

APPENDIX

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APPENDIX A

NOTE: This disposition is nonprecedential.

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

2019-1141, 2019-1144

[Filed November 1, 2019]

| | |
|----------------------------------|---|
| AMERANTH, INC., |) |
| <i>Plaintiff-Appellant</i> |) |
| |) |
| v. |) |
| |) |
| DOMINO'S PIZZA, LLC, |) |
| DOMINO'S PIZZA, INC., |) |
| <i>Defendants-Appellees</i> |) |
| |) |
| PAPA JOHN'S USA, INC., |) |
| OPENTABLE, INC., GRUBHUB, INC., |) |
| SEAMLESS NORTH AMERICA, LLC, |) |
| O-WEB TECHNOLOGIES LTD., |) |
| HOTELS.COM, L.P., STUBHUB, INC., |) |
| TICKETMASTER, LLC, LIVE NATION |) |
| ENTERTAINMENT, INC., |) |
| TRAVELOCITY.COM LP, HOTEL |) |
| TONIGHT, INC., ORBITZ, LLC, |) |
| EXPEDIA, INC., FANDANGO, INC., |) |
| HOTWIRE, INC., KAYAK SOFTWARE |) |
| CORPORATION, EMN8, INC., HILTON |) |
| INTERNATIONAL CO., HILTON |) |

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RESORTS CORPORATION, HILTON)
WORLDWIDE, INC., USABLENET,)
INC., STARWOOD HOTELS &)
RESORTS WORLDWIDE INC., MOBO)
SYSTEMS, INC., AGILYSYS, INC.,)
ATX INNOVATION, INC., BEST)
WESTERN INTERNATIONAL, INC.,)
HYATT CORPORATION, ORDR.IN,)
INC., NAAMA NETWORKS, INC.,)
MARRIOTT HOTEL SERVICES, INC.,)
MARRIOTT INTERNATIONAL, INC.,)
RITZ CARLTON HOTEL COMPANY,)
LLC, RENAISSANCE HOTEL)
OPERATING COMPANY, APPLE, INC.,)
TICKETBISCUIT, LLC, EVENTBRITE,)
INC., TICKETFLY, INC., STARBUCKS)
CORPORATION, IPDEV CO., ORACLE)
CORPORATION,)
Defendants)
_____)

Appeals from the United States District Court for
the Southern District of California in Nos. 3:11-cv-
01810-DMS-WVG, 3:12-cv-00733-DMS-WVG, Judge
Dana M. Sabraw.

Decided: November 1, 2019

RICHARD CHARLES WEINBLATT, Stamoulis &
Weinblatt LLC, Wilmington, DE, argued for plaintiff-
appellant.

FRANK A. ANGILERI, Brooks Kushman PC,
Southfield, MI, argued for defendants-appellees. Also

represented by THOMAS W. CUNNINGHAM, JOHN P. RONDINI.

Before PROST, *Chief Judge*, PLAGER and DYK,
Circuit Judges.

DYK, *Circuit Judge.*

Ameranth, Inc. (“Ameranth”) sued Domino’s Pizza, LLC and Domino’s Pizza, Inc. (together, “Domino’s”) for infringement of various claims of U.S. Patent No. 8,146,077 (“the ’077 patent”). The district court entered judgment that claims 1, 4–9, 11, and 13–18 of the ’077 patent are patent ineligible under 35 U.S.C. § 101. We affirm as to claims 1, 6–9, 11, and 13–18, but hold that the district court lacked declaratory judgment jurisdiction as to claims 4 and 5.

BACKGROUND

Beginning in 2011, Ameranth filed numerous actions against companies in the hospitality industry for infringement of various patents covering communications systems for generating and transmitting menus. Ameranth asserted various claims of the ’077 patent and U.S. Patent Nos. 6,384,850 (“the ’850 patent”), 6,871,325 (“the ’325 patent”), and 6,982,733 (“the ’733 patent”).

The district court consolidated the actions for pretrial purposes including discovery and claim construction. Ameranth’s complaint against Domino’s asserted infringement of the ’077, ’850, ’325, and ’733 patents. Domino’s filed counterclaims asserting that

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the '077, '850, '325, and '733 patents are patent ineligible under § 101.

Various defendants challenged Ameranth's patents before the Patent Trial and Appeal Board ("Board") in Covered Business Method proceedings. In *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1245 (Fed. Cir. 2016), this court held that claims of the '850, '325, and '733 patents on appeal from the Board's decision are patent ineligible. By early 2017, those three patents were no longer at issue in the consolidated district court proceeding, and only infringement of the related '077 patent remained.

Domino's was among the various defendants accused of infringement in the district court actions. In June 2018, defendants Pizza Hut, Inc. and Pizza Hut of America, Inc. (together, "Pizza Hut") filed a motion for summary judgment of unpatentability under § 101 with respect to the '077 patent. Ameranth and Pizza Hut settled, and Domino's requested permission in effect to substitute itself for Pizza Hut to pursue the motion. That request was granted.

On September 25, 2018, the district court granted the motion for summary judgment of unpatentability, finding that "the asserted claims of the [']077 Patent are unpatentable under § 101." J.A. 15. The district then entered final judgment in the action against Domino's and adjudicated that "all asserted claims of the '077 Patent (claims 1, 4–9, 11, 13–18) are patent ineligible under Section 101." J.A. 1–2.

Ameranth appeals. We have jurisdiction under 28 U.S.C. § 1295(a)(1).

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We review a district court's grant of summary judgment without deference. A district court's decision on patent eligibility is reviewed de novo except that its factual determinations are reviewed for clear error. *Berkheimer v. HP Inc.*, 881 F.3d 1360, 1365, 1368 (Fed. Cir. 2018).

With respect to jurisdiction, we review de novo whether a case or controversy exists and apply Federal Circuit law. *Sanofi-Aventis U.S., LLC v. Dr. Reddy's Labs., Inc.*, 933 F.3d 1367, 1372 (Fed. Cir. 2019).

DISCUSSION

I. Jurisdiction

Ameranth contends that it asserted only claims 1, 6, 9, 13, and 17 against Domino's and thus the district court's order invalidating nine other claims (i.e., claims 4–5, 7–8, 11, 14–16, and 18) should be vacated for lack of declaratory judgment jurisdiction.

Article III courts have subject matter jurisdiction only if there is an actual case or controversy. *See MedImmune, Inc. v. Genentech, Inc.*, 549 U.S. 118, 126–27 (2007). “[T]he existence of a case or controversy must be evaluated on a claim-by-claim basis” in patent cases. *Fox Grp., Inc. v. Cree, Inc.*, 700 F.3d 1300, 1307 (Fed. Cir. 2012) (quoting *Jervis B. Webb Co. v. So. Sys., Inc.*, 742 F.2d 1388, 1399 (Fed. Cir. 1984)). “[J]urisdiction must exist ‘at all stages of review, not merely at the time the complaint [was] filed,’” *Streck, Inc. v. Research & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1282 (Fed. Cir. 2012) (second alteration in original) (quoting *Benitec Austl., Ltd. v. Nucleonics, Inc.*, 495 F.3d 1340, 1343 (Fed. Cir. 2007)), and “a

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counterclaimant must show a continuing case or controversy with respect to withdrawn or otherwise unasserted claims,” *id.* at 1283. All of the circumstances are considered in determining the existence of a case or controversy. *See MedImmune*, 549 U.S. at 127.

Ameranth does not dispute the existence of a case or controversy for claims 1, 6, 9, 13, and 17. But Ameranth argues that the district court was without power to determine the patent eligibility of claims 4–5, 7–8, 11, 14–16, and 18 of the ’077 patent because there was no case or controversy with respect to those claims. We first address the latter seven claims (claims 7–8, 11, 14–16, and 18).

In its infringement contentions, Ameranth accused Domino’s of infringing various claims of the ’077 patent including the seven claims. Ameranth attached to the complaint, its Disclosure of Asserted Claims and Infringement, including allegations that “Domino’s Ordering System infringes at least . . . claims 1, 3, 6, 7, 8, 9, 11, 12, 13, 15, 16, 17, and 18 of the [’]077 patent.” J.A. 12425–26. Domino’s then pled counterclaims seeking a declaratory judgment that the claims were unpatentable under § 101. Despite the broad language of the complaint, the district court ordered Ameranth to “select no more than five (5) claims from each patent to assert” and that it “may assert additional claims at this time only with leave of Court.” J.A. 2192; *In re: Ameranth Patent Litig. Cases* (“*In re Ameranth*”), No. 3:11-cv-01810 (S.D. Cal. 2012), ECF 623 at 2. The district court also required Ameranth’s infringement contentions to “consist of one representative version of

each Defendant's accused system for the five selected claims." J.A. 2192.

As a result, Ameranth amended its disclosure of asserted claims: it listed claims 6–8, 14, and 18 in its November 15, 2013 disclosure; and claims 1, 6, 9, 13, and 17 in its July 5 and August 7, 2017 disclosures. *In re Ameranth*, ECF 1217-5 at 1, 1217-6 at 1; J.A. 2196. Thus, Ameranth did not list claims other than 1, 6, 9, 13, and 17 in its latest amended disclosure of asserted claims. In the amendments, Ameranth stated that the selection was due to the district court's order and alleged that "Domino's infringes *at least* the [listed five claims of the '077 patent]" and it "reserves the right to assert additional and/or different claims in the future by Court order." *In re Ameranth*, ECF 1217-5 at 1–2, 1217-6 at 1; J.A. 2196. There was no indication that Ameranth altered its position that Domino's Ordering System infringes claims 7–8, 11, 14–16, and 18.

The fact that Ameranth did not include certain claims which it originally accused of infringement in the amended disclosure of asserted claims does not mean that a case or controversy with respect to those claims disappeared. An actual suit affirmatively asserting the claims is not a requirement for an Article III case or controversy. *Cardinal Chem. Co. v. Morton Int'l, Inc.*, 508 U.S. 83, 95 (1993) ("In patent litigation, a party may satisfy th[e] burden, and seek a declaratory judgment, even if the patentee has not filed an infringement action."). The Supreme Court in *MedImmune* has also held that even a "reasonable apprehension of suit" is not a requirement for Article III jurisdiction. 549 U.S. at 132 n.11; *see also Asia Vital*

Components Co. v. Asetek Danmark A/S, 837 F.3d 1249, 1252 n.1 (Fed. Cir. 2016) (recognizing that a “reasonable apprehension of imminent suit” is no longer a prerequisite although it may be a factor that can satisfy Article III controversy).

