

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.
Petitioner,

v.

ISIX IP LLC,
Patent Owner.

IPR2024-00615
U.S. Patent No. 6,308,178

**PETITIONER'S AUTHORIZED REPLY
TO PATENT OWNER'S PRELIMINARY RESPONSE**

Pursuant to the Board's email dated July 29, 2024, Petitioner files this Reply to Patent Owner's Preliminary Response ("POPR," Paper 7). Both the strength of SAP's Petition and the *Fintiv* factors foreclose discretionary denial. If, however, the Board finds that analysis favors discretionary denial, then SAP provides the Solera stipulation submitted as Ex-7001 in accordance with the Director's Memorandum for the Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (Jun. 21, 2022) ("Memo"). Institution of this proceeding is requested.

I. THE *FINTIV* FACTORS FAVOR INSTITUTION

The *Fintiv* factors disfavor discretionary denial. Petitioner will immediately request—and should receive—a stay of the proceedings; the district court case is at an early stage; Petitioner diligently filed this petition a few months after being served Patent Owner's infringement contentions, and well within the one-year deadline.

Under the *first factor*, the Board typically declines to speculate on what a district court Judge may do if a stay is requested. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 at 12 (PTAB May 13, 2020). But here, a stay should be granted. Unlike cases where stays are typically denied, Patent Owner here is not a competitor, and waited several years after the patent expired to file suit, thereby foregoing injunctive relief. *See Comm'n Techs., Inc. v. Samsung Elec. Am., Inc. et al.*, No. 2:21-CV-00444-JRG, 2023 WL 1478447 (E.D. Tex. Feb. 2, 2023). (Judge Gilstrap

granting stay where IPR was instituted covering all asserted claims of expired patent owned by a non-competitor non-practicing entity). In *Comm'n Techs.*, the institution decision issued two months before the Markman hearing and the final written decision in the IPR was scheduled to issue four months after the district court trial date. The timing of that case is the same as this one. Thus, this factor disfavors discretionary denial.

Under the *second factor*, Isix referenced the expected time to trial (March 2025), which comes before the expected PTAB decision (September 2025). But these dates are within months of each other, and small timing differences weigh only slightly in favor of discretionary denial. *Samsung Electronics Co., Ltd, et al. v. Staton Techiya, LLC*, IPR2022-01106, Paper 10 at 1 (PTAB Jan. 9, 2023). Regardless, “the proximity to trial should not alone outweigh all of [the] other factors.” Memo, 8.

Moreover, “scheduled trial dates are unreliable and often change,” thus “[a] court’s scheduled trial date ... is not by itself a good indicator of whether the district court trial will occur before the statutory deadline for a final written decision.” *Id.* It is the Eastern District of Texas’ “long-standing practice ... to set multiple cases to begin trial on the same day. ... Sometimes none of the cases set for a particular trial date settle, meaning that the Court then has a backlog of cases to try later.” *Atlas Global Techs. LLC v. TP-Link Techs.*, No. 2:21-CV-00430-

JRG, 2023 WL 5512068, at *1 (E.D. Tex. Aug. 25, 2023); *see also Apple Inc. v. Koss Corp.*, IPR2021-00255, Paper 22 at 11 (PTAB June 3, 2021) (“whether the Texas court’s trial takes place before, contemporaneously with, or after our final written decision statutory deadline involves speculation” relying on, *inter alia*, “the propensity of the Texas court to reschedule trials once the PTAB has denied a related petition.”). The panel thus cannot simply look at time-to-trial statistics without further considering the likelihood of schedule slippage, particularly for one of the busiest trial judges in the country. See Memo, 8 (“the PTAB will also consider additional supporting factors such as the number of cases before the judge in the parallel litigation”). This factor should be neutral or, at most, weigh only slightly in favor of discretionary denial.

Under the ***third factor***, there has been very limited activity in the parallel proceedings. Fact discovery is in its infancy—the plaintiff has not issued any written discovery or noticed any depositions—and it does not close until October 28, 2024. The institution decision will come before the close of fact discovery, any claim construction ruling, expert report exchanges and dispositive motions. Thus, this factor strongly weighs against denial.

Under the ***fourth factor***, despite the existence of some overlap of issues, Petitioner also asserts invalidity in District Court based on several prior art references not in the Petition, as well as invalidity based on prior art products for the challenged patent. Furthermore, the Petition challenges claim not asserted in

the District Court; and “it is likely that [a PTAB] proceeding will address claims ultimately not asserted in the [related] case,” reducing the overlap of issues when the parties are required to limit both the asserted claims and the asserted prior art before trial, as is true in the related litigation. *Id.* at 17-18. Thus, Factor 4 is neutral or weighs against denial.

Under the *fifth factor*, while the parties are the same in the parallel litigation, this factor is closely related to the timing consideration of the second factor and, thus, also should not outweigh the more critical factors addressed above. *Id.* at 10 and 19.

Based on a holistic analysis of *Fintiv* factors 1-5, the Board should not discretionarily deny institution.

II. Compelling Evidence of Unpatentability

“[T]he PTAB will not deny institution of an IPR ... under *Fintiv* [] when a petition presents compelling evidence of unpatentability.” Memo, 9. Here, SAP’s Petition presents compelling evidence of unpatentability. For instance, Grounds 1 and 2 both apply a *single* prior art reference with detailed explanation and expert support; Ground 3 simply combines these two references into an obviousness ground. *T-Mobile USA, Inc. v. Cobblestone Wireless, LLC*, IPR2024-00137, Paper 15 at 15-16 (PTAB May. 22, 2024) (finding compelling merits based on “detailed limitation-by-limitation comparison” of the claims to the prior art, “with extensive citations to the prior art and supporting [expert] testimony”). Isix’s validity arguments, on the other hand, are mere

attorney argument that is easily rebutted by the Petition evidence, as shown below.

