

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MAPLEBEAR INC. D/B/A INSTACART,
Petitioner,

v.

CONSUMERON, LLC,
Patent Owner.

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

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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I. INTRODUCTION

The Majority's finding that U.S. Patent No. 11,238,465 (the "'465 Patent") is not entitled to an effective filing date of October 11, 2011, misapplies well-established written description caselaw, contradicts the "express objective" of the '465 Patent, and ignores the "undisputable fact" that products ordered online are routinely out-of-stock. Dissent at 8. Patent Owner, Consumeron, LLC, respectfully requests Director Review to correct the Majority's clearly erroneous misapplication of Federal Circuit precedent, determine that the '465 Patent is entitled to an effective filing date of October 11, 2011, and reverse the Majority's decision because the "prior art" of record postdates the '465 Patent by at least five years.

This case turns on a very straightforward question: Did the Majority err as a matter of law when requiring *in haec verba* support for a claim limitation that was undisputedly well-known in the art and at least inherently disclosed in the priority application? The answer must be yes. As the Dissenting Judge recognized, the Majority's narrow focus on minute details of a single exemplary embodiment failed "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.**

Dissent at 1-2 (emphasis added); *see also id.* at 11 (citing Ex. 1011, U.S. Patent Application No. 13/270,848 (“’848 Application”) at ¶¶ 4-6, 24).

The Dissent is correct. The Majority’s “narrow focus on the specific steps of a preferred embodiment”—to the exclusion of the other necessary considerations in evaluating what the written description reasonably conveys—was improper. *See* Dissent at 11. Consumeron thus respectfully requests Director Review and reversal of the Final Written Decision.

II. LEGAL STANDARD

The Director may review a final decision for abuse of discretion. USPTO, Director Review Process at 2.B, Proceedings under part 42 of 37 C.F.R. (effective October 31, 2024). “An abuse of discretion is found if the decision: (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on erroneous conclusions of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (citation omitted).

The written description requirement is satisfied where the disclosure “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). The analysis underlying this test requires an examination of (1) what the patent discloses—explicitly and inherently—and (2) the knowledge of a POSITA at the time of the invention. See *Capon v. Eshhar*, 418 F.3d 1349, 1357-58 (Fed. Cir. 2005) (“The ‘written description’ requirement must be applied in the context of the particular invention and the state of the knowledge [in the art].”). Both types of evidence must be considered because the disclosure is written for a skilled artisan, “and such a person comes to the patent with knowledge of what has come before.” *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005).

III. STATEMENT OF THE CASE

The ’465 Patent teaches methods and systems that enable a customer to give real-time feedback to an agent while the agent shops on the customer’s behalf. ’465 Patent at 1:60-2:12. Rather than place an online order directly with a seller, the customer makes an “acquisition request” for one or more goods. This acquisition request is transmitted to an agent, who then proceeds to a shopping location. *Id.* at 2:30-41. The agent is equipped with a device that delivers real-time images to the customer, showing the agent on his way to the shopping location and throughout the entire purchase process. *Id.* at 2:41-46. Customers using this system can, therefore,

give the agent “real-time feedback on the goods to be purchased.” *Id.* at 1:63, 2:46-57.

In the Petition, Instacart argued that the '465 Patent lacked written description for the following limitation:

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

'465 Patent at Claim 1 (emphasis added).¹ In particular, Petitioner suggested that the specification of the '848 Application *only* contemplates transmitting information on a replacement product when the agent *actually* locates the exact product requested in the customer's acquisition request. *See, e.g.*, Petition at 20. On the limited record pre-Institution, the Board agreed that the '848 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.” Institution Decision at 6.

¹ Petitioner presented parallel arguments against Independent Claim 14. Patent Owner's arguments in this brief apply equally to Independent Claims 1 and 14.

