

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.

IPR2023-00865
U.S. Patent No. 11,238,465

**PETITIONER'S AUTHORIZED REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

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PETITIONER'S EXHIBIT LIST

Ex.1001	U.S. Patent No. 11,238,465
Ex.1002	Prosecution History of U.S. Patent No. 11,238,465
Ex.1003	Declaration of Dr. Henry Houh under 37 C.F.R. § 1.68
Ex.1004	<i>Curriculum Vitae</i> of Dr. Henry Houh
Ex.1005	U.S. Patent Application Publication No. 2016/0148302 to Carr et al.
Ex.1006	U.S. Patent No. 10,592,962 to Lauka et al.
Ex.1007	U.S. Patent Application Publication No. 2021/0182930 to Yee et al.
Ex.1008	U.S. Patent Application Publication No. 2013/0085807 to Deborah Anne Cincotta
Ex.1009	U.S. Patent Application Publication No. 2014/0149160 to Argue et al.
Ex.1010	U.S. Patent No. 10,510,084 to Dearing et al.
Ex.1011	U.S. Patent Application No. 13/270,848 (as filed)
Ex.1012	Redline Comparison of '133 Application and '848 Application
Ex.1013	Order, 1:21-cv-01147, Dkt. 201 (D.Del) (1.18.2023)
Ex.1014	Memorandum Opinion, 1:21-cv-01147, Dkt. 200
Ex.1015	"Research and Application of the EAN-13 Barcode Recognition on Iphone," Li et al., 2010 International Conference on Future Information Technology and Management Engineering, IEEE 2010
Ex.1016	"Shop Social: The Adventures of a Barcode Scanning Application in the Wild," Engelsma et al., Fourth International Conference on Mobile Computing, Applications and Services, Institute for Computer Sciences, Social Informatics and Telecommunications Engineering 2013

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Ex.1017	Oxford English Dictionary (excerpts)
Ex.1018	U.S. Patent Application Publication No. 2003/0006974 to Clough et al.
Ex.1019	U.S. Patent Application Publication No. 2002/0027164 to Mault et al.
Ex.1020	U.S. Patent 7,734,729 to Du et al.
Ex.1021	"Spotlight: The Rise of the Smart Phone," Zheng et al., IEEE Distributed Systems Online March 2006, IEEE 2006
Ex.1022	May 24, 2019 Wayback Machine capture of Barcodelookup.com (https://web.archive.org/web/20190524041844/https://www.barcodelookup.com/)
Ex.1023	U.S. Patent 7,156,311 to Attia et al.
Ex.1024	U.S. Patent 7,233,914 to Wijaya et al.
Ex.1025	U.S. Patent 10,628,835 to Barron et al.
Ex.1026	"Review Spotlight: A User Interface for Summarizing User-generated Reviews Using Adjective-Noun Word Pairs," Yatani et al., CHI 2011, May 7–12, 2011, Association of Computer Machinery
Ex.1027	"'Popularity Effect' in User-Generated Content: Evidence from Online Product Reviews," Goes et al., Information Systems Research 25(2):222-238 (2014)
Ex.1028	Microsoft Computer Dictionary (excerpts)
Ex.1029	E-mail from trials@uspto.gov authorizing Preliminary Reply and Sur-Reply
Ex.1030	Prosecution History of U.S. Patent Application No. 17/585,779 (retrieved September 14, 2023 from Patent Center)
Ex.1031	Merriam-Webster Dictionary (excerpts) ("acquire")

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Ex.1032	U.S. Provisional Application No. 61/237,128
Ex.1033	Redline Comparison of U.S. Provisional Application No. 61/237,128 and U.S. Patent Application No. 12/711,867
Ex.1034	Collins English Dictionary (excerpts)
Ex.1035	16 USC § 620
Ex.1036	Merriam-Webster Dictionary (excerpts) (“otherwise”)

Petitioner Maplegear Inc. d/b/a Instacart submits this Reply to Patent Owner Consumeron's Preliminary Response filed August 24, 2023 ("POPR," Paper 6) on the three topics authorized by the Board. *See* Ex.1029. Consumeron's Preliminary Response arguments are incorrect, and the Board should institute trial.

