

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEARMAP US, INC.,
Petitioner

v.

PICTOMETRY INTERNATIONAL CORP.,
Patent Owner

IPR2024-00729
U.S. Patent 9,182,657

**PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION
UNDER 35 U.S.C. § 313 and 37 C.F.R. § 42.107**

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I. INTRODUCTION

The Board should deny institution of the Petition for *Inter Partes* Review (“Petition”) challenging claims 1-5, 14, 19-21, 26, and 27 of U.S. Patent No. 9,182,657 (“the ’657 Patent”) (EX1001) for at least three reasons.

First, the Board should deny institution because the Petition entirely fails to show how Petitioner’s proposed combination satisfies Petitioner’s own definition of the claim language. 37 C.F.R. § 42.104(b) requires a petition to set forth (a) how a challenged claim is to be construed and (b) where each element of the construed claim is found in the prior art. It is “Petitioner’s affirmative duty to ***explain in the Petition*** how the challenged claims should be construed and how, ***as so construed***, they are unpatentable.” *Intel Corp. v. VLSI Technology LLC*, IPR2019-00034, Paper 13, 15-16 (P.T.A.B. Sept. 25, 2020).¹

Here, the Petition provides a construction for the portion of independent claim 1 reciting “*the computer system controls the first and second image-capturing devices separately*” but then fails to identify where in the cited references all the elements of Petitioner’s proposed construction can be found. Because of this, Petitioner has failed to establish a reasonable likelihood of prevailing with respect to any of the challenged claims.

¹ Unless otherwise noted, all emphasis in the present paper has been added.

Second, the Board should deny institution because the Petition does not show with particularity how the references allegedly teach the limitations of the challenged claims. The 72 pages of claim charts in the Petition setting forth Petitioner's grounds take a consistent format. For each claim element, the claim chart recites a portion of the claim language in bold followed by an "e.g." parenthetical that sets forth a series of quotations identifying multiple different components from the reference(s) *without any explanation*. Without some type of explanation or clarification as to the pertinence of the cited portions, it is impossible to understand with particularity how Petitioner may be attempting to map the cited references to the claim language. For example, is Petitioner attempting to map each of the different components individually to the claim language, or a combination of all the different components, or a combination of some but not all the different components, or some other approach?

The Board recognizes this lack of clarity in a Petition can enable a Petitioner "to deviate from the arguments initially presented in the Petition in a manner that may prejudice" Patent Owner. *ADT LLC v. Vivint, Inc.*, IPR2022-00642, Paper 7 at 14 (P.T.A.B. Oct. 4, 2022) (citing *Wasica Fin. GmbH v. Cont'l Auto. Sys. Inc.*, 853 F.3d 1272, 1286 (Fed. Cir. 2017)). This concern is exacerbated here where Petitioner's repeated use of unexplained quotations identifying multiple different components of the references provides a myriad of possible permutations requiring

Patent Owner and the Board to choose among various different potential combinations to arrive at the challenged claims. This “is not the Board’s role, nor is it fair to Patent Owner to have to defend against such ill-defined and multifarious challenges.” *Playtika Ltd. v. Nexrd Corp.*, IPR2021-00952, Paper 14 at 14 (P.T.A.B. November 6, 2021) (citing to *Microsoft Corp. v. FG SRC, LLC*, 860 F. App’x 708, 713 (Fed. Cir. 2021) (non-precedential)).

Third, potentially to compensate for its lack of explanation, Petitioner repeatedly cites to large chunks of Dr. Forsyth’s Declaration (EX1003) throughout the Petition’s claim charts. However, Petitioner cannot use the 400-plus pages of Dr. Forsyth’s Declaration to fill the substantive gaps in the Petition. The Federal Circuit and Board have consistently held that using an expert declaration to present arguments that are missing from the corresponding brief violates the rule against incorporation by reference set forth in 37 C.F.R. § 42.6(a)(3). Further, the Petition uses all but thirteen words of the 14,000-word limit. Petitioner cannot be allowed to circumvent the word limit for IPR petitions through the improper incorporation of Dr. Forsyth’s Declaration to provide additional analysis and explanation entirely missing from the Petition.