During trial, Consumeron pointed out that the inventors set out to solve a particular problem in the field of e-commerce: “Errand runners who ‘purchase[d] the wrong product’ . . . created dissatisfied customers who ‘lost significant time in acquiring the desired product.’” POR at 4 (quoting ’465 Patent); Ex. 2008 (“Mitzenmacher Decl.”) at ¶ 25; Ex. 2009 at 325; Ex. 2010 at 91. Consumeron then produced un rebutted testimony and evidence establishing that “[t]he various reasons for the delivery of the wrong product were common knowledge at the time of the invention to skilled artisans and laypersons alike.” *Id.* For example, an order picker might make a mistake, a merchant might have out-of-date images on its website, the website might have been a scam, or the desired product might be out of stock. POR at 4.

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

In its Reply, Instacart did not dispute that “[d]ocumentary evidence and plain real-world experience establish that ‘stock-outs’ were and remain a commonplace nuisance.” POR at 18 (citing Ex. 2009 at 325; Ex. 2010 at 91). Instead, Petitioner

insisted that the '848 Application **only** contemplates an agent looking for a replacement product “when a desired product is **in stock** but unsatisfactory.” Reply at 9. Instacart thus argued that the '848 Application fails to even reasonably convey to a skilled artisan what to do if the agent accidentally grabs the wrong product (a problem explicitly disclosed in the specification) because the specification **only** suggests that the agent to look for a replacement product when he originally identifies the requested product. *See id.* at 3-10.

Consumeron pointed out the logical and legal flaws in Instacart's position in its Sur-Reply. Sur-Reply at 3-7. As Consumeron noted, Instacart's narrow focus on the details of one embodiment to the exclusion of (1) the rest of the specification; (2) inherent aspects of the disclosed shopping experience; and, (3) the well-known fact to skilled artisans that sometimes products are out of stock, was contrary to several well-established written description tenets of Federal Circuit law. *Id.* For example, Consumeron argued that *Yeda Rsch. & Dev. Co. v. Abbott GmbH & Co. KG*, 837 F.3d 1341, 1345 (Fed. Cir. 2016) holds that the Board must evaluate inherent disclosures when considering written description issues, and *Zoltek Corp. v. United States*, 815 F.3d 1302, 1308 (Fed. Cir. 2016) holds that “information that is already known and available to the experienced public” need not be disclosed to satisfy the written description requirement. Sur-Reply at 5-6.

In the Final Written Decision, the Majority agreed with Instacart, while Administrative Patent Judge DeFranco, author of the Institution Decision, dissented in favor of Consumeron. Rather than addressing the knowledge of skilled artisan or what the '848 Application as a whole conveys to a POSITA, the Majority found that the '848 Application “does not contemplate any instance in which an agent encounters a product that is unavailable”² and thus “does not describe an agent performing the steps relating to a replacement product” in response. FWD at 12.

The Dissenting Judge, on the other hand, properly applied Federal Circuit precedent in arriving at the conclusion that the '848 Application provides written description support for the “failing to locate” and “product is not available” limitations. Taking into account “how a skilled artisan would have understood its disclosure *as a whole*,” the Dissent found that “the '848 application’s description of

² Notably, the Board’s Institution Decision (and Final Written Decision), adopted a proposed level of ordinary skill in the art, which includes “approximately two years of experience working *in the field of electronic commerce*” in addition to technical education or training in fields such as electrical engineering or computer science. Institution Decision at 4-5 (emphasis added) (quoting Pet. at 27); FWD at 7. The Board agreed, as the parties proposed, that “[l]ack of work experience can be remedied by additional education, and vice versa.” *Id.*

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.” Dissent at 1-2.

IV. ARGUMENT

The Director should reverse the Majority's priority determination and find that the “failing to locate an identified product” (claim 1) and “determining that the identified product is not available” (claim 14) elements are supported by the written description in the '848 Application, and are thus entitled to the October 2011 priority date.

