

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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XACTWARE SOLUTIONS, INC.,  
Petitioner,

v.

PICTOMETRY INTERNATIONAL CORP.,  
Patent Owner.

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Case IPR2016-00594  
Patent 8,542,880 B2

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

MOORE, *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 Corrected Petition (Paper 6 (“Pet.”)) requesting an *inter partes* review of claims 1–10 and 13–20 of U.S. Patent No. 8,542,880 B2 (Ex. 1001, “the ’880 patent”). Pursuant to 35 U.S.C. § 314(a), we determined the Petition showed a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–10 and 13–20 and instituted an *inter partes* review of those claims. Paper 13, 19. Patent Owner filed a Patent Owner Response (Paper 31, “PO Resp.”), and Petitioner filed a Reply to Patent Owner’s Response (Paper 33, “Reply”). Patent Owner also filed a Motion to Exclude certain exhibits. Paper 36 (“Mot.”). Petitioner filed an Opposition to the Motion to Exclude. Paper 42 (“Mot. Opp.”). Patent Owner filed a Reply to Petitioner’s Opposition to the Motion to Exclude. Paper 44 (“Mot. Reply”). An oral hearing was held before the Board. Paper 51.

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 1–10 and 13–20 of the ’880 patent are unpatentable. *See* 35 U.S.C. § 316(e).

### *A. Related Proceedings*

Patents related to the ’880 patent are involved in IPR2016-00582, IPR2016-00586, IPR2016-00587, IPR2016-00589, IPR2016-00590, IPR2016-00591, IPR2016-00592, IPR2016-00593, IPR2016-01775, IPR2017-00021, IPR2017-00027, IPR2017-00034, and IPR2017-00036. The ’880 patent is involved in the following district court matter: *Eagle*

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

*B. The '880 Patent*

The '880 patent relates to a system for determining the attributes of a real world three-dimensional building. Ex. 1001, Abstract. In one embodiment, first location data corresponding to the location of a building is input by a user, and visual access of an aerial image of a region including the roof structure of the building corresponding to the first location data is provided. Ex. 1001, 9:50–10:15, 11:9–16, Figure 3. A moveable visual marker is provided in the region corresponding to the first location data, the visual marker capable of being moved to the top of the building to more precisely identify the location of the building roof structure. *See id.* The relocated position of the visual marker acts as a final location having location coordinates. *See id.* User acceptance of the final location of the visual marker is input, and one or more oblique images of an aerial imagery database corresponding to the location coordinates of the final location are provided to the user. *Id.* at 1:33–56.

*C. Illustrative Claim*

Of the instituted claims, claims 1 and 14 are the only independent claims. Claims 2–10 and 13 depend either directly or indirectly from claim 1 and claims 15–20 depend either directly or indirectly from claim 14.

Claim 1, reproduced below, is illustrative.

1. A process for determining attributes of a roof structure of a real-world three-dimensional building, comprising the acts of:

providing at least one computer input field for a user to input first location data generally corresponding to the location

of the building;

providing visual access to an aerial image of a region including the roof structure of the building corresponding to said first location data, the aerial image taken from a straight down overhead view with respect to the roof structure;

on the aerial image of the region, providing a visual marker that is moveable on a computer monitor around said region, said visual marker initially corresponding to said first location data, wherein said visual marker may be moved to a final location on top of the building to more precisely identify the location of the building roof structure, the final location having location coordinates;

providing a computer input capable of signaling user-acceptance of the final location of said marker; and

providing visual access to one or more oblique images of an aerial imagery database corresponding to location coordinates of the final location.

Ex. 1001, 13:53–14:8.

*D. Asserted Grounds of Unpatentability*

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

<b>Challenged Claims</b>	<b>Basis</b>	<b>Reference</b>
1–10 and 13–20	§ 102(b)	Pictometry <sup>1</sup>

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

## II. ANALYSIS

### A. *Patent Owner's Motion to Exclude Evidence*

Patent Owner moves to exclude several of Petitioner's exhibits, including Exhibits 1004, 1011, 2010–2016, and 2019–2026. Mot. 1. As an initial matter, Petitioner argues that Patent Owner's Motion to Exclude is improper because:

Patent Owner must timely object to evidence it seeks to exclude. 37 C.F.R. § 42.64(b). Patent Owner failed to timely object to Exhibits 2010-2016 and 2019-2026. Accordingly, Patent Owner's motion to exclude these exhibits should be denied. Petitioner served the contents of Exhibits 2010-2016 and 2019-2026 as supplemental evidence on Patent Owner in response to Patent Owner's objections to the Pictometry Manual. Critically, at that time, these documents were not yet formally of record, and therefore did not yet constitute evidence in this proceeding. *See* 37 C.F.R. 42.63(a) ("All evidence must be filed in the form of an exhibit."). Patent Owner filed objections to this supplemental evidence on September 30, 2016 (Paper 17), but these objections were improper because the supplemental evidence was not yet in the record. Patent Owner then introduced Petitioner's supplemental evidence as its own evidence in its Patent Owner Response and filed these documents as Exhibits 2010-2016 and 2019-2026. Patent Owner never objected to Exhibits 2010-2016 and 2019-2026 once they were of record. Petitioner responded to Patent Owner's arguments with respect to Exhibits 2010-2016 and 2019-2026 in its Petitioner Reply. Accordingly, Patent Owner failed to object to Exhibits 2010-2016 and 2019-2026, and thus deprived Petitioner of the opportunity to introduce supplemental evidence.