For these reasons, individually and collectively, the Board should deny institution.

II. THE PETITION IS DEFICIENT

A. All of Petitioner's grounds fail because the Petition does not show the references render the claims obvious.

The Petition sets forth seven different grounds to challenge eleven claims of the '657 Patent. Petition, 26. Independent claim 1 is challenged under Ground 1 based on Petitioner's proposed combination of Loewen in view of Fujimoto. *Id.* This is the only challenge to independent claim 1. *Id.* The remaining Grounds 2-7 challenge dependent claims that further limit claim 1. *Id.*; EX1001, 14:64-18:39.

As established below, Petitioner fails to show how Petitioner's proposed combination satisfies Petitioner's own construction of the claim language for independent claim 1. For at least this reason, Petitioner has failed to establish a reasonable likelihood of prevailing with respect to independent claim 1. Because the remaining challenged claims depend from claim 1, Petitioner has failed to establish a reasonable likelihood of prevailing with respect to *any* of the challenged claims. Accordingly, institution should be denied.

1. Petitioner fails to show how Petitioner's proposed combination satisfies Petitioner's own construction of independent claim 1.

The Petition fails to establish how Petitioner's proposed combination of Loewen and Fujimoto in Ground 1 satisfies Petitioner's own construction of the claim language for independent claim 1. The Petition explicitly construes the portion

of [1.f]² reciting “*the computer system controls the first and second image-capturing devices separately*” to mean: “control data sent by the computer system that cause image-capturing devices to capture images at different instants and/or at different intervals.” Petition, 27. However, the Petition’s analysis for [1.f] entirely fails to establish the proposed combination of Loewen and Fujimoto teaches “***control data sent by the computer system*** that causes image-capturing devices to capture images at different instants and/or at different times.”

The Petition simply does not identify what disclosure from Loewen or Fujimoto teaches the “control data” required by Petitioner’s claim construction. In fact, the phrase “control data” does not appear anywhere in the Petition other than the sentence setting forth Petitioner’s claim construction. Petition, 27; *see* Petition generally.

At no point does the Petition address what disclosure of Loewen or Fujimoto, or even the proposed combination of Loewen and Fujimoto, allegedly teaches the “control data” required by Petitioner’s construction for [1.f]. Specifically, in the claim chart setting forth the analysis for [1.f], the Petition quotes various portions of Loewen and Fujimoto ***without any explanation*** as to what Petitioner may be alleging

² For clarity and consistency, any reference to a claim element in the present paper uses the same labeling as used by Petitioner in the Petition.

to be “control data,” as shown in the following screenshots:

[1.f]]	Loewen plus Fujimoto discloses or renders obvious this limitation. EX1003, ¶179. Loewen discloses that the computer system (<i>see</i> cl.1.d) transmits image-capture signals to the first image-capturing device and the second image-capturing device (<i>see</i> cl.1.a-cl.1.b) to cause the first and second image-capturing devices to capture images (<i>e.g.</i>, EX1004, 3:3-10 (“still cameras exposure is automated by including in the system a capability for detecting a tower structure and an onboard computer (a central processing unit) containing operational software and operatively connected to the cameras and the tower detecting device”; “still cameras, computer, and detection capability are operationally interconnected to automatically activate the still cameras at the exposure points along the transmission line”); 7:13-31 (“still camera”
	“trigger[ed]... to acquire the images”); 6:31-58 (“[to] fire the still cameras, the computer must pre-arm the camera prior to... the actual trip”); 11:15-18 (“cameras... trigger[ed] based on actual detection of the presence of the tower structure”); <i>see also</i> cl.1.a; cl.1.b).¹² <i>See</i> EX1003, ¶¶180-187, 194; EX1004, Abstract, Fig.8; <i>see also</i> EX1004 4:1-13, 7:34-55, 10:50-67, 11:1-14, <i>supra</i>, p.23-24 (discussing Loewen).

Petition, 67-68 (emphasis original).

