

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE, INC., ET AL.
Petitioners

v.

AMERANTH, INC.
Patent Owner

Case CBM2014-00013
Patent No. 6,982,733

MAIL STOP PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
Post Office Box 1450
Alexandria, Virginia 22313-1450

Submitted Electronically via the Patent Review Processing System

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S LIST OF EXHIBITS

Exhibit No.	Description
2001	Memorandum of Points and Authorities in Support of Plaintiff Ameranth, Inc.'s Motion to Disqualify Counsel (Fulbright Jaworski)
2002	Memorandum of Points and Authorities in Support of Plaintiff Ameranth, Inc.'s Motion to Disqualify Counsel (Akin Gump)
2003	"Domino's Pizza First in Industry to Offer Mobile Ordering" (September 27, 2007)
2004	http://www.dailymotion.com/video/xr7y4b_tim-cook-calls-patent-wars-pain-in-the-ass_tech
2005	157 Cong. Rec. S1053 (Mar. 1, 2011)
2006	157 Cong. Rec. S5441 (Sept. 8, 2011)
2007	"Software Patent Reform Just Died in the House," Washington Post, Nov. 20, 2013
2008	Nov. 18, 2013 Letter from Victoria A. Espinel, President and CEO of the Business Software Alliance
2009	http://www.bsa.org/advocacy/intellectual-property-and-innovation
2010	http://www.bsa.org/~media/Files/Policy/Patents/JointCBMLetter091913
2011	"Ameranth Signs Major New Patent License with PAR Technology Corporation for its Patented 21 st Century Communications Web/Wireless Synchronization Inventions" (Jan. 28, 2013)

2012	“Ameranth Signs Major New Patent License with Snapfinger, Inc. for its Patented 21 st Century Communications Web/Wireless Synchronization Inventions” (Jan. 24, 2012)
2013	Secondary Factors Evidence and Nexus Charts Submitted in App. Ser. No. 11/112,990 (U.S. Pat. No. 8,146,077)
2014	April 21, 2010 Claim Construction Order (Judge Everingham)
2015	September 9, 2010 Claim Construction Order (Judge Everingham)
2016	September 13, 2010 Claim Construction Order (Judge Everingham)
2017	August 10, 2012 Claim Construction Order (Judge Payne)
2018	July 5, 2013 Order re: Motions to Dismiss (Judge Sammartino)
2019	157 Cong. Rec. S1379 (Mar. 8, 2011) (Statement of Senator Kyl)
2020	157 Cong. Rec. S5431 (Sept. 8, 2011) (Statement of Senator Kyl)
2021	“Ameranth Wireless Awarded Computerworld Honors 21 st Century Achievement Laureate Medal” (April 16, 2001)
2022	Letter from Computerworld Honors Program (July 5, 2001)
2023	“Wireless Finds a Welcome in Hospitality,” Business Week (Feb. 9, 2004)
2024	Steve Glen (VP of Marriott) Letter to K. McNally (Feb. 3, 2000)

2025	Computerworld Honors Archive
2026	Ameranth Receives Moby Award For Wireless Mobile Computer Application (Sept. 13, 2000)
2027	“Food.com and Ameranth Technology Announce Partnership to Develop Link From Food.com site With Ameranth's 21st Century Restaurant System” (July 15, 1999)
2028	Internal Food.com Memo between its Executive Team (Sept. 13, 1999)
2029	Examiner Interview Summary in App. Ser. No. 11/112,990, October 14, 2011
2030	Web Characterization Terminology & Definitions at §2.3, May 24, 1999, http://www.w3.org/1999/05/WCA-terms
2031	<i>SFA v. 1-800-Flowers.com</i> , Case No. 6:09-cv-340-LED (E.D. Tex. April 11, 2013)
2032	https://developer.apple.com/library/ios/documentation/IDEs/Conceptual/iOS_Simulator_Guide/iOS_Simulator_Guide.pdf
2033	<i>Kilopass Tech v. Sidense Corp.</i> , No. 2013-1193 (Fed. Cir. Dec. 26, 2013)

I. STATEMENT OF PRECISE RELIEF REQUESTED

In accordance with 37 C.F.R. § 42.207(a), Patent Owner, Ameranth, Inc., submits this Preliminary Response to the Petition for Covered Business Method (“CBM”) review (“Petition,” “Pet.” or “Am. (‘Amended’) Petition”). For the reasons set forth below, the Patent Trial and Appeal Board (“PTAB” or “Board”) should deny the Petition for review of claims 1-16 of U.S. Patent No. 6,982,733 (“the ‘733 patent”) because (1) the ‘733 patent is not a CBM patent, because it is unrelated to the practice, management or administration of a financial product or service and/or is directed to a technological invention, (2) the claims of the ‘733 patent are not invalid under 35 U.S.C. §112 and (3) the claims of the ‘733 patent are not patent ineligible under 35 U.S.C. §101.

The Petition itself obfuscates the truth, hides critical facts, and is rife with inconsistencies, errors, omissions, deceptions and mischaracterizations. When the facts were counter to their invalidity allegations, Petitioners simply ignored or withheld them—not only from the PTAB but from their own expert as well. When there were no facts supporting their contentions, Petitioners were not fazed—they simply invented new ones. When it was clear that the examiner allowed the ‘850 parent application claims over the prior art, Petitioners simply cited to his rejection of different claims not even in the ‘850 patent. When the actual elements of the ‘733 claims did not support their positions, they simply added new elements to suit their purposes. When the dependent claims contradicted their positions, they tried to sweep them under the rug. When the evidentiary record refuted their positions, they simply withheld it. Specifically, Petitioners withheld from the PTAB all the judicial rulings and multiple

Markman constructions from three different federal judges, rulings which previously rejected Petitioners' core invalidity allegations and rejected and refute Petitioners' claim construction proposals.¹ Petitioners also purposefully parsed and restricted the scope of their expert's analysis by withholding all contradictory evidence from him and manipulated the definition of a POSA, so as to exclude the internet and "Web page" knowledge and skills that a true POSA would have, because such knowledge would have rendered all of their written description and indefiniteness arguments incorrect.² It was no accident that the scope of Mr. Larson's review omitted Ameranth's U.S. Pat. No. 8,146,077 (the "'077 patent") (the fourth in Ameranth's patent family and subject of CBM2014-00014), because exclusion of that knowledge would allow him to assert plausible deniability as to knowledge of the vast amount of contradictory evidence in the `077 files, including the direct evidentiary links to

¹ Petitioners also conveniently ignore the fact that their lead counsel, Mr. Zembek, was also counsel for defendants on almost all of the prior adverse judicial rulings and that Mr. Zembek's firm recently hired Judge Everingham's law clerk (Jim Warriner), who assisted in writing three of those Markman rulings and subsequently worked on this CBM matter and the *Ameranth v. Pizza Hut et al.* case under Mr. Zembek's direction. Mr. Warriner's improper involvement in this matter and the Southern District of California case is the subject of one of two disqualification motions pending in the district court (Exhs. 2001, 2002). Petitioners are charged with knowledge of all these prior rulings and thus were required to disclose them to the PTAB per counsel's duty of candor requirement.

² This kind of tactical calculation, *i.e.*, narrowly restricting the definition of a POSA (so that he/she would then know very little) to support §112 contentions before the PTAB, while concurrently asserting a much broader POSA scope in district court to support invalidity contentions based on prior art, is highly duplicitous and indicative of improper motivations in the filing of the present Petition.

the *Ameranth v. Menusoft* case and its Markman rulings. This renders the entire Larson Declaration unreliable and meaningless.

Worse yet, while the Petitioners now self-servingly allege that Ameranth's '733 patent claims are invalid and patent ineligible, they do so while also simultaneously seeking patents for themselves directed to the same subject matter as the '733 patent. Apple and the other Petitioners withheld the fact that Apple is even now concurrently asserting to the USPTO that its own copycat hospitality market patent titled "Systems and Methods for Processing Orders and Making Reservations Using an Electronic Device" (US 2013/0332208), published December 12, 2013, is non-obvious and represents a patentable invention. This should independently constitute an estoppel against their contradictory arguments in the Petition. This kind of hypocritical "hide the ball" litigation tactic as to all contradictory evidence has no place in the AIA petition process. *See* 37 C.F.R. §42.12. The Board should deny the Petition for these ethical reasons alone as well as for the following substantive factual and legal reasons, as fully explained herein.

First, Petitioners mischaracterize the claimed invention as a financial product or service by superficial attorney arguments devoid of any focus on the actual claims of the '733 patent.

Second, Petitioners assert that the '733 patent is not directed to a technological invention, while ignoring the vast amount of contradictory evidence well known to them, based on a blatant misrepresentation of the parent application prosecution history, which actually compels the opposite conclusion that the actual claimed software system invention was technological and novel

and non-obvious over the prior art (because the Examiner said it was, contrary to Petitioner's **false** characterization of the Examiner's statements) and was directed to a technical solution to a technical problem. Also, Petitioners' reliance on a May 22, 2001 rejection in the parent application, when the claims issued in the '733 patent (in a continuation-in-part application which included new material) were not even submitted until November 1, 2001, conclusively, and additionally, proves that the earlier rejection was inapplicable to the actual '733 claims which were issued much later with additional material vis-à-vis the '850 claims.³ Petitioners' argument thus fails to meet the heightened "more likely than not" standard for institution of CBM review because it provides no credible basis for anticipation or obviousness of any claim.

Third, Petitioner's arguments under §101 are based on a gross mischaracterization of the actual claimed subject matter; the claims are clearly directed to patentable subject matter under all controlling precedent.

Fourth, Petitioners' arguments regarding §112 have been previously rejected by multiple federal judges and are incompatible with their arguments regarding the purported teachings of the prior art. Petitioners contradict their own arguments by first asserting that the '733 patent is so rudimentary that its claims are not patentable over prior art which the Examiner himself allowed the claims over (as discussed below), but then allege that the patent is so inexorably complex that one of ordinary skill in the art could not possibly understand those

³ The Examiner's May 22, 2001 comments were inapplicable to all claims of all patents because they were made in regard to claims which did not issue in any of the patents, as discussed more fully below.

claims. Petitioners' contradictions eviscerate their own arguments.

Fifth, Petitioners ignored the uniqueness of numerous dependent claims by incorrectly asserting that the patentability of those dependent claims rises and falls with the independent claims. That is factually and legally incorrect.

Sixth, the Petitioners' expert's definition of the level of skill of a POSA is deceptively incomplete and their core claim construction positions (alleging, *e.g.*, that the critical inventive "synchronization" claim elements are "method steps") were rejected by all three federal judges and are simply wrong. Thus, because the overall validity analysis of the claims must be based on a *correct* claim construction, all of the Petitioners' invalidity/ineligibility arguments (which are all based on their *incorrect* claim constructions) also fail.⁴

Accordingly, for each of these reasons, which are described in greater detail below, the Petition should be denied in its entirety.

II. BACKGROUND

Patent Owner Ameranth, a small but innovative software company founded in 1996, is the type of company for which the protections of the U.S. patent system were intended. Its entrepreneur founders saw needs and invented a visionary means to meet them, not "abstractly," but with real, proven, award-winning products based on the patented computer software system technology encompassed, *inter alia*, by the

⁴ "[H]ow a person of ordinary skill in the art understands a claim term provides an objective baseline from which to begin claim interpretation." *Phillips v. AWH Corp.*, 415 F.3d 1303, 1313 (Fed. Cir. 2005). Claim scope is determined by analyzing each limitation in light of the claim as a whole before determining compliance with statutory requirements for patentability. MPEP 2106.01(III)(A). Claims must be construed before engaging in a validity analysis. *Phillips*, 415 F.3d at 1327.

'733 patent. Ameranth, in fact, invented, produced and deployed *five* such products which were directed to meeting specific technical needs of business and commerce, and which were the opposite of an “abstract idea.”⁵ Ameranth was properly awarded the '733 patent and three other issued patents which protect those inventions, and deployed its award-winning software products into the market, across thousands of restaurants, hotels, casinos, clubs and stadiums and, as confirmed by Harvard Business School, Ameranth's technology innovations effectively set the wireless ordering standard⁶ until the Petitioners' (all much larger companies) copying and willful infringements largely displaced them (adopting Ameranth's innovations as their own) and took the market that Ameranth created for themselves.

Ameranth was thus compelled by Petitioners' improper conduct to enforce its patents against infringers. This includes, *e.g.*, Petitioner Domino's, which claimed in 2007 that it had invented aspects of Ameranth's technology, and characterized it as its own “breakthrough technology.”⁷ The importance of Ameranth's right to protect its

⁵ As discussed below, those products include Ameranth's (1) 21st Century Restaurant, (2) Improv Comedy Club web/mobile ticketing, (3) Hostalert Reservations/Waitlist, (4) eHost-web/mobile hotel concierge and (5) Magellan restaurant reservations.

⁶ Harvard Bus. Sch. Press (2005) (“Ameranth's main product, 21st Century Restaurant is *poised to become the industry standard* for mobile wireless ordering and payment processing in restaurants.”) (emphasis added) (Exh. 2013 at Exh. A thereto, p. 11 (Nexus Charts)).

⁷ “With the addition of yet another order-taking channel, Domino's is thrilled to lead the market with this breakthrough technology.” *See* Exh. 2003. Domino's made this claim despite now disparaging Ameranth's inventions as an unpatentable “abstract idea.” Further contradicting its position, Domino's had sought two patents for itself (App. Serial Nos. 09/491,265 and 10/182,091) for technology similar to Ameranth's

inventions from copying and infringement was emphasized by Petitioner Apple's CEO, Tim Cook: “*The worst thing in the world that can happen to you if you are an engineer and you have given your life to something - is for someone to rip it off and put their name on it.*” (http://www.dailymotion.com/video/xr7y4b_tim-cook-calls-patent-wars-pain-in-the-ass_tech) (Exh. 2004)). Yet, Apple is trying to do **just that**, right now, to Ameranth, with its own copycat hospitality market patent application.

It is a daunting challenge for a very small company to defend its inventions and its rights against so many powerful corporations, but Ameranth is determined to do so. The current Petition is yet another in a long series of delay and harassment tactics employed by large company defendants against Ameranth, first in the district court lawsuits and now before the Board. Petitioners’ objective is merely to allow them to continue to infringe Ameranth's patents without consequence and adversely affect Ameranth’s licensing program.⁸ Moreover, Petitioners’ contrived arguments have been rejected previously by three different district court judges. And it is clear that Petitioners are using the CBM process merely as a litigation delay tactic in view of the fact that not all defendants have joined the Petition or the Petitions against Ameranth’s other three patents (in a thinly-disguised attempt to avoid estoppel in the district court after this effort fails). Petitioners' dubious tactics abuse the goals of the CBM program, which was designed to provide an alternative and expedited forum for adjudication of the validity of a particular narrow type of patents and not merely a

inventions. Yet only Ameranth obtained patents on this technology.

⁸ The *Ameranth v. Pizza Hut et al.* case against Petitioners in the Southern District of California is currently stayed pending conclusion of this and the three other CBM proceedings.

second venue for **already failed** arguments that did not survive the litigation process and which are intended only to impose further delay and expense.

III. PETITIONERS LACK STANDING BECAUSE THE '733 PATENT IS NOT A COVERED BUSINESS METHOD PATENT UNDER THE AIA

In violation of 37 C.F.R. §42.304(a), Petitioners have failed to demonstrate that the '733 patent is a covered business method patent as defined by 37 C.F.R. §42.304 and, as such, lacks standing to petition for CBM patent review.

A. The '733 Patent Does Not Claim A Financial Product or Service

A "covered business method patent" is a patent that "claims a method or corresponding apparatus for performing data processing or other operations used in the practice, administration, or management of a financial product or service, except that the term does not include patents for technological inventions." AIA §18(d)(1); *see also* §18(a)(1)(B), 37 C.F.R. §§42.301(a), 42.302. For purposes of determining whether a patent is eligible for a covered business method patent review, the focus is on the claims. *See* CBM Final Rules, 77 Fed. Reg. 48734, 48736 (Aug. 14, 2012) ("CBM Rules") (Pet. Exh. 1026) (In accordance with 37 C.F.R. §42.6(d), Patent Owner refers to Exhibits and documents already of record).

