

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEARMAP US, INC,
Petitioner,

v.

PICTOMETRY INTERNATIONAL CORP.,
Patent Owner.

IPR2022-00733 (Patent 8,542,880 B2)
IPR2022-00734 (Patent 9,135,737 B2)

Record of Oral Hearing
Held: August 8, 2023

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

IPR2022-00733 (Patent 8,542,880 B2)

IPR2022-00734 (Patent 9,135,737 B2)

APPEARANCES:

ON BEHALF OF THE PETITIONER:

W. KARL RENNER, ESQUIRE
THOMAS ROZYLOWICZ, ESQUIRE
CRAIG A. DEUTSCH, ESQUIRE
YAO WANG, ESQUIRE
Fish & Richardson P.C.
1000 Maine Avenue SW
Washington, D.C. 20224

ON BEHALF OF THE PATENT OWNER:

KYLE L. HOWARD, ESQUIRE
GREGORY WEBB, ESQUIRE
JONATHAN BOWSER, ESQUIRE
Haynes and Boone, LLP
Dallas-North
6000 Headquarters Drive
Suite 2000
Plano, Texas 75024

The above-entitled matter came on for hearing on Tuesday, August 8, 2023, commencing at 1:00 p.m. EDT, by video/by telephone.

1 P R O C E E D I N G S

2 - - - - -

3
4 JUDGE BAER: Good afternoon, everyone. This is our hearing for
5 IPR 2022-00733, that's addressing Patent Number 8,542,880 and IPR 2022-
6 734 that addresses Patent 9,135,737. The Petitioner in these cases is
7 Nearmap and the Patent Owner is Pictometry International in the 733 case
8 and Eagle View Technologies in the 734 case. If we could, let's go ahead
9 and get the parties appearances please. Who do we have for Petitioner?

10 MR. ROZYLOWICZ: Yes, Your Honor. My name is Tom
11 Rozylowicz for Petitioner Nearmap. I'm joined today by my colleagues,
12 Karl Renner, Craig Deutsch, and Yao Wang.

13 JUDGE BAER: And will just you and Mr. Wang be presenting?

14 MR. ROZYLOWICZ: Your Honor, Mr. Deutsch will be presenting
15 to the 880 patent and Dr. Wang will be setting -- I'm sorry, Dr. Wang will be
16 presented to the 880 patent and Mr. Deutsch will be presenting to the 737
17 patent.

18 JUDGE BAER: And will you be presenting at all?

19 MR. ROZYLOWICZ: Your Honor, possibly on rebuttal, but
20 otherwise, Mr. Deutsch and Dr. Wang will handle their respective patents.

21 JUDGE BAER: Great, thank you. And who do we have for Patent
22 Owner, please?

23 MR. HOWARD: Good morning, Your Honor. This is Kyle Howard,
24 the lead counsel for Patent Owner. And I'm joined today by my colleagues
25 Gregory Webb, as well as Jonathan Bowser. Mr. Webb will be presented on

1 the 880 patent, and Mr. Bowser will be presenting on the 737 patent, Your
2 Honor.

3 JUDGE BAER: Great. Thank you. We'll try and keep everybody
4 straight. We got a lot of people involved here. Welcome to everyone. It's
5 good to have you up here, we certainly appreciate you making the effort to
6 do this. We set forth the procedure for the hearing in our trial order, but just
7 to remind everybody of how this is going to work, the parties are each going
8 to have 60 minutes of total time to present their arguments in both cases.

9 In addition, we have Mr. Wang, the LEAP practitioner, we are glad
10 to have you here and glad to have you participate in that program. We're
11 going to give Petitioner another 15 minutes to accommodate that.

12 But we do have the full record and the slides that you filed, so we can
13 follow along, but it would be helpful so that we can keep the record clear, if
14 you would let us know what slide you're referring to, or if you're referring to
15 an exhibit, a page number, that sort of thing, if you would make that clear, so
16 we can keep the record straight, that would be helpful.

17 In addition, if you would mute your mic when you're not speaking,
18 and if it's been some time since you've spoken, if you would please identify
19 yourself so our court reporter can keep the parties and the people straight.

20 There is a public line here, and I know we do have some confidential
21 material that you could get into on the 734 case. I've looked through the
22 material, and it appears to me that the only confidential material is the actual
23 sales numbers, and the pictures from the software, the actual proprietary
24 software. So it is my hope that we can get through this without getting into
25 any confidential information.

1 You can refer to exhibit numbers, you can refer to your briefs, but if
2 we could get through this without actually mentioning those numbers, you
3 can just say the number on page, or the picture on page, that would be
4 helpful. If you feel like you can't do that, and we just have to do it, please
5 let me know, and we can clear the public line. But again, we have all that
6 information in front of us and it seems to me we can address the substance of
7 the secondary considerations argument in the 734 case without getting into
8 any actual confidential information in the transcript. With that, are there any
9 questions from Petitioner's counsel?

10 MR. ROZYLOWICZ: No, Your Honor, I think that's pretty much
11 consistent with our expectations for how we planned to speak to that portion
12 of the record.

13 JUDGE BAER: Great. And are there any questions from Patent
14 Owner's counsel?

15 MR. HOWARD: No, Your Honor.

16 JUDGE BAER: Great. With that, we are ready to begin. Let's start
17 with Petitioner. Who will be presenting first for Petitioner? I assume it will
18 be Mr. Deutsch?

19 MR. ROZYLOWICZ: Yes, Your Honor, it will be Mr. Deutsch
20 speaking first to the 737 patent.

21 JUDGE BAER: Great. Mr. Deutsch, would you like to reserve any
22 of your 45 minutes, excuse me, any of your 60 minutes for rebuttal time?

23 MR. ROZYLOWICZ: Your Honor, I think collectively between Mr.
24 Deutsch and Dr. Wang, I think we planned to speak to looking at it as 75
25 minutes, I think we planned to spend 25 minutes on each of the 737 patent

1 and 880 patent, and reserve approximately the outstanding 25 minutes for
2 rebuttal.

3 JUDGE BAER: Okay. And I certainly won't hold you to that. You
4 know, if you want, I will try to give you a reminder when you're getting
5 towards your rebuttal. So, and you're right, it is 75 minutes. Thanks for
6 that. So, we'll aim for 50 and 25, is that what you said?

7 MR. ROZYLOWICZ: Yes, Your Honor.

8 JUDGE BAER: All right. So, I will give you a warning at 50
9 minutes. And, with that, we are ready to begin when you're ready to begin.
10 Go ahead and start when you're ready.

11 MR. ROZYLOWICZ: Thank you. And with that, Your Honor, I'll
12 let Mr. Deutsch take the floor.

13 MR. DEUTSCH: Thank you, Your Honor. I'm Craig Deutsch for
14 Petitioner. I plan on speaking to the 737 patent. The 737 patent was the
15 subject of previous final written decision. The record before us today,
16 however, is very different.

17 Regarding the obviousness grounds, Patent Owner disputes only a
18 subset of limitation 1.5 and as to secondary considerations, Fox Factory
19 clarified the requirements demonstrating co-extensiveness after the previous
20 737 decisions, and the record in this case includes additional evidence
21 demonstrating the lack of nexus and was not considered in the previous
22 proceeding.

23 So, I'd like to start out very briefly touching on interpretation of
24 limitation 1.5, discuss the combinations set forth in the petition, how they
25 address each aspect of limitation 1.5, and then turn to secondary
26 considerations.

1 Starting with Slide 4, limitation 1.5 is shown on the left side of the
2 slide. Patent Owner has alleged that the petition alleged that the entirety of
3 limitation 1.5 should not be entitled to any patentable weight, but that's not
4 really what the petition argues. And, the element by element analysis shows
5 where features of 1.5 not directed to content are disclosed in the prior art.
6 The petition pointed out the prior analysis by the Board, which is shown on
7 the right side of Slide 4 which noted that three-sided content does not
8 distinguish over generating and displaying any graphical or textural
9 information.

10 Turning ahead to Slide 5, and this is on the right side of Slide 5,
11 when deposed, Dr. Forsyth reiterated that the prior art addresses 1.5. and I'd
12 like to turn to that article in more detail. Heller, Quam, and Deaton and how
13 these references fit together. And to do so, I think we can turn directly to
14 page 12 of the petition which provides an overview of the Heller reference.

15 Heller describes, and this is quoted at page 12 of the petition. Heller
16 describes various aspects of the radius system which is a software platform
17 that enables the creation of a three-dimensional model that captures the basic
18 geometry of a site under examination. Such as a house or a commercial
19 building, based on analysis of images of the site. Heller also describes a
20 number of brand-new shapes or primitives that are used to model buildings
21 and structures.

22 And continuing down the petition to page 14, Heller shows steps to
23 manually model building using the box primitive. Page 15 of the petition
24 discusses Quam. Quam describes the RCDE or Radius Common
25 Development Environment, which is a portion of the radius platform that

1 provides a foundation for the radius test bed system that's described in
2 Heller.

3 And as further described on page 15 of the petition, Quam provides
4 additional details on aspects of the radius platform that's described in Heller.
5 There is no dispute as to the combination of Heller and Quam which both
6 describe the same system.

7 But, turning back to the slides, Slide 18, in ground 2, the petition sets
8 forth the reasons why a person of skill in the art would have combined
9 Heller and Quam's system with Deaton, in order to avail Heller and Quam's
10 system to Deaton's suggestions of various first reports such as the project
11 report. The Heller Quam system provides the software and site models and
12 in the combined system, which is explained at the bottom left of Slide 18,
13 this system is used to generate and output a roof estimate report consistent
14 with Deaton's description of roof reports.

15 Returning to the right side of Slide 18, and digging a little further into
16 Deaton, Deaton provides a roof estimate report through this description of its
17 project report and other reports. The project report as described to include
18 specification details and work items for repairing or replacing infrastructure
19 and Deaton further describes numerical values and parameters that are
20 included in the report. These include --

21 JUDGE BAER: Mr. Deutsch?

22 MR. DEUTSCH: Yes.

23 JUDGE BAER: To get into the details of this a little bit, is there any
24 system that could generate a roof estimate report, that would not include a
25 report generation engine? In other words, once we get the report, do we
26 always, always, always have a roof report generation engine?

1 MR. DEUTSCH: Yes, thank you, Your Honor. I think, so in this
2 case, the -- we had identified the software and the RCDE system that
3 generates the report as the roof generator engine. And you're right, there's
4 nothing specific that Patent Owner points to as additional that's required by
5 that limitation. And so, I think in the instant case, its satisfied by Heller and
6 Deaton's description of those software components and that generate and
7 output this information. And that's also consistent with the 737 specification
8 itself.

9 JUDGE BAER: Thank you.

10 MR. DEUTSCH: One other issue that Patent Owner has taken,
11 argued against, and this is turning to Slide 11, is generating an outputting
12 aspect, generating, and outputting a roof estimate report using a report
13 generation engine. But, you know, in addition to what I've mentioned a
14 moment ago, the petition did describe these aspects of the RCDE system
15 which is the software that generates and outputs particular roof data in
16 graphical and textual form.

17 And digging into that data a little bit further, again, on Slide 11,
18 Quam provides examples of this, such as information associated with the
19 contour map function, the map grip function, the text function. And so,
20 through all these teachings, a person of skill in the art would have
21 understood that Heller and Quam system and the Heller Quam Deaton
22 system generates and outputs a roof estimate report.

23 And these actual disclosures of Heller and Quam aren't meaningly
24 disputed in Patent Owner's briefing. There is complaints about this being
25 improper new argument, but these features of Heller and Quam were

1 discussed in the original analysis of the petition, discussed further in the
2 reply. They just haven't been engaged with. I'm going to --

3 JUDGE BAER: Would you get into the intended use limitation? I
4 remember seeing that in the Deaton reference, but in the first combination
5 that the, Heller, Quam, you assert that Heller Quam teaches the sort of the
6 intended use limitation which is the for use in limitation?

7 MR. DEUTSCH: Yes, yes. Thank you, Your Honor. So, you're
8 correct. First goes to ground 2, there is no dispute in the combination with
9 Deaton. That's satisfied through Deaton's additional exposure. Even as to
10 ground 1 though, the -- we think the petitions analysis demonstrated that.
11 That was a description that was set forth in the petition because the Heller
12 Quam system generates and outputs information that's relevant to roof
13 repair.

14 Now I'll turn briefly on that point to Slide 13. Dr. Forsyth provide
15 additional testimony on this point including as shown here at paragraph 19
16 of Exhibit 1041, and he had explained that the Heller and Quam system
17 provides information about the geometry of roof structures and would have
18 informed the viewer as to parameters for estimating and implementing roof
19 repair and construction activities. And so even in ground 1, giving full
20 treatment to that last phrase of 1.5, we think ground 1 has satisfied that
21 through Heller and Quams description that was set forth in the petition.

22 So, I can turn next, if there's no further questions on that point, to the
23 combination with Deaton and the motivation to align with the Heller and
24 Quam system. And that's something, turning to Slide 19, Patent Owner
25 hasn't directly addressed the acting teachings and combination that's
26 proposed by the petition.

1 On the top left of Slide 19, there's an excerpt from page 29 of the
2 POR which I think is worth taking a quick look at, where Patent Owner
3 focuses on paragraph 10 of Deaton. But the petitions analysis is not limited
4 to paragraph 10 of Deaton. Instead, there's other discussion, particularly
5 paragraph 107, that talks about the Kreft report that the POR's analysis of
6 1.5A just doesn't address.

7 And then in sur reply, which is excerpted at the bottom left of Slide
8 19, Patent Owner alleges that Petitioner does not attribute any teaching of
9 Deaton to a report generator engine. And again, this is something that we go
10 back to the petition and the actual combination, and as explained in our
11 reply, Heller and Quam that provide these features and that would have been
12 enhanced to generate and output reports based on Deaton's suggestion
13 regarding his reports.

