

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEARMAP US, INC.,
Petitioner,

v.

EAGLE VIEW TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2022-00734
Patent 9,135,737

PETITIONER'S BRIEF ON REMAND

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I. INTRODUCTION

The answers to the Board’s questions are straightforward and dispositive: 1) The roof report content language constitutes printed matter that is not entitled to patentable weight, and 2) evidence of secondary considerations directed to roof report content is thus “not relevant” to the challenged claims. *Praxair Distrib. v. Mallinckrodt Hosp. Prods. IP*, 890 F.3d 1024, 1035 (Fed. Cir. 2018) (finding printed matter claim language cannot provide basis for secondary considerations because it is not entitled to patentable weight). The Final Written Decision’s (“Decision”) conclusions that the alleged embodying products have a “strong correspondence” to, and are coextensive with, the claims cannot stand when reconsidered in view of the proper interpretation of the roof report content limitation. The alleged embodying products include significant additional features, e.g., roof report content not entitled to patentable weight and alleged to be the basis of praise and commercial success, and are not coextensive. On remand, applying a proper *Graham* factor analysis, and considering the secondary considerations evidence against the proper scope of the claims in which the roof report content is not entitled to patentable weight, a finding of nonobviousness cannot be sustained.

II. THE ROOF REPORT CONTENT LIMITATION CONSTITUTES PRINTED MATTER THAT IS NOT ENTITLED TO PATENTABLE WEIGHT

Claim 1 of the ’737 patent references roof report content with language

relating to printed subject matter that is not entitled to patentable weight. In particular, claim 1 includes language indicating that a roof report “includes numerical values for corresponding slope, area, or lengths of edges of at least some of a plurality of planar roof sections of the roof.” These limitations are directed to printed matter that has no function or structural relation to the substrate on which it is printed or displayed, and are entitled to no patentable weight. *In re DiStefano*, 808 F.3d 845, 850 (Fed. Cir. 2015); Pet., 6-11. In a prior IPR involving the ’737 patent, the Board properly held accordingly. Pet., 6-7 (citing NEARMAP-1010, 18), 8-11.

Patent Owner never disputed this interpretation of the roof report content limitation. Response, 11-15; Paper 38, 31:24-32:5 (“Do you contest that the contents of the roof estimate report are not entitled to patentable weight as we held in the previous IPR? . . . Mr. Bowser: Oh, we have not contested that.”). There is therefore no basis to depart from the Board’s prior, undisputed interpretation that the roof report content is not entitled to patentable weight.¹

¹ Even if printed matter is not entitled to patentable weight in the validity context, it may still be an infringement limitation. *See, e.g., Abbott Labs. v. Sandoz, Inc.*, 566 F.3d 1282, 1291 (Fed. Cir. 2009) (finding process terms in product-by-process claims serve as infringement limitations, even if not entitled to patentable weight).

III. PATENT OWNER’S EVIDENCE OF SECONDARY CONSIDERATIONS IS DIRECTED TO SUBJECT MATTER ENTITLED TO NO PATENTABLE WEIGHT AND IS NOT RELEVANT TO PATENTABILITY OF THE CHALLENGED CLAIMS

A. The Board’s Conclusion of a Presumption of Nexus Was Improperly Based on Subject Matter Entitled to No Patentable Weight

A finding that the roof report content limitation is not entitled to patentable weight fully disposes of Patent Owner’s alleged secondary considerations. As noted in Section I and as the Federal Circuit has explained, secondary considerations evidence directed to printed matter claim language that has no patentable weight is “not relevant.” *Praxair*, 890 F.3d at 1035. (“No patentable weight means no patentable weight.”).² Because the roof report content limitation of claim 1 is not entitled to weight, the relied upon overlap between the roof report *content* of Twister/Render House and claim 1 is not relevant to the obviousness inquiry.

First, proper construction of the roof report content limitation undermines the purported “correspondence” between Twister/Render House and claim 1.

² *Praxair* was subsequent to the prior ’737 IPR, and is yet additional intervening caselaw highlighting that the secondary considerations evidence here is woefully inadequate to outweigh the strong showing of obviousness under *Graham*.

Decision, 11. The Decision expressly credited Patent Owner’s analysis of content features of claim 1 in finding a “strong correspondence” and applying a presumption of nexus. *Id.* (citing POR, 38-57, including Patent Owner’s mapping of content limitations at 42-44). In particular, the Decision relied on Patent Owner’s element-by-element comparison of the challenged claims to the embodying products, which included Patent Owner’s analysis with respect to the roof report content features of claim 1. Decision, 11 (citing PO Resp. 38-57). The roof report content features, in part, thus led to the improper determination of a “strong correspondence”³ between the challenged claims and alleged embodying products. *Id.* But if the roof-report content features are not limiting, they are “not relevant” to the secondary considerations analysis and cannot form the basis of correspondence relied upon in the Decision. The purported “correspondence” between Twister and Render House and claim 1 is meaningfully lessened.