Mot. Opp. 14–15. In sum, Petitioner argues that Patent Owner's objections were untimely because they were served prior to the subject Exhibits being entered into evidence. Patent Owner responds:

Upon Patent Owner's objections to Exhibit 1004, Petitioner provided fifteen documents as supplemental evidence. Patent Owner timely objected to those documents. *See* Paper 17. In its Response (Paper 31), Patent Owner reiterated those objections, but still substantively addressed that supplemental evidence in the event the Board did not ultimately exclude the evidence. As a result of Patent Owner's efforts, Petitioner was afforded the ability to substantively respond and/or introduce further supplemental evidence as early as Patent Owner's timely objections or with Petitioner's Reply to Patent Owner's Response, but did neither.

Mot. Reply 3. Given the sequence of events, there is no prejudice to Petitioner, who introduced these documents and was served objections at an early stage. Patent Owner apparently cited to the documents in its Patent Owner Response to preserve the right to substantively respond to these documents rather than wait to see if they were presented in Petitioner's Reply. Pursuant to our discretion under 37 C.F.R. § 42.5(c)(3), we do not dismiss Patent Owner's Motion to Exclude due to allegedly untimely filed objections.

Below we address each exhibit Patent Owner moves to exclude.

1. Ex. 1004 will not be excluded

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 it should be excluded as legally irrelevant as Petitioner allegedly has failed to establish that Exhibit 1004 is prior art under 35 U.S.C. § 102. Mot. 1–2. Patent Owner argues that the copyright notice on the EFS 2.7 User Guide is hearsay. *Id.* These issues go

to the sufficiency of the evidence whether Pictometry was publicly accessible. A motion to exclude is the wrong vehicle to challenge public availability, which is a substantive issue that goes to the sufficiency of the evidence, not to admissibility. *FLIR Sys., Inc. v. Leak Surveys, Inc.*, IPR2014-00411, slip. op., Paper 113 at 4 (PTAB September 3, 2015) (“A motion to exclude is not a vehicle for addressing the weight to be given evidence.”); *see also* 77 Fed. Reg. 48,756, 48,767 (Aug. 14, 2012) (“A motion to exclude . . . may not be used to challenge the sufficiency of the evidence to prove a particular fact.”). Thus, we do not exclude Exhibit 1004.

2. Ex. 1011 will not be excluded

Exhibit 1011 is a Merriam-Webster Dictionary Definition for “database” copied or printed from a web page. Ex. 1011. We do not reach claim construction so we do not rely on dictionary definitions in this Decision. Thus, Patent Owner’s Motion to Exclude as to Exhibit 1011 is moot. Exhibit 1011 will not be excluded.

3. Ex. 2010 will not be excluded

Patent Owner argues Exhibit 2010, Cohasset Town Report 2008, should be excluded as irrelevant under Fed. R. Evid. 401 and 402 because it refers to the software, not the User Guide, and does not specifically mention that a member of the public has access to the software, but rather only that Cohasset and the MAPC (“Metropolitan Area Planning Council”) have access. Mot. 5. Patent Owner’s arguments go to the sufficiency of the evidence, not the admissibility of the evidence. Exhibit 2010 is relevant because Petitioner asserts the User Guide was distributed with the software

and the end users were persons of ordinary skill. Thus, Exhibit 2010 will not be excluded.

4. Ex. 2011 will not be excluded

Petitioner argues Exhibit 2011, LARIAC1 Pictometry Training, should be excluded as lacking foundation, incomplete (missing linked documents), irrelevant, hearsay, and lacking authentication (Fed. R. Evid. 104, 106, 401, 402, 802, and 901). Mot. 5–6. Patent Owner’s arguments as to relevance go to the sufficiency of the evidence, not the admissibility of the evidence. Exhibit 2011 has indicia including the URL address and page heading suggesting it is authentic and has foundation. *See* Fed. R. Evid. 901(b)(4) (“[a]pppearance, contents, substance, internal patterns, or other distinctive characteristics, taken in conjunction with circumstances” may establish authenticity). As to the missing links, they do not appear to be necessary to understand the document.

Petitioner offers Exhibit 2011 for the truth of its statements that training sessions for EFS 2.7 (R1.11) software were held in Hartford, Connecticut for municipalities. If an exception does not apply, the rule against hearsay operates to prohibit out-of-court statements from being offered to prove the truth of the matter asserted. Fed. R. Evid. 801–803. Petitioner asserts Exhibit 2011 falls within Fed. R. Evid. 803(8) as a record of public entity (LARIAC) setting out the Los Angeles County office’s activities in providing software training sessions. *See* Mot. Opp. 6; *c.f.* Mot. Reply 4 (arguing Ex. 2011 does not show agency activities). We agree. Ex. 2011 will not be excluded.



