuracy" from Alex Jo, "a professional translator specializing in translating Korean to English" with "more than 25 years of experience" attesting that Exhibit 1006 is "a true, correct, and complete translation to the best of my knowledge and ability" that was executed "under penalty of perjury" in the United States. Ex. 1006 (last page). This certification complies with our rules even if the translation in Exhibit 1006 was prepared by Mr. Jo reviewing an initial

translation translated by someone else, as Patent Owner's declarant, Mr. Kim, suggests. *See* Ex. 2008 ¶¶ 2–3.

As for the alleged translation errors identified by Patent Owner, on the current record, it appears that none of them affect the substance of the grounds in the Petition. In other words, even if we accept that Petitioner's translation contains the errors identified by Patent Owner's declarant, the corrections Mr. Kim proposes do not materially change the underlying teachings Petitioner relies upon. *See generally* Ex. 2008 ¶¶ 4–5. In any event, Patent Owner will have the opportunity to develop its concerns regarding the accuracy of Petitioner's translation, including by offering evidence of any translation errors it believes are material to Petitioner's grounds, in its subsequent papers at trial.

Patent Owner's Preliminary Response also raises several arguments concerning the merits of the "Park-Kim combination." Prelim. Resp. 35–37.[16] First, Patent Owner contends that the Park-Kim combination would not provide an image of the product in "real-time" and "would, at most, provide an image to a server where the customer can receive the image at some later time." *Id.* at 35. According to Patent Owner, both Park and Kim teach that images and video are sent from the agent's mobile communication terminal to a web server and presented over the Internet. *Id.* at 35–37. Patent Owner argues this is not communicating images in "real-time" because the it requires "the customer to initiate a separate transaction to watch the video"

[16] As Patent Owner points out, these arguments relate to the combination of Park and Kim, which forms the basis of Petitioner's challenges in both of the grounds in the Petition. *See* Prelim. Resp. 34, n. 4. At this stage, Patent Owner does not raise separate arguments for Grounds 2.

and there is "no communication path between the customer and delivery agent." *See Id*.

On the current record, Patent Owner's "real-time" arguments are unavailing for several reasons. First, both Park and Kim expressly teach that images and video are communicated in "real-time" from the mobile devices operated by their delivery agents/providers to the customer. Ex. 1005, 4:18–32; Ex. 1006, 2. Patent Owner does not address these teachings in the Preliminary Response even though they directly contradict its argument that the combination of Park and Kim do not provide for real-time communication of a product image.

Second, Patent Owner's arguments that real-time communication of an image cannot occur over the internet or require the customer to "initiate a separate transaction" (e.g., by responding to a prompt in a confirmation message) appear to be inconsistent with the description of the preferred embodiment in the Specification of the '191 patent. Figure 1 of the Specification depicts communication between the customer computer (30) and mobile delivery agent system (42) occurring through a server (14) accessed via the internet (18). And after the delivery agent is selected, the Specification describes communication between the agent and the customer occurring through the internet. *See* Ex. 1001, 5:33–38 (explaining that after a desired delivery agent is selected in Figure 3 steps 108 or 109 and the customer's shopping request and profile are sent at step 110, a communications link between that agent and the customer is established "through a telephone or internet connection"). The Specification also states that video from the real-time video device in the MDAS is "preferably" transmitted to and stored on server 14. *Id.* at 8:22–30. Patent Owner's

Preliminary Response does not attempt to square these descriptions of the preferred embodiment with its argument that a skilled artisan would understand that Park's "live video feed" is not in real-time because Park describes passing that video data through a web server to the customer. *See* Prelim. Resp. 35–36 (quoting Ex. 1005, 48:12–16).[17]

Moreover, according to the description of the preferred embodiment in Figure 3 of the Specification, after the agent's device communicates to the customer that a product has been identified, the customer "has the option of inspecting the product in real-time at [step] 117." Ex. 1001, 7:3–4. The transmission of the product image does not occur until the customer "chooses to inspect the product" and "communicate[s] instructions to the delivery agent at [step] 118." *Id.* at 7:4–8. In this regard, the preferred embodiment, like Patent Owner's description of the functionality in Park and Kim, requires the customer to perform an action before receiving an image of the product for inspection. *See* Prelim. Resp. 29–31. It may be that when the customer does not quickly respond to the prompt to inspect the product

[17] Patent Owner's related argument "Park states that such technology is not even available which cuts against any potential disclosure" of delivering real-time images to the customer is also unavailing on the current record. *See* Prelim. Resp. 29 (citing Ex. 1005, 48:31–49:7). Park explains that its concept of sending real-time video from the delivery agent to the customer "is dependent upon radically increased capabilities to convey large amounts of data over a cellular network in real time." Ex. 1005, 49:4–7. On the current record, this seems to suggest the technology existed, but that its implementation was limited at least in some areas by the data capacity of then existing cellular networks—an issue that would seem to apply in equal measure to the systems and methods in the '067 patent. In any event, Patent Owner has not offered evidence at this stage of the proceeding to support its interpretation of Park's teachings.