Ameranth’s original accusation that Domino’s infringed claims 7–8, 11, 14–16, and 18 created a case or controversy. See *Cardinal Chem.*, 508 U.S. at 99–100. “A company once charged with infringement must remain concerned about the risk of similar charges if it develops and markets similar products in the future.” *Id.* “Merely the desire to avoid the threat of a ‘scarecrow’ patent, in Learned Hand’s phrase, may [] be sufficient to establish jurisdiction under the Declaratory Judgment Act.” *Id.* at 96.

Under our case law, the original case or controversy could cease if the patentee withdrew its claims of infringement. See *Streck, Inc. v. Research & Diagnostic Sys., Inc.*, 665 F.3d 1269, 1276, 1284 (Fed. Cir. 2012) (patentee eliminated claims in its infringement contentions that included information on “[e]ach claim of each patent in suit that is allegedly infringed” by the opposing party (alteration in original)); *Fox Grp., Inc. v. Cree, Inc.*, 700 F.3d 1300, 1308 (Fed. Cir. 2012) (patentee withdrew its assertion of certain claims).

Unlike *Streck* and *Fox*, there is no indication that Ameranth here withdrew its accusations of alleged infringement of claims 7–8, 11, 14–16, and 18. Ameranth limited its claims here only because it was compelled to limit the claims by order of the district court. Eliminating claims 7–8, 11, 14–16, and 18 from the amended disclosure of asserted claims did not

eliminate the case or controversy with respect to those claims.

This case is similar to *Voter Verified, Inc. v. Premier Election Solutions, Inc.*, 698 F.3d 1374 (Fed. Cir. 2012). In *Voter Verified*, the patentee alleged in its complaint infringement of every claim of the asserted patent but “later pared back its infringement contentions” with the “caveat that discovery might dictate reintroducing ‘other claims in the patents in suit.’” *Id.* at 1382. This court held that the defendants “kept any ‘unasserted’ claims before the district court by maintaining their respective counterclaims” and thus the district court had jurisdiction to rule on the validity of those claims. *Id.* This is consistent with the Declaratory Judgment Act, which allows a defendant to “counterclaim for a declaration of invalidity and noninfringement . . . [so that] the defendant is protected against the possibility that the [rights holder] will dismiss the suit or that the infringement action will not resolve all of the issues between the parties.” *Green Edge Enters., LLC v. Rubber Mulch Etc., LLC*, 620 F.3d 1287, 1300–01 (Fed. Cir. 2010) (quoting 10B Charles Alan Wright, Arthur R. Miller & Mary Kay Kane, *Federal Practice and Procedure* § 2761 (3d ed. 1998 & Supp. 2010)). In summary, a case or controversy existed with respect to claims 7–8, 11, 14–16, and 18.

The remaining claims found to be patent ineligible by the district court are claims 4 and 5. In its infringement contentions, Ameranth did not accuse Domino’s of infringing claims 4 and 5 while it noticed other claims discussed above. Domino’s conceded during oral argument that there was no case or

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controversy with respect to claims 4 and 5.¹ We therefore conclude that the district court did not have jurisdiction to determine the patent eligibility of claims 4 and 5 of the '077 patent.

II. Notice

Ameranth contends that even if there was a case or controversy with respect to claims 4–5, 7–8, 11, 14–16, and 18, it did not receive notice that those claims would be subject to the summary judgment motion or ruling.

Ameranth points out that Pizza Hut originally filed a motion for summary judgment of unpatentability with respect to only claims 1, 6, 8, 13, and 17. But under Rule 56 of the Federal Rules of Civil Procedure, a district court has power to enter summary judgments sua sponte. Fed. R. Civ. P. 56(f); *see also Int'l Visual Corp. v. Crown Metal Mfg. Co.*, 991 F.2d 768, 770 (Fed. Cir. 1993) (citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 326 (1986)). For such judgments to be proper, generally the losing party should be on notice so that it has an opportunity to present evidence. *See* Fed. R. Civ. P. 56(f); *Int'l Visual*, 991 F.2d at 770; *OSRAM Sylvania, Inc. v. Am. Induction Techs., Inc.*, 701 F.3d 698, 709 (Fed. Cir. 2012) (citing *Portland Retail Druggists Ass'n v. Kaiser Found. Health Plan*, 662 F.2d 641, 645 (9th Cir. 1981)).

¹ During oral argument, Domino's included claim 14 in the list of claims not originally asserted, but, as discussed above, the record shows that Ameranth affirmatively asserted claim 14 in its November 15, 2013, amended disclosure.

Ninth Circuit law, which governs here, recognizes situations where a district court may enter summary judgment against a party even without notice if the party had a “full and fair opportunity to ventilate the issues.” *See Arce v. Douglas*, 793 F.3d 968, 976 (9th Cir. 2015) (quoting *United States v. Grayson*, 879 F.2d 620, 625 (9th Cir. 1989)). In *Grayson*, for example, the district court ruled beyond the government’s summary judgment motion and dismissed the defendants’ counterclaim. 879 F.2d at 625. The defendants had developed factual allegations and legal theories with respect to the counterclaim and presented them in their briefing in opposition to the government’s motion. *Id.* The defendants thus had a “full and fair opportunity to ventilate the issues raised in their counterclaim” that was not covered by the motion. *Id.* There was similarly a full and fair opportunity here.

When Pizza Hut settled with Ameranth and Domino’s requested to join Pizza Hut’s motion, the district court allowed the request and permitted Ameranth to file a supplemental opposition. Ameranth’s supplemental opposition addressed all the claims and not just the five listed in the summary judgment motion. For instance, Ameranth argued the patent eligibility of “the claims of the []077 Patent,” stating that “none of the []077 Patent claims are directed to merely ‘configuring and transmitting menus,’” and contended that they are “not directed to any abstract idea.” J.A. 10235, 10240; *In re Ameranth*, ECF 1313 at 8. It asserted the “eligibility of claims 1–12 of the []077 Patent,” and further argued the non-conventionality of “all claims,” noting that they were issued after “a lengthy, seven year prosecution process”

and “found valid by the PTAB” in response to multiple CBM petitions. J.A. 10250–51, 10255. Ameranth also argued that “claims 2–5, 7, 10–12, 14–16 and 18 are patent eligible.” J.A. 10258.

As such, we find that Ameranth had the opportunity to and did address claims 7–8, 11, 14–16 and 18 in its supplemental briefing. After a hearing, the district court granted the summary judgment motion, ruling that “the asserted claims of the [']077 Patent are unpatentable under § 101,” J.A. 15, and entered judgment that “all asserted claims of the '077 Patent (claims 1, 4–9, 11, 13–18) are patent ineligible under Section 101,” J.A. 1–2. Under the circumstances, we see no procedural error in granting summary judgment with respect to claims 7–8, 11, 14–16 and 18.

III. Patent Eligibility

We next address the patent eligibility of claims 1, 6–9, 11, and 13–18 of the '077 patent. Ameranth argues that the district court erred by relying on *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229 (Fed. Cir. 2016), which held that claims of the '850, '325, and '733 patents on appeal are patent ineligible. Those patents and the '077 patent are in the same patent family.

In *Apple*, the claims covered a first menu consisting of menu categories and an application software for generating a second menu using the first menu. 842 F.3d at 1234. The Board had determined that the claims “are directed to the abstract idea of ‘generating a second menu from a first menu and sending the second menu to another location.’” *Id.* at 1240. This court held that the claims are abstract as they neither

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recited “a particular way of programming or designing the software to create menus” with particular features nor covered “a specific improvement in the way computers operate” and that the claim limitations are insignificant post-solution activities. *Id.* at 1241–42.

Ameranth asserts that claims 1, 6–9, 11, and 13–18 of the ’077 patent recite different elements than the claims at issue in *Apple*. To be sure, independent claims 1, 9, and 13 are different from the claims in *Apple* in some respects. Here, claims 1 and 9 cover systems enabled for synchronous communications and automatic formatting of a programmed handheld menu configuration (“PHMC”) that is generated using a master menu and that can display cascaded sets of linked graphical user interface (“GUI”) screens for multiple handheld devices. Similarly, claim 13 recites a system that can automatically format a PHMC for display as cascaded sets of linked GUI screens and synchronize information between its master database, handheld device, web server, and webpage. Notwithstanding the difference from *Apple*, the district court found that the claims of the ’077 patent suffered from the same ineligibility defects. We agree, applying the two-step approach of *Alice Corp. v. CLS Bank International*, 573 U.S. 208 (2014) and *Mayo Collaborative Services v. Prometheus Laboratories, Inc.*, 566 U.S. 66 (2012).

At step one, we “first determine whether the claims at issue are directed to a patent-ineligible concept.” *Alice*, 573 U.S. at 218. We generally agree with the district court that the claims are directed to configuring and transmitting hospitality menu related information

using a system that is capable of synchronous communications and automatic formatting. This focus is confirmed by Ameranth’s characterization that automatically configuring and synchronizing menus for multiple handheld devices was not previously possible and the specification’s emphasis that the inventions enable automatic database updates and fast synchronization between a database and handheld devices. ’077 patent, col. 3, ll. 27–35, col. 5, ll. 3–7; *see also Charge-Point, Inc. v. SemaConnect, Inc.*, 920 F.3d 759, 765–66 (Fed. Cir. 2019) (explaining that the step one inquiry “as looking at the ‘focus’ of the claims” and the specification may illuminate the true focus).

