

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
Petitioner,

v.

PARKING WORLD WIDE LLC,
Patent Owner.

IPR2023-00385
Patent 10,438,421

**PATENT OWNER'S SUR-REPLY TO
PETITIONER'S REPLY**

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LISTING OF EXHIBITS

Ex. No.	Description
2010	AutoZone® email about fuel efficiency

I. INTRODUCTION

The Petitioner alleged in its Reply that the Patent Owner's Response contained duplicate arguments, Reply p. 4. The Patent Owner asserts here that its arguments were necessary to respond to each Ground of the Petitioner. Each Ground had different combinations of patents against different groups of claims of the '421 patent. The Board instituted this Proceeding and viewed the Petitioner as having a reasonable likelihood of success in proving that at least claim 1 of the '421 patent is unpatentable through Ground 1, Institution Decision, 19, 21. However, the Patent Owner must defend the '421 patent against four Grounds. Thus, the Patent Owner presented argument for each Ground in its Response. Similar to appellate practice during patent prosecution, see MPEP §1205.02 citing 37 C.F.R. 41.37, the Patent Owner asserts its claims of the '421 patent stand separately.

As a reminder, a patent is presumed valid, 35 U.S.C. §282, MPEP §716.07. Also a Patent Owner must have "trust that these [patent rights] procured are valid and enforceable," Steven P. Caltrider, *Away from the Edge*, ABA LANDSLIDE, vol. 16 no. 1, at 1 (Sep. 2023).

Thus, the Board's confirmation of the patentability of at least one of the challenged claims of the Patent Owner's U.S. Pat. No. 10,438,421 with provision

to amend any patentable dependent claim into independent form if a parent independent claim is found unpatentable is requested.

II. ARGUMENT

A. PETITIONER HAS NOT CARRIED ITS BURDEN OF PROVING BY A PREPONDERANCE OF THE EVIDENCE THAT THE PRIOR ART REFERENCES ARE ANALOGOUS ART

The Petitioner has asserted that the Patent Owner views *In re Bigio*, 381 F.3d 1320 (Fed. Cir.) case differently, Reply p. 4. The Patent Owner notes that the Board brought the *In re Bigio* case to light, Institution Decision, 8. Looking at the prior art references briefly, the Patent Owner asserts Ivey's usage of a map differs markedly from the '421 Patent's usage of a real time image. Then the Patent Owner asserts Matsumoto's usage of a fixed video device viewing an entire parking lot, differs markedly from the Patent Owner's usage of a real time image along a street. Then the Patent Owner asserts Tillotson's usage of an input device or sensor in a parking space within a parking lot differs markedly from the '421 Patent's usage of a real time image while not counting cars entering and exiting a parking lot. Then the Patent Owner notes Slemmer '556 describes a system that uses detectors to find objects while the '421 patent avoids usage of detectors. Turning to the next prior art reference, the Patent Owner asserts that Ward '675 had its system connect with parking meters with its customer transmitting a meter

number to a cell phone company for billing while the Patent Owner's invention does not utilize parking meters. And the Patent Owner asserts that Haynes '166 had in its method a camera, or video device mounted upon a pole that surveys an entire lot while the '421 Patent receives imagery from a mobile device's camera held by an officer at his height suggests a movable camera feed at street level.

From the preceding brief summaries of the prior art references, the Patent Owner asserts once more that the prior art references do not logically commend themselves to an inventor's attention, *Scientific Plastic Prods. Inc., v. Biotage AB*, 766 F.3d 1355 (Fed. Cir. 2014), as identified by the Reply p. 9. The Patent Owner then notes that existence of differences between the prior art does not support tenuous logic, *Id.* at p. 12.

B. PETITIONER HAS NOT CARRIED ITS BURDEN OF PROVING BY A PREPONDERANCE OF THE EVIDENCE THAT THE PRIOR ART REFERENCES DO NOT TEACH AWAY FROM THE CLAIMED INVENTION.

