

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEARMAP US, INC.
Petitioner

v.

EAGLE VIEW TECHNOLOGIES, INC.
Patent Owner

IPR2022-00734

U.S. Patent 9,135,737

PATENT OWNER'S PRELIMINARY RESPONSE
TO PETITION FOR INTER PARTES REVIEW

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PATENT OWNER'S EXHIBIT LIST¹

August 3, 2022

EX2001	Reserved
EX2002	Reserved
EX2003	Complaint, <i>Eagle View Technologies, Inc. and Pictometry International Corp. v. Nearmap US, Inc.</i> , No. 2:21-cv-00283, ECF No. 2 (D. Utah May 4, 2021) (Oberg)
EX2004	Amended Patent Case Scheduling Order, <i>Eagle View Technologies, Inc. and Pictometry International Corp. v. Nearmap US, Inc.</i> , No. 2:21-cv-00283, ECF No. 99 (D. Utah July 26, 2022) (Oberg)

¹ Citations to non-patent document exhibits are to the original page numbering in the exhibits, unless the Bates-stamped page numbers are specifically referenced.

I. INTRODUCTION

Patent Owner, Eagle View Technologies, Inc., submits this Preliminary Response to the Petition (“Petition”) (Paper 2). The Board should deny institution of the Petition for at least four reasons.

First, the Board previously determined—and the Federal Circuit affirmed—that the challenged claims of the ’737 patent are patentable and nonobvious based on Patent Owner’s “extensive” and “decisive” evidence of objective indicia of nonobviousness. The Board should follow the Federal Circuit’s decision affirming the patentability of the challenged claims and deny institution of the Petition.

The ’737 patent was previously challenged in IPR2016-00592 (“Xactware IPR”). In the Xactware IPR, the Board determined in a Final Written Decision that Patent Owner submitted “extensive evidence” of commercial success and industry praise and “extensive evidence of nexus” that compelled a finding of nonobviousness. The Board explained that Patent Owner’s secondary considerations evidence was “decisive.” The Federal Circuit *affirmed* the Board’s decision of nonobviousness based on Patent Owner’s secondary considerations evidence.

Petitioner fails to acknowledge the Board’s finding of “extensive evidence of nexus” or that the Federal Circuit affirmed, finding there was “substantial evidence support[ing] the Board’s finding of nexus.” Petitioner argues that the

publicly available information from the Xactware IPR is insufficient to establish nexus. In making this argument, Petitioner seems to simply ignore the extensive publicly available evidence set forth in the Board's Final Written Decision establishing the clear nexus between the claims of the '737 patent and the secondary considerations evidence. Further, Petitioner disregards the fact that the Board's final determination and the Federal Circuit's affirmance were based on the *full secondary considerations evidence*.

Second, because the secondary considerations evidence previously provided by Patent Owner remains unchanged and Petitioner challenges the claims of the '737 patent only on obviousness grounds, there can only be one outcome to the current IPR: the challenged claims of the '737 patent are patentable and nonobvious. Petitioner does not challenge the claims of the '737 patent on any anticipation ground that would render Patent Owner's secondary considerations evidence immaterial. Instead, Petitioner sets forth only obviousness challenges. Petitioner's obviousness challenges cannot overcome Patent Owner's "extensive" secondary considerations evidence that the Board and Federal Circuit previously found "decisive." Accordingly, for at least the same reasons set forth in the Board's Final Written Decision in the Xactware IPR, the claims of the '737 patent are patentable and nonobvious.

Third, instituting a trial in this proceeding would be an inefficient use of the

Board's and the parties' resources in view of the Federal Circuit's affirmance that Patent Owner's secondary considerations evidence decisively weighed in favor of nonobviousness. It would be inefficient for the Board and the parties to relitigate a dispositive issue that was already decided by the Board and affirmed by the Federal Circuit. This is especially true when the decisive secondary considerations evidence previously provided by Patent Owner remains unchanged. In fact, Petitioner does not assert that there has been any material changes to the facts that would cause a different outcome. There is simply no reason to waste the Board's and the parties' resources relitigating an issue that was argued, fully considered, and decided by the Board—then affirmed by the Federal Circuit—when there has been no change to the underlying facts and, therefore, the outcome must be the same.

