

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 RESPONSE

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Exhibit	Description
2001	Screenshots from “Webvan Distribution Center” video obtained at https://www.youtube.com/watch?v=os66TTScS1o
2002	Walmart Online Order, https://www.walmart.com/cp/3893115
2003	Prosecution History of U.S. Patent No. 10,628,835
2004	LII/Legal Information Institute Definition of “Acquire”
2005	Collins English Dictionary Definition of “Transaction”
2006	Cambridge English Dictionary Definition of “Transaction”
2007	Substitution for Store Pickup and Delivery Items – Walmart.com
2008	Declaration of Dr. Michael Mitzenmacher
2009	Title of Article
2010	Carlton H. Scott, “ <i>Efficient Allocation of Online Grocery Orders</i> ”, , Int. J. Productivity and Quality Management, Vol. 1, Nos. 1/2 (2006)
2011	Deposition Transcript of Henry Houh, Ph.D., dated February 13, 2024
2012	Applicant's Remarks/Arguments, dated December 14, 2023
2013	Jonathan J. Hull, “ <i>Mobile Image Recognition: Architectures and Tradeoffs</i> ” Ricoh Innovations, Inc.
2014	Hend S. Al-Khalifa, “ <i>An M-Learning System Based on Mobile Phones and Quick Response Codes</i> ”, Journal of Computer Science 7 (3), 427-430 (2011)
2015	Lauren Elizabeth Stewart, B.S. Adv, “ <i>QR Codes: Creative Mobile Media Approaches</i> ” The University of Texas at Austin (May 2010)
2016	Hairong Li, <i>QR Code Mobile Promotion: An Initial Inquiry</i> , ResearchGate (April 5, 2021), https://www.researchgate.net/publication/279387105

Patent Owner's Response
IPR2023-00865 (U.S. Patent No. 11,238,465)

2017	Deposition Transcript of Henry Houh, Ph.D., dated October 20, 2023
2018	Hannu Yrjola and Kari Tanskanen, <u>Grocery E-Commerce Consumer Behavior and Business Strategies</u> 160-163 (2005)

I. INTRODUCTION

The Challenged Claims¹ are patentable because Carr (Ex. 1005) and Lauka (Ex. 1006) are not prior art. The Challenged Claims enjoy priority to at least the filing date of its parent application, U.S. Patent Appl. No. 13/270,848 (Ex. 1011, the “’848 Application”), filed on October 11, 2011.

The Board should find that the Challenged Claims enjoy written description support because the ’848 Application conveys to a skilled artisan that the inventors had possession of the “failing to locate a product” and “determining that a product is unavailable.” The parties and basic common experience confirm that customers routinely go shopping and fail to locate the product they set out to purchase. This problem is one of the few, immediately recognizable reasons that people who shop online often receive the wrong or otherwise unsatisfactory products, which is the problem the inventors set out to solve. And because the specification is written for those of skill in the art, the POSITA evaluates the teachings of the ’465 Patent with a full understanding that agents will often fail to locate products identified in a customer’s acquisition request.

¹ Maplebear Inc. d/b/a Instacart (“Petitioner”) petitioned for *inter partes* review (IPR) of U.S. Patent No. 11,238,465 (Ex. 1001, the “’465 Patent”), challenging claims 1-19 (“the Challenged Claims”).

Taking a blinkered view of the teachings of the specification and common human experience, Petitioner suggests that the inventors meant to limit their solution to the wrong/unsatisfactory product problem to circumstances where an agent always finds the exact product identified in the customer's acquisition request. *See* Paper 2 ("Pet.") at 16-22. Not only does that argument not make sense in the context of the problem the inventors set out to solve, but it relies on a long rejected test for written description that searches narrowly for express or inherent disclosure of the limitation. That is not the law, and there is no dispute that customers routinely go shopping and fail to locate the product they set out to find.

Petitioner's written description challenge for "determining the information from the bar or QR code" limitation is likewise unavailing. The '848 Application discloses scanning a bar code or QR code to obtain product data, including images of the product, and sending that product data to the customer so that they can make an informed shopping decision. Petitioner's suggestion that the product data obtained by scanning these codes does not include images of the product directly contradicts the specification.

The Challenged Claims are also patentable over the asserted references because Carr does not teach or suggest the "acquisition request" and "acquiring" limitations. The Challenged Claims, the specification, and both parties' experts agree that "acquiring" goods requires a transaction. Applying this common

understanding of the Challenged Claims, the claims are patentable because Carr's assembler, the alleged agent, does not participate in the transaction necessary to acquire the goods. Instead, Carr discloses the traditional Internet shopping model, in which the customer places an order and pays the seller for the goods via a seller's website. Thus, rather than acquiring goods while fulfilling an "acquisition request," which is a request for an agent to shop for goods on behalf of the customer, the order assembler merely collects the order items and places them in bins without engaging in the transaction necessary to acquire the goods.

The Challenged Claims are patentable over the asserted references for at least these reasons and the additional reasons explained below.

II. OVERVIEW OF THE '465 PATENT

The traditional Internet shopping model involves a customer visiting a merchant's website, adding goods to a shopping cart, and purchasing the goods via the website's checkout page. The merchant processes the payment, fulfills the order, and delivers the goods to the customer using its own employees or by contracting with a delivery service like UPS® or FedEx®. '465 Patent at 1:35-42; Ex. 2008 ("Mitzenmacher Decl."), ¶ 24.

The inventors of the '465 Patent identified several key problems with this traditional Internet shopping model. For one, customers were wary of online shopping because goods advertised on a merchant's website often did not accurately

depict the goods eventually delivered to the customer. '465 Patent at 1:50-59. Errand runners who “purchase[d] the wrong product” also created dissatisfied customers who “lost significant time in acquiring the desired product.” *Id.* at 1:60-2:3. The various reasons for the delivery of the wrong product were common knowledge at the time of the invention to skilled artisans and laypersons alike. Mitzenmacher Decl., ¶ 25 (citing Exs. 2009 at 325 and 2010 at 91 (order pickers/assemblers identifying substitute items that are unsatisfactory)). Sometimes the employees responsible for fulfilling a traditional online order, “order pickers,” made mistakes. Sometimes the merchant failed to update the photo on the website to reflect the currently available inventory. Sometimes merchants scammed customers. Sometimes the desired product was out of stock. Mitzenmacher Decl., ¶ 25 (citing Ex. 2018 at 162).

In response to these problems, the inventors developed a Mobile Delivery Agent System (“MDAS”) that, in certain embodiments, enables a customer to give real-time feedback to an agent while the agent shops on the customer's behalf. '465 Patent at 2:7-11; Mitzenmacher Decl., ¶ 26. When a customer wishes to make a remote acquisition, they initiate an “acquisition request” identifying one or more items. '465 Patent at 5:63-66. That acquisition request is transmitted to a server and then forwarded to an agent, who visits a shopping location and shops for one or more items. *Id.* at 5:67-6:12. While the agent is shopping for the goods, the customer, in

these particular scenarios, can inspect the goods and give the agent “real-time” feedback. *Id.* at 7:31-8:4. Accordingly, if the agent picked the wrong item off of the shelf—a common occurrence in the context of “assemblers” or “order pickers,” who fulfilled traditional online orders—the customer could tell the agent, in real-time, to shop for a different item. *Id.*; Mitzenmacher Decl., ¶ 26.

Accordingly, as described with respect to Figure 3, the server sends a customer-initiated “acquisition request” to an agent. ’465 Patent at 5:63-8:17, FIG.3. The agent travels to the store location (step 113), locates a product, and sends an image of the product to the customer for real-time inspection (steps 116-117). If the customer approves the inspected product, the agent purchases the product at (step 120). *Id.* at 7:13-8:4, Fig. 3. If the inspected product is not satisfactory for any reason, the customer can reject the product and request additional shopping at the current shopping location or elsewhere (steps 117-119). *Id.* at 7:33-63 (describing scenarios where the customer rejects the identified product and requests additional shopping for a substitute product). Mitzenmacher Decl., ¶ 27.

While the agent is shopping, they provide the customer with information about substitute products, so that the customer is able to make an “informed” decision about the product the agent ultimately purchases on the customer’s behalf:

[T]here is seen to be a need in the art for a remote acquisition and delivery system which provides a customer with detailed information needed to make an informed purchase or acquisition.

