

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

**PETITIONER'S REQUEST FOR DIRECTOR REVIEW
OF THE BOARD'S INSTITUTION DECISION**

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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.71 and the Revised Interim Director Review Process, Petitioner Roofr Inc. (“Roofr”) respectfully requests Director Review of the Board’s Institution Decision. The Board’s denial of institution was based solely on its finding that the prior art reference, Kennedy, is not prior art to the ’840 patent. As explained below, the Board’s Decision was an abuse of discretion. The Board found that all twenty-six challenged claims were entitled to an earlier priority date, despite the fact that the evidence before the Board only addressed a single claim—claim 10. Further, this evidence does not show that claim 10 is entitled to an earlier priority date.

II. PROCEDURAL BACKGROUND

Roofr filed its Petition challenging claims 1-25 and 28 of U.S. Patent No. 8,170,840 (“’840 patent”) on January 3, 2023. *See* Paper 1. The ’840 patent claims priority to an earlier provisional application dated October 31, 2008. For purposes of the Petition, Roofr did not dispute that the ’840 patent was entitled to the October 31, 2008 prior date. Paper 1 at 5.

The Petition relied on four grounds of unpatentability:

Ground	Prior Art Combination
1	Kennedy and Bailey Render Obvious Claims 1-25 and 28 of the ’840 patent
2	Kennedy, Bailey and Pictometry Render Obvious Claims 1-25 and 28 of the ’840 patent

3	Pershing-789 and Kennedy Render Obvious Claims 1-25 and 28 of the '840 patent
4	Pershing-789, Kennedy and Pictometry Render Obvious Claims 1-25 and 28 of the '840 patent

See Pet. at x. Petitioner relied on prior art reference Kennedy (U.S. Pat. Pub. No. 2009/0304227 A1) as a primary reference in Grounds 1 and 2, and as a secondary reference in Grounds 3 and 4. Kennedy was published on December 10, 2009 and claims priority to provisional applications filed on February 1, 2008 and April 22, 2008. Kennedy, thus, qualifies as prior art under the '840 patent under at least pre-AIA § 102(e).

On May 9, 2023, Patent Owner, Eagle View Technologies, Inc., filed its Preliminary Response. *See* Paper 11. Patent Owner argued that Kennedy was not prior art to the '840 patent, alleging that the '840 patent was entitled to a January 1, 2008 reduction to practice date antedating Kennedy. *Id.* at § IV.2. Patent Owner also argued that Petitioner failed to show that Kennedy was entitled to claim priority to its provisional applications. *Id.* at VI.1. Patent Owner also argued that the Board should use its discretion to deny the petition under § 325(d) and on substantive grounds. *Id.* § III, V.

On May 23, 2023, Petitioner requested leave to file additional briefing on Patent Owner's arguments related to its alleged early reduction to practice and discretionary denial arguments. Ex. 1029. The Court granted both parties

leave to file five pages of supplemental briefing on these issues. Paper 13 at 14.

On June 6, 2023, Petitioner filed its Reply to Patent Owner's Preliminary response arguing, *inter alia*, why Kennedy qualified as prior art to the '840 patent. Paper 12. On June 13, 2023, Patent Owner filed its Sur-Reply to Patent Owner's Preliminary Response. *Id.* at 13.

On August 1, 2023, the Board issued a Decision Denying Institution of the '840 petition. *Id.* at 14. The Board's Decision Denying Institution focused exclusively on Patent Owner's argument that Kennedy did not qualify as prior art based on an alleged early reduction to practice of the '840 patent. The Board specifically relied on Patent Owner's citation to its prior litigation with Xactware¹ in 2020 (to which Petitioner was not a party), finding that: "The Xactware Order and prior testimony from [inventor] Mr. Pershing and [trial expert] Prof. Stevenson...[is] probative as to the prior art status of Kennedy." Paper 14 at 13.

¹ *Eagle View Technologies, Inc. v. Xactware Solutions, Inc.*, No. 1:15-cv-07025-RMB-SAK (DNJ)

III. STANDARD OF REVIEW

“Requests for Director Review of the Board’s decision whether to institute an AIA trial ... shall be limited to decisions presenting (a) an abuse of discretion or (b) important issues of law or policy.” See Revised Interim Director Review Process. An abuse of discretion arises if the Board’s decision “is clearly unreasonable.” *Ericsson Inc. v. Intellectual Ventures I LLC*, 901 F.3d 1374, 1379 (Fed. Cir. 2018) (quotation omitted).

IV. THE BOARD ABUSED ITS DISCRETION BY RELYING ON TRIAL TESTIMONY AND THE COURT’S ORDER FROM THE XACTWARE LITIGATION

Of the *twenty-six* claims challenged in the petition, the evidence the Board considered *only* related to claim 10. The Board’s decision was an abuse of discretion and was “clearly unreasonable” because the evidence the Board relied upon does not confirm that claim 10 of the ’840 patent was actually reduced to practice before the earliest provisional application.

