

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

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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I. INTRODUCTION

The primary dispute between the parties centers on a single prior-art reference—Abhyanker.¹ Petitioner says that this reference teaches all aspects of claim elements 1f, 11f, and 17d; Patent Owner disagrees. The resolution of this dispute, and the full scope of Abhyanker’s teachings, is a question of fact determined from the perspective of a person of ordinary skill in the art (POSITA).

Petitioner lacks evidence to carry its burden of showing that Abhyanker teaches elements 1f, 11f, and 17d because, among other things, the Petition (i) failed to properly resolve the level of ordinary skill in the art and (ii) relied on testimony from an alleged expert who had neither the formal education nor the computer-related experience to qualify as a POSITA. These flaws are highlighted in the Patent Owner Response, where Patent Owner also explains how Abhyanker fails to satisfy the temporal requirement of elements 1f, 11f, and the functional requirement of elements 1f, 11f, 17d.

In response, Petitioner simply changed theories. The Petition originally mapped Abhyanker’s “additional verifications” to the claimed “second computer input” of elements 1f and 11f. But now Petitioner says that it is relying on Abhyanker’s “marker locking” feature as allegedly satisfying the claimed “second

¹ EX1005 – U.S. Publication No. 2007/0220174 A1 to Abhyanker.

computer input.” This new theory is untimely, improper, and should not be considered. But even if it is, Abhyanker’s “marker locking” feature does not satisfy either the temporal requirement of elements 1f and 11f or the functional requirement of elements 1f, 11f, and 17d. And the testimony from Mr. Cummings (Petitioner’s expert) on these issues should be given no weight because (i) he is not a POSITA and (ii) his opinions are conclusory.

At bottom, Petitioner fails to meet its burden of showing that the claims are obvious. The Board should therefore issue a Final Written Decision holding that the claims of the ’800 patent are *not* unpatentable.

II. PETITIONER FAILS TO DEMONSTRATE THAT ABHYANKER RENDERS OBVIOUS ELEMENTS 1F, 11F, AND 17D.

All grounds in the Petition rely on a single reference—Abhyanker—as allegedly teaching claim elements 1f, 11f, and 17d. The POR shows how Abhyanker fails to teach these claim elements. Petitioner’s responsive arguments fail for four reasons: (A) Petitioner’s new theory set forth in its Petitioner Reply is untimely and should be disregarded; (B) Abhyanker’s “marker locking” feature does not satisfy the temporal requirement of elements 1f and 11f; (C) Abhyanker’s “marker locking” feature also does not satisfy the functional requirement of elements 1f, 11f, and 17d; and (D) Petitioner’s failure to properly resolve the level of skill in the art undermines its invalidity arguments.

A. The Board should not consider Petitioner’s new and untimely invalidity theory.

Petitioner abandoned the invalidity theory it originally presented in the Petition for claim elements 1f, 11f, and 17d, and improperly presents a new theory for those elements for the first time in its Reply. This is improper. *See Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016) (“[T]he expedited nature of IPRs bring with it an obligation for petitioners to make their case in their petition to institute.”). Accordingly, Petitioner’s new invalidity theory should be disregarded.

The Petition’s original invalidity arguments for elements 1f, 11f, and 17d are brief and conclusory, but those arguments unambiguously map Abhyanker’s “additional verifications” to the claimed “second computer input.” Pet., 34-35, 53, 55-56. In fact, this mapping is repeated three times. Pet., 34-35. For example, the Petition states, “Abhyanker’s additional verifications are the claimed ‘second computer input capable of signaling user-acceptance of the building roof structure location within the first image.’” Pet., 34. And the Petition argued that Abhyanker’s “marker locking” feature is an example of the “additional verifications.” Pet., 34.

