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Paper 35
Date: February 29, 2024

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.

IPR2022-01356
Patent 8,244,594 B2

Before CARL M. DEFRANCO, ROBERT L. KINDER, and MICHAEL A. VALEK, *Administrative Patent Judges*.

DEFRANCO, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)



Consumeron, LLC ("Consumeron) is the owner of U.S. Patent No. 8,244,594 B2 (Ex. 1001, "the '594 patent"). Maplebear, Inc. d/b/a Instacart ("Instacart") filed a Petition requesting *inter partes* review of claims 1, 4, 5, 8, 9, and 13–17 of the '594 patent. Paper 1 ("Pet."). We instituted *inter partes* review of all the claims as challenged in the Petition. Paper 9 ("Inst. Dec."). Consumeron filed a response (Paper 19, "PO Resp."), Instacart filed a reply (Paper 24, "Pet. Reply"), and Consumeron followed with a sur-reply (Paper 29, "PO Sur-Reply"). We held a hearing on January 11, 2024, a transcript of which is in the record. Paper 34. For the reasons below, we determine that Instacart demonstrates by a preponderance of the evidence that challenged claims 1, 4, 5, 8, 9, and 13–17 are unpatentable as obvious under 35 U.S.C. § 103(a).

I. BACKGROUND

A. Related Matters

The '594 patent is the subject of a parallel infringement action in *Consumeron, LLC v. Maplebear Inc. d/b/a Instacart*, No. 1:21-cv-01147 (D. Del. Aug. 6, 2021) ("Delaware action"). Paper 3, 1. The Delaware action is presently stayed pending our decision here. *See* Ex. 3002.

Instacart has also filed petitions challenging the claims of several related patents that are also at issue in the parallel Delaware action. Those petitions are the subject of the following *inter partes* reviews: IPR2022-01357 (US 10,628,835 B2); IPR2022-01358 (US 10,115,067 B2); and IPR2022-01359 (US 9,202,191 B2).

Notably, Instacart challenges the claims of yet another related patent, US 11,238,465 B2 ("the '465 patent). The '465 patent derived from the same application—US Application 12/711,867 ("the '867 application")—as

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the '594 patent challenged here and is the subject of another *inter partes* review—IPR2023-00865 ("the 865 IPR"). *Compare* Ex. 1001, code (21), *with* Ex. 3005, code (63). As discussed below in Section II.B.3, the claims of both the '594 and '465 patents share a common term, the construction of which is in dispute in both proceedings.

B. The '594 Patent

The '594 patent describes "[a] system and method for remote acquisition and delivery of goods." Ex. 1001, Abstract, 1:64–65. The system includes "a server in communication with customer computers" and a "mobile delivery agent system" also in communication with the server. *Id.* at 1:65–2:4. Figure 1 of the '594 patent, reproduced below, is a schematic diagram of the system.

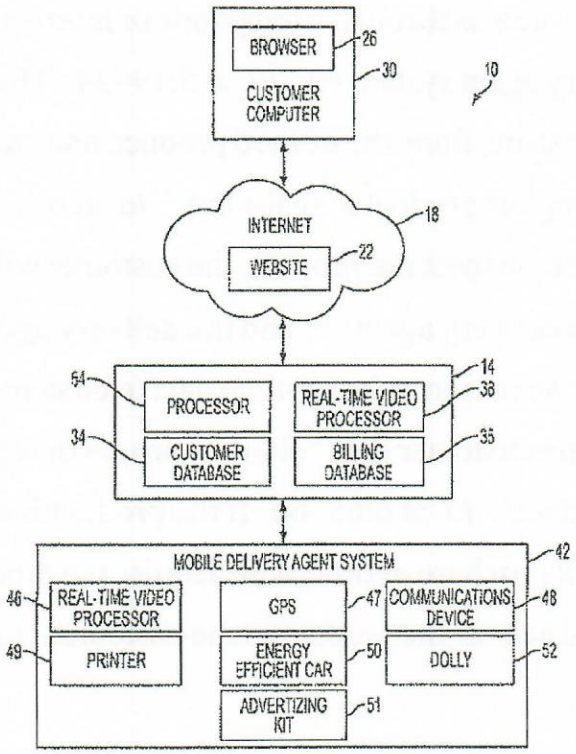


FIG. 1

Figure 1 depicts a customer computer 30 accessing a service provider's server 14 over the internet. *Id.* at 2:52–58. Server 14 communicates with a plurality of mobile delivery agent systems 42. *Id.* at 3:9–11. Each mobile delivery agent system 42 includes a real-time video processor 46, global positioning system (GPS) 47, and a communications device 48. *Id.* at 3:11–14. A customer contacts the service provider through the system depicted in Figure 1 and receives information regarding delivery agents in the vicinity of the store where they would like the delivery agent to obtain a product. *Id.* at 4:21–36.

Once the delivery agent is selected, "a customer shopping or acquisition request and profile is sent to the delivery agent . . . and a communications link is established between the customer and the selected delivery agent . . . such as through a telephone or internet connection" using the mobile delivery agent system 42. *Id.* at 5:19–24. The delivery agent then travels to the store, finds the desired product, and "the customer has the option of inspecting the product in real-time." *Id.* at 6:33–55. "If the customer chooses to inspect the product, the customer will communicate instructions to the delivery agent . . . and the delivery agent will utilize real-time video device 46 to transmit real-time data to customer computer 30." *Id.* at 6:55–58. The customer then "either approves or rejects acquisition of the inspected product." *Id.* at 6:65–66. If the product is approved, "the delivery agent will purchase or otherwise acquire the product on behalf of the customer" and deliver the product to the customer. *Id.* at 7:7–14.

C. The Challenged Claims

Of the challenged claims, claims 1 and 13 are independent. Neither party disputes that claims 1 and 13 recite similar limitations. Claim 1, reproduced below, is illustrative of the claimed subject matter (with emphasis added for claim limitations in dispute):

> 1. A method for remote acquisition and delivery of goods comprising:
>
> deploying a plurality of delivery agents of a service provider to various geographic locations, each delivery agent having a mobile delivery agent system in communication with at least one remote server, wherein each mobile delivery agent system includes: a real-time video device, a global positioning device, and a communication device;
>
> *receiving a first acquisition request from a first customer for a set of one or more goods;*
>
> obtaining information, including location information based on signals from the global positioning devices and availability status information, on the plurality of delivery agents;
>
> obtaining a selection of one of the plurality of delivery agents for fulfilling the first acquisition request;
>
> deploying one of the plurality of delivery agents to a location having the first set of one or more goods;
>
> *electronically transferring an image of the first set of one or more goods to the first customer using the real-time video device;*
>
> *acquiring the first set of one or more goods via the delivery agent;* and
>
> delivering the first set of one or more goods to a delivery site selected by the first customer.

Ex. 1001, 9:44–10:2.

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D. The Asserted Challenges

Claims Challenged	35 U.S.C. §	Basis
1, 8, 9, 13–15	103(a)	Park,[1] Kim[2]
5, 16, 17	103(a)	Park, Kim, Hileman[3]
4	103(a)	Park, Kim, Pugliese[4]

In further support of these challenges, Instacart relies on the declarations of Dr. Henry Houh. *See* Exs. 1003, 1044. Consumeron relies on the declaration of Dr. Michael Mitzenmacher. *See* Ex. 2016.

