

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

DIETGOAL INNOVATIONS LLC,

Plaintiff,

v.

ARBY'S RESTAURANT GROUP, INC.,

et al.,

Defendants.

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Civil Action No. 2:11-cv-00418-DF

Jury Trial Demanded

**PLAINTIFF DIETGOAL INNOVATIONS LLC'S SUR-REPLY IN OPPOSITION
TO DEFENDANTS GOOGLE INC. AND JIMMY JOHN'S FRANCHISE LLC'S
MOTION TO DISMISS FOR FAILURE TO STATE A CLAIM
BASED ON UNPATENTABLE SUBJECT MATTER**

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Pursuant to FED. R. CIV. P. 12(b)(6), Plaintiff DietGoal Innovations LLC (“DietGoal”) DietGoal files this sur-reply in opposition to Defendants Google Inc. (“Google”) and Jimmy John’s Franchise LLC’s (“Jimmy John’s”) (collectively “Defendants”) Motion to Dismiss for Failure to State a Claim Based on Unpatentable Subject Matter and requests that the Court deny the motion.

I. INTRODUCTION

In order to form different eating habits and to make different meal choices, an individual’s conscious knowledge regarding the health and nutritional impact of food items and meals must change. U.S. Patent No. 6,585,516 (“the ‘516 Patent”) provides a computerized meal planning tool that assists and trains the individual to make different and better informed decisions regarding their meal choices. Prior to the present invention, the dietary tool taught by the ‘516 Patent did not exist. *See* Col. 1:8-10 and Abstract. This computerized method and system cannot be performed or implemented without the use of a computer.

The Defendants either misunderstand the invention or intentionally misconstrue its scope as even a plain read of the claims cannot support an interpretation that the method and system can be implemented or performed in the human mind or simply through use of pen and paper. In a failed attempt to divorce the invention from its essential computerized components, the Defendants construe terms and phrases out of context in order to support their ill-defined theory. Acceptance of such contentions requires a stretch of the imagination.

In their reply, in addition to repeating a number of misleading contentions, Defendants rely on three inapposite cases: *CyberSource*, *Fort Properties*, and *Dealertrack*, all of which serve only to demonstrate the vast contrast between the claims in this case and those that may well deserve rejection through the “course ineligibility filter” of § 101.

Any concerns regarding the patent are easily overcome with proper construction of any disputed claim terms and should appropriately be addressed at a later time. If the Court is so inclined as to grant the Defendants' motion, DietGoal requests that the Court reserve any such ruling until claim construction is complete.

II. ARGUMENTS

A. Defendants Do Not Meet the Standard for Dismissal under 12(b)(6) and Fail to Demonstrate That Claim Construction Would Not Sufficiently Address Any Alleged Concerns Regarding the '516 Patent

The validity of a patent is presumed such that “[e]ach claim of a patent is presumed valid independently of the validity of other claims.” 35 U.S.C. § 282. The Defendants have a high burden of establishing invalidity by clear and convincing evidence. *Kaufman Company, Inc. v. Lantech, Inc.*, 807 F.2d 970, 973 (Fed. Cir. 1986). In deciding a motion to dismiss, the court must take the plaintiff's factual allegations as true and construe those facts in light most favorable to it. *See Ashcroft v. Iqbal*, 129 S. Ct. 1937, 1949 (2009). When there are well-pleaded factual allegations, “a court should assume their veracity and then determine whether they plausibly give rise to an entitlement to relief.” *Id.* at 1950.

The '516 Patent is drawn to a computerized meal planning system and method that addresses the need in the field to provide for an effective dietary tool. The Defendants' accused products each practice the method and implement the system taught by the '516 Patent. Defendants' motion cannot change this fact and only demonstrates a desperate attempt to avoid the inevitable. When the facts are drawn in the light most favorable to DietGoal, the Defendants' motion falls short of the requisite standard for dismissal under Rule 12(b)(6).

Additionally, if inclined to grant the motion, the Court should not determine subject matter eligibility of the '516 Patent prior to claim construction. *See Ultramercial, LLC v. Hulu, LLC*, 657 F.3d 1323, 1325 (Fed. Cir. 2011) (“a definition of the invention via claim construction

can clarify the basic character of the subject matter of the invention. Thus, claim meaning may clarify the actual subject matter at stake in the invention and can enlighten, or even answer, questions about subject matter abstractness.”). Although the eligibility of the ’516 Patent is evident without claim construction, dismissal without the same would be premature. *See In re Bilski*, 545 F.3d 943, 951 (“[C]laim construction...is an important first step in a § 101 analysis”), *reversed on other grounds*; *cf. In re Nuriyten*, 500 F.3d 1346, 1352 (“As in any other context in which the scope and meaning of the claims bears on the ultimate determination at hand, we must start by considering the issue of claim construction.”). The Defendants fail to show any evidence to the contrary or why such construction must be expedited.

