

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

PETITIONER'S REPLY TO PATENT OWNER'S RESPONSE

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LIST OF EXHIBITS

LIST OF NEWLY FILED EXHIBITS

Exhibits concurrently filed with Petitioner's Reply To Patent Owner's

Response:

No.	Description
1132	Nitin Sawhney & Chris Schmandt, <i>Nomadic Radio: Scaleable and Contextual Notification for Wearable Audio Messaging</i> , Proc. of CHI'99, 96-103 (May 1999)
1133	Reply Declaration of Christopher Schmandt, dated September 19, 2025

LIST OF PREVIOUSLY FILED EXHIBITS

No.	Description
1101	U.S. Patent No. 8,751,948 (" '948 Patent ")
1102	File History of U.S. Patent No. 8,751,948
1103	Declaration of Christopher Schmandt, dated September 20, 2024 (" Schmandt Decl. ")
1104	International Patent Application Publication No. WO 2009/140386 to Wetzer et al. (" the PCT publication ")
1105	U.S. Patent Application Publication No. 2004/0044736 to Austin-Lane et al. (" Austin-Lane ")
1106	U.S. Patent Application No. 12/465,331 (" the May 2009 parent application ")
1107	U.S. Patent No. 8,499,250 (" the '250 parent patent ")
1108	U.S. Provisional Patent Application No. 61/052,765 (" the May 2008 provisional application ")
1109	Full Claims Listing (1-7, 10-11, 13, 18-19, 23, 29, and 35-36)

No.	Description
1110	U.S. Patent Application No. 13/086,165 to Wetzner et al. (“ the April 2011 CIP application ”)
1111	U.S. Patent No. 7,348,968 to Thomas Dawson (“ Dawson ”)
1112	U.S. Patent No. 7,136,045 to Rosenberg et al. (“ Rosenberg ”)
1113	Lee et al., <i>Haptic Pen: A Tactile Feedback Stylus for Touch Screens</i> , Proc. of the 17th ann. ACM symp. on User interface software & tech. (UIST ’04), 291-294 (Oct. 2004) (“ Lee ”)
1114	Hoggan et al., <i>Investigating the Effectiveness of Tactile Feedback for Mobile Touchscreens</i> , Proc. of the SIGCHI Conf. on Human Factors in Computing Sys. (CHI ’08), 1573-1582 (Apr. 2008) (“ Hoggan ”)
1115	Stephen Brewster and Aurora Constantin, <i>Tactile Feedback for Ambient Awareness in Mobile Interactions</i> , Proc. of the 24 th BCS Interaction Specialist Grp. Conf. (BSC ’10), 412-417 (Sept. 2010) (“ Brewster ”)
1116	<i>IBM Rational Application Developer V6 Portlet Application Development and Portal Tools</i> (August 2005) (“ WebSphere-Portal ”)
1117	Ron Ben-Natan et al., <i>Mastering IBM WebSphere Portal</i> (2004) (“ Ben-Natan ”)
1118	<i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume I: Installation and Administration</i> (May 2005) (“ WebSphere-Everyplace-1 ”)
1119	<i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume II: Application Development</i> (March 2005) (“ WebSphere-Everyplace-2 ”)
1120	<i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume IV: Advanced Topics</i> (March 2005) (“ WebSphere-Everyplace-4 ”)
1121	N/A
1122	U.S. Patent 7,376,907 to Santoro et al. (“ Santoro ”)

No.	Description
1123	<i>Microsoft Computer Dictionary</i> (5th Edition) (excerpts)
1124	U.S. Patent No. 5,548,692 (“ Cok ”)
1125	<i>Microsoft Internet Explorer ResourceKit</i> , Microsoft (1998)
1126	David Pogue, <i>iPhone The Missing Manual</i> (excerpts) (2007)
1127	David Pogue, <i>Mac OS X Leopard The Missing Manual</i> (excerpts) (2007)
1128	Harry Newton, <i>Newton’s Telecom Dictionary</i> (20th Ed.) (excerpts) (2004)
1129	WSRP standard 1.0 specification
1130	WSRP standard 2.0 specification
1131	Correspondence to Cyandia’s Counsel (dated January 14, 2025) (<i>Sotera</i> stipulation)

I. INTRODUCTION

The only issue in dispute is whether the 2009 application provides sufficient written description support for the later-filed challenged claims of the '948 patent, which issued from a continuation-in-part application (“the CIP”) of the 2009 application. Specifically, Patent Owner alleges only that the PCT publication is not prior art because the challenged claims are entitled to the earlier filing date of the 2009 application.

