

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROOFR INC.,
Petitioner

v.

PICTOMETRY INTERNATIONAL CORP.,
Patent Owner

IPR2023-00435
Patent 10,648,800

**PRE-INSTITUTION REPLY IN SUPPORT OF
PETITION FOR *INTER PARTES* REVIEW**

TABLE OF CONTENTS

	<u>Page</u>
I. DENIAL BASED ON § 325(D) IS NOT WARRANTED	1
A. Kennedy and Pictometry	1
B. Pershing-789 and Abhyanker	3
C. Bailey	5

I. DENIAL BASED ON § 325(d) IS NOT WARRANTED

A. Kennedy and Pictometry

Kennedy is relied upon in Ground 3 as a primary reference to show the bulk of the limitations in the challenged claims. Pictometry is relied upon in Ground 2 to show superimposing an outline drawing on a nadir image as required by claims 9 and 14. Neither Kennedy nor Pictometry was cited in an IDS or addressed by the Examiner during prosecution of the '800 patent. Indeed, **no** prior art reference was substantively addressed during prosecution—the claims were issued without rejection. Thus, *Becton, Dickinson* factors (“*BD* factors”) (a) (similarity of the art), (b) (cumulativeness of art), (c) (extent of prior art evaluation), (d) (overlap in arguments), (e) (error in prior art evaluation) and (f) (facts warranting reconsideration) do not apply, because the Grounds present new art and new arguments never evaluated during examination. Notably, Patent Owner does **not** argue that these references are cumulative.

Instead, Patent Owner argues that these references were considered in parent applications of the '800 patent. POPR at 29. First, the references were merely cited in an IDS during prosecution of two of the '800 patent's family members ('222 and '254 patents). *Id.* This is irrelevant because these family members recite **different claims** than the '800 patent. In any case, citing

references in an IDS is insufficient under § 325(d). *CrowdStrike, Inc. v. Webroot Inc.*, IPR2023-00126, Paper 9 at 14 (PTAB May 5, 2023) (“[W]e cannot determine the extent to which Morris 340 was evaluated during the examination because it was never used in a rejection.”); *Scientific Design Co., Inc. v. Shell oil co.*, IPR2022-00158, Paper 7 at 25 (PTAB April 4, 2022) (“The Examiner, apart from initialing the asserted art in an IDS, did not indicate a substantive evaluation of the asserted art and, therefore, we credit Petitioner’s argument[.]”).

Patent Owner’s cases are inapposite. In *Ivantis*, the PTAB found denial was warranted where the prior art at issue was ***relied upon by the examiner to reject similar claims*** in a related patent and overcome by applicant. *Ivantis, Inc. et al. v. Sight Sciences, Inc.*, IPR2022-01529, paper 16 at 15 (PTAB March 21, 2023). Likewise, in *Boragen* the PTAB denied institution where the exact combination of primary references relied upon in the petition was used to reject the claims five times. *Boragen, Inc. v. Syngenta Participations AG*, IPR2020-00124, Paper 16 at 15 (May 5, 2020) (emphasis added). *Boragen*’s brief mention of an IDS focused on an ancillary, secondary prior art reference used in only one ground. *Id.* at 21-22. Neither case suggests that denial is warranted here.

Patent Owner's suggestion that Petitioner failed to analyze error under Step 2 is without merit. POPR 34-35. None of the art in the petition was considered during prosecution. Pet. at 19. Had the art (or cumulative art) been considered, the claims should have been rejected for the reasons set forth in the petition Grounds. *See, e.g.*, Pet. at 20 (arguing that the unconsidered references disclose all of the claim limitations). This is an error under Step 2. *See Scientific Design Co.*, Paper 7 at 23, 25-26 (rejecting Patent Owner's argument that Petitioner made "no attempt" to address Step 2: "Petitioner appears to address the error [under Step 2] by explaining the prosecution history of the '813 patent, clarifying that the asserted art was ***not substantively evaluated*** during examination (apart from being initialed in an IDS) or a basis for rejection...Petitioner sufficiently demonstrates that the Examiner erred in overlooking the relevant disclosures of the cited references.") (emphasis added).

B. Pershing-789 and Abhyanker

Pershing-789 is used in Grounds 1 and 2 to show the bulk of the challenged claim elements. Abhyanker is used in Grounds 1-3 to show the claimed user "inputs." There is no dispute that Abhyanker was not of record during prosecution of the '800 patent. Pershing-789 was merely cited in an

IDS during prosecution. Thus, these references do not implicate § 325(d) for the same reasons discussed in Section A.

Patent Owner argues that the Examiner did substantively address both Pershing-789 and Abhyanker in a grandparent application—the ’749 patent (Patent Owner does **not** argue that these references were discussed or used in rejections in any other related application). POPR at 29-30. But this is irrelevant because the grandparent application addressed **different** claims. In particular, Patent Owner admits the ’749 claims were allowed due to their recitation of images having two different resolutions (POPR at 16), limitations not present in the ’800 claims. Thus, the ’749 prosecution history is irrelevant. Indeed, the Examiner did not issue a double-patenting rejection for the ’800 patent based on the ’749 claims.

Moreover, the grandparent prosecution history supports institution. The Examiner explained that Abhyanker was “**combinable**” to Pershing-789, consistent with the Petition. POPR at 16, citing Ex. 2024 at 138. The Examiner’s findings that Abhyanker’s drag-and-drop feature meets the overlapping user “inputs” recited in both the ’749 and ’800 claims further affirms Petitioner’s Grounds which rely on Abhyanker in the same manner. *Compare* Pet. at 30-36 with POPR at 16. This supports institution. To the extent the Examiner was aware of this combination during the ’800

proceeding, his failure to re-apply this combination is a material error for the same reasons discussed in Section A.

Patent Owner also cites the PTAB's denial of a petition filed against the '880 patent (a grandparent of the '800 patent) to support its request for denial. But there the Board denied institution of grounds based on Abhyanker because they were *redundant* of the instituted grounds. Ex. 2023 at 183. This does not show that the Office rejected Abhyanker's teachings—quite the opposite. Accordingly, Patent Owner's arguments should be rejected.

C. Bailey

Bailey is used in Ground 3 to show using roof estimates to generate reports. Bailey was not before the Examiner during the examination of the '800 patent *or any of its family members*. POPR at 29. Thus, § 325(d) is not implicated for the same reasons discussed in Section A.

Petitioner argues that Bailey is cumulative of Pershing-789. But Pershing-789 was not considered during the '800 prosecution either, and, thus, cannot be considered cumulative. Further, as discussed above, to the extent Pershing-789 was considered and ignored, this constitutes material error weighing in favor of institution—the same argument applies to Bailey.

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CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(E), 42.105(A))

The undersigned hereby certifies that on June 6, 2023 a copy of the foregoing was served via email on counsel at the email addresses provided in Patent Owner's mandatory disclosures:

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