

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 9,183,538

**PATENT OWNER'S OBJECTIONS TO PETITIONER'S EVIDENCE
PURSUANT TO 37 C.F.R. § 42.64(b)(1)**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to 37 C.F.R. § 42.64(b)(1), Patent Owner Pictometry International Corporation (“Pictometry” or “Patent Owner”) objects under the Federal Rules of Evidence (“F.R.E.”) to the admissibility of Exhibits 1003, 1008, and 1011–1013, which Petitioner Roofr Inc. (“Roofr” or “Petitioner”) filed with its Petition.

Patent Owner timely objects under 37 C.F.R. § 42.64(b)(1) within the allowed ten business days of the institution of trial.

I. EXHIBITS 1008 AND 1013

Patent Owner objects to Exhibits 1008 and 1013 under F.R.E. 401–403 for including information that is irrelevant or whose probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence.

Patent Owner also objects to these exhibits as impermissible hearsay under F.R.E. 801 and 802 to the extent these exhibits are offered for the truth of the matters asserted. Petitioner has not identified any applicable exception or exclusion to the rule against hearsay that applies to these exhibits.

Patent Owner further objects to exhibit 1013 under F.R.E. 901 because Petitioner has not presented evidence sufficient to support a finding that the documents in question are what Petitioner claims them to be. There is no evidence that the documents are self-authenticating under F.R.E. 902.

II. EXHIBIT 1011

Patent Owner objects to Exhibit 1011 under F.R.E. 401–403 because this exhibit is not cited in any paper submitted in this proceeding. This exhibit is thus irrelevant, and the probative value to any ground upon which trial was instituted is substantially outweighed by the danger of unfair prejudice, confusing the issues, undue delay, wasting time, or needlessly presenting cumulative evidence.

Patent Owner further objects to this exhibit under F.R.E. 901 because Petitioner has not presented evidence sufficient to support a finding that the document in question is what Petitioner claims it to be. There is no evidence that the document is self-authenticating under F.R.E. 902.

III. EXHIBIT 1012

Patent Owner objects to Exhibit 1012 under F.R.E. 602 for lack of personal knowledge to the extent Dr. Hall-Ellis testifies on topics to which she does not have personal knowledge.

Patent Owner also objects to this exhibit under F.R.E. 702 and 703 because there has not been an adequate showing that Dr. Hall-Ellis's testimony is based on sufficient facts or data, is the product of reliable principles or methods, or that the testimony will help the Board understand the evidence or determine a fact in issue.

IV. EXHIBIT 1003

Patent Owner objects to Exhibit 1003 to the extent Patent Owner relies on Exhibits 1008, 1011, and 1013 for the same reasons as provided above, and/or

because Exhibits 1008, 1011, and 1013 are not qualified to be the basis for an expert opinion under FRE 703. Therefore, these portions of Exhibit 1003 are inadmissible under FRE 702 and FRE 703.

Patent Owner also objects to Exhibit 1003 under FRE 702 and 703 because Mr. Cummings is not qualified as an expert by knowledge, skill, experience, training, or education in the subject matter of the '538 patent, does not have ordinary skill in the art of the '538 patent, and there has not been an adequate showing that Mr. Cummings's testimony is based on sufficient facts or data, is the product of reliable principles or methods, or that the testimony will help the Board understand the evidence or determine a fact in issue.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jonathan Tuminaro/

Jonathan Tuminaro (Reg. No. 61,327)
Counsel for Patent Owner

Date: August 4, 2023

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CERTIFICATION OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing **PATENT OWNER'S OBJECTIONS TO PETITIONER'S EVIDENCE PURSUANT TO 37 C.F.R. § 42.64(b)(1)** was served electronically via e-mail on August 4, 2023, in its entirety on the following:

James M. Glass (Lead Counsel)
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Respectfully Submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jonathan Tuminaro/

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