'465 Patent at 2:7-12 (emphasis added); *see also id.* at 7:31-35 (disclosing that the agent transmits real-time data to the customer for inspection and approval for purchase via the agent), 7:60-63 (disclosing that if additional shopping is requested “the shopping agent will move to other similar products or may travel to another location in search of a satisfactory product”); Mitzenmacher Decl., ¶ 28.

During the acquisition process, the agent can scan a bar code or QR code to “identify[] and communicat[e] information about the product of concern” to the customer:

The customer is allowed to interact with the delivery agent to inspect the product remotely using the digital image capture device and the communication device. For instance, digital pictures or video can be taken and used to communicate the product to the customer. On the other hand, bar codes, QR (Quick Response) codes, image recognition or near field communication can be used in identifying and communicating information about the product of concern.

'465 Patent at 2:46-54; *see also id.* at 7:50-54 (“The product data can be collected by scanning a bar code associated with the product, or perhaps a QR code.”). The specification provides that “[i]nformation regarding the product” includes “pictures,

bar codes, QR codes, video, instructions, recipes, specifications, ingredients, where manufactures, etc.” *Id.* at 9:65-10:2; Mitzenmacher Decl., ¶ 29.

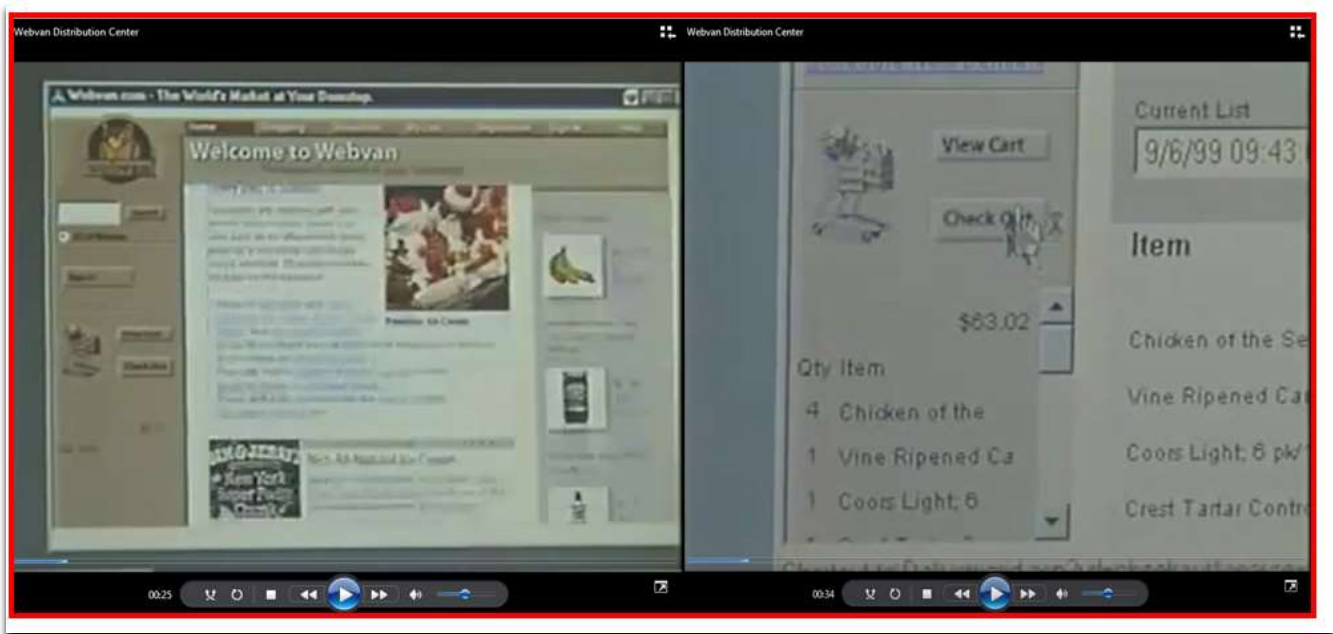
III. LEVEL OF ORDINARY SKILL IN THE ART

In IPR2022-01357 (the “1357 IPR”) challenging related U.S. Patent No 10,628,835 (the “835 Patent,” Ex. 1025), Consumeron proposed the following definition for a person of ordinary skill in the art (“POSITA” or “skilled artisan”) as of August 2009, as “someone with a background in electrical engineering, computer science or the like. However, industry experience can make up for a lack of technical training, and more education can make up for a lack of industry experience.” *Maplebear Inc. D/B/A Instacart v. Consumeron LLC*, IPR2022-01357, Paper 19 at 9 (P.T.A.B. May 26, 2023). Consumeron adopts this definition of a POSITA/skilled artisan. Mitzenmacher Decl., ¶¶ 19-23.

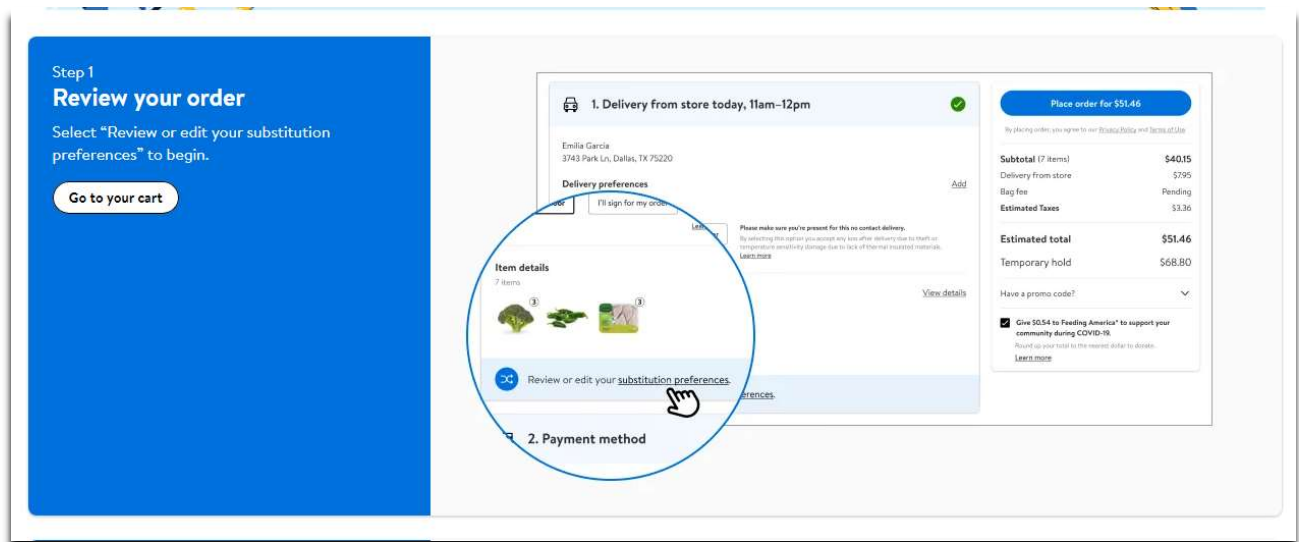
IV. OVERVIEW OF THE TECHNICAL FIELD AND ASSERTED REFERENCES

A. Traditional Internet Shopping

Before Consumeron’s invention, online shopping was limited to a basic process where customers could buy goods through a seller’s website, and then have them delivered. A company like Webvan, for example, would display still images of products on its website, and customers could place an order and pay for them using the ubiquitous checkout methodology:



Ex. 2001 at 0:25-0:34 (screenshots from “Webvan Distribution Center” video obtained at <https://www.youtube.com/watch?v=os66TTSs1o>). In fact, Walmart (which is the listed applicant of Carr (*see* Carr at Cover)) employs the same checkout methodology, as shown below:



Ex. 2002 at 1; *see also* Carr at ¶ 48 (disclosing that a customer places an order and

“purchase[s] the items in a virtual shopping environment”); *see also* § IV.B, *infra* (disclosing Carr’s traditional approach); Mitzenmacher Decl., ¶ 30.