The Petitioner asserted that one difference between a prior art reference and the '421 Patent claims allowed use of that reference in obviousness analysis, Reply p. 9, citing *Graham v. John Deere*, 383 U.S. 1 (1966). The Petitioner then contradicted that by noting a difference in a prior art reference is not enough, Reply p. 12, citing *Meiresonne v. Google, Inc.*, 849 F.3d 1379 (Fed Cir. 2017). The

Petitioner then continues that a prior art reference must discourage or criticize the '421 patent claims, Reply at p. 13. However the prior art used by Petitioner has priority dates before the '421 patent's own priority date and that makes expressly discouraging or criticizing the claims of a later invention not possible.

The Patent Owner asserts that the Petitioner overlooks the complete disclosure of all embodiments in the '421 patent's specification, *Netflix, Inc. v. Divx, LLC*, 80 F.4th 1352 (Fed. Cir. 2023). The Patent Owner also identifies that complete disclosure includes "full disclosure," see *In re Bigio* F3.d at 1326. Petitioner in focusing on select parts of the '421 patent rather than the whole of it improperly contradicts *Netflix, Inc. v. Divx, LLC*, Reply at p. 5 l. 3.

The Petitioner then notes the '421 patent claims use the linking word comprising and make the claims open to additional features and prior art, Reply at p. 14. As the door has opened, the Patent Owner asserts that camera position may come into the '421 patent claims from its specification. As the Court noted as fundamental, that claims are construed in light of the specification and both are to be read to ascertain the invention, *United States v. Adams*, 383 U.S. 39, 49 (1966).

C. PETITIONER HAS NOT CARRIED ITS BURDEN OF PROVING BY A PREPONDERANCE OF THE EVIDENCE THAT THE PETITIONER DID NOT USE IMPROPER HINDSIGHT.

The Petitioner mentioned that prior art references must “criticize, discredit, or otherwise discourage” investigation into the ‘421 patent claims, Reply at p.13 citing *In re Fulton*, 391 F.3d 1195 (Fed. Cir. 2004). However the prior art used by Petitioner has priority dates before the ‘421 patent’s own priority date, thus the Patent Owner’s patent cannot teach, criticize, or discourage past patentees and inventors that came before it.

The Petitioner has used the Ivey ‘037 reference in this Proceeding against the ‘421 patent claims. However, the Patent Owner disclosed the Ivey ‘037 reference in its provisional application for patent, Patent Owner’s exhibit 2001 p. 4, in its non-provisional application for patent, Patent Owner’s exhibit 2002 p. 5, and to the Examiner during prosecution on the Information Disclosure Statement, Petitioner’s exhibit 1002 p. 78, 156. “The examiner must consider all the prior art references (alone and in combination) cited in the application ... including those cited by the applicant in a properly submitted Information Disclosure Statement,” MPEP §707.05 citing MPEP §609 citing 37 C.F.R. 1.97. Following that disclosure, the Examiner elected not to use the Ivey ‘037 reference any further against the Patent Owner’s application that matured in the ‘421 patent, see Petitioner’s exhibit 1002 p. 262, 265, 268. And now the Patent Owner finds the Ivey ‘037 reference used against it again in this Proceeding. As before, the Patent Owner asserts that an obviousness rejection ought not include information from the Applicant’s

disclosure, see *In re McLaughlin* 443 F.2d 1392, 1395, 170 U.S.P.Q. 209, 212

(CCPA 1971) and then not considered by the Examiner during prosecution, MPEP §707.05 citing 37 C.F.R. 1.104.

D. PETITIONER HAS NOT CARRIED ITS BURDEN OF PROVING BY A PREPONDERANCE OF THE EVIDENCE THAT A POSITA WOULD HAVE BEEN MOTIVATED TO COMBINE THE PRIOR ART AS SET FORTH IN THE PETITION BY EFFICIENCY.

