

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

BRYCER, LLC, BRYCER MANAGEMENT, INC.,

Petitioners

v.

TEGRIS, INC.,

Patent Owner.

Case No. IPR2023-01196
Patent No. 11,126,966

DECLARATION OF LEROY MCNULTY

TABLE OF CONTENTS

Contents

I.	INTRODUCTION	1
II.	BACKGROUND AND QUALIFICATIONS	2
III.	MATERIALS CONSIDERED	5
IV.	LEGAL UNDERSTANDING	5
IV.	LEVEL OF ORDINARY SKILL IN THE ART	8
V.	THE '966 PATENT AND THE CHALLENGED CLAIMS	10
VI.	SECONDARY CONSIDERATIONS AS INDICIA OF NONOBVIOUSNESS	12
A.	Nexus to Tegriss and Brycer Commercial Offerings	12
B.	COMMERCIAL SUCCESS	18
C.	INDUSTRY PRAISE	20
D.	I am aware of people in the fire safety industry praising Tegriss' patented system. Soon after Lynnwood used the Tegriss records management system, Richland and Marysville started using the program. Everett, Mount Vernon, Burlington, Anacortez, Kennewick and other continue to use the program today. COPYING	20
E.	UNEXPECTED RESULTS	21

I, LeRoy McNulty, declare as follows:

I. INTRODUCTION

1) I have been asked to provide my testimony on behalf of patent owner Tegriss, Inc. (“Tegriss”) in connection with *inter partes* review (“IPR”) proceedings in IPR2023-01196 Brycer LLC and Brycer Management, Inc. (“Petitioners”), involving U.S. Patent No. 11,126,966 (the “’966 Patent”), titled “Systems and Methods for a Web Based Inspection Compliance Registry and Communication Tool” by named inventors Andrew S. Moren and Robert J. Moren. I understand Tegriss owns ‘966 Patent by way of assignment. EX1001.

2) I understand Petitioners challenge Claims 8-16 of the ‘966 Patent as allegedly being unpatentable under 35 U.S.C. § 103 in view of certain alleged prior art references. Paper 9 (“Institution Decision”) at 9. Petitioners challenge Claims 8-16 on the following ground:

- a. Claims 8-16, 35 U.S.C. § 103, based on Key, Ex. 1005
(U.S. Patent Application Publication No.
2002/0029222A1, published Mar. 7, 2002), Chauhan,
Ex. 1016 (W.O. International Publication No.
2004/104891A1, published Dec. 2, 2004), Sweeney Ex.
1006 (U.S. Patent Application Publication No.

2005/0021449A1, published Jan. 27, 2005), and
McKinney Ex. 1020 (U.S. Patent Application Publication
No. 2004/0230455A1, published Nov. 18, 2004)
("Ground 1").

3) I also understand the Board instituted review of all the
Challenged Claims based on Ground 1. *Id.* at 2.

4) I am familiar with the technology at issue in the '966 Patent. I
have been asked to provide my technical review, analysis, insights, and
opinions regarding the '966 Patent and opinions related to how Tegriss'
products practice certain claims of the '966 Patents and the commercial
success of the patented products, including Brycer's service offering it calls
The Compliance Engine ("TCE").

5) In reaching my opinions, I considered the materials identified
in this Declaration based on my education, training, research, personal
knowledge, and professional experience.

6) I make this Declaration based on my own personal knowledge
and, if called upon to testify, would testify competently to the matters
contained herein.

II. BACKGROUND AND QUALIFICATIONS

7) I received a Bachelor of Science degree from the University of

Phoenix in 2005. I received an A.T.A. in Fire Investigation from Edmonds Community College in 1995. I received an A.T.A. in Fire Command Administration from Edmonds Community College in 1985.

