

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ZESTY.AI, INC.,
Petitioner

v.

AON RE, INC.,
Patent Owner

Case IPR2025-01360
U.S. Patent No. 11,030,491

**PETITIONER’S OPPOSITION TO PATENT OWNER’S
REQUEST FOR DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
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PETITIONER’S UPDATED EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 11,030,491 to Okazaki (“’491 patent”)
1002	Prosecution History of U.S. Patent No. 11,030,491 (“Prosecution History”)
1003	Declaration of Dr. David A. Forsyth
1004	<i>Curriculum Vitae</i> of Dr. David A. Forsyth
1005	U.S. Publication No. 2015/0186953 to Gross et al. (“Gross”)
1006	U.S. Patent No. 10,755,357 to Davis et al. (“Davis”)
1007	U.S. Patent No. 6,970,593 to Furukawa (“Furukawa”)
1008	Jafri, <i>et al.</i> , “A Survey of Face Recognition Techniques,” <i>Journal of Information Processing Systems</i> , Vol. 5, No. 2, June 2009, pp. 41-68 (“Jafri”)
1009	U.S. Patent No. 8,078,436 to Pershing et al. (“Pershing”)
1010	U.S. Patent No. 6,885,771 to Takahashi (“Takahashi”)
1011	U.S. Publication No. 2009/0265193 to Collins et al. (“Collins”)
1012	U.S. Publication No. 2015/0302529 to Jagannathan (“Jagannathan”)
1013	U.S. Patent No. 4,941,122 to Weideman (“Weideman”)
1014	U.S. Patent No. 8,995,757 to Ciarcia et al. (“Ciarcia”)
1015	Redistricting Data Hub, “TIGER Boundary Files,” accessible at https://redistrictingdatahub.org/data/about-our-data/tiger-boundary-files/ (last accessed July 10, 2025)
1016	Norman, J., “Origins of Google Earth,” History of Information, accessible at https://www.historyofinformation.com/detail.php?entryid=3145 (last accessed July 13, 2025)
1017	Krizhevsky, <i>et al.</i> , “ImageNet Classification with Deep Convolutional Neural Networks,” <i>Communications of the ACM</i> , Vol. 60, No. 6, May 2017
1018	Lin, <i>et al.</i> , “Network In Network,” 2013

Exhibit No.	Description
1019	Bradski, “The OpenCV Library,” accessible at https://www.drdobbs.com/open-source/the-opencv-library/184404319 (last accessed July 10, 2025)
1020	van der Walt, <i>et al.</i> , “scikit-image: image processing in Python,” <i>PeerJ</i> , June 2014
1021	“Cartographic Work in Japan 2000 – 2005,” United Nations Economic and Social Council, June 2005
1022	Usery, <i>et al.</i> , “Mapping Developments and GIS in the USGS, 1884-2009,” International Cartographic Association, January 2009
1023-1025	<i>Intentionally Left Blank</i>
1026	UK Patent Application GB 2531551
1027	U.S. Application Publication No. 2014/0289834 to Lindemann
1028	United States District Court for the District of Delaware Stay Statistics (2024-2025)
1029	U.S. District Court – Judicial Caseload Profile, Federal Court Median Time to Trial Statistics

I. INTRODUCTION

The Director should decline to exercise discretion to deny institution of this *inter partes* review (IPR) Petition because it is an early challenge, Aon does not have settled expectations, and the FWD will issue long before trial. Moreover, the examiner made a material error by not even attempting to locate prior art for the very features Aon now contends are the point of novelty. Indeed, the examiner did not even make a single prior art rejection for the '491 patent or any of the related patents challenged by Zesty.

Aon's arguments do not square with the facts and the previous decisions issued by the Director. For example, Aon contends it had settled expectations because of the parties' prior communications yet it brushes aside that Zesty repeatedly and consistently told it that its patents are invalid. As another example, Aon contends that this is a late challenge, contrary to the Director's prior decisions and despite the undisputed fact that the '491 patent had been in force for just over 4 years at the time of the filing of this Petition. And Aon's arguments on the merits rely on plain mischaracterizations of both the Petition and Dr. Forsyth's testimony.