(e.g., the confirmation message in Figure 2 of Kim) there is a delay between the time the image is taken by the agent and the time the customer receives it. But at least in those instances where the customer does immediately seek to inspect the product, the current record supports Petitioner's argument the combination of Park's live video feed and Kim's teaching of obtaining a product image would result in the data being passed to the customer as it is gathered (i.e., in real-time). *See* Pet. 36–39.

Patent Owner's argument that the Petition "fails to identify any teaching in the proposed Park-Kim combination where the delivery agent's device provides to the customer acquisition and delivery information of the product" is also unavailing on the current record. Prelim. Resp. 38–39 (internal quotations omitted). The terms "customer acquisition and delivery information" are not recited in the challenged claims. Instead, the premise for this argument is language in Patent Owner's construction of "mobile delivery agent system," which we, like the Delaware court, have not adopted. *See supra* V.C.i. Moreover, even if the challenged claims did recite such a requirement, the Petition demonstrates sufficiently for institution that the delivery agent's device in the Park-Kim combination would have provided acquisition and delivery information to the customer. *See* Pet. 19–20, 36–38 (citing evidence that the agent's device allows the customer to "interactively view, in real-time, the progress of his order from reception and compilation" to delivery); 41 (citing Kim Figure 2 showing "delivery completion message" sent to customer).

Patent Owner also argues that a POSITA would not have been motivated to combine Park and Kim as articulated in the Petition. *See* Prelim. Resp. 39–49. According to Patent Owner, a POSITA would not have

been motivated "to modify Park's system with Kim's technique because it directly undermine[s] Park's requirement for extremely fast and efficient delivery based on optimized routing algorithms used to determine delivery manifests" and "waiting for customer confirmation defeats Park's intended goal." *Id.* at 40–41. Patent Owner further asserts that "Petitioner fails to show how this time [i.e., the time to send a product image and receive confirmation from the user] would even be factored into Park's routing algorithms." *Id.* at 41; *see also id.* at 43–44 (arguing that "Petitioner's bare-bone contention that Kim's technique would only take two minutes to implement finds no evidentiary support").

On the current record, we disagree with Patent Owner and find that Petitioner has articulated a sufficient rationale for combining the references. Petitioner asserts, supported by the testimony of its declarant and teachings in Park and Kim, that the combination would "enhance the reliability of the delivery" and "increase customer satisfaction" by providing a "a sensory cue of a visual comparison between the product to be delivered and the desired product." *See* Pet. 22–25 (citing exhibits). Petitioner also explains that the problem Kim's product confirmation functionality is intended to address is "particularly acute" for perishable items such as food, which Park teaches its system is designed to deliver. *Id.* at 23. Petitioner acknowledges that adding Kim's functionality would add time to the delivery process, but argues that "[a]ny additional time . . . could be absorbed into the desired hour delivery time of Park" or "alternatively, a POSITA would have recognized that the confirmation teachings of Kim could be provided as an option to the user with an advisory message to the user that such confirmation may add time to his or her order." *Id.* at 26.

Petitioner's rationale is reasonable on the current record. While Park is focused on providing fast delivery, it would seem that a POSITA would also understand that delivering the wrong product is likely to cause an even greater delay then the additional time necessary to for the delivery agent to send a product image and receive customer confirmation. *See* Pet. 25 (urging that incorporating Kim's functionality "would reduce the likelihood in Park that the delivery agent made an incorrect delivery, thereby saving resources in the Park system (e.g., by preventing the delivery of goods that would need to be returned and/or refunded") (citing Ex. 1003 ¶ 67; Ex. 1021, 3:4–53). Moreover, Petitioner's argument that the product confirmation functionality could be presented as an option so as to balance the competing desire for fast delivery would seem to be a reasonable exercise of a POSITA's ordinary creativity. *See KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) ("A person of ordinary skill in also a person of ordinary creativity, not an automaton.").

We also disagree with Patent Owner's argument that the testimony of Dr. Houh supporting these arguments is conclusory and entitled to no weight. It is true that portions of Dr. Houh's declaration are the same as the arguments in the Petition, but the reasons Dr. Houh and Petitioner provide for the proposed modification of Park with Kim are not overly conclusory and are supported with citations to a number of references. *See* Pet. 22–27; Ex. 1003 ¶¶ 64–69 (citing exhibits). At this stage, Petitioner's evidence, including the testimony of Dr. Houh, is sufficient to support the allegations in the Petition. Patent Owner will have an opportunity to respond more fully at trial, including through cross-examination of Dr. Houh and by presenting other evidence and argument in response to Petitioner's showing.

