

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
Petitioner,

v.

PARKING WORLD WIDE LLC,
Patent Owner.

IPR2023-00385
Patent 10,438,421 B2

Before WILLIAM V. SAINDON, BENJAMIN D. M. WOOD, and
ROBERT J. SILVERMAN, *Administrative Patent Judges*.

WOOD, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Oracle Corporation (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–7 of U.S. Patent No. 10,438,421 B2 (Ex. 1001, “the ’421 patent”). Parking World Wide LLC (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). Upon considering the Petition and the Preliminary Response, we determine that Petitioner has satisfied this threshold requirement, and therefore we institute *inter partes* review of claims 1–7 of the ’421 patent.

B. Related Proceedings

The parties state that the ’421 patent has been asserted in the following district court proceedings: *Parking World Wide, LLC v. City of Clayton*, Case No. 4:22-cv-01373 (E.D. Mo.) (filed Dec. 26, 2022); *Parking World Wide, LLC v. City of St. Louis*, Case No. 4:22-cv-01252 (E.D. Mo.) (filed Nov. 22, 2022). Pet. 4; Paper 5, 1.

The parties state that the ’421 patent was previously at issue in: *Parking World Wide, LLC v. City of San Francisco et al.*, Case No. 4:21-cv-01499 (E.D. Mo.) (filed Dec. 23, 2021, dismissed Aug. 15, 2022). Pet. 4; Paper 5, 2.

C. The '421 Patent

The '421 patent, titled “Parking Status System,” issued October 8, 2019, from an application filed December 5, 2014. Ex. 1001, codes (21), (22), (45), (54). The '421 patent describes a parking status system that overlays on a real-time image of a street, lot, or garage the payment status of any parking space shown in the image. *Id.* at code (57).

Figure 6 of the '421 patent, reproduced below, illustrates the operation of the parking status system of the '421 patent. Ex. 1001, 7:18–20, 13:28–30.

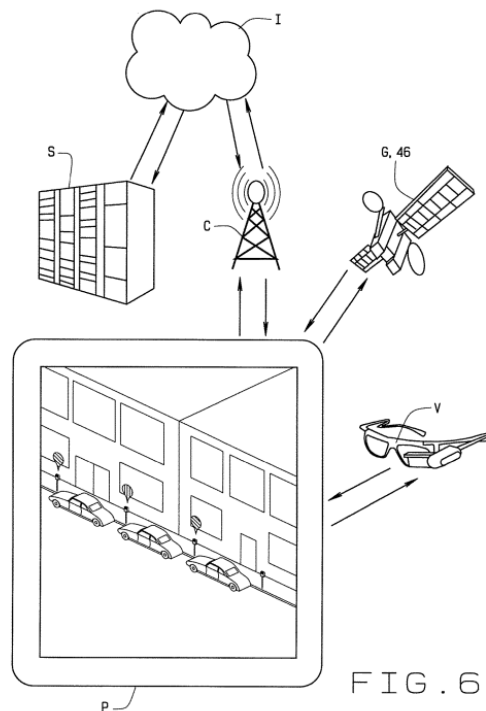


Figure 6 shows a pictorial representation of the communication channels and devices used by the parking status system of the '421 patent. *Id.* at 7:18–20, 13:28–30.

The parking status system of the '421 patent generally operates on a portable electronic device—e.g., a tablet or virtual video glasses V—used by parking control officer P. Ex. 1001, 13:28–49, Fig. 6. The parking status

system displays a live visual image of the actual street scene in front of the device. *Id.* at 7:45–8:8, Fig. 1. The device ascertains its position using fixes from GPS system G and its orientation using an onboard gyroscope and compass, and communicates both, via wireless telecommunications network C and Internet I, to parking authority servers S. *Id.* at 14:7–10. The system then obtains the payment status (paid or unpaid) of parking spaces appearing in the image from server S or, alternatively, from the meters themselves (so called “smart meters”), or from a sensor embedded in the street surface of the parking space that detects the presence or absence of a vehicle over it. *Id.* at 8:29–40, 11:17–19. The meters’ payment status is visually displayed on the meters appearing in the image viewed on the device; for example, a green flag may appear over a parking space that has been paid for, and a red flag may appear over an unpaid parking space. *Id.* at 11:63–12:6. Displayed payment-status markers allow the parking control officer to readily determine if vehicles near the officer are improperly parked in an unpaid space:

The parking control officer glances at the visual image on the portable electronic device to identify unpaid parking spaces and then glances at the actual scene to find vehicles in the unpaid parking spaces. The parking control officer then proceeds with enforcement measures against the vehicles in unpaid spaces, such as writing parking tickets or deploying a boot.