The PTAB is the most efficient and fastest forum to resolve the parties' dispute. Accordingly, the Director should deny Aon's request for discretionary denial and, under the Director Institution process, determine this IPR warrants institution for the reasons set forth in the Petition.

II. THE EARLY CHALLENGE OF THE '491 PATENT WEIGHS AGAINST DISCRETIONARY DENIAL.

A. This Petition is an early challenge to the '491 patent.

The '491 patent issued on June 8, 2021 and had been in force just over four years at the time of the Petition's filing on July 30, 2025. Countless recent discretionary decisions determine that challenges of patents less than six years old are "early challenges," determining that the patent owner had, thus, not developed strong settled expectations and referring those IPRs for consideration on the merits. *See, e.g., OnePlus Tech. (Shenzhen) Co. v. Pantech Corp.*, IPR2025-00756, Paper 11 at 2 (P.T.A.B. Oct. 3, 2025) (referring "early challenge" for patent issued in 2020); *Berkshire Hathaway Energy Co. v. Birchtech Corp.*, IPR2025-00274 et al., Paper 23 at 3 (P.T.A.B. July 2, 2025) (patents issued July 9, 2019; Mar. 24, 2020); *Shenzen Tuozhu Tech. Co. v. Stratasys, Inc.*, IPR2025-00438 et al., Paper 10 at 2 (P.T.A.B. July 17, 2025) (including patents issued 2020 or later). This case is no different. Aon's arguments regarding the age of the '029 patent are irrelevant to the '491 patent, and in any case as discussed below, efficiency dictates institution where 3 of the 4 challenges are early challenges. The early challenge here favors consideration of the merits by the Director.

B. Aon does not have a reasonable basis to allege "settled expectations" based on prior discussions between the parties, where Zesty repeatedly told Aon their patents were invalid.

Aon next contends that it had "settled expectations" based on the parties'

prior dealings. DD Br., 5-9. But Aon’s characterizations of these dealings brush aside important details. When Aon first contacted Zesty in 2020 about the parent ’029 and ’285 patents (the only patents in the family that had issued at this point; the ’058 and ’491 patents issued later, in 2021), Zesty promptly responded that it does not infringe and had prior art related to the patents. EX2011, 2, 4. There were no “settled expectation” of validity—quite the contrary. Aon complains that Zesty did not share the prior art. DD Br., 5-9. But Zesty was under no obligation to do so.

Moreover, Aon’s reaction to being told that the patents were invalid confirms that there were no “settled expectation” of validity. After 2020, Aon did not contact Zesty for another 2.5 years. At that point, in May 2023, [REDACTED]

[REDACTED]

[REDACTED] See EX2007, 7; EX2017, 1. In response, Zesty noted that it had [REDACTED]

[REDACTED] with Aon and in that vein that [REDACTED]

[REDACTED]

for the reasons expressed by Zesty’s counsel in the meeting in 2020 (i.e., the patents were invalid and not infringed). EX2007, 6; EX2017, 1. Indeed, Mr. Toth (Zesty’s Founder and CEO) emphasized that no further issues were raised by Aon after the original discussions in July 2020, and, in fact, [REDACTED]

[REDACTED], suggesting the matter was resolved. EX2007,

6. Again, communications ceased until early 2025.

These communications should not, and cannot, give rise to any reasonable expectation from Aon that it has “settled expectations” in the enforceability of the ’491 patent. Indeed, the timing of these communications, if anything, create “settled expectations” for Zesty that it would not be sued. After the initial communication in 2020, where Zesty stated the patents [REDACTED] and were invalid, Zesty did not hear from Aon for another 2.5 years. In 2023, when Aon contacted Zesty again, [REDACTED] [REDACTED]. After that, Aon waited nearly another year to sue Zesty.