Fourth, the Board should exercise its discretion to deny institution under *Fintiv*. The parties will have invested significantly in the invalidity issues before the Board would issue its institution decision, and Petitioner has not stipulated to avoid overlap between this IPR proceeding and the parallel district court proceeding. None of the *Fintiv* factors weigh in favor of institution.

II. THE BOARD ALREADY FOUND THE CLAIMS PATENTABLE

The Board should deny institution because the Board has already maintained the patentability of the claims of the '737 patent based on extensive evidence of

nonobviousness, and the Federal Circuit agreed, noting that “substantial evidence supports the Board’s finding.” Ex.1016, 2.² In the Xactware IPR, Patent Owner demonstrated that challenged claims 1, 9, 10, 16, 25, 26, and 34 are nonobvious based on “decisive” and “extensive” secondary considerations evidence. Ex.1010, 26, 27, 33, 34. In particular, the Board found that Patent Owner presented “extensive evidence” indicating that Patent Owner’s “Twister and Render House products are coextensive with the challenged claims,” and that the commercial success of and industry praise for these products confirmed that the challenged claims are nonobvious. Ex.1010, 31, 32-33, 34.

The Board found that Patent Owner provided “extensive evidence of nexus” between the evidence of commercial success and industry praise and the challenged claims. Ex.1010, 27, 33, 34. The Federal Circuit affirmed the Board’s decision, finding that “substantial evidence supports the Board’s finding of nexus.” Ex.1016, 2. The Board’s determination of nonobviousness based on Patent Owner’s “extensive” secondary considerations evidence is therefore final. *See XY, LLC v. Trans Ova Genetics, L.C.*, 890 F.3d 1282, 1294 (Fed. Cir. 2018) (Federal

² Petitioner provided the slip opinion of the Federal Circuit’s decision as Ex.1016. The Federal Circuit’s decision is also available at *Xactware Solutions, Inc., v. Eagle View Techs., Inc.*, 755 Fed.Appx. 1015 (Fed. Cir. 2019).

Circuit's "affirmance renders final [Board's] judgment" on validity of patent

reviewed by Board). Accordingly, the Board should deny institution because the Board and the Federal Circuit have already determined that Patent Owner's "decisive" secondary considerations evidence establish that the challenged claims are patentable and nonobvious.

III. THE DECISIVE AND EXTENSIVE SECONDARY CONSIDERATIONS EVIDENCE REMAINS UNCHANGED

The Board set forth in its *publicly available* Final Written Decision how Patent Owner presented "decisive" and "extensive" secondary considerations evidence to establish that the challenged claims were nonobvious based on the commercial success of and industry praise for Patent Owner's Twister and Render House products. Ex.1010, 26, 30-31, 34. Further, the Board determined that there was "extensive evidence" of nexus between the challenged claims and the secondary considerations evidence. Ex.1010, 27, 31, 29. None of the "decisive" and "extensive" evidence the Board relied on to find the claims patentable and nonobvious has changed. The language of the challenged claims has not changed, and the extensive secondary considerations evidence has not changed. The Board should therefore find the challenged claims patentable and nonobviousness for the same reasons set forth in the Board's Final Written Decision in the Xactware IPR. *See*, Ex.1010, 31, 32-33, 34.

Petitioner's obviousness challenges cannot overcome Patent Owner's

secondary considerations evidence that the Board and Federal Circuit found

“decisive[ly]” proved the challenged claims patentable and nonobvious. The

“extensive” and “decisive” evidence the Board relied on remains unchanged.

Therefore, there can be only one outcome to this IPR: the challenged claims are patentable and nonobvious based on Patent Owner's secondary considerations evidence.