Id. at 9:25–32.

D. The Challenged Claims

Petitioner challenges claims 1–7 of the ’421 patent. Pet. 1. Claims 1 and 5 are independent. Ex. 1001, 17:33–18:20, 18:37–20:8. Claim 1 is reproduced below (with Petitioner’s limitation designations added):

1. [1.PRE] A method for representing the parking status of a plurality of parking spaces to a screen of a user's portable electronic device upon a real time camera view, any of said at least one parking space being one of PAID for current payment and UNPAID upon exhaustion of payment, any of a plurality of subscribers utilizing said method to reserve at least one of the plurality of parking spaces and then to pay for at least one of the plurality of parking spaces, the method comprising:

[1.A] assembling a database upon a computer of said plurality of parking spaces, said database including geographic locations of said plurality of parking spaces and time limits applicable to each of said plurality of parking spaces;

[1.B] updating a database upon a computer of subscribers, said database including a list of parking spaces reserved by each subscriber, a list of parking spaces paid for by each subscriber, and a list of the expiration times for each paid for parking space of each subscriber;

[1.C] calculating a location of said user, said calculating a location of said user adapted to utilize a location finding feature of said user's portable electronic device;

[1.D] determining upon a computer a location of one of said plurality of parking spaces by comparing the location of said user to said database of said plurality of parking spaces and selecting one of said plurality of parking spaces within eight to ten feet of the position of said user;

[1.E] comparing upon a computer the location of one of said plurality of parking spaces with said database of subscribers further comprising comparing upon a computer the location of one of said plurality of parking spaces against said list of parking spaces paid for by said subscribers for a match between said location and said list of parking spaces paid for by said subscribers;

[1.F] upon detecting a match between said location and said list of parking spaces paid for by said subscribers, comparing the matched parking spaces to said list of expiration times and upon detecting the matched parking spaces exceeding an expiration time displaying upon said user's screen an UNPAID payment indicia upon an image of the matched parking space, wherein the user may execute enforcement measures upon any vehicle in said matched parking space showing said UNPAID indicia;

[1.G] wherein said method transforms upon a computer location data of said plurality of parking spaces and payment status data of said plurality of parking spaces into indicia of UNPAID parking spaces;

[1.H] said comparing the matched parking space to said list of expiration times and upon detecting the matched parking space exceeding an expiration time and said method places said indicia of UNPAID on an image of a matched parking space upon the real time camera view on the screen of a user's device for enforcement.

Ex. 1001, 17:33–18:20 (Claim 1).

E. Asserted Grounds of Unpatentability

Petitioner contends that the challenged claims are unpatentable based on the following specific grounds (Pet. 9):¹

¹ Petitioner's list of grounds (Pet. 6) erroneously indicates that claim 7 is challenged under Grounds 1 and 3, and claim 6 is challenged under Grounds 2 and 4.

No.	Claims Challenged	35 U.S.C. §	Reference(s)/Basis
1	1–3, 5, 6	§ 103	Ivey, ² Matsumoto, ³ Tillotson ⁴
2	4, 7	§ 103	Ivey, Matsumoto, Tillotson, Slemmer ⁵
3	1–3, 5, 6	§ 103	Ward, ⁶ Haynes, ⁷ Tillotson
4	4, 7	§ 103	Ward, Haynes, Tillotson, Slemmer

Petitioner also relies on the Declaration of Dr. Joseph Paradiso (Ex. 1003) to support its proposed grounds. Pet. 9 (citing Ex. 1003 (“Paradiso Decl.”)).

II. ANALYSIS

A. *Legal Standards Used in the Merits Analysis*

“In an IPR, the petitioner has the burden from the onset to show with particularity why the patent it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016) (citing 35 U.S.C.

² Ivey et al., US 2006/0059037 A1, published March 16, 2006 (Ex. 1005).

³ Matsumoto, JP 2008-217835 A, published September 18, 2008 (Ex. 1006), for which Petitioner submitted a Certified English Translation (Ex. 1007).

⁴ Tillotson et al., US 2006/0250278 A1, published November 9, 2006 (Ex. 1011).

