

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 B2

Record of Oral Hearing
Held: April 17, 2024

Before WILLIAM V. SAINDON, BENJAMIN D. M. WOOD, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

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The above-entitled matter came on for hearing on April 17, 2024,
commencing at 9:00 a.m., via video teleconference.

P R O C E E D I N G S

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JUDGE WOOD: Good morning. We are here for oral argument in IPR2023-00385, Oracle Corporation v. Parking World Wide LLC. I'm Judge Wood. Also on the panel are Judges Saindon and Silverman. Let's begin with a roll call for Petitioner.

MR. HERMAN: Good morning, Your Honors. This is Patrick Herman from Orrick, Herrington & Sutcliffe, lead counsel for Petitioner, Oracle. Also with me on the line are Jared Bobrow and Gerry Porter, Petitioner's backup counsel, both from Orrick, and EunHae Park, a representative from Oracle.

JUDGE WOOD: All right. Thank you, Mr. Herman. Can we have a roll call for Patent Owner, please?

MR. MCCLOSKEY: Certainly. Chuck McCloskey, counsel for Parking World Wide, Patent Owner. And also joining us on the call as Parking World Wide's president and inventor on the Patent, Mr. Gil Bashani.

JUDGE WOOD: All right. Thank you, Mr. McCloskey. According to the hearing order, Petitioner will have 45 minutes to present argument in this case, and Patent Owner will have 45 minutes to respond. Petitioner will open the hearing by presenting its case, and Patent Owner will respond to Petitioner's argument. Petitioner may reserve rebuttal time to respond to arguments presented by Patent Owner, and Patent Owner may reserve time for sur-rebuttal. Do we have any questions or concerns?

MR. HERMAN: None for Hermann.

MR. MCCLOSKEY: None, Your Honor.

1 JUDGE WOOD: Mr. McCloskey?

2 MR. MCCLOSKEY: I have no question this morning.

3 JUDGE WOOD: All right. Thank you very much. So, let's begin
4 with Petitioner. Mr. Herman, will you be presenting?

5 MR. HERMAN: Yes, Your Honor.

6 JUDGE WOOD: And would you like to reserve rebuttal time?

7 MR. HERMAN: Fifteen minutes, Your Honor.

8 JUDGE WOOD: Fifteen minutes. All right. So, I will be keeping
9 time. I encourage the parties to also keep time. And with that, we can begin
10 when you're ready, Mr. Herman.

11 MR. HERMAN: Thank you, Your Honor. Good morning. We're
12 here today to discuss the '421 Patent. And if Your Honors will turn to slide
13 2 of Petitioner's demonstratives, which were filed yesterday. This slide
14 includes an excerpt from the '421 Patent summary of the invention. So,
15 what does the Patent say it relates to? The Patent characterizes itself as
16 relating to a parking status system that visually indicates parking status of
17 vehicles in the field of view of a parking control officer.

18 So, moving on to slide 3, this slide reproduces Claim 1 of the '421
19 Patent, and this is one of the two Independent Claims that issue in this
20 proceeding. The other is Claim 5, which is substantively the same as Claim
21 1. And while the Claim includes a large amount of language, I've
22 highlighted three limitations here on the slide because they provide a good
23 overview of the Claim's focus. So, first as you can see in red, the Claim
24 mentions various databases. One of these stores parking space locations and
25 parking time limits. Another stores parking subscriber information,
26 including reserved spots. Second, as seen in green, the method allows a

1 user's location to be determined. And that user can be a parking
2 enforcement officer. And third, in blue at the bottom, the method will
3 determine using the databases whether a parking spot near the user is unpaid.
4 If so, the method provides an indication of this unpaid status on a real-time
5 display visible to the user to allow enforcement to occur.

6 So, slide 4 provides a basic graphical overview of that claimed
7 method. Again, the databases storing parking space and subscriber
8 information are in a server that's highlighted in red. The user location
9 finding feature is shown to be interacting with a green highlighted GPS
10 satellite. And the real-time display with indicia of parking payment status
11 that can be used for enforcement is shown in blue in the bottom of the
12 figure. So, in sum this is a Patent about paying for parking and the way of
13 displaying that parking information to the user. And the Claims more
14 specifically require this to be a displayed real-time view of parking spaces
15 with overlaid parking payment status information to facilitate parking
16 enforcement.