14 So, I'll dig into those motivations to combine Deaton with Heller a
15 little bit more. The, you know, first Patent Owner hasn't disputed the
16 predictable advantages that would have been recognized by a person of skill
17 in the art, and motivated the combination. Again, in the Patent Owner
18 response, the focus is on Deaton's reports having descriptions that they're
19 based on a manual, onsite physical inspection. But, in making that
20 argument, Patent Owner has not addressed the teachings of the reports
21 themselves and the predicable benefits that a person of skill in the art would
22 have taken away from Deaton.

23 Turning to Slide 21, as set forth in the petition and Dr. Forsyth's first
24 declaration, and this is at the top right of Slide 21, including the production
25 of a report described by Deaton and the system resulting from the
26 combination of Heller and Quam would have advantageously enabled the

1 site models describe in Heller and Quam to be utilized (inaudible) and
2 execute maintenance repairs and construction products. And in doing so,
3 would increase the utility of the combined system.

4 Turning to Slide 22, I'd like to touch on Patent Owner's argument
5 and its response that Deaton has corrected the collecting roof measurement
6 information based on the physical inspection of a roof onsite unless Keller
7 and Quam that are directed to creating 3D models based on images. Again,
8 this argument mischaracterizes the combination and is premised on bodily
9 incorporation of onsite physical inspection of the roof.

10 But, when properly considering the combination as its set forth in the
11 petition, a person would not be compelled to blindly require onsite physical
12 inspection to the exclusion of Heller and Quam's original modeling solution.
13 And this is something that's responsive to Patent Owner's assertions, our
14 Petitioner's reply, reiterated the combination and Dr. Forsyth provided
15 additional testimony which is excerpted at the right of Slide 22 where he
16 explained that the predictable benefits of implementing Deaton's suggestions
17 related to its roof reports would have been recognized without requiring
18 onsite physical inspection. And this is especially the case because Heller
19 and Quam already models roof structures and inputs -- outputs information
20 about the structures.

21 And further to that point, and again, consistent with the combination
22 and motivation that were set forth in the petition, Dr. Forsyth explained
23 additional description in Deaton, and this is shown in the bottom left of Slide
24 22, of benefits of reducing expensive and labor intensive operations
25 associated with recording of information related to the repair and the

1 replacement of infrastructure and a subsequent generation of reports using
2 this information.

3 So, the utility of Heller and Quam would have been enhanced in
4 these advantages that were demonstrated in Deaton itself are furthered by the
5 combination as its set forth in the petition. So, with that, if there are no
6 further questions on the art and combinations, I'd like to turn to discussion of
7 secondary considerations.

8 JUDGE BAER: That would be helpful, thanks.

9 MR. DEUTSCH: And we can turn first to Slide 26 and I'll start out
10 noting that in the prior IPR, the decision found that the Petitioner did not
11 present evidence to rebut Patent Owner's secondary considerations. The
12 record here is very different though. Here there is extensive evidence
13 demonstrating additional unclaimed features of the alleged (inaudible)
14 products. There's also evidence demonstrating the lack of nexus, both in the
15 form of documentary evidence and testimony from Patent Owner's own
16 declarant.

17 So, first turning to Slide 26, there -- Patent Owner is not entitled to a
18 presumption of nexus here, because there is no evidence that Render House
19 and Twister are coextensive. The products include significant unclaimed
20 features that are not recited by the 737 claims. And this is something that's
21 highlighted by Patent Owner's own analysis shown on Slide 26. The law
22 requires that the patentee demonstrate that the product is essentially the
23 claimed invention as set forth in Fox Factory. But Patent Owner relies on an
24 analysis that merely attempts to show that the products embody the
25 challenged claims.

1 Now, Fox Factory is subsequent to the earlier 737 decisions,
2 demonstrates a need for more proof, but Patent Owner here relies on the
3 earlier 737 decisions without addressing this update in the law. And Fox
4 Factory provides further explanation not on this slide, but that is cited in the
5 reply at page 13. The decision explained that a product is not co-extensive
6 with the patented invention, for example if the patented invention is only a
7 component of a commercially successful machine or process, where the
8 product includes a critical unclaimed feature, not covered by the independent
9 claims for example. The claims are not coextensive.

10 JUDGE GIANNETTI: Counsel, on Slide 26, are you making a
11 distinction between “embodied the challenged claims” and “essentially the
12 claimed invention”? And if so, what do you see as the difference between
13 those two terms?

14 MR. DEUTSCH: Yes, thank you, Your Honor. So, there is --
15 making a distinction between framework that is called for in Fox Factory
16 and the Patent Owner’s analysis. And Patent Owner’s analysis relies on
17 merely embodying the challenge claims. But that’s not enough.

18 JUDGE GIANNETTI: And by that you mean that the claims read on
19 the product, is that what you're saying?

20 MR. DEUTSCH: Yes. Yes, thank you for clarifying. And that's the
21 analysis that they go through, they have testimony that -- from their expert,
22 Dr. Bajaj, that attempts to show that the Twister and Render House products
23 include each elements of the 737 claims. But what his analysis and what
24 Patent Owner’s analysis does not do is address the full scope of these
25 embodying products and the question of whether there are additional critical

1 features that would demonstrate that a presumption of nexus is not
2 appropriate.

3 JUDGE GIANNETTI: But you would agree that at least as a first
4 step, they have to show that the claims read on the product, is that right?

5 MR. DEUTSCH: Right. That's correct. And so it's not --

6 JUDGE GIANNETTI: That's not sufficient, is that what you were
7 saying? It's a necessary but not sufficient addition?

8 MR. DEUTSCH: I think that's right. Correct. Our argument is that
9 --

10 JUDGE GIANNETTI: What --

11 MR. DEUTSCH: --they're wrong to show that it embodies the
12 challenged claims but that's not enough to provide the analysis that's
13 required set forth in the final (inaudible).

14 JUDGE GIANNETTI: But would you agree that at least they've
15 fulfilled that first condition? That they have demonstrated that the product
16 embodies the claim in the sense that the claims read on the product, or are
17 you challenging that?

18 MR. DEUTSCH: I think as to independent Claim 1, you know, the
19 focus of our analysis is not that they haven't shown that they -- that the
20 Twister and Render House products embody the challenged claims. They
21 haven't done so for some of the dependent claims, like Claim 9, there is --
22 there is a dispute whether that claim is embodied by the Twister and Render
23 House products.

24 But, right. The issue is in the additional requirements that need to be
25 demonstrated, they've fallen short and haven't taken that next step. Because
26 there are additional features of these products, and they're significant. The

1 evidence demonstrates that they're critical to the way these products operate
2 and how they're received by users.

3 JUDGE BAER: And that's the thing --, this is Judge Baer, Mr.
4 Deutsch, to be clear, those two features are pitch determination and allowing
5 input of location, is that correct? Did I miss any or are there more or do I
6 have them correct?

7 MR. DEUTSCH: Those are the two features that we have focused
8 on. And to be clear, I think the, you know, the full scope of the Twister and
9 Render House products is ambiguous and we don't have full visibility into
10 that. And so I think, you know, it's possible there are additional features that
11 Dr. Bajaj, in his testimony said he didn't look into the scope. He described
12 the software as both complicated and having many, many components. Yes,
13 those were two that are clear in their briefing and other proceedings and also
14 clear in the manuals for the software and are important --

15 JUDGE BAER: To the extent there are other unknown critical
16 features, you would agree, wouldn't you, that the burden would be on you to
17 identify those. Right. Once we have something that is a claim reads on the
18 product if you will, it is up to you, as the patent challenger or the challenger
19 to the secondary considerations to show critical features that are unclaimed.
20 Would you agree? That is, if there are some that we're not aware of, because
21 we just don't have that information, that burden would be on you to produce
22 those, to find those?

23 MR. DEUTSCH: I think -- so I guess I'm not sure that that is the
24 case here where and there is limited ability for Petitioner to do that. We're
25 talking about Patent Owner's products. And so they haven't met that burden
26 of the framework of showing that there is not additional features such that

1 they're coextensive. And that's the piece, it's not enough to meet the
2 standard simply to show its embodied, and then at that point, the burden
3 shifts to the Petitioner to deal with the other elements or the other factors
4 here. I think --

5 JUDGE BAER: Let's address the criticality of its determination and
6 allowing the location. So the question as I understand it from Fox Factory is
7 whether those things are critical. And Fox Factory has this discussion, brake
8 pads being not -- sorry, being -- things outside of brake pads are critical to
9 an automobile. Is there any more case law that will help us to determine
10 whether something is critical or not? Whether unclaimed features are
11 critical or not?

12 MR. DEUTSCH: So, I think, I mean, we can provide some case law
13 at the moment. I guess before turning to the case law, I would point to some
14 of the facts in the record about the significance of these, which I think are
15 helpful in that or even aside from where that line is. We're in a zone in this
16 case, where it's very clear the significance of that to users of the reports, and
17 that's something that's reflected in the manuals themselves which, you
18 know, I'll refrain from getting too deep into that, because that's been
19 designated by the other side as confidential, but there is language in how
20 they, the manual describes pitch determination.

21 It's something that appears in Patent Owner's exhibits related to
22 industry praise for example, and so one example of this is Exhibit 1026,
23 which is one of the exhibits Patent Owner cites to for praise, and on page 3
24 of Exhibit 1026, one the features that they talk about is pitch determination.
25 Well, that's something that is the subject both kind of from a functional
26 standpoint that's important to users, it's been the source of praise for users of

1 the reports. And so, I think that's kind of the zone we're in where there's this
2 set of evidence that demonstrates the significance of it to the users of the
3 reports. And that I think, you know, once we're out of that zone, where there
4 isn't co-extensiveness and there's no presumption of nexus --

5 JUDGE BAER: Well, let's, I'd like to back up. First of all, you're
6 about 25 minutes in which would be about half of your time, but I think this
7 is the critical issue where I'd like to spend a little bit more time. And on this
8 criticality question. Again, in Fox Factory, we have the example of brakes
9 in the automobile. Do we have any other case law examples? Because this
10 does not strike me as a case where the software are the brakes, right? And,
11 excuse me, the patent is the brakes and the software is the automobile.
12 There is a huge difference between what's claimed and the secondary
13 considerations, what they're addressing, right. So, is there any other case
14 law where you can -- that you can point me to that will help me to
15 understand what it takes for something to be critical such that even though
16 claims read on the product, that they are not coextensive?

17 MR. DEUTSCH: Yes, that's something I can review and provide
18 additional case law on that. I think other portions of Fox Factory are also
19 helpful in terms of the facts of that issue in that case as well. I mean, the
20 fact that the things like pitch determination are the subject of other patent
21 claims also goes to that question as well, as opposed to being a feature that's
22 not critical, that's just a trivial additional thing. Which it might not rise to
23 that level of criticality.

24 JUDGE BAER: If there's anything you'd like to -- more to address
25 on this case, again, you're, you know, over half your time. You're welcome
26 to spend your time however you like, but, you know, I want to make sure we

1 focus on the critical things. So, if there's anything else you'd like to address
2 briefly or you're welcome to turn to the other case.

3 MR. DEUTSCH: Sure. Yes. And there are a few things that I think
4 would be worthwhile just to step through briefly. And again, this, you
5 know, like I mentioned, discussing secondary considerations, there's new
6 evidence here that goes to not only the lack of nexus to the claims, but also
7 explains reported commercial success and praise, other reasons for that.

8 And I won't step through all of that in detail, but briefly, looking at
9 Slide 32 for example, accuracy is a big focus in the briefing of Patent Owner
10 as to basis for their secondary considerations, but if we step through much of
11 their evidence, we see that things like high resolution imagery are really
12 what's driving an accuracy of the reports, and that's something that's in the
13 exhibits and also comes out in declaration or in testimony from Patent
14 Owner's declarants that was cited in the reply.

15 And then, there's additional evidence explaining reporting
16 commercial success. Turning to Slide 34, they had introduced a range of
17 tools to make it easier to order reports essentially broadening the sales
18 channels for placing reports. They did this through mobile ordering, through
19 iPad, through tablet applications. They touted integrating with AccuLynx
20 roofing management software, and then on Slide 35, critically they expanded
21 geographic coverage, driving report sales and revenues for previously
22 unavailable locations.

23 And so here we have sales are growing because there are reports that
24 are available for new areas that just weren't available before. And this
25 continues Slides 36 through 38 highlight additional features that were
26 introduced during the relevant period that are not tied to claimed features.

1 This includes small measurement resorts, this includes QuickSquares
2 reports, and I think it bears mentioning briefly with respect to something like
3 QuickSquares reports, these were reports that were advertised as providing
4 an estimate within approximately one hour. There is nothing in the record
5 that ties QuickSquares reports to features of the 737 claims, or the software
6 that Eagle View relies on. Dr. Bajaj never mentioned that and Patent Owner
7 never explained how these reports were generating or what feature were --

8 JUDGE GIANNETTI: Counsel, it's Judge Giannetti again. Do you
9 construe Fox Factory as requiring that the patented invention be the only
10 thing that drives the commercial success? Do you think that there is room
11 for argument that there are other factors involved, but that still doesn't mean
12 that the commercial success isn't significant?

13 MR. DEUTSCH: Yes, thank you for that question, and I think --
14 right. I mean, we're not arguing that it's so narrow, that Fox Factory is so
15 narrow. I think the important thing here is that Patent Owner hasn't shown
16 these features to be relevant at all for how it relates to the claim. And so,
17 you know, whether it needs to be the exact set of features as recited in the
18 claim, there needs to be some relevance and it needs to be tied to an
19 inventive feature. So we're not saying that Fox Factory is so narrow, but
20 here we're not even in that zone where there is no relevance at all for
21 something like the QuickSquares reports.