5. Ex. 2012 will not be excluded

Patent Owner asserts Exhibit 2012, LAR-IAC2 Product Guide, should be excluded as lacking foundation, irrelevant because it refers to a computer file name without containing evidence of the content of that file, and lacking authentication (Fed. R. Evid. 104, 401, 402, and 901). Mot. 6–7.

Petitioner relies on Exhibit 2012 to show that the User Guide is included with the software in a computer folder. Reply 4–5. Exhibit 2012 is relevant to that issue and has indicia on the first two pages suggesting it is authentic and is an official posting by Los Angeles County and has foundation. *See* Mot. Reply 5; Fed. R. Evid. 901(b)(4), 901(5). Exhibit 2012 will not be excluded.

6. Ex. 2013 will be excluded

Patent Owner asserts Exhibit 2013, “Los Angeles County Extends its License Agreement with Pictometry for New Oblique Aerial Photos,” should be excluded as irrelevant, hearsay, and a best evidence problem (Fed. R. Evid. 401, 402, 802, 1001, and 1002). Mot. 7–8.

Exhibit 2013 is offered to prove the truth of its statement that EFS software was licensed to 88 cities in Los Angeles County in 2006 (Reply 5) and, thus, is hearsay. Fed. R. Evid. 802. Petitioner asserts Exhibit 2013 falls within Fed. R. Evid. 803(18) as a statement in a periodical because the header and URL in the exhibit identify the document as an online newspaper publication. Mot. Opp. 7. Fed. R. Evid. 803(18) states:

Learned Treatises. To the extent called to the attention of an expert witness upon cross-examination or relied upon by the expert witness in direct examination, statements contained in published treatises, **periodicals**, or pamphlets on a subject of

history, medicine, or other science or art, established as a reliable authority by the testimony or admission of the witness or by other expert testimony or by judicial notice. *If admitted, the statements may be read into evidence but may not be received as exhibits.*

*Id.* (emphasis added).

Under a plain language interpretation, this exception applies to documents used by expert witnesses and the last sentence of the rule means that a learned treatise may not be received as an exhibit. Thus, Exhibit 2013 cannot fall under this exception to hearsay. *See, e.g., Fisher v. United States*, 78 Fed. Cl. 710, 714 (Fed. Cl. 2007) (excluding books and articles from admission as exhibits, but permitting statements to be read pursuant to Fed. R. Evid. 803(18)). Exhibit 2013 will be excluded.

7. Ex. 2014, Ex. 2015, and 2016 will be excluded

Patent Owner asserts Exhibit 2014 should be excluded as lacking foundation and authentication (Fed. R. Evid. 104 and 901). Mot. 8–9. Patent Owner does not assert that Exhibit 2014 is hearsay. *Id.* Patent Owner asserts Exhibit 2015, “Information about TXWILM Administrative Training,” should be excluded as lacking foundation, incomplete, irrelevant, hearsay, lacking authenticity, and failing best evidence (Fed. R. Evid. 104, 106, 401, 402, 802, 901, 1001, and 1002). *Id.* Patent Owner asserts Exhibit 2016, “Pictometry Administrative Training,” should be excluded as irrelevant, hearsay, and lacking authentication (Fed. R. Evid. 104, 401, 402, 802, 901, 1001, and 1002). *Id.* Petitioner provides a Declaration stating “Exhibit 2014 is a true and accurate copy of Pictometry Administrative Training PowerPoint, downloaded from <http://documentslide.com/documents/pictometry-administrative-training->

[mikehoran-pictometry-international-customer.html](#)” and “Exhibit 2016 is a true and accurate copy of Pictometry Administrative Training, downloaded from [www.mahaskacounty.org/wpcontent/uploads/2012/08/Training-Overview-.pdf](#).” Paper 43.

As to Exhibit 2014, Patent Owner asserts “[w]e do not know when, from where, or by whom Ex. 2014 was obtained.” Mot. 9. We agree, other than a declaration asserting that the documents were downloaded from a particular website, Petitioner has not explained how or why the document was stored on the “mahaskacounty.org” website or how downloading from that website provides authentication for that document to be what it purports to be, i.e. a Pictometry slide actually used a presentation to a customer.

Rule 901 of the Federal Rules of Evidence requires authentication of evidence “as a condition precedent to admissibility.” Fed. R. Evid. 901. This requirement is satisfied by “evidence sufficient to support a finding that the item is what its proponent claims.” *Id.* Official publications from government websites generally are considered to be self-authenticating. *See Williams v. Long*, 585 F.Supp.2d 679, 686–89 (D.Md. 2008). There, however, is no argument presented that Exhibit 2014 is an official publication and no indicia of the public authority on the printout. *See id.* Printouts from websites are not self-authenticating. *See Sun Protection Factory, Inc. v. Tender Corp.*, 2005 WL 2484710, slip op. at 6, n. 4 (M.D. Fla. Oct. 7, 2005).