Certain features of the challenged claims, however, are not supported by the 2009 application. 35 U.S.C. §§ 112, 120; *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008). For example, the 2009 application fails to disclose “determining a notification method” and discloses only two types of alerts (visual and auditory), but not the claims’ generic “alert.” At most, only the CIP’s new matter discloses these claim features.

II. THE 2009 APPLICATION DOES NOT PROVIDE WRITTEN DESCRIPTION SUPPORT FOR “DETERMINING A NOTIFICATION METHOD” AND “GENERATING NOTIFICATION DATA”

The claims’ “determining a notification method” includes three distinct requirements: (1) determining where to send the alert (i.e., which devices to send the alert to), (2) determining how to send the alert (i.e., which protocol to use), and (3) determining how to present the alert (e.g., visual or auditory). All three of these

determinations are necessary for the user to be notified. Patent Owner disputes only whether the claims require the third aspect—determining how to present the alert. Paper 21 at 10-11.

The claims require this third aspect, and, as the Board correctly found in its institution decision, the 2009 application does not provide written description support for this aspect of the required “determining” element at least because the application discloses only providing an alert, not how to present the alert, much less determining how to present the alert based on the external devices’ current states. Paper 13 at 21. The 2009 application also fails to provide written description support for determining which protocol to use (i.e., how to send the alert) at least because it discloses only one protocol (HTTP). Paper 1 at 27-28. Indeed, the 2009 application discloses only a single predetermined way to provide an alert: an in-channel alert sent to a user’s logged-in device(s) using HTTP. EX1106, [0039]. As such, it lacks disclosure of “determining a notification method,” which, at most, is taught only by the new matter recited in the 2011 CIP application.

**A. At Most, Only The 2011 CIP’s New Matter
 Supports The “Determining” and “Generating” Elements**

The 2009 application does not disclose multiple notification methods, much less determining which one to use based on the current state of the user’s devices.

Specifically, the 2009 application discloses its alert process in only one paragraph—
paragraph 39:

If an established condition is met, the channel alert server
... determine[s] the active devices of the subscriber, and
then pass[es] through the web services gateway [] and the
channel grid framework [] to provide a visual or auditory
alert in the channel [].

EX1106, [0039]. Petitioner does not dispute that a web services gateway uses the HTTP protocol, as argued by Patent Owner. *E.g.*, Paper 21 at 25; EX2006, 1-2. The parties also do not appear to dispute that a user must be logged into their account (i.e., have an active session) on a given device to view the channel grid (and thus an alert provided within the channel grid) on that device. EX1106, [0050]-[0051], [0061], FIGS. 4-5; *see also* EX1101, 15:57-16:10. Thus, at most, the 2009 application conveys possession of a channel alert server that uses a predefined protocol (HTTP) to send a predefined alert (an in-channel alert) to the user's logged-in device(s).

As explained in the petition, “[t]he April 2011 CIP application adds an entirely new set of drawings and over 100 paragraphs of text, including new subject matter related to the alerts, such as ... explanation of how the system determines the notification method for the alert.” Paper 1 at 9. Indeed, “[w]hen Applicant amended the claims in December 2013, adding this [determining a notification method] and

several other claim elements, Applicant cited as support ten paragraphs in the April 2011 CIP application ... [n]one of [which] is in the May 2009 [] application.” *Id.*, at 28. Applicant did not cite any paragraph of the 2009 application, including paragraph 39. EX1102, 316.

Among other things, these CIP-only paragraphs add a notification manager that determines a notification method based on the user’s alert preferences and the current statuses of their devices. EX1110, [0041], [0130], [0145] (cited by EX1102 at 316). For example, cited CIP paragraphs 130 and 145 disclose how the notification manager:

queries the configuration server [] for the user’s notification preferences and correlates these notification preferences with session manager [] to determine the best notification method. That is, the notification manager queries the configuration server [] and determines, for example, that the user has certain online notification preferences and certain offline notification preferences. If online, notify by, for example, the user's active session. If offline, notify by, for example, a txt message, call the user's landline, call a friend of the user, and the like. Additionally, notifications may be based on user identity, user role, user location, time, date, and the like.

EX1110, [0130], [0145]; *see also id.*, [0092], [0131], [0146], FIGS. 7B, 11.

The 2011 CIP application also adds several alerts not mentioned in the 2009 application, including IM, email, text messages, and tactile alerts, and discloses that the user can select how they wish to be notified. EX1110, [0093], [0168]. “For example, the user [] may select notify by: Current Device, Email, IM, SMS, Mobile, and the like.” EX1110, [0168]; *see also id.*, FIGS. 15, 18-21.