Petitioner’s reliance on Abhyanker’s “additional verifications” was crucial to the invalidity theory it advanced in the Petition. Petitioner mapped Abhyanker’s drag-and-drop feature to the claimed “first computer input” of elements 1d and

11d. And because Abhyanker’s “additional verifications” follow Abhyanker’s drag-and-drop, Petitioner needed to map Abhyanker’s “additional verifications” to the claimed “second computer input” to try to satisfy the temporal requirement of elements 1f and 11f. And to try to satisfy both temporal and functional requirements of elements 1f and 11f, Petitioner attempted to (and needed to) link Abhyanker’s “additional verifications” to Abhyanker’s “marker locking” feature.

But Petitioner has changed course in the Reply. It now argues that it is *not* relying on Abhyanker’s “additional verifications” for the claimed “second computer input.” Reply, 1 (“Most of PO’s arguments are directed to Abhyanker’s ‘additional verifications’—*which Petitioner does not even contend discloses the limitation.*”) (emphasis added). Instead, Petitioner now asserts a new theory that relies solely on Abhyanker’s “marker locking” feature for the disclosure of limitations 1f, 11f, and 17d. Reply, 13. And Petitioner argues that it is immaterial whether Abhyanker’s “marker locking” feature is an example of an “additional verification.” Reply, 13-15.

Petitioner’s new invalidity theory for elements 1f, 11f, and 17d is improper. *See Intelligent Bio-Sys.*, 821 F.3d at 1369. Elements 1f and 11f have a temporal requirement—the second computer input is provided *in response to* the designation of the building roof structure location. *See, e.g.*, EX1001, claim 1f (“*responsive to receiving* the designation of the building roof structure location, *providing a*

second computer input”) (emphasis added). Petitioner and Mr. Cummings originally relied on Abhyanker’s “additional verifications” to address the temporal requirement, not Abhyanker’s “marker locking” feature. Pet., 33-34; EX1003, ¶¶62-64. To the extent that Petitioner now argues that Abhyanker’s “marker locking” feature satisfies the temporal requirement, the Board should not consider this argument because it is new and untimely. It is also wrong, as explained below. Indeed, Petitioner has abandoned the only feature of Abhyanker (the “additional verification”) that could have potentially satisfied the temporal requirement of elements 1f and 11f.

B. Abhyanker’s “marker locking” feature does not satisfy the temporal requirement of elements 1f and 11f.

Claim elements 1f and 11f include a temporal requirement—the “second computer input capable of signaling user-acceptance” (in elements 1f and 11f) must be provided *in response* to the user’s designation of a roof structure location (in elements 1d and 1e). POR, 12-13. And the POR explains how Petitioner’s reliance on Abhyanker fails to satisfy this temporal requirement. POR, 24-27. In response, Petitioner does not dispute that elements 1f and 11f include a temporal requirement. Reply, 18. Nor does Petitioner dispute that it relies on only Abhyanker as allegedly teaching these elements. POR, 24-27. Instead, Petitioner argues that PO’s interpretation of Abhyanker supposedly “contradicts the teachings of the ’800 patent.” Reply, 18. But Petitioner’s reading of the ’800 patent is wrong.

Petitioner's argument centers around Figures 4A-4C of the '800 patent.

Reply, 18-22. It alleges that the '800 patent describes an embodiment in which a "confirm selection" button 104 in Figures 4A-4C is displayed on the user interface throughout the process and that the claimed "second computer input" reads on the "confirm selection" button 104. Reply, 18-22. Petitioner then likens Abhyanker's "marker locking" feature to the '800 patent's "confirm selection" button 104. Reply, 24 ("Abhyanker's 'lock pushpin' option that implements the marker locking feature mirrors the '800 patent's 'confirm selection' button.").

Petitioner is incorrect that the claimed "second computer input" reads on the '800 patent's disclosure of the "confirm selection" button 104 depicted in Figures 4A-4C. This is because, unlike the claimed "second computer input," the "confirm selection" button 104 is *not* provided in response to a first computer input (such as a drag-and-drop) that signals the user's designation of a roof structure. Rather, the specification explains that a checkbox (illustrated in Figure 4D) is provided *in response* to the "confirm selection" button 104 being activated:

[I]f confirmed selection button 104 or other such user acceptance is activated, another screen (and/or report) optionally may be provided, such as screen 100 as depicted in FIG. 4D [reproduced below]. . . . Also, a checkbox may be providing a further reconfirmation that the users reviewed the image is correct.

