

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
Patent 9,135,737 B2

Before THOMAS L. GIANNETTI, GARTH D. BAER, and
RUSSELL E. CASS, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

Nearmap US, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”), requesting an *inter partes* review of claims 1, 6, 7, 9, 10, 16, 17, 25, 26, and 34 (the “challenged claims”) of U.S. Patent No. Patent 9,135,737 B2 (Ex. 1001, “the ’737 patent”). Eagle View Technologies, Inc., (“Patent Owner”) filed a Preliminary Response to the Petition (Paper 9, “Prelim. Resp.”).

We have authority under 35 U.S.C. § 314 to determine whether to institute *inter partes* review. For the reasons discussed below, we institute *inter partes* review.

II. BACKGROUND

A. RELATED MATTERS

The ’737 patent is at issue in *Eagle View Technologies v. Nearmap US*, 2-21-cv-00283 (D. Utah). Pet. 74; *see* Paper 6, 2. The ’880 patent is also the challenged patent in IPR2016-00592. *Id.*

B. THE ’737 PATENT

The ’737 patent relates to a roof estimation system that provides a user interface configured to facilitate roof model generation based on one or more aerial images of a building roof. Ex. 1001, code (57). Figure 1 of the ’737 patent is reproduced below.

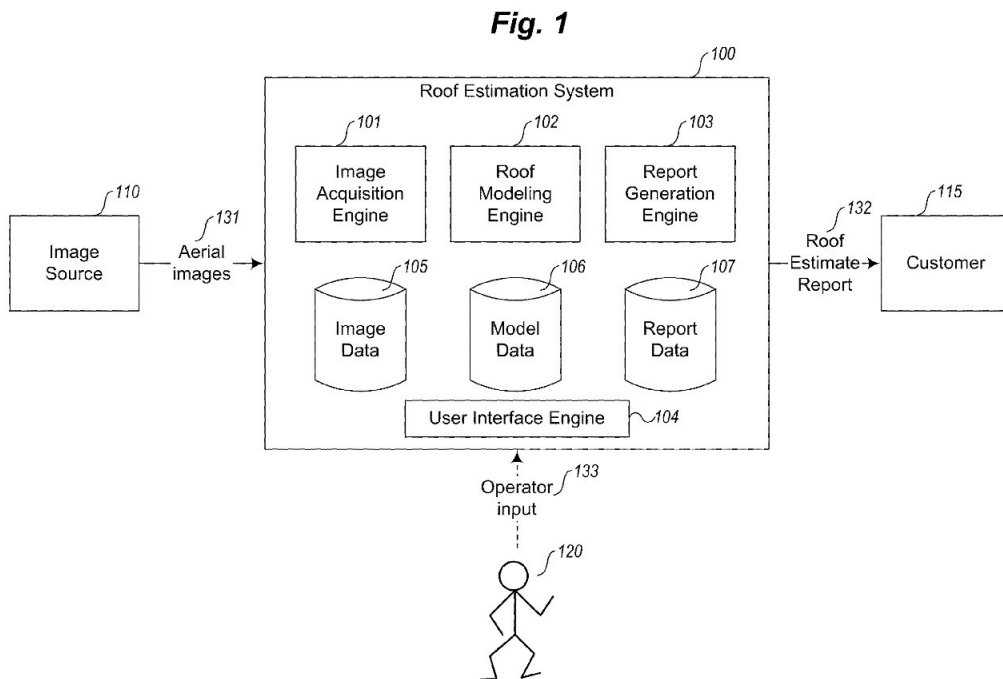


Figure 1 is a block diagram of an example Roof Estimation System (“RES”). *Id.* at 3:42–44. RES 100 includes image acquisition engine 101, roof modeling engine 102, report generation engine 103, image data 105, model data 106, and report data 107. *Id.* at 3:44–46. RES 100 is communicatively coupled to image source 110, customer 115, and operator 120. *Id.* at 3:47–48. RES 100 is configured to generate roof estimate report 132 for a specified building, based on aerial images 131 of the building received from the image source 110. *Id.* at 3:52–55.

