

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 RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION	1
II.	OVERVIEW OF THE ’948 PATENT	4
A.	The ’948 Patent’s Family Relationships	4
B.	The ’948 Patent and its Family Member Disclosures	5
III.	LEVEL OF ORDINARY SKILL IN THE ART	9
IV.	THE CHALLENGED CLAIMS ARE PATENTABLE BECAUSE THE PCT PUBLICATION IS NOT PRIOR ART AS THE 2009 PARENT PROVIDES WRITTEN DESCRIPTION SUPPORT FOR ALL CHALLENGED CLAIMS	10
A.	The 2009 Parent Provides Written Description Support for the Providing an Alert to an External Device	10
1.	Claim Construction: Provide an Alert <i>Encompasses</i> but Does Not Require Any One Type of Alert	11
2.	The 2009 Parent Discloses Providing an Alert Under the Proper Construction	12
3.	The 2009 Parent Also Satisfies the Written Description Requirement Because Tactile Alerts Were Well-Known in the Art at the Time of Filing	15
B.	The 2009 Parent Provides Written Description Support for the “Information” Claim Terms	19
C.	The 2009 Parent Provides Written Description Support for “Determining a Notification Method” and “Generating Notification Data”	20
1.	Claim Construction: “Determining a Notification Method”	21

2.	The 2009 Parent Provides Written Description Support For “Determining a Notification Method” Under the Proper Construction or Petitioner’s Construction.....	24
(a)	The 2009 Parent Discloses Determining the Devices to Send the Alert to and How to Send the Alert.....	24
(b)	The 2009 Parent Also Discloses How to Present an Alert Which is Included in Petitioner’s Construction	25
3.	The 2009 Parent Provides Written Description Support For “Generating Notification Data”	28
D.	The 2009 Parent Provides Written Description Support For “the at Least One External Device” (Elements [1.10] F, [1.11] G, and [1.12] H)	30
1.	“Session Data” Indicates That “the at Least One External Device” Provided the Alert Is/Are the User’s Active Device(s)	31
2.	“At Least One or More External Devices” Means One or More Devices, Not Each Device.....	34
E.	All Other Limitations in the Challenged Claims Find Written Description Support in the 2009 Parent	37
V.	CONCLUSION.....	44

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>3Shape A/S v. Align Tech., Inc.</i> , No. IPR2021-01120, Paper 15 (P.T.A.B. Jan. 11, 2022)	11, 13, 14
<i>Agilent Techs., Inc. v. Bio-Rad Labs. Inc.</i> , No. IPR2019-00266, Paper 10 (P.T.A.B. Oct. 23, 2019)	18
<i>Ajinomoto Co. v. Int'l Trade Comm'n</i> , 932 F.3d 1342 (Fed. Cir. 2019)	18
<i>Bicon, Inc. v. Straumann Co.</i> , 441 F.3d 945 (Fed. Cir. 2006)	36
<i>Bos. Sci. Corp. v. Johnson & Johnson</i> , 647 F.3d 1353 (Fed. Cir. 2011)	16, 18
<i>Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH</i> , No. IPR2019-01469, Paper 6 (P.T.A.B. Feb. 13, 2020)	38
<i>D Three Enterprises, LLC v. SunModo Corp.</i> , 890 F.3d 1042 (Fed. Cir. 2018)	14, 15
<i>Falkner v. Inglis</i> , 448 F.3d 1357 (Fed. Cir. 2006)	12
<i>Hologic, Inc. v. Smith & Nephew, Inc.</i> , 884 F.3d 1357 (Fed. Cir. 2018)	18
<i>LizardTech, Inc. v. Earth Resource Mapping, Inc.</i> , 424 F.3d 1336 (Fed. Cir. 2005.)	12
<i>Oatey Co. v. IPS Corp.</i> , 514 F.3d 1271 (Fed. Cir. 2008)	23
<i>Pandrol USA, LP v. Airboss Ry. Prods., Inc.</i> , 424 F.3d 1161 (Fed. Cir. 2005)	15
<i>Polaris Innovations Ltd. v. Brent</i> , 48 F.4th 1365 (Fed. Cir. 2022)	22

PowerOasis, Inc. v. T-Mobile USA, Inc.,
522 F.3d 1299 (Fed. Cir. 2008) 13, 14

PowerOasis, Inc. v. T-Mobile USA, Inc.,
No. Civ. 05-cv-42-PB, 2006 WL 753206 (D.N.H. Mar. 22, 2006).....14

Spectra-Physics, Inc. v. Coherent, Inc.,
827 F.2d 1524 (Fed. Cir. 1987) 15, 18

Tech. Licensing Corp. v. Videotek, Inc.,
545 F.3d 1316 (Fed. Cir. 2008) 37

Yeda Rsch. & Dev. Co. v. Abbott GmbH & Co. KG,
837 F.3d 1341 (Fed. Cir. 2016) 17, 29

Statutes

35 U.S.C. § 112 2, 5, 11

PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Petition for <i>Inter Partes</i> Review of U.S. Patent No. 8,751,948, <i>SAP America, Inc. v. Cyandia, Inc.</i> , No. IPR2024-01432, Paper 1 (P.T.A.B. Sept. 20, 2024)
2002	Microsoft Computer Dictionary, Pages 23, 271, 475 (5th Ed. 2002)
2003	A. Sahami, et al., "Rich Tactile Output on Mobile Devices," <i>Aml</i> 2008, 210-21 (2008)
2004	I. Oakley, et al., "Did you feel something? Distracter tasks and the recognition of vibrotactile cues," <i>Interacting with Computers</i> 20, 354–363 (2008)
2005	T. S. Ueng, et al., "SMS ALERT SYSTEM AT NSRRC," <i>IEEE Particle Accelerator Conference (PAC)</i> (2007)
2006	Microsoft Learn webpage – "Application Gateway TCP/TLS proxy overview (Preview)," available at https://learn.microsoft.com/en-us/azure/application-gateway/tcp-tls-proxy-overview , dated Sept. 6, 2024
2007	IBM Dictionary of Computing, Pages 615-616 (10th Ed. 1993)
2008	IBM webpage, "Session data" available at https://www.ibm.com/docs/en/informix-servers/14.10?topic=memory-session-data , dated March 15, 2023
2009	Declaration of James Hannah in Support of Patent Owner's Preliminary Response
2010	Order, <i>Netlist, Inc. v. Micron Technology, Inc., et al.</i> , Case No. 2:22-cv-00294-JRG, Dkt. No. 72 (E.D. Tex. Mar. 12, 2024)
2011	Order, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Samsung Semiconductor Inc.</i> , Case No. 2:22-cv-00293-JRG, Dkt. No. 180 (E.D. Tex. Oct. 17, 2023)

Exhibit	Description
2012	Order, <i>Netlist, Inc. v. Samsung Electronics Co., Ltd., Samsung Electronics America, Inc., Samsung Semiconductor Inc.</i> , Case No. 2:22-cv-00293-JRG, Dkt. No. 689 (E.D. Tex. Mar. 11, 2024)
2013	Excerpt from U.S. District Court – National Judicial Caseload Profile for the Eastern District of Texas, available at https://www.uscourts.gov/sites/default/files/2024-12/fcms_na_distprofile0930.2024.pdf
2014	USPTO's June 21, 2022 Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation
2015	Docket Control Order, <i>Cyandia, Inc. v. SAP America, Inc. and SAP SE</i> , Case No. 2:24-cv-00096-JRG, Dkt. No. 32 (E.D. Tex. June 17, 2024)
2016	Order, <i>Cyandia, Inc. v. SAP America, Inc.</i> , Case No. 2:24-cv-00096-JRG, Dkt. No. 85 (E.D. Tex. Mar. 27, 2025)
2017	Declaration of Michael T. Goodrich, Ph.D. in Support of Patent Owner's Response
2018	Excerpts from Pogue, David, "iPhone: The Missing Manual," O'Reilly Media, Inc., Pogue Press (1st Ed. August 2007)
2019	Koski, Heli, et al., "Innovation and Dominant Design in Mobile Telephony," <i>Industry and Innovation</i> , Vol. 14, No. 3, 305-324, July 2007, available at https://www.tandfonline.com/doi/abs/10.1080/13662710701369262
2020	Excerpts from Barney, Lee S., "Developing Hybrid Applications for the iPhone," Addison-Wesley, Pearson Education (2009)
2021	Li, Kevin A., et al., "PeopleTones: A System for the Detection and Notification of Buddy Proximity on Mobile Phones," <i>MobiSys '08</i> , June 17-20, 2008