100

ADDRESS TO BE MEASURED:

1710 STRAND AVE.

CITY: 108

TYBEE ISLAND

STATE: 109

GA.

ZIP CODE 110

31328

NUMBER OF PLANES 111

RUSH PROCESSING 112

OPTIONAL: 113

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, 10:30-38, FIG. 4D (annotated). Thus, under the proper interpretation of the '800 patent, the claimed “second computer input” reads on the checkbox of Figure 4D—not the “confirm selection” button 104 of Figure 4C—because it is the checkbox of Figure 4D that is provided *in response* to receiving the user’s designation that the “marker has been moved to [the] final location,” EX1001, 10:25-28, in accordance with the temporal requirement of elements 1f and 11f.

Abhyanker does not teach elements 1f and 11f under the proper interpretation of the '800 patent. Under this interpretation, the claimed “second computer input” does *not* read on the '800 patent’s “confirm selection” button 104. And because Petitioner equates Abhyanker’s “marker locking” feature to the '800 patent’s “confirm selection” button 104, the claimed “second computer input” also does *not* read on Abhyanker’s “marker locking” feature.

In addition to misreading the '800 patent, Petitioner also mischaracterizes PO's arguments. Petitioner argues that "PO's interpretation of 'responsive to'" would "prohibit[] the 'user acceptance' computer input from being displayed before a marker has been moved." Reply, 21-22. But that is not PO's interpretation. After "responsive to" in elements 1f and 11f, the claim recites "*providing* a second computer input," not "*displaying* a second computer input." The term "providing" is broader than the term "displaying" and covers not only displaying, but also other forms of making a second computer input available (e.g., audible, displaying a confirm button that was previously inactive (grayed out), etc.). Thus, the phrase "responsive to" in elements 1f and 11f requires that the input for signaling user acceptance may only be *provided* after the user designates a roof structure. And, contrary to Petitioner's argument, Reply, 22-23, this interpretation of "responsive to" is consistent with PO's expert's testimony that the claims do not require *displaying* the second computer input in response to the first computer input; they instead require *providing* the second computer input in response to the first computer input.

Petitioner's other arguments with respect to Abhyanker's Figure 11 also fail. *First*, Petitioner argues that "Figure 11 of Abhyanker only reflects ***one*** embodiment, and is not an embodiment Petitioner relies on." Reply, 26 (emphasis in original). But that argument is inconsistent with Petitioner's expert's testimony.

EX2032, 79:21-80:4 (“Q. Okay. And in the marker locking request, that’s referred to in operation 1110 of Figure 11A [of Abhyanker], is the request that you referred to in paragraph 64 and 65 of your declaration, correct? . . . A. Yes.”).

Second, Petitioner baldly asserts that it “described above” how Abhyanker supposedly “teaches that markers may be relocated *before* the marker locking feature is activated, such that the marker locking is responsive to those relocations.” Reply, 27 (emphasis in original). But, of course, Petitioner does not even bother to cite any section of its Petition or portion of Abhyanker that supports this bald assertion. In contrast to Petitioner’s naked assertions, Patent Owner showed in detail how “Abhyanker’s marker-locking request in Figure 11A occurs well *before* (not after and in response to) use of drag-and-drop in Figure 11C.” POR, 25 (citing EX1005, FIGs. 11A-11C and EX2031, ¶79).

Accordingly, as set forth above and in the POR, Abhyanker’s “marker locking” feature does not satisfy the temporal requirement of elements 1f and 11f.

