

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEARMAP US, INC.,

Petitioner,

v.

EAGLE VIEW TECHNOLOGIES, INC.,

Patent Owner

IPR2022-00734

U.S. Patent No. 9,135,737

**PATENT OWNER'S REPLY TO
PETITIONER'S BRIEF ON REMAND**

TABLE OF CONTENTS

I.	Introduction.....	1
II.	The challenged claims are patentable even if the roof-report limitation is not entitled to patentable weight.....	1
III.	Claim Construction – Elements [1.5(a)] and [1.5(b)] are entitled to Patentable Weight.....	4
IV.	Secondary Considerations of Non-obviousness	5
	A. Petitioner’s reliance on <i>Praxair</i> is misplaced.	5
	B. Patent Owner established a clear nexus between the secondary considerations evidence and the challenged claims that Petitioner failed to rebut.....	6
	C. Patent Owner’s evidence of commercial success and industry praise is not limited to the detailed requirements as to the contents of the roof estimate report.....	9
V.	<i>Graham</i> Factor Analysis.....	10
	CERTIFICATE OF SERVICE.....	13

I. INTRODUCTION

To answer the Board's question, assuming the roof-report limitation¹ is not entitled to patentable weight does not change the fact that the record evidence compels a finding of non-obviousness as to all challenged claims. Patent Owner showed that each limitation of the challenged claims is embodied by Patent Owner's Twister and Render House products that achieved significant commercial success and industry praise. Petitioner has not rebutted this. In addition, Patent Owner showed that the compelling evidence of commercial success and industry praise is the direct result of the unique characteristics of the claimed invention. Therefore, the Board should maintain its finding that the challenged claims are patentable over Petitioner's obviousness grounds even if the roof-report limitation is not entitled to patentable weight.

II. THE CHALLENGED CLAIMS ARE PATENTABLE EVEN IF THE ROOF-REPORT LIMITATION IS NOT ENTITLED TO PATENTABLE WEIGHT

In the Final Written Decision in the Xactware IPR (IPR2016-00592), the Board addressed the patentable weight of the roof-report limitation finding that

¹ "wherein the roof estimate report includes numerical values for corresponding slope, area, or lengths of edges of at least some of a plurality of planar roof sections of the roof."

“the detailed requirements as to the contents of the roof estimate report are not entitled to patentable weight.” EX1010, 18. At the same time, the Board determined that Patent Owner’s “extensive evidence” of commercial success and industry praise and “extensive evidence of nexus” required a finding of non-obviousness. *Id.*, 26-35. The Federal Circuit affirmed the Board’s decision. The same result should follow here.

In the present case, Patent Owner provides the same extensive evidence of commercial success, industry praise, and nexus that again requires a finding of non-obviousness in view of Petitioner’s proposed obviousness challenges. Patent Owner’s evidence shows the commercial success and industry praise is the “direct result of the unique characteristics of the claimed invention.” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1373-1374 (Fed. Cir. 2019). Patent Owner sets forth extensive, unrebutted evidence showing the Twister and Render House products embody each element in each challenged claim. POR (Paper 16), 38-57; EX2032, ¶ 179 (Dr. Bajaj’s claim charts across pages 113-173).

Further, contrary to Petitioner’s assertions, the commercial success and industry praise evidence is not limited to the detailed requirements as to the contents of the roof estimate report. Instead, the evidence establishes that “approximately 96 percent of the top 25 insurance carriers” (EX1020, 1; *see also* EX1029, 8) and “about one-fifth of the roofing contractor market” (EX1024, 1)

relied upon roof estimate reports generated and output by the Twister and Render House products because the “process saves contractors and roofers hours of time spent measuring and scoping a roof” (EX1021, 1) and does so “without the danger and added time of an adjustor climbing onto a roof.” (EX1023, 4). Obtaining a roof estimate report from Patent Owner became an *industry standard*. (EX1026, 1 (“*EagleView invented the concept of 3D aerial roof measurements and has quickly become the industry standard in both the roofing and insurance industries.*”)). This evidence is not tied to the roof-report limitation.