A. Patent Owner Proved Extensive Evidence of Nexus That Remains Unchanged

Patent Owner showed that its Twister and Render House products use the claimed invention to “creat[e] accurate roof estimate reports faster and at less expensive than previous solutions.” Ex.1010, 29 (citing Ex.1012 at 66). For example, the Board found that “Patent Owner provided extensive evidence that the Twister and Render House products are coextensive with the challenged claims and that the reports sold were created using the Twister and Render House products.” Ex.1010, 31-32. Thus, the Board was “persuaded that nexus exists between the challenged claims and the commercially successful products at issue.” Ex.1010, 31, 34 (“we are persuaded that Patent Owner has shown strong evidence of nexus between the challenged claims and the Twister and Render House products used to produce the commercially successful reports.”). None of the information establishing an “extensive” and “strong” nexus has changed.

B. Patent Owner Proved Extensive Evidence of Commercial Success That Remains Unchanged

The Board was “persuade[d] [] that Patent Owner’s Twister and Render House products experienced *significant commercial success and wide-spread use in the industry.*” Ex.1010, 31 (emphasis added). For example, the Board found that ““approximately 96 percent of the top 25 insurance companies rely on [Eagle View Technologies 3D aerial roof measurement reports] in their claims departments.”” Ex.1010, 30 (citing Ex.1020, 1; Ex.1029, 8). The Board found that “the Twister and Render House products are coextensive with the challenged claims, and that the commercially successful reports were created using the Twister and Render House products.” Ex.1010, 31-32. This commercial success evidence has not changed.

C. Patent Owner Proved Extensive Evidence of Industry Praise That Remains Unchanged

The Board found that “Patent Owner’s extensive evidence of industry praise weighs in favor of the non-obviousness of the claimed invention.” Ex.1010, 34. For example, the Board credited evidence that Patent Owner is a “leader in sophisticated imagery for uses in the property and casualty, contractor, government, and commercial spaces.” Ex.1010, 33 (quoting Ex.1023, 3). In addition, the Board found that a Bloomberg article touted the accuracy of Patent Owner’s roofing reports, stating that ““most insurance carriers at this point treat

[Patent Owner's roofing reports] as gospel.” Ex.1010, 34 (quoting Ex.1024, 2).

Further, the Board found that an article from the California Business Journal indicated that “Eagle View made one of the biggest breakthroughs in the history of the industry by creating a state-of-the-art software program that remotely snaps sophisticated aerial pictures of roofs and accurately measures lengths, pitches, valleys and other hard-to-see areas on roofs.” Ex.1010, 34 (quoting Ex.1027, 2). The Board also found that this California Business Journal article indicated that “Eagle View changed the industry forever with this technology.” Ex.1010, 34 (quoting Ex.1027, 2). As with Patent Owner's commercial success evidence, the Board found that “Patent Owner's extensive evidence of industry praise weighs in favor of the non-obviousness of the claimed invention.” Ex.1010, 34. This industry praise evidence has not changed.

**D. Petitioner Does Not Rebut Any of the Extensive Evidence
Showing a Nexus with the Secondary Considerations Evidence**

Patent Owner's “extensive evidence” of nexus between the challenged claims and Patent Owner's commercially successful and industry-praised Twister and Render House products remains unchanged. Petitioner's only response to the Board's finding of “extensive evidence of nexus” is that “the publicly available evidence from the Xactware IPR is insufficient to establish a nexus between the Challenged Claims and the evidence of secondary considerations.” Petition, 55; *see also id.*, 57, 59-60 (same argument). Thus, Petitioner is disputing the Board's

finding, and the Federal Circuit's affirmance, of a nexus between the challenged claims and Patent Owner's extensive evidence of commercial success and industry praise simply because Patent Owner presented confidential evidence in support of its showing. Petitioner's argument lacks merit for at least three reasons.

First, the Board's Final Written Decision, which explains the reasons why there is a nexus between the challenged claims and Patent Owner's Twister and Render House products, is not redacted and publicly available. Ex.1010, 29, 32, 33. **Second**, Petitioner does not rebut *any of the evidence* in the Board's Final Written Decision showing why there is "extensive evidence of nexus" between the challenged claims and Patent Owner's Twister and Render House products. Ex.1010, 27, 33. **Third**, and most importantly, the Federal Circuit has already affirmed the findings by the Board—finding substantial evidence supporting a nexus between the challenged claims and Patent Owner's extensive evidence of commercial success and industry praise. Ex.1016, 2.