1. Legislative History Of AIA And Intent Of CBM Review

Neither the AIA nor the CBM Rules provide an explicit definition for "practice, administration, or management of a financial product or service." However, the CBM Rules indicate that the legislative history and intent of the AIA definitions and the CBM review program would be instructive in determining the contours of the "financial product or services" language. *See* CBM Rules, 77 Fed. Reg. 48735 (Aug. 14, 2012) (Pet. Exh. 1026).

Petitioners have cited a statement from Senator Schumer (also quoted in the CBM Rules) to the effect that the CBM program was drafted to encompass patents "claiming activities that are financial in nature, incidental to a financial activity or complementary to a financial activity." *Id.* at 48735, quoting 157 Cong. Rec. S5432 (Sept. 8, 2011) (Pet. Exh. 1026). Patent Owner notes that the quoted statement was in response to a statement by Congressman Shuster that incorrectly characterized the CBM program as limited only to companies in the financial services sector. As such, it must also be noted that Senator Schumer clarified that "[i]n response to concerns that earlier versions of the amendment were too broad," the CBM patent review would be "narrowly targeted." *See* 157 Cong. Rec. S1053 (Mar. 1, 2011) (Exh. 2005).

2. *The '733 Claims Are Not Directed To Financial Services*

In support of their erroneous assertion that the claimed subject matter of the '733 patent is directed to activities that are financial in nature, Petitioners cherry picked references from the specification dealing with particular applications of the invention for, *inter alia*, restaurant ordering (Am. Petition 19-20). Apparently, Petitioners believe that any use of a technological invention in commerce compels the conclusion that the invention is directed to a financial product or service. However, that belief is not supported by the statute, legislative history, rules or the invention as claimed. The claimed inventions are not directed to "ordering," "reservations," "ticketing," "customer frequency," "payment processing" or "wait-list management" *per se*, they are directed to specialized computer software system functionality which may be used in those contexts, pursuant to recitations of particular claims, as detailed below. But use of the inventions in a business to make money does not transform the

claimed inventions into “financial services.” Petitioners self-servingly defined “financial product or service” to include the application environments in which the claimed inventions may be used, then tautologically declared that the ‘733 claims are therefore directed to a financial product or service (Am. Petition 17-20). Petitioners’ argument requires a leap which the AIA does not allow the Board to make.

Also, by claiming subject matter specifically directed to hospitality industries such as lodging, food service, reservations and ticketing, the '733 patent claims "technologies common in business environments across sectors" with "no particular relation to the financial services sector" and is thus excluded from CBM review. *See* 157 Cong. Rec. S5441 (Sept. 8, 2011) (Exh. 2006). Notably, none of Ameranth’s 26 licensees is a financial services company, and no defendant accused of infringing the ‘733 patent is a financial services company.

One possible end result of use of the claimed systems of the '733 patent may include the sale of, *e.g.*, a meal, hotel room or ticket (the realization of which is outside the scope of the claimed invention), but the claimed subject matter is not thereby automatically a "financial product or service." Such a strained construction is grossly over-inclusive and contrary to the plain meaning of the statute, and would also subsume every software/data processing patent under the purview of the CBM review program. But Congress has recently chosen not to extend CBM review beyond the financial realm to include, *e.g.*, all software patents. For example, H.R. 3309 originally included an expansion of the CBM program to cover all patents. That provision was removed to obtain passage. (*See* “Software Patent Reform Just Died in the House,” *Washington Post*, Nov. 20, 2013 (Exh. 2007)). In fact, at least one of the Petitioners (Apple) lobbied vigorously (and successfully) to strike the CBM program

expansion provision from H.R. 3309. (See Nov. 18, 2013 Letter from Victoria A. Espinel, President and CEO of the Business Software Alliance (“BSA”), in which Petitioner Apple is a controlling member) (General Counsel of Apple, Bruce Sewell, is also Vice Chairman of the BSA) (Exh. 2008)). Thus, in the Petition, Apple argues for an overreaching reading of the AIA as regards Ameranth’s patents, but when it comes to Apple’s own patents, Apple is fighting tooth and nail to prevent the AIA from being expanded to cover review of software/data processing patents. In fact, one of Apple-controlled BSA’s stated reasons for even existing is to “[e]nsure that patents are available to inventions in the software field just as they are available to inventions in any other industry.” (See <http://www.bsa.org/advocacy/intellectual-property-and-innovation> (Exh. 2009)).

Apple’s lobbying efforts against CBM expansion are diametrically opposed to what it told the Board in its Petition:

[W]e are writing to express our opposition to recent legislative proposals expanding the America Invents Act’s “covered business method patent” program. These proposals could harm U.S. innovators – a driving force of economic growth and job creation in this country – by unnecessarily undermining the rights of patent holders. . . data processing is integral to everything from cutting-edge cancer therapies to safety systems that allow cars to respond to road conditions in real time to prevent crashes. Subjecting data processing patents to the CBM program would thus create uncertainty and risk that discourage investment in any number of fields where we should be trying to spur continued innovation.

See <http://www.bsa.org/~media/Files/Policy/Patents/JointCBMLetter091913> (Exh. 2010). Apple has thus publicly admitted in its lobbying efforts, via its participation in and control over the BSA, that the CBM program does not encompass software/data

processing patents. All the while, Apple has been pursuing CBM review of the ‘733 patent, a patent which is clearly not directed to the “very narrow class of financial-services-related patents” which Apple admitted defines the scope of CBM review applicability. Apple and its privies (the other co-Petitioners) should thus be estopped from making the diametrically opposite argument here.

B. The '733 Patent Is Directed To A Technological Invention Which Is Novel And Unobvious Over The Prior Art And Is Directed To A Technical Solution To A Technical Problem

1. The Technological Nature Of The ‘733 Patent

The ‘733 patent describes and claims various forms of an information management and synchronous communications system primarily contemplated for use in the hospitality industry. The inventions described in the patents are software systems that have been licensed by 26 independent companies.⁹ These claimed inventions necessarily synchronize the operations of computers, databases, Web servers and wireless handheld computing devices (such as “smartphones”), etc., to perform specific hospitality related functions. The decisions of these 26 different companies to license Ameranth's patents are compelling evidence that Ameranth's inventions are novel and non-obvious, and these licensees’ **independent** statements about Ameranth's patents are compelling as to the true novelty of the patents.¹⁰

⁹ Ameranth's 26 licensees include some of the largest hospitality companies in the world, the majority of which sought licenses entirely independently of litigation.

¹⁰ ““Reaching an agreement with Ameranth for the use of its **novel patents** was important to Par, since we provide many of the restaurant and hotel industry’s top brands and renowned properties with our industry leading hospitality products, solutions and services.,’ stated Paul Domorski, Chairman & CEO of Par Technology Corporation.”; “Reaching an agreement with Ameranth for the use of its patents was very important to

Petitioners, however, which include some of the world’s largest hospitality enterprises, have blatantly copied and practice the patented inventions across a wide range of, *inter alia*, online and mobile ordering, ticketing and reservation functions. Amazingly, while **now** asserting that Ameranth “invented nothing,” Petitioner Micros¹¹ (the world's largest hospitality technology company) tried to buy Ameranth in 1999-2000 to obtain exclusive rights to Ameranth's intellectual property¹² and, as discussed below, Petitioner Marriott praised Ameranth's technology as innovative and Petitioner Agilysys licensed Ameranth's technology from 1999 until 2012. If the ‘733 patent inventions did not uniquely “solve a technical problem” essential to their mobile/web operations, Petitioners would not be using the inventions, or they would develop “work around” solutions. Yet, they all continue to infringe.

To further appreciate the novel technical aspects of the inventions of claims 1-3 of the ‘733 patent, it is critical to understand the technical problems which the inventors first recognized in September 1998 and for which they uniquely invented the solution. While the invention applies to different hospitality applications, the

Snapfinger, as we provide most of the restaurant industry’s top brands with web, mobile, and call center remote ordering technology,” stated Jim Garrett, CEO of Snapfinger, Inc. “We wanted to ensure that our restaurant partners were in compliance with *Ameranth’s visionary patents* in order to avoid exposing them to potential uncapped liabilities. (Jan. 2013 and Jan. 2012 Press Releases approved by Par and Snapfinger (emphasis added) (Exh. 2011, 2012); *see also In re Roufett*, 149 F.1350, 1355 (Fed. Cir. 1998) (“licenses show[] industry respect for the invention”).

¹¹ Apple, Domino’s, OpenTable and Fandango are Petitioners in the present proceeding. Other parties referred to as Petitioners herein are parties to the other three Petitions filed against Ameranth’s patents in the same family.

¹² *See* Exh. 2013 at 4-5 & Exh. A thereto, pp. 2-3.

patented inventions were originally conceived in the context of restaurant ordering using wireless handheld devices. A number of problems existed with the use of such technology. For example, because of the smaller screen sizes of wireless handheld devices, electronic menus formatted for standard personal computer screens would not fit well or display in readable fashion on such devices. Moreover, restaurant menu selections are really comprised of cascading tiers of options which must be correctly represented on whatever device or series of screens they are presented on. (*See, e.g.*, U.S. Pat. No. 6,384,850 (“’850 patent”) col. 1:41-2:5, 2:32-47, 3:45-57, 6:26-8:59) (the ‘733 includes all disclosure in the ‘850 and additional material).

Computerized electronic menus link these hierarchal tiers of options/ modifiers in a manner that allows selection of a complete orderable item. Thus, if a customer wishes to order a Turkey Club sandwich with Swiss cheese and potato salad, the menu navigation process might progress, *e.g.*, from Screen 1¹³ (Breakfast, Lunch or Dinner) to Screen 16 (Sandwiches, Soups, or Salads) to Screen 58 (Ham and Cheese, Turkey Club, Hot Pastrami, *etc.*), to Screen 112 (Swiss, American, Cheddar, Havarti) to Screen 197 (coleslaw, potato salad, fries, fruit), and so on, until an order is completed. However, one of the problems which arises when a computerized menu created for use on a standard PC is to be used on a wireless handheld device with a smaller display screen on which less information can appear in a single view is that

¹³ The numbers are merely illustrative. The salient point is that a large number of “screens” are required to make up an entire “menu,” which must be linked in a logical and functional manner to enable ordering of the desired menu courses, items, side dishes and/or condiments. And all of that information must be presented on display devices of different screen size and using multiple types of, *inter alia*, operating systems/platforms and communications protocols.

linkages and sequencing of the cascaded menu options, modifiers, sub-modifiers, etc., must change. *See* '850 col. 2:32-47 and Figures 1, 7, and accompanying text.

This re-sequencing challenge exists whenever an electronic menu is configured for use on a smaller wireless handheld device. When only a single type of handheld device is used (for instance, if all wait staff use the same type of device), the re-linking will be the same for all such devices. But the problem is more complex when the menu is not simply used by wait staff with uniform devices, but also is accessible by individual consumers who have many different kinds of computing devices and smartphones with different and non-standard display screen sizes and characteristics. In order to work in such a varied environment, the menu generation system must be capable of adapting to the different screen sizes/display characteristics of the different devices and formatting, linking and sequencing the different cascading screens and menu tiers to work properly on all such devices, as shown throughout the '733 patent.

As also described throughout the '733 patent, other problems understood by the inventors included the challenges involved in getting the menus out to remote computing devices on which orders would be placed and maintaining system synchronization so that the same substantive hospitality information (*e.g.*, menu items) would appear on any of the connected devices regardless of whether screen size, formatting, or sequencing levels, etc., were different device to device. Further, the inventors knew that a viable system had to address the reality that menus change. The inventors did not believe that electronic menu systems which required manual programming or inputting of menu information into individual handheld devices were practical or commercially viable, and certainly not for consumer mobile devices. The inventors realized that the same substantive information had to be reflected on each

of the computing devices displaying the menu, regardless of format, without an inordinate amount of data manipulation or programming with every change.

The patented invention uniquely solved these challenges with a technological software system solution in which a central database maintains “database equilibrium” and contains a “single truth” of hospitality data—for example, an up-to-date restaurant menu with current items and pricing—and through the software modules described in the patents (menu configuration software, a communication control module, communication protocols and application programming interfaces, etc.) causes that same *substantive* menu data to be correctly formatted, sequenced, displayed and updated across a variety of connected devices—including but not limited to different types of wireless handheld computing devices, such as smart phones. See ‘733 patent, *passim*.

The ‘733 patent system claims also recite functionality enabling “manual modification” of a second or modified menu after generation of said menu (and the method claims recite the step of manually modifying the second menu). The manual modification functionality is described as being achieved, *e.g.*, via handwriting or voice capture/recognition. (‘733 patent col. 3:48-4:46).

At the time of the inventions of the ‘733 patent, the *above*-described computer software functionality, and the specifically recited arrangement of computer and software components, were unknown to a person of skill in the art, and the claimed inventions were not achievable using existing components either with or without the knowledge of a person of skill in the art. As explained herein, because Ameranth’s patents describe a “technological invention,” they do not meet the definition of a covered business method patent and are thus not subject to CBM review.

2. Many Others Have Found Ameranth's Claimed Inventions To Be Novel and Innovative

Significant commercial success and industry recognition followed for the technology developed by Ameranth embodying the inventions described in the patents, testifying to the novel and innovative nature of Ameranth's patented technology. This is evidenced in the comprehensive Secondary Factors Declarations provided to the USPTO in the prosecution of Ameranth's U.S. Patent No. 8,146,077 (the "'077 patent"), a follow-on patent in the '850 and '733 patent family, including detailed explanations of nexus to the claimed subject matter, as discussed below.

Ameranth invented and deployed five software products for the hospitality industry which practiced claims of the patents—21st Century Restaurant, Improv Comedy Club Ticketing, Hostalert, Magellan (with Zagat), and eHost. *See, e.g.*, Pet. Exh. 1048 at 5-6. Red Lobster, Seasons 52, and Medieval Times restaurants and Zagat adopted Ameranth's technology for its operations. Ameranth's patented technology was also deployed at numerous sports and entertainment venues, including, *e.g.*, American Airlines Center, Madison Square Garden, Staples Center, Lambeau Field, and Improv and Funny Bones comedy clubs throughout the country.¹⁴ Holiday Inn likewise deployed Ameranth's technology in thousands of

¹⁴ Before deciding to stop paying its license fees in 2012, Petitioner Agilysys (which acquired Infogenesis in 2006) licensed Ameranth's patents for more than a decade, which covered their product deployments at, *e.g.*, Madison Square Garden, Staples Center, Lambeau Field and American Airlines Center. *See* Exh. 2013 at Exh. A thereto, p. 11 (Nexus Charts) ("The solution was recently installed at American Airlines Center . . . to provide in-seat service to patrons." "We are also bringing wireless solutions to customers like Park City (Utah) and MGM/Mirage' added Scot Martiny, Vice President, Sales and Marketing for Infogenesis." "The level of interest is very high among the cruise, casino, resort, stadium and restaurant segments").

hotels nationwide.¹⁵

Many others have acknowledged the unique inventive aspects of Ameranth's patents. For example, Judge Everingham of the Eastern District of Texas concluded that "The menus are interactive and serve two important functions: displaying an up-to-date menu and entering an order. *The invention solves a number of problems with the prior art.*" Exh. 2014, p. 2 (emphasis added). In the litigation involving the present Petitioners in the Southern District of California, Judge Sammartino provided the following synopsis: "The '850 Patent [the '850 specification is also included in its entirety in the '733 patent, along with additional material] covers an information management and synchronous communications system and method for generating computerized menus for use on specialized displays. *The invention allows for the more efficient use of handheld wireless devices in the restaurant and hospitality fields by creating an integrated solution that formats data for smaller displays and allows for synchronization of data.*" *Ameranth v. Pizza Hut et al.*, Dkt. No. 27 at 3 (Exh. 2018) (emphasis added). Petitioners ignored the aspects of the '733 claims which distinguish over the prior art—they simply pointed to certain components of the claimed system in isolation (*e.g.*, "computer" and "internet") and alleged that the entire claimed system is thus presumptively not patentable based on their superficial

¹⁵ Ameranth's technology and products have also won several major industry technology awards (one nominated personally by Bill Gates, as discussed below), and Ameranth has been recognized as a leader in wireless technology innovation in both national publications (including *The Wall Street Journal*, *New York Times*, *USA Today*, and *Time Magazine*) and in prominent hospitality industry publications.

and incorrect characterization. That is most certainly not allowed by the AIA CBM provision, as stated repeatedly by the AIA's sponsors during debate on the Bill:

[B]usiness methods do not include “technological inventions.” . . . the definition applies only to abstract business concepts and their implementation, whether in computers or otherwise, but does not apply to inventions relating to computer operations for other uses or the application of the natural sciences or engineering.