The evidence further establishes that Patent Owner used its patented, computer-implemented method embodied in the Twister and Render House products to achieve tremendous commercial success. Patent Owner became “a leading provider of reports on structures used in claims processes in the property and casualty insurance and the contractors['] markets.” (EX1023, 3). Resulting directly from the unique characteristics of the claimed invention embodied in the Twister and Render House products, Patent Owner experienced significant sales increases, including exponential revenue growth. POR, 59-60; Paper 39, 13 (noting “unrebutted evidence that [Patent Owner’s] revenue and roof report sales grew dramatically.”).

Petitioner fails to rebut any of Patent Owner’s secondary considerations evidence with anything more than speculation or conjecture. As a result, applying a

proper *Graham* factor analysis, Patent Owner's secondary considerations evidence far outweighs Petitioner's proposed obviousness combinations leading to only one outcome—a finding of non-obviousness as to all challenged claims.

III. CLAIM CONSTRUCTION – ELEMENTS [1.5(a)] AND [1.5(b)] ARE ENTITLED TO PATENTABLE WEIGHT

On remand, the only limitation Petitioner asserts is not entitled to patentable weight is the roof-report limitation. Brief, 2. This is consistent with the Final Written Decision in the Xactware IPR, where the Board concluded that “the detailed requirements as to the contents of the roof estimate report are not entitled to patentable weight.” EX1010, 15-18. From the Board's analysis it is clear that the use of “the detailed requirements as to the contents of the roof estimate report” refers to the roof-report limitation. *Id.* The remaining portions of element [1.5] (with indicators **(a)** and **(b)** added) are entitled to patentable weight:

(a) generating and outputting a roof estimate report using a report generation engine,²

(b) wherein the generated roof estimate report is provided for repair and/or constructing the roof structure of the building.

² Petitioner explicitly agrees that Element [1.5(a)] “represent[s] an affirmative technical step having patentable weight.” Brief, 6.

IV. SECONDARY CONSIDERATIONS OF NON-OBVIOUSNESS

A. Petitioner's reliance on *Praxair* is misplaced.

Petitioner's attempted reliance on *Praxair Distrib. v. Mallinckrodt Hosp. Prods. IP*, 890 F.3d 1024 (Fed. Cir. 2018) to suggest the Board should not consider any of Patent Owner's secondary considerations evidence is misplaced. As an initial point, *Praxair* did not address the presumption of nexus whatsoever and, therefore, does not preclude a presumption of nexus even when a claim limitation may not be given patentable weight. Further, in *Praxair* the “only secondary consideration” evidence related to a claim element that was not given patentable weight. *Praxair*, 890 F.3d at 1035 (“The only secondary consideration Mallinckrodt alleges is based on the information claimed in the providing information limitation”). Unlike *Praxair*, the secondary considerations evidence here is not limited to a single claim element that lacks patentable weight. Instead, the secondary considerations evidence here is tied to the Twister and Render House products that embody each and every element of the challenged claims. Further, as discussed below, the extensive evidence of commercial success and industry praise is tied to claim elements indisputably having patentable weight.

B. Patent Owner established a clear nexus between the secondary considerations evidence and the challenged claims that Petitioner failed to rebut.

“[A] patentee is entitled to a rebuttable presumption of nexus between the asserted evidence of secondary considerations and a patent claim if the patentee shows that the asserted evidence is tied to a specific product and that the product ‘is the invention disclosed and claimed.’” *Fox Factory*, 944 F.3d at 1373 (emphasis removed) (quoting *Demaco Corp. v. F. Von Langsdorff Licensing Ltd.*, 851 F.2d at 1392). There can be no dispute that Patent Owner’s secondary considerations evidence is “tied to a specific product”—namely, the Twister and Render House products—and “is the invention disclosed and claimed” by the challenged claims of the ’737 Patent.