The Petitioner has relied upon efficiency as a slim reason to combine prior art references, Reply p. 17, 18 citing *Intel Corp. v. Qualcomm, Inc.*, 21 F.4th 784 (Fec. Cir. 2021) [without hint to combine in prior art references themselves]. However, the Patent Owner notes that the *Intel* case contradicts the *Fulton* case where prior art references must “criticize, discredit, or otherwise discourage” investigation into the ‘421 Patent’s claims, Reply at p.13. Seeking to discourage investigation appears to the Patent Owner as a reason of substance. The Petitioner may not have a reason to support combining prior art references, as per the *Intel* case, but may have discouragement, as per the *Fulton* case, see generally *expressio unius est exclusio alterius*, Black’s Law Dictionary 1717 (8th Ed. 2004)(expression of one thing is to exclude another). The Patent Owner notes the Petitioner may attempt to use no reason or a discouragement to investigate but not both, to combine prior art references.

The Patent Owner then returns to and refines the question as what type of efficiency the Petitioner seeks from the prior art references. Just last month, AutoZone® emailed an advertisement to lead counsel for the Patent Owner asserting fuel efficiency as a reason to change the oil in an automotive engine, see Patent Owner's exhibit 2010.

E. STATEMENTS IN PETITIONER'S REPLY PUT AT RISK THE DECORUM OF THIS PROCEEDING.

The regulations behind this Proceeding explain that “every party must act with courtesy and decorum in all Proceedings before the Board, including in interactions with other parties,” 37 CFR § 42.1 (c). Decorum includes suitable behavior and conduct generally viewed as propriety, *Webster's New College Dictionary*, 3rd Ed. p. 300 (2008). Courtesy includes polite behavior, *Id.* at 266. Perhaps the Petitioner might recollect its statements of “nonsensical,” Reply p. 15, 16, “at odds with the law,” *Id.* at p. 8, “is not the law,” *Id.* at p. 12, “improperly,” *Id.* at p. 13, “unpersuasive,” *Id.* at p. 15, and “bare attorney argument,” *Id.* at p. 1, 2, 18. As to attorney argument, let us remember Pres. Roosevelt who promoted the saying “do what you can, with what you've got, where you are” of a Virginia Squire, *Theodore Roosevelt, An Autobiography*, Ch. IX, at 337, Macmillan Co. (1913)[crediting the quote to Squire Bill Widener]. These preceding statements in

the Reply may appear as emphasis by the Petitioner. The Patent Owner, being on the receiving end of such statements, asserts that such statements in the Petitioner's Reply put the decorum of this Proceeding into unnecessary tension.

III. CONCLUSION

The Patent Owner asserts that the prior art references, of Ivey '037, Slemmer '566, Tillotson '278, Haynes '166, Ward '675, and Matsumoto '835, do not logically commend themselves to an inventor's attention. The Patent Owners asserts that the Petitioner did not look at the full and complete disclosure of the '421 Patent regarding an image of a mobile camera. Turning to hindsight, the Patent Owner assert that an obviousness rejection ought not include information from the Applicant's disclosure and not utilized by the Examiner of the '421 Patent. The Patent Owner lastly notes the Petitioner may attempt to use no reason or a discouragement to investigate but not both, to combine prior art references in this Proceeding.

For the foregoing reasons, the Board should confirm the patentability of at least one of the challenged claims 1-7, of the Patent Owner's U.S. Pat. No. 10,438,421 with provision to amend any patentable dependent claim into independent form if a parent independent claim is found unpatentable.

Dated: February 14, 2024

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CERTIFICATION PURSUANT TO 37 C.F.R. §42.11

Pursuant to 37 C.F.R. §42.11, the undersigned hereby certifies that this Patent Owner's Sur-Reply is not being presented for an improper purpose and that all legal contentions, allegations, and denials are warranted and have evidentiary support.

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CERTIFICATION OF COMPLIANCE

Pursuant to 37 C.F.R. §42.24(a)(1)(i), the undersigned hereby certifies that the foregoing Patent Owner's Sur-Reply complies with the type volume limitation. According to the utilized word-processing system's word count, the Sur-Reply, excluding the caption, table of contents, table of exhibits, certification pursuant to 37 C.F.R. §42.11, certificate of word count, and certificate of service, contains 1816 words.

Dated: February 14, 2024

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CERTIFICATE OF SERVICE

The undersigned hereby confirms that the foregoing Patent Owner's Sur-Reply was caused to be served on February 14, 2024 to the Board via the P-TACTS system and by electronic mail upon the following counsel of record for Petitioner whose consent is of record:

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