

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.

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

**PATENT OWNER'S SUR-REPLY
TO PETITIONER'S AUTHORIZED REPLY**

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I. THE CHALLENGED CLAIMS ENJOY PRIORITY TO AT LEAST ITS PARENT APPLICATION

The Board should deny institution because the '465 Patent's priority date is no later than October 11, 2011, which predates all of prior art raised in the Petition. The priority application, which shares a specification with the '465 Patent, explicitly discloses an agent who fails to locate a requested product and instead acquires a replacement product based upon feedback from the customer. *See* Paper 6 ("POPR") at 7-16; '465 Patent at 7:31-63. As such, there is no merit to Petitioner's argument that the claim limitations of "failing to locate" a "replacement product" lack written description support.

Petitioner's reliance on an Office Action in a different, pending application is a red herring. In that case, the Examiner issued an initial Office Action after the Petition was filed and merely repeated the same arguments of the Petitioner, even citing the same prior art that the Petitioner raised in the Petition that post-dates the priority date of Consumeron's application. Ex. 1030 at 235, 254-255. Furthermore, the record in that case is far from complete as Consumeron has not responded to the Office Action. Accordingly, the Examiner's Office Action that Petitioner raises in its Authorized Reply (Paper 7, ("Reply")) should be given no weight.

II. "ACQUISITION REQUEST"

There is no need to consider the proper construction of "acquisition request" because the claims are entitled to a priority date that predates all of the prior art.

Nevertheless, the claim language, specification, and extrinsic evidence confirm that the term “acquisition request” means “a request for an agent to shop for goods on a customer’s behalf.” POPR at 30-32. Although Petitioner attempts to poke holes in Consumeron’s argument, it has not articulated any alternative construction other than to say that an acquisition request means a “request to acquire.” Reply at 7. But because the parties’ dispute depends on the meaning of the word “acquire,” Petitioner continues to abrogate its duty under 37 C.F.R. § 42.104(b)(3)-(4) to explain how the claims are unpatentable *as properly construed*. The Board should, therefore, deny institution because Petitioner has not articulated any objective understanding of the term “acquisition request” that could possibly encompass an agent merely picking up already purchased goods.

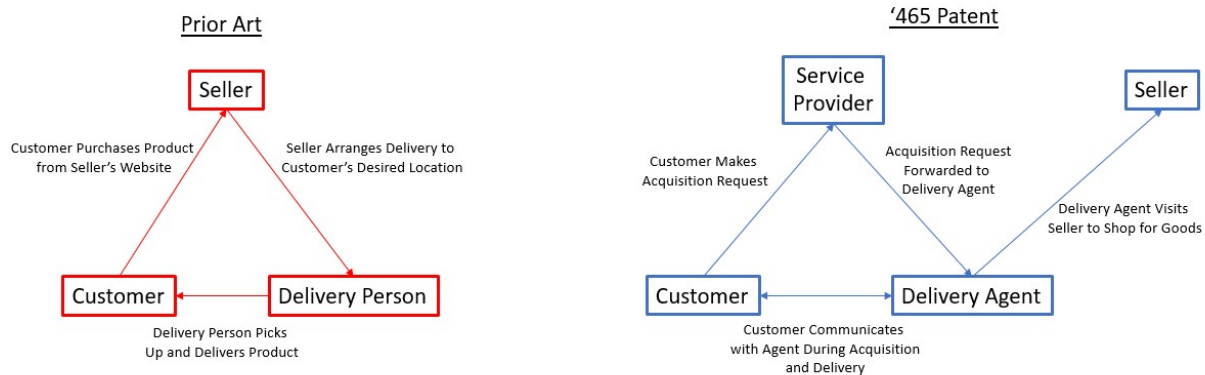
The Board should adopt Consumeron’s construction because it is consistent with the surrounding claim language while Petitioner’s is not. *ACTV, Inc. v. The Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) (claim language must be considered in “the context of the surrounding words”) (citations omitted). After receiving the acquisition request, the agent “electronically transmit[s] information on a replacement product for the identified product . . . to the customer,” “send[s] the information for the customer to approve the purchase of the replacement product,” and “upon receiving approval of the purchase from the customer, acquire[s] the replacement product.” ’465 Patent at Claim 1, 14. Obtaining and

transmitting images to the customer, finding replacement products, and purchasing goods are all acts that take plainly take place while shopping for goods and which would not take place if the customer ordered the goods via the seller's website.

The specification reinforces this interpretation because it explicitly points out the problems with, and distinguishes, the type of online order that Petitioner seeks to find within the scope of the claims. *Chicago Bd. Options Exch., Inc. v. Int'l Sec. Exch., LLC, LLC*, 677 F.3d 1361 at 1372 (Fed. Cir. 2012) (repeatedly noting the "inadequacies" and "deficiencies" of a traditional methodology is not within claim scope). As the inventors explained, the traditional Internet shopping model often left customers unsatisfied because they (1) had little to no control over where the goods would be shipped from, (2) could not evaluate the actual product before purchasing it, and (3) would often receive the wrong item. *See* '465 Patent at 1:39-59.