These facts are similar to those in *PowerOasis*, *Tronzo*, and *Tech. Licensing*, where claims were not entitled to a parent application’s filing date because the claims were supported by only new matter added in a CIP. *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1309-1310 (Fed. Cir. 2008); *Lockwood v. Am. Airlines, Inc.*, 107 F.3d 1565, 1572 (Fed. Cir. 1997); *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1332-1334 (Fed. Cir. 2008); *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998). For example, in *Tech. Licensing*, when adding a new claim by amendment, Applicant similarly cited to only new matter added in the CIP application for § 112 support. *Tech. Licensing*, 545 F.3d at 1333-1334.

Here, Applicant added significant new matter (drawings and description) and pointed to *only* this new matter as allegedly providing § 112 support for the claims’ “determining a notification method.” EX1102, 316. Notifying a user in a predetermined way is not determining a notification method. Although paragraph 39 of the 2009 application briefly mentions delivering an in-channel alert to the user, it does not disclose *determining* which protocol to use to send the alert or how to

present the alert based on the current state of the user's devices. At most, only the CIP application does. This is precisely one of the situations where a claim should not be allowed to be backdated to the filing date of the earlier application. *Tech. Licensing*, 545 F.3d at 1333-1334 (“[A] person skilled in the art [must] understand from the earlier application alone, without consulting the new matter in the [CIP], that the inventor had possession of the claimed [invention] when the [earlier] application was filed.”).

**B. The 2009 Application Does Not
Support Determining A Notification Method
Because It Discloses Only One Predefined Alert Process**

The 2009 application lacks written description support for “determining a notification method” at least because it suggests only one way to provide an alert. Specifically, the POR appears to argue that the 2009 application discloses sending an in-channel alert to the user's logged-in device(s) using HTTP. Paper 21 at 24 (citing EX1106, [0039]), 25 (web services gateway uses HTTP); EX1106, [0050]-[0051], [0061], FIGS. 4-5 (user must be authenticated to view channels/alerts); *see also* EX1101, 15:57-16:10 (same).

Patent Owner's argument strips the “determining” term of any meaning. Paper 21 at 24-25. What is there for the server to determine if it always uses the same predetermined process to provide an alert? *See Kaneka Corp. v. Xiamen Kingdomway Grp. Co.*, 790 F.3d 1298, 1305 (Fed. Cir. 2015) (“A process consists

of a series of acts or steps. It consists of doing something [It] cannot be interpreted as doing nothing”). (citation modified) (quoting *In re Kollar*, 286 F.3d 1326, 1332 (Fed.Cir.2002)) The only way this claimed “determining” has any meaning consistent with the ’948 patent’s specification is if the server includes several possible notification methods and performs steps to decide which one to use based on the current state of the external user devices. Otherwise, there can be no “determining,” just executing a predefined command.

Thus, the 2009 application does not convey possession of “determining a notification method” at least because it discloses only one predetermined way to provide an alert: an in-channel alert sent to the user’s logged-in devices using HTTP. There are no other options to choose from, and thus, no “determining.” The server simply executes a predefined command.

**1. The 2009 Application Does Not Support
Determining Which Protocol To Use Because
It Discloses Only One Predefined Protocol (HTTP)**

The 2009 application suggests only one protocol to deliver the alert—HTTP. EX1106, [0039]. Patent Owner points to only the web services gateway, which uses HTTP. *E.g.*, Paper 21 at 25; EX2006, 1-2. Thus, there is no “determining” for the server to do. It simply uses the one and only predefined protocol at its disposal (HTTP) to deliver the alert in the one and only way it can: through a web services gateway to a channel displayed on a logged-in device.

To the extent Patent Owner points to the 2008 provisional application's disclosure of SMS and email alerts (EX1108, 23), this argument should be dismissed for four reasons: two procedural, two substantive.

First, Patent Owner forfeited this argument by failing to include it in the POR. *See, e.g., Google LLC v. Uniloc 2017 LLC*, IPR2020-00447, Paper 24 at 9-10 n.6 (PTAB May 11, 2021); *In re Nuvasive, Inc.*, 842 F.3d 1376, 1380 (Fed. Cir. 2016). The POR does not argue that the provisional application's disclosure of SMS and email alerts supports determining which protocol to use to send the alert. Instead, the POR mentions this disclosure only in the "Overview of the '948 patent" section (Paper 21 at 7) and when arguing how "determining a notification method" should be construed (Paper 21 at 23). Indeed, the POR points only to the 2009 application for written description support of the "determining a notification method." Paper 21 at 24-28.

