

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 REPLY
TO PATENT OWNER'S RESPONSE**

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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.1021	"Spotlight: The Rise of the Smart Phone," Zheng et al., IEEE Distributed Systems Online March 2006, IEEE 2006
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I. INTRODUCTION

The Petition and Dr. Houh's testimony establish how the prior art renders obvious the challenged claims of the '465 patent. Consumeron's Patent Owner Response (Paper 12, "Response") fails to rebut this *prima facie* case of obviousness because it relies upon the incorrect construction of "*acquisition request*" that was finally rejected by the Board in related IPR proceedings IPR2022-01356, -01357, -01358, and -01359. The Response also fails to establish that claims 1 and 14 are entitled to a priority date any earlier than the filing date of the '465 patent. Consumeron's reliance on obviousness and extrinsic evidence does not create written description support when the '848 application itself does not include the required disclosure.

II. THE '465 PATENT IS ONLY ENTITLED TO A PRIORITY DATE OF APRIL 20, 2020

Consumeron has not established that the '465 patent is entitled to a priority date any earlier than April 20, 2020. The Petition illustrated that independent claims 1 and 14 do not find § 112 written description support in U.S. Application 13/270,848 ("848 application"), the application to which the '465 patent claims priority. The Response fails to rebut that showing.

A. The '848 application fails to support the “*failing to locate an identified product*” and “*determining that the identified product is not available*” limitations.

The crux of Consumeron's argument as to why the '848 application supports the “*failing to locate an identified product*” (claim 1) and “*determining that the identified product is not available*” (claim 14) limitations is that “basic common experience confirm[s] that customers routinely go shopping and fail to locate the product they set out to purchase.” Response, 1.¹ Even if Consumeron is correct that customers sometimes fail to find products, this “basic common experience” is not sufficient to confer § 112 support. First, the '848 application makes no reference to the *specific problem* of an agent failing to locate a product identified by the customer or determining that such product is unavailable. Second, even if it was obvious that an agent may fail to locate a product, the claims also recite what the agent should do in response: transmit information on a replacement product. This “if-then” sequence of problem and solution is the “claimed subject matter” that must be disclosed—but is not disclosed—by the '848 application. *See Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc)

¹ The Response incorrectly quotes these claim limitations as “failing to locate a product” and “determining that a product is unavailable.” (Response, 1).

(explaining that “the hallmark of written description is disclosure” by the specification).

1. The claims address a different remote acquisition problem than the one addressed in the specification.

Many things can go wrong when an agent is remotely acquiring goods—for example: (i) the agent acquires the identified good, but it is unsatisfactory to the customer; (ii) the agent acquires the wrong good (i.e., not the good identified in the acquisition request), and (iii) the agent fails to locate the identified good or determines the identified product is unavailable. The '465 patent's claims lack written description support because they identify and attempt to solve scenario (iii)—failure to locate a good—but the '848 application attempts to solve the *different* problem of scenario (i)—the identified good being unsatisfactory.

For example, claim 1 recites the specific problem of “*failing to locate an identified product of the set of one or more goods,*” and claim 14 recites the similar problem of “*determining that the identified product is not available.*” Upon an agent encountering these problems, the claims require that the agent responds by electronically transmitting information on “*a replacement product for the identified product,*” including by “*obtaining a bar or QR code of the replacement product.*” The '848 application does not convey to a POSITA that the inventors had possession of either the problem or solution of unavailable products—it neither

describes the problem nor instructs an agent on what to do when a requested item cannot be located or is unavailable. The '848 application is instead directed to what an agent should do when the requested product **can** be located.