So in sum, during the five years between when Aon first contacted Zesty and then sued, Aon spent nearly 3.5 of those years resting on its laurels. At no point during these five years did Zesty suggest that the patents were valid [REDACTED] [REDACTED]. Indeed—quite the opposite—Zesty repeatedly reaffirmed its position that the patents were invalid. Aon cannot sit around, ignore Zesty’s repeated statements that the patents were invalid, and now claim it had “settled expectations” because it is upset Zesty did not share its prior art. *See Apple Inc. v. Ferid Allani*, IPR2025-00856, Paper 11 (P.T.A.B. Sept. 5, 2025) (the petitioner’s settled expectations weighed against denial, where petitioner informed the patent owner it did not require a license and patent owner waited for years to assert the patent). Further, it is not reasonable to have expected Zesty—a small start-up company with less than 30 employees in 2020—to expend its limited resources to

file IPRs challenging patents owned by Aon—a leading global professional services firm with more than \$15 billion in revenues—based solely on purported allegations of infringement. Zesty should not be faulted for waiting to file this IPR until after the '491 patent was asserted against it, particularly when Aon chose to wait four years after the '491 patent issued to assert it, with only sporadic prior communications regarding the patent family.

Aon's reliance on previous decisions to support its "settled expectations" fares no better. DD Br., 5-9. In both the *Jinkosolar* and *NKT* cases, the Office found the patent owner had strong settled expectations largely based on the age of the patent, not based exclusively on notice. *See Jinkosolar Co. v. Longi Green Energy Tech. Co.*, IPR2025-00859, Paper 10 at 2 (P.T.A.B. Sept. 3, 2025) (finding strong settled expectations because the patent has been in force for ten years); *NKT Photonics, Inc. v. Omni Continuum LLC*, IPR2025-00839, Paper 10 at 2 (P.T.A.B. Sept. 4, 2025) (finding strong settled expectations because the patent has been in force for nearly 17 years). And Aon's reliance on *Apple v. Apex Beam* actually supports referral—not denial. That decision does not even discuss "notice." Rather, it was a referral to the merits panel under circumstances similar to those here—the IPRs were early challenges of recently issued patents (2021 or later) and the final written decision was likely to issue before the district court trial. *Apple Inc. v. Apex Beam Techs., LLC*, IPR2025-00896, Paper 10 at 2-3 (P.T.A.B. Sept. 3, 2025).

Accordingly, that this is an early challenge and Aon's expectations should have been anything other than "settled," strongly weigh against denial of this IPR.

III. *FINTIV* FAVORS CONSIDERATION OF THE MERITS.

The discretionary factors under *Apple Inc. v. Fintiv, Inc.*, when considered as a whole, strongly weigh in favor of consideration of the merits. IPR2020-00019, Paper 11 at 5-6 (P.T.A.B. Mar. 20, 2020) (precedential) ("*Fintiv*").

A. Factor 1 weighs against denial because there is evidence the district court will enter a stay if this IPR is instituted.

Factor 1 weighs against denial because the district court is highly likely to grant a stay. Zesty has submitted IPRs challenging all four patents involved in the district court proceeding, and institution of all four is likely because of the strong merits presented. *See* Pet., 3. Under these circumstances (where a petitioner files its stay motion after all patents asserted in district court have IPRs instituted at the PTAB), the district court in Delaware has granted a stay 77% of the time. *See* EX1028. And indeed, Judge Murphy (the assigned judge in the parallel district court proceeding) has granted 100% of stay motions under these circumstances. *Id.*

B. Factor 2 strongly weighs against denial because the Board will enter a final written decision months before the district court trial.

Factor 2 strongly weighs against discretionary denial. The projected statutory deadline for issuing a FWD is February 4, 2027. A trial date has not yet been set in the district court; the scheduling order notes it will "likely [be] in mid 2027." EX2015, 10. The last hard deadline in the schedule is "Replies to Case

Dispositive/Daubert Motions,” scheduled for February 8, 2027, which would be followed by the pretrial conference and only then trial. *Id.*, 12. This further confirms that trial will occur well after the FWD—even assuming that there are no delays in the district court proceedings. The median time to trial statistics of 35 months puts the trial date even later, at mid-January 2028. EX1029, 14. Thus, the Board will likely issue its FWD five to eleven months *before* the district court trial.