8) I have spent more than 30 years of my 49-year career in the fire prevention industry. My longest running work experience consisted of 31 years with the City of Lynnwood, Washington where I held many positions before retiring as an Assistant Chief in 2011

9) In the last two years of my employment with the City of Lynnwood, I implemented the first "Cloud-based" fire prevention records management program in the nation. The system is operated by Tegriss Inc. in Gig Harbor, Washington. The program is designed to not only create a searchable database, it also creates relationships between service companies, business owners and the local fire department or Authority Having Jurisdiction (AHJ). The outcome creates an analytical database to help fire department administrators plan for training, prepare for cultural shifts and design models for future services within their communities. As a result of my influence in the fire service, Tegriss offered me a Client Representative position after I retired from Lynnwood.

10) In January 2015, I signed an employment contract with the City of Mukilteo to provide fire prevention services. During the next 22 months,

we built the fire prevention program from inception and used Tegrís to improve the interaction between the service industry and the city of Mukilteo. We also trained the fire crews how to conduct inspections and interact with city staff for development purposes. Before leaving, we and trained my replacement who was promoted in October 2016. I returned to this position many times as Mukilteo has continuous staff turnover.

11) My education includes a Bachelor of Science in Business Management, an ATA in Fire Command Administration and an ATA in Fire Investigation. Although I started a Master's Degree in International Marketing, I did not complete the program. I have accumulated academic credits in various fields of study from local community colleges, the University of Phoenix, Eastern Oregon University and the National Fire Academy. I have held multiple certifications within the fire service.

12) In addition, I taught at various Washington State Community Colleges in fire service academics from 1985 to 2005. I authored a pre-approved study guide for the International Codes to be used in Washington State Community Colleges. During my time with Tegrís, we published many articles for fire service periodicals praising the advent of the cloud-based maintenance and testing of fire safety equipment within the built environment across the nation.

13) I have extensive knowledge of the requirements for compliance with state and local government laws and regulations relating to fire and life safety. Exhibit 1 attached here is my curriculum vitae that I incorporate herein by reference.

III. MATERIALS CONSIDERED

14) I considered information from various sources in forming my opinions. I also reviewed the documents and references cited herein.

IV. LEGAL UNDERSTANDING

15) I relied on instructions from Tegriss' legal counsel as to the applicable legal standards to use in arriving at my opinions in this Declaration. My opinions are informed by my understanding of the relevant law.

16) I understand a person of ordinary skill in the art ("POSA") is assumed to have knowledge of all prior art references. I understand multiple prior art references or teachings can be combined to show a patent claim would have been obvious. I understand the proponent of an obviousness challenge must show a person of ordinary skill in the art would have had reason or motivation to combine the references in the way the elements are recited in the claim. This reason or motivation can come from different sources—like the prior art—but it cannot come from the

challenged patent's own disclosure. The challenger of a patent claim cannot use hindsight to assert the inventor's own work against the inventor to argue the invention would have been obvious. I further understand a combination is improper when one of ordinary skill in the art, upon reading a reference, would be discouraged from following the path set out in the reference. I understand this standard may be met when a reference criticizes, discredits, or otherwise discourages modifying the reference to arrive at the claimed invention.

17) I understand objective evidence of non-obviousness ("secondary considerations" of non-obviousness) must be considered when evaluating whether a claimed invention would have been obvious to one of ordinary skill at the time of invention. I understand these secondary considerations may include, for example: (i) a long-felt but unmet need in the prior art was satisfied by the claimed invention; (ii) commercial success of products covered by the patent; (iii) unexpected results achieved by the invention; (iv) praise of the invention by others skilled in the art; (v) the taking of licenses under the patent by others; (vi) whether others had tried and failed to make the invention; (vii) whether persons of ordinary skill in the art expressed surprise or disbelief regarding the invention; (viii) whether the inventor proceeded contrary to accepted wisdom; and (ix) deliberate

copying of the invention. I understand there must be a nexus between any such secondary consideration of non-obviousness and the claimed invention. I also understand that “[a] patentee is entitled to a rebuttable presumption of nexus between the asserted evidence of secondary considerations and a patent claim if the patentee shows that the asserted evidence is tied to a specific product and that the product is the invention disclosed and claimed.”