Exhibit	Description
2022	Deposition transcript of Christopher Schmandt, <i>SAP America, Inc. v. Cyandia, Inc.</i> , No. IPR2024-01433, taken on June 18, 2025
2023	Excerpts from Opening Expert Report of Paul C. Clark, DSc., <i>Cyandia, Inc. v. SAP America, Inc.</i> , Case No. 2:24-cv-00096-JRG (E.D. Tex.), served on May 16, 2025
2024	Excerpts from Plaintiff Cyandia, Inc.'s Reply Claim Construction Brief, <i>Cyandia, Inc. v. SAP America, Inc.</i> , Case No. 2:24-cv-00096-JRG, Dkt. No. 80 (E.D. Tex. Mar. 12, 2025)
2025	Excerpts from Defendants' Responsive Claim Construction Brief, <i>Cyandia, Inc. v. SAP America, Inc.</i> , Case No. 2:24-cv-00096-JRG, Dkt. No. 78 (E.D. Tex. Mar. 5, 2025)
2026	Excerpts from Dictionary of Computer and Internet Terms, Page 434 (10th Ed. 2009)
2027	Marti, Stefan, et al., "Giving the Caller the Finger: Collaborative Responsibility for Cellphone Interruptions," ACM (CHI 2005)
2028	Preliminary Constructions, <i>Cyandia, Inc. v. SAP America, Inc.</i> , Case No. 2:24-cv-00096-JRG (E.D. Tex.), dated April 24, 2025

I. INTRODUCTION

Cyandia respectfully requests that the Board affirm the patentability of the Challenged Claims because Cyandia's PCT Publication, which is the primary reference in the Petition's only ground, is not prior art.¹ The '948 Patent properly claims priority to U.S. Patent Application No. 12/465,331 filed May 2009 (Ex. 1106, the "2009 Parent"), which provides written description support for all of the Challenged Claims. This priority benefit disqualifies the PCT Publication as prior art because it shares the 2009 Parent's disclosure and was filed on the same day. *Compare* Ex. 1104 with Ex. 1106. Because Petitioner cites the PCT Publication as disclosing nearly every limitation of the Challenged Claims, Petitioner also admits that the 2009 Parent provides written description support for those limitations, and Petitioner's allegations that remaining limitations lack written support in the 2009 Parent are meritless for the following reasons.

First, the 2009 Parent provides ample written description support for an apparatus that provides alerts on a user's external devices. Petitioner's observation that the 2009 Parent does not expressly list "tactile alerts" among other exemplary

¹ The Petition's only ground relies on the PCT Publication (Ex. 1104) and Austin-Lane (Ex. 1105) in challenging 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").

types of alerts does not raise any issues under 35 U.S.C. § 112 because exhaustive lists of examples are not necessary to establish written description support for a generic term. *See* Pet. at 25-27. In any event, written description exists under Petitioner's proposed construction because the 2009 Parent inherently discloses tactile alerts and tactile alerts were well-known in the art in 2009.

Second, the 2009 Parent also provides ample written description support for the term "information." Petitioner's argument that the 2009 Parent does not adequately describe "information" echoes its argument about providing alerts on external devices, and it fails for essentially the same reasons: an inventor need not list every possible type of information to show adequate written description support for the generic term, "information;" tactile information was inherently disclosed in the 2009 Parent, and tactile information was well-known in the art in 2009.

Third, the 2009 Parent provides 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 based on the current state of the at least one external device indicated by the session data" under any reasonable interpretation of the claim. As properly construed, determining a notification method requires only determining which device(s) to send the alert to and how to send the alert, which the Board agreed was disclosed in the 2009 Parent. *See* Paper 13 at 20-21. Even if the third aspect of the construction applied at institution (determining how to present the alert) is

considered a limitation that should be read from the specification into the claims, it is disclosed in the 2009 Parent because it discloses storing the settings for such determinations in the user's profile in the same way as the allegedly invalidating prior art, Austin-Lane. See Pet. at 53; Paper 13 at 20-21.

Because the 2009 Parent provides written description support for “determining a notification method,” it also provides written description for “generating notification data.” Paper 13 at 22 (determining 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”).

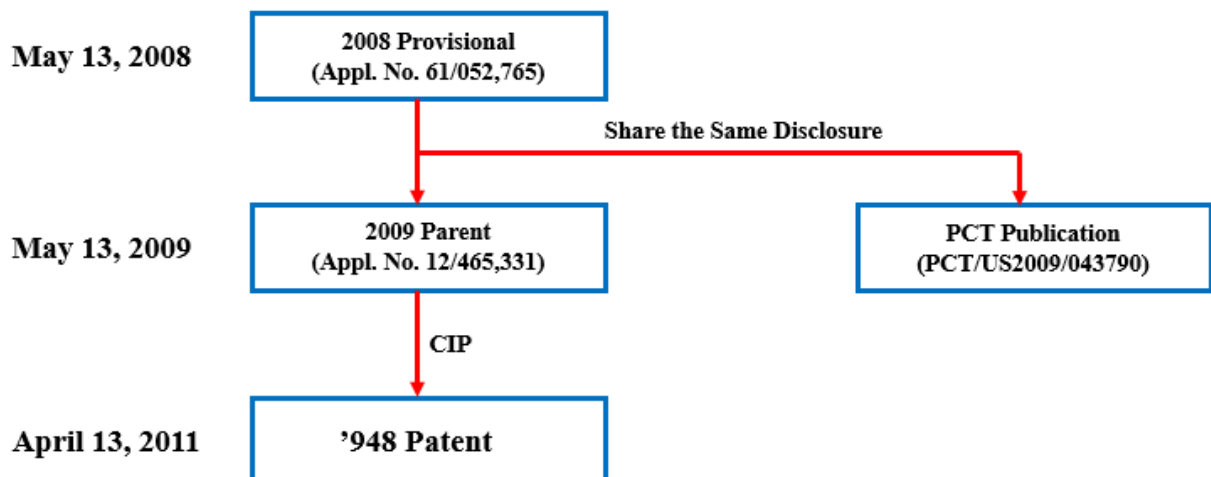
Fourth, the 2009 Parent provides written description support for “provide at least one alert ***on the at least one external device*** based on the current state of the at least one external device indicated by the session data” because it discloses identifying the active devices of the user based on session data and sends alerts to active devices. Petitioner's suggestion that the claim language requires sending an alert to the user's inactive device(s) misconstrues the term “session data,” which is only received for devices that are in sessions (*i.e.* active device(s)). Petitioner's argument also rewrites the term “at least one alert on the at least one external device” to require “at least one alert on ***each of*** the at least one external device,” which

materially alters and improperly narrows the scope of what the inventors claimed as their invention.

II. OVERVIEW OF THE '948 PATENT

A. The '948 Patent's Family Relationships

The '948 Patent is a continuation-in-part ("CIP") of the 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 (63), (60). The PCT Publication likewise claims priority to the 2008 provisional and shares the same disclosure as the 2009 Parent. See Ex. 1104 at ¶ [0001]; Pet. at 32 (asserting that the PCT Publication is identical to the 2009 Parent, "containing the same drawings and specification."). The family relationship between these applications is shown below:



As discussed herein, the 2009 Parent, which the '948 Patent incorporates by reference and claims priority to, provides § 112 written description support for *all* Challenged Claims. Ex. 2017 (“Goodrich Decl.”) at ¶¶ 41-42.

B. The '948 Patent and its Family Member Disclosures

The '948 Patent describes instantiating a channel grid framework, which is an interactive matrix of channels that enables a user to receive and interact with secure user-centric information and providing alerts to the user's device(s) upon detected changes to secure user-centric information. '948 Patent at Abstract. Both the '948 Patent and the 2009 Parent disclose (1) examples of alerts provided on user devices, (2) how to determine a notification method for providing alerts on the user devices, and (3) determining which user devices receive the alerts. See Goodrich Decl. at ¶ 43.