Second, acknowledgement by Patent Owner of significant roof report content within Twister and Render House further demonstrates how Patent Owner has failed to demonstrate coextensiveness with the ’737 claims. To this point, whether Twister and Render House embody features that limit claim 1, because Twister and Render House are also said by Patent Owner to disclose non-limiting

roof report content, evidence of industry praise and commercial success directed to roof report content cannot support a finding of nexus. Simply put, because the content of the roof report of claim 1 is not entitled to weight, the Decision's conclusions are based on legal error and must be withdrawn.

Proper construction of the roof report content limitation highlights that Twister/Render House include significant unclaimed features, precluding application of a presumption of nexus. In order for a presumption of nexus to apply, a product must be “essentially the claimed invention” such that “the unclaimed features amount to nothing more than additional insignificant features.” *See SightSound Techs., LLC v. Apple Inc.*, 809 F.3d 1307, 1319 (Fed. Cir. 2015) (“If a product both embodies the claimed features and is coextensive with the claims at issue, a nexus is presumed. In other words, a nexus exists if the commercial success of a product is limited to the features of the claimed invention.”). The roof report content is far from insignificant to Twister and Render House, according to Patent Owner's own assertions. Rather than supporting correspondence between the alleged embodying products and the claims, roof report content in fact highlights a significant aspect of Twister and Render House directed to features beyond the claimed limitations entitled to patentable weight. To be clear, “the purpose of the coextensiveness requirement is

to ensure that nexus is presumed only when the product ‘*is* the invention disclosed and claimed.’” *Campbell Soup Co. v. Gamon Plus, Inc.*, 10 F.4th 1268, 1276 (Fed. Cir. 2021). Roof report content is critical to Twister and Render House, but is not part of the claim—the roof report content limitation has no patentable weight and is “not relevant” to the obviousness inquiry.⁴

The significance of roof report content to Twister and Render House is not disputed. Indeed, the roof report content was credited by Patent Owner for driving purported success and praise of Twister and Render House. Reply, 15-18 (“accuracy” of measurements and “high-resolution aerial photographs”). Patent Owner’s briefing explains at length the industry praise and commercial success of Twister and Render House roof reports which, as discussed in more detail below, is based on the *content* of roof reports. *Infra.* III.B-C. Simply put, roof report content goes to the heart of the asserted industry praise and commercial success, and is certainly not merely an “additional insignificant feature.” Twister and Render House, the success of which depends on roof report content, are thus not “essentially the claimed invention.”

⁴ Consistent with Petitioner’s d.ct. claim construction, while the “generating and outputting” clause is believed to represent an affirmative technical step having patentable weight, contents of the roof report itself are not entitled to weight.

Moreover, Patent Owner failed to present any evidence about the extent of Twister and Render House beyond overlap with particular claim features. Patent Owner's own declarant acknowledged that the software included "many, many components," but that he was not familiar with the full scope of its capabilities and features. Reply, 14 (citing NEARMAP-1044, 46:2-48:14 ("very directed"); 47:20-22 (did not review the source code); 18:11-21. And Patent Owner itself has alleged industry praise and commercial success tied to a different patent ('770) in an unrelated proceeding.⁵ Reply, 13 (citing NEARMAP-1042, -43). Patent Owner alone has exclusive access to the full scope of Twister and Render House features, which Patent Owner holds out as proprietary. Yet, Patent Owner did not even attempt to show either Twister or Render House 'is the invention disclosed and claimed,' and Patent Owner cannot do so. The alleged embodying products include vast meaningful features not recited by claimed features entitled to patentable weight, of which roof report content is an example. *See, also*, Reply, 11-14. The evidence of record prevents application of a presumption of nexus.

⁵ The independent claims of '770 and '737 have different scope, yet Patent Owner has failed to account for what portion of the purported success and praise was attributable to '770 claim features versus '737 claim features, rendering its analysis here meaningfully diluted, at best.

B. Patent Owner’s “Industry Praise” Evidence Is Directed To Content Entitled To No Patentable Weight

With construction of the roof-report content features of claim 1 left unaddressed, the Decision relied on evidence of industry praise. But a finding that the roof-report limitations are not entitled to patentable weight renders such reliance improper—the purported industry praise is directed to *content* and other features entitled to no patentable weight. The reliance on industry praise directed to content highlights deficiencies as to both the presumption of nexus (because the roof report content is significant to the alleged embodying products, as discussed above), and nexus-in-fact (because evidence directed to claim language that does not have patentable weight is “not relevant”).

Patent Owner cited evidence that “[h]aving an Eagle View report has become an industry accepted standard” and that the software “accurately measures lengths, pitches, valleys, and other hard-to-see areas on roofs.” Decision, 14 (citing EX1027); POR, 61-62 (citing EX1025, EX1026). This type of information corresponds to the roof report content features of claim 1—“numerical values for corresponding slope, area, or lengths of edges.”⁶ Patent Owner’s exhibits themselves confirm the praise is based on numerical measurements and other

⁶ It is undisputed that “aerial pictures” and accuracy are not dictated by the claims.

content of the roof report. For example, Exhibits 1025 and 1026 cited in the Decision tout “accurate measurements” and “diagrams and roof layout” reflected in the roof reports. EX1025, 1; EX1026, 1, 3. In other words, but-for the roof report content, this purported praise would not be.