18) I understand objective indicia of non-obviousness can be the most probative evidence of non-obviousness in the record and enables the court to avert the trap of hindsight. Objective indicia of nonobviousness may often establish that an invention appearing to have been obvious in light of the prior art was not. To be afforded substantial weight, the objective indicia of nonobviousness must be tied to the novel elements of the claim at issue. Objective indicia need only be reasonably commensurate with the scope of the claims.

19) I also understand secondary considerations include commercial success enjoyed by embodiments of the patented invention, industry praise for the patented invention, copying by others, and the existence of a long-felt but unmet need for the invention. Evidence of objective indicia of nonobviousness must have a nexus to the claims, *i.e.*, there must be a

legally and factually sufficient connection between the evidence and the patented invention. I understand that Tegriss bears the burden of showing that a nexus exists. To determine whether the patentee has met that burden, one must consider the correspondence between the objective evidence and the claim scope.

20) To be relevant, I understand a secondary consideration must have a legally and factually sufficient connection (nexus) to the claimed invention. A nexus is presumed when a commercial product (if relevantly successful, for example) is the invention disclosed and claimed in the patent.

IV. LEVEL OF ORDINARY SKILL IN THE ART

21) Tegriss' counsel has informed me the claims of a patent are judged from the perspective of a hypothetical construct involving a POSA at the time the claimed invention of the patent was made. I understand the relevant priority date is January 23, 2007. I understand the "art" is the field of technology to which the '966 Patent is related.

22) I understand Tegriss contends a POSA in the relevant time period for the '966 Patent would have had knowledge of and experience in the inspection and maintenance of fire hydrants or at least similar emergency or life safety assets and software available for use in connection

therewith in 2007. Paper No. 8, at 13. In its Institution Decision, I understand the Patent Trial and Appeal Board (the “Board”) applied Brycer’s description of the qualifications of POSA. Paper 9 at 21-2.

23) Based on my education and experience in the field set forth above, I meet each of the definitions of one of ordinary skill in the art discussed above, including the levels of skill articulated by Brycer and Tegriss. I am qualified to provide opinions about how one of ordinary skill in the art would have interpreted and understood the ‘966 Patent and the alleged prior art cited in the Petition. I meet this definition because I have the unique experience of using both Tegriss Web-Based records management program (Tegriss) and Brycer’s “The Compliance Engine” (TCE) Web-Based as part of my assigned duties as Fire Marshal. We implemented the first use of a Web-Based records management program in the nation at Lynnwood Fire Department in 2009. I later implemented the Tegriss program at the Mukilteo Fire Department and the Everett Fire Department in Washington State. I also used TCE at North County Regional Fire Authority which includes the cities of Arlington and Stanwood in Washington State

24) I was asked to consider the ‘966 Patent, the state of art from 2007 through today, and prior art through the eyes of a POSA. I applied the

perspective of a POSA in rendering my opinions.

V. THE '966 PATENT AND THE CHALLENGED CLAIMS

25) I understand Brycer challenges the validity of the '966 Patent. The Challenged Claims 8-16 of '966 Patent are directed to fire hydrant management systems.