	Fujimoto discloses controlling multiple image-capturing devices separately (<i>e.g.</i>, EX1005, ¶0004 (“a computerized control for opening the shutters of a plurality of cameras independently of one another”); Cl.1 (“computerized control for aerial photography... each shutter... driven at independently different interval time”)). <i>See id.</i>, ¶Fig.2; <i>see also</i> EX1005, Abstract, ¶0001, ¶0006, ¶0008, ¶0010; EX1003, ¶¶188-191:
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Petition, 70 (emphasis original).

Beyond the lack of explanation, notably missing from the series of quotes from Loewen and Fujimoto shown in these screenshots is any mention of “data” or

“information” or other similar language that Petitioner might be mapping to “control data.” Because the Petition does not identify what, if anything, from Loewen or Fujimoto Petitioner is considered to be “control data,” the Petition also fails to address whether any such unidentified “control data” is “*sent by the computer system*” as further required by Petitioner’s claim construction.

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016). In this regard, it is “**Petitioner’s affirmative duty to explain in the Petition how the challenged claims should be construed and how, as so construed, they are unpatentable.**” *Intel* IPR2019-00034, at 15-16. The importance of this requirement has been stressed by the Federal Circuit. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). (“It is of the *utmost importance* that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’”). It is not incumbent on the Board or Patent Owner to work out the details of Petitioner’s challenge based on unexplained portions of the references cited by Petitioner. The burden to prove unpatentability is Petitioner’s to carry and that burden never shifts to Patent Owner. *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015).

Further, it is well established that Petitioner cannot rely on arguments found only in Dr. Forsyth's Declaration (EX1003) to cure the substantive deficiencies of the Petition. Petitioner's reliance on arguments made only in Dr. Forsyth's Declaration requires the Board to sift through the record for pertinent facts and arguments and inject its own reasoning, but that is not the Board's role. *See Harmonic*, 815 F.3d at 1363 (citing 35 U.S.C. § 312(a)(3) (requiring IPR petitions to identify "with particularly ... the evidence that supports the grounds for the challenge to each claim.")). Using a witness declaration to present substantive analysis in place of the Petition violates the Board's rules as well as Board and Federal Circuit precedence. *See* 37 C.F.R. § 42.6(a)(3) ("[a]rguments must not be incorporated by reference from one document into another document.") *Cisco Systems, Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 8 (P.T.A.B. Aug. 29, 2014), ("[U]sing footnotes to cite to large portions of another document, without sufficient explanation of those portions, amounts to incorporation by reference."); *see also Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1371 (Fed. Cir. 2023) ("The burden of production cannot be met simply by throwing mountains of evidence at the Board without explanation or identification of the relevant portions of that evidence.").

Likewise, any arguments only made in a footnote are forfeited. *CommScope Techs. LLC v. Dali Wireless Inc.*, 10 F.4th 1289, 1296 (Fed. Cir. 2021) ("First, an

argument that is only made in a footnote of an appellant's brief is forfeited."); *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006) ("arguments raised in footnotes are not preserved.").

Even if the Board considers the additional, improperly incorporated arguments from Dr. Forsyth's Declaration referenced only in footnote 12 of the Petition (*see* Petition, 68-69 n.12), Petitioner has still failed to meet its burden of establishing that the combination of Loewen and Fujimoto teaches "***control data sent by the computer system*** that causes image-capturing devices to capture images at different instants and/or at different times."

Like the Petition, Dr. Forsyth fails to make an explicit mapping of the cited references to "control data," let alone "control data sent by the computer system." *See* EX1003, ¶¶179-195, Appendix B, 57-68. In fact, Dr. Forsyth does not use the phrase "control data" other than to acknowledge [1.f] "***requires 'control data sent by the computer system*** that cause image-capturing devices to capture images at different instants and/or at different intervals." EX1003, ¶¶ 26, 179, Appendix B, 59; *see* EX1003 generally. However, in the analysis of [1.f], Dr. Forsyth specifically discusses signals transmitted by Loewen's GPS and altimeter. EX1003, ¶¶182-183. Dr. Forsyth asserts that "Loewen expressly discloses the use of ***signals transmitted from Loewen's GPS and altimeter to Loewen's computer***" to trigger Loewen's still cameras to capture images. EX1003, ¶182. However, signals ***received by Loewen's***

computer from Loewen's GPS or altimeter cannot be considered "***control data sent by the computer system.***"

