

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
Patent 11,238,465 B2

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

Opinion for the Board filed PER CURIAM.

Opinion, dissenting, filed by 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. 11,238,465 B2 (Ex. 1001, “the ’465 patent”). Mapbear, Inc. d/b/a Instacart (“Instacart”) filed a Petition requesting *inter partes* review of claims 1–19 of the ’465 patent. Paper 2 (“Pet.”). We instituted *inter partes* review of all the claims as challenged in the Petition. Paper 9 (“Inst. Dec.”). Consumeron filed a response (Paper 12, “PO Resp.”), Instacart filed a reply (Paper 16, “Pet. Reply”), and Consumeron followed with a sur-reply (Paper 17, “PO Sur-Reply”). We held a hearing on August 27, 2024, a transcript of which is in the record. Paper 28 (“Hrg. Tr.”). For the reasons below, we determine that Instacart demonstrates by a preponderance of the evidence that challenged claims 1–19 are unpatentable under 35 U.S.C. § 103(a).

I. BACKGROUND

A. *Related Matters*

The ’465 patent is related to another patent, US 10,628,835 (“the ’835 patent”), which was the subject of an earlier *inter partes* review that resulted in a final written decision holding all challenged claims unpatentable. *See Mapbear Inc. d/b/a Instacart v. Consumeron LLC*, IPR2022-01357, Paper 35 (PTAB Feb. 29, 2024) (“the 1357 IPR”). In particular, the ’465 patent was issued from an application filed April 20, 2020, and is a continuation of, and claims priority to, the application that resulted in the ’835 patent challenged in the earlier 1357 IPR, namely, US Application 13/270,848 (“the ’848 application”), filed October 11, 2011. *Compare* Ex. 1001, codes (22), (63), *with* Ex. 1025, codes (21), (22). Thus, the ’465 and ’835 patents share a common specification, including claim terms whose construction we resolved in the 1357 IPR. *See* 1357 IPR, Paper 35 at 11 (construing

“acquisition request” and “acquiring”). In addition to the 1357 IPR, the ’465 patent is related to the patents at issue in IPR2022-01356, IPR2022-01358, and IPR2022–01359. *See* Paper 27, 2–3. Our final written decision in the 1357 IPR and these other cases are presently on appeal to the U.S. Court of Appeals for the Federal Circuit. *Id.*

We also note that the related ’835 patent is the subject of a parallel infringement action by Consumeron against Instacart, namely, *Consumeron, LLC v. Maplebear Inc. d/b/a Instacart*, No. 1:21-cv-01147 (D. Del.) (filed Aug. 6, 2021) (“Delaware action”). *See* Paper 27, 2–3. Although the ’465 patent is not a part of that action, Consumeron has stated that it “believes Instacart infringes the ’465 Patent for the same or similar reasons articulated in Consumeron’s First Amended Complaint with regard to the ’835 Patent.” *See id.* at 2. The Delaware action is presently stayed pending Consumeron’s appeal of our final written decision in the 1357 IPR.

B. The ’465 Patent

The ’465 patent describes “[a] system and method for remote acquisition and delivery of goods” ordered over the internet. Ex. 1001, code (5, 2:16–17. The system includes “a server in communication with customer computers or devices via a website on the internet” and “a mobile delivery agent system in communication with the server.” *Id.* at 2:17–25. Figure 1 of the ’465 patent, reproduced below, is a schematic diagram of the system.

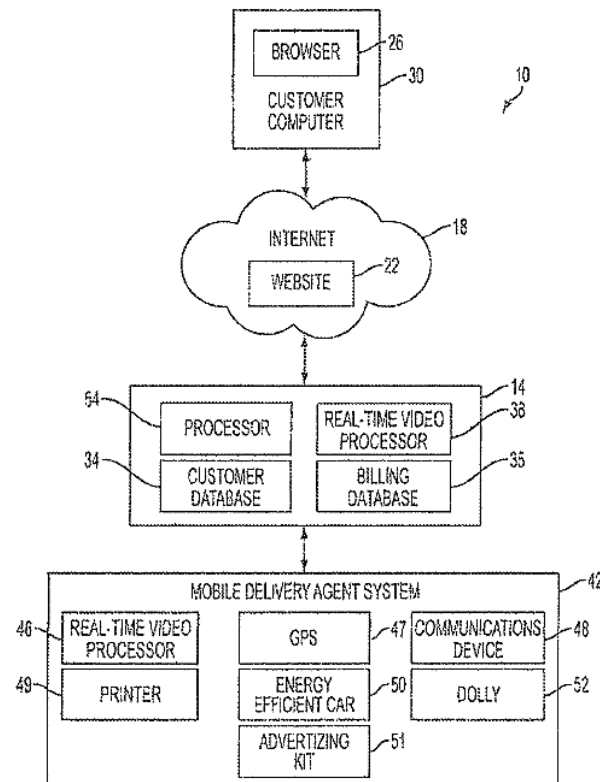


FIG. 1

Figure 1 depicts a customer computer 30 accessing a service provider's server 14 via the internet 18. *Id.* at 3:18–25. Server 14 communicates with a plurality of mobile delivery agent systems 42. *Id.* at 3:44–46. Each mobile delivery agent system 42 includes a digital image capture device 46, global positioning system (GPS) 47, and a communications device 48. *Id.* at 3:46–53. 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 4:63–5:10.

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 5:64–6:1. 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 7:13–35. “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 7:36–40. The customer then “either approves or rejects acquisition of the inspected product.” *Id.* at 7:55–56. 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 7:65–8:4. On the other hand, if the product is rejected, “the customer has the choice of inspecting another product or terminating the service.” *Id.* at 7:56–58. “If the customer requests further shopping, the delivery agent will move to other similar products or may travel to another location in search of a satisfactory product.” *Id.* at 7:60–63.

C. The Challenged Claims

Of the challenged claims, claims 1 and 14 are independent. Both are method claims, which the parties argue together. *See* Pet. 47–49 (referencing claim 1 mapping for claim 14); PO Resp. 31–32 (arguing only “Independent Claims” and “Claims 1, 14” together). Claim 1, reproduced below, is illustrative of the claimed subject matter (with Instacart’s bracketed numbering included to identify particular limitations):

[1.0.1] A method for remote acquisition and delivery of goods through one or more agents of a service provider, [1.0.2] each agent having a mobile agent system in communication with at least one remote server, [1.0.3] with each mobile agent system

including: a digital image capture device and a communication device, said method comprising:

[1.1] receiving, through the at least one remote server, a first acquisition request from a customer for a first set of one or more goods;

[1.2] contacting, through the communications device, the one or more agents;

[1.3] upon failing to locate an identified product of the set of one or more goods, electronically transmitting information on a replacement product for the identified product of the set of one or more goods to the customer using the digital image capture device of the agent, including:

[1.4] obtaining a bar or QR code of the replacement product;

[1.5] determining the information from the bar or QR code, wherein the information includes at least one image of the replacement product; and

[1.6] sending the information for the customer to approve the purchase of the replacement product based on the information determined from the bar or QR code; and

[1.7] upon receiving approval of the purchase from the customer, acquiring the replacement product, via the agent.

D. The Asserted Challenges

Claims Challenged	35 U.S.C. §	Basis
1, 4, 5, 8, 9, 11, 12, 14, 16, 17	103	Carr, ¹ Lauka ²
2, 3, 10, 15	103	Carr, Lauka, Yee ³
6, 7	103	Carr, Lauka, Cincotta ⁴
13	103	Carr, Lauka, Argue ⁵
18, 19	103	Carr, Lauka, Dearing ⁶

¹ US 2016/0148302 A1, published May 26, 2016 (Ex. 1005, “Carr”).