C. Abhyanker’s “marker locking” feature also does not satisfy the functional requirement of elements 1f, 11f, and 17d.

In addition to the temporal requirement, claim elements 1f and 11f also have a functional requirement: the “second computer input” is “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*.” EX1001, 14:20-26

(emphasis added). Claim element 17d recites a similar feature. Abhyanker does not teach this functional requirement. POR, 25-27. Instead, as explained in the POR, Abhyanker discloses a “marker locking” feature that “is used to claim the ‘wiki profile’ associated with the address at which the marker is located.” POR, 26. Petitioner’s two responsive arguments both fail.

First, Petitioner argues that Abhyanker’s “marker locking” feature is *not* for claiming a wiki profile, but instead is for enabling a user to control future relocation of the marker in the mapping environment. Reply, 15-18. This new argument by Petitioner, which goes to show a POSITA would have understood Abhyanker’s teachings regarding the “marker locking” feature, is unsupported attorney argument. And, as set forth below, Petitioner’s expert does not qualify as a POSITA so his testimony regarding how a POSITA would have interpreted Abhyanker should be disregarded. *See infra* Section IV.A.

Second, Petitioner argues that “claiming a ‘wiki profile’ is only one condition that may activate the marker locking feature” and that another condition (the one upon which Petitioner relies) is when a user seeks to lock a pushpin so as to prevent other users from moving the pushpin to another location. Reply, 16-17. That may be true, but it is irrelevant. Although locking a pushpin may prevent other users from thereafter moving the pushpin, this alleged function of Abhyanker’s “marker locking” feature is different than the functional requirement

of elements 1f, 11f, and 17d. In other words, enabling a user to control future relocation of a marker (Abhyanker's alleged function) does not teach or suggest signaling user-acceptance of a building roof structure location (the functional requirement of elements 1f, 11f, and 17d). And, critically, it is Petitioner's burden to prove that a POSITA would have understood that controlling future relocation of a marker (as disclosed in Abhyanker) is the same as signaling user-acceptance of a building roof structure location (as recited in the functional requirement of elements 1f, 11f, and 17d). Petitioner has not presented any evidence on this point; it only presents unsupported attorney argument.

Thus, as set forth above and in the POR, Abhyanker's "marker locking" feature does not satisfy the functional requirement of elements 1f, 11f, and 17d.

D. Petitioner's failure to properly resolve the level of skill in the art undermines its invalidity arguments.

Petitioner's obviousness analysis is fundamentally flawed because it fails to properly resolve the level of ordinary skill in the art. POR, Section III.B.2. Petitioner concedes that the claims of the '800 patent are generally directed to a system and process for roof measurement using an image of a roof. Pet., 2-3. More specifically, these claims, as well as the asserted primary references, are all directed to *computer-implemented* systems and technologies. See POR, 28; see also EX1004, FIG. 1; EX1005, ¶112; EX1009, FIG. 1; Pet., 11 ("Kennedy teaches a computer implemented method for generating a roof estimate."). As a result, Dr.

Bajaj explained, and the Board agreed, that a necessary qualification of any POSITA of the '800 patent is experience with computer-implemented technologies. EX2031, ¶39; DI, 7. Neither Petitioner nor its expert applied this level of skill in their obviousness analysis, further demonstrating that Petitioner fails to prove that the claims would have been obvious. POR, 27-29.

Petitioner responsive arguments lack merit. *First*, Petitioner argues, “the Board effectively recognized that the alternate level of skill in the art it adopted did not undermine Mr. Cummings’[s] opinions and was not otherwise fatal to the Grounds presented in the Petition.” Reply, 11. But “the Board is not bound by any findings made in its Institution Decision.” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1068 (Fed. Cir. 2016). And the fully developed record is significantly different than the preliminary record that the Board reviewed in its Institution Decision. Before institution, for example, the Board did not have the benefit of Dr. Bajaj’s testimony regarding the appropriate level of skill in the art and the teachings (or lack thereof) of the references. Nor did Patent Owner have the opportunity to cross-examine Mr. Cummings which, as set forth above and in the POR, ultimately revealed significant, fatal deficiencies in Petitioner’s obviousness challenge.