In *Lorraine v. Markel American Ins. Co.*, 241 F.R.D. 534 (D. Md. 2007), the court noted that a witness authenticating electronic evidence must “provide factual specificity about the process by which the electronically

stored information is created, acquired, maintained, and preserved without alteration or change, or the process by which it is produced if the result of a system or process that does so.” *Id.* at 545. Thus, to authenticate printouts from a website lacking authenticating indicia and circumstances under Fed. R. Evid. 901(b)(4), the party proffering the evidence must produce “some statement or affidavit from someone with knowledge [of the website] . . . for example [a] web master or someone else with personal knowledge would be sufficient.” *See In re Homestore.com, Inc. Sec.Litig.*, 347 F.Supp.2d 769, 782 (C.D.Cal.2004). The evidence here is insufficient. Thus, Exhibit 2014 will be excluded.

As to hearsay, Exhibits 2015 and 2016 are offered to prove the truth of matters regarding Pictometry training asserted in the exhibits. Reply 5. Petitioner asserts that Exhibits 2015 and 2016 can be admitted under the exception for party admissions. Mot. Opp. 9–10. Federal Rules of Evidence 801(d)(2)(C) and (D) provide that a hearsay exception exists when “[t]he statement is offered against an opposing party and . . . was made by a person whom the party authorized to make a statement on the subject [or] was made by the party’s agent or employee on a matter within the scope of that relationship and while it existed.” Petitioner has not provided evidence of who prepared this document and whether they were authorized to make the statements within the document. Nor did Petitioner present direct evidence that these training slides were actually presented to customers. Thus, Petitioner has not shown these documents fall within an exclusion to hearsay.

Petitioner also argues Exhibit 2015 and 2016 are “admissible under Fed. R. Evid. 807 because each has sufficient circumstantial guarantees of trustworthiness, is offered as evidence of a material fact, is more probative on the point for which it is offered than other evidence Petitioner can obtain through reasonable efforts, and will serve the interests of justice.” Mot. Opp. 13–14. Petitioner does not specify the “circumstantial guarantees” nor why it could not have obtained “more probative” evidence. Thus, we are not persuaded by that argument.

Exhibits 2015 and 2016 will be excluded.

8. Ex. 2019 will be excluded

Patent Owner asserts Exhibit 2019, “GIS Working Group Meeting Minutes,” should be excluded as irrelevant, hearsay and lacking authentication (Fed. R. Evid. 401, 402, 802, and 901). Mot. 11. Petitioner asserts Exhibit 2019 is a self-authenticating official government document from the Metropolitan Planning Commission (Genesee County), a public authority, under Fed. R. Evid. 902(5) and because Exhibit 2019 constitutes meeting minutes from the Genesee County GIS Working Group, a public entity, Exhibit 2019 is admissible as a public record under Fed. R. Evid. 803(8). Mot. Opp. 10. We disagree. There is no indicia on the document tending to provide foundation. *Cf.* Fed. R. Evid. 901(b)(4). Petitioner provides no indication of the source of the document. Exhibit 2019 will be excluded.

9. Ex. 2020 will not be excluded

Patent Owner argues Exhibit 2020, “GIS: Pictometry: Oblique Imagery training,” should be excluded as lacking foundation, irrelevant,

hearsay, and lacking authenticity (Fed. R. Evid. 104, 401, 402, 802, and 901). Mot. 11–12.

Petitioner argues Exhibit 2020 is self-authenticating under Fed. R. Evid. 902(5) because it was obtained from a Connecticut government website as the URL and indicia on the document indicate it was produced by Connecticut government agency including an agency official’s name and contact information. Mot. Opp. 10–11 (citing Ex. 2020); *Williams*, 585 F.Supp.2d at 686–89. We agree. Also, that indicia provides authentication and foundation. *See* Fed. R. Evid. 901(b)(4). Petitioner asserts Exhibit 2020 also falls within Fed. R. Evid. 803(8) as a record of the government of Connecticut, a public entity, setting out training sessions for the EFS software. Mot. Opp. 10–11. We agree. Exhibit 2020 will not be excluded.

10. Ex. 2021 will not be excluded

Patent Owner asserts Exhibit 2021, “Pictometry License Guidelines”, should be excluded as lacking foundation, irrelevant, hearsay, and lacking authenticity (Fed. R. Evid. 104, 401, 402, 802, and 901). Mot. 12–13. However, Patent Owner’s arguments are directed to the sufficiency of the exhibit to prove “live” use of the Pictometry software occurred and are an improper basis for a motion to exclude. *Id.* Therefore, Exhibit 2021 will not be excluded.

11. Ex. 2022 will not be excluded, Exhibit 2023 and 2024 will be excluded

Patent Owner asserts Exhibit 2022, “Pictometry – April 19, 2007”; Exhibit 2023, “Welcome to Your End User Training”; and Exhibit 2024, “Electronic Field Study™ Getting Started Guide” should be excluded as

irrelevant, hearsay, and unauthenticated (Fed. R. Evid. 401, 402, 802, and 901). Specifically, Patent Owner asserts Exhibits 2022, 2023, and 2024 are hearsay and should be excluded under Fed. R. Evid. 802 since they are offered to prove that the training actually occurred (Ex. 2022), or that a User Guide is installed when EFS software is installed (Ex. 2023), or that the document was actually used (Ex. 2024).