² US 10,592,962 B1, issued Mar. 17, 2020 (Ex. 1006, “Lauka”).

³ US 2021/0182930 A1, published June 17, 2021 (Ex. 1007, “Yee”).

⁴ US 2013/0085807 A1, published Apr. 4, 2013 (Ex. 1008, “Cincotta”).

⁵ US 2014/0149160 A1, published May 29, 2014 (Ex. 1009, “Argue”).

⁶ US 10,510,084 B2, issued Dec. 17, 2019 (Ex. 1010, “Dearing”).

In further support of these challenges, Instacart relies on the declaration of Dr. Henry Houh (Ex. 1003, “Houh Decl.”). Consumeron, in turn, relies on the declaration of Dr. Michael Mitzenmacher (Ex. 2008, “Mitzenmacher Decl.”).

II. ANALYSIS

A. Level of Ordinary Skill in the Art

Instacart submits that a person of ordinary skill in the art (“POSITA”) 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. 27 (citing Ex. 1003 ¶¶ 22–25). Consumeron responds that one skilled in the art would have been “someone with a background in electrical engineering, computer science, or the like” and 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. 7 (citing Ex. 2016 ¶¶ 19–23). But, as Consumeron’s expert acknowledges, Consumeron’s proposed definition “is not materially different” from Instacart’s. See Ex. 2016 ¶ 22. Accordingly, while we adopt the level of skill in the art as defined by Instacart our findings and analysis would be the same under Consumeron’s proposal.

B. Priority

The parties dispute whether the primary references underlying each of Instacart’s obviousness challenges—Carr and Lauka—qualify as prior art to the challenged ’465 patent. See Pet. 14–27; PO Resp. 12–31; Pet Reply 1–14; PO Sur-Reply 2–11. This dispute turns on whether the challenged

claims are entitled to the benefit of the filing date of the parent '848 application (Ex. 1011, "'848 application"). If they are, then Carr and Lauka do not qualify as prior art. If, however, the written description in the '848 application is lacking as Instacart asserts, the '465 patent is not entitled to the benefit of a filing date earlier than April 20, 2020. *See* Ex. 1001, code (22). In that event, it is undisputed that all of the asserted references qualify as prior art.⁷

Instacart contends that "at least two limitations of each independent claim (claims 1 and 14) of the '465 patent are not supported by the '848 application's written description" and that "a showing that the '848 application does not support the '465 patent claims is sufficient to demonstrate that the '465 patent is not entitled to any earlier priority date." Pet. 17. According to Instacart, there are two sets of limitations in claims 1 and 14 that lack sufficient written support in the '848 application are:

(1) "upon failing to locate an identified product of the set of one or more goods, electronically transmitting information on a replacement product of the set of one or more goods to the customer using the digital image capture device of the agent" (claim 1), and "determining that the identified product is not available" (claim 14); and

(2) "determining the information from the bar or QR code, wherein the information includes at least one image of the replacement product" (claim 1), and "obtaining a bar code [or] QR code of a replacement product . . . sending to the customer the information determined from the bar code or QR

⁷ Although not the focus of the parties' priority arguments, it seems that the availability of Yee, Cincotta, Argue, and Dearing as prior art also turns on this issue. *See* Pet. 29–30 (asserting these references qualify as prior art based on dates before April 20, 2020, but after the filing date of the '848 application).

code . . . wherein the information includes at least one image of the replacement product” (claim 14).

See id. at 17–18, 23. We address each set of limitations in turn below, assessing whether the disclosure in the ’848 application “reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date.” *Ariad Pharms., Inc. v. Eli Lilly and Co.*, 598 F.3d 1335 1351 (Fed. Cir. 2010) (en banc).

1. “failing to locate an identified product” (claim 1) and “determining that the identified product is not available” (claim 14)

In our institution decision, we found Instacart had demonstrated a reasonable likelihood it would prevail in showing these limitations lack written description support in the ’848 application. Inst. Dec. 6–9. In particular, we agreed with Instacart that “the ’848 parent application assumes that the product ordered by the customer is available and does not contemplate a scenario where the product is unavailable or otherwise describe the action to be taken if the product is unavailable.” *Id.* at 6. We also explained that it would be “improper hindsight to derive written description support by ‘[w]orking backward from a knowledge of the claims’” and that “[e]ntitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed.” *Id.* at 8 (quoting *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1349 (Fed. Cir. 2013) and *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1571–72 (Fed. Cir. 1997)).

At trial, Consumeron disputes our preliminary finding. *See* PO Resp. 13–28. It contends the ’848 application provides sufficient written description for these limitations because it “recognized the problem of

customers receiving wrong and unsatisfactory products” and “resolves it with agents who provide detailed information about the identified product and receive real time feedback.” *Id.* at 16–18 (citing ’848 application ¶¶ 5–6). According to Consumeron, a POSITA would understand “that desired products may be out of stock and, consequently, that the agent will sometimes fail to locate them.” *Id.* at 18 (citing Mitzenmacher Decl. ¶¶ 47–48); *see also id.* at 24 (arguing that given “the commonplace experiences that desired products are often out of stock “Petitioner’s allegation that the ’848 Application *assumes* that the desired product would always be identified defies common sense”).

Based on this “common-sense knowledge” Consumeron contends a POSITA would understand that if a product is out-of-stock, “the agent then makes a judgment call and identifies another [similar] product” and conveys an “image of that product for real-time inspection.” PO Resp. 20, 25 (citing Mitzenmacher Decl. ¶¶ 47–49, 58 (offering “[a]s a concrete example” the agent substituting organic for the customer’s regular brand of ketchup when the latter is unavailable)). From there, Consumeron asserts that if “the product is unsatisfactory, the customer can reject that product and request further shopping for a similar or satisfactory product, such as [another brand of ketchup] (*i.e.* another replacement product.” *Id.* at 20–21 (citing ’848 application ¶¶ 23–24; Mizentmacher Decl. ¶ 50). Alternatively, Consumeron argues that if “the agent does not want to make a judgment call” the ’848 application describes the agent notifying “the customer that the purchase cannot be completed,” which in its view would also lead to the customer shopping for a replacement product. *Id.* at 21–22 (citing ’848 application ¶¶ 24–25; Mitzenmacher Decl. ¶ 51).

In reply, Instacart contends that the “‘basic common experience’ is not sufficient,” standing alone “to confer § 112 support,” and that “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.” Pet. Reply 2. Instacart argues that the passages Consumeron cites from the ’848 application relate to different remote acquisition problems (i.e., where the agent acquires a good, but it turns out to be the wrong good or is otherwise unsatisfactory to the customer) than scenarios where the customer’s identified product cannot be located or is unavailable as recited in claims 1 and 14. *See id.* at 3–7. According to Instacart, [t]he ’848 application does not convey to a POSITA that the inventors had possession of either the problem or solution of unavailable products,” but “is instead directed to what an agent should do when the requested product can be located.” *Id.* at 3–4.

Instacart further argues that “general knowledge of stock-outs is insufficient to support claims” 1 and 14 because they “require specific agent actions *in response* to this problem.” Pet. Reply 8. According to Instacart, there are no “blaze marks” in the ’848 application that “guide a POSITA through the stock-out problem” by “describ[ing] what the agent is to do when the desired product is *out of stock*, as required by claims 1 and 14.” *Id.* at 5, 8–9 (citing *In re Ruschig*, 379 F.2d 990, 995 (C.C.P.A. 1967)). Instacart contends that Consumeron’s arguments are instead premised on “speculative actions and extrinsic evidence” regarding what a POSITA would “envision” an agent could do, which is at most “obviousness reasoning” that is “legally ‘not sufficient’ for written description support.”