I. PRIORITY DATE DETERMINATIONS ARE PERMISSIBLE IN IPR

The POPR alleges "Petitioner's back-door effort to challenge validity under Section 112 violates 35 U.S.C. § 311(b)." POPR, 24. This argument is foreclosed by precedent holding the opposite.

In *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365 (Fed. Cir. 2023), the Federal Circuit addressed this specific issue. The patent owner before the Board attempted to establish an earlier priority date for its challenged claims; the Board disagreed with the patent owner's effort after evaluating the claims and finding the claims to lack sufficient written description support in the priority applications. *Id.* at 1369-70. On appeal, the patent owner alleged "the Board's determinations regarding the written description requirement of 35 U.S.C. § 112 exceeded its statutory authority under 35 U.S.C. § 311(b)." *Id.* at 1373. The Court found this argument to be "**without merit**" because § 311(b) "merely dictates the grounds on which an IPR petition may be based, not the issues that the Board may consider to resolve those grounds." *Id.* (emphasis added), *quoting Arthrex Inc. v. Smith & Nephew, Inc.*, 35 F.4th 1328, 1344-45 (Fed. Cir. 2022). The Court further wrote

that the petitioner “complied with § 311(b) by asserting invalidity grounds under § 103.” *Parus*, 70 F.4th at 1373.

The same applies here. Petitioner complied with the statute by raising unpatentability grounds under § 103. *See* Petition, 29 (listing § 103 grounds). Consumeron asserts that Petitioner's references are not prior art based on an alleged entitlement to an earlier priority date. *See* POPR, 7-20. To resolve the dispute, the Board can institute trial and “determine whether the challenged claims satisf[y] the written description requirement” (*Parus*, 70 F.4th at 1373) as part of the unpatentability determination without exceeding its statutory authority. Consumeron's argument to the contrary is without merit.

II. EVENTS IN RELATED PROSECUTION SUPPORT PETITIONER'S PRIORITY ARGUMENT

As the Petition noted, “the '465 patent is related to the following pending application: U.S. 17/585,779.” Petition, 74. The '465 patent and '779 application recite similar claim limitations. For example, the '465 patent recites “*upon failing to locate an identified product of the set of one or more goods*” (Ex.1001, 11:20-21) and the '779 application similarly recites “*upon failing to locate the at least one item*” (Ex.1030, p. 22). The '465 patent also recites “*at least one image of the replacement product*” (Ex.1001, 11:28-29) and the '779 patent similarly recites “*an image of the replacement product*” (Ex.1030, p. 22).

The Petition argued that these limitations are not found in the '465 patent's priority applications, including the '848 application. *See* Petition, 22 (“*failing to locate an identified product*”); 23 (“*replacement product*”). The examiner of the '779 application appears to agree, as the examiner found that the prior applications, including the '848 application, “fail to provide support for” the similar limitations in the '779 application.¹ Ex.1030, p. 235.

The fact that another branch of the Office found substantially similar claims to not have support in the priority applications confirms “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition” meriting institution. 35 U.S.C. § 314(a).

III. CLAIM CONSTRUCTION

A. An “*acquisition request*” is a request to acquire, not “shop”

Consumeron contends that the proper construction of “*acquisition request*” is “a request for an agent to shop for goods on a customer’s behalf.” POPR, p. 30. Neither the intrinsic nor extrinsic evidence, however, requires the agent to “shop”

¹ The examiner did not indicate consideration of the Petition in the Notice of References Cited. *See* Ex.1030, p. 278. Also, notably, the examiner applied the Petition’s Carr reference to reject some of the '779 application’s claims. *See id.*, 255.

or even make a purchase—the agent must simply acquire goods, consistent with the plain language of the claim. It would be improper to narrowly require shopping when Consumeron elected to broadly claim *all* types of “*acquisition request[s]*.”

Contrary to Consumeron's position, the specification does not equate an “acquisition request” with a “shopping request.” POPR, pp. 30-32. Instead, the specification's repeated use of the phrasing “purchase *or otherwise* acquire” and “shopping *or* acquisition request” confirms that an acquisition can be performed by means other than purchase or shopping. *See* Ex.1036 (Merriam-Webster Dictionary) (defining “otherwise” as “in a different way or manner”).

Preferably, the user specifies the exact location from which the selected delivery agent is to *purchase or otherwise acquire* the product, such as a retail store location.

