

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 B2

Before STACEY G. WHITE, GARTHD. BAER, and RUSSELL E. CASS,
Administrative Patent Judges.

BAER, *Administrative Patent Judge.*

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Roofr Inc. (“Petitioner”) filed a Petition requesting an *inter partes* review of claims 1–17 (the “challenged claims”) of U.S. Patent No. 10,648,800 B2 (Ex. 1001, “the ’800 patent”). Paper 5, 1 (“Pet.”). Pictometry International Corp. (“Patent Owner”) filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 12, “Pet. Reply.”) and Patent Owner filed a Sur-reply (Paper 13, “PO Sur-reply”).

Under 35 U.S.C. § 314, an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” Upon consideration of the Petition in view of the present record and for the reasons explained below, we determine that Petitioner has shown a reasonable likelihood of prevailing with respect to at least one of the challenged claims. Accordingly, we institute an *inter partes* review on all grounds set forth in the Petition.

B. Related Proceedings

The parties identify the following related matters: *Eagle View Technologies, Inc. v. Nearmap US, Inc.*, 2:21-cv-00283 (D. Utah); *Eagle View Technologies, Inc. v. GAF Materials LLC*, 2:22-cv-00215 (D. Utah); and *Pictometry International Corp. v. Roofr, Inc.*, 1:21-cv-01852 (D. Del). Pet. 91; Paper 3, 2.

C. The ’800 Patent (Ex. 1001)

The ’800 patent is directed to measuring a roof using an image. Ex. 1001, code (54). Figure 3 is reproduced below.

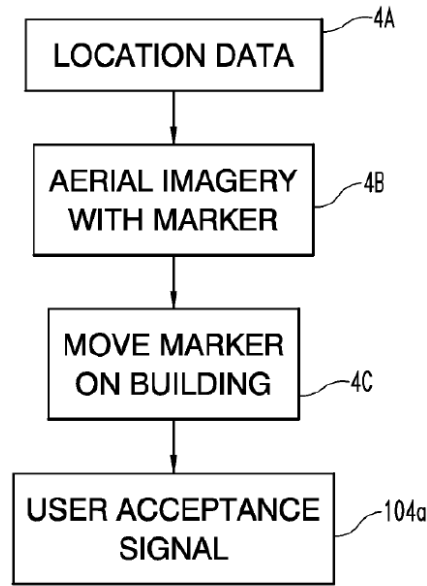


Fig. 3

Figure 3 is “a flow chart of acts according to the present invention.” *Id.* at 2:3–4. At step 4A, “location data . . . is entered.” *Id.* at 11:39. At step 4B, “[a]erial imagery with a marker is provided.” *Id.* at 11:39–40. Next, a “person moves the marker on the image of the building” at step 4C. *Id.* at 11:40–41. “User acceptance of that marker position is then signaled” at step 104a. *Id.* at 11:41–42.

D. Illustrative Claim

Of the challenged claims, claims 1, 11, and 17 are independent. Claim 1 is illustrative and is reproduced below.

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.

Ex. 1001, 14:7–29.

E. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability. Pet. vii.

Claims Challenged	35 U.S.C. §	References/Basis
1–17	103(a)	Pershing-789 ¹ , Abhyanker ²
9, 14	103(a)	Pershing-789, Abhyanker, Pictometry ³
1–17	103(a)	Kennedy ⁴ , Abhyanker, Bailey ⁵

Petitioner submits a declaration from Tony Cummings. Ex. 1003.

¹ US 2008/0262789 A1, Pub. Oct. 23, 2008 (Ex. 1004).

² US 2007/0220174 A1, Pub. Sep. 20, 2007 (Ex. 1005).

³ *Pictometry: Aerial Photography on Steroids*, LET Staff, Law Enforcement Technology (July 2002) (Ex. 1008).

⁴ US 2009/0304227 A1, Pub. Dec. 10, 2009 (Ex. 1009).

⁵ *Roofer: Steep Roofing Inventory Procedures And Inspection And Distress Manual for Asphalt Shingle Roofs*, David M. Bailey, U.S. Army Corps of Engineers, CERL Tech. Rept. (December 1999) (Ex. 1010).