Id. at 9–11 (quoting *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1564, 1572 (Fed. Cir. 1997)).

In sur-reply, Consumeron reiterates its view that the “problem of, and solution to, unavailable products is explicitly described in the [’848 application.” PO Sur-Reply 3. Consumeron further asserts these limitations are inherently disclosed because “POSITAs were well aware that desired products cannot always be found.” *Id.* at 5. According to Consumeron, “Petitioner’s view—that the inventors only considered scenarios in which the desired product would be identified—defies common sense and ignores the knowledge of a skilled artisan” because “[t]he solution the inventors devised . . . is just as effective for dealing with a product that cannot be found as it is for dealing with a product that is unsatisfactory for some other reason.” *Id.* at 6–7.

After considering the full trial record, we again find that Instagram has the better position. The claim language recites a scenario where the agent “fail[s] to locate an identified product” (claim 1) or “determin[es] that the identified product is not available” (claim 14). In response, claims 1 and 14 recite specific steps the agent performs to transmit information about and ultimately acquire a “replacement product.” *See* elements [1.3]–[1.6] and [14.4]–[14.8] (using the nomenclature from the Petition). However, the written description in the ’848 application does not contemplate any instance in which an agent encounters a product that is unavailable. Thus, it also does not describe an agent performing the steps relating to a replacement product in response to failing to locate the identified product or determining that it is unavailable as recited in claims 1 and 14. *See* Houh Decl. ¶¶ 49–61 (testifying that “a POSITA would not have recognized the ’848 application

as contemplating scenarios in which the products cannot be located or in which are not available and the '848 application similarly does not contemplate what actions to take in those scenarios").⁸

We begin with the description of the embodiment in Figures 2 and 3, which both parties cite as support for their respective positions.⁹ *See, e.g.*, Pet. 18–21; PO Resp. 20–23. The '848 application describes a method in which a customer selects a location “where a *desired product* is being sold” (steps 104, 105) and sends an “acquisition request” to a delivery agent to acquire the product (steps 108–110). '848 application ¶¶ 17, 20 (emphasis added). The delivery agent then travels to the store “and *finds the desired product* to be acquired” (steps 113, 115). *Id.* ¶ 23 (emphasis added). “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” (steps 116, 117). *Id.* (emphasis added). “Next, the customer either approves or rejects acquisition of *the inspected product*” (steps 119, 120, 122). *Id.* ¶ 24 (emphasis added). All of these disclosures state that the agent

⁸ Consumeron argues Dr. Houh’s testimony should be given little weight because he “admitted he did not evaluate what the '848 Application reasonably conveys to a skilled artisan.” Resp. 26 (citing Ex. 2011, 74:8–76:6, 83:4–84:1, 92:22–95:5). We disagree. Dr. Houh’s testimony indicates that he properly considered what the '848 application reasonably conveys to a POSITA. *See* Ex. 1003 ¶¶ 52, 56, 58, 61, 65. The portions of his cross-examination testimony cited by Consumeron do not suggest otherwise. For the reasons explained below, we credit Dr. Houh’s testimony over the competing interpretations offered by Consumeron and Dr. Mitzenmacher.

⁹ The dissent criticizes the majority’s analysis as “overly narrow” and too focused on the preferred embodiment. *See* Dissent 7–8. We disagree. Our analysis considers the entirety of the '848 application, including all of the passages cited by Consumeron and the dissent.

locates and identifies the customer's desired product *before* making the product available for inspection by the customer, which is at odds with the requirement in claim 1 of the agent "failing to locate an identified product" and in claim 14 of the agent "determining that the identified product is not available."

The background section of the '848 application in paragraphs 4–6 likewise refers to scenarios where the product identified by the customer has been located and is available for inspection. Here, the '848 application describes a problem in the prior art with existing internet-based companies that "arrange errands to be run for a fee," i.e., "if the person running the errand purchases the wrong product, the person placing the order will not know until the item is delivered." '848 application ¶ 5. The surrounding description explains that this problem may be especially acute for "customers who are particular about style, quality or actual function" and therefore "may wish to further view or otherwise examine an item before purchasing." *Id.* ¶ 4; *see also id.* ¶ 5 (noting this "may not be too important for certain items, say milk" but could be "significant for other items, such as a dress, designer shoes or a painting"). "Based on . . . these reasons," paragraph 6 states that there is a need for a system that "provides a customer with detailed information needed to make an informed purchase or acquisition." *Id.* ¶ 6. But as before, all of the scenarios disclosed as background involve instances where the customer's identified product is available and can be located for inspection, even if it ultimately turns out to be the "wrong product" because the customer, upon closer inspection, decides it is not what they actually want or determines the agent has mistakenly located the incorrect product.

Consumeron’s arguments that the passages above describe an instance where the identified product is unavailable, and the testimony it offers from its declarant in support of those arguments (*see* PO Resp. 18–21; Mitzenmacher Decl. ¶¶ 47, 49–50, 54, 57–58), are unpersuasive for several reasons. First, Consumeron’s description of an agent finding the customer’s desired product to be out of stock product and making a “judgment call” to present a similar, but different, product for inspection, arises entirely from the testimony of Dr. Mitzenmacher and the extrinsic sources he cites. There is no mention of such in the passages Consumeron cites from the ’848 application. Second, Dr. Mitzenmacher’s testimony that a POSITA would interpret these passages to describe an agent making a judgment call to present the customer with a different product than the one they selected is not credible because it contradicts the actual written description, which explicitly states that the agent “finds the *desired product*” and “identifies the *product of interest*” to present for customer inspection. Ex. 1011 ¶ 23 (emphasis added). It is only in the event the customer’s desired product is rejected, that the ’848 application provides that “the delivery agent will move to other similar products or may travel to another location in search of a satisfactory product.” *Id.* ¶ 24. Accordingly, we agree with Instagram that Consumeron’s (and Dr. Mitzenmacher’s) interpretation is improperly premised on “hindsight” informed by “[w]orking backward with a knowledge of the claims.” *See* Pet. Reply 5 (quoting *Novozymes*, 723 F.3d at 1349), 8–9 (explaining the ’848 application lacks blaze marks to guide a POSITA).

Consumeron’s alternative theory that the ’848 application describes an agent notifying the customer that the acquisition cannot be completed

because the item is unavailable and presenting a replacement product instead (*see* PO Resp. 21–23), fares no better. First, the portion of the written description Consumeron relies on for this theory states that: “If the customer is not qualified for the amount of the desired purchase, or if the delivery agent cannot complete the transaction for any reason, the customer is notified that the acquisition cannot be made as indicated at 122.” ’848 application ¶ 25. That passage, particularly when read in context of the rest of paragraph 25, is primarily focused on issues relating to payment. *See also* Houh Decl. ¶¶ 59–60 (testifying there are many reasons why a transaction cannot be completed that do not relate to product availability).

Consumeron’s interpretation of the phrase “any reason” to describe specific instances where the identified product cannot be located or is unavailable is another example of improper hindsight in its analysis. *See Novozymes*, 723 F.3d at 1349. For that reason, we do not find Dr. Mitzenmacher’s testimony on this point (Mitzenmacher Decl. ¶¶ 51–54) credible. Second, even accepting Consumeron’s interpretation, the ’848 application describes a different response (i.e., notifying the customer the transaction cannot be completed) than that recited in the subsequent steps of claims 1 and 14 (i.e., sending information about and acquiring a replacement product). Thus, it does not provide written description for the claimed methodology.

