

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE INC.,
Petitioner

v.

VISUAL REAL ESTATE, INC.,
Patent Owner

Case IPR2014-01341
Patent 8,078,396

**VRE'S MOTION FOR OBSERVATIONS REGARDING
CROSS-EXAMINATION OF PETITIONER'S
EXPERT WITNESS DR. JOHN R. GRINDON**

Visual Real Estate, Inc. (“VRE”) submits the following observations to the cross-examination of Petitioner’s expert witness Dr. John R. Grindon. VRE deposed Dr. Grindon on September 15, 2015. The Board authorized VRE to file observation on the testimony of Dr. Grindon in its Scheduling Order (Paper No. 12). The transcript of the testimony of Dr. Grindon is provided as VRE Exhibit 2007.

Observation 1: In Ex. 2007, at 26:10-27:14, Dr. Grindon testified:

(Grindon Exhibit 7, U.S. Patent 10 No. 7,239,760 was marked for 11 identification, as of this date.)

Q. U.S. Patent No. 7,239,760 B2 to DiBernardo. Do you recognize Grindon Exhibit 7 [Ex. 2008]?

A. Yes.

Q. Is that one of the same patents that you identified in paragraph three of your October 4, 2011 declaration marked as Grindon Exhibit 4 [Ex. 2002]?

A. Yes.

Q. If you look at it, it was filed on May 16, 2005, correct? Look at the paragraph marked It says filed.

MR. MACEDO: Counsel, you can point it to him if you need to.

A. You're asking the date of filing of the '760 patent?

Q. Correct.

A. May 16, 2005.

Q. And it is claimed to be a division of Application Number

09/758717 filed on January 11, 2001, correct?

A. Yes.

Q. And that's the same serial number as Grindon Exhibit 5 [Ex. 2009, see p. 17:8-18], correct?

A. The numbers appear to be the same, yes.

In Ex. 2007, Dr. Grindon further testified at 45:13-46:10:

Q. Now, the Vederi patent in-suit, Grindon-7 [Ex. 2008], has a filing date of May 16, 2005, correct?

A. Patent '760, which was considered in the Vederi matter?

Q. Correct.

A. Has a filing date of September 22nd. I'm sorry; May 16, 2005.

Q. *Now, if the court had said that the claims that were presented in the '760 patent were not entitled to a priority date before the filing date of the '760 patent, would your opinions in Grindon Exhibit 4 have been different?*

MR. ALMELING: Objection; form. Objection; outside the scope.

A. *Again, I didn't consider in this the declarations that we are here to talk about today. But as I sit here, I am not seeing a reason why there would be a substantive difference in the level of skill in the art even through 2005.* [Emphasis added]

In Ex. 2007, Dr. Grindon further testified at 251:23-252:23,

Q. Whether you read it in 2011 or whether you read it today, what DiBernardo is teaching is that its making a trade off of image quality for computational intensity. Whether you need to do that in 2011 is

another story. What DiBernardo is teaching is to make that trade off, right?

A.. It seems right.

Q. That teaching is true today as it was in 2000, as it was in 2011, as it was in 2004, correct?

A. The teaching referenced to 2000 in DiBernardo.

Q. The teaching in DiBernardo which was written in 2000 is the DiBernardo is teaching you how to do a trade off between image quality and algorithmic complexity.

A. At that time.

Q. Well at any time. But whether you need to do that later on is another story, but it's teaching this is how I trade off on image quality to save on algorithmic complexity, right?

A. If I'm understanding you, that's right.

In Ex. 2007, Dr. Grindon further testified at 303:21-304:21,

Q. But my question is: Would any of the testimony contained in Grindon Exhibit 4 [Ex. 2002] change if DiBernardo's '760 patent [U.S. Patent No. 7,239,760, Ex. 2008] were only entitled to its 2005 filing date?

A. I didn't consider that question directly in the disclosure of Exhibit 1. If you're asking me right now just as I sit here to give you my thoughts on that, I would really have to review this again to see if I would make any changes if the date moved to 2005.

