UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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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.

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Case IPR2019-00610
Patent 9,454,748 B2

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

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## I. INTRODUCTION

Even if the Board were to accept everything Petitioner asserts about what Barbosa teaches, Petitioner still loses:  Petitioner has not identified a questionnaire disclosed by Barbosa as being ***both*** executable ***and*** automatically transferred as required by step (b) of claim 7.  Petitioner also loses because its arguments about what Barbosa teaches regarding automatic transfers and executable questionnaires are conclusory and unsupported.  Alternatively, Petitioner loses because its arguments regarding step (f) of claim 7 are both untimely and insufficient.

## II. PETITIONER FAILED TO IDENTIFY A QUESTIONNAIRE THAT IS "EXECUTABLE" AND "AUTOMATICALLY TRANSFERRED"

Claim 7 requires a questionnaire that is both "executable" and "automatically transferred."  Petitioner has not asserted that any questionnaire from Barbosa meets both requirements.  For the requirement that the questionnaire be "executable," Petitioner identifies Barbosa's "industry-specific program" and asserts that it is "executable" because Barbosa teaches that it can be programmed in Java.  *See* Pet. Remand Brief at 2-3.  But for the requirement that the executable questionnaire be automatically transferred, Petitioner ignores that it was the "industry-specific program" that it said was the executable questionnaire.  Instead of attempting to show that Barbosa discloses that the industry-specific program is automatically transferred, Petitioner points to various portions of Barbosa as teaching the automatic transfer of other things.  Indeed, in its section on "automatic

transfer," Petitioner does not so much as allude to the industry-specific program that it relied on as being the "executable questionnaire." *See* Pet. Remand Brief at 5-7.

Petitioner first relies on Barbosa's disclosure of "field assessment data synchronization" as discussed in its original petition. Pet. Remand Brief at 5 (citing Petition at 43-44). Petitioner argues that a person of skill "would understand" that this data synchronization would occur automatically. *Id.*; *see also* Ex. 1005 at ¶ 177 (opining only that Barbosa discloses synchronization of data) [Roman Decl]. But the synchronization of that **data** is not the same as the synchronization of the industry-specific program (or of any other executable questionnaire). So even if Petitioner had established that synchronization necessarily involves an automatic transfer (it has not—more on that below), Petitioner still would not have shown that Barbosa discloses an automatic transfer of the executable questionnaire.

Petitioner next says that it argued in reply that "Barbosa discloses automatically distributing **executable** templates" for updated inventory and task tracking. Pet. Brief at 6 (citing Reply ISO Petition at 13-15) (emphasis added). But Petitioner's reply never asserted that the templates were executable. *See* Reply ISO Petition at 13-15. So Petitioner cannot now argue that in its remand brief. Moreover, even if Petitioner could establish that these update templates are

executable (it cannot—more on that below), and even if Petitioner could show that Barbosa teaches automatically transferring them to the handheld device (it cannot—more on that below as well), Petitioner still would not have shown that Barbosa discloses that the "industry specific program" is automatically transferred.

Finally, Petitioner points to its reply argument about "Barbosa's express teaching regarding the importance of coordinating among remote users in the field." Pet. Remand Brief at 7 (citing Reply ISO Petition at 15). Petitioner's final argument in no way shows that Barbosa actually discloses automatically transferring anything, much less an "executable questionnaire"—and much, much less the industry-specific program on which Petitioner relied.

The various teachings of Barbosa that Petitioner points to might have supported an argument that it would have been *obvious* to automatically transfer the industry specific program—which explains why Petitioner repeatedly couched them in language about what Barbosa "would have led" a person of skill to "understand" or to "appreciate" about the system disclosed by Barbosa. *See* Pet. Remand Brief at 5-7 (quoting various portions of Petitioner's original papers). But they do not establish that Barbosa *actually discloses* automatically transferring the executable questionnaire, which is the sole issue on which the Federal Circuit remanded. Accordingly, the Board should again rule that Petitioner failed to meet its burden of establishing that claim 7 is unpatentable.

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