

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEARMAP US, INC.
Petitioner

v.

EAGLE VIEW TECHNOLOGIES, INC.
Patent Owner

IPR2024-00716

U.S. Patent 10,671,648

**PATENT OWNER'S SUR-REPLY TO
PETITIONER'S REPLY**

Petitioner's Reply (Paper 7) further highlights the deficiencies of the Petition without identifying *any* actual misrepresentations of the record by Patent Owner. Petitioner's Reply does not change the fact that the Petition fails to address the challenged claims with particularity. Even worse, Petitioner's Reply presents new arguments that were not presented in the Petition. Therefore, the Board should deny institution.

I. Petitioner's Reply Fails to Identify any Actual Misrepresentations by Patent Owner.

As established in the POPR (Paper 6), the Petition shifts the burden to the Board and Patent Owner to decipher how long string quotes—over multiple pages, with no explanations or citations—allegedly teach specific claim features. *See* POPR, 5-16. As an example, for [12.a.4], the Petition presented multiple claim elements in the left column and a long series of quotations without citations in the right column. *See* Petition, 32-34. This required the Board and Patent Owner to attempt to find the relevant quotes and piece together Petitioner's convoluted mapping without any guidance.

A plain reading of the Petition dictates that *time*-related quotes may be relevant to the *time* identifiers, *time* periods, or *time* history limitations of [12.a.4] and *geographic*-related quotes may be relevant to the “*geographic* point on earth” limitation of [12.a.4]. *See* POPR, 21. If Petitioner expected a different understanding or mapping, then it was Petitioner's burden to provide such an

explanation in the Petition. 37 C.F.R. § 42.22(a)(2). Instead, when confronted with the fact that the *time*-related quotes set forth in the Petition failed to teach the required time history limitation, *see* POPR, 20-24, Petitioner accused Patent Owner of “affirmatively delet[ing] language,” making “false suggestion[s],” and “ignor[ing]...detailed discussions.” Reply, 1-2.

Upon review of Petitioner's Reply, however, it becomes clear Petitioner was expecting the Board and Patent Owner to understand—*without any explanation* in the Petition—that Petitioner meant to link together the *time*-related quotes, the *geographic*-related quotes, six pages of the Petition setting forth a “detailed introduction to Harris,” two pages of the Petition summarizing background art, and thirty-one paragraphs of Dr. Shahabi's Declaration to address the time history limitation of [12.a.4]. Reply, 2-3. Notably, the Reply fails to establish how the Board or Patent Owner could have possibly known—based on the Petition—to attempt to piece all these disparate parts together specifically for the time history limitation. Rather than identifying any misrepresentations of the record by Patent Owner, the new mappings and explanations in the Reply emphasize the lack of clarity caused by the Petition's failure to include *any explanations* as to the mapping of the long string quotes to the claim language.

II. The Reply Sets Forth New Mappings Not Presented in the Petition.

In the Reply, Petitioner asserts for the first time that the *geographic-related*

quotes, along with the “detailed introduction to Harris” and the section summarizing background art, were intended to be mapped to the *time history* limitation of [12.a.4]. *See* Reply, 2-3 (highlighting all geographic-related language). These connections were never made, let alone explained in detail, in the Petition. Rather, Petitioner presents these new characterizations and connections for the first time in the Reply. The Board should see this for what it is: an improper attempt to cure the deficiencies of the Petition.

III. The Entire Petition Suffers from the Same Lack of Explanation.

As shown in the POPR, the rest of the Petition suffers from the same lack of specificity. For each limitation, the Petition provides claim language followed by a single-sentence series of quotations *without any explanation* as to which quotes apply to which claim limitations. *See* POPR, 6-12. The Board should not excuse Petitioner's failure to provide detailed explanations regarding which prior art quotes relate to which claim limitations. It is Petitioner's burden to show *with particularity* how the cited prior art teaches the claim limitations. Petitioner has failed to do that. The Board should deny institution.

Dated: August 30, 2024

Respectfully submitted,

/ Gregory P. Webb /

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Eagle View Technologies, Inc., § Patent Owner's Sur-reply to Petitioner's
Patent Owner § Reply
 § U.S. Patent No. 10,671,648

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on
Petitioners' counsel as detailed below.

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