

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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SAP AMERICA, INC.,  
Petitioner,

v.

CYANDIA, INC.,  
Patent Owner.

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IPR2024-01433  
Patent 8,751,948 B2

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Before JEFFREY S. SMITH, MITCHELL G. WEATHERLY, and  
JASON W. MELVIN, *Administrative Patent Judges*.

MELVIN, *Administrative Patent Judge*.

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

## I. INTRODUCTION

SAP America, Inc. (“Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting institution of *inter partes* review of claims 1–7, 10, 11, 13, 18, 19, 23, 29, 35, and 36 (“the challenged claims”) of U.S. Patent No. 8,751,948 B2 (Ex. 1101, “the ’948 patent”). Patent Owner, Cyandia, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 7 (“Prelim. Resp.”).

An *inter partes* review may not be instituted unless “the information presented in the petition . . . and any response . . . shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a) (2018). “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. § 42.108(a) (2021).

For the reasons that follow, and based on the present record, we conclude that Petitioner has shown a reasonable likelihood it will prevail with respect to at least one challenged claim, and we institute *inter partes* review of the ’948 patent.

### A. REAL PARTIES IN INTEREST

Petitioner identifies itself and SAP SE as the real parties in interest. Pet. xi. Patent Owner identifies itself as the real party in interest. Paper 5.

### B. RELATED MATTERS

Petitioner and Patent Owner identify *Cyandia, Inc. v. SAP America, Inc. et al.*, Case No. 2:24-cv-00096-JRG (E.D. Tex. Feb. 12, 2024) (“Texas litigation”) as a related matter involving the ’948 patent. Pet. xi; Paper 5.

Patent Owner also identifies U.S. Patent No. 8,578,285, and U.S. Patent No. 8,595,641 as challenged in IPR proceedings. Paper 5.

### C. THE '948 PATENT (EX. 1101)

The '948 patent is titled “Methods, Apparatus and Systems for Providing and Monitoring Secure Information via Multiple Authorized Channels and Generating Alerts Relating to Same” and relates “generally to monitoring secure sources of information to determine particular aspects, trends, and/or values associated with the information, and providing one or more alerts in connection with same.” Ex. 1101, code (54), 1:66–2:3. The Specification describes “an information delivery system for, and methods of, eventing and alerting using multiple information forms and sources across multiple types and/or brands of electronic devices, such as televisions, mobile devices, and computing device.” *Id.* at 5:42–46. The information delivery system provides “the display of and access to secure user-centric information via the construct of a channel grid framework serving as a desktop on a user device.” *Id.* at 5:47–50. “The channel grid framework includes multiple user-selectable items that provide access to corresponding ‘channels’ by which respective portions of user-centric information are delivered to a user.” *Id.* at 5:50–53.

The user and the user device are first authenticated to receive the secure user-centric information, and the user-selectable items included in the channel grid framework on the desktop for the user device are based on information access rights and security protocols defined for the corresponding channels, the user, and the user device.

*Id.* at 5:54–59.

Figure 3 of the '948 patent is reproduced below.