Consumeron’s inherency argument is similarly unavailing. PO Resp. 27; PO Sur-Reply 4–5. We accept that a POSITA would have known based on general knowledge of the industry that “products may be out of stock” at a store, i.e., what Dr. Mitzenmacher and the parties refer to as a “stock-out” problem. Mitzenmacher Decl. ¶ 47; *see also* PO Resp. 18, 27; Pet. Reply 8–11; PO Sur-Reply 6–7 (referring to “stock-outs” or the “stock-out problem”).

But it does not follow that an agent encountering a stock-out would necessarily respond according to the specific steps recited in claims 1 and 14.¹⁰ For example, instead of sending information about a replacement product, the agent could travel to another location to look for the same product, or notify the customer that the desired product could not be found and terminate the transaction. Because the '848 application only contemplates scenarios where a product can be located, it does not describe the agent's response in the event the identified product cannot be located or is unavailable, much less reasonably convey possession of a method comprising the specific, responsive steps in claims 1 and 14.¹¹

¹⁰ See *Novartis Pharms. Corp. v. Accord Healthcare, Inc.*, 38 F.4th 1013, 1017 n. 2 (Fed. Cir. 2022) (recognizing that the written description requirement may be satisfied when a skilled artisan would understand that a limitation was *necessarily present*, but noting that “[i]f an implicit disclosure is one that would render the limitation obvious to a skilled artisan, such a disclosure cannot . . . satisfy the written description requirement.”) (citations omitted); see also PO Sur-Reply 5 (citing cases addressing inherent disclosure of properties in chemical compositions).

¹¹ The dissent argues there is inherent description because “the agent necessarily would inform the customer if the desired product could not be located or was otherwise unavailable.” Dissent 3–4. We disagree because there are multiple actions an agent could take that differ from the specific response recited in the claims. The question here is not only whether the agent would inform the customer if the desired product could not be located, but also whether the '848 application describes the agent performing the recited claim steps *in response to* being unable to locate that product. While acknowledging that there are “alternative solutions,” the dissent assumes the recited response is an inherent response to the inherent problem of product unavailability. See Dissent 11–12. In our view, this assumes too much, crossing the line between what the written description reasonably conveys the inventors were in possession of they filed the '848 application and what one could argue is obvious in light of the that disclosure. See, e.g., *Novartis*,

Consumeron’s remaining arguments boil down to assertions that it would have been obvious that the agent could respond to a stock-out by taking the same steps described for other scenarios where the identified product is available, but is rejected by the customer. *See, e.g.*, PO Resp. 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”), 25–26 (citing extrinsic sources suggesting “traditional assemblers/order pickers” make judgment calls to send a replacement product that can lead the wrong product being delivered and arguing the inventors “invented a system capable of rectifying” such) (citing Mitzenmacher Decl. ¶¶ 53, 57–58; Ex. 2009, 325; Ex. 2010, 91). That is the wrong inquiry. “Entitlement to a filing date does not extend to subject matter which is not disclosed, but would be obvious over what is expressly disclosed. It extends only to that which is disclosed.” *Lockwood*, 107 F.3d at 1571–72. Likewise, “[i]t is not enough that a claimed invention is an obvious variant of that which is disclosed in the [written description]” because the actual “[d]isclosure is essential.” *Novartis*, 38 F. 4th at 1016 (citation omitted); *see also Ariad*, 598 F.3d at 1351 (“[T]he hallmark of written description is disclosure.”). Here, regardless of what might have been obvious to a POSITA in light of the ’848 application, the disclosure therein does not reasonably convey that the inventors were in possession of the methodology recited in claims 1 and 14.

Finally, we address Consumeron’s attempt to analogize the facts of this case to those in *Pozen Inc. v. Par Pharm., Inc.*, 696 F.3d 1151 (Fed. Cir.

38 F. 4th at 1016; *Lockwood*, 107 F.3d at 1571–72 (it is not enough that the claimed invention may be an obvious variant of what is disclosed).

2012) (“*Pozen*”) and *Hologic, Inc. v. Smith & Nephew, Inc.*, 885 F.3d 1357 (Fed. Cir. 2018) (“*Hologic*”). See PO Resp. 17–18, 26–27. Our reviewing court has explained that “determining whether a patent complies with the written description requirement will necessarily vary depending on the context.” *Ariad*, 598 F.3d at 1351 (citation omitted). For this reason, the import that can be drawn from the specific facts of these cases is limited; it does not undermine our findings based on the particular circumstances here.

Indeed, the facts of *Pozen* and *Hologic* are readily distinguishable. In *Pozen*, the Federal Circuit held that the district court did not clearly err in finding written description for the terms “therapeutic package” and “finished pharmaceutical container” because the specification disclosed several dosage forms of the recited pharmaceuticals and there was evidence that a POSITA would understand that such dosage forms are administered in containers with FDA-required labeling. *Pozen*, 696 F.3d at 1166–67. Here, however, not only does the ’848 application not describe a scenario where the identified product is unavailable, it also does not describe—expressly, inherently, or otherwise reasonably convey to a POSITA—that the recited “replacement product” steps are taken in response to that unavailability.

The issue in *Hologic* was whether the priority application sufficiently described a limitation requiring a light guide to be “permanently fixed.” There, the Federal Circuit observed that the Board had made numerous findings concerning the configuration of elements described in the figures and specification that “taken together” supported the Board’s finding that the written description “contemplated a ‘permanently affixed’ light guide.” *Hologic*, 884 F.3d at 1362–63. This is a substantial difference from the facts of this case, where we find that there is nothing in the written description of

the '848 application that contemplates the identified product being unavailable, much less the particular steps the agent performs in response to that determination. Accordingly, even if one assumes a POSITA by their own knowledge would have been aware that a product could be out of stock or otherwise unavailable, the '848 application does not reasonably convey the particular response recited in claims 1 and 14.

For these reasons, we find that the '848 application fails to provide sufficient written description for “failing to locate an identified product” (claim 1), and “determining that the identified product is not available” (claim 14). Because these limitations are recited, either expressly or incorporated by dependency, in all the challenged claims, Instacart has sufficiently demonstrated that all of the asserted references qualify as prior art for its patentability challenges.

2. *“determining the information from the bar or QR code, wherein the information includes at least one image of the replacement product” (claim 1) and “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).*

Instacart also asserts that the '848 application lacks written description for the “bar or QR code” limitations of claims 1 and 14.¹² See Pet. 23–26; Pet. Reply 11–15. Although Instacart does not dispute that the '848 application generally discloses an agent scanning a bar code or QR code to obtain product data for sending to a customer, it argues that the '848

¹² Although Instacart has already established that the asserted references qualify as prior art, we address this secondary argument for completeness.

application “fails to support the idea of determining images from a bar or QR code,” as required by the claims. Pet. 23–24. According to Instacart, the portion of the ’848 application on which Consumeron relies for support merely discloses images, bar codes, and QR codes as “*alternative types of product information*” sent to the customer without any mention of the bar or QR codes including images. Pet. Reply 13–14; *see also* Pet. 24–25 (“bar/QR code data and images appear to be separate concepts or options . . . there is no disclosure bridging the two concepts . . .”).

We disagree. When read as a whole, the ’848 application provides sufficient written support for the concept that a bar/QR code scanned by the agent and sent to the customer may include an image of the product as part of the product information encompassed within the code. Admittedly, as noted by Instacart, the ’848 application describes the sending of images to a customer as being an alternative to the sending of bar/QR codes. *See, e.g.,* ’848 application ¶¶ 8, 29. But, elsewhere, the ’848 application brings those concepts together by promoting bar/QR codes as “enabling a host of information related to the product” that one skilled in the art would immediately recognize as encompassing an image of the product—

[T]here are various forms for data transmission and communication disclosed in connection with the most preferred embodiments of the invention, with *these data forms including, but not being limited to, still images* (either alone or in combination with image recognition software), streaming video (really just a series of still images), *bar code data and QR data, all of which are generically encompassed by a digital image capturing device* and an associated processing device. *Certainly bar code and QR data may be preferable due to associated accuracies, the ability to readily conduct simultaneous price comparisons for the product via internet searching or links, and enabling a host of information related to the product to be*

presented, e.g., nutritional or health information, product ratings and the like.