Rather than address the publicly available evidence identified in the Board's Final Written Decision, Petitioner dismissively argues that "[w]ithout an established nexus between the evidence and the challenged claims, the evidence of commercial success and industry praise presented by Patent Owner in the Xactware IPR is *irrelevant* to the present proceeding." Petition, 60 (emphasis added). Petitioner is wrong. Contrary to Petitioner's argument, the Board's

previous findings of nexus, commercial success, and industry praise are *very relevant* to this proceeding because the Board determined that Patent Owner's secondary considerations evidence "decisive[ly]" showed that the challenged claims are patentable and nonobvious. Ex.1010, 26. Further, in asserting an alleged lack of a nexus, Petitioner fails to address the fact that the Federal Circuit *affirmed* the Board's previous finding of nexus, noting that "*substantial evidence supports the Board's finding of nexus.*" Ex.1016, 2.

E. The Petition Offers Nothing More Than Unsubstantiated Theories Against Extensive Secondary Considerations Evidence

Rather than contest the publicly available evidence cited in the Board's Final Written Decision in the Xactware IPR, Petitioner offers numerous, unsubstantiated theories for why there may allegedly be no nexus between the challenged claims and the "extensive evidence" of commercial success and industry praise for Patent Owner's Twister and Render House products, which embody the challenged claims. Petition, 60-66. All of Petitioner's arguments fail because they are based on conjecture and are contradicted by the Board's final decision in the Xactware IPR. Petitioner cannot rebut the Board's previous finding of a nexus between the challenged claims and Patent Owner's Twister and Render House products with unsubstantiated theories. *See Dish Network LLC v. Sound View Innovations, LLC*, IPR2020-00969, Paper 20 at 28 (PTAB Nov. 25, 2020) (finding Petitioner's challenge to secondary consideration evidence insufficient because "[t]he inquiry

at hand requires evidence, not supposition.”)

First, Petitioner contends that Patent Owner's commercial success evidence is not tied to “consistently accurate roof measurements” achieved by the claimed invention because “one factor that would affect the accuracy of the measurements” is improved resolution of the aerial images. Petition, 62-64. Petitioner appears to argue that because Patent Owner merged with Pictometry International Corp. (“Pictometry”), which is ““a leading provider of aerial imagery and the originator of technology for aerial oblique image capture”” (Petition, 63 (quoting Ex.1030, 1)), the consistently accurate roof measurements achieved by Patent Owner's Twister and Render House products is due to obtaining higher resolution versions of the “first and second aerial images” as a result of Patent Owner's merger with Pictometry. Petition, 62-63. This is nothing but conjecture.

In fact, Petitioner admits that “the Challenged Claims do not recite any limitations related to capturing the first and second aerial images.” Petition, 63. Consequently, the Board's determination that the “extensive evidence of nexus” between the challenged claims and Patent Owner's Twister and Render House products was made independent of the particular resolution of the “aerial photos” recited in the challenged claims. Petitioner cites to its witness, Dr. Forsyth, in support of its theories, but Dr. Forsyth's testimony simply mirrors the unsubstantiated theories in the Petition. Petition, 62-64 (citing Ex.1003, ¶¶ 125-

128, which are identical to Petition, 62-64 except for citations to Ex.1003).

Petitioner's conjecture cannot overcome the "extensive evidence of nexus" between the challenged claims and Patent Owner's Twister and Render House products found by the Board and *affirmed* by the Federal Circuit. Further, the Board expressly found that Patent Owner's Twister and Render House products, which have a nexus with the challenged claims, achieved commercial success for reasons other than improved resolution of the aerial resolution. Ex.1010, 29-33.