Petitioner argues Exhibit 2022 is not hearsay under Fed. R. Evid. 803(8) as a record of the Department of Regional Planning of Los Angeles County, a public entity, evidencing its activities in licensing of the EFS software by that Office. Mot. Opp. 12; *c.f.* Mot. Reply 4 (arguing Ex. 2011 does not show agency activities)). We agree.

Petitioner asserts Exhibits 2023 and 2024 are Patent Owner's own documentation and constitute party admissions under Fed. R. Evid. 801(d)(2)(A). Mot. Opp. 12. Federal Rules of Evidence 801(d)(2)(C) and (D) provide that a hearsay exclusion exists when "[t]he statement is offered against an opposing party and . . . was made by a person whom the party authorized to make a statement on the subject [or] was made by the party's agent or employee on a matter within the scope of that relationship and while it existed." Petitioner has not provided evidence of who prepared this document and whether they were authorized to make the statements within the document. Thus, Petitioner has not shown that these documents fall within the hearsay exclusion.

Petitioner also argues Exhibit 2023 and 2024 are "admissible under Fed. R. Evid. 807 because each has sufficient circumstantial guarantees of trustworthiness, is offered as evidence of a material fact, is more probative

on the point for which it is offered than other evidence Petitioner can obtain through reasonable efforts, and will serve the interests of justice.” Mot. Opp. 13–14. Petitioner does not specify the “circumstantial guarantees” nor why it could not have obtained “more probative” evidence. Thus, we are not persuaded by that argument.

Thus, Exhibit 2022 will not be excluded and 2023 and 2024 will be excluded.

12. Ex. 2025 and 2026 will be excluded

Patent Owner asserts Exhibits 2025 and 2026, “Pictometry Announces Technical Advancements for GIS Professionals<sup>1</sup>” and “Pictometry Announces Technical Advancements for GIS Professionals<sup>2</sup>,” should be excluded as hearsay and lacking authentication (Fed. R. Evid. 802 and 901). Patent Owner’s authentication argument goes to the sufficiency of the evidence to prove public accessibility and are improper. As to hearsay, Petitioner asserts that Exhibits 2025 and 2026 are periodicals citing statements made by Pictometry representatives, and thus constitute party admissions under 801(d)(2)(A). Even if the statements fall under the party admissions exclusion to hearsay, they are also hearsay because the statements are reported in periodicals not a document created by the party making the alleged admission. *See Larez v. Los Angeles*, 946 F.2d 630, 641–45 (9th Cir. 1991) (asserting newspaper articles containing party admissions should be examined under 803(24) [now 807]).

The only exception that colorably applies to these hearsay statements in the periodical is Fed. R. Evid. 807. Petitioner asserts Exhibit 2025 and 2026 evidence the forthcoming release of EFS 2.7 software in 2006 and



early 2007. Reply 5. Petitioner does not specify the “circumstantial guarantees” nor why it could not have obtained “more probative” evidence. For example, Petitioner could have requested information about release dates of the Pictometry software in discovery because Pictometry is a party. Thus, Exhibits 2025 and 2026 will be excluded.

13. Summary

For the reasons above, Exhibits 1004, 1011, 2010, 2011, 2012, 2020, 2021, and 2022 will not be excluded and Exhibits 2013, 2014, 2015, 2016, 2019, 2023, 2024, 2025, and 2026 will be excluded.

*B. Asserted Prior Art — Pictometry*

Patent Owner argues that Petitioner does not demonstrate that Pictometry is prior art. PO Resp. 13–20. Patent Owner, thus, contests whether Pictometry is a prior art “printed publications” in accordance with 35 U.S.C. §§ 102 and 311(b).

1. Principles of Law

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).

## 2. Background

Patent Owner contends that Pictometry is not prior art under 35 U.S.C. § 102(b) because Petitioner failed to demonstrate that Pictometry was publicly accessible. PO Resp. 13–20. In particular, Patent Owner argues that “Petitioner’s evidence shows, if anything, that a Pictometry EFS User Guide was only made available to a closed group of licensees who were governmental entities.” PO Resp. 15.

Pictometry purports to be an “Electronic Field Study™ User Guide.” Ex. 1004, Cover Page. The document contains the notation, “Copyright © 2007 Pictometry International Corp.” *Id.* at ii. Pictometry purports to be a user guide for a software system developed by Pictometry International Corporation, with the guide being “written for both new and current users.” Ex. 1004, xiii. The User Guide is denominated “Version 2.7,” documentation release 2.7.1.3, dated “July 2007,” and states that it was printed in the United States of America. *Id.* at Cover Page, ii. The document contains, further, notices of protected trademarks and an address for Pictometry International Corporation. *Id.* at ii. The foregoing

information in Pictometry appears to be dated nearly two years prior to the effective filing date of the '880 patent (May 29, 2009).

A Pictometry EFS User Guide was provided as part of an image capture system in which government entities were provided a service to capture aerial images. Ex. 2009 (copy of a collective procurement contract and license agreement between Pictometry International Corp. and the Metropolitan Area Planning Commission (“MAPC Agreement”)).

