

Bajaj, Raghav

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, September 6, 2023 7:04 AM
To: Bajaj, Raghav; Trials
Cc: Jarratt, Scott; Oliver, Angela; Stephenson, Lyric; Hannah, James; Fuller, Jenna; Price, Jeffrey H.
Subject: RE: IPR2023-00865

EXTERNAL: Sent from outside Haynes and Boone, LLP

Counsel,

From the Board –

No conference call is needed. Petitioner is authorized to file a 7-page reply to the preliminary response, and Patent Owner may follow with a 7-page sur-reply, if it so desires. The reply must be filed by September 15, 2023, and the sur-reply by September 22, 2023. No further briefing will be authorized.

Regards,

Esther Goldschlager
Supervisory Paralegal Specialist
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Bajaj, Raghav <Raghav.Bajaj@haynesboone.com>
Sent: Tuesday, September 5, 2023 3:41 PM
To: Trials <Trials@USPTO.GOV>
Cc: Bajaj, Raghav <Raghav.Bajaj@haynesboone.com>; Jarratt, Scott <Scott.Jarratt@haynesboone.com>; Oliver, Angela <Angela.Oliver@haynesboone.com>; Stephenson, Lyric <Lyric.Stephenson@haynesboone.com>; Hannah, James <JHannah@KRAMERLEVIN.com>; Fuller, Jenna <JFuller@KRAMERLEVIN.com>; Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>
Subject: IPR2023-00865

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Dear Honorable Board:

Pursuant to 37 CFR 42.108(c), Petitioner Maplegear, Inc. d/b/a Instacart requests leave to file a Preliminary Reply to Patent Owner Consumeron's Preliminary Response in IPR2023-00865 to address three issues, each of which could not have been addressed in the Petition or reasonably anticipated at the filing of the Petition (on May 10, 2023).

First, Petitioner seeks to address Patent Owner's argument at pages 21-24 of the Preliminary Response, which alleges "Petitioner Improperly Challenges the Patentability of the '465 Patent Under 35 U.S.C. 112." After the Petition was filed, the Federal Circuit (on June 12, 2023) rendered a precedential decision in *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365 (Fed. Cir. 2023) which addresses this issue.

Second, Petitioner seeks to notify the Board of developments in the prosecution of a continuation application, US Application No. 17/585,779 (see Petition, p. 74, Related Matters). On August 16, 2023, the examiner found that the substantially similar claims of the '779 Application are not entitled to the filing date of the common priority application, US Patent Application No. 13/270,848.

Third, Petitioner seeks to address Patent Owner's claim construction arguments for the term "acquisition request" at pages 30-32 of the Preliminary Response. Petitioner could not have anticipated Patent Owner would base its construction on a portion of the US Code related to "timber," "forests," and "forest resources." See Preliminary Response, p. 30 (citing Ex.2004 (16 USC 620e)); 16 USC 620. Further, Petitioner could not have anticipated that Patent Owner would seek to construe this term as it did not offer a construction in the co-pending district court litigation involving claims with the same term.

Petitioner seeks seven pages for its authorized Preliminary Reply, and would consent to a Patent Owner Preliminary Sur-Reply of equal length.

Counsel for Petitioner has conferred with counsel for Patent Owner. Patent Owner states the following:

"Consumeron does not oppose additional a Reply and Sur-Reply on the first issue.

We oppose additional briefing on the second issue because a rejection in ongoing prosecution in another case has no bearing here, particularly because the Examiner has not evaluated the applicants counter arguments.

We also oppose briefing on the third issue. The claim construction issue raised in the the preliminary response was foreseeable, and Petitioner was obligated to address this key term in the petition rather than waiting for Patent Owner's preliminary response."

Counsel for the parties are available for a teleconference with the Board on September 7, 2023.

Respectfully submitted,

Raghav Bajaj
Lead Counsel for Petitioner

HAYNES BOONE

Raghav Bajaj

Partner
raghav.bajaj@haynesboone.com

Haynes and Boone, LLP

600 Congress Avenue
Suite 1300
Austin, TX 78701-3285

(t) [+1 512.867.8520](tel:+15128678520)
(f) [+1 512.867.8603](tel:+15128678603)
(m) [+1 202.683.7810](tel:+12026837810)

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