

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner.

IPR2024-01433
Patent 8,751,948

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

I. ARGUMENT

The Board found no written description support in the 2009 parent application for claim step F), which dynamically determines a notification method based on the current state of the external devices. Patent Owner argues that the Board overlooked the following snippet of the 2008 Provisional application, which says nothing about *determining* a notification method: “[a]bility to monitor select data and send alerts to send email, SMS, RSS, or kick off [an] application event/process/workflow.” Paper 16 at 10. As the Board found for similar snippets in the 2009 application: “Nothing about that indicates the system determines how an alert is presented.” Paper 13 at 21. The Board overlooked nothing relevant. Instead, it properly rejected Patent Owner’s argument that the mere disclosure of different types of alerts suffices to describe the claims’ dynamic determination of a notification method based on the current state of the external devices, and correctly concluded that “Petitioner presents particularly strong merits here.” *Id.*, 12.

A. Patent Owner Distorts The CIP Claim Language

Patent Owner’s Director Review Request hinges on a distortion of step F) of the CIP ’948 patent’s claims. Step F)’s “determining” step occurs only if an alert condition has been identified in step E), and it must be based on the “current state” of one or more external user devices—reflected in “session data.” EX1101, 31:61–67. Patent Owner reduces this to simply having multiple notification methods

available. Paper 16 at 10–11. But that an alarm clock can be set to either play the radio or emit loud beeps does not mean it is programmed to wait until the set alarm time arrives to determine which method to use based on some current condition.

The Board correctly recognized this distinction (Paper 13 at 20–21), which Patent Owner ignores. While Patent Owner characterizes the Board hewing to the plain meaning of claim step F) as adopting a position the Petition had not raised, in fact the Board was rejecting the faulty claim distortion of the POPR. Paper 16 at 11.

Patent Owner’s cited disclosure from the 2008 Provisional—merely listing SMS, email, and other alert types—fails to show any decision-making process tied to real-time device state. There is no conditional logic. No dynamic selection. No use of current session data to affect method choice. Just a list of capabilities, not a mechanism for making a context-sensitive choice among them.

Thus, the Board was correct to reject Patent Owner’s oversimplification of claim step F) and to find no support in the 2009 application for step F).

B. The Board’s Preliminary Fact Findings Are Not Inconsistent

For the teaching of step F) in the prior art, Petitioner relied on Austin-Lane:

Austin-Lane teaches determining a notification method ...
based on the current state of the at least one external device
indicated by the session data (“presence information”
(EX1105, *passim*)) For example, if ‘the presence
information [] indicate[s] that the user 305 presently is

online using notebook computer 310d ... and that the user 305 has an active IM connection ... the notification delivery service 352 may provide the notification to the user 305 using an instant message to the notebook computer 310d.

Paper 1 at 53–54 (quoting EX1105, [0046]).

Patent Owner argues that it was inconsistent for the Board to find that Austin-Lane teaches the notification-method determination step F) while also finding that the PCT/2009 application does not provide written description support for this element. Paper 16 at 11–12 (citing Paper 13 at 21). Patent Owner also argues that Petitioner admitted “that the PCT Publication discloses this limitation.” *Id.*, 7–8. Both assertions are wrong. Petitioner instead acknowledged that the PCT/2009 application does *not* disclose this claim element and relied on Austin-Lane to provide this teaching. Paper 1 at 30–31, 53–54. Specifically, the POSITA “would have been motivated to modify the PCT publication system to select the notification method based on the user’s online presence to ensure the user receives the alert promptly.” *Id.*, 41. There was no admission. There was no inconsistency. The Board correctly found that Austin-Lane, not the PCT publication, teaches this determination step F). Paper 13 at 21, 24–26.

C. The Board Had No Obligation To Discuss The 2008 Provisional

Patent Owner faults the Board for not mentioning certain snippets from the

2008 Provisional but the Board is not required to mention all evidence it considers, *Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1328 (Fed. Cir. 2017), nor to consider evidence not shown by its proponent to be relevant to the issue at hand, *Aqua Prods. v. Matal*, 872 F.3d 1290, 1325–26 (Fed. Cir. 2017) (en banc) (plurality opinion) (the Board must consider evidence “bearing on the issue before it.”).

In its POPR, Patent Owner conceded that it had the “burden of production to present argument and evidence showing that the 2009 parent provides written description support for each limitation of the Challenged Claims.” Paper 7 at 49. In attempting to meet that burden, Patent Owner cited to a snippet on page 23 of the 2008 Provisional that it relies on its Director Review request. But Patent Owner did not explain how this snippet was even relevant to whether the later 2009 application provided sufficient written description support for the CIP claims. Paper 7 at 6.

While the 2009 application incorporates by reference the 2008 Provisional, the POPR did not mention that incorporation or explain how it might affect the written description analysis of the 2009 application. The POPR did not respond to Petitioner’s point that “Patent Owner cannot show [the 2008 Provisional] qualifies as a ‘U.S. patent or U.S. patent application publication’ under 37 C.F.R. 1.57(d).” Paper 1 at 25. It neither showed that the 2008 Provisional had been published when the 2009 application was filed nor argued that such publication was unnecessary under the incorporation-by-reference requirements of 37 C.F.R. 1.57(d).

Further, Patent Owner did not argue or show that the cited 2008 Provisional snippets described the same embodiment described by the 2009 application. Paper 7 at 32–37. The Board was not obligated to consider the 2008 Provisional’s snippets absent this required argument and showing. The written description requirement is not satisfied by cherry picking different elements of different embodiments guided by hindsight knowledge of issued claims. *Novozymes A/S v. DuPont Nutrition Biosciences APS*, 723 F.3d 1336, 1349 (Fed. Cir. 2013).

With Patent Owner having failed to explain or support any theory under which the 2008 Provisional’s snippets bore on the question at hand, the Board had no obligation to mention those snippets.

II. CONCLUSION

When Patent Owner identified to the Examiner alleged support for claim limitation step F) it cited only new matter added by the CIP application. Paper 1 at 14. The reason is clear: the new claim limitation was not described in the 2009 parent application. For this and other reasons the Board correctly concluded that “Petitioner presents a particularly strong case that the challenged claims are not entitled to claim an effective filing date earlier than 2011.” Paper 13 at 13. Therefore, Petitioner respectfully requests that the Director deny the Request.

Respectfully submitted,

Dated: April 29, 2025

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
IN COMPLIANCE WITH 37 C.F.R. § 42.6(e)(4)**

The undersigned certifies that on April 29, 2025, Petitioner emailed copies of **AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST** to the following email addresses, which Patent Owner has agreed constitutes service. *See* Paper 5 (Patent Owner's Mandatory Notices).

jhannah@kramerlevin.com

jprice@kramerlevin.com

kkastens@kramerlevin.com

jfuller@kramerlevin.com

ckeller@kramerlevin.com

svdocketing@kramerlevin.com

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