Alerts: The '948 Patent and 2009 Parent describe alerts generically while also providing non-limiting alert examples. See, e.g., '948 Patent at 2:42-44, 9:39-43; Ex. 1106 at ¶ [0023], Claim 9, ¶ [0039]. Specifically, the 2009 Parent's non-limiting examples include visual and auditory alerts:

If an established condition is met, the channel alert server 211 may notify the identity management server 208 to confirm the subscriber of the event, determine the active devices of the subscriber, and then pass through the web services gateway 207 and the channel grid framework 201 *to provide a visual or auditory alert in the channel 202.*

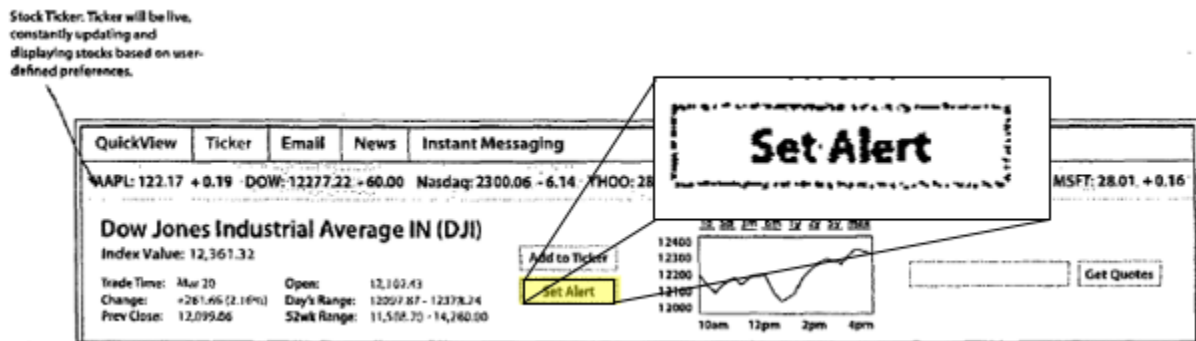
Ex. 1106 at ¶ [0039] (emphasis added); *see also* Goodrich Decl. at ¶ 44.

Determining a Notification Method: This method refers to determining the device(s) of the user to send the alert to and how to send the alert. *See* IV.C.1, *infra* (construing “determining a notification method”). For instance, the 2009 Parent discloses an identity management server that determines the user’s active device(s) based on session data and the protocol (e.g., HTTP) to send the alert via the web services gateway:

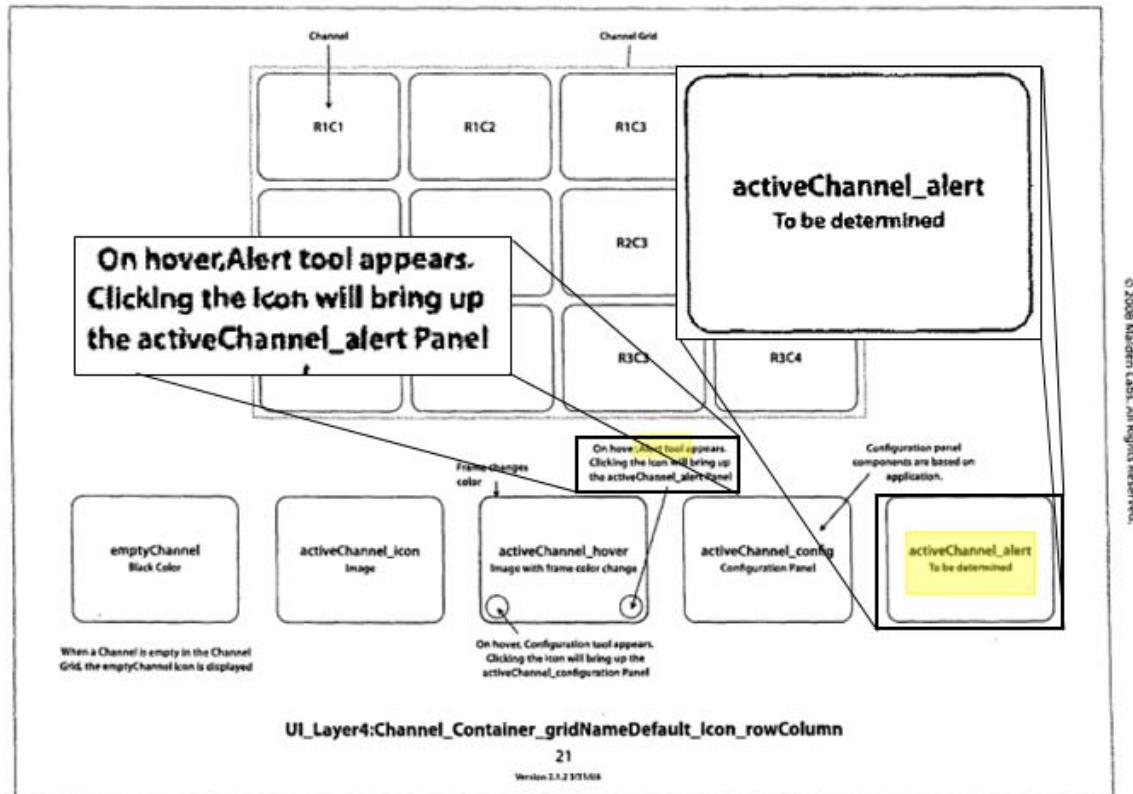
If an established condition is met, the channel alert server 211 may notify the ***identity management server 208*** to confirm the subscriber of the event, ***determine the active devices of the subscriber***, and then pass ***through the web services gateway 207*** and the channel grid framework 201 to provide a visual or auditory alert in the channel 202 The 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.

Ex. 1106 at ¶ [0039] (emphasis added); *id.* at ¶ [0021] (“Information may be delivered to a user based on the user’s identity as established by the system when the user’s session is established”). In some instances, the system may employ user preferences when determining, for example, whether a user wants a visual or auditory alert presented in their channel application on the device. *See id.* at ¶ [0034] (“[A] user profile may be established which may identify user preferences, platform identifies, and services support instructions as to how the user wishes information to behave on the selected platform.”); Goodrich Decl. at ¶ 45.

The 2008 provisional provides details on the system's user-defined preferences that the system can consult in its determinations. For example, the “generalPreferences” tab provides the “[a]bility to monitor select data and send alerts to [] email, SMS, RSS.” Ex. 1108 at 23 (emphasis added). As shown below, the alert is set “based on user-defined preferences” and can appear through a “programming interface” or “media presentation devices” via the presentation determination.



Id. at 45 (annotated).



Id. at 50 (annotated); *see also id.* at ¶ [0010] (“These alerts can also be made to appear, through a programming interface, through other media presentation devices such as digital high definition television or audio signals.”). Accordingly, as was well-known in the art at the time, the 2009 Parent and 2008 provisional disclose storing user preferences that are used by the system. *See* Goodrich Decl. at ¶ 46.

Providing Alerts on User Devices: Both the '948 Patent and 2009 Parent describe alerts provided to *active* devices as indicated by session data. *See, e.g.,* '948 Patent at 20:65-21:2, 21:8-11; Ex. 1106 at ¶ [0039]. For instance, the 2009 Parent discloses determining *the active devices* based on session information and providing alerts on those devices:

If an established condition is met, the channel alert server 211 may notify the ***identity management server 208*** to confirm the subscriber of the event, ***determine the active devices of the subscriber*** The alert can appear as defined on other platforms such as a mobile device

Ex. 1106 at ¶ [0039] (emphasis added).

Information may be delivered to a user based on the user's identity as established by the system when the ***user's session is established***.

Id. at ¶ [0021] (emphasis added); *see also* Goodrich Decl. at ¶ 47.

III. LEVEL OF ORDINARY SKILL IN THE ART

A person of ordinary skill in the art (“POSITA”) as of May 2008 or May 2009 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. Additional experience may make up for a lack of education and vice versa. *See* Goodrich Decl. at ¶¶ 16-19.

IV. THE CHALLENGED CLAIMS ARE PATENTABLE BECAUSE THE PCT PUBLICATION IS NOT PRIOR ART AS THE 2009 PARENT PROVIDES WRITTEN DESCRIPTION SUPPORT FOR ALL CHALLENGED CLAIMS

The Challenged Claims find written description support in the 2009 Parent, which entitles them to a priority date of at least the 2009 Parent.² Because of the priority benefit, the PCT Publication used as the primary reference in the Petition's only ground is disqualified as prior art.

A. The 2009 Parent Provides Written Description Support for the Providing an Alert to an External Device

The 2009 Parent discloses providing an alert to the user's external devices. *See* § II.B, *supra*. For example, “the channel alert server 211 may notify the identity management server 208 to confirm the subscriber of the event, determine the active devices of the subscriber, and then pass through the web services gateway 207 and the channel grid framework 201 to provide a visual or auditory alert in the channel 202.” Ex. 1106 at ¶ [0039]. As it did at institution, the Board should reject Petitioner's contention that the term “alert” should be read to require specific *examples* of alerts, including auditory, visual, and tactile alerts. But even if

² Independent Claims 35 and 36 are substantially identical to Independent Claim 1. *See* Pet. at 65. Accordingly, any written description argument referencing Claim 1 applies equally to Claims 35 and 36.

compliance with Section 112 requires disclosure of **tactile** alerts, the 2009 Parent supports that disclosure because tactile alerts were well-known in the art and were inherent in the disclosure as mobile devices outputted tactile alerts at the time of filing.

