

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROOFR, INC.,
Petitioner

v.

PICTOMETRY INTERNATIONAL CORP.,
Patent Owner

Case IPR2023-00435
U.S. Patent No. 10,648,800

PATENT OWNER'S PRELIMINARY RESPONSE

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
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2014	Microsoft Word Comparison Petition to Cummings Declaration
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2018	<i>Intentionally Left Blank</i>
2019	<i>Intentionally Left Blank</i>
2020	<i>Intentionally Left Blank</i>
2021	U.S. Patent No. 8,417,061 to Kennedy et al.
2022	Prosecution History of U.S. Appl. No. 12/470,984 (now U.S. Patent No. 8,401,222)
2023	Prosecution History of U.S. Appl. No. 13/774,478 (now U.S. Patent No. 8,542,880)
2024	Prosecution History of U.S. Appl. No. 13/786,699 (now U.S. Patent No. 9,329,749)

Exhibit	Description
2025	Prosecution History of U.S. Appl. No. 14/018,943 (now U.S. Patent No. 9,244,589)
2026	Prosecution History of U.S. Appl. No. 15/005,977 (now U.S. Patent No. 9,933,254)
2027	Prosecution History of U.S. Appl. No. 15/943,337 (now U.S. Patent No. 10,197,391)
2028	PRWeb, “EagleView Technology Corporation President and CEO Chris Barrow Named EY Entrepreneur Of The Year® 2015 for the Pacific Northwest,” published June 18, 2015

I. INTRODUCTION

Pictometry International Corp. and its parent company EagleView Technologies, Inc. (collectively, “Patent Owner”) lead the industry “in aerial imagery, data analytics and GIS solutions.” EX2028, 0001. Their large patent portfolio is evidence of the innovation they bring to the industry. The patent at issue here, U.S. Patent No. 10,648,800 (“’800 patent”), protects one of their inventive methods.

The ’800 patent stems from a long line of innovative patents generally claiming methods of measuring rooftops using aerial imagery. These patents were all reviewed by the same Examiner, Atiba O. Fitzpatrick. Throughout the examination of the ’800 patent’s family of patents, Examiner Fitzpatrick was presented with and considered four of the references asserted here: Pershing-789¹, Abhyanker², Pictometry³, and Kennedy⁴. In fact, Examiner Fitzpatrick *explicitly* considered the combination of Pershing-789 and Abhyanker, and proposed *the*

¹ EX1004, U.S. Patent Publication No. 2008/0262789 A1 to Pershing et al.

² EX1005, U.S. Patent Publication No. 2007/0220174 A1 to Abhyanker.

³ EX1008, “Pictometry: aerial photography on steroids,” LET Staff, *Law Enforcement Technology* (July 2002).

⁴ EX1009, U.S. Patent Publication No. 2009/0304227 A1 to Kennedy et al.

claim amendment that overcame this combination during examination of an earlier-filed application (U.S. Application No. 13/786,699, now U.S. Patent No. 9,329,749). EX2003, 0138, 0140-0141.

Without analyzing or even acknowledging the examination of this earlier-filed application, the Petition relies on the exact same combination of Pershing-789 and Abhyanker that was previously considered by Examiner Fitzpatrick. In fact, every ground in the Petition relies on Abhyanker without analyzing or otherwise acknowledging that this reference was explicitly considered during examination. Nor does this Petition—which was filed one day before the one-year statutory bar—acknowledge (1) that Pictometry and Kennedy were also considered by Examiner Fitzpatrick and (2) that the relied-on teachings of Bailey⁵ are cumulative of those found in Pershing-789—which, again, Examiner Fitzpatrick considered.

Under these circumstances, the Board should deny institution of *inter partes* review of claims 1-17 of U.S. Patent No. 10,648,800 (“’800 patent”) for two reasons.

First, the Board should deny institution under 35 U.S.C. § 325(d) because

⁵ EX1010, “Roofer: Steep Roofing Inventory Procedures And Inspection And Distress Manual For Asphalt Shingle Roofs,” David M. Bailey, *U.S. Army Corps of Engineers* (December 1999).

the Petition fails under both part one and part two of *Advanced Bionics*⁶. Under part one, the Petition fails to acknowledge that the same or substantially the same art was already *explicitly* considered by Examiner Fitzpatrick during examination because the Petition fails to mention any of the prosecution histories of the earlier-filed applications within the '800 patent's family. And, under part two, Petitioner does not even attempt to demonstrate any material error or omission by the Examiner. Thus, Petitioner's analysis under § 325(d) is fatally deficient.

Second, the Board should also deny institution on the merits because the Petition fails to show that Abhyanker, which is relied on for all grounds, discloses the independent claims' "geographic position." This "geographic position," the '800 patent explains, can be used to assist in the retrieval of high-resolution aerial imagery of rooftops in order to create a more accurate rooftop-repair estimate. *See* EX1001, 11:1-38. Without addressing these teachings, the Petition asserts that Abhyanker's disclosure of a "marker" teaches the claimed "geographic position." *See* Pet., 31. But Abhyanker's "marker" does not include a street address, latitude and longitude coordinates, nor any other way to *uniquely* identify the "geographic position" of an identified structure, as explicitly taught in the '800 patent. EX1001,

⁶ *Advanced Bionics v. MED-EL Elektromedizinische Geräte GMBH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential).

3:64-67. Nor is there any teaching in Abhyanker, or explanation in the Petition, about how Abhyanker's "marker" can be used to access imagery from a higher-resolution database, as also taught in the '800 patent. EX1001, 11:1-38. And the Petitioner's expert cannot remedy these deficiencies in the Petition because the so-called expert is not even a person of ordinary skill in the art and his declaration is essentially a *verbatim* copy of the Petition without any additional facts or reasoning. Petitioner's expert declaration should therefore be given no weight.

For either of these reasons, the Board should deny institution.

II. BACKGROUND

A. The '800 patent discloses an innovative process to increase accuracy in measuring roofs through aerial imagery.

The '800 patent is generally directed to a computer-implemented "system and process for roof measurement using imagery." EX1001, Title. Conventional aerial-imagery services come with limitations, such as inaccurate designations of a roof structure. EX1001, 1:27-33. To overcome these limitations, the '800 patent allows "for user acceptance of the final location of a roof structure." EX1001, 9:62-63. For example, an initial location of a roof structure may be specified by the street address, whereas the user-accepted location may be specified by the latitude and longitude coordinates of the roof structure, as illustrated in Figure 4B (reproduced below). EX1001, 10:61-67.

100

ADDRESS TO BE MEASURED:
1710 STRAND AVE. 108

CITY:
TYBEE ISLAND 109

STATE:
GA. 110

ZIP CODE
31328 111

NUMBER OF PLANES 112

RUSH PROCESSING 113

OPTIONAL:
REFERENCE NUMBER: 114
CLAIM NUMBER: 115

106b

502a

☒ I have reviewed the image and confirm my selection is correct.

LATITUDE REFERENCE:
38.7492

LONGITUDE REFERENCE:
-85.2748

ADD TO CART 116

Fig. 4D

EX1001, FIG. 4D.

The user-accepted location data, which is different than the street address, can then be used, for example, to access high-resolution images from an imagery database. EX1001, 11:1-38. The '800 patent explains:

[B]y translating the street address stated in longitude and latitude, it is easier to correlate to the second database. In this way, [the] first imagery database from which the final location is selected may be internet based imagery having . . . [a] corresponding street address look up field. ***Only further using the latitude and longitude coordinates to access imagery from a second imagery database, such as for example Pictometry's database.*** Thereafter, using the imagery from the second database can generate in computer memory outline drawings around outlines corresponding to roof planes based on tracing from imagery from said second imagery database.

EX1001, 11:10-21 (emphasis added). “[T]he first imagery database may merely be straight down, or plan views, whereas the second imagery may include a variety of

oblique images,” which allows for “more complete image reporting to the client.”

EX1001, 11:24-31.

Like this description in the Specification, independent Claim 1 is directed to a method that relies on user-accepted location data. This claim recites:

1. A process, comprising:

receiving first location data;

providing visual access to a first image corresponding to the first location data, the first image including a roof structure of a building;

providing a first computer input capable of signaling *a designation from a user of a building roof structure location* within the first image, wherein the building roof structure location is *a geographic position of the building roof structure and is different than the first location data*;

receive a designation of the building roof structure within the first image;

responsive to receiving the designation of the building roof structure location, providing a second computer input capable of signaling user-acceptance of the building roof structure location within the first image, wherein user-acceptance is one or more affirmative steps undertaken by the user to confirm the designation of the building roof structure location; and

subsequent to receiving the user-acceptance confirming the designation of the building roof structure location, providing a report for the building roof structure.

EX1001, Claim 1 (emphasis added).

One critical element of claim 1 is the user-designated “geographic position of the building roof structure [that] is different than the first location data.”