C. CHALLENGED CLAIMS

Petitioner challenges claims 1, 6, 7, 9, 10, 16, 17, 25, 26, and 34. Of the challenged claims, claims 1, 16, and 26 are independent. Independent claim 1 is representative and is reproduced below:

1. A computer-implemented method in a roof estimate report system including at least one processor and a memory coupled to the at least one processor, the method comprising:

displaying, by the at least one processor of the roof estimate report system, a plurality of aerial images of a roof at the same time, each of the aerial images providing a different view, taken from a different angle of the same roof;

displaying, by the at least one processor of the roof estimate report system, respective line drawings representing features of the roof, the respective line drawings overlying a first and a second aerial image of the plurality of aerial images of the roof, the line drawing overlying the first aerial image of the roof having features in common with the line drawing overlying the second aerial image of the roof;

in response to user input, changing, by the at least one processor of the roof estimate report system, the line drawing representing a feature of the roof that overlies the first aerial image of the roof;

in response to the changing, making corresponding changes, by the at least one processor of the roof estimate report system, to the line drawing overlying the second aerial image; and

generating and outputting a roof estimate report using a report generation engine, wherein the roof estimate report includes numerical values for corresponding slope, area, or lengths of edges of at least some of a plurality of planar roof sections of the roof, wherein the generated roof estimate report is provided for repair and/or constructing the roof structure of the building.

Ex. 1001, 23:55–24:19.

D. ASSERTED GROUNDS OF UNPATENTABILITY

Petitioner asserts the following grounds of unpatentability. Pet. 2.

References	Basis	Challenged Claims
Heller ¹ , Quam ²	§ 103	1, 6, 7, 9, 10, 16, 17, 25, 26, 34
Heller ³ , Quam, Deaton	§ 103	1, 6, 7, 9, 10, 16, 17, 25, 26, 34

III. ANALYSIS

A. DISCRETIONARY DENIAL BASED ON *FINTIV*

Patent Owner asserts that we should deny institution 35 U.S.C. § 314(a), in deference to the related District Court Litigation. *See* Prelim. Resp. 22–25. Petitioner disagrees. Pet. 68–73.

Under 35 U.S.C. § 314(a), the Director has discretion to deny institution of review. *See SAS Inst., Inc. v. Iancu*, 138 S. Ct. 1356 (2018) (“[Section] 314(a) invests the Director with discretion on the question whether to institute review.” (emphasis omitted)); *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (“[T]he PTO is permitted, but never compelled, to institute an IPR proceeding.”).

¹ Heller, “The Site-Model Construction Component of the RADIUS Testbed System,” in Proceedings: ARPA Image Understanding Workshop (1997) (Ex. 1004, “Heller”).

² Quam, “The Radius Common Development Environment,” in RADIUS: Image Understanding for Imagery Intelligence (1997) (Ex. 1005, “Quam”).

³ U.S. 2006/0235611, Pub. Oct. 19, 2006 (Ex. 1006, “Deaton”).

One instance when the Board considers exercising this discretion is when there is an early trial date in related litigation as part of assessing all relevant circumstances, including the merits, to balance considerations such as system efficiency, fairness, and patent quality. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv* Order”); *NHK Spring Co. v. Intri-Plex Technologies, Inc.*, IPR2018-00752, Paper 8 at 19–20 (PTAB Sept. 12, 2018) (precedential). The Board evaluates six factors when making this assessment. *See Fintiv* Order, at 5–6. Further, “the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at 6.

On June 21, 2022, the Director issued an Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court Litigation (“Interim *Fintiv* Guidance”).⁴ The Interim *Fintiv* Guidance provides “several clarifications” to “the PTAB’s current application of *Fintiv* to discretionary denial where there is parallel litigation” in response to comments received from stakeholders in response to a Request for Comments (RFC). Interim *Fintiv* Guidance 2.