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Instacart submits that one skilled in the art would have had "a bachelor's degree in electrical engineering, computer engineering, computer science, or equivalent training, and approximately two years of experience working in the field of electronic commerce" and that "[l]ack of work experience can be remedied by additional education, and vice versa. Pet. 13 (citing Ex. 1003 ¶ 24). Consumeron responds that one skilled in the art would have been "someone with a background in electrical engineering, computer science, or the like," but that "industry experience can make up for a lack of technical training, and more education can make up for a lack of industry experience." PO Resp. 9 (citing Ex. 2016 ¶¶ 17–20).

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[1] WO 01/11523 A1, published Feb. 15, 2001 (Ex. 1005) ("Park").
[2] Certified translation of KR2003-0085802, published Nov. 7, 2003 (Ex. 1006); corrected certified translation of Figure 2 (Ex. 1038); and original Korean language version (Ex. 1007) (collectively, "Kim").
[3] US 2003/0040944 A1, published Feb. 27, 2003 (Ex. 1009) ("Hileman").
[4] US 2002/0072974 A1, published June 13, 2002 (Ex. 1010) ("Pugliese").

We discern no material difference between the levels of skill in the art espoused by the parties. Nor does Consumeron's expert. *See* Ex. 2016 ¶ 20 ("Petitioner's definition of a POSITA is not materially different from my definition."). Accordingly, we adopt the level of skill in the art as defined by Instacart.

B. Claim Construction

1. "acquisition request"

The parties dispute the meaning of "acquisition request" as recited in independent claims 1 and 13. *See* PO Resp. 9–12; Pet. Reply 1–6; PO Sur-Reply 2–8. Consumeron argues that "acquisition request" should be construed to mean "a request for an agent *to shop* for goods on a customer's behalf." PO Resp. 9 (emphasis added). Instacart argues, on the other hand, that "[n]either the intrinsic nor extrinsic evidence, however, requires the agent to "shop" or even make a purchase." Pet. Reply 1–2. According to Instacart, "the agent must simply acquire goods, consistent with the plain language of the claim" and "[i]t would be improper to narrowly require shopping when Consumeron elected to broadly claim *all* types of '*acquisition request[s].*'" *Id.* at 2.

We previously construed the term "acquisition request" in the related 865 IPR to encompass "not only a request for an agent to shop for and purchase goods for delivery to a customer, but also to encompass a request for a delivery agent to simply pick up and deliver goods that have been pre-purchased by the customer." *See* Ex. 3006, 9–11 (granting institution in conjunction with construing "acquisition request"). As noted above in Section I.A ("Related Matters"), the 865 IPR centers on the '465 patent, whose lineage derives from the same application—the '867 application—as

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the '594 patent challenged here. *Compare* Ex. 1001, code (21) (referencing Appl. No. 12/711,867), *with* Ex. 3005, code (63) (also referencing Appl. No. 12/711,867). Indeed, the '594 and '465 patents share essentially identical specifications and figures. Thus, based on the final record before us (as discussed below) and consistent with our prior construction in the related 865 IPR and, we likewise determine here that Instacart's construction of "acquisition request" is the more reasonable one. *See SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1316 (Fed. Cir. 2015) ("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)).

More specifically, as we explained in the 865 IPR, the specification does not equate an "acquisition request" exclusively with a shopping or purchase request. *See* Ex. 3006, 10–11. Rather, the specification repeatedly uses the phrase "purchase *or otherwise* acquire" to indicate that a delivery agent may acquire goods by means other than purchasing or shopping. *See, e.g.*, Ex. 1001, 4:58–60 ("[T]he user specifies the exact location from which the selected delivery agent is to *purchase or otherwise acquire* the product, such as a retail store location."); *id.* at 7:7–9 ("If the product is approved at 120, the delivery agent will *purchase or otherwise acquire* the product on behalf of the customer at 121."); *id.* at 2:9–12 ("[T]he user provides the service provider with information regarding the type of product desired and the shopping or acquisition location from which the user desires to *purchase or otherwise obtain* the product.") (emphases added).

Consumeron's argument that the specification "uses the word 'or' to refer to things that are synonymous to each other" is not persuasive. *See* PO Resp. 10; PO Sur-Reply 4 (essentially same). As noted above, the specification uses the phrase "purchase or *otherwise* acquire." Ex. 1001, 4:58–60, 7:7–9 (emphasis added); *see also id* at 2:9–12 (similar). By including the adverb "otherwise," the specification makes clear that purchase and acquire are not used synonymously, but rather that acquiring is broader and encompasses other ways of obtaining a product. *See* Ex. 1039, 1 ("otherwise" means "in a different way or manner").

Indeed, the specification unequivocally describes instances where the delivery agent acquires a product without purchasing or shopping for it. For instance, the specification explains that the customer may "pre-purchase[]" goods such that the customer requests simply that the delivery agent "pick-up" of the goods:

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

Id. at 7:33–40 (emphases added). Even more explicitly, the specification states:

> [A]lthough discussed in the context of a customer who wishes to purchase a product, it should be understood that system 10 may be utilized *to schedule both pick-ups and delivery of any type of goods, including free goods*.

Id. at 9:18–21 (emphasis added). Those disclosures collectively indicate that a delivery agent can fulfill an acquisition request *without* necessarily shopping for or purchasing goods.

Consumeron attempts to distinguish those descriptions, urging that they refer to an "alternative" embodiment that "does not expand the meaning of the term 'acquisition request' beyond its ordinary meaning." PO Sur-Reply 4–5. But that argument is premised on an incorrect assumption that the ordinary meaning is limited to purchasing or shopping. Here, nothing in the intrinsic record suggests that the term "acquisition request" excludes the specification's embodiments where "pre-purchased" or "free" goods are only in need of "pick-up." To the contrary, as noted above, the specification repeatedly states the delivery agent may "otherwise acquire" goods without purchasing them, thereby, indicating that the agent can fulfill an acquisition request *without* necessarily shopping for the goods on the customer's behalf. *See* Ex. 1001, 4:58–60, 7:7–9.

Extrinsic evidence also favors Instacart's position. In particular, Instacart cites dictionary definitions of "acquire" that contemplate acquiring something by means other than purchasing or shopping. *See* Ex. 1042, 1 ("If you acquire something, you buy or obtain it for yourself, or someone gives it to you."); Ex. 1043, 1 ("acquire" means "to come into possession or control of often by unspecified means"). In contrast, the narrower definition Consumeron cites is not persuasive because it comes from an unrelated statute, 16 U.S.C. § 620, and provides a meaning intended specifically within the context of that statute.[5] PO Resp. 12 (citing Ex. 2018). Consumeron does not explain why that definition should apply outside the context of that statute, much less demonstrate it reflects the understanding of one skilled in the art here.

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[5] The cited statute relates to the "conservation of forest resources." *See* Ex. 1046 (stating the purpose of 16 U.S.C. § 620(b)(1)).