Patent Owner provided extensive, unrebutted evidence showing the Twister and Render House products embody each and every element of the challenged claims. POR, 38-57. Dr. Bajaj provided detailed charts with screen shots and excerpts from the user guides establishing that the Twister and Render House products are the invention claimed in the ’737 Patent. EX2032, ¶179 (Dr. Bajaj’s claim charts across pages 113-173). On the Federal Circuit’s spectrum of correspondence, Twister and Render House are towards the end with near perfect correspondence to the challenged claims of the ’737 Patent. *See Teva Pharms. Int’l GmbH v. Eli Lilly & Co.*, 8 F.4th 1349, 1361 (Fed. Cir. 2021) (“At one end of the

spectrum lies 'perfect or near perfect correspondence,' and at the other end lies 'no or very little correspondence.'" (citing *Fox Factory*, 944 F.3d at 1374).

Petitioner alleges various features of Twister and Render House are unclaimed and the contents of the roof estimate report being directed to printed matter prevent the products from being coextensive with the claims. Brief, 3-7. However, the case law is clear that "there is rarely a perfect correspondence between the claimed invention and the product" and that "one or more unclaimed features" does not prevent a presumption of nexus. *Fox Factory*, 944 F.3d at 1373. Instead, the "presumption analysis requires the fact finder to consider the unclaimed features of the stated products to determine their level of significance and their impact on the correspondence between the claim and the products." *Teva*, 8 F.4th at 1361.

The features Petitioner identifies—whether unclaimed or not carrying patentable weight—do not undermine the overwhelming evidence provided by Patent Owner establishing the strong correspondence between the Twister and Render House products and the challenged claims. For example, Petitioner argues that dependent claims of another patent (the '770 patent) are the reason for the commercial success of Twister and Render House. Brief, 7. The Board already considered and rejected Petitioner's erroneous argument attempting to tie Patent Owner's significant commercial success to unclaimed features. Paper 39, 14

(Petitioner's "alternative theories as to the products' commercial success are too speculative to rebut Patent Owner's presumed nexus."). Further, the Board determined that "Petitioner's argument is not enough to undermine or rebut the presumed nexus between the claimed invention and the asserted secondary-considerations evidence." Paper 39, 11-13. This is not a situation where the patented invention is only a component of a commercially successful machine or process or where a "critical" feature is unclaimed. Instead, as the evidence shows, the Twister and Render House products are coextensive with the challenged claims.

Finally, Petitioner has entirely failed to rebut the presumption of nexus to which Patent Owner is entitled. In this regard, a "patent challenger may not rebut the presumption of nexus with argument alone" but instead must "present evidence showing that the proffered objective evidence was 'due to extraneous factors other than the patented invention.'" *Quanergy Sys., Inc. v. Velodyne Lidar USA, Inc.*, 24 F.4th 1406, 1418 (Fed. Cir. 2022) (quoting *WBIP, LLC v. Kohler Co.*, 829 F.3d 1317, 1329); *see also Brown & Williamson*, 229 F.3d at 1130 (citing *Demaco*, 851 F.2d at 1393) ("a patent challenger cannot successfully rebut the presumption with argument alone—it must present evidence."). Petitioner fails to cite any credible evidence supporting the various speculative assertions about other factors that

Petitioner alleges might possibly be responsible for some of the commercial success or industry praise for Patent Owner's Twister and Render House products.

C. Patent Owner's evidence of commercial success and industry praise is not limited to the detailed requirements as to the contents of the roof estimate report.

The evidence of commercial success and industry praise for the Twister and Render House products is not limited to the detailed requirements as to the contents of the roof estimate report. Instead, among other things, the evidence establishes that “approximately 96 percent of the top 25 insurance carriers” (EX1020, 1; see also EX1029, 8) and “about one-fifth of the roofing contractor market” (EX1024, 1) relied upon Patent Owner's claimed technology because the “process saves contractors and roofers hours of time spent measuring and scoping a roof” (EX1021, 1) and does so “without the danger and added time of an adjustor climbing onto a roof.” (EX1023, 4). Obtaining a roof estimate report generated and output by the Twister and Render House products became an *industry standard*. (EX1026, 1) (“EagleView invented the concept of 3D aerial roof measurements and has quickly become the industry standard in both the roofing and insurance industries.”). These are a just few examples of the extensive evidence of commercial success and industry praise unrelated to the detailed requirements as to the contents of the roof estimate report.

