

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XACTWARE SOLUTIONS, INC.
Petitioner

v.

PICTOMETRY INTERNATIONAL CORP.
Patent Owner

Case IPR2016-00593
U.S. Patent No. 8,823,732

**PETITIONER'S NOTICE OF APPEAL TO THE UNITED STATES COURT
OF APPEALS FOR THE FEDERAL CIRCUIT**

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Pursuant to 35 U.S.C. § 141, 35 U.S.C. § 142, 35 U.S.C. § 319, and 37 C.F.R. § 90.2, and 37 C.F.R. § 90.3, Petitioner Xactware Solutions, Inc. (“Petitioner” or “Xactware”) hereby appeals to the United States Court of Appeals for the Federal Circuit and gives notice of its appeal. Xactware hereby appeals from the Final Written Decision in IPR2016-00593 entered by the United States Patent and Trademark Office’s Patent Trial and Appeal Board (“Board”) on August 28, 2017 (“Decision”) and from all orders, decisions, rulings, and opinions of the Decision, those orders, decisions, rulings, and opinions underlying, supporting, leading up to and/or incorporated into the Decision; and any orders, decisions, rulings, and opinions that adversely affected Xactware. A copy of the Decision is attached.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), Xactware further indicates that the issues on appeal include, but are not limited to, the Board’s determination that Petitioner has not shown by a preponderance of the evidence that Claims 12–15, 21–23, 25–27, 33–38, 44, and 45 of U.S. Patent No. 8,823,732 B2 (“the ’732 patent”) are unpatentable; the Board’s decision to grant the Patent Owner Pictometry International Corp.’s motion to exclude certain exhibits, including Exhibits 2013, 2014, 2015, 2016, 2019, 2023, 2024, 2025, and 2026; the Board’s determination that Petitioner has not established by a preponderance of the evidence that Pictometry Int’l Corp., *Electronic Field StudyTM User Guide*, Version

2.7 (July 2007) (“Pictometry”) (Exhibit 1004) was publicly accessible so as to render it a printed publication under 35 U.S.C. §§ 102(b) and 311(b); the Board’s conclusion that Petitioner has not established by a preponderance of the evidence that Claims 12–15, 21–23, 25–27, 33–38, 44, and 45 of the ’732 patent are unpatentable under 35 U.S.C. § 103(a); the Board’s conclusion that Petitioner has not established by a preponderance of the evidence that that Claims 12–15, 21–23, 25–27, 33–38, 44, and 45 of the ’732 patent are unpatentable under 35 U.S.C. § 103(a) over Pictometry and Michael Gleicher, *Image Snapping*, Advanced Technology Group Apple Computer, Inc., 1995 (“Gleicher”) (Exhibit 1005); any applicable claim construction issues; the Board’s failure to consider the evidence of record and/or the evidence and materials proffered by Xactware; the Board’s findings that conflict with the evidence of record and/or that are not supported by substantial evidence and/or that are otherwise inconsistent with the evidence and materials proffered by Xactware; any other adverse finding or determination made in support of the Decision; and all findings or determinations supporting or related to any or all of those issues, as well as any other issues that were decided adversely to Xactware in any orders, decisions, rulings, and opinions underlying, supporting, leading up to and/or incorporated into the Decision.

Xactware is concurrently filing true and correct copies of this Notice of Appeal to the United States Court of Appeals for the Federal Circuit, along with

the required fees, with the Clerk of the United States Court of Appeals for the Federal Circuit and serving this Notice of Appeal to the United States Court of Appeals for the Federal Circuit on the Director of the United States Patent and Trademark Office.

October 24, 2017

Dated

/Mark E. Nikolsky/

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CERTIFICATE OF SERVICE

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I hereby certify that on October 24, 2017 the original version of this PETITIONER'S NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, including this Certificate of Service, was served by hand on the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office
c/o Office of the General Counsel
10B20, Madison Building East
600 Dulany Street
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I hereby certify that a true and correct copy of this PETITIONER'S NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, including this Certificate of Service, was filed on October 24, 2017 electronically through the Patent Trial and Appeal Board's PTAB E2E system:

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United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that a true and correct copy of this PETITIONER'S NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, including this Certificate of Service, was filed electronically, and the requisite fees are being paid, on October 24, 2017 with the

Clerk's Office of the United States Court of Appeals for the Federal Circuit, 717 Madison Place, NW, Washington, DC 20439 in accordance with the rules of that Court. On October 24, 2017, a true and correct copy of this PETITIONER'S NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, including this Certificate of Service, is also being mailed via Priority Mail Express® to Clerk of Court, United States Court of Appeals for the Federal Circuit, 717 Madison Place, NW, Washington, DC 20439. On October 24, 2017, a true and correct copy of this PETITIONER'S NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, including this Certificate of Service, is also being served via hand service on the Clerk of Court, United States Court of Appeals for the Federal Circuit, 717 Madison Place, NW, Washington, DC 20439. I further certify that, on October 24, 2017, the requisite number of copies of this PETITIONER'S NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, including this Certificate of Service, were served on the United States Court of Appeals for the Federal Circuit, 717 Madison Place, NW, Washington, DC 20439 in accordance with the rules of that Court.