Q. You're not saying that any of the testimony you provided earlier today was wrong; is that correct? You stand by whatever you testified to earlier today?

A. I am not aware as I sit here of any mistakes.

Q. So whatever you testified earlier today is still true tonight as it was whenever you made the testimony?

A. I, again, am not aware of anything that I would change. Just recalling the testimony up to this point.

This testimony is relevant to at least Paper No. 22 (Pet. Reply) at 1-2, 18-20, 22; Ex. 1012 (Grindon Resp. Dec.) at ¶ 15-18; and Ex. 2002 (Grindon's Vederi Dec.) at ¶¶ 28, 38-41. This testimony is relevant because the Petitioner relies on Dr. Grindon's modification and clarification of his Vederi Declaration (Ex. 2002) in Dr. Grindon's Responsive Declaration (Ex. 1012) in asserting invalidity of the '396 patent in the Petitioner's Reply Paper No. 22 at 1-2, 18-20, 22.

Observation 2: In Ex. 2007, at 260:9-261:13, Dr. Grindon testified,

Q. The first embodiment that you're describing in paragraph 37, you talk about the post processing system which includes a computer with a video acquisition card and a processor programmed with instructions to take the image and positional data and create one more composite images for storing into an image database, correct?

A. Essentially, right.

Q. And in the alternative, you talk about the on-the-fly technique where it can go directly from the camera into the image card and done without any additional processing after it's been formed, right?

A. Yes.

Q. And while in your new declaration you say that you could have a hybrid system which does both the on-the-fly, in some instances, and the post processing in other instances, you're not suggesting that DiBernardo would teach that you should do both on the same image, are you?

A. *That wasn't the intent.* Let's look at the declaration. Can you point me to the paragraph?

Q. I'm looking at paragraph 24 on page 17.

A. *The intent was different images, not the same image.*

This testimony is relevant to at least Paper No. 4 (Corr. Pet.); Paper No. 23 (Pet. Reply) at p. 1, 5, 8-24; Ex. 1001 (Fuchs Dec.); Ex. 1012 (Grindon Resp. Dec.) at ¶ 15-21; and Ex. 2002 (Grindon's Vederi Dec.) at ¶ 38. This testimony is relevant because the Petition relies on the prior art reference DiBernardo (Ex. 1005) in asserting the invalidity of the '396 patent. Paper No. 4.

Observation 3: In Ex. 2007, at 161:21-162:12, Dr. Grindon testified,

Q. So the important concepts that you draw out of that is that they should understand computer science image and location; is that correct?

A. That's not what I said. You asked if a person with a computer

science background would be able to do this. Certainly they would if they also had an understanding of some of these engineering concepts that are involved.

Q. What engineering concepts are you talking about?

A. The ones I just mentioned; what's longitude, what's latitude, what are image files. Things of that sort.

Q. What type of engineering is that?

A. That would be electrical engineering.

Q. Electrical engineering teaches you about latitude and longitude; is that your testimony?

A. That is the type of background that would be most useful in understanding not just the mechanics of the process of using the software packages, but also the meaning of the results and what needs to be done.

This testimony is relevant to at least Paper No. 4 (Corr. Pet.); Paper No. 22 (Pet. Reply) at 1-2, 3, 11; Ex. 1001 (Fuchs Dec.) at para 13-17; Ex. 1012 (Grindon Resp. Dec.) at ¶ 12, 17-18; and Ex. 2002 (Grindon's Vederi Dec.) at ¶¶ 12-17. This testimony is relevant because the Petition (and its original Declarant Dr. Fuchs) relies on the definition of a person of ordinary skill in the art as set forth by Dr. Fuchs in asserting invalidity of the '396 patent, which does not include an electrical engineering background. Paper No. 4.

Respectfully submitted,

Dated: September 25, 2015 By: /Charles R. Macedo/

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U.S. Patent No. 8,078,396

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies that on this 25th day of September, 2015, a copy of the foregoing PATENT OWNER'S MOTION FOR OBSERVATIONS was served via e-mail on the counsel of record for the Petitioner at the following e-mail addresses:

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