As recited in the claims, the concept of synchronous communications and automatic formatting for different handheld devices without more is an abstract idea. *See Cellspin Soft, Inc. v. Fitbit, Inc.*, 927 F.3d 1306, 1316 (Fed. Cir. 2019) (“[T]he need to perform tasks automatically is not a unique technical problem.”). Claims 1, 9, and 13 do not contain specifics of “a particular conception of how to carry out that concept” and thus fail to make those claims non-abstract. *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1346 (Fed. Cir. 2018). Those claims “fail[] to recite a practical way of applying an underlying idea . . . [and] instead were drafted in such a result-oriented way that they amounted to encompassing ‘the principle in the abstract’ no matter how implemented.” *Id.* at 1343; *see also Elec. Power Grp., LLC v. Alstom S.A.*, 830 F.3d 1350, 1356 (Fed. Cir. 2016) (“[E]ssentially result-focused” and functional language “has been a frequent feature of claims held ineligible under § 101”). Ameranth concedes that the claims cover “a particular

way of programming and designing the software.” Appellant Br. 23. But the claims do not describe the software other than results sought to be achieved.²

Given that the claims are abstract, at step two, we next determine whether the claimed limitations involve more than “well-understood, routine, and conventional activit[ies].” *Alice*, 573 U.S. at 225 (alteration in original) (quoting *Mayo*, 566 U.S. at 73). The district court concluded that the recited hardware and software elements and features including “real-time synchronization,” “automatic formatting . . . for display as cascaded sets of linked graphical user interface[s],” and a “different number of user interface screens from at least one other wireless handheld computing device” do not make the claims inventive. J.A. 14–15.

Claims fall short of an inventive concept when they “simply instruct the practitioner to implement the abstract idea with routine, conventional activity.” *Ultramercial, Inc. v. Hulu, LLC*, 772 F.3d 709, 715 (Fed. Cir. 2014). The specification acknowledges that the “functions falling within the described invention” can be based on “commonly known” programming steps, ’077 patent, col. 12, ll. 57–61, and the claim limitations describe a desired result but do not instruct

² Ameranth argues that this case is like *Core Wireless Licensing S.A.R.L. v. LG Electronics, Inc.*, 880 F.3d 1356 (Fed. Cir. 2018) where claims involving the display of menu on a screen were held to be patent eligible. *Core Wireless* is distinguishable because there the claims included specific details such as, inter alia, “a particular manner by which the summary window must be accessed” and limitations on “the type of data that can be displayed in the summary window.” 880 F.3d at 1362–63.

how to accomplish that result. The alleged abstract idea cannot, itself, provide an inventive concept. This is because “a claimed invention’s use of the ineligible concept to which it is directed cannot supply the inventive concept that renders the invention ‘significantly more’ than that ineligible concept.” *BSG Tech LLC v. Buyseasons, Inc.*, 899 F.3d 1281, 1290 (Fed. Cir. 2018). That is the case here. Accordingly, we conclude that independent claims 1, 9, and 13 are directed to an abstract idea, fail to disclose an inventive concept, and thus are patent ineligible.

Dependent claims 6–8, 11, and 14–18 recite limitations that do not cure the above problems. Claims 6 and 18 require a smartphone; claims 7 and 17 recite completion of payment processing; and claim 8 recites creating layout, views, or fonts in conformity with display screen parameters and enabling preview for manual modification. Claims 11 and 16 require two integrated hospitality applications; claim 14 covers a Wireless Hub Application, Web Hub Application, Linked Databases, and Communications Setup Application; and claim 15 recites automatic importation of information from a database. These additional limitations in those claims are themselves routine and conventional, and thus we determine that they are also patent ineligible.

Ameranth contends that the district court ignored its declarations on the inventiveness of its patent claims. But even after reviewing the evidence in the light most favorable to Ameranth, it does not create a genuine dispute of material fact that would preclude summary judgment.

The declarations to a large extent are directed to unclaimed features. For instance, the declaration of Dr. Michael Shamos, Ameranth’s expert, emphasizes that maintaining screen linkages was a core feature why the claimed inventions were not conventional. Such a feature, however, is not recited in the claims.³

Other declarations are equally irrelevant for different reasons. The declaration of inventor Mr. Keith McNally includes statements that no one had implemented the purported inventive features prior to his realization. The declaration of Mr. Douglas Dedo states that “Microsoft considered Ameranth’s new system synchronization and integration technology to be innovative and ground-breaking in 1999–2000.” J.A. 11112. But these declarations do little to relate the claimed features to the asserted praise. In any event, “[g]roundbreaking, innovative, or even brilliant discovery does not by itself satisfy the § 101 inquiry.” *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. 576, 591 (2013). And “[t]hat some of the . . . steps were not previously employed . . . is not enough—standing alone—to confer patent eligibility.” *Ultramercial*, 772 F.3d at 716; *see also Synopsys, Inc. v. Mentor Graphics Corp.*, 839 F.3d 1138, 1p151 (Fed. Cir. 2016) (“[A] claim for a *new* abstract idea is still an abstract idea.” (emphasis in original)).

Ameranth also argues that its declarations confirm that the inventions solved computerized problems. But

³ Ameranth similarly argues that its inventions eliminate the need for scrolling in the display of small screen devices. This feature also is not claimed.

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they contain general statements that are uninformative and suffer from the above deficiencies.

Accordingly, we agree with the district court's determination that claims 1, 6–9, 11, and 13–18 are patent ineligible.

CONCLUSION

For the foregoing reasons, we affirm the district court's grant of summary judgment of patent ineligibility with respect to claims 1, 6–9, 11, and 13–18, and remand to the district court to vacate the judgment with respect to claims 4 and 5 for lack of declaratory judgment jurisdiction.

**AFFIRMED-IN-PART, VACATED-IN-PART,
AND REMANDED**

COSTS

Each party shall bear its own costs.

UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT

2019-1141, 2019-1144

[Filed November 1, 2019]

AMERANTH, INC.,)
Plaintiff-Appellant)
)
v.)
)
DOMINO'S PIZZA, LLC,)
DOMINO'S PIZZA, INC.,)
Defendants-Appellees)
)
PAPA JOHN'S USA, INC.,)
OPENTABLE, INC., GRUBHUB, INC.,)
SEAMLESS NORTH AMERICA, LLC,)
O-WEB TECHNOLOGIES LTD.,)
HOTELS.COM, L.P., STUBHUB, INC.,)
TICKETMASTER, LLC, LIVE NATION)
ENTERTAINMENT, INC.,)
TRAVELOCITY.COM LP, HOTEL)
TONIGHT, INC., ORBITZ, LLC,)
EXPEDIA, INC., FANDANGO, INC.,)
HOTWIRE, INC., KAYAK SOFTWARE)
CORPORATION, EMN8, INC., HILTON)
INTERNATIONAL CO., HILTON)
RESORTS CORPORATION, HILTON)
WORLDWIDE, INC., USABLENET,)
INC., STARWOOD HOTELS &)
RESORTS WORLDWIDE INC., MOBO)
SYSTEMS, INC., AGILYSYS, INC.,)
ATX INNOVATION, INC., BEST)

WESTERN INTERNATIONAL, INC.,)
HYATT CORPORATION, ORDR.IN,)
INC., NAAMA NETWORKS, INC.,)
MARRIOTT HOTEL SERVICES, INC.,)
MARRIOTT INTERNATIONAL, INC.,)
RITZ CARLTON HOTEL COMPANY,)
LLC, RENAISSANCE HOTEL)
OPERATING COMPANY, APPLE, INC.,)
TICKETBISCUIT, LLC, EVENTBRITE,)
INC., TICKETFLY, INC., STARBUCKS)
CORPORATION, IPDEV CO., ORACLE)
CORPORATION,)
Defendants)
_____)

Appeals from the United States District Court for the Southern District of California in Nos. 3:11-cv-01810-DMS-WVG, 3:12-cv-00733-DMS-WVG, Judge Dana M. Sabraw.

JUDGMENT

THIS CAUSE having been considered, it is

ORDERED AND ADJUDGED:

**AFFIRMED-IN-PART, VACATED-IN-PART, AND
REMANDED**

ENTERED BY ORDER OF THE COURT

November 1, 2019

/s/ Peter R. Marksteiner
Peter R. Marksteiner
Clerk of Court

APPENDIX B

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

CASE NO. 11cv1810 DMS (WVG)

[Filed September 25, 2018]

IN RE: AMERANTH CASES,)
)
)

**ORDER GRANTING DEFENDANTS DOMINO'S
PIZZA, LLC AND DOMINO'S PIZZA, INC.'S
MOTION FOR SUMMARY JUDGMENT OF
UNPATENTABILITY**

This case comes before the Court on the motion for summary judgment of unpatentability of the sole remaining patent in this case, United States Patent Number 8,146,077 (“the ‘077 Patent”). The motion was originally filed by Defendant Pizza Hut, LLC. Ameranth filed an opposition to the motion, and Pizza Hut filed a reply. After the motion was reset for hearing, Ameranth and Pizza Hut settled their case. Thereafter, Domino’s filed an *ex parte* motion to join Pizza Hut’s motion and to again reset the motion for hearing. The Court granted that *ex parte* motion, gave Ameranth leave to file a surreply and reset the motion for hearing. The motion came on for hearing on September 21, 2018. William Caldarelli appeared and argued for Ameranth and Frank Angileri appeared and

argued for Domino's. After thoroughly considering the parties' briefs and the record on file herein, and after hearing oral argument from counsel, the Court grants the motion.

I.