As explained in the Petition, in the principal embodiment of Figs. 2-3 in the '848 application², a customer sends an “acquisition request” for a “particular product” to the delivery agent (step 110), and “the selected delivery agent travels to the store location . . . and ***finds the desired product*** to be acquired” (step 113). Ex. 1011, ¶¶ 20, 23 (emphasis added); *see also id.* at ¶ 23 (“The delivery agent then enters the shopping location and ***identifies the product of interest.***”). In response to the desired product being located, the delivery agent: (i) “communicates to the customer that ***the product has been identified***, and the customer has the option of inspecting the product in real-time at 117,” (ii) “if the customer chooses to inspect ***the product***, . . . the delivery agent will utilize digital image capture device 46 to transmit real-time data to customer computer 30,” and (iii) if the customer “rejects acquisition of ***the inspected product***,” the “delivery

² Consumeron and its expert state that “[t]he claims read on the acquisition services embodiment” illustrated in Fig. 3 and described in ¶ 23 of the '848 application and 5:63-8:4 of the '465 patent. Response, 39; Ex.2008, ¶ 82; Ex.1038, 63:17-19 (“Figure 3 meets the elements of Claims 1 and 14 as described”).

agent will move to other similar products.” *Id.* at ¶¶ 23, 24. Crucially, each of these agent actions depends upon the customer's desired product being initially located. There is simply no disclosure in the '848 application of what an agent is to do “upon failing to locate an identified product” or if the agent “determin[es] that the identified product is not available,” as contemplated by claims 1 and 14.

Accordingly, given that lack of disclosure in the '848 application, the written description requirement prevents Consumeron from later claiming in the '465 patent the problem of an agent failing to find a good and a solution to that problem. *See Amgen Inc. v. Hoechst Marion Roussel Inc.*, 314 F.3d 1313, 1330 (Fed. Cir. 2003) (stating that “[t]he purpose of the written description requirement is to prevent an applicant from later asserting that he invented that which he did not”).

2. The “wrong product” example in the background does not support the claims.

In the Response, Consumeron attempts to improperly derive written description support for the claims by “[w]orking backward from a knowledge of the claims, that is by hindsight.” *See Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1349 (Fed. Cir. 2013) (quoting *In re Ruschig*, 379 F.2d 990, 995 (C.C.P.A. 1967)) (explaining that written description support cannot be pieced together by an “amalgam of disclosures plucked selectively” from an application). For instance, the Response repeatedly points to the single mention

of errand runners “purchas[ing] the wrong product” in the background of the '848 application as an example of the claimed scenarios of “*failing to locate an identified product*” and “*determining that the identified product is not available.*” See, e.g., Response, 17 (quoting '848 application, ¶ 5). This background example, however, does not provide the desired support for two reasons.

First, the principal embodiment of the '848 application does not identify or attempt to solve the “wrong product” problem. The figures and description do not describe the actions an agent should take when they inadvertently grab a product other than the product requested by the customer. As noted above, Figs. 2-3 only describe agent actions upon “find[ing] the desired product to be acquired.” '848 application, ¶¶ 20, 23, 24. This is confirmed when the '848 application describes what an agent is to do when a customer rejects the inspected product—the agent is to find “similar products,” *not* the correct product as would be expected if the agent initially grabbed the wrong product. *Id.*, ¶ 24. Accordingly, to the extent Consumeron asserts that the claims recite a solution to the “wrong product” problem, such a solution is not proposed in the '848 application and lacks § 112 support.

Second, the “wrong product” background example is also inconsistent with the claim language of claims 1 and 14. The “*failing to locate an identified product*” language of claim 1 logically cannot encompass an agent grabbing the wrong

product because the agent would **not** transmit information on a “*replacement product*” upon grabbing the wrong product. They would instead transmit information on the **wrong** product because the agent would not know it is wrong. *See* Ex.1038 (Mitzenmacher deposition), 79:13-21 (confirming that if the agent “picked the wrong item,” the agent would send a picture of “the wrong item”). If, on the other hand, the agent discovered their mistake, they would put the wrong product back and transmit information on the correct (“*identified*”) product—again, not on a “*replacement product*.” Moreover, even if the customer alerted the agent that the gathered product is “wrong” via inspection, the agent wouldn’t attempt to locate a “*replacement product for the identified product*” as claimed—the agent would instead locate the “*identified product*” itself. *See* Ex.1038, 82:3-20. With respect to claim 14, the recited “*determining that the identified product is not available*” is an entirely different concept than an agent gathering the “wrong product,” and is similarly not supported. *See id.* at 79:22-80:5 (agreeing that the agent mistakenly believes the desired product **is available** when they grab the “wrong item”).

