UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

STARBUCKS CORPORATION, et al.

Petitioners

v.

FALL LINE PATENTS, LLC

Patent Owner.

Case No. IPR2019-00610
Patent No. 9,454,748

PETITIONERS' SUPPLEMENTAL BRIEF IN SUPPORT OF PETITION FOR INTER PARTES REVIEW

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Pursuant to the Board's Order (Paper No. 24), Petitioners submit this supplemental brief regarding claim construction issues identified by the Board. As the Board correctly notes, "Patent Owner appears to implicitly construe . . . limitations to require each of [various steps] be performed by executing device independent tokens." Paper No. 24 at 3. The claims have no such requirement. Neither the claim language nor the specification requires the claimed elements to all be performed via device independent or indifferent tokens. In fact, so construing the claims would foreclose several embodiments in the specification. Accordingly, Petitioners submit that because the claim limitations are not as narrow as Patent Owner suggests, all Challenged Claims should be cancelled in view of the prior art.

I. PETITIONERS' SUPPLEMENTAL CLAIM CONSTRUCTION POSITIONS

A. The claims do not require tokens to be exclusively device indifferent or device independent.

The Challenged Claims require a tokenized questionnaire with a plurality of "device independent" (claims 19, 21) or "device indifferent" (Claim 1) tokens. The claims do not require, however, that the tokens making up the questionnaire ***consist solely of*** device independent or indifferent tokens. The claim language does not support this requirement, and the specification does not suggest the patentee restricted the claims in this manner.

First, the claim language does not require the tokens to consist of only device independent or indifferent tokens. In claims 19 and 21, the limitation recites a

"tokenized questionnaire ***comprising*** a plurality of device independent tokens." The Manual of Patent Examining Procedure explicitly states, "The transitional term 'comprising' . . . is inclusive or open-ended, and it does not exclude additional, unrecited elements or method steps." MPEP, 8th ed., rev. 1 § 2111.03 (2003); *see, e.g., Genentech, Inc. v. Chiron Corp.,* 112 F.3d 495, 501 (Fed. Cir. 1997). Therefore, the recitation of "comprising" in claims 19 and 21 means that while the resulting method must have at least some device independent tokens, the claims do not ***exclude*** device dependent tokens.

Had the patentee intended the language to be so restricted, he could have used "consisting of," which does "exclude[] any element, step, or ingredient not specified in the claim." MPEP, 1 § 2111.03; *see also Multilayer Stretch Cling Film Holdings, Inc. v. Berry Plastics Corp.*, 831 F.3d 1350, 1359 (Fed. Cir. 2016) (holding there is an "exceptionally strong presumption that a claim term set off with 'consisting of' is closed to unrecited elements"). Here the patentee did not include such a restriction, which indicates the element is open-ended. The same is true for Claim 1. Claim 1 recites "tokenizing said questionnaire, thereby producing a plurality of device indifferent tokens representing said questionnaire." The claim language does not include any exclusionary clauses to suggest that the plurality of tokens must consist solely of device indifferent tokens.

Second, the specification does not require all of the tokens to be device

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