17 So, slide 5 provides an overview of the grounds that are at issue in
18 this proceeding. The first two grounds rely on references to Ivey,
19 Matsumoto, and Tillotson, and the third and fourth grounds rely on a
20 different collection of references, Ward, Haynes, and Tillotson. So before
21 moving on to discuss the party's disputes, I would like to provide some
22 context by briefly walking through the prior art.

23 So, if you turn to slide 6, this slide summarizes the Ivey and
24 Matsumoto references that are at issue in Grounds 1 and 2 in the petition.
25 As you can see in the left of the slide, Ivey, just like the '421 Patent, teaches
26 the system for displaying parking status information to facilitate

1 enforcement. More particularly, it teaches the system that displays a parking
2 payment status map on a handheld computer carried by a parking control
3 officer. And the figures on the bottom show that paid and unpaid spots are
4 indicated to that officer by color on the map. As seen on the right,
5 Matsumoto also relates to a system that relates parking information, in
6 particular vacant and occupied spots in the parking lot, and it does so via a
7 live action image of a parking lot displayed to the user. And Matsumoto
8 explains that using this live action image allows the user to quote,
9 immediately grasp, end quote parking spot status and location. So, slide 7
10 briefly summarizes how these teachings translate into the petition's grounds.
11 So, Ivey teaches databases of parking spaces and time limits. Another
12 reference, Tillotson teaches subscriber databases. Next, both Ivey and
13 Matsumoto teach systems that are able to ascertain the location of a user's
14 device. And Ivey provides a display for parking enforcement while
15 Matsumoto supplements this by teaching that parking information can be
16 relayed via a real-time view.

17 Now the petition explained in detail why a POSITA would have
18 understood these references to include these teachings and why that POSITA
19 would have been motivated to combine them. So, slide 8 summarizes the
20 Ward and Haynes references that issue in Grounds 3 and 4. As shown on
21 the left, Ward relates to a parking payment system. According to Ward, the
22 system includes an enforcement device that provides a graphical display
23 with parking space status indicia. And you see an example of that in the
24 figure reproduced on the left bottom of the slide. And multiple parking
25 spaces are displayed there with indicia indicating whether or not the spaces
26 are paid so as to allow enforcement to occur. As shown on the right, Haynes

1 relates to a system for relating information relating to parking spaces to a
2 user. And according to Haynes, one way to do so is to provide an actual
3 representation of the parking spaces in a parking lot that can be updated in
4 real time.

5 Now, slide 9 is similar to the slide I showed before, but this one
6 summarizes how Ward's and Hayne's teachings translate into Grounds 3 and
7 4. So, Ward teaches the database of parking spaces and time limits.
8 Tillotson again teaches subscriber databases. Ward teaches the use of GPS
9 to ascertain the location of the user's device, and Ward also provides a
10 display for parking enforcement, and Haynes supplements this by teaching
11 that parking information can be relayed via a real-time view. And the
12 petition once again explains why it would have been obvious to combine
13 these various teachings.

14 So, slide 10, moving on to the issues confronting the Board, this
15 slide, slide 10, summarizes what is not in dispute. First, there is no dispute
16 that the prior art in the petition all came before the '421 Patent. So, it all
17 admittedly qualifies as prior art. Second, Patent Owner does not argue that
18 any required Claim limitation is missing from the prior art. So there is no
19 dispute that the art teaches, at least separately, everything the Claims here
20 require. And third, Patent Owner has not identified any secondary
21 considerations for the Board to consider.

22 So, slide 11 provides an overview of the issues that remain in
23 dispute. So, Patent Owner argues that the art is not analogous, that the
24 petition engaged in hindsight, and that there is no motivation to combine.
25 So, these issues should all sound familiar. That is because they are no
26 different from those raised by Patent Owner in its preliminary response. In

1 fact, very little has changed since the Board instituted. In addition to making
2 the same basic arguments, Patent Owner has not submitted any expert
3 testimony. It also did not depose Petitioner's expert. In fact, it submitted
4 only two further exhibits, an army navigation manual and an email counsel
5 got regarding oil changes. So, the evidence is basically the same as it was
6 when the Board confronted these issues at institution.