Second, Petitioner also argues: (i) that Patent Owner does not explain how or why a different level of skill alone would result in a different conclusion; and (ii)

that Mr. Cummings confirmed all of his opinions remain the same under the level of skill adopted by the Board in the Institution Decision. Reply, 10-11. Those arguments miss the point. One of the primary disputes between the parties is the full extent of what Abhyanker teaches: Petitioner says that Abhyanker teaches elements 1f, 11f, and 17d; Patent Owner says Abhyanker does not. The resolution of this dispute is a question of fact that is determined from the perspective of a person of ordinary skill in the art. Petitioner's failure to properly resolve the level of ordinary skill in the art undermines its arguments about what Abhyanker teaches, thereby undermining all of Petitioner's obviousness arguments. And because Mr. Cummings is not a POSITA of the '800 patent, all of his opinions about what Abhyanker teaches should be disregarded. *See infra* Section IV.A.

Thus, Petitioner's arguments and Mr. Cummings's opinions are undermined by their failure to properly resolve the level of ordinary skill in the art, further demonstrating that Petitioner fails to prove that the claims are obvious.

III. DEPENDENT CLAIMS 2, 9, 14 ARE NON-OBVIOUS.

Claims 2, 9, and 14 each relate to an "outline drawing." Claim 9 recites: "providing 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." The "outline drawing" of claim 9 refers to the "*outline drawing* corresponding to the roof structure of the

building” recited in claim 2. Claim 14 recites the same feature.

The POR explains that none of the references relied on in the Petition teaches an “outline drawing,” as required by these claims. *See, e.g.*, POR, 30 (“Pershing-789’s scale marker is not an ‘outline drawing.’”), 33 (“Pictometry does not teach or suggest[] superimposing an outline drawing on a roof structure.”), 34 (“A skilled artisan thus would not have understood Kennedy’s sizing tool to be (or to enable a user to create) an outline drawing of a roof structure.”).

Petitioner has nothing but naked attorney arguments to support its assertion that a POSITA would have understood the prior art’s measuring tools to render obvious the claimed “outline drawing.” Indeed, Petitioner acknowledges that the relied-upon features from the prior art are *not* expressly disclosed as outline drawings, but instead are measuring tools. In particular, for Pershing-789, Petitioner relies on the “express disclosure” of “visual indications of distance (e.g., a scale marker).” Reply, 28 (citing Pet., 56-57). For Pictometry, Petitioner relies on “distance and annotation tools” that “can be used to ‘analyze any house [or] building.’” Reply, 28 (citing Pet., 63-64). And, for Kennedy, Petitioner relies on the disclosure of a “sizing tool” that may be superimposed on an image. Reply, 29-30 (citing Pet., 68). None of these measuring tools is expressly disclosed as an outline drawing. And Mr. Cummings’s testimony on this issue should be disregarded because, as explained in the next section, Mr. Cummings is not a

POSITA of the '800 patent.

In sum, Petitioner has failed to satisfy its burden to show that the prior art teaches the “outline drawing” required in claims 2, 9, and 14. These claims are therefore not unpatentable.

IV. THE BOARD SHOULD NOT CREDIT PETITIONER’S EXPERT.

The Board should not credit Mr. Cumming’s testimony because (A) he is not a POSITA with respect to the '800 patent and (B) his opinions are conclusory and lack evidentiary support. Either reason on its own would be sufficient to give Mr. Cummings’s testimony no weight. Combined, these two reasons compel the conclusion that Mr. Cummings’s testimony should not be credited.

A. Because Mr. Cummings is not a POSITA, the Board should not credit his testimony from the perspective of a POSITA.

It is undisputed that Mr. Cummings has no formal education in the use of computer software to analyze images. EX2032, 25:11-13. In fact, he does not have any formal education in *any* computer-related field. EX2032, 24:16-19. Petitioner nonetheless argues that, based on the standard adopted by the Board in the Institution Decision, Mr. Cummings should still be qualified as a POSITA (despite his lack of relevant formal education) because he supposedly has relevant computer-related experience. Reply, 2-7. As an initial matter, “the Board is not bound by any findings made in its Institution Decision.” *Trivascular*, 812 F.3d at 1068. And, more importantly, the fully developed record demonstrates that Mr.