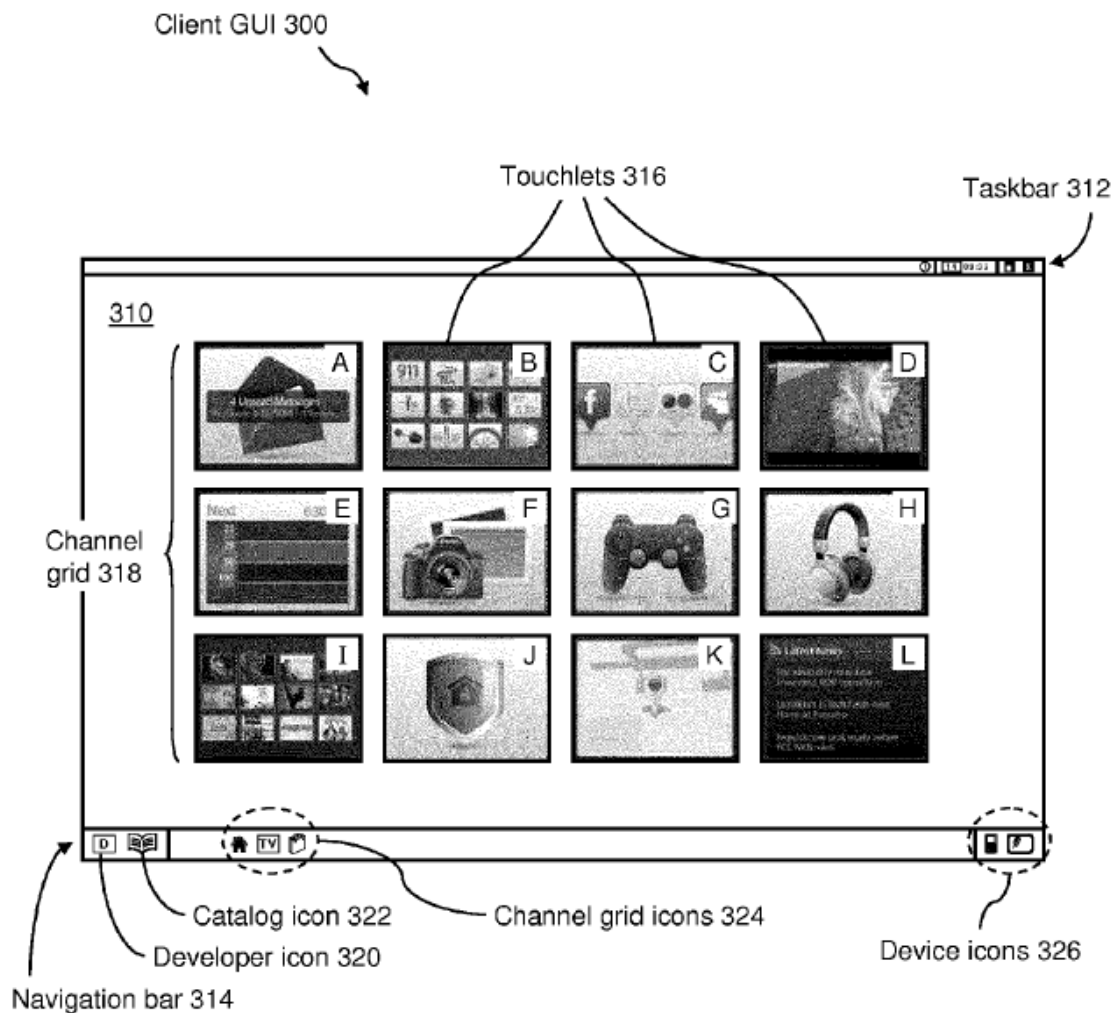


**FIG. 3**

Figure 3 illustrates a screenshot of an example of a client GUI 300 that shows an example of a channel grid which is one example of a presentation framework of PID application 112. *Id.* at 11:13–16. Client GUI 300 includes main viewing panel 310, a taskbar 312 provided along the top of main viewing panel 310, and a navigation bar 314 provided along the bottom of main viewing panel 310. *Id.* at 11:16–20. Multiple touchlets 316A through 316L are presented in a 3x4 channel grid 318 in the main viewing panel 310

of client GUI 300. *Id.* at 11:38–40. Each touchlet 316 in the 3x4 channel grid 318 of client GUI 300 represents a channel 200 of a specific purpose and/or function. *Id.* at 11:42–44.

#### D. THE CHALLENGED CLAIMS

Claim 1 is independent and is reproduced below<sup>1</sup>:

- [1.1] 1. An apparatus to provide secure user-centric information on at least one user platform operated by a user, and to evaluate at least some of the secure user-centric information, the apparatus comprising:
  - [1.2] at least one communication interface facilitating wired and/or wireless communications with the at least one user platform via one or more transmission media;
  - [1.3] at least one memory storing processor-executable instructions; and
  - [1.4] at least one processor communicatively coupled to the at least one communication interface and the at least one memory, retrieving processor-executable [sic] instructions from the at least one memory, and executing the processor-executable instructions to provide and evaluate at least some of the secure user-centric information by:
- [1.5] A) implementing a channel grid framework including a matrix of a plurality of authorized channels through which the user receives and/or interacts with, via the at least one user platform, respective portions of the secure user-centric information based at least in part on information access rights and/or security protocols respectively associated with the plurality of authorized channels, the plurality of authorized channels including at least a first channel through which the user receives and/or interacts with first

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<sup>1</sup> We adopt the bracketed identifiers added by Petitioner. Pet. 12–13; Ex. 1109.

- channel information constituting a first portion of the secure user-centric information;
- [1.6] B) establishing a user profile to identify user preferences, platform identities, and service support instructions that determine how the secure user-centric information behaves on the at least one user platform;
  - [1.7] C) receiving configuration data indicating one or more user preferences regarding alerts transmitted via the first channel based on the user profile;
  - [1.8] D) receiving session data indicating a current state of at least one external device of the user;
  - [1.9] E) monitoring at least the first channel information so as to determine one or more events, conditions, logical workflows, discrete information values or signal data, based on at least one threshold condition or parameter relating to the first channel information and determined based on the user preferences indicated by the configuration data; and if the one or more events, conditions, logical workflows, discrete information values or signal data is/are determined in E):
  - [1.10] F) determining a notification method by which to provide at least one alert on the at least one external device based on the current state of the at least one external device indicated by the session data;
  - [1.11] G) generating notification data according to the determined notification method, wherein the notification data is configured to cause the at least one external device to provide the at least one alert on the at least one external device; and
  - [1.12] H) controlling the at least one communication interface to transmit the notification data to the at least one external device via the first channel without being requested by the user, wherein the transmission of the notification data to the at least one external device is

based at least in part on information access rights and/or security protocols respectively associated with the corresponding plurality of authorized channels, the user, and the at least one user platform.