Accordingly, the ’848 application as a whole and ’465 patent claim language illustrate that the “wrong product” example fails to provide the desired written description support.

3. A POSITA's knowledge of the "stock-out" problem is irrelevant when the claims require both the problem *and* solution.

Consumeron additionally alleges that 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." Response, 18. Even if true, general knowledge of stock-outs is insufficient to support claims that require specific agent actions *in response* to this problem. That is, even if a skilled artisan reading the specification recognized that the product identified in the acquisition request may be out of stock, the specification doesn't instruct the artisan how to solve that problem. The Court of Customs and Patent Appeals observed long ago that an identified problem without a solution does not confer written description support:

It is an old custom in the woods to mark trails by making blaze marks on the trees. It is no help in finding a trail or in finding one's way through the woods where the trails have disappeared—or have not yet been made, which is more like the case here—to be confronted simply by a large number of unmarked trees. Appellants are pointing to trees. We are looking for blaze marks which single out particular trees. We see none.

In re Ruschig, 379 F.2d 990, 995 (C.C.P.A. 1967); *see also Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1347 (Fed. Cir. 2016). Here, Consumeron is pointing to trees

(the stock-out problem) rather than blaze marks. The '848 application is missing those blaze marks to guide a POSITA through the stock-out problem. As explained above, the '848 application only describes what an agent is to do when a desired product is *in stock* but unsatisfactory—it does not describe what the agent is to do when the desired product is *out of stock*, as required by claims 1 and 14. Without description of that particular solution, the '848 application fails to provide § 112 support.

Tacitly acknowledging this gap in the '848 application, Consumeron instead speculates as to how an agent would have responded to the stock-out problem. Citing extrinsic evidence and its expert (but seldom the specification), Consumeron hypothesizes that “the assembler *could* identify a substitute item (replacement product).” Response, 19; *see also id.* at 23 (“[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.”). These speculative actions based on extrinsic evidence and obviousness reasoning are legally “not sufficient” for written description support. *Lockwood v. American Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997) (“It is not sufficient for purposes of the written description requirement of § 112 that the disclosure, when combined with the knowledge in the art, would lead one to speculate as to modifications that the inventor might have envisioned, but failed to

disclose.”). More precisely, the “knowledge of ordinary artisans” may not be used “to teach limitations that are not in the specification.” *Rivera v. ITC*, 857 F.3d 1315, 1322 (Fed. Cir. 2017).

Consumeron’s “concrete example” about what an agent might do if the requested Heinz ketchup is out-of-stock adds nothing because it is not rooted in the disclosure of the ’848 application, in which the agent locates and transmits information on the desired product. Every aspect of Consumeron’s example is hypothesized and not described in the specification:

- “However, if the requested Heinz brand is out-of-stock” [**not described**];
- “the agent then makes a judgment call and identifies another ketchup product (for instance, Heinz Organic)” [**not described**];
- “and conveys to the customer an image of that [replacement] product for real-time inspection, as in step 117.” [**not described**].

Response, 20. Consumeron’s footnote implying that the examiner of the related ’779 application found written description support for the Heinz ketchup example is also not rooted in reality. *Id.* at 21, n. 5 (quoting Consumeron’s *own* interpretation of the examiner interview). The examiner was explicit during the examiner interview that the specification “still fails to provide support for the failure to locate an item” and thus “no agreement was reached.” Ex.1039 (’779

Prosecution History), 311. Consumeron's reprise of the same arguments and evidence rejected by the examiner should be similarly rejected by the Board.³

Consumeron's evidence and example, *at best*, indicates that a POSITA may have found it obvious to select a replacement product for an out-of-stock item, but obviousness is insufficient to establish § 112 support, as also noted by the examiner of the '779 application. *See Lockwood*, 107 F.3d at 1572; *see also* Ex.1039, 311 ("Examiner further noted that obviousness does not factor into the written description requirement when evaluating priority.").