B. Defendants Rely on Unavailing Case Law to Support Their Strained Theory

1. The Claims of the ’516 Patent are Distinct from the Claims in *CyberSource*

The Defendants’ continued reliance on *CyberSource Corp. v. Retail Decisions, Inc.*, 654 F.3d 1366 (Fed. Cir. 2011) is misguided. In *CyberSource*, the court first analyzed a method claim that covered “any method of detecting credit card fraud based on information relating past transactions to a particular “Internet address.” *Id.* at 1372. The first step in the claim required “obtaining information about other transactions that have utilized an Internet address that is identified with the [] credit card transaction.” *Id.* The court noted that the claim did not cover the initial creation of a database, and found that “even if some physical steps are required to obtain information from the database (e.g., entering a query via a keyboard, clicking a mouse), such data-gathering steps cannot alone confer patentability.” *Id.* The second step called for “constructing a map of credit card numbers...” that could be performed by writing down a list of credit card transactions. *Id.* The court noted that “there is no language in claim 3 or in the [] patent’s specification that requires the constructed ‘map’ to consist of anything more than a list

of a few credit card transactions.” *Id.* The third step required “utilizing the map of credit card numbers to determine if the credit card transaction is valid,” which the court noted encompassed “literally *any* method for detecting fraud.” *Id.* at 1373 (emphasis in original).

The court noted that **every single step** of this claim could be performed in the human mind. *Id.* The court held that such methods are “unpatentable **not** because there is anything wrong with claiming mental method steps as part of a process containing non-mental steps, but rather because computational methods which can be performed *entirely* in the human mind are... ‘basic tools of scientific and technological work’ that are free to all.” *Id.* (bold emphasis added).

The second claim the court analyzed was a “Beauregard claim” directed to a computer readable medium “containing program instructions for a computer to perform a particular process” that recited the steps of “obtaining credit card information,” “verifying the credit card information,” “constructing a map,” and “utilizing the map...to determine if the credit card transaction is valid.” *Id.* at 1373-74. Despite its recitation of “a computer readable medium,” the court treated this claim as a method claim and found it to be equally unpatentable for the same reasons. *Id.* at 1374-75.

Unlike the claims in *CyberSource* where all of the recited method steps could be performed entirely in the human mind, the claims of the ‘516 Patent cannot be performed or implemented without a computerized system or program. Independent Claims 1 and 2, which are not method claims, recite “a system of computerized meal planning” that comprises a computerized “User Interface,” a “Database of food objects,” and “at least one Picture Menus” and “a Meal Builder,” respectively. The “at least one Picture Menus” must be structured so that it “displays on the User Interface meals from the Database that a user can select from to meet customized eating goal.” The “Meal Builder” must be structured so that it “displays on the User

Interface meals from the Database, and wherein a user can change content of said meals and view the resulting meals' impact on customized eating goals.” Such a system cannot be “performed in the human mind.” The human mind cannot be a computerized system with a User Interface, a Database, and either a “Picture Menus” or a “Meal Builder” that allow for interactive displaying of meals from the Database.

Relying on *CyberSource*, the Defendants seek to confuse the system claims with method claims in order to force these claims into conformity with their misconstrued theory. Motion at 10; Reply at 4. However, unlike the seemingly Beauregard structured claim in *CyberSource* that required the performance of method steps, such as “obtaining credit card information,” “verifying the credit card information,” “constructing a map,” and “utilizing the map...to determine if the credit card transaction is valid,” the system claims in this case do not recite any steps. The requirement that the Picture Menus be displayed in an interactive manner that enables a user to select “meals from the Database...to meet customized eating goals” is not a recitation of a step but descriptive functional language that defines the structure of the “Picture Menus” and the “Meal Builder.”

The actual method claims of the ‘516 Patent, “computerized planning that can influence behavior,” require a computerized program to perform each specific step. *See* Claims 12 and 13. First, the computerized program must perform the step of “preparing a Database of food objects.” Unlike the claims in *CyberSource* that did not cover the initial creation of a database, the Claims here require database creation. The system claims similarly require the “Database of food objects” to be structured such that it, for example, is “organizable into meals.” *See* Claim 1. In one embodiment, the specification teaches that the “Food Database is a database of foods that have been compiled.” Col. 2:25-26. In another embodiment, it can “incorporate a behavior

analysis” that “comprises compiling and analyzing specific information on a user’s instinctive preferences and tendencies...[t]hus, the Meal Database and Food Database can be modified to include meals that the user has indicated he likes” or alternatively “meals that the user dislikes can be...deleted from the Meal Database and the Food Database.” Col. 2:33-45; *see also* previously submitted Exhibit B, ‘810 Application, at 1 ¶ 0010 (“a computer database is provided including presentations of a plurality of objects, the presentations being displayable in successive groups, each group including a plurality of presentations. A computer program is then caused to display successive groups, together with display of graphics associated with each of the groups.”).