Beyond the simple fact that signals *received* by Loewen's computer are not control data *sent* by Loewen's computer, Petitioner's reliance on Loewen's GPS and altimeter as the "at least one geo-locating device" of [1.c] (*see* Petition, 58-60) necessarily prevents the signals transmitted by the GPS and altimeter from being "control data *sent by the computer system.*"

The computer system of [1.f] is the same computer system recited in [1.d]³ that "***receiv[es] and stor[es]*** ... said at least one ***geo-locating signal***" issued by the at least one geo-locating device of [1.c] (*i.e.*, Loewen's GPS and altimeter in Petitioner's proposed combination). Consistent with Petitioner's mapping of the GPS and altimeter to the "at least one geo-locating device" of [1.c], Petitioner does *not* attempt to include the GPS or altimeter as part of the recited "computer system" of [1.d]. *See* Petition, 60-63. Instead, in a "e.g." parenthetical following "computer system," the Petition cites to three different portions of Loewen as follows: "3:3-10 ('onboard computer (a central processing unit) containing operational software');

³ Petitioner acknowledges this fact in the analysis of [1.f] by noting "Loewen discloses that **the computer system (see cl.1.d)**" (part of original emphasis removed).

7:13-31 ('onboard aircraft computer 42' (Fig.8)); Abstract ('central processing unit containing operational software')." Petition, 60. There is no mention of Loewen's GPS or altimeter.

Accordingly, Petitioner's proposed combination clearly treats Loewen's GPS and altimeter as separate and distinct from the computer system recited in [1.d] and [1.f]. *See* Petition, 58-63. Therefore, the signals transmitted by Loewen's GPS and altimeter and received by Loewen's computer cannot be "control data sent by the computer system" as required by Petitioner's claim construction. This is because (1) the GPS and altimeter are not part of the computer system in Petitioner's proposed combination, and (2) the signals transmitted by Loewen's GPS and altimeter are *received by* Loewen's computer, not *sent by* Loewen's computer.

Finally, to the extent that Petitioner may attempt to argue that the analysis set forth in the Petition is sufficient to satisfy some other alternative construction of the claim language other than Petitioner's proposed construction "such an analysis should have been set forth explicitly in the Petition." *Intel*, IPR2019-00034, Paper 13 at 16 (Decision denying a Request for Rehearing where the petitioner argued for a plain meaning construction of a claim element that was not present in the Petition) ("Thus, **had Petitioner intended to rely on the purported plain meaning construction ... and argue, under that claim construction, ... such an analysis should have been set forth explicitly in the Petition.**")). As recognized by the

Board, it is “Petitioner’s affirmative duty to **explain in the Petition** how the challenged claims should be construed and **how, as so construed, they are unpatentable.**” *Id.* at 15-16 (citing 37 C.F.R. § 42.104(b)(3)-(4)). Petitioner has failed to meet this burden here. Therefore, institution should be denied.

B. The Petition does not show with particularity how the references teach the limitations of the challenged claims.

An IPR petition must “identif[y], in writing and with particularity, each claim challenged” and “the grounds for the challenge to each claim.” 35 U.S.C. § 312(a)(3). The particularity requirement imposes two separate duties on petitioners.

First, petitioners must “specify where each element of the claim is found in the prior art.” 37 C.F.R. § 42.104(b)(4). To do so, petitioners must identify some disclosure in the prior art for each claim element, typically in the form of a quotation or figure.

Second, petitioners must also provide “a **detailed explanation** of the **significance of the evidence.**” 37 C.F.R. § 42.22(a)(2). In most cases, claim language is not found *ipsissimis verbis* in the prior art, and does not need to be. *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009). But this is precisely why a petitioner must additionally explain why the cited disclosure of a prior art reference teaches or discloses the features recited in the corresponding claim element.