### 3. User Guide Confidentiality Provisions

Patent Owner asserts “the version of Pictometry EFS User Guide proffered by Petitioner as Ex. 1004, shows a user agreement that binds the user to all the terms and conditions of the ‘License Agreement,’ ‘including the use, distribution, and proprietary nature of Pictometry’s Software, Images and Documentation.’” PO Resp. 17 (citing Ex. 1004, 5).

Petitioner argues that the “the copyright notice in the EFS 2.7 User Guide, as well as the indication that the guide was ‘written for both new and current users,’ coupled with notices of protected trademarks, an address for Pictometry International Corporation, and limitations on reproduction, storage, or transmittal of the publication ‘without the prior written permission of Pictometry Corporation’ all indicate that the EFS 2.7 User Guide ‘was a type of document intended for wide distribution.’” Reply 6–7 (citations omitted). We agree that a provision in a copyrighted work disseminated publically that it may not be copied without permission does not defeat the public nature of such a dissemination. As discussed below, however, there are further limitations on the dissemination of the User Guide.

4. User Guide Licensing Provisions

Patent Owner asserts that Pictomerty was made available only to a closed group of licensees. PO Resp. 15. Evidence suggests the User Guide was provided only to licensees who purchased access to the Pictomerty software. Ex. 2009. We agree with Patent Owner. *Cf. Garrett Corp. v. U.S.*, 422 F.2d 874, 878 (Ct. Cl. 1970) (emphasis added) (citation omitted)

(While *distribution to government agencies and personnel alone may not constitute publication* . . . distribution to commercial companies *without restriction* on use clearly does. Also pertinent is the fact that after 1950, the report was made available for dissemination in the United States through the Defense Department to government contractors who were advised of its availability and could obtain copies upon request at no cost.)

As recognized in *Garrett*, “[t]o be a ‘publication’ under the statute, a document must, among other things, be accessible to the public,” wherein the public “constitutes that class of persons concerned with the art to which the document relates and thus most likely to avail themselves of its contents.” *Id.* at 877–78. The factors bearing on whether a printed document was indeed published set forth in *Garrett*, include “the number of copies made, availability, accessibility, dissemination, and even intent.” *Id.* at 878.

The license agreement with the MAPC goes further than the copyright limitations in the User Guide itself. As shown by the MAPC Agreement, the Documentation, such as any EFS User Guide, was confidential and the license agreement bound the licensee to keep such documentation confidential. The license agreement defines “Licensed Documentation” as “written and/or electronic materials containing instructions and other

information related to the use of the Licensed Images and Licensed Software.” MAPC Agreement, Ex. 2009, p. 14, Article 1.10. The Licensed Documentation is included in the “Licensed Products” controlled by the MAPC Agreement. Ex. 2009, p. 14, Article 2.1.

The MAPC Agreement states that workstations upon which the Licensed Products are installed must be owned or leased by, located on the property of, under the control of, and used only by the Licensee or Authorized Subdivisions. Further, the Licensed Documentation could only be accessed through designated workstations and servers. Ex. 2009, p. 14, Article 3.1. Remote access to the Licensed Products by unauthorized persons is also prohibited under the MAPC Agreement. Ex. 2009, p.15, Article 3.2.

Copying, publication, transmittal, and sale of the Licensed Products are also prohibited. *Id.* The MAPC Agreement states under “Confidentiality of Licensed Products” that the Licensed Products are commercially valuable, proprietary products owned by Pictometry and are treated by Pictometry as confidential and contain substantial trade secrets of Pictometry. Ex. 2009, 16, Article 8.4. The licensee agrees that it will not disclose, provide a copy of, or disseminate the Licensed Products and that its personnel will protect the Licensed Products from unauthorized use, disclosure, copying, and dissemination, and that access to the Licensed Products and each part thereof will be strictly limited. *Id.* We acknowledge that these represent significant limitations on the dissemination of the User Guide.

5. Burden of Proof is on Petitioner

Petitioner asserts “the MAPC Agreement is only a single contract involving the EFS software and provides no evidence that the EFS software and the EFS 2.7 User Guide were actually maintained confidential by the parties of the MAPC Agreement, or that the EFS software and the EFS 2.7 User Guide were inaccessible to those of ordinary skill in the art.” Reply 9. However, this improperly puts the burden to disprove public accessibility on Patent Owner.

Although Patent Owner challenges whether Pictometry is a printed publication, the burden remains on Petitioner to demonstrate unpatentability. *See Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (*citing Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1326–27 (Fed. Cir. 2008)) (discussing the burden of proof in an *inter partes* review). Petitioner must demonstrate by a preponderance of the evidence that the challenged claims are unpatentable, and one aspect of such a showing is that the references relied upon are patents or printed publications. *See* 35 U.S.C. §§ 311(b) 316(e).