Second, the computerized program must perform the step of, as recited in Claim 12 “allowing a user to choose meals from one or more Picture Menus, which display on a User Interface meals comprised from the food objects from the Database,” or, as recited in Claim 13, “allowing the user to change the meals using a Meal Builder, which displays on the User Interface the food objects from the meals from the Database, corresponding to the Picture Menus.” Unlike the “constructing a map” step in the *CyberSource* claims that could be performed by simply using a pen and paper, the step of allowing a user to choose or change meals requires that the selection be from either a “Picture Menus” or a “Meal Builder” that “displays on the User Interface” meals or food objects from the Database. A computerized user interface cannot be written down with pen and paper nor made selectable through such means. The system and method require input from the user in order to provide a customized displayable output. Figure 10 is an exemplary embodiment that depicts a user interface that shows the complexity of the claimed computerized system and method:

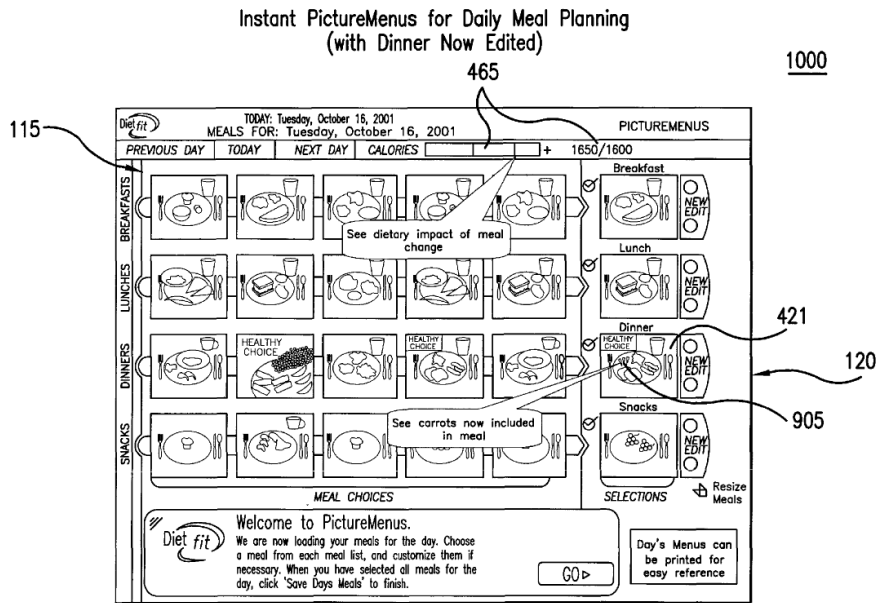


FIG. 10

Thus, not a single step of the method or any aspect of the claimed system can be performed in the human mind. The invention is dependent on the use of a specialized computer. Even if the Defendants’ unreasonable contention is credited and the final step of the method claim is deemed to be performed in the human mind, the performance of a single step in the mind is not enough to overcome the “course eligibility filter” of § 101. *See Ultramercial*, 657 F.3d at 1326.

2. Defendants’ Reliance on *Fort Properties* and *Dealertrack* are Equally Inapposite

Without analysis, defendants rely on *Fort Properties, Inc. v. American Master Lease LLC*, 2012 U.S. App. LEXIS 3900 (Fed. Cir. Feb. 27, 2012) to support their misguided contentions. In *Fort Properties*, the claims were directed towards a “method of creating a real estate investment instrument” that did not require the use of a computer. *Id.* at *12. Each of the claims recited the conceptual steps of “aggregating real property into a real estate portfolio, dividing the interests in the portfolio into a number of deedshares, and subjecting those shares to

a master agreement.” *Id.* Although the claims were tied to the physical world through the use of “deeds, contracts, and real property,” the performance of the steps themselves were abstract because they did not recite “sufficient physical activity to constitute patentable subject matter.” *Id.* at *12-14. The claims that contained the additional limitation of requiring a computer to “generate a plurality of deedshares,” was also found to be ineligible because the use of a machine in that case did not “impose meaningful limits on the claim’s scope” and “did not play a significant part in permitting the claimed method to be performed.” *Id.* at *16 (quoting *CyberSource*, 654 F.3d at 1375).

Defendants’ reliance on *Dealertrack, Inc. v. Huber*, No. 2009-1566, 2012 U.S. App. LEXIS 1161 (Fed. Cir. Jan. 20, 2012)¹ is equally unavailing. In *Dealertrack*, the court held that claims to a method of applying for credit did not satisfy § 101 because the claims were “silent as to how a computer aids the method, the extent to which a computer aids the method, or the significance of a computer to the performance of the method.” *Id.* at *17.