26) Challenged Claims 8-16 of the '966 Patent require a "computer-implemented method for using a fire hydrant management software and a web-based registry to track requisite inspection of an owned asset comprising:"

- a. granting remote access to a web-based registry system, wherein the web-based registry is configured to run a fire hydrant management software, to at least three classes of user, wherein the three classes of user comprise: (1) an owner of an asset (2) an approval authority (3) an inspector;
- b. retrieving, by a computer-based fire hydrant management software system, real time records of assets from a database, the database being accessible and augmentable by a classes of user;
- c. analyzing the records of assets from the database to identify notification events;
- d. based on the analysis, notifying an owner of an asset of a notification

- event, wherein the notice includes a standard format description of the type of inspection, and a cost associated with the type of inspection, and wherein the notification event comprises a designatable interval in advance of an impending deadline for the inspection, and wherein the owner of the asset, upon remotely accessing the fire hydrant management software compliance registry, may update and review the status of the assets;
- e. based upon the analysis, sending a standard format notice to the approval authority of the status of the assets assigned to the approval authority, and wherein the approval authority, upon accessing the web-based registry, may update and review the status of the assets assigned;
 - f. upon logging on to a password controlled website configured to provide access to the fire hydrant management software, providing to an inspector the owner selects, the selection based upon a list of qualified inspectors that are available to inspect the asset based upon attributes including proximity to the asset, a web-based template configured to describe the asset and each of the steps of the inspection;
 - g. receiving from the inspector, inspection information in specific

- response to the web-based template;
- h. storing in a database in association with the asset, the inspection information, wherein the inspection information is accessible to the users, and updating the database in association with the asset based upon the inspection information;
 - i. transmitting to the approval authority, a standard format compliance report including noting compliance, wherein the compliance report includes, noting deficiencies in the asset and storing the noted deficiencies in association with the asset.

VI. SECONDARY CONSIDERATIONS AS INDICIA OF NONOBVIOUSNESS

A. Nexus to Tegriss and Brycer Commercial Offerings

24) I have personal knowledge and experience with Tegriss' fire hydrant management system and Brycer's competing offering TCE.

25) In 2008 and 2009, the City of Lynnwood began experiencing the negative effect of the 2007 recession. The fire department received pressure from elected officials to assess cost efficiencies and to prepare for lay-offs. As the Assistant Fire Chief and Fire Marshal for Lynnwood, I began to research methods of record keeping that would streamline our "paper-only" records management system. I found that Tegriss had a

program available that not only streamlined the third-party reporting process of inspection contractors, but also helped reduce and eliminate the need for maintaining paper records. Prior to our partnership with Tegriss, inspection contractors developed and printed their own reports. Every contractor formatted their reports individually and very few of them used the same format. The reports were not only difficult to review, but we only received hard copies from approximately 16% of the contractors. We primarily received only reports with deficiencies and had few reports from contractors with no deficiencies. Without a searchable database, we needed to hand search for records, which takes time and is labor intensive. In the Fall of 2009, Tegriss approached me at a Fire Marshal's symposium in Vancouver, Washington to explain their process. We fully implemented the Tegriss program in 2010. I retired in 2011 in order to allow the city of Lynnwood to continue to employ my staff. I would later be offered a position at Tegriss to promote their Web-based records management program as a client representative. In approximately 2013, I began seeing other companies, including Brycer, promoting their version of the Tegriss program. I would later re-enter the fire service in 2015 to establish fire prevention divisions in Mukilteo, Everett and North County Regional Fire Authority (NCRFA). At NCRFA I used TCE for approximately 8 months

before retiring again in 2022.

26) Tegriss' system is the invention disclosed and claimed in the '966 Patent. It is a computer-implemented method for using a fire hydrant management software and a web-based registry to track inspections of assets related to fire safety. The Tegriss system provides asset owners, approval authorities, and inspectors all remote access to a web-based registry system. Tegriss configured its web-based registry to run the fire hydrant management software to at least three classes of users, namely, the asset owner, the authorities having jurisdiction ("AHJ"), and the inspector.

27) The Tegriss computer-based fire hydrant management software system retrieves real time records of assets from a database. Each of the class of users may access and update the database.

28) The Tegriss computer-based fire hydrant management software system analyzes the records of assets from the database and identifies events requiring notification to the classes of users.