Second, Petitioner presents another unsubstantiated theory that "strategic business decisions undoubtedly contributed to Patent Owner's alleged success," including Patent Owner's merger with Pictometry, which "gave Patent Owner control over the 'high resolution aerial oblique imagery' its roof estimate reports are 'derived from,' which undoubtedly contributed to Patent Owner's commercial success." Petition, 65-66 (citing Ex.1030, 1-2; Ex.1035, 1-2). Again, this is nothing but conjecture and guesswork. Contrary to Petitioner's conjecture, the Board found that "approximately 96 percent of the top 25 insurance companies rely on [Eagle View Technologies 3D aerial roof measurement reports] in their claims departments." Ex.1010, 30 (citing Ex.1020, 1; Ex.1029, 8). In addition, the Board noted that Patent Owner's products are used by "about one-fifth of the roofing contractor market, according to an estimate by market researcher IbisWorld." Ex.1010, 30 (citing Ex.1024). Further, Patent Owner showed that "the

Twister and Render House products...embody the challenged claims in order to generate the roofing reports that it sold, and that the reports sold were created using the Twister and Render House products.” Ex.1010, 32-33. The Board was “persuade[d] [] that Patent Owner’s Twister and Render House products experienced *significant commercial success and wide-spread use in the industry.*” Ex.1010, 31 (emphasis added). Petitioner’s conjecture in this regard cannot overcome the Board’s previous finding, as ***affirmed*** by the Federal Circuit, that Patent Owner’s Twister and Render House products achieved commercial success for reasons other than “higher resolution aerial images” or “strategic business decisions,” as Petitioner theorizes.

Third, Petitioner alleges that “[t]he merger with Pictometry also eliminated a clear competitor to Patent Owner’s roof estimate reports.” Petition, 66 (citing Ex.1031, 1-2). Again, this is nothing but conjecture. Patent Owner merged with Pictometry in 2013. As the Board noted, “Patent Owner’s financial reports show both that it sold a significant number of roofing reports and that its sales grew significantly between 2009 and 2015.” Ex.1010, 30 (citing Ex.1012, 67-68). Thus, contrary to Petitioner’s conjecture, Patent Owner’s commercial success due to the Twister and Render House products, which have a nexus with the challenged claims, was demonstrated beginning years before the merger with Pictometry.

Fourth, Petitioner provides even more conjecture when it alleges that

“[o]ther business factors also contributed to Patent Owner's alleged success.”

Petition, 66. For example, Petitioner theorized that “much of Patent Owner's alleged commercial success is likely due to its business relationships (*e.g.*, with the insurance companies that use its reports), as well as efforts in the areas of marketing, sales, customer support, and other areas that are commonly necessary to operate a profitable business.” Petition, 66. This, again, is nothing but conjecture.

Notably, Petitioner does not contest the nexus between the challenged claims and the “extensive evidence of industry praise.” Ex.1010, 34. Petitioner simply provides one conclusory argument that the evidence of industry praise “results from factors other than [that] of the purported invention embodied by the Challenged Claims of the '737 patent.” Petition, 60-61.

In direct contrast to Petitioner's speculative arguments, the Board previously heard arguments and received evidence from both sides of the issue, fully considered the arguments and evidence, and decided that the challenged claims are nonobvious based on Patent Owner's “extensive evidence of nexus” between the challenged claims and Patent Owner's Twister and Render House products. Further, the Federal Circuit held that “substantial evidence supports the Board's finding of nexus.” Ex.1016, 2. To ignore these previous decisions based on Petitioner's mere speculative arguments and conjecture would be improper.

IV. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY INSTITUTION

Instituting trial in this proceeding would be an inefficient use of the Board's resources in view of the Federal Circuit's affirmance that Patent Owner's secondary considerations evidence "decisive[ly]" weighed in favor of nonobviousness. Ex.1010, 26; Ex.1016, 2. It would be inefficient for the Board and the parties to relitigate a dispositive issue that was already decided by the Board and affirmed by the Federal Circuit. Petitioner's speculation and conjecture cannot rebut the Board's final determination that "Patent Owner [] provided sufficient evidence to establish a nexus between the challenged claims and the Twister and Render House products," and that Patent Owner's "extensive evidence" of commercial success and industry praise confirmed that the challenged claims are nonobvious. Ex.1010, 29, 31, 33, 34.

