UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AMERICAN MULTI-CINEMA, INC.; AMC ENTERTAINMENT HOLDINGS, INC.; BOSTON MARKET CORPORATION; MOBO SYSTEMS, INC.; MCDONALD'S CORPORATION; MCDONALD'S USA; PANDA RESTAURANT GROUP, INC.; PANDA EXPRESS INC.; PAPA JOHN'S INTERNATIONAL, INC.; STAR PAPA LP; and PAPA JOHN'S USA, INC.
Petitioner

v.

FALL LINE PATENTS, LLC
Patent Owner.

Case IPR2019-00610
Patent 9,454,748 B2

PATENT OWNER'S OPENING BRIEF ON REMAND FROM THE COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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The Federal Circuit remanded on whether Petitioner met its burden of showing that Barbosa ***actually*** discloses the automatic transfer of the executable questionnaire as required by step (b) of claim 7. On that issue, the Board should again rule that Petitioner failed to meet its burden. Alternatively, the Board should rule that Petitioner failed to meet its burden for step (f) of claim 7.

1. The Board's Final Written Decision

Before the Board, Petitioner argued that the "updating of inventory tracking and ordering information" taught by Barbosa was a transfer of the recited questionnaire. *See* Paper 32 at 50 [FWD].

The Board rejected that argument on the merits for two reasons. First, Petitioner failed to explain why this updating amounted to a transfer of the recited questionnaire. *Id*. at 50 ("Mr. Roman, however, does not persuasively explain why the described inventory tracking and ordering information constitutes a transfer of the recited questionnaire."); at 51 ("Nor does Mr. Roman provide any other evidence to support a finding that this updated template is the recited questionnaire."). Second, Petitioner failed to explain why this updating—which could be provided merely as text—amounted to an executable questionnaire. *Id*. at 50 ("Mr. Roman does not explain how the mere transfer of questions, which could be provided merely as text, discloses the transfer of an executable questionnaire.");

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at 51 ("Mr. Roman provides no evidence that this updated template is executable, rather than merely text.").

Moreover, the Board never found that Petitioner had shown that Barbosa discloses automatically transferring the updates. The Board understood Petitioner's (reply) argument to be that it would have been obvious in view of Barbosa's teachings to make the transfer automatic. *See id.* at 50-51. The Board merely accepted that position ***for purposes of argument*** when it ruled against Petitioner on other grounds. *See id.* ("Additionally, according to Mr. Roman, it would have been obvious to transfer the updated inventor questions to the handheld device automatically . . . . But even if we were to afford weight to that testimony, it would merely establish that questions were automatically transferred to the handheld, not that an executable questionnaire was."). The Board never ruled that Barbosa made obvious—much less ***actually*** disclosed—automatically transferring the updates.

2. The Federal Circuit's Remand

The sole ruling of the Board on which the Federal Circuit remanded was whether Petitioner had shown that Barbosa ***actually*** discloses the automatic transfer requirement of step (b). *See AMC Multi-Cinema, Inc. v. Fall Line Patents,*

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LLC, No. 2021-1051, 2021 WL 4470062, *8 (Fed. Cir. 2021).[1] The Federal Circuit ruled that Petitioner had (timely) argued to the Board that Barbosa actually disclosed automatically transferring the question updates by arguing that "the synchronization necessary in a wireless context would be understood as automatic." *Id*. at *17. Importantly, the Federal Circuit did not rule on the merits of that argument. The Federal Circuit also ruled that the Board failed to adequately explain why the passages from Barbosa relied on by Petitioner did not establish that the updates constituted an "executable" questionnaire that was automatically transferred. *See id.* at *20. *Id*. Again importantly, the Federal Circuit did not rule that Petitioner's evidence supported its argument. Based on these rulings, the Federal Circuit remanded to the Board for further analysis.

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[1] The Federal Circuit affirmed the Board's ruling that Petitioner's argument that the automatic transfer requirement of step (b) was an ***obvious*** modification of Barbosa was untimely. *See AMC Multi-Cinema, Inc. v. Fall Line Patents, LLC*, No. 2021-1051, 2021 WL 4470062, *7, 9 (Fed. Cir. 2021). It also affirmed the Board's ruling that Petitioner failed to establish unpatentability based on Hancock-Falls (Ground 7). *See id*. And it agreed that Petitioner failed to point to anything in Falls that teaches the automatic transfer requirement of step (b). *See id.*

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3. Claim Construction

Per the order of the Board, the parties took up the construction of "executable" and agreed as follows:

> The parties agree that Java and markup languages (XML, HTML, JSON, etc.) are "executable" and that the Microsoft Dictionary definition cited by the Board ("of, pertaining to, or being a program file that can be run") is acceptable with that clarification.

Paper No. 36 [1/10/22 Joint Statement].

4. The Board Should Again Rule That Petitioner Did Not Meet Its Burden For Step (b)

There are three reasons why the Board should again rule that Petitioner failed to meet its burden for step (b) of claim 7.

First, as the Board previously concluded, Petitioner failed to establish that the updates on which it relies qualify as the questionnaire recited by claim 7. *See* Paper 32 at 50, 51 [FWD]. In addition to the requirements of step (b), claim 7 imposes a host of other requirements that must be met by the alleged questionnaire. Petitioner did not even attempt to show that the updates meet the other requirements of the claim.

Second, as the Board previously concluded, Petitioner failed to establish that the updates on which it relies qualify as being an "executable" questionnaire. The

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