C. Factor 3 strongly weighs against denial because there has been minimal investment, and Zesty was diligent in filing this IPR.

The district court is in the very early stages, with initial infringement contentions only recently served on October 27, 2025 and invalidity contentions not due until late November. EX2015, 4. At the time of the institution decision (February 4, 2026), the parties will have exchanged proposed initial constructions, but neither party will have submitted any briefing and the Markman hearing will be over three months away. *Id.*, 5-8. This is not meaningful investment. Aon’s cite to *Keyless* (DD Br., 19) is inapposite—there the Office found significant investment because *all* claim construction briefing was *complete* and the Markman hearing was *days away*. *Samsung Elecs. Co. v. Keyless Licensing, LLC*, IPR2025-00526, Paper 12 at 2 (P.T.A.B. July 17, 2025); *id.*, Paper 8 at 5. Further, Zesty filed this IPR expeditiously—a mere five months after the district court complaint was filed. The minimal investment and Zesty’s diligence weigh against denial. *Fintiv*, 10-12.

D. Factor 4 weighs against denial because Zesty submitted a stipulation.

Zesty timely submitted a *Sotera* stipulation, Paper 6, which “mitigates any concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions.” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (P.T.A.B. Dec. 1, 2020) (precedential).

The circumstances here are distinguishable from cases where a *Sotera* stipulation was found insufficient to ensure the IPR would be a true alternative to district court. For example, in *Motorola*, there was significant investment in the parallel proceeding and a trial date eleven months *prior* to the projected FWD date. *Motorola Sols., Inc. v. Stellar, LLC*, IPR2024-01205, Paper 19 at 3-4 (P.T.A.B. Mar. 28, 2025). Likewise in *Cisco*, the district court had not granted a stay, and the likely trial date was three months before the Board’s projected FWD date. *Cisco Sys., Inc v. WSOU Invs. LLC*, IPR2025-00188, Paper 14 at 3 (P.T.A.B. Aug. 22, 2025). Here, the FWD will be months *before* the trial, the district court is likely to grant a stay, and there is little investment. Thus, this factor weighs against denial.

E. Factor 5 weighs against denial.

The parties in the parallel litigation are the same and the Board will reach its determination before the district court. *See BOE Tech. Grp. Co., Ltd. v. Optronix Scis. LLC*, IPR2024-01130, Paper 16 at 13 (P.T.A.B. Jan. 27, 2025) (noting weight of factor 5 depends on which tribunal is likely to reach a decision first); *NVIDIA*

Corp. v. Invensas Corp., IPR2020-00603, Paper 11 at 23 (P.T.A.B. Sept. 3, 2020)

(factor 5 weighs against denial where Board is likely to reach a FWD first).

F. Factor 6 weighs against denial because the merits are strong.

The Office made a material error in issuing the '491 patent without including search terms directed to *multiple* machine learning classifiers. *See* Section IV. The Petition presents strong challenges based on prior art that the examiner should have considered, but did not. Like the '491 patent, Gross discloses assessing the condition of a property using Classifier Engine(s). Indeed, the Petition demonstrates a majority of the claims are unpatentable over Gross alone; the minor limitations in the additional claims are rendered obvious by the other combinations. And Aon's alleged "weaknesses" are without merit for the reasons discussed below (Section VI). Thus, this factor weighs against denial.

G. Considered as a whole, the *Fintiv* factors strongly weigh against denial of institution.

In sum, all six of the *Fintiv* factors weigh against discretionary denial, and this consideration weighs in favor of the Director considering the Petition's merits.