Patent Owner submitted no inventor notebooks, schematics, proof of sales or even a sworn declaration from an inventor to substantiate its priority claim. Instead, Patent Owner’s sole evidence in support of an earlier priority date is a Court order from the Xactware litigation—to which Petitioner was not a party—and the deposition testimony of two of Patent Owner’s witnesses from that litigation. This evidence is insufficient because the Court’s Order

made no findings regarding priority, and the testimony of Patent Owner's interested witnesses is insufficient on its own to establish an earlier priority date. *See, e.g., Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998) ("In order to establish an actual reduction to practice, an inventor's testimony must be corroborated by independent evidence.").

In particular, Patent Owner argued in its Preliminary Response that: "In the Xactware Litigation, Patent Owner established, and the court confirmed in its post-trial Order, that both requirements were satisfied to establish an ARTP of January 1, 2008, for independent claim 10 of the '840 patent (which was the only asserted claim of the '840 patent)." Paper 11 at 40-41. Patent Owner cited testimony from named inventor of the '840 patent and Patent Owner's employee, Mr. Chris Pershing, for support. *Id.* citing Ex. 2005. Patent Owner also cited its expert's testimony in that case by Professor Stevenson. *Id.* citing Ex. 2007. The Board relied on this evidence to support its finding that the challenged claims were entitled to an early priority date: "The Xactware Order and prior testimony from [inventor] Mr. Pershing and [trial expert] Prof. Stevenson...[is] probative as to the prior art status of Kennedy." Paper 14 at 13

First, as Petitioner argued in its pre-institution Reply, the Xactware Court did not "confir[m]" that claim 10 is entitled to an earlier priority date as

Patent Owner suggests. POPR at 39. Indeed, there were *no findings* made concerning claim 10's priority date. Patent Owner's evidence confirms that the Xactware jury verdict cited in the POPR did not address priority at all. Ex. 2003 at 5. Likewise, Patent Owner's citation to the district court's Order is also unavailing. The Order cited by Patent Owner is an Order by the Court denying Defendant Xactware's motion for a new trial. Ex. 2005 at 4. In that Order, the Court merely found that a new trial was not warranted because there was not "overwhelming" evidence against the jury's decision supporting validity. Ex. 2005 at 4, 28-30. The court made no affirmative evidentiary findings related to the priority of claim 10, much less "confir[m]" that claim 10 is entitled to an early priority date. Nor could it, because the jury had not made any findings as to priority in the first place.

The Court instead merely noted that Defendant's arguments disputing the early priority date were not so "overwhelming" that they "le[f]t no room for the jury to draw significant inferences in favor of EagleView." Ex. 2005 at 30. The Court's findings denying Xactware's motion were unsurprising given the Court's description of Defendant's case on the first page of the Order as an "unreal wonderland where up is down, left is right":

It is a great irony that the Defendants, Xactware Solutions, Inc., ("Xactware") and Verisk Analytics, Inc. ("Verisk") (collectively the "Defendants"), have described this litigation as a "journey through the looking glass" where the parties and this Court

“ended up deep within some unreal wonderland where up is down, left is right.” (Opposition Brief, Dkt. 874, at 6). ***It is so true. At times this Court felt like Alice.*** The Court strove to make sense of the farrago of shifting defenses, arguments transforming into new, but likewise unpersuasive ones.

Ex. 2005 at 3 (emphasis added).

Thus, the Court’s denial of Xactware request for a new trial is not a confirmation that claim 10 is entitled to an early priority date, rather it was a rebuke of the arguments advanced by Defendant in a case to which Petitioner was not a party. The Board’s findings based on this Order are, thus, “clearly unreasonable” because they tether Petitioner to the failings of a Defendant in Xactware.

Moreover, the Court’s Order did not turn on the priority issue. The Court went on to find that: “Even if [the references in question] were prior art, the Court would find that Defendants failed to meet their burden of showing that either disclosed the Asserted Claims for the reasons set forth in EagleView’s sur-reply brief.” Ex. 2005 at 30, n. 11.

Second, the Board’s decision was “clearly unreasonable” in its reliance on two of ***Patent Owner’s*** trial witnesses: Patent Owner’s employee and named inventor, Chris Pershing, and Patent Owner’s litigation expert, Professor Stevenson. Petitioner noted that this testimony was untested by Petitioner or the Board, and one of the witnesses—Mr. Pershing—was clearly

an interested party in that litigation. It is well-settled that such an interested witness's testimony on its own is insufficient. *See, e.g., Medichem, S.A. v. Rolabo, S.L.*, 437 F.3d 1157, 1170 (Fed. Cir. 2006) (“Nonetheless, such deference is often of little consequence in a corroboration inquiry because the *raison d'être* of the corroboration requirement is our refusal to base priority determinations on a court's uncorroborated assessments of a testifying inventor's credibility. Even the most credible inventor testimony is *a fortiori* required to be corroborated by independent evidence, which may consist of documentary evidence as well as the testimony of non-inventors.”).