Turning to the *Fintiv* factors, Petitioner asserts that “[t]he Court has not yet set a date for the claim construction hearing, and the scheduling order indicates that it will not set a trial date until 14 days after its claim construction ruling.” Pet. 70 (citing Ex. 1013). Patent Owner does not dispute this. Prelim. Resp. 23. Therefore, the district court trial will likely

⁴ The Interim *Fintiv* Guidance is available at https://www.uspto.gov/sites/default/files/documents/interim_proc_discretionary_denials_aia_parallel_district_court_litigation_memo_20220621_.pdf.

occur after our final written decision in this proceeding, and factor 2 (timing of trial) weighs against exercising discretion to deny institution. The litigation also is in a relatively early stage because, the parties appear to have just completed exchanging infringement and invalidity contentions and no claim construction hearing has occurred. Pet. 71–72; Prelim. Resp. 23–24. Therefore, factor 3 (investment in the district court litigation) also weighs against exercising discretion to deny institution.

Additionally, because this case is in a relatively early phase, the district court will have the ability to determine whether to stay the District Court Litigation in favor of this IPR (factor 1). Pet. 69–70. Further, because our final written decision will likely occur before trial in the District Court Litigation, the overlap in parties (factor 5) and any overlap in issues (factor 4) do not weigh in favor of exercising discretion to deny institution. Finally, we determine that the sixth *Fintiv* factor (other circumstances) is neutral. Accordingly, we decline to exercise our discretion to deny institution.

B. DENIAL BASED ON IPR2016-00592

A different petitioner challenged the same patent at issue in this case in IPR2016-00592.⁵ In that case, the Board found secondary considerations of nonobviousness decisive in concluding that the petitioner had not shown the challenged claims were unpatentable. *See* Ex. 1010, 34–35. Ultimately, the Federal Circuit affirmed the Board’s decision. Ex. 1016, 2–3.

In this case, Patent Owner argues we “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

⁵ In this case, Petitioner challenges three additional dependent claims—claims 6, 7, and 17—that were not at issue in IPR2016-00592.

Circuit agreed.” Prelim. Resp. 7–8. In particular, Patent Owner notes that in IPR2016-00592, the Board found the challenged claims were nonobvious in light of Patent Owner’s evidence of commercial success of and industry praise. *Id.* at 9. “The Board also determined,” Patent Owner explains, “that there was ‘extensive evidence’ of nexus between the challenged claims and the secondary considerations evidence.” *Id.* (quoting Ex. 1010). We should deny institution, according to Patent Owner, because “[n]one of the decisive and extensive evidence the Board relied on to find the claims patentable and nonobvious has changed.” *Id.* (quotation marks omitted).

We decline to deny institution based only on the Board’s secondary-considerations conclusion in a previous case. In IPR2016-00592, the petitioner failed to rebut a presumption of nexus that arose because Patent Owner’s products were found by the panel to be coextensive with the challenged claims based on the evidence and arguments presented there. Ex. 1010, 27–34. Here, even if Patent Owner is correct that none of the information establishing nexus has changed, Petitioner should be afforded an opportunity to present its own evidence and argument to rebut that presumption at trial.

In addition, the Board weighs secondary considerations against the scope and content of the asserted prior art and any differences between the asserted art and the challenged claims. *See WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1328 (Fed. Cir. 2016) (explaining that “the strength of each of the *Graham* factors must be weighed in every case and must be weighted en route to the final determination of obviousness or non-obviousness”). In IPR2016-00592, after considering the asserted prior art, the Board noted that it found “certain aspects of” the petitioner’s “obviousness allegations to be at

best a close call.” Ex. 1010, 34. Although the panel concluded that there, secondary considerations were “decisive,” it did so only as after weighing petitioner’s obviousness challenge in that case. *Id.* at 34–35. Here, Petitioner challenges the ’737 patent based on references and supporting evidence that are different from the references and supporting evidence in the previous case. *Compare* Pet. 2, *with* Ex. 1010, 5. Because this case involves different patentability challenges than those in IPR2016-00592, we decline to deny the Petition based on the Board’s secondary-considerations analysis in that case.

For the foregoing reasons we decline to deny institution based on our secondary-considerations analysis in IPR2016-00592.

