UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner.

IPR2024-01432
U.S. Patent No. 8,751,948
Issued: June 10, 2014
Application No. 13/086,165
Filed: April 13, 2011

Title: METHODS, APPARATUS, AND SYSTEMS FOR PROVIDING AND MONITORING SECURE INFORMATION VIA MULTIPLE AUTHORIZED CHANNELS AND GENERATING ALERTS RELATING TO SAME

PETITIONER'S STATEMENT ON PARALLEL PETITIONS

Petitioner SAP America, Inc. concurrently files two petitions for *inter partes* review of claims 1-7, 10-11, 13, 18-19, 23, 29, and 35-36 (the "challenged claims") of U.S. Patent No. 8,751,948 (the "'948 patent"). These two materially distinct, non-cumulative petitions are justified by a potential priority dispute regarding the effective filing date of the challenged claims. **Petition 1 (IPR2024-01432)** shows that the challenged claims were obvious even if entitled to Patent Owner's earliest alleged effective filing date of May 13, 2008. **Petition 2 (IPR2024-01433)** shows that the challenged claims are not entitled to an effective filing date before 2011 at least because the 2009 ancestor application does not provide written description support for the challenged claims. Petition 2 also explains how the challenged claims are obvious over an intervening family member publication (the PCT publication, EX1104) and the Austin-Lane reference (EX1105), which is also relied on in Petition 1.

Pursuant to the November 2019 Consolidated Trial Practice Guide ("CTPG"), Petitioner submits this paper to rank the two concurrently-filed petitions and explain the differences between the petitions, why those differences are material, and why the Board should institute IPR on both petitions. *See* CTPG, 59-60.

I. <u>RANKING OF PETITIONS</u>

While Petitioner submits that both petitions should be instituted, it **ranks Petition 2 first and Petition 1 second**.

II. DIFFERENCES BETWEEN THE TWO PETITIONS

While each petition challenges the same claims of the ’948 patent, they do so based on different effective filing dates and different primary prior art references. As shown in the table below, Petition 1 assumes a May 2008 effective filing date and challenges the claims based on the WebSphere references (EX1004-1009) and Austin-Lane (EX1010). Petition 2 assumes an effective filing date no earlier than 2011, and challenges the claims based on the intervening PCT publication (EX1104) and Austin-Lane (EX1105). Petition 2 shows that Patent Owner cannot backdate its claims to the May 2009 parent application (EX1106) at least because it does not provide Section 112 written description support for the challenged claims of the ’948 patent, as required by Section 120 in order to establish priority.

Petition 1 (IPR2024-01432)	Petition 2 (IPR2024-01433)
Ground 1: WebSphere References[1] and Austin-Lane (§ 103): claims 1-7, 10-11, 13, 18-19, 23, 29, and 35-36	Ground 1: PCT Publication and Austin-Lane (§ 103): claims 1-7, 10-11, 13, 18-19, 23, 29, and 35-36

[1] The WebSphere references are WebSphere-Portal (EX1004), Ben-Natan (EX1005) and WebSphere-Everyplace (WebSphere-Everyplace-1 (EX1006), WebSphere-Everyplace-2 (EX1007), WebSphere-Everyplace-3 (EX1008), and WebSphere-Everyplace-4 (EX1009)).

III. THE PRIORITY DATE DISPUTE IS MATERIAL AND WARRANTS INSTITUTION OF BOTH PETITIONS

The Board should institute IPR on both petitions at least because a priority dispute is precisely the kind of dispute that the Board and CTPG have said may warrant filing and institution of two petitions. *See*, *e.g.*, *Apple Inc. v. Sonrai Mem. Ltd.*, IPR2023-00975, Paper 9 at 14 (PTAB Dec. 14, 2023) (granting institution of two parallel petitions because a "potential priority dispute between the two parties justifies institution of the two petitions"); *10X Genomics*, *Inc. v. Bio-Rad Labs.*, *Inc.*, IPR2020-00088, Paper 8 at 47 (PTAB Apr. 27, 2020) (granting institution of two parallel petitions where one petition presented a priority date dispute); *Microsoft Corp. v. InterDigital Patent Holdings*, *Inc.*, IPR2024-00537, Paper 10 (PTAB Jul. 15, 2024) (same); *Medtronic*, *Inc. v. Teleflex Innovations S.A.R.L.*, IPR2020-00136, Paper 20 at 39 (PTAB June 26, 2020) (a priority dispute is "precisely one of the circumstances … in which more than one petition may be necessary"); CTPG, 59 ("a dispute about priority date" may warrant institution on multiple petitions).

Moreoever, both petitions present compelling merits and discretionarily denying one of them would unfairly allow Patent Owner to escape proper review of its claims. That is, instituting both petitions will allow the Board to fulfill its mission "to improve patent quality and restore confidence in the presumption of validity that comes with issued patents." *Code200*, *UAB v. Bright Data Ltd.*, IPR2022-00861,

Paper 18 at 6 (PTAB Aug. 23, 2022). Public interest and efficiency concerns call for resolution of these unpatentability issues all in one forum.

Finally, it it was not practicable to present both grounds in a single petition. Each petition presents only one obviousness ground. The priority dispute and sole associated obviousness ground in Petition 2 are over 9,000 words and the single obviousness ground in Petition 1 is over 11,000 words. The claims alone total more than 2,100 words. There would not have been inadequate words in a single petition, especially given the need to address Section 325(d) and *Fintiv* issues, and to include other sections such as an introduction, summary of grounds, claim construction, POSITA definition, and explanation of the state of the art. Thus, two petitions are required to fully present the issues, and institution of both petitions is warranted.

Respectfully submitted,

Dated: September 20, 2024

By: /Roy Chamcharas/

Roy Chamcharas (Reg. No. 61,735)
roy.chamcharas@klarquist.com
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Tel: 503-595-5300
Fax: 503-595-5301

Counsel for Petitioner

CERTIFICATE OF SERVICE

The undersigned certifies that on September 20, 2024, a copy of the foregoing **Petitioner's Statement on Parallel Petitions** was served by **Express Mail** on the Patent Owner at the following address of record as listed on the USPTO Patent Center:

Foley & Lardner LLP
3000 K Street N.W., Suite 600
Washington, DC 20007-5109

By: /Roy Chamcharas/

Roy Chamcharas (Reg. No. 61,735)
roy.chamcharas@klarquist.com
KLARQUIST SPARKMAN, LLP
One World Trade Center, Suite 1600
121 S.W. Salmon Street
Portland, Oregon 97204
Tel: 503-595-5300
Fax: 503-595-5301

Counsel for Petitioner