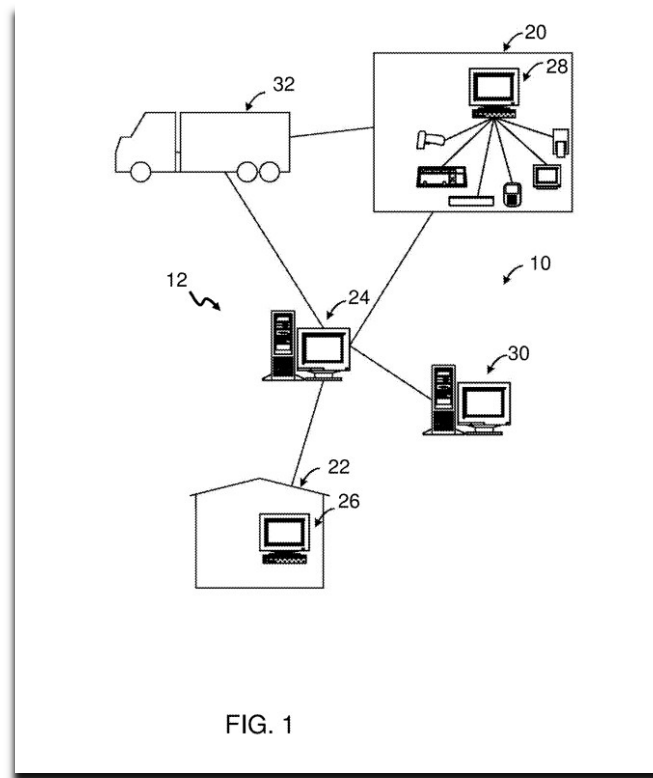
Under this traditional approach, a customer places an order via the seller’s website, and the seller’s web server processes the order and payment. In this manner, a customer shops for and purchases goods directly from a seller via the seller’s website with order assemblers simply collecting and placing in packages the purchased goods for delivery. Mitzenmacher Decl., ¶ 31.

B. Carr

Carr published from an application filed on November 20, 2014, roughly three years *after* the ’465 Patent’s effective filing date of at least October 11, 2011.² See Carr at Cover (22); Mitzenmacher Decl., ¶ 32.

Carr describes the traditional checkout shopping model as a customer places an order and “purchase[s] the items in a virtual shopping environment” with a fulfillment system that assembles the customer’s order. Carr at ¶ 48; *see also id.* at ¶ 91. Specifically, with reference to figure 1 (reproduced below), Carr discloses that a customer 26 visits a website (hosted on server 24) and places an order for goods:

² As established in § V.A, *infra*, Carr does not qualify as prior art.



Id. at Fig. 1; *see also id.* at ¶¶ 76, 83-85, 89, 91; Mitzenmacher Decl., ¶ 33. The customer order is sent to store 20/fulfillment center 12, where assemblers gather the purchased goods and place them in bins. Carr at ¶¶ 74, 87, 94.

Carr's virtual shopping environment refers to Walmart's ® website, which enables customers to shop for and purchase goods. Carr at (71) (listing the applicant as Wal-Mart Stores, Inc.), ¶ 51 (explaining that "[a] customer purchasing items from the store 20 for delivery . . . will typically view an internet webpage or access an application or app corresponding to the store . . . the customer may have an account with the store and may sign into the system"); Mitzenmacher Decl., ¶ 34.

If an ordered product is out of stock, the server informs the customer about possible substitute items and gives the opportunity to purchase one or more of them. Carr at ¶¶ 98, 101; *see* Ex. 2007 (“We’ll charge you the price of the substituted item(s). You will notice a temporary authorization hold. This is the amount we authorize to cover . . . replacements”). The assembler then receives notification of the substituted item after they have been purchased, retrieves the item, and places it in the bin. Carr at ¶ 110. Thus, just as with traditional shopping methodologies, the customer places an order and purchases the products (ordered or substituted) via a virtual shopping environment (like Walmart’s) with assemblers simply gathering and placing in bins the already purchased goods. *See* Carr at ¶¶ 47-48, 51; Mitzenmacher Decl., ¶ 34.

Unlike Carr’s virtual shopping environment, the MDAS, in certain embodiments, interacts with the customer to send product information for inspection of the goods and approval to purchase in response to receiving an acquisition request for an agent to shop for the goods and purchase them upon receiving approval. *See* ’465 Patent at Fig. 3; Mitzenmacher Decl., ¶ 35.

C. Lauka

Lauka issued from an application filed on June 24, 2016, close to five years *after* the '465 Patent's effective filing date of at least October 11, 2011.³ *See* Lauka at Cover (22). Petitioner relies on Lauka for its alleged disclosure of using an order picker's smartphone as an imaging device and/or bar code scanner. *See* Pet. at 31 (citing Lauka at 3:11-18, 3:29-4:19); Mitzenmacher Decl., ¶ 36.

V. THE CHALLENGED CLAIMS ARE PATENTABLE OVER THE CARR-LUAKA COMBINATIONS IN GROUNDS 1-5⁴

Petitioner's proposed grounds of unpatentability fail for at least two reasons. *First*, the primary references, Carr and Lauka, are not prior art to the '465 Patent. As discussed in detail below, the '465 Patent is entitled to a priority date of at least October 2011, the filing date of its parent, the '848 Application, which antedates the Carr and Lauka references by several years. Pet. at 29 (disclosing that Carr is a printed publication published May 26, 2016, while Lauka was filed June 24, 2016 and issued March 17, 2020). Contrary to Petitioner's allegations, the '848

³ As established in § V.A, *infra*, Lauka does not qualify as prior art.

⁴ Petitioner relies on Carr and Lauka as its primary references for all grounds, with grounds 2-5 challenging the dependent claims. *See* Pet. at 29. Accordingly, Consumeron's arguments apply equally to Grounds 1-5 of the Petition.

Application provides sufficient written description support for the Challenged Claims. Mitzenmacher Decl., ¶¶ 37-38.

Second, Carr does not teach the “acquisition request” and “acquiring” limitations when the appropriate construction of “acquisition request” is applied. *Id.* at ¶ 39.

A. Carr and Lauka Are Not Prior Art

Carr and Lauka are not prior art to the '465 Patent, which properly claims priority to, among other applications, the '848 Application, which was filed on October 11, 2011, well before the earliest effective filing dates of Carr and Lauka. *See* Pet. at 13; Carr at Cover (22); Lauka at Cover (22). Therefore, the '465 Patent is entitled to an effective filing date of at least October 11, 2011.

Under 35 U.S.C. §120, there are four requirements that an application must satisfy to obtain the benefit of an earlier filing date of a previously filed application: (1) the invention in the application must be disclosed in the original application pursuant to 35 U.S.C. §112; (2) the application must be filed while the previously filed application is still pending; (3) there must be a common inventor between both applications; and (4) there must be a specific reference to the earlier filed application. There is no dispute that the '465 Patent satisfies the second, third, and fourth requirements, and the '848 Application provides written description for the following claim limitations:

- **Limitation [1.3] / [14.3]:** “failing to locate an identified product of the set of one or more goods / “determining that the identified product is not available” (“failing to locate a product” and “determining that a product is unavailable” limitations)); and
- **Limitation [1.4] / [14.5-14.6]:** “determining the information from the bar or QR code, wherein the information includes at least one image of the replacement product” / “electronically transmitting information to the customer...including: obtaining a bar code [or] QR code of a replacement product for the identified product . . . sending to the customer the information determined from the bar code or QR code . . . wherein the information includes at least one image of the replacement product” (collectively, hereinafter “obtaining and sending to the customer the information determined from the bar code or QR code including at least one image of the replacement product” limitation).

'465 Patent at Claims 1 and 14; Mitzenmacher Decl., ¶ 40. Because the '465 Patent is entitled to the effective filing date of at least October 2011, Carr and Lauka are not prior art.

1. The '848 Application Provides Written Description Support For the “Failing to Locate a Product” and “Determining That a Product is Unavailable” Limitations

The '848 Application provides support for the “failing to locate a product” and “determining that a product is unavailable” limitations because it “reasonably conveys to those skilled in the art that the inventor had possession of the claimed

subject matter as of the filing date” based on an “objective inquiry into the four corners of the specification.” *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

The analysis underlying this test requires an examination of both the patent disclosure (*i.e.* the specification and figures) and the state of the knowledge in the art at the time of the invention. *See Capon v. Eshdar*, 418 F.3d 1349, 1357-58 (Fed. Cir. 2005) (“The ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge [in the art].”). This is because the disclosure is written for a skilled artisan “and such a person comes to the patent with knowledge of what has come before.” *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005) (“The patent specification is written for a person of skill in the art, and such a person comes to the patent with the knowledge of what has come before”).