Id. ¶ 30 (emphasis added). In our view, that description reasonably conveys to one skilled in the art that the “host of information” embedded within the bar/QR code may very well include an image of the product. *See* Mitzenmacher Decl. ¶¶ 62–66. Thus, we find that the ’848 application provides sufficient written support for the requirement determining information from a bar/QR code wherein that information includes “at least one image” of a product. That said, we note our prior finding that ’848 application does sufficiently describe performing the steps relating to a “replacement product” in response to being unable to locate the identified product or determining that product is unavailable.

C. Claim Construction

The parties dispute the meaning of “acquisition request” and “acquiring” as recited in some of the steps of claims 1 and 14, namely, “receiving . . . a first acquisition request from a customer” and “acquiring the replacement product, via the agent.” *See* PO Resp. 32–42; Pet. Reply 15–21; PO Sur-Reply 12–14. Consumeron argues that these terms should be construed to mean “a request for an agent to *shop for goods* on a customer’s behalf.” PO Resp. 32 (emphasis added). Instacart responds 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 claim’s plain language” 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.

As noted above in the “Related Matters” section, we previously construed the terms “acquisition request” and “acquiring” in our final written decision in the related 1357 IPR to encompass “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.” *See* 1357 IPR, Paper 35 at 11. It is undisputed that the ’465 patent at issue here and the ’835 patent at issue in the 1357 IPR are related and share essentially identical specifications, figures, and claim terms. *See* Pet. Reply 16; PO Resp. 38 n.6. Thus, for the same reasons as in our final written decision in the related 1357 IPR, we likewise determine here that Instacart’s construction of “acquisition request” is the correct 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))). Consumeron provides no persuasive justification for us to depart from our prior reasoning in the related 1357 IPR.

More specifically, the specification of the ’465 patent supports a construction that does not equate “acquisition request” for a product (or “acquiring” a product) exclusively with a shopping or purchase request, as Consumeron contends. *See* PO Resp. 32–37. Rather, the specification repeatedly uses the terms “purchase *or otherwise* acquire” and “purchase or *otherwise* obtain” to indicate that a delivery agent may acquire goods by means other than purchasing or shopping. *See, e.g.*, Ex. 1001, 5:34–36 (“[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 7:65–67 (“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 2:32–36 (“[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 “ties the agent’s acquisition to the shopping transaction” and “uses the terms ‘shopping’ and ‘acquisition’ as synonyms” is not persuasive. PO Resp. 33–34. By using the adverb “otherwise,” as noted above, the specification makes clear that purchase and acquire are not used synonymously. Rather, the terms “acquisition” and “acquiring” are broader in scope and encompass ways of obtaining a product that do not necessarily require purchasing it. *See* Ex. 1039, 1 (“otherwise” means “in a different way or manner”). Indeed, the specification clearly 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:

[T]he 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 8:25–33 (emphases added). Even more explicitly, the specification states that, “although 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 10:50–54 (emphasis added). Those disclosures indicate that a delivery agent can fulfill an acquisition request *without* shopping for or purchasing goods. Thus, it would be error to import an unrecited shopping requirement into the claims as Consumeron seeks to do here.

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. 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’s disclosure that the delivery agent may “otherwise acquire” and “otherwise obtain” goods informs the reader that the agent can fulfill an acquisition request *without* necessarily purchasing the goods on the customer’s behalf. *See* Ex. 1001, 5:34–36, 7:65–67.

Extrinsic evidence also favors Instacart’s position. For instance, Instacart cites dictionary definitions to support that the plain and ordinary meaning of “acquisition” and “acquiring” encompasses “coming into possession or obtaining something” by means that are not restricted to purchasing or shopping. Pet. Reply 20 (citing Ex. 1031 (defining “acquire” as “to come into possession or control of[,] often by unspecified means”); Ex. 1034 (“If you acquire something, you buy or obtain it for yourself, or someone gives it to you.”)). 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.¹³ *See* PO Resp. 36 (citing Ex. 2004). Consumeron does not explain why that definition should apply outside the context of that statute, much less demonstrate it reflects the plain and ordinary meaning as understood by one skilled in the art.

Moreover, Consumeron’s extrinsic definition conflicts with the description of “acquisition” and “acquire” in the specification, which, as explained above, expressly contemplates a broader meaning, such as picking up a product without requiring the agent to purchase or 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 the claim terms “acquisition request” and “acquiring” are limited to a request for an agent to shop for and purchase goods on a customer’s behalf. Rather, we agree with Instacart that “acquisition request” and “acquiring” have their ordinary meaning, which encompasses obtaining a product by means other than purchasing or shopping for it. Accordingly, consistent with the record here and our construction in the related 1357 IPR, we construe the terms “acquisition request” and “acquiring,” as recited in claims 1 and 14, to

¹³ The cited statute relates to the “conservation of forest resources.” *See* Ex. 1035 (stating the purpose of 16 U.S.C. § 620).

encompass 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.

D. Obvious Over Carr and Lauka

Instacart challenges claims 1, 4, 5, 8, 9, 11, 12, 14, 16, and 17 as being obvious over the combined teachings of Carr and Lauka. *See* Pet. 30–50. We begin with independent claims 1 and 14.

1. Claims 1 and 14

In challenging these claims, Instacart submits a detailed mapping of how the asserted Carr-Lauka combination satisfies each of the recited elements of claims 1 and 14. *See id.* at 35–44 (claim 1), 47–49 (claim 14). Instacart also explains why one skilled in the art would have been led to combine their respective teachings with a reasonable expectation of success of arriving at the claimed invention. *See id.* at 31–34.

Central to Instacart’s challenge of claims 1 and 14 are the claimed “acquisition request” and “acquiring” limitations. To meet the “acquisition request” limitation, Instacart points to Carr’s disclosure of a customer placing an order for goods from a website associated with a store, whereby the store has a server for receiving and processing the customer’s order. *See* Pet. 38 (citing Ex. 1005 ¶¶ 9, 60, 73). And to meet the “acquiring” limitation, Instacart points to Carr’s disclosure of an assembler (corresponding to the claimed “agent”) fulfilling the customer’s order and sending the customer a list of substitute goods for any unavailable goods so the customer may approve their purchase as the order is being assembled for delivery. *Id.* at 42–44 (citing Ex. 1005 ¶¶ 96–99).

Consumeron argues in response to Instacart’s showing for claims 1 and 14 that Carr fails to teach the “acquisition request” and “acquiring”

limitations “[w]hen the appropriate construction is applied.” PO Resp. 42. According to Consumeron, “‘acquisition request’ details *an agent* shopping for goods on the customer’s behalf, with ‘acquiring’ encompassing *the agent* completing the transaction for the goods (purchasing the goods).” *Id.* (emphases added). Based on that construction, Consumeron argues that Instacart’s showing is deficient because the transaction, i.e., the purchase of goods, in Carr is completed online between the customer and the seller rather than by the agent, i.e., the assembler of the goods, as required by the claims 1 and 14—

Carr’s customer online order, which is a transaction 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. . . . This customer order is not an “acquisition request” for an assembler to shop for goods on the customer’s behalf because the transaction is complete between the customer and the seller’s (Walmart’s) virtual shopping environment. The online customer order in Carr . . . represents the purchase of the products by the customer, rather than an agent.