Ex. 1101, 31:17–32:15. Claims 35 and 36 are also independent and recite limitations similar to claim 1’s. *Id.* at 36:1–38:19. The remaining challenged claims depend, directly or indirectly, from claim 1. *Id.* at 32:16–35:12.

#### E. PRIOR ART AND ASSERTED GROUNDS

Petitioner asserts the following unpatentability grounds:

| Claim(s) Challenged                     | 35 U.S.C. § <sup>2</sup> | Reference(s)/Basis                                          |
|-----------------------------------------|--------------------------|-------------------------------------------------------------|
| 1–7, 10, 11, 13, 18, 19, 23, 29, 35, 36 | 103                      | The PCT publication <sup>3</sup> , Austin-Lane <sup>4</sup> |

Pet. 2. Petitioner relies also on the Declaration of Christopher Schmandt. Ex. 1103.

#### F. LEGAL STANDARDS

A claim is unpatentable “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 at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103(a). The question of obviousness involves resolving

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<sup>2</sup> The ’948 patent claims priority to a May 13, 2008, provisional application. Ex. 1101, codes (60), (63); *see* Pet. 12. Therefore, the pre-AIA statutes apply.

<sup>3</sup> International Patent Application Publication No. WO 2009/140386 (Ex. 1104).

<sup>4</sup> U.S. Patent Application Publication No. 2004/0044736 (Ex. 1105).

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 ordinary skill in the art; and when presented (4) objective evidence of non-obviousness, *i.e.*, secondary considerations.<sup>5</sup> *See Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). Further, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *See KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

## II. DISCRETIONARY DENIAL

Patent Owner urges us to exercise our discretion to deny institution under 35 U.S.C. § 314(a) in view of the Texas litigation and *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). The *Fintiv* order identifies several factors when considering whether to deny institution in view of related litigation, with the goal of balancing efficiency, fairness, and patent quality:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and

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<sup>5</sup> In the present record, neither party presents arguments or evidence relating to secondary considerations.

6. other circumstances that impact the Board's exercise of discretion, including the merits.

*Fintiv*, Paper 11, 5–6.

We allowed the parties additional briefing to address the *Fintiv* factors. Paper 9 (“Pet. Supp.”); Paper 10 (“PO Supp.”). Additionally, Petitioner provided a stipulation (Ex. 1131) similar to the one in *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A)).

#### A. *FINTIV* FACTOR 1: LIKELIHOOD OF STAY

Petitioner contends that it “plans to file a motion to stay in the district court.” Pet. 5; *accord* Pet. Supp. 1.

Patent Owner argues that this factor “weighs in favor of discretionary denial because no motion to stay the case is pending, and Petitioner has presented no evidence that Judge Gilstrap would grant a stay if a trial is instituted.” Prelim. Resp. 9. Additionally, Patent Owner submits that Judge Gilstrap “recently denied a motion to stay under nearly identical circumstances.” PO Supp. 1.

We conclude this factor is neutral because Petitioner has not requested a stay and the district court has not ruled on a potential stay. We will not speculate on the likelihood of a stay.

#### B. *FINTIV* FACTOR 2: DISTRICT COURT TRIAL DATE

Petitioner contends that, although trial is scheduled for about six months before our final written description is expected, that timing is in question because Petitioner plans to file the afore-mentioned motion for stay,

and because “there is a pending motion and a cross-motion to transfer the case.” Pet. 5; *accord* Pet. Supp. 1.

Patent Owner argues that this factor “weighs in favor of discretionary denial because trial is scheduled to begin in the co-pending litigation on October 6, 2025, six months before a final written decision is due in the case.” Prelim. Resp. 10 (citing Ex. 2006, 1); *accord* PO Supp. 1. Patent Owner notes that statistics on median time to trial in the district-court forum indicate a trial roughly four months before our final written decision. Prelim. Resp. 10.

After the parties’ briefing, the district court denied both transfer motions. Ex. 2016. Thus, we have little reason to doubt the scheduled trial date, though the record regarding usual timing in the district court reflects it may be slightly later than scheduled. We conclude that this factor favors discretionary denial.