II. DISCUSSION

A. Discretion under 35 U.S.C. § 325(d)

Patent Owner contends we should deny institution under 35 U.S.C. § 325(d) “because ‘the same or substantially the same prior art or arguments previously were presented to the Office.’” Prelim. Resp. 27. Specifically, Patent Owner explains, the same examiner allowed the challenged claims despite considering four of the five asserted prior art references during prosecution for earlier-filed applications in the ’800 patent’s family. *See* Prelim. Resp. 29–30.⁶ For the one reference that was not before the examiner in related applications, Patent Owner asserts that its teachings are cumulative of those from a reference that the examiner considered. *Id.* at 28. For the reasons given below, we are not persuaded to exercise our discretion to deny the Petition based on § 325(d).

In evaluating arguments under § 325(d), we use a two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of the first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential).

Patent Owner has not demonstrated that this case satisfies the first part of the *Advanced Bionics* framework. It is undisputed that four of the five

⁶ Only one of the asserted references, Pershing-789, was cited during prosecution of the challenged patent. *See* Prelim. Resp. 29; Pet. Reply 3–4.

asserted references were not of record during the '800 patent's prosecution. *See* Prelim. Resp. 24–25; PO Sur-reply 1. Even though several of the Petition's asserted references were considered during various parent applications' prosecutions, Patent Owner does not establish that the at-issue claims in those related applications were substantively the same as those at issue in this case. *See* Prelim. Resp. 7–35. To the contrary, the one side-by-side comparison Patent Owner provides shows that the previously-considered claim was substantively different. *See id.* at 25–26. Specifically, the parent application's allowed claim includes a key limitation related to images having two different resolutions—a limitation that the challenged claims lack. *See id.* at 26. The examiner noted this two-resolutions feature, which is not in the challenged claims, was what ultimately distinguished the parent application's claims over the asserted prior art. *Id.* at 15–17.

Although Patent Owner overcame four of the five asserted references during the parent application's prosecution, it did so by adding a limitation that is not in the challenged claims. In short, it is not enough to satisfy the first part of the *Advanced Bionics* framework that Patent Owner overcame the same or substantively similar art or arguments *for materially different claims* in different patent applications. We decline to exercise our discretion to deny institution under § 325(d).

B. Claim Construction

In an *inter partes* review proceeding, we construe patent claims using the same standard used in a civil action under 35 U.S.C. § 282(b), including construing the claim in accordance with the ordinary and customary meaning of the claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b). Neither

party proposes an express construction for any claim terms. Pet. 2; *see generally* Prelim. Resp. We agree that no claim terms require express construction for purposes of this Decision.

C. Level of Ordinary Skill in the Art and Petitioner's Declarant

Petitioner contends “a person of ordinary skill in the art at the time of the alleged invention would have [a] bachelor's degree in architecture or an equivalent with at least five years of experience performing roof estimation,” and that “more experience would compensate for less formal education, and vice versa.” Pet. 2 (citing Ex. 1003 ¶¶ 1–7).

Patent Owner asserts that Petitioner's definition is problematic because the challenged claims include computer-related features, yet “Petitioner's proposed definition does not require any experience with computers, software, or user interfaces.” Prelim. Resp. 39. According to Patent Owner, one skilled in the art would have 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 40. In addition, Patent Owner contends that we should give no weight to Mr. Cummings's opinions because he “holds a Bachelor of Architecture, but has no education related to computer technologies,” and therefore does not qualify as a skilled artisan. *Id.* at 42. Patent Owner also asserts we should give Mr. Cummings's opinions no weight because they are “a verbatim carbon-copy of the Petition.” *Id.*

We agree with Patent Owner that one skilled in the art would have computer-related experience, as that is more consistent with the prior art and patent specification before us. *See Okajima v. Bourdeau*, 261 F.3d 1350,

1355 (Fed. Cir. 2001) (prior art itself may reflect an appropriate level of skill). While Patent Owner’s proposed definition better reflects this requisite experience, we agree with Petitioner’s definition to the extent it recognizes that experience may compensate for formal education, and vice versa. *See* Pet. 2. Thus, at this stage, we adopt Patent Owner’s definition, but add Petitioner’s education-versus-experience caveat.