22 And, you know, related and going back to our earlier discussion
23 around co-extensiveness, there is, you know, we're talking about a
24 presumption for Patent Owner, to the benefit of Patent Owner, and so them
25 seeking that presumption need to close the gap on the additional
26 requirements as set forth in Fox Factory. So that's their burden, they own

1 that burden, and they haven't met it in this case. So with that, I will turn it
2 over to my colleague, Mr. Wang to discuss the 880 patent.

3 MR. WANG: Good afternoon, Your Honors. May it please the
4 Board? I'm Yao Wang with Fish Richardson, representing our client
5 Nearmap as the Petitioner in this IPR and it's the 880 patent. You just heard
6 from my colleague, Mr. Deutsch, regarding the 737 patent. Regarding the
7 880 patent, plan on using 20 minutes for our opening, and 10 minutes for our
8 rebuttal.

9 Let's turn to Slide 2 of Petitioner's demonstratives which has a list of
10 all the issues that have already been briefed by both parties. We'll focus on
11 three issues on this list. Namely, issue one, the issue of a claim construction
12 for 1.5 and 14.5. Issue 2A, the application of prior art of 1.5 and 14.5. And
13 issue 2D, dependent claims including dependent Claim 3.

14 In the interest of time, we'll lead with issue 1 which is claim
15 construction of 1.5 and 14.5. Our position is Patent Owner's construction is
16 improper. As you'll see, however, the record makes clear that it doesn't
17 matter how 1.5 is constructed. By the way, the Kennedy Florance Kreft
18 combination meets this limitation. This is issue 2A on that list. If time
19 permits, we'll further explain issue 2D, the Kennedy led combination also
20 made dependent Claim 3. Our arguments equally apply with issues 3
21 regarding (inaudible) combination. Your Honors would like us to tackle any
22 other issue first, we can certainly entertain that.

23 JUDGE BAER: Lets go ahead and start with the 1.5 and the 14.5
24 issue.

25 MR. WANG: Thank you. We will turn to Slide 4. We first turn to
26 claim construction of 1.4, I'm sorry, 1.5 and 14.5. As reproduced on the

1 right-hand side, element 1.5 recites and quotes, providing visual access to
2 one or more oblique images of an area imagery database corresponding to
3 location coordinates of the final location. Element 14.5 recites the same
4 substance.

5 In Patent Owner's response which we reproduced on the left-hand
6 side, Patent Owner proposed to construct this element to include and quote
7 accessing an area imagery database to retrieve the one or more oblique
8 images corresponding to the location coordinates of the user accepted final
9 location by displaying one or more oblique images retrieved from the area
10 database.

11 However, the recorded evidence is now supported on this proposal as
12 we have already explained in our briefings. In the interest time we will
13 focus on claim meaning. Returning to Slide 7. As shown on the right-hand
14 side, element 1.5 does not require accessing a database to retrieve images
15 from the database. Not only is the word retrieve missing, the preposition
16 term from also cannot be found. Significantly 1.3 and 1.4 --

17 JUDGE GIANNETTI: Counsel, it's Judge Giannetti. It does say
18 "providing," though. And couldn't providing be accessing a database?

19 MR. WANG: Right. In that case, providing visual access which
20 access is used to now would bear proposition as to it includes the verb form
21 of access in the form of accessing a database in element 1.5. And in
22 particular, accessing database for the purpose of retrieving images from that
23 database.

24 JUDGE GIANNETTI: So, what's your construction of visual access?
25 How does it differ from that?

26 MR. WANG: When you --

1 JUDGE GIANNETTI: (inaudible).

2 MR. WANG: We do not believe a 1.5 needs to be constructed. The
3 claim meaning speaks for itself.

4 JUDGE GIANNETTI: Well, it seems to be something that's in
5 dispute here. Hotly in dispute. You don't offer a constitution for it?

6 MR. WANG: We believe claim meaning of 1.5 does not require the
7 accessing database.

8 JUDGE GIANNETTI: Okay. So, tell me what the claim meaning
9 is?

10 MR. WANG: The claimed meaning is you don't need to access a
11 database to retrieve that image.

12 JUDGE GIANNETTI: Oh. But your opponent says that it includes
13 not just accessing, but accessing a database and you don't agree with that,
14 but you're not willing to tell us what it means.

15 MR. WANG: Your Honor --

16 JUDGE GIANNETTI: You're telling me what it doesn't, but you're
17 not telling me what it does mean in your clients view, in your view.

18 MR. WANG: Well --

19 JUDGE GIANNETTI: And I find that confusing that you're not
20 willing to take a position on what it means.

21 MR. WANG: Well, our position is that it does not require the image
22 retrieval stamp. In other words, that image retrieval stamp as alleged by
23 Patent Owner is not necessarily (inaudible) 1.5.

24 JUDGE GIANNETTI: So what does it mean though? What does it
25 mean? It says providing visual access. Do you mean it just produces a

1 picture? I mean, what does it mean if it doesn't mean what they say it
2 means?

3 MR. WANG: If it helps, I can walk through the earlier steps of 1.3
4 and 1.4 as recited quickly before --

5 JUDGE GIANNETTI: I'm not asking you to walk through the rest
6 of the claim. I'm just trying to get to what your view is, what your side's
7 view is as to what it means? If it doesn't mean what they say it means, what
8 does it mean?

9 MR. WANG: It means you -- there's the process of accessing and
10 displaying that image, and the --

11 JUDGE GIANNETTI: The image is presumably stored someplace,
12 right?

13 The image has to be stored someplace.

14 MR. WANG: Well, I think that's a valid statement. That 1.5 does
15 not require you to retrieve that image (inaudible).

16 JUDGE GIANNETTI: Well, it says it provides visual access. You
17 know, if the thing is stored, if the image is stored, then providing visual
18 access means it must be retrieved from some storage.

19 MR. WANG: That's inference a little too far is not required so --

20 JUDGE GIANNETTI: Why is that? That sounds pretty logical to
21 me.

22 MR. WANG: If I --

23 JUDGE GIANNETTI: You agree that it's stored someplace, right?

24 MR. WANG: That's certainly within the scope of Claim 1, but it's
25 not required by 1.5.

1 JUDGE GIANNETTI: Oh. So, how do you provide visual access if
2 not retrieving it from the storage?

3 MR. WANG: If it helps, I can point to Dr. Forsyth's transcript.

4 JUDGE GIANNETTI: All right. Thanks. Anything that helps. I'm
5 puzzled right now.

6 MR. WANG: Your Honor, my co-counsel, Tom Rozylowicz, would
7 be to speak briefly on this.

8 JUDGE GIANNETTI: Sure.

9 MR. ROZYLOWICZ: If it helps.

10 JUDGE GIANNETTI: Go ahead.

11 MR. ROZYLOWICZ: Thank you. Thank you, Your Honor. A
12 couple things I think we need to bear in mind when we construe this
13 limitation in view of the specification, right. So, I think among the other
14 things that is not disputed in this case is the fact that both 1.3 and 1.5 are
15 formed and what Patent Owner acknowledges could be a single access
16 operation. And asked where we get the image from, certainly speaks to well
17 may speaks to accessing different data stores including a database. It also
18 speaks that you could in fact access it directly from memory itself.

19 So, you know, in trying to be responsive to your question for how I
20 would construe this limitation, Your Honor, I would respectfully submit that
21 it could be debilitating or enabling any access to the oblique image. I feel
22 like I'm trying to -- not being responsive to your question, Your Honor, but
23 kind of given the breadth of those examples, and what's in the record it's
24 hard for me to give you more to work with.

25 JUDGE GIANNETTI: Okay, fine. I've got your position. I
26 understand your answer. Thank you.

1 JUDGE BAER: How about displaying. Is displaying by itself
2 enough? This is Judge Baer by the way. Is displaying providing visual
3 access? Just displaying?

4 MR. ROZYLOWICZ: Yes, Your Honor, I think that absolutely
5 would meet the limitation.

6 JUDGE BAER: Thank you.

7 MR. ROZYLOWICZ: Your Honor, with that I'll defer to my
8 colleague to continue on with his planned remarks.

9 MR. WANG: Thank you, Your Honor. Your Honor, our position is
10 by the end of the day, it doesn't really matter how 1.5 is constructed. The
11 petition proposes a combination that meets the condition of 1.5 one way or
12 the other. With that, we can turn to Slide 20. This is our issue 2A.
13 Proposed combination meets element 1.5. So, if I may, I would like to
14 redirect your attention to our petition starting at page 34. Please let me
15 know if Your Honors are there.

16 JUDGE BAER: Yes.

17 MR. WANG: Thank you. You can see on page 34 on the heading of
18 1.5, our petition starts I quote in a combination Kennedy provides that after a
19 mapping system obtains and presents the vertical area image of a building,
20 such as a house as shown in Kennedy's status 35, a system obtains one or
21 more oblique area images of the building from a GIS data base and presents
22 the one or more oblique area images as shown in Kennedy's Figures 35 --
23 36.

24 This portion of the petition goes on to say I quote, "Kennedy explains
25 that a vertical area image is obtained before any oblique area images in order
26 to generate a roof sizing tool. And that is used by each perspective view to

1 size the roof." Your Honor if you keep scrolling down, you'll see on page 35
2 of the petition, we presented Figures 35 of Kennedy which shows an
3 example of a retrieved vertical area image of the roof of a house.

4 Your Honors, keep scrolling down. On page 36 of the petition, we
5 presented Figure 36 of Kennedy which shows the retrieved oblique area
6 image of the roof of a house. Also, on page 36 of the petition, I quote, "In
7 the combination, after the buildings marker has been moved to the new
8 location, the new location can be confirmed through a dialogue box to
9 update location information for the building, such as the GPS coordinates of
10 a geocoded address of the building, as described in Kreft." That portion of
11 the petition goes on to state as I quote, "The geocoded address which the
12 new GPS coordinates based on the actual center of the building is then used
13 to obtain the oblique area images as described in Kennedy."

14 Your Honor, in the petition we went even further with a (inaudible)
15 example on page 37, which is coming up. On page 37, of the petition, I
16 quote, "Stated in the combination, with reference to Kennedy's Figure 1,
17 after obtaining the vertical area image and after the GPS coordinates or the
18 geocoded address entered by a user or updated the image retrieval system
19 would use the updated coordinates to retrieve the oblique area image from
20 the GIS database, such as Microsoft, Google Earth or any of a number of
21 other commercially available databases."

22 With that, we submit that our petition presented this combination that
23 would meet the requirements as imposed by Patent Owner on 1.5. Pause for
24 a moment in cause you guys have additional questions? Assuming no
25 questions at moment, let's turn to Slide 45 to start our discussion about
26 dependent Claim 3.

1 JUDGE BAER: And, Counsel, just so you know, you have about
2 two minutes left before you're into your rebuttal time.

3 MR. WANG: Understood. Thank you, Your Honor. Our position is
4 that our combination also allows for image retrieval using the latitude and
5 longitude coordinates from the secondary image or database as recited by
6 dependent Claim 3. On this issue, we want to emphasize two items here in
7 the interest of time.

8 First, the retrieval using latitude and longitude coordinates as recited
9 by the dependent Claim 3. Our position is that the prior art provided by us
10 in the petition teaches the use of GPS coordinates such as the latitude and
11 longitude coordinates to retrieve data. Specifically we cited Florance at
12 paragraph 547 as recited by the petition at page 45 under heading of the 3.2.

13 Florance at paragraph 547 describes an example. Let me quote from
14 paragraph 547. In the middle of 547, the example goes coordinates latitude
15 and longitude coordinates corresponding to the pixels calculates a spatial
16 index based on the coordinates and retrieves data associated with the
17 coordinates and the spatial index. Now with that, we leave first item of
18 using longitude and latitude coordinates to issue data has been met by the
19 prior art.

20 Our second item is the use of multiple databases. As explained in our
21 petition at 43, in a combination with Kennedy and Kreft suggested the use of
22 multiple databases been maintained in its quality and data consistency. For
23 example Kennedy at column six, lines 832, which is cited by Petitioner at
24 43, it leads with this sentence. Quote, "More than one source of images is
25 provided to system 100 and used to determine roof size and the pitch", end
26 the quote there.

1 Additionally, Kreft at column 2, line 56 to columns 3, line 4, further
2 discusses the quality issue with data in the IS databases in that there are
3 always errors and gaps in these databases and sometimes you may not be
4 able to derive accurate data from one database.

5 JUDGE BAER: Mr. Wang, where was this in the petition again
6 please?

7 MR. WANG: Hmm?

8 JUDGE BAER: Where was this in the petition, please?

9 MR. WANG: Petition at 43. I believe we reproduced that on our
10 Slide 43 as well.

11 JUDGE BAER: 43. Thank you.

12 MR. WANG: Yes, on our Slide 43, we have a snippet from Kreft for
13 that portion speaking to a need to use multiple databases to maintain data
14 consistency. And we strongly believe that a POSITA would have been
15 motivated and would have found it obvious to consult a multiple databases.
16 Your Honor, may I ask the court reporter about how much time we have
17 left?

18 JUDGE BAER: You've got, let's see, you've got 18 minutes left.

19 MR. WANG: Thank you, Your Honor. We'll reserve 18 minutes for
20 our rebuttal. And with that, we'll turn the floor to Patent Owner.

21 JUDGE BAER: I apologize, you have 23 minutes left.

22 MR. WANG: Your Honor, thank you. That's even better.

23 JUDGE BAER: Okay. With that, we will turn to the Patent Owner.
24 I believe Mr. Howard, is that correct?

25 MR. BOWSER: Your Honor, this is Jonathan Bowser for Patent
26 Owner. I will be first presenting on the 737, just to follow the same order.