Patent Owner's arguments that "Kim does not disclose sending instructions from the customer to the MDAS" and that the Park-Kim combination does not teach "direct communication" between the MDAS and the customer are also unavailing on the current record. Prelim. Resp. 47–53. Figure 2 of Kim shows a line that extends directly from the customer at step S19 to the delivery service provider at step S20. Petitioner contends, and the current record supports, that this illustrates the direct communication of instructions from the customer to the MDAS confirming the order. Pet. 40–42.

In contrast, the current record does not support Patent Owner's argument that "there is no message sent" because the line in Kim Figure 2 has "no arrow from box S19 to box S20." Prelim. Resp. 47–48, 50–51. As an initial matter, only the arrowhead is missing in Petitioner's translated figure and there are other lines also missing arrowheads where it would seem that communication has necessarily occurred.[18] Thus, on the current record, we do not interpret the absence of an arrowhead on the line between box S19 and box S20 to mean, as Patent Owner urges, that the customer confirms the product "when the customer simply views the image received from the server without any mechanism for feedback." Prelim. Resp. 48. More importantly, the original figure in the untranslated version of Kim *does include an arrowhead* with the line between box S19 and box S20. Ex. 1007, 7. This suggests that the missing arrowhead is a typographical error in the

[18] For example, there is no arrowhead on the line between the customer at step S10 "Order a product" and the delivery service provider at step S11, but it would seem that a communication must occur for the provider to be able to "Take a phone of the ordered product" at step S11. Ex. 1006, Fig. 2.

translated exhibit (Ex. 1006). It also contradicts Patent Owner's argument that Kim fails to teach the communication of instructions confirming the order from the customer to the delivery agent's device. *See* Prelim. Resp. 41 ("A careful review of Figure 2 show that there is no arrow from box S19 to box S20."). To the extent the missing arrowhead in the translated version of Kim's Figure 2 (Ex. 1006) is a typographical error, Petitioner is authorized to file a corrected version of its translation of Kim Figure 2 that includes the all of the arrowheads shown in the original Figure 2 of Kim (Ex. 1007). That corrected version should be filed within one month of institution and should include a certification attesting to its accuracy per 37 C.F.R. § 42.63(b).

Patent Owner's arguments that there is no direct communication between the agent's and the customer's devices because Park and Kim teach that information is presented over the Internet or sent to a web server for storage are also unavailing on the current record. *See* Prelim. Resp. 49–50. As Petitioner points out, the Specification "does not use the phrase a "*direct communication*" to describe communication between the customer and a mobile agent, but it states that 'a communication link is established between the customer and the selected delivery agent at step 111, **such as through a telephone or internet connection**." Pet. 39 n. 3 (quoting Ex. 1001, 5:23–25). The Specification also states that video footage from the MDAS is "[p]referably . . . stored on the server 14." Ex. 1001, 8:10. Thus, to the extent Patent Owner contends that the term "direct communication" somehow excludes communication over the internet involving a server it will need to present evidence of such and attempt to reconcile its claim interpretation with the Specification's description of the preferred embodiment at trial.

Patent Owner's related argument for the communication means limitations in claim 14 is unavailing for the same reasons. *See* Prelim. Resp. The Petition asserts that a POSITA would have modified Park to perform the product confirmation functionality taught in Kim. *See* Pet. 24. On the current record, Petitioner has sufficiently demonstrated that this combination would result in a structure that is the same or equivalent to a MDAS because the agent's device in Park includes a real-time video and communication device, that when combined with Kim performs the recited function.[19] *See Fresenius USA, Inc. v. Baxter Int'l, Inc.*, 582 F.3d 1288, 1299 (Fed. Cir. 2009) (explaining that to show a means-plus-function limitation "was present in the prior art" one "must prove that the corresponding structure—or an equivalent—was present in the prior art").

Finally, Patent Owner argues that the Park-Kim combination does not teach that the customer communicates "approval for the agent to immediately purchase the one or more goods viewed by the customer" as recited in element 1.5. Prelim. Resp. 55–59. According to Patent Owner, "Park operates just like UPS with the goods purchased prior to an agent picking them up" and Kim "is simply designed [to] send an image to a se[r]ver that can be downloaded at a later time." *Id.* at 55–56. Thus, urges Patent Owner, "Petitioner does not articulate how it proposes that Kim's alleged method of purchasing goods after confirmation would be incorporated into Park's system." *Id.* at 57–59.

[19] Petitioner has also shown that Park and Kim disclose the other structures, e.g., a server and customer device/computer, recited in the parties' and Delaware court's construction for these terms.