1. Claim Construction: Provide an Alert *Encompasses* but Does Not Require Any One Type of Alert

At institution, the Board correctly found that alerts may include “tactile, auditory, and visual information as possibilities **but do not require** any one type of information.” Paper 13 at 15-16 (emphasis added). Thus, while the claims encompass tactile alerts, they do not require tactile alerts. *See 3Shape A/S v. Align Tech., Inc.*, No. IPR2021-01120, Paper 15 at 20 (P.T.A.B. Jan. 11, 2022) (“Ancestral Applications can provide written description support for the challenged claims without specifically disclosing an embodiment” where the claims *encompass*, “without requiring” the embodiment) (emphasis added). The Board should maintain its claim construction findings because the specification need not describe every possible example of a generic term to provide written description for the generic term. Goodrich Decl. at ¶ 50.

The Board’s finding is consistent with the specification, which describes “alerts” generically and without limitation to particular alert types. *See, e.g.*, ’948 Patent at 2:42-44 (“[A]ctionable and/or non-actionable **alerts** may be generated (e.g., in response to one or more triggers) on one or more authenticated user devices and/or

other devices.”) (emphasis added); *id.* at 5:32-36 (“[B]elow are more detailed descriptions of various concepts related to, and embodiments of, inventive methods, apparatus and systems for providing and monitoring secure information via multiple authorized channels and generating **alerts** relating to same.”) (emphasis added). Consistent with this disclosure, the 2009 Parent similarly describes alerts generically, including any type of alert that may be “defined on other platforms such as a mobile device, a television (set top box), a Blu-ray player, or other devices.” Ex. 1106 at ¶ [0039]; *see also id.* at ¶ [0023], Claim 9; Goodrich Decl. at ¶ 51.

For at least the foregoing reasons, Cyandia respectfully requests that the Board maintain its preliminary construction for providing an alert, which encompasses, but does not require, tactile, auditory, or visual alert types. Goodrich Decl. at ¶ 52.

2. The 2009 Parent Discloses Providing an Alert Under the Proper Construction

As established above, the Challenged Claims **encompass**, but do not require, providing tactile alerts. *See* § IV.A.1, *supra*. In this case, written description is not lacking “simply because the embodiments of the specification do not contain examples explicitly covering the full scope of the claim language.” *Falkner v. Inglis*, 448 F.3d 1357, 1366 (Fed. Cir. 2006) (quoting *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005)).

The Board's decision in *3Shape A/S and 3Shape Inc. v. Align Tech., Inc.*, IPR2021-01120, Paper 15 (P.T.A.B. Jan. 11, 2022) is instructive on this point. In the *3Shape* decision, the Board found that the "independent claims **encompass** using unfiltered white light to illuminate an intraoral structure, not that the independent claims **require** using white light to illuminate an intraoral structure." *Id.* at 15 (emphasis added). The Board, therefore, concluded that because the claims "**encompass[ed], without requiring**" its use, the ancestral application "provide[d] written description support for the challenged claims without specifically disclosing an embodiment illuminating an intraoral structure with white light." *Id.* at 20 (citation omitted). Here too, because the alert claim term encompasses, without requiring, a tactile alert, the 2009 Parent provides written description support even though only auditory and visual alert examples are expressly disclosed. *See* § II.B, *supra* (discussing the alert examples disclosed in the 2009 Parent).

The *3Shape* decision also distinguishes *PowerOasis* on this point. *Pet.* at 26 (citing *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299 (Fed. Cir. 2008)); *see also* Paper 13 at 18 (addressing Petitioner's *PowerOasis* citation). In the *3Shape* decision, *PowerOasis* was cited for the understanding that "all *limitations* must appear in the specification" but that written description is not lacking where the specification does not contain examples covering the full scope of the claims.

3Shape A/S, Paper 15 at 15 (citing *PowerOasis*, 522 F.3d at 1306) (further citations omitted).

In *PowerOasis*, unlike in *3Shape* and here, the claims **required** embodiments not disclosed in the parent document. At the lower court, the term “customer interface” was construed to mean an interface that “may be located on the customer’s laptop computer as well as on the vending machine.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, No. Civ. 05-cv-42-PB, 2006 WL 753206, at *7-8 (D.N.H. Mar. 22, 2006). Because the customer laptop embodiment was only disclosed in the child application, and the claim construction explicitly included that embodiment **in the limitation**, the Federal Circuit determined that the child could not claim priority to the parent. *PowerOasis*, 522 F.3d at 1310-11 (affirming the “broader construction” and finding that the parent document did not disclose a customer’s laptop embodiment).

Petitioner’s reliance on *D Three Enterprises, LLC v. SunModo Corp.*, 890 F.3d 1042 (Fed. Cir. 2018) is inapt for similar reasons. Pet. at 21. In *D Three Enterprises*, because the first set of claims required “**any** attachment bracket[],” the Federal Circuit found that “washerless assemblies using attachments other than the attachment bracket 1700 . . . [were] not adequately disclosed” in the parent application because it did not “contemplate[] the use of other types of attachment brackets.” 890 F.3d at 1050 (emphasis added). Similarly, because the second set of

claims required a washer placed at a specific location below or above the flashing, the parent document's disclosure of only a washer placed above did not support the claim. *Id.* at 1051-52. This rationale is not applicable here, where providing a tactile alert on an external device is not a **requirement** of the limitation.

PowerOasis and *D Three Enterprises* are also inapposite because they do not involve a generic term that was well-known in the art with the parent document disclosing examples. That is, unlike *PowerOasis* and *D Three Enterprises*, the 2009 Parent demonstrates possession of the full claim scope, discussed as follows.

3. The 2009 Parent Also Satisfies the Written Description Requirement Because Tactile Alerts Were Well-Known in the Art at the Time of Filing

The 2009 Parent also satisfies the written description requirement because a patent need not expressly disclose what was well-known in the art, and tactile alerts were well-known in the art in 2009. *Spectra-Physics, Inc. v. Coherent, Inc.*, 827 F.2d 1524, 1534 (Fed. Cir. 1987) (citation omitted) (holding that “a patent need not teach, and preferably omits, what is well known in the art.”); *see also* Goodrich Decl. at ¶¶ 53-65. It is black letter law that written description must be evaluated from “the viewpoint of one of skill in the art” and, because of this, an inventor may “rely on information that is ‘well-known in the art’ for purposes of meeting the written description requirement.” *Pandrol USA, LP v. Airboss Ry. Prods., Inc.*, 424 F.3d

1161, 1165 (Fed. Cir. 2005); *Bos. Sci. Corp. v. Johnson & Johnson*, 647 F.3d 1353, 1366 (Fed. Cir. 2011).

Petitioner and its expert admit that tactile alerts were well-known in the art by 2009. Ex. 1103 at ¶ 47 (“POSITAs in 2009 were familiar with visual, auditory, and tactile information”); *id.* at ¶ 48 (“The most common sensory modality of information conveyed to a user using . . . mobile smart phones[] in 2009 was visual information, with auditory information second, and tactile information a distant third.”); Goodrich Decl. at ¶¶ 54-57. Additional evidence confirms that tactile alerts (vibrations, for example) were widely used by mobile phones at this time. *See* Ex. 2003 at Abstract; Ex. 2004 at 354 (listing a number of articles describing the use of tactile alerts in mobile applications); Ex. 2005 at 401 (“When the recipient’s mobile phone receives the SMS message, he is notified by his mobile phone with a sound or vibrating.”); Goodrich Decl. at ¶¶ 54, 57 (citing Exs. 2018, 2019).

While mobile devices could present a tactile alert, there were also a number of application programming interfaces (APIs) that caused such alerts to be presented on mobile devices. Goodrich Decl. at ¶¶ 59-64. For example, JavaScript functions included a “Device.vibrate ()” element that “[c]auses the phone to vibrate for the standard amount of time.” *See* Ex. 2020 at 97; *see also id.* at 98-99; Goodrich Decl. at ¶¶ 61-63 (explaining how the PhoneGap JavaScript API includes Device.vibrate”). As another example, at this time, almost all mobile phone APIs

included a “playVibrate function” that “represent[ed] the standard function for turning on the actuator” and where a server can send tactile alerts using APIs. See Ex. 2021 at 8; Goodrich Decl. at ¶¶ 59-60 (discussing a system that sends tactile alerts to mobile devices using APIs). Thus, this evidence further demonstrates that providing tactile alerts on devices was well-known at the time of filing.

Furthermore, because tactile alerts were essential features of mobile phones in 2009, the 2009 Parent's disclosure of displaying an alert as “defined on other platforms such as a mobile device” (Ex. 1106 at ¶ [0039]) inherently discloses tactile alerts. Goodrich Decl. at ¶ 65; *Yeda Rsch. & Dev. Co. v. Abbott GmbH & Co. KG*, 837 F.3d 1341, 1345 (Fed. Cir. 2016) (“Under the doctrine of inherent disclosure, when a specification describes an invention that has certain undisclosed yet inherent properties, that specification serves as adequate written description to support a subsequent patent application that explicitly recites the invention's inherent properties.”).

