

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BJ'S WHOLESALE CLUB HOLDINGS, INC.,
Petitioner,

v.

WALMART APOLLO, LLC,
Patent Owner.

IPR2022-01496
Patent 10,368,187 B2

Before NEIL T. POWELL, MITCHELL G. WEATHERLY, and
ARTHUR M. PESLAK, *Administrative Patent Judges*.

WEATHERLY, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. Background

BJ's Wholesale Club Holdings, Inc. ("Petitioner") filed a petition (Paper 1, "Pet.") to institute an *inter partes* review of claims 1–21 (the "challenged claims") of U.S. Patent No. 10,368,187 B2 (Ex. 1001, "the '187 patent"). 35 U.S.C. § 311. Walmart Apollo, LLC ("Patent Owner")

timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). Institution of an *inter partes* review is authorized by statute when “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Based on our review of the record, we conclude that Petitioner is reasonably likely to prevail with respect to at least one of the challenged claims.

Petitioner challenges the patentability of claims as follows:

Claim(s) challenged	35 U.S.C. §¹	Reference(s)
1–21	103	Poole, ² Hammad ³
1–21	103	Roeding, ⁴ Poole

Generally, Patent Owner contends that the Petition should be denied in its entirety. On April 24, 2018, the Supreme Court held that, under 35 U.S.C. § 314, the Office may not institute review of fewer than all claims challenged in the petition. *SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018). For the reasons expressed below, we determine that Petitioner has

¹ The Leahy-Smith America Invents Act (“AIA”) included revisions to 35 U.S.C. §§ 102 and 103 that became effective March 16, 2013. The application for the ’187 patent was filed December 7, 2017, which claims priority to a provisional application filed December 9, 2016. Therefore, we apply the post-AIA versions of 35 U.S.C. §§ 102 and 103.

² U.S. Pat. Pub. No. 2015/0356667 A1 (Ex. 1006, “Poole”).

³ U.S. Pat. Pub. No. 2013/0166332 A1 (Ex. 1007, “Hammad”).

⁴ U.S. Pat. No. 8,489,112 B2 (Ex. 1008, “Roeding”).

demonstrated a reasonable likelihood of establishing that at least claim 1 is unpatentable. In accordance with the *SAS* decision and 37 C.F.R.

§ 42.108(a), we institute an *inter partes* review of all challenged claims of the '187 patent on all grounds alleged by Petitioner.

B. Related Proceedings

The parties identify the '188 patent as a subject of *Sam's West, Inc. et al. v. BJ's Wholesale Club Holdings, Inc.*, Case No. 6:22-cv-00587 (M.D. Fla., Mar. 22, 2022). Pet. 1 (citing Ex. 1020); Paper 3, 1.

C. The '187 Patent

The '187 patent is titled “Systems and Methods for Identifying Available Location-Based Services.” Ex. 1001, code (54). The '187 patent issued on July 30, 2019, from Application No. 15/834,674, which was filed on December 7, 2017. *Id.* at codes (45), (21), (22). Application No. 15/834,674 claims priority to Provisional Application No. 62/432,339, filed December 9, 2016. *Id.* at code (60).

The '187 patent explains that “[m]obile applications executing on a mobile computing device . . . may . . . use . . . the . . . device’s wireless communication capabilities to interact with other computing devices.” Ex. 1001, 1:15–18. One embodiment of the '187 patent describes “a system for performing location-based services” that “includes a mobile application executable on a mobile computing device operated by a user.” *Id.* at 1:25–28. “The system also includes a machine-readable element [(MRE)] configured to provide location information and used in initiating performance of one or more available ordered services.” *Id.* at 1:32–37, 2:34–37. “The system also includes a server hosting a[] services management framework coupled in communication with a database and the

mobile application,” where “[t]he database includes one or more services previously ordered by the user”—“referred to as ‘ordered services.’” *Id.* at 3:1–5.