Cummings's computer-related experience falls far short of what would be necessary to qualify as a POSITA.

Indeed, Mr. Cummings has absolutely no firsthand experience in any computer-related technology that is relevant to the '800 patent. To make up for this lack of firsthand experience, he claims to have collaborated with other "software developers"—plural—"to create new software in [his] field." EX1003, ¶6. But, on cross-examination, he conceded that this so-called collaboration with "software developers" consisted of work with a single programmer—Mr. Cummings's nephew. EX2032, 17:19-18:13, 20:1-9. This work began in the 2009/2010 timeframe, *id.*, 18:1-13, 23:14-20, which is at or after the critical date of the patent. And the full extent of Mr. Cummings's role in this so-called collaboration was limited to describing concepts and desired features for his nephew to put into the software. *Id.*, 18:1-13. That Mr. Cummings may have a computer-programmer nephew who developed software after the critical date of the '800 patent based on Mr. Cummings's input in no way endows Mr. Cummings with sufficient computer-related experience to qualify him as a POSITA with respect to the '800 patent.

Faced with Mr. Cummings's paucity of computer-related experience, Petitioner argues that Mr. Cummings would not need experience in source code or computer programming to qualify as a POSITA. *See* Reply, 5. That argument misses the point. The '800 patent and prior art all deal with computer-implemented

processes. Indeed, Mr. Cummings agreed that claim 1 of the '800 patent recites such a process. EX2032, 43:10-44:2. Understanding how these computer-implemented processes work is necessary for a complete understanding of the patent and applied references. *See Kyocera Senco Indus. Tools Inc. v. Int'l Trade Comm'n*, 22 F.4th 1369, 1375-77 (Fed. Cir. 2022).

Kyocera is instructive. There, a POSITA was described as having certain formal education and at least a certain minimum number of years of experience designing power nailers. *Id.* at 1375-76. *Kyocera* offered testimony from a technical expert who had “advanced degrees in engineering and extensive experience in the design and manufacture of fastener driving tools,” but “lack[ed] experience in power nailer design.” *Id.* at 1376. The ALJ excluded the expert’s testimony on doctrine of equivalents, but admitted his testimony as to literal infringement. *Id.* On appeal, the Federal Circuit held that the admission of the expert’s testimony was an abuse of discretion. *Id.* The Federal Circuit reasoned:

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. Without that skill, the witness’ opinions are neither relevant nor reliable. The opinions would not be based on any specialized knowledge, training, or experience that would be helpful to the factfinder. In fact, “admitting testimony from a person . . . with no skill in the pertinent art serves only to cause mischief and confuse the factfinder.” [*Sundance, Inc. v.*

DeMonte Fabricating Ltd., 550 F.3d 1356, 1362 (Fed. Cir. 2008)]. That testimony would “amount[] to nothing more than advocacy from the witness stand.” *Id.* at 1364-65.

Kyocera, 22 F.4th at 1376-77. Accordingly, the Federal Circuit held, “the ALJ abused his discretion by admitting [the expert’s] testimony on any issue that is analyzed through the lens of an ordinarily skilled artisan.” *Id.* at 1377-78.

Like the expert in *Kyocera* who lacked experience in power nailer design that was relevant to the patent-at-issue there, Mr. Cummings lacks any computer-related experience that is relevant to the patent-at-issue here. That Mr. Cummings knows, worked with, and is related to someone who might have relevant computer-related experience does not somehow endow Mr. Cummings with that same experience. Because Mr. Cummings’s lacks the relevant computer-related experience of a POSITA, his testimony should be given no weight.