IV. THE OFFICE MADE A MATERIAL ERROR, ISSUING THE '491 PATENT WITHOUT A PRIOR ART SINGLE REJECTION.

The Director should consider the Petition on the merits and institute review because the Office made a material error in issuing the '491 patent that should be corrected. The '491 patent issued without even a *single* prior art rejection. *See* Pet., 9-10 (citing EX1002). In fact, *none of the patents* across the four IPR proceedings

received a *single* rejection based on prior art. *See* Pet., 9-10; IPR2025-01357 Pet., 8-9; IPR2025-01358 Pet., 8; IPR2025-01359 Pet., 8-9. That is exceedingly rare, especially across a family of patents. And ultimately, it was the Office’s own flawed search strategy that led to this anomaly.

The examiner’s prior art search missed features of the claimed invention—features that Aon itself now characterizes as the point of novelty of the ’491 patent. Specifically, Aon suggests that the ’491 patent is a “pioneering invention” that features *two separate machine learning classifiers*, one that classifies property characteristics and another that classifies property conditions. DD Br., 3-4. Yet the examiner’s search strategy does not include any search terms directed to this concept at all, let alone *multiple* machine learning classifiers.¹ *See* EX1002, 139-140, 206, 211, 217, 219. Instead, the examiner first probes machine learning and classification in general, uncovering approximately 65,000 results. *See id.*, 139, 217. Then, the examiner focuses on the general application of these techniques for property condition assessment and aerial imagery analysis, terminating the search shortly thereafter. *See id.* Notably, *no search terms* relating to property characteristic classification or multiple machine learning classifiers for property

¹ Worse still, in the three related IPRs, the examiner’s search strategy did not include a *single* search term related to machine learning classifiers *at all*.

assessment, aerial imagery analysis, or any analogous field were used.

And in the Notice of Allowance the examiner provides no discussion on what Aon now claims is the point of novelty. Instead, the examiner focuses on the claims' allowability over prior art that does not even discuss *machine learning classifiers* at all. EX1002, 198 (noting reasons for allowance are similar to those of the '029 patent's). Had a more robust prior art search been performed, it would have been evident the '491 patent should not have been allowed, particularly if the examiner had found Gross, Davis, and Furukawa. The Office should institute review to address this material error. *Accord, e.g., Alliance Laundry Sys. LLC v. PayRange LLC*, IPR2025-00573, Paper 9 (P.T.A.B. July 17, 2025).

V. THE PTAB IS THE MOST EFFICIENT FORUM TO DETERMINE VALIDITY OF THE '491 AND RELATED PATENTS.

Zesty concurrently challenges the '491 patent and three related patents in co-pending IPRs. The challenged claims are substantially similar across all four IPRs and Zesty relies on Gross and Davis to teach the majority of claim limitations in all proceedings. In addition, each of the patents issued less than six years ago:

Patent (IPR)	Issue Date
10,650,285 (IPR2025-01357)	May 12, 2020
10,529,029 (IPR2025-01358)	January 7, 2020
11,195,058 (IPR2025-01359)	December 7, 2021
11,030,491 (IPR2025-01360)	June 8, 2021

All four of Zesty's challenges are "early challenges." *See, e.g., Shenzhen Tuozhu Tech.*, IPR2025-00438 et al., Paper 10 (determining patent issued February 2020 has not been in force for a significant period of time). This weighs against discretionary denial in each case. *Id.* Regardless, even if Aon had developed settled expectations in the earliest issued patent (it has not), where a patent owner has no settled expectations in three of four challenged patents, the PTAB is still the more efficient forum to address the validity of *all* four patents together in a single forum. *See Padagis US LLC v. Neurelis, Inc.*, IPR2025-00464, Paper 12 (P.T.A.B. July 16, 2025) (two patents challenged early, third patent is part of same family; it is an efficient use of Board resources to address the related patent); *Embody, Inc. v. LifeNet Health*, IPR2025-00248, Paper 13 at 3 (P.T.A.B. June 26, 2025) (it would be "an efficient use of Board resources" to review the older parent patent along with the child (issued in 2022)). Efficiency weighs in favor of the Director considering the merits of all four of Zesty's challenges.