Accordingly, even if Patent Owner's secondary considerations evidence touting the ability of the Twister and Render House products to produce accurate measurements was not considered, there would still be an extensive amount of secondary considerations evidence establishing the commercial success of the Twister and Render House products and industry praise for product features tied to claim elements that indisputably have patentable weight. In this regard, the substantial amount of evidence related to the roof estimate reports generated and output by the Twister and Render House products tied to elements [1.5(a)] and/or [1.5(b)]—but unrelated to the detailed requirements as to the contents of the roof estimate reports—is more than sufficient to establish compelling proof of commercial success and industry praise.

V. *GRAHAM* FACTOR ANALYSIS

In *Graham*, the Supreme Court set forth the factors to be considered when making an obviousness determination: (1) the scope and content of the prior art; (2) the level of skill of a person of ordinary skill in the art; (3) the differences between the claimed invention and the teachings of the prior art; and (4) the extent of any objective indicia of non-obviousness. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). Applying a proper *Graham* factor analysis to the current case, Patent Owner's secondary considerations evidence far outweighs Petitioner's

proposed obviousness combinations requiring a finding of non-obviousness as to all challenged claims.

Patent Owner established through this trial that the Heller-Quam combination (Petitioner's Ground 1) fails to teach at least claim elements [1.5(a)] and [1.5(b)]. *See* POR, 25-27; Sur-Reply, 8-10. In this regard, Petitioner's analysis related to the Heller-Quam combination is facially deficient because Petitioner did not give any patentable weight to elements [1.5(a)] and [1.5(b)]. *Id.*

Patent Owner also established that the Heller-Quam-Deaton combination (Petitioner's Ground 2) fails to teach the features of at least element [1.5(a)]. *See* POR, 28-30; Sur-Reply, 10-11. Patent Owner further established why a POSITA would not have combined Deaton with Heller and Quam as proposed by Petitioner. *See* POR, 30-35; Sur-Reply, 12-16.

For these reasons, Petitioner's proposed combinations under both Grounds 1 and 2 are weak and fail to meet the requirements to establish a *prima facie* case of obviousness with respect to the challenged claims.

On the other hand, Patent Owner's secondary considerations evidence is overwhelming. Patent Owner provided extensive, un rebutted evidence showing the Twister and Render House products embody each and every element of the challenged claims. The evidence of commercial success and industry praise for the

Twister and Render House products is far reaching and not limited to the detailed requirements as to the contents of the roof estimate report.

Accordingly, even if a small portion of secondary considerations evidence specifically tied to the detailed requirements as to the content of the roof estimate report was ignored, there remains a large amount of secondary considerations evidence establishing commercial success of the Twister and Render House products and industry praise for product features tied to claim elements having patentable weight, including claim elements [1.5(a)] and [1.5(b)]. “These real world indicators of whether the combination would have been obvious to the skilled artisan in this case ‘tip the scales of patentability.’” *Apple Inc. v. Samsung Elecs. Co.*, 839 F.3d 1034, 1058.

Considering Petitioner's proposed obviousness combinations in view of the strength of Patent Owner's secondary considerations evidence, it is clear that Petitioner has not met its burden to show that the challenged claims would have been obvious. Therefore, the Board should issue a finding of non-obviousness as to all challenged claims.

Respectfully submitted,

Dated: March 22, 2024

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CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6(e), that service was made on counsel for the Petitioner as detailed below.

Date of service March 22, 2024

Manner of service Electronic Service: IPR53317-0003IP1@fr.com

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