B. The '848 application fails to support “*determining the information from the bar or QR code, wherein the information includes at least one image of the replacement product*” (claim 1) or “*obtaining a bar code [or] QR code of a replacement 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*” (claim 14)

As discussed above, Consumeron has failed to establish that the '848 application provides written description support for the concept of an agent failing to locate the customer's desired product and transmitting information on a “*a replacement product for the identified product.*” On that basis alone, Consumeron

³ Apparently reading the writing on the wall, Consumeron effectively conceded the examiner was right, as it cancelled the unsupported claim limitations instead of facing a likely final § 112 rejection. Ex.1039, 329.

has failed to show support for these additional limitations that also require a “*replacement product*” for an unavailable product.

Beyond that, Consumeron similarly fails to establish § 112 support for the claimed concept of determining images from a bar or QR code. The Response again improperly relies upon obviousness theories to cobble together disparate portions of the '848 application to arrive at subject matter not originally possessed by the inventors. Moreover, even if obviousness was relevant at all, the '848 application *teaches away* from transmitting stock images obtained from a QR code to customers—such images are described as “inadequate to accurately depict the item” desired by a customer. '848 application, ¶ 4.

1. The claims require the specific act of “*determining*” an image from a bar code, which lacks § 112 support.

Both claims 1 and 14 require the affirmative act of “*determining*” an image from the bar or QR code. The pertinent question with respect to § 112 is not “whether one skilled in the art *might* be able to” determine an image from a bar code but “whether the application necessarily discloses” that specific act of determining. *Martin v. Mayer*, 823 F.2d 500, 505 (Fed. Cir. 1987) (quoting *Jepson v. Coleman*, 314 F.2d 533, 536 (1963) (emphasis in original)). The '848 application lacks such disclosure, as illustrated in the Petition.

The Response fails to rebut this showing because it does not (and cannot) point to a specific disclosure of “*determining*” an image from the bar or QR code. Instead, Consumeron attempts to manufacture support by weaving together unrelated portions of the specification. It points to (i) the generic statement that “QR (Quick Response) codes ... can be used in identifying and communicating information about the product” to the customer and (ii) the unrelated statement in a different portion of the specification 21 paragraphs later that “the customer sends information regarding the product such as pictures, bar codes, QR codes, video, instructions, recipes, specifications, ingredients, where manufactured, etc. to server 14.” Response, 28-29 (citing ’848 application, ¶¶ 8, 29). Based on these distinct portions of the ’848 application, Consumeron concludes: “Accordingly, the ’848 Application discloses scanning bar codes and QR codes to provide information about the product, including product images, to the customer.” *Id.* at 29.

Consumeron’s conclusion is necessarily based upon obviousness because neither cited portion of the ’848 application describes “*determining*” an image from the bar or QR code. In the first scenario, an agent uses QR codes to send information to a customer, but there is no mention of sending images, much less “*determining*” images from QR codes. ’848 application, ¶ 8. In the second, reverse scenario, a customer sends information to the agent, and images and QR codes are listed as *alternative* types of product information: “the customer sends information

regarding the product such as **pictures, bar codes, QR codes**, video...” ’848 application, ¶ 29. Accordingly, without actual disclosure of “*determining*” images from QR codes, these portions of the ’848 application are insufficient to confer § 112 support—even if such determining would have been obvious. *L.A. Biomedical Research Inst. at Harbor-UCLA Med. Ctr. v. Eli Lilly & Co.*, 849 F.3d 1049, 1057 (Fed. Cir. 2017) (“disclosure in a parent application is not sufficient if it ‘merely renders the later-claimed invention obvious...’”) (quoting *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1158 (Fed. Cir. 1998)). And, as noted above, Consumeron’s citation to extrinsic evidence (Ex.2013, 2014, 2015) cannot be used to “teach limitations that are not in the specification.” *See Rivera*, 857 F.3d at 1322.

