

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ROOFR, INC.,
Petitioner

v.

EAGLE VIEW TECHNOLOGIES, INC.,
Patent Owner

Case IPR2023-00437
U.S. Patent No. 8,170,840

**PATENT OWNER’S SUR-REPLY TO PETITIONER’S REPLY TO PA-
TENT OWNER’S PRELIMINARY RESPONSE**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
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PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit	Description
2001	U.S. Provisional Application No. 61/197,904
2002	Certified Prosecution History of U.S. Patent No. 8,170,840
2003	DNJ-1-15-cv-07025-796 Verdict Form
2004	DNJ-1-15-cv-07025-799 Judgment
2005	DNJ-1-15-cv-07025-863 Order Denying Mot for New Trial
2006	DNJ-1-15-cv-07025-804 Inventor (Pershing) trial testimony
2007	DNJ-1-15-cv-07025-808 Expert (Stevenson) trial testimony
2008	DDE-1-21-cv-01852-1 Original Complaint (Roofr)
2009	DDE-1-21-cv-01852-12 Amended Complaint (Roofr)
2010	April 5, 2018 Memorandum
2011	Assignment Record for Pershing-789
2012	Assignment Record for '840 patent
2013	U.S. Patent No. 8,417,061 B2 to Kennedy
2014	Microsoft Word Comparison Petition to Cummings Declaration
2015	<i>Intentionally Left Blank</i>
2016	<i>Intentionally Left Blank</i>
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Exhibit	Description
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 requested reply to the POPRs in IPR2023-00435, -00436, and -00437

Petitioner failed to properly address the prosecution and litigation histories of the '840 patent in its Petition, and now futilely seeks to rehabilitate the Petitioner's cursory and fatally flawed arguments on two issues: (1) Kennedy's status as prior art in light of the Xactware Litigation, and (2) discretionary denial under § 325(d) in light of art considered by the Examiner in the certified prosecution history (which Petitioner did not submit). In its Reply, Petitioner makes no attempt to justify its failure in its Petition to apprise the Board of the key holdings from the Xactware Litigation (despite having notice) or to review and provide the certified prosecution history of the '840 patent that includes key art.

Moreover, Petitioner's reply fails to demonstrate that Kennedy is prior art and refute that discretion under § 325(d) strongly favors denial. For these independent reasons and others cited in the POPR, the Board should deny institution.

I. 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 Kennedy's status as prior art and the § 325(d) issues were supposedly "not foreseeable." EX2029. But Petitioner does not dispute that it had notice of the Xactware Order before filing the Petition. And the clear directive under both

§ 325(d) and *Advanced Bionics*¹ asks whether the same or substantially the same art was previously presented to the Office. 35 U.S.C. § 325(d); *Advanced Bionics*, Paper 6, 8. Petitioner thus should have addressed *in the Petition* the relevant holdings from the Xactware Litigation and the art in the certified prosecution history. EX2030, 1. It did not and should not have been allowed to try to cure foreseeable flaws in the Petition *after the one-year statutory-bar date*. Cf. *Google LLC v. Val-trus Innovs. Ltd.*, IPR2022-01197, Paper 12, 5 (P.T.A.B. Mar. 29, 2023).

II. PATENT OWNER PREVIOUSLY ANTEDATED KENNEDY.

Petitioner does not deny that, before it filed its Petition, it knew of the post-trial Order in the Xactware Litigation, ruling that the trial evidence fully supported a jury finding that the Kennedy patent² is not prior art to claim 10. POPR, 20-22, 39-47. Nor does Petitioner deny that “independent claims 1 and 16 ... include the same or similar elements as claim 10,” and thus the court’s ruling in the Xactware Litigation should apply to all of the independent claims. POPR, 41 n.8. In its Reply, Petitioner makes no attempt to justify its failure to apprise the Board of this critical ruling during the Xactware Litigation that is directly at odds with Petitioner’s position that Kennedy qualifies as prior art.

¹ *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020) (precedential).

² Kennedy (EX1009) is the pre-grant publication of the Kennedy patent.