BACKGROUND

The '077 Patent is entitled, "Information Management and Synchronous Communications System with Menu Generation, and Handwriting and Voice Modification of Orders." As indicated in the specification, there are four principal objects of the invention described and claimed in the '077 Patent: To provide an improved information management and synchronous communications system that (1) "facilitates user-friendly and efficient generation of computerized menus for restaurants and other applications that utilize equipment with non-PC-standard graphical formats, display sizes and/or applications[.]" (2) "provides for entry, management and communication of information from the operator as well as to and from another computer, Web page menu, remote digital device using a standard hardwired connection, the internet or a wireless link[.]" (3) "is small, affordable and lightweight yet incorporates a user-friendly operator interface and displays menus in a readily comprehensible format[.]" and (4) "enables automatic updating of both wireless and internet menu systems when a new menu item is added, modified or deleted from any element of the system." ('077 Patent at 2:61-3:17.) There are eighteen claims in the '077 Patent, three independent and fifteen dependent. Claim 1 is representative, and provides:

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An information management and real time synchronous communications system for configuring and transmitting hospitality menus comprising:

- a. a central processing unit,
- b. a data storage device connected to said central processing unit,
- c. an operating system including a first graphical user interface,
- d. a master menu including at least menu categories, menu items and modifiers, wherein said master menu is capable of being stored on said data storage device pursuant to a master menu file structure and said master menu is capable of being configured for display to facilitate user operations in at least one window of said first graphical user interface as cascaded sets of linked graphical user interface screens, and
- e. menu configuration software enabled to generate a programmed handheld menu configuration from said master menu for wireless transmission to and programmed for display on a wireless handheld computing device, said programmed handheld menu configuration comprising at least menu categories, menu items and modifiers and wherein the menu configuration software is enabled to generate said programmed handheld menu configuration by utilizing parameters from the master menu file structure defining at least the menu

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categories, menu items and modifiers of the master menu such that at least the menu categories, menu items and modifiers comprising the programmed handheld menu configuration are synchronized in real time with analogous information comprising the master menu,

wherein the menu configuration software is further enabled to generate the programmed handheld menu configuration in conformity with a customized display layout unique to the wireless handheld computing device to facilitate user operations with and display of the programmed handheld menu configuration on the display screen of a handheld graphical user interface integral with the wireless handheld computing device, wherein said customized display layout is compatible with the displayable size of the handheld graphical user interface wherein the programmed handheld menu configuration is configured by the menu configuration software for display as programmed cascaded sets of linked graphical user interface screens appropriate for the customized display layout of the wireless handheld computing device, wherein said programmed cascaded linked graphical user interface screens for display of the handheld menu configuration are configured differently from the cascaded sets of linked graphical user interface screens for display of

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the master menu on said first graphical user interface, and

wherein the system is enabled for real time synchronous communications to and from the wireless handheld computing device utilizing the programmed handheld menu configuration including the capability of real time synchronous transmission of the programmed handheld menu configuration to the wireless handheld computing device and real time synchronous transmissions of selections made from the handheld menu configuration on the wireless handheld computing device, and

wherein the system is further enabled to automatically format the programmed handheld menu configuration for display as cascaded sets of linked graphical user interface screens appropriate for a customized display layout of at least two different wireless handheld computing device display sizes in the same connected system, and

wherein a cascaded set of linked graphical user interface screens for a wireless handheld computing device in the system includes a different number of user interface screens from at least one other wireless handheld computing device in the system.

(Id. at 15:56-16:61.)

The '077 Patent was filed on April 22, 2005, and is a continuation of United States Patent Number 6,982,733 (“the ‘733 Patent”), which in turn is a continuation-in-part of United States Patent Number 6,384,850 (“the ‘850 Patent”). United States Patent Number 6,871,325 (“the ‘325 Patent”) is also part of this patent family, and is a continuation of the ‘850 Patent. The specification of the ‘077 Patent is identical to that of the ‘733 Patent, and it is “largely the same as [the ‘850 and ‘325 Patents], containing two additional figures and some additional description.” *Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1234 n.1 (Fed. Cir. 2016).¹

These consolidated cases, when originally filed in 2011, alleged infringement of the ‘850 and ‘325 Patents only. The ‘733 and ‘077 Patents were added to the case in subsequent pleadings. In 2013, a majority of Defendants in these cases filed petitions with the Patent Trial and Appeal Board (“PTAB”) seeking review of the ‘850, ‘325 and ‘733 Patents under the Transitional Program for Covered Business Method (“CBM”) Patents. The PTAB instituted review on all three petitions, and it found certain claims of these three patents unpatentable under 35 U.S.C. § 101. On appeal, the Federal Circuit affirmed the PTAB’s determinations of unpatentability, and reversed the PTAB’s determinations that the other claims were patentable. *Id.* at 1245. Specifically, the Federal Circuit

¹ Exhibit A to the Declaration of Melissa Smith in support of Pizza Hut’s motion is a version of the ‘077 Patent that highlights those portions of the specification that were not included in the specification of the ‘850 Patent. (See ECF No. 1120-3.)

found all instituted claims of the ‘850, ‘325 and ‘733 Patents unpatentable under § 101. *Id.* In light of that decision, the ‘850, ‘325 and ‘733 Patents are no longer at issue here.

Various Defendants in these cases also twice petitioned the PTAB for CBM review of the ‘077 Patent. The first of those petitions was filed in 2014, and was denied. (*See* Decl. of John Osborne in Supp. of Opp’n to Mot. (“Osborne Decl.”), Ex. 9.) The second petition was filed in 2017, after the Supreme Court’s decision in *Alice Corp. Pty Ltd. v. CLS Bank Int’l*, ___ U.S. ___, 138 S.Ct. 2347 (2014), and the Federal Circuit’s decision in *Apple*. That petition was also denied. (*See* Osborne Decl., Ex. 5.)

II.

DISCUSSION

Domino’s moves for summary judgment that the ‘077 Patent is unpatentable under § 101. Specifically, Domino’s argues the claims of the ‘077 Patent are directed to an abstract idea, and the claim elements, considered individually and in combination, fail to transform that abstract idea into a patent-eligible invention.

Section 101 of the Patent Act provides, “Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.” 35 U.S.C. § 101. The Supreme Court has “long held that this provision contains an important implicit exception: Laws of

nature, natural phenomena, and abstract ideas are not patentable.” *Alice*, 134 S.Ct. at 2354 (quoting *Ass’n for Molecular Pathology v. Myriad Genetics, Inc.*, 569 U.S. ___, 133 S.Ct. 2107, 2116 (2013)). The reason for this exception is “pre-emption. [citation omitted] Laws of nature, natural phenomena, and abstract ideas are ‘the basic tools of scientific and technological work.’” *Id.* (quoting *Myriad*, 133 S.Ct. at 2116) (internal quotation marks omitted). “[M]onopolization of those tools through the grant of a patent might tend to impede innovation more than it would tend to promote it,’ thereby thwarting the primary object of the patent laws.” *Id.* (quoting *Mayo Collaborative Services v. Prometheus Labs., Inc.*, 566 U.S. ___, 132 S.Ct. 1289, 1293 (2012)). The Supreme Court has also stated, however, that courts must “tread carefully in construing this exclusionary principle lest it swallow all of patent law.” *Id.* (citing *Mayo*, 132 S.Ct. at 1293-94). As stated in *Alice*, courts “must distinguish between patents that claim the ‘buildin[g] block[s]’ of human ingenuity and those that integrate the building blocks into something more, thereby ‘transform[ing]’ them into a patent-eligible invention[.]” *Id.* (quoting *Mayo*, 132 S.Ct. at 1294, 1303).

The test for determining patent-eligibility is two-pronged. “First, we determine whether the claims at issue are directed to one of those patent-ineligible concepts.” *Id.* at 2355. This “‘directed to’ inquiry applies a stage-one filter to claims, considered in light of the specification, based on whether ‘their character as a whole is directed to excluded subject matter.’” *Enfish, LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335 (Fed. Cir. 2016) (quoting *Internet Patents Corp. v. Active Network*,

Inc., 790 F.3d 1343, 1346 (Fed. Cir. 2015)). At stage one, courts “look to whether the claims in the patent focus on a specific means or method, or are instead directed to a result or effect that itself is the abstract idea and merely invokes generic processes and machinery.” *Two-Way Media Ltd. v. Comcast Cable Communications, LLC*, 874 F.3d 1329, 1337 (Fed. Cir. 2017), *pet. for cert. filed*, (U.S. July 27, 2018) (No. 18-124), (citing *McRO, Inc. v. Bandai Namco Games Am., Inc.*, 837 F.3d 1299, 1314 (Fed. Cir. 2016)).

If the claims are directed to an abstract idea, courts then proceed to the second step, which asks “[w]hat else is there in the claims before us?” *Alice*, 132 S.Ct. at 2355 (quoting *Mayo*, 132 S.Ct. at 1296-97). “To answer that question, we consider the elements of each claim both individually and ‘as an ordered combination’ to determine whether the additional elements ‘transform the nature of the claim’ into a patent-eligible application.” *Id.* (quoting *Mayo*, 132 S.Ct. at 1298, 1297). The Supreme Court “described step two of this analysis as a search for an ‘inventive concept’—i.e., an element or combination of elements that is ‘sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.’” *Id.* (quoting *Mayo*, 132 S.Ct. at 1294) (quotation marks omitted).

“Patent eligibility under § 101 presents an issue of law that [the Federal Circuit] review[s] de novo.” *Accenture Global Servs., GmbH v. Guideware Software, Inc.*, 728 F.3d 1336, 1340-41 (Fed. Cir. 2013) (citing *Bancorp Servs., LLC v. SunLife Assurance Co. of Can.*, 687 F.3d 1266, 1273 (Fed. Cir. 2012)). “This legal

conclusion may contain underlying factual issues.” *Id.* at 1341 (citing *Ultramercial, Inc. v. Hulu, LLC*, 722 F.3d 1335, 1339 (Fed. Cir. 2013)). However, “it is also possible, as numerous cases have recognized, that a § 101 analysis may sometimes be undertaken without resolving factual issues.” *Mortgage Grader, Inc. v. First Choice Loan Servs., Inc.*, 811 F.3d 1314, 1325 (Fed. Cir. 2016). In that circumstance, “the § 101 inquiry may appropriately be resolved on a motion for summary judgment.” *Id.*