7 Now I will address each of these three remaining issues in turn.
8 So, moving on to slide 12. Slide 12 summarizes why Patent Owner believes
9 the petition's prior art is not analogous art. So here Patent Owner attempts to
10 cabin the art to a limited subset of teachings. For example, Patent Owner
11 characterizes ideas relating only to map usage. Matsumoto was
12 characterized as relating only to a video camera on a pole in a parking lot.
13 And Tillotson is characterized as relating only to parking space sensors.
14 And Slemmer is characterized as relating only to detectors. And Patent
15 Owner makes the same type of cabining argument when addressing the art at
16 issue in Grounds 3 and 4.

17 So, to begin, the art in the petition is of course not limited to just
18 the narrow set of teachings Patent Owner highlights. Ivey does not limit
19 itself to just the display of maps. It's more broadly directed to a system that
20 provides an enforcement officer with an efficient visual display of parking
21 status to enable enforcement. Matsumoto is not limited to just a single
22 camera on a pole in a parking lot. It is more broadly directed to systems that
23 visually relay parking spot information, including via live images. And
24 Tillotson is not limited to space sensors. It is more broadly directed to a
25 system for reserving and paying for parking spaces. So rather than
26 accounting for this, Patent Owner instead unilaterally comes up with an

1 extraordinarily narrow characterization of the art and then argues that when
2 so narrowly construed, the art is too different to be considered together. But
3 this is not how one determines if art is analogous.

4 So, slide 13 sets forth the legal standard that must actually be
5 employed. First, as seen in the case quote on the top of the slide, courts,
6 including the Board, take quote, expansive view of what constitutes
7 analogous art, end quote. In other words, a broad view and not a narrow
8 limited view is taking regarding the technical field of the Patent at issue and
9 the art's teachings when determining whether the art is analogous. Second,
10 the next case quote shows that there are two tests that can be applied to
11 determine if art is analogous. Satisfying either of these tests is sufficient.
12 The first test considers whether the art is from the same field of endeavor as
13 the Patent in question. And it's the art's general field and not only a specific
14 narrow example that is important. The second test considers whether the art
15 is from a different field but is still reasonably pertinent to the problems
16 addressed by the Patent. So, all the art in the petition here satisfies both of
17 these tests. It is in the same field and addresses the same problems identified
18 in the '421 Patent.

19 So, slide 14 summarizes what the '421 Patent itself identifies as its
20 field of endeavor. And this slide includes passages from the Patent's
21 abstract, the background, and the summary of the invention. And as shown,
22 the Patent repeatedly explains that it's directed to parking space status or
23 managing systems. So, slide 15, in fact, this does not appear to be in
24 dispute. This slide includes an excerpt from Patent Owner's response brief.
25 And here, Patent Owner itself characterizes the '421 Patent's field as the
26 quote, management of parking systems, end quote. So, slide 16, when the

1 totality of the art's teachings are considered instead of just the narrow
2 teachings that Patent Owner focuses on, it is apparent that all of the prior art
3 in the petition is in the very same technical field as the '421 Patent.

4 So, slide 16 summarizes the technical fields of Ivey, Matsumoto,
5 and Tillotson. As shown in the upper left, Ivey characterizes itself as
6 relating to a parking payment status map, or a parking management
7 computer system that provides payment information. Again, this is the very
8 same technical field as the '421 Patent's, management of various aspects of
9 parking systems. In fact, as Patent Owner itself repeatedly points out, the
10 '421 Patent identifies Ivey as a pertinent reference in its specification. Now,
11 as shown on the lower part of the slide, Matsumoto also relates to a system
12 for managing parking, specifically a parking lot information and guidance
13 system. And as shown in the upper right, Tillotson relates to a parking
14 management system that provides parking space availability data. So, all of
15 these references, which are at issue in Grounds 1 and 2, relate to aspects of
16 parking management systems. They all teach systems that collect and relay
17 information to users about parking.