Isix's Arguments	Petition Support For Ground 1 (Brann)	Petition Support For Ground 2 (Suresh)
Brann and Suresh lack "source applications and destination applications." POPR at 30-34.	Brann's system coordinates data between "competing programs." Pet at 21 (citing Ex. 1003 at 1:16-30). A POSITA would recognize that "programs" and "applications" were used interchangeably. <i>Id.</i> (citing Ex. 1002 at ¶58; Ex. 1009).	Suresh's "conventional RDMS systems" and "data warehouses and data marts" are applications because they are computer programs designed to assist in the performance of a specific task. Pet. at 46-47 (citing Ex. 1002 at ¶¶64, 130; Ex. 1009).
Brann and Suresh lack "integrating data among heterogenous source applications and destination applications." POPR at 30-34.	Brann describes "integration" of heterogenous computer systems. Pet. at 21-22 (citing Ex. 1003 at 5:27-28, 2:45-55, 1:16-30; Ex. 1002 at ¶58-62; Ex. 1009), 16 (citing Ex. 1002 at ¶46-47).	Suresh's system extracts, transforms, and loads data between source and target applications. Pet. at 44-45 (citing Ex. 1004 at 6:23-29, 6:16-19, Fig. 2, Ex. 1002 at ¶124-126). A POSITA would recognize that the source and destination applications are heterogenous because they are "operational databases" and "warehouses or data marts," respectively, and data is transformed between them. Pet. at 46 (citing Ex. 1004 at 6:8-19; Ex. 1002 at ¶127-129).
Brann and Suresh lack "a repository of information relating to the source and destination applications." POPR at 34-37.	Brann describes that all the instructions and data needed to perform a translation are stored in a database. Pet. at 28 (citing Ex. 1003 at Abstract, 3:5-8, 3:19; 4:6-7, 4:53-55,	Suresh's system includes "a repository, which is used to keep track of . . . mapping information." Pet. at 48-49 (citing Ex. 1004 at 6:23-29, 6:56-65, 5:17-20, 6:46-52, 10:35-

	14:63-64, 20:64-67; Ex. 1002 at ¶¶63-78).	11:6; Ex. 1002 at ¶¶136-140).
Brann and Suresh lack “[the repository including] a first module including a plurality of instruction sets, each instruction of each instruction set activating a data element.” POPR at 37-40.	Brann teaches a “list of subroutines” (plurality of instruction sets) “to be invoked and an order in which they should be invoked.” Pet at 29 (citing Ex. 1003 at 7:26-27). These instructions are stored in a portion of a database (first module). <i>Id.</i> (citing Ex. 1003 at 7:33-34; Ex. 1002, ¶¶79-83). Each of the instructions activate a subroutine “activating a data element” by instructing the Control Program to call that subroutine. Pet. at 29 (citing Ex. 1002 at ¶84-87).	Suresh describes “pipelines” (first module) which include “cascading sequences of transformation components” (plurality of instruction sets) which map and transform data (activating a data element). Pet. at 49-56 (citing Ex. 1004 at 6:23-29, 6:61-65, 7:3-14, 7:25-27, 7:38-42, Fig. 4, Fig. 5, Fig. 7; Ex. 1002 at ¶141-156.

In fact, Isix misreads Brann at several points, including arguing that Brann’s instructions are not stored in a database (POPR at 37-38) despite Brann expressly teaching utilizing “instructions from the *database*.” Ex. 1003 at 7:26-38. Isix similarly misunderstands Brann’s discussion of the “function pointer” (POPR at 38) which is specific to the C programming language, not to the overall operation of Brann’s system. Ex. 1003 at 7:31-41 (“the programs may be written in any language . . . in the C language this is a ‘function pointer’”).

In sum, and in light of Isix’s lack of “declaratory evidence or evidence of objective indicia of non-obviousness to rebut Petitioner’s seemingly straightforward

case of obviousness,” the Petition presents compelling merits. *Inergy Techn., Inc. v. Force MOS Techn. Co., Ltd.*, IPR2024-00094, Paper 9 at 36-37 (PTAB May. 21, 2024).

III. SOTERA STIPULATION

SAP submits that discretionary denial is unwarranted. But if the Board disagrees and nevertheless determines that discretionary denial is warranted, then Petitioner stipulates to not pursue any invalidity ground on that patent that was raised or that could have been reasonably raised in this IPR in the associated litigation.¹

Dated: August 2, 2024

Respectfully submitted,

/Jeffri A. Kaminski /
Jeffri A. Kaminski
Lead Counsel for Petitioner
Registration No. 42,709

¹ This stipulation is effective only to the extent determined to be legally proper or necessary in connection with, e.g., *Apple Inc. v. Vidal*, 63 F.4th 1 (Fed. Cir. 2023).

Petitioner's Exhibit List

Ex-7001	District Court Stipulation
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CERTIFICATE OF SERVICE

The undersigned certifies that, in accordance with 37 C.F.R. §42.6(e) and 37 C.F.R. §42.105, service was made on Patent Owner as detailed below.

Date of service August 2, 2024

Manner of service Electronic Email: cab@CLandS.com; john@CLandS.com

Documents served **Petitioner's Authorized Reply to Patent Owner's Preliminary Response**

Persons served Cabrach J. Connor
John M. Shumaker
CONNOR LEE & SHUMAKER PLLC
609 Castle Ridge Road, Suite 450
Austin, Texas 78746

/Jeffri A. Kaminski /
Jeffri A. Kaminski
Lead Counsel for Petitioner
Registration No. 42,709