C. *FINTIV* FACTOR 3: INVESTMENT IN RELATED DISTRICT COURT LITIGATION

Petitioner contends that “the district court case is still in its early stages (only infringement and invalidity contentions have been exchanged).” Pet. 4. Petitioner submits that this factor is, at best, neutral, because the *Markman* hearing has not yet occurred and opening invalidity expert reports are not due until mid-May, with expert reports being due near the end of June. Pet. Supp. 1–2. Additionally, Petitioner notes that it filed the Petition diligently, about four months after receiving infringement contentions. *Id.* at 2.

Patent Owner contends that “[t]he parties have already expended a significant amount of investment in the parallel litigation, having served infringement and invalidity contentions and claim construction terms.”

Prelim. Resp. 11. Patent Owner asserts that the *Markman* hearing will have been held before institution. PO Supp. 2. Further, in Patent Owner's view, the four-month time between receiving infringement contentions and filing the Petition is a "substantial" delay. *Id.*

Although the *Markman* hearing was scheduled for April 2, 2025, the district court has delayed it until April 24, 2025. Ex. 3001, 9. Thus, the district court has not substantively addressed issues regarding the '948 patent. Initial expert reports are due May 12, 2025, and expert discovery closes June 23, 2025. Pet. Supp. 2 (citing Ex. 2015, 2–3). Additionally, in its recent order denying the transfer motions, the district court stated that its "case is still in its early stages." Ex. 2016, 9. We agree with that assessment and conclude that the facts here show that neither the parties nor the district court have invested substantially in the Texas litigation. "If, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution." *Fintiv*, Paper 11, 10. We conclude that this factor favors institution.

#### D. *FINTIV* FACTOR 4: OVERLAP OF ISSUES

Petitioner stipulates that, if we institute review, it "will not pursue in the E.D. Tex. district court litigation any ground of unpatentability that is raised or reasonably could have been raised in any instituted IPR." Ex. 1131. Petitioner argues that the stipulation strongly favors institution. Pet. Supp. 2.

Patent Owner argues that there is substantial overlap of the claims challenged and the grounds, arguments, and evidence involved in both forums. Prelim. Resp. 12. That statement seems to rely on Petitioner asserting in the district court the two references at issue here. *Id.*

Petitioner’s *Sotera* stipulation will eliminate the overlap between this proceeding and invalidity at the district court. Unlike the other, related IPRs for which we discretionarily deny review (*e.g.*, IPR2024-01432, -01495, & -01496), this proceeding does not involve references that fundamentally convey the same information as may be presented as system art in the Texas litigation. In light of the stipulation and nature of the asserted ground, we conclude that this ground strongly favors institution.

E. *FINTIV* FACTOR 5: DEFENDANT IN DISTRICT COURT

There does not appear to be any dispute that Petitioner is the defendant in the district court litigation. Thus, this factor favors discretionary denial.

F. *FINTIV* FACTOR 6: OTHER CIRCUMSTANCES, INCLUDING THE MERITS

Petitioner contends that the Petition presents “compelling merits” and thus justifies institution. Pet. 5; *accord* Pet. Supp. 2.

Patent Owner contests that evaluation. Prelim. Resp. 13. Additionally, Patent Owner argues that the Texas litigation will resolve “the entire four-patent dispute between the parties” and thus is a better way to proceed. PO Supp. 2.

Based on our evaluation of the record, Petitioner presents particularly strong merits here. Petitioner’s showing depends on a single reference for nearly every limitation, with a modification to only one aspect of that reference. Patent Owner does not dispute whether that primary reference—the PCT publication—discloses each of the limitations for which it is asserted. Nor does Patent Owner dispute the benefits that would have motivated skilled artisans to modify the PCT publication by applying

Austin-Lane's teachings. The only dispute Patent Owner raises against obviousness relates to an asserted claim-construction position that Petitioner does not advance. *See infra* at 26 (§ III.D).

Although Patent Owner disputes the effective filing date for the challenged claims, our evaluation indicates the Petitioner presents a particularly strong case that the challenged claims are not entitled to claim an effective filing date earlier than 2011. *See infra* at 16 (§ III.C).

Petitioner's case is particularly strong because the prosecution history shows that the applicant relied on disclosures made in a CIP application when adding certain limitations, rather than relying on disclosures in an earlier-filed application in the priority chain of the '948 patent. Moreover, the paragraphs in the earlier-filed application on which Patent Owner now relies for support do not disclose aspects that Patent Owner agrees the challenged claims require.

We conclude that the Petition presents particularly strong merits. That consideration is balanced by issues that remain in the district court, regardless of whether we institute in this proceeding. We conclude that this factor is neutral overall.

#### G. OVERALL DETERMINATION

The balance of all *Fintiv* factors do not favor the exercise of our discretion to deny institution. Therefore, we determine that discretionary denial is not appropriate in this case.

