

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROOFR INC.,
Petitioner

v.

PICTOMETRY INTERNATIONAL CORP.,
Patent Owner

IPR2023-00437
Patent 8,170,840

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

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I. THE '840 PATENT IS NOT ENTITLED TO AN EARLIER PRIORITY DATE

Patent Owner's reliance on a Court order from the *Xactware* litigation—which did not involve Petitioner—and the deposition testimony of two of Patent Owner's witnesses from that case to support an early priority claim should be rejected. POPR at 39-40. First, the *Xactware* Order only addressed claim 10—it did not address any other challenged claim and, thus, does not warrant denial. POR at 39. Second, the Order is not a “final” judgment—the case settled during appeal before any CAFC decision. Ex. 1013. Thus, it is not binding on Petitioner (not a party to *Xactware*) or the PTAB. Third, the *Xactware* Court did not “confir[m]” that claim 10 is entitled to an earlier priority date (POPR at 39)—the jury's verdict did not address priority at all (Ex. 2003 at 5), and the Court merely found that a new trial was not warranted because there was not “overwhelming” evidence against the jury's decision supporting validity, which was based on a variety of arguments, not just priority (Ex. 2005 at 30, n. 11). This is not a binding judgment regarding the priority of claim 10 (much less all the challenged claims). Finally, **none** of the evidence in the *Xactware* case has been tested by Petitioner or vetted by the PTAB—Patent Owner cites no case law suggesting that institution should be denied under such circumstances. Accordingly, Patent Owner's arguments should be rejected.

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

A. Pictometry

The petition relies on Pictometry in Grounds 2 and 4—not before the Examiner—to disclose a “pitch determination marker.” The Examiner issued the claims based on his belief that the prior art failed to disclose this limitation. 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 argues that Pictometry is cumulative of three prior art references “considered” in prosecution: (1) a **Field Guide** (EX2002 at 0858-72), (2) a **Press Release** (EX2002 at 856-57) and (3) **Website Screenshots** (EX2002 at 0845-55, 0873-78). POPR at 28-30. First, these allegedly cumulative references were not “considered,” they were merely cited in an IDS, which is insufficient under § 325(d). *CrowdStrike, Inc. v. Webroot Inc.*, IPR2023-00126, Paper 9 at 14 (PTAB May 5, 2023) (“[W]e cannot determine the extent to which Morris 340 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) (“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[.]”)).

Patent Owner’s cases are inapposite. 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. *Ivantis, Inc. et al. v. Sight Sciences, Inc.*, IPR2022-01529, paper 16 at 15 (March 21, 2023). Here, the allegedly cumulative art was not used in a rejection. In *Boragen* the PTAB denied institution where the exact combination of primary references relied upon in the petition was used to reject the claims five times. *Boragen, Inc. v. Syngenta Participations AG*, IPR2020-00124, Paper 16 at 15 (May 5, 2020). *Boragen’s* brief mention of an IDS focused on an ancillary, secondary prior art reference used in only one ground. *Id.* at 21-22. Neither case supports denial.

Second, Pictometry is not cumulative. Pictometry discloses the missing “pitch determination marker”: it teaches an angle measurement tool (Pet. at 16) that “is able to capture **every feature** in its entirety” and can be used to analyze “**any house [or] building**” based on oblique aerial imaging (Pet. at 56, citing 1008 at 114). Pictometry includes motivations to combine with roof

estimation art, disclosing an “**indispensable**” tool that can determine “**exac[t]**” measurements. Pet. at 56, citing Ex. 1008 at 115-16.

Patent Owner fails to identify cumulative disclosures. The **Field Guide** is not cumulative because it includes only statements that its tools can be used to measure angles—it says nothing about roof estimation. Ex. 2002 at 869-70. The **Wayback Machine Screenshots** teach that their tools should **not** be used for surveying buildings precisely because they are **imprecise**. Ex. 2002 at 846-47, 873-74 (same). This is the opposite of Pictometry’s teachings. Finally, the **Press Release** is not cumulative because it does not disclose measuring angles at all (Ex. 2002 at 856-57), noting it should be used for preliminary measurement “before sending out surveyors and inspection crews[.]” Ex. 2002 at 856.

Even if the Examiner had considered Pictometry (or cumulative references), then he erred by allowing the claims over a disclosure of a “pitch determination marker” under *Advanced Bionics* Step 2. Contrary to Patent Owner’s suggestion (POPR at 33), the petition does address Step 2 arguing that Pictometry was not considered and it discloses the allegedly missing limitation—this is a material error. Pet. at 17-19; *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); *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).

B. Kennedy

The Petition relies on Kennedy to show the “pitch determination marker” in Grounds 1 and 3. Kennedy was noted as pertinent art and listed in an IDS, but not discussed. POPR at 26. This is insufficient to show that Kennedy was considered under § 325(d). *See* Section A. In any case, to the extent the Examiner did consider Kennedy he erred by issuing the claims, because it discloses a “pitch determination marker.” Pet. at 18, n. 1.

C. Pershing-789 And Bailey

Patent Owner’s arguments concerning Pershing-789 and Bailey are a red herring. Petitioner relies on these references to show limitations the Examiner **agreed** were disclosed in the prior art. These references are used in combination with the **new** art and **new** arguments discussed above in Sections A and B. Thus, these references do not implicate § 325(d) either.

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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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