18 So, slide 17, the other references in the petition are no different.
19 Slide 17 summarizes the technical fields of Ward, Haynes, and Slemmer. As
20 shown in the upper left, Ward relates to a parking payment system that again
21 displays parking information for purposes of enforcement. So once again,
22 this is the very same field as the '421 Patent. Next, as shown in the upper
23 right, Haynes also relates to a method for managing parking, including the
24 display of space information. Finally, as shown at the bottom, Slemmer
25 similarly relates to yet another parking management system, what it calls an
26 automated parking director that informs users of available parking spots. So

1 once again, the references all relate to aspects of parking management and
2 parking information. Because of this, the prior art in the petition is plainly
3 art that a POSITA would have known of and would have collectively
4 considered when trying to address problems regarding parking management.

5 Now, slide 18, the prior art in the petition, is also directed to the
6 same types of problems as the '421 Patent. As shown on this slide, the
7 Patent explains that its method addresses multiple problems encountered by
8 parking management systems. This includes problems with coin payments,
9 parking enforcement difficulties, limitations on the types of parking
10 information displayed, and problems arising from the use of what the Patent
11 calls fixed plates.

12 So, slide 19, the prior art addresses the same problems that are
13 addressed by the '421 Patent. Ivey, Ward, and Tillotson all teach systems
14 that improve ways to pay for parking. Ivey and Ward both teach systems
15 that provide for improved enforcement by displaying parking status
16 information in a way that allows for quicker assessments of whether parking
17 spots are paid. Matsumoto, Haynes, and Slemmer all teach improved
18 displays, including real-time images that are meant to more quickly and
19 accurately relay information relating to parking spaces to users. Finally,
20 Ivey and Ward also teach improved methods to determine parking spot
21 occupation that does not rely on fixed plates.

22 So, in sum, this is not a case where the prior art is unrelated and far
23 afield from the Patent at issue. Instead, all the art relates in some fashion to
24 systems and methods for managing parking. This is also not a case where
25 the art solves different problems different from the Patents. Instead, just like
26 the '421 Patent, the art is directed to the same type of parking payment,

1 enforcement, and display problems that are purportedly addressed by the
2 '421 Patent.

3 So, slide 20, moving on to the next dispute, Patent Owner also
4 argues that the petition engaged in what the Patent Owner calls hindsight.
5 So, slide 21 provides an overview of the purported hindsight identified by
6 Patent Owner. According to Patent Owner, it constituted hindsight to rely
7 on Ivey in the first place, because that Patent is referenced in the '421
8 Patent's specification. And you can see an example of that from Patent
9 Owner's sur-reply on the slide here.

10 So, slide 22, no case holds that citing a prior art reference in the
11 specification somehow prevents that reference's use in an obviousness
12 analysis. That would make no sense because the prior art is what it is. A
13 Patentee cannot change that. The only case that Patent Owner cites in
14 support of its erroneous position says nothing to the contrary. Instead, the
15 only thing it expresses is that the prior art does not include, quote,
16 knowledge gleaned only from applicant's disclosure, end quote. So, Ivey's
17 teachings are not something that the '421 Patent contributed to the art. They
18 are not applicant's teachings, Ivey made that contribution to the art. And the
19 petition here cites to Ivey, not the '421 Patent, to show what was in the prior
20 art.

21 So, slide 23 shows the specification's discussion of Ivey. And as
22 you can see on the slide, that discussion is very limited. All that the
23 specification does is mention Ivey's use of a two-dimensional map for
24 parking enforcement purposes, and it notes that this map does not display
25 images of actual vehicles.

26 So, moving on to slide 24, the petition did not limit itself to just the

1 teachings of Ivey set forth in the '421 Patent specification. As shown, the
2 petition repeatedly explained how Ivey would be improved by
3 supplementing its map display with a live action image of parking spaces as
4 taught by Matsumoto. So, Matsumoto is of course not referenced in the '421
5 Patent, nor are the references in the petition's other grounds. And none of
6 the petition's grounds employ the '421 Patent as a guide. Instead, the
7 petition explains why the arts teachings, including Ivey's teachings, would
8 have led a person having ordinary skill in the art to conclude that the Claims
9 are obvious.