1 And then Mr. Webb will be presenting on the 880 patent. We would like to
2 use 50 minutes, 5-0, for our orintgal presentation, and then reserve 10
3 minutes for rebuttal.

4 JUDGE BAER: Sounds good. Mr. Bowser, whenever you are ready,
5 you can begin.

6 MR. BOWSER: Okay. Thank you, Your Honors. I have -- I have
7 shared my slides here. One second. Can you see my screen?

8 JUDGE BAER: We can.

9 MR. BOWSER: Okay, but it's not the --

10 JUDGE BAER: Take your time. We won't start until you get this
11 figured out.

12 MR. BOWSER: Give me one moment here.

13 JUDGE BAER: Sure.

14 MR. BOWSER: Sorry. I am -- all right. I am going to start on Slide
15 5. Slide 6. Okay. So, Slide 6 is a reproduction of limitation 1. -- or Claim 1
16 and what's in dispute is a limitation 1.5. And on the right-hand side of this
17 slide, you can see that there's a summary of our overall arguments
18 throughout this proceeding. And I want to touch on 1.5 primarily. We can
19 see the limitation 16.3 and 26.3, are quite similar. So, the arguments apply
20 to those limitations as well.

21 What we've shown throughout this proceeding is that ground 1
22 doesn't teach 1.5 and ground 2 also doesn't teach 1.5. Petitioner's counsel
23 made a comment that we've only focused on, you know, one limitation. This
24 is the allowable limitation that was discussed during prosecution. It's not
25 Patent Owner's burden to necessarily show that every single limitation is not
26 taught by the prior art.

1 What I want to touch on next is Patent Owner's comment about how
2 they did not construe limitation 1.5 as lacking patentable weight but that's
3 just simply not supported by the record. We can see here a reproduction on
4 Slide 8. This is what is on the petition, page 6 of the petition, after
5 reproducing the entirety of the limitation 1.5. We can see highlighted at the
6 bottom, and these limitations are directed to generating printed matter and
7 then the lesson -- least limitations are entitled to no patentable weight.

8 What Petitioner's counsel pointed out is that they were applying the
9 Boards final written decision in the (inaudible) IPR but that's just simply not
10 the case, and I'm going to show you why. So, the reason why limitations
11 1.5A and 1.5B at a minimum are entitled to patentable weight is because
12 here we can see at the Exhibit 1010 is the Board's final written in the
13 (inaudible) IPR and that was focused on the claimed content of the
14 information at the highlighted portion at the top, and then later on the same
15 page, the detailed requirements as to the contents of the roof estimate report.

16 So, if there are any portions of limitation 1.5 that are not entitled to
17 patentable weight, those are the non-highlighted portions. But, the
18 highlighted portions, limitations 1.5 A and 1.5B are in fact entitled to
19 patentable weight, because they are not directed to the claimed content of the
20 information or the detailed requirements as to the contents of the roof
21 estimate report. And I'm next going to move to Slide 10 --

22 JUDGE BAER: Mr. Bowser, just to make sure I understand your
23 position, I understand your position that parts A and B are entitled to
24 patentable weight. Do you contest that the contents of the roof estimate
25 report are not entitled to patentable weight as we held in the previous IPR?
26 Do you contest that?

1 MR. BOWSER: Oh, we have not contested that, Your Honor. We
2 do -- we have argument that -- well, let me be clear here. We have said that
3 if a portion of 1.5 is not entitled to patentable weight, then it is in fact the
4 unhighlighted portions. We have not explicitly contested the finding in the
5 prior IPR.

6 JUDGE BAER: Thank you.

7 MR. BOWSER: So, I want to return next to why Patent Owner's
8 argument applied this improper construction, okay, and we can see on Slide
9 13. This is a reproduction of claim -- I'm sorry, petition page 34. This is the
10 analysis, gives the specific information content of the report describes the
11 claim as not limiting if follows that is showing and generating and
12 displaying any graphical or textural information is sufficient to meet the
13 claim.

14 And if you look at the petition in ground 1, and you look at the
15 analysis on pages 33 to 35, you'll see that all the Petitioner ever discusses, at
16 all, is about displaying information. And that is indicative because that's all
17 Petitioner thought that it had to do. Generating and displaying graphical
18 information.

19 I want to address something else that Petitioner's counsel raised
20 before and they pointed out and this is your -- if you have the Petitioner's
21 slides up, you can see it. It's on Slide 11. It's also on page 21 of the petition.
22 And here, this is indicative of what's -- of the level of analysis in this
23 position because you can see as described in greater detail below, see
24 limitation 1.5 (inaudible), the combined system of Heller and Quam
25 produces a roof estimate report. That's it. They never followed it up. They
26 don't actually show how Heller or Quam ever discloses a roof estimate

1 report. And that's important. Because if you go to pages 33 to 35 of the
2 petition, you'll see all there is is a discussion about displaying information.
3 That's it.

4 And also I want to point out something or I want to just point to
5 something interesting. At the beginning of Petitioner's presentation, they
6 pointed to the overview of Heller and the overview of Quam. That's
7 interesting for two things. Number one, they don't actually rely on those
8 specific teachings when they analyze limitation 1.5. Not at all. And the
9 other thing too that's important there is when Petitioner's counsel pointed
10 out the overview of Heller. If you look at pages 33 to 35, not once does
11 Petitioner ever rely on Heller. So I'm not sure why there pointing to the
12 overview of Heller, and they're also they're relying on the overview of
13 Quam.

14 I want to move next to Slide 14 and here, we see that Heller and
15 Quam are quite different from limitation 1.5. The focus of Heller and
16 Quam, and they are related, because Quam is essentially describing what's in
17 Heller. Heller describes the radius model, and Quam it describes
18 implementing it with the RCDE which is the Radius Common Development
19 Engine. So, but the reason I had mentioned that is because we can see
20 throughout this, its pervasive. Heller and Quam are simply directed to
21 creating a 3D model with images and that's it. There is no report that's ever
22 generated. And certainly not a report that is generated for the purpose of
23 repair and or construction. That's just simply missing from their analysis.
24 And that is important because its Petitioner's burden to show that Heller and
25 Quam teach limitation 1.5 and they simply have not done so.

1 On Slide 15, I want to point out here, this is an entirely new argument
2 in their reply. And its improper, because certainly it's not responsive to the
3 argument in the Patent Owner response. In the Patent Owner response, the
4 argument was the petition hasn't shown why Heller or Quam discloses 1.5A
5 or 1.5B. And what does Petitioner do in response? They come back with
6 this well, here's this concept about roof data. If you look at the petition, this
7 concept of roof data is never mentioned. Not once in the petition. So this is
8 an entirely new argument that is not responsible.

9 And the other thing that's instructive about this is as we can see, you
10 can see it cited paragraph 18 of Dr. Forsyth's second declaration. This is an
11 entirely conclusory argument done in response to the reply. So, it's -- not
12 only is it improper because it's an entirely new argument, it's not responsive
13 to anything in the Patent Owner response, but it also doesn't even meet its
14 burden of showing that.

15 So, I want to move next to Slide 16. I'm going to talk about ground
16 2. And what's interesting about ground 2 is I think here Petitioner was
17 hedging its bets, because they probably recognized that, you know, portions
18 of limitation 1.5 are entitled to patentable weight. So then they added
19 limitation -- so then they added Deaton. We can see very clearly to the
20 extent this limitation and they're of course referring to limitation 1.5, is
21 found to be entitled to patentable weight, is none the less rendered obvious
22 by the Heller Quam Deaton combination.

23 What I'm going to talk about is how the ground 2 analysis is also
24 deficient because it doesn't show how Deaton, just like Heller, and just like
25 Quam, teaches limitation 1.5A. So we see at the top of Slide 18, this is an
26 overview of the Petitioner's ground 2 argument. In the combination Deaton

1 describes a roof inspection system that generates and outputs various
2 supports. You heard from Petitioner's counsel make, you know, give a lot
3 of attention to the fact that we focused on paragraph 10. Well, the reason we
4 focused on paragraph 10 is because that's what Petitioner cites too.

5 And we can see on paragraph 10, in the petition, you know, again it's
6 their burden to show that the limitations are disclosed. All we have is a roof
7 inspection system that collects roof inspection information. And it's done so
8 by having a physical onsite inspection. In other words, you have a worker, a
9 roofer or some type of contractor going to the location of the building under
10 inspection and then using a tape measure and taking measurements.

11 JUDGE BAER: Mr. Bowser, putting aside the --

12 MR. BOWSER: Yes.

13 JUDGE BAER: -- onsite issue, which I understand is about the
14 reason to combine, they also cite paragraph 107 of Deaton. And paragraph
15 107 talks about a project report, correct? So, I understand the argument on
16 paragraph 110, but what about paragraph 107?

17 MR. BOWSER: Okay. I'm going to get, let me go there. That's a --
18 yes, that's very good. So, the question, Your Honor, is addressed on Slide
19 19. And they talk about a project report. What is the project report actually
20 described as? It is linking the inspection data, which we know is earlier
21 from an onsite inspection and its linking it to generic or specific
22 manufacturer prices. That's what the project report is about, okay. It is
23 creating a report based on the physical onsite inspection. And how do we
24 know that? Also I'm going to go to slide let's see, Slide 21 which tells this
25 quite clearly.

1 So, we see at the bottom and there's a second -- another point that I'm
2 going to make about this slide, but to answer your question, Your Honor, it
3 talks about a project report, right. And that's in paragraph 107. And the
4 project report is created in accordance with a condition identified in the
5 assessment report. What Petitioner conveniently left out is the assessment
6 report, because the assessment report is also based on a physical inspection.
7 So you have to go out to the site, inspect the, you know, the building under
8 inspection and then identify deficiencies. And then that's what is used to
9 create the protect report.

10 It seems as if Petitioner, you know, did a word search here and found
11 the word report and said oh, okay, well, we can use Deaton's project report
12 because it has the word report. But the reason it -- that it does -- the
13 combination doesn't make sense at all, as we can see at the top, is because
14 Petitioner has argued that a POSITA would understand that Deaton's
15 techniques for generating a roof estimate report based on the 3-dimensional
16 model, you just have to stop there. Because Deaton never talks about
17 creating a roof estimate report from a 3-dimensional model. The very basis
18 of their combination is flawed. And I want to go back to --

19 JUDGE BAER: Are you saying that Deaton is non-analogous art
20 because it involves onsite inspections? Is this your argument, that its
21 actually non-analogous art?

22 MR. BOWSER: We have not made it the argument that it is non-
23 analogous art, no. Your argument -- the argument that we have made
24 throughout this proceeding is the fact that, and I'm now on Slide 20, is that
25 there is insufficient motivation to combine Deaton with the Heller Quam

1 combination for a couple reasons. Heller and Quam are directed to creating
2 3D models based on images, okay?

3 Petitioner never explains how a POSITA would take the
4 measurement information from an onsite physical inspection and then
5 somehow include that in Heller and Quam to create a roof estimate report.
6 The other thing too, is that Petitioner has changed its story here. Earlier you
7 heard from Petitioner's counsel about how --

8 JUDGE GIANNETTI: And, counsel, before you leave that point, is
9 it your contention that a person of ordinary skill in the art would not be able
10 to take data, which was generated possibly manually, and use a computer to
11 produce an automated report? Is that beyond the skill of this person of
12 ordinary skill? It sounds like -- to me, I think that's not beyond the skill of a
13 high school student.

14 MR. BOWSER: Well, Your Honor --

15 JUDGE GIANNETTI: That's what you seem to be saying.

16 MR. BOWSER: Well, what I'm saying, Your Honor, is the fact that
17 Petitioner hasn't shown how you would combine Deaton's system that uses
18 physical inspection information from an onsite inspection and incorporate
19 that into Heller and Quam. Heller and Quam operates based on images,
20 right. So, how do we get the information? It seems like implied in your
21 question is wouldn't it have been obvious just to take that information and
22 import it into Heller and Quam? Well, our argument --

23 JUDGE GIANNETTI: Or to provide Heller and Quam with the basic
24 computer capability of producing a report. I mean, that's not a big step
25 forward is it? For a person of ordinary skill?

1 MR. BOWSER: Well, Your Honor, Petitioner hasn't shown why
2 you would modify Heller and Quam. What we've seen is very vague and
3 general, you know, motivation, source deficiency and things like that.

4 JUDGE GIANNETTI: So, you think that you need proof that
5 reporting and providing a report, an Excel spreadsheet is -- you think that's
6 beyond the skill and that needs to be spelled out? I don't know. To me, that
7 sounds like it's pretty basic.

8 MR. BOWSER: Well, if -- the concept of including information to a
9 computer if you go outside the petition, if, you know, you go outside the --

10 JUDGE GIANNETTI: I'm not talking about how -- I'm talking about
11 basic skills of a person of ordinary skill.

12 MR. BOWSER: Okay, but --

13 JUDGE GIANNETTI: Do you need a textbook or a computer
14 programming manual that shows you how to do an Excel? Is that what --
15 would that satisfy you? You know, Excel for Dummies, or something? I
16 mean, this is such a basic skill. I just don't see why this is beyond the skill
17 of a person of ordinary skill. I think your argument just is not moving me.

18 MR. BOWSER: Okay. Well, Your Honor, it's not necessarily that
19 we're arguing again that a person of ordinary skill would not be able to
20 incorporate information from an onsite inspection. What we're arguing is --

21 JUDGE GIANNETTI: Isn't that the end of your -- why isn't it the
22 end of it? It seems to be that you conceded that.

23 MR. BOWSER: Well what -- I haven't conceded that including
24 information is not knowing what I'm arguing is at no point has the Petitioner
25 shown how Heller and Quam would produce a roof estimate report. Okay.
26 Because the --

1 JUDGE GIANNETTI: Do you mean, they would have to produce a
2 computer program, is that what you're saying?

3 MR. BOWSER: They wouldn't have to produce a computer program
4 --

5 JUDGE GIANNETTI: They're teaching it. Teaching. The teaching
6 is that, you know, you can produce a program. I don't know. I understand
7 your position, but —.