Id. at 42–43 (footnote omitted); *see also id.* at 44 (“the customer completes the transaction, not Carr’s assemblers”). In other words, according to Consumeron, Carr’s disclosure of *the customer* shopping for and purchasing goods is not an “acquisition request” because there is no request for *the agent* to shop for and purchase goods on behalf of the customer.

Consumeron does not persuade us that the asserted Carr-Lauka combination lacks the claimed “acquisition request.” That is because Consumeron premises its entire argument on an overly narrow construction of “acquisition request,” a construction that we rejected as discussed above in Section II.C. When “acquisition request” is properly construed so as not to require the agent to shop for and purchase goods, but simply to pick-up

and deliver goods, Carr’s customer order is an “acquisition request” because it is a request for the agent to assemble and pick-up, i.e., acquire, the ordered goods. Indeed, Consumeron concedes as much when explaining Carr’s disclosure. *See* PO Resp. 43–44 (“The customer’s placed order is then sent to the store/order fulfillment system where assemblers simply retrieve and place in bins the already purchased goods.”). Thus, we find that the asserted Carr-Lauka combination satisfies the claimed step of “receiving, through the at least one remote server, a first acquisition request from a customer for a first set of one or more goods.”

Nor does Consumeron fare any better with its argument that Carr lacks the claimed step of “upon receiving approval of the purchase from the customer, acquiring the replacement product, via the agent.” *See* PO Resp. 44–46. According to Consumeron,

Carr’s assemblers do not receive notifications of the ‘approval of the purchase’ prompting them *to complete the transaction (purchase the goods) during the ‘acquiring’ step, as required by the Challenged Claims*. . . .

Rather, Carr’s assemblers simply receive a list of the ordered or substituted (alternative) goods prompting them to gather the goods and place them in bins, nothing more. . . . An assembler simply receiving a list to then gather goods does not amount to “*acquiring*” the goods (*i.e. completing the purchase transaction*).

Id. at 44–45 (emphases added); *see also id.* at 45 (“the assembler simply receives communication on the alternative good to then add it to the customer order, they do not receive the approval for the purchase to *thereby complete the purchase transaction*” (emphasis added)).

We disagree with Consumeron’s suggestion that the “acquiring” step requires the agent to “complete the purchase transaction.” As discussed

above in Section II.C, the claimed “acquiring” step is not limited to shopping for or purchasing a good and encompasses the agent simply picking up or obtaining the substitute goods upon receiving the customer’s approval. Carr clearly discloses that step when properly construed. More specifically, in Carr, if a particular good from the customer’s initial purchase order is not available, “the assembler may establish a list of substitute goods,” which is then “communicated to the customer” for the customer “to choose one of the substitute goods to be included in the order.” Ex. 1005 ¶¶ 95–98. The customer then “choose[s] one of the substitute goods as an alternative good” (*id.* ¶ 98), and “[t]he alternative good is communicated back to the assembler,” who “includes the alternative good in the customer order” (*id.* ¶ 101).

The customer’s communicated choice of the alternative good and its addition to the customer’s final purchase order corresponds to the claimed “*approval of the purchase from the customer.*” See Ex. 1003 ¶ 132. Consumeron’s assertion that Carr’s agents do not receive approval of the purchase of replacement goods (PO Resp. 44–46) is unavailing because a POSITA would have understood that Carr’s customer approves the purchase of the alternative good after the initial purchase order when that customer identifies a *different* good as the alternative good to be added to the final purchase order. See Ex. 1005 ¶¶ 95–98. Thus, when read as a whole, Carr supports Instacart’s showing that Carr meets the claimed step of “upon receiving the approval of the purchase from the customer, acquiring the replacement product, via the agent.”

As for the remaining limitations of claims 1 and 14, Consumeron does not dispute Instacart’s showing. See PO Resp. 31–32, 42–46 (arguing

only the “acquisition request” and “acquiring” limitations of the “Independent Claims”); *see also* PO Sur-Reply 18 (same). Thus, we need not expressly address the sufficiency of Instacart’s showing as to those *undisputed* limitations. *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.”). And because the parties argue claims 1 and 14 together, and because of the similarity of claim scope, we apply the above analysis across both of these claims. *See* Pet. 47–49 (mapping claim 14 to showing for claim 1); PO Resp. 31–32 (arguing “Independent Claims” and “Claims 1, 14” together). In doing so, we find that Instacart demonstrates by a preponderance of the evidence that claims 1 and 14 would have been unpatentable as obvious over the combined teachings of Carr and Lauka.

2. Dependent Claims 2–13 and 15–19

Consumeron does not dispute Instacart’s showing with respect to dependent claims 2–13 and 15–19, including its showing that it would have been obvious to combine the various asserted references with a reasonable expectation of success (*see* Pet. 51–53 (ground 2), 58–60 (ground 3), 62–65 (ground 4), 66–68 (ground 5)), except presumably that it relies on its arguments in support of base claims 1 and 14 from which they respectively depend. *See* PO Resp. 31–32, 42–46 (arguing only that limitations of the independent claims are lacking from the asserted prior art). To the extent Consumeron does so, those arguments are unavailing for the same reasons stated above with respect to base claims 1 and 14. As for the additional limitations recited in the dependent claims themselves, we need not expressly address the sufficiency of Instacart’s showing as to those

undisputed limitations. *See In re NuVasive*, 841 F.3d at 974. Thus, Instacart has met its burden of demonstrating the unpatentability of dependent claims 2–13 and 15–19.

III. CONCLUSION

For all the above reasons, we determine that Instacart demonstrates, by a preponderance of the evidence, that claims 1–19 of the ’465 patent are unpatentable.¹⁴

Claims	35 U.S.C. §	Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1, 4, 5, 8, 9, 11, 12, 14, 16, 17	103	Carr. Lauka	1, 4, 5, 8, 9, 11, 12, 14, 16, 17	
2, 3, 10, 15	103	Carr, Lauka, Yee	2, 3, 10, 15	
6, 7	103	Carr, Lauka, Cincotta	6, 7	
13	103	Carr, Lauka, Argue	13	
18, 19		Carr, Lauka, Dearing	18, 19	
Overall Outcome			1–19	

¹⁴ Should Consumeron 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 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).

IV. ORDER

Accordingly, it is:

ORDERED that Instacart has shown by a preponderance of the evidence that claims 1–19 of U.S. Patent No. 11,238,465 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.

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
Patent 11,238,465 B2

Opinion, dissenting, by DEFRANCO, *Administrative Patent Judge*.

I hereby dissent from the majority's finding that Carr and Lauka qualify as prior art to the '465 patent. According to the majority, the '848 application, from which the '465 patent claims priority, lacks written description support for the claimed steps of the agent "failing to locate an identified product" (claim 1) or "determining that the identified product is not available" (claim 14), and thus, does not antedate either Carr or Lauka. That finding by the majority focuses on a preferred methodology in the '848 application while failing to consider how a skilled artisan would have understood its disclosure *as a whole*. In my opinion, the skilled artisan reasonably would have understood the '848 application's description of a delivery agent communicating with a customer in real-time so as to keep the

customer informed during the entire purchase process, as described at length in the '848 application, would reasonably convey to the skilled artisan that the agent inevitably would inform the customer if an initially ordered product could not be located or was otherwise unavailable for purchase. As such, I would determine that the '848 application provides adequate written description support for the claimed invention, thereby disqualifying Carr and Lauka as prior art to the '465 patent.