Patent Owner relies on a survey (prepared by Patent Owner) that “praised the ‘[q]uality of reports’ by giving them an ‘[e]xcellent’ rating.” Decision, 15 (citing PO Resp. 62). Here again, as Patent Owner’s own declarant confirmed, this praise was directed to the quality of the *information* in the report—the report *content*. Reply, 22 (citing EX1054 25:17-26:12, 26:13-27:9, and 29:21-30:9).

The Decision also relies on praise that is not directed to Twister/Render House or its reports at all, but rather aerial imagery technology generally. At page 15, the Decision cites discussion of “[a]erial imagery” generally as a “disruptive innovation,” never mentioning any connection to Twister/Render House or a claimed feature. EX1029, 12. The Decision quotes EX1023 as describing “Patent Owner’s products” as a “killer app.” But the full context confirms that it refers to the application of aerial imagery “in the insurance space for purposes of roof estimating,” never expressly referring to Twister or Render House, or any feature in the claims. *Id.* The excerpt of Exhibit 1023 is thus, at best, directed to praise based on content of the reports related to “roof estimating.” Similarly, Patent

Owner quotes a CEO of a roofing service as purportedly touting the accuracy of Render House/Twister reports, when in fact the statements are directed to “aerial measurement technology” generally. EX1019, 3.

The deficiencies in Patent Owner’s secondary considerations analysis are not remedied by assertion that the praised accuracy is the result of manual adjustment features (Limitations [1.3]-[1.4]). As Dr. Forsyth explained, other aerial roof measuring services were available at the time, and the claimed features related to modifying and displaying line drawings overlaid over aerial images of the roof were known. NEARMAP-1041, ¶32 (citing EX1019, 2 (mentioning other aerial roof measuring services)). There is no dispute that the manual adjustment features were known in the art, including from Heller/Quam, and Patent Owner never alleges these features to be unique compared to alternative aerial roof measuring services available at the time.

Simply put, “there must be a nexus to some aspect of the claim not already in the prior art.” *In re Kao*, 639 F.3d 1057, 1068–69 (Fed. Cir. 2011) (emphasis in original). “Where the offered secondary consideration actually results from something other than what is both claimed and novel in the claim, there is no nexus to the merits of the claimed invention.” While a patent owner may be able to show, for example, “that it is the claimed combination as a whole that serves as a

nexus for the objective evidence,” the record here lacks even an attempt by Patent Owner to make such a showing. *Id.* Patent Owner’s assertion fails as a matter of law.

Likewise, Patent Owner’s improper reliance on report content features is not rendered moot by assertion that the reports are delivered “faster” and “at less expense,” or reducing “liability and risk.” Decision, 12-13. These comparisons are in relation to “climbing onto roofs and manually measuring,” and directed to “accuracy” of report *content*, not to anything recited by the claims and certainly not the manual adjustment features undisputedly known in the prior art. *See, e.g.*, Reply, 15, 22; EX1019; EX1025, 1.

C. Patent Owner’s “Commercial Success” Evidence Is Directed To Content Entitled To No Patentable Weight

Patent Owner’s evidence of commercial success is likewise based on the roof report content—the primary evidence of success is based on sales of roof reports—reports purchased for their roof report content. Here again, a finding that the roof-report limitations are not entitled to patentable weight renders such reliance improper.

There is no dispute that the roof reports were purchased for their roof report content. Patent Owner specifically alleges success flowing from the “accuracy” of the content. But if the content is not entitled to patentable weight, sales based on

the underlying content has no bearing on the obviousness inquiry.

To be clear, annual revenue numbers and growth alone are insufficient to demonstrate commercial success. This is especially the case in a nascent field poised for growth, as a result of “computerizing” or “Internetizing” and releasing apps on wireless devices. Reply, 19. *In re Applied Materials, Inc.*, 692 F.3d 1289, 1300 (Fed. Cir., 2012) (“weak evidence”).

This deficiency is also not remedied by assertions that reports were less expensive than previous manual techniques, which are unsupported and have little bearing on relationship to the ’737 claims, especially where the claims employed known techniques, (e.g., set forth in Grounds 1 and 2) and a “dozen competitors” (EX1025, 2) were in the market.

Ultimately, Patent Owner disregards the controlling indicia of obviousness in the proper *Graham* factor analysis. Rather than long-felt need, the record establishes that the advent of high-resolution aerial imagery resulted in ***short-felt need***. NEARMAP-1029, 12 (“Aerial imagery emerging as a disrupting innovation”); Pet., 62-64. Likewise, the lack of high-resolution imagery makes clear that there was ***no failure of others***. And the Institution Decision’s endorsement of predictable combinability of Heller with Quam resulted in ***expected***, not unexpected, results.

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 CFR § 42.6(e)(4), the undersigned certifies that on March 8, 2024, a complete and entire copy of this Petitioner's Brief on Remand was provided via email, to the Patent Owner by serving the email correspondence addresses of record as follows:

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