The '848 Application identified and resolved the long-felt problem of online shoppers receiving the wrong or otherwise unsatisfactory products. *See* '848 Application at ¶¶ 5-6. A skilled artisan reading the application would have immediately recognized the various reasons that online merchants would deliver the wrong or unsatisfactory products. For example, products offered for sale on the website might be out of stock, the website might show stale images of last year's model, the website might be running a scam, or the order picker might have made a

mistake when assembling the order. Mitzenmacher Decl., ¶¶ 42-43 (citing Exs. 2009 and 2010 (describing out of stocks)). A skilled artisan recognizes that the '848 Application disclosed a solution to the wrong/unsatisfactory product problem in all of these scenarios. Mitzenmacher Decl., ¶ 43.

The Board should reject Petitioner's attempt to manufacture a written description issue on the basis that one embodiment described in the specification discloses that the agent actually finds and permits the customer to inspect the product identified in the acquisition request. *See* Pet. at 18-20 (citing '848 Application at Fig. 3); *see also id.* at 17-21. That myopic view of the disclosure ignores the very problem the inventors set out to solve and the undisputable fact that an agent will not always be able to locate the exact product identified in an acquisition request. Mitzenmacher Decl., ¶ 44. Petitioner's position is also contrary to the law, which does not require explicit or inherent disclosure of well-known concepts, which are ideally *not* disclosed in the specification.

a. The '848 Application Describes the “Failing to Locate a Product” And “Determining That a Product is Unavailable” Limitations

A skilled artisan would appreciate that the '848 Application contemplates scenarios wherein the agent identifies a replacement product because of unavailability or misidentification of the requested product. Mitzenmacher Decl., ¶

45. The Federal Circuit's holding in *Pozen Inc. v. Par Pharm., Inc.*, 696 F.3d 1151 (Fed. Cir. 2012) is instructive to the case here.

In *Pozen*, the claimed “therapeutic package” and a “finished pharmaceutical container” were not specifically recited or otherwise disclosed in the original disclosure. *Id.* at 1166. Nonetheless, the Federal Circuit affirmed the district court's finding of adequate written description support because “dispensing pharmaceutical products in containers or packages was not a new or unpredictable concept” *Id.*; *see also id.* at 1166-67. (determining that a skilled artisan would have understood that the inventors possessed the well-known concept of distributing tablets in containers or packages even).

Similarly, a skilled artisan reviewing the '848 Application would understand that the inventors possessed identifying a replacement product when the requested product could not be located. Mitzenmacher Decl., ¶ 46. The '848 Application recognized the problem of customers receiving wrong and unsatisfactory products. '848 Application ¶ 5 (identifying the problem of errand runners “purchas[ing] the wrong product” as it “creates the potential for a confrontation, or at the very least, a dissatisfied purchaser who has now also lost significant time in acquiring the desired product.”). And, the root causes for this problem were known at the time. Whether the customer received the wrong product because it was out of stock or an order

picker misidentified the desired item, the specification need not spell out these well-known scenarios.

And whatever the underlying reason for the wrong product being identified, the '848 Application resolves it with agents who provide detailed information about the identified product and receive real time feedback about the product. '848 Application at ¶ 6. Accordingly, the disclosed solution ensures that the identified product is satisfactory for purchase even if it is not the requested product. '848 Application at ¶¶ 5-6; Mitzenmacher Decl., ¶ 46.

A skilled artisan comes to the patent with the knowledge that desired products may be out of stock and, consequently, that the agent will sometimes fail to locate them. *See Pozen Inc.*, 696 F.3d at 1167 (“[T]he patent specification is written for a person of skill in the art, and such a person comes to the patent with the knowledge of what has come before”) (citation omitted); *see also Capon*, 418 F.3d at 1357-58 (expressing that the “law is applied to each invention in view of the state of relevant knowledge”). Just like dispensing pharmaceutical products in containers or packages, the fact that products may sometimes be out of stock is understood. Mitzenmacher Decl., ¶ 47.

Documentary evidence and plain real-world experience establish that “stock-outs” were and remain a commonplace nuisance. *See, generally*, Ex. 2009 at 325; Ex. 2010 at 91. And because stock-outs occurred regularly, order pickers or

assemblers were often faced with a problem: of whether to substitute the ordered product for a different one or to assume that the customer would prefer nothing at all. Ex. 2009 at 325 (explaining that an order assembler “could not make a judgment for a customer as to whether that customer would like a close substitute or would prefer to do without them.”). In making this judgment call, the assembler could identify a substitute item (replacement product) that was potentially unsatisfactory to the customer. Ex. 2010 at 91 (“Substitution for items out of stock is a problem online since the picker does not know what would satisfy the customer substituting a different brand may [] result in dissatisfaction.”). This is precisely the problem identified in the ’848 Application. See ’848 Application at ¶ 5; Mitzenmacher Decl., ¶ 47.

Petitioner and its expert, Dr. Houh, further confirm that a skilled artisan would understand that when requested products are out-of-stock they are not available or identifiable, consequently resulting in assemblers identifying replacements:

[A] POSITA would have recognized that, when an item (“*an identified product*”) is out of stock, an order assembler would “*fail[] to locate*” the item.

Pet. at 39; Ex. 1003 at ¶ 117 (testifying that a POSITA “would have recognized that, when an item (“an identified product” [of the acquisition request] is out of stock, an

order assembler would “fail[] to locate” the item and thus scan the UPC of substitutes for the unavailable good.”); Mitzenmacher Decl., ¶ 48.

A skilled artisan reading the '848 Application would, therefore, understand that the application operates in accordance with this common-sense knowledge when remedying the issue of delivery personnel identifying another product, which may not be to the customer's satisfaction. *See* '848 Application at ¶¶ 5-6 (the disclosed solution ensures that the identified product is to the customer's satisfaction before purchase); Mitzenmacher Decl., ¶ 49. As one concrete example, an agent upon receiving an acquisition request travels to the shopping location to shop for the requested product as identified in the acquisition request (e.g., Heinz Tomato Ketchup). '848 Application at ¶ 23. However, if the requested Heinz brand is out-of-stock, the agent then makes a judgment call and identifies another ketchup product (for instance, Heinz Organic) and conveys to the customer an image of that product for real-time inspection, as in step 117. *Id.* at Fig. 3, ¶¶ 23-24.

Although this is the **wrong** ketchup brand requested, if the replacement product is satisfactory, the customer can approve the purchase via the agent, as in step 120. *Id.*; *see also id.* at ¶¶ 5-6. Significantly, Dr. Houh, stated that although this is the wrong brand, if it is to a customer's satisfaction, the customer would ultimately get the product desired. *See* Ex. 2011 (“Houh Tr. 1”) at 58:20-59:12. If, on the other hand, the product is unsatisfactory, the customer can reject that product

and request further shopping for a similar or satisfactory product, such as Hunt's Tomato Ketchup (*i.e.* another replacement product). *Id.* at ¶ 24.⁵ Accordingly, the contemplated scenario describes the “failing to locate a product” and “determining that a product is unavailable” limitations in a way understandable to a skilled artisan to support written description. Mitzenmacher Decl., ¶ 50.

Furthermore, a skilled artisan would understand that to the extent that the agent does not wish to make a judgment call, the '848 Application also provides that the agent can notify the customer that the purchase cannot be completed. *See* '848 Application ¶ 25 (“If the customer is not qualified for the amount of the desired purchase, or if the delivery agent cannot complete the transaction for any reason, the customer is notified that the acquisition cannot be made as indicated at 122.”) (emphasis added). In this scenario, the customer can request further shopping for a replacement product without the agent identifying the replacement product absent customer input. *See id.* at ¶ 24 (“If the customer requests further shopping, the

⁵ During the examiner interview of related U.S. Patent Appl. No. 17/585,779 (“the '779 application”), the examiner indicated that the Heinz ketchup example “was operating in accordance with the invention.” Ex. 2012 at 7-8. Nonetheless, to expedite prosecution, the applicant removed the “failing to locate” language from the pending claims. *Id.* at 8.

delivery agent will move to other similar products or may travel to another location in search of a satisfactory product.”). Hence, this contemplated scenario lends further support for the limitations at issue. Mitzenmacher Decl., ¶ 51.

