

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROOFR INC.,
Petitioner

v.

PICTOMETRY INTERNATIONAL CORP.,
Patent Owner

IPR2023-00436
Patent 9,183,538

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

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

A. Bailey

Petitioner relies on Bailey *in all four petition Grounds* to show the “predominant pitch” limitation. Pet. at Grounds 1-4. Bailey was not before the Examiner. Bailey’s disclosure of “predominant pitch” is significant because, as Patent Owner admits, the Examiner found that “the prior art of record *fails to teach ‘predominant pitch[.]’*” POPR at 15, citing Ex. 2002 at 2448. 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, including identification of the limitation the examiner found missing in the prior art.

Patent Owner’s suggestion that Petitioner failed to analyze error under Step 2 is without merit. POPR 20-21. None of the art in the petition was considered during prosecution. Pet. at 18. Had the art (or cumulative art) been considered, the claims should have been rejected for the reasons set forth in Grounds 1-4. *See, e.g.*, Pet. at 20 (arguing that Bailey discloses the “predominant pitch” limitation the examiner believed was missing). 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).

Patent Owner makes two cumulateness arguments to support its request for discretionary denial. But these arguments support institution. First, Patent Owner argues that Bailey’s disclosure of “predominant pitch” is cumulative of an EagleView reference (an NPL not publicly available on Patent Center) which Patent Owner points out **expressly discloses** “Predominant Pitch.” POPR at 15, citing Ex. 2002 at 2515. This does not support discretionary denial. To the contrary, it shows that the very limitation the Examiner believed to be missing was, in fact, in the prior art before him. This material error identified in the POPR is yet another reason institution is warranted under *Advanced Bionics* Step 2. *Haliburton Energy Services, Inc. v. U.S. Well Services, LLC*, IPR2022-00074, Paper 9 at 15 (PTAB May 12, 2022) (finding error where a prior art reference’s teachings were overlooked).

Second, Patent Owner argues that Bailey is cumulative of an ARMA roof estimation procedure. POPR at 15-16. But while Bailey and the roof estimation procedure both disclose that “pitch” and “slope” refer to the same thing (*compare* POPR at 16, citing Ex. 2002 2470 *with* Pet. at 12-13, citing Ex. 1006 at 134), the roof estimation procedure excerpt cited by Patent Owner does not disclose “predominant pitch” as Bailey does (Pet. at 11-12, citing Ex. 1010 at 12, 17 (disclosing “predominant slope”)). Even if it did, this would further support institution because, again, it would show another material error by the Examiner.

B. Pershing-789 and Kennedy

Pershing-789 and Kennedy are used as primary references in the petition. Patent Owner argues that discretionary denial is warranted because Pershing-789 and Kennedy were both “considered” during prosecution by the Examiner. POPR 12-13. But, even if true, this would not warrant denial because the ***combination*** of these references with new prior art, Bailey, presents ***new*** arguments not previously before the Office, including a disclosure of “predominant pitch.” Thus, none of the *BD* factors apply here for the same reasons discussed in Section A above.

In any case, Pershing-789 and Kennedy were ***not*** considered. They were not discussed nor were they the basis for a rejection. Kennedy was

merely cited in an IDS (POPR at 13), and a prior publication of Pershing-789 was cited by the Examiner in the Notice of Allowance (POPR at 12). This is insufficient. *CrowdStrike, Inc. v. Webroot Inc.*, IPR2023-00126, Paper 9 at 14 (PTAB May 5, 2023) (declining to exercise discretion under § 325(d): “[W]e cannot determine the extent to which [the prior art] 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) (declining to exercise discretion under § 325(d): “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[.]”); *Tesla, Inc. v. Arsus, LLC*, IPR2022-01216, Paper 9 at 7-8 (PTAB December 23, 2022) (“even though Dechamp was cited, ***Dechamp was not applied in any rejection***...the same or substantially the same art and arguments were not previously presented to the Office”); *Maplebear Inc. d/b/a Instacart v. Consumeron, LLC*, IPR2022-1358, Paper 9 at 9 (PTAB March 3, 2023) (declining to deny institution where prior art reference was merely cited in an IDS).

Patent Owner’s cited case law does not suggest the contrary. 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—arguments

that were eventually overcome by applicant. *Ivantis, Inc. et al. v. Sight Sciences, Inc.*, IPR2022-01529, paper 16 at 15 (PTAB March 21, 2023). Pershing-789 and Kennedy were not previously analyzed here. Likewise, in *Boragen* the PTAB denied institution where the exact combination of primary references relied upon in the petition was previously “asserted by the Examiner in **five separate office actions** before being overcome by the applicant.” *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)—*Boragen* does not stand for the proposition that discretionary denial is warranted where, as here, only half of the prior art in a petition was merely cited by the Examiner (but not discussed). Further, even if these references are considered evaluated, the Examiner still erred for the same reasons discussed in Section A.

C. Abhyanker

Patent Owner argues that Abhyanker warrants denial because it is cumulative of a reference, Thornberry-693. POPR at 16-17. But the petition cites Abhyanker to show elements that the Examiner **agreed** were known. POPR at 16. The petition combines Abhyanker with **new** art and presents **new** arguments, and, thus, does not implicate § 325(d). See Sections A-B.

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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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