2. The ’848 application cautions a POSITA *against* using images derived from QR codes.

Even ignoring the above, Consumeron’s reliance upon obviousness to establish written description fails for the additional reason that the ’848 application teaches away from an agent determining images from QR code of products in a shopping location.

As explained in the Petition, the ’848 application is predicated upon the known issue in “internet shopping” of internet-based pictures being “inadequate to accurately depict the item” selected by a customer. ’848 application, ¶ 4. The ’848

application purports to solve this issue by instead having an agent capture and transmit “real-time” pictures and video of a product in a store to a customer for inspection—as illustrated in step 117 of Fig. 3 (“REAL-TIME INSPECTION OF PRODUCT”). ’848 application, ¶ 23, Fig. 3. Sending a customer an image derived from a bar or QR code would not permit real-time inspection, and would perpetuate the known problem of inadequate images in internet shopping identified in the background. Ex.1003 (Houh Declaration), ¶¶ 76-77. Accordingly, a POSITA having the background in the art of internet shopping would not understand the ’848 application to convey or disclose the idea of determining an image from a bar or QR code for transmission to a customer, as such images were known to be inadequate. *See Capon v. Eshdar*, 418 F.3d 1349, 1358 (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].”).

III. THE BOARD SHOULD AGAIN REJECT CONSUMERON’S OVERLY NARROW CONSTRUCTION OF “ACQUISITION REQUEST”

In the four proceedings challenging family members of the ’465 patent, the Board held in the Final Written Decisions that the term “*acquisition request*” has its “ordinary meaning, which encompasses but is not limited to purchasing or shopping and includes other means of acquiring a product.” *See, e.g., Maplebear Inc. D/B/A Instacart v. Consumeron LLC*, IPR2022-01357, Paper 35 at 11 (Feb.

29, 2024); *see also* IPR2022-01356, Paper 35 at 11 (Feb. 29, 2024); IPR2022-01358, Paper 36 at 13 (Feb. 29, 2024); IPR2022-01359, Paper 35 at 15 (Feb. 29, 2024). Based on this ordinary meaning, “acquisition request” includes “not only a request for a delivery agent to shop for and purchase goods, but also a request for the agent to pick up or obtain pre-paid goods.” *Id.*

The '465 patent is derived from the same specification as its previously challenged family members and its claims share many common terms. Accordingly, the term “*acquisition request*” should be construed in the same plain and ordinary way in this proceeding. *See Trustees of Columbia Univ. v. Symantec*, 811 F.3d 1359, 1369 (Fed. Cir. 2016) (“where multiple patents ‘derive from the same parent application and share many common terms, we must interpret the claims consistently across all asserted patents’” (quoting *NTP, Inc. v. Research in Motion, Ltd.*, 418 F.3d 1282, 1293 (Fed. Cir. 2005))); *In re Katz Interactive Call Processing Pat. Litig.*, 639 F.3d 1303, 1325 (Fed. Cir. 2011) (claims should be interpreted consistently across patents sharing the same specification).

Indeed, Consumeron is precluded from again arguing its construction based on the doctrine of collateral estoppel. Each requisite factor is met: (1) the prior actions presented an identical issue of patentability (the construction of “*acquisition request*”); (2) the prior actions actually litigated and adjudged the issue, as each final written decision acknowledged; (3) the prior actions required

determination of the claim construction issue; and (4) the prior actions featured full representation of the estopped party by the same counsel appearing here. *See Google LLC v. Hammond Dev. Int'l*, 54 F.4th 1377, 1381 (Fed. Cir. 2023) (explaining collateral estoppel factors). And though Consumeron is presently appealing those final written decisions, “the pendency of an appeal has no [e]ffect on the finality or binding effect of a trial court’s holding.” *SSIH Equipment S.A. v. Int’l Trade Comm’n*, 718 F.2d 365, 370 (Fed. Cir. 1983); *see also Medtronic, Inc. v. Teleflex Life Sciences Ltd.*, IPR2020-01343, Paper 85, pp. 71–72 (PTAB Feb. 23, 2022) (APJ Paulraj writing in a concurring opinion in support of application of collateral estoppel despite pending appeal of previous decision to avoid “inconsistent results” and “gamesmanship”). Thus, the Board can properly rely on its previous decisions and apply collateral estoppel to the claim construction issue in this proceeding.