EX1001, Claim 1. This “geographic position” can be used to obtain a second photo

from an imagery database, as explained above and as recited in dependent Claim 9. EX1001, Claim 9 (“providing visual access to a nadir image from an imagery database corresponding to location coordinates of the building roof structure location”). As discussed below, Petitioner fails to demonstrate that Abhyanker teaches or suggests this claimed “geographic position,” and Petitioner does not rely on any of the other prior-art references for this claim element.

B. Abhyanker, Pershing-789, Kennedy, and Pictometry were presented to the Examiner during examination of six earlier-filed patents in the '800 patent's family.

The '800 patent is a continuation stemming from a long line of patents that generally cover a “system and process for roof measurement using [aerial] imagery.” *See* EX1001, Title. The same Examiner, Atiba O. Fitzpatrick, examined each of the applications in the '800 patent's family, as well as the '800 patent itself. *See, e.g.*, EX1002, 100. Over a roughly ten-year period, these patents were examined using the same or substantially the same references relied on in the Petition. The prosecution history of each patent is described below. For ease of review, Figure 1 illustrates the relationship between each patent in the '800 patent's family.

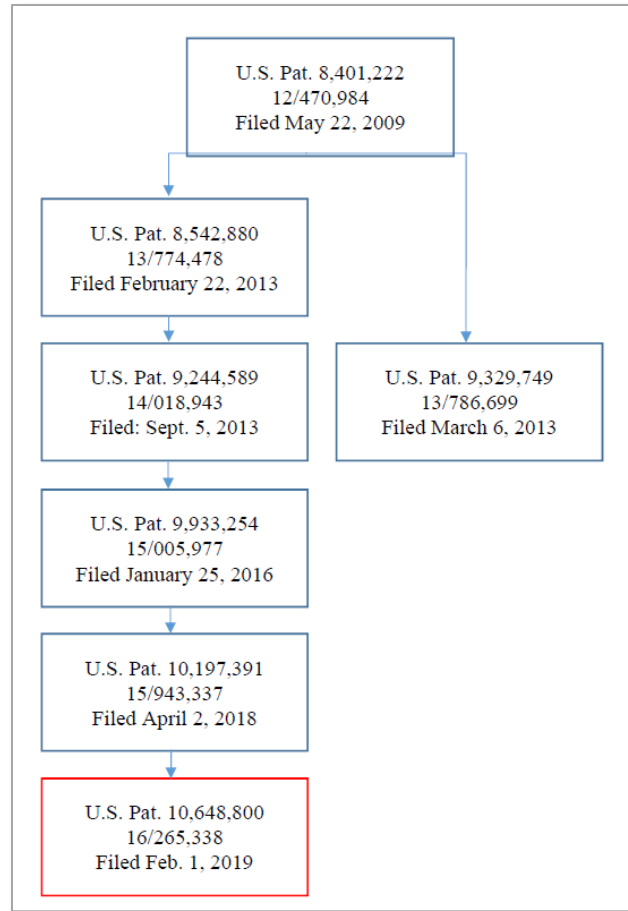


Figure 1 – Overview of Patents within the Family of the '800 Patent

- The '222 Patent: Kennedy, Pictometry, and Pershing-789 were presented to and considered by Examiner Fitzpatrick.**

The first patent in the '800 patent's family is U.S. Patent No. 8,401,222 ("222 patent), which issued from U.S. Application No. 12/470,984 ("984 application"), as illustrated in Figure 2 below. *See* EX1001, (63). Like every application in the '800 patent's family, the '984 application was examined by Examiner Atiba O. Fitzpatrick. EX2022, 0149-0150. And, as explained below,

Kennedy, Pictometry, and Pershing-789 were all presented to and considered by Examiner Fitzpatrick.

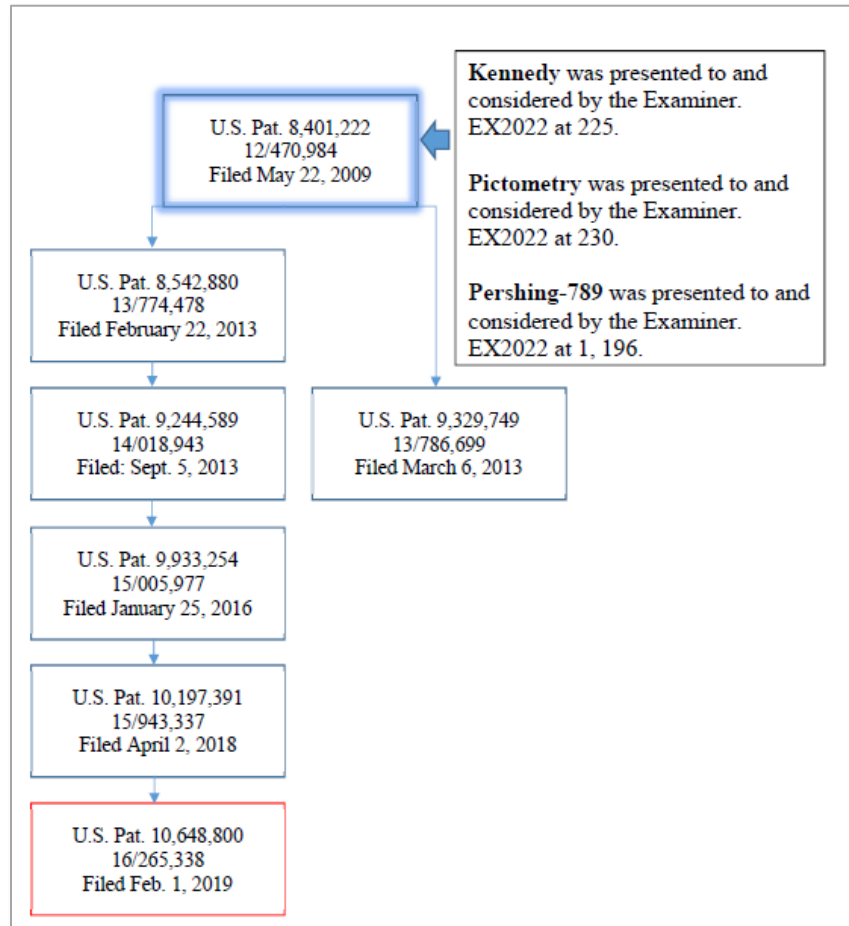


Figure 2 – Overview of Examination of the '222 Patent

Examiner Fitzpatrick issued two Office Actions relating to the '984 application. In the first Office Action, Examiner Fitzpatrick issued a three-way restriction requirement. EX2022, 0149-0156. In the second Office Action, Examiner Fitzpatrick rejected elected claims 23 and 25-33 under 35 U.S.C. § 103(a) as unpatentable over U.S. Publication No. 2010/0110074 ("Pershing-074") in light of U.S. Publication No. 2006/0200311 ("Arutunian"). EX2022, 0179.

In response, the Applicant amended independent Claim 23 as follows:

23. A process for determining attributes of a roof structure of a real-world three-dimensional building, comprising the acts of:
Providing at least one computer input field for a user to input first location data generally corresponding to the location of the building;
Providing visual access to an oblique image ~~digital aerial imagery~~ of a region including the roof structure of the building corresponding to said first location data;
On the oblique image ~~said imagery~~ of [a] the region, providing a visual marker that is moveable on said computer monitor around said region, said visual marker initially corresponding to said first location data, wherein said visual marker may be moved to a final location on top of the building to more precisely identify the location of the building roof structure, the final location having location coordinates;
Providing a computer input capable of signaling user-acceptance of the final location of said marker[.]; and
Providing visual access to one or more images of an aerial imagery database corresponding to location coordinates of the final location.

EX2022, 0209. The Applicant argued that Pershing-074’s “registrations markers do not ‘initially’ correspond to ‘said first location data’ generally corresponding to the location of the building as set forth in claim 23.” EX2022, 0216. The Applicant also argued that Pershing-074 did not “provide [visual] access to one or more images of an aerial imagery database corresponding to location coordinates of the final location.” EX2022, 0217. Instead, Pershing-074 merely allows an operator to use the markers to “transform[]” an image into a uniform 3D reference grid. EX2022, 0217.

The Examiner accepted these arguments and amendments, and issued a Notice of Allowance for the '984 application. EX2022, 0244. Importantly, Examiner Fitzpatrick initialed—indicating that she considered—the references cited in the Applicant's information disclosure statements, *including three of the references relied on in the Petition*: Kennedy (EX2022, 0269), Pictometry (EX2022, 0274), and Pershing-789 (EX2022, 0204). The '222 patent issued on March 19, 2013. EX2022, 0301.

2. The '880 Patent: The PTAB declined to institute an Abhyanker-based ground in an IPR.

The second patent in the '800 patent's family is U.S. Patent No. 8,542,880 ("'880 patent"), which issued from U.S. Application No. 13/774,478 ("'478 application"), as illustrated in Figure 3 below. EX1001, (63). Examiner Fitzpatrick issued a single rejection relating to priority under § 112 and double patenting in view of the '222 patent. EX2002, 0087-0092.