Petitioner's assertion that product unavailability is not a reason that the transaction cannot be completed is based on the incorrect belief that the requested product is first identified before there is an indication that the agent cannot complete the transaction. *See* Pet. at 19-20 (inspecting the product “**before** any indication that the delivery agent cannot complete the transaction”). To the contrary, the '848 Application discloses that “the customer may choose to terminate the acquisition services at any time,” which would include the disclosed circumstance where the customer is observing the agent's shopping in real-time and it becomes evident that the requested item cannot be found. '848 Application ¶ 24, ¶ 23 (disclosing a customer initiating real-time contact with the agent as the agent is entering the shopping location); *see also id.* at ¶ 25 (“[I]f the delivery agent cannot complete the transaction for any reason, the customer is notified that the acquisition cannot be made....”), ¶ 30 (disclosing that “the steps for the methods of remote acquisition and delivery of goods described herein do not necessarily need to be in the order in which they are presented above.”); Mitzenmacher Decl., ¶ 52.

Petitioner's other assertion, that there are numerous scenarios why a transaction could not be completed (*see* Pet. at 21-22), ignores the context in which the invention arises: to resolve the problem of wrong/unsatisfactory products being delivered. In the context of the problem solved, a skilled artisan would envision that when a requested product is unavailable, the agent can notify the customer and receive instructions for a replacement product that is to the customer's satisfaction, as the '848 Application conveys. Mitzenmacher Decl., ¶ 53.

In view of the foregoing, the '848 Application as read in view of the skilled artisan, conveys with reasonable certainty that the agent would either identify a replacement product (for which the remedial steps ensure it is to the customer's satisfaction before purchasing) or notify the customer that the transaction cannot be completed (for which the customer can request further shopping for a satisfactory replacement product). Under either scenario, the application provides more than sufficient support for the "failing to locate a product" and "determining that a product is unavailable" limitations. Mitzenmacher Decl., ¶ 54.

b. Petitioner's View Lacks Common Sense, Applies the Wrong Legal Test, and Ignores the Knowledge of a Skilled Artisan

Petitioner's allegation that the '848 Application *assumes* that the agent will be able to find the product identified in an acquisition request lacks common sense, ignores the knowledge of a skilled artisan, and misapplies the law. *See* Pet. at 18-

20 (citing '848 Application at Fig. 3); *see* § V.A.1.a, *supra*; *see* Paper 9 (“Institution Decision”) at 7-8 (stating that the application presumes that the agent “locates and identifies the [requested] product in the first instance”); Mitzenmacher Decl., ¶ 55.

Setting out to shop for a new shirt and being disappointed when the shirt is not available in the right color or size is a universal experience, and the specification need not—and preferably does not—spell out such well-known facts. MPEP 2163, Section II.A.3 (citing *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986) and *Capon*, 418 F.3d at 1357 (“The ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge As each field evolves, the balance also evolves between what is known and what is added by each inventive contribution.”)). Given the '848 Application's recognition of the fact that wrong or unsatisfactory products were often delivered and the commonplace experience that desired products are often out of stock, Petitioner's allegation that the '848 Application *assumes* that the desired product would always be identified defies common sense. Mitzenmacher Decl., ¶ 56.

Thus, although one embodiment contemplates that the agent locates the product identified in the acquisition request, it is common knowledge that the desired product may be out of stock when the agent arrives at the shopping location. '848 Application at ¶ 23. Because the “inventive contribution” was not directed to the

various well-known circumstances that would lead to the delivery of wrong or unsatisfactory products (but what to do to prevent that outcome) there is no requirement that the specification spell out these well-known concepts in detail. *Capon*, 418 F.3d at 1358. The inventors did not purport to invent stock outages, they invented a system capable of rectifying all cases where the lack of customer inspection would have otherwise led to the delivery of the wrong or unsatisfactory product. '848 Application at ¶¶ 5-6; Mitzenmacher Decl., ¶ 57.

Accordingly, for example, if the customer's ordered product (e.g., Heinz Tomato Ketchup) is not available, traditional assemblers/order pickers were faced with the judgment call to send a replacement product (e.g., Heinz Organic) that might not be satisfactory or simply cancel the order. *See* § V.A.1.a, *supra* (citing Ex. 2010 at 91 ("Substitution for items out of stock is a problem online since the picker does not know what would satisfy the customer . . . substituting a different brand may [] result in dissatisfaction.")). Accordingly, the '848 Application does not only contemplate the scenario of the identified product, as in Figure 3, being the requested product but other scenarios in which it is another product yet the desired product if to the customer's satisfaction because those scenarios are the ones that would lead to the delivery of a wrong or unsatisfactory product. Mitzenmacher Decl., ¶ 58.

Petitioner's argument is also self-contradictory. In his declaration, Dr. Houh testified that the '848 Application *only* discloses a scenario in which the agent actually finds the customer's desired product. *See* Ex. 1003 at ¶¶ 51-53. During cross-examination, however, he testified that a skilled artisan would understand that the customer receives their desired product, even if it is different from the product originally requested. *See* Houh Tr. 1 at 58:20-59:12. In that case, the "desired product" is evidentially not the product the agent initially found, meaning that the agent failed to locate the "desired product." Mitzenmacher Decl., ¶ 59.

Petitioner's argument also misstates the applicable legal test, suggesting that written description requires express disclosure. *See Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357, 1364 (Fed. Cir. 2018) (rejecting the petitioner's argument that the disclosure lacked written description support because it did not "expressly or necessarily include" the claim limitation); *Pozen Inc.*, 696 F.3d at 1166-67 (finding written description support despite the specification not expressly disclosing packages or containers). Dr. Houh admitted that he did not evaluate what the '848 Application reasonably conveys to a skilled artisan. Houh Tr. 1 at 74:8-76:6, 83:4-84:1; *see also id.* at 92:22-95:5. The Board, therefore, should give Dr. Houh's declaration little to no weight. *Cf. Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 294 (Fed. Cir. 1985) ("Lack of factual support for expert opinion going to factual determinations, however, may render the testimony

of little probative value in a validity determination.”). In any event, there is at least inherent disclosure of the challenged limitations because products are admittedly often out of stock, and an agent would necessarily encounter stock-outs in the course of acquiring goods on behalf of customers. Houh Tr. 1 at 55:2-56:3 (Dr. Houh has experienced goods being out of stock), 78:18-79:16 (Dr. Houh could not complete the transaction for out-of-stock goods).

Moreover, the level of detail necessary to find written description in the instant case is lower than what is needed for unpredictable arts. *See Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357 (Fed. Cir. 2018). Similar to *Hologic*, there are only two well-known things that may happen when an agent visits a store on behalf of the customer: She either finds the product identified in the acquisition request or she doesn't. *Hologic*, 884 F.3d at 1361 (“[T]he field of this invention is a predictable art, such that a lower level of detail is required to satisfy the written description requirement than for unpredictable arts.”). In the latter case, the agent will end up showing the customer a wrong or unsatisfactory product, and the customer can provide real time feedback on that wrong or unsatisfactory product. *See* § V.A.1.a, *supra*. Further, as in *Hologic*, the allegedly missing disclosure was understood. *Hologic*, 884 F.3d at 1362 (finding that various types of the claim element—a “light guide”—were well-known in the art); *see* § V.A.1.a, *supra*. As such, as in *Hologic*, the claim limitations are supported by the disclosure.

* * *

In view of the foregoing, the '848 Application reasonably conveys to those skilled in the art that the inventors had possession of the claimed subject matter by at least the filing date of the '848 Application. Mitzenmacher Decl., ¶ 60.

2. The '848 Application Provides Written Description Support For the “Obtaining and Sending to the Customer the Information Determined From the Bar Code or QR Code Including at Least One Image of the Replacement Product” Limitation

The '848 Application provides support for the “obtaining and sending to the customer the information determined from the bar code or QR code including at least one image of the replacement product” limitation. Mitzenmacher Decl., ¶ 61. In the institution decision, the Board did not address Petitioner's written description challenged for this limitation. *See, generally*, Institution Decision. The Board should reach the same conclusion on the full trial record.