I hereby certify that a true and correct copy of this PETITIONER'S NOTICE OF APPEAL TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT, including this Certificate of Service, has been

served in its entirety on October 24, 2017 via electronic mail and Priority Mail

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Patent Owner.

Case IPR2016-00593
Patent 8,823,732 B2

Before BRYAN F. MOORE, STACEY G. WHITE, and
GARTH D. BAER, *Administrative Patent Judges*.

BAER, *Administrative Patent Judge*.

FINAL WRITTEN DECISION

35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner, Xactware Solutions, Inc., filed a Petition (Paper 1 (“Pet.”)) requesting an *inter partes* review of claims 12–15, 21–23, 25–27, 33–38, 44, and 45 of U.S. Patent No. 8,823,732 B2 (Ex. 1001, “the ’732 patent”). Pursuant to 35 U.S.C. § 314(a), we determined Petitioner showed a reasonable likelihood that it would prevail in establishing the unpatentability of all challenged claims and instituted an *inter partes* review. Paper 13, 13. Patent Owner filed a Patent Owner Response (Paper 31, “PO Resp.”), and Petitioner filed a Reply to Patent Owner’s Response (Paper 32, “Reply”). Patent Owner also filed a Motion to Exclude certain exhibits. Paper 36, “Mot.”. Petitioner filed an Opposition to the Motion to Exclude (Paper 41) and Patent Owner filed a Reply (Paper 43). An oral hearing was held before the Board. Paper 44.

We issue this Final Written Decision pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73. Having considered the record before us, we determine Petitioner has not shown by a preponderance of the evidence that claims 12–15, 21–23, 25–27, 33–38, 44, and 45 of the ’732 patent are unpatentable. *See* 35 U.S.C. § 316(e).

A. *Related Proceedings*

Patents related to the ’732 patent are involved in IPR2016-00582, IPR2016-00586, IPR2016-00587, IPR2016-00589, IPR2016-00590, IPR2016-00591, IPR2016-00592, IPR2016-00594, IPR2016-01775, IPR2017-00021, IPR2017-00027, IPR2017-00034, and IPR2017-000363. The ’732 patent is involved in the following district court matter: *Eagle*

View Technologies, Inc., v. Xactware Solutions, Inc., No. 2:15-cv-07025 (D.N.J.). Pet. 1–2; Paper 4, 2–3.

B. The '732 Patent

The '732 patent relates to a method for creating image products that includes capturing and processing image data to create geo-referenced images. Ex. 1001, (57). Edge detection procedures are then performed on the images on the geo-referenced images. *Id.* The image are saved in a database so that users can interact with the geo-referenced images through a user interface. *Id.*

C. Illustrative Claim

Of the instituted claims, claims 12, 23, and 35 are independent. Claim 12 is illustrative and reproduced below.

12. A sequence of instructions stored on at least one non-transitory computer readable medium for running on a computer system capable of displaying and navigating digital imagery, the sequence of instructions comprising:

instructions for causing the computer system to display a pixel representation of a geo-referenced, edge-detected image, wherein the pixel representation includes one or more detected edges in the geo-referenced, edge-detected image;

instructions for causing the computer system to allow the user to select one of the one or more detected edges by moving a cursor over the pixel representation, wherein the cursor is caused to snap-to a selected detected edge when the cursor is within a predetermined distance from the selected detected edge;

instructions for causing the computer system to allow the user to accept the selected detected edge as an edge of interest; and

instructions for causing the computer system to allow the user to determine and store one or more points of interest along the edge of interest.

Ex. 1001, 9:62–10:16.

D. Asserted Grounds of Unpatentability

We instituted *inter partes* review on the following ground of unpatentability.

Challenged Claims	Basis	References
12–15, 21–23, 25–27, 33–38, 44, and 45	§ 103(a)	Pictometry ¹ and Gleicher ²

Paper 13, 13.

II. ANALYSIS

A. PATENT OWNER’S MOTION TO EXCLUDE EVIDENCE

Patent Owner moves to exclude Exhibits 1004, 1011, 2010–2016, and 2019–2026. Mot. 1. In our Final Written Decision in *Xactware Solutions, Inc., v. Pictometry International Corp.*, IPR2016-00594 (PTAB Aug. 24, 2017) (Paper 46, “IPR2016-00594 FWD”), we considered Patent Owner’s motion to exclude the same evidence (also appearing in the same documents designated as Exhibits 1004, 1011, 2010–2016, and 2019–2026). *See* IPR2016-00594 FWD 5–17. The parties’ arguments in connection with Patent Owner’s motion to exclude in the present *inter partes* review are

¹ ELECTRONIC FIELD STUDY USER GUIDE, VERSION 2.7, PICTOMETRY INT’L CORP. (July 2007) (Ex. 1004, “Pictometry”).