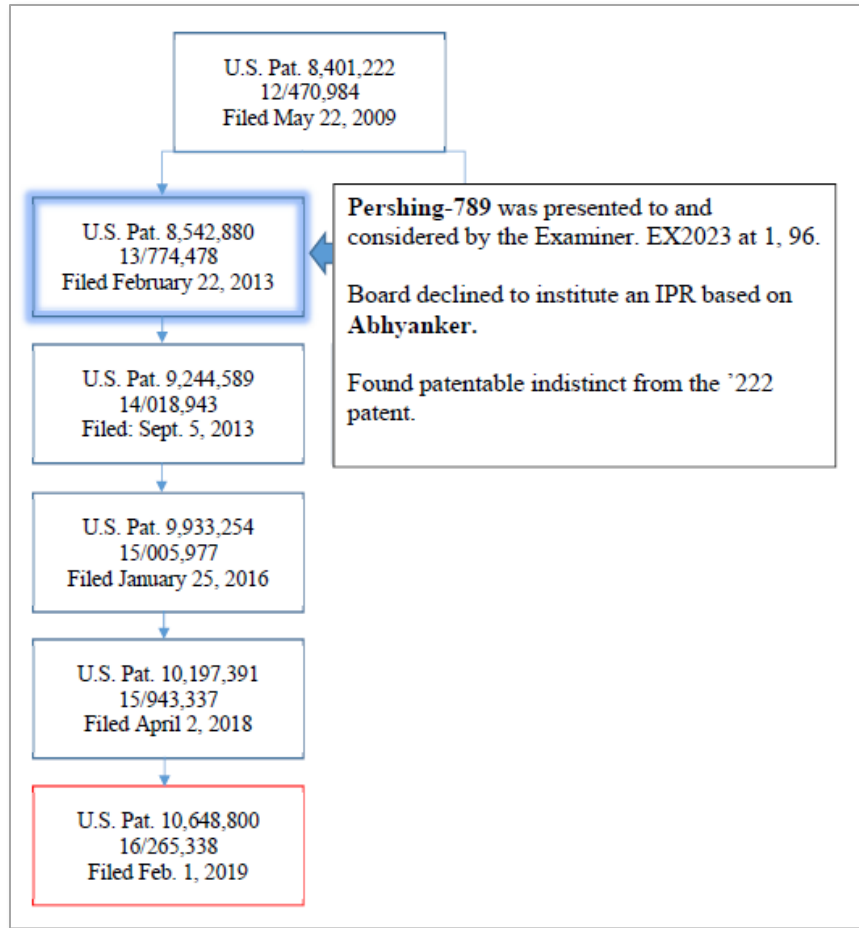


Figure 3 – Overview of Examination of the '880 Patent

To overcome the rejections, the Applicant amended the claims and filed a terminal disclaimer. *See* EX2023, 0126. The Examiner issued a Notice of Allowance on August 1, 2013. EX2023, 0134. One of the references relied on in the Petition—Pershing-789—was included in the Examiner’s prior-art searches. EX2023, 0096. The '880 patent issued on September 24, 2013. EX2023, 0159.

In a subsequent proceeding, the Board declined to institute an Abhyanker-based ground in an *inter partes* review (“IPR”) against the '880 patent. In 2015, the '880 patent was asserted against Xactware Solutions, Inc. (“Xactware”) in the

District of New Jersey. *See Eagle View Technologies, Inc. v. Xactware Soln's, Inc.*, 1:15-cv-07025 (D.N.J. Sep. 23, 2015). On February 8, 2016, Xactware filed an IPR petition against the '880 patent. *Xactware Soln's, Inc. v. Pictometry International Corp.*, IPR2016-00594 (P.T.A.B. February 8, 2016). Xactware asserted three pieces of prior art:

1. U.S. Patent Publication No. 2007/0220174 ("Abhyanker");
2. A published manual by Pictometry International Corp. entitled "Pictometry Visual Intelligence, Electronic Field Study User Guide" ("Xactware's Pictometry Reference"); and
3. A publication by Hsieh entitled "Design and Evaluation of a Semi-Automated Site Modeling System" ("Hsieh").

See EX2023, 0169-0170. The PTAB granted institution of the IPR with respect to Xactware's Pictometry reference but denied institution with respect to both Hsieh and Abhyanker. *See* EX2023, 0179, 0183. The PTAB eventually issued a Final Written Decision finding that the petitioner failed to show by a preponderance of the evidence that the claims of the '880 patent were unpatentable. EX2023, 0268.

In 2022, a second IPR petition was filed against the '880 patent. *Nearmap US, Inc. v. Pictometry Int'l Corp.*, IPR2022-00733 (P.T.A.B. March 21, 2022). The PTAB granted institution of the IPR on Nov. 1, 2022. *Nearmap US*, IPR2022-00733, Paper 10 (P.T.A.B. Nov. 1, 2022). The proceeding is still pending.

3. The '749 and '589 Patents: Examiner Fitzpatrick considered the substance of Pershing-789 and Abhyanker.

The third and fourth patents in the '800 patent's family—U.S. Patent No. 9,329,749 (“'749 patent”) and U.S. Patent No. 9,244,589 (“'589 patent”)—were prosecuted in parallel, and both included amendments to overcome the combination of Pershing-789 and Abhyanker—the prior-art combination in Ground 1 of the Petition.

a. Prosecution History of the '749 Patent

The '749 patent issued from U.S. Application No. 13/786,699 (“'699 application”), filed on March 6, 2013 as a continuation of the '222 patent, as illustrated in Figure 4 below. EX1001, (63). Examiner Fitzpatrick found that the claims of the '699 patent were not patentably distinct over claims of the '222 patent. EX2024, 0105. After filing a terminal disclaimer, EX2024, 0124, the Applicant then filed an IDS on July 7, 2015 listing Abhyanker, EX2024, 0126.

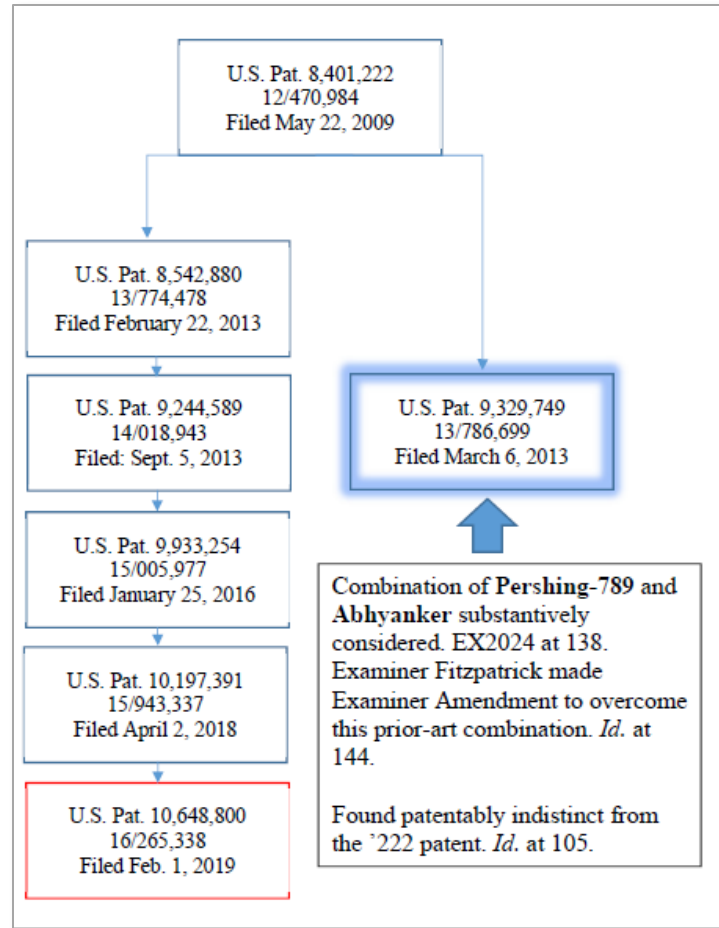


Figure 4 – Overview of the Examination of the '749 Patent

After receiving this IDS, Examiner Fitzpatrick initiated an interview on September 17, 2015 to discuss Abhyanker, Pershing-789, and Winn⁷. EX2024, 0138. Examiner Fitzpatrick explained that Abhyanker could be combined with Pershing-789 “to teach all limitations of [then-pending] independent claim 1,” but proposed an amendment to overcome this combination, as shown in the following excerpted and annotated version of the Examiner-Initiated Interview Summary:

⁷ U.S. Application No. 2009/0096808 A1 to Winn et al.

Substance of Interview

(For each issue discussed, provide a detailed description and indicate if agreement was reached. Some topics may include: identification or clarification of a reference or a portion thereof, claim interpretation, proposed amendments, arguments of any applied references etc...)