In any event, Consumeron provides no justification to depart from the Board’s well-reasoned construction in those related proceedings. The Response repeats many of the same arguments that the Board previously rejected in the Final Written Decisions. *See* Response, 32-37. Where the Response appears to make “new” arguments, those arguments fail to distinguish the ’465 patent claims from the previous challenged claims. For example, Consumeron points to the “*approve the purchase*” language in claim 1 as a reason to construe “*acquisition request*”

narrowly, arguing that the Board's broader construction "effectively removes limitations from the claims." Response, 41-42. The "*approve the purchase*" language, however, is also recited in the claims of the '835 patent previously analyzed by the Board in IPR2022-01357. *See* Ex.1025 ('835 patent), claim 1 ("*sending the image for the first customer to inspect and approve the purchase of the particular product*").

The "*approve the purchase*" claim language is in fact not inconsistent with a plain and ordinary construction of "*acquisition request*," as confirmed by the surrounding claim language and specification. Like the '835 patent claims, the '465 patent claims do ***not*** require an agent to make a purchase. Rather, the claims recite "***acquiring*** the replacement product, via the agent"—which, by definition, is consistent with an "***acquisition request***." Dependent claim 4 further confirms that the agent must only "***acquire***" (not purchase) after receiving customer approval: "*obtaining consent from the customer to **acquire** the identified product...; **acquiring** the identified product, via the one or more agents.*"⁴

⁴ As noted in the Petition, because "*the identified product*" in claim 1 is the product that is not located, and a "*replacement product*" is instead included within the customer's order, Petitioner interprets this language as referring to consent to acquire the replacement product. Petition, 44; Ex.1003, ¶134.

Moreover, in the scenario in which the customer “pre-pay[s]” for the goods (Ex.1001, 8:25-33), it makes sense that the customer must still approve their *own* remote purchase (not the agent’s). The stated purpose of the ’465 patent is to allow a customer to inspect a product *before* remotely purchasing it. Ex.1001, 9:23-29 (explaining that the “present invention” is a system that “supplies a customer with the detailed information needed to **make an informed purchase...remotely**”). This is also consistent with the background knowledge that it “was well-known that customers prefer to inspect products before purchasing.” IPR2022-01357, Paper 35 at 18. Accordingly, in the “pre-payment” scenario, even though the customer may have pre-paid, they have not yet completed a remote purchase, which requires inspection, approval, and agent possession (i.e., acquisition). Ex.1001, 8:25-33, 9:23-29, Fig. 3; *see also* Ex.1040 (defining “purchase” as payment *plus* possession: “to **obtain** by **paying** money or its equivalent”). The Board’s plain and ordinary construction is thus consistent with the claims and specification of the ’465 patent.

Even ignoring the above, Consumeron’s position should be rejected because it would inject even more uncertainty into the claims. Consumeron purports to construe only the term “*acquisition request*,” but in its explanation it also separately construes the term “*acquiring*” and does so inconsistently. For example, Consumeron alleges that “the term ‘acquisition request’ means ‘a request for an

agent to shop” Response, 32. Yet, in the next paragraph, Consumeron alleges that “the term ‘acquiring,’ ... requires the agent to purchase (i.e. complete a transaction for) the goods.” *Id.* at 33. Consumeron offers no explanation why an “*acquisition request*” requires an agent to “shop,” but “*acquiring*” requires an agent to “purchase.” Nor does it explain what it means for an agent to “shop” and how shopping relates to purchasing. The specification offers no help. *See e.g.*, Ex.1001, 1:29 (stating instead that “the present invention pertains to **customer shopping**”).