Further, the Board's validity determination based on secondary considerations evidence in the Xactware IPR is final because the Federal Circuit ***affirmed*** the Board's determination. Ex.1016; *see also* XY, 890 F.3d at 1294. In particular, the Federal Circuit held that "substantial evidence supports the Board's finding of nexus." Ex.1016, 2. Petitioner contends that the Board need not follow the Federal Circuit's affirmance because "[t]he Federal Circuit [] faulted [Xactware] for not presenting evidence to counter Patent Owner's evidence." Petition, 68 (citing Ex.1016, 2). However, this statement by Petitioner is

misleading. The Federal Circuit noted that Xactware did not challenge the

presumption of nexus before the Board:

The parties spent most of their briefing in these appeals debating the evidentiary showing required for a patent owner to be given the presumption of nexus as to evidence it offers to show secondary considerations of non-obviousness. We do not reach that issue for two reasons. First, ***this was not clearly at issue in the parties' briefing before the Board.*** In its Patent Owner Response, Eagle View Technologies, Inc. ("Eagle View") argued that a nexus existed between its secondary considerations evidence and the patent claims because the relevant products "are the invention disclosed." *E.g.*, J.A. 1162. In its Reply, ***Xactware merely challenged the credibility of Eagle View's expert and argued that the expert's testimony failed to demonstrate that the products actually practiced the claimed inventions.*** *E.g.*, J.A. 1786–88. ***The evidentiary showing necessary to earn the presumption of nexus was simply not at issue before the Board.***

Ex.1016, 2.

Thus, to the extent the Federal Circuit "faulted" Xactware as Petitioner contends (Petition, 56, 68), the Federal Circuit did so because Xactware did not present evidence to rebut the *presumption of nexus*. Ex.1016, 2.

However, any potential dispute about the *presumption of nexus* is immaterial because the Board explicitly found that the challenged claims *have a nexus* with the commercially successful and industry-praised Twister and Render House products. Ex.1012, 29 ("Patent Owner has provided sufficient evidence to establish a nexus between the challenged claims and the Twister and Render House

products.”), 31 (“Patent Owner has provided extensive evidence that the Twister and Render House products are coextensive with the challenged claims.”). Still further, as discussed above, the Federal Circuit held that “substantial evidence supports the Board’s finding of nexus.” Ex.1016, 2.

Accordingly, Petitioner’s argument that the Board and Federal Circuit “faulted” Xactware for not presenting evidence to rebut the *presumption of nexus* has no bearing on this proceeding because Patent Owner fully established a nexus between the challenged claims and the Twister and Render House products. *See Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 33 at 33 (PTAB Jan. 24, 2020) (precedential) (explaining that a lack of presumption of nexus is not dispositive, because “the patent owner is still afforded an opportunity to prove nexus by showing that the evidence of secondary considerations is the direct result of the unique characteristics of the claimed invention.”) (quoting *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1375 (Fed. Cir. 2019) (internal quotation omitted)). Again, the Board agreed that Patent Owner proved a nexus between the claimed invention and the Twister and Render House products, and the Federal Circuit affirmed that finding. Ex.1016, 2 (“[S]ubstantial evidence supports the Board’s finding of nexus.”).

Accordingly, the Board should exercise its discretion to deny institution because the Board already determined that Patent Owner’s secondary

considerations evidence “decisive[ly]” weighed in favor of nonobviousness.

Ex.1010, 26. Relitigating this issue would be an inefficient use of the Board's and the parties' resources.

Petitioner challenges three additional dependent claims—claims 6, 7, and 17—that were not at issue in the Xactware IPR. However, the nonobviousness of independent claims 1 and 16 would be dispositive for dependent claims 6, 7, and 17. *In re Fine*, 837 F.2d 1071, 1076 (Fed. Cir. 1988) (“Dependent claims are nonobvious under section 103 if the independent claims from which they depend are nonobvious.”). Patent Owner has proven that independent claims 1 and 16 are nonobvious based on “decisive” and “extensive” secondary considerations evidence, and the Federal Circuit affirmed. Therefore, claims 6, 7, and 17 are nonobvious at least based on their dependency on a nonobvious independent claim.

V. THE BOARD SHOULD DENY INSTITUTION UNDER THE *FINTIV* FRAMEWORK

Patent Owner asserted the '737 Patent, as well as seven other patents, against Petitioner in *Eagle View Technologies, Inc. and Pictometry International Corp. v. Nearmap US, Inc.*, No. 2:21-cv-00283 (D. Utah). Ex.2003. As discussed below, the Board should exercise its discretion in view of *Fintiv* to deny institution under 35 U.S.C. § 314(a). *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-6 (PTAB Mar. 20, 2021) (“*Fintiv*”).