The Board's suggestion that the 2009 Parent's disclosure may “tend[] to limit the described alerts to particular forms” is at odds with the evidence and precedent. See Paper 13 at 19. The 2009 Parent does not evince any intention to limit the types of alerts that can be provided to an external device. Although one embodiment discloses two particular types of alerts that may be provided through a channel, neither this embodiment nor any other in the 2009 Patent or the '948 Patent suggests

that the inventors meant to limit the scope of the invention to any particular alerts. Rather, the various types of alerts available in 2009 were well known and a “patent need not teach, and preferably omits.” *Spectra-Physics*, 827 F.2d at 1534 (citation omitted).

The principle that written description support exists where a specification claims a broad genus and describes exemplary non-limiting species is well settled. *See Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357, 1362 (Fed. Cir. 2018) (finding written description support for the generic “light guide” because the ancestral application disclosed a “fibre optics bundle” which was a type of “light guide” and that “various types of light guides were well-known in the art”); *Ajinomoto Co. v. Int’l Trade Comm’n*, 932 F.3d 1342, 1359 (Fed. Cir. 2019) (finding written description support for “more potent promoter” because the patent disclosed four examples and “the genus of more potent promoters was already well explored in the relevant art”) (citing *Bos. Sci. Corp.*, 647 F.3d at 1366); *Agilent Techs., Inc. v. Bio-Rad Labs. Inc.*, No. IPR2019-00266, Paper 10 at 4-5 (P.T.A.B. Oct. 23, 2019) (denying the petitioner’s request for rehearing because there was written description support for the generic “heater” where it was undisputed that broader category of heaters was well-known in the art and that the application disclosed a particular type, a “lid heater”). Thus, alert examples described in a specification do not limit the

specification to just those alert types where the broader category of alerts, including tactile alerts, was well-known in the art and provided on mobile devices.

* * *

For at least the foregoing reasons, Cyandia respectfully submits that providing an alert finds written description support in the 2009 Parent.

B. The 2009 Parent Provides Written Description Support for the “Information” Claim Terms

The 2009 Parent also provides written description support for “user-centric information,” as Petitioner’s obviousness analysis confirms by citing to the disclosure found in the PCT Publication (and therefore 2009 Parent) for interpretation. *See* Pet. at 43-44 (citing Ex. 1104 at ¶ [0022], [0036] (“user-centric information”)); *see also* Ex. 1106 at ¶¶ [0022], [0036], Goodrich Decl. at ¶¶ 66-67. Thus, it is unnecessary for the Board during trial to construe “information” where the “information” term recited in full is admittedly supported by the 2009 Parent.

To the extent that the Board construes the “information,” it should reject Petitioner’s contention that the claim should be limited to tactile information for the same reasons discussed above. *See* Paper 13 at 15-16 (the Board interpreting Petitioner’s “information” and “provide [an] alert” constructions in the same way); *cf.* Pet. at 25 (alleging that the “claims’ ‘secure, user-centric information’ encompasses tactile information”).

C. The 2009 Parent Provides Written Description Support for “Determining a Notification Method” and “Generating Notification Data”

The 2009 Parent provides written description support for “determining a notification method” under the proper construction, which only requires determining which device(s) should receive the alert and how to send the alert. See Goodrich Decl. at ¶¶ 68-71.

At institution the Board considered the written description question by assuming that this limitation requires all three aspects of Petitioner's implicit construction of “determining a notification method” that “can include,” *i.e.* “(1) the user device(s) to send the notification to . . . (2) the communication protocol to use to send the notification . . . ; and (3) . . . how to present the notification.” Pet. at 53; Paper 13 at 20-21 (citing Prelim. Resp. at 34-35). However, the third aspect (“how to present the notification”) is not always needed to determine the notification method, as Petitioner's experts acknowledge. See § IV.C.1, *infra*; see also Ex. 1106, ¶¶ 23, 39. The 2009 Parent, therefore, provides written description support for the Challenged Claims because the Board already agreed that the 2009 Parent discloses the first two aspects of this construction. Paper 13 at 20-21.

Nonetheless, even if all three aspects were required, the 2009 Parent still provides written description support because the third aspect is based on ***user preferences*** that (1) the 2009 Parent discloses, (2) Petitioner's expert acknowledges

includes alert information on the presentation of alerts; and (3) was well-known in the art to be used by systems in determining how to present an alert. Because the 2009 Parent discloses “determining a notification method” under the proper construction (or Petitioner’s construction), it also “discloses generating notification data.” Paper 13 at 22 (stating 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”); § IV.C.3, *infra*.

1. Claim Construction: “Determining a Notification Method”

In the context of the intrinsic evidence, “determining a notification method” includes *determining the device(s) to send the alert to and how to send the alert*. Goodrich Decl. at ¶ 72. This construction differs from the tacit construction applied in the Petition in that how to present an alert (aspect 3) is not required. Pet. at 53. The Board’s adoption of the proposed construction resolves the written description controversy because at institution the Board agreed that the first two aspects are disclosed in the 2009 Parent. See Paper at 13 at 20-21 (focusing only on the third aspect in its analysis).³

³ As discussed in Section IV.C.2.b *infra*, even if Petitioner’s implicit construction is applied, the 2009 Parent provides written description support for the third aspect.

The construction including only aspects one and two is supported by and consistent with the '948 Patent specification, which discloses a “Home Security” embodiment that provides an alert on the user’s device(s) if motion is detected. See *Polaris Innovations Ltd. v. Brent*, 48 F.4th 1365, 1378 (Fed. Cir. 2022) (agreeing with the Board’s adoption of a construction because it was “supported by and consistent with the specification.”). In this embodiment, the system determines (1) that there is an active session on the user’s laptop computer and (2) the protocol (e.g., AMF) for sending the alert via the client gateway. '948 Patent at 20:49-21:36 (disclosing that the system “determine[s] whether the user 116 has an active session . . . [I]n one example, it is determined that the user 116 as an active session on his/her laptop computer” and the system “dispatches the event notification (i.e., alert) through user’s logical event queue. For example, the client gateway 418 . . . transmits (via AMF) the alert”). In this manner, the notification method for the alert is determined as the alert is delivered to the user’s active laptop computer by the protocol through the client gateway. *Id.* at 21:23-36; see also Goodrich Decl. at ¶ 73.

Determining how to present the alert (aspect 3), however, is not a necessary part of determining a notification method. For example, the 2009 Parent discloses an embodiment in which “[t]he alert can appear as defined on other platforms such as a mobile device.” Ex. 1106 at ¶ [0039]; Goodrich Decl. at ¶ 74. In that

embodiment, the mobile device, not the processor, determines how to present the alert, so the overly-narrow construction applied at institution is inconsistent with the intrinsic record. *See Oatey Co. v. IPS Corp.*, 514 F.3d 1271, 1276 (Fed. Cir. 2008) (“We normally do not interpret claim terms in a way that excludes embodiments disclosed in the specification.”).

Furthermore, for some communications protocols, once the protocol is specified, the manner the alert is presented is implicit, SMTP (**email**) or SMS (**text message**). *See, e.g.*, Ex. 1108 at 23 (describing the system sending alerts via SMTP (email) or SMS (text) under the “generalPreferences” tab). Petitioner’s expert, Mr. Schmandt, agreed that how to present an alert may be “implicit in the protocol” in some instances. *See, e.g.*, Ex. 2022 (“Schmandt Dep. Tr.”) at 26:5-27:1 (testifying that text is the “the default with the HTML”). In the co-pending District Court proceeding, Petitioner’s expert, Dr. Clark, accounted for these instances when interpreting “determining a notification method” as requiring only the determination of the devices to send the alert to and how to provide the alert, SMTP (email) or SMS (text). Ex. 2023 at ¶¶ 534-535 (“Clark Rpt.”); Goodrich Decl. at ¶ 75.

Thus, for at least the foregoing reasons, “determining a notification method” includes *determining the device(s) to send the alert to and how to send the alert*. Goodrich Decl. at ¶ 76.

**2. The 2009 Parent Provides Written Description Support For
“Determining a Notification Method” Under the Proper
Construction or Petitioner’s Construction**

**(a) The 2009 Parent Discloses Determining the Devices to
Send the Alert to and How to Send the Alert**

The 2009 Parent provides written description support for “determining a notification method” under the proper construction because it discloses how the system determines the user device(s) to send the alert to and how to send the alert. See Goodrich Decl. at ¶¶ 77-80.