Examiner informed Applicant that the Abhyanker reference that Applicant recently provided in IDS filed 07/07/2015 was combinable with the Pershing reference to teach all limitations of the independent claim 1. Examiner explained that Abhyanker teaches limitations pertaining to initially placing a marker in an image location near a roof and then permitting a user to move the marker to a final location atop a roof. Pershing teaches accessing oblique aerial images of rooftops, from a database, in response to the specification of an address location. Examiner also explained that the Winn reference teaches accessing higher resolution secondary images from a database and that these images may include a roof. Applicant did not acquiesce to Examiner's assertions, but agreed to Examiner's Amendments in order to advance prosecution towards allowance.

EX2024, 0138, Examiner-Initiated Interview Summary (annotated).

The Applicant agreed to Examiner Fitzpatrick's proposed amendment to advance prosecution. EX2024, 0138. The claim 1 was then amended as follows:

A non-transient computer memory storing computer logic, that when executed by computer hardware causes the computer hardware to determine attributes of a roof structure of a real-world three-dimensional building by:

Providing at least one computer input field for a user to input first location data generally corresponding to the location of the building;

Providing visual access to [an] a first oblique image of a region including the roof structure of the building corresponding to said first location data, the first oblique image having a first resolution;

On the oblique image of the region, providing a visual marker that is moveable on said computer monitor around said region, said visual marker initially corresponding to said first location data, wherein said visual marker may be moved to a final location on top of the building roof structure, the final location having location coordinates;

Providing a computer input capable of signaling user-acceptance of the final location of said marker; and,

Providing visual access to one or more second images of an aerial imagery database corresponding to location coordinates of the final location, the one or more second images having a second resolution that is higher than the first resolution.

EX2024, 0140-0141. Examiner Fitzpatrick noted that the “Examiner’s amendments distinguish over the cited art”—Abhyanker and Pershing-798—which *“does not teach that second images of higher resolution are accessed from a database relative to a final location atop a rooftop as indicated by a user.”*

EX2024, 0141 (emphasis added).

b. Prosecution History of the ’589 Patent

The ’589 patent was examined in parallel with the ’749 patent and issued from U.S. Application No. 14/018,943 (“’943 application”), as illustrated in Figure 5 below. EX1001, (63). Again, the Examiner was Atiba O. Fitzpatrick. EX2025, 0103. And Pershing-789, EX2025, 111, and Abhyanker, EX2025, 157, were again before Examiner Fitzpatrick, but she issued only one rejection on the merits: an obviousness-type double-patenting rejection over claims of the ’880 patent. EX2025, 0103-0106.

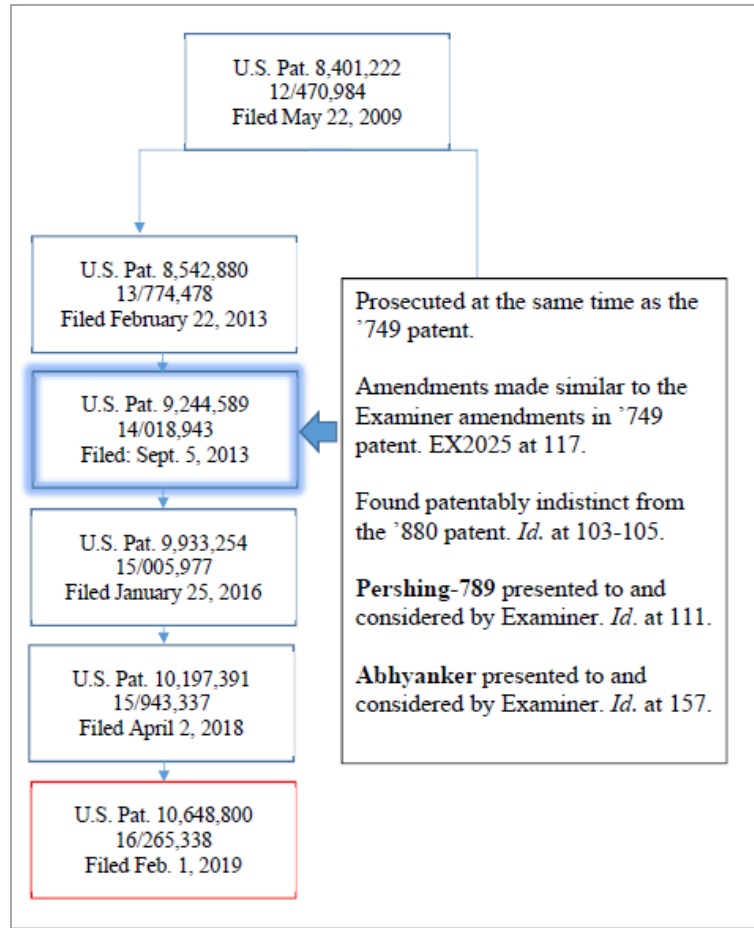


Figure 5 – Overview of the Examination of the '589 Patent

On March 23, 2015, the Applicant amended the claims similar to the Examiner amendments made in the '699 application. Amended claim 1 reads as follows:

A process for determining attributes of a roof structure of a real-world three-dimensional building, comprising the acts of:
providing at least one computer input field for a user to input first location data generally corresponding to the location of the building;
providing visual access to [an] a first aerial image of a region including the roof structure of the building corresponding to said first location data, ~~the aerial image taken from a straight~~

~~down overhead view with respect to the roof structure~~ the first aerial image having a first resolution;
on the aerial image of the region, providing a visual marker that is moveable on a computer monitor around said region, said visual marker initially corresponding to said first location data, wherein said visual marker may be moved to a final location on top of the building to more precisely identify the location of the building roof structure, the final location having location coordinates;
providing a computer input capable of signaling user-acceptance of the final location of said marker; and
providing visual access to one or more ~~second oblique aerial~~ second aerial images ~~[[of]] from an aerial imagery database corresponding to location coordinates of the final location,~~ the one or more second aerial images having a second resolution that is higher resolution than the first resolution.

EX2025, 0117-0118. The Examiner then issued a Notice of Allowance on April 8, 2015. EX2025, 0135.

4. The '254 Patent: Examiner Fitzpatrick again allowed claims over Abhyanker, Pershing-789, Kennedy, and Pictometry.

The fifth patent in the '800 patent's family is the '254 patent, which issued from U.S. Application No. 15/005,977 ("977 application"), as illustrated in Figure 6 below. EX1001, (63). With the filing of the '977 application, the Applicant included an IDS that included four of the references relied on in the Petition: Kennedy, EX2026, 0004; Pictometry, EX2026, 0009; Abhyanker, EX2026, 0011; and Pershing-789, EX2026, 0014.

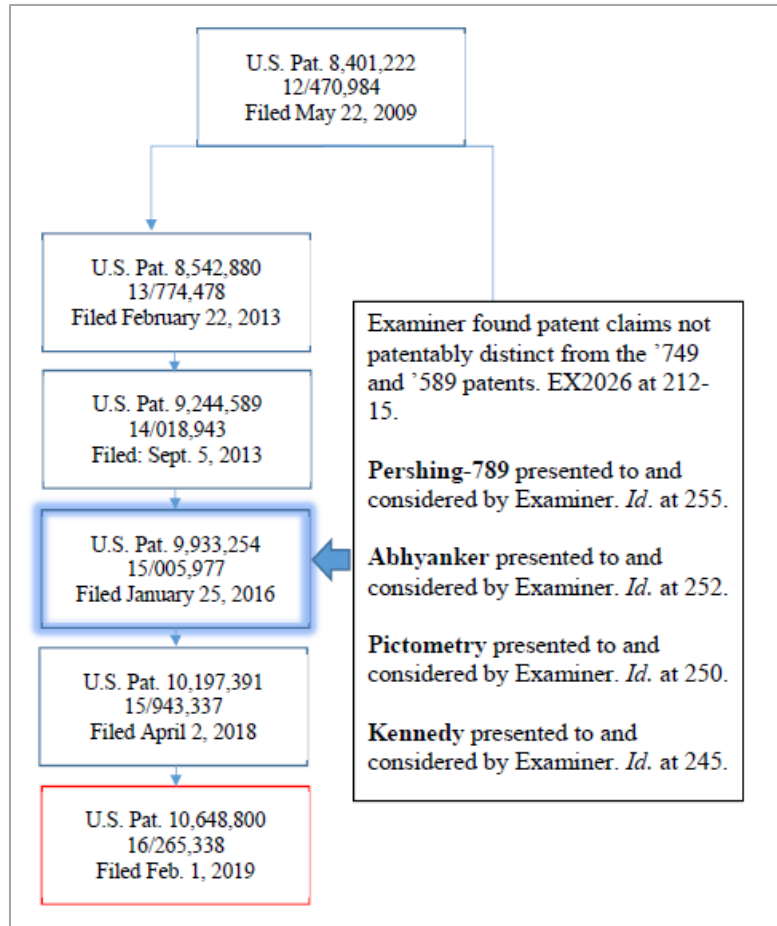


Figure 6 – Overview of the Examination of the '254 Patent

The Examiner, again, was Atiba O. Fitzpatrick. EX2026, 0212. Examiner Fitzpatrick indicated that she considered all of the references cited in the IDS—including Kennedy, EX2026, 0245; Pictometry, EX2026, 0250; Abhyanker, EX2026, 0252; and Pershing-789, EX2026, 0255—but she did not issue any art-based rejections. Instead, Examiner Fitzpatrick rejected all claims under § 101 and stated that the claims were not patentably distinct over claims of the '749 and '589 patents. EX2026, 0212-0215.

