

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner.

Case IPR2024-01433
U.S. Patent No. 8,751,948

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

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I. INTRODUCTION

Patent Owner, Cyandia, Inc., respectfully requests that the Director vacate the Board's Institution Decision ("D.I.") and deny the Petition ("Pet.") because Cyandia's PCT Publication (Ex. 1104) is not prior art to U.S. Patent No. 8,751,948 (Ex. 1101, "the '948 Patent").

The Board's determination that written description support for the term "determining a notification method by which to provide at least one alert on the at least one external device" first appeared in the '948 Patent, which is a continuation-in part application, overlooked that the earliest application in the '948 Patent's priority chain, a provisional application filed in 2008 (Ex. 1108, "the 2008 Provisional"), plainly discloses this limitation. The Board ignored the 2008 Provisional and Petitioner's admissions on its way to finding that the very same disclosure—determining to send a particular type of alert (e.g., an email) to a particular user device based on the device's session data—satisfied this limitation for purposes of obviousness but not for purposes of written description.

II. STATEMENT OF THE CASE

A. The '948 Patent

The '948 Patent is a continuation-in-part of U.S. Patent Application No. 12/465,331 (Ex. 1106, "2009 Parent"), which was filed on May 13, 2009, and claims priority to a provisional application filed in May 2008 (Ex. 1108, the "2008

Provisional”). See ’948 Patent at Cover; Ex. 1106 at ¶ [0001] (2009 Parent claiming priority to the 2008 Provisional). It discloses and claims methods for instantiating an interactive matrix of channels, which enables a user to receive and interact with secure user-centric information and provides alerts to the user’s active device(s) upon detected changes to that information. ’948 Patent at Abstract. An exemplary channel matrix view is illustrated below:

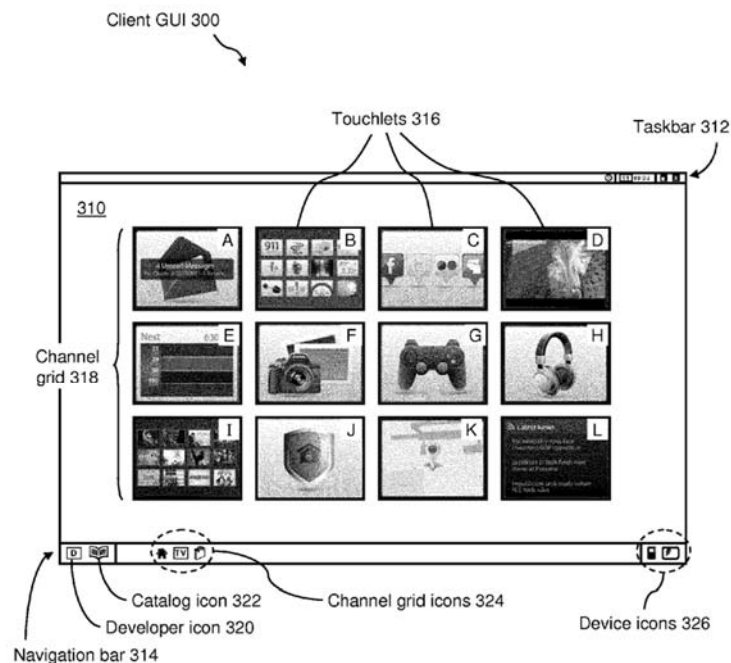


FIG. 3

Id., FIG. 3.

As is relevant to this case, the 2009 Parent discloses a “channel alert server” that monitors channel information, detects events (e.g., an alarm condition at a residence), determines which of the user’s devices are active, and sends a visual or

auditory alert through the channel to the active device(s). Ex. 1106, ¶ [0039].

Alerts can also “appear as defined on other platforms such as a mobile device, a television (set top box), a Blu-ray player, or other devices.” *Id.* A user similarly can assign “event alerts or triggers” to “provide a notification to the user.” *Id.*

The 2008 Provisional includes additional descriptions of alerts, including several figures illustrating exemplary embodiments for notifying a user in response to monitored data triggering an event. For example, the 2008 Provisional states that the system has the “[a]bility to monitor select data and send alerts to send email, SMS, RSS, or kick off an application event/process/workflow.” 2008 Provisional at 23; *id.* at 12 ¶ [0010] (“These alerts can also be made to appear, through a programming interface, though other media presentation devices such as digital high definition television or audio signals.”).