29) The Tegriss computer-based fire hydrant management software system, based on that analysis, then notifies an owner of an asset of an event. That notice includes a description of the type of inspection required and associated with the type of inspection. The notification event happens as a predetermined interval in advance of the pending inspection deadline.

The asset owner may remotely access the fire hydrant management software compliance registry, review, and update the status of the asset.

30) The Tegriss computer-based fire hydrant management software system, based on the foregoing analysis, sends a notice to the AHJ regarding the status of the assets assigned to the approval authority. The AHJ may access the web-based registry, review, and update the status of the assets assigned.

31) The Tegriss computer-based fire hydrant management software system allows users to log on to a password controlled website and access the fire hydrant management software, allow the owner to select an inspector based upon a list of qualified inspectors available to inspect the asset based on attributes such as the proximity to the asset, and to provide the selected inspector a web-based template to describe the asset and each of the steps of the inspection.

32) The Tegriss computer-based fire hydrant management software system then receives from the inspector specific inspection information about the inspected asset.

33) The Tegriss computer-based fire hydrant management software system stores in a database in association with the asset, the inspection information. The classes of users may then access in real time the

inspection information. The system then updates the database in association with the asset based upon the inspection information.

34) The Tegriss computer-based fire hydrant management software system then transmits to the AHJ a compliance report including noting compliance, noting deficiencies in the asset, and storing the noted deficiencies in association with the asset.

35) Brycer's system is the invention disclosed and claimed in the patent. I have used Brycer's TCE system, and it provides the same functionality as I described above with respect to Tegriss's system.

36) I studied Exhibit 2 attached to Tegriss' Complaint against Brycer in the case captioned Tegriss, Inc. v. Brycer LLC, *et al.*, N. D. Illinois, Case No. 1:23-cv-07744 filed on October 7, 2023. I attach a copy of that Exhibit as Exhibit 2 to this Declaration (the "Claim Chart"), incorporated herein by reference. EXHIBIT 2018.

37) The Claim Chart accurately reflects my knowledge of Brycer's TCE system. I have personally used Brycer's TCE system at www.thecomplianceengine.com.

38) Brycer's TCE is a computer-implemented method for using an asset management software and web-based registry to track inspection of an owned asset, *e.g.*, fire hydrant, sprinkler system, *etc.*

39) Brycer's TCE grants remote access to a web-based registry system, which is configured to run a fire hydrant (owned asset) management software, to at least three classes of users, namely, the owner of an asset, an approval authority, and an inspector.

40) TCE retrieves, through computer-based asset management software, real time records of assets from a database, the database being accessible and augmentable by users.

41) TCE analyzes the records of assets from the database to identify notification events.

42) TCE notifies asset owners of a notification event, wherein the notice includes a standard format description of the type of inspection, and a cost associated with the type of inspection, and wherein the notification event comprises a designatable interval in advance of an impending deadline for the inspection, and wherein the owner of the asset, upon remotely accessing the fire hydrant management software compliance registry, may update and review the status of the assets.

43) Based upon the analysis, The Compliance Engine sends a standard format notice to the approval authority of the status of the assets assigned to the approval authority, and wherein the approval authority, upon accessing the web-based registry, may update and review the status of

the assets assigned.

44) TCE, upon logging on to a password controlled website configured to provide access to the fire hydrant management software, providing to an inspector the owner selects, the selection based upon a list of qualified inspectors that are available to inspect the asset based upon attributes including proximity to the asset, a web-based template configured to describe the asset an each of the steps of the inspection.

45) The Compliance Engine provides for the inspector to submit inspection information in response to the web-based template.

46) The Compliance Engine stores in a database in association with the asset, the inspection information, wherein the inspection information is accessible to the users, and updates the database in association with the asset based upon the inspection information.

47) The Compliance Engine transmits to the approval authority a standard format compliance report including noting compliance, wherein the compliance report includes noting deficiencies in the asset and storing the noted deficiencies in association with the asset.