8 MR. BOWSER: Well, Your Honor, the key distinction here is the
9 fact that Heller and Quam again are focused on 3D images. And at no point
10 does Petitioner meet its burden to show how you would use physical onsite
11 inspection information. Petitioner has even though it never relied on
12 limitations -- or this for limitation 1.5, if you go to -- let me point out
13 something here.

14 If you go to page 53 of the petition, and this is basically their analysis
15 for limitation 1.5. They cite to two paragraphs. Paragraph 10 and Paragraph
16 107, and that's it. They haven't shown why a POSITA would have been
17 motivated to use information in a graphical form. How you would get that
18 information to Heller and Quam.

19 One of the things that's instructed is in the reply, Petitioner now cites
20 to paragraph 70 of Deaton and, you know, because that word uses -- because
21 that paragraph uses the word model. Again, we're another position where it
22 must be a word search expedition. And what we have is providing graphical
23 models of a particular design. But at no point does Deaton ever link that
24 model to the project report. You know, what we have here, Your Honor, is
25 just taking bits and pieces of Deaton and then its all of a sudden mashing

1 them into Heller and Quam. But there's just simply no analysis to support
2 that.

3 I want to move here to quickly touch on Claim 16 and 26. And it's
4 important, because there are three independent claims that are addressed in
5 the petition. We can see on in the bottom of the cite, all the Petitioner did
6 for Claims 16 and 26, is say see Claim 1 and that's it. There was no analysis
7 whatsoever. What we've done on Slide 23, is highlighted specific unique
8 limitations of Claims 16 and 26 that are never addressed in the petition.

9 And what the Petitioner did in its reply is then they said well, it
10 brought in a lot more evidence or, I'm sorry, a lot more argument and
11 portions of Heller and Quam that they didn't in fact rely on, and then cited
12 10 pages of the petition and said effectively to the Board go figure it out or
13 the Patent Owner, go figure it out, somewhere it's in there. I mean, this is
14 quite instructive of as to what we've seen in this petition. It's just generally
15 oh, as it's described in the petition.

16 What I want to next touch on the decisive evidence of secondary
17 considerations. And this is, sorry. If you go to Slide 28 which is a
18 (inaudible) reply and then we have here just our overall argument. Okay. A
19 couple things here that's important about secondary considerations. In this
20 IPR, as Petitioner

21 's counsel pointed out earlier, this was already -- sorry, the 737 patent
22 was already subject to an IPR and in that IPR, the Board found that Patent
23 Owner presented extensive and decisive evidence of secondary
24 considerations. And on that basis, the Board found that the claims were non-
25 obvious.

1 And in this particular IPR, we have presented the same evidence. I
2 would also point out that the Federal Circuit affirmed the Boards finding of
3 non-obvious based on the secondary considerations evidence. And what's
4 significant also is that Dr. Bajaj has submitted detailed claim charts showing
5 how each challenged claim is embodied by the Twister and Render House
6 products.

7 JUDGE BAER: Mr. Bowser, I just -- this is Judge Baer. I'd like to
8 get to this critical issue in the Fox Factory case. So, this pitch determination
9 and allowing input of a location, those aren't claimed. Your opponent says
10 those are critical and they've got some cites to some of your documents that
11 say something about importance, that sort of thing. And I asked counsel for
12 some direction for how we determine whether an unclaimed feature is
13 critical.

14 I seem to know from the case law that if I have, you know, secondary
15 considerations addressed to a car and claims addressed to brake pads, that
16 there are critical things that are not in the claim. Can you please help me
17 with any case law on this point as to how do we determine whether
18 unclaimed features are critical? So the first question is about case law. My
19 second question is, is there any or, excuse me, any evidence of record that
20 shows that these things are not critical?

21 MR. BOWSER: So to answer your first question as to case law
22 guidance, what we have put into the record and also Petitioner's counsel has
23 put into the record, I would also indicate to you that this is Petitioner's
24 burden to rebut the presumption. But what we have is from Fox Factory,
25 and I'm going to just read a short portion and this by the way is at page 1374
26 of the Fox Factory decision. What it says is that there's -- that there's a

1 spectrum and its either perfect or near perfect correspondence on the one
2 end, and on the other end there's very little. And the Federal Circuit says
3 although we do not require the patentee to prove perfect correspondence to
4 meet the co-extensiveness requirement, what we do require is that the
5 patentee demonstrate that the product is essentially the claimed invention.
6 And we have met that burden, Your Honors, because we have shown that all
7 the challenged claims are embodied in the Twister and Render House
8 products.

9 Petitioner has pointed out two specific dependent claims in the 770
10 patent which I don't think by way that Petitioner ever put that exhibit into
11 the record. But, it is -- they're talking about two dependent claims and they
12 have argued that they are in fact critical. And there is no evidence to prove
13 that they are not critical, because I think what you're effectively asking,
14 Your Honor, is like how do you disprove a negative. What the importance is
15 is that we have shown that the claims embody, are embodied by the Twister
16 and Render House products. And that's what's required by the law.

17 And we can see in the Fox Factory case that presuming nexus is
18 appropriate when the patentee shows that the objective evidence is tied to a
19 specific product and that product embodies the claimed features and is co-
20 extensive with them. Every single claim that is challenged in this
21 proceeding is that is embodied by Twister and Render House. And the other
22 thing --

23 JUDGE GIANNETTI: Doesn't Fox Factory say that there is more
24 than that, that that's just the first step?

25 MR. BOWSER: For the presumption, Your Honor, I mean --

1 JUDGE GIANNETTI: It's a presumption, but it's a rebuttable
2 presumption. Right. The question is, have they successfully rebutted it?
3 And that's what I think counsel was asking you, what Judge Baer was asking
4 you, if they successfully rebutted the presumption. Are these features that
5 they mentioned critical features or not? If so, how do we determine that?

6 MR. BOWSER: So, if it's here, if the burden is on the Petitioner to
7 show that they are in fact critical because as Patent Owner, we have shown
8 that the claims are co-extensive with the products. And the Petitioner has
9 not met its burden.

10 JUDGE GIANNETTI: Okay. Tell us why. Now you're going to tell
11 me why they haven't met their burden.

12 MR. BOWSER: Well, they're identifying specific, you know,
13 components of the Twister and Redner House software products that, you
14 know, one of which is adding an address and another one is moving the
15 pointer for the purpose of determining pitch.

16 Now, the Twister and Render House, each one of the -- as you use
17 the software to create the reports that have been so commercially successful
18 and have led to such praise, you know, there may be instances where you
19 don't necessarily have to put an address, so it is in fact not critical. But this
20 is not in the record, Your Honor. What we have is essentially just
21 Petitioner's sort of conclusory argument these are in fact critical.

22 Now, as Patent Owner, we're not going to dispute the fact that, you
23 know, in some instances it might be important to have the address, but they
24 are not in fact critical to the implementation of the Twister and Render
25 House products.

1 JUDGE GIANNETTI: Is it critical to the limitation or critical to the
2 commercial success? What is this critical feature that Judge Baer asked you
3 about?

4 MR. BOWSER: The critical feature is to the products themselves,
5 okay, and here what we have is the reports that are generated by the Twister
6 and Render House products. Twister and Render House are not publicly
7 available. They are kept, you know, it's a proprietary software. But it's the
8 reports themselves that create these unique inventions.

9 I'd love to turn to Slide 31, but I will not do so only because of, it has
10 confidential information. But it's indicative as to why this is so important,
11 because we can see that, you know, outside of a presumption issue,
12 Petitioner has shown, unmistakably, a nexus between the commercial
13 success and the reports that were generated. And what we see if you could
14 please turn on your own to Slide 31, because again --

15 JUDGE BAER: We have them.

16 MR. BOWSER: -- confidential information. Okay. What we have,
17 and this is on pages 59 and 60 of the Patent Owner response, we have an
18 exponential growth of revenue. And this is not Eagle Views revenue, this is
19 revenue simply from the sales of reports that are created by Twister and
20 Render House. From the period of, you know, 2009 to 2015, and I'm not
21 going to get into the exact numbers, but you can see for yourself, sorry.

22 JUDGE GIANNETTI: Counsel, let me ask you, is there a dispute
23 that your product has been commercially successful?

24 MR. BOWSER: Well, there is a dispute because Petitioner --

1 JUDGE GIANNETTI: Isn't that the question is why is it
2 commercially successful? Is it attributable to the invention or to these other
3 features that they pointed to? Isn't that really the question? I mean, it --

4 MR. BOWSER: Well --

5 JUDGE GIANNETTI: I'm not going go to your sales revenues, but,
6 you know --

7 MR. BOWSER: Yes, yes.

8 JUDGE GIANNETTI: -- I think probably the parties would agree
9 that your product has been successful. I think that's the dispute. I think the
10 question is, you know, why is it successful?

11 MR. BOWSER: Petitioner has made a number roof -- well, let me
12 back up.

13 JUDGE GIANNETTI: We'll hear it on the rebuttal, but, you know, I
14 don't think that there is a dispute that there is, you know, that the products
15 been successful. The question is, is it attributable to the invention. Which I
16 think is the gist of Fox Factory.

17 MR. BOWSER: Right. Well, it is attributable to the invention
18 because we have shown that the claims, all the challenged claims are
19 embodied by the Twister and Render House products. And it is the reports
20 that are generated with Twister and Render House that have had such
21 remarkable commercial success. It's not based on simply, you know, other
22 aspects. You know, Petitioner has tried to sort of like effectively kick some
23 mud here and say well, it could be because you have iPhone app. Well,
24 that's just making it easier to order reports. It could be because of improved
25 resolution of images. Again, these are all just sort of scatter shot arguments
26 where what consumers are buying is the reports because they have

1 remarkably accurate information. And what they effectively do is they
2 avoid the situation with Deaton which is having to go onsite and inspect
3 because now you can use imagery to create remarkably accurate reports.
4 That's what customers are buying. And Twister and Render House which
5 embody the claims are --

6 JUDGE GIANNETTI: Counsel, when you say the reports, are you
7 talking about assembling the data or producing the data? The reports, if you
8 have the data, a report is fairly easy to produce, isn't it? You have the
9 results.

10 MR. BOWSER: Let me --

11 JUDGE GIANNETTI: It's a question of putting them on a
12 spreadsheet or whatever you need to do. I don't know what form these
13 reports take, but it seems to me that's a pretty mechanical process if you
14 have the data.

15 MR. BOWSER: Let me -- Your Honor, we have a slide on what
16 exactly sort of is an example of a report. This is of course an example. It is
17 not a spreadsheet. It is very detailed information but the idea here is this is
18 used by roofing contractors, this is used by sorry, let me go back here. And
19 insurance companies.

20 And by the way, I should also add in terms of commercial success,
21 we've put in the record too that 24 of the top 25 insurance companies, 96
22 percent of reports are using Eagle View. So what we can see here is very
23 detailed reports taken from images. So this would allow someone to design,
24 repair, construct a roof structure without actually having to go on site. And
25 they're very detailed examples. We can see a line drawing, this is the overall,
26 you know, drawing of the lines. We can see specific ridgelines. And then

1 we also get dimensions of the roof sections. Let me go to Slide 31. Let me -
2 - Your Honor, how much do I -- have I used?

3 JUDGE BAER: You've used 31 minutes. You have 19 remaining
4 before you enter your rebuttal time.

5 MR. BOWSER: Okay. I want to make one last point here about
6 we're going to go after this to Slide 32 which is the industry praise. So, this
7 is not just necessarily revenue information. This is also comments from
8 folks in the industry. On slide -- sorry, yes, sorry, Slide 32 I'm on, Exhibit
9 1026, this is just, you know, comments from the Palm Beach County
10 Roofing and Sheetmetal Contractors Association, right. And then we see
11 another one from Phoenix Roofing. This is testimony, or not testimony, but
12 comments from folks in the industry how revolutionary the product was and
13 it changes. So we also have extensive evidence of industry praise.

14 JUDGE BAER: So I'd like to ask a question --

15 JUDGE GIANNETTI: But just to get back to my point briefly and
16 I'll let you continue. This industry praise talks about reports produced most
17 accurate measurement. It seems to me the measurements are more important
18 than the reports, aren't they? I mean, that's kind of what I'm reading into
19 this is, that the results are accurate, and I guess they're presented in the
20 reports, but it seems to me if the results weren't accurate, the reports wouldn't
21 be accurate.

22 MR. BOWSER: May I ask what you mean by results?

23 JUDGE GIANNETTI: Well, it says accurate measurements. The
24 reports provide accurate measurements.

1 MR. BOWSER: So what this is doing is taking imagery and then
2 having very accurate measurements of roof dimensions from the images
3 alone. Okay.

4 JUDGE GIANNETTI: Data. That's accurate. Data that is accurate,
5 right?

6 MR. BOWSER: Right. But it also requires some type of analysis
7 and --

8 JUDGE GIANNETTI: Okay. All right.

9 MR. BOWSER: And what we saw in that example of, you know,
10 finding specific measurements of portions of a roof structure. For example,
11 like a certain, you know, let's say the front of the roof would be 30 feet,
12 right. And we know that from the image alone. And it's because of the
13 unique software in Twister and Render House which are able to do that. It's
14 not just looking at the image. There's also very intelligent manipulation in
15 terms of how and this is encompassed within the claims itself, how there's
16 lines being drawn on it and there's lines that are drawn on the specific
17 portions are able to lend itself to the accurate measurements.