⁵ Slemmer et al., US 2006/0170566 A1, published August 3, 2006 (Ex. 1010).

⁶ Ward, US 2008/0114675 A1, published May 15, 2008 (Ex. 1008).

⁷ Haynes et al., US 7,123,166 B1, issued October 17, 2006 (Ex. 1009).

§ 312(a)(3) (requiring *inter partes* review petitions to identify “with particularity . . . the evidence that supports the grounds for the challenge to each claim”)); *Dynamic Drinkware, LLC v. Nat’l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (discussing the burden of proof in *inter partes* review).

A claim is unpatentable under 35 U.S.C. § 103 if “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious . . . to a person having ordinary skill in the art to which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including: (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective evidence of nonobviousness, i.e., secondary considerations. *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17–18 (1966).

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art would have had

at least a Bachelor’s Degree in computer science, electrical engineering, or a related subject, and two years of experience working with augmented reality, portable electronic devices, mobile computing, databases, computer networks, or related technologies. A more advanced degree can substitute for work experience. This POSITA would be aware of and generally knowledgeable about the structure and operation of augmented reality devices as well as different databases and computer networks. Paradiso Decl., ¶¶ 40–43.

Pet. 15.

Patent Owner submits that it “does not believe it is necessary to address at this time Petitioner’s proffered level of ordinary skill in the art for the limited purpose of [the] Preliminary Response,” but “[i]f *inter partes* review is instituted, Patent Owner will address the level of ordinary skill in the art in its Patent Owner Response.” Prelim. Resp. 13. Patent Owner also submits that “[f]or purposes of this Preliminary Response, Petitioner’s proffered level of skill for a POSA is sufficient.” *Id.*

We discern no reason, at this stage of the proceeding, to question Petitioner’s proposed level of ordinary skill, and therefore adopt Petitioner’s definition for purposes of this Decision.

C. Claim Construction

We construe claim terms “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. [§] 282(b), including construing the claim in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” 37 C.F.R. § 42.100(b); *see Phillips v. AWH Corp.*, 415 F.3d 1303, 1312–13 (Fed. Cir. 2005) (en banc). Any special definitions for claim terms must be set forth in the Specification with reasonable clarity, deliberateness, and precision. *See In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Petitioner “submit[s] that the terms of the 421 Patent’s claims do not require further construction and can be afforded their plain and ordinary meaning.” Pet. 14–15 (citing *Paradiso Decl.* ¶ 78). Petitioner submits that the Petition’s “sections comparing the claims to the prior art include further

discussion of the plain and ordinary meaning of certain claim terms.” *Id.* at 15 (citing *Paradiso Decl.* ¶¶ 115–386).

Patent Owner “also does not believe it is necessary to address claim construction for the limited purpose of th[e] Preliminary Response because the deficiencies in the Petition are not affected by particular claim constructions,” and notes that “[i]f *inter partes* review is instituted, Patent Owner will address the claim construction in its Patent Owner Response.” Prelim. Resp. 13.

For purposes of this Decision, and based on the record before us, we determine that no construction of any term is necessary, as the threshold question of institution can be decided without doing so. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (approving Board decision not to construe claim language where the construction is not material to the dispute).

D. Ground 1: Claims 1–3, 5, and 6—Ivey, Matsumoto, and Tillotson

Petitioner alleges that claims 1–3, 5, and 6 would have been obvious over Ivey, Matsumoto, and Tillotson. Pet. 9, 23–49. Patent Owner opposes. Prelim. Resp. 13–21.

1. Ivey (Ex. 1005)

Ivey is titled “Local Enforcement of Remotely Managed Parking Payment Systems,” and “relates to the field of computer-implemented parking payment status displays, and more specifically to a particularly efficient graphical representation and intuitive user interface by which a parking control officer can verify remotely administered payment of parking

fees.” Ex. 1005, code (54), ¶ 1. Figure 1 of Ivey, reproduced below, illustrates a hand-held computer displaying a parking status map. *Id.* ¶ 9.