B. The Petition

Petitioner, SAP America, Inc. (“Petitioner”), challenged Claims 1-7, 10, 11, 13, 18, 19, 23, 29, 35, and 36 of the '948 Patent (“Challenged Claims”) on the basis that it they are not entitled to claim priority to the earliest applications in its priority chain, allegedly “making an earlier family member, the PCT publication (WO 2009/140386) (EX1104), section 102(b) prior art to the '948 patent.” Pet. at 1. Among other limitations not relevant here (because the Board found they were in

compliance with 35 U.S.C. § 112),¹ Petitioner argued that the term “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” lacked written description support from any of its earlier-filed ancestral applications. *Id.* at 27-28.

The basis for Petitioner's argument was that support for this limitation was first introduced in the 2011 CIP, U.S. Patent Application No. 13/086,165. Pet. at 27 (“The April 2011 CIP application added arguable support for aspects of this claim limitation with discussions of the functions and operation of a ‘notification manager’ to ‘determine the best alert notification method.’”) (quoting Ex. 1110). Although it granted that the 2009 Parent teaches “determining the user's active devices (EX1106, [0039]),” Petitioner faulted that application for allegedly not “explain[ing] if or how this determination impacts which notification method is selected to deliver the alert.” *Id.* at 28.

In arguing that the Challenged Claims were obvious over Cyandia's PCT Publication and Austin-Lane, Petitioner asserted that Austin-Lane teaches

¹ The Board concluded that whether there is written description support for the term “generating notification data” is dependent on whether there is written description for “determining a notification method.” D.I. at 22

“determining a notification method” because it determines a “delivery mechanism” that “can include” determining which devices to send the alert to, the protocols used to send the alert, and how the alerts are presented:

- (1) the user device(s) to send the notification to (e.g., phone, PDA, notebook computer, desktop computer) (*e.g.*, EX1105, [0005], [0029], [0032], [0046], [0061], FIG. 1);
- (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)) (*e.g.*, EX1105, [0004], [0033], [0048]); 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) (*e.g.*, EX1105, [0039], [0046], [0079])).

Pet. at 53.

C. The Preliminary Response

In its Preliminary Response (“POPR”), Cyandia argued that the 2009 Parent and 2008 Provisional both disclose this limitation because, like Austin-Lane’s determination of a “delivery mechanism,” the ancestral applications disclose “a channel alert server that confirms the subscriber and determines which of the subscriber’s devices are active before causing an alert to be presented in the appropriate channel on the appropriate device(s).” POPR at 32-33. Specifically, Cyandia argued that the 2009 Parent discloses the same three features that Petitioner argued were sufficient to satisfy this limitation, including determining:

(1) the user device(s) to send the notification to (e.g., phone, PDA, notebook, computer, desktop computer). Ex. 1106 at ¶ [0039] (describing determining the active devices to send the alert to); *see also* ¶¶ [0020], [0023], [0027], [0033];

(2) the communication protocol to use to send the notification, i.e., how to send the notification (e.g., SMTP, SMS, HTTP). *Id.* At ¶¶ [0026], [0031], [0039] (describing a web services gateway that the alert is passed through); and

(3) the type of alert to provide, i.e., how to present the notification. *Id.* At ¶¶ [0023], [0039] (describing alert types and how the alert appears on the user's devices).

Id. at 34-35 (footnote omitted). In support of this point, Cyandia also cited the disclosures from the 2008 Provisional, including the “[a]bility to monitor select data and send alerts to send email, SMS, RSS, or kick off and [sic] application event/process/workflow.” *Id.* at 35 (cross-referencing POPR (§ II.B.2) at 6-7 (quoting 2008 Provisional at 23)).