For most of the claim elements, Petitioner has only provided the first of these

two particularity requirements: identifying prior art quotations. The Petition repeatedly provides *no explanation* of the quotations provided, let alone the “detailed explanation” required by the Board’s rules.

This omission is not inconsequential. The particularity requirement is “of the utmost importance.” *Intelligent Bio-Systems*, 821 F.3d at 1369. “[L]ack of clarity” in a petition enables petitioners “to deviate from the arguments initially presented in the Petition in a manner that may prejudice” patent owners. *ADT*, IPR2022-00642, Paper 7 at 14 (citing *Wasica*, 853 F.3d at 1286). “While the Board’s requirements are strict ones, they are requirements of which petitioners are aware when they seek to institute an IPR.” *Intelligent Bio-Systems*, 821 F.3d at 1369.

The Petition relies on 72 pages of claim charts to address the challenged claims. *See* Petition, 44-115. For each claim element, the Petition starts with an introductory sentence stating which reference allegedly discloses the claim element and then addresses the claim element with a single, often multi-page, single-spaced sentence. In these sentences, claim language is presented in bold followed by “e.g.” parentheticals listing quotations of the prior art.

To provide an example of this approach, a screenshot of the Petition’s analysis for limitation [1.d] of claim 1 is shown below.

[1.d]	Loewen discloses this limitation. EX1003, ¶158. Loewen discloses a computer system (e.g., EX1004, 3:3-10 (“onboard computer (a central processing unit) containing operational software”); 7:13-31 (“onboard aircraft computer 42” (Fig.8)); Abstract (“central processing unit containing operational software”))¹⁰ receiving and storing said first and sec-	Introductory Sentence Claim Language “e.g.” Parenthetical providing quotes but no explanation
	ond image-data signals and said at least one geo-locating signal (e.g., EX1004, 3:51-57 (“still and video images, along with the geographic coordinates are transmitted to data storage units on board the aircraft”); 8:65-9:5 (“computer recording all the GPS data strings as well as continuous laser readings [] into a text file... file also contains... time stamp of the time when the laser altimeter located a transmission tower structure, and in cooperation with the GPS, the longitude/latitude coordinates of each tower”); 3:37-50 (“position of the aircraft in longitude and latitude coordinates” is “transmitted to the onboard computer”); 6:31-58 (“cameras... write their information directly to the onboard computer”); 7:13-31 (“onboard aircraft computer 42 is interconnected with the GPS and trigger system, and also the data storage unit”); Fig.8 (“onboard aircraft computer 42”)). See EX1003, ¶159-167; EX1004, 7:34-55, Figs.8-10; see also <i>id.</i> 1:16-24, 2:50-3:2, 3:3-10, 4:31-34, 7:59-61, 9:14-31, 9:32-39, 9:40-47, 11:19-28, <i>supra</i>, p.18 (discussing Loewen).	Claim Language “e.g.” Parenthetical providing quotes but no explanation Additional Citations

Petition, 60-61 (annotated).

As shown above, following the sentence setting forth the claim language and quotes from the reference *without any explanation* is a citation to Dr. Forsyth's Declaration and a string of additional citations to the reference and other portions of the Petition, but without any quotations or explanations of which features these additional citations might relate to.

For claim elements throughout the Petition, Petitioner repeatedly presents claim language interspersed with similar “e.g.” parentheticals that *list*, but *never explain*, quotations from the cited references. For example, continuing reference to the Petition's analysis of [1.d] shown above, [1.d] recites at least six different aspects

performed by a computer system that must be shown in the prior art:

- “receiving...first...image-data signals”;
- “receiving...second image-data signals”;
- “receiving...at least one geo-locating signal”;
- “storing said first...image-data signals”;
- “storing...second image data signals”; and
- “storing...said at least one geo-locating signal.”

EX1001, 15:14-16.

