

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE OFFICE OF THE UNDER SECRETARY OF COMMERCE
FOR INTELLECTUAL PROPERTY AND DIRECTOR OF THE
UNITED STATES PATENT AND TRADEMARK OFFICE

NEARMAP US, INC.,
Petitioner,

v.

EAGLE VIEW TECHNOLOGIES, INC.,
Patent Owner.

IPR2022-00734
Patent 9,135,737 B2

Before JOHN A. SQUIRES, *Under Secretary of Commerce for Intellectual
Property and Director of the United States Patent and Trademark Office.*

ORDER
Initiating *Sua Sponte* Director Review

On October 27, 2023, the Board issued a Final Written Decision in this *inter partes* review (“IPR”) finding that Nearmap US, Inc. (“Petitioner”) had not shown that the claims of the challenged patent were unpatentable. Paper 39 (“First Final Decision” or “First Final Dec.”). In reaching its decision, the Board determined that Eagle View Technologies, Inc.’s (“Patent Owner”) objective indicia of nonobviousness evidence outweighed Petitioner’s prima facie showing of obviousness. First Final Dec. 16. The Board also acknowledged that in a different IPR challenging the same patent, the Board found objective indicia of nonobviousness “decisive in concluding that the petitioner had not shown the challenged claims were unpatentable,” and the U.S. Court of Appeals for the Federal Circuit subsequently affirmed that decision. *Id.* at 10 (citing *Xactware Solutions, Inc. v. Eagle View Techs., Inc.*, IPR2016-00592, Paper 50 (Ex. 1010); Ex. 1016, 2–3).

On November 27, 2023, Petitioner filed a request for Director Review of the First Final Decision, arguing that the Board failed to resolve several claim construction disputes, which affected the Board’s objective indicia analysis. Paper 40 (“Request”), 2–12. Petitioner also argued that the Board only addressed objective indicia and failed to “explain how it weighed the other *Graham* factors” and why the objective indicia “purportedly outweighed them.” *Id.* at 14–15 (emphasis omitted).

The Director granted the Request and subsequently vacated the Board’s First Final Decision, determining that the Board: (1) failed to explain the claim construction underlying its obviousness analysis; (2) failed to explain how it weighed the evidence of objective indicia; and

(3) insufficiently analyzed the *Graham*¹ factors. Paper 43, 8–9. The Director remanded the case to the Board for further proceedings consistent with the Director Review decision. *Id.* at 10.

On July 15, 2024, the Board issued a second Final Written Decision finding that Petitioner had shown the challenged claims were unpatentable as obvious after resolving the claim construction issues and determining that Patent Owner had not established that its objective indicia evidence had a nexus to the challenged claims. Paper 51 (“Final Decision”), 17–18, 27–28.

Patent Owner appealed that decision but, before the appeal was decided, the Office intervened on my behalf and requested a remand of the case to “reconsider the Board’s decision in light of [Patent Owner’s] arguments regarding nexus for commercial success and industry praise.” Ex. 3101. The Federal Circuit granted the motion. Ex. 3102. Accordingly, I initiate a *sua sponte* Director Review to reconsider the Board’s Final Decision in light of Patent Owner’s arguments and evidence as to the objective indicia of nonobviousness. An opinion will issue in due course.

Accordingly, it is:

ORDERED that a *sua sponte* Director Review of the Board’s Final Written Decision in this *inter partes* review (Paper 51) is initiated.

¹ *Graham v. John Deere Co.*, 383 U.S. 1 (1966).

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