The '848 Application discloses the “obtaining and sending to the customer the information determined from the bar code or QR code including at least one image of the replacement product” limitation. '848 Application at ¶ 8 (describing that “bar codes, QR (Quick Response) codes, image recognition or near field communication can be used in *identifying and communicating information* about the product of concern”); *see also id.* at ¶ 23 (“On the other hand, the *product data* can be collected by scanning a bar code associated with the product”) (emphasis added), ¶ 30

(disclosing that bar codes and QR data “enable[e] a host of *information related to the product* to be presented”) (emphasis added). The disclosure also describes that “information regarding the product” includes “*pictures*, bar codes, QR codes, video, [and] instructions” *Id.* at ¶ 29. Accordingly, the ’848 Application discloses scanning bar codes and QR codes to provide information about the product, including product images, to the customer. Mitzenmacher Decl., ¶ 62.

Petitioner acknowledges some of these disclosures but maintains that “the ’848 Application does not contemplate the use of a bar or QR code to retrieve image information from the bar or QR code.” Pet. at 24. But that is exactly what the ’848 Application discloses, *i.e.* scanning a bar code to collect product data (’848 Application at ¶ 23) that includes “pictures” or “images” of the product (*id.* at ¶ 29) and presenting “information related to the product” to the customer (*id.* at ¶ 8, ¶ 30). In fact, the application describes that the image capture device includes image recognition software that a skilled artisan understands is used to identify and scan bar or QR codes to obtain images from links. *Id.* at ¶ 8; Mitzenmacher Decl., ¶¶ 63-64 (citing Ex. 2013 at 1-2 (describing the use of image recognition software to retrieve electronic data such as images that are linked to QR codes); *see also* Ex. 2014 at 427; Ex. 2015 at 1; Ex. 2016 at 62)).

Petitioner also suggests that the “at least one image of the replacement product” cannot be a static image stored in a database. Pet. at 23, 25. But the claims

do not require that the image be a “live” image taken in the store, they require determining information about a product, including at least one image of the product, from a bar code or QR code. Indeed, the fact that scanning the bar code causes an image to be sent to a customer addresses the problem of incorrect pictures posted online because the bar code ensures that the image sent to the customer is tied to the product. ’848 Application at ¶ 6; Mitzenmacher Decl., ¶ 65.

Moreover, contrary to Petitioner’s suggestion (Pet. at 25), the specification describes how sending product images determined based on bar/QR codes achieves the goals of the invention. ’848 Application at ¶ 30 (“Certainly bar code and QR data may be preferable due to associated accuracies, the ability to readily conduct simultaneous price comparisons for the product via internet searching or links, and enabling a host of information related to the product to be presented, e.g., nutritional or health information, product ratings and the like.”). Similarly, during prosecution of the ’465 Patent application, the applicant amended the then-pending claims to specify that the “information determined from the bar or QR codes include at least one image of the identified product” to highlight the goal of the invention:

To overcome these problems, the current invention requires that information on an identified product for the set of one or more goods be transmitted to the customer using a digital image capture device of an agent. ***This goal is specifically achieved*** by obtaining a bar or QR code of the identified product of a first set of one or more goods;

determining the information from the bar or QR code; and sending the information for the customer to approve the purchase of the particular product based on the information determined from the bar or QR code. Claim 1 has been amended to specify that the information determined from the *bar or QR code includes at least one image of the identified product*.

Ex. 1002 at 63-64 (emphasis added); Mitzenmacher Decl., ¶ 66.

For at least the foregoing reasons, the '848 Application provides written description support for the “obtaining and sending to the customer the information determined from the bar or QR codes including at least one image of the replacement product” limitation. Mitzenmacher Decl., ¶ 67.

B. Carr Does Not Teach “Acquisition Request” and “Acquiring” Under the Correct Construction (Independent Claims)

The term “acquisition request” is “a request for an agent to shop for goods on a customer’s behalf,” with “acquiring” covering the agent completing the transaction (purchasing) the goods. Mitzenmacher Decl., ¶¶ 68-87. The claim language, specification, and extrinsic evidence confirm this construction as the evidence demonstrates that an “acquisition request” entails the agent shopping for the goods and when “acquiring” completing the transaction for the goods on behalf of the customer. The Board’s preliminary rejection of Consumeron’s construction is premised on the alternative pre-purchase embodiment that the Challenged Claims do not read on.

Accordingly, applying the appropriate construction, Carr does not teach an “acquisition request,” wherein the agent shops and completes the transaction for the goods (purchases) during the “acquiring” step “upon receiving the approval of the purchase.” ’465 Patent at Claims 1, 14.

1. Claim Construction: “Acquisition Request”

a. The Claim Language, Specification, and Extrinsic Evidence Confirm Consumeron’s Construction of “Acquisition Request”

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.” *Trading Techs. Int’l, Inc. v. Open E Cry, LLC*, 728 F.3d 1309, 1319 (Fed. Cir. 2013) (“In construing claims, a court seeks to discern the meaning of a particular term used in one or more claims of a patent, based, *inter alia*, on evidence drawn from the specification, the surrounding claim language, the prosecution history, and relevant extrinsic sources.”); Mitzenmacher Decl., ¶ 70.

Starting with the claims themselves, the terms must be considered in “the context of the surrounding words of the claims.” *ACTV, Inc. v. Walt Disney Co.*, 346 F.3d 1082, 1088 (Fed. Cir. 2003) (“While certain terms may be at the center of the claim construction debate, the context of the surrounding words of the claim also must be considered in determining the ordinary and customary meaning of those terms.”). Here, the context of the words surrounding “acquisition request” requires

an agent shop for goods on behalf of the customer during the steps of “electronically transmitting information on a replacement product,” including “obtaining” a bar or QR code, “determining the information,” and “sending the information for the customer to approve the purchase.” ’465 Patent at Claim 1; *see also id.* at Claim 14; Mitzenmacher Decl., ¶ 71. Similarly, the term “acquiring,” considered in the context of the surrounding claim language, requires the agent to purchase (*i.e.* complete a transaction for) the goods. *See* ’465 Patent at Claims 1, 14 (reciting the customer “approv[ing] the purchase” and the agent “receiving approval of the purchase” during the step of “acquiring”); Mitzenmacher Decl., ¶ 71.

The specification confirms this usage of “acquisition request” and “acquiring” in the context of an agent shopping for goods on behalf of a customer. ***First*** and foremost, the specification explicitly ties the agent’s acquisition to the shopping transaction. *See* ’465 Patent at 8:18-21 (“If the customer is not qualified for the amount of the desired purchase, or **if the delivery agent cannot complete the transaction** for any reason, the customer is notified that **the acquisition cannot be made** as indicated at 122.”) (emphasis added). Thus, per the intrinsic record, the transaction is completed by the agent, not the customer (as disclosed in Carr). Mitzenmacher Decl., ¶ 72.

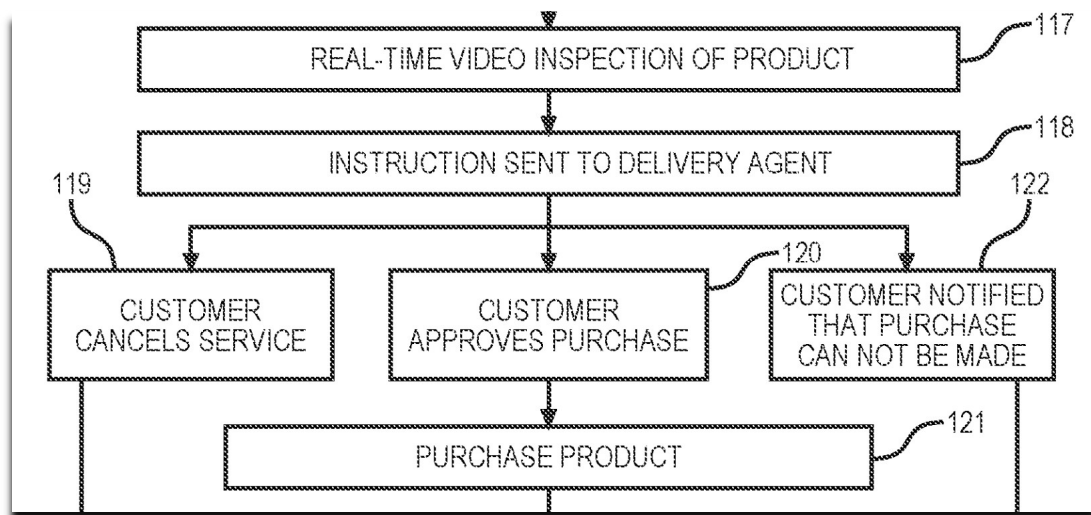
Second, the claimed invention as disclosed in the specification remedies the deficiencies in the “standard method by which customers purchase goods remotely

for delivery to a location of the customer's choice" with its "method for remote acquisition and delivery of goods." *Compare* '465 Patent at 1:35-1:38 *with id.* at Abstract; *Chicago Bd. Options Exch., Inc. v. Int'l Sec. Exch., LLC*, 677 F.3d 1361, 1372 (Fed. Cir. 2012) (where a patent repeatedly notes the "inadequacies" and "deficiencies" of a traditional methodology and proposes a remedy for the perceived deficiencies, it "reasonably may be viewed as a disavowal of that subject matter from the scope of the Patent's claims."). Thus, the specification's noted deficiencies of the traditional methodology and improvement over represent a disavowal of an agent simply picking up goods, with nothing more, from the claims of the '465 Patent. Mitzenmacher Decl., ¶ 73.