As shown above, in the claim chart addressing [1.d] (Petition, 61), the Petition lists several quotes from Loewen following claim language of [1.d]:

- “still and video images, along with the geographic coordinates are transmitted to data storage units” EX1004, 3:51-57;
- “computer recording all the GPS data strings” EX1004, 8:65-9:5;
- transmitting “position of the aircraft...to the onboard computer” EX1004, 3:37-50;
- “computer 42 is interconnected with the GPS and trigger system, and also the data storage unit,” EX1004, 7:13-31; and
- an “onboard aircraft computer 42.” EX1004, Fig. 8.

However, the Petition provides no explanation beyond these bare quotations. It is Petitioner's burden to “provide an *understandable explanation*...of the

patentability challenges.” *Corephotonics, Ltd. v. Apple Inc.*, 84 F.4th 990, 1001 (Fed. Cir. 2023). Without some type of explanation or clarification, it is impossible to understand *with particularity* how Petitioner may be attempting to map the quoted portions to the claim language. For example, is Petitioner attempting to map each of still images *and* video images to the claim language, or only still images, or only video images, or a combination of still and video images, or some other approach? Because Loewen describes still images and videos being obtained, processed, and stored differently (*see* EX1004, 2:39-3:10, 3:16-36, 6:3-31, 6:39-51; 8:54-64; 9:48-57), it is important to know what particular images, if any, Petitioner is relying upon to understand the proposed combination.

Without an explanation providing guidance as to how Petitioner may have intended the quotes to be mapped to the claim language for each claim element, the Petition requires the Board and Patent Owner to sift through the cited portions of the references in an attempt to ascertain how Petitioner may be applying the prior art to the challenged claims. This “is not the Board’s role, nor is it fair to Patent Owner to have to defend against such ill-defined and multifarious challenges.” *Playtika*, IPR2021-00952, Paper 14 at 14 (citing to *Microsoft*, 860 F. App’x at 713 (non-precedential)). Further, because the Petition includes several quotes identifying multiple different components for each claim element, the effect of the lack of explanation is compounded when the claim elements are considered together as part

of each of the challenged claims as a whole. The result is an indecipherable web of potential paths and permutations that makes it impossible for the reader to know what mapping Petitioner may have intended.

The Petition entirely omits the requisite explanation of the relevance of the quotations for all the claim elements other than [1.e]. For [1.e], the Petition provides an explanation of how Petitioner is mapping the quoted portions of Loewen to the claim language. Petition, 65-67 (e.g., explaining the mapping of the “‘coordinat[ing]’ and ‘label[ing]’” in Loewen to the “‘associat[ing]’” of [1.e]). This is the *only instance* of such an explanation for any of Grounds 1-7 set forth in the Petition. See Petition, 44-115.⁴

The presence of an explanation of the relevance of the quoted portions of the reference in the context of [1.e] emphasizes the fact that Petitioner knew how to provide such an explanation but intentionally chose not to for any of the other claim elements. In choosing to provide *no explanation* as to the relevance of the cited

⁴ While the Petition sets forth alleged reasons to combine the various references for claim elements [1.f], [3.c]-[3.e], [4]-[5], [19]-[21], and [26]-[27], the alleged reasons to combine fail to describe or explain how the quoted passages of the references should be mapped to the claim language. See Petition, 67-72, 74-82, 85-92, 95-115.

portions of the references for the remaining claim elements, Petitioner failed to meet its burden of showing with particularity how the references teach the limitations of the challenged claims.

Multiple Board panels have denied institution of IPR petitions that present similar series of blind quotations without explanations of the prior art. For example, the Board denied institution where the “[p]etitioner’s claim chart span[ned] twenty-two pages and consist[ed] of block quotes from the prior art references” that were “unaccompanied by requisite explanation of how the cited portions teach or disclose the claim limitations or of their significance to the analysis.” *VIZIO, Inc. v. Nichia Corp.*, IPR2017-00552, Paper 9 at 17 (P.T.A.B. July 7, 2017).