18 JUDGE GIANNETTI: I don't want to make up more of your time on
19 this, I understand your point. Thank you.

20 MR. BOWSER: Let me just ask one more time on this critical
21 question or whether it is essentially the invention. I understand your
22 position that these two additional features are not. I understand the
23 Petitioner's position that they are. What I'm looking for, and I want to make
24 sure I have this straight, is any legal analysis or framework, legal
25 framework, other than just whether I would characterize it as essential or
26 critical, or whether these features are the -- are -- whether these features are

1 critical or essential. Whether these unclaimed features are critical or
2 essential. Is there any legal framework or is it just up to a fact finder to
3 determine and characterize it as critical or not? And it's fine if you want to
4 address that on rebuttal.

5 MR. BOWSER: Yes. So, Your Honor, what I'm aware of and in our
6 research, we have found Fox Factory is the closest point on this in terms of
7 what in fact is critical, and it is up to the fact finder. But again, what I need
8 to make clear is the fact that it is the Petitioner's burden to show that
9 something is in fact critical, not the Patent Owner's, because we have proven
10 that the claims are co-extensive with the product.

11 JUDGE BAER: Understood. Thank you.

12 MR. BOWSER: And with that, I will turn it over to my colleague,
13 Mr. Webb, who is going to be talking about the 880.

14 JUDGE BAER: Thank you.

15 MR. WEBB: I'm using share my screen if that's okay?

16 JUDGE BAER: Yes.

17 Mr. WEBB: Thank you, Your Honor. All right, Your Honors, my
18 name is Greg Webb, and I'm here on behalf of Patent Owner Pictometry
19 International regarding the 880 patent. And as we will discuss, Petitioner's
20 challenge of the 880 patent failed for two fundamental reasons. First,
21 Petitioner's proposed combinations under both ground 1 and ground 2A,
22 those disclose the second, providing visual access step of independent
23 Claims 1 and 14. Second, Petitioner's reasons for combining the references
24 under all of the grounds are not supported by the teachings of the references
25 and in some instances are based on directly contradictory and irreconcilable
26 reasoning.

1 I'm going to jump to Slide 5 of the demonstratives. We see here
2 independent Claim 1 of the 880 patent with some of the portions relevant to
3 the dispute between the parties highlighted. Independent Claim 14 is not
4 shown here but it includes similar limitations. For example, claim element
5 14.5 is substantially familiar to claim element 1.5, so for the purposes of our
6 discussion, I will focus primarily on Claim 1 with the understanding that the
7 points are equally assertable to Claim 14.

8 As shown, Claim 1 is directed to a process for determining attributes
9 of a roof structure and begins at element 1.1. In element 1.1, a user inputs
10 first location data that generally corresponds to a location of a building.
11 Then in element 1.2, the process provides visual access to an area image
12 corresponding to the first location data input in element 1.1. And they refer
13 to element 1.2 as the first providing visual access step.

14 Next, elements 1.3 and 1.4 provide a visual marker that is movable to
15 a final location on top of the building. This is to more precisely identify the
16 location of the building's roof structure. And then the final location is
17 accepted by the user in element 1.4.

18 Finally, the claim process concludes with element 1.5 and element
19 1.5 it builds upon the previous claim elements by providing visual access to
20 one or more oblique images of, and this is explicitly record, of an aerial
21 imagery database corresponding to a location coordinates of the user
22 accepted final location from element 1.4.

23 JUDGE GIANNETTI: Mr. Webb, do you recall the discussion we
24 had with your opponent about providing visual access? Do you agree that
25 that term would include just displaying the information?

26 MR. WEBB: No, Your Honor, we do not agree with that. In fact --

1 JUDGE GIANNETTI: Why not? Why not?

2 MR. WEBB: A, you cannot make an explicit distinction between
3 providing visually depicting which I would say is displaying an image and
4 providing visual access to an image which as we see I can -- let me jump to
5 -- let's see. Actually I'll go back to slide -- if you see here that both or we
6 see here that even the Petitioner has --

7 JUDGE GIANNETTI: You're on Slide 10? Slide 9?

8 MR. WEBB: Slide 9, sorry. Slide 9.

9 JUDGE GIANNETTI: You have to give us a slide. You have to
10 give us the slide number.

11 MR. WEBB: Yes, understood.

12 JUDGE GIANNETTI: Give us a minute to scroll to the right place.
13 I'm using my own copy.

14 MR. WEBB: Got you.

15 JUDGE GIANNETTI: Okay. Go ahead.

16 MR. WEBB: On Slide 9, we see that even the Petitioner has
17 acknowledged that these limitations require access and display of the images
18 to meet the limitations of providing visual access. And the claim explicitly
19 states that the images are of the aerial image database which implies that it
20 must be retrieved from there.

21 JUDGE BAER: But how could you display an image without
22 accessing it first? How could anybody ever display an image without
23 necessarily also accessing it?

24 MR. WEBB: I think it's fair to say you have to access it through
25 somewhere. Its whether it needs to be accessed from a database or not. And
26 Claim 1 makes clear and if we turn to slide -- this is on Slide 15, sorry not

1 15. This is on slide -- excuse me. Sorry with the slides here. If we go back
2 to Slide 5 which has the full Claim 1, we see element 1.2 requires providing
3 visual access to an aerial image and it doesn't require it to be from any
4 particular location. Whereas element 1.5 explicitly requires the visual
5 access to be of one or more oblique images of an aerial imagery database.
6 So we see here just based on the explicit claim language we know that visual
7 access needs to be from the images from the aerial imagery database which
8 can be distinguished between 1.2 which just says providing visual access to
9 an aerial image. It doesn't matter where it may be accessed from.

10 JUDGE BAER: Visual image.

11 MR. WEBB: Does that answer your question, Your Honor?

12 JUDGE BAER: I mean, I think so. The question is if I pull an image
13 from a database, and then later I access that, you know, does it have to be
14 directly from a database or can it be that I pulled it from a database and I
15 now display it? And I'm now, you know, later displaying it from memory or
16 something like that.

17 MR. WEBB: Right. So here, I think the providing visual access here
18 needs to be from the database and we have the actual -- extra part of this
19 claim, right, the corresponding to location coordinates of the final location.
20 All right. So that's important because we see that in 1.4 we have the user
21 accepted location of that final location and then we provide visual access to
22 the oblique images based on the location coordinates of that final location.
23 So we move (inaudible) database based on that final location coordinates.

24 JUDGE BAER: Lets flesh this out a little bit. Let's say you have a
25 situation, you -- let me put it this way. Do you agree that if a user does not
26 move the marker, right, if the marker is where they want it to be without

1 them moving it, and they accept it, that would -- that would -- your claims
2 would read on that circumstance? Or does the user actually have to move
3 the marker?

4 MR. WEBB: I think it would be rare that the use doesn't have to
5 move markers, but if they didn't move the marker, that would lbe fine. But
6 we wouldn't not that it's the final location until the user accepts it in element
7 1.4. So in your scenario, by a matter of luck, the marker is right where I
8 want it to be, I look at the screen, I say oh yes, that's exactly where I want it
9 to be. It still isn't my final location yet because we don't know. You could
10 move it, you may not move it, or you could move it and then move it back
11 because you find out its actually not better. But it's not -- you don't have a
12 final location until the user accepts that location in element 1.4. And at that
13 point we can retrieve the images that correspond to that final location
14 coordinate.

15 JUDGE BAER: And what if the Petitioner had two different
16 references? The first reference describing aerial images, and the second
17 reference, a different reference having oblique images. Would that change
18 your argument at all? Is the problem that this is really one reference
19 accessing oblique and aerial images all at once? Would it change if there
20 were two different references? One with aerial images and one with oblique
21 images?

22 MR. WEBB: I don't think that would change the analysis, I mean, as
23 you pointed out, all the references inf front of us here have the single image
24 retrieval step where you obtain all the images, top down and oblique at one
25 time. But even if it were a situation where you had two separate ones,
26 there's nothing of record saying that I performed one imagery retrieval for

1 top-down view, then I move a marker to get a final location and then I do a
2 second separate image retrieval step for oblique images. There is just
3 nothing on the record related to that.

4 JUDGE BAER: But doesn't Petitioner's rationale for combining
5 these references, which is to increase accuracy, doesn't that explain why a
6 person of skill in the art would have to do these in two separate steps? In
7 other words, if you're going to have a marker, which we know one of the
8 references teaches, you're going to have a movable marker and you're going
9 to have a confirmation box, which we know another reference teaches. And
10 you're going to use those to improve accuracy. Isn't it clear to a person of
11 skill in the art that you must first do one and then the other?

12 MR. WEBB: I think it's important to context for those, right. So the
13 movable marker on Florance is when you move the marker to get -- to put it
14 more directly over the property so that when you search later, for example,
15 you search within a property box or properties along one side of a road, you
16 get those properties only that show up in your results. So there's not another
17 image retrieval step for different images. Once you've processed the
18 property and moved the marker, that's where the process ends in Florance.
19 There is no additional searching, especially not additional retrieval images
20 based on that moved marker.

21 JUDGE BAER: Well, that's certainly true. The additional image
22 retrieval would be the additional image in Kennedy or Deaton, which would
23 be getting the oblique images. And my question is how else could a person
24 of skill in the art put this together to improve accuracy without doing one
25 image retrieval step and then a second image retrieval step?

1 MR. WEBB: Your Honor, I believe that's a question for Petitioner,
2 right. That's their burden to show how you would do this. And here the art
3 is clear. They all include a single image retrieval step, whether you move a
4 marker or not. There is no concept of doing a second later image retrieval
5 step in any of the references.

6 JUDGE BAER: So let me ask you this question then. Does the
7 patent address why you want two separate retrieval steps? The reason for
8 that, the benefit of two separate retrieval steps?

9 MR. WEBB: It talks about how, you know, moving the marker to
10 the right directly over the roof data or the roof structure of the property, kind
11 of the element 1.3 of the claim, gives you a GPS coordinate that then can be
12 used for that updated search in 1.4 or 1.5 so that you have -- you're getting
13 the best oblique images you can for then processing and, you know,
14 generating roof structure information based on that real world 3 dimensional
15 building. I think what we're seeing here is the Petitioner has seen, you
16 know, the claims that are here and kind of used that as a roadmap to try and
17 piece together what is the prior art has. But critically the prior art is missing
18 a second image retrieval step as claimed in Claims 1 and 14. So, we talked
19 about this a little bit --

20 JUDGE GIANNETTI: Are you contesting that these claims, these
21 steps have to be performed in order? Or are you agreeable that this process
22 has to be performed in the order that's set forth in the claim?

23 MR. WEBB: I think in some ways yes, it needs to be performed
24 somewhat in order.

25 JUDGE GIANNETTI: What does that mean? They're in order or
26 not?

1 MR. WEBB: Sure, I was going to explain what I meant. So --

2 JUDGE GIANNETTI: Okay.

3 MR. WEBB: Essentially you have to have the element 1.1 must
4 occur first because it needs data corresponding to the location of the
5 building. And then you provide visual access in 1.2 based on 1.1

6 JUDGE GIANNETTI: Yes.

7 MR. WEBB: Those two have to happen in order. 1.3 and 1.4 follow
8 from that, you know, you can't move the marker until you have the image
9 from 1.2. And 1.4 is the user acceptance of that final location. So, all of
10 those need to be in order I believe, followed by 1.5 which builds on all of
11 those elements to then provide the oblique images based on that user
12 accepted final location in 1.4.

13 JUDGE GIANNETTI: So they have to be performed in order?

14 MR. WEBB: I think that, yes. I think that is what ends up, when you
15 walk through logically what is required from each step, it ends up needing to
16 be performed in order.

17 JUDGE GIANNETTI: Okay, thank you.

18 MR. WEBB: Okay. We've talked about this in our discussion
19 already, but I will jump to the claim construction of element 1.4 and 1.5 a
20 little more explicitly. As we talk about that two limitations require, you
21 know, 1.2 did not require the access to be from any particular place whereas
22 1.5 does.

23 And then if we jump to Slide 13 of the presentation, we see it's
24 important to note that Dr. Bajaj, Patent Owner's expert only provided
25 construction of the second providing visual access steps. Dr. Bajaj did not
26 construe the first providing visual access step in element 1.2. And during his

1 deposition Dr. Bajaj was asked about this construction of the second
2 providing visual access step, and in response Dr. Bajaj explained, and we see
3 this on the right-hand side of the screen, why a POSITA would understand
4 element 1.5 to acquire access in a database and more specifically the
5 explicitly recited aerial imagery database.

6 In the reply, the Petitioner quoted a small portion of Dr. Bajaj's
7 testimony a little bit out of context and tried to use it in a bit of a misleading
8 manner. We see this on the left-hand side of the screen. And the Petitioner
9 improperly implied that Dr. Bajaj testified that any and all instances
10 providing visual access require accessing a database such that both elements
11 1.2 and 1.5 would require accessing a database.

12 But there are two problems with this argument. First, and most
13 importantly, Dr. Bajaj did not testimony that element 1.2 requires accessing
14 a database. And second, even if element 1.2 were understood to require
15 access and accessing a database, it would not create any type of claim
16 differentiation issue as Petitioner asserts.

17 Turning to Slide 14, sorry turning Slide 15, actually, we see here a
18 reproduction of dependent Claims 2 and 3. As shown Claim 3 depends from
19 Claim 2 which further depends from Claim 1 so that Claim 3 would require
20 all the limitations of both Claims 1 and 2. And importantly, as we see
21 continued in Claims 2 and 3, even if claim element 1.2 is understood to
22 require accessing a database and claim 1.5 is properly construed to require
23 accessing to recited aerial imagery database. Claim 3 would still further
24 limit of Claim 1. Clearly for these reasons, it's clear that Petitioner's claim
25 differentiation argument is simply wrong.