² Michael Gleicher, *Image Snapping*, 1995 (Ex. 1005, “Gleicher”).

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substantively the same as the arguments made in IPR2016-00594. In IPR2016-00594, we denied Patent Owner’s motion to exclude Exhibit 1004 (Pictometry), Exhibit 1011 (a Merriam-Webster Dictionary Definition “database” copied from a web page), Exhibit 2010 (Cohasset Town Report 2008), 2011 (LARIAC1 Pictometry Training), Exhibit 2012 (LAR-IAC2 Product Guide), Exhibit 2020 (“GIS: Pictometry: Oblique Imagery training), Exhibit 2021 (“Pictometry License Guidelines”), and Exhibit 2022 (“Pictometry – April 19, 2007”). IPR2016-00594 FWD 5–17. We granted Patent Owner’s motion to exclude Exhibit 2013 (article titled “Los Angeles County Extends its License Agreement with Pictometry for New Oblique Aerial Photos”), Exhibit 2014 (“Pictometry Administrative Training”), Exhibit 2015 (“Information about TXWILM Administrative Training”), Exhibit 2016 (“Pictometry Administrative Training”), Exhibit 2019 (“GIS Working Group Meeting Minutes”), Exhibit 2023 (“Welcome to Your End User Training”), Exhibit 2024 (“Electronic Field Study Getting Started Guide”), Exhibit 2025 (“Pictometry Announces Technical Advancements for GIS Professionals1”), and Exhibit 2026 (“Pictometry Announces Technical Advancements for GIS Professionals2”). *Id.* We adopt the same findings and conclusions here. For the reasons explained in IPR2016-00594, we deny the motion to exclude Exhibits 1004, 1011, 2010, 2011, 2020, 2021, and 2022, but grant the motion to exclude Exhibits 2013, 2014, 2015, 2016, 2019, 2023, 2024, 2025, and 2026. *See id.*

B. ASSERTED PRIOR ART—PICTOMETRY (EX. 1004)

Exhibit 1004 is titled Pictometry Electronic Field Study User Guide Version 2.7 (“EFS 2.7 User Guide,” “Pictometry,” or “User Guide”) and, as the name suggests, is a user guide for the Pictometry software product. *See* Ex. 1004, xiii. Patent Owner argues that Petitioner does not demonstrate that Pictometry is prior art. PO Resp. 5–10. In our Final Written Decision in IPR2016-00594, we considered substantively the same arguments and evidence Patent Owner and Petitioner raise in this case. *See* IPR2016-00594 FWD 17–29; *compare* IPR2016-00594 Paper 31, 13–20 *with* PO Resp. 6–13; *and compare* IPR2016-00594 Paper 33, 3–9 *with* Reply 4–11. In IPR2016-00594, we found Pictometry’s limited dissemination to some governmental entities subject to licensing restrictions was not sufficient to show public dissemination or public accessibility. IPR2016-00594 FWD 17–29. We adopt that same finding here. For the reasons explained in IPR2016-00594, we find that Petitioner has not established by a preponderance of the evidence that Pictometry was publicly accessible so as to render it a printed publication under 35 U.S.C. §§ 102(b) and 311(b).

C. OBVIOUSNESS OF CLAIMS 12–15, 21–23, 25–27, 33–38, 44, AND 45

Petitioner asserts that claims 12–15, 21–23, 25–27, 33–38, 44, and 45 are unpatentable under 35 U.S.C. § 103(a) as obvious over Pictometry and Gleicher. Pet. 21–37. As noted above, we determine that Pictometry is not a printed publication under 35 U.S.C. §§ 102(b) and 311(b). Because Petitioner’s obviousness ground relies extensively on Pictometry (*see* Pet. 21–37), we conclude Petitioner has not established by a preponderance of

the evidence that that claims 12–15, 21–23, 25–27, 33–38, 44, and 45 are unpatentable under 35 U.S.C. § 103(a) over Pictometry and Gleicher.

III. CONCLUSION

In conclusion, Petitioner has not shown by a preponderance of the evidence that claims 12–15, 21–23, 25–27, 33–38, 44, and 45 are unpatentable under 35 U.S.C. § 103(a).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner has not shown by a preponderance of the evidence that claims 12–15, 21–23, 25–27, 33–38, 44, and 45 of the '732 patent are unpatentable;

FURTHER ORDERED that, Patent Owner's Motion to Exclude is DENIED as to Exhibits 1004, 1011, 2010, 2011, 2012, 2020, 2021, and 2022, and GRANTED as to Exhibits 2013, 2014, 2015, 2016, 2019, 2023, 2024, 2025, and 2026; and

FURTHER ORDERED that, because this is a Final Written Decision, the parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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