Third, the specification uses the terms "shopping" and "acquisition" as synonyms and does not suggest that the agent will do anything differently if it receives a "shopping request" rather than an "acquisition request." '465 Patent at 6:16-20. Instead, following the agent's receipt of a "shopping or acquisition request," "[t]he request for a particular product is sent to the selected delivery agent, along with the desired shopping location." '465 Patent at 6:7-9. In turn, the agent travels to the "shopping location" to shop for the requested product, if the product identified by the agent is rejected, the customer can "request[] further shopping, [and] the delivery agent will move to other similar products or may travel to another location in search of a satisfactory product." *Id.* at 7:13-63. Accordingly, whether

a shopping request or an acquisition request, the agent goes to the shopping location and shops for goods on the customer's behalf, they do not simply pick up already purchased goods. Mitzenmacher Decl., ¶ 74.

Fourth, the “acquisition request” is covered by “acquisition services” in which the agent shops for and purchases goods on behalf of the customer, and which span from an agent receiving the request to purchasing the goods at the shopping location. '465 Patent at 5:63-8:4 (referring to “acquisition services” as those spanning from steps 110-121 of Fig. 3). Excerpted Figure 3 (reproduced below) depicts a few of the acquisition services, including the agent sending images of the goods for real-time inspection by the customer who either approves the purchase of the goods via the agent or rejects the purchase and requests further shopping:



'848 Application at Fig. 3 (excerpted); *see also* '465 Patent at 7:31-8:4. Accordingly, to carry out the acquisition services depicted in Figure 3, the agent

shops for and purchases the goods on behalf of the customer. Mitzenmacher Decl., ¶ 75.

In regards to the specification's "purchase or otherwise acquire" passage, the extrinsic evidence is particularly helpful: it lists various ways to acquire goods while ultimately confirming that there must be some "transaction" that transfers possession from the original owner to the new one. Ex. 2004 (defining "acquire" as meaning "to come into possession of, whether directly or indirectly, through *sale, trade, exchange or other transaction*") (emphasis added); *see also* Ex. 2005 (defining "transaction" as an "act of buying or selling something."). Here, Exhibit 2004 accurately depicts the use of "acquiring" in the context of the language of the claims as the agent completes the transaction through a purchase when the customer "approve[s] the purchase" and the agent "receiv[es] the approval of the purchase." '465 Patent at Claim 1. Petitioner complains that Exhibit 2004's definition is "not useful" because it is found in a portion of the U.S. Code relating to "forest resources" but does not dispute its accuracy. Paper 7 ("Petitioner's Prelim. Reply") at 7. Moreover, Dr. Houh testified that in the context of commerce, and particularly in the context of goods labeled with a QR code, "acquiring" requires a transaction, such as a purchase. *See* Houh Tr. 1 at 8:15-9:10, 10:4-16, 13:5-7; Mitzenmacher Decl., ¶ 76.

Accordingly, in fulfilling the “acquisition request” and “acquiring” steps, the agent shops for and purchases the goods on behalf of the customer. Mitzenmacher Decl., ¶ 77.

b. The Board's Preliminary Findings Are Based on the Alternative Pre-Purchase Embodiment Which Contradicts the Language of the Claims and Removes Limitations From the Claims

The Board's preliminary findings that “acquisition request” covers the simple pick up of goods are based on the alternative pre-purchase embodiment that contradicts the language of the claims and effectively removes limitations from the claims. Institution Decision at 9-10; *see also id.* at 13-14; Mitzenmacher Decl., ¶¶ 78-79. The mere fact that the specification includes an alternative embodiment of a customer pre-purchasing goods does not outweigh the language of the claims which clarify that the agent purchases the goods upon receiving approval.

First, construing the claims to encompass the alternative pre-purchase embodiment contradicts the language of the claims. *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 embodiment in this case would contradict the language of the claims.”). The specification discloses an alternative pre-purchase embodiment, wherein the customer pre-purchases the goods and the agent only provides pick-up and delivery services, excluding acquisition services.

Compare '465 Patent at 8:25-34 (describing the alternative pre-purchased embodiment in which “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”); *with id.* at 5:63-8:4 (describing the “acquisition services as those spanning from steps 110-121 of Figure 3); Mitzenmacher Decl., ¶ 80.

In this embodiment, therefore, the agent picks up and delivers the pre-purchased goods. Mitzenmacher Decl., ¶ 81. Indeed, as Dr. Houh admits, the specification does not use the term acquire or acquisition to describe the “pick-up and delivery” services the agent can perform when “the acquisition cannot be made.” Ex. 2017 (“Houh Tr. 2”)⁶ at 110:1-110:21. And as Dr. Houh further acknowledged that the '465 Patent describes “acquisition services” as a service other than “pick-up and delivery services.” Houh Tr. 2 at 101:21-102:14 (identifying “acquisition services” as a service other than “pick-up and delivery services”). In that case, the customer is not charged for acquisition services, and the agent does not acquire the goods. Mitzenmacher Decl., ¶ 81.

⁶ Dr. Houh's deposition is in relation to the '835 Patent, which is the parent of the '465 Patent and shares the same specification and “acquisition request” claim term.

It would be unreasonable, therefore, to construe the terms acquisition request and acquiring to encompass mere pick-up and delivery of goods pre-purchased by the customer because those services do not require a transaction, it is an option to take when the acquisition cannot be completed, and the inventors used different language to differentiate acquisition services from mere pickup and delivery services.

Further disclosures through the specification confirm this conclusion. For example, the specification describes acquisition services to include the acts of traveling to a shopping location, obtaining and sending images of the goods to the customer, receiving customer approval for the purchase, and then purchasing the goods via the agent. '465 Patent at 5:63-8:4 (depicting the acquisition service steps). The claims read on the acquisition services embodiment. For instance, the claims require the customer to “approve the purchase” after receiving from the agent images of the goods, and “upon receiving approval on purchase,” the agent acquires the goods by completing the necessary purchase transaction. *See id.* at Claim 1; Mitzenmacher Decl., ¶ 82.

The specification's “shared-pick up events” and “purchase or otherwise acquire” fall within these acquisition services of shopping for goods, they do not otherwise indicate the fulfillment of an acquisition request without the need for shopping as the Board stated at institution. *See Institution Decision* at 10-11. The

“shared pick-up event” passage relates to an agent performing acquisition services by shopping for goods on behalf of *two or more customers*:

[A]ny additional customer that selects the same agent will also send an acquisition request to system 10, wherein the agent will electronically transfer an image, either in still or video form, of the requested goods .

. . in the same manner as described with respect to the first customer.”

’465 Patent at 6:59-67 (emphasis added). That is, in a shared pick-up event the agent fulfills the acquisition requests of two or more customers by shopping for goods on their behalf. Likewise, the agent “purchase[s] or otherwise acquire[s]” goods when she completes whatever transaction is necessary to acquire the goods, whether that is a purchase (as recited in the Challenged Claims) or some other transaction, such as a trade or exchange. Mitzenmacher Decl., ¶ 83 (citing Ex. 2004).