10 So, slide 25, the party's final dispute relates to the motivation to
11 combine. And Patent Owner makes a number of points here. So as shown
12 on slide 26, Patent Owner argues that the petition merely points to efficiency
13 as a motivation to combine without providing further explanation. So as
14 shown on slide 27, this is not correct. The petition did not merely use the
15 word efficiency without providing further explanation or reasons basis. So,
16 slide 27 collates with the petition and the expert declaration that the petition
17 site actually says. And as can be seen, Petitioner and its expert did explain
18 and provide a detailed reasoned basis as to why a person of ordinary skill in
19 the art would have understood the combined art to improve efficiency. So,
20 the left of the slide lists the reasons why applications of Matsumoto's real-
21 time parking display to Ivey's parking enforcement system would have
22 improved efficiency. So here the petition and Petitioner's expert explained
23 that doing so with streamlined enforcement allow an officer to verify the
24 payment status of many spots simultaneously, allow the officer to issue
25 citations faster, and avoid the need to individually check many parking
26 meters at the same time. The right of the slide lists the reasons why

1 application of Tillotson's parking spot reservation systems would have
2 improved the efficiency of Ivey. And as shown, the petition and Petitioner's
3 expert explained that doing so would make the system easier to use,
4 especially during times of congestion, would simplify the payment process,
5 would reduce the time needed to pay for parking, and make it easier for
6 payments to be accepted. So, Patent Owner addresses none of this, does not
7 explain why faster streamlined enforcement would not improve efficiency,
8 or why a simplified payment process would not improve both the parking
9 experience and the efficiency of parking payment collection. It also offered
10 no evidence of its own rebutting the petition's showing. Instead, it relies
11 solely on attorney argument that does not even account for what the petition
12 and Petitioner's expert actually said.

13 So, slide 28, Patent Owner next argues that the prior art teaches
14 away from what the '421 Patent Claims require, but as shown on this slide,
15 Patent Owner's sole reason for saying this is that each of the prior art
16 references discussed in the petition includes additional features not required
17 by the '421 Patent's Claims. And you see some examples of this in the
18 excerpt from Patent Owner's response brief on this slide. So, Patent Owner
19 points out that the prior art references include discussion of parking lots,
20 maps, and vehicle counting, but none of the art in the petition is limited in
21 this way. Ivey and Ward do not say that they are limited to and must be
22 used only with maps. Instead, both teach systems that display parking status
23 information in an intuitive and graphical way to allow for enforcement.
24 Likewise, Matsumoto and Haynes do not say they are limited to just a single
25 camera on a pole in a parking lot. Instead, both teach the use of multiple
26 cameras, providing images of different parking spots, and both more

1 generally teach that parking spot information can be conveyed in various
2 different ways, including graphically and via live images. And Tillotson
3 certainly does not say that it is limited to just car counting. Instead, it more
4 generally teaches a system that allows a user to reserve and pay for parking
5 spots, and the same applies to the references in the petition's other grounds.
6 None of those references are limited to just the embodiment set forth in their
7 specifications.

8 So, slide 29, not only is Patent Owner wrong about what the prior
9 art teaches, but what it does point to is simply not a teaching away, as shown
10 by the case site on this slide, merely identifying general preferences or
11 alternatives in the prior art is not a teaching away. Instead, the prior art
12 needs to criticize, discredit, or discourage a particular combination. So here,
13 Patent Owner points to nothing in the prior art showing that Ivey teaches
14 away from either real-time images, like that in Matsumoto, or the types of
15 parking reservations disclosed in Tillotson, and the same applies to the
16 references in Grounds 3 and 4. Yes, these references provide examples with
17 features not present in the '421 Patent, but they never limit themselves to just
18 those examples or state that their teachings have absolutely no applicability
19 elsewhere. And because of that, there is no teaching away here.

20 In slide 30, Patent Owner also argues in its sur-reply that if it
21 cannot point to other unclaimed features in the prior art to show that the art
22 teaches away, then quote, camera positions may come into the '421 Patent
23 Claims from its specifications, end quote. And that's from Patent Owner's
24 sur-reply on pages three and four. But two wrongs do not make a right. The
25 mere disclosure of different embodiments and unclaimed features in the
26 prior art is not a teaching away, and preferred embodiments from a Patent

1 specification are not to be read into the Patent Claims.

2 In slide 31 and the latter is exactly what Patent Owner appears to
3 be improperly proposing to do here. So, slide 31 shows Claim 1. And as
4 can be seen, the Claim does not require any particular camera position.
5 Instead, it simply references a real-time camera view. That real-time camera
6 view does not need to result from a camera in or on the user device itself. It
7 could be generated by any camera with any position. So, Patent Owner
8 would like to add a position limit to the Claim that simply isn't there.