Statement of Senator Kyl, 157 Cong. Rec. S1379 (Mar. 8, 2011) (Exh. 2019).

[A]n actual software invention is a technological invention, and is not subject to review under section 18.

Statement of Senator Kyl, 157 Cong. Rec. S5431 (Sept. 8, 2011) (Exh. 2020);

see also Statement of Senator Schumer, 157 Cong. Rec. S1364 (Pet. Exh. 1043);

Matal at 633-35 (Pet. Exh. 1029).

Petitioners have not made *any* credible allegation of how the ‘733 claims are not directed to technological innovations over the prior art. Specifically, with respect to the claims which recite the synchronous generation and transmission of “menus” from a central server to a handheld computing device or Web page (claims 1-3), Petitioners cite no prior art references or combination of references which teach or suggest this functionality in the context of the claimed subject matter as a whole. The Petition is equally deficient as regards the claims which recite a system for generating and synchronizing menu data between the controlling CPU/data storage device and another computing device (claims 4-11) or a method for synchronizing menu data between the controlling CPU/data storage device and another data storage medium (claims 12-15). Moreover, Petitioners entirely ignored the vast amount of secondary evidence confirming the non-obviousness of the inventions, including even their own prior licensing of it, and purposefully shielded their “expert” from knowledge of that

evidence. Petitioners counsel simply hand waved by citing to preliminary and totally irrelevant statements by the Examiner during prosecution in hope the members of the PTAB panel are not looking closely, as discussed below. However, the Board is required to examine the basis for institution of a CBM review put forth by a Petitioner and is not required nor allowed to make conclusions which are not supported by something in the record evidence and argument presented in the Petition, nor is the PTAB allowed to ignore evidence to the contrary which was withheld by Petitioners.

In contrast to the Petition's failure to point to anything credible indicating that the '733 claims are not technological inventions which are anticipated or obvious in view of the prior art, Patent Owner has detailed copious evidence of the technological, innovative, nature of Ameranth's claimed inventions.¹⁶ For example, Microsoft's founder Bill Gates, in personally nominating Ameranth for one of its many technology awards based on its patented technology, stated that: "Ameranth is one of the leading pioneers of the information technology age for the betterment of mankind." Exh. 2013 at Exh. A, p. 10; *see also* Exhs. 2021, 2022, 2025. A Business Week article about Ameranth's hospitality technology, and its co-founder and lead inventor, Keith McNally (Ameranth's current President), commented:

Keith McNally's eMenu technology is his latest bid to speed service, and gain efficiencies, in the restaurant and hotel industries . . . it's not quite Star Trek

¹⁶ While Ameranth's '850, and then '325 and '733 patents, were issued prior to Ameranth's submission of its extensive secondary factors evidence (in support of the later-issued '077 patent), that evidence is equally supportive of the non-obviousness of the claims of the '733 patent. *See* attached '077 Secondary Factors Declaration and Nexus Summary attached as Exh. A thereto (Exh. 2013).

Exh. 2023; Exh. 2013 at Exh. A, p. 11. Steve Glen, a vice-president of Marriott (yet another petitioning defendant—at odds with its own later-contrived petition allegations), wrote:

As you are aware, Marriott International is very interested in [Ameranth’s] 21st Century Restaurant System technology and we believe that many of its **innovative features** will enhance the efficiency of our operations, increase customer satisfaction and help increase profitability in our operations.

Exh. 2024 (emphasis added); Exh. 2013 at Exh. A, p. 10. Also, Computerworld notified Ameranth that:

The case study of your exceptional use of information technology- Ameranth Wireless Improv Comedy Club Solution-has been included in the Computerworld Honors Online Archive as an example of a **revolutionary change** you have **created** at the commencement of a new century.

Exh. 2022(emphasis added); Exh. 2013 at Exh. A, p. 12; *see also* Exhs. 2021, 2025.

A September 2000 press release for the Moby Award won by Ameranth states:

This award, from Mobile Insights honors the **best and finest implementations** of mobile computing and wireless data communications.

Exh. 2026 (emphasis added); Exh. 2013 Exh. A, p. 10.

Although Petitioners baselessly assert that Ameranth’s innovations as embodied in the ‘733 patent do not describe a technological invention, the facts and these multiple independent sources concluded otherwise. When these facts, the actual claim language, and the Markman rulings withheld by the Petitioners are considered in their entirety, a conclusion is compelled that the ‘733 patent claims technological inventions which are not taught or suggested by the prior art, are not directed to “business methods,” and thus are excluded from CBM review.

3. *The Petition Grossly Misstates The Actual Claims*

Petitioners’ core thesis on “technological invention” is that the ‘733 patent

invention was “directed at solving the business problem of how to become more user friendly through computerizing non-computerized processes.” (Am. Petition at 22). Petitioner’s characterization is clearly wrong in light of the actual claim language, which is directed, *inter alia*, to a system for transformation of a “first” or “master” **computerized** menu into a “second” or “modified” **computerized** menu (claims 1-16).¹⁷ The misleadingly cropped passage from the ‘733 patent quoted by Petitioners (“solving the problem of converting paper-based menus or Windows PC-based menu screens to small PDA-sized displays and Web pages”) was merely a statement that restaurant menus had historically been paper based. Clearly, the claims are directed to computerizing **second** menus for non PC standard sized displays once menus were first computerized. This computerization of second menus presented unique problems with regard to how such menus could be presented on various “non standard PC sized” screen types and sizes, as well as on Web pages. *See* ‘850 & ‘733 patent Abstract (“user-friendly and efficient generation of **computerized menus and reservations** with handwritten/voice modifications for restaurants and other applications that utilize equipment **with nonstandard** graphical formats, display sizes

¹⁷ Clearly these claims are directed to converting the data representing the **first/master** menu (which represents real, physical objects) into a **second/modified** and different form of that data (the epitome of a transformation), and this computerized task could not possibly be performed by a human, *i.e.*, synchronously linking with all of the parameters in the central database and calculating exactly how to make the resulting menu appear optimally on multiple handheld devices or Web pages as recited in claims 1-3. *See* April 21, 2010 Markman Order at 8 (Exh. 2014) (Claims 1-11 are directed to “a computerized system having multiple devices in which **a change to data** made on a central server is updated on client devices and vice versa.”) (emphasis added).

and/or applications”) (emphasis added); ‘850 col. 1:6-12 (“This invention relates to an information management and synchronous communications system and method *for generation of computerized menus for restaurants* and other applications with specialized display and synchronous communications requirements related to, for example, the use of equipment or software *with non-PC-standard* graphical formats, display sizes and/or applications.” (emphasis added). These unique problems were the primary technical problems the claimed invention was directed to, as discussed above. No claim of the ‘733 patent is directed to “scanning” a paper menu and converting it into a digital form as Petitioner’s proffered interpretation misleadingly implies. Thus Petitioner’s mischaracterization of the patent claims is overtly wrong as are its core claim constructions, as addressed below.

Petitioners go on to allege that the patent’s description of implementation of the invention by common computer languages is somehow meaningful (Am. Petition at 23). This is a further attempt to mislead the PTAB into making an incorrect and superficial analysis divorced from the actual claim language. However, the eligibility of a patent for CBM review is determined by what the patent actually claims. CBM Rules, 77 Fed. Reg. 157 at 48736 (Pet. Exh. 1026). The ‘733 independent claims recite a system/method for generating and transmitting a menu to a wireless handheld device or Web page (claim 1), a system for generating a second/modified menu and synchronizing same on another computing device (claims 4, 5) and a method for generating a second menu and synchronizing same with another data storage device (claim 12), all of which enable or involve manual modification functionality. Further, numerous ‘733 dependent claims include additional and independently unique inventive elements all of which

were entirely ignored by Petitioners. The claimed inventions are systems/methods which operate pursuant to particular software-programmed functionality. The inventions include uniquely inventive software elements and are not generic amalgams of “off the shelf” parts or methods implemented with off the shelf parts. As it has done in prior CBM cases, the Board should reject Petitioners’ mischaracterization of the claimed subject matter.¹⁸

4. The Petition Fails To Provide Any Credible Basis For Its Contention That The Claims Do Not Define A Technological Feature That Is Novel And Unobvious Over The Prior Art

Critically, Petitioner’s **only** argument that the ‘733 patent claims do not “as a whole recite[] a technological feature that is *novel and unobvious over the prior art*” (37 C.F.R. §42.301(b)) is based on the Examiner’s comments in the parent ‘850 application regarding a purported prior art reference over which the actual issued claims of the ‘850 patent were *allowed*. Petitioners’ Exhibit 1035 (Office Action dated May 22, 2001), discussed at pages 24-25 of the Petition, is an Office Action in the parent application which stated the Examiner’s prior art positions regarding claims which are not even in the ‘850 patent and which are thus not relevant to the Petition and indisputably cannot form the basis for a CBM review of the actually issued claims. Conclusive proof of the utter failure of Petitioner’s facile argument is provided by the Examiner’s stated Reasons for Allowance of the ‘850 claims in the

¹⁸ See, e.g., CBM2013-00027, Inst. Dec. at 37 (“Petitioner contends that the invention [] centers on the abstract idea of “determining a price using external data sources.” We do not view [the] independent claims . . . as reciting merely determining a price using external data sources. The[] claims recite a specific combination of computer components that interact in such a way to match or compare buy and sell orders for a plurality of securities based upon conditions set forth within each order.”).

very same document cited by Petitioners:

Claims 20-30, 40-43 and 55 [later renumbered as '850 issued claims 1-16] are ***allowed over the prior art of record.***

Applicant has claimed uniquely distinct features in the instant invention which are not found in the prior art either singularly or in combination They are . . . “a sub-modifier menu stored on data storage device and displayable in a window of graphical user interface, and application software for generating a second menu from first menu and transmitting second menu to a wireless handheld computing device or Web page.” The closest prior art, ***Cupps (US Patent No. 5,991,739)*** and Chen (US Patent No. 5,724,069) discloses convention of user interactive interface providing an on-line ordering distribution, either singularly or in combination, ***fail to anticipate or render the above underlined limitations obvious.***

Statement of Reason for Allowance, App. Ser. No. 09/400,413 (Pet. Exh. 1035 at 6-7) (underlined/italicized emphasis in original, bold/italicized emphasis added).

The ***only*** reference relied on by Petitioners, Cupps U.S. Pat. No. 5,991,739, as purportedly rendering the claims not novel and obvious, was thus expressly rejected by the Examiner (in the very same Office Action cited by Petitioners) as a basis for unpatentability of the ***actual issued claims*** of the '850 patent. Dispositively, the Examiner ***allowed*** claims based on, *inter alia*, their inclusion of “application software for generating a second menu from [a] first menu and transmitting [the] second menu to a wireless handheld computing device or Web page.” The technological features of the claims thus undeniably include specific software functionality which distinguished over the prior art.¹⁹ These claimed technological features, among

¹⁹ Petitioners must demonstrate that it is “more likely than not” that at least one claim is unpatentable. 77 Fed. Reg. at 48685 (Aug. 14, 2012) (Pet. Exh. 1027). Because the

others, were not directed to using known technologies; these features simply did not exist prior to the invention, and the Petition made no credible showing otherwise.²⁰

Further, the Cupps patent belonged to the Food.com company, which admitted that it needed Ameranth's technology by partnering with Ameranth to obtain the 21st Century Restaurant technology covered by the '850 and '733 patents:

“Our partnership with Ameranth fits perfectly into our plans for the delivery of online orders from a consumer's keyboard to a restaurant's kitchen," said Food.com's Chairman and CEO, Rich Frank. "Ameranth's technology will help us to increase both the speed and the efficiency in transmitting orders to our partner restaurants, and will significantly decrease our margin of error. The same capabilities that will allow for these improvements in online ordering will also enable users to make reservations, check wait times, and place themselves on wait-lists so that they don't have to spend endless hours waiting to get seated when they decide to dine out.”

“technological feature” question is intertwined with whether the challenged claim is “*novel and unobvious over the prior art*” (37 C.F.R. §42.301(b)), the “more likely than not” standard is applicable to the technological feature question. Petitioners have not met this high threshold requirement because the purported prior art submitted by Petitioners was actually distinguished by the Examiner as not teaching or suggesting the actual claimed invention, and the owner of that very same alleged prior art actively sought to obtain the patented Ameranth technology for itself.

²⁰ Moreover, the Petition’s failure to consider the actual recitations of the '733 patent claims is yet another fatal defect. The '733 claims were not submitted until Nov. 1, 2001, six months after the Office Action statements on which Petitioners’ rely to make their misleadingly argument regarding alleged prior art, and the '733 claims recite limitations not in the '850 issued claims. Further, Petitioners’ reliance on Examiner statements regarding '850 claim subject matter, *e.g.*, “wherein the second menu is created in conformity with hypertext markup language or extensible markup language,” (Am. Petition at 25) is not relevant to the '733 patent because such language does not appear at all in the '733 claims.

July 1999 Food.com Press Release (Exh. 2027).

At the precise time of the filing of the parent ‘850 application, in 1999, Food.com (previously Cybermeals) was the world leader in online food ordering, yet partnered with Ameranth to obtain Ameranth’s synchronization technology. At the time (just one week before the priority application leading to the ‘850 patent was filed), Food.com sought to obtain the exclusive right to Ameranth’s technology:

I have met with Keith McNally [Ameranth Founder and lead inventor of the ‘850 and ‘733 patents] to agree on the deal points on a Licensing Agreement. Here are the products and services we would want.

1. Menu Wizard – this is a tool which digitally constructs and updates restaurant menus. [The] benefits to us with this tool would be the following:
 - a) Create and update menus faster with significant labor savings
 - b) Lower cost of maintenance (restaurant customers will be able to update and change specials themselves)
 - c) Exclusive rights to this tool (barrier to entry)
2. Communications Wizard—this tool creates a standard that can be used to integrate with any POS terminal and establishes the online ordering protocol.
3. Reservations—Food.com would have exclusive rights to the online reservation system. They would help us create a hybrid system that can connect with the POS but can also operate through a call center as we establish the POS integration.