C. OBVIOUSNESS ANALYSIS

1. Level of Skill in the Art

Petitioner contends a person of ordinary skill in the art at the time of the ’737 patent “would have had at least a Bachelor’s Degree in an academic area emphasizing the design of electrical, computer, or software technologies, or a similar discipline, and at least two years of experience related to computerized image analysis and three-dimensional modeling.” Pet. 4–5. Further, “education could compensate for a deficiency in work experience, and vice-versa.” *Id.* at 5. At this stage, Patent Owner does not provide a description of the person of ordinary skill.

Petitioner’s description is consistent with the prior art and patent specification before us and is supported by credible expert testimony. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (prior art itself may reflect an appropriate level of skill). For the purpose of our decision, we adopt Petitioner’s description.

2. Claim Construction

We find no claim terms require express construction for us to determine whether to institute *inter partes* review. See *Realtime Data, LLC v. Iancu*, 912 F.3d 1368 (Fed. Cir. 2019) (“The Board is required to construe ‘only those terms . . . that are in controversy, and only to the extent necessary to resolve the controversy.’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

3. Description of Prior Art References

a. Heller (Ex. 1004)

Heller discloses a “the RADIUS model-supported image exploitation paradigm,” that “creat[es] a 3-dimensional model that captures the basic geometry of the site under examination.” Heller’s Figure 4 is reproduced below.