A. Step One - Abstract Idea

“The ‘abstract ideas’ category embodies ‘the longstanding rule that [a]n idea of itself is not patentable.’” *Alice*, 134 S.Ct. at 2355 (quoting *Gottschalk v. Benson*, 409 U.S. 63, 67 (1972)). The Federal Circuit has recognized that “[i]nformation as such is an intangible’ and that collecting, analyzing, and displaying that information, without more, is an abstract idea.” *Interval Licensing LLC v. AOL, Inc.*, 896 F.3d 1335, 1344 (Fed. Cir. 2018) (citing *Elec. Power Grp., LLC v. Alstom*, 830 F.3d 1350, 1353-54 (Fed. Cir. 2016)). See also *Intellectual Ventures I LLC v. Capital One Financial Corp.* (“*Intellectual Ventures IIP*”), 850 F.3d 1332, 1340 (Fed. Cir. 2017) (stating collecting, displaying and manipulating data is abstract idea). It has also stated, “[t]he category of abstract ideas embraces ‘fundamental economic practice[s] long prevalent in our system of commerce,’ including ‘longstanding commercial practice[s]’ and ‘methods of organizing human activity[.]’” *Intellectual Ventures I LLC v. Symantec Corp.*, 838 F.3d 1307, 1313 (Fed. Cir. 2016) (quoting *Alice*, 134 S.Ct. at 2356). This is so even

if the practices or methods are “performed on a computer[,]” *Enfish*, 822 F.3d at 1334, or are limited “to a particular field of use or technological environment, such as the Internet.” *Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1366 (Fed. Cir. 2015). At *Alice* step one, the key consideration is “whether the claims ... focus on a specific means or method that improves the relevant technology or are instead directed to a result or effect that itself is the abstract idea and merely invoke generic processes and machinery.” *Smart Systems Innovations, LLC v. Chicago Transit Authority*, 873 F.3d 1364, 1371 (Fed. Cir. 2017) (quoting *McRO*, 837 F.3d at 1313). “The Federal Circuit has recognized that this process sometimes involves ‘close calls about how to characterize what the claims are directed to.’” *Local Intelligence, LLC v. HTC America, Inc.*, No. 5:17-cv-06437-EJD, 2018 WL 1697127, at *4 (N.D. Cal. Apr. 6, 2018) (quoting *BASCOM Glob. Internet Servs., Inc. v. AT&T Mobility LLC*, 827 F.3d 1341, 1348 (Fed. Cir. 2016)). It has also “acknowledged that ‘precision has been elusive in defining an all-purpose boundary between the abstract and the concrete.’” *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1258 (Fed. Cir. 2016), *cert. denied*, ___ U.S. ___, 137 S.Ct. 1596 (2017), (quoting *Internet Patents*, 790 F.3d at 1345).

Here, the parties dispute what the claims of the ‘077 Patent are directed to. Domino’s argues the claims are directed to the abstract idea of configuring and transmitting menu information. Ameranth is less clear in what the claims are directed to. In its initial opposition to the motion, it asserted “[t]he invention

was, inter alia, in the software which configured the hardware to perform the inventive functions[.]” and that the claims were “directed to specific implementations of ‘master menus’ whereby they are, inter alia, used to configure ‘programmed handheld menu configurations’ (‘PHMC’) by using the master menu ‘file structure’ and are synchronized with the handheld PHMC.” (Opp’n at 11.) In the supplemental opposition, Ameranth has retreated from its position that the invention is in the software, and is now explaining the claims by reference to the problem allegedly being solved, which Ameranth describes as “the challenges of synchronizing and automatically reformatting hospitality information contained in a master menu/master database with different wireless handheld devices with varying display screen sizes and characteristics[.]” (Supp. Opp’n at 2-3.) This reference to the problem, however, is not a complete or concise explanation of what the claims are directed to. On their face, the claims are directed to a system for (1) configuring and transmitting hospitality information from a master menu/database to wireless handheld devices with different display screen sizes and (2) enabling real-time synchronous communications and formatting between the wireless handheld devices and the master database.

In *Apple*, the Federal Circuit found the claims of the ‘850, ‘325 and ‘733 Patents were directed to an abstract idea. 842 F.3d at 1241. The claims there were directed to “systems including menus with particular features.” *Id.* Here, the claims include additional limitations, namely, wireless handheld devices with different display screen sizes, and enabling real-time

synchronous communications and formatting between the devices in the system. However, none of those limitations fills the void set out by the Federal Circuit in *Apple*. In other words, despite the additional limitations, the claims here, like those in the related patents, “do not claim a particular way of programming or designing the software to create menus that have these features, but instead merely claim the resulting systems.” *Id.*

Ameranth attempts to avoid this result by relying on the two PTAB decisions denying the requests to institute CBM review of the ‘077 Patent. The first of those decisions, however, was issued before the Federal Circuit’s decision in *Apple*. That decision also relies on *Ultramercial*, 722 F.3d 1335, which was subsequently vacated by the Supreme Court.² (*See* Osborne Decl., Ex. 9 at 34.) And the second decision does little more than explain why the first decision was correct. (*See* Osborne Decl., Ex. 5.) This Court is not particularly persuaded by the reasoning of those decisions, and in any event, those decisions are not binding on this Court.

Ameranth also relies on three cases: *Core Wireless Licensing S.A.R.L. v. LG-Electronics, Inc.*, 880 F.3d 1356 (Fed. Cir. 2018), *Visual Memory LLC v. NVIDIA Corp.*, 867 F.3d 1253, 1258 (Fed. Cir. 2017), and *Local Intelligence*, 2018 WL 1697127. But each of those cases is distinguishable.

² In a revised decision, the Federal Circuit found the claims in *Ultramercial* were “patent-ineligible under § 101.” *Credit Acceptance Corp. v. Westlake Servs.*, 859 F.3d 1044, 1048 (Fed. Cir. 2017).

In *Core Wireless* and *Local Intelligence*, the patents at issue “disclose[d] improved display interfaces, particularly for electronic devices with small screens like mobile telephones.” 880 F.3d at 1359. *See also Local Intelligence*, 2018 WL 1697127, at *8 (finding claims at issue indistinguishable from claims at issue in *Core Wireless*). Similarly, in *Visual Memory*, the asserted claims were “directed to a technological improvement: an enhanced computer memory system.” 867 F.3d at 1259. In essence, the claims in both cases were “directed to a specific improvement in the capabilities of computing devices[.]” *Core Wireless*, 880 F.3d at 1361-62.

Unlike the claims in those cases, the claims of the ‘077 Patent are not directed to improving the capabilities of any particular computing device. Rather, the ‘077 Patent is directed to “computerization” of “paper-based ordering, waitlist and reservations management ... in the hospitality industry.” (‘077 Patent at 2:45-57.”) (*See also* Rep. Tr. (Draft) at 4, Sept. 21, 2018 (describing problem being solved as “taking the large-scale paper menus that we have all seen and trying to get them down into a blackberry screen in a way that was usable and readable.”)) And the claims themselves are directed to the resulting system wherein hospitality information is configured and transmitted to wireless devices with different display screen sizes, and those devices are able to engage in real-time synchronous communication with other devices in the system. Like the claims of the ‘850, 325 and ‘733 Patents, which the Federal Circuit found to be patent-ineligible, the claims of the ‘077 Patent:

do not claim a particular way of programming or designing the software to create menus that have [the claimed] features, but instead merely claim the resulting systems. [citation omitted] Essentially, the claims are directed to certain functionality—here, the ability to generate menus with certain features. Alternatively, the claims are not directed to a specific improvement in the way computers operate.

Apple, 842 F.3d at 1241 (citation omitted). To be sure, the claims of the ‘077 Patent include functionality in addition to the generation and transmission of menus, but the inclusion of additional steps does not change the nature of the underlying invention, which is “directed to an abstract idea.” *Id.* See also *Interval Licensing*, 896 F.3d at 1344-45 (finding claims “directed to an abstract idea because they consist of generic and conventional information acquisition and organization steps that are connected to, but do not convert, the abstract idea—displaying a second set of data without interfering with a first set of data—into a particular conception of how to carry out that concept.”); *Uniloc USA, Inc. v. HTC America, Inc.*, No. C17-1558JLR, 2018 WL 30008870, at *7 (W.D. Wash. June 15, 2018), *appeal docketed*, No. 18-2185 (Fed. Cir. July 23, 2018), (finding claims directed to abstract idea where they were “directed to a result, not a specific means or method” and were “not technological improvements[.]”) Thus, the Court proceeds to step two of the § 101 inquiry.

B. Step Two - Inventive Concept

The second step of the § 101 inquiry “is the search for an inventive concept, which is something sufficient to ensure that the claim amounts to significantly more than the abstract idea itself.” *Secured Mail Solutions LLC v. Universal Wilde, Inc.*, 873 F.3d 905, 911 (Fed. Cir. 2017), *cert. denied*, ___ U.S. ___, 138 S.Ct. 2000 (May 14, 2018), (citing *Content Extraction & Transmission LLC v. Wells Fargo Bank*, 776 F.3d 1343, 1347 (Fed. Cir. 2014)). Here, “we look with more specificity at what the claim elements add, in order to determine whether they identify an inventive concept in the application of the ineligible subject matter to which the claim is directed.” *Intellectual Ventures III*, 850 F.3d at 1338 (quoting *Affinity Labs*, 838 F.3d at 1258). “To save a patent at step two, an inventive concept must be evident in the claims.” *Two-Way*, 874 F.3d at 1338 (citing *RecogniCorp, LLC v. Nintendo Co.*, 855 F.3d 1322, 1327 (Fed. Cir. 2017)).

Here, claim 1 sets out a number of elements in the patented system, including: (1) Computer hardware (“a central processing unit[,]” etc.), (2) computer software (“an operating system[,]” “menu configuration software”), (3) “real-time synchronous communication” to and from the wireless handheld computing devices, and (4) “automatically format[ting] the programmed handheld menu configuration” for “at least two different wireless handheld computing device display sizes[.]”³ Domino’s goes through these elements

³ These elements are essentially the same as those set out in the other independent claims, 9 and 13.

individually and in combination, and explains why they do not transform the abstract idea discussed above into an inventive concept.

As to the hardware elements, Domino's asserts those elements are typical and conventional, and Ameranth does not dispute that assertion.

As to the software elements, Domino's argues those are "commonly known." Ameranth does not dispute that argument either, nor could it in light of the specification. (See '077 Patent at 12:57-61 ("The software applications for performing the functions falling within the described invention can be written in any commonly used computer language. The discrete programming steps are commonly known and thus programming details are not necessary to a full description of the invention."))

On the element of synchronization, Domino's contends that was "insignificant post-solution activity," as found by the Federal Circuit in *Apple*. 842 F.3d at 1242. Ameranth does not dispute this argument, but instead argues the synchronization element was "non-conventional." (See Supp. Opp'n at 18-23.) Ameranth's argument, however, fails to acknowledge the Federal Circuit's decision in *Apple*, much less refute the court's statement that "[t]he invention merely claims the addition of conventional computer components to well-known business practices." 842 F.3d at 1242. Ameranth's argument also fails to address the specification, which describes one of the benefits of the Windows CE® operating system as "built-in synchronization between handheld devices, internet and desktop infrastructure[.]" ('077 Patent at 12:14-17.)