9 Slide 32, indeed, the Board itself noted in its institution decision,
10 which is quoted in the excerpts on this slide, that Claim 1 does not specify
11 how the claimed real-time camera view is obtained. And Patent Owner has
12 done nothing over the course of the proceeding to change this. It points to
13 nothing in the Claims that could possibly require a particular camera
14 position, and it points to nothing in the specification or the prosecution
15 history that would require reading a limit into the Claims. Instead, it just
16 baldly says that it should be entitled to do so because it is not allowed to
17 erroneously discount the prior art because that art includes features not
18 precluded by the '421 Patent's Claims. Once again, this is not how Claims
19 are construed, and it is not how the prior art is assessed.

20 And with that, Your Honors, unless there are further questions or
21 any questions, I would like to reserve the remainder of my time for rebuttal.

22 JUDGE WOOD: All right. Judges Silverman and Saindon, do we
23 have any further questions?

24 JUDGE SAINDON: No questions at this point. Thank you.

25 JUDGE WOOD: All right. Thank you, Mr. Herman. So, we --
26 you have four minutes left, so you have 19 minutes for rebuttal at this point.

1 MR. HERMAN: Thank you, Your Honor.

2 JUDGE WOOD: Mr. McCloskey, would you like to reserve
3 rebuttal time?

4 MR. MCCLOSKEY: Yes, Your Honor, we'd like to reserve 10
5 minutes for rebuttal.

6 JUDGE WOOD: Okay. Thank you, Mr. McCloskey. That will
7 give you 35 minutes for your presentation, and you may begin when you're
8 ready.

9 MR. MCCLOSKEY: Thank you, Your Honor. I represent the
10 Patent Owner, Parking World Wide LLC in Missouri. Also on the call is our
11 inventor who is listed on the Patent. As a reminder, Patents are presumed
12 valid. In listening to the Petitioner's presentation, we appreciate his effort
13 and thought put into analyzing this Patent and attempting to take an issue
14 with it. That took a lot of brain power, and we appreciate that. Listening to
15 the presentation, reading the slides, a couple items came to mind. There's a
16 discussion about what the camera is -- what camera is being used. On slide
17 3 of the demonstratives and slide 31 of the demonstratives, the camera is
18 identified as providing a real-time view on the user's portable electronic
19 device. The user is holding the camera. The invention claimed in the Patent
20 operates upon a portable electronic device of the user. Presumably, in our
21 modern world, mobile phone, tablet, computer at present, at the time of grant
22 issuing the Patent, it would have been earlier generation mobile phones,
23 earlier generation tablets that were present at that time. At the time of
24 writing the Patent application and its provisional 14 years ago, very early
25 generation smartphones and tablets were envisioned by the inventor at the
26 time. Technology has moved along the Patent as the Patent Owner believes

1 covers the present day technology. There is some discussion --

2 JUDGE WOOD: Mr. McCloskey, if I can just ask a quick
3 question.

4 MR. MCCLOSKEY: Certainly. Yes, Your Honor.

5 JUDGE WOOD: I think Petitioner's argument is that what is
6 claimed is that the user's screen displays the camera. It's not necessarily the
7 camera itself. So, it can display an image taken by a different camera. Now,
8 why would the Claim not encompass that possibility?

9 MR. MCCLOSKEY: Because our Claim specified that it was on
10 the user's portable electronic device. At the time of writing the Patent
11 application, at the time of the Patent's issuance, smartphone technology,
12 tablet technology, and onboard cameras.