Similarly, the Board rejected a petition that “provide[d] no explanation of how it interprets the quoted or cited statements.” *Shenzhen Jimuyida Tech. Co., Ltd. v. Artec Europe S.A.R.L.*, IPR2023-01148, Paper 6 at 19 (P.T.A.B. Jan. 16, 2024). In *Shenzhen*, the Board explained that “this approach places an undue burden on the Board to sift through the information presented by Petitioner and attempt to discern correspondence and differences between the claimed subject matter and the teachings of the prior art.” *Id.*

The Board rejected a petition that included a similar list of “recitations of disclosure from the prior art, without context or further analysis.” *Sinjimoru v. Geneze Innovation Inc.*, IPR2021-00493, Paper 8 at 12 (P.T.A.B. July 28, 2021).

The Board “decline[d] to abandon [its] role as adjudicator, or step into the role of advocate, to scour the record to discover whether the Petition, in fact, advances evidence sufficient to support institution of review.” *Id.* at 22.

In each of these cases, the petition did not include “a detailed explanation of the significance of the evidence.” 37 C.F.R. § 42.22(a)(2). The Petition here has the same fatal deficiencies. An IPR petitioner “has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic*, 815 F.3d at 1363. Petitioner has failed to meet that burden in the current case. It is not incumbent on the Board or Patent Owner to fill out the details of Petitioner’s challenge based on unexplained portions of prior art references cited by Petitioner.

Because the Petition has not presented its patentability challenge “with particularity,” it falls short of the Board’s rules for providing a “detailed explanation” of “where each element of the claim is found in the prior art,” as required by 37 C.F.R. §§ 42.22(a)(2) and 42.104(b)(4). Like the above-identified petitions similarly rejected by the Board for lacking particularity, the Board should deny institution of this Petition due to its repeated lack of clarity or explanation.

C. The Petition’s reliance on Dr. Forsyth’s Declaration to present substantive arguments missing from the Petition violates the Board’s rules against improper incorporation by reference and improperly circumvents the word limit for IPR petitions.

In addition to the fact that the Petition lacks the required particularity for the Board and Patent Owner to properly understand Petitioner’s challenges, the Petition

is also deficient because it violates the Board's rules against improper incorporation by reference. The Board's rules provide that "[a]rguments must not be incorporated by reference from one document into another document." 37 C.F.R. § 42.6(a)(3).

To the extent Petitioner argues the explanations and details entirely missing from the Petition are included in the cited portions of Dr. Forsyth's Declaration (EX1003), this form of using a witness declaration to present substantive analysis in place of the Petition violates the Board's rules as well as Federal Circuit and Board precedence.

The Petition scatters various citations to Dr. Forsyth's Declaration throughout the 72 pages of claim charts. Dr. Forsyth's Declaration presents substantive arguments entirely missing from the Petition. Dr. Forsyth's Declaration is a lengthy 85,008-word, 392-page document (excluding Dr. Forsyth's CV). In the end, the Petition simply provides a list of quotes from the cited references and citations to Dr. Forsyth's Declaration. Dr. Forsyth's Declaration is the only document setting forth any type of substantive explanation of the potential relevance of the quotes from the cited references to the claim language.

For example, as discussed above, the Petition uses a "e.g." parenthetical—much *less than a page* in total—to address limitation [1.d], *see supra* § II.B., without any explanation of the relevance of the evidence. By contrast, Dr. Forsyth's Declaration uses paragraphs 159-167 with reference to a significantly expanded

claim chart in Appendix C—together *over 22 pages*—to address the same claim language. Using an expert's declaration to raise substantive arguments that are entirely missing from the petition in this manner violates the Board's rules against improper incorporation by reference. *See* 37 C.F.R. § 42.6(a)(3).

Further, Petitioner's repeated citations to Dr. Forsyth's Declaration in place of providing substantive arguments and analysis in the Petition is a clear attempt to bypass the petition word limit. The Petition uses all but thirteen words of the 14,000-word limit. Given the inadequacies of the Petition, the only way to potentially understand Petitioner's proposed unpatentability challenges is to wade through the 85,000+ words of Dr. Forsyth's Declaration, which dwarfs the 14,000 words granted to petitioners. *See* 37 C.F.R. § 42.24(a)(1)(i).

The Federal Circuit and the Board have both held that similar uses of declarations to present substantive arguments in place of IPR briefs violate Rule 42.6(a)(3).