### III. ANALYSIS

#### A. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner contends that a person of ordinary skill in the art at the time of filing “would have had a bachelor’s degree in electrical engineering, computer science, or equivalent, with two or more years of experience developing and implementing graphical user interfaces for controlling server-based applications, including handling asynchronous notifications generated by those applications and web services, such as portal systems, or an equivalent amount of relevant work or research experience” and “would have been familiar with common approaches for presenting information on a graphical user interface, including various layouts for presenting multiple elements, such as icons, widgets, windows, etc.” Pet. 14–15. Petitioner describes further capabilities that such a person of ordinary skill in the art would have had. *Id.* at 15–16.

Patent Owner asserts that a person of ordinary skill in the art at the time of filing “would have had a Bachelor’s degree in electrical engineering, computer science, or the like, and/or four or more years of experience in server-based applications” and that “[a]dditional experience may make up for a lack of education and vice versa.” Prelim. Resp. 14.

Because Petitioner’s proposed level of ordinary skill in the art appears to be consistent with the challenged patent and prior art, we adopt it and use “skilled artisans” to refer to people with such skill at the time the invention was filed. We do not perceive a substantive distinction between the parties’ definitions, but note that Petitioner’s definition provides more detail about the capabilities of skilled artisans. Should either party believe that the definition of ordinary skill in the art affects a disputed issue in the trial, it

should point out how and identify any potential dispute about the level of skill.

#### B. CLAIM CONSTRUCTION

We construe claims according to the standard used in the federal courts in civil actions under 35 U.S.C. § 282(b), which is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b). Under *Phillips*, the “words of a claim ‘are generally given their ordinary and customary meaning,’” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1312–13.

Petitioner proposes that we construe the claim term “provide [an] alert” as “present a tactile, auditory, or visual notification” and construe the claim term “information” as “tactile, auditory, or visual information.” Pet. 17–19. Patent Owner submits that, instead, “provide [an] alert” should be construed as “presenting an alert notification” and “information” construed as “digital data.” Prelim. Resp. 14–20.

Petitioner’s proposed constructions seek to avoid limiting claim 1 to certain types of information or alerts. *See* Pet. 17. In particular, Petitioner points to “alert information” as including tactile alerts. *Id.* Patent Owner does not dispute that aspect of the claims. Indeed, Patent Owner contests only whether an “alert” “should be construed to require specific types of alerts.” Prelim. Resp. 15. As to “information,” Patent Owner raises the same criticism—that Petitioner’s construction is unduly narrow. *Id.* at 17–18.

We do not view Petitioner’s proposed constructions as establishing or affecting an unpatentability dispute. Both proposed constructions include

tactile, auditory, and visual information as possibilities, but do not require any one type of information. Patent Owner’s position also allows for those same types of information and additional ones. Thus, any dispute regarding claim scope for “information” or “alerts” does not materially impact a dispute about patentability.

Another term, however, may impact a patentability dispute. Below, we discuss the parties’ respective positions regarding whether the claims require delivering alerts to each of multiple devices when such devices are detected. *See infra* at 22 (§ III.C.4). This depends on the construction of “provide at least one alert on the at least one external device.” While we preliminary conclude below that the language does not require delivering alerts to each of multiple external devices, this claim-construction issue may warrant further development at trial.

Other than as discussed, we do not expressly construe any terms at this stage. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))). Should either party believe that a position taken during trial depends on a particular claim construction, we encourage the party to explain that dependence and why its asserted construction is correct.

#### C. APPLICABLE FILING DATE FOR THE CHALLENGED CLAIMS

Petitioner contends that the challenged claims may not claim the benefit of their May 2009 ancestor application because that application does not provide written-description support for the claims. Pet. 19–30. The PCT publication asserted as prior art was published November 19, 2009.

Ex. 1104, code (43). Petitioner asserts the PCT publication is substantively identical to the May 2009 application. Pet. 32 (citing Ex. 1104; Ex. 1106). Petitioner asserts that because the May 2009 application does not provide written-description support for the challenged claims, the PCT publication is prior art under § 102(b). *Id.* (arguing this result even assuming the '948 patent were entitled to the applicable filing date of a January 2011 provisional application). *Id.*; see Ex. 1101, code (60). Patent Owner contends that the May 2009 application supports the challenged claims such that they are entitled to a priority claim, disqualifying the PCT publication as prior art. Prelim. Resp. 20–49.

Petitioner identifies four claim terms or concepts that it alleges lack support in the May 2009 application: information and alerts that include tactile notifications (Pet. 25–27); “determining a notification method” (*id.* at 27–28); “generating notification data” (*id.* at 28–29); and providing the claimed alert to multiple external devices (*id.* at 29–30). As discussed below, we agree with Petitioner as to “determining a notification method.” That alone means that the challenged claims are not entitled to the earlier filing date of the May 2009 application, and thus that the PCT application is available as prior art.