The claimed invention remedies these deficiencies in the "standard method by which customers purchase goods remotely for delivery to a location of the customer's choice" with its "method for remote acquisition and delivery of goods." *Compare* '465 Patent at 1:35-1:39 *with id.* at 2:17-18. Rather than ordering products directly from an online retailer, the customer sends an acquisition request to a service provider. *Id.* at 2:30-36. That acquisition request includes the type of product the customer desires and may also include the particular "acquisition location from which the user desires to purchase or otherwise obtain the product." *Id.* The

acquisition request is passed onto an agent, who visits the shopping location and shops for the product while also interacting with the customer. *Id.* at 2:37-54. Once a purchase or acquisition is approved, the agent acquires the product and delivers it to the customer. *Id.* at 2:54-57. The differences between these two methods are illustrated in the following schematic diagrams:



Notably absent from the diagram representing the '465 Patent's acquisition request methodology is any interaction between the customer and the seller, such as the type of traditional online order that Petitioner asserts is within the scope of the claims. Because the '465 Patent explicitly distinguishes this traditional shopping model, it would be unreasonable to construe the claims to encompass it. *SciMed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001).

The specification provides further support for Consumeron's construction because it uses the word "or" to signal that "shopping" and "acquisition" are synonyms. '465 Patent at 5:63-66; *Epic Games, Inc. v. Ingeniosh, LLC*, IPR2022-00202, Paper 29 at 18-19 (P.T.A.B. May 19, 2023) (finding that the specification's

phrase “portal or gateway” uses the word “or” to refer to things that are synonymous to each other). For instance, Figure 3 illustrates how an agent receives a “shopping or acquisition request” (step 110). After receiving this request, the agent identifies a product for inspection (step 117) (*i.e.* shops for the product). The customer approves the purchase of the product (step 120), and the agent purchases the product (step 121). ’465 Patent at Fig. 3, 5:63-66, 7:31:8-4 (disclosing that approving the “acquisition of the inspected product” is synonymous with the “customer approves purchase”); *see also* POPR at 30-31 (confirming that an acquisition request triggers an agent to shop to identify goods for customer inspection and approval).

Contrary to Petitioner’s assertion (Reply at 5-6), the ’465 Patent’s “pre-purchase” embodiment does not change the meaning of the term “acquisition request” because it is disclosed as an alternative. *TIP Sys., LLC v. Phillips & Brooks/Gladwin, Inc.*, 529 F.3d 1364, 1373 (Fed. Cir. 2008) (declining to “construe the claim term to encompass the alternative”). Indeed, the specification is explicit that this alternative embodiment does not involve fulfilling an acquisition request because the customer is not billed for the costs associated with acquiring the product. ’465 Patent at 8:25-32 (“***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.”) (emphasis added). The pre-purchase embodiment is also inconsistent with the claim language, which requires a

“customer to approve the purchase” and *“upon receiving approval of the purchase”* the agent “acquir[es]” the goods. *Id.* at Claims 1, 14.

Finally, Exhibit 2004 sheds light on the ordinary meaning of “acquisition request,” as used within the context of the ’465 Patent. Ex. 2004 (defining “acquire” as “to come into possession of, whether directly or indirectly, through sale, trade, exchange or other transaction”). And while Petitioner complains that this definition is “unhelpful” because it is found in a portion of the U.S. Code relating to “forest resources,” it does not address Consumeron’s arguments about its relevance.¹ Reply at 7. This definition is helpful because it clarifies that acquiring goods requires a transaction that transfers possession from one entity to another and sheds light on what the specification means when it refers to “purchas[ing] or otherwise acquir[ing] the product.” ’465 Patent at 7:65-8:4.

The general-purpose definitions that Petitioner cites in its Reply cannot change the meaning provided in the intrinsic record, and support Consumeron’s proposed construction. Reply at 6-7 (citing Exs. 1031, 1034). Each of these definitions is consistent with an agent shopping for goods because shopping is how

¹ Petitioner does not claim that the term “acquire” requires consultation of a technical dictionary such that this definition *a priori* irrelevant. Indeed, Petitioner’s definitions are taken from general-purpose dictionaries.

one “buy[s] or obtains[s]” or “come[s] into possession or control of” goods. Exs. 1034, 1031.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY PRIORITY DATE CHALLENGES BASED ON A COMMON SPECIFICATION

In *Parus Holdings Inc. v. Google LLC*, the Federal Circuit held that the Board is not precluded from considering issues necessary to resolve petition grounds. 70 F.4th 1365, 1373 (Fed. Cir. 2023). However, the *Parus* Court did not apply the burden-shifting framework articulated in *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, as it pertains to continuation applications. 800 F.3d 1375, 1380 (Fed. Cir. 2015). Unlike priority claims in a CIP or to a provisional, which Examiners do not generally review, priority claims in a continuation only depend on compliance with the written description requirement, which is reviewed. *Id.* Thus, the '465 Patent enjoys a presumption of priority to the parent application, and Petitioner's cited references are, facially, not prior art. In order to overcome this presumption, **Petitioner** was required to raise a prohibited written description ground in the first instance, which is very different from circumstances where a **Patent Owner** attempts to **antedate** a reference that facially qualifies as prior art. At the very least, the Board should discretionarily deny attempts to manufacture obviousness grounds with references that facially do not qualify as prior art because AIA prohibits the predicate ground.

Patent Owner's Sur-Reply
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CERTIFICATE OF SERVICE

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

<i>Date of service</i>	September 22, 2023
<i>Manner of service</i>	Electronic Mail (raghav.bajaj.ipr@haynesboone.com; scott.jarratt.ipr@haynesboone.com; angela.oliver.ipr@haynesboone.com; lyric.stephenson.ipr@haynesboone.com)
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