As a preliminary matter, I agree with the majority's definition of a skilled artisan as having "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." *See* Maj. Op. 7. Indeed, in addressing the claimed methodology, Instacart concedes that "the technology is simple" and involves nothing more than "a common human experience like going to the store, not finding something." Hrg. Tr. 15:7–13. Nor does Instacart dispute that online shopping—"by which customers purchase goods remotely for delivery to a location of the customer's choice"—was a "standard method" of shopping by the time of the '848 application. *See* Ex. 1011 ¶ 3. That indicates that the field of the invention is a predictable art, such that a lower level of detail is needed to find written description support in the '848 application than would be needed for an unpredictable art. *See Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357, 1361 (Fed. Cir. 2018). We must keep that in mind when evaluating whether the '848 application "*reasonably conveys* to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc) (emphasis added).

Based on the evidence of record here, I would find that the '848 application provides enough detail to reasonably convey to a skilled artisan that the inventors possessed the claimed subject matter of “failing to locate an identified product” and “determining that the identified product is not available.” Although not described expressly, those claim limitations are a necessary and inherent aspect of the '848 application. *See Yeda Rsch. & Dev. Co. v. Abbott GmbH & Co. KG*, 837 F.3d 1341, 1345 (Fed. Cir. 2016) (“Under the doctrine of inherent disclosure, when a specification describes an invention that has certain undisclosed yet inherent properties, that specification serves as adequate written description to support a subsequent patent application that explicitly recites the invention’s inherent properties.”).

A skilled artisan would reasonably understand that the disputed claim limitations are inherently disclosed by appreciating the problem and solution the inventors described in the '848 application. First, a skilled artisan would understand that the inventors sought to solve the well-known problem of delivery agents purchasing the “wrong product” and online customers having to “return” that product, which “creates the potential for a confrontation or, at the very least, a dissatisfied purchaser.” Ex. 1011 ¶¶ 4–5. The skilled artisan would also appreciate the solution the inventors devised to overcome that problem—“a remote acquisition and delivery system” that allows a customer “to receive *real-time feedback* on the goods to be purchased” and “provides a customer with *detailed information* needed to make an *informed* purchase or acquisition.” *Id.* ¶¶ 5–6 (emphases added). As confirmed by Consumeron’s expert, the inventors’ description of the problem and solution in the '848 application would reasonably convey to a

skilled artisan that the delivery agent necessarily would inform the customer not only if the desired product was located but also if the product could not be located or was otherwise unavailable. *See* Ex. 2008 ¶¶ 46–47, 49, 53–58.

More specifically, Consumeron’s expert credibly testifies that a skilled artisan in the relevant time frame would reasonably understand the ’848 application as conveying two scenarios in the fulfillment of a customer’s order—(1) the agent locates the product ordered by the customer, or (2) the agent does not locate the product or finds it otherwise unavailable. *See* Ex. 2008 ¶ 57 (“[A]lthough one embodiment contemplates that the agent locates the product identified in the acquisition request, the fact remains that when the agent arrives the product may be out of stock.”). The ’848 application discloses the former scenario explicitly in paragraphs 23 and 24, while disclosing the latter scenario *inherently* through its stated objective in paragraph 5 and 6 of minimizing the chance of a “dissatisfied” customer by having the delivery agent communicate with the customer in “real-time” so as to provide them with “detailed information needed to make an informed purchase or acquisition.” Ex. 1011 ¶¶ 5–6, 23–24. And, consistent with that stated objective of keeping the customer informed during the purchase process, the real-time exchange between the delivery agent and the customer inevitably would involve the agent informing the customer if a desired product could not be located or was otherwise unavailable. *See* Ex. 2008 ¶¶ 46–47, 49, 53–58 (citing Ex. 1011 ¶¶ 5–6).

I disagree with the majority’s observation that the testimony of Consumeron’s expert is “improperly premised on ‘hindsight’ informed by ‘working backward from a knowledge of the claims.’” Maj. Op. 15 (citing Pet. Reply 5). Rather, Consumeron’s expert testifies at length about what

the '848 application inherently discloses to a skilled artisan, while properly recognizing that obviousness is not the proper standard for written description support—

Q [by Instacart's counsel]. So you do not know whether if something is inherent in a specification that would satisfy as a written description requirement?

A [by Consumeron's expert]. I believe I've heard that term or terminology before. You know, I don't have on hand, you know, what would be a corresponding definition of inherent as used in that legal sense. But to the extent that I do understand it from a technical standpoint, again, I believe I've stated clearly, *I believe it is, you know, inherent in the way that term is typically used in the shopping experience, that a person may go to an establishment to purchase a good and that good may not be available.*

Q. And you also don't know whether--if something is legally obvious in the specification, whether that would satisfy the written description requirement?

A. My understanding, to the extent I understand it, is like that alone would not satisfy the legal requirement. . . . I guess, you know, obvious in the legal and some specific legal sense may not be sufficient. Again, to be clear, my report doesn't say it would be obvious, that this would simply be already known to a POSITA. And, again, to the extent that I understand the legal difference, *I would think inherent is a clearly better term of choice and that it is the nature of the shopping experience that you may go to an establishment and not find the good that you are looking for.*

Q. Can this same well-known information be used to fill a disclosure gap in a specification when it comes to written description? [Objection by Consumeron's counsel].

A. I'm not – I'm not sure what you mean or if I've used the term in my report “disclosure gap.” . . . But from the technical perspective, you know, as I stated at the end at paragraph 11, given this perspective, in some instances a patent owner can rely on information that is well known in the art to

satisfy a written description. And, again, my understanding in patents is, you know, you assume your reader has also just some level of common knowledge. *I can just say, again, the idea that you may go to an establishment and, you know, with a desire to purchase an item and that item may not be available, you know, they may not have the item is, I think, a well-known experience.*

* * *

Q. So how does the '848 application solve that problem?

A. . . . I wouldn't want to speak for all the possible ways that it solves the problem, but, in particular, you know, *the '848 [application] is directed towards processes, which would allow interaction between the agent, I guess, the delivery agent and the customer in order to make sure the appropriate items were picked.*

Ex. 1038, 71:22–74:12, 78:4–14 (emphases added).

That testimony by Consumeron's expert, as well as his declaration testimony, supports two important findings in my opinion. *First*, a skilled artisan reading the '848 application in the relevant time frame would be familiar with the nature of online shopping and the fact that a desired product is not always available, and, *second*, the skilled artisan would immediately recognize that, inherent to the process of providing the customer with real-time feedback and detailed information about a desired product, is the necessity to apprise the customer when the product is unavailable. *See* Ex. 2008 ¶¶ 46–47, 53–58 (Consumeron's expert confirming as much). Indeed, that is the entire premise of the invention described in the '848 application—keeping the customer “satisfied” and “informed” by equipping the delivery agent with a mobile communication device¹ that allows “real-time feedback” between the agent and the customer

¹ This is described throughout the '848 application as a “mobile delivery agent system,” such as a “cell phone” that incorporates a “digital camera”

and “provides a customer with detailed information needed to make an informed purchase or acquisition.” Ex. 1011 ¶¶ 5–6. I struggle to see how a skilled artisan reviewing that description might *reasonably* think that the delivery agent would, on the one hand, inform a customer that a product has been located, but, on the other hand, suddenly fall silent if the product could not be located or was otherwise unavailable.

In finding otherwise, the majority takes an overly narrow approach to the ’848 application by focusing on a preferred embodiment to the exclusion of the disclosure as a whole. More specifically, the majority focuses on the particular steps recited in paragraphs 23 and 24 of the ’848 application where the delivery agent “finds the desired product” and “then communicates to the customer that the product has been identified” so that “the customer has the option of inspecting the product in real-time.” *See* Maj. Op. 13–14 (quoting “’848 Application” ¶¶ 23–24); *see also id.* at 16 (faulting Consumeron’s expert for “contradict[ing] the actual written description, which explicitly states . . .”). In doing so, the majority errs by crediting Instacart’s expert, who opines exclusively on what the ’848 application *expressly* recites, without ever considering what a skilled artisan would *inherently* understand from reading the ’848 application as a whole in light of the knowledge in the art at the time. *See* Ex. 1003 ¶¶ 46–61.