Internal Food.com Memo between its Executive Team (Exh. 2028). Thus, not only did the Examiner conclude that the ‘850 claims were novel and non-obvious over the Cupps patent technology, but so did *the owner/inventor of the Cupps patent*. See, e.g., 1.132 Declaration in App. Ser. No. 11/112,990, Dec. 13, 2010, at pp. 3-4 & Exh. A, p. 3 (Exh. 2013) (showing nexus between claims of follow-on application in ‘850 patent family and secondary evidence of non-obviousness including, *inter alia*, the

Cupps patent and Food.com, *i.e.*, a direct correlation between the “Communications Wizard” and “Menu Wizard,” which Food.com sought from Ameranth, with Ameranth’s “21st Century Restaurant” software product and with elements of claims of patents in the ‘850 patent family); *see also* Examiner Interview Summary, App. Ser. No. 11/112,990, October 14, 2011 (Exh. 2029) (In this follow-on application in the ‘850 patent family, Examiner Brophy and Supervisory Examiner Bullock concluded that “[T]he applicant explained how *the secondary factors show non obviousness.*” (emphasis added). Subsequent to the Interview, an Examiner’s Amendment was entered and the claims allowed). Moreover, the owner/inventor of the Cupps patent was clearly a person of ordinary skill in the art at the time of the Ameranth inventions, and thus Food.com’s repeated use of the word “**tool**” in describing the Ameranth products (and how such **tools** would solve Food.com’s **problems**) eviscerates Petitioners’ contention that the Ameranth products and patents are not directed to technical solutions to technical problems as well as confirming that they are not “abstract ideas.”²¹

Unlike the recent Institution ruling as to the technological invention aspect in CBM2013-00027 (at page 10), in which it was stated that “Patent Owner does not assert that, **at the time of the invention** in the ’419 patent, electronic trading platforms, nor computer networks, were unknown, unachievable, or incapable of

²¹ Still further, Petitioner QuikOrder is now the owner of the Cupps patent and thus cannot be assumed to have committed an unintentional mischaracterization of the relevance of the Cupps patent to the ‘850 and ‘733 patents. Tellingly, QuikOrder was also very interested in Ameranth’s patented technology, as was the original owner Food.com. The only difference is that the original owner sought to use the technology via a license, whereas QuikOrder does so via infringement.

being combined in the manner claimed” (emphasis added), Ameranth has provided indisputable evidence of the non-obviousness of its inventions at “**the time of the invention**” which was also explained contemporaneously in the patents themselves:

[T]he unavailability of any simple technique for creating restaurant menus and the like for use in a limited display area wireless handheld device or that is compatible with ordering over the internet has prevented widespread adoption of computerization in the hospitality industry. Without a viable solution for this problem, organizations have not made the efforts or investments to establish automated interfaces to handheld and Web site menus and ordering options.

‘850 patent col. 2:39-47.²² And the only evidence cited by Petitioners as allegedly showing knowledge in the prior art shows no such thing as explained above.

Thus, Petitioners’ argument regarding the purported absence of a technological feature is irreparably flawed (as well as being an attempt to mislead the PTAB as to what the prosecution record actually says). Petitioners therefore have put forth ***no*** credible reason whatsoever on which the PTAB could base a determination that the

²² See also, e.g., Secondary Factors Evidence presented in Exh. 2013:

They [Ameranth] had just developed an innovative new solution- that they called their 21St Century Restaurant “software wizard”- which had the capability to interface existing “point of sale” (POS) systems (with their intensive graphical user interfaces and complex databases) to the mobile wireless devices that we were preparing to introduce to the market in 1999.

Without this new solution, the “barriers to entry” would have remained enormous and prohibitive to allow wireless devices to move from the “niche area” of the market to the mainstream.

(March 2008 Memorandum of John Harker of Symbol Technology) (Exh. 2013 at Exh. A thereto, p. 3).

actual issued claims of the '850 and '733 patents are not novel and obvious over the prior art, and the record evidence (which Petitioners either mischaracterized or failed to mention) compels the opposite conclusion. A CBM proceeding cannot be instituted where the alleged absence of a technological feature is actually **refuted** by the record evidence as it is here. Moreover, a party taking a position adverse to the patentability of a claim bears the burden of proving a factual underpinning for invalidity, and the Board may not remedy such party's deficiency by inserting new facts or rationales. *See Rambus Inc. v. Rea*, 731 F.3d 1248, 1255 (Fed Cir. 2013).

5. *The Petition Also Failed To Consider The Claims As A Whole As Required By The AIA And The PTAB Rules*

The Petition fails for yet another critical reason. 37 C.F.R. §42.301(b) states that the technological invention determination requires a case-by-case consideration of "whether the claimed subject matter as a whole recites a technological feature that is novel and unobvious over the prior art; and solves a technical problem using a technical solution." However, Petitioners have mistakenly pointed to individual elements and features of the claims of the '733 patent, declaring them to be "conventional hardware" or "conventional software" components. *See* Am. Petition at 26-27. The correct analysis is whether the claimed subject matter **as a whole** recites a novel and non-obvious technical feature. 37 C.F.R. § 42.301(b). Moreover, Petitioners conspicuously failed to mention the wireless handheld computing device limitation present in claims 1-3 of the '733 patent. Further, Petitioners ignored the "manually modified" limitation present in all claims of the '733 patent. They ignored these limitations because a principal technological feature of each of claims 1-3 is the functionality of specialized software to synchronize menus between a central

database and wireless handheld computing devices and a principal technological feature of every claim of the '733 patent is the functionality of specialized software to synchronize menus on different devices and to provide for manual modification functionality. As the Board has held in other cases, an unsupported allegation of “conventional” components fails where the claims are “limited to machine operation” and the Petition fails to explain how the claim elements “represent routine, conventional, general-purpose computer activity.” *See* CBM2013-00017, Denial of Request for Rehearing, Paper No. 17 at p. 3-4.

A straightforward reading of the specification and prosecution history of the '733 patent clearly shows the presence of numerous technical features which were not known in the prior art, and thus the claims as a whole (all of which include one or more of these features) were clearly not known in the prior art. *See, e. g.*, Examiner's Reasons for Allowance, May 22, 2001 (*see* Pet. Exh. 1035 at pp. 6, 7). For example, as discussed above, core inventive concepts described in the '733 patent and reflected in the claims include software functionality for automatically transforming, reconfiguring, and correctly relinking the cascading tier structures of hospitality menu information for display and operation on different types and sizes of computerized devices (desktop PCs, laptops, smartphones, etc.), and synchronizing such hospitality data, and changes thereto, across the computerized system without necessity of individualized updates/revisions to each device. Moreover, each claim adds the “manually modified” functionality, which was not known in the prior art in the context of computerized menus as claimed. Whether certain aspects of the entire claimed system might have been known in the prior art is irrelevant. The combination of all of the claimed features (including the novel features discussed above),

considered as a whole, comprises a technological feature that was novel and unobvious over the prior art at the time of the invention.

Petitioners incorrectly allege that the inventions recited in the claims of the '733 patent could be performed using only a pen and paper (*See* Am. Petition at 8, 55) and that the inventions are directed to the “business problem of how to become more user friendly through computerizing non-computerized processes” Am. Petition at 22, 26. Petitioners’ characterization is incorrect. As previously noted, practicing the synchronous invention with pen and paper is not even possible due to the very nature of the claimed invention, which is not the simple computerization of printed menus as Petitioners simplistically and incorrectly allege. As detailed above, the Petition fails to even minimally address *the actual claims* of the ‘733 patent.

As previously mentioned, in yet another example of the Petitioners’ two-faced approach to trying to tear down the patent rights of others while simultaneously trying to obtain the very same rights for themselves, Petitioner Apple argues that the ‘733 claims are directed to “conventional” subject matter while also filing its own patent application on the same subject matter covered by the ‘733 patent. In Pat. Pub. No. US 2013/0332208 (published Dec. 12, 2013), Apple seeks a patent on “*Systems and Methods for Processing Orders and Reservations Using an Electronic Device.*” This application includes subject matter which Apple seeks to claim for itself and which is encompassed by the ‘733 patent including, *e.g.*, transmitting a “menu” to, and receiving an “order” from, a “portable electronic device.” Apple’s ongoing attempt to patent this technology is an admission that the ‘733 claims, which were filed eleven years before Apple’s application, were **not** “conventional.” Apple did not disclose this patent

application to Ameranth, the Board or to the District Court for the Southern District of California. The Board should appreciate Apple’s hypocritical conduct for what it is—a duplicitous attempt to game the patent system to eliminate the legitimate rights of others and lay claim to those rights for itself. The Board should view all of Apple’s and the other Petitioners arguments through that lens.

6. *The ‘733 Patent Claims Technological Inventions Directed To Technical Solutions To Technical Problems*

Petitioners argue that Ameranth’s invention “simply computerizes the well-known concept of generating menus and facilitating orders from the menus, a concept that has been performed by humans ‘verbally’ or by ‘pen and paper’ for years before the patent application was filed.” Am. Petition at 8-9, 55. Based on that erroneous characterization of what the patent claims actually cover, Petitioners contend that the patents merely claim a non-patentable “abstract idea.” *Id.* at 7. As discussed above, however, Ameranth’s ‘733 patent is not directed to merely rendering electronic versions of traditional paper menus and permitting ordering from those menus.

Core inventive concepts described in the ‘733 patent and reflected in the claims include software functionality for automatically transforming, reconfiguring, and correctly relinking the cascading tier structures of hospitality menu information for display and operation on different types and sizes of computerized devices and software-enabled interfaces (desktop PCs, laptops, Web browsers, smartphones, etc.), and efficiently and quickly synchronizing such hospitality data, and changes thereto, across the computerized system without necessity of individualized updates/ revisions to each device. These functions not only are performed by software components operating and interacting with a computerized system (central/master database,

computer operating system, Web server, Web pages, wireless handheld computing devices, etc.), but could not be performed without such technological components, and thus the claimed invention is not merely a computer replacement for functions performed previously either verbally or using pen and paper. The invention was not simply creating computerized menus, it was, *inter alia*, solving the problem of how to display and synchronize computerized menus on non-standard devices/interfaces. See e.g., ‘850 patent col. 3:26-29 (“[G]enerate and maintain computerized menus for, e.g., restaurants and other related applications that utilize non-PC-standard graphical formats, display sizes or applications.”). The ‘733 claims also recite manual modification functionality in the context of computerized menus as specifically recited in each claim, which was a solution for the problem of needing to provide for greater flexibility in the computerized menu context than was known as regards menus controlled entirely from the back end of a system. Thus, Ameranth’s patented inventions “solve a technical problem using a technical solution,”²³ which was not described or suggested by the prior art as was recognized by the Examiner during prosecution of the parent application (including the very same alleged prior art, the Cupps reference, which the Petitioners put forth as the sole basis for their contention that the claims of the ‘850 and ‘733 patents are not directed to a technological invention). Consequently, the patents in suit are exempt from CBM review.

²³ The legislative history makes clear that software systems may qualify as technological inventions: “[T]echnological inventions are excluded from the scope of the program . . . technological inventions include inventions in the natural sciences, engineering, and computer operations—and [] inventions in computer operations obviously include software inventions.” S. 5431 Leg. History, Statement of Sen. Kyl, Cong. Rec.-Senate, September 8, 2011 (Exh. 2020).

IV. CLAIM CONSTRUCTION

During a review before the Board, the claims of an unexpired patent must be provided their broadest reasonable interpretation in light of the specification. 37 C.F.R. § 42.300(b); 77 Fed. Reg. 157 at 48697-48698 (Aug. 14, 2012) (Pet. Exh. 1027). The broadest reasonable construction means that "the words of the claim must be given their 'plain meaning' unless such meaning is inconsistent with the specification." MPEP § 2111.01(I); *see* 77 Fed. Reg. 157 at 48699 (Pet. Exh. 1027). In the absence of a specific definition in the specification, a claim term is presumed to take on its ordinary and customary meaning that the term would have to a person of ordinary skill in the art. *Id.* Significantly:

Though understanding the claim language may be aided by explanations contained in the written description, it is important not to import into a claim limitations that are not part of the claim. For example, a particular embodiment appearing in the written description may not be read into a claim when the claim language is broader than the embodiment.

MPEP § 2111.01(II) (*quoting Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004)).

In their Amended Petition, which Petitioners filed because their original Petition was deemed insufficient due to Petitioner's failure to provide any claim constructions whatsoever, Petitioners again failed to provide any meaningful claim constructions. The few constructions they have reluctantly provided are incorrect,²⁴

²⁴ As explained below, Petitioners' expert's definition of the skills of a POSA is materially incomplete and incorrect, innately confirming that Petitioners' proposed constructions are incorrect, because claims must be interpreted as seen through the eyes of a POSA at the time of the invention. Further, if an expert cannot even properly define the level of skill for a POSA, his entire opinion should be considered as unsupported and ignored by the PTAB. "The Board has broad discretion as to the

and Petitioners withheld and ignored multiple prior district court constructions and holdings which directly refute what Petitioners now argue to the Board. This is particularly incredulous considering that three (3) separate claim construction orders were issued in 2010 construing claims of the ‘733 patent. These orders specifically rejected the very constructions and arguments which Petitioners re-allege yet again. Yet Petitioners neither provided nor disclosed to the PTAB any of these highly relevant previous judicial constructions and interpretations of the ‘733 claims.²⁵

In contrast, Patent Owner adopts and accepts all of the previous judicial constructions (Exhs. 2014-2017) (Exh. 2017 is a Markman Order by Judge Payne of the Eastern District of Texas construing terms of the ‘850 and ‘325 patents, which have limitations in common with the ‘733 patent), and urges the Board to adopt them for this proceeding as well because they were thoughtfully considered based on the intrinsic evidence only²⁶ and are entirely consistent with the “broadest reasonable

weight to give declarations offered in the course of prosecution,” *In re American Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1368 (Fed. Cir. 2004), and may give little weight to expert testimony lacking persuasive factual corroboration. Further, all written description allegations are necessarily defective as well. *See Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1384 (Fed. Cir. 1986) (“a patent need not teach, and preferably omits, what is well known in the art.”).

²⁵ The Federal Circuit has expressed disapproval for such “gamesmanship:”

Kilopass was making claim construction arguments to the United States Patent and Trademark Office Board of Patent Appeals and Interferences (the “Board”) that were directly contrary to those being made to the court in order to distinguish over a key piece of prior art during a concurrent inter partes reexamination. The district court admonished Kilopass for engaging in “gamesmanship.”

Kilopass v. Sidense Corp., No. 2013-1193 at 9 (Fed. Cir. Dec. 26, 2013) (Exh. 2033).

²⁶ The only exception was that the judge relied on the definition of “Web page”

interpretation” standard applicable in this proceeding. Each of the prior district court constructions was determined by consideration of the claim language and the specification description where deemed necessary to understand the meaning of a term used in the claims, which Patent Owner submits is precisely the standard the Board must apply here.²⁷ "The protocol of giving claims their broadest reasonable interpretation during examination does not include giving claims a legally incorrect interpretation. This protocol is solely an examination expedient not a rule of claim construction." *In re Skvorecz*, 580 F.3d 1262 (Fed. Cir. 2009). Moreover, USPTO personnel must first determine the scope of a claim by thoroughly analyzing the language of the claim before determining if the claim complies with each statutory requirement for patentability. MPEP 2106(II)(C).

Thus, the Board must construe the entirety of the challenged claims, including all dependent claims (which Petitioners fatally glossed over), before performing any analysis of validity. Critically, Petitioners have failed to consider the claims as a whole and failed to provide proposed constructions for even a small fraction of the

provided by the well-respected World Wide Web Consortium in 1999 to refute the Defendants’ attempts to mischaracterize the “Web page” definition based on the very same reference (Microsoft Computer Dictionary) which Petitioners and their expert rely on again in the instant Petition.

²⁷ Note that the PTAB adopts district court claim constructions where they “are consistent with the ordinary and customary meaning of the terms as understood by one of ordinary skill in the art.” *Apple v. SightSound*, CBM2013-00019, Paper No. 17, Non-Institution Decision at 7. Notably, Petitioner Apple was also the Petitioner in the aforementioned CBM Petition, and in that proceeding Apple disclosed district court claim constructions. Thus, when favorable to it, Apple discloses district court claim constructions to the PTAB; when unfavorable, Apple pretends they don’t exist.

pertinent elements of any claim. Petitioners' conclusory arguments thus must be rejected. *See In re Pearson*, 494 F.2d 1399, 1405 (CCPA 1974) ("Attorney's arguments in a brief cannot take the place of evidence."); *In re De Blauwe*, 736 F.2d 699, 705 (Fed. Cir. 1984) (lawyer arguments and conclusory statements which are unsupported by factual evidence are entitled to little probative value).