6. Petitioner’s Reply Evidence of Public Accessibility

Petitioner offers several documents to support its contention that Pictometry was publically accessible despite the license restrictions. Reply 3–7, 9. Initially, we address some common arguments made by Petitioner for context. Petitioner appears to equate public institutions such as state and local agencies with the “public” for purposes of public dissemination. *Id.* We disagree. Dissemination to “public institutions” is to the government and, as suggested in *Garrett*, is not equivalent to dissemination that provides

accessibility to the interested general public. *Cf. Garrett Corp.*, 422 F.2d at 878. Additionally, dissemination to government agencies or commercial entities under obligations not to further disseminate the Pictometry User Guide (even if some employees of those entities are ordinarily skilled artisans) is not a “public” dissemination, but rather a limited dissemination. *See ServiceNow, Inc. v. Hewlett-Packard Co.*, Case IPR2015–00707 (PTAB Aug. 26, 2015) (Paper 12) (considering a “statement restricting use and dissemination” of a reference to undermine public accessibility”); *see also In re Wyer*, 655 F.2d 221, 227 (C.C.P.A. 1981) (“[I]ntent to make public [and] activity in disseminating information . . . may aid in determining whether an item may be termed a ‘printed publication.’”); *cf. Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1351 (Fed. Cir. 2008) (finding that “ETSI did not impose restrictions on ETSI members to prevent them from disseminating information about the standard to nonmembers,” which weighed toward public accessibility). Also, viewing images or demonstrations or even public use of the software is not a public dissemination *of the User Guide itself*, which is the only reference that is alleged to be prior art in this case. Given that understanding, Petitioner presents the following evidence of public accessibility.

Petitioner relies on the Cohasset Town Report that mentions, in April 2008, aerial imagery captured by Pictometry “may be viewed through Pictometry’s Electronic Field Study software version 2.7, which is also available at no cost to municipalities.” Reply 4 (citing Ex. 2010, 26). However, the Cohasset Town Report does not state that the general public

would have access to the imagery or the software, including the User Guide. Ex. 2010.

Petitioner asserts the LARIAC1 Pictometry Training website printout discloses that training sessions were held relating to the EFS software in 2007 and 2008. Reply 4 (citing Ex. 2011). Petitioner cites to a website printout that purports to have a last modified date of April 6, 2009, to show training sessions for EFS 2.7 (R1.11) software were held in Hartford, Connecticut for municipalities which Petitioner states are “public entities.” *Id.* at 6 (citing Ex. 2020). Also, Petitioner cites to Exhibit 2022 as evidence that EFS training seminars were held in 2007. Ex. 2022. Petitioner asserts this evidences that, at least as early as 2007, the EFS software was shown during training sessions for governmental entities, which the Petitioner describes as “public.” *Id.* at 4. However, as explained above, showing the software to government employees under licensing restriction establishes neither that the User Guide was disseminated, nor that the dissemination was public. *Cf. Garrett Corp.*, 422 F.2d at 878.

Petitioner relies on Exhibit 2012 to show that the User Guide is included with the software in a computer folder. Reply 4–5. Petitioner cites to Exhibit 2021 as evidence that Pictometry permits live usage of the EFS software at public meetings, as well as installation and use of the software on town-owned computers at municipal halls which Petitioner asserts are “public entities and location.” Reply 6. Exhibit 2021 states “it is acceptable to use the Pictometry images in a ‘live’ setting as long as you are using it to conduct town business.” Ex. 2021. This statement does not amount to allowing unfettered access to the User Guide for the pertinent part of the



public. For example, Exhibit 2021 does not state that the public will have access to use the software as opposed to agency employees using “images” from the software, nor does it state that the User Guide that Petitioner actually relies on as prior art was accessible to the public. Ex. 2021, 1–2. Even if the User Guide was in a folder on a computer available to the public as suggested by Petitioner, Petitioner has not shown that a member of the public would be aware that a User Guide was stored in a folder on the computer, or that they could locate it exercising reasonable diligence. *See In re Lister*, 583 F.3d 1307, 1311. Also, Ex. 2021 is concerned with the use or distribution of imagery from the Pictometry software and very specifically limits public access to even that aspect of the Pictometry product. If anything, Exhibit 2021 shows that Pictometry took the confidentially provisions of its license seriously.

Even if use of the software could have been viewed at a “public” meeting without a license as Petitioner contends (Reply 5), Exhibit 2021 does not refer to the User Guide, which is the asserted prior art. Petitioner does not present sufficient argument or evidence showing that the User Guide was publicized or otherwise accessible. *See SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1197 (Fed.Cir. 2008) (“[A]n unpublicized paper with an acronym file name posted on an FTP server resembles a poster at an unpublicized conference.”); *Virginia Innovation Scis., Inc. v. Samsung Elecs. Co.*, 983 F. Supp. 2d 713, 738 (E.D. Va. 2014) (prior art in question was not sufficiently shown to be generally on sale to the interested public, and was instead “restricted” to members of a publishing organization, which required membership dues for access).

The lack of evidence of widespread dissemination of the software as a commercially available product to the public as opposed to being licensed only to certain governmental agencies, and the restrictions on copying and dissemination, notwithstanding dissemination to certain governmental agencies with restricted access, undermines Petitioner's contention that Pictometry is a printed publication. Ultimately, Petitioner does not provide evidence or persuasive argument that even a "live" presentation about Pictometry software would have lead an ordinarily skilled artisan to the User Guide in the absence of obtaining a license or obtaining other special access to the Pictometry software.