Domino's did not address the concept of "real-time" separately from the concept of "synchronization," but that element, too, fails to demonstrate an inventive concept. As stated by this Court in a previous case, "[r]eal-time execution is essentially adding a 'but faster' step to the claim." *Clarilogic, Inc. v. Formfree Holdings Corp.*, No. 15-cv-41 DMS (NLS), 2016 WL 3247890, at *2 (S.D. Cal. Mar. 4, 2016). And the simple inclusion of a "real-time" feature through the use of "entirely conventional, generic technology[,]" which is what the claims of the '077 Patent recite, does not provide an inventive concept. *Elec. Power Grp.*, 830 F.3d at 1356. *See also Two-Way Media*, 874 F.3d at 1340-41 (finding no inventive concept in claim requiring "receiving and transmitting a real-time media stream" through "anything other than conventional computer and network components according to their ordinary functions.")

The only other two elements set out in the claims are the automatic formatting of the programmed handheld menu configuration for display as cascaded sets of linked graphical user interface screens, and the requirement that the system include "a different number of user interface screens from at least one other wireless handheld computing device in the system." On these two elements, Domino's again says they were "commonplace," and Ameranth again does not dispute that assertion. Instead, it reverts to its unconventionality argument. That argument, however, is little more than *ipse dixit*. And automatically formatting the programmed handheld menu configuration in a particular way and for more than one handheld device adds little, if anything, to the

invention beyond the concept of synchronization discussed above. That Ameranth has described the concept in different terms does not make it any more inventive. *See Intellectual Ventures III*, 850 F.3d at 1342 (“The mere fact that the inventor applied coined labels to conventional structures does not make the underlying concept inventive.”)

As with the related patents, there is nothing in these elements, either individually or in combination that “transform[s] the claimed abstract idea into a patent-eligible application of the abstract idea.” *Apple*, 842 F.3d at 1242. Accordingly, the asserted claims of the ‘077 Patent are unpatentable under § 101.

III.

CONCLUSION

For these reasons, the Court grants Domino’s motion for summary judgment of unpatentability, and vacates all dates currently set in these cases. The parties shall meet and confer on the form of judgment, *i.e.*, whether judgment should be entered in the lead case on all claims or whether judgment should be entered in each individual case, and submit either a joint proposed judgment/judgments or a joint status report on or before **October 2, 2018**.

IT IS SO ORDERED.

DATED: September 25, 2018

/s/Dana M. Sabraw
HON. DANA M. SABRAW
United States District Judge

APPENDIX C

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

Lead Case No. 11cv1810 DMS (WVG)

[Filed July 27, 2018]

IN RE: AMERANTH PATENT)
LITIGATION)
)
)

**JOINT PRE-TRIAL ORDER
[LOCAL RULE 16.1.f.6]**

[AMERANTH DOMINO'S]

Plaintiff, Ameranth, Inc. (“Ameranth”) and defendants Domino’s Pizza, LLC and Domino’s Pizza, Inc. (“Domino’s”) hereby submit this Joint Pre-Trial Order pursuant to Local Rule 16.1.f.6 and the Court’s December 14, 2017 Case Management Conference Order (Dkt. No. 898).

1. Statement of the Case to be Read to Jury

See Exhibit 1.

2. List of Causes of Action to be Tried

See Exhibit 2.

3. Witness Lists

a. Ameranth's lists of fact witnesses expected to be called, expert witnesses expected to be called, and additional witnesses for which the right to call is reserved, is attached as **Exhibit 3**.

a. Domino's lists of fact witnesses expected to be called, expert witnesses expected to be called, and additional witnesses for which the right to call is reserved, is attached as **Exhibit 4**.

4. Exhibit Lists

a. Ameranth's lists of exhibits expected to be offered at trial, and exhibits for which the right to offer at trial is reserved, is attached as **Exhibit 5**.

b. Domino's lists of exhibits expected to be offered at trial, and exhibits for which the right to offer at trial is reserved, is attached as **Exhibit 6**.

5. Statement of Stipulated Facts

See Exhibit 7.

6. Deposition Transcript Excerpts to be Offered at Trial in Lieu of Live Testimony

a. Ameranth's list of deposition excerpts to be offered at trial in lieu of live testimony is attached as **Exhibit 8**.

b. Domino's list of deposition excerpts to be offered at trial in lieu of live testimony is attached as **Exhibit 9**.

7. Jury Instructions, Verdict Forms, Voir Dire Questions

The parties will submit proposed jury instructions, verdict forms and *voir dire* questions to the Court as provided in Local Rule 16.1.f.9.b.

8. Jury Trial/ Issues to be Determined by the Court

The case shall be tried by jury. However, questions of patentability under 35 U.S.C. § 101, and whether a case is exceptional are questions of law to be determined by the Court. Ameranth also contends that questions of indefiniteness are to be determined by the Court. Domino's contends that factual issues of indefiniteness are to be submitted to the jury. Likewise, any award of pre-judgment or post-judgment interest is to be determined by the Court.

9. Time Estimate for Trial

The parties will each present its case in 15 to 20 hours.

Dated: July 27, 2018

CALDARELLI HEJMANOWSKI & PAGE
LLP

By: /s/ William J. Caldarelli

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LLC and DOMINO'S PIZZA, INC.*

* * *

*[Certificate of Service Omitted in the
Printing of this Appendix]*

EXHIBIT 1

JOINT STATEMENT OF THE CASE

This is an action for patent infringement.

The parties in this case are plaintiff Ameranth, Inc. (“Ameranth”), and defendants Domino’s Pizza, LLC and Domino’s Pizza, Inc. (“Domino’s”).

The plaintiff in this case is Ameranth, Inc. Ameranth asserts that it is the owner of United States Patent No. 8,146,077—which you will hear referred to as “the ’077 Patent.” Domino’s contests that assertion.

Ameranth filed suit in this court seeking money damages from defendant Domino’s for allegedly infringing the ’077 Patent by using, selling, and/or offering for sale a system that Ameranth contends practices claims 1, 6, 9, 13 and 17 of the ’077 Patent. Ameranth also contends that Domino’s has actively induced and contributed to infringement to these claims of the ’077 Patent by others.

Domino’s is a pizza company that supports franchise pizza delivery restaurants. Domino’s operates an electronic ordering system through which consumers all over the country can, among other things, view the menu for their local Domino’s store and place orders for pizza or other food items, for delivery or carry-out.

Ameranth contends that Domino’s online ordering system, together with Domino’s mobile applications operating on user mobile devices, infringes Ameranth’s ’077 Patent. Domino’s disputes Ameranth’s contentions

and its claim for damages. Domino's contends that its systems do not infringe Ameranth's patent because they are fundamentally different from the claims of the '077 Patent.

Domino's also asserts that the '077 Patent is invalid because: (1) the claims of the '077 Patent not meet the requirements of patentability, (2) Ameranth put the invention on sale more than one-year prior to filing for the patent, and (3) because the technology was already known, or was obvious, at the time of the alleged invention. Ameranth disputes these assertions and contends that the '077 Patent is valid and enforceable.

EXHIBIT 2

CAUSES OF ACTION TO BE TRIED¹

A. Direct Infringement of the '077 Patent.

Whether Ameranth has proven by a preponderance of the evidence that Domino's directly infringes any of the Asserted Claims (1, 6, 9, 13 and 17) of the '077 Patent, either literally or under the doctrine of equivalents.

1. Elements of Direct Infringement.

- a. A defendant literally infringes an Asserted Claim if it makes, uses, offers to sell, or sells an accused product, as each of those terms are defined by the Court, that includes/practices every limitation of the Asserted Claim.
- b. The fact that an accused product may have additional features not included in the patent claim will not avoid infringement, so long as the requirements of direct infringement are satisfied.

A defendant infringes an Asserted Claim under the doctrine of equivalents if it makes, uses, offers to sell, or sells a system that includes parts that are identical or equivalent to each limitation of the Asserted Claim. A part is equivalent to a limitation of

¹ The statements herein are not binding on the parties' jury instruction positions.

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an Asserted Claim if a person of ordinary skill in the field would think the differences between the claim limitation and the corresponding aspect of an Accused Product are insubstantial. One way to determine this is to look at whether the corresponding aspect of the Accused Product performs substantially the same function, in substantially the same way, to achieve substantially the same result as the limitation in the claimed invention.

The application of the Doctrine of Equivalents can be limited by events occurring during patent prosecution, by claim amendment, or by the prior art, as provided by law.

2. Damages for Direct Infringement

A patent holder should be awarded a reasonable royalty if a valid claim of a patent is infringed. A reasonable royalty is the payment for a license that would have resulted from a hypothetical negotiation between the patent holder and the alleged infringer taking place at the time the first infringing activity began.

3. Defenses to Direct Infringement

- a. There can be no direct infringement of an Asserted Claim if a patent holder fails to prove that defendant makes, uses, offers to sell, or sells a system that practices every element that Asserted Claim.

- b. There can be no infringement of a patent claim that a defendant proves by clear and convincing evidence is invalid as anticipated or obvious or invalid for indefiniteness.

B. Indirect Infringement

1. Contributory Infringement of the '077 Patent.

Whether Ameranth has proven by a preponderance of the evidence that Domino's contributorily infringes any of the Asserted Claims (1, 6, 9, 13 and 17) of the 077 Patent?

a. Elements of the Claim.

To show contributory infringement, a patent holder must prove:

1. Another person or entity directly infringes a claim of the patent.
2. The defendant offers for sale or sells an important component of the infringing product or system.
3. The component offered for sale or sold by defendant is not a common component suitable for non-infringing use, but rather, is especially made or adapted for a use that infringes the claimed invention.
4. The defendant offers for sale or sells the component with knowledge of the patent and knowledge that the component is

especially made or adapted for use in a manner that infringes the patent.

b. Damages for Contributory Infringement.