VI. AON'S ADDITIONAL ARGUMENTS FOR DISCRETIONARY DENIAL LACK MERIT.

A. Zesty has not engaged in inappropriate forum shopping and the filing of this IPR comports with the intent of the AIA.

First, Aon incorrectly contends that by waiting to file the Petition until after the district court ruled on Zesty's Rule 12(b)(6) motion to dismiss under § 101, Zesty misuses the IPR process. DD Br., 9-12. Rather, the opposite is true. Zesty

recognized that the Office has previously determined it would not be an efficient use of PTAB resources to institute an IPR when a district court has already found the challenged claims invalid. *See Hulu, LLC v. Piranha Media Distrib., LLC*, IPR2024-01252, Paper 27 (P.T.A.B. Apr. 17, 2025) (informative, Director Review decision). Thus, Zesty specifically waited for the ruling on the § 101 motion before filing this IPR, out of respect for the Board’s procedures and limited resources.

Zesty made one more attempt to negotiate with Aon, by sharing pre-filing drafts of the IPR Petitions, again to avoid having to burden the Board. Ironically, Aon now suggests this attempt was yet more gamesmanship—quite the opposite. After receiving the district court’s decision denying the § 101 motion, Mr. Toth made one final attempt “to move past legal disputes” and collaborate based on the parties’ “longstanding relationship.” EX2002, 1. Mr. Toth believed there was “far more to gain through collaboration than continued litigation.” *Id.*, 2. Unfortunately, Aon declined Mr. Toth’s offer and, accordingly, Zesty proceeded to file the IPRs.

So in sum, Aon suggests that Zesty is misusing the IPR process simply because Zesty first tried numerous other avenues to avoid burdening the Board. That is not misusing the IPR process, rather it is being respectful of the Board’s limited resources. And importantly, Zesty’s request for the Office to review its error in issuing the ’491 patent entirely comports with the intent of the AIA for “providing a more efficient system for challenging patents” and “reducing

unwarranted litigation costs.” H.R. Rep. No. 112-98 at 39-40 (2011). As a small company, these efficiencies and cost-savings are of critical importance to Zesty.

B. The Petition’s reliance on expert testimony is entirely proper and consistent with Board regulations.

Aon also suggests, incorrectly, that the Petition relies on expert testimony to fill in “gaps” related to the claimed “*another machine learning algorithm*.” DD Br., 12-14. Put simply, Aon is wrong and mischaracterizing the Petition. The Petition does not rely on expert testimony to fill in *a single gap*, let alone the specific alleged “gap” identified by Aon related to the *another machine learning algorithm*. In fact, the Petition relies on the explicit disclosure of Gross to teach the claimed “*another machine learning algorithm*.” Pet., 29 (citing EX1005, ¶80). As pointed out in the Petition, Gross explicitly discloses it may be useful to employ multiple classifiers (i.e., multiple algorithms)—exactly what the claims require. EX1005, ¶80. And, although the Petition uses ellipses to focus on the most salient part of the disclosure, the omitted material does not support Aon’s incorrect interpretation that Gross is only “referencing multiple classifiers identifying the same information concerning the same thing and then averaging the output.” DD Br., 14. In fact, Aon ignores that the language it highlights from Gross discloses different classifiers can give “a ***combined*** or averaged score” (i.e., each classifier identifies different information concerning different things that is then combined). EX1005, ¶80; *also id.* ¶¶126, 130. Furthermore, Aon neglects to mention that the

Petition also points to Gross’s disclosure that different classifiers could be “customized” for different purposes to identify different things. Pet., 29 (citing EX1005, claim 26).

Citations to Dr. Forsyth’s testimony for this element simply confirm how a POSA would have understood that Gross’s disclosure teaches the claimed “*another machine learning algorithm.*” EX1003, ¶¶80, 84-87. Dr. Forsyth’s testimony is not relied on to fill a gap—Gross already discloses multiple classifiers. Rather, his testimony simply explains what the disclosures of Gross would mean to a POSA, exactly what the regulations suggest such testimony is for. *See* 37 C.F.R. § 42.65(a) (requiring disclosure of underlying facts to support testimony).