In operation, a user can approach a local POS terminal with a mobile computing device and use a mobile application thereon to scan a machine-readable element generated and displayed at the POS terminal. Ex. 1001, 3:22–30, 6:13–16. The mobile application can then decode the identifiers in the machine-readable element and identify therefrom the location of a POS terminal associated with the machine-readable element as well as the types of services available at that location. *Id.* at 3:17–30, 3:50–51, 4:24–27, 6:13–25. According to the ’187 patent, “types of services include purchasing goods and services, processing a pharmacy order, financial services such as transferring or receiving money to/from a third party, receiving an electronic receipt (i.e., an e-receipt) from a purchase, and returning an item from the e-receipt.” *Id.* at 2:63–67. In turn, “[t]he mobile application transmits the available types of services to [the] services management framework being executed on [the] server,” which “maps the available types of services to the ordered services associated with the user to determine which ordered services are available at the particular location and transmits that information to the mobile application.” *Id.* at 3:52–3:58. Available ordered services may be automatically processed “for example, if pharmacy services are available . . . an associate may be notified to pick up a previously filled prescription for delivery to the user”—or the user may be asked which available ordered services she wishes to have performed. *Id.* at 3:64–4:5.

D. Illustrative Claim

Claims 1, 8, and 15 are independent claims. Claim 1, which is representative, recites:

1. A system for identifying available location-based services, the system comprising:
 - a mobile application executable on a mobile computing device operated by a user;
 - a database storing one or more previously ordered services associated with the user, wherein the one or more previously ordered services are pending services that are not yet complete due to the services requiring an interaction of the user with a physical facility;
 - a plurality of location-specific computing devices located at a plurality of locations within a facility that are configured to use location-based wireless communication to transmit a code to the mobile application that identifies types of services available to be performed at a location of a location-specific computing device, at least one available service differing between two of the plurality of locations, wherein the available types of services are location-based services capable of being performed at a location of a location-specific computing device;
 - a machine-readable element configured to provide location information used in initiating performance of one or more available ordered services; and
 - a server communicatively coupled to the database and the mobile application and hosting a services management framework configured to map the one or more previously ordered services to the one or more available types of services to determine one or more available ordered services at a location of a location-specific computing device, wherein the one or more available ordered services are ordered services capable of being performed at a location of a location-specific computing device,

wherein the mobile application is configured to:

receive a code from a first location-specific computing device
of the plurality of location-specific computing devices;

identify one or more available types of services based on the
code;

transmit, to the services management framework, the
identification of the one or more available types of
services and user authentication data;

receive an indication from the services management
framework of the one or more available ordered services;

decode the machine-readable element to decode location
information; and

initiate performance of at least one of the one or more
available ordered services determined by the services
management framework using the decoded location
information.

Id. at 9:48–10:31.

II. ANALYSIS

A. Claim Interpretation

We interpret claims in the same manner used 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). When applying that standard, we interpret the claim language as it would have been understood by one of ordinary skill in the art in light of the specification. *Wasica Fin. GmbH v. Cont’l Auto. Sys., Inc.*, 853 F.3d 1272, 1279–80 (Fed. Cir. 2017). Thus, we give claim terms their ordinary and customary meaning as understood by an ordinarily skilled artisan. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir.

2005) (en banc). Only terms that are in controversy need to be construed, and then only to the extent necessary to resolve the controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

Neither party proposes a specific construction for any claim term. Pet. 9–10; Prelim. Resp. 13–14. Accordingly, we determine that an express construction of any claim term is not necessary for purposes of this Decision. *See Wellman, Inc. v. Eastman Chem. Co.*, 642 F.3d 1355, 1361 (Fed. Cir. 2011) (“[C]laim terms need only be construed ‘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).)).

B. Legal Standards

The Supreme Court in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007), reaffirmed the framework for determining obviousness as set forth in *Graham v. John Deere Co.*, 383 U.S. 1 (1966). The *KSR* Court summarized the four factual inquiries set forth in *Graham* that we apply in determining whether a claim is reasonably likely to be unpatentable as obvious under 35 U.S.C. § 103(a) as follows: (1) determining the scope and content of the prior art, (2) ascertaining the differences between the prior art and the claims at issue, (3) resolving the level of ordinary skill in the pertinent art, and (4) considering objective evidence indicating obviousness or nonobviousness. *KSR*, 550 U.S. at 406. With these standards in mind, we address each challenge below.

C. Claims 1–21: Obviousness in View of Poole and Hammad

Petitioner argues that the combined teachings of Poole and Hammad render claims 1–21 unpatentable as obvious. Pet. 10–38. Generally,

Petitioner relies on Poole as describing most of the limitations in claim 1, *id.* at 10–23, and relies upon Hammad in combination with Poole as describing the machine-readable element among other limitations, *id.* at 14, 18, 19.