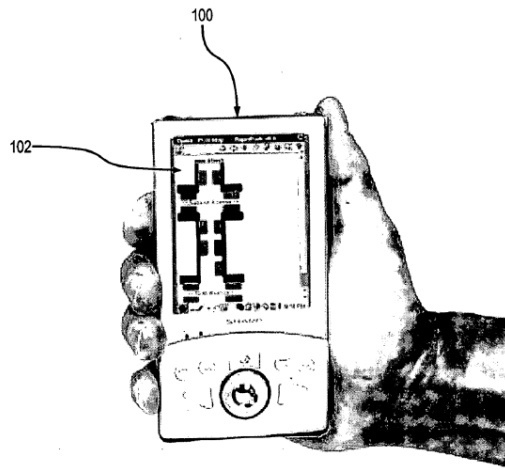


FIGURE 1

Figure 1 illustrates a hand-held computer which shows a parking status map. *Id.* ¶ 9.

Parking payment status map 100 shown in Figure 1 is received from server 502 via wide area network 504, and displayed on hand-held computer 102 carried by a parking control officer. *Id.* ¶¶ 20, 25, Figs. 5, 6. Parking payment status map 100 includes spatially-related representations of parking spaces, indicating each space’s status as paid or unpaid. *Id.* ¶ 20, Fig. 3. For example, paid spaces may be shown in green and unpaid spaces may be shown in red. *Id.* ¶ 22, Fig. 3.

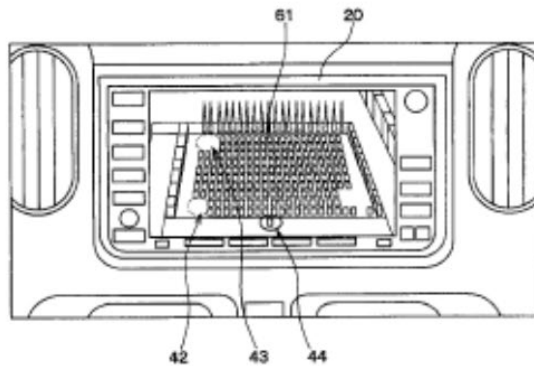
2. *Matsumoto (Exs. 1006, 1007)*

Matsumoto is titled “Parking Lot Guidance System,” and “relates to a system for indicating to the user the vacant status of a parking lot.” Ex. 1007, Abstract. Matsumoto’s parking lot guidance system employs a host computer associated with the parking lot that “generates an image

which makes it possible to visually recognize a vacant parking space in a parking lot . . . on the basis of a bird's-eye image of the parking lot . . . photographed by a camera” and transmitted to nearby vehicles. *Id.*

Figure 5 of Matsumoto, reproduced below, shows an example of a display of a live-action image, and Figure 6 of Matsumoto, reproduced below, shows an example of a display of a live-action image with a vacant parking space highlighted. *Id.* ¶ 74.

[Fig. 5]



[Fig. 6]

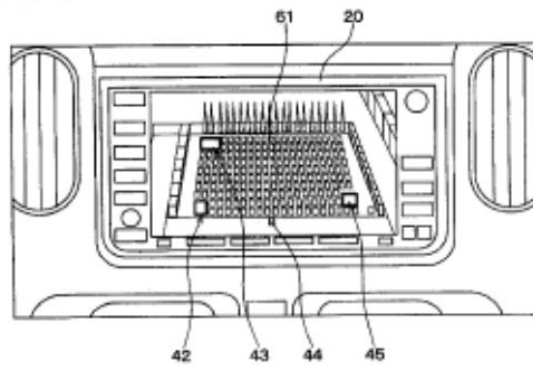


Figure 5 shows an example of a display of a live-action image, and Figure 6 shows an example of a display of a live-action image with a vacant parking space highlighted. *Id.* ¶ 74.

Figure 5 illustrates a live-action image shown on display device 20 of car navigation device 10 showing vacant spaces 42 and 43 and vehicles 61 at other positions in the parking lot. *Id.* ¶ 59. Figure 6 illustrates the same lot with vacant parking space in areas 42, 43, and 45 highlighted, e.g., with a bold line surrounding each vacant space superimposed on the photographed image. *Id.* ¶ 60.

3. *Tillotson (Ex. 1011)*

Tillotson is titled “System and Method for Assessing Parking Space Occupancy and for Reserving Same,” and “relates to systems and methods

for traffic control, and in particular to a system and method for monitoring and reserving parking spaces.” Ex. 1011, code (54), ¶ 2. Tillotson’s parking space information and reservation system (PSIRS) identifies available parking spaces and allows users to reserve and pay for an available space. *Id.* at code (57), ¶ 23, Fig. 2.