Further, Aon does not cite to any case where institution was denied based on improper use of expert testimony. Even in the case Aon does cite, DD Br., 12-13, the Acting Director found the patent owner had *not* shown that the petitioner was using the expert to fill gaps. *Cambridge Indus. USA, Inc. v. Applied Optoelects., Inc.*, IPR2025-00434, Paper 11 at 2 (P.T.A.B. June 26, 2025). Aon’s argument of alleged improper expert testimony reliance does not support discretionary denial here. *Accord GD Energy Products, LLC v. Kerr Machine Co.*, PGR2025-00031, Paper 11 at 2 (P.T.A.B. June 25, 2025) (persuaded expert’s “testimony is merely complying with regulations requiring disclosure of ‘underling facts or data’”).

C. There are no inconsistent claim construction positions: the parties have not exchanged claim construction positions in district court and Dr. Forsyth accurately testifies to the single meaning of “feature” as used in the ’491 patent.

Here, Aon first alleges that Zesty has taken inconsistent claim construction positions in related IPR petitions and the district court proceeding. DD Br., 17-19. As explained in Zesty’s ’029 and ’285 discretionary denial opposition briefs, Aon’s assertion is, at best, a gross mischaracterization of the parties’ positions in the district court proceedings, considering claim construction has not even begun in the district court (*see* EX2015, 5-8 (setting schedule for claim construction)) and Dr. Forsyth’s testimony given in the related IPR proceedings, which is not inconsistent with Zesty’s § 101 motion in the district court.

Further, Aon’s suggestion that Dr. Forsyth relies on inconsistent definitions of the “feature” makes no sense and is directly contradicted by Dr. Forsyth’s own explanations. Dr. Forsyth explicitly states that there are “multiple potential meanings of the word ‘feature’” and specifically identifies two distinct meanings: the general meaning referring to “an aspect, quality, or facet of something” versus the computer vision meaning referring to “pieces of information that can be derived from the pixel content of an image”—a fact Aon itself acknowledges. DD Br., 17-18 (citing EX1003, ¶65; EX2018, ¶91; EX2019, ¶71). Given Dr. Forsyth’s explanation, it should then come as no surprise to Aon that Dr. Forsyth applies a different meaning of the term “feature” for different claims. Indeed, that is exactly

what he said he was doing because the '491 patent applies a different meaning in different contexts of the claims.

Second, it was entirely appropriate for Dr. Forsyth to apply multiple meanings of the term “feature” across the proceedings. Indeed, Dr. Forsyth provided detailed support for these interpretations, citing specific portions of the '491 patent (and the other challenged patents) discussing “property features,” e.g., rooftops and swimming pools, and explaining how “property features” include “structural features, manmade features ... and/or natural features.” EX1003, ¶65 (citing EX1001, 8:36-38, 2:42-47). And likewise, the '491 patent (and the other challenged patents) also refers to “feature” in the computer vision context, for example describing that its “extract[ed] image-related features” can include “angles, outlines, substantially homogenous fields, etc.” EX1001, 8:34-44; EX1003, ¶36; *see also* EX2019, ¶71.

So in sum, Zesty does not take inconsistent claim construction positions across and/or in related IPR petitions and the district court proceeding. Importantly, Aon does not even attempt to argue that Dr. Forsyth interpreted the term “features” wrong in the '491 patent, or individually in any of the other patents either. As such, Aon is not suggesting Dr. Forsyth’s interpretations are wrong—it simply complains that Dr. Forsyth uses different definitions. But the same word can have different meanings across patents if it is used differently. *See Aventis*

Pharms. Inc. v. Amino Chems. Ltd., 715 F.3d 1363, 1374 (Fed. Cir. 2013) (“[T]he same claim term can have different constructions depending upon the context of how the term is used within the claims and specification.”). Aon only has itself to blame for that by using the term “features” differently in its different patents. The Petition should not be denied on this basis.