Petitioners' shockingly sparse claim construction proposals (supported by nothing other than attorney argument and an insubstantial "expert declaration" of less than six pages based on an incomplete and flawed definition of the skill level of a POSA²⁸) begin with "Web page," which Petitioners assert means "a document on the World Wide Web." Petitioners' proposal is astounding in view of the fact that Judge

²⁸ Petitioners' expert statement incorrectly focused only on "**wireless networks and devices**" and excluded knowledge and expertise of Web sites, Web pages, Web servers etc., from the skills and knowledge a POSA would indisputably have. That omission necessarily eliminated any credibility whatsoever as to Petitioners' frivolous allegation that the '850 and '733 specifications lack written description for sending menus to "Web pages." *See Larson Decl.*, p. 3 ("In my opinion, a person of ordinary skill in the art to which the patents pertain would have a Bachelor's degree in either electrical engineering or computer science and two years of experience developing software for wireless networks and devices.") (Pet. Exh. 1042). Excluding "**Web page**" experience from the knowledge of a POSA, when every '850 claim, and '733 claims 1-3 include "**Web page**" as a claim term, is indisputably incorrect. Ameranth proposes that "and two years of experience in Web servers, Web pages and HTML/XML" would have to be added to the end of Mr. Larson's definition of POSA to comprise a correct level of skill in the particular field of the '850 and '733 patents. Further, experts are required to actually conduct an investigation into the record evidence, and the total failure to consider any of the prior Markman rulings renders the entire expert opinion fatally flawed. Consequently, all of the expert's opinions should be ignored.

Everingham in the Eastern District of Texas construed “Web page” to mean “a document, with associated files for graphics, scripts, and other resources, accessible over the internet and viewable in a web browser” and Judge Payne in the Eastern District of Texas, in a separate case involving the ‘850 and ‘325 patents, construed “Web page” precisely the same way. (Exhs. 2014, 2017). Both Judges Everingham and Payne rejected the Petitioners’ construction and relied on the definition of Web page provided by the World Wide Web Consortium in 1999, which is as authoritative on Web definitions as is possible. (Web Characterization Terminology & Definitions at §2.3, May 24, 1999, <http://www.w3.org/1999/05/WCA-terms> (Exh. 2030)).

Petitioners’ proposal is doubly vexing considering that Mr. Zembek, lead counsel for Petitioners, was the same attorney who lost the very same argument before Judge Everingham. Patent Owner does not assert that Mr. Zembek is estopped from now proposing a construction at odds with the prior judicial constructions, but Patent Owner does submit that not providing the Board with the prior constructions is wrong and deceptive, to put it mildly. Even worse, Petitioners apparently withheld all of these prior Markman constructions even from *their own expert*, who failed to acknowledge or even opine on them. His “review” effort was limited to the following as is shown on page 3: “I have been asked to review the ‘850, ‘325, and ‘733 Patents and their prosecution histories.” Tellingly, there is no list of any other evidence that was considered by Petitioners’ expert in forming his opinions, further showing lack of any credibility of this purported expert opinion. There is yet another critical “omission” from the expert’s review, beyond ignoring all of the relevant judicial rulings. It was no accident that the Petitioner’s “excluded” a review of the ‘077 patent and its extensive prosecution history from their expert’s opinion. Petitioners did not

want their expert to have to admit knowing of all of the non-obviousness evidence and proper knowledge that a POSA would have had (as is extensively explained in the numerous 1.131 and 1.132 declarations contained in the `077 prosecution history). Further, the prosecution history of the `077 patent includes extensive references to the *Menusoft* case and to the prior Judge Everingham Markman rulings. Thus, without **excluding** the `077 prosecution history from their expert's consideration, he would have been compelled to review and consider those Markman rulings, which eviscerate Petitioners' presently-proposed constructions and invalidity/ineligibility arguments. While Ameranth understands that each of the four CBM petitions filed against Ameranth's patents must be evaluated individually, Patent Owner asks the Board to take special note of the complete **omission** of the `077 evidence from the Larson Declaration and the omission of the Larson Declaration from the `077 Petition (CBM2014-00014). **Why?** Once again, the Petitioners excluded the prior judicial rulings from their expert so that he could support their fatally flawed arguments, which were already specifically **rejected** in numerous judicial rulings. This kind of selective parsing of the full evidentiary record to maintain Petitioners' expert's "lack of knowledge" renders the Larson Declaration and the entire Petition based thereon irreparably defective. PTAB proceedings are not a "hide the ball" game, hoping that the PTAB does not know or will not discover the truth. Larson had the right to offer different claim construction proposals, yet the very premise of even being an "expert" is to have considered **all** of the relevant evidence, not to be willfully blind to "inconvenient truths" in order to be able to render an opinion to suit a client's fancy. *See Kilopass Tech v. Sidense Corp.*, No. 2013-1193 at 15 (Fed. Cir. Dec. 26, 2013) ("The 'should know' rubric obviously applies when a party attempts to escape the

consequences of its conduct with the bare statement, ‘I didn’t know.’”), *citing Eltech Sys. Corp. v. PPG Indus., Inc.*, 903 F.2d 805, 810 (Fed. Cir. 1990) (Exh. 2033).

After clearly having sought construction of the synchronization elements of the ‘733 claims for the **functional terms** that they truly are (in the *Menusoft* case) and which Judge Everingham confirmed them to be, Mr. Zembek, on behalf of Petitioners, now contradictorily asserts that the synchronization aspects of the claims are actually “**method steps**.” This flip-flop is not an issue involving the “broadest reasonable construction” rubric but rather is an attempt to mislead and confuse the Board. Petitioners now assert that “wherein applications and data are synchronized” is a method step having a plain and ordinary meaning, yet Petitioners do not say **what** that meaning is to the minds of Petitioners or through the lens of a proper POSA. Petitioners really are not concerned with providing a construction for “synchronized,” of course, they are instead merely trying to argue that the use of “synchronized” makes the claim hybrid. This assertion is striking considering that Judge Payne had absolutely no difficulty in construing “synchronized” in the ‘850 and ‘325 claims to simply mean “made to be the same” in 2012 and he further observed that “both the specification and the ordinary meaning [] suggest that the meaning of synchronization is to ensure that data on the devices is made to be the same.” (Exh. 2017). This is also entirely consistent with Judge Everingham's 2010 Markman constructions. Moreover in 2013, yet a **third** judge, Judge Sammartino in the Southern District of California, specifically rejected Petitioners’/Defendants’ “mixed claim” argument with respect to the “synchronized” element of ‘850 claims 12-16 and ‘325 claims 11-15 by holding:

[T]he Court is unpersuaded that the term “synchronized” requires any user action, but merely describes the ability of the system to synchronize applications and data between the various devices. . . . Accordingly,

because the claims do not impermissibly create hybrid method and apparatus claims, Defendants' motion is DENIED on this basis.

(Exh. 2018). Thus all other adjudicative bodies have summarily rejected Petitioners' "method step" constructions and/or "mixed" claims arguments. The fact that Petitioners would make the same argument before the Board and not tell the Board about the prior holdings is flabbergasting and disrespectful of the PTAB. The Board should closely examine this and every other argument in the Petition.

Likewise, the recitation of "wherein said [second / modified] menu is manually modified [. . .] after generation" is not a method step as Petitioners assert, it is merely a description of the ability of the system to enable manual modification of the generated second menu, just as "synchronized" was construed by Judge Sammartino to provide functionality of the system, not a method step. Patent Owner does agree that this claim element should have its plain and ordinary meaning, which is the words of the claim itself in the context of the claim as a whole, as recognized by Judge Everingham, who construed "manually modified" to mean:

[T]he court rejects the defendants' proposed construction "to change by the hands of the user." (See also '733 patent, claim 4 ("said second menu is manually modified by handwriting or voice recording after generation")). Although the specification discusses handwriting and voice recording, there is no indication that "manually modified" must be limited to the preferred embodiments. Therefore, ***"manually modified" is construed to mean "effecting a change as a result of a user's input or request."***

(Exh. 2014 at 26) (emphasis added). Judge Everingham thus construed the terminology as a functional limitation provided by the claimed software, which functionality was effected as a result of a user action, but did not include the user action itself as urged by the defendants (represented by Mr. Zembek). Moreover, the

claim element in which this terminology appears specifically recites “**application software**” for performing the recited functionality. “Application software” functionality is not a method step. Petitioners’ argument is facially ridiculous and appears to assume the Board will not even read the claim language.²⁹

Petitioners’ proposed “central processing unit” construction fails to take account of the actual usage of this terminology in the specification. Specifically, Judge Everingham recognized in his claim construction that claims 1-3 of the ‘733 patent are directed to a “a computerized system having multiple devices in which a change to data made *on a central server* is updated on client devices and vice versa.” (emphasis added) (Exh. 2014 at 8). This construction reflects the centralized nature of the control over the recited menu generation and transmission functionality via the central processing unit as recited in claims 1-4, and also as regards other claims which include a recitation of “master menu” (claim 5). The recited central processing unit is not a generic CPU, it is a particular processing unit which, in combination with specialized application software and other components, provides synchronized menus across different devices in the system. This claim element thus cannot be construed as a broadly generic CPU; to do so would conflict with usage in the specification and the structure of claim 1 as a whole, and would thus impermissibly deviate from the broadest *reasonable* interpretation standard which the Board must apply.

Petitioners’ proposed “operating system” construction fails to comport with the specification usage of the terminology used in the claims. For example, the ‘850 specification describes and incorporates “GUI operating systems” which enable “a

²⁹ Still further, Petitioners’ own expert did not opine that a POSA would have understood any of the ‘733 system claim elements as reciting method steps.

particular application program [to] present[] information to a user through a window of a GUI” (‘850 patent, col. 5:6-16). The specification further states: “The window environment is generally part of the operating system software that includes a collection of utility programs for controlling the operation of the computer system. The computer system, in turn, interacts with application programs to provide higher level functionality, including a direct interface with the user.” (*Id.* at col. 5:64-6:2). Patent Owner thus submits that the broadest reasonable interpretation supported by the specification is “software that controls the operation of a computer system including the system’s interactions with application software programs, including the provision of a user interface.”

Based on the foregoing, adopting Petitioners’ proffered construction of the terms for which Petitioners actually proposed constructions would ignore the patent description in favor of generic constructions which do not address the specification and claim usage of the subject terminology. As regards the terms for which Petitioners provided no proposed constructions, as well as other terms of the claims which must be construed in order to make coherent determinations based on the claims as a whole (as the Board is required to do), Patent Owner urges the Board to adopt the proposals provided by Patent Owner as they are consistent with the specification and plain meaning of the subject terminology and are consistent with the existing constructions from multiple, independent, federal judges. Specifically, Patent Owner urges the Board to adopt the constructions provided above, and to adopt the constructions given to other claim terms which were ordered by the four prior judicial claim constructions (Exhs. 2014-2017) and Judge Sammartino’s rejection of Petitioners’ “mixed” claims argument (Exh. 2018) involving the same terminology in

the ‘850 and ‘325 patents, and which Petitioners have not challenged.³⁰

V. THE PETITION DID NOT ESTABLISH THAT ANY CLAIM IS MORE LIKELY THAN NOT INVALID

A. Petitioners Have Not Established That The Claims Of The ‘733 Patent Are Invalid On The Asserted Ground Based On 35 U.S.C. §112

1. The Claims Do Not Mix Apparatus And Method Elements

Petitioners have made their “hybrid claim” argument before, in the District Court (Southern District of California), and it has been summarily rejected by that Court as regards the challenge to the “synchronized” limitation (as recited in ‘850 claims 12-16 and ‘325 claims 11-15). The claim elements which Petitioners challenge clearly are proper functional limitations.

Proof of indefiniteness requires demonstrating that the claim “is insolubly ambiguous, and no narrowing construction can properly be adopted.” *Microprocessor Enhancement Corp. v. Texas Instr. Inc.*, 520 F.3d 1367, 1374 (Fed. Cir. 2008) (district court erred in finding indefiniteness). Petitioners cannot meet this burden, or even a lessened burden, because the ‘733 system claims do not require any user actions as was the situation in all of Petitioners’ cited cases.

Petitioners allege that the recitation of “manually modified” functionality in the ‘733 system claims is a method step (Am. Petition at 32-33). It clearly is not. What is recited in the asserted claims is the function or capability of the software-enabled

³⁰ Note that only claims of the ‘733 patent reciting “menu” subject matter with wireless handheld computing device limitations were asserted and construed in the *Menusoft* case (e.g., ‘733 claims 1-3), only claims involving cross-system synchronization of “hospitality applications” were involved in the *Par* case (e.g., ‘850 claims 12-16 and ‘325 claims 11-15), whereas the *Pizza Hut* case deals with all types of claims in all of Ameranth’s asserted patents. Menusoft and Par are now licensees.

system, it is not a step and it is not a user's input. Petitioners' cropping of "application software" from the elements in which the "manually modified" recitations appear is egregious. The actual claim language, e.g., in claim 1, reads:

g. **application software** for generating a second menu from said first menu and transmitting said second menu to a wireless handheld computing device or Web page, wherein **the application software** facilitates the generation of the second menu . . . wherein said second menu is manually modified after generation.

'733 claim 1 (emphasis added). Nowhere in this claim language is there any mention of a user's action³¹—which was clearly present in the cases Petitioners rely on (*IPXL* and *In re Katz*). Moreover, the claimed functionality is explicitly stated to be provided by the application software, among other functions provided by the software. Moreover, the "manually modified" limitation of claim 1 of the '733 patent was construed by Judge Everingham in the Eastern District of Texas as requiring only the capability of "effecting a change *as a result of a user's input or request.*" See Exh. 2014 at 26 (emphasis added). Judge Everingham thus construed the terminology as a functional limitation provided by the claimed software, which functionality was effected *as a result of* a user action, but the construction did not include the user action itself as urged by the defendants (represented by Mr. Zembek), and rejected by the court.³² Such claim language is clearly not indefinite under *IPXL* as discussed

³¹ On page 53 of the Amended Petition, Petitioners attempt to deceive the Board by citing to material from the specification involving statements of user actions (e.g., Petitioners quote "[t]he information entered by the user is transmitted to the server."). Those actions **do not appear in the claims** and are thus irrelevant.

³² Petitioners' reference to the recitation of "manually modified" in method claim 12 is inapposite. Claim 12 is a method claim, not a system claim reciting application software functionality as is the case for all '733 system claims. Likewise, Petitioners'

below. The public (*e.g.*, Ameranth’s 26 licensees) clearly understands that infringement occurs when a system including the recited functionality/capability is made, used, sold or offered for sale.

Petitioners’ citations to the *Katz* and *IPXL* cases are mischaracterizations of those cases. *IPXL* dealt with a claim which recited “the *user uses*” and *Katz* dealt with a claim which recited “said individual *callers* digitally *enter* data.” In both, a user’s action was recited, which is clearly not the case here. *Rembrandt Data Techs., LP v. AOL, LLC*, 641 F.3d 1331 (Fed. Cir. 2011), is similarly inapposite. *Rembrandt* involved a claim which recited a “step of transmitting” as stated by Petitioners. However, “manually modified” as recited in the claims is not “transmitting.” It is a recitation of functional capability of the application software, whereas “transmitting” as used in the *Rembrandt* claims is not a statement of capability, it is the recitation of an action.³³ Clearly, “manually modified” is a recitation of a capability of the system, not a user action, as was abundantly clear to Judge Everingham.

IPXL and *Katz* did not hold that claims are indefinite as “hybrid” where the pertinent claim language involves recitation of capabilities of the system via functional language, as has been pointed out by numerous district courts:

[T]he claims in [*IPXL* and *Katz*] suffered from a true ambiguity as to

assertion that “computer systems cannot write” (Am. Petition at 35) is a red herring. The recited functionality is not to “handwriting,” it is to the capability of the computer system to recognize and interpret, *e.g.*, handwriting as exemplified, *inter alia*, by dependent claim 6, which recites “wherein the manual modification involves handwriting capture.” A clear functional recitation cannot be casually rendered indefinite based on the pointless contrivances of an accused infringer.