4. *Principles of Law*

“A patent for a claimed invention may not be obtained, notwithstanding that the claimed invention is not identically disclosed as set forth in [35 U.S.C. § 102], if the differences between the claimed invention and the prior art are such that the claimed invention as a whole would have been obvious before the effective filing date of the claimed invention to a person having ordinary skill in the art to which the claimed invention pertains.” 35 U.S.C. § 103. Obviousness is a question of law based on underlying findings of fact. *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). The underlying factual considerations “include the scope and content of the prior art, the differences between the prior art and the claimed invention, the level of ordinary skill in the art, and any relevant secondary considerations” of non-obviousness, including commercial success of the patented product or method, a long-felt but unmet need for the functionality of the patented invention, and the failure of others who have unsuccessfully attempted to accomplish what the patentee has achieved. *Id.* at 17–18. The obviousness analysis should not be conducted “in a narrow, rigid manner,” but should instead focus on whether a claimed invention is merely “the result[] of ordinary innovation,” which is not entitled to patent protection. *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007).

5. *Claim 1*

a. Petitioner's Contentions

Petitioner contends that Ivey teaches limitations [1.A], [1.E], [1.F], and [1.G]. Pet. 25–26, 31–35. Petitioner further contends that the preamble is taught by Ivey in view of Matsumoto and Tillotson; limitation [1.B] is taught by Ivey in view of Tillotson; and limitations [1.C], [1.D], and [1.H] are taught by Ivey in view of Matsumoto. *Id.* at 24–25, 26–31, 35–36. Petitioner supports these contentions with specific citations to the record and with Dr. Paradiso's testimony. At this stage of the proceeding, Patent Owner does not dispute Petitioner's contentions regarding the teachings of the prior art.

Petitioner further submits that one of ordinary skill in the art would have displayed Ivey's parking-space-payment information on a real-time camera view, as taught by Matsumoto, to “more efficiently streamline parking enforcement.” Pet. 47–48. Regarding the modified Ivey with Tillotson, Petitioner asserts:

A POSITA would have recognized that adapting Ivey in view of Tillotson's teachings would have been advantageous to both Ivey and Matsumoto and would make the parking management system more efficient and easier to use—a result that would have been highly desirable to a POSITA during the relevant time period, particularly in settings with high usage or limited resources.

Id. at 48. Petitioner supports these contentions with Dr. Paradiso's testimony. *Id.* at 47–48 (citing Ex. 1003 ¶¶ 279–282). At this stage of the proceeding, and based on the current record, Petitioner's articulated reasons to combine Ivey, Matsumoto, and Tillotson are supported by rational underpinning.

b. Patent Owner's Arguments Opposing Institution

Patent Owner raises several arguments generally opposing institution of *inter partes* review. Patent Owner first argues that Ivey was made known to the Examiner during the prosecution of the application that issued as the '421 patent, both in the Specification filed December 5, 2014 and in a January 27, 2015 Information Disclosure Statement. Prelim. Resp. 14 (citing Ex. 1002, 13, 78). Patent Owner therefore considers Ivey to be "AAPA" and, under *Qualcomm, Inc. v. Apple Inc.*, 24 F.4th 1367 (Fed. Cir. 2022) unavailable to support *inter partes* review. *Id.*

We disagree that *Qualcomm* is applicable here. *Qualcomm* held that descriptions of prior art contained in a challenged patent—i.e., applicant-admitted prior art, or AAPA—cannot form "the basis" of a ground for *inter partes* review. *Qualcomm*, 24 F.4th at 1374. Here, however, Petitioner is not relying on the description of Ivey found in the '421 patent as the basis of Ground 1, but rather on Ivey itself. Accordingly, this argument is unavailing.

Patent Owner also argues that Ground 1 lacks merit because the '421 patent "has a different classification than Matsumoto . . . and Tillotson" Prelim. Resp. 16. According to Patent Owner, Tillotson's U.S. Patent classification of 340/932.2 differs from the U.S. Patent classification of the '421 patent, 705/13; and Matsumoto's international patent classification of G08G 1/14 differs from the '421 patent's international patent classification of G07B 15/00. *Id.* at 15–16 (citing Exs. 2007, 2008). Patent Owner submits that "arrangements to collect fares [the '421 patent's international classification] . . . differs markedly from indicating free parking spaces [Matsumoto's international classification]" *Id.* at 16. Similarly, Patent

Owner contends that “transportation facility access [the ’421 patent’s U.S. patent classification] . . . differs markedly from vehicle parking indicators [Tillotson’s U.S. patent classification]” *Id.*