In view of the foregoing, the Challenged Claims recite an agent carrying out an “acquisition request” by performing various acquisition services (including shopping for and purchasing goods that the customer has approved) and are not broad enough to encompass embodiments that do not involve the agent acquiring, or completing the transaction, on the customer’s behalf, such as picking up and delivering pre-purchased goods. Mitzenmacher Decl., ¶ 84. It would, therefore, be in error to construe the claims to encompass the alternative “pre-purchase” embodiment that contradicts the language of the claims by simply having an agent pick up pre-purchased goods, nothing more. *Rolls-Royce, PLC v. United Techs.*

Corp., 603 F.3d 1325, 1334 (Fed. Cir. 2010) (“Although reluctant to exclude an embodiment, this court must not allow the disclosed embodiment to ‘outweigh the language of the claim, especially when the court's construction is supported by the intrinsic evidence.’”).

Second, an interpretation covering the alternative pre-purchase embodiment also effectively removes limitations from the claims. *Wasica Fin. GmbH v. Cont'l Automotive Sys., Inc.*, 853 F.3d 1272, 1288 n.10 (Fed. Cir. 2017) (holding that “construing ‘bit sequence’” to allow for an empty, zero-bit sequence would effectively remove the ‘first bit sequence,’ ‘second, or third bit sequence,’ and ‘fourth and final bit sequence’ limitations from the claim, as it would make them optional or potentially nonexistent”). The Challenged Claims require that upon receiving an image of the product (1) a customer approves the purchase, and (2) the agent receives the approval of the purchase. ’465 Patent at Claims 1, 14. To construe “acquisition request” to broadly encompass a customer’s pre-purchase of goods for which an agent merely picks up the goods would remove the purchase limitations from the claims, as it would make them optional or potentially non-existent. Indeed, in this alternative, the agent simply renders a receipt showing proof of pre-payment by the customer. *See* ’465 Patent at 8:31-33. As such, if the customer already pre-purchased the product, a customer would not “approve the purchase” only after receiving an image of the product from the image capture device, and there is no

need for the agent to “receiv[e] approval of the purchase” to thereby complete the transaction as the customer has already done so through their pre-purchase. *See* '465 Patent at Claims 1, 14; Mitzenmacher Decl., ¶ 85.

In view of the foregoing reasons, the alternative pre-purchase embodiment broadly covering an agent's pick up of goods does not outweigh the language of the claims as supported by the specification's disclosure of acquisition services encompassing an agent shopping for and purchasing goods on behalf of the customer. Mitzenmacher Decl., ¶ 86.

* * *

In view of the intrinsic and extrinsic record, an “acquisition request” means “a request for an agent to shop for goods on a customer's behalf.” Mitzenmacher Decl., ¶ 87.

2. Carr Does Not Teach or Suggest the “Acquisition Request” and “Acquiring” Limitations When the Appropriate Construction is Applied

When the appropriate construction is applied, an “acquisition request” details an agent shopping for goods on the customer's behalf, with “acquiring” encompassing the agent completing the transaction for the goods (purchasing the goods). *See* § V.B.1, *supra*. Carr's customer's online order, which is a transaction

completed between a seller (Walmart)⁷ and the customer, does not involve an assembler shopping and completing the transaction for the goods on the customer's behalf. *See* Pet. at 42-44 (For the “acquisition request” and “acquiring” limitations, Petitioner relies on Carr's customer order and an assembler adding the goods to the order, respectively); Mitzenmacher Decl., ¶ 88.

This customer order is not an “acquisition request” for an assembler to shop for goods on the customer's behalf because the transaction is complete between the customer and the seller's (Walmart's) virtual shopping environment. The online customer order in Carr, like in other traditional Internet shopping models (*see* § IV.A, *supra*), represents the purchase of the products by the customer, rather than an agent. *See* Carr at ¶ 48 (disclosing that the customer places an order and purchases items via the virtual shopping environment), ¶ 51 (describing “[a] *customer purchasing items from the store 20* . . . will typically view an internet webpage or access an application or app corresponding to the store.”) (emphasis added), ¶ 118 (disclosing that the processing device handles the purchase transaction with a customer). The customer's placed order is then sent to the store/order fulfillment

⁷ As discussed above in Section IV.B, Carr's applicant is “Wal-Mart Stores, Inc.” Carr at Cover (71).

system where assemblers simply retrieve and place in bins the already purchased goods. *See id.* at ¶¶ 53, 54, 74; Mitzenmacher Decl., ¶ 89.

A similar process applies for substituted goods, with the only addition being that the order fulfillment system modifies the customer order to include the substituted good. *See Carr* at ¶ 101; *see also id.* at ¶¶ 98, 110. For instance, in the event that the ordered good is out of stock, Carr offers a similar item as a substitute and will charge the customer the price of the substituted item, which is covered by a temporary authorization hold that accounts for replacements. *See id.* at ¶¶ 107-110; Ex. 2007. Upon customer selection of the substituted good, the order fulfillment system modifies the customer order to include the substituted item. *Carr* at ¶ 101; Mitzenmacher Decl., ¶ 90.

Because a customer order in Carr is no more than an offer for and payment of the goods over the seller's website, the customer completes the transaction, not Carr's assemblers. Accordingly, Carr's assemblers do not receive notifications of the "approval of the purchase" prompting them to complete the transaction (purchase the goods) during the "acquiring" step, as required by the Challenged Claims. *See* § V.B.1.a, *supra* (establishing that "acquiring" entails completing the transaction in the context of an agent shopping for goods on behalf of a customer); Ex. 2004 (the term "acquire" means "to come into possession of, whether directly or indirectly, through sale, trade, exchange, or other transaction."); Mitzenmacher Decl., ¶ 91.

Rather, Carr's assemblers simply receive a list of the ordered or substituted (alternative) goods prompting them to gather the goods and place them in bins, nothing more.

In general, the second server 28 provides a list of the goods in the order, as well as the selected pick-up time to one or more employees of the store 20 (assemblers). The assemblers gather the goods and place the goods in a bin or bins such that the order can be provided to or adjacent to the customer's motor vehicle.

Carr at ¶ 74; *see also id.* at ¶¶ 87, 94.

Once a chosen alternative good is sent back to the assembler, the assembler retrieves the substitute good and places the substitute good in the bin.

Id. at ¶ 110. An assembler simply receiving a list to then gather goods does not amount to “acquiring” the goods(*i.e.* completing the purchase transaction). Mitzenmacher Decl., ¶ 92.

Carr's disclosure of “an assembler includ[ing] the alternative good in a customer order” (Carr at ¶ 101) amounts to the same conclusion. Pet. at 43-44 (citing Carr at ¶ 101). Here too, the assembler simply receives communication on the alternative good to then add it to the customer order, they do not receive the approval for the purchase to thereby complete the purchase transaction. *Id.* Significantly, on cross-examination, Dr. Houh omitted the “purchase” language from the “upon receiving approval of the purchase” term. Houh Tr. 1 at 29:5-12, 30:9-16, 32:20-

33:13. This omission should be taken for what it is: there is no concept in Carr of an assembler receiving approval on the ***purchase***. As discussed above, the transaction is completed between the customer and seller, as the seller's processing device "handle[s] the purchase transaction with a customer." Carr at ¶ 118; *see, e.g., id.* at ¶¶ 47, 48, 51, 118. As such, the assembler only receives what alternative good to add to the order, not the approval for purchase prompting them to complete the transaction for the good. Significantly, Dr. Houh agrees that the customer completes the transaction for the goods, not the assembler. *See* Houh Tr. 1 at 37:12-38:21; Mitzenmacher Decl., ¶ 93.

Given that the customer purchases the goods via a seller's website, the customer order is not an "acquisition request" for an assembler to shop for goods on behalf of the customer, and an assembler gathering/adding goods to a customer order is not "acquiring" which entails completing the transaction upon "receiving approval of the purchase." *See* § V.B.1, *supra*. Therefore, Carr's disclosure of "receiving a customer order" and an assembler simply adding goods to the order does not teach or suggest the claimed "acquisition request" and "acquiring" limitations. Mitzenmacher Decl., ¶ 94.

VI. CONCLUSION

For all of these reasons, Consumeron respectfully requests that the Board hold patentable the Challenged Claims.

Dated: February 26, 2024

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CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that the portions of the foregoing **PATENT OWNER'S RESPONSE** specified in 37 C.F.R. §42.24 has 10,293 words in compliance with the 14,000-word limit set forth in 37 C.F.R. §42.24(b)(1). This word count was prepared using Microsoft Word word-processing system used to prepare this paper.

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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.

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