If the disclosure in the '848 Application “reasonably conveys to those skilled in the art that the inventor had possession of the claimed subject matter,” then the '465 Patent claims are entitled to its filing date. *Ariad Pharms., Inc.*, 598 F.3d at 1351. The claimed subject matter need not be described *in haec verba* or even explicitly in order to reasonably convey possession to a skilled artisan. *Id.* at 1352; *Yeda Rsch. & Dev. Co.*, 837 F.3d at 1345.

Here, as in all written description inquiries, an analysis of what the '848 Application would have reasonably conveyed to skilled artisans in October 2011 necessarily requires an evaluation of what skilled artisans already knew at the time

because patent applications “need not include information that is already known and available to the experienced public” in order to meet the written description requirement. *Zoltek Corp.*, 815 F.3d at 1308; *see also 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.”).

Ignoring these bedrock principles, Instacart and its own expert (and ultimately the Majority) focused only on what was *explicitly* disclosed in the '848 application and failed to account for what a skilled artisan knew in October 2011 and what the '848 Application inherently discloses. Both contribute to what a skilled artisan would understand to be reasonably conveyed by the specification as the invention possessed by the inventors, even if not recited *in haec verba*. *Ariad Pharms., Inc.*, 598 F.3d at 1352.

The Dissent correctly considered all of the evidence regarding these factors in concluding that the '848 Application provides written description support for the challenged limitations; upon a review of the same “entire evidence,” the Director will be “left with the definite and firm conviction that” the Majority made a mistake in concluding the opposite. *Rowe v. Dror*, 112 F.3d 473, 478 (Fed. Cir. 1997), citing *United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948) (“A finding is ‘clearly erroneous’ when although there is evidence to support it, the reviewing court on the entire evidence is left with the definite and firm conviction that a mistake has

been committed.”). Accordingly, the Majority’s clearly erroneous factual findings here regarding priority should be reversed by the Director.

A. The ’848 Application Provides Written Description Support For the “Failing to Locate an Identified Product” (claim 1) and “Determining That the Identified Product is Not Available” (claim 14) Limitations

The ’848 Application identified and provided a solution to the long-felt problem of online shoppers receiving the wrong or otherwise unsatisfactory products. See ’848 Application at ¶¶ 5-6. A skilled artisan reading the application would have known, based on the state of the art in October 2011, the various reasons that online merchants would deliver the wrong or unsatisfactory products. For example, products listed on the website might be out of stock, the website might show stale images of last year’s model, or the order picker might have made a mistake when assembling the order. Mitzenmacher Decl. at ¶¶ 42-43 (citing Exs. 2009, 2010 (describing out of stocks)). Because the “inventive contribution” was not directed to the various well-known circumstances that would lead to the delivery of wrong or unsatisfactory products (but what to do to prevent that outcome) there is no requirement that the specification spell out these well-known concepts in detail. *Capon*, 418 F.3d at 1358.

According to Dr. Mitzenmacher and the Dissent, a POSITA in October 2011 would have recognized that the ’848 Application discloses a solution to the wrong/unsatisfactory product problem *in all of these scenarios*: “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.” See Dissent at 3 (quoting ’848 Application at ¶¶ 5-6); see also Mitzenmacher Decl. at ¶ 43. That solution is not specific to the *reason* the shopper encounters a problem with acquiring the desired product, so the ’848 Application reasonably conveys 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.” Dissent at 3-4 (emphasis added) (citing Mitzenmacher Decl. at ¶¶ 46-47, 49, 53-58).

Consumeron respectfully requests that the Director adopt the Dissent’s reasoning and find written description support for the contested limitations.

B. The Majority Did Not Conduct the Written Description Analysis Required by Federal Circuit Precedent

To determine the full scope of what the written description discloses to a POSITA, the Board was required to examine (1) the explicit *and inherent* disclosures of the ’848 Application and (2) the skilled artisan’s knowledge as of October 2011. See *Capon*, 418 F.3d at 1357-58. The Majority did not do this. Instead, it conducted a partial analysis of one part of the specification and gave up when it did not find *haec verba* support for an inevitable, inherent, and annoying part of the shopping process. See Dissent at 8. This incomplete analysis led the Majority to a clearly

erroneous factual finding that ignores the fundamental premise of the '848 Application and improperly requires its inherent disclosures to conform to a single exemplary embodiment.