But the Board did not address this issue noting that Petitioner would not have been entitled to depose these witnesses had they signed declarations and finding that: “We see nothing in the record to indicate that the evidence is not credible and we find it relevant that the district court noted no issues with the evidence that was presented before it at trial.” Paper 14 at 13. The problem with the Board's rationale in this regard is that Patent Owner did not submit a sworn declaration from its witness as the Board noted it could have. Had it done so, at least Petitioner could have requested an opportunity to depose Mr. Pershing and Professor Stevenson. Here, Petitioner was denied any path to do so and, thus, had no opportunity to cross-examine Mr. Pershing or Mr. Stevenson in support of its pre-institution Reply.

Further, Professor Stevenson’s testimony was based on alleged testing of EagleView’s products offered in January 2008. POPR at 41. But Patent Owner did not submit any of Mr. Stevenson’s tests for evaluation. It was not reasonable for the Board to rely on Mr. Stevenson’s characterization of his tests without requiring Patent Owner to at least produce the underlying data for review. In any case, as discussed below, the Court’s Order and litigation testimony only addressed claim 10 and did not relate to any of the other twenty-five claims challenged in the petition.

V. THE BOARD ABUSED ITS DISCRETION BY APPLYING PATENT OWNER’S EVIDENCE DIRECTED TOWARDS CLAIM 10 TO ALL OF THE CHALLENGED CLAIMS

Even if the foregoing evidence relied upon by the Board from the Xactware litigation were credible, the Board’s Decision is still “clearly unreasonable” because that litigation *only addressed claim 10* of the ’840 patent. Thus, the Court’s Order and witness testimony cannot be the basis for denying the instant petition, which challenges claims 1-25 and 28. *See, e.g., Lucent Techs., Inc. v. Gateway, Inc.*, 543 F.3d 710, 718 (Fed. Cir. 2008) (“Patent claims are awarded priority on a claim-by-claim basis[.]”)

The Board’s Decision found that: “Petitioner, however, recognizes the substantial similarity of the independent claims in this proceeding. For example, Petitioner provides a detailed discussion of how Kennedy and Bailey

are alleged to teach the limitations of independent claim 1...[for] independent claims 10 and 16, Petitioner refers back to its allegations regarding claim 1[.]” Paper 14 at 12. But the Board’s Decision inaccurately describes the Petition and the claims.

Indeed, when assessing claims 10 and 16 petitioner did not merely cross-cite to claim 1 as the Board’s Decision found. To the contrary, when addressing claim 10(f) Petitioner relies on its prior art analysis for both claims 1 and 3. Paper 1 at 49. Likewise, Petitioner relies on its analysis of claims 1, 2, 4 and 10 when addressing claim 16. Paper 1 at 50-51. This confirms the opposite of the Board’s findings—that there are unique limitations across the independent claims.

Moreover, ***similarity*** between claims does not excuse Patent Owner (or the Board) from its burden to show evidence that each challenged claim was entitled to an early priority date. That the ***prior art*** disclosures cited by Petitioner may be broad enough to cover independent claims 1, 10 and 16 has no bearing on whether Patent Owner reduced to practice all of the independent claims at the same time. There is no such evidence in the record, and the Board’s Decision includes no analysis of the other twenty-five challenged claims.

VI. THE BOARD ABUSED ITS DISCRETION BY IGNORING PETITIONER'S ARGUMENTS

The Board's Decision was also "clearly unreasonable" because it ignored Petitioner's arguments in its pre-institution Reply, finding that "Petitioner was allotted briefing to address issues raised in the Preliminary Response and chose not to address the sufficiency of evidence that it referred to as 'not relevant' without sufficiently explaining why Patent Owner's evidence lacked relevance. This leaves us to decide Petitioner's likelihood of success with evidence from Patent owner that is largely unchallenged and un rebutted." Paper 14 at 13.

To the contrary, Petitioner made the *same* challenges to Patent Owner's evidence as cited herein—though, in abbreviated form given the Board's 5-page briefing limit. *See* Paper 12 at 1. Petitioner did not merely state that Patent Owner's evidence was "not relevant" as the Board suggests. *Compare* Paper 14 at 13 *with* Paper 12 at 1.

VII. CONCLUSION

For the foregoing reasons, Petitioner requests Director Review of the Board's Institution Decision.

Date: August 31, 2023

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CERTIFICATE OF LENGTH

The undersigned hereby certifies that this document is eleven pages and thus complies with the applicable limit.

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