To overcome the Examiner's rejections, the Applicant amended the claims and filed a terminal disclaimer. *See* EX2026, 0262-0263, 0285. Application claim 1 was amended as follows:

1. A process, comprising:
providing at least one computer input field for a user to input first
location data generally corresponding to a geographic location
of a building;
receive first location data;
providing visual access to a first aerial image of a region ~~including a~~
~~roof structure of the building~~ corresponding to ~~[[said]]~~ the first
location data, the first aerial image having a first resolution and
including a roof structure of the building;
providing a first computer input capable of signaling a designation
from the user of a building roof structure location within the
first aerial image, wherein the building roof structure location is
a geographic position of the building roof structure and is
different than the first location data;
receive the designation of the building roof structure;
responsive to receiving the designation of the building roof structure
location, providing a second computer input capable of
signaling user-acceptance of a final the building roof structure
location within the first aerial image, wherein user-acceptance
is one or more affirmative steps undertaken by the user to
confirm the designation of the building roof structure location;
and
responsive to receiving the user-acceptance confirming the
designation of the building roof structure location, providing
visual access to one or more second aerial images of an aerial
imagery database corresponding to geographic location
coordinates of the ~~final~~ building roof structure location, the one
or more second aerial images having a second resolution that is
higher resolution than the first resolution.

EX2026, 0262-0263. Notably, the “providing a first computer input” element and the “responsive to receiving” element—which were added to overcome Examiner

Fitzpatrick’s rejections—are substantially similar to elements found in the claims of the ’800 patent. *See infra* Section II.B.6; *see also* EX1001, Claim 1.

Examiner Fitzpatrick then issued a Notice of Allowance. EX2026, 288.

5. The ’391 Patent: Examiner Fitzpatrick again allowed claims over Abhyanker and Pershing-789.

The sixth patent in the ’800 patent’s family is the ’391 patent, which issued from U.S. Application No. 15/943,337 (“’337 application”), as illustrated in Figure 7 below. EX1001, (63). The application filing included an IDS that cited, among other references, Abhyanker (EX2027, 0070) and Pershing-789 (EX2027, 0085). Although Examiner Fitzpatrick considered both Abhyanker (EX2027, 0139) and Pershing-789 (EX2027, 0154), she rejected the as-filed claims for only obviousness-type double patenting over claims of the ’254 patent, EX2027, 0119-0020. After the Applicant filed a terminal disclaimer, EX2027, 0174, Examiner Fitzpatrick issued a Notice of Allowance, EX2027, 0183-0185.

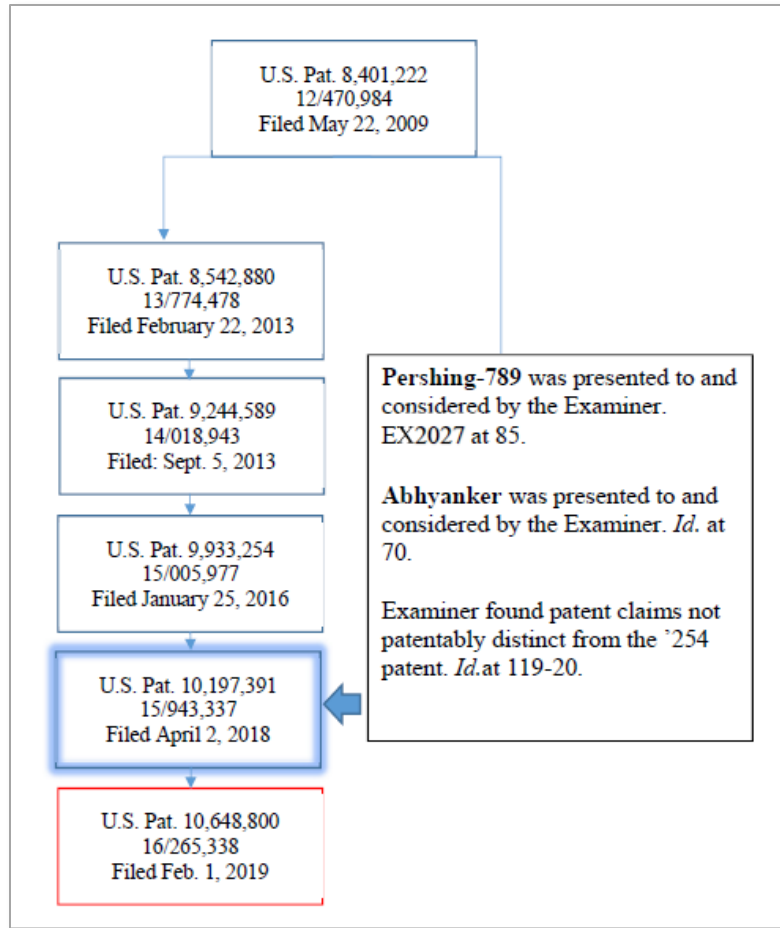


Figure 7 – Overview of the Examination of the '391 Patent

6. The '800 Patent: Examiner Fitzpatrick allowed claims that are substantially similar to those in the '254 patent.

The '800 patent is the seventh patent in a family of patents and issued from U.S. Application No. 16/265,338 (“’338 application”), as illustrated in Figure 8 below. EX1001, (21), (63).

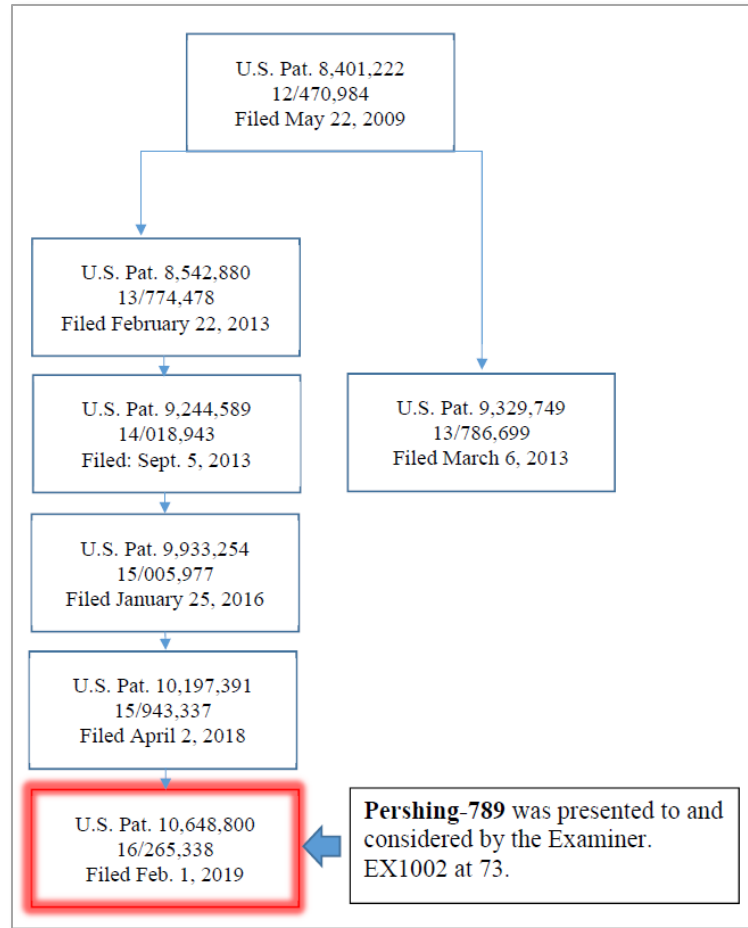


Figure 8 – Overview of the Examination of the '800 Patent

With the application filing, the Applicant included an IDS listing Pershing-789. EX1002, 73. Examiner Fitzpatrick issued a Notice of Allowance without any amendments to the claims and included the following “Reasons for Allowance”:

Limitations pertaining to “responsive to receiving the designation of the building roof structure location, providing a second computer input capable of signaling user-acceptance of the building roof structure location within the first image, wherein user-acceptance is one or more affirmative steps undertaken by the user to confirm the designation of the building roof structure location; and subsequent to receiving the user-acceptance confirming the designation of the building roof structure location, providing a report for the building

roof structure”, in conjunction with other limitations present in the independent claims, distinguish over the prior art.

EX1002, 105. The ’800 patent issued on May 12, 2020. EX1002, 140.