1 JUDGE BAER: You are now into your rebuttal time, which is fine,
2 but you're at 50 minutes.

3 MR. WEBB: Yes. I will save the remainder of my time for rebuttal
4 as well then, thank you.

5 JUDGE BAER: Thank you. Okay. Petitioner, you are up for
6 rebuttal and you have 23 minutes.

7 MR. DEUTSCH: Your Honors, could I request a short bathroom
8 break?

9 JUDGE BAER: Of course. We'll take a 5-minute recess.

10 MR. DEUTSCH: Thank you.

11 OFF THE RECORD

12 ON THE RECORD

13 JUDGE BAER: Do we have counsel for Petitioner back? I see you.

14 MR. DEUTSCH: Yes, we are ready, Your Honor.

15 JUDGE BAER: All right, and counsel for Patent Owner, are you
16 back?

17 MR. BOWSER: Yes, we're ready.

18 JUDGE BAER: Great. Petitioner, again, you have 23 minutes
19 remaining and you can start when you're ready.

20 MR. DEUTSCH: Thank you, Your Honor, and I will start with the
21 737 patent. In particular, I'll touch on secondary considerations discussions
22 that we had as well as talk about a few issues that were asserted to be
23 improper new arguments. And then I also wanted to touch on briefly the
24 other independent claims that were addressed in the petition.

25 So, on the first topic, related to the legal framework for determining
26 criticality, that isn't in the record at the moment from either Patent Owner or

1 Petitioner. Be happy to submit additional briefing to assist on that topic.
2 But we do have on the record evidence showing that Patent Owner has
3 advertised the criticality of these features, in particular the pitch
4 determination feature. So this is reflected in multiple exhibits. First with
5 respect to the Twister, excuse me, and Render House manuals which are
6 shown on Petitioner's Slide 28. I don't want to go too far on that because
7 that's something that was designated confidential, but there are highlighted
8 portions that are relative -- relevant to this factor.

9 And second, in its secondary considerations analysis, Patent Owner
10 relied on Exhibit 1026 which provides another example of the significance
11 of pitch determination. And so the quote that Patent Owner had provided
12 talked about the accuracy of measurements citing to page 1 of that exhibit.
13 In scrolling down further, we see more on page 3 about what that was
14 including pitch determination. And so its relevant both to the criticality and
15 again, to the extent there is praise, its speaking to things like pitch
16 determination, which is significant to the performance of those reports, how
17 those reports are received and used.

18 And so this is again, something that, you know, there's a question of
19 who has the burden of discussing these things, and the party not in a position
20 to further assess this is Petitioner. And it's clear from Fox Factory that the
21 patentee as to nexus bears the burden, it stands to reason that even more so
22 when it comes to the presumption that burden is on Patent Owner. They just
23 --

24 JUDGE BAER: But once they've shown, once the Patent Owner has
25 shown that the claims cover the commercially successful product, doesn't it

1 then turn to you? Doesn't the burden shift to you to show that there is
2 something critical that is unclaimed?

3 MR. DEUTSCH: I think that --

4 JUDGE BAER: Isn't it impossible for a Patent Owner to go through
5 every possible feature in a product that is unclaimed, that they used colored
6 pictures, that some of the properties have a garage. All these other things,
7 and say this is not critical, that's not critical. That would be an impossible
8 burden for a Patent Owner to meet. So is it true that it must be Petitioner's
9 burden, once the Patent Owner has shown that the claims read on the
10 product, to show that there is something critical?

11 MR. DEUTSCH: I think here we're in a situation where that -- those
12 additional features haven't even been engaged with. So we have the -- we
13 know that there are these additional features there.

14 JUDGE BAER: I don't understand your statement that those features
15 haven't been engaged with. You have identified two additional features,
16 that's fine. My question is, you know, to the extent that there's something
17 else out there, isn't it your burden to show it?

18 MR. DEUTSCH: And I think the question that you're asking with
19 respect to establishing the presumption, right? I mean, I think the question
20 here, there is -- I heard from Patent Owner that they said the claims are co-
21 extensive and so therefore we've -- we're entitled to presumption and the
22 burden shifts. But at this point, we're at a stage where they haven't gotten
23 to that point of showing that the claims are co-extensive by --

24 JUDGE BAER: I think what Patent Owner meant by that is once
25 they have shown the claims read on the patent. Excuse me, that the claims
26 read on the product. At that point, they have shown co-extensiveness until

1 Petitioner challenges that by showing some sort of critical, unclaimed
2 feature. I don't think they mean that, you know, the conversation is
3 completely done. And that's what I'm trying to push you on. Once they
4 have established that claims read on the product, isn't it Petitioner's burden
5 to show that there is some critical, unclaimed feature?

6 MR. DEUTSCH: So, I think, I mean, wherever that lands, I mean, I
7 think the evidence of record shows that. Just given the statements that
8 Patent Owner has made about their own products, both in manuals, what's
9 appeared in the exhibits that they cite to specifically about like pitch
10 determination. And so that's something that I think is, it's in the record and
11 we've demonstrated. And it's something that goes and it goes both to the co-
12 extensiveness question, and it also goes to a lack of any specific nexus,
13 because there's these other features that the purported praise for example is
14 attributed to. So it goes to both of these questions.

15 And I think the, I mean, one other thought on that question of where
16 the burden falls, Fox Factory does not inform a burden shift of this type.
17 And I don't see that in the Fox Factory discussion. The way it played out
18 there was a little bit -- in that case, they reiterated that there was no showing
19 of co-extensiveness, no presumption and to get to nexus and the patentee
20 still bears the burden of showing that. And its comparing the evidence
21 between the product and the evidence of secondary considerations. And I
22 can -- I'm turning to --

23 JUDGE CASS: Counsel, this is Judge Cass. Let me follow up on
24 this co-extensiveness issue. So, looking at Fox Factory, it's my
25 understanding that co-extensive means something more than just the claims
26 cover the product. But, obviously it doesn't mean that they're identical and

1 the claims include every feature that might be important. So, how are we
2 supposed to understand, you know, what is -- what does Patent Owner have
3 to show here to get this presumption based on co-extensiveness?

4 I think Fox Factory kind of sets out that if you have a situation where
5 I think as you had the brakes in a car, you know, it's going to be hard to
6 show co-extensiveness in that situation where you have just one small
7 feature. But it seems to me that here, we've got more than just brakes in a
8 car. We've got, you know, a pretty significant feature. So, what would
9 Patent Owner have to do to show -- to get their presumption based on co-
10 extensiveness?

11 MR. DEUTSCH: Thank you, Your Honor. Well, I think, I mean, the
12 purpose here of the presumption is a situation where if the -- if the
13 embodying product is essentially the claimed invention, then we can feel
14 pretty good that the commercial success or the industry praise was tied to
15 that product. But the more, you know, as you have these additional features,
16 they're -- that's called into question and there's not this guarantee that those
17 are tied together. And then proceed to the next step of showing actual
18 nexus. And so that's really where, when we're in this zone where there's so
19 much ambiguity and we have this evidence of additional features that are
20 relevant to the performance, that seems problematic and, you know, the
21 purpose of applying that presumption no longer holds up. If I'm answering -
22 -

23 JUDGE CASS: But there are always going to be additional features
24 though, I mean, it's hard to imagine a situation where a claim is going to
25 cover every aspect of a product that might contribute in some way to its
26 success. So, again, one way I've looked at it is to see, you know, how big of

1 a contribution the invention is making as compared to other features. But
2 and so do you have evidence in the record on that? Do you introduce
3 evidence showing that the feature that's claimed isn't important and that
4 there are other features that are more important? Or are you just basically
5 saying Patent Owner hasn't met its burden?

6 MR. DEUTSCH: No, there is evidence and I think you're right, I
7 mean, we aren't saying it has to be a one-to-one correspondence. There is a
8 small amount of wiggle room but it needs to be close. And here we have a
9 situation whereas the pitch determination, it's like the brake and car example
10 where that's going to be a problem for users of the reports without that
11 information. And that's reflected, again, in Patent Owner's own manuals
12 talking about these features. It's reflected in the newsletters, like Exhibit
13 1026, that again, are being relied on by Patent Owner for accurate
14 measurements but then as an example of that measurement its pitch
15 determination. So we have, you know, from all of these sources.

16 JUDGE CASS: So is the pitch determination going to -- is that
17 something that's different from the product that's, you know, the subject of
18 the commercial success here and other competitive products? Or is that
19 something that is going to be comparable in multiple products in the market?
20 Do we have evidence of that?

21 MR. DEUTSCH: I mean, as to I think third party products, there is
22 not -- not for the discussion of that type of comparison. But it's something
23 again, that's -- it's not a -- there hasn't been any evidence showing that that's
24 just a, kind of standard throw away feature, but for purposes of roof repair
25 and replacement for example it becomes very significant.

26 JUDGE CASS: Okay, thank you.

1 MR. DEUTSCH: And I'm happy to dig in further to if some of the
2 other evidence. We talked about Exhibit 1026 which was on the left of their
3 slide. There's Exhibit 1028 which was on the right of that slide which
4 relates to again, they're relying on industry praise. That exhibit, other
5 exhibits in the record are things from Eagle View themselves as opposed to
6 third party praise of the product.

7 And again, further to this discussion, there just isn't anything tying it
8 to what's actually claimed and important in the 737 claims. And so I think
9 the -- taking a step back, it's -- even if there's a product that embodies the
10 claims and enjoyed commercial success, that's not enough on its own to set
11 aside a finding of obviousness. Especially in the face of additional factors
12 that drove sales or that were the cause of industry praise.

13 So, things like making it available on various platforms, selling it on
14 phone applications, tablet applications, other roofing software applications,
15 far better explain the commercial success than anything tied to the claims.

16 So with that, I can touch on the ground 1 and 2 analysis a bit more.
17 There was quite a bit of discussion from Patent Owner that -- asserting that
18 some of that discussion was new or improper in the reply. But everything
19 that we rely on in Heller and Deaton for hitting the limitations of the claims
20 was cited in the petition. And so, I know and again, that the petition
21 provides description at pages 12 through 17 and then later specially with
22 respect to limitation 1.5 and this was shown in our Slide 11. And this is not
23 new argument. Its disclosure in Heller and Quam that Patent Owner was
24 certainly aware of.

25 And, you know, one small point that I'll make, in the petition, you
26 know, we were clear about how this disclosure was being used and noted for

1 example at the bottom of page 12 in the footnote that a general descriptions
2 provided for the references and combinations are incorporated into each
3 subsection below apply in these references. So, it wasn't -- it's not as
4 though, you know, I'm talking about things in a separate heading makes
5 them ineligible and certainly because for the same portions of Heller and
6 Quam, the same aspects are being discussed throughout the petition and that
7 we relied on consistently in the reply.

8 And very briefly, I'll also note similar situation with respect to the
9 other independent claims. And so there, Patent Owner had noted that the
10 petition cited back to the Claim 1 analysis despite additional language that
11 that highlighted in independent Claim 16 and independent Claim 26 and as
12 you set forth in the reply, this is, you know, those limitations were not
13 forgotten or overlooked. They were just addressed up above in the Claim 1
14 analysis. And so that's in the petition and in the reply and Dr. Forsyth's
15 second declaration responsive to the Patent Owner response he expanded on
16 that further. And I'll note that that -- those specific disclosures haven't been
17 challenged. Patent Owner declined to depose Dr. Forsyth a second time on
18 any of that discussion and so it really bows to the substance not refuted.

19 JUDGE BAER: On the particular question of just the first
20 combination of Quam and Heller and just the limitation about the use of the
21 report which is provided for repair and or constructing the roof structure of
22 the building, this is in your petition, pages 33 and 34. Actually 33 through
23 35. I sort of see your argument on generating a report, because you talk
24 about showing a, showing the data, displaying the data that sort of thing. I
25 think it's a closer call on the intended use. Is your position that look, the
26 intended use isn't limiting, so we didn't have to show it or even understand?

1 Or is it that no, somewhere there in that 33 through 35, we really did touch
2 on the intended use limitations such that if it is limiting we showed where it
3 is. Or its somewhere else in your petition for that matter?

4 MR. DEUTSCH: Yes, thank you. And I think, I mean, the petition
5 is, it's there in ground 1. And we did show it. I think, you're right, I mean,
6 there's a -- I'm not sure we needed to but it is there. And that's something
7 that in addition to how it was explained in the petition, Dr. Forsyth had
8 explained relying on that same disclosure in Heller and Quam why that's the
9 case. And what he said and this is paragraph 19 of Exhibit 1041 he had
10 noted that Heller Quam system provides information about the geometry of
11 roof structures. Importantly that would have informed the viewer as to the
12 parameters for estimating and implementing roof repair construction
13 activities. And so through what Heller and Quam is generating and
14 outputting, the relevance to these roof structures giving ground 1 that last
15 element. But of course, you know, as to ground 2 there's no question, all
16 that's not in dispute as to what Patent Owner refers to as limitation 1.5B.

17 JUDGE BAER: Thank you.

18 MR. DEUTSCH: I'm happy to dive into more details on Claim 16 or
19 26 or 9 and 10, but in the interest of time, if there are no questions I'll turn it
20 over to the 880 topics.

21 JUDGE BAER: That would be great, thank you.

22 MR. DEUTSCH: Thank you.

23 MR. ROZYLOWICZ: Your Honors, can I respectfully ask how
24 much time is remaining?

25 JUDGE BAER: You've got about 4 minutes. I'm willing to give you
26 two more extra beyond that.

1 MR. ROZYLOWICZ: Thank you, Your Honor. I'd first like to
2 speak to Judge Giannetti's comments as to whether or not instruction is
3 required. Again, Your Honor, respectfully we maintain our position that
4 plain order of meaning works. With that said, and again in the context of
5 both direct access of databases as described in the specification as well as
6 was noted by Judge Baer, indirect access that have direct memory access
7 themselves, but certainly on page -- Slide 6 of today's presentation as
8 acknowledged by the Patent Owner in their response on page 13. You
9 know, these operations can in fact be performed in a single access operation.