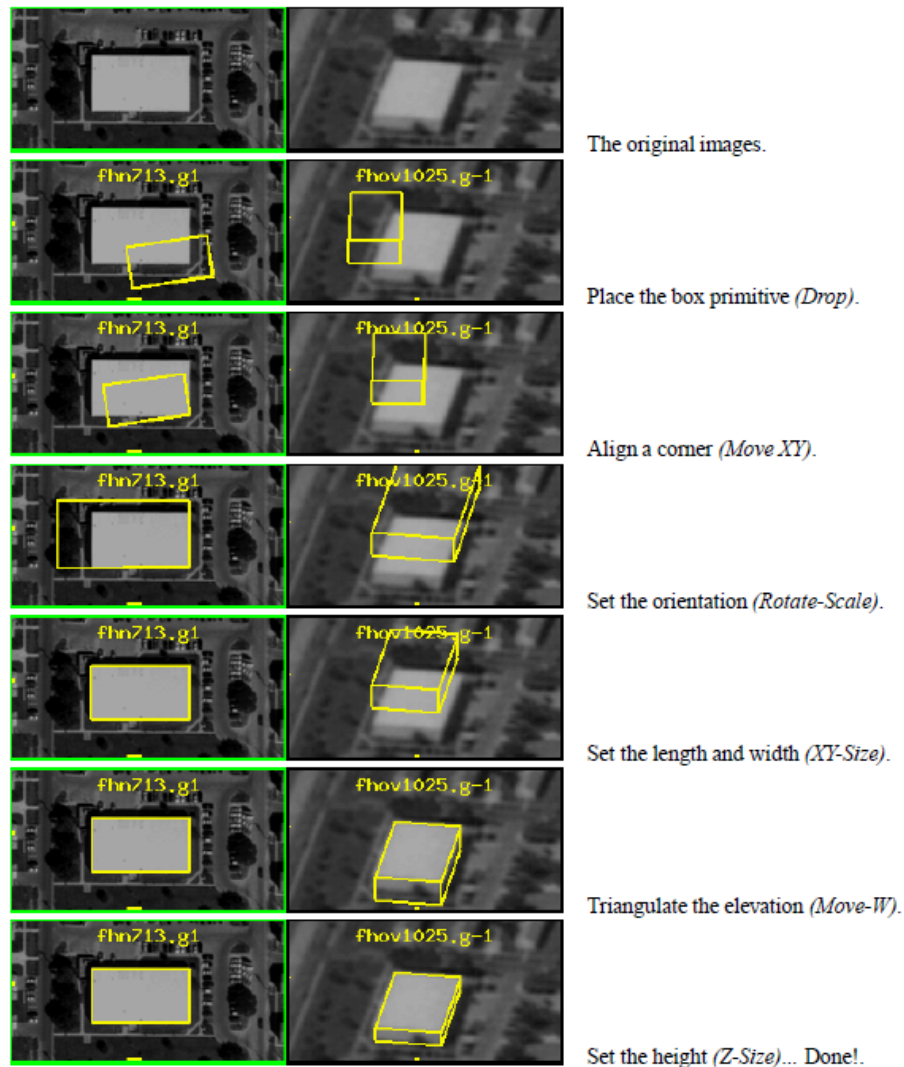


Figure 4 shows “[t]he sequence of adjustments used to manually model a building.” *Id.* at 6.

b. Quam (Ex. 1005)

Quam describes the “RADIUS Common Development Environment,” which “provides the foundation for the RADIUS Testbed System.”

Ex. 1005, 1. Quam teaches RADIUS’s image registration process, which is “the process of determining and/or refining the internal and external parameters (e.g., position, orientation) of the sensor used to acquire the image.” *Id.* at 14. Quam also provides descriptions and screenshots of a

“Registration Tool” that “lead[s] the user through the necessary steps to register a new image.” *Id.* at 14–15, Figs. 8, 9, 10.

c. Deaton (Ex. 1010)

Deaton describes “a roof inspection system” that generates and outputs various reports. Ex. 1006 ¶ 10.

4. Petitioner’s Proposed Combinations

Petitioner corresponds the RADIUS system, as described in Heller and Quam, to the ’737 patent’s claimed computer-implemented, roof-estimation system. *See* Pet. 19–50. Petitioner describes its proposed combination as “Heller’s ‘RADIUS Testbed System’ (RTS) . . . implemented using the advantageous implementation details and other information about the ‘RADIUS Common Development Environment (RCDE)’ described by Quam, providing a beneficial implementation environment for the site modeling operations described in Heller.” *Id.* at 16. According to Petitioner, a skilled artisan “would have been motivated and found it obvious to implement Heller’s ‘RADIUS Testbed System (RTS)’ using the implementation details and other information about the ‘RADIUS Common Development Environment (RCDE)’ described by Quam,” because “Heller and Quam both describe portions of the ‘RADIUS’ site modeling platform.” *Id.* at 17. Further, Patent Owner explains, Quam provides “practical implementation details of the [RADIUS] system” that are not specified in Heller. *Id.*

Petitioner’s second asserted grounds mirror its first, except that Petitioner adds Deaton for its explicit teaching of producing a roof estimate report. *See id.* at 50–51. According to Petitioner, one skilled in the art would have been motivated to combine Deaton with the Heller-Quam

system because “including the production of such a report . . . would advantageously enable the site models described in Heller and Quam to be utilized to plan and execute maintenance, repair, and new construction projects, thereby increasing the utility of the combined system.” *Id.* at 51.

In sum, Petitioner provides a detailed analysis corresponding each challenged claim element to relevant disclosures in Heller and Quam. *See id.* at 19–55. Patent Owner does not challenge Petitioner’s substantive analysis in its Preliminary Response. We have reviewed Petitioner’s arguments and the underlying evidence cited in support and are persuaded that, at this stage, Petitioner sufficiently demonstrates that the challenged claims would have been obvious over the asserted prior art.

IV. CONCLUSION

For the foregoing reasons, we have determined that there is a reasonable likelihood that the Petitioner would prevail with respect to at least one of the claims challenged in the Petition. We therefore institute trial as to all challenged claims on all grounds stated in the Petition. We decline also to exercise our discretion to deny institution under 35 U.S.C. § 314(a).

V. ORDER

Accordingly, it is:

ORDERED that *inter partes* review of claims 1, 6, 7, 9, 10, 16, 17, 25, 26, and 34 of the ’737 patent is instituted on all grounds in the Petition;

FURTHER ORDERED that pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4, notice is hereby given of the institution of a trial; the trial will commence on the entry date of this decision.

IPR2022-00734
Patent 9,135,737

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