The 2009 Parent discloses an identity management server that determines which of the subscriber’s devices are active and which protocol (e.g., HTTP) should be used to send the alert to the active device(s) via web services gateway 207:

If an established condition is met, the channel alert server 211 may notify the identity management server 208 to confirm the subscriber of the event, **determine the active devices of the subscriber**, and then **pass through the web services gateway 207** and the channel grid framework 201 to provide a visual or auditory alert in the channel 202.

Ex. 1106 at ¶ [0039] (emphasis added); *see also id.* at ¶¶ [0020]-[0021], [0023]. [0026]-[0027], [0031], [0033]; Goodrich Decl. at ¶ 78.

A POSITA would know from the 2009 Parent disclosure how active devices are determined and how alerts are sent by the system. See Goodrich Decl. at ¶ 79. For instance, session information indicates the active user devices and is what the system uses to “determine the active devices of the subscriber” to send the alert to.

See Ex. 1106 at ¶ [0039], ¶ [0021] (disclosing that “[i]nformation may be delivered to a user based on the user’s identity as established by the system when the user’s session is established.”); Pet. at 51 (describing “session data” as meaning “data indicating whether and which of the **user’s device(s) is/are active**”) (citing Ex. 1104, **paragraph 39**); *id.* at 54 (explaining that “a channel alert server [] **determines the active devices** of the user and delivers an alert to the user’s device(s)”) (citing Ex. 1104, **paragraph 39**) (emphases added). Also “web services gateway[s]” use protocols, such as HTTP, to send information to client devices. See Ex. 1106 at ¶ [0039]; Ex. 2006 at 1-2 (describing that an application gateway uses HTTP to send information to clients).

Thus, under the proper construction, “determining a notification method” finds support in the 2009 Parent’s disclosure of its system determining the user device(s) to send the alert to (active device(s)) and how to send the alert (HTTP via the web services gateway). See Goodrich Decl. at ¶ 80.

(b) The 2009 Parent Also Discloses How to Present an Alert Which is Included in Petitioner’s Construction

Even if determining a notification method **also** requires how to present an alert (the third aspect), that aspect is also disclosed in the 2009 Parent because it discloses user preferences that instruct the system of how information should be presented on various platforms. See Goodrich Decl. at ¶¶ 81-85.

During cross-examination, Mr. Schmandt agreed that the third aspect is satisfied if the system consulted user preferences to determine how to present the alert (visually or auditory, for example). Schmandt Dep. Tr. at 52:7-20 (Q: “So long as the information is defined in the user preferences, alert goes out . . . ? A. That’s the third aspect of it. . . .”). Mr. Schmandt further acknowledged that the 2009 Parent’s disclosed “user preferences” and that it includes alert information as to how a user wants the alert to be presented:

Q. So you agree that the PCT Publication teaches a user profile that identifies user preferences . . . as to how the user wishes information to behave on the selected platform?

A. Yes.

Q. Is an alert information?

....

A. [M]y answer to your question is yes.

Id. at 101:18-102:13;⁴ *see also* Goodrich Decl. at ¶ 82.

⁴ As established in Section II.A *supra*, the PCT Publication and the 2009 Parent share the same specification and therefore provide the same disclosure support.

Mr. Schmandt also admitted that it was well-known in the art for a user to set user preferences and a system to reference the user preferences (*i.e.* alert information) to determine how to present an alert:

And it seems pretty clear you would want to respect user preferences.
Users were already use to the idea of setting preferences on their device.
So the only reasonable way for such a system to work would be to allow
the user . . . to set those preferences.

Id. at 53:6-19; *see also id.* at 50:3-52:16. Thus, based on express disclosure and what was well-known in the art, a POSITA would know that the disclosed user preferences (including alert information) are used by “the system [to] determine[] how an alert is presented” (the third aspect). Paper 13 at 21; Goodrich Decl. at ¶¶ 81-83.

In this respect, the 2009 Parent contains the same disclosure as Austin-Lane for “determining a notification method” under Petitioner’s construction including all three aspects. When contending that Austin-Lane discloses the term, Petitioner points to Austin-Lane’s disclosure of determining “***the user device(s)***” to send the alert to, “***the communications protocol***” used to send the alert, and “***how to present***” the alert. Pet. at 53 (emphases added). Petitioner itself admits that the PCT Publication—and thereby the 2009 Parent—is equivalent to Austin-Lane because:

[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)

* * *

[T]he PCT Publication *discloses setting the same type of alert* (stock alert) and presenting it in the same way (visually) as Austin-Lane.

Pet. at 54 (citing Ex. 1104 at ¶¶ [0023], [0039]) (emphases added); Ex. 1106 at ¶¶ [0023], [0039]. To present the alert “visually,” the system may use user preferences to determine that presentation type, just as in Austin Lane. *See, e.g.*, Ex. 1105 at ¶¶ [0019], [0038]. In this manner, the notification method for the alert is determined as the “active devices” are identified, the alert “deliver[ed]” to these devices, and the alert “present[ed] [] in the same way (visually) as in Austin-Lane.” Pet. at 54; *see also* Goodrich Decl. at ¶¶ 84-85.

* * *

For at least the foregoing reasons, the 2009 Parent provides written description support for “determining a notification method” under either the proper construction or Petitioner’s implicit one.

3. The 2009 Parent Provides Written Description Support For “Generating Notification Data”

At institution, the Board agreed that “if the May 2009 application discloses determining a notification method and discloses delivering a notification data” it then “discloses generating a notification data.” *See* Paper 13 at 22. Accordingly,

the 2009 Parent discloses “generating a notification data” for the reasons discussed directly above. Goodrich Decl. at ¶¶ 86-87.

“Notification data” is, at the very least, inherently disclosed in the 2009 Parent because for the alert to be displayed on the user’s device, there necessarily exists notification data responsible for the display. Pet. at 41, 55 (interpreting “notification data” as “the data transmitted to the user’s device that is responsible for causing the alert to be displayed on the user’s device” because “it ‘provide[s] the notification to the user’”); Goodrich Decl. at ¶¶ 88. “Under the doctrine of inherent disclosure, when a specification describes an invention that has certain undisclosed yet inherent properties, that specification serves as adequate written description to support a subsequent patent application that explicitly recites the invention’s inherent properties.” *Yeda Rsch. & Dev. Co.*, 837 F.3d at 1345.

Petitioner acknowledges that the PCT Publication—and therefore the 2009 Parent—discloses setting and presenting the alert on the device:

[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) . . . [and] discloses **setting the same type of alert** (stock alert) and **presenting it** in the same way (visually).

Pet. at 54 (emphasis added) (citing Ex. 1104 at ¶¶ [0023], [0039], Claim 9); *see also* Ex. 1106 at ¶¶ [0023], [0039]. Notification data is, therefore, a necessary and

inherent aspect of the 2009 Parent because it is what causes the alert to be displayed on the user's device. Pet. at 41; *see also* Goodrich Decl. at ¶ 88.

Additionally, Petitioner confirms that a POSITA was aware of notification data and how it is transmitted between devices. Ex. 2001, IPR2024-01432 Petition at 4 (“[A] POSITA would have been *familiar* with communication protocols and markup languages commonly used for *transmitting information (including notification data)* between a server and a user's device(s).”) (emphases added); Goodrich Decl. at ¶ 89. This shows that based on the detailed disclosure of alerts and how they are generated and presented to a user, that generating notification data was disclosed, as this is the mechanism for causing the alert to be displayed. *See* Pet. at 41-42.

In view of the foregoing, “generating notification data” according to the “notification method” is supported by the 2009 Parent.

D. The 2009 Parent Provides Written Description Support For “the at Least One External Device” (Elements [1.10] F, [1.11] G, and [1.12] H)

The 2009 Parent discloses providing an alert to one or more of the user's external devices. *See* Ex. 1106 at ¶ [0039] (“If an established condition is met, the channel alert server 211 may notify the identity management server 208 to confirm the subscriber of the event, *determine the active devices* of the subscriber, and then pass through the web services gateway 207 and the channel grid framework 201 to

provide a visual or auditory alert in the channel 202.”) (emphasis added). Petitioner's written description challenge of “the at least one external device” is in error because it wrongly assumes that the alert is to be provided to “any external devices for which the *received session data indicates that the device is not currently in use.*” Pet. at 29-30 (emphasis added). That is, Petitioner's argument misinterprets the Challenged Claims by assuming that “session data” can be received for a user's *inactive* device(s).

Petitioner's written description challenge of “the at least one external device” is also error because it inserts an unclaimed requirement that *each* of the user's external devices must provide the alert.