Patent Owner does not currently contest Petitioner’s showing on whether the prior art describes or suggests every limitation of claim 1. *See* Prelim.

Resp. 14–27. Rather, Patent Owner argues that Petitioner has failed to demonstrate a reasonable likelihood of establishing that an ordinarily skilled artisan would have been motivated to combine teachings of Poole and Hammad as Petitioner proposes for claim 1, *id.* at 19–24, or that an ordinarily skilled artisan would have had a reasonable expectation of success in making the proposed combination, *id.* at 25–27. For the reasons expressed below, we determine that Petitioner has sufficiently demonstrated that an ordinarily skilled artisan would have been motivated to combine the teachings of Poole and Hammad as proposed for claim 1 and would have reasonably expected success in doing so.

1. Claim 1

a) Motivation to Combine Poole and Hammad

Patent Owner first contends that Petitioner’s reasons for combining the teachings of Poole and Hammad are “conclusory and insufficient.” Prelim. Resp. 19–22 (citing Pet. 19–20). Patent Owner, likewise, contends that Mr. Williams’ declaration testimony “similarly recites related conclusory statements in the Petition, which does not cure the Petition’s deficiencies.” *Id.* at 17 (citations omitted). Patent Owner further contends that Poole is “related to the use of a mobile device inside a retail store” and is not in the same field as Hammad which is “related to the use of a mobile device inside a stadium hosting sporting events.” *Id.* at 16.

Patent Owner next contends that a person of ordinary skill in the art would not have “combine[d] the systems and methods of Poole for locating and purchasing items within a retail store with the systems and methods of the preferred embodiment of Hammad. . . that is directed towards ‘gameday mobile purchasing’ in a stadium using a virtual wallet.” Prelim. Resp. 18 (citing Ex. 1006, Abst.; Ex. 1007 ¶ 95). Patent Owner further contends that “Hammad discloses using that virtual wallet to check out once goods are selected, or to facilitate pre-purchasing of pre-selected goods for delivery to the user’s seat in the stadium.” *Id.* (citing Ex. 1007 ¶¶ 96, 99). Patent Owner further contends that Poole “relates to an overall shopping experience at a physical retail store and relates to assisting the customer with locating items in the store, and potentially assisting the customer with checking out virtually once the customer has selected the goods to purchase.” *Id.* at 18–19 (citing Ex. 1006, Figs. 4, 6). Patent Owner further contends that a person of ordinary skill in the art would not combine Poole and Hammad because Hammad “describes problems that would arise in a stadium, such as, for example, problems related to having multiple vendors in the stadium, but such problems are in no way relevant to a retail store.” *Id.* at 19.

Patent Owner next contends that a person of ordinary skill in the art would not have combined Hammad’s user login information or check-in information with Poole’s mobile application. Prelim. Resp. 19. According to Patent Owner, a person of ordinary skill in the art would not have combined Hammad’s disclosure of the user device communicating authentication information, as asserted in the Petition, with Poole “because in Poole, after determining a location of a customer in the store . . . the system of Poole determines whether the customer device is executing the

customer assistance application” and “identifies merchandise items near the customer . . . and may display those items on the display of the customer device.” *Id.* at 20–21 (citing Pet. 19–20; Ex. 1006 ¶¶ 47, 52, 55, 57). Patent Owner further contends that the first time Poole’s system needs personalized use information is when the customer selects one of the displayed items for purchase. *Id.* at 21 (citing Ex. 1006 ¶ 81, Figs. 4, 7).

Patent Owner next contends that an ordinarily skilled artisan would have had “no motivation to combine scanning a barcode to receive a sensor identifier as disclosed by Poole with Hammad’s capturing a QR code to initiate a purchase.” Prelim. Resp. 23. According to Patent Owner, in Poole “scanning the barcode associated with the first sensor may initiate the step of ‘receiving a merchandise identifier associated with a merchandise item located near the first sensor.’” *Id.* Patent Owner further contends that, in Hammad, “the user may capture a snapshot of the QR code to initiate purchase transaction processing.” Patent Owner argues that an ordinarily skilled artisan would not have been motivated “to combine Hammad and Poole because in Poole, if the user desires to purchase items, a POSA would understand that those items are already selected and saved in the customers shopping cart on the customer assistance application.” *Id.*

Patent Owner next contends that an ordinarily skilled artisan would have understood “that the user in Poole can check out solely on their phone after adding the merchandise item(s) to the shopping cart because the items the user wants to buy are already there.” Prelim. Resp. 23. According to Patent Owner, “Poole has no need for implementing a QR code or bar code to check out as Hammad discusses because it would add additional, and unnecessary steps to Poole.” *Id.* Patent Owner further contends that

“scanning the barcode of Poole may initiate the step of ‘receiving a merchandise identifier associated with a merchandise item located near the first sensor’” but “in Hammad . . . the user has already selected items to purchase when it scans the QR code.” *Id.* at 23–24 (citing Ex. 1007 ¶ 161).

