

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 IPR2023-00436
U.S. Patent No. 9,183,538

**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
P.O. Box 1450
Alexandria, VA 22313-1450

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PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit	Description
2001	<i>Intentionally Left Blank</i>
2002	Certified Prosecution History of U.S. Patent No. 9,183,538
2003	<i>Intentionally Left Blank</i>
2004	<i>Intentionally Left Blank</i>
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2011	<i>Intentionally Left Blank</i>
2012	<i>Intentionally Left Blank</i>
2013	<i>Intentionally Left Blank</i>
2014	Microsoft Word Comparison Petition to Cummings Declaration
2015	U.S. Application Publication 2010/0179787 to Pershing et al.
2016	U.S. Patent No. 8,145,578 to Pershing et al.
2017	Microsoft Word Comparison Pershing-789 to Pershing-787
2018	U.S. Application Publication 2010/0296693 to Thornberry et al.
2019	U.S. Application Publication 2013/0155109 to Schultz et al.
2020	Excerpt from Merriam-Webster's Collegiate Dictionary, Eleventh Edition, 2008 (definition of predominant)
2021	<i>Intentionally Left Blank</i>
2022	<i>Intentionally Left Blank</i>
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Exhibit	Description
2026	<i>Intentionally Left Blank</i>
2027	<i>Intentionally Left Blank</i>
2028	<i>Intentionally Left Blank</i>
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 request reply to the POPRs in IPR2023-004345, -00436, and -00437

I. INTRODUCTION

The Petition relies on the same or substantially the same prior art already considered by the Examiner during prosecution of the '538 patent. POPR, 11-20. Both primary references, Kennedy and a republication of Pershing-789 (with identical specification and drawings), were considered by the Examiner during prosecution. *Id.*, 12-13. And teachings substantially similar to secondary references Bailey and Abhyanker also were considered. *Id.*, 13-20.

In its Reply, Petitioner doubles down on the argument that § 325(d) does not apply because “[n]one of the art in the petition was considered during prosecution.” Reply, 1. This misses the point. The precedential *Advanced Bionics* decision clearly instructs that, under Part 1, “[p]reviously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS).” *Advanced Bionics v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 7-8 (P.T.A.B. Feb. 13, 2020) (precedential). Part 1 of *Advanced Bionics* is clearly met, and the burden is on Petitioner to demonstrate material error. *Id.*, 8-9. Petitioner certainly did not do so in the Petition, *see* Pet., 18; POPR, 10-11, and the assertion in the Reply that “[h]ad the art ... been considered, the claims should have been rejected for the reasons set forth in Grounds 1-4,” is insufficient to show material error. Reply, 1; *see Advanced Bionics*, 8-9 n.9 (listing examples of material error).

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 both § 325(d) and the *Advanced Bionics* 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. As previously highlighted to the Board, Petitioner thus should have addressed the prior art cited during prosecution of the ’538 patent. EX2030. It did not and should not have been given an opportunity 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) (Director Vidal vacating and remanding a § 325(d) denial, in order to allow Petitioner to submit a reply where “it was not reasonably foreseeable for Petitioner to anticipate a § 325(d) argument with respect to the asserted [] reference”).

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

A. Bailey

Petitioner argues that it was error under Part 2 of *Advanced Bionics* not to reject the claims based on Bailey’s alleged disclosure of “predominant pitch,” the

limitation the Examiner determined was missing from the prior art. Reply, 1-2 (citing *Scientific Design Co. v. Shell Oil Co.*, IPR2022-00158, Paper 7, 23, 25-26 (P.T.A.B. Apr. 4, 2022)). But in *Scientific Design*, the Board determined that error was shown, not simply because the asserted art “was not substantively evaluated during examination,” but “[b]ased on the strength of Petitioner’s challenges.” IPR2022-00158, Paper 7 at 25-26. Here, as explained in the POPR, Petitioner’s challenges are not strong, at least because the Petition “fails to demonstrate that Bailey (the only reference it relies on for this feature) teaches a ‘predominant pitch’ under Petitioner’s own interpretation.” POPR, 30; *see id.*, 28-34.

EagleView Guide¹—cited by the Examiner in the same Office Action where he determined the art did not disclose the claimed “predominant pitch”—like Bailey, includes a singular reference to “predominant pitch.” *See* POPR, 14-15 (citing EX2002, 2448, 2451, 2506-2534). Petitioner contends that EagleView Guide’s “express[] disclos[ure],” Reply, 2, of “predominant pitch” supports a finding of material error by the Examiner. *Id.* But the opposite is true. By determining the “predominant pitch” limitation was missing from the prior art, the Examiner indicated that he did not consider a simple recitation of the words

¹ Petitioner notes that EagleView Guide is “an NPL not publicly available on Patent Center.” Reply 2. This is irrelevant. The Examiner considered it and anyone requesting a certified copy of the file history would have access to the same.

“predominant pitch,” without more, to be sufficient to meet the claim limitation under his interpretation thereof. *See* POPR, 29-30; EX2002, 2448. And Petitioner adopted the Examiner’s interpretation. Pet., 1, 5. Bailey adds nothing new to EagleView Guide’s teachings.

B. Pershing-789 and Kennedy

Petitioner first argues that the combination of Pershing-789 and Kennedy with “new prior art, Bailey, presents new arguments not previously before the Office.” Reply, 3. But, as discussed, the relevant teachings of Bailey are not new.

Petitioner also argues that Pershing-789 and Kennedy “were not considered” because “[t]hey were not discussed nor were they the basis for a rejection.” *Id.* But the cases cited by Petitioner do not support its assertion that it “is insufficient” to have been considered by the Office that a reference “was merely cited in an IDS” or “by the Examiner.” *See* Reply, 3-4.

In *CrowdStrike, Inc. v. Webroot Inc.*, the Board said “[i]t is not clear there is enough ... to move to [Part 2],” but in any event found a sufficient showing of error under Part 2 to avoid § 325(d). IPR2023-00126, Paper 9, 14 (P.T.A.B. May 5, 2023). Notably, the Board did *not* decline to exercise discretion simply because the reference was not used in a rejection, as Petitioner implies. Reply, 4.

In *Scientific Design*, the Board declined to apply § 325(d) “[b]ased on the strength of Petitioner’s challenges,” rather than solely on a lack of substantive

evaluation of the art during prosecution. IPR2022-00158, Paper 7 at 25-26. The challenge here is not strong. *See* POPR, 22-34. In *Tesla, Inc. v. Arsus, LLC*, there were *additional* references asserted in that petition that were not cited during prosecution. IPR2022-01216, Paper 9, 7-8 (P.T.A.B. Dec. 23, 2022). That is not the case here. In *Maplebear Inc. v. Consumeron, LLC*, the primary references cited in the petition were not previously considered. IPR2022-01358, Paper 9, 9 (P.T.A.B. Mar. 3, 2023). The art Petitioner refers to in its parenthetical in the Reply is just one secondary reference used in *Maplebear* petition. *Id.* at 6, 9.

C. Abhyanker

Petitioner admits that “the petition cites Abhyanker to show elements that the Examiner agreed were known.” Reply, 5. Abhyanker adds nothing new.

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.* Petitioner has not shown any material error in the Examiner’s patentability conclusions over the same or substantially the same prior art that is relied on in the Petition. The Board should defer to the Examiner’s conclusions and deny institution.

Respectfully submitted,

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Date: June 13, 2023

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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
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