Given this definition, on the present record we disagree with Patent Owner that Mr. Cummings does not qualify as a person of skill in the art. Although Mr. Cummings may lack formal computer-related education, he “ha[s] extensive experience using software related to construction” including “decades working with software related to construction modeling and estimation.” Ex. 1003 ¶ 6. Mr. Cummings further “ha[s] experience collaborating with software developers to create new software in my field.” *Id.* At this stage, we find Mr. Cummings’s experience sufficient to qualify as a skilled artisan. In addition, we do not find it problematic that the Petition repeats certain portions of Mr. Cummings’s testimony. Though portions of the Petition may be the same as Mr. Cummings’s testimony, that does not undermine the testimony’s persuasiveness or its status as evidence, nor does it mean Petitioner’s arguments are conclusory, as Patent Owner suggests. *See* Prelim. Resp. 42–43.

D. Description of Prior Art References

1. Pershing-789 (Ex. 1004)

Pershing-789 teaches “[a] system that allows the remote measurement of the size, geometry, pitch and orientation of the roof sections of a building and then uses the information to provide an estimate to repair or replace the roof.” Ex. 1004, code (57).

2. *Abhyanker (Ex. 1005)*

Abhyanker teaches “marker placement in a mapping environment.” Ex. 1005, code (54). Abhyanker teaches that “the method may include applying a drag and drop algorithm that enables the user to sequentially and/or concurrently relocate markers in the mapping environment, iteratively performing additional verifications.” *Id.* ¶ 11.

3. *Kennedy (Ex. 1009)*

Kennedy teaches “[a] roof estimating software program [that] receives location information of a building in [a] selected region and then presents the aerial image files showing roof sections of building.” Ex. 1009, code (57). Kennedy further teaches “a sizing tool for determining the size, geometry, and pitch of the roof sections of a building being displayed.” *Id.*

4. *Bailey (Ex. 1010)*

Bailey teaches a “Roof Section Identification Worksheet” that identifies various roof attributes including area, pitch, and length. Ex. 1010, 12–22.

E. Obviousness Analysis

1. *Ground 1: Obviousness based on Pershing-789 and Abhyanker*

In its first unpatentability ground, Petitioner contends that claims 1–17 would have been obvious over Pershing-789 and Abhyanker. Pet. 24–63. Based on the present record and for the reasons explained below, we determine that Petitioner has demonstrated a reasonable likelihood of success in proving that claims 1–17 would have been obvious over Pershing-789 and Abhyanker.

a) Petitioner's Proposed Combination of Pershing-789 and Abhyanker

Petitioner relies primarily on Pershing-789 for the bulk of the challenged claims' elements, including receiving a location, providing an image of the location for roof measurement, and providing a report for a selected roof in the image. Pet. 5–7; *see id.* at 27–30, 35–63. Petitioner relies on Abhyanker for teaching the claimed user inputs—i.e., allowing a user to place a marker on the roof in question and to confirm the right selection was made. *See id.* at 7–9, 30–35. Petitioner argues that one of ordinary skill would have been motivated to modify Pershing-789's teachings with Abhyanker's user inputs because “allowing a user to designate a geographic position of a roof and to subsequently confirm that the roof location is correct would promote the *accuracy of the system*.” *Id.* at 24. This accuracy, Petitioner explains, saves money and time, while also adding convenience. *Id.* at 25.

Patent Owner argues that Petitioner's asserted combination fails to teach a single limitation—the claimed “geographic position.” Prelim. Resp. 35–38. We address that issue below.

b) Geographic Position

Claim 1 requires “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.” Ex. 1001, 14:12–17. Independent claims 11 and 17 have similar limitations. Petitioner corresponds Abhyanker's digital marker to the claimed first computer input. Pet. 30–31. According to Petitioner, Abhyanker teaches that the user may drag and drop the marker on an aerial

image of a roof, and that the roof structure's location is a geographic position of the building roof structure that is different than the first location data (i.e., the original location of Pershing-789's marker before it was dragged-and-dropped by the user) as the claims require. *Id.* at 31–32.