10 And some of this, if we were compelled to offer a definition, I think
11 certainly with Judge Baer what you offered up in terms of any -- I'm sorry,
12 any display would in fact work might be one definition. Again, providing
13 access in whatever way you need to to provide access would suffice. Again,
14 I'll pause here and see if there's any questions or comments. Okay.

15 Second point, Your Honor, I think there was some question as to
16 would our analysis change if we in fact had access to two different
17 databases. Again, as we discussed with respect to Claim 3, we believe that
18 two different databases are in fact not contemplated by this particular
19 combination. But I think that was related to some comment by Mr. Webb
20 that we bear the burden to pose the combination. We respectfully suggest
21 that Patent Owner's improperly wanting bodily incorporation. Again,
22 looking at our combination as proposed and contemplated with Kennedy
23 Keane and Kreft on case 18 as suggest we can put that forward in the record
24 in our petition.

25 Your Honor, I want to pause to see if there's any further questions on
26 the 880 patent before I return to one issue related to the 737 patent? Okay.

1 Hearing no objections I wanted to speak to something that Judge Cass
2 brought up. I'm not sure, but I'm concerned that there might be some
3 confusion over the meaning of the term co-extensiveness. From my
4 understanding, I believe it simply means that there is no other compelling
5 features at issue. Fox Factory in particular dealt with a particular change
6 and gap and how it was filled relative to a chain that would be used in a
7 bicycle transmission. In that case, I think co-extensiveness makes sense in
8 this conversation, because we're dealing with a rather simple mechanical
9 inventions in the context of what is -- was a complex featured software
10 system. I would suggest that finding co-extensiveness is a far more
11 demanding task going forward.

12 And again, without what Fox Factory tells us is that without co-
13 extensiveness they lose their presumption of a nexus and with that being the
14 case I think we then fall back to the WMS Gaming decision in the Federal
15 Circuit 1999 which reminds us that the Patent Owner in fact bears the
16 burden of establishing that nexus. So, Your Honor, that was really the last
17 thing I planned to speak to. I'm certainly happy to respond to any additional
18 questions. If there's not I'll conclude our remarks there.

19 JUDGE BAER: I don't think we have anything further.

20 MR. ROZYLOWICZ: Thank you, Your Honor.

21 JUDGE BAER: Thank you.

22 MR. BOWSER: Your Honors, this is Jonathan Bowser again.

23 Before I start, just be clear, how many minutes do we have for sur rebuttal?

24 JUDGE BAER: 10 minutes.

25 MR. BOWSER: 10 minutes, okay. So, I'd like to first start off with
26 an argument that Petitioner made in his rebuttal where they pointed to foot

1 note 5 on page 12 of the petition. This is an entirely new argument that
2 they're sort of now relying on to effectively justify using portions of Heller
3 and Quam that they never actually cited to. So, on a, you know, I don't find
4 that at all surprising because we've seen a number of new arguments come
5 up over and over again.

6 What we have to go on is when you look at limitation 1.5, what did
7 they cite? That's what the petition, I mean, it's the Petitioner's burden to
8 show a particularity why a specific limitation is disclosed and they just
9 haven't met that burden. Petitioner's counsel said multiple times very
10 vaguely was cited in the petition, I'm using their quotes. But look at what
11 the petition cited for specific limitations. That's what we challenged and
12 that was deficient.

13 And so I'm going to turn next to the issue of secondary
14 considerations. As for the Fox Factory issue, so it's quite clear in Fox
15 Factory that it talks about the presumption of nexus being a rebuttable
16 presumption and that it's the Patent Owner's burden to show that. And then
17 once that burden is met, then that's what by definition is a rebuttable
18 presumption. So then the challenger here would have to rebut that. So that
19 it's quite clear the challenger here, Nearmap, has that burden. So, they
20 haven't done so.

21 I want to point out a couple examples. The only thing that they cited
22 to are adding location data to reports and at pitch determinations. So, one of
23 the things that they point to is Exhibit 2007 on page 22, and I'm going to be
24 very general here because this is a confidential document. But what is
25 described --

1 JUDGE BAER: What is this confidential document? Can you give
2 us the reference again please?

3 MR. BOWSER: Exhibit 2007, page 22. Its page number 22.

4 JUDGE BAER: All right, give us just a moment if you would and I'll
5 hold up on your time. I just need to pull up the document.

6 MR. BOWSER: Okay. So as we see there, there's the heading up at
7 the top of page 22. That specific aspect and again, I'm being very vague
8 here and very general, but that specific aspect is what is described as being
9 critical. It's not the pitch determination. That specific feature that you see in
10 the header and I'm not going to say what it is, but that specific features is
11 what is described as critical. It is not described as the dependent Claim 11
12 of the 770 as being critical.

13 So we have the situation where Petitioner's burden is to show that
14 something is in fact critical. Petitioner's counsel made the argument that
15 seemed to suggest that they shouldn't have to do that because they don't
16 necessarily know the product as well. But, that is contrary to what the
17 burden of framework set forth and Fox Factory established, right. We have
18 shown that the claims are coextensive. They have not shown that features
19 that are unclaimed in the 737 patent are critical. I would point out that, you
20 know, that those features about having location data and sometimes having
21 pitch information, you know, that might be part of the successful output of a
22 report, but ultimately it's the information in the report that --

23 JUDGE GIANNETTI: Mr. Bowser, just one -- sorry to interrupt.
24 This is Judge Giannetti again. I'm just confused a little bit about this burden
25 shifting thing. I've actually got Fox Factory up here and I'm looking at it. Is
26 it your connection that all you have to do to shift the burden is to show that

1 the claims read on the product? Is that your position? Because I don't think
2 that's consistent from Fox Factory if that's what your position is?

3 MR. BOWSER: Well, I'm reading from a portion of Fox Factory
4 here. I'm sorry I just lost the PDF here.

5 JUDGE GIANNETTI: That's what you seem to be saying.

6 MR. BOWSER: So, what we have, it's not necessarily -- I'm sorry,
7 would you repeat your question? I'm looking for Fox Factory.

8 JUDGE GIANNETTI: Is it sufficient to shift the burden to the Patent
9 Owner? Excuse me. Is it sufficient for the Patent Owner to shift the burden
10 to Petitioner to show simply that the product is co-extensive with the claims
11 in the sense that the claims read on the product? Is that enough?

12 MR. BOWSER: Well, in this case it is enough, because we've shown
13 that the Twister and Render House products embody the change claims. I
14 will read from Fox Factory here and you may remember earlier I talked
15 about how it's kind of a sliding scale in the sense of there's perfect
16 correspondence and then there is obviously on the other end of the spectrum
17 there's not, you know, there's not very good correspondence.

18 JUDGE GIANNETTI: Okay. I just want to make sure my question
19 gets answered. I don't think that my question called for a sliding scale, but
20 go ahead. Answer the question.

21 MR. BOWSER: Okay. So, it is -- you're asking is it sufficient to
22 show that the claims just simply embody the product?

23 JUDGE GIANNETTI: Yes. In the sense that they read on the
24 product.

25 MR. BOWSER: I would say in this particular instance it doesn't
26 because Fox Factory requires, and I'm quoting here, "What we do require is

1 that that the patentee demonstrate that the product is essentially the claimed
2 invention." And that's exactly what we've done, Your Honor. And so we
3 have a --

4 JUDGE GIANNETTI: So here's what it also says. We reject
5 SRAM's attempt to reduce the co-extensiveness requirement to an inquiry
6 into whether the patent claims broadly cover the product that is subject of
7 the evidence in the secondary considerations. In other words, I think they're
8 saying it's not enough just to read the claims on the product. Do you agree
9 with that?

10 MR. BOWSER: Well, I would agree int that particular instance, and
11 the reason why it was not enough was because they were other critical
12 features that were unclaimed. And here we have a situation where the
13 challenger has not shown that there are unclaimed critical features.

14 JUDGE GIANNETTI: But doesn't this place this burden -- but
15 doesn't Fox Factory place the burden on the party claiming commercial
16 success? Doesn't that -- isn't that what this says? Isn't it enough just show
17 that the patent claims read on the product? That you've got to show that
18 these other, that's essentially the same and that there aren't other features
19 that might be in the mix?

20 MR. BOWSER: Right. And we've done that because so reading in
21 Fox Factory --

22 JUDGE GIANNETTI: But you agree with that. You agree with that
23 reading of the case? That you have --

24 MR. BOWSER: I would agree that --

25 JUDGE GIANNETTI: -- the responsibility to --

1 MR. BOWSER: Certainly -- I'm sorry. I apologize. I would agree,
2 Your Honor, with the concept that it is the Patent Owner's burden to show
3 that the claims are in fact co-extensive. And we have done that here, not
4 only with showing how the claims are embodied. But also, we've done --
5 we've met that burden because we have shown other evidence as to how the
6 claims are essentially representative of the Twister and Render House
7 products.

8 JUDGE GIANNETTI: Okay. So you claim that any other features
9 that the products may have that go beyond what's in the claims that these are
10 not essential features. Is that what your position is?

11 MR. BOWSER: We're -- what we have shown, Your Honor, is the
12 fact that, you know, sometimes you might have advantageous aspects such
13 as adding the address information. That's certainly, you know that might
14 make the report a little bit better.

15 JUDGE GIANNETTI: Yes.

16 MR. BOWSER: It's not necessarily crucial to the accuracy of the
17 reports. The accuracy of the reports is because of the way that the claims of
18 the 737 patent cover the product. I would also say, Your Honor, too, even if
19 the presumption is not established, we have also met the burden to show that
20 the claims are -- they have a nexus to the specific secondary considerations
21 evidence because --

22 JUDGE GIANNETTI: Even without the presumption you say that
23 you demonstrated nexus?

24 MR. BOWSER: Yes. Well, nexus is a different inquiry, Your
25 Honor. So, the rebuttable presumption has to do with a co-extensiveness
26 and nexus has to do with whether something is the direct result.

1 JUDGE GIANNETTI: Yes.

2 MR. BOWSER: And we have shown that the direct result of creating
3 and generating and outputting these reports as recited in the 737-patent led
4 to the remarkable commercial success and the industry praise.

5 JUDGE GIANNETTI: And you understand that that's --

6 MR. BOWSER: Yes, Your Honor. Yes. And we --

7 JUDGE GIANNETTI: No shifting on that.

8 MR. BOWSER: Yes.

9 JUDGE GIANNETTI: So that's --

10 MR. BOWSER: Your Honor.

11 JUDGE GIANNETTI: All right, thank you.

12 MR. WEBB: Okay, I know, Your Honors, we are mostly out of time
13 but if you'll allow me to just make one point regarding the 880. Thank you.
14 So a couple times today Petitioner has implied that Patent Owner has
15 somehow acknowledged or agreed that a single access operation can be used
16 to satisfy both elements 1.2 and 1.5. Petitioner pointed to the Patent
17 Owner's response where we talk about how Kennedy obtains all its images,
18 the vertical and or the oblique images in a single image retrieval to somehow
19 mean that we're agreeing that that can satisfy both elements 1.2 and 1.5.

20 We would make that -- like to make it explicitly clear that we do not
21 agree with that. They are two sperate providing (inaudible) access steps and
22 they cannot be met by single image retrieval steps. And with that if you
23 have no other questions that's the last point I wanted to make.

24 JUDGE BAER: Anything further from any of my colleagues?

25 JUDGE GIANNETTI: Not from me.

1 JUDGE BAER: Great. With that, that will conclude our hearing.
2 Before we let you all go, does our court reporter have any questions for the
3 parties about spellings or anything like that?

4 COURT REPORTER: Yes, Your Honor, if I could just go through
5 my notes.

6 JUDGE BAER: Yes.

7 COURT REPORTER: Thank you very much.

8 JUDGE BAER: You can do that now. Go ahead. Patent Owner, can
9 you confirm that we're okay designating this as non-confidential?

10 MR. WEBB: Yes, that should be fine.

11 JUDGE BAER: And I assume that Petitioner (inaudible).

12 MR. BOWSER: I would agree with that.

13 JUDGE BAER: Great. Thank you, Mr. Bowser. And counsel for
14 Petitioner, you don't have any concerns on that line, do you?

15 MR. ROZYLOWICZ: No, sir, Your Honor.

16 JUDGE BAER: Okay, with that we will conclude. Let me again say
17 thank you to the parties, it's been very helpful. In particular, we do
18 appreciate Mr. Wang your participating in our LEAP program, that's great.
19 We are happy to see that and happy to have you participate. With that the
20 case is submitted. Thank you very much.

21 (Whereupon, at 3:36 p.m., the proceedings were concluded.)

IPR2022-00733 (Patent 8,542,880 B2)

IPR2022-00734 (Patent 9,135,737 B2)

PETITIONER:

Walter Karl Renner

Thomas Rozylowicz

Daniel D. Smith

Patrick Darno

Patrick Bisenius

Craig Deutsch

Yao Wang

FISH & RICHARDSON P.C.

axf-ptab@fr.com

tar@fr.com

dsmith@fr.com

darno@fr.com

bisenius@fr.com

deutsch@fr.com

ywang@fr.com

PATENT OWNER:

Kyle Howard

Gregory Webb

Jonathan Bowser

HAYNES AND BOONE, LLP

kyle.howard.ipr@haynesboone.com

greg.webb.ipr@haynesboone.com

jon.bowser.ipr@haynesboone.com