Instead, Petitioner's Reply advances four arguments that fail to grapple with the POPR's arguments and generally miss the point. Petitioner first argues that denial is not warranted because "the *Xactware* order only address[es] claim 10." Reply, 1. But, again, Petitioner does not dispute that the independent claims recite the same or similar elements, POPR, 41 n.8, or even attempt to identify any material differences between these claims. Nor could it because the Petition routinely refers to claim 1 to address claims 10 and 16, *id.* (citing Pet., 48-51, 73-76), showing that Petitioner agrees that these claims recite the same or similar elements.

Petitioner's next two arguments contend that the Xactware Order is not binding on Petitioner or the PTAB. Reply, 1. But that misses the point because Patent Owner never argued that it is binding. Rather, Patent Owner argued that in failing to confront the trial evidence and post-trial Order regarding Kennedy, Petitioner failed to meet the standard for institution under *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 (P.T.A.B. Dec. 20, 2019), which requires far more than typical notice pleading. POPR, 34, 39-47. Petitioner does not even mention this standard, let alone explain how the *Petition* satisfied it.

Finally, Petitioner's fourth argument—that "**none** of the evidence in the *Xactware* case has been tested by Petitioner or vetted by the PTAB," Reply, 1—runs headlong into the policy underlying the Board's discretion to deny institution, POPR, 46-47 (arguing that "discretionary considerations ... favor denying institu-

tion”). Board policies disfavoring expending resources to re-litigate issues and seeking to promote consistency with district court decisions strongly support denying institution, *id.*, and Petitioner provides no rebuttal to the contrary.

III. PETITIONER’S § 325(d) ARGUMENTS IGNORE *ADVANCED BIONICS*, ARE NOT CREDIBLE, AND ARE UNTIMELY.

In the Petition, Petitioner glossed over § 325(d), arguing that the first part of *Advanced Bionics* was not satisfied and thus the Board need not reach the second part. In its Reply, Petitioner doubles down on its argument that the first part is not satisfied and presents new arguments addressing the second part. But Petitioner is still wrong about the first part, and, to the extent the Board considers Petitioner’s new arguments, those fail to establish the requisite material error.

A. The Petition presents the same or substantially the same art.

Each of the four references asserted in the Petition are “the same or substantially the same” as those that “previously were presented to the Office” during original prosecution of the ’840 patent. 35 U.S.C. § 325(d). The Examiner applied Pershing-789 in the first Office Action and cited Kennedy as pertinent art in the same document. POPR, 1-2, 18, 26-27. Bailey is substantially the same as background teachings in the ’840 patent, Pershing-789, and Kennedy. POPR, 2, 27-28. And the Pictometry Article is substantially the same as the Pictometry NPL that the Examiner considered during prosecution, including a Pictometry Guide that describes relevant aspects in more detail than the asserted Pictometry Article. POPR,

2, 28-32. Also, the Petition's *combinations* are cumulative with the teachings that the Examiner considered, POPR, 31-32, a point Petitioner fails to rebut.

Petitioner's argument that Pershing-789 "do[es] not implicate § 325(d)," Reply, 5, is not credible and contrary to the statutory text and to *Advanced Bionics*. Petitioner's argument that Kennedy and the Pictometry NPL were not "discussed" or "considered" because the Examiner did not use them to reject claims, Reply, 2, 5, is contrary to *Advanced Bionics*'s instruction that "[p]reviously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant." *Advanced Bionics*, 7-8. Petitioner's cursory argument that Pershing-789 and Bailey are used in "new" combinations, Reply, 5, fails to address that the Petition's combinations are cumulative. *See* POPR, 31-32. And Petitioner's only argument that the Pictometry Article is not cumulative with the Pictometry Guide is that the guide "says nothing about roof estimation." Reply, 4. But neither does the Pictometry Article. The first part of *Advanced Bionics* is plainly satisfied.

B. Petitioner's new arguments fail to show material error.

Petitioner now argues that the Examiner committed material error in allowing the claims over Kennedy and the Pictometry NPL. Reply, 4-5. But mere disagreement "regarding the purported treatment of the art or arguments" fails to establish material error. *Advanced Bionics*, 9. Regardless, neither Kennedy nor Pictometry teaches a "pitch determination marker," as Petitioner alleges. POPR, 49-56.

Respectfully submitted,

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

A handwritten signature in black ink, reading "Richard M. Bemben". The signature is written in a cursive style with a large, stylized "R" at the beginning.

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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 13, 2023 upon the following parties via electronic mail:

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