Under these circumstances, the use by the government agencies does not constitute sufficient dissemination or accessibility. Petitioner does not show unrestricted access to the User Guide to any specified number of interested skilled artisans "merely for the asking." *See Aluminum Co. of Am. v. Reynolds Metals Co.*, 1989 WL 165064, at \*2 (N.D. Ill. 1989) (document with export control notice distributed to thirty-three groups, including "thirteen nongovernmental companies and individuals," held not "publically accessible" where groups treated document as confidential by not circulating it further—i.e., it was not "accessible 'merely for the asking'") (citation omitted)). Pictometry's restrictive license language, and restrictions on use of the imagery, indicate an intent to restrict use, copying, and further dissemination. *Cf. Garrett Corp.*, 422 F.2d at 878 (Ct. Cl. 1970).

7. Excluded Exhibits

We have excluded Exhibits 2013, 2014, 2015, 2016, 2019, 2023, 2024, 2025, and 2026. We note, however, that these exhibits would not change our opinion as to the public accessibility of the Pictometry reference.

Exhibit 2013 is offered to prove that EFS software was licensed to 88 cities in Los Angeles County in 2006 (Reply 5). As noted above, providing the software to government employees under licensing restriction is not a public dissemination of the User Guide. *Cf. Garrett Corp.*, 422 F.2d at 878. Petitioner asserts Exhibit 2014, Pictometry’s PowerPoint training slides, state that the software also installs the EFS 2.7 User Guide (slide 16) and that users can freely make as many copies of the EFS 2.7 User Guide as they would like (slide 17). Reply 5. Exhibit 2015 is offered to show that the PowerPoint file of Exhibit 2014 was created April 29, 2003 and last modified on September 16, 2008, which according to Petitioner, places the evidence of Exhibit 2014 well before the priority date of the ’880 patent. Reply 5.

According to Petitioner, Exhibits 2014 and 2015 are “evidence that the user guide was distributed with the software, and an admission by Pictometry that it permitted unlimited copies of the EFS 2.7 User Guide to be made.” *Id.* The slides state “Can make this available to whomever needs access to it. You can print as many as needed.” Ex. 2014, slide 16. Even if we considered this evidence, we would give it little weight because the language on the slide is not corroborated by any testimony explaining its meaning. The slide purports provide access to “whomever needs access to it.” *Id.* In the context of a presentation to users of a software licensed by an

employer, if the Exhibits 2014 and 2015 were considered, we would determine it is unlikely that such a statement would be understood to be an invitation to provide copies to the general public.

Exhibit 2016 describes end user training including installation and use of EFS software and is offered apparently to show training of public users.

Reply 5. As noted above, providing training regarding the software to government employees under licensing restriction is not a public dissemination of the User Guide.

Exhibits 2019, 2025, and 2026 are offered to show the forthcoming release of EFS 2.7 software in 2006 and early 2007. Reply 5. However, Petitioner's failure to show public accessibility does not rest on whether the software was released prior to the critical date.

Exhibit 2023 is offered as evidence of the installation of EFS 2.7 User Guide on computers when EFS 2.7 software is installed (slides 43–44).

Reply 6. This is duplicative of Exhibit 2012 and is not persuasive of public accessibility for the same reasons stated above with regard to Ex. 2012.

Exhibit 2024 is offered as evidence of encouragement by Pictometry that new users consult the EFS 2.7 User Guide. As noted above, providing the User Guide to “new users” who are government employees or other entities under licensing restriction is not a public dissemination.

Thus, the excluded exhibits do not show by a preponderance of the evidence that Pictometry was publically accessible and would not change our opinion as to public accessibility.

8. Summary

On balance, Petitioner does not make a sufficient showing of dissemination or public accessibility. Petitioner does not argue clearly, and the record does not show based on any such argument, that dissemination to some governmental entities and entities subject to licensing restriction on dissemination constitutes sufficient public dissemination to ordinarily skilled artisans.

Accordingly, 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).

*C. Anticipation of Claims by Pictometry*

Petitioner asserts that claims 1–10 and 13–20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Pictometry. Pet. 16. As noted above, we determine that Petitioner has not shown that Pictometry is a printed publication under 35 U.S.C. § 102(b). Thus, Petitioner has not established by a preponderance of the evidence that that claims 1–10 and 13–20 are unpatentable under 35 U.S.C. § 102(b) as anticipated by Pictometry.

III. CONCLUSION

In conclusion, Petitioner has not shown by a preponderance of the evidence that claims 1–10 and 13–20 are unpatentable under 35 U.S.C. § 103(a).

IV. ORDER

In consideration of the foregoing, it is hereby:

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ORDERED that Petitioner has not shown by a preponderance of the evidence that claims 1–10 and 13–20 of the '880 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. Exhibits 2013, 2014, 2015, 2016, 2019, 2023, 2024, 2025, and 2026 are excluded from the trial; 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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