Moreover, Consumeron's extrinsic definition conflicts with the description of "acquire" in the specification, which, as explained above, expressly contemplates a broader meaning of acquiring, such as picking up a product without requiring the agent to shop for it. Thus, to the extent Consumeron's extrinsic definition conflicts with the specification, we do not give it any weight. *See Phillips v. AWH Corp.*, 415 F.3d 1303, 1314 (Fed. Cir. 2005) (en banc) (explaining that an extrinsic definition may be consulted "so long as th[at] definition does not contradict any definition found in or ascertained by reading of the patent documents") (internal quotations omitted).

For all the above reasons, we reject Consumeron's argument that "acquisition request" is limited to a request for an agent to *shop* for goods. Rather, we agree with Instacart that "acquisition request" has its ordinary meaning, which encompasses but is not limited to purchasing or shopping and includes other means of acquiring a product. Accordingly, consistent with the record here and our construction in the related 865 IPR, we construe "acquisition request" to include 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.

2. "real time"

In instituting trial here, we adopted a construction of "real-time" consistent with the way the district court construed the term in the Delaware action, that is, "real time" means "data that is passed along as it is gathered." *See* Inst. Dec. 5 (citing Ex. 1034, 2; Ex. 1035, 22–26).[6] Notably, that is the

[6] We cite to the original pagination of Exhibit 1035, which is the district court's "Memorandum Opinion" on claim construction.

very construction Consumeron advocated before the district court. *See* Ex. 1035, 4. Now, having seen Instacart's challenges, Consumeron proposes that we alter that construction because the district court allegedly "accepted" that the term "does not include any 'intentional delay' in the transmission." PO Resp. 13 (citing Ex. 1035, 22, 26); *see also* PO Sur-Reply 11–12 (essentially same).

Although the district court considered "intentional delay" in the course of construing "real time," the district court does not appear to have accepted Consumeron's narrower construction in that regard. More accurately, the district court stated it "sees no reason that a 'real-time' transmission of data could not both involve no inherent delay *and permit a system that requires multiple 'clicks' to operate*." Ex. 1035, 24 (emphasis added). In addition, the district court quoted from a technical dictionary, which provided:

> The basic definition of real-time data is that it is data that is not kept or stored, but is passed along to the end user as quickly as it is gathered. It is important to note that real-time data does not mean that the data gets to the user instantly. There may be any number of bottlenecks related to the data collection infrastructure, the bandwidth between various parties, or even just the slowness of the end user's computer. Real-time data does not promise data within a certain number of microseconds. It just means that the data is not designed to be kept back from its eventual use as it is collected.

Id. at 25 (citing "Technopedia").

In other words, the district court contemplated that real-time data includes data that is transmitted as it is gathered *despite some inherent delay* in transmitting and accessing the data, such as bottlenecks in the infrastructure, slowness of the user's computer, or "multiple clicks" by the

user. With that in mind, we reject Consumeron's attempt to alter our construction of "real-time" to exclude so-called "intentional delay." Thus, consistent with the district court and our institution decision, we maintain that "real-time" transmission means "data that is passed along as it is gathered."

3. "mobile delivery agent system"

In our institution decision, we adopted a construction of "mobile delivery agent system" consistent with the way the term was construed in the Delaware action, namely, "a mobile system that includes at least a device to capture video or still images and a device set up to communicate with a remote server." *See* Inst. Dec. 4–5 (citing Ex. 1034, 1; Ex. 1035, 13–17). Neither party disputes that construction. *See* PO Resp. 12 (adopting our construction); Pet. Reply 1–7 (disputing only the meaning of other claim terms). Thus, we maintain our construction as stated above.

4. order of steps

Consumeron contends that the challenged claims should be construed such that the claimed step of "transferring" an image of goods to a customer "happens before" the step of "acquiring" the goods via the delivery agent. PO Resp. 26; *see also* PO Sur-Reply 9 ("The claims and specification require that the step of transferring an image of goods to a customer occurs *before* acquiring the goods via the agent.").

In the Delaware action, however, Consumeron contended that the claimed "[s]teps do not need to be performed in order," but "can be performed before or after the previous recited step." Ex. 1027, 17–18.[7] The

[7] We cite to the original pagination of Exhibit 1027.

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district court agreed and adopted a construction that "the steps of method claims do not need to be performed in order unless the claim recites an order." Ex. 1035, 11. To that end, the district court noted that the specification of the '594 patent states, unequivocally, 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." *Id.* at 10 (citing "'594 Patent at 9:36–39" (emphasis added)). That acknowledgement in the '594 patent comports with Consumeron's representation to the district court that the steps as claimed need not be performed in a specific order.

In any event, we need not resolve the issue of Consumeron's seemingly conflicting positions because Instacart shows that the asserted combination of Park and Kim performs the steps in the order that Consumeron now proposes here, as explained below.

C. Instacart's Challenge of Independent Claims 1 and 13 Based on Park and Kim

We begin with Instacart's challenge of independent claims 1 and 13 as being obvious over the combined teachings of Park and Kim. *See* Pet. 17–38, 42–49. In challenging those claims, Instacart submits a detailed mapping of how Park and Kim satisfy each of the recited claim elements. *See id.* at 25–38 (claim 1), 42–49 (claim 13). Instacart also explains why one skilled in the art would have been motivated to combine their respective teachings with a reasonable expectation of success of arriving at the claimed invention. *See id.* at 20–25.

Consumeron raises essentially five arguments in response to Instacart's showing for claims 1 and 13. *See* PO Resp. 21–48. According to Consumeron, Instacart:

(1) fails to show the asserted Park-Kim combination discloses the delivery agent receiving an "acquisition request" from the customer (*id.* at 22–24);

(2) fails to show the asserted Park-Kim combination discloses the delivery agent "acquiring the . . . goods" for the customer (*id.* at 24–25);

(3) fails to show the asserted Park-Kim combination discloses the delivery agent "transferring an image" of the goods to the customer *before* "acquiring the . . . goods" (*id.* at 25–27);

(4) fails to show the asserted Park-Kim combination discloses the delivery agent communicating with the customer in "real-time" (*id.* at 27–32); and

(5) fails to articulate a sufficient reason to combine Park and Kim (*id.* at 32–48).

In raising these arguments, Consumeron argues independent claims 1 and 13 together. *See* PO Resp. 21–22, 24, 32 (applying arguments to Claims 1 and 13). We address each of Consumeron's arguments in the order raised by Consumeron. And, although we may focus on Consumeron's arguments to identify the issues in dispute, we never shift the ultimate burden from Instacart to prove unpatentability of the challenged claims. 35 U.S.C. § 316(e) (2018); *see also Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) ("In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable."); *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (explaining specific burdens in *inter partes* review).

1. "receiving a first acquisition request from a first customer"

To begin, Consumeron argues that the asserted Park-Kim combination lacks disclosure of the "acquisition request" recited in the "receiving" step of

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claims 1 and 13. *See* PO Resp. 22–24. According to Consumeron, "Park's disclosure of a customer shopping and placing an order for goods is not an 'acquisition request' because there is no request for an agent to shop on behalf of the customer." *Id.* at 22. Instead, "the customer [in Park] has already shopped for and purchased the product before the delivery agent arrives to pick up and deliver it." *Id.* at 23; *see also id.* at 24 ("[Park's] order is not an 'acquisition request' because the goods have already been purchased by the customer.").