Unquestionably, Instacart’s expert is aware of the proper standard for finding written description support. *See* Ex. 1003 ¶¶ 52, 56, 61. But, in opining that “[t]he ’848 application does not contemplate, or reasonably

and has the ability to send “short message service (sms) alerts” (i.e., text messages) and initiate “voice transmissions corresponding to Skype™ communications.” Ex. 1011 ¶¶ 7, 14, 23.

convey” the disputed claim limitations, Instacart’s expert proceeds to simply quote *explicit* excerpts of paragraphs 23 and 24 of the ’848 application while assessing *specific* steps “reflected in Figure 3” or “readily apparent from Figure 3.” *Id.* ¶¶ 51–54. Nowhere, however, does Instacart’s expert analyze the broader implications of other descriptions in the ’848 application, most importantly paragraphs 5 and 6, which describe the true scope of the invention rather than merely specific steps of a preferred method. In other words, Instacart’s expert undertakes a *partial* analysis that opines only on what the ’848 application expressly discloses, whereas a proper analysis considers what a skilled artisan reasonably would have understood it to be describing both expressly and inherently in light of the state of the art of online shopping at the time. By focusing primarily on the particular steps of a preferred method, the testimony of Instacart’s expert (and the majority’s reliance on it) falls well short of the proper analysis needed to determine what the ’848 application reasonably conveys to a skilled artisan in the relevant time frame.

To that end, the overly narrow approach taken by Instacart’s expert (and the majority) not only ignores the express objective of the ’848 application—which minimizes “the potential for a confrontation or, at the very least, a dissatisfied purchaser” by allowing for “real-time feedback” and the exchange of “detailed information” between the delivery agent and the customer” (Ex. 1011 ¶¶ 5–6)—but also ignores the undisputable fact that inherent to any online shopping experience is the reality that desired products are routinely out-of-stock or otherwise unavailable for purchase. Indeed, Consumeron’s expert confirms that “given the ’848 Application’s recognition of the fact that wrong or unsatisfactory products were often

delivered and the commonplace experience that desired products are often out of stock, [Instacart's] allegation that the '848 Application *assumes* that the desired product would always be identified defies common sense" and "ignores the knowledge of a POSITA." Ex. 2008 ¶¶ 55–56. That testimony is consistent with the evidence of record showing it was well-known in the art that out-of-stock products were (and remain) a commonplace problem with online shopping. *See, e.g.*, Ex. 2009, at 9 ("This is a real concern in some industries, such as the grocery industry, which averages 8–10% stock-outs."); Ex. 2010, at 4 ("Substitution for items out of stock is a problem online since the picker does not know what would satisfy the customer. . . . To compensate for this problem, Peapod shows consumers online what will be substituted if their first choice is not available.").

I disagree with the majority's finding that Consumeron's solution to the scenario of a delivery agent finding a product to be out-of-stock or otherwise unavailable "arises entirely from the testimony of [Consumeron's expert] and the extrinsic sources he cites." Maj. Op. 15. Rather, based on my review of the evidence, the '848 application conveys a solution not only to the express problem of a customer rejecting an unsatisfactory product but also to the well-known problem of a delivery agent finding a product is out-of-stock—"the customer has the choice of inspecting another product." Ex. 1011 ¶ 24; *see also id.* ("If the customer requests further shopping, the delivery agent will move to other similar products . . . in search of a satisfactory product."). That the '848 application describes the customer choosing another product in the context of rejecting an unsatisfactory product does not preclude one skilled in the art from immediately recognizing that the solution described in the '848 application—"real-time

feedback” to minimize the potential for a “dissatisfied” customer and to keep the customer “informed”—is just as effective for resolving the problem of an out-of-stock product as it is for an unsatisfactory product. *See* Ex. 2008 ¶¶ 46–47, 49, 57–58 (citing Ex. 1011 ¶¶ 5–6, 23–24). The ’848 application need not spell out these well-known scenarios of online shopping. *See Immunex Corp. v. Sandoz Inc.*, 964 F.3d 1049, 1064 (Fed. Cir. 2020) (“It is well-established that a patent specification need not re-describe known prior art concepts.”); *Zoltek Corp. v. United States*, 815 F.3d 1302, 1308 (Fed. Cir. 2016) (“The written description ‘need not include information that is already known and available to the experienced public.’” (citation omitted)).

I also disagree with the majority’s finding that a delivery agent encountering an out-of-stock product would not “necessarily” respond by offering a “replacement product,” as required by the claims, and, instead, might “travel to another location to look for the same product, or notify the customer that the desired product could not be found and terminate the transaction.” Maj. Op. 17. Apparently, the majority views the availability of a limited number of other responsive solutions as diminishing the necessity to offer a replacement product. The majority fails to acknowledge one key fact, however—the ’848 application already contemplates those alternative solutions in addressing the problem of a dissatisfied customer. *See* Ex. 1011 ¶ 24 (“the customer has the choice of inspecting another product or terminating the service” *or* requesting that the agent “travel to another location”). Moreover, contrary to the majority’s suggestion, the ’848 application’s disclosure of a limited number of alternative solutions does not negate the fact that the *first* solution listed in paragraph 24 for dealing with a dissatisfied customer is for the delivery agent to offer the

customer the choice of another product, which, as discussed above, a skilled artisan necessarily would have recognized as an equally effective solution when encountering an out-of-stock product. *See* Ex. 2008 ¶¶ 46–47, 53–58.

In sum, the majority cannot escape the inventive contribution reasonably conveyed to a skilled artisan from reviewing the ’848 application’s express *and inherent* disclosures—keeping an online customer satisfied and informed during the purchase process by equipping the delivery agent with a mobile communication device that allows the delivery agent to interact with the customer in real-time and provide the customer with detailed information, including the ability to choose another product in the event an initially-ordered product is unsatisfactory (as expressly disclosed) or out-of-stock (as inherently disclosed). *See* Ex. 1011 ¶¶ 4–6, 24. The majority’s narrow focus on the specific steps of a preferred embodiment of the invention improperly ignores (1) the written description as a whole, (2) the inherent aspects of online shopping, and (3) the well-known fact that products are commonly out of stock, *all of which are key factors that Consumeron’s expert addresses but Instacart’s expert ignores.*

Thus, I respectfully dissent from the majority’s determination that the ’848 application does not provide written description support for the claimed subject matter of the agent “failing to locate an identified product” (claim 1) or “determining that the identified product is not available” (claim 14). Nor do I agree with the majority’s suggestion that the ’848 application fails to provide a solution for those scenarios. Rather, based on the evidence of record, I would find that the challenged claims find written description support in the ’848 Application and, thus, determine that Carr and Lauka are disqualified as prior art to the ’465 patent.

IPR2023-00865
Patent 11,238,465 B2

FOR PETITIONER:

Scott T. Jarratt
Angela M. Oliver
Destiny L. Stephenson
Laura Vu
HAYNES & BOONE LLP
scott.jarratt.ipr@haynesboone.com
angela.oliver.ipr@haynesboone.com
lyric.stephenson.ipr@haynesboone.com
laura.vu.ipr@haynesboone.com

FOR PATENT OWNER:

James Hannah
Jenna Fuller
Jeffrey H. Price
KRAMER LEVIN NAFTALIS & FRANKEL LLP
jhannah@kramerlevin.com
jfuller@kramerlevin.com
jprice@kramerlevin.com