*1. Information and alerts that include tactile information*

Petitioner submits that the May 2009 application describes alerts limited to visual and auditory alerts, whereas the challenged claims encompass tactile alerts. Pet. 25. Thus, argues Petitioner, the May 2009 application does not support the full scope of the claims. *Id.* at 26.

Patent Owner contends, on the other hand, that the May 2009 application “encompasses within its scope all alerts that were definable on

external devices at the time of the invention, including tactile alerts.” Prelim. Resp. 22 (emphasis omitted). Patent Owner points to disclosure that an “alert can appear as defined on other platforms such as a mobile device a television (set top box), a Blu-ray player, or other devices.” *Id.* (quoting Ex. 1106 ¶ 39) (emphasis omitted). In Patent Owner’s view, the law does not require that the May 2009 application disclose every example of well-known alerts and that even Petitioner agrees that tactile alerts were well known at the time. *Id.* at 23 (citing Ex. 1103 ¶¶ 47, 48). Patent Owner bolsters that with additional evidence that tactile alerts were “widely used by mobile phones at this time.” *Id.* at 24 (citing Ex. 2003, Abstract; Ex. 2004, 354; Ex. 2005, 401). Moreover, Patent Owner argues, “tactile alerts were essential features of mobile phones in 2009,” so when the May 2009 application discloses alerts “defined on other platforms such as a mobile device,” that inherently discloses tactile alerts. *Id.*

We think Patent Owner potentially has the better argument, though the issue is close. Petitioner relies on case law where an expanded scope of embodiments within the claim language meant that an earlier description failed to support the full scope of the claims. Pet. 26 (citing *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299 (Fed. Cir. 2008)). But here, the record supports Patent Owner’s position that the mobile phones disclosed in the May 2009 application already included tactile alerts. Because the May 2009 application generically described alerts on mobile phones, the challenged claims are not directed to a distinct embodiment, as were the claims in *PowerOasis*. See 522 F.3d at 1309 (distinguishing disclosure of user interfaces on a unitary vending-machine apparatus from the later

claimed interface located on a customer's laptop or separate from the vending machine).

Balanced against that state of the art, however, is Petitioner's position that the May 2009 application's language does not indicate such alerts were within the scope of the invention. The May 2009 application does state that an alert may "appear" on a mobile phone, and also that the channel alert server may "provide a visual or auditory alert in the channel." Ex. 1106 ¶ 39. This tends to limit the described alerts to particular forms.

While we think the record slightly supports Patent Owner's position, it does not change our ultimate decision, and we leave this potential dispute for further development and resolution at trial.

## 2. Determining a notification method

Petitioner contends that the May 2009 application does not describe how to determine a notification method or how to use session data as claimed. Pet. 27–28. The challenged claims require: "determining a notification method by which to provide at least one alert on the at least one external device based on the current state of the at least one external device indicated by the session data." Ex. 1101, 31:64–67. Petitioner contends that support for that limitation appears first in an April 2011 CIP application. Pet. 27 (citing Ex. 1110 ¶¶ 90–93, 130–132, 145–147, 160). Petitioner notes that when the applicant amended the claims in December 2013 to add this claim language, it cited as support multiple paragraphs first appearing in the April 2011 CIP application. *Id.* at 28 (citing Ex. 1102, 316; Ex. 1110 ¶¶ 41, 62, 92, 95, 96, 112, 113, 130, 145, 155, 160).

Patent Owner argues that Petitioner's position would read in a requirement to determine the "best" notification method. Prelim. Resp. 33.

We do not agree. Petitioner notes that certain disclosures added to the April 2011 CIP application describe a “notification manager” to “determine the best alert notification method.” Pet. 27 (quoting Ex. 1110 ¶ 131; citing *id.* ¶¶ 90–93, 130–132, 145–147, 160). That does not mean that Petitioner construes the claim language to require determining the best method, only that disclosing a mechanism that “determine[s] the best alert notification method” provides written-description support for a requirement to “determin[e] a notification method.” Petitioner is clear in its position that the May 2009 application “does not describe how to determine a notification method or how to use ‘session data’ in the manner required by this claim limitation.” Pet. 27–28.

Patent Owner asserts that the May 2009 application discloses “determining a notification method” through a channel alert server that can “determine the active devices of the subscriber . . . to provide a visual or auditory alert in the channel.” Prelim. Resp. 32 (quoting Ex. 1106 ¶ 39). That disclosure appears to address the claim language requiring an alert “based on the current state of the at least one external device indicated by the session data.” It does not, however, address the claim language “determining a notification method.”