As shown by the following side-by-side comparison, the claims of the ’800 patent include the element of “providing a first computer input” and the element of “responsive to receiving” that are nearly identical to similar elements found in the ’254 patent—which, again, Examiner Fitzpatrick allowed over *Pershing-789*, *Kennedy*, *Pictometry*, and *Abhyanker*:

Claim 1 of the ’254 Patent	Claim 1 of the ’800 Patent
1. A process, comprising: providing at least one computer input field for a user to input first location data generally corresponding to a geographic location of a building; receive first location data; providing visual access to a first aerial image of a region corresponding to the first location data, the first aerial image having a first resolution and including a roof structure of the building;	1. A process comprising: receiving first location data; providing visual access to a first image corresponding to the first location data, the first image including a roof structure of a building;
<i>providing a first computer input capable of signaling a designation from the user of a building roof structure location within the first aerial image, wherein the building roof structure location is a geographic position of the building roof structure and is different than the first location data;</i>	<i>providing a first computer input capable of signaling a designation from a user of a building roof structure location within the first image, wherein the building roof structure location is a geographic position of the building roof structure and is different than the first location data;</i>

Claim 1 of the '254 Patent	Claim 1 of the '800 Patent
receive the designation of the building roof structure;	receive a designation of the building roof structure within the first image;
<i>responsive to receiving the designation of the building roof structure location, providing a second computer input capable of signaling user-acceptance of the building roof structure location within the first aerial image, wherein user-acceptance is one or more affirmative steps undertaken by the user to confirm the designation of the building roof structure location; and</i>	<i>responsive to receiving the designation of the building roof structure location, providing a second computer input capable of signaling user-acceptance of the building roof structure location within the first image, wherein user-acceptance is one or more affirmative steps undertaken by the user to confirm the designation of the building roof structure location; and</i>
responsive to receiving the user-acceptance confirming the designation of the building roof structure location, providing visual access to one or more second aerial images of an aerial imagery database corresponding to geographic location coordinates of the building roof structure location, the one or more second aerial images having a second resolution that is higher resolution than the first resolution.	subsequent to receiving the user-acceptance confirming the designation of the building roof structure location, providing a report for the building roof structure.

EX2026, 0262-0263; EX1001, 41.

C. Petitioner and Patent Owner are currently litigating the '800 patent in Delaware.

On December 29, 2021, Pictometry filed a patent-infringement lawsuit in Delaware against the Petitioner alleging infringement of two patents: U.S. Patent Nos. 9,138,538 and 10,648,800. *Pictometry Int'l Corp. v. Roofr, Inc.*, 1:21-cv-01852, D.I. 1 (D. Del. 2021). Pictometry later amended its Complaint to assert a

third patent, U.S. Patent No. 8,170,840. *Id.*, D.I. 12. With respect to the '800 patent, Petitioner was served with the Complaint on January 4, 2022. *Id.*, D.I. 6. This triggered the one-year time bar under 35 U.S.C. § 315(b) for filing an IPR. The Petition here was filed on January 3, 2023—the last day of the one-year time bar.

III. THE BOARD SHOULD EXERCISE ITS DISCRETION TO DENY THE PETITION UNDER § 325(d) AND *ADVANCED BIONICS*.

The Board should exercise its discretion under 35 U.S.C. § 325(d) to deny institution because “the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d). The Board in *Advanced Bionics* “restat[ed] the framework in [§ 325(d)’s] statutory language” as a “two-part framework,” and clarified how the six, non-exhaustive *Becton, Dickinson*⁸ factors fit within the two-part framework. *Advanced Bionics* at 7-11. As explained below, part one is satisfied here because the Petition relies on the same or substantially the same (cumulative) art that was considered by the Office during original examination of the '800 patent and its related patents. At part two, Petitioner does not even attempt to show material error based on its incorrect belief that part one is not satisfied. *See* Pet., 21.

⁸ *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 (P.T.A.B. Dec. 15, 2017) (precedential: § III.C.5, first paragraph).

A. The Petition relies on the same or substantively the same prior art that was considered during examination of the '800 patent.

The Petition relies on the same prior art and teachings that Examiner Fitzpatrick repeatedly (and substantively) considered throughout the examination of the '800 patent and its patent family. In particular, the Petition relies on five different prior-art references—Abhyanker, Pershing-789, Kennedy, Bailey, and Pictometry—that are organized into the following three grounds:

Ground	Prior Art	Claims
1	Pershing-789 and Abhyanker	1-17
2	Pershing-789, Abhyanker, and Pictometry	9 and 14
3	Kennedy, Abhyanker, and Bailey	1-17

Pet., vii, 24, 63, 66. As explained below, (1) Examiner Fitzpatrick considered Pershing-789, Abhyanker, Kennedy, and Pictometry during examination of the '800 patent and its related applications, and (2) Bailey's teachings are cumulative of those in at least Pershing-789. For at least these reasons, part one of *Advanced Bionics* is satisfied.

1. The Petition relies on Pershing-789, Abhyanker, Kennedy, and Pictometry—which were *repeatedly* and *explicitly* considered by Examiner Fitzpatrick.

The '800 patent is but one patent in a family of earlier-filed patent applications. Without addressing or otherwise acknowledging the examination of *any* of these earlier-filed applications, the Petitioner asserts that “[n]one of the

prior art in th[e] petition was substantively addressed by either the Examiner or the Applicant during prosecution of the '800 patent.” Pet., 19. That assertion is wrong.

Examiner Fitzpatrick *repeatedly* and *explicitly* considered Abhyanker, Pershing-789, Pictometry, and Kennedy over a roughly ten-year period while examining earlier-filed applications in the '800 patent's family:

- **Pershing-789** was cited in IDSs and considered during examination of the '222 patent, the '880 patent, the '749 patent, the '589 patent, the '254 patent, the '391 patent, and the '800 patent;
- **Abhyanker** was cited in IDSs, considered during original examination, or considered in IPR proceedings of the '880 patent, the '749 patent, the '589 patent, the '254 patent, and the '391 patent;
- **Kennedy** was cited in IDSs and considered during examination of the '222 patent and the '254 patent; and
- **Pictometry** was cited in IDSs and considered during examination of the '222 patent and the '254 patent.

See supra Section II.B. Although all of these references are not cited on the face of the '800 patent, Examiner Fitzpatrick would have “consider[ed] the prior art properly cited in the earlier application[s].” M.P.E.P. § 2001.06(b).

Petitioner concedes that Pershing-789 is listed “on the face of the '800 patent,” Pet., 19, but the file histories of the earlier-filed applications show that Examiner Fitzpatrick's understanding of Pershing-789 goes much deeper than a “mere citation of a reference,” *contra id.* For example, Examiner Fitzpatrick explicitly considered Pershing-789 in combination with Abhyanker during examination of the '749 patent. EX2024, 0138, 0144; *supra* Section II.B.3. This

combination of Pershing-789 and Abhyanker, Examiner Fitzpatrick explained, taught all limitations of the then-pending claims. EX2024, 0138, 0144; *supra* Section II.B.3. But Examiner Fitzpatrick proposed a claim amendment, which was accepted by the Applicant, to distinguish the claims over the combination of Abhyanker and Pershing-789. EX2024, 0138, 0144; *supra* Section II.B.3. In other words, Examiner Fitzpatrick was not only aware of the combination of Abhyanker and Pershing-789, but also substantively considered this combination during examination of the earlier-filed applications in the '800 patent's family.

The Board may properly rely on the prosecution histories of these earlier-filed applications to deny institution of the Petition under § 325(d). *See, e.g., Ivantis, Inc. v. Sight Sciences, Inc.*, IPR2022-01540, Paper 14 at 9-10 (P.T.A.B. Mar. 22, 2023) (denying institution based on a reference considered during examination of the grandparent application to the patent-at-issue); *II-VI, Inc. v. Soto*, IPR2021-01361, Paper 10 at 20 (P.T.A.B. Feb. 15, 2022) (denying institution under § 325(d) and agreeing that “the prosecution history of the grandparent patent may legitimately bear on our assessment [under § 325(d)]”); *Becton, Dickinson & Co v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 28 (P.T.A.B. Dec. 15, 2017) (denying institution based on grounds relying on prior art that was considered during the prosecution of the parent applications).

In sum, Petitioner fails to analyze the prosecution histories of the earlier-filed applications in accordance with the *Advanced Bionics* framework. As a result, Petitioner failed to mention that four of the references relied on in the Petition—Abhyanker, Pershing-789, Kennedy, and Pictometry—were previously presented to and considered by the Office.

2. Bailey’s teachings, which Petitioner relies on, are substantially the same as—and thus cumulative to—those already explicitly considered by Examiner Fitzpatrick.

Bailey’s teachings upon which Petitioner relies are cumulative with art considered during prosecution. In short, Bailey’s teachings are substantially the same as background teachings from Pershing-789, which the Examiner plainly considered. But Petitioner hardly addresses Bailey in its § 325(d) arguments. *See* Pet., 18-21.

Petitioner relies on Bailey in Ground 3 as allegedly teaching the following: (1) providing a report; and (2) gathering data to inform roof inspectors on the needed level of repair on a roof. Pet., 69, 74, 89. Pershing-789 describes both of these teachings. For example, the background section of Pershing-789 states, “[u]sing this information, the roofing contractor then prepares a written estimate and then timely delivers it to the homeowner.” EX1004, ¶ 6. In addition, Pershing-789 further explains, “[s]uch measurements can then be used to prepare an estimate to repair or replace the roof or install equipment thereon.” EX1004, ¶ 10.