On the current record, we disagree with Patent Owner. As explained above, Petitioner has shown on the current record that Kim teaches that, after viewing the product image, the customer directly communications instructions to the delivery provider's device to "confirm the product." Pet. 40–41 (quoting Ex. 1006, 1, 3, Fig. 2). Thereafter, the product is delivered to the customer. Ex. 1006, 3, Fig. 2. In view of these teachings, Petitioner contends it would have been obvious that

> the "confirmation" directly communicated to the agent's device is an "*approval for the agent to immediately purchase the one or more goods viewed by the customer.*" Specifically, Kim teaches that the "customer places an order of a product **to a delivery service provider**" rather than placing the order with the seller, so it would have been obvious that the delivery service provider makes the purchase and does not do so until the customer confirms the image.

Prelim. Resp. 41 (internal citations omitted). Petitioner supports these assertions with citations to Kim, Dr. Hough's testimony, and other references evidencing that customers prefer to inspect products before they purchase them. *Id.* (citing Ex. 1003 ¶ 123; Ex. 1006, 3, 5; Ex. 1014, 2; Ex. 1022, 3). At present, this showing is sufficient to meet Petitioner's burden as it relates to element 1.5. Patent Owner will have the opportunity to respond more fully to Petitioner's evidence in its subsequent papers. In particular, Patent Owner's argument that products in Park's system are purchased prior to the delivery agent's involvement would benefit from further development at trial.

For these reasons and based on the current record, Petitioner has established a reasonable likelihood it will prevail in demonstrating that claims 1 and 14 are unpatentable over Park, Kim, and Williams.

Petitioner's showing for dependent claims 3, 4, 6–10, and 15 is also sufficient for institution. The Petition presents evidence and argument to support Petitioner's assertion that the cited references teach or suggest the additional limitations recited in each of these claims. Pet. 46–55, 59–60 (addressing additional limitations in claims 3, 4, 6–10, and 15). At this stage, Patent Owner does not make any arguments against Petitioner's showing for these claims beyond its arguments for the independent claims, which are unavailing for the reasons explained above.

F. Ground 2: obviousness over Park, Kim, Williams, and Hileman

Ground challenges claims 11–13 and relies on the same combination of Park, Kim, and Williams for most of the limitations of claim 11. *See* Pet. 61–71. The Petition adds Hileman to the combination to address the recitation of "an input configured to receive . . . a selection made by the customer of one of the plurality of delivery agent systems representing delivery agents" in claim 11. *Id.* at 65–67.

Patent Owner does not raise any separate argument for Ground 2 in its Preliminary Response, but asserts the same arguments regarding the "Park-Kim combination" in Ground 1. *See* Prelim. Resp. 34 n. 4.

On the current record, we are persuaded that Petitioner's showing for Grounds 2 is sufficient to meet the burden for institution of *inter partes* review for each of the claims challenged in that ground. To the extent Patent Owner asserts the same arguments for Ground 2 as it does for Ground 1, those arguments are unavailing on the current record. *See supra* § IV.E (addressing Patent Owner's arguments regarding the Park-Kim combination).

VI. CONCLUSION

Based on the current record, we determine Petitioner has shown a reasonable likelihood that it will prevail in establishing that at least one claim of the '191 patent is unpatentable. Accordingly, we institute review of all claims challenged on all of the grounds in the Petition. *See* Consolidated Trial Practice Guide (Nov. 2019), 64, available at https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf.

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim. Our view with regard to any conclusion reached in the foregoing analysis could change upon completion of the record.

VII. ORDER

Accordingly, it is:

ORDERED that pursuant to 35 U.S.C. § 314, an *inter partes* review is hereby instituted as to claims 1, 3, 4, and 6–15 of the '191 patent based on the unpatentability challenges presented in the Petition;

FURTHER ORDERED that, within one month of the date of this Decision, Petitioner is authorized to file a corrected version of the translation of Figure 2 in Exhibit 1006 that includes all of the arrows depicted in the original Figure 2 in Exhibit 1007 and a certification pursuant to 37 C.F.R. § 42.63(b); and

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial commencing on the entry date of this decision.

For PETITIONER:

Raghav Bajaj
Scott Jarratt
Angela Oliver
Destiny Stephenson
HAYNES & BOONE LLP
raghav.bajaj.ipr@haynesboone.com
scott.jarratt.ipr@haynesboone.com
angela.oliver.ipr@haynesboone.com
lyric.stephenson.ipr@haynesboone.com

For PATENT OWNER:

James Hannah
Jeffrey H. Price
Jenna Fuller
KRAMER LEVIN NAFTALIS & FRANKEL LLP
jhannah@kramerlevin.com
jprice@kramerlevin.com
jfuller@kramerlevin.com