Patent Owner recognizes that Petitioner asserts disclosures in the prior art for “determining which devices to send the alert to, the protocols used to send the alert, and how alerts are presented.” *Id.* at 34 (emphasis omitted). But when Patent Owner asserts that the May 2009 application discloses determining how alerts are presented, it points to paragraphs that do not support the assertion. *Id.* at 35 (citing Ex. 1106 ¶¶ 23, 39). The first, paragraph 23, states that a “trigger may cause the information channel to

change its appearance or to take other actions that may be implemented by the developer” and that “one action that may be implemented is to provide a notification to the user.” Ex. 1106 ¶ 23. Nothing about that indicates the system determines how an alert is presented. The second, paragraph 39, states that the channel alert server may “provide a visual or auditory alert in the channel” and that the “alert can appear as defined on other platforms.” Nothing about that indicates the system determines how an alert is presented. Patent Owner has not shown how the May 2009 application discloses a determining a notification method, as claimed.

In Patent Owner’s view, Petitioner admits that the May 2009 application (which is the same as the asserted PCT publication) describes determining a delivery mechanism because Petitioner compares it to Austin-Lane, stating that the PCT publication “already includes a channel alert server that determines the active devices of the user and delivers an alert to the user’s device” and “discloses setting the same type of alert (stock alert) and presenting it in the same way (visually) as Austin-Lane.” Prelim. Resp. 35 (quoting Pet. 54) (emphasis omitted). But simply delivering an alert does not necessarily mean the notification method for that alert was determined. We conclude that Petitioner’s statement does not show the PCT publication discloses “determining a notification method” as claimed.

The present record supports Petitioner’s assertion that the May 2009 application does not provide written-description support for the “determining a notification method” limitation. Accordingly, the challenged claims are not entitled to claim priority to that application.

3. Generating notification data

Petitioner submits that the May 2009 application does not disclose “generating notification data according to the determined notification method” because it does not disclose a “determined notification method,” as discussed above, and therefore cannot disclose generating notification data as claimed. Pet. 28–29. Patent Owner contends that the May 2009 application discloses “details on how to set and present the alert on the user device, which inherently requires notification data.” Prelim. Resp. 37–38. As aptly framed by Petitioner, this issue depends on the “determining a notification method” limitation and does not represent a separate dispute. We agree with Patent Owner that, if the May 2009 application discloses determining a notification method and discloses delivering a notification according to that method, then it also discloses generating notification data. But the present record does not show that the May 2009 application discloses determining a notification method.

4. Providing alerts to multiple external devices

Petitioner submits that the May 2009 application does not disclose “providing the claimed alert to multiple external devices as required in steps F), G), and H) of each of the independent claims.” Pet. 29–30. In this regard, Petitioner relies on claim language directed to “determining a notification method by which to provide at least one alert on the at least one external device.” *Id.* (citing Ex. 1101, 31:65–67, 32:3–11). Because the antecedent claim language requires “at least one external device of the user,” Petitioner argues that the claim scope “includes one *or more* external devices” and therefore “that the alert be provided to each external device for which session data is received.” *Id.* Patent Owner contends that Petitioner’s

position improperly interprets the claim language, which encompasses many scenarios:

(1) one alert on the user's only external device, (2) multiple alerts on the user's only external device, (3) one alert on a subset of the user's multiple external devices, (4) multiple alerts each device of a subset of the user's external devices, (5) one alert on each of the user's external devices, and (6) multiple alerts on each of the user's external devices.

Prelim. Resp. 40–41. In Patent Owner's view, Petitioner's position unduly limits the claim to only the fifth scenario. *Id.* at 41.

We agree with Patent Owner. Nothing about the claim language requires multiple external devices, so even if a user had multiple external devices, the claim language would map onto a subset consisting of one such device. Any alerts provided or not provided to devices other than that one device would be irrelevant to the claim language. Accordingly, we agree with Patent Owner that the claims do not require delivering alerts to each one of a user's multiple external devices.

#### D. OBVIOUSNESS OVER THE PCT PUBLICATION AND AUSTIN-LANE

Petitioner submits that the challenged claims are obvious over the PCT publication and Austin-Lane. Pet. 30–65.

The PCT publication is titled “Apparatus and Methods for Interacting with Multiple Information Forms Across Multiple Types of Computing Devices.” Ex. 1104, code (54). The PCT publication identifies four inventors: Michael Wetzter, Thomas Theriault, Mark Dingman, and Rupert Key. *Id.* at code (75). The '948 patent lists only two inventors: Michael Wetzter, Thomas Theriault as inventors. Ex. 1101, code (75). Both the '948 patent and the PCT publication claim priority to U.S. Provisional Patent

Application Serial No. 61/052,765, filed May 13, 2008. Ex. 1104 ¶ 1; Ex. 1101, code (60). The PCT publication relates “generally to user-centric information convergence and, more particularly, to apparatus and methods for interacting with multiple information forms across multiple types of computing devices and platforms.” Ex. 1104 ¶ 2.