D. Petitioner’s obviousness theories arise from a proper construction and diligent analysis of inconsistent patent claim language.

Aon also contends that the Board should deny the Petition because of alleged incohesive obviousness theories. DD Br., 14-17. Once again, Aon faults Zesty for the very inconsistencies that Aon created in its own patent family.

Aon alleges that Zesty presents inconsistent positions despite alleged “substantial similarity” between element 1.5 of the ’491 patent and element 1.2 of the ’285 patent. DD Br., 15-16. Yet Aon’s comparison ignores the very contextual analysis that Aon’s own brief acknowledges Dr. Forsyth provided. Specifically, Aon argues that Zesty uses the computer vision context of the term “feature” for the ’285 patent but “takes a different, unexplained, and inconsistent tack” for the ’491 patent and uses the term in its standard context. *Id.* As noted above, however, Dr. Forsyth provided a fully explained analysis about why the claim terms have different meanings in different contexts, which Aon ignores.

Further, Aon’s isolated comparison of these elements guts the respective claim sets of their context, demonstrating that they are not the “substantially

similar elements” that Aon alleges them to be. DD Br., 15-16. The antecedent of “the respective feature” in element 1.5 of the ’491 patent is “one or more property features of the property location” in element 1.4. *See* EX1003, ¶¶76-78. This context explains why Dr. Forsyth concludes that “[w]hen referring to the claimed *features of a property location*, property features, and respective feature from each image, the ’491 patent uses the word *feature* in the second sense” (i.e., physical aspects, qualities, or facets of a property). *Id.*, ¶65. Dr. Forsyth further notes that claim 8 recites “wherein a first feature of the at least one feature of the property location comprises a natural feature,” examples of which include “trees, ponds,” which are “physical aspects, qualities, or facets of a property.” *See id.*, ¶¶102, 36, 65 (citing EX1001, 2:66-3:9). Thus, despite Aon’s own emphasis on context, Aon simply disregards this critical claim language that makes Dr. Forsyth’s construction inescapable. DD Br., 15-16; *see also id.*, 13-14.

In stark contrast, the claims of the ’285 patent tell a different story. Looking just to the second half of element 1.2 (of ’285) reveals “the one or more features are each represented by a set of pixel groupings, and the one or more features represent the characteristic of the property.” EX2019, ¶70. Claim 9 (of ’285) provides even more context, making explicit that it is “image-related features” that are being extracted. *Id.*, ¶¶94-96. These details are all noted by Dr. Forsyth, and form the basis for his explanation that “the claimed *features* [in the ’285 patent]

appear to follow the computer vision meaning of the term.” *See id.*, ¶71.

Aon then concocts a hypothetical scenario where the same or overlapping panel may be asked to construe the same word differently in related patents’ claims, arguing that Zesty created a risk of unexplained inconsistency that creates complex IPRs that risks inconsistent results. DD Br., 16-17. Aon has again missed the point. The claim construction process exists precisely because claim terms can have different meanings based on context and intrinsic evidence. The mere need to perform claim construction cannot counsel for denial of an IPR. And Aon’s cite to *Interactive Commc’ns* is inapplicable. There, the Director reversed the Board’s decision due to its reliance on an expert’s conflicting testimony. *Interactive Commc’ns Int’l, Inc. v. Blackhawk Network Inc.*, IPR2024-00465, Paper 39 at 3 (P.T.A.B. Oct. 1, 2025). In contrast, Dr. Forsyth’s testimony is not inconsistent, but rather he includes the precise reasoning followed to arrive at his conclusions, which does not conflict with testimony he provided in related proceedings.

Aon’s arguments thus fail on all fronts and provide no basis for denial.

VII. CONCLUSION

For these reasons, the Director should deny Aon’s request to discretionarily deny this IPR and should institute review of the challenged claims.

Respectfully submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. §§ 42.6(e))

I certify that the above-captioned **PETITIONER’S OPPOSITION TO
PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL** and
associated Exhibits 1028-1029 were served in their entireties on November 4,
2025, upon the following parties via electronic mail:

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