13 JUDGE WOOD: Okay. Thank you.

14 MR. MCCLOSKEY: The Petitioner also discussed what teachings
15 on -- what the prior art taught and what the prior art didn't and could either
16 side use it. I took a look at the *Bigio* case that the Board presented in its
17 institution decision and refreshed my recollection on it. The case was
18 interesting. It described how a hairbrush was actually shown in three prior
19 toothbrush Patents. The Board did affirm the examiner. However, the
20 Board had a reminder that when using other prior art, there has to be
21 substantial evidence behind it. And also remember common sense from the
22 *In re Oetiker* case. Petitioner has attempted to explain through its expert that
23 there was plenty of substantial evidence, but Patent Owner respectfully
24 disagreed. The Petitioner was explaining through the prior art what it
25 believes the parking system involves was in the Patent. We take the view
26 that a parking system is showing the precise location of a parking space or

1 parking spot. Somewhere in the system, our Patent Owner envisions that the
2 Patent would even cover nonlinear positions of parking. It doesn't have to
3 be in a lot. It can be scattered on the street. It can be scattered across the
4 town. The Patent doesn't require the user to reserve a specific spot or the
5 last available spot. It can be more flexible than that. And we assert that that
6 is not quite shown in the prior art.

7 As described in the documents and also in the demonstratives and
8 discussion today, there's much reference to Ivey. Patent Owner asserts that
9 Ivey was put into the Patent specifications in the beginning over 14 years
10 ago following a Patent search. It was there. The examiner could read it. It
11 was put on the information disclosure form during the Patent application
12 area of this, what became the Patent. The examiner looked at it and didn't
13 use it. And now, the Petitioner seeks to bring it back. So, taking a piece of
14 what was mentioned in a Patent application and bring it back here years later
15 to use against the granted Patent. Something doesn't sound right with that.

16 The Petitioner also reminded us about efficiency. Efficiency
17 appears in many, many places. As described near the end, the Petitioner
18 noted that simplified payment could be an efficiency argument. Just about
19 every business in our country seeks to improve its payment systems every
20 day. It's almost generic. We're not entirely sure that's the best grounds for
21 efficiency. Efficiency also appears quite often in advertising. That was my
22 last exhibit, which was an email sent to me by an auto shop suggesting it
23 was time for an oil change and they used the word efficiency twice. So that
24 was in our most recent exhibit. So, efficiency appears in many, many
25 places. We believe it borders on generic. So those are some things we
26 would encourage the Board to think about as it reviews the documents

1 before it, presentations here, the discussion here, and the questions and the
2 answers.

3 We also noticed that in some of the discussions of prior art, and we
4 believe this separates it from the Patent, many of the cameras, whether in
5 preferred embodiments or alternate embodiments, were at elevation. Some
6 of them were mounted on tops of poles and the other ones claimed a bird's
7 eye view. A bird's eye view generally implies it's from overhead. The
8 present invention has the user using their portable electronic device in their
9 hand, typically with this onboard camera. They're at ground level. They
10 don't always have a bird's eye view. We believe that's a significant
11 difference between prior art and the Patent. As a reminder, the present
12 invention here allows a user and the parking management to look at specific
13 spots or spaces in their parking system. The user does not have to take the
14 last available space, as often happens in the parking garage. When the gate
15 opens, you can take any space you want. The present invention allows a
16 person to go to or use a specific space. It's more precise in its usage and its
17 operation. So primarily, we disagree that the prior art is analogous. The
18 present invention is looking at a specific type of parking system, allows for
19 precision, wait, precision, reservation, and payment for parking spaces, as
20 the user is potentially driving up to the parking area. And it allows the
21 management system to also look at specific spaces in real-time. We do not
22 believe that is shown in the prior art. The present invention operates on a
23 ground level system, not an elevated system. The user of the present
24 invention can take it with them as they go along a route or doing
25 enforcement or checking. The other prior art that mentions mounted
26 systems, sensors, fixed devices, that does not suggest any sort of movement

1 by a user or a parking control officer.

2 That concludes our presentation part. We're open to questions
3 regarding the presentation or the Patent.

4 JUDGE WOOD: All right. Thank you, Mr. McCloskey. A couple
5 of questions. I just want to confirm that Patent Owner did not submit
6 demonstratives.

7 MR. MCCLOSKEY: That is correct. Patent Owner did not submit
8 the demonstratives.

9 JUDGE WOOD: Did Patent Owner depose Petitioner's declarant?

10 MR. MCCLOSKEY: Patent Owner did not depose the Petitioner's
11 declarant.

12 JUDGE WOOD: All right. And Patent Owner does not have its
13 own expert witness or declarant?

14 MR. MCCLOSKEY: That is correct.

15 JUDGE WOOD: All right. Okay. Thank you, Mr. McCloskey.
16 You have 25 minutes left. So, you have basically 35 minutes left for any
17 rebuttal.