1. “Session Data” Indicates That “the at Least One External Device” Provided the Alert Is/Are the User's Active Device(s)

The Challenged Claims require providing an alert to external device(s) based on “session data” that signifies *active* device(s). '948 Patent at Claim 1. Therefore, providing an alert on “at least one external device” refers to user's external device(s) that are *active*, which is disclosed in the 2009 Parent. See Goodrich Decl. at ¶¶ 90-97.

In the claim construction briefing at District Court, Cyandia argued that the alert is provided to the user active device(s) because “session data” cannot be sent

by a “device that is off.” *See* Ex. 2024 at 19-20.⁵ The District Court agreed and in its preliminary constructions at the April 24, 2025 *Markman* hearing adopted the plain and ordinary meaning, which means that “session data” indicates the current state of the user’s active device(s) since the data cannot be sent by inactive device(s). *See* Ex. 2028 at 5 (District Court’s Preliminary Constructions).⁶

The intrinsic and extrinsic records support these conclusions. The ’948 Patent and 2009 Parent disclose session data as information indicating the user’s active device(s). *See* ’948 Patent at 21:1-2, 23:28-29 (data indicating active sessions of the user’s device(s)); Ex. 1106 at ¶ [0039] (“active devices of the subscriber”). Session data is also known in the art to indicate active device sessions. *See* Ex. 2007 at 616 (session data: “Data about a session”); *id.* at 615 (Session: (1) “all the activities which take place during the establishment, maintenance, and release of the connection.” (3) “The period of time during which a user of a terminal can

⁵ At District Court, Petitioner asserted that the Challenged Claims were indefinite because the claims required the alert to be sent to “**each**” external device from which session data is received including inactive devices, but the specification “describes the alert being sent to a device that session data indicates is currently in use by the user.” *See* Ex. 2025 at 23-24.

⁶ At the time of filing, the Court has not issued its claim construction order.

communicate with an interactive system . . .”); *see also* Ex. 2002 at 475 (Session: “The time during which a program is running. In the most interactive programs, a session is the time during which the program accepts input and processes information.”); Ex. 2008 (“When a client application requests a connection to the database server, the database server begins a *session* with the client and creates a data structure for the session in shared memory.”); Ex. 2026 at 434; Goodrich Decl. at ¶ 91.

Petitioner's expert at District Court, Dr. Clark, also interpreted “session data” in this way when asserting that alerts are sent to “user's device where ***the session is active.***” Clark Rpt. at ¶ 535 (emphasis added); Goodrich Decl. at ¶ 96. Accordingly, if session data exists and is received for a particular external device, that device has an active session.

This interpretation is fully described in paragraph 39 of the 2009 Parent, which discloses determining which of a user's devices are active and providing a particular alert on those devices:

If an established condition is met, the channel alert server 211 may notify the identity management server 208 to confirm the subscriber of the event, ***determine the active devices of the subscriber, and then pass through the web services gateway 207*** and the channel grid framework 201 to ***provide a visual or auditory alert*** in the channel 202 The ***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.***

Ex. 1106 at ¶ [0039] (emphasis added). The 2009 Parent further discloses that session data is generated for the active devices when “the user’s session is established,” which allows for “[i]nformation [to] be delivered to a user.” *Id.* at ¶ [0021]; *see also* Goodrich Decl. at ¶¶ 93-95.

Petitioner correctly interprets session data as indicating only **active devices** in its obviousness analysis. *See* Pet. at 51; Goodrich Decl. at ¶ 97. There, Petitioner relies on paragraph 39 (copied above) in asserting that the PCT Publication’s disclosed system “receives the session data indicating a current state of the at least one external device of the user (i.e., data indicating whether and which of the user’s device(s) is/are active)” . . . to “determine the active devices of the subscriber” to send the alert to. *See* Pet. at 51-52 (citing Ex. 1104 at ¶ [0039]) (emphases added); *see also* Ex. 1106 at ¶ [0039] (same). Through this reliance, Petitioner admits that (1) session data indicates “active device(s) of the subscriber” that are provided the alert, and that (2) the 2009 Parent provides written description support for “the at least one external device” because the user’s active device(s) are determined and provided the alert.

2. “At Least One or More External Devices” Means One or More Devices, Not Each Device

The Board should reject Petitioner’s written description argument because it misreads the claims. Specifically, although Petitioner contends that the claims require providing an alert on **each** of “the at least one external device” (active and

inactive), the plain language of the claims only require “provid[ing] **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”:

D) receiving session data indicating a current state of at least one external device of the user;

* * *

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;

'948 Patent at Claim 1 (emphasis added); Goodrich Decl. at ¶ 98.

There is not a one-to-one correspondence between the “at least one alert” and the “at least one external device,” as Petitioner’s interpretation suggests. Pet. at 29-30; Goodrich Decl. at ¶ 99. Instead, the plain language of the claims contemplates providing:

- (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 on 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.

Petitioner's interpretation of the claims rewrites their plain language to encompass only the fifth scenario. The Board should, therefore, reject Petitioner's argument because it is inconsistent with the plain language of the claims.

Petitioner's argument also improperly removes patentable weight from the phrase: "based on the current state of the at least one external device indicated by the session data." '948 Patent at Claim 1; *Bicon, Inc. v. Straumann Co.*, 441 F.3d 945, 950 (Fed. Cir. 2006) ("[C]laims are interpreted with an eye toward giving effect to all terms in the claim."). As claimed, and as explained in the 2009 Parent, the system collects session data that indicates whether one or more of a user's devices are active and causes alerts to be presented on the active devices. '948 Patent at Claim 1; Ex. 1106 at ¶¶ [0021], [0039]. If Petitioner's reading of the Challenged Claim were correct, one or more alerts would have to be provided on **each** of the user's external devices **regardless** of the session data, thereby rendering that limitation superfluous.

If the claim is read as written, however, then the language "based on the current state of the at least one external device" makes perfect sense: notification methods are determined for one or more of the user's external devices, depending on the session data. For example, if a user has five external devices and session data indicates that three of them are active, then notification methods can be determined for the three active devices. '948 Patent at Claim 1. That is precisely what is

disclosed in the 2009 Parent. Ex. 1106 at ¶ [0039] (“If an established condition is met, the channel alert server 211 may notify the identity management server 208 to confirm the subscriber of the event, determine the active devices of the subscriber, and then pass through the web services gateway 207 and the channel grid framework 201 to provide a visual or auditory alert in the channel 202.”).

* * *

For at least the foregoing reasons, the 2009 Parent provides written description support for “the at least one external device” that is provided the alert.

E. All Other Limitations in the Challenged Claims Find Written Description Support in the 2009 Parent

While Petitioner's written description challenge only identifies the five limitations discussed above, all other limitations of the Challenged Claims enjoy written description at least as far back as the 2009 Parent. *See* Goodrich Decl. at ¶¶ 100-104; *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008) (finding that the patent owner is required to show “why the written description in the earlier application supports the claim . . . that means producing sufficient evidence and argument to show that an ancestor to the [challenged patent], with a filing date prior to the [date of the challenged patent], contains a written description that supports all the limitations of [the challenged claims]”).

First, during examination of the '948 patent application, the Examiner accorded the 2009 Parent priority date to several limitations made before

amendments.⁷ Particularly, in its priority date findings, the Examiner determined that the pre-amendment limitations were disclosed in the 2009 Parent. *See* Ex. 1102 at 272-273 (“[T]he claimed invention gets priority date of 05/13/2009 as claimed feature is disclosed in application 12/465,331 [the 2009 Parent].”); Goodrich Decl. at ¶¶ 101-102.

Accordingly, the issue of written description for the pre-amendment limitations has been considered by the Office, and Petitioner does not allege any error, let alone material error, made by the examiner in its priority finding. *See* Pet. at 2-4 (alleging only that amendments made after the examiner’s priority finding lack written description support and asserting no error in the examiner’s priority finding for the pre-amendment limitations). Therefore, for the pre-amendment limitations, the Board should defer to the examiner’s evaluation of the 2009 Parent and their findings of written description support. *C.f. Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, No. IPR2019-01469, Paper 6 at 8-9 (P.T.A.B. Feb. 13, 2020) (precedential) (indicating that if the petitioner fails to make

⁷ The limitations include Element [1.1], Element [1.2], Element [1.3], Element [1.4], Element [1.5] (also recited in Independent Claims 35 and 36), Claims 2, 4-7, 10-11, 13, 18-19, 23, and 29 (collectively, the “pre-amendment limitations”). *See* Ex. 1102 at 75-85.

a showing of material error, the Board should “defer to previous Office evaluations of the evidence of record”).

