

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.,¹
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

Vacating the Decision Granting Institution and
Denying Institution of *Inter Partes* Review

¹ Nearmap US, Inc. (“Petitioner”) reached a settlement with Eagle View Technologies, Inc. (“Patent Owner”) and is no longer participating in the proceeding. Ex. 3103.

On July 23, 2026, I initiated *sua sponte* Director Review in the above-referenced *inter partes* review (IPR) to reconsider the Board's Final Written Decision ("Decision," Paper 51) in light of a prior IPR challenging the same patent and the parties' settlement in this IPR. Paper 53. I have reviewed the Decision, the relevant papers, and the relevant exhibits and determine that this IPR should be de-instituted to ensure fairness, efficiency, and predictability. *See Magnolia Med. Techs., Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 6–8 (Director May 14, 2026) (precedential) (determining that in exercising institution discretion, the Director considers public interest factors, such as the economy, efficient administration of the Office, ability of the Office to timely complete its AIA reviews, and integrity of the patent system to ensure fairness, efficiency, and predictability in patent disputes).

The challenged patent issued in 2015, and this IPR is the second one filed against the same patent. In the first IPR (IPR2016-00592), the Board determined that the petitioner had not shown that any of the challenged claims were unpatentable based on the strength of Patent Owner's objective indicia evidence, and the United States Court of Appeals for the Federal Circuit affirmed that determination. IPR2016-00592, Papers 50 (Board's final written decision), 56 (Federal Circuit's Decision and Mandate).

In this proceeding, based on different prior art, the Board found the claims unpatentable after determining that Patent Owner's objective indicia evidence lacked a nexus to the challenged claims. Decision 24–27. Patent Owner appealed. Petitioner subsequently settled its dispute with Patent Owner. The Office intervened in the appeal after the settlement and requested a remand to review the Decision, which the Federal Circuit granted. Paper 54.

In view of the prior determination, which was affirmed, and the fact that Petitioner and Patent Owner have settled their dispute, I find that maintaining this IPR would be an inefficient use of Office resources. Maintaining this IPR now would result in an increased risk of inconsistent outcomes and create additional expenses for Patent Owner even though the underlying dispute has now settled. Thus, I find that justice is better served by vacating the Decision, vacating the Board's decision to institute, and exercising discretion to deny institution.

Accordingly, it is:

ORDERED that the Board's Final Written Decision (Paper 51) is vacated;

FURTHER ORDERED that the Board's decision granting institution of *inter partes* review (Paper 10) is vacated; and

FURTHER ORDERED that the Petition is denied and no trial is instituted.

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