Cyandia further noted that Petitioner expressly acknowledged that the PCT Publication² discloses delivering an alert to devices, setting an alert type, and presenting the alert “in the same way” as Austin-Lane:

² The PCT Publication and the 2009 Parent share a specification.

[T]he PCT publication's system *already* includes a channel alert server that *determines the active devices of the user and delivers an alert to the user's device(s)*.

* * * *

the PCT publication *discloses setting the same type of alert* (stock alert) and *presenting it in the same way* (visually) as Austin-Lane.

POPR at 35 (citing Pet. at 54 (citing Ex. 1104 at ¶¶ [0023], [0039])) (emphasis modified). Because the PCT Publication and the 2009 Parent share a specification, Petitioner's admission that the PCT Publication discloses this limitation is also an admission that the 2009 Parent also discloses this limitation.

Accordingly, as Cyandia argued, the ancestral applications plainly disclose all three features that Petitioner argued this limitation "can include." *Id.* at 36 ("Accordingly, when applying the correct construction, the 2009 parent discloses determining a notification method for alerts because it discloses determining a delivery mechanism for the alerts, including *which devices* to send the alert to, the *protocols* to send the alert, and *how to present* the alerts."); Pet. at 53.

D. The Institution Decision

In its Institution Decision, the Board adopted Petitioner's implied interpretation of the "determining a notification method." D.I. at 20 ("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.’’). Based on this construction the Board determined that Austin-Lane discloses this limitation because it discloses those three features:

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.

Id. at 26. Thus, the Board agreed with Petitioner’s argument that Austin-Lane discloses determining “how to present the notification, (e.g., text, an icon, a pop-up window, a video, an email, an audible or tactile alarm).” *Id.* at 25.

In its written description analysis, the Board acknowledged that the 2009 Parent discloses all aspects of this limitation except for a determination of “how an alert is presented.” *Id.* at 21 (“Nothing about that indicates the system determines how an alert is presented.”). However, the Board did not mention Cyandia’s citation to the 2008 Provisional, which plainly discloses determining how to present a notification (e.g., by “email, SMS, [or] RSS”). See POPR at 6-7 (citing 2008 Provisional at 23); *id.* at 35 (referencing the 2008 Provisional).

The Board also improperly discounted Petitioner’s admission that the PCT Publication (and therefore the 2009 Parent) discloses this limitation. While the Board appeared to agree with both parties that the PCT Publication (and, therefore, the 2009 Parent) discloses how to present a notification on an external device (e.g.,

“visually”), it found that “simply delivering an alert does not necessarily mean the notification method for that alert was determined.” D.I. at 21. This rationale was not raised in the Petition, and the Board cited no record evidence in support. *Id.*

III. LEGAL STANDARD FOR DIRECTOR REVIEW

Requests for Director Review of a Board's decision whether to institute an AIA trial may be granted where there is an abuse of discretion. See USPTO, Revised Interim Director Review Process at 2.B, Availability of Director Review: AIA Trial Proceedings (last modified March 18, 2025). An abuse of discretion is found if a decision: “(1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.” See *Ultratec, Inc. v. CaptionCall, LLC*, 872 F.3d 1267, 1272 (Fed. Cir. 2017) (citation omitted).

IV. ARGUMENT

The Board overlooked disclosures from the 2008 Provisional and improperly disregarded Petitioner's admissions, which both confirm that the inventors were in possession of “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” by 2009 at the very latest.

A. The Board Overlooked the 2008 Provisional

The Board abused its discretion because it failed to consider the 2008 Provisional in its decision. *Aqua Prods. v. Matal*, 872 F.3d 1290, 1325-26 (Fed. Cir. 2017) (en banc) (plurality opinion) (holding that the Board’s findings “must be based” on “*the entirety* of the record” and that failure to consider the full record is “an abuse of discretion which provides an independent basis” for vacatur).