In *C-Cation*, the Board denied institution where a petition similarly used citations to an expert declaration to present its substantive arguments. *See* IPR2014-00454, Paper 12 at 7-10. The Board explained that such citations “to other claim charts in another document ... amounts to incorporation by reference.” *Id.* at 9. The petition in *C-Cation* relied on a 250-page expert declaration to present its arguments, which the Board found “amount[ed] to a self-help increase in the length of the brief

and [was] a pointless imposition on the court's time." *Id.* at 10.

Similarly, in *General Access Solutions, Ltd. v. Sprint Spectrum L.P.*, the Federal Circuit held that a patent owner's response brief "fail[ed] to explain" the substantive argument "with any specificity." 811 F. App'x 654, 658 (Fed. Cir. 2020) (non-precedential). Rather, "[t]o identify [the patent owner's] substantive arguments, the Board was forced to turn to a declaration ... and further to delve into a twenty-nine-page claim chart attached as an exhibit." *Id.* Even where the patent owner's briefing "fell under the page limits," the Federal Circuit held that its reliance on a supporting declaration was a "voluntary decision to violate a procedural rule." *Id.* Doing so "force[d]" the Board to "play archeologist with the record" and "search for arguments that might have been made outside of the parties' briefing." *Id.* at 657 (quoting *DeSilva v. DiLeonardi*, 181 F.3d 865, 866-67 (7th Cir.1999)). Petitioner's decision to do the same here is an identical violation of Rule 42.6(a)(3), but also far exceeds the 14,000 page-limit for IPR petitions.

In *Boston Scientific Neuromodulation Corp. v. Nevro Corp.*, the Federal Circuit similarly held that "reliance on" an exhibit for substantive arguments that were entirely missing from a brief was "clearly an attempt to incorporate arguments by reference" and a violation of 42.6(a)(3). 813 F. App'x 572, 583 (Fed. Cir. 2020) (non-precedential).

In *Intelligent Bio-Systems, Inc. v. Illumina Cambridge Ltd*, the Board found

that a petitioner's reply that "relie[d] extensively on in-depth explanations and supporting documentary evidence presented in Dr. Branchaud's Reply Declaration" but did not include such explanations itself "d[id] not comply with 37 C.F.R. § 42.6(a)(3)." IPR2013-00517, Paper 87 at 16 (P.T.A.B. Feb. 11, 2015) (quoted but not relied on in *Intelligent Bio-Systems*, 821 F.3d at 1366).

Further, the Federal Circuit recently affirmed the Board's decision to reject evidence presented only in an expert declaration and incorporated by reference into a brief "in violation of Rule 42.6(a)(3)." *Parus*, 70 F.4th at 1369. The Federal Circuit explained that "[t]he burden of production cannot be met simply by throwing mountains of evidence at the Board without explanation or identification of the relevant portions of that evidence." *Id.* at 1371.

Like these other examples, the Petition here presents claim charts that, for almost all the claim elements, provide of series of quotes from the cited references without any substantive explanation of the relevance of those quotes. To the extent Petitioner is attempting to rely on substantive explanations found in the cited portions of Dr. Forsyth's Declaration to fill the holes in the Petition, such an approach is a violation of Rule 42.6(a)(3) regarding incorporation by reference and improperly avoids the 14,000-word limit for IPR petitions. Accordingly, the Board should deny institution for these additional reasons.

III. CONCLUSION

Patent Owner asks that the Board deny institution of the Petition for *Inter Partes* Review for any or all of the reasons presented above.

Respectfully submitted,

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IV. CERTIFICATE OF WORD COUNT

Under 37 C.F.R. § 42.24(b)(1), the undersigned attorney for Patent Owner declares that the argument section of this Patent Owner's Preliminary Response (Sections I-III) has 4,901 words, according to the word count tool in Microsoft Word™.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Pictometry International Corp. § Patent Owner's Preliminary Response
Patent Owner §
 § U.S. Patent No. 9,182,657
 §

CERTIFICATE OF SERVICE

The undersigned certifies, under 37 C.F.R. § 42.6, that service was made on
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