We are not persuaded for the simple reason that Consumeron premises its argument on an overly narrow and incorrect construction of "acquisition request." As discussed above, when properly construed, "acquisition request" is not limited to a request for a delivery agent to shop for and purchase goods, but rather also encompasses a request for the agent simply to pick-up and deliver goods that have been pre-purchased by the customer. To that end, Consumeron concedes that the asserted Park-Kim combination discloses a delivery agent picking up goods that have been pre-purchased. *See* PO Resp. 23 (conceding "Park at 3:10–19" discloses "the customer has already shopped for and purchased the product before the delivery agent arrives to pick up and deliver it"). Thus, we find that the asserted Park-Kim combination's disclosure of a delivery agent picking up pre-purchased goods for delivery to a customer meets the claimed "acquisition request."

2. "acquiring the . . . one or more goods via the delivery agent"

Similarly, Consumeron argues that the asserted Park-Kim combination lacks the subsequently-recited step in claims 1 and 13 of "*acquiring* the first set of one or more goods via the delivery agent." PO Resp. 24–25 (emphasis added). According to Consumeron, Instacart's

showing that Park teaches this limitation "is inconsistent with the plain meaning of the term 'acquire' and the explicit distinction drawn in the specification between a delivery agent 'acquiring' goods and merely picking up and delivering goods already purchased by the customer." *Id.* at 25. But, this argument, like Consumeron's argument with respect to "acquisition request," is premised on a misunderstanding that "acquiring" excludes simply picking-up goods. It does not. Nor do we see any meaningful distinction between the meaning of "acquiring" and "acquisition" as used in the claims, and Consumeron does not argue otherwise. Thus, because the asserted Park-Kim combination indisputably discloses that a delivery agent *picks-up* goods that have been pre-purchased, we reject the notion that Park fails to meet the claimed step of "acquiring the first set of one or more goods via the delivery agent."

3. order of the steps of "transferring an image" and "acquiring the . . . one or more goods"

Next, Consumeron argues that claims 1 and 13 require that the step of "transferring an image" of the goods to the customer occurs "before" the step of "acquiring the . . . goods via the delivery agent." PO Resp. 25; *see also id.* at 26 ("In light of the intrinsic record, and the wording of the claims, the electronic transfer of an image happens before the goods are acquired."). According to Consumeron, "[i]n Park, the goods are paid for and packaged at a warehouse *before* a delivery agent arrives for pick up," while "[i]n Kim, likewise, the goods are purchased online from the delivery service provider *before* that same delivery service provider (*i.e.* the merchant) captures images of the purchased goods. *Id.* at 26–27 (citing Ex. 1005, 48:12–23; Ex. 1006, 2). With that in mind, Consumeron surmises that "the Park-Kim

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combination would, at best, result in taking pictures of products *after* the customer places an order and purchases the products via a website." *Id.* at 27.

We disagree. To the extent Park does not *explicitly* teach that the delivery agent transmits images of the goods themselves to the customer before the agent acquires them, i.e., picks them up, Instacart points to Kim's teaching that—

> "Upon receiving an order of a product from a customer . . . a delivery service provider uses his/her mobile communication terminal equipped with a digital camera *to capture an image of the product ordered by the customer*" and "*send the images to the customer real-time* so that the product ordered . . . can be confirmed."

Pet. 36 (quoting Ex. 1006, Abstract, 2, respectively). Those disclosures by Kim collectively teach that the delivery agent (i.e., "delivery service provider") uses their mobile device to send an image of the ordered product to the customer before the customer confirms whether the delivery agent may proceed to acquire the product.

Consumeron contends that "the goods [in Kim] are *purchased* online from the delivery service provider *before* that same delivery service provider (*i.e.* the merchant) captures images of the purchased goods." PO Resp. 27 (first emphasis added). But that contention erroneously equates the customer's online order of a product with the delivery agent's acquisition of the product for delivery. Nowhere does Kim characterize the delivery agent as acquiring the product based simply on the fact of a customer ordering the product. Instead, as taught by Kim, the delivery agent's acquisition of the product hinges on the customer first seeing an image of the product and giving their approval.

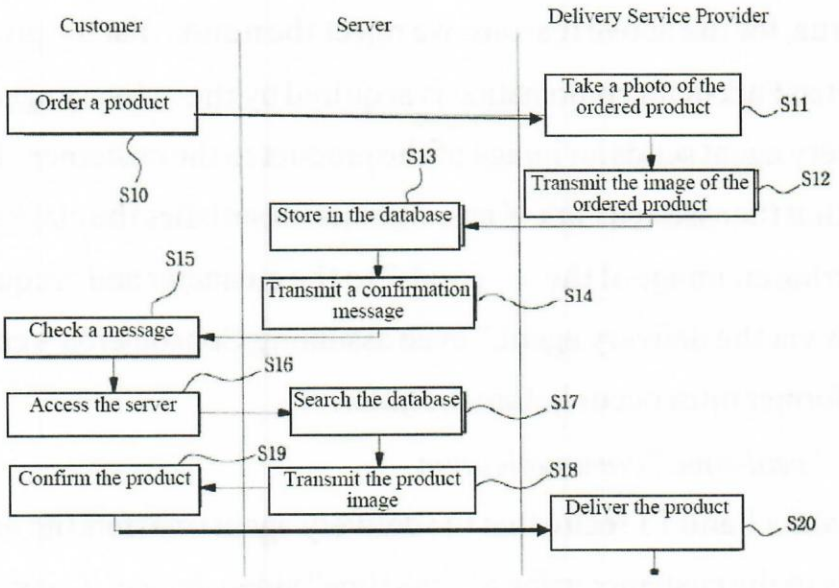
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More specifically, Kim describes the process by which the delivery agent ultimately acquires the product on behalf of the customer as follows:

> Step 1, wherein a customer places an order of a product to a delivery service provider via phone, fax or the Internet, *which prompts the delivery service provider to capture an image or video of the ordered product through a mobile communication terminal equipped with a digital camera and transmits the image to a server*; and
>
> * * *
>
> Step 4, *wherein the server searches the database to transmit the image or video of the product ordered by the customer to the customer's mobile communication terminal*; and
>
> Step 5, wherein the customer uses his/her own mobile communication terminal to receive the image or video of the ordered product and confirm the product; and
>
> Step 6, wherein the delivery service provider delivers the product to the intended recipient upon the customer's confirmation of the product.

Ex. 1006, 3 (emphases added). Figure 2 of Kim, reproduced partially below, likewise illustrates the process.

FIG. 2



Ex. 1038, 2.

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In our view, one skilled in the art reasonably would have understood, from the above description and figure in Kim, that only after the delivery agent sends an image of the ordered product to the customer, and only after the customer inspects the image and confirms the product, does the delivery agent actually acquire the product for delivery to the customer. Ex. 1003 ¶¶ 51, 55–56. Conversely, where the customer rejects the product, one skilled in the art logically would have recognized that the delivery agent would not acquire the product, much less bill the customer for the rejected and undelivered product. Thus, in Kim, we find that the delivery agent's transmittal of images to the customer precedes the delivery's agent's acquisition of the product.