We understand Patent Owner to be arguing that Matsumoto and Tillotson are not analogous art with respect to the ’421 patent because of their different patent classifications. Patent classification systems do not, however, control the analogous-art inquiry. The predecessor to our reviewing court has stated that evidence of classification in different categories by the PTO “is inherently weak . . . because considerations in forming a classification system differ from those relating to a person of ordinary skill seeking solution for a particular problem.” *In re Mlot-Fijalkowski*, 676 F.2d 666, 670 n.5 (CCPA 1982).⁸ Instead, “the similarities and differences in structure and function of the inventions disclosed in the references to carry far greater weight.” *In re Ellis*, 476 F.2d 1370, 1372 (CCPA 1973). At this stage of the proceeding, Patent Owner does not address the structural and functional similarities and differences between the ’421 patent and the cited prior art. Nor does Patent Owner address “the two separate tests [that] define the scope of analogous prior art: (1) whether the art is from the same field of endeavor, regardless of the problem addressed and (2) if the reference is not within the field of the inventor’s endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved.” *In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004). Thus, at this stage of the proceeding, we are not persuaded that Matsumoto and Tillotson are not analogous art.

⁸ We see no reason why this statement would not also apply to international patent classifications.

Patent Owner further argues that Ivey teaches overlaying parking status on a map rather than on a real-time picture of a parking space, as claimed. This argument is unpersuasive. Ground 1 relies on the combination of Ivey and Matsumoto, not Ivey alone, to teach payment-status indicia on a real-time camera view of a parking space. Pet. 35–37. *See In re Merck & Co.*, 800 F.2d 1091, 1097–98 (Fed. Cir. 1986) (“Non-obviousness cannot be established by attacking references individually where the rejection is based upon the teachings of a combination of references” (citations omitted)).

Patent Owner next argues that Matsumoto teaches obtaining, via an antenna “located at the lot’s gate,” an image of a parking lot from a camera “with a bird’s eye view of [the] lot,” whereas “the Patent Owner’s invention does not have a fixed antenna at a parking lot gate and does not have a fixed camera.” Prelim. Resp. 17. This argument is unpersuasive because claim 1 does not specify how the claimed “real time camera view” is obtained, and therefore does not exclude the claimed real-time camera view being obtained from a camera mounted at the parking lot.

Patent Owner further argues that “Tillotson ‘278 counted vehicles entering a parking lot,” and uses “an entry counter 310 and an exit counter 312,” whereas “the Patent Owner’s invention does not have counters at an entry and an exit and does not count vehicles per se.” Prelim. Resp. 17 (citing Ex. 1011, 11); *see* Ex. 1011 ¶ 39 (discussing entry counter 310 and exit counter 312). This argument also does not persuade us that institution of *inter partes* review is unwarranted. Petitioner proposes combining Tillotson’s teachings regarding its PSIRS system, which permits users to reserve and pay for parking spaces, with Ivey and Matsumoto; Petitioner

does not propose combining aspects of Tillotson’s disclosure discussing entry counter 310 and exit counter 312. Pet. 24–25, 27–28 (citing Ex. 1011 ¶¶ 23, 59, 65).

Finally, Patent Owner argues that Ivey, Matsumoto, and Tillotson “do not recognize parking status overlay upon a real time video image,” and thus “[i]n overlooking [this claimed feature], the obviousness rejection using two combined references slips into hindsight.” Prelim. Resp. 17–18. We disagree. Patent Owner does not identify any knowledge relied upon by Petitioner that was gleaned only from the ’421 patent’s disclosure and that was not otherwise within the level of ordinary skill at the time of the invention, and therefore does not support its allegation of hindsight. *See In re McLaughlin*, 443 F.2d 1392, 1395 (CCPA 1971) (“Any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made and does not include knowledge gleaned only from applicant's disclosure, such a reconstruction is proper.”).

c. Conclusion Regarding Claim 1

For the foregoing reasons, and based on the current record, we determine that Petitioner is reasonably likely to prevail in showing that claim 1 would have been obvious over Ivey, Matsumoto, and Tillotson.

6. *Claims 2, 3, 5, and 6*

Claim 5 is independent, claims 2 and 3 depend from claim 1, and claim 6 depends from claim 5. Petitioner contends that the limitations of claim 5, and the additional limitations of dependent claims 2, 3, and 6, are taught or suggested by Ivey, Matsumoto, and Tillotson. Pet. 9, 37–49.