Second, the limitations amended after the examiner’s priority date findings, and which are not identified in Petitioner’s written description, are also supported by the 2009 Parent as the table below shows:

Claim Limitations/Claim	2009 Parent Support
Limitation [1.6] (Step 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;	Paragraph [0034] Transfer icon #1 mobile device 204, transfer icon # 2 television 205, and transfer icon # 3 other device type may each be a hardware device or software application. If a selected channel202 exists in the application host transfer tool 203, the channel 202 may be moved to a transfer icon through a drag and drop instruction. During a drag and drop function, the channel 202 may be transformed to become available on a selected platform (e.g., a mobile device). During an initial configuration of channels 202, a user profile may be established which may identify user preferences, platform identities, and service support instructions as to how the user wishes information to behave on the selected platform. The selected platform may need to be electronically connectable such as through the Internet, close over-the-air mechanism (e.g., Bluetooth®), or through a wired connection. When the channel 202 appears on the selected platform, it may retain all of its original native functionality from the channel grid framework 201 if it has been configured or programmed to do so. The application host and transfer tool 203 transfer icons 204, 205, 206 may serve as trigger mechanisms, each to activate a channel download to a specific, registered device or platform. The download may be activated by a drag and drop of an

Claim Limitations/Claim	2009 Parent Support
	application host and transfer tool 203 in which channel 202 application resides onto a transfer icon 204, 205, 206, which, in turn, may send the download request to a remote server application where the appropriate and device or platform specific application may be downloaded to the requesting device or platform. Ex. 1106 at ¶ [0034].
Limitation [1.7] (Step C) receiving configuration data indicating one or more user preferences regarding alerts transmitted via the first channel based on the user profile;	Paragraph [0023] The assignment of information priority, event alerts or triggers, and complex actions that can result from the user's interaction with a channel may be built upon and exploited by developers. A development tool or facility may be provided to a developer to create many forms of customization. Triggers may be parameterized against information behavior. Non-limiting examples of triggers may include exceeding a quantified numerical limit and multiple similar events trending in a certain direction. The trigger may cause the information channel to change its appearance or to take other actions that may be implemented by the developer. By way of non-limiting example, one action that may be implemented is to provide a notification to the user. <i>Id.</i> at ¶ [0023]. Paragraph [0039] The channel alert server 211 may be a hardware device or software application that may continually monitor application and information activities defined by a channel. By way of non-limiting example, a user or developer may define threshold conditions with definitive values assigned to events, conditions, logical workflows, discrete information values or signal data. If an established condition is met, the channel alert server 211 may notify the identity management server 208

Claim Limitations/Claim	2009 Parent Support
	to confirm the subscriber of the event, determine the active devices of the subscriber, and then pass through the web services gateway 207 and the channel grid framework 201 to provide a visual or auditory alert in the channel 202. Likewise, the alert may trigger additional actions affecting the channel 202 and the underlying computer application. For example, a channel may be established to monitor an alarm condition of a business or residence. If a condition at the business or residence triggers an alarm, an additional alert action such as notifying a law enforcement agency or a protective services group may be triggered. The 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. <i>Id.</i> at ¶ [0039].
Limitation [1.8] (Step D) receiving session data indicating a current state of at least one external device of the user;	See Step C, Paragraph 39. Paragraph [0021] Information may be delivered to a user based on the user's identity as established by the system when the user's session is established. Because the user is known and authenticated, preferences and rights to certain information types can be defined and managed for the user. <i>Id.</i> at ¶ [0021].
Limitation [1.9] (Step E) monitoring at least the first channel information so as to determine one or more events, conditions, logical workflows, discrete information values or	See Step C, Paragraph 39. Claim 9. The computer-readable storage media of claim 8 further comprising computer-readable instructions configured to cause one or more computer processors to execute the operations comprising:

Claim Limitations/Claim	2009 Parent Support
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):	configuring the channel grid framework to provide an intelligent alert object; comparing the evaluated content provided by the first computer application to a predetermined intelligent alert threshold condition; and displaying an alert condition on the first and second platforms when the evaluated content meets the predetermined threshold condition. <i>Id.</i> at Claim 9.
Claim 3. The apparatus of claim 1, wherein if the one or more events, conditions, logical workflows, discrete information values or signal data is/are determined in E), the at least one processor controls the at least one memory so as to store trigger information relating to the one or more determined events, conditions, logical workflows, discrete information values or signal data.	<i>See</i> Step C, Paragraph 39.

Goodrich Decl. at ¶ 103 (citing '948 Patent at Claims 1 and 3); *see also* Pet. at 13-14.

Third, Petitioner's obviousness analysis also affirms written description support because Petitioner relies on the PCT Publication's disclosure for these limitations—which is “***substantively identical to the May 2009 parent application, containing the same drawings and specification.***” Pet. at 32 (emphasis added); see also *id.* at 43 (Element [1.1] (relying on the PCT Publication's disclosure), 44 (Element [1.2] (same)), 45 (Element [1.3] (same)), 45-46 (Element [1.4] (same)), 47-49 (Element [1.5] A) (same)), 49-50 (Element [1.6] B) (same)), 50 (Element [1.7] C) (same)), 50-52 (Element [1.8] D) (same)), 52-53 (Element [1.9] E) (same)), 58 (Claim 2 (same)), 58-59 (Claim 3 (same)), 59-60 (Claim 4 (same)), 60 (Claim 5 (same)), 60-61 (Claim 6 (same)), 61 (Claim 7 (same)), 61-62 (Claim 10 (same)), 62 (Claim 11 (same)), 62-63 (Claim 13 (same)), 63 (Claim 18 (same)), 64 (Claim 19 (same)), 64 (Claim 23 (same)), 64-65 (Claim 29 (same)); see also Goodrich Decl. at ¶ 104.

* * *

In view of the foregoing, the 2009 Parent provides written description support for each limitation of the Challenged Claims. Therefore, the '948 Patent is entitled to the filing date of the 2009 Parent. Cyandia respectfully requests that the Board hold patentable the Challenged Claims because the PCT Publication is not prior art under pre-AIA § 102(b). See Pet. at 32.

V. CONCLUSION

For at least the foregoing reasons, the Board should hold patentable the Challenged Claims.

Respectfully submitted,

Dated: June 30, 2025

/James Hannah/

James Hannah (Reg. No. 56,369)
Kristopher Kastens (Reg. No. 57,517)
HERBERT SMITH FREEHILLS
KRAMER (US) LLP
333 Twin Dolphin Drive, Suite 700
Redwood Shores, CA 94065
Telephone: (650) 752-1700
Facsimile: (650) 752-1800
James.Hannah@hsfkramer.com
Kris.Kastens@hsfkramer.com

Jeffrey H. Price (Reg. No. 69,141)
Jenna Fuller (Reg. No. 74,212)
HERBERT SMITH FREEHILLS
KRAMER (US) LLP
1177 Avenue of the Americas
New York, NY 10036
Telephone: (212) 715-7502
Facsimile: (212) 715-8302
Jeffrey.Price@hsfkramer.com
Jenna.Fuller@hsfkramer.com

Attorneys for Patent Owner
Cyandia, Inc.

CERTIFICATE OF COMPLIANCE WITH 37 C.F.R. § 42.24

The undersigned hereby certifies that the portions of the above-captioned **PATENT OWNER'S RESPONSE** specified in 37 C.F.R. § 42.24 has 9,705 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24(b)(2). This word count was prepared using the Microsoft Word word-processing system used to prepare this paper.

Dated: June 30, 2025

/James Hannah/
James Hannah (Reg. No. 56,369)
Kristopher Kastens (Reg. No. 57,517)
HERBERT SMITH FREEHILLS
KRAMER (US) LLP
333 Twin Dolphin Drive, Suite 700
Redwood Shores, CA 94065
Telephone: (650) 752-1700
Facsimile: (650) 752-1800
James.Hannah@hsfkramer.com
Kris.Kastens@hsfkramer.com

Jeffrey H. Price (Reg. No. 69,141)
Jenna Fuller (Reg. No. 74,212)
HERBERT SMITH FREEHILLS
KRAMER (US) LLP
1177 Avenue of the Americas
New York, NY 10036
Telephone: (212) 715-7502
Facsimile: (212) 715-8302
Jeffrey.Price@hsfkramer.com
Jenna.Fuller@hsfkramer.com

Attorneys for Patent Owner
Cyandia, Inc.

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 sends an email notifying Petitioner of the filing, service was made on the Petitioner as detailed below.

<i>Date of service</i>	June 30, 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)
<i>Documents served</i>	PATENT OWNER'S RESPONSE
<i>Persons Served</i>	KLARQUIST SPARKMAN, LLP, Roy Chamcharas, Andrew M. Mason, Todd M. Siegel, Samuel B. Thacker

/James Hannah/
James Hannah
Registration No. 56,369
Lead Counsel for Patent Owner