Neither Consumeron nor its expert ever addresses Kim's explicit disclosure of that scenario. Instead, they make the erroneous assumption that a customer ordering a product in Kim is the same as a delivery agent acquiring the product. *See* PO Resp. 27 (citing Ex. 2016 ¶ 68); PO Sur-Reply 9–10. As explained above, that is not the case.

Thus, for the above reasons, we reject the notion that the product in the asserted Park-Kim combination is acquired by the delivery agent *before* the delivery agent sends an image of the product to the customer. Rather, we find that the asserted Park-Kim combination satisfies the claimed steps of "transferring an image of the . . . goods" to the customer and "acquiring the . . . goods via the delivery agent," even assuming Consumeron's contention that the former must occur before the latter.

4. "real-time" communication

Claims 1 and 13 recite that the delivery agent transfers the image of the goods to the customer using a "real-time" video device. Consumeron

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contends that "Park taken alone or in combination with Kim fails to teach or suggest real-time communications of a product image from an MDAS to a customer because, *both Park and Kim send images to a server with a customer having to make a request to the server for those images*, which introduces 'intentional delay' in the transmission of data." PO Resp. 28 (emphasis added); *see also id.* at 30 ("[Park's] system is designed with a web server that intentionally stores and delays any transmission."); *id.* ("Kim, like Park, also transmits images to a server and not the customer (which introduces intentional delay)."). In other words, according to Consumeron, the fact that the asserted Park-Kim combination sends images through a server, to which the customer must request access, precludes the images from being sent in real-time. We disagree.

At the outset, we note that nothing in the claim language excludes the transmission of images through a web server. Indeed, the claims themselves expressly require a "server," reciting that the delivery agent's mobile device is "in communication with at least one remote server" for communicating images to the customer. Ex. 1001, 9:47–49 (claim 1), 10:62–64 (claim 13). Thus, the terms "server" and "real time" are not mutually exclusive.

Moreover, we are not persuaded by Consumeron's argument that, because the customer in the asserted Park-Kim combination must request access to the web server, the transfer of the image cannot be in real-time. *See* PO Resp. 28–31; PO Sur-Reply 14. That argument fails for the simple reason that the preferred embodiment in the challenged '594 patent contemplates just such a scenario. For instance, as shown in Figure 1 of the '594 patent and described in the specification, real-time communication between customer computer 30 and delivery agent mobile device 42 occurs

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through "server 14," which includes "real-time video processor 38." Ex. 1001, 2:52–58, 3:6–14, Fig. 1. Importantly, like the Park-Kim combination, the '594 patent explains that the delivery agent notifies the customer that real-time video of the product is available through the web server, which the customer must choose to access in order to view real-time images of the product.

> The delivery agent then enters the shopping location and identifies the product of interest. The delivery agent then 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. *If the customer chooses to inspect the product, the customer will communicate instructions to the delivery agent at 118, and the delivery agent will utilize real-time video device 46 to transmit real-time data to customer computer 30*. . . . Next, the customer either approves or rejects acquisition of the inspected product.

Id. at 6:50–66; *see also id.* Fig. 3 (showing an alert is sent to the customer (step 116) notifying them of the availability of real-time video of the product).

Thus, according to the '594 patent itself, only if the customer actively chooses to access the real-time video via the server will the customer be able to see real-time images of the product. Neither Consumeron nor its expert persuasively explains why the preferred embodiment in the '594 patent, where the customer must actively choose to interact with the web server in order to see the real-time video, does not introduce the same "intentional delay" that Consumeron contends is present in the asserted Park-Kim combination, where the customer likewise must request access to the web server in order to see the real-time video. *See* PO Resp. 28–32 (citing Ex. 2016 ¶¶ 70–78). Indeed, both experts agree that personal computers

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"typically" receive data from web servers by making "requests." *Compare* Ex. 1045, 32:12–33:14 (Consumeron's expert testifying), *with* Ex. 1044 ¶ 54 (Instacart's expert agreeing). Thus, we reject the notion that a customer having to request access to a server in order to view real-time data introduces the sort of delay that places such a scenario outside the scope of the claims. Instead, similar to the preferred embodiment in the '594 patent, the intervening server in the Park-Kim combination, with which the delivery agent interacts to send images and the customer interacts to receive images, falls squarely within the scope of the claims.[8]

More specifically, Park discloses that the delivery agent uses a "mobile digital camera" to provide online customers with a "live video feed" that is presented through a "web server . . . over the Internet." Ex. 1005, 48:10–20. The delivery agent's live video feed "allow[s] customers to interactively view, *in real-time*, the progress of [their] order, from reception and compilation to delivery . . . by the delivery agent." *See id.* at 4:27–32. Although Park may not specify explicitly that viewing the progress of the order in real-time includes viewing the goods themselves while they are being compiled, Kim nonetheless does, teaching that the agent uses their mobile device to send an "image or video of the ordered product" at the

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[8] To the extent Consumeron attributes intentional delay to a customer taking certain steps, such as "multiple clicks," in order to request access to the server, we are not persuaded. *See* PO Sur-Reply 14. As discussed above, we agree with the district court's findings in the Delaware action that such steps are inherent to the technology being used. *See* Ex. 1035, 22 (finding that "real-time" transmission of data "does not . . . exclude any delay 'based on the laws of physics and the technology you are using.'"); *see also id.* at 24 (finding "no reason that a 'real-time' transmission of data could not . . . permit a system that requires multiple 'clicks' to operate").

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seller's location prior to delivery. Ex. 1006, 3–4. Accordingly, the Park-Kim combination discloses that the agent transmits images of goods to a customer "in real-time," as required by the claims. *See* Ex. 1003 ¶¶ 86–89; Ex. 1044 ¶¶ 48–54, 57–61.

To the extent Consumeron contends that Park "is designed with a web server that intentionally stores and delays any transmission" of the live video feed, we disagree. *See* PO Resp. 29–30 (citing Ex. 2016 ¶ 73). Although Consumeron cites the testimony of its expert in support of that notion, nowhere does that cited testimony ever say that Park's web server "stores" the live video feed. *See* Ex. 2016 ¶ 73. Instead, Consumeron's expert opines on two points that we previously found meritless (in preceding paragraphs), namely, (1) that Park's live video feed sends images of "packaged" goods to the customer, not "images of the products," and (2) that Park's live video feed can only be accessed "by making a separate request to the server." *See id.*

The first point simply faults the *content* of the live video feed in Park while saying nothing about Park's server, and the second point simply faults the customer's *request* to access the server while saying nothing about how Park's live video feed is actually being processed through the server. In contrast, Park makes clear that, upon accessing the web server, "[t]he web server will then present the video over the Internet," which can be done "in many ways," one of which is to provide "every customer with a live video feed." Ex. 1005, 48:10–20. Thus, we reject, as unsupported and conclusory, Consumeron's contention that Park somehow "stores" the live video before it reaches the customer. Neither Park itself nor Consumeron's expert supports such a theory.