Bailey's teachings are thus substantially the same as and cumulative with the Pershing-789 teachings that were applied and considered by the Examiner during prosecution. Petitioner's failure to address Bailey in its § 325(d) arguments only confirms that Bailey is cumulative, satisfying part one of *Advanced Bionics*.

The table below summarizes how each of Petitioner's applied references are the same or substantially the same as art that was previously considered, and demonstrates that step one of the *Advanced Bionics* framework is satisfied.

Reference	The same or substantially the same under § 325(d)?
Pershing-789	Yes, listed on the face of the '800 patent. Also presented to, and considered by, the Examiner during the examination of the '222 patent, the '749 patent, the '880 patent, the '589 patent, the '254 patent, and the '391 patent.
Abhyanker	Yes, presented to, and considered by, the Examiner during the examination of the '749 patent, the '589 patent, the '254 patent, and the '391 patent.
Kennedy	Yes, presented to, and considered by, the Examiner during the examination of the '222 patent and the '254 patent.
Pictometry	Yes, presented to, and considered by, the Examiner during the examination of the '222 patent and the '254 patent.
Bailey	Yes, relied upon teachings (i.e., providing reports and estimating repairs) cumulative with (at least) teachings in Pershing-789, which was considered during examination.

In sum, the first part of the *Advanced Bionics* test is plainly met. Pershing-789, Abhyanker, Kennedy, and Pictometry were presented to the Patent Office during prosecution. The remaining reference, Bailey, is cumulative of teachings in at least Pershing-789. Therefore, the Petition presents the same or substantially the same art that was previously considered by the Office.

B. Petitioner does not even address part two of *Advanced Bionics* and thus fails to identify any material error in the Office’s prior evaluation of the prior art.

The Petitioner does not allege *any* material error under the second prong of *Advanced Bionics*. Under the second part of the *Advanced Bionics* framework, “if either condition of [the] first part of the framework is satisfied, [the Board determines] whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *Advanced Bionics* at 8; *see id.* at 10-11. The Petitioner carries the burden of demonstrating material error, and the failure to do so generally results in the denial of institution. *Id.* at 8-9; *see also Becton, Dickinson* at 17-18 (explaining that factor (e) asks “whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art”); *Microsoft Corp. v. AlmondNet, Inc.*, IPR2022-01319, Paper 9, 11 (P.T.A.B. January 30, 2023) (denying institution under § 325(d) where Petitioner did not sufficiently address whether the Office materially erred); *Microsoft*, IPR2022-01319, Paper 14 (P.T.A.B. April 23, 2023) (denying Petitioner’s request for rehearing of decision denying institution).

Petitioner’s arguments under § 325(d) hinge entirely on the first part of the *Advanced Bionics* framework. Pet., 18-21. For the second part, Petitioner asserts only that “the Board does not have to address the second prong of the analysis.” Pet., 21. That is incorrect for the reasons stated above, and Petitioner’s failure to

address the second part of *Advanced Bionics* is fatal to the Petition. *Advanced Bionics* at 8-9 (“If a condition in the first part of the framework is satisfied and the petitioner fails to make a showing of material error, the Director generally will exercise discretion not to institute *inter partes* review.”); *Microsoft*, IPR2022-01319, Paper 9 at 11 (denying institution and explaining that “Petitioner’s assertion that the prior art references in the Petition ‘were not substantively considered during the prosecution of the [the challenged patent], or in the prior CBM challenge,’ without further explanation, is insufficient”); *Microsoft*, IPR2022-01319, Paper 14 at 5 (denying Petitioner’s request for rehearing of decision denying institution; rejecting Petitioner’s argument that “the only way Petitioner could have demonstrated Office ‘error’ was by showing that [the asserted reference] renders the challenged claims unpatentable” (emphasis omitted)).

In sum, the Board should deny institution under § 325(d) because the first part of the *Advanced Bionics* framework is satisfied, and Petitioner fails to identify material error under (or even address) the second part of the framework.

IV. PETITIONER FAILS TO DEMONSTRATE A REASONABLE LIKELIHOOD THE CLAIMS WOULD HAVE BEEN OBVIOUS.

The Board should also deny institution on the merits because the Petition fails to demonstrate a reasonable likelihood of prevailing because the Petitioner fails to show that Abhyanker teaches the claimed “geographic position.” Because

the Petition relies on Abhyanker for this claim element in *all* proposed grounds, *each* proposed ground fails. Further, the Petitioner’s obviousness analysis in each ground is deficient because the Petitioner fails to correctly resolve the level of ordinary skill in the art—one of the required *Graham* factors that must be resolved *before* reaching a conclusion on obviousness. And Petitioner’s reliance on Mr. Cummings cannot salvage the Petition’s deficiencies because Mr. Cummings is not even a person of ordinary skill in the art (“POSITA”) and his opinions are nothing but a carbon-copy of the Petition.

A. Petitioner fails to demonstrate that Abhyanker discloses the claimed “geographic position.”

Each of independent claims 1, 11, and 17 recites “wherein the building roof structure location is a geographic position of the building roof structure and is different than the first location data.” EX1001, 14:14-17, 15:3-6, 16:18-20.

Importantly, the ’800 patent notes, “[t]he term ‘location data’ means information which uniquely identifies geographic position. This may include latitude and longitude coordinates, street addresses and/or otherwise.” EX1001, 3:64-67.

Abhyanker does not teach or suggest “providing a first computer input capable of signaling a designation from a user of a building roof structure location within the first image, *wherein the building roof structure location is a geographic position of the building roof structure and is different than the first location data.*”

Petitioner alleges that Abhyanker’s “digital marker” teaches this limitation because

“a user may drag and drop this marker anywhere in the image.” Pet., 31. But Abhyanker’s “drag and drop” marker does not provide a “geographic position” of a roof structure. *Contra id.* Indeed, Petitioner fails to present any argument as to how Abhyanker’s marker provides information relating to the “geographic position of the building roof structure” such as “latitude and longitude coordinates, street addresses and/or otherwise.” *See* EX1001, 3:64-67.

Indeed, the value and necessity of the “geographic position” limitation becomes clearer when read in light of Claim 9. Claim 9 recites, “[t]he process of claim 2, further comprising[] visual access to a nadir image from an *imagery database* corresponding to location coordinates of the *building roof structure location*, and wherein the outline drawing is super-imposed on the nadir image.” EX1001, 14:52-56 (emphasis added). Claim 9 describes a process in which the “first computer input[’s]” designation of a “geographic position” of the building roof structure results in an image retrieved from an “imagery database.” EX1001, 14:52-56. The specification explains that these images may be retrieved through the “location coordinates of the building roof structure location.” EX1001, 14:54-55. The “location coordinates of the building roof structure” come from the user-inputted “geographic position” of claim 1.

In contrast, Abhyanker teaches only a “marker,” similar to “a pushpin, an indicator, a pointer, a pin, etc.” that can be placed on an image. *See* Pet., 31. The

Petition fails to explain how such a “pushpin” can uniquely identify a “geographic position,” as taught in the ’800 patent. EX1001, 3:64-67. Nor does the Petition explain how such a “pushpin” can be used to access higher-resolution imagery data, as also taught in the ’800 patent. EX1001, 11:1-38.

In sum, Petitioner fails to demonstrate a reasonable likelihood that Abhyanker teaches or suggests providing a “geographic position,” which is recited in each independent claim.

B. Mr. Cumming’s opinion cannot salvage the Petition’s deficiencies.

Mr. Cumming’s opinion is insufficient to correct the fatal flaws in the Petition. *First*, the Petition fails to properly resolve the level of ordinary skill in the art under *Graham*. *Second*, under the proper definition, Mr. Cummings is not even a POSITA. *Finally*, Mr. Cumming’s opinion is merely a carbon copy of the Petition’s own conclusory statements. For these reasons, the Board should reject Mr. Cumming’s opinions as conclusory and unsupported.

1. Mr. Cummings and the Petitioner fail to properly resolve the level of ordinary skill in the art.

Mr. Cummings and Petitioner fail to properly resolve the level of ordinary skill in the art. Under § 103, properly resolving “the level of ordinary skill in the pertinent art” has long been a necessary predicate for determining obviousness. *Graham v. John Deere Co. of Kansas City*, 383 US 1, 17 (1966) (“Under § 103, the scope and content of the prior art are to be determined; differences between the

prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved.”).

Petitioner and its expert, Mr. Cummings, allege that a POSITA “would have [a] bachelor’s degree in architecture or an equivalent with at least five years of experience performing roof estimation,” with the caveat that “more experience would compensate for less formal education, and vice versa.” Pet., 2; EX1003, ¶7. But neither Petitioner nor Mr. Cummings provide any evidence or explanation informing how they reached their proposed conclusion.