B. COMMERCIAL SUCCESS

47) The Tegriss fire hydrant management system is commercially successful despite the initial reluctance of stakeholders, e.g., owners, AHJ,

and inspectors to adopt such a system.

48) I am aware of many towns and cities using the Tegriss fire hydrant management system and the TCE to improve compliance.

49) Tegriss faced a difficult challenge in getting the first fire department to accept and embrace this new technology. Fire departments are notoriously resistant to embrace change. Independent service providers are typically self-made individuals who also resist change and particularly if it comes with a cost. Owners of the assets are more willing to use a web-based product as long as the fire department is pressuring them to comply. I received many threatening letters, emails and phone calls from contractors resisting this web-based program. Once the process began to show promise, inspectors began to see an increase in testing and maintenance of existing life safety appliances. Many inspection companies actually saw increased workloads and hired more staff. One owner of an inspection company in the Tri-cities area of Washington complained that he has to hire more inspectors to keep up with the new requests he was receiving from property owners. Asset owners were getting their life safety systems tested and maintained at recommended intervals and AHJ's began building their web-based records systems to more efficiently view problems within their jurisdictions. It was hard to be the first in the nation to accept

this technology, but in retrospect, it's been good for the industry, increased life safety for communities around the nation and streamlined antiquated records management.

C. INDUSTRY PRAISE

49) I am aware of people in the fire safety industry praising Tegriss' patented system. Soon after Lynnwood used the Tegriss records management system, Richland and Marysville started using the program. Everett, Mount Vernon, Burlington, Anacortez, Kennewick and other continue to use the program today.

D. COPYING

50) Before Tegriss filed its patent application in 2008, the fire safety industry operated archaically. As previously stated, prior to the availability of Tegriss, most AHJ's maintained records in paper forms and filed them in large file cabinets. This method was not easily searchable and often paper files were mislaid or filed in the wrong location. The service industry developed their own individual forms. Furthermore, each service company protected their own proprietary formatting processes. Few service companies used an industry wide formatting style.

51) As early as 2007, I learned of Tegriss' invention. Since that time, Tegriss has worked hard to make the system available and has become the

gold standard in the industry.

52) Since Tegriss's launched, competing systems including Brycer's TCE have launched establishing copying and further supporting evidence of the invention's commercial success.

53) Tegriss met a Long Felt-unmet need – Prior to Tegriss' patent, it was difficult/impossible to access real-time information in an efficient and timely manner? As stated, Tegriss provided a patented program that was needed to manage records and a web-based program that helps located needs of the community.

E. UNEXPECTED RESULTS.

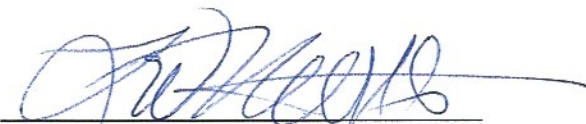
54) The Tegriss fire hydrant management system provided surprising and unexpected results including significantly improved compliance shown by both Tegriss's evidence and evidence published by Brycer relating to TCE.

55) During an emergency situation firefighters can access real-time information regarding which units are operating correctly and which are not? Because of the web-based format of Tegriss, emergency response personnel can get real-time information on life safety systems during an emergency. As long as emergency response vehicles have Internet access, property information can be accessed with a few keystrokes.

In signing this Declaration, I recognize this Declaration will be filed as evidence in an *inter partes* review before the Patent Trial and Appeal Board of the United States Patent and Trademark Office. I also recognize I may be subject to cross-examination in the case and cross-examination will take place within the United States. If cross-examination is required, I will appear for cross-examination within the United States during the time allotted.

I hereby declare all statements made herein of my own knowledge are true and all opinions expressed herein are my own; and further these statements were made with the knowledge willful false statements and the like so made are punishable by fine or imprisonment or both, under Section 1001 of Title 18 of the United States Code.

Dated: 4/15/24



LeRoy McNulty