

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

XACTWARE SOLUTIONS, INC.,
Petitioner,

v.

EAGLE VIEW TECHNOLOGIES, INC.,
Patent Owner.

Case IPR2016-00582
Patent 8,078,436 B2

Before HOWARD B. BLANKENSHIP, BRYN F. MOORE, and
STACEY G. WHITE, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

Petitioner, Xactware Solutions, Inc., filed a Second Corrected Petition requesting an *inter partes* review of claims 1–5, 7–13, 15–23, 25–31, 33–40, 42, 46–52, and 54–56 of U.S. Patent No. 8,078,436 B2 (Ex. 1001, “the ’436 patent”). Paper 10 (“Pet.”). In response, Patent Owner, Eagle View Technologies, Inc., filed a Preliminary Response. Paper 11 (“Prelim. Resp.”). We have jurisdiction under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . the information presented in the petition . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

For the reasons set forth below, we do not institute an *inter partes* review of the ’436 patent.

A. Related Matter

The ’436 patent is involved in the following lawsuit: *Eagle View Tech., Inc. v. Xactware Solutions, Inc.*, No. 2:15-cv-07025 (D. N. J.). Pet. 1–2.

B. Illustrative Claim

Of the challenged claims, claims 1, 18, and 36 are the only independent claims.

Claim 1, reproduced below, is illustrative.

1. A computing system for generating a roof estimate report, the computing system comprising:

a memory;

a roof estimation module that is stored on the memory and that is configured, when executed, to:

receive a first and a second aerial image of a building having a roof, each of the aerial images providing a different view of the roof of the building;

correlate the first aerial image with the second aerial image; and

generate, based at least in part on the correlation between the first and second aerial images, a three-dimensional model of the roof that includes a plurality of planar roof sections that each have a corresponding slope, area, and edges; and

generate and transmit a roof estimate report that includes one or more top plan views of the three-dimensional model annotated with numerical values that indicate the corresponding slope, area, and length of edges of at least some of the plurality of planar roof sections using at least two different indicia for different types of roof properties.

Ex. 1001, 15:58–16:13.

C. Prior Art Relied Upon

Petitioner relies upon the following prior art references:

Yuan Hsieh, *Design and Evaluation of a Semi-Automated Site Modeling System*, CMU-CS-95-195, COMPUTER SCIENCE 1–76 (Nov. 1995) (“Hsieh”) (Ex. 1004).

MARTIN BARBER, APPLICAD PRODUCT BULLETIN, “KEY FEATURES OF OUR ROOFING SOFTWARE” 1–45 (Nov. 2002) (“Applicad”) (Ex. 1005).

D. Asserted Grounds of Unpatentability

Petitioner asserts the following grounds of unpatentability:

Challenged Claims	Basis	References
1–5, 7–13, 15–23, 25–31, 33–40, 42, 46–52, and 54–56	§ 103(a)	Hsieh and Applicad

II. ANALYSIS

A. Overview

Petitioner argues that claims 1–5, 7–13, 15–23, 25–31, 33–40, 42, 46–52, and 54–56 of the '436 patent are rendered obvious by the combination of references listed above. *See supra* Section I.D. Petitioner has the burden to establish in its Petition a reasonable likelihood of success, including, among other things, making a threshold showing that the Hsieh reference is a “printed publications” within the meaning of 35 U.S.C. §§ 102(b) and 311(b). 35 U.S.C. § 314(a); *see* 37 C.F.R. § 42.108(c); *Apple, Inc. v. DSS Tech. Mgmt., Inc.*, Case IPR2015-00369, slip op. at 4–5, 9–11 (PTAB Aug. 12, 2015) (Paper 14). For the reasons set forth below and on this record, Petitioner does not satisfy its burden.

