

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NEARMAP US, INC.
Petitioner

v.

PICTOMETRY INTERNAIONAL CORP.
Patent Owner

IPR2024-00729

U.S. Patent 9,182,657

**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 show how Petitioner's proposed combination satisfies Petitioner's own claim construction of independent claim 1. 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 fails to show how Petitioner's proposed combination satisfies Petitioner's own construction of [1.f]. POPR, 4-12. In its Reply, Petitioner accuses Patent Owner of making "false[] suggest[ions]" and "misstat[ing] the Petition and Petitioner's expert testimony." Reply, 1. Reviewing the substance of Petitioner's Reply, it becomes clear that Petitioner's basis for these unfounded accusations is a perceived difference between "which in turn triggers" and "to trigger" as shown below.

"Loewen expressly discloses the use of signals transmitted from Loewen's GPS and altimeter to Loewen's computer, which in turn triggers Loewen's still cameras to capture images." Reply, 1 (emphasis removed).	"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. POPR, 9 (emphasis removed).
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More specifically, Petitioner asserts that Patent Owner's use of the simplified language "to trigger" instead of "which in turn triggers" somehow "hides what Dr.

Forsyth *actually* stated.” Reply, 1 (emphasis original). Notably, however, Petitioner does not explain what substantive difference, if any, exists between these very similar phrases. Instead of identifying any misrepresentations of the record by Patent Owner, Petitioner’s arguments emphasize the deficiencies of the Petition.

Regardless of the phraseology, the fact remains the same: the Petition simply does not identify what disclosure from Loewen or Fujimoto teaches the “*control data*” required by Petitioner’s claim construction. There can be no dispute that neither “to trigger” nor “which in turn triggers” teaches the use of “control data.” To the extent Petitioner may now be attempting to argue that sending “control data” is inherent, Petitioner is required to show that “control data” is *inevitably* sent by the computer system to trigger the cameras. *See In re Montgomery*, 677 F.3d 1375, 1380 (Fed. Cir. 2012) (“The inherent result must *inevitably* result from the disclosed steps.”). However, Petitioner’s own evidence establishes other ways of triggering cameras that do not rely on control data being sent by a computer system. *See, e.g.*, EX1005, 5 (describing the use of amplified electrical pulses from an interval timer to open a camera shutter). Therefore, Petitioner necessarily cannot meet the high bar required for inherency.

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

The Reply includes numerous excerpts from Dr. Forsyth’s Declaration. Reply, 1-2. However, it is well established that Petitioner cannot use a witness declaration

to present substantive analysis not contained in the Petition because doing so 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.”). Further, Patent Owner previously addressed Dr. Forsyth's testimony. *See* POPR, 8-11 (establishing that Dr. Forsyth, like the Petition, fails to map any teachings of the cited references to “control data sent by the computer system” as required by Petitioner's claim construction).

Finally, the Reply asserts that Patent Owner ignored various other portions of the Petition relevant to the “control data” aspect of [1.f]. Reply, 3. In particular, Petitioner asserts that Patent Owner “ignore[d]” the Petition's discussion of [1.a]-[1.b] (13 pages), claim 20 (6 pages), and the background art (19 pages). Reply, 3. However, the specific connections between parts of these 38 additional pages of the Petition and [1.f] as set forth in the Reply were never made, let alone explained in detail, in the Petition. Further, even considering the newly identified parts, the Petition still fails to identify “control data sent by the computer system.” There is simply no mention of “control data” or similar language in the newly cited portions and, as discussed above, Petitioner cannot meet the high bar required for inherency. Accordingly, institution should be denied.

Dated: August 30, 2024

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Pictometry International Corp., § Patent Owner's Sur-reply to Petitioner's
Patent Owner § Reply
 § 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
Petitioners' counsel as detailed below.

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