As Petitioner and Mr. Cummings concede, “[t]he ’800 patent is generally directed towards a ‘system and process for roof measurement’ using an image of a roof.” Pet., 2; EX1003, ¶16. The claims are directed to a process for producing roof measurement reports using a computer interface, a non-transitory computer memory storing computer logic, and a method for repairing or construction of a roof. *See, e.g.*, EX1001, Claims 1, 11, 17. The asserted primary references—which may reflect the appropriate level of skill in the art, *Okajima v. Bordeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001)—are also directed to computer-implemented systems and technologies. *See, e.g.*, EX1004, FIG. 1; EX1005, ¶112; EX1009, FIG. 1; Pet., 11 (“Kennedy teaches a computer implemented method for generating a roof estimate.”). Yet, Petitioner’s proposed definition does not require any experience with computers, software, or user interfaces. *See* Pet., 2; EX1003, ¶7.

To the extent the Board preliminarily adopts a POSITA definition at this stage of the proceeding, it should reject Petitioner’s proposed definition and adopt a definition similar to the definition that the Board previously adopted with respect to the ’880 patent, a grandparent to the patent at issue. In *Nearmap US*, the challenged ’880 patent is generally directed to computer-implemented technologies for determining the attributes of a roof structure. *Nearmap US*, IPR2022-00733, Paper 10 at 2-3. The Board in *Nearmap US* preliminarily adopted a POSITA definition requiring an academic background and at least two years of experience with computer technologies:

[A] Bachelor’s Degree in an academic area emphasizing the design of electrical, computer, or software technologies, or a similar discipline, and at least two years of experience related to computerized image analysis and three-dimensional modeling.

Id. at 6-7. The Board explained that this “description is consistent with the prior art and patent specification before us,” *id.* at 7, where the primary reference used in the first asserted Ground of *Nearmap US* was the Kennedy patent, which was previously published as the Kennedy publication involved in that *Nearmap* IPR, *id.* at 4 n.1; EX2021 (U.S. Patent No. 8,417,061 B2 was published as US 2009/0304227). Thus, if the Board adopts a definition of a POSITA, it should reject the Petitioner’s POSITA definition and adopt the POSITA definition from the related ’880 patent.

2. Mr. Cummings is not a person of ordinary skill in the art, and his opinions should be given no weight.

Mr. Cummings does not have education and experience in computer technologies and, therefore, cannot be a POSITA. Thus, his opinions are unreliable and should be given no weight. “To offer expert testimony from the perspective of a skilled artisan in a patent case—like for claim construction, validity, or infringement—a witness must at least have ordinary skill in the art.” *Kyocera Senco Industrial Tools Inc. v. Int’l Trade Comm’n*, 22 F.4th 1369, 1376-77 (Fed. Cir. 2022). “Without that skill, the witness’ opinions are neither relevant nor reliable.” *Id.*; see also *Avail Medsystems, Inc. v. Teladoc Health, Inc.*, IPR2022-00444, Paper 10 at 22-26, 28-29, 31 (P.T.A.B. July 21, 2022) (in decision denying institution, according no weight to expert’s “testimony from the perspective of a skilled artisan” because the expert lacked the specific experience with teleconferencing systems required under the adopted definition of a skilled artisan); *Incyte Corp. v. Concert Pharms., Inc.*, PGR2021-00006, Paper 68 at 8-9 (P.T.A.B. May 11, 2022) (in final written decision, according no weight to expert’s opinions “with regard to issues of treating hair loss disorder” because the expert lacked the specific experience required under the adopted definition of a POSITA).

In *Kyocera*, the Federal Circuit held that it was an abuse of discretion to admit any expert testimony from the perspective of a skilled artisan when the expert lacks the specific experience required of such a skilled artisan. *Kyocera*, 22

F.4th at 1375-78. In particular, “[t]he level of ordinary skill in the art” of the patent-at-issue in *Kyocera* “require[d] experience in power nailer design.” *Id.* at 1377. Although *Kyocera*’s expert had “advanced degrees in engineering and extensive experience in the design and manufacture of fastener driving tools,” *id.* at 1376, he lacked the specific experience with power nailer design required under the adopted definition of a POSITA, *id.* at 1377. Accordingly, the court held that it was improper to rely on the expert’s testimony “on any issue that [was] analyzed through the lens of an ordinarily skilled artisan.” *Id.* at 1377-78.

Like the expert in *Kyocera*, Mr. Cummings does not satisfy the correct definition of a POSITA, which would include education and experience with computer technologies, such as software and user interfaces. Mr. Cummings holds a Bachelor of Architecture, but has no education related to computer technologies. EX1003, ¶2. His lack of skill in the relevant art further demonstrates that the Board should not credit Mr. Cummings’s opinions.

3. Mr. Cummings’s opinions are conclusory and repeat *verbatim* the Petition, and thus are entitled to no weight.

Mr. Cummings opinion is a verbatim carbon-copy of the Petition and should be given no weight. “[C]onclusory expert testimony is inadequate to support an obviousness determination” *TQ Delta, LLC v. Cisco Systems, Inc.*, 942 F.3d 1352, 1359 (Fed. Cir. 2019); *see also In re Magnum Oil Tools Int’l*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (“To satisfy its burden of proving obviousness, a petitioner

cannot employ mere conclusory statements.”). The Board does not credit declaration testimony that “merely repeats, verbatim, the conclusory assertion for which it is offered to support.” *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9 at 15-16 (P.T.A.B. August 24, 2022) (precedential) (emphasis omitted); *see also id.* at 15 (“[T]he cited declaration testimony is conclusory and unsupported, adds little to the conclusory assertion for which it is offered to support, and is entitled to little weight.”); 37 C.F.R. § 42.65(a).

As a further example of Petitioner’s rush job in filing this Petition, the key substantive sections of Mr. Cummings’s declaration repeat *verbatim* Petitioner’s conclusory arguments presented in the Petition and are not entitled to any weight. *See* EX2014. For example, Mr. Cummings’s opinions regarding a POSITA’s motivation to combine Pershing-789 and Abhyanker repeat *verbatim* the Petition. *Compare* Pet. at 24-26, with EX1003, ¶¶44-46. The same is true of Mr. Cummings’ opinions with respect to the motivation to combine in the other two grounds. *Compare* Pet., 64-66 (Abhyanker, Pershing-789, and Pictometry), with EX1003, ¶¶122-126 (same); *compare* Pet., 67-69 (Kennedy, Abhyanker, and Bailey), with EX1003, ¶¶128-130 (same). In his declaration, Mr. Cummings even states that “*Petitioner* has already explained why a POSITA would have been motivated to combine” certain teachings, EX1003, ¶126, misidentifying himself as the Petitioner and copying the Petition. *See* Pet., 65.

Mr. Cummings's Declaration is the quintessential cut-and-paste copy of attorney argument that *Xerox* instructs should be given no weight.

V. CONCLUSION

The Board should deny institution for two independent reasons.

First, denial is proper under § 325(d) in accordance with both the first and second prongs of *Advanced Bionics*. Under the first prong, the Petitioner failed to analyze or otherwise address the prior art properly considered during the examination of the earlier-filed applications within the family of the '800 patent. Compounding its failure, the Petitioner completely (and fatally) ignores the second prong of *Advanced Bionics*.

Second, Petitioner fails to show that the relied-on prior art teaches the “geographic position” found in each independent claim of the '800 patent. And Mr. Cummings' conclusory opinions cannot salvage this deficiency in the Petition.

For either of these reasons, the Board should deny institution.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jonathan Tuminaro/

Michael D. Specht (Reg. No. 54,463)
Jonathan Tuminaro (Reg. No. 61,327)
Richard M. Bemben (Reg. No. 68,658)
Counsel for Patent Owner

Date: May 9, 2023

1100 New York Avenue, N.W.
Washington, D.C. 20005
(202) 371-2600

**CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITATION,
TYPEFACE REQUIREMENTS, AND TYPE STYLE REQUIREMENTS**

1. This Patent Owner's Preliminary Response complies with the type-volume limitation of 14,000 words, comprising 8,361 words, excluding the parts exempted by 37 C.F.R. § 42.24(a)(1).

2. This Patent Owner's Preliminary Response complies with the general format requirements of 37 C.F.R. § 42.6(a) and has been prepared using Microsoft® Word 2016 in 14 point Times New Roman.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jonathan Tuminaro/

Jonathan Tuminaro
Registration No. 61,327
Counsel for Patent Owner

Date: May 9, 2023

1100 New York Avenue, N.W.
Washington, D.C. 20005
(202) 371-2600

CERTIFICATION OF SERVICE

The undersigned hereby certifies that true and correct copies of the foregoing **PATENT OWNER'S PRELIMINARY RESPONSE** and **EXHIBITS 2014** and **2021-2028** were served electronically via e-mail on May 9, 2023, in their entireties on the following counsel for Petitioner:

James M. Glass (Lead Counsel)
Sean Gloth (Back-Up Counsel)
QUINN EMANUEL URQUHART & SULLIVAN, LLP
jimglass@quinnemanuel.com
seangloth@quinnemanuel.com

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