Cyandia demonstrated written description support for “how to present the notification”—the only part of Petitioner’s tacit interpretation of this term the Board found to be missing from the 2009 Parent (D.I. at 21)—with citations to the 2008 Provisional. POPR at 35 and 6-7. As the table below shows, the 2008 Provisional disclosure indicates that alerts may be presented in email, SMS (text), and/or window application form, just like Austin-Lane, which Petitioner cited for showing how an alert is presented:

	2008 Provisional	Austin-Lane
“Determining a Notification Method”	“The 2008 provisional states that the system has the ‘[a]bility to monitor select data and send alerts to send email, SMS, RSS, or kick off [an] application event/process/workflow.’” POPR at 6 (citing 2008 Provisional at 23) (emphasis added).	“(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).” Pet. at 53 (emphasis added).

That the Board overlooked this evidence is sufficient to demonstrate that the Board abused its discretion. *Aqua Prods.*, 872 F.3d at 1325-26. However, because the 2008 Provisional contains the same disclosure as Austin-Lane, reversal is the only logical choice. Either determining to send a user an alert through an email discloses determining “how to present the notification” or it does not. If it does, then the 2008 Provisional provides written description for this limitation, and the PCT Publication is not prior art. If it does not, then the claims are patentable because Austin-Lane does not teach it either.

B. The Board Erroneously Disregarded a Party Admission in Favor of a Meritless Theory That Was Not Raised in the Petition

Cyandia also respectfully requests that the Director vacate and reverse the D.I. because the Board disregarded Petitioner's admission that the PCT Publication (and by extension the 2009 Parent) discloses determining a notification method, *including* “how to present the notification,” in favor of a non-sensical theory that was not raised in the Petition.

“[T]he Board must base its decision on arguments that were advanced by a party, and to which the opposing party was given a chance to respond.” *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016) (citations omitted). The D.I. fails this test because its reasoning—i.e., “simply delivering an alert does not necessarily mean that the notification method was determined”—was not based on any argument raised in the Petition. Nor was it based on any other

evidence of record. D.I. at 21. Thus, the crux of the D.I. has no argumentative or evidentiary support.

The theory is also inscrutable. The '948 Patent discloses many different ways for any given alert to be presented on an external device. As the 2008 Provisional discloses, it may be presented via “email, SMS, [or] RSS.” 2008 Provisional at 23. The Board fails to explain how a system can send an email alert without determining to send an email alert. Further, as the 2009 Parent and PCT Publication disclose, the system can determine to present an alert audibly or visually. 2009 Parent at ¶ [0039]; Pet. at 54 (admitting that “the PCT publication’s system already includes a channel alert server that determines the active devices of the user and delivers an alert to the user’s device(s)” and “setting the same type of alert (stock alert) and presenting it in the same way (visually) as Austin-Lane”) (citing Ex. 1104, [0039]; Ex. 1105, [0036-40], [0057-58]; Ex. 1108, 45). Thus, if a user instructs the system to send an email alert when a stock price of interest hits a threshold value, the system will determine which of the user’s devices are active and determine to send emails to those devices. According to the Board,³ the claims require nothing more. D.I. at 21, 25-26.

³ Cyandia does not concede that “determining a notification method” requires *all three* of the features the Board considered. D.I. at 25-26. Nevertheless, reversal is warranted because the '948 Patent’s ancestors disclose all three features.

Cyandia, therefore, respectfully requests that the Director vacate and reverse the D.I. because Petitioner admitted that this limitation was disclosed in the PCT Publication (and 2009 Parent), which means that the PCT Publication is not prior art.

V. CONCLUSION

For at least the foregoing reasons, Cyandia respectfully requests that the Director vacate and reverse the D.I.

Respectfully submitted,

Dated: April 21, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the P-TACTS constitutes electronic service if Patent Owner send an email notifying Petitioner of the filing, service was made on the Petitioner as detailed below.

<i>Date of service</i>	April 21, 2025
<i>Manner of service</i>	Electronic Filing with the Board (roy.chamcharas@klarquist.com; andrew.mason@klarquist.com; todd.siegel@klarquist.com; samuel.thacker@klarquist.com; SAP_Cyandia_IPRs@klarquist.com)
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<i>Persons Served</i>	KLARQUIST SPARKMAN, LLP, Roy Chamcharas, Andrew M. Mason, Todd M. Siegel, Samuel B. Thacker

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