As the Dissent points out, the Majority relied on Instacart's expert's analysis concerning the *explicit* disclosures of the '848 Application, which ignored the "express objective" of the '848 Application as well as the "undisputable fact" that products ordered online are routinely out-of-stock. *Id.* Dr. Mitzenmacher's testimony addresses both considerations, and the Majority erred in dismissing it as purportedly "premised on 'hindsight' informed by '[w]orking backward with a knowledge of the claims.'" FWD at 15 (citations omitted); *see also* Dissent at 4-5 (disagreeing with majority). It is not ***hindsight*** for an expert to cite documentary evidence to establish what was known to POSITA at the time of the invention or to opine about what a specification inherently discloses; such evidence forms a ***necessary part*** of the written description analysis. *Capon*, 418 F.3d at 1357-58; *LizardTech, Inc.*, 424 F.3d at 1345.

Dr. Mitzenmacher's testimony provided the necessary information for the Board to conduct the full analysis required for a proper written description analysis, which Instacart's expert did not bring to the Board's attention or attempt to rebut.

C. The Majority's Identified Premise of the '848 Application is Overly Narrow

Because the Majority dismissed Dr. Mitzenmacher's testimony regarding the knowledge of a skilled artisan and what a skilled artisan would understand the '848 Application to reasonably convey, it arrived at an overly narrow conception of the '848 Application. FWD at 14, 17 (determining that the '848 Application is *only* directed to scenarios in which an agent actually finds the exact item a customer ordered).

The Majority's narrow reading of the '848 Application defies common sense and leads to absurd results. For example, the Majority's determination that the '848 Application only permits real-time inspection of a product when the agent finds the *exact* product identified in the customer's acquisition request, conflicts irreconcilably with the fact that the specification expressly discloses providing the customer with a real-time view of the entire acquisition process. '848 Application at ¶¶ 8, 23, 27. Thus, when an agent inevitably is unable to locate a particular product—because it was out of stock, for example—the customer will be informed and can give the agent real-time instructions to either terminate the acquisition process or find a suitable replacement. *Id.* at ¶¶ 23-24.

Indeed, as the Dissent found, the “entire premise” of the '848 Application is to inform and satisfy the customer ***throughout a transaction***. See Dissent at 6-7 (the invention equips “the delivery agent with a mobile communication device that

allows ‘real-time feedback’ between the agent and the customer and ‘provides a customer with detailed information needed to make an informed purchase or acquisition’”) (quoting ’848 Application at ¶¶ 5-6). The ’848 Application’s disclosure of presenting real-time images to a customer throughout the transaction conflicts irreconcilably with the Majority’s determination that the ’848 Application does not allow a customer to inspect products until after the agent has identified that the requested product is available. FWD at 13-14.

Accordingly, as the Dissent determined, the Majority’s opinion fails to consider what the disclosure “reasonably conveys” to a POSITA:

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.

Dissent at 7. The Dissent is correct. The Majority’s search for *in haec verba* support for the contested limitations ignores Federal Circuit precedent, dismisses dispositive un rebutted evidence out of hand, and defies common sense. *See id.* at 8 (“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.").

V. CONCLUSION

Consumeron respectfully requests that the Director grant its request for Director Review of the Final Written Decision and either reverse or vacate the Majority's decision.

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Respectfully submitted,

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CERTIFICATE OF SERVICE

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

<i>Date of service</i>	December 20, 2024
<i>Manner of service</i>	Electronic Mail (scott.jarratt.ipr@haynesboone.com; angela.oliver.ipr@haynesboon.com; lyric.stephenson.ipr@hayensboon.com; laura.vu.ipr@haynesboon.com)
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