For the following reasons, we determine that Patent Owner’s contentions do not undercut Petitioner’s showing based on the present record.

Many of Patent Owner’s contentions are based on what a person of ordinary skill in the art would or would not have understood. For example, Patent Owner contends a person of ordinary skill in the art “would not understand to combine the systems and methods of Poole for locating and purchasing items with a store with the systems and methods of the preferred embodiment of Hammad . . . that is directed towards ‘gameday mobile purchasing’ in a stadium and using a virtual wallet.” Prelim. Resp. 18. However, Patent Owner does not support this contention concerning the understanding of a person of ordinary skill in the art with evidence. *Id.* Similarly, Patent Owner contends that an ordinarily skilled artisan would understand aspects of Poole regarding check out without scanning a machine readable element that render Hammad’s method of capturing and using a QR code “unnecessary.” Such contentions, if supported with evidence, may raise factual issues but those issues are better resolved on a full evidentiary record at trial.

We reviewed Patent Owner’s contentions and determine, based on the present record, that Petitioner has sufficiently stated reasons why one of ordinary skill in the art would have been motivated to combine the teachings of Poole and Hammad as Petitioner proposes. Petitioner’s contentions are

sufficiently supported by the testimony of Mr. Williams which he supports with citations to Poole and Hammad. Ex. 1003 ¶¶ 85–91 (citing Ex. 1006 ¶¶ 5, 28, 94; Ex. 1007 ¶¶ 100, 161, Abst.). Based on the present record, we do not find Petitioner’s stated reasons for combining the teachings of Poole and Hammad to be “conclusory and insufficient” as Patent Owner asserts.

b) Reasonable Expectation of Success

Patent Owner contends that “the Petition fails to discuss reasonable success at all” and fails to meet its burden to show why a person of ordinary skill in the art “would have a reasonable expectation of success of the combined system.” Prelim. Resp. 23–24. Patent Owner further contends that that there would not be a reasonable expectation of success in combining Hammad’s QR code to initiate a purchase with Poole. *Id.* at 25.

While it is true that the Petition does not use the term “reasonable expectation of success,” Mr. Williams testifies that “[a] person of ordinary skill in the art would have had no difficulty combining the bar code generator and display taught by Hammad with the Poole system because Poole already contemplates a bar code” and the combination “would have provided a predictable result of allowing an enhanced barcode display in place of the barcode contemplated by Poole.” Ex. 1003 ¶ 81. Based on Mr. Williams’ testimony, Petitioner sufficiently establishes a reasonable expectation of success.

c) Conclusion for Claim 1

For all the foregoing reasons, we determine that Petitioner has shown a reasonable likelihood that claim 1 would have been unpatentable over Poole and Hammad.

2. Claims 2–7

Claims 2–7 depend from claim 1. Ex. 1001, 10:32–58. Petitioner sets forth evidence and argument as to why Poole and Hammad allegedly render these claims unpatentable. Pet. 23–28.

Patent Owner does not address these claims in the Preliminary Response separately beyond the arguments discussed above for claim 1. *See generally* Prelim. Resp.

We reviewed Petitioner’s evidence and arguments and determine that Petitioner has sufficiently shown a reasonable likelihood that these dependent claims would have been unpatentable over Poole and Hammad.

3. Claims 8–21

For independent claims 8 and 15, Petitioner largely relies on its contentions for various limitations of claim 1, adding that Poole not only discloses a system but also a method to use said system (claim 8) and a computer readable medium to implement the system or method (claim 15). Pet. 28–38 (citing Ex. 1003 ¶¶ 189–212, 235–238, 240, 244, 246, 248, 250, 252, 254, 256, 258). Patent Owner does not provide separate arguments for claims 8 or 15. *See generally* Prelim. Resp.