A patent holder should be awarded a reasonable royalty for infringing use of claim of a patent. The amount of damages for contributory infringement is limited by the number of instances of direct infringement by a product or system to which the defendant substantially contributed.

c. Defenses to Contributory Infringement

1. There can be no contributory infringement if patent holder fails to establish that there is any direct infringer (i.e., a user that makes, uses, offers to sell, or sells a system that practices every element of an Asserted Claim).
2. There can be no contributory infringement if a patent holder fails to identify a part that is sold and especially adapted or made for a use that infringes.
3. There can be no contributory infringement if a patent holder fails to show knowledge that the part was especially made “for a use that infringes the claimed invention.”

2. Inducing Infringement of the '077 Patent.

Whether Ameranth has proven by a preponderance of the evidence that Domino's

induces infringement any of the Asserted Claims (1, 6, 9, 13 and 17) of the '077 Patent?

a. Elements of the Claim.

To show inducing infringement, a patent holder must prove:

1. Another person or entity directly infringes a claim of the patent.
2. The defendant either: (a) intentionally took action during the time the patent claim was in force intending to cause the infringing acts by the alleged direct infringer or (b) the defendant was aware of the patent and knew that the acts, if taken, would constitute infringement of that patent; or (c) the defendant believed there was a high probability that the acts by the alleged direct infringer infringed the '077 Patent, and the defendant took deliberate steps to avoid learning of that infringement.

b. Damages for Inducing Infringement.

A patent holder should be awarded a reasonable royalty for infringing use of claim of a patent. The amount of damages for inducing infringement is limited by the number of instances of direct infringement by a product or system that induced.

c. Defenses to Inducing Infringement of the '077 Patent

1. There can be no induced infringement if patent holder fails to establish that there is any direct infringer (*i.e.*, a user that makes, uses, offers to sell, or sells a system that practices every element of an Asserted Claim)
2. If the defendant was aware of the patent but reasonably believed that the acts in question did not infringe the patent, then the defendant cannot be liable for induced infringement.

C. Invalidity by Anticipation

Whether Domino's has proven by clear and convincing evidence that any of the Asserted Claims of the '077 Patent are invalid on the grounds of anticipation under 35 U.S.C. § 102.

1. Elements of Anticipation

- a. To anticipate a claim, each and every limitation in the claim must be present in a single item of prior art, either stated expressly or inherently, so that someone of ordinary skill in the art to which the claimed invention pertains, looking at that one reference, could make and use the claimed invention.

D. Invalidity by Obviousness

Whether Domino's has proven by clear and convincing evidence that any of the Asserted Claims of the '077 Patent is invalid as obvious under 35 U.S.C. § 103.

1. Elements of Obviousness

- a. A patent claim is invalid for obviousness if the claimed invention, as a whole, would have been obvious to a person of ordinary skill in the field of the invention at the time the invention was made, taking into account additional considerations, if any, indicating that the invention was not obvious, including, *inter alia*, evidence of secondary factors indicating non-obviousness.

E. Invalidity by Indefiniteness (35 U.S.C. § 112)

Whether Domino's has proven by clear and convincing evidence that any of the Asserted Claims of the '077 Patent are invalid as indefinite under 35 U.S.C. § 112.

1. Elements of Indefiniteness

A claim term is indefinite if it leaves the skilled artisan to consult the unpredictable vagaries of any one person's opinion or if the claims, read in light of the disclosure, fail to inform those skilled in the art about the scope of the invention with reasonable certainty.

F. Invalidity by Lack of Patentable Subject Matter (35 U.S.C. § 101)

Whether Domino's has proven by clear and convincing evidence that any of the Asserted Claims of the '077 Patent is invalid as directed to unpatentable subject matter under 35 U.S.C. § 101.

1. Elements of Non-Patentable Subject Matter

An inventor is not entitled to a patent on laws of nature, natural phenomena, or abstract ideas. Determining whether the patent claims are directed to such patent-ineligible subject matter involves two steps.

First, there must be a determination as to whether the claims at issue are directed to a patent-ineligible concept, such as an abstract idea. If not, the inquiry stops there.

If they are directed to a patent-ineligible concept, the elements of each asserted claim must be considered both individually and as an ordered combination to determine whether the claims contain an "inventive concept," meaning the claims contain limitation(s) that transform the nature of the claim into a patent-eligible application of the abstract idea.

Well-understood, routine, or conventional activities previously known to the industry do not provide an "inventive concept."

G. Exceptional Case

Whether this is an exceptional case under 35 U.S.C. § 285 for which either Ameranth or Domino's is entitled to attorneys' fees.

1. Elements of Exceptional Case

- a. Prevailing party
- b. Must consider the totality of the circumstances and determine whether the case "stands out," by a preponderance of the evidence, with respect to the strength of the party's position or the unreasonable manner of litigating.

EXHIBIT 11

STATEMENT OF STIPULATED FACTS

1. Ameranth, Inc. (“Ameranth”) is a Delaware corporation having a principal place of business in San Diego, California.

2. Domino’s Pizza, Inc. is a Delaware corporation having a principal place of business in Ann Arbor, MI.

3. Domino’s Pizza, LLC is a Michigan limited liability company having a principal place of business in Ann Arbor, MI.

4. The patent at issue, U.S. Patent No. 8,146,077 (“the ’077 Patent”), is titled “Information Management and Synchronous Communications System with Menu Generation, and Handwriting and Voice Modification of Orders.”

5. The ’077 Patent expires on September 21, 2019.

6. The named inventors of the ’077 Patent are Keith McNally, William Roof, and Richard Bergfeld.

7. The named assignee of the ’077 Patent, as listed on the patent, is Ameranth, Inc.

8. On March 27, 2012, Ameranth sued Domino’s for infringement of the ’077 Patent, immediately after issuance of the patent.

9. Ameranth asserts independent claims 1, 9, and 13, and dependent claims 6 and 17 of the ’077 Patent against Domino’s.

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10. Ameranth seeks a “reasonable royalty” as damages. Ameranth does not seek any “lost profits” or other damages.

APPENDIX D

**UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF CALIFORNIA**

CASE NO. 11cv1810 DMS (WVG)

[Filed October 10, 2013]

IN RE: AMERANTH PATENT)
LITIGATION CASES,)
)
)

**ORDER (1) RESOLVING PARTIES' JOINT
MOTION FOR DISCOVERY DISPUTE,
(2) RESOLVING PARTIES' JOINT MOTION
REGARDING SERVICE OF AMENDED
INFRINGEMENT CONTENTIONS AND
(3) RESETTING DATES**

[Docket Nos. 450, 455]

This case comes before the Court on the parties' (1) Joint Motion for Determination of Discovery Dispute [Docket No. 450] and (2) Joint Motion Regarding Service of Amended Infringement Contentions [Docket No. 455].

The first motion concerns Defendant QuikOrder's responses to Plaintiff's interrogatories regarding source code organization. Plaintiff served similar interrogatories on other Defendants, and thus the Court gave those parties an opportunity to file briefs on

the issue, which some Defendants have done. The Court also gave Plaintiff an opportunity to file a reply, which it has done.

The subject interrogatories ask Defendants to identify by name, purpose and location certain “projects” within Defendants’ source codes that correspond to the accused systems. Defendants objected to the interrogatories on several grounds, and rely on Federal Rule of Civil Procedure 33(d) in response. Specifically, they assert the answers to Plaintiff’s interrogatories may be found in their respective source codes. The primary issue before the Court is whether Defendants’ reliance on that Rule is sufficient or further responses are necessary.

Federal Rule of Civil Procedure 33(d) states:

If the answer to an interrogatory may be determined by examining, auditing, compiling, abstracting, or summarizing a party’s business records (including electronically stored information), and if the burden of deriving or ascertaining the answer will be substantially the same for either party, the responding party may answer by:

- (1) specifying the records that must be reviewed, in sufficient detail to enable the interrogating party to locate and identify them as readily as the responding party could; and
- (2) giving the interrogating party a reasonable opportunity to examine and audit the records and to make copies, compilations, abstracts, or summaries.

Fed. R. Civ. P. 33(d). “A requesting party claiming an inappropriate use of Rule 33(d) must ‘make a prima facie showing that the use of Rule 33(d) is somehow inadequate, whether because the information is not fully contained in the documents or because it is too difficult to extract.’” *RSI Corp. v. Int’l Business Machines Corp.*, No. 5:08-cv-3414 RMW, 2012 WL 3095396, at *1 (N.D. Cal. July 30, 2012) (quoting 7 J. Moore, *Moore’s Federal Practice* § 33.105 (3d ed. 2012)). If the requesting party meets that showing, “[t]he burden then shifts to the producing party to show that: (1) a review of the documents will actually reveal answers to the interrogatories; and (2) the burden of deriving the answer is substantially the same for the party serving the interrogatory as for the party served.” *Id.* (citing 7 Moore’s).

Here, Plaintiff does not argue the information it seeks is not contained in Defendant’s source codes. Rather, it argues it will incur a “substantial burden” if it is forced to review those source codes to discover the requested information. However, “discovery by its very nature is burdensome, and that especially holds true in patent cases.” *Digital Reg of Texas, LLC v. Adobe Systems Inc.*, No. CV 12-01971-CW (KAW), 2013 WL 3361241, at *6 (N.D. Cal. July 3, 2013). That the task of discovering the requested information is burdensome does not mean it is too difficult for Plaintiff to perform. Accordingly, the Court denies Plaintiff’s motion to compel QuikOrder, and any other Defendants to which similar interrogatories were sent, to provide further responses to its interrogatories.

With respect to the second motion, pursuant to a July 26, 2013 Order issued by Magistrate Judge Stormes, Plaintiff was to amend its preliminary infringement contentions in four respects: (1) to provide more specifics with respect to the doctrine of equivalents, (2) to provide facts supporting its theory of contributory infringement, (3) to state how the previous versions of Defendants' accused systems are the same or reasonably similar to the charted version or provide a separate chart for each accused version and (4) to identify with specificity where in the accused system the alleged infringement occurs and how the claim elements are met. In that Order, Magistrate Judge Stormes also ordered the parties to meet and confer regarding (1) a schedule for the service of the amended infringement contentions and (2) whether Plaintiff should amend its infringement contentions as to Defendants other than OpenTable, Wanderspot and Best Western.