³³ When recited as a step as in *Rembrandt*, “transmitting” violates *IPXL*. However, “transmitting” when recited as functionality of software is not violative of *IPXL*.

whether the claims require a product or performing a method. In particular, those cases involved apparatus claims incorporating steps where a user acts *upon the system*. Here, the claims involve capabilities *of the system*, as limitations on the "event manager" and "subsystem" structural elements. The functional language merely describes the functional capability of the claimed structures. . . . [T]he language present in the claims is functional despite the lack of "configured to" or similar wording . . . "detect[ing]," "infer[ring]," and "initiat[ing]" serve to recite the system's capabilities.

SFA v. 1-800-Flowers.com, Case No. 6:09-cv-340-LED (E.D. Tex. April 11, 2013) (Exh. 2031 at page 32-33) (emphasis in original).

[T]he Federal Circuit . . . concluded that . . . **where the claims require capability, not actual use, or describe functional limitations, such claims are not invalid based on the IPXL rule.**

Claim 18 claims an apparatus that has the capability **of** performing certain steps if activated by the user. Whether the user actually performs the functions is "of no import" . . . the *IPXL* rule does not apply. Similarly, claim 27 describes: "A portable electronic device, comprising ... computer readable memory comprising instructions that, when executed by the one or more processors, perform operations comprising: receiving a plurality of user inputs ... and displaying a current character string as input by the user, ... [and] in response to the further user input, replacing the current character string...." [T]he patentable subject matter is the apparatus, which has the *capability* of performing certain steps when certain user inputs are received.

Apple, Inc. v. Samsung Elec. Co., 877 F.Supp.2d 838, 895-96 (N.D. Cal. 2012) (emphasis added, citations omitted).

[C]laims containing both a physical description of an apparatus and a description of the apparatus' function, e.g., "communicates," "populates," "configured to," and "upon activation," were not impermissible apparatus-method claims. Instead, these "claims simply use active language to describe the capability of the apparatuses; they do

not claim the activity itself.”³⁴

In *Biosig Inst. v. Nautilus, Inc.*, 715 F.3d 891, 904 (Fed. Cir. 2013), the Federal Circuit rejected a mixed claims argument, holding that *IPXL* was inapplicable, because the challenged claims were apparatus claims with functional limitations. *Id.* Likewise, the ‘733 claims are clearly system claims with functional limitations. As was also the situation in *Apple* and *Ricoh*, and numerous other cases cited therein and in the footnote below, the subject claims in the present case clearly contain a physical description of the claimed system as well as a description of the functionality of the system. For example, claim 1 of the ‘733 patent recites a central processing unit, data storage device, operating system and application software for generating and transmitting a second menu to a wireless handheld computing device or Web page. Petitioners fail to acknowledge the readily obvious software functionality/capability of the explicitly-recited system components, including the application software, and thus fail to make out any credible argument under *IPXL*. The shallowness of Petitioners’ argument is exemplified by their assertion that the Federal Circuit in the *Katz* case “summarily rejected a ‘functional limitation’ argument.” (Am. Petition at 34). This argument is nothing less than a blatant attempt to mislead the Board. In *Katz*, the Federal Circuit indeed rejected the patentee’s argument that the faulty claim language was a functional limitation—but that was only because the language in *Katz*

³⁴ *Ricoh Co., Ltd. v. Katun Corp.*, 486 F. Supp. 2d 395, 402-03 (D.N.J. 2007) (citations omitted); *accord WesternGeco L.L.C. v. ION Corp.*, 876 F.Supp. 2d 857, 874 (S.D. Tex. 2012) (“a functional limitation [is] an attempt to define something by what it does rather than by what it is”); *Kara Tech. Inc. v. Stamps.com Inc.*, 2008 WL 8089236 * 21 (C.D. Cal. April 3, 2008) (“[T]he claim includes a limit to the function of the invention . . . active language to describe the capability of the apparatus.”).

was not a functional limitation, unlike the language of the '733 claims. The *Katz* decision did not hold that functional limitations are method steps as Petitioners assert they are. In fact, Petitioners quoted the salient language from *IPXL* and *Katz* which shows that the challenged language in those cases was indeed directed to user actions, not functional limitations. (Am. Petition at 34-35 (“wherein . . . the user uses,” “wherein . . . callers digitally enter data” and “wherein . . . callers provide . . . data”)). And Petitioners highlighted in bold italicized type that the *Katz* decision referred to the claim elements challenged in those cases as “***directed to user actions, not system capabilities***.” *Id.* Conversely, the subject claim language of the '733 patent is clearly directed to system capabilities as explained above.

Still further, dependent claims of the '733 patent contain terminology which demonstrate that the “manually modified” terminology is a recitation of system software functionality. *See, e.g.*, claims 2 and 10 (“the modified second menu can be selectively printed on any printer directly from the graphical user interface of a hand-held device” or “other computing device”), 3 and 11 (“the modified second menu can be linked to a specific customer at a specific table directly from the graphical user interface of a hand-held device” or “other computing device”), 6 and 8 (“the manual modification involves handwriting capture” or “voice capture”). Clearly, the manually modified menu is produced by software functionality ***in response to*** an input as shown by claims 6 and 8, and the manually modified menu generated by the software functionality is available for further functions as shown by claims 2, 3, 10 and 11. Moreover, claims 2, 3, 10 and 11 use “can be” terminology to further define the manual modification functionality recited in the independent claims. This is clearly a recitation of functional capability, not a user action. Thus,

these dependent claim recitations themselves, when combined with the elements of their base claims, are not hybrid, and the recitations of the dependent claims further demonstrate that the independent claims themselves are not hybrid.

It is also noteworthy that all four of Ameranth's patents in the '850/'733 patent family have been exhaustively reviewed over more than a decade by a cadre of different and varied USPTO patent examiners, including numerous supervisory patent examiners, resulting in 4 separately issued patents containing a total of 65 claims. Three of these patents have also been reviewed by two different courts in the Eastern District of Texas in the context of claim construction, and never has any issued claim been found to be indefinite in any way, including any alleged "hybrid claim" basis for indefiniteness. Petitioners' "hybrid" arguments are frivolous.

2. Petitioners' Other Section 112 Arguments Fail

As a threshold matter, Petitioners ignored a highly relevant factor which must be considered by the Board, *i.e.*, that the '733 claims are all "**original claims.**" MPEP 2163.03(I). Original claims constitute their own description. *In re Koller*, 613 F.2d 819 (CCPA 1980). Although original claims do not *ipso facto* satisfy the written description requirement, they are entitled to a "strong presumption" of compliance with §112. *See* MPEP §§ 2163 (I)(A), (II)(A). The '733 claims are all "**original claims,**" and thus any conclusion of a lack of written description must be supported by clear evidence which overcomes the strong presumption. *Id.* But, as detailed above, Petitioners depend on their expert's deceptively incomplete definition of the level of skill of a POSA, which makes all of their written description arguments fatally defective.³⁵

³⁵ The test for definiteness under §112, second paragraph, is whether "those skilled in

Petitioners' assertion that the '733 patent does not satisfy the written description requirement is particularly troubling in view of Petitioners' failure to disclose prior judicial rulings directly contradicting their arguments. This omission is not a result of differing claim construction standards between the USPTO and the district courts. Rather, while purporting to adopt the "broadest reasonable interpretation," Petitioners implicitly insert their own previously rejected claim constructions (in the *Menusoft*, *Par* and *Pizza Hut* lawsuits).

For example, Petitioners' indefiniteness/written description argument is based on their proposed construction of "transmitting to a Web page" (which is recited only in claims 1-3), which has no support other than raw attorney argument and Petitioners' thin, insubstantial, and wholly conclusory "expert" declaration. *See* Am. Petition at 46-49, and Exhs. 1037 and 1042 thereto. Yet Petitioners withhold the fact that Judge Everingham of the Eastern District of Texas *rejected* their proposed construction for that term (Exh. 2016), and found the claim sufficiently understandable. In fact, there was never any contention or question otherwise, even by the very same lead attorney who now feigns incomprehension. Judges Everingham and Payne similarly *rejected* Petitioners' current proposal for "Web page," and adopted Ameranth's construction. Exhs. 2016, 2017 at 9. These withheld judicial claim constructions completely undermine the core invalidity arguments made in the

the art would understand what is claimed when the claim is read in light of the specification." *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 806 F.2d 1565, 1576 (Fed. Cir. 1986). When determining whether a specification contains adequate written description, one must make an "objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art." *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

Petition. The withholdings were not due to a lack of awareness; lead counsel for defendants in the *Menusoft* case in which Petitioners' constructions were previously rejected are the same Fulbright & Jaworski attorneys serving as lead counsel for Petitioners in this matter. Petitioners are thus well aware of the courts' constructions of the claims of this patent, but Petitioners intentionally chose to not disclose same to the PTAB.³⁶

The Petitioners' newly contrived "single species" argument is actually a deceptive repackaging of a claim construction position previously *rejected* in the Eastern District of Texas. In the *Ameranth v. Menusoft* case, Menusoft's counsel (lead counsel for Petitioners here), argued for a construction that would have limited "synchronization" to a single embodiment, namely, when an entire database is stored locally on a wireless handheld device with exchanges between that database and a central database. The Eastern District of Texas *rejected* that position in the *Menusoft* case, finding "it is not necessary that the clients have local databases." Exh. 2014 at 7-8. In the *Ameranth v. Par* case, a second Eastern District of Texas judge *rejected* a

³⁶ "A claim is indefinite only when it is not amenable to construction or insolubly ambiguous." *Teva Pharms USA, Inc. v. Sandoz, Inc.*, 723 F.3d 1363, 1368 (Fed. Cir. 2013). "If the meaning of the claim is discernible, even though the task may be formidable and the conclusion may be one over which **reasonable persons will disagree**, we have held the claim sufficiently clear to avoid invalidity on indefiniteness grounds." *Exxon Research & Eng'g Co. v. United States*, 265 F.3d 1371, 1375 (Fed. Cir. 2001) (emphasis added). It cannot be argued that Judges Everingham and Payne would not be "reasonable persons who disagree," even if the Board were to construe the claims differently. Thus, on the record evidence, withheld by Petitioners, there can be no indefiniteness of claims which have been judicially construed (multiple times).

similar argument, construing synchronization to straightforwardly mean “made to be the same” as disclosed in the specification. Exh. 2017 at 17.

In their Petition, however, Petitioners present **the same twice-rejected** claim construction, now deceptively repackaged in the guise of an argument that their failed construction (synchronization between a local database on a handheld and master database) is the only “species” of synchronization supposedly disclosed in the patents, and that any other application of synchronization therefore fails the written description requirement. But Petitioners do not disclose to the PTAB that two district courts have already interpreted the patents and concluded that intrinsic support exists therein for a much broader interpretation of synchronization. Petitioners acknowledge that the PTAB uses the “broadest reasonable interpretation” standard; thus, the district courts’ broad interpretation of synchronization should be applied in the CBM process, entirely eviscerating Petitioners’ argument. Moreover, there is nothing in any of the claims requiring synchronization with a handheld device “database.” As recognized by the previous judicial claim constructions, the functionality is provided to transmit menu **data** to, *e.g.*, a handheld device or Web page (claims 1-3), but there is no local “database” required anywhere in the claims nor does the specification require a local database. In fact, the Petitioners self-servingly contrived term “**local database**” is not even used in the specification. This illuminates the lack of integrity behind the entire Petition. Petitioners’ argument cannot be relevant to §112 because it does not relate to the actual ‘733 claims.

Further refuting the “single species” argument based on an alleged lack of “Web page” teachings is the patent disclosure of the novel “**preview functionality**”

of the invention,³⁷ which was completely ignored by Petitioners:

[T]he preferred embodiment facilitates preview of the handheld device **or Web page version** of the POS menu on the desktop before downloading and configuration.

850 patent, col. 10:1-4 (emphasis added). The Petition also completely ignored Figure 7 and its explanatory text:

A PDA **or Web page format** could appear like FIG. 7 or the display could be configured for particular requirements since fully customizable menu generation and display are contemplated.

Id. col. 10:23 -26 (emphasis added).

Still further, the Petition ignored **all** dependent claims, incorrectly alleging that only the independent claims should be considered in a CBM petition. This is a fatal error because several of the dependent claims specifically expand on the independent claims and address and contradict the Petitioners' "single species" allegations, in addition to all the other arguments presented herein in defense of the patentability of the independent claims. For example, claim 2 includes "wherein the modified second menu can be selectively printed on any printer directly from the graphical user interface of a hand-held device," claim 3 recites "wherein the modified second menu can be linked to a specific customer at a specific table directly from the graphical user interface of a hand-held device," claims 6 and 13 include "wherein the manual

³⁷ Ameranth conceived, developed, tested and deployed its "wireless handheld emulator" in 1998 (*see, e.g.*, '733 col. 9:62-10:6) and filed a patent application on same in 1999. It was copied almost a decade later by Apple as the iPhone simulator (https://developer.apple.com/library/ios/documentation/IDEs/Conceptual/iOS_Simulator_Guide/iOS_Simulator_Guide.pdf (Exh. 2032)). This copied technology is now used worldwide by virtually all Apple application developers—yet Apple duplicitously alleges that Ameranth's inventions are mere "abstract ideas" of no importance.

modification involves handwriting capture,” claims 7 and 14 include the term “wherein the handwriting capture involves handwriting recognition and conversion to text,” claims 8 and 15 recite “wherein the manual modification involves voice capture,” claims 9 and 16 recite “wherein the voice capture involves voice recognition and conversion to text,” claim 10 recites “wherein the modified second menu can be selectively printed on any printer directly from the graphical user interface of said other computing device” and claim 11 recites “wherein the modified second menu can be linked to a specific customer at a specific table directly from the graphical user interface of said other computing device.” Each of these dependent claims further explain, in differing ways, the details of various additionally unique implementations of the claimed synchronization. All of Petitioners’ associated invalidity contentions fail at least against these dependent claims because those claims were not addressed at all. Petitioners’ contentions against the dependent claims are thus unsupported, and also contradicted by the record evidence. There is thus no basis for institution of a review of these claims.

Likewise, Petitioners argue that the claim terms for transmitting a menu to a Web page (found in claims 1-3) are indefinite, unsupported, and even nonsensical. Am. Petition at 47; Larson Decl. ¶19 (Pet. Exh. 1042). Yet the examiner of the ‘850 parent application specifically cited to this **very functionality** as core to his reasons for allowance, *i.e.*, “application software for generating a second menu from first menu and transmitting second menu to a wireless handheld computing device or Web page.” Statement of Reasons for Allowance, App. Ser. No. 09/400,413 (Pet. Exh. 1035 at 6-7). Further, Petitioners deceptively failed to disclose that Judge Everingham already *rejected* the very same argument in the *Menusoft*, and construed

“transmitting to a Web page” to mean “causing the transmitted information to be reflected on a web page,” and specifically found “support for this definition in the intrinsic record, where the patentee used the term ‘[is] reflected instantaneously on ... a web page’” to describe the transmission of information to a web page. ‘850 Patent, 4:21-23.’ (Exh. 2016).

In *Crown v. Ball Container*, the Federal Circuit rejected arguments that the claims at issue described a desired result, that the specification narrowly limited the scope of the invention and that the claims were outside that scope:

The test for sufficiency of a written description is "whether the disclosure clearly 'allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.'" The disclosure must "reasonably convey[] to those skilled in the art that the inventor had possession of the claimed subject matter as of the filing date." Possession means "possession as shown in the disclosure" and "requires an objective inquiry into the four corners of the specification from the perspective of a person of ordinary skill in the art." Original claims are part of the specification and in many cases will satisfy the written description requirement.

Crown Pkg. Tech., Inc. v. Ball Container Corp., 635 F.3d 1373, 1380 (Fed. Cir. 2011) (citations omitted). Similarly, the Ameranth '850 and '733 patent specification supports the synchronization features of the patent claims (and not just the narrow species that is misconstrued by Petitioners). "Synchronization between a central database and multiple handheld devices, synchronization and communication between a Web server and multiple handheld devices ... [and keeping] multiple sites in synch with the central database" is described and set forth in the specification, *see* '850 patent, col. 10:63-11:48. As noted therein, "The discrete programming steps [to provide for this synchronization] are commonly known and thus programming details

are not necessary to a full description of the invention." Synchronization with web pages, as in the claimed system, via a Web server, is described at 12:21-44.