Ex.1001, 5:34–36.

If the product is approved at 120, the delivery agent will *purchase or otherwise acquire* the product on behalf of the customer at 121 and deliver the product based on the delivery options specified in the customer's profile, or amended delivery instructions provided by the customer at the beginning of a particular shopping request or at some time during a particular shopping request.

Id. at 7:65–8:4.

Once registered, the user provides the service provider with information regarding the type of product desired and the shopping or acquisition location from which the user desires to ***purchase or otherwise obtain*** the product.

Id. at 2:32–36. The specification is thus explicit that a delivery agent can fulfill an acquisition request **without** the agent shopping or purchasing. For example, the description of Fig. 3, which illustrates the main process flow of the “acquisition services” provided to the customer, explains that a customer may “pre-purchase[]” a good that the agent acquires by “pick-up.” Ex.1001, 7:6-7, 7:32-40.

Alternatively, the customer has the option of **paying the retailer or seller directly**, in which case the customer will only be billed for the **pick-up** and delivery services provided. ... If pre-purchased by the customer, the delivery agent obtains a receipt showing proof of **pre-payment** by the customer.

Ex.1001, 8:25–33. Similarly, the specification explains that an agent can fulfill a “request for purchase ***or*** acquisition” when visiting a “shopping location”:

A mobile delivery agent in close proximity to the shopping location will receive the request for purchase **or acquisition** from the system, and the delivery agent will proceed to the shopping location.

Ex.1001, 2:36–41. That is, an agent need not make a “purchase” even when traveling to a “shopping location.”

Consumeron understood the distinction between acquisition and shopping when it filed the first non-provisional application in the family leading to the '465 patent (US 12/711,867). Specifically, the non-provisional application was modified relative to the precursor provisional application (US Prov. 61/237,128) to broaden its scope beyond “shopping.” For example, Consumeron replaced:

- in the title: “REMOTE **SHOPPING**” with “REMOTE **ACQUISITION**”;
- in the abstract: “to remotely **shop** for a product(s)” with “to remotely **acquire** a product”; and
- in the specification: “purchase” with “purchase **or otherwise acquire**”.

See Ex.1032; Ex.1033 (comparison of US Prov. 61/237,128 and US 12/711,867).

Faced with invalidating art, Consumeron cannot now retreat from its own effort to broaden the scope of the '465 patent beyond shopping.

The extrinsic evidence is consistent with the above intrinsic evidence and confirms that an acquisition does not require a purchase or transaction. A sampling of dictionaries, including the Collins English Dictionary relied upon by Consumeron, defines “acquire” as simply coming into possession or obtaining something without requiring purchase. *See, e.g.*, Ex.1034 (Collins English Dictionary) (“If you acquire something, you buy or obtain it for yourself, or someone gives it to you.”); Ex.1031 (Merriam-Webster Dictionary) (defining

“acquire” as “to come into possession or control of [something] often by unspecified means”).

Consumeron's alternative reliance on federal statutes related to “forest resources or products in short supply in the western United States” is not useful. *See* Preliminary Response, p. 30 (citing Ex.2004); Ex.1035 (excerpt from 16 U.S.C. § 620). Legal statutes related to **forestry** are not pertinent to understand the meaning of “*acquisition request*” in the claims of the '465 patent.

The Board should adopt the plain and ordinary meaning of “*acquisition request*” consistent with the specification: “a request to acquire.” Not only is Consumeron's construction overly narrow, but, if adopted, would inject unnecessary uncertainty into the proceeding as the specification does not explain what it means for a delivery agent to “shop.” *See e.g.*, Ex.1001, 1:29 (stating instead that “the present invention pertains to **customer shopping**”). The Preliminary Response similarly does not explain what actions by the agent would constitute shopping.

When “*acquisition request*” is properly construed, the prior art renders obvious the challenged claims, as the Petition illustrates.

IV. CONCLUSION

For the foregoing reasons, Petitioner requests that the Board institute trial.

Respectfully submitted,

Dated: September 15, 2023
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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. § 42.6(e),
service was made on Patent Owner as detailed below.

Date of service September 15, 2023

Manner of service Electronic Service by E-Mail

Documents served Petitioner's Authorized Reply to Patent Owner's
Preliminary Response
Exhibits 1029-1036

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