In response to that Order, the parties filed the Joint Motion Regarding Service of Amended Infringement Contentions. In the Joint Motion, Plaintiff stated it could not meet the requirement set out in number (4) above without first reviewing Defendants' source codes. It also argued that it should only have to amend its infringement contentions as to OpenTable, Wanderspot and Best Western. Defendants disputed their source codes were necessary for Plaintiff to comply with requirement number (4). They also asserted Plaintiff should amend its infringement contentions as to all Defendants, not just the three identified above.

After the parties filed the Joint Motion, the case was reassigned to the undersigned Judge. Pursuant to a September 13, 2013 Order, the Court gave Defendants who had not yet had an opportunity to be heard on the Joint Motion an opportunity to file a brief on the issues, and gave Plaintiff an opportunity to file a response. Defendants Starbucks, Apple, Eventbrite, Ticketfly and Ticketbiscuit each filed a separate brief in which they argue they should not have to produce their source codes for Plaintiff to amend its infringement contentions. Plaintiff filed a consolidated response.

After reviewing Magistrate Judge Stormes's order, the parties' briefs, the record in this case and the relevant authority, the Court agrees with Plaintiff that Defendants should provide their source codes prior to Plaintiff amending its infringement contentions. Some Defendants (OpenTable, Papa John's, GrubHub, Domino's, O-Web, Seamless, Pizza Hut and QuikOrder) have already done so. Thus, Plaintiff can amend its infringement contentions as to these Defendants right away. As to the other Defendants, the Court orders as follows:

1. The other Defendants shall produce their respective source codes to Plaintiff as follows:
 - a. Wanderspot and the Hotel Companies shall provide their source codes on or before **October 25, 2013**.
 - b. The Travel Aggregators shall provide their source codes on or before **November 8, 2013**.

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- c. The Ticketing Companies shall provide their source codes on or before **November 22, 2013**.
 - d. The POS Companies shall provide their source codes on or before **December 6, 2013**.
 - e. All other Defendants, including Starbucks, Eventbrite, Ticketfly, Ticketbiscuit and Apple, shall provide their source codes on or before **December 20, 2013**.
2. Plaintiff shall provide its amended, or initial, infringement contentions as follows:¹
- a. For the Pizza Companies and Providers, on or before **October 25, 2013**.
 - b. For the Food Ordering Companies, on or before **November 8, 2013**.
 - c. For the Reservations Companies, on or before **November 22, 2013**.
 - d. For the Hotel Companies, on or before **December 6, 2013**.
 - e. For the Travel Aggregators, on or before on or before **December 20, 2013**.
 - f. For the Ticketing Companies, on or before **January 3, 2014**.

¹ The following list includes all Defendants, to the extent they believe Plaintiff's infringement contentions are inadequate. If any Defendant is satisfied with Plaintiff's infringement contentions, Plaintiff need not amend its contentions as to those Defendants.

- g. For the POS Companies, on or before **January 17, 2014**.
- h. For all other Defendants listed in 1.e. above, on or before **January 31, 2014**.

Plaintiff is directed to select no more than five (5) claims from each patent to assert against all Defendants for a maximum of twenty (20) claims. Plaintiff may assert additional claims at this time only with leave of Court. Plaintiff's amended infringement contentions shall consist of one representative version of each Defendant's accused system for the five selected claims of each patent asserted against that Defendant.² If Plaintiff asserts indirect infringement (contributory or inducement) by a Defendant, Plaintiff shall provide as part of its infringement contentions an example of how the Defendant indirectly infringes, including the identity of the direct infringer and factual basis for the Defendant's intent.

3. Plaintiff may provide infringement contentions for additional accused systems or versions following the issuance of the claim construction order as provided in Patent L.R. 3.6(a).

4. No later than **March 31, 2014**, Defendants shall serve invalidity contentions pursuant to Patent L.R. 3.3 and produce documents as required by Patent L.R. 3.4. Defendants shall jointly provide a list of prior art they contend individually or in combination invalidates the patents at issue. Defendants shall jointly serve one set of initial invalidity contentions on Plaintiff in

² This limitation moots requirement (3) of Judge Stormes's order.

accordance with the format set forth in the local rules. The contentions shall be directed at the claims Plaintiff selects for its infringement contentions. Defendants' production of information pursuant to Local Rule 3.4(a), setting forth the technical specifications and other information for their accused system is limited to the system identified in Plaintiff's initial infringement contentions. Defendants' contentions shall include all, if any, prior art they contend invalidates a claim based on anticipation. Defendants shall include no more than five separate prior art combinations they contend invalidate based on obviousness. For the latter purpose, Defendants may assert additional prior art references or combinations at this time only with leave of Court.

5. Defendants may assert additional invalidity contentions following issuance of the claim construction order as provided in Patent L.R. 3.6(b).

6. Counsel for all parties shall meet and confer and select no more than ten (10) claim terms or phrases from each patent for construction.

7. On or before **April 21, 2014**, the parties shall exchange preliminary claim constructions pursuant to Patent L.R. 4.1(a) and identify extrinsic evidence as required by Patent L.R. 4.1(b). On or before **May 12, 2014**, the parties shall exchange responsive claim constructions pursuant to Patent L.R. 4.1(c) and identify extrinsic evidence as required by Patent L.R. 4.1(d). In the interests of efficiency and reducing the cost of litigation, Defendants are encouraged to provide an omnibus preliminary claim construction and an omnibus response to Plaintiff.

8. On or before **July 7, 2014**, the parties shall complete and file a joint claim construction chart, joint claim construction worksheet, and joint hearing statement pursuant to Patent L.R. 4.2.

9. All discovery intended for use in the claim construction hearing must be completed no later than **August 18, 2014**. See Patent L.R. 4.3.

10. Defendants shall file one omnibus claim construction brief and response. To the extent any Defendant wishes to present an argument specific to its position, it may do so in a supplemental brief or response not to exceed five (5) pages. No later than **September 22, 2014**, the parties shall simultaneously file their opening claim construction briefs. See Patent L.R. 4.4(a). No later than **October 6, 2014**, the parties shall simultaneously file their responsive claim construction briefs. See Patent L.R. 4.4(b). Each side's opening and responsive brief shall cover all the claim terms sought to be construed and shall not exceed 35 pages in length.

11. On **October 9, 2014**, at **1:30 p.m.** the Court will hold a joint telephonic conference to discuss the parties' intended presentations at the claim construction hearing, including any tutorial and testimony.

12. The claim construction hearing will be held on **November 3, 2014**, at **9:00 a.m.** See Patent L.R. 4.5. The Court shall hold a joint case management conference at the end of the claim construction hearing. Counsel shall come prepared to discuss trial dates and case management dates leading up to trial.

IT IS SO ORDERED.

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DATED: October 10, 2013

/s/Dana M. Sabra
HON. DANA M. SABRAW
United States District Judge

APPENDIX E

NOTE: This disposition is nonprecedential.

**UNITED STATES COURT OF APPEALS
FOR THE FEDERAL CIRCUIT**

2019-1141, 2019-1144

[Filed January 6, 2020]

| | |
|----------------------------------|---|
| AMERANTH, INC., |) |
| <i>Plaintiff-Appellant</i> |) |
| |) |
| v. |) |
| |) |
| DOMINO'S PIZZA, LLC, |) |
| DOMINO'S PIZZA, INC., |) |
| <i>Defendants-Appellees</i> |) |
| |) |
| PAPA JOHN'S USA, INC., |) |
| OPENTABLE, INC., GRUBHUB, INC., |) |
| SEAMLESS NORTH AMERICA, LLC, |) |
| O-WEB TECHNOLOGIES LTD., |) |
| HOTELS.COM, L.P., STUBHUB, INC., |) |
| TICKETMASTER, LLC, LIVE NATION |) |
| ENTERTAINMENT, INC., |) |
| TRAVELOCITY.COM LP, HOTEL |) |
| TONIGHT, INC., ORBITZ, LLC, |) |
| EXPEDIA, INC., FANDANGO, INC., |) |
| HOTWIRE, INC., KAYAK SOFTWARE |) |
| CORPORATION, EMN8, INC., HILTON |) |
| INTERNATIONAL CO., HILTON |) |

RESORTS CORPORATION, HILTON)
WORLDWIDE, INC., USABLENET,)
INC., STARWOOD HOTELS &)
RESORTS WORLDWIDE INC., MOBO)
SYSTEMS, INC., AGILYSYS, INC.,)
ATX INNOVATION, INC., BEST)
WESTERN INTERNATIONAL, INC.,)
HYATT CORPORATION, ORDR.IN,)
INC., NAAMA NETWORKS, INC.,)
MARRIOTT HOTEL SERVICES, INC.,)
MARRIOTT INTERNATIONAL, INC.,)
RITZ CARLTON HOTEL COMPANY,)
LLC, RENAISSANCE HOTEL)
OPERATING COMPANY, APPLE, INC.,)
TICKETBISCUIT, LLC, EVENTBRITE,)
INC., TICKETFLY, INC., STARBUCKS)
CORPORATION, IPDEV CO., ORACLE)
CORPORATION,)
Defendants)
_____)

Appeals from the United States District Court for
the Southern District of California in Nos. 3:11-cv-
01810-DMS-WVG, 3:12-cv-00733-DMS-WVG, Judge
Dana M. Sabraw.

**ON PETITION FOR PANEL REHEARING AND
REHEARING EN BANC**

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Before PROST, *Chief Judge*, NEWMAN, PLAGER,*
LOURIE, DYK, MOORE, O'MALLEY, REYNA, WALLACH,
TARANTO, CHEN, HUGHES, and STOLL, *Circuit Judges*.

PER CURIAM.

O R D E R

Appellant Ameranth, Inc. filed a combined petition for panel rehearing and rehearing en banc. The petition was referred to the panel that heard the appeal, and thereafter the petition for rehearing en banc was referred to the circuit judges who are in regular active service.

Upon consideration thereof,

IT IS ORDERED THAT:

The petition for panel rehearing is denied.

The petition for en banc rehearing is denied.

The mandate of the court will issue on January 13, 2020.

FOR THE COURT

January 6, 2020

Date

/s/ Peter R. Marksteiner

Peter R. Marksteiner
Clerk of Court

* Circuit Judge Plager participated only in the decision on the petition for panel rehearing.