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Similar to Park, Kim provides a delivery agent (i.e., "delivery service provider") with a mobile device "equipped with a digital camera." Ex. 1006, Abstract. Using the mobile device, Kim's delivery agent "capture[s] an image of the product ordered by the customer and transmits it to a server." *Id.*; *see also id.* at 3 (Step 1), Fig. 2 (S11–S13). "[T]he server transmits a confirmation message to the customer . . . and then transmits the image of the ordered product to the customer who has checked the message so that the customer can confirm whether the product ordered is identical to the product being delivered." *Id.*, Abstract; *see also id.* at 3 (Steps 2–5), Fig. 2 (S14–S18). Importantly, Kim teaches that, once the customer receives notice from the delivery agent via the server (i.e., "confirmation message to the customer"), the transmission of images to the customer may take place "in real time"—

> [T]his invention is intended to enhance the reliability of the delivery services . . . by capturing images of the entire delivery service process, such as a product ordered, . . . and *transmitting the images in real time to the customer* who ordered the product.

Id. at 2 (emphasis added). Only after the customer "receive[s] the image" and "confirm[s] the product" will the delivery agent acquire the product for delivery to the customer. *Id.* at 3 (Step 6)

Although Kim states that "the server stores the image" while prompting the customer to confirm the product in the image, nowhere does Kim foreclose the customer from viewing images in real time once the customer accesses the web server and begins communicating with the delivery agent to confirm product images. Indeed, one skilled in the art would have understood as much because "Kim is explicit that the [delivery

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agent's mobile] terminal 'transmit[s] the images *in real time* to the customer." Ex. 1044 ¶¶ 58–61 (quoting Ex. 1006, 2). Granted, in some instances, the customer may not quickly respond to the system message requesting that the customer begin the confirmation process, in which case product images will be stored on the server for later viewing by the customer. But where the customer promptly responds to the system message and accesses the live video feed through the server, one skilled in the art reasonably would have understood from the combined teachings of Park and Kim that the video's images are being viewed by the customer in real time, i.e., as they are being gathered and sent to the server from the delivery agent's mobile terminal. *See id.* ¶ 51 ("*[E]ven if* the first video frame has 'intentional delay' because of the initial request, as [Consumeron] asserts, none of the subsequent frames have any 'intentional delay' and instead, those frames are passed along as they are gathered without any further action needed by the customer.").

For all the above reasons, we find that Park, as modified by Kim, teaches or suggests the claimed step of the delivery agent transmitting images of goods to the customer using a "real-time video device," as required by claims 1 and 13. By modifying Park's teaching of the delivery agent transmitting a live-video feed to the customer while compiling an order with Kim's teaching of the delivery agent transmitting product images in real time to the customer via the web server, one skilled in the art would have recognized that, upon establishing communication with the web server, the customer indisputably receives and views product images on the live video feed as they are gathered, i.e., in real time, despite having to undertake

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the initial step of accessing the server to do so. *See* Ex. 1003 ¶¶ 86–89; Ex. 1044 ¶¶ 48–54, 57–61.

5. Reason to combine Park and Kim

Consumeron also raises several arguments in dispute of Instacart's reason for combining Park and Kim. *See* PO Resp. 32–48. As an initial matter, Consumeron argues that Instacart's reason for combining Kim with Park is flawed because it "relies on a fundamental misunderstanding of Kim's disclosure." *Id.* at 33. According to Consumeron and its expert, Kim's "delivery service provider" is actually the "seller" from which products are ordered, and "not an agent" who fulfills the order and delivers the products as disclosed in Park. *Id.* at 34 (citing Ex. 2016 ¶¶ 51–55, 80, 81, 91, 92). We disagree.

To begin, Kim draws a clear distinction between a "seller" and a "delivery service provider." Ex. 1006, 2–3; Ex. 1044 ¶¶ 70–72. As background, Kim explains that "a customer purchases a product either by visiting a seller in person or by ordering the product . . . without visiting the seller in person . . . whereby the seller has the ordered product delivered to the customer." Ex. 1006, 2. But when describing the "invention," Kim refers exclusively to a "delivery service provider" and not the "seller." *Id.* at 3. It is this "delivery service provider" who obtains images of the product, transmits the images through a server to the customer, and receives instructions back from the customer confirming the product. *Id.*; *see also* Ex. 1038, Fig. 2.

Nothing in Kim suggests that the delivery service provider must be the same entity that actually sells the ordered product. Indeed, the term "delivery service provider" itself suggests an entity that provides delivery

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services as opposed to the seller of goods. Thus, even if Kim does not expressly state that the seller and delivery service provider are two separate entities, it nonetheless reasonably suggests a delivery agent, as opposed to a seller, who travels to the seller's location to shop on the customer's behalf. *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007) ("A person of ordinary skill is also a person of ordinary creativity, not an automaton."). For these reasons, the overly restrictive interpretation of Kim advanced by Consumeron and its expert is not credible.

Consumeron also contends that "modifying Park's warehouse-based delivery model as suggested in the Petition would impermissibly alter Park's principle of operation as viewed through the lens of its contribution to the art." PO Resp. 35. According to Consumeron, Kim's teaching of an agent that obtains an image of the product could not be factored into Park's system because Park's goods are already packaged by the time the delivery agent picks them up. *Id.* at 35–38. Consumeron asserts that the additional time required to unpackage the goods, transmit an image, await customer confirmation, and then repackage the goods for delivery would alter Park's inventive concept by destroying its basic objective of "one-hour delivery." *Id.* at 38–41.

Again, we disagree with Consumeron. As Instacart points out, Park's system and method is not limited to one-hour delivery. *See* Pet. Reply 19. To the contrary, Park teaches that items can be "delivered within the hour *or* within a customer specified delivery window" exceeding an hour. Ex. 1005, Abstract (emphasis added), 20:9–12 (describing "processing orders for deferred delivery (i.e. those *not* required to be delivered in the next hour)" (emphasis added)); *see also* Ex. 1044 ¶ 29. Moreover, while Park places

some emphasis on delivery time, it also explains that its goal is to promote customer satisfaction. *See* Ex. 1005, 30:16–18 (increasing "dispatch efficiency and customer satisfaction"), 34:5–7 (resequencing delivery "to ensure 100% customer satisfaction"). In that regard, the reason that Instacart articulates for combining Park and Kim dovetails with Park's objective of improving customer satisfaction by ensuring the product to be delivered is acceptable to the customer. *See* Ex. 1044 ¶ 65 ("[A] POSITA would have understood that a customer ordering goods would care little if an unacceptable product was delivered quickly.").

Consumeron's arguments also overstate the impact the combination would have on Park's delivery time. Much of Consumeron's and its expert's testimony interpreting Park are premised on an "e-Dreams film"[9] and other exhibits relating to a "Kozmo.com system," which Consumeron contends is the system disclosed in Park. *See* PO Resp. 37–40; PO Sur-Reply 19–20; Ex. 2016 ¶¶ 48, 86, 88, 89, 97, 100, 101 (citing Exs. 2023–2029). Although these extraneous exhibits may reflect a commercial implementation of some aspects of Park's system, they certainly do not limit the teachings of Park itself, nor do they evidence how one skilled in the art would have approached the combination of Park and Kim as asserted in the Petition.