Petitioner relies on the PCT publication for most limitations and asserts that skilled artisans would have had reason to apply Austin-Lane’s teachings to “(1) determine a notification method for the alert based on the user’s presence information and (2) generate the notification based on the determined notification method.” Pet. 41.

Austin-Lane is titled “Cascaded Delivery of an Electronic Communication” and “relates to systems and methods of delivering information to a delivery mechanism.” Ex. 1105, code (54), ¶ 2. Austin-Lane describes that “selecting a delivery mechanism to be used for delivering an electronic communication (e.g., a notification) includes determining actual availability of an intended recipient presently to receive the electronic communication using at least one candidate delivery mechanism before attempting to deliver the electronic communication using the candidate delivery mechanism.” *Id.* ¶ 6. “Selecting the delivery mechanism also includes deciding whether to send the electronic communication using the candidate delivery mechanism based on the determined actual availability.” *Id.*

Petitioner asserts that skilled artisans would understand from Austin-Lane that “selecting a notification method that sends the alert to a device (e.g., notebook computer) and, optionally, an application (e.g., instant messaging) on that device that the user is currently using ensures the user

receives the alert ‘without significant delay.’” Pet. 41 (citing Ex. 1105 ¶ 46, 6–9, 19, 21, 23, 24, 27, 29, 35, 39, 55). Thus, Petitioner reasons, skilled artisans would have had reason to modify the PCT application’s approach with Austin-Lane’s teachings “to ensure the user receives the alert promptly.” *Id.* (citing Ex. 1103 ¶ 73).

As to the “determining a notification method” limitation (1.10), Petitioner asserts that Austin-Lane teaches determining:

(1) the user device(s) to send the notification to (e.g., phone, PDA, notebook computer, desktop computer); (2) the communication protocol to use to send the notification, i.e., how to send the notification (e.g., SMTP (for email), SMS (for texts), HTTP (for web browsers)); and (3) the type of alert to provide, i.e., how to present the notification, (e.g., text, an icon, a pop-up window, a video, an email, an audible or tactile alarm), based on the current state of the at least one external device indicated by the session data (“presence information”), which may include whether and on which device(s) the user is online and/or whether and on which applications the user has an active session.

*Id.* at 53 (internal citations omitted) (citing Ex. 1105 ¶¶ 4, 5, 29, 32, 33, 39, 46, 48, 61, 79, Fig. 1).

Petitioner asserts that skilled artisans would have further understood that, once the system determines a notification method, “the content and/or format of the notification data for a visual alert is different than for an audible alert, and that even for visual alerts, the notification data is different for text (e.g., instant message) than graphics (e.g., flashing icon).” *Id.* at 42; *accord id.* at 56–57. Thus, reasons Petitioner, skilled artisans would have had reason to incorporate Austin-Lane’s teachings to “generate notification data according to the determined notification method to ensure the alert is

successfully and properly provided on the user’s device(s).” *Id.* at 42 (citing Ex. 1103 ¶ 74); *accord id.* at 57 (“to conform to the requirements/specifications of the determined notification method”).

Patent Owner contests that the asserted combination, arguing that Petitioner does not show that it satisfies a requirement to determine the *best* notification method. Prelim. Resp. 50. That purported requirement comes from Patent Owner’s view of how Petitioner applies the claim language in its priority-date argument discussed above. *Id.* As discussed, however, we do not agree that Petitioner implicitly construes the claims to require determining the best notification method. *See supra* at 19 (§ III.C.2). Nor has Patent Owner argued that we should adopt such a construction. Because Patent Owner’s position that Petitioner fails to show the combination discloses “determining a notification method” depends on its view of Petitioner’s claim-construction position, and because that view is incorrect, Patent Owner’s position is unpersuasive.

We conclude that the claim language reads on Austin-Lane’s disclosure of determining “a presentation method of the notification” such as “using an instant message to the notebook computer” (Ex. 1105 ¶¶ 39, 46), in combination with teachings regarding the device to which the notification is sent and the protocol used to deliver it. We further conclude that Petitioner has provided an adequate reason that skilled artisans would have looked to Austin-Lane’s teachings and combined them with the system described in the PCT publication, as discussed. We have further reviewed the uncontested aspects of the challenge to claim 1 (Pet. 43–58) and determine that Petitioner is reasonably likely to prevail proving obviousness of claim 1.

#### IV. CONCLUSION

For the reasons discussed above, we conclude that Petitioner has shown a reasonable likelihood of prevailing with respect to unpatentability of at least one claim. Accordingly, we institute *inter partes* review.

#### V. ORDER

Accordingly, it is

ORDERED that, pursuant to 35 U.S.C. § 314(a), *inter partes* review of claims 1–7, 10, 11, 13, 18, 19, 23, 29, 35, and 36 of the '948 patent is instituted on the grounds raised in the Petition; 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.

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Patent 8,751,948 B2

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