We reviewed Petitioner’s evidence and arguments for claims 8 and 15 and for at least the reasons discussed with respect to claim 1 determine that Petitioner has shown a reasonable likelihood that claims 8 and 15 would have been unpatentable over Poole and Hammad.

For dependent claims 9–14 and 16–21, Petitioner sets forth evidence and argument as to why these claims would have been unpatentable over Poole and Hammad. Pet. 31–33, 36–38. Patent Owner does not provide separate arguments for these claims. *See generally* Prelim. Resp.

We reviewed Petitioner’s evidence and arguments and determine that Petitioner has sufficiently shown a reasonable likelihood that these dependent claims would have been unpatentable over Poole and Hammad.⁵

D. Discretionary Denial Under 35 U.S.C. § 325(d)

Patent Owner contends we should exercise our discretion to deny institution under 35 U.S.C. § 325(d). Prelim. Resp. 37. Patent Owner contends that Poole is “at best substantially similar to [a] reference[] applied by the Patent Office during prosecution.” *Id.* at 39. Patent Owner further contends that “Petitioner offers nothing new in citing its secondary reference Hammad, which concerns generating a QR code, which the Patent Office also considered.” *Id.*

Patent Owner contends that “the ’187 patent was allowed after a thorough examination.” Prelim. Resp. 40. Patent Owner contends that the Examiner issued two office actions during prosecution. *Id.* In the first office action, the Examiner issued a § 112 rejection and a § 103 rejection over two references, Kostka⁶ in view of Ogaswwara.⁷ *Id.* at 40–41. After the applicant amended the claims, the Examiner issued a second and final office action rejecting the claims under § 103 over Kostka in view of

⁵ We need not reach the merits of Petitioner’s second ground of unpatentability based upon the combination of Roeding and Poole to decide whether to institute *inter partes* review because our analysis of the first ground suffices for rendering that decision.

⁶ U.S. Pat. Pub. No. 2015/0079942 A1 (Ex. 2001, “Kostka”).

⁷ U.S. Pat. No. 6,123,259 (Ex. 2003, “Ogasawara”).

Ogasawara in further view of Dickson.⁸ *Id.* at 41. After an interview with the Examiner, the claims were allowed. *Id.*

Patent Owner next contends that Poole “is cumulative of at least the Kostka publication (Ex. 2001) applied during prosecution.” *Id.* at 42. According to Patent Owner, “[b]oth references are directed to systems for identifying available location-based services and both include using a mobile application to assist the customer while shopping” and each “disclose[] location-specific computing devices at a plurality of locations in the facility, such that when the user is in the facility information on products near the user can be transmitted to the user’s mobile device.” *Id.*; *see also id.* at 42–44 (summarizing disclosure of Poole and Kostka (citing Ex. 1006 ¶¶ 6, 27, 33, 34, 80; Ex. 2001 ¶¶ 9, 11, 12, 24, 26, 28, 31)). According to Patent Owner, “Poole’s disclosure is cumulative to that of Kostka—*i.e.*, the primary reference considered during prosecution, which applicant’s claim amendments overcame.” *Id.* at 44 (citing Ex. 1002, 23–24).

Patent Owner next contends that Hammad “is cumulative of . . . the Ogasawara reference (Ex. 2003) applied during prosecution.” Prelim. Resp. 47. Patent Owner contends that “Ogasawara was used for the machine readable element and related limitations.” *Id.* (citing Ex. 1002, 89–91, 198). According to Patent Owner, “Petitioner used Hammad for the machine-readable element limitations in the Petition as well.” *Id.*

Patent Owner next contends that “Petitioner never even attempts to show how the Examiner erred in allowing the claims over the same or

⁸ U.S. Pat. Pub. No. 2002/0138345 A1 (Ex. 2002, “Dickson”).

substantially the same art and arguments that the Petition presents.” *Id.* at 49.

1. Legal Framework

The statute provides that “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). Our Consolidated Trial Practice Guide (“CTPG”) indicates that the decision whether to deny institution on this basis “is a fact-dependent decision, in which the Board balances the petitioner’s desire to be heard against the interest of the patent owner in avoiding duplicative challenges to its patent.” Patent Trial and Appeal Board Consolidated Trial Practice Guide, 62 (Nov. 2019).⁹

We use a two-part framework to analyze a request to exercise discretion to deny institution under § 325(d). First, we determine “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). Second, “if either condition of the first part of the framework is satisfied,” then we consider “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of the challenged claims.” *Id.* In applying this framework, we refer to the non-exclusive factors delineated in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (PTAB Dec. 15, 2017)

⁹ Available at <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf>.