Moreover, Petitioners admitted that the "'733 patent also discloses use of web sites as part of the synchronization process.'" (Am. Petition at 41). Any POSA would know that a Web site is comprised of Web pages, which the Microsoft Computer Dictionary, relied on by Petitioners, clearly states. (Pet. Exh. 1042 at attachment p. 479 ("Web site: A group of related HTML documents and associated files, scripts and databases that is served up by an HTTP server on the World Wide Web.")). Further, the Petition admits that "[t]he patent discloses transmission of a menu to a wireless handheld computing device or a web server." (Am. Petition at 46). Even under Petitioners' own proposed construction of "Web server," *i.e.*, "server software that uses HTTP to serve up HTML documents and any associated files and scripts when requested by a client, such as a Web browser," Petitioners thus admit that a Web server receives a menu and transmits Web pages.³⁸ Clearly, the claims are directed to making menus available to end user devices via Web pages (*see, e.g.*, '850 patent col. 5:51-54 ("The server hardware is configured by software . . . including Web server software")), as confirmed by Petitioners' own admissions. Petitioners' lead counsel, Mr. Zembek, also admitted that the '850 and '733 patents include:

³⁸ Still further, Judge Everingham construed element "g" of claim 1 of the '733 patent as directed to, *inter alia*, "application software, which is capable of transmitting to both wireless handheld computing devices **and Web pages**" (Exh. 2014 at 11) (emphasis added). This construction clearly includes, *inter alia*, Web server and communications control software functionality within the scope of the recited "application software" and a true POSA would know this. A true POSA would certainly understand how the menus are transmitted to Web pages in light of the patent description and would also be aware of what Petitioners admitted.

[A] description of the traditional client/server architecture including “client computers” on the client end and “Web server computers” on the server end. The Patents-in-Suit explain that the “software running on the user’s computer that enables the user to view the HTML documents” is called a “browser.”

Pet. Exh. 1037 at 2. Clearly, a true POSA would know that a client/server browser based system does not have a database on a handheld mobile device. The Petition also incorrectly stated that “[T]he only disclosure of implementation of the synchronization function is that “the menu generation approach of the present invention uses Windows CE” (Am. Petition at 41). That is clearly wrong; the specification states, *e.g.*, that “[a] single point of entry works to keep all wireless handheld devices **and linked web sites** [which clearly contain Web pages] in synch with the backoffice server applications” (‘850 patent col. 4:14-16 (emphasis added)), which is not a Windows CE implementation *per se*.

The transmission of a menu to a Web page or handheld device is described at ‘850 patent col. 4:5-23 and 8:60-10:26, in addition to the sections cited above, and also satisfies the written description requirement, as confirmed by Judge Everingham in the *Menusoft* case: "The Court finds support for this definition in the intrinsic record, where the patentee used the term “[is] reflected instantaneously on ... a web page” to describe the transmission of information to a web page. ‘850 Patent, 4:21-23." (Exh. 2016) (emphasis added). Petitioners’ flawed argument is based on an improper construction for “Web page.” The proper construction is that provided by the World Wide Web Consortium in 1999 as discussed above and adopted by both Judges Everingham and Payne, while rejecting the Petitioners’ proposed construction.

Moreover, Petitioners’ unsupported arguments are legally insufficient to

support a Section 112 argument based on inadequate written description:

In arguing that a species does not constitute[] a description of the genus of which it is part, there must be some analysis that either: (1) considers factors such as the knowledge of one skilled in the art and the level of predictability in the field, or (2) demonstrates that the specification reflects that the invention is, in fact, no broader than what is disclosed in the specification.

Alstom Power Inc. v. Hazelmere Res. Ltd., Reexam. No. 95/001,368, at 14-15 (Dec, 17, 2013) (citing *Bilstad v. Wakalopulos*, 386 F.3d 1116, 1124 (Fed. Cir. 2004) and *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998)). Petitioners provided no credible analysis under either prong of the Federal Circuit’s requirement for making out a case of inadequate written description based on a “species” argument. Petitioners provided only unsupported attorney argument, which falls far short of what is required to make out a plausible case of inadequate written description, and provided a fatally flawed and deceptively parsed/constrained “expert” report which did not include Web/internet expertise within the knowledge base of a person of ordinary skill in the art. Clearly, lack of knowledge regarding the Web/internet automatically removes the specification’s description of Web/internet transmission/synchronization from the knowledge base on which a true POSA would understand the claims. Petitioners’ arguments are thus conclusory and unsupported. As was pointed out by the PTAB Board in *Alstom*, “lack of written description must be demonstrated by more than pointing out the difference in scope.” *Id.* at 14. In the present case, there is no difference in scope—the claim scope is fully described in the specification as detailed above. But even without such full description, Petitioners’ unsupported allegations are fatally deficient for the aforesaid reasons.

The '733 disclosure thus "clearly 'allow[s] persons of ordinary skill in the art to recognize that [the inventor] invented what is claimed.'" *Ariad*, 598 F.3d at 1351.

B. Petitioners Have Not Established That The Claims Of The '733 Patent Are Invalid on the Asserted Ground Based on 35 U.S.C. §101

The test for patent eligibility under 35 U.S.C. §101 is not amenable to bright-line categorical rules. *See Bilski v. Kappos*, 130 S. Ct. 3218, 3229-30 (2010). Further, the Federal Circuit has recognized that it has been especially difficult to apply §101 properly in the context of computer-implemented inventions. *CLS Bank Intl v. Alice Corp. Pty. Ltd.*, 717 F.3d 1269, 1277 (Fed. Cir. 2013) (*en banc*). Because Petitioners' claim constructions (based on their incorrect "method steps" construction) are themselves innately wrong, the entire premise of their §101 allegations also fail.

"[W]hether the ... patent is invalid for failure to claim statutory subject matter under §101[] is a matter of both *claim construction* and statutory construction." *State St. Bank & Trust Co. v. Signature Fin. Group*, 149 F.3d 1368, 1370 (Fed. Cir. 1998).

Patent Owner submits that the Board will conclude, after properly construing and considering the actual claimed subject matter as a whole and considering the totality of the specification/drawings, that the Petition did not address the actual claimed subject matter of the '733 patent and that said subject matter is clearly patent eligible.

Section 101 lists new and useful processes, machines, manufactures, and compositions of matter as broad categories of patent-eligible subject matter. "In choosing such expansive terms ... modified by the comprehensive 'any,' Congress plainly contemplated that the patent laws would be given wide scope." *Bilski*, 130 S. Ct. at 3225 (quoting *Diamond v. Chakrabarty*, 447 U.S. 303, 308 (1980)). Courts have fashioned three limited exceptions to the aforementioned §101 categories,

prohibiting patents directed to: laws of nature, physical phenomena and abstract ideas. *See Mayo Coll. Svcs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289, 1293 (2012).

An abstract idea by itself is not patentable, but patent protection is available for a practical application of an abstract idea. *Id.* at 1293-94; *Bilski*, 130 S. Ct. at 3230. To be patent-eligible, a claim cannot simply state the abstract idea and add the words "apply it." *See Mayo*, 132 S. Ct. at 1294. If the claim incorporates meaningful limitations, it is directed to more than just an abstract idea. *See Id.* at 1297.

1. The Petition Grossly Mischaracterized The Actual Claimed Subject Matter

Petitioners allege that the invention recited in the claims of the '733 patent is directed to the purely abstract idea of computerizing menus. They further argue that the claimed system is simply a replacement for pen and paper. Petitioners' §101 argument is based on their incorrect allegation that "menus are generated faster than with the non-computerized process" (Am. Petition at 9, 56) is what the '733 inventions as recited in claims 1-16 is about. However, there is nothing in these claims about being "fast" and Petitioners ignore the numerous specific software and functional combinatory limitations in these claims. Petitioners are trying to convince the PTAB that nothing other than adding mere computerization is involved. They are completely wrong as shown herein.

Petitioners also allege that the '733 claims are directed to nothing more than placing an order. (Am. Petition at 64-66). However, there is no recitation of "order" in any of the '733 claims. Moreover, merely using the inventive combination of hardware and software elements in an "ordering" environment does not make the claims merely directed to the abstract idea of entering

“orders.” Patent Owner is confident that the Board is not a receptive audience for Petitioners’ misleading, simplistic and incorrect characterizations. Petitioners’ arguments can be quickly dismissed on even the most cursory examination of the actual claim language. As it has done in prior cases, Patent Owner submits that the Board should entirely reject Petitioners’ mischaracterization of the claimed subject matter.³⁹

The claims of the ‘733 patent recite an information management and synchronous communications system or method for synchronization of computerized menus between a central/master menu/database and a wireless handheld computing device or Web page (claims 1-3) or other computing device (claims 4-16), and all claims require “manual modification” functionality vis-à-vis the generated second menu. As previously noted, the claimed menu generation and transmission functionality was not known at the time of the '733 patent invention, as recognized by the Examiner in his Reasons for Allowance in the parent application (issued as the ‘850 patent), and Petitioners have not even attempted to present any credible evidence that it was; nor have Petitioners even attempted to point to any evidence that the manual modification functionality was known in the prior art in the context of the claimed system/method as a whole. The features and components claimed by the '733 patent thus comprise meaningful limitations and are much more than mere abstract ideas. The functions performed using these features and components are not insignificant pre- or post-solution activity; they are, in combination, the inventive solution itself. Moreover, Ameranth’s, and Petitioners’, products embodying the

³⁹ See, e.g., CBM2013-00027, Inst. Dec. at 37 (discussed above) (rejecting proposed Section 101 ground where Petitioner mischaracterized the claims).

inventions described and claimed in the '733 patent have enjoyed significant commercial success and industry recognition, validating the novel and innovative nature of Ameranth's patented technology. "[I]nventions with specific applications or improvements to technologies in the marketplace are not likely to be so abstract that they override the statutory language and framework of the Patent Act." *Research Corp. Tech., Inc. v. Microsoft Corp.*, 627 F.3d 859, 869 (Fed. Cir. 2010).

Petitioners further argue that the specific components recited in the claims of the '733 patent add nothing because each was known individually in the prior art. That is simply untrue. Moreover, the argument is antithetical to the law:

In determining the eligibility of [a] claimed process for patent protection under §101, ... claims must be considered as a whole. It is inappropriate to dissect the claims into old and new elements and then to ignore the presence of the old elements in the analysis.

Diamond v. Diehr, 450 U.S. 175, 188 (1981); *see also Bilski*, 130 S. Ct. at 3230.

While it may be true that certain components of the present invention were known at the time of the filing of the parent application leading to the '850 and '733 patents, that is true for almost all inventions—it is those components in combination (with the specific new and inventive software and synchronization functionality which provides the claimed interaction of these components) which must be analyzed.

Petitioners' analysis, however, does not account sufficiently for any of the claims as a whole (*i.e.*, the particular combination of components and how the claims require that they be used in the claimed specialty software-enabled system). Petitioners rest their §101 argument on the claimed system's use of allegedly "typical" computer elements and the alleged failure "to disclose any algorithms for the synchronous communications of menus." (Am. Petition at 8,

54). However, as previously noted, the claims of the '733 patent recite a system/method comprising a specific combination of components and features that interact in a specific way as dictated by the recited software functionality to, *inter alia*, generate and transmit menus on and to various components of the claimed system, and which functionality is described throughout the specification. Moreover, there is no requirement that claimed software functionality must be disclosed in a particular algorithm, and Petitioners cited no authority for such proposition.⁴⁰ Also, Petitioners' allegations that the claims do not disclose "how" the computer is programmed or how specified functions are performed is a red herring. "The purpose of claims is not to explain the technology or how it works, but to state the legal boundaries of the patent grant." *S3 Inc. v. nVIDIA Corp.*, 259 F.3d 1364 (Fed. Cir. 2001). "How" claimed functions are performed would, at most, be relevant to an enablement argument, which Petitioners did not make.

As recently concluded by the PTAB in CBM2013-00027, a recited "controller

⁴⁰ Petitioners confuse means-plus-function claiming with functional claiming. However, "[c]omputer-implemented inventions are often disclosed and claimed in terms of their functionality. This is because writing computer programming code for software to perform specific functions is normally within the skill of the art once those functions have been adequately disclosed." (MPEP 2161.01(I) (*citing Fonar Corp. v. General Elec. Co.*, 107 F.3d 1543, 1549 (Fed. Cir. 1997))). In any event, even if the '850 claims included means-plus-function elements, which they do not, there is no requirement to disclosure line by line code. *See Medical Inst. & Diag. Corp. v. Elekta AB*, 344 F.3d 1205, 1214 (Fed. Cir. 2003) ("there would be no need for a disclosure of the specific program code if software were linked to the . . . function and one skilled in the art would know the kind of program to use.").

computer” which included a “‘means for matching’” constitutes a special purpose computer that performs the recited function of ‘matching’ the conditional buy and sell orders using the ‘external multiple data sources.’” (*Id.*, Inst. Dec. at 38). Similarly, the recited synchronous system functionality of the ‘733 claims involves synchronizing multiple components. This functionality is that of a special purpose computer conceived by the inventors of the ‘733 patent, it was not available in anything that existed at the time of the invention.⁴¹ The recited systems/methods of the ‘733 patent are thus directed to a new and nonobvious combination of patentable-eligible software functionality and components, or a method for using such software functionality and components, that comprise a patentable improvement over the prior art and thereby impose meaningful limitations.

2. *The ‘733 Patent Claims Fall Squarely Within The Federal Circuit’s And Supreme Court’s Bounds Of Patent Eligible Subject Matter*

The Federal Circuit's recent decision in *Ultramercial v. Hulu* provides an independent reason that the Petition must be denied. In *Ultramercial*, the Federal Circuit affirmed the validity of a claim that is much closer to a business method claim than any issued claim of the ‘733 patent. *See, e.g.*, U.S. Pat. No. 7,346,545, Claim 1 (directed to “a method for distribution of products over the Internet,” and which was a representative claim considered in *Ultramercial*). The Federal Circuit held that it "does not need the record of a

⁴¹ For example, the “central processing unit” of claims 1 and 4 (discussed above) is not a generic CPU or generic database, it is specially purposed for providing the claimed synchronization functionality, and thus does not preempt all uses of CPUs/databases in computerizing menus.

formal claim construction to see that many of these steps require intricate and complex computer programming." *Ultramercial, LLC v. Hulu, LLC*, 722 F.3d 1335, 1350 (Fed. Cir. 2013). The Federal Circuit stated further "even without formal claim construction, ***it is clear that several steps plainly require that the method be performed through computers, on the internet, and in a cyber-market environment.*** One clear example is the third step, 'providing said media products for sale on an Internet website.'" *Id.* (emphasis added). Further, "programming creates a new machine, because a general purpose computer in effect becomes a special purpose computer once it is programmed to perform particular functions pursuant to instructions from program software." *Id.* at 1353 (citing *In re Alappat*).

The exact same is true for claims 1-11 of Ameranth's '733 patent, if not more so—even more clearly than the valid *Ultramercial* method claim, system claims 1-11 of the '733 patent recite computers and applications of computer technology via specialized computer software.⁴² Each of claims 1-11 of the '733 patent is directed to components arranged in a network, implemented in computing devices, and requiring intricate and complex computer programming that enables the interconnected hardware/software elements to all work together as defined by the claims.⁴³ For example, claims 1-3 of the '733

⁴² The *Ultramercial* claim, which was held patentable, actually involves a financial transaction including receipt of payment. Thus, the *Ultramercial* claim may be more accurately characterized as being directed to "financial" subject matter as opposed to the system claims of the '733 patent, which recite no such financial subject matter.