18 MR. MCCLOSKEY: Very good. Thank you, Your Honor.

19 JUDGE WOOD: All right. Judge Saindon and Silverman, do you
20 have any questions at this point? All right. Thank you. Mr. Herman, do
21 you have any rebuttal?

22 MR. HERMAN: Just very briefly, Your Honor. So, during Patent
23 Owner's presentation, Patent Owner focused, or appeared to focus on two
24 limitations. First, related to the limitation, the Claims that requires a real-
25 time camera view, and there, Patent Owner argued, or at least appeared to
26 argue that there's a difference between what the Claims require and what the

1 prior art is teaching. And Petitioner submits that that is a new argument, that
2 Patent Owner did not point to any difference between what the Claims
3 require and what the prior art is teaching. Instead, it focused itself on other
4 issues as to whether the prior art is analogous or whether the prior art
5 teaches a way. So, any attempts to distinguish the Claims from the prior art
6 would be in Petitioner's view a new argument.

7 And there was also reference in Patent Owner's presentation about
8 the Claims excluding a camera that essentially generates a bird's eye view.
9 And I'd refer the Board again to Claim 1 that all that Claim 1 requires is a
10 real-time camera view. As I mentioned in my initial presentation, the Claim
11 does not specify where that real-time camera view comes from, it does not
12 require it to be generated in any particular way or via any particular camera,
13 and it certainly does not exclude any particular real-time camera view as
14 long as it is in fact a real-time camera view.

15 And Patent Owner also argued that for some reason that the prior
16 art does not teach what Patent Owner called a ground level system, and there
17 are two issues with that. Number one, it's another new argument. It's not
18 something that Patent Owner raised or a point of distinction that it made in
19 its response brief or its sur-reply. And number two, Patent Owner did not
20 even attempt to tie that particular argument to the Claims. The Claims here
21 don't say anything about ground level systems versus other types of systems.
22 Instead, they just require reserving parking spots wherever they are.

23 And with that, Your Honor, I'm happy to answer any other
24 questions that you may have, but I don't have any other further points to
25 make.

26 JUDGE WOOD: All right. Thank you, Mr. Hermon. Mr.

1 McCloskey, do you have any sur-rebuttal?

2 MR. MCCLOSKEY: I have a brief sur-rebuttal, Your Honor.

3 Now, listening to the Petitioner's latest part of the presentation, there was a
4 discussion about new arguments. We disagree with that. We are trying to
5 defend our Patent here of our client. And the Petitioner also believes that
6 they can introduce whatever they find in the prior art at whatever time they
7 seek to use it. That appears to some as a using of something new.

8 Therefore, we've responded in kind each time we read the prior art, we see
9 additional things that can be useful. So, we don't -- we disagree that it's new
10 to do that.

11 Petitioner has also tried to disagree with us regarding whether
12 ground level is part of the Claim. We refer the Board back to slide number
13 31 of the Petitioner's demonstratives. You know, the preamble of the Claim
14 mentions the intended use of the device mentioned in the Claim, where it's
15 on the user's portable electronic device. The Claim also concludes in its last
16 sentence, and it's actually its last clause, upon a real-time camera view of the
17 user's device. We believe that narrows the Claim to being displayed on a
18 law enforcement officers or parking officer's device. Such officers primarily
19 are at ground level. We do not believe that includes any helicopter of law
20 enforcement. Primarily, it's the ground level parking enforcement. We
21 believe that is an inherent part of the Claim by how we stated it in Claim
22 number 1, as shown on slide 31.

23 And that concludes the sur-reply. We're open to any additional
24 questions from the Board.

25 JUDGE WOOD: All right. Thank you, Mr. McCloskey. I don't
26 have any further questions. Judge Saindon, Judge Silverman, do you have

1 any questions? All right. All right. Thank you both, Mr. Herman, Mr.
2 McCloskey. I appreciate your comments. And we will take this case under
3 advisement and an opinion will issue in due course. That concludes our oral
4 argument in IPR2023-00385.

5 Thank you very much.

6 (Whereupon the above-entitled matter went off the record at 9:44
7 a.m.)

IPR2023-00385
Patent 10,438,421 B2

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