(precedential as to § III.C.5, first para.). These factors are: a) the similarities and material differences between the asserted art and the prior art involved during examination; b) the cumulative nature of 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 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 f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments. *Id.* at 17–18.

These factors “should be read broadly . . . to apply to any situation in which a petition relies on the same or substantially the same art or arguments previously presented to the Office during a proceeding pertaining to the challenged patent.” *Advanced Bionics*, Paper 6 at 10. If, after review of factors (a), (b), and (d), we determine the same or substantially the same art or arguments previously were presented to the Office, then factors (c), (e), and (f) relate to whether the petitioner demonstrates that the Office erred in a manner material to patentability of the challenged claims. *Id.*

2. Analysis

In response to the rejection over Kostka, Ogasawara, and Dickson, the applicant added several limitations to claim 1, including “wherein the one or more previously ordered services are pending services that are not yet complete due to the services requiring an interaction of the user with a physical facility.” Ex. 1002, 50; *see also* Ex. 1001, 9:53–56. In arguing for the patentability of claim 1 over Kostka, the applicant specifically argued

that “Kostka does not disclose, teach, or suggest” this limitation. Ex. 1002, 50.

Petitioner relies on Poole for disclosing this limitation. Pet. 12. In particular, Petitioner contends “Poole discloses that the database 314 . . . stores a list of merchandise items for purchase, where the list of merchandise items 104 for purchase is ‘a wish list, or a list of merchandise items 104 for future purchase’ and “[t]he list of merchandise items 104 may include a piece of clothing that user wants to try on within a facility before purchasing.” *Id.* (citing Ex. 1003 ¶¶ 107–110; Ex. 1006 ¶¶ 44, 80, 88).¹⁰ Thus, Petitioner relies on Poole for the precise limitation of claim 1 that the applicant convinced the Examiner was not disclosed by Kostka. Ex. 1002, 50. Consequently, we find that Poole is not substantially the same as Kostka. Further, Patent Owner does not direct us to any rejection in the prosecution history where the Examiner determined that this limitation was disclosed in any prior art reference and our review of the prosecution history reveals none.

Petitioner relies on Hammad for the machine-readable element. Pet. 14. Petitioner also relies on Hammad for disclosure of other limitations in claim 1. *Id.* at 18, 19. The Examiner, however, relied on Ogasawara for only the machine-readable element. Ex. 1002, 89–90. Because Petitioner relies on Hammad for more than the machine-readable element, we find that Hammad is not cumulative of Ogasawara for the purposes of our analysis of whether to discretionarily deny the Petition under § 325(d).

¹⁰ As discussed above in our analysis of claim 1, Patent Owner does not dispute Petitioner’s contention that Poole discloses this limitation. *See* Prelim. Resp. 12–25.

Because Petitioner does not rely on the same or substantially the same art or arguments previously presented to the Office, we find that the first prong of the *Advanced Bionics* framework is not satisfied and we need not address the second prong of the framework.

For the foregoing reasons, we do not exercise our discretion to deny institution under 35 U.S.C. § 325(d).

III. CONCLUSION

For the reasons expressed above, we determine that Petitioner has demonstrated a reasonable likelihood of showing that claim 1 of the '187 patent is unpatentable as obvious. In accordance with the Court's decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018) and 37 C.F.R. § 42.108(a), we institute an *inter partes* review of all challenged claims of the '187 patent on all grounds alleged by Petitioner.

Patent Owner does not currently proffer any separate argument for the continued patentability of any dependent claim. *See generally* Preliminary Resp. Nevertheless, this Decision does not reflect a final determination on the patentability of any claim. We further note that the burden remains on Petitioner to prove unpatentability of each challenged claim. *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

IV. ORDER

For the reasons given, it is:

ORDERED that *inter partes* review of claims 1–21 of U.S. Patent No. 10,368,187 B2 is *instituted* with respect to all grounds of unpatentability set forth in the Petition; and

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FURTHER ORDERED that pursuant to 35 U.S.C. § 314(a), *inter partes* review of U.S. Patent No. 10,368,187 B2 is instituted commencing on the entry date of this Order, and pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is given of the institution of a trial.

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