⁴³ Method claims 12-16 are specifically directed to a method of using such components arranged in a network, implemented in computing devices, and requiring

patent recite a wireless handheld computing device and Web page which interacts with the rest of the system via specialized software functionality. The software limitations/requirements of the claims apply to the specifically recited wireless handheld device and Web page limitations as well as to the back office/central database/first menu software limitations/requirements.⁴⁴

Further, the Board’s decision in *SightSound*, applying *Ulramercial*, is dispositive. There, the petitioner argued that the claims recited the abstract idea of selling digital music. However, the Board, *sua sponte*, rejected the asserted 101 ground (*SightSound*, CBM2013-00019, Paper No. 17, at 16-21) because the claim “recites a specific combination of computer components, at specific locations, that interact in a specific way to accomplish the steps of the method.” *Id.* at 18. The Board concluded that “[t]he ‘first memory,’ ‘second memory,’ ‘transmitter,’ ‘receiver,’ and ‘telecommunications line’ components, and the specific functions performed using those components, represent meaningful limitations on the scope of the claim that take it beyond the

intricate and complex computer programming which enables the interconnected hardware elements to all work together as defined by the claims.

⁴⁴ Petitioners completely ignore that claims 1-3 of the ‘733 patent recites a “wireless handheld computing device,” which was construed by Judge Everingham as “a wireless computing device that is sized to be held in one’s hand.” (Exh. 2014). Thus, even if these claims were directed broadly to “computerizing menus,” which they are not, they would still not preempt uses of such broadly-construed claims on non-handheld computing devices, and thus would not preempt all computerized menus. The same is true for the “manually modified” functionality present in all claims; the actual claimed subject matter simply cannot preempt all computerized menus.

abstract concept of selling music.” *Id.* at 18-19. Likewise, the ‘733 claims require a specific combination of components to interact in a specific way to accomplish the synchronization of, *e.g.*, menus.

As was the case for the steps of the *Ultramercial* and *SightSound* claims, the limitations of the '733 system claims do not merely claim an abstract idea; nor are they directed to an unpatentable law of nature or mathematical formula. *Diehr*, 450 U.S. at 187. The claims of the ‘733 patent clearly satisfy both of the recognized independent bases for patent eligibility, *i.e.*, via the particularized software which all claims require, they are tied to particular machine(s) and they transform an article. Still further, while satisfaction of either prong of the machine or transformation test (the present claimed invention satisfies both) confers patent eligibility under Section 101, the machine or transformation prong is not the only means by which a court can conclude that claims are directed to patent eligible subject matter. *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010). Specifically, an “abstract idea” inquiry is required separate and apart from the machine or transformation test analysis. Under such inquiry, the claimed invention of the ‘733 patent cannot be performed by pen and paper or in a human’s head as discussed above.

Also consistent with finding these claims patent eligible is *SiRF Tech., Inc. v. ITC*, 601 F.3d 1319, 1332-1333 (Fed. Cir. 2010), in which the Federal Circuit held that claims involving GPS technology recited patentable subject matter because, "there is no evidence here that the calculations here can be performed entirely in the human mind. Here, as described, the use of a GPS receiver is essential to the operation of the claimed methods." As the Federal Circuit further

stated in *SiRF*: “It is clear that the methods at issue could not be performed without the use of a GPS receiver; indeed without a GPS receiver it would be impossible to generate pseudoranges or to determine the position of the *GPS receiver* whose position is the precise goal of the claims.” *Id.* at 1332. The '733 claims, similarly, are not directed to mere calculations that can be performed entirely in the human mind. As discussed throughout this Response, the '733 claims are directed to specialized functionality involving interaction between components (precisely analogous to the functionality provided by the GPS receiver in *SiRF*) which cannot be performed without specially programmed computer(s) and have absolutely nothing to do with anything that could possibly be performed by pen and paper or in the human mind (for example, application software functionality for generating a second menu from a first menu and transmitting the second menu to a wireless handheld computing device or Web page—a pen and paper or the human mind cannot generate a computerized menu and transmit it to a wireless handheld device or Web page). What’s more, the Petition made no assertion or argument that the actual claimed subject matter of the '733 patent could be performed in the human mind.

It should be further noted that the '733 patent's dependent claims contain additional elements that are also particularly tied to a machine or machines and/or transform an article, further emphasizing their patentability.⁴⁵ *See, e.g.*, claims 2 (“the modified second menu can be selectively printed on any printer directly from the graphical user interface of a hand-held device”), 3 (“the modified second menu can be linked to a specific customer at a specific table directly from the

⁴⁵ *Ultramercial*, 722 F.3d at 1340 (“the question of eligible subject matter must be determined on a claim-by-claim basis”).

graphical user interface of a hand-held device”), 6 and 13 (“the manual modification involves handwriting capture”), 7 and 14 (“the handwriting capture involves handwriting recognition and conversion to text”), 8 and 15 (“the manual modification involves voice capture”), 9 and 16 (“the voice capture involves voice recognition and conversion to text”), 10 (“the modified second menu can be selectively printed on any printer directly from the graphical user interface of said other computing device”) and 11 (“the modified second menu can be linked to a specific customer at a specific table directly from the graphical user interface of said other computing device”).

Petitioners were required to analyze **each claim** individually and consider all elements of each claim as a whole in conducting their analysis. Instituting a CBM review of the dependent claims would be improper because their unique inventive and patent eligible functionality was entirely **ignored** by the Petition and thus a challenge to those claims has been waived.

But the Federal Circuit's analysis in *Ultramercial* did not end with the terms of the claim. The Federal Circuit also looked at the figures in the specification: “[i]n addition, Figure 1, alone, demonstrates that the claim is not to some disembodied abstract idea but is instead a specific application of a method implemented by several computer systems, operating in tandem, over a communications network.” *Ultramercial*, 722 F.3d at 1350.

As in *Ultramercial*, the '733 patent specification also includes Figures, as well as textual description, which show that claims 1-16 are not drawn to a disembodied abstract idea, but are instead tied to a particular computer implementation. For example, Figure 1 of the '733 and '850 patents shows a menu presented via a user interface which is analogous to the “**first**” or

“master” menu” of ‘733 claims 1, 4, 5 and 12, and Figure 7 shows a menu presented via a user interface, including applicability to both a wireless handheld computing device format and a Web page format, which is analogous to the “**second** menu” of ‘733 claim 1. Figures 2-5 further demonstrate the extensive use of computer interfaces to provide inputs which the claimed menu generation and transmission software use to configure menus for display on computing device screens, *i.e.*, the **transformation** of a menu into a different form suitable for display on the particular target display device, *e.g.*, a wireless handheld computing device. The specification provides much more description of the menu generation, transmission and display functionality as recited, *inter alia*, in ‘733 claim 1, as discussed above, *e.g.*:

With reference to FIG. 1, the preferred embodiment includes an intuitive GUI 1 from which to build a menu on a desktop or other computer. A hierarchical tree structure 2 is used to show the different relationships between the menu categories 3 (*e.g.*, soups, salads, appetizers, entrees, deserts, etc.), menu items 4 (*e.g.*, green salad, chicken caesar salad, etc.), menu modifiers 5 (*e.g.*, dressing, meat temperature, condiments, etc.) and menu sub-modifiers 6 (*e.g.*, Italian, French, ranch, bleu cheese, etc.).

‘850 patent, col. 6:9-21.

FIG. 7 is a schematic representation of a point of sale interface 15 for use in displaying a page-type menu 16 created using the inventive menu generation approach. As can be seen from FIG. 7, the page menu is displayed in a catalogue-like point-and-click format whereas the master menu, FIG. 1, is displayed as a hierarchical tree structure. Thus, a person with little expertise can "page through" to complete a transaction with the POS interface and avoid having to review the entire menu of FIG. 1 to place an

order. *A PDA or Web page format could appear like FIG. 7*
 ‘850 patent, col. 10:14-26 (emphasis added).

The ‘733 claims are directed to a computer software system which is limited to discrete components and specific functionality which does not preempt any basic principle, and thus are not subject to CBM review:

Pre-emption is only a subject matter eligibility problem when a claim preempts all practical use of an idea. . . . Claim 4 further limits performing a real time Web transaction to completing the funds transfer by object routing. Claim 4 would not cover methods that do not use object routing to complete the transfer of funds in a software program that can be accessed by an internet user, i.e., a Web application

SAP, Inc. v. Pi-Net Intl. Inc., CBM2013-00013, Paper No. 15, Inst. Dec. at 21.

Viewing the subject matter of the '733 patent as a whole, the invention involves an extensive use of computers, networks, and computer interfaces, just as the patent in *Ultramercial* did (and even more so for the ‘733 patent because the ‘733 patent actually recites computer, network and display/interface functionality provided via specialized software (*e.g.*, menus)). Petitioners’ “abstract idea” argument (Am. Pet. at 7-9, 56-58, 61-62, 64) is legally incorrect because it improperly boils the claims down to the supposedly abstract idea of “computerizing menus” while ignoring all of the computer implemented limitations described above:

[A]ny claim can be stripped down, simplified, generalized, or paraphrased to remove all of its concrete limitations, until at its core, something that could be characterized as an abstract idea is revealed. A court cannot go hunting for abstractions by ignoring the concrete, palpable, tangible limitations of the invention the

patentee actually claims.

Ultramercial, 722 F.3d at 1344. Likewise, Petitioners’ patentable subject matter challenge under §101 wholly ignores the inventive content and technological nature of the ‘733 patent. The patent describes software system inventions, embodying numerous unique and essential claim limitations, that have been widely deployed by Ameranth and that have won acclaim and technology awards. Just as controlling authority has long established that independent confirmations of non-obviousness via secondary factors provide some of the best evidence against obviousness, the independent actions of the numerous panels of judges awarding Ameranth its many technology awards for the five different products embodying the claims, as well as 26 patent licensees, confirm that Ameranth's invention is not a mere “abstract idea.”

Further, Petitioners’ argument that the inventions do not “transform a particular article into a different state or thing” is absurd. As described above, the very essence of many of the claims is transformation of “first menus” into “second menus” suitable for display and navigation on handheld devices or Web pages, *i.e.*, for a different use. “Transformation and reduction of an article ‘to a different state or thing’ is the clue to patentability of a process claim that does not include particular machines.” *Bilski v. Kappos*, 130 S. Ct. 3218, 3227 (2010) (*quoting* *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972)).⁴⁶ “Transformation of electronic data [such as the claimed menus] has been

⁴⁶ “X-ray attenuation data produced in a two dimensional field by a computed tomography scanner” [] clearly represented physical and tangible objects, namely the structure of bones, organs, and other body tissues. Thus, ***the transformation of that raw data into a particular visual depiction of a physical object on a display was sufficient to render that more narrowly-claimed process patent-eligible. We further note for clarity that the electronic transformation of the data itself into***

found when the nature of the data has been changed such that it has a different function or is suitable for a different use.” MPEP 2106(II)(B)(1)(b) (*citing In re Bilski*, 545 F.3d 943, 962-63 (Fed. Cir. 2009) (*aff’d sub nom Bilski v. Kappos*, 130 S. Ct. 3218 (2010))); *see also* MPEP §2106(II)(B)(1)(b) (emphasis added):

An article can also be electronic data that represents a physical object . . . identified by indicating what the data represents, the particular type or nature of the data, and/or how or from where the data was obtained.

Clearly, menus are physical objects and the application software claimed by the ‘733 patent transforms data representations of those physical objects to different forms. Still further, the constituents of menus, *i.e.*, categories, items etc., are physical objects. Thus, data representations of physical objects are transformed by the claimed functionality on multiple levels. The ‘733 patent claims are thus patent eligible under the very standard which Examiners in the USPTO must apply.

The claims of the '733 patent do not preempt all uses of menus on computers, as the Petition erroneously asserts. Rather, the scope of the claims is limited to, *e.g.*, a particular information management and synchronous communications system for generating and transmitting or synchronizing computerized menus representative of physical menus (and their physical constituents, *e.g.*, food to be ordered) as detailed above and recited explicitly in claims 1-11, or a particular information management and synchronous communications method for generating and synchronizing computerized menus representative of physical menus (and their physical

a visual depiction in Abele was sufficient; the claim was not required to involve any transformation of the underlying physical object that the data represented.

In re Bilski, 545 F.3d 943, 962-63 (Fed. Cir. 2008) (*en banc*) (citation omitted, emphasis added), *aff’d Bilski v. Kappos*, 130 S. Ct. 3218 (2010).

constituents, *e.g.*, food to be ordered) as detailed above and recited explicitly in claims 12-16. The Petitioners' §101 challenges should be rejected by the Board for the reasons stated above. Moreover, as discussed above, the dependent claims add limitations which clearly restrict the various claims to particular functionality, which *ipso facto* means that such claims do not preempt all uses. For example, dependent claims 2 and 10 include further limitations directed to printing directly from the GUI of a user device, dependent claims 3 and 11 include further limitations directed to linking the second/modified menu directly to a particular customer at a particular table, claims 6, 7, 13 and 14 include further limitations directed to handwriting capture/recognition, claims 7, 9, 14 and 16 include further limitations directed to conversion to text and claims 8, 9, 15 and 16 include further limitations directed to voice capture/recognition. No rational person could argue that printing, handwriting or voice capture/recognition, or conversion to text are not transformations. Still further, not only do the independent claims recite particularized menu generation/synchronization aspects which negate any preemption issue, the independent claims are further limited (*vis-à-vis* the '850 independent claims) to "manually modified" functionality, and thus further avoid preempting every possible manner of computerizing menus.

Claims 1-16 are not merely abstract ideas. No one can credibly argue that claims 1-16 preempt every possible way (or even a substantial number of ways) of "computerizing menus," as Petitioners have mischaracterized them. As such, Petitioners have not shown that it is "more likely than not" that any of claims 1-16 are unpatentable under 35 U.S.C. §101, and thus the Petition for covered business method review must be denied on those grounds.

**3. 35 U.S.C. §101 Is Not A Condition For Patentability
And Thus Cannot Form A Ground For CBM Review**

Petitioner's challenge under Section 101 ignores recent Federal Circuit case law concluding that §101 is not a condition for patentability. *CLS Bank*, 717 F.3d at 1276; *Ultramercial*, 722 F.3d at 1341. Although the Board has previously addressed the question of whether it has the authority to institute a CBM proceeding on the basis of §101 (*see SAP Am., Inc. v. Versata Dev. Grp., Inc.*, Case CBM2012-00001, Paper No. 36, at 32-36 (PTAB Jan. 9, 2013), it did so prior to the Federal Circuit's recent decisions in *CLS Bank* and *Ultramercial*.

The express statutory language defining available grounds for CBM review states that such grounds must be invalidity based on "a condition for patentability," but does not include Section 101 as a condition for patentability. 35 U.S.C. § 282(b)(2). All ten Federal Circuit judges in *CLS Bank v. Alice (en banc)* agreed that §101 is *not* a condition for patentability, distinguishing that section from §§102 and 103. The Federal Circuit agreed, contrary to the Board's decision in *SAP v. Versata*, that §101 is a threshold determination for patent eligibility, and is *not* a condition for patentability. *Accord Ultramercial*, 722 F.3d at 1341; *see also* Preliminary Response, CBM2013-00049, Paper No. 16 at 55-61. In view of the clarification provided by the Federal Circuit and in light of the clear statutory language, Patent Owner respectfully asks that the Board re-evaluate its previous decision on this issue.

VI. CONCLUSION

For at least the reasons set forth above, the Board should not initiate a CBM review in this case. The '733 patent is not directed to a "financial product or service" and is also a "technological invention" exempt from CBM review. Moreover,

Petitioner has failed to establish that any of Claims 1-16 are more likely than not invalid under 35 U.S.C. §§101 or 112.

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Respectfully Submitted,

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CERTIFICATE OF SERVICE

I certify that, in accordance with 37 C.F.R. §42.6, a true and correct copy of the foregoing Patent Owner's Preliminary Response was served on January 13, 2014 by causing said documents to be delivered via electronic mail, per agreement of the parties, to counsel for Petitioners at the following addresses:

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