The cases that Petitioner cites do not lead to a different result. Petitioner cites *Avail Medsystems, Inc. v. Teladoc Health, Inc.*, IPR2022-00444, DI (Paper 10) (PTAB July 21, 2022) and *Varian Med. Sys., Inc. v. Best Med. Int’l, Inc.*, IPR2020-00072, FWD (Paper 71) (PTAB Apr. 23, 2021) for the proposition that, even if Mr. Cummings is not a POSITA, the Board may still consider his testimony on issues for which he is qualified. Reply, 6-7. But neither of Petitioner’s cases stand for that broad proposition. In *Avail*, the Board determined that it could not “give any weight to [the expert’s] opinions regarding what a skilled artisan would

have understood and/or derived from the disclosed technology because [that] is necessarily from the perspective of a skilled artisan.” *Avail*, IPR2022-00444, DI, 27. And, in *Varian*, rather than excluding the expert’s testimony, the Board “simply [did] not rely on it or g[a]ve it little or no probative weight, as appropriate, in [its] analysis.” *Varian*, IPR2020-00072, FWD, 22. The Board should do the same here.

At bottom, Mr. Cummings possesses neither the formal education nor the relevant computer-related experience to qualify as a POSITA. Thus, under Federal Circuit law, it would be improper to credit any testimony that Mr. Cummings proffers from the perspective of a POSITA. *Kyocera*, 22 F.4th at 1376-77.

B. The Board should not credit Mr. Cumming’s opinions because they are conclusory and lack evidentiary support.

Patent Owner does *not* argue that Mr. Cummings’s opinions should be given no weight simply “because his opinions are replicated in the Petition,” as Petitioner asserts. Reply, 7. Rather, Patent Owner argues that Mr. Cummings’s opinions are carbon copies of the assertions in the Petition *and* that those carbon-copy opinions (as well as the assertions in the Petition) are conclusory. POR, 37-39. It is the conclusory nature of Mr. Cummings’s opinions that entitle them to no weight. *See Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, DI (Paper 9), 15-16 (PTAB Aug. 24, 2022) (not crediting expert testimony that “merely repeats, verbatim, the conclusory assertion for which it is offered to support”).

These conclusory opinions are exemplified in Mr. Cummings's analysis of element 1f. For that element, Mr. Cummings simply repeats the same conclusory assertions found in the Petition. *Compare* EX1003, ¶¶62-66 *with* Pet., 33-35. And, as set forth above and in the Patent Owner Response, those conclusory assertions fail to explain how Abhyanker's additional verifications and locking mechanism meet element 1f. *See supra* Section II; POR, 12-27.

V. CONCLUSION

Petitioner fails to meet its burden of persuasion in this proceeding. The Board should reject the Petition and find all of the challenged claims not unpatentable.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jonathan Tuminaro/

Michael D. Specht (Reg. No. 54,463)
Jonathan Tuminaro (Reg. No. 61,327)
Richard M. Bemben (Reg. No. 68,658)
Steven M. Pappas (Reg. No. 73,904)
Jennifer Meyer Chagnon (Reg. No. 55,440)
Counsel for Patent Owner

Date: March 12, 2024

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600

CERTIFICATE OF WORD COUNT (37 C.F.R. § 42.24(d))

1. This Patent Owner's Sur-Reply complies with the type-volume limitation of 5,600 words, comprising 4,468 words, excluding the parts exempted by 37 C.F.R. § 42.24(c).
2. This Patent Owner's Sur-Reply 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 font.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jonathan Tuminaro/

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

Date: March 12, 2024

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600

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

I certify that the above-captioned **PATENT OWNER'S SUR-REPLY** was served in its entirety on March 12, 2024, upon the following parties via electronic mail:

James M. Glass (Lead Counsel) jimglass@quinnemanuel.com
Scott Baker (Back-up Counsel) scottbaker@quinnemanuel.com
Ron Hagiz (Back-up Counsel) ronhagiz@quinnemanuel.com
QUINN EMANUEL URQUHART & SULLIVAN, LLP
QE-roofr-ipr@quinnemanuel.com

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX PLLC

/Jonathan Tuminaro/

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

Date: March 12, 2024

1101 K Street, NW, 10th Floor
Washington, DC 20005
(202) 371-2600