

IN THE 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 SUR-REPLY TO PETITIONER’S REPLY TO
PATENT OWNER’S PRELIMINARY RESPONSE**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit	Description
2001	<i>Intentionally Left Blank</i>
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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)

Exhibit	Description
2024	Prosecution History of U.S. Appl. No. 13/786,699 (now U.S. Patent No. 9,329,749)
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
2029	May 23, 2023 Email from Roofr’s Counsel to the Board in IPR2023-00435, -00436, and -00437
2030	May 23, 2023 Email from Patent Owner’s Counsel to the Board regarding Roofr’s requested reply to the POPRs in IPR2023-00435, -00436, and -00437

I. INTRODUCTION

The Petition relies on the same or substantially the same prior art that was previously presented to the Office in the prosecution history of the '800 patent.

Four out of the five references relied on in the Petition were explicitly considered by Examiner Atiba O. Fitzpatrick during examination of earlier-filed applications in the '800 patent's family. POPR, 28-31. For example, Examiner Fitzpatrick *explicitly* considered Abhyanker—which is relied on in all three grounds of the Petition—and proposed *the* claim amendment to distinguish over this prior-art reference during examination of the earlier-filed '749 patent. *Id.*, 2-3, 14-17. Then, during examination of the grandparent '254 patent, Examiner Fitzpatrick again allowed claims over Abhyanker as well as Pershing-789, Kennedy, and Pictometry. *Id.*, 19-22. This conclusion deserves deference here because independent claim 1 of the grandparent '254 patent and independent claim 1 of the '800 patent are substantially similar, as shown by a side-by-side claim comparison in the POPR. *Id.*, 25-26.

The fifth and final prior-art reference relied on in the Petition—Bailey—is cumulative to Pershing-789, which was already explicitly considered by Examiner Fitzpatrick. *Id.*, 31-33.

Because none of these issues were addressed or even mentioned in the Petition, the Board should deny institution. *Id.*, 2-3, 27-33.

II. PETITIONER’S REQUEST FOR ADDITIONAL BRIEFING WAS NOT SUPPORTED BY GOOD CAUSE.

A petitioner’s request for leave to file a reply to the preliminary response “must make a showing of good cause.” 37 C.F.R. § 42.108(c). That showing was not made here. Without identifying any new facts or law, Petitioner merely asserts that the § 325(d) issues were supposedly “not foreseeable.” EX2029. But the clear directive under § 325(d) and the *Advanced Bionics*¹ framework asks whether the same or substantially the same art or arguments were previously presented to the Office. 35 U.S.C. § 325(d); *Advanced Bionics*, Paper 6, 8. Petitioner thus should have addressed the prior art from the prosecution histories of the earlier-filed applications. EX2030, 1. It did not and should not have been allowed to try to cure foreseeable flaws in the Petition *after the one-year statutory-bar date*. Cf. *Google LLC v. Valtrus Innovs. Ltd.*, IPR2022-01197, Paper 12, 5 (P.T.A.B. Mar. 29, 2023) (§ 325(d) argument based on foreign-counterpart reference not “foreseeable”).

III. PETITIONER’S ARGUMENTS AGAINST DISCRETIONARY DENIAL LACK MERIT.

A. Kennedy and Pictometry

Petitioner argues that the citation of Kennedy and Pictometry in an IDS during examination of the ’222 and ’254 patents is “irrelevant because these family

¹ *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020).

members recite different claims than the '800 patent.” Reply², 1. That is not quite right. Petitioner’s argument ignores the fact that independent claim 1 of the earlier-filed '254 patent and independent claim 1 of the '800 patent are substantially similar—as shown in the side-by-side claim comparison on page 25 of the POPR. Petitioner’s Reply does not even mention this claim comparison.

Nor do Petitioner’s cases stand for the proposition that “citing references in an IDS is insufficient under § 325(d).” See Reply, 1-2. In *CrowdStrike*, the patent owner’s § 325(d) argument relied on different prior art than the prior art relied on in the petition. *CrowdStrike, Inc. v. Webroot Inc.*, IPR2023-00126, Paper 9, 14 (P.T.A.B. May 5, 2023). But *CrowdStrike* is inapposite here because Kennedy and Pictometry are the *exact same* references cited in the Petition and previously considered by Examiner Fitzpatrick. See POPR, 8-11, 19-22, 25-26, 29.

In *Scientific Design*, the Board declined to exercise its discretion under § 325(d) to deny institution because the petition addressed the examiner’s error “by explaining the prosecution history of the '813 patent” and “clarifying that the asserted art was not substantively evaluated during examination.” *Scientific Design Co., Inc. v. Shell Oil Co.*, IPR2022-00158, Paper 7, 25 (P.T.A.B. Apr. 4, 2022). But *Scientific Design* is not applicable here because Petitioner here did not even

² “Reply” refers to Petitioner’s “Pre-Institution Reply in Support of Petition for *Inter Partes* Review” (Paper 12).

discuss the prosecution histories of the '222 or '254 patents, let alone identify any alleged error in Examiner Fitzpatrick's examination of those patents.

Lastly, Petitioner's analysis of Pictometry and Kennedy as standalone references glosses over the fact that the Petition relies on these references only in combination with Abhyanker. In particular, every ground in the Petition relies on Abhyanker as allegedly teaching the "geographic position" limitation found in independent claim 1 of the '800 patent. *See* Pet., 30-32, 73. But a nearly identical "geographic position" limitation appears in independent claim 1 of the '254 patent—which, again, Examiner Fitzpatrick allowed over Abhyanker, Pershing-789, Kennedy, and Pictometry. POPR, 25. Petitioner has not shown any error in this conclusion by Examiner Fitzpatrick. To the contrary, the Petition fails to show that Abhyanker teaches this "geographic position" limitation. *Id.*, 3-4, 35-38.

B. Pershing-789 and Abhyanker

Petitioner argues that Examiner Fitzpatrick's analysis of Pershing-789 and Abhyanker during examination of the '749 patent "is irrelevant because the grandparent application addressed different claims." Reply, 4. But that argument is contradicted by Petitioner's own concession that "both the '749 and '800 claims" recite "overlapping user 'inputs'" limitations. *Id.* In any event, Petitioner's argument ignores the side-by-side claim comparison showing the substantial similarity between claim 1 of the '800 patent and claim 1 of the '254 patent—

which, again, Examiner Fitzpatrick allowed over both Pershing-789 and Abhyanker (as well as Kennedy and Pictometry). *See* POPR, 25.

C. Bailey

Petitioner argues, without any explanation or legal authority, that Bailey “cannot be considered cumulative” to Pershing-789 because “Pershing-789 was not considered during the ’800 prosecution.” Reply, 5. Petitioner also argues that, “to the extent Pershing-789 was considered and ignored, this constitutes material error weighing in favor of institution.” *Id.* But “Petitioner’s assertion that the prior art references in the Petition ‘were not substantively considered during the prosecution of the [’800 patent] . . . ,’ without further explanation, is insufficient.” *Microsoft Corp. v. AlmondNet, Inc.*, IPR2022-01319, Paper 9, 11 (P.T.A.B. Jan. 30, 2023).

IV. CONCLUSION

The *Advanced Bionics* “framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.” *Advanced Bionics*, Paper 6, 9. “If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.” *Id.* Here, Petitioner has not shown any material error in Examiner Fitzpatrick’s patentability conclusions over the same or substantially the same prior art that is relied on in the Petition. The Board should therefore defer to Examiner Fitzpatrick’s conclusions and deny institution.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE and EXHIBITS 2029-2030** were served in their entireties on June 13, 2023 upon the following parties via electronic mail:

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