Consumeron's argument that Park's delivery agent would have to "unpackage . . . meticulously packaged" goods, "wait" for confirmation

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[9] According to Consumeron, the e-Dreams film is a "documentary film (2002), *available at* <https://www.youtube.com/watch?v=j847rYNo2G0>." PO Resp. 17. Although Consumeron's response includes what appears to be screenshots from that film, the film itself was not filed as an exhibit. *See id.* at 17, 37 (lacking exhibit numbers). Accordingly, the e-Dreams film is not record evidence, but, even if it was, our findings would be the same.

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from the customer, and then "repackage" the goods is not supported by the actual teachings in Park. *See* PO Resp. 35–36 (citing Ex. 2016 ¶¶ 84, 94). More accurately, Park simply teaches that products at the distribution center are placed in "bags suitable for being carried by a delivery agent to the customer's delivery location." Ex. 1005, 16:24–28; Ex. 1044 ¶ 32. One skilled in the art would have recognized, as a matter of "ordinary creativity," that Park's packaging process could easily be modified to accommodate Kim's technique of enhancing the reliability of the delivery such that the delivery agent would take a picture of the goods before placing the goods in the bag for delivery. Ex. 1044 ¶ 68. While this may add time to the process, we find persuasive the testimony of Instacart's expert that the delay would be relatively small and offset by other benefits, such as enhanced reliability of the delivery and customer satisfaction, or mitigated by providing the confirmation as an "option" to the customer along with an advisory message that such confirmation "may add time to his or her order." Ex. 1003 ¶¶ 56–58; *see also* Ex. 1044 ¶¶ 65–80 (rebutting the testimony of Consumeron's expert). In contrast, the competing testimony of Consumeron's expert is less compelling because it overemphasizes Park's focus on one hour delivery, while largely ignoring the benefits one skilled in the art would have understood from combining the teachings of Park and Kim. *See* Ex. 2016 ¶¶ 84–116.

Finally, Consumeron's arguments that "[Instacart] fails to square Park's warehouse-based model with Kim's technique to show *how* the specific modification would even work" or "*would be* factored into Park's intelligent routing algorithm" are unavailing. PO Resp. 41–47. Consumeron's arguments do not reflect the proper inquiry because they

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focus on features of Park that are not required by the challenged claims. *See Axonics, Inc. v. Medtronic Inc.*, 73 F.4th 950, 957 (Fed. Cir. 2023) ("The inquiry is not whether a relevant artisan would combine a first reference's feature with a second reference's feature to meet the requirements of the first reference that are not requirements of the claims at issue."). Put differently, the test is not whether Kim's product confirmation technique may be "bodily incorporated" into Park's system, but rather whether one skilled in the art would have been motivated to combine the teachings to achieve the claimed invention, recognizing that some ordinary creativity might be required to carry out that combination. *See Facebook Inc. v. Windy City Innovations LLC*, 973 F.3d 1321, 1343 (Fed. Cir. 2020). As explained above, Instacart's showing demonstrates as much and includes credible testimony from its expert explaining how one skilled in the art would have implemented the asserted Park-Kim combination to arrive at the method of the challenged claims. *See* Ex. 1003 ¶¶ 51–59.

6. Conclusion

As noted earlier, Consumeron argues independent claims 1 and 13 together. Thus, applying the above analysis across both claims, we find that Instacart demonstrates by a preponderance of the evidence that claims 1 and 13 would have been obvious over the combined teachings of Park and Kim.

D. Dependent Claim 9

Claim 9 depends from claim 1 and additionally recites "checking the one or more goods off an electronic shopping list in real-time as each of the one or more goods is acquired." Ex. 1001, 10:39–41. For this step, Instacart relies on Park's teaching of "order pickers" pulling items from stock. *See* Pet. 40–42 (citing Ex. 1005, 23:15–22).

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Consumeron separately disputes Instacart's showing for claim 9. *See* PO Resp. 48–51; PO Sur-Reply 22–23. According to Consumeron, there are "two decisive problems with [Instacart's] theory." PO Resp. 49. *First*, according to Consumeron, it is the "order picker personnel" in Park who are "acquiring the goods and checking them off a list," not the "delivery agent," as the claims require, "who is different" from the order picker personnel. *Id.* at 49–50. *Second*, according to Consumeron, the goods gathered by the order picker personnel in Park are "placed in pending mode" and "only provisionally pulled from stock as they have yet to be paid for," and "[b]ecause in the 'pending mode' the items in the order are not 'complete and paid for,' the transaction has not been completed such to 'check[] . . . off an electronic shopping list in real-time . . . as the dependent claim requires." *Id.* at 51 (citing Ex. 2016 ¶ 122).

In turn, Instacart replies that claim 9 does not require that the delivery agent be the one to check the goods off a list. Pet. Reply 23. According to Instacart, "the 'acquir[ing]' in claim 9 is not the same 'acquiring' by the agent in independent claim 1." *Id.* Thus, regarding Consumeron's first argument, Instacart argues that "nothing in the language of claim 9 limits the actor who checks off individual goods as they are acquired," and "[t]hus, it is immaterial whether Park's order picker checks off the individual goods in the process of acquisition, while the delivery agent acquires the '*set*' of goods in a bag." *Id.* at 23–24. And regarding Consumeron's second argument, Instacart reiterates that "acquisition of goods does not require payment," and "[t]hus, it is irrelevant that in the 'pending mode' [of claim 9] the items in the order are not 'complete and paid for.'" *Id.* at 24 (quoting PO Resp. 51).

Consumeron sur-replies that claim 9 "is limited to the agent because checking the goods off an electronic shopping list must occur in *real-time* as the goods are acquired via the agent." PO Sur-Reply 22. Also, according to Consumeron, even if claim 9 "could be read broadly . . . to cover two different actors," Park's order pickers "do not perform any of the actions necessary to acquire goods according to any of the parties' dictionary definitions or the intrinsic evidence." *Id.* at 22–23.

Instacart has the better position. Claim 9 adds the step to claim 1 of "checking the one or more goods off an electronic shopping list in real-time as each of the one or more goods is acquired." Ex. 1001, 10:39–41. Importantly, that claim language does not specify who performs the step of checking each of the goods off the list as they are acquired, nor does it require that the goods be acquired "via the delivery agent" as recited in the "acquiring" step of claim 1. That distinction supports Instacart's position that the additional step of checking off each good in claim 9 need not be part of the step of acquiring the goods in claim 1, and, thus, claim 9 reasonably can be construed to encompass two different actors performing those steps, that is, Park's order picker checks off the goods and Park's delivery agent acquires the goods.