A. Factor 1 is Neutral (Likelihood of a Stay)

Fintiv factor 1 is neutral because Petitioner has not requested a stay in the district court proceeding. Given that no motion to stay has been filed, the Board should not infer the outcome of any potential motion. *See Dish Network L.L.C. v. Broadband iTV, Inc.*, IPR2020-01359, Paper 15 at 11 (PTAB Feb. 12, 2021) (“It would be improper to speculate...what the [] court might do regarding a motion to stay”).

B. Factor 2 is Neutral (Timing of Trial)

Fintiv factor 2 is neutral as Petitioner admits that “any comparison of a projected FWD date against potential trial dates is, at best, speculative.” Petition, 70. And even if the Board does issue a final written decision before the district court proceeding concludes, the ongoing district court proceeding still impacts the efficiency concerns addressed in the *Fintiv* framework. *Fintiv* at 9 (“If the court’s trial date is ... *significantly after* the projected statutory deadline, the decision whether to institute will *likely implicate other factors* ... such as the resources that have been invested in the parallel proceeding.”)

C. Factor 3 Favors Denial (Investment in Parallel Proceeding)

Factor 3 weighs in favor of denial because the parties will have invested significantly in the district court proceeding before the institution decision. The Board is projected to issue its institution decision by November 3, 2022. Before

that date, Patent Owner will have served Final Infringement Contentions on August 29, 2022, and Petitioner will have served Final Invalidity Contentions on September 16, 2022 and Final Non-Infringement Contentions on September 30, 2022. *See* Ex.2004, 1-2. That is, Patent Owner and Petitioner will have invested significantly in the merits of the invalidity positions prior to the institution decision. *See Sand Revolution II, LLC v. Cont'l Intermodal Grp.–Trucking LLC*, IPR2019-01393, Paper 24 at 10 (PTAB June 16, 2020) (the Board emphasizing that the focus of factor 3 is on the amount invested “in the merits of the invalidity positions.”). Accordingly, by the time the Board issues its institution decision, the parties will have invested significantly in the invalidity positions in the district court proceeding, thereby weighing in favor of denial.

D. Factor 4 Favors Denial (Overlap of Issues)

Factor 4 weighs in favor of denial, because Petitioner has not foreclosed the likelihood of having duplicative invalidity positions. Specifically, Petitioner has made no stipulation to avoid overlapping invalidity grounds presented in the district court proceeding and the Petition. Thus, the potential for overlap of issues favors denial.

E. Factor 5 Favors Denial (Overlapping Parties)

Factor 5 weighs in favor of discretionary denial because the same parties are involved in both proceedings.

F. Factor 6 Favors Denial (Other Circumstances)

Factor 6 weighs in favor of denial because the Board previously determined—and the Federal Circuit affirmed—that the challenged claims of the '737 patent are patentable and nonobvious based on Patent Owner's "extensive" and "decisive" evidence of objective indicia of nonobviousness. Therefore, it would be a waste of the Board's and the parties' resources to move forward with this proceeding.

Accordingly, a holistic analysis of the *Fintiv* factors shows that the *Fintiv* factors weigh in favor of discretionary denial.

VI. CONCLUSION

The Board should deny institution of the Petition for the reasons presented above.

Respectfully submitted,

Dated: August 3, 2022

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Lead Counsel for Patent Owner

VII. CERTIFICATE OF WORD COUNT

Under 37 C.F.R. § 42.24(b)(1), the undersigned attorney for the Patent Owner declares that the argument section of this Patent Owner's Preliminary Response (Sections I-VI) has 4,460 words, according to the word count tool in Microsoft Word™.

/Kyle L. Howard/
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Lead Counsel for Patent Owner

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Eagle View Technologies, Inc., § Patent Owner's Preliminary Response
Patent Owner §
 § U.S. Patent No. 9,135,737
 §

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. §§ 42.105 and 42.6, that service was made on Petitioners' counsel as detailed below.

Date of service August 3, 2022

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