B. Hsieh

Patent Owner argues that Petitioner has not met its burden to demonstrate that Hsieh is prior art. Prelim. Resp. 16–17. We look to the underlying facts to make a legal determination as to whether a document is a printed publication. *Suffolk Techs., LLC v. AOL Inc.*, 752 F.3d 1358, 1364 (Fed. Cir. 2014). A party seeking to introduce a reference “should produce

sufficient proof of its dissemination or that it has otherwise been available and accessible to persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *In re Wyer*, 655 F.2d 221, 227 (CCPA 1981) (quoting *Philips Elec. & Pharm. Indus. Corp. v. Thermal & Elecs. Indus., Inc.*, 450 F.2d 1164, 1171 (3d Cir. 1971)). The determination of whether a document is a “printed publication” under 35 U.S.C. § 102(b) involves a case-by-case inquiry into the facts and circumstances surrounding its disclosure to members of the public. *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). Public accessibility is a key question in determining whether a document is a printed publication and is determined on a case-by-case basis. *Suffolk Techs.*, 752 F.3d at 1364. To qualify as a printed publication, a document “must have been sufficiently accessible to the public interested in the art.” *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009) (citation omitted).

Patent Owner asserts “there is no evidence that Hsieh was indexed or otherwise made accessible to the public, as required.” Prelim. Resp. 9. The Petition did not discuss or submit any affidavit regarding the date of public availability of Hsieh. Petitioner’s Declarant did not discuss the date of public availability of Hsieh. Nevertheless, Hsieh’s contains the following indicia related to the date of public accessibility: a date, “November 1995”; a code, “CMU-CS-95-195,” in the title below the author’s name on the cover page; and, what appears to be a bar code on its back cover, but we have no evidence as to the meaning of that series of numbers or when the bar code was applied to the back of this document. *See* Ex. 1004, 1, 82. Hsieh also

contains a number that appears to be a library Dewey Decimal number “510.7808 C28R 95-195” on the lower left side of the cover. *Id.* at 1. Finally, Hsieh appears to be stamped on the second page with “University Libraries Carnegie Mellon University Pittsburgh PA 15213-3890.” *Id.* at 2. Petitioner does not explain these indicia. Also, we have no affidavit to explain when these indicia were added to the copy of Hsieh that is in the record.

The code and Dewey decimal number *may* show that at some point the reference was indexed but does not indicate the date of indexing or whether it actually was shelved prior to the critical date. *See Lister*, 583 F.3d at 1314 (finding that a document was available in the U.S. Copyright Office, but that was not the end of the inquiry because the court also must consider “whether anyone would have been able to learn of its existence and potential relevance prior to the critical date”). Given this lack of sufficient evidence regarding accessibility prior to the critical date, we also take into account that Petitioner provided no corroborating evidence of the public accessibility of Hsieh. *See Lister*, 583 F.3d at 1317 (“substantial evidence that the Lister manuscript was publicly accessible” not provided and evidence does not “suffice[] to prove a prima facie case of accessibility that would shift the burden” to [applicant] Lister). For the reasons stated above, we find these indicia to be lacking as proof of the date the Hsieh reference was publically accessible.

In view of the foregoing, we conclude that, on this record, Petitioner has not met its burden of at least a preliminary showing that Hsieh is a printed publication as contemplated by 35 U.S.C. §§ 102 and 311(b).

III. CONCLUSION

Petitioner asserts only one challenge, i.e. that claims 1–5, 7–13, 15–23, 25–31, 33–40, 42, 46–52, and 54–56 are obvious over the combination of Hsieh and Applicad. Pet. 47–59. Because we are not persuaded that Petitioner has demonstrated sufficiently that Hsieh is a printed publication available before the priority date, we are not persuaded that Petitioner has demonstrated a reasonable likelihood that claims 1–5, 7–13, 15–23, 25–31, 33–40, 42, 46–52, and 54–56 are unpatentable under 35 U.S.C. § 103(a) over Hsieh and Applicad. Thus, for the foregoing reasons, we determine that the information presented does not show that there is a reasonable likelihood that Petitioner would prevail at trial with respect to at least one claim of the '436 patent, based on any grounds presented in the Petition. On this record, we deny the petition for *inter partes* review of claims 1–5, 7–13, 15–23, 25–31, 33–40, 42, 46–52, and 54–56.

IV. IV. ORDER

Accordingly, it is

ORDERED that that the Petition is DENIED as to all challenged claims of the '436 patent, and no trial is instituted.

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