A plain and ordinary reading of “acquisition” and “acquiring” eliminates this uncertainty, as both terms simply mean coming into possession or obtaining something without requiring purchasing or shopping. *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”).⁵

⁵ Consumeron appears to appreciate the difference between acquiring and purchasing, as it recently amended the pending claims in the ’779 application to recite “purchase request” and “purchasing the product” instead of “acquisition

Petitioner respectfully requests that the Board should maintain its plain and ordinary reading of “*acquisition request*” set forth in the related proceedings.

IV. CARR IN VIEW OF LAUKA RENDERS OBVIOUS THE CHALLENGED CLAIMS WHEN GIVEN THEIR PROPER SCOPE

Each of Consumeron's arguments as to why the prior art fails to render obvious the challenged claims is predicated upon its overly narrow construction of “*acquisition request*.” When the claims are correctly construed, Carr in view of Lauka renders them obvious.

The Response first alleges that Carr fails to teach an “*acquisition request*” because “Carr's customer's online order, which is a transaction completed between a seller (Walmart) and the customer, does not involve an assembler shopping and completing the transaction for the goods on the customer's behalf.” Response, 42-43. When “*acquisition request*” is given its proper scope that does not require agent shopping and purchasing, Carr's customer order teaches an “*acquisition request*” because it is a request to acquire the desired goods. Ex.1005, ¶ 9 (teaching “receiving a customer order at an order fulfillment system,” where the “customer order includes at least one good”). Nothing more is required.

request” and “acquiring the product” (but later flip-flopped back to “acquisition” and “acquiring”). Ex.1039, 456-59.

Consumeron further alleges that Carr is deficient because the customer order “represents the purchase of the products by the customer, rather than an agent.” Response, 43. The claims on their face do not require an agent purchase—only agent acquisition: “*acquiring the replacement product, via the agent.*” Carr teaches agent acquisition: the “assembler includes the alternative good in the customer order.” Ex.1005, ¶ 101; *see also* Ex.1031 (acquire: “to come into possession or control”). Further, Carr teaches that its agent’s acquisition is done “*upon receiving approval of the purchase from the customer,*” as claimed. In Carr, the customer selects and approves of the alternative good, which “is communicated back to the assembler” and the “assembler includes the alternative good in the customer order.” Ex.1005, ¶¶ 99, 101. The customer’s communicated approval therefore corresponds to the customer’s “*approval of the purchase*” of the alternative good because the need for an alternative good was not known until after the customer submitted the original order. Despite Consumeron’s assertion otherwise, the customer could not have previously purchased the alternative good because the customer identified a *different* good in the order.

Consumeron’s assertion that “Carr’s assemblers do not receive notifications of the ‘approval of the purchase’ prompting them to complete the transaction” (Response, 44) fails for the same reasons. The claims do not require an agent to complete a transaction, and the customer’s communicated approval of the

alternative good must logically be an approval of its purchase. To the extent Consumeron is attempting to read the additional words “by the agent” into the phrase “*approval of the purchase by the agent*,” the claims are not so narrow. Because claims require identification of a replacement product *after* the customer's initial acquisition request, the customer must still approve the *customer's* purchase of the later-identified replacement product.

Accordingly, the combined teachings of Carr and Lauka render obvious each and every limitation of the independent claims when interpreted correctly.⁶

V. CONCLUSION

For the foregoing reasons, Petitioner respectfully requests the Board find the challenged claims unpatentable.

Respectfully submitted,

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⁶ The Response does not separately argue any other limitation, or any of the dependent claims. *See generally* Response.

CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), Petitioner hereby certifies, in accordance with and reliance on the word count provided by the word-processing system used to prepare this Reply, that the number of words in this paper is 5,107. This word count excludes the table of contents, table of authorities, mandatory notices under §42.8, certificate of service, certificate of word count, signature block, and appendix of exhibits. *See* 37 C.F.R. §42.24(c).

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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.

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