Patent Owner does not raise any arguments against institution of review of these claims that have not already been addressed above in connection with claim 1.

7. *Conclusion as to Ground 1*

We determine, on the current record, that Petitioner demonstrates a reasonable likelihood of prevailing in showing that independent claim 1 would have been obvious over Ivey, Matsumoto, and Tillotson. Thus, we institute *inter partes* review of claim 1.

“When instituting *inter partes* review, the Board will authorize the review to proceed on all of the challenged claims and on all grounds of unpatentability asserted for each claim.” 37 C.F.R. § 42.208(a). We must “either (1) institute as to all claims challenged in the petition and on all grounds in the petition, or (2) institute on no claims and deny institution.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019), 5–6, 64; *see also PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1359–60 (Fed. Cir. 2018) (stating a decision to institute is “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”). Thus, because we have decided to grant institution on Ground 1 with respect to claim 1, we must do the same for claims 2, 3, 5, and 6.

E. *The Remaining Grounds*

As discussed above, because we have decided to institute *inter partes* review on Ground 1, we must do the same for the remaining grounds as well. Nonetheless, we consider Patent Owner’s arguments in opposition to Grounds 2–4.

F. Ground 2: Claims 4 and 7—Ivey, Matsumoto, Tillotson, and Slemmer

Claim 4 depends from claim 1 and claim 7 depends from claim 5. Petitioner alleges that claims 4 and 7 would have been obvious over Ivey, Matsumoto, Tillotson, and Slemmer. Pet. 9, 49–52.

Patent Owner argues that Ivey cannot be used to support a ground of unpatentability because it is AAPA. Prelim. Resp. 15. As discussed above in connection with Ground 1, this argument is unpersuasive.

Patent Owner also argues that Slemmer has a different U.S. patent classification than the '421 patent, and therefore, presumably, is not analogous art. Prelim. Resp. 16. Again, for the reasons discussed above in connection with Ground 1, this argument is unpersuasive.

G. Grounds 3 and 4: Claims 1–3, 5, and 6 — Ward, Haynes, and Tillotson, and Claims 4 and 7 — Ward, Haynes, Tillotson, and Slemmer

Petitioner contends that: (i) claims 1–3, 5, and 6 would have been obvious over Ward, Haynes, and Tillotson; and (ii) claims 4 and 7 would have been obvious over Ward, Haynes, Tillotson, and Slemmer. Pet. 9, 52–75.

As with Grounds 1, and 2, Patent Owner argues that Ward and Haynes are not analogous art because they have different U.S. patent classifications than the '421 patent. Prelim. Resp. 15–16. As discussed above, this argument is unpersuasive. Appellant further argues that “Ward ‘675 had its System connect with parking meters 20,” whereas “the Patent Owner’s invention does not utilize parking meters.” Prelim. Resp. 18. This argument is not persuasive because the claims do not appear to exclude application to metered parking spaces. Indeed, the Specification specifically refers to its

parking status system integrating “position, direction, view ahead, and parking *meter* status into a common visual image updated in real time.” Ex. 1001, 4:26–29 (emphasis added). Appellant also contends that “Haynes ‘166 had in its method a camera 1420 mounted upon a pole 122,” whereas “the Patent Owner’s invention does not utilize a camera mounted upon a pole.” Prelim. Resp. 18. As we pointed out above in discussing a similar argument, however, claim 1 does not specify how the claimed “real time camera view” is obtained, and therefore does not exclude the claimed real-time camera view being obtained from a camera mounted on a pole.

III. CONCLUSION

For the foregoing reasons, we determine that Petitioner has shown that there is a reasonable likelihood that it would prevail with regard to at least one of the claims challenged in the Petition. Accordingly, we institute *inter partes* review of claims 1–7 of the ’421 patent on all asserted grounds.

IV. ORDER

For the reasons given, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–7 of the ’421 patent on all asserted grounds is *instituted*; and

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), notice is hereby given of the institution of trial, which will commence on the entry date of this Decision.

IPR2023-00385
Patent 10,438,421 B2

PETITIONER:

Donald Daybell
Gerald Porter
ORRICK, HERRINGTON & SUTCLIFFE LLP
D2DPTABDocket@orrick.com
PTABDocketG1P6@orrick.com

PATENT OWNER:

Charles McCloskey
Charles C. McCloskey, LLC
chuck@mccloskeypatentlaw.com