In contrast, the present invention requires the use of a computer to implement the system and to perform the method. Without the computer, the Database of food objects cannot be prepared and the user would not be allowed to choose meals from Picture Menus or change meals using a Meal Builder, both of which display a complex user interface that interactively displays meals from the Database of food objects. The claimed invention “requires intricate and complex computer programming” and “specific application to the Internet and cyber-market environment,” which advances the field of computerized meal planning tools. *See Ultramercial, LLC v. Hulu, LLC*, 657 F.3d 1323, 1328 (Fed. Cir. 2011); *see also* Response at 15, 18-19.

¹ Defendants unjustly criticize DietGoal for not discussing *Dealertrack* in its response; however, Defendants did not previously cite this case nor was DietGoal aware of its existence until now.

C. Defendants' Other Repeated Contentions Continue to be Unavailing

“[T]he purpose of the Patent Act is to encourage innovation, and the use of broadly inclusive categories of statutory subject matter ensures that ‘ingenuity...receive[s] a liberal encouragement.’” *Ulramercial*, 657 F.3d at 1326 (Fed. Cir. 2011). The Defendants’ misconstruction of the patent seeks to limit the broad scope of § 101 by taking phrases and DietGoal’s arguments out of context in order to support their ill-defined theory. For example, the Defendants contend that the ‘516 Patent does not meet eligibility requirements because the invention does not provide detailed programming specification, a disclosure issue addressed under § 112. Reply at 7. However, no defined “level of programming complexity [is] required before a computer-implemented method can be patent-eligible. *Ulramercial*, 657 F.3d at 1328. *In re Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994).

In this case, the specification provides sufficient support for the level of programming required to implement and perform the claimed invention. For example, in one embodiment, a computer program selects “n” pairs or other multiples of objects based on specific criteria, including size, shape, color, texture or other identifying or functional variations. The user then inputs and records choice of one of each pair or more presented on screen...Interactive software algorithms then utilize the user input data and integrate such data with predetermined or derived criteria to create a plan for behavior modification that can be manually overridden and then evaluated.” ‘810 Application at 6 ¶ 0077. In another embodiment, the software program must be written so that “[c]hosen items can be identified and moved onto any virtual surface, platform, table, or plate as realistic images by ‘click and drag’ or other means...Alternatively, computer-generated objects, or other object combinations selected from external but linked exchangeable database modules, are presented either randomly or selected for visual evaluation...” *Id.* at ¶

0078. Such requirements provide sufficient disclosure to enable one skilled in the art, such as a computer or website programmer, to implement the present invention. *See* 35 U.S.C. § 112.

The Defendants also suggest that the invention does not disclose a useful application and that even if it does such an application is not relevant because it is not specifically stated in the claims. Reply at 9. However, in *Research Corp.* the court found recitation in the specification of the application of the patent to the field of computer technology enough to support eligibility. *Research Corp. Techs., Inc. v. Microsoft Corp.*, 627 F.3d 859, 869 (Fed. Cir. 2010) (finding).

The Defendants also contend that the invention does not meet the “machine-or-transformation” test, a non-dispositive, limited inquiry which the patent satisfies. *See Bilski v. Kappos*, 130 S. Ct. 3218, 3226 (2010). A claimed process is patentable under this test if it (1) “is tied to a particular machine or apparatus,” or (2) “transforms a particular article into a different state or thing.” *SiRF Tech., Inc. v. Int’l Trade Comm’n.*, 601 F.3d 1319, 1332 (Fed. Cir. 2010). As explained above, the present invention depends upon the use of a computer, without which the claims would be meaningless. For example, a computerized program must perform the step of “preparing a Database of food objects” by creating the database, “allowing a user to choose meals from one or more Picture Menus” or “using a Meal Builder” both of which interactively display selectable options on a complex User Interface. *See, e.g.*, Claims 12 and 13. Such a computer program transforms a generalized computer into a specialized computer for meal planning. *See Alappat*, 33 F.3d 1526, 1545 (Fed. Cir. 1994); *Ultramercial*, 657 F.3d at 1329 (“A programmed computer contains circuitry unique to that computer”).

III. CONCLUSION

“Congress intended statutory subject matter to include anything under the sun that is made by man.” *Diamond v. Chakrabarty*, 447 U.S. 303, 309 (1980). Defendants’ motion seeks to improperly limit the broad scope of § 101 and should be denied.

Dated: March 5, 2012

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that all counsel of record who are deemed to have consented to electronic service are being served with a copy of this document via the Court's CM/ECF system per Local Rule CV-5(a) on this 5th day of March, 2012. Any other counsel of record will be served by facsimile transmission and first class mail.

/s/ Niky Bukovcan

Niky Bukovcan