To that end, Instacart demonstrates that Park's order picker performs the step of "checking . . . goods off an electronic shopping list," as required by in claim 9. In particular, Park teaches that its system can "provide a *view of the items selected* to the order pickers at the appropriate distribution center . . . in real time, such that items in the order may be provisionally pulled from stock and placed in a pending mode" as they are selected by the customer. Ex. 1005, 23:15–22 (emphasis added). We credit the testimony

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of Instacart's expert that one skilled in the art would have understood that this "view" of the selected items is an "electronic shopping list" and that the order picker placing the items in "pending mode" as they are pulled from stock is "analogous to checking off" each item from the shopping list because it informs the order picker that they no longer need to acquire that item. *See* Ex. 1003 ¶¶ 98–99. We also credit the testimony of Instacart's expert that, even if Park did not expressly disclose checking items off an electronic shopping list, such functionality was well-known in the art and would have been obvious. *See id.* ¶¶ 100–103 (discussing "knowledge" of one skilled in the art).

Consumeron's second argument that the pending items are not acquired because they are not "paid for" is also unavailing. PO Resp. 48; *see also* PO Sur-Reply 25 ("acquiring goods requires some transaction between the agent and seller, such as a sale, trade, exchange"). As explained above in Section II.B.1, "acquiring" as recited in claim 1 is not limited to purchasing items and encompasses picking up items for delivery to the customer. With that in mind, we find that Park teaches or suggests that each item on the list is "acquired," as recited in claim 9, when the order picker pulls it from stock and places it in the pending mode. *See* Ex. 1003 ¶¶ 98–99. Thus, Instacart shows by a preponderance of the evidence that the asserted Park-Kim combination teaches or suggests the step of claim 9.

E. Dependent Claim 4

Claim 4 depends from claim 1 and additionally recites "receiving instructions from the first customer using the communication device to remotely inspect the first set of one or more goods utilizing the real-time video device." Ex. 1001, 10:12–15. For this limitation, Instacart relies on

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teachings in Park and Kim as well as Pugliese's teaching relating to dynamically displaying images of items in response to customer instructions. Pet. 65–66 (citing Ex. 1005, 4:26–32; Ex. 1006, 2; Ex. 1010, claim 1, ¶¶ 8, 146, 167, 178; Ex. 1003 ¶¶ 161–164).

Consumeron separately disputes Instacart's showing for claim 4. *See* PO Resp. 52; PO Sur-Reply 23. According to Consumeron, "the proposed Park-Kim-Pugliese combination and alleged rationale suffer from the same deficiencies" as urged for the challenge based on Park and Kim. PO Resp. 52. That is, Consumeron contends, "Park's warehouse-based delivery model in which delivery agents undertake a grab-and-go delivery operation does not allow for taking images of the actual goods, let alone waiting for instructions from a customer for remote inspection of the goods that have already been packaged. *Id.* In reply, Instacart points out that Consumeron "presents no distinct arguments with respect to the combination of Park, Kim, and Pugliese aside its arguments" relating to the Park-Kim combination. *See* Pet. Reply 24.

Instacart has the better position. Pugliese teaches receiving instructions from a customer to remotely inspect goods as recited in claim 4. Ex. 1010, claim 1, ¶¶ 8, 167; *see also* Ex. 1003 ¶¶ 162–163 (citing additional disclosures in Pugliese). It would have been obvious to combine Pugliese's teaching with Park's system in order to allow the customer to choose whether and what products to inspect because doing so would enhance interactivity and save time in the event the customer only wanted to inspect certain products in their order. *See* Ex. 1003 ¶¶ 156–158.

Kim also teaches the "receiving instructions" step of claim 4. For instance, Kim teaches that the customer's placement of an order over the

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Internet "prompts the delivery service provider to capture an image or video of the ordered product." Ex. 1006, 3. As such, Kim's customer order constitutes "instructions from the first customer to remotely inspect the first set of one or more goods utilizing the image capture device" that are received on the agent's communication device as recited in claim 4. Ex. 1003 ¶ 161. Thus, even without the teachings in Pugliese, Instacart sufficiently demonstrates that claim 4 would have been obvious over Park and Kim.

Finally, Consumeron's argument that "Park's warehouse-based delivery model" does not allow for receiving instructions to remotely inspect a product is unavailing. As explained above in Section II.C.5, we credit Instacart's showing that it would have been obvious to modify Park to allow the delivery agent to use the existing camera on their mobile device to obtain an image of the product, transmit it to the customer, and receive instructions from the customer. That doing so may add time to the delivery or require the agent to remove the product from a delivery bag does not overcome that showing. *Id.* Moreover, the additional combination of Pugliese's teachings allowing the customer to specify an inspection option (e.g., whether to inspect on a product by product basis) would have been an obvious and beneficial extension of the asserted Park-Kim combination. *See* Ex. 1003 ¶¶ 157–160. Accordingly, Instacart sufficiently demonstrates that the asserted Park-Kim combination teaches or suggests all the limitations of dependent claim 4.

F. Remaining Dependent Claims 5, 8, and 14–17

Instacart challenges dependent claims 8, 14, and 15 as obvious over Park and Kim, and challenges dependent claims 5, 16, and 17 as obvious

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over Park, Kim, and Hileman. *See* Pet. 38–40, 49–61. Consumeron does not dispute Instacart's showing for these dependent claims, except presumably to rely on its arguments in support of the base claims from which they depend, i.e., claims 1 and 13. *See* PO Resp. 48–52 (arguing separately only dependent claims 4 and 9). To the extent Consumeron applies its arguments for base claims 1 and 13 to the dependent claims, those arguments are unavailing for the same reasons explained above with respect to claims 1 and 13.

We need not expressly address the sufficiency of Instacart's showing as to the *undisputed* limitations of dependent claims 5, 8, and 14–17. *See In re NuVasive*, 841 F.3d at 974 ("The Board, having found the only disputed limitations together in one reference, was not required to address undisputed matters."). Nonetheless, we have reviewed Instacart's showing for each of those dependent claims and find that the record fully supports that claims 8, 14, and 15 would have been obvious over the combined teachings of Park and Kim, and claims 5, 16, and 17 would have been obvious over the combined teachings of Park, Kim, and Hileman. *See* Pet. 38–40 (claim 8), 49–51 (claims 14 and 15), 52–61 (claims 5, 16, and 17).

III. CONCLUSION

For all the above reasons, we determine that Instacart demonstrates, by a preponderance of the evidence, that claims 1, 4, 5, 8, 9 and 13–17 of the '594 patent are unpatentable as obvious under 35 U.S.C. § 103(a).[10] A summary of our determination is provided in the table below:

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[10] Should Consumeron Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this Decision, we draw Consumeron's attention to the April 2019 *Notice*

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Claims	35 U.S.C. §	Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 8, 9, 13–15	103(a)	Park, Kim	1, 8, 9, 13–15	
5, 16, 17	103(a)	Park, Kim, Hileman	5, 16, 17	
4	103(a)	Park, Kim, Pugliese	4	
Overall Outcome			1, 4, 5, 8, 9, 13–17	

IV. ORDER

Accordingly, it is:

ORDERED that Instacart has shown by a preponderance of the evidence that claims 1, 4, 5, 8, 9, and 13–17 of U.S. Patent 8,244,594 B2 are unpatentable; and

FURTHER ORDERED that, because this is a Final Written Decision, parties to this proceeding seeking judicial review of our Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Consumeron chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Consumeron of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. *See* 37 C.F.R. §§ 42.8(a)(3), 42.8(b)(2).

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