Patent Owner argues that Abhyanker's drag-and-drop marker does not provide a geographic position of a roof structure because it does not provide "latitude and longitude coordinates, street addresses and/or otherwise." Prelim. Resp. 37 (citing Ex. 1001, 3:64–67). We disagree with Patent Owner's argument because nothing in the claims or specification limits the claimed geographic position to latitude and longitude coordinates or a street address. The passage from the '800 patent that Patent Owner cites to support its argument suggests that the claimed "location data" may include latitude and longitude coordinates or street addresses. Prelim Resp. 36 (citing Ex. 3:64–67). The passage does not, however, suggest that the claimed geographic position must be in the same format as the location data. Further, the claims' plain language requires only that after the user's input, the geographic position of the building's roof structure must be "different than the first location data." Like the specification, nothing in the claims' plain language suggests that the location data and the geographic position must be in the same format. Thus, based on Petitioner's analysis (*see* Pet. 30–32) and for the reasons explained above, we agree with Petitioner that Abhyanker teaches the claimed limitation related to geographic position.

c) Ground 1 Summary

Other than as outlined above, Patent Owner does not additionally challenge Petitioner's obviousness analysis at this stage. We have reviewed Petitioner's arguments and the underlying evidence cited in support and are

persuaded that, at this stage, Petitioner sufficiently demonstrates a reasonable likelihood of succeeding in its obviousness challenge to claims 1–17 based on Pershing-789 and Abhyanker.

2. Petitioner’s Additional Obviousness Grounds

In its second unpatentability ground, Petitioner contends that claims 9 and 14 would have been obvious over Pershing-789, Abhyanker, and Pictometry. Pet. 36–63. Petitioner adds Pictometry in case “Patent Owner argues that Pershing-789 does not disclose an ‘outline drawing is superimposed on the nadir image,’ as required by claims 9 and 14.” *Id.* at 63. Petitioner explains that Pictometry expressly teaches superimposing drawings on a nadir image and one skilled in the art would have been motivated to incorporate this feature because it was a known way of “allow[ing] roofers and customers to see the house being analyzed” that improved accuracy, flexibility, and precision when analyzing buildings. *Id.* at 65.

In its third obviousness ground, Petitioner contends that claims 1–17 would have been obvious over Kennedy, Abhyanker, and Bailey. Pet. 66–89. Here, Petitioner relies primarily on Kennedy for “the bulk of the claim elements recited in the ’800 patent, including a software system for locating a customer’s roof at a specific geographic location and analyzing roof dimensions.” *Id.* at 66. As with its other grounds, Petitioner relies on Abhyanker for teaching “designat[ing] the geographic position of a roof to be analyzed using a marker,” and “includ[ing] a subsequent user confirmation option to ensure the correct roof is being analyzed.” *Id.* at 66–67. Petitioner explains that one skilled in the art would have been motivated to modify Kennedy’s teachings with Abhyanker’s to promote the system’s

accuracy. *Id.* at 67. Petitioner adds Bailey for teaching generating a report based on roof attributes, and explains that a skilled artisan would have been motivated to include Bailey's report to facilitate roof repairs. *Id.* at 69–70.

Other than as outlined above, Patent Owner does not additionally challenge Petitioner's second and third obviousness grounds. We have reviewed Petitioner's arguments and the underlying evidence cited in support and are persuaded that, at this stage, Petitioner sufficiently demonstrates a reasonable likelihood of succeeding in both its obviousness challenge to claims 9 and 14 based on Pershing-789, Abhyanker, and Pictometry, and in its challenge to claims 1–17 based on Kennedy, Abhyanker, and Bailey.

III. CONCLUSION

After considering the evidence and arguments presented in the current record, we determine that Petitioner has demonstrated a reasonable likelihood of success in proving that at least one of the challenged claims of the '800 patent is unpatentable. We therefore institute trial on all challenged claims and grounds raised in the Petition. At this stage of the proceeding, we have not made a final determination as to the patentability of any challenged claim or as to the construction of any claim term. Any final determination will be based on the record developed during trial. We place Patent Owner on express notice that any argument not asserted in a timely-filed Response to the Petition, or in another manner permitted during trial, shall be deemed waived, even if that argument was presented in the Preliminary Response.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–17 of the '800 patent is instituted with respect to all grounds set forth in the Petition; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the '800 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

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