Second, disclosures in a provisional application—even if incorporated by reference in a non-provisional—cannot be used to show that the non-provisional application provides written description support for a claim because such disclosure is essential material that can only be incorporated from a U.S. patent or U.S. patent application publication, not a provisional application. *See* 37 C.F.R. § 1.57(d) ("Essential material' may be incorporated by reference, but only by way of an incorporation by reference to a U.S. patent or U.S. patent application publication

‘Essential material’ is material that is necessary to: (1) Provide a written description of the claimed invention”); *see also* MPEP § 608.01(p). Provisional applications are not patent application publications. 35 U.S.C. § 122(b)(2)(A) (“An application shall not be published if that application is ... (iii) a provisional application”).

Third, even if a POSITA considered the 2008 provisional application, they would not have understood the 2009 application to convey possession of multiple notification methods. Applicant abandoned the other types of alerts (SMS and email) disclosed in the 2008 provisional application by omitting them from the 2009 application. *Cf. DDR Holdings, LLC v. Priceline.com LLC*, 122 F.4th 911, 915-918 (Fed. Cir. 2024) (construing claim term “merchant” in line with non-provisional application’s narrower description that a merchant produces, distributes, or sells only goods, not goods *and services*, as more broadly disclosed in the provisional); *DNA Genotek Inc. v. Spectrum Sols. LLC*, No. 2023-2017, 2025 WL 502040, at *3 (Fed. Cir. 2025) (non-precedential) (affirming that omission of provisional application embodiments from non-provisional application supported narrow claim construction despite provisional being incorporated by reference.).

Fourth, even if a POSITA would have understood the 2009 application to convey possession of the other types of alerts disclosed in the 2008 provisional application (SMS, email), they still would not have understood the 2009 application to convey possession of determining which protocol to use based on the current state

of the user's devices at least because the provisional application discloses only that these other types of alerts exist.

**2. The 2009 Application Does
Not Support Determining How To Present
The Alert, Which Is Required By The Claims**

“[D]etermining a notification method” requires determining how to present the alert, and, as the Institution Decision correctly found, the 2009 application does not provide written description support for this. Paper 13 at 21.

**a) “Determining A Notification Method”
Requires Determining How To Present The Alert**

As correctly found by the Institution Decision (Paper 13 at 21), the claims’ “determining a notification method” requires determining how to present the alert, at least because this is what the ’948 patent’s specification discloses and the claims recite. EX1101, 21:1-3, 21:23-36, 23:28-31, 23:51-61, 25:67-26:3, 28:11-14. For example, the specification discloses determining whether to present the alert as, e.g., a text message if the user is offline, or as, e.g., an in-channel border color change if the user is online. *Id.* The claims themselves confirm that the notification method “provide[s]” the alert “on the at least one external device” and that the notification data “cause[s] the ... external device to provide the ... alert.” *Id.*, 31:17-32:15, 36:1-38:19. Dependent claims 13, 16, and 17 further confirm that the notification data dictates how the appearance of a channel changes to generate the alert. *Id.*, 33:39-

55, 33:60-34:5. Thus, the notification method does not just determine how or where to send the alert; it also dictates how the alert is presented.

In wrongly arguing the contrary, Patent Owner points to an embodiment disclosed in the 2009 application that the challenged claims do not cover. Specifically, Patent Owner points to an embodiment in which “[t]he alert can appear as defined on other platforms such as a mobile device.” Paper 21 at 22 (quoting EX1106, [0039]). The claims, however, require that the apparatus (server), not the external device, determines the notification method. Thus, this irrelevant embodiment from the 2009 application cannot be used to help inform the meaning of the claims because it is excluded by the express language of the claims. *Helmsderfer v. Bobrick Washroom Equip., Inc.*, 527 F.3d 1379, 1383 (Fed. Cir. 2008) (affirming construction that excluded the preferred and other illustrated embodiments because “[c]ourts cannot rewrite claim language”); *Elekta Instrument S.A. v. O.U.R. Sci. Int’l, Inc.*, 214 F.3d 1302, 1308 (Fed. Cir. 2000) (“unambiguous [claim] language ... controls over any contradictory language in the written description”); *Chef Am., Inc. v. Lamb-Weston, Inc.*, 358 F.3d 1371, 1374 (Fed. Cir. 2004) (Courts “construe the claim as written, not as the patentees wish they had written it.”).

Patent Owner also wrongly argues that the claims do not require determining how to present the alert because the manner the alert is presented is implicit in at

least some protocols. Paper 21 at 23. Even if that were true, the server necessarily determines how to present the alert as part of determining which type of alert to use. For example, if an SMS text is only visual and a phone call causes the phone to ring, the server still determines whether to present the alert as a silent SMS text or an audible phone call by virtue of determining which alert to use.

Indeed, the '948 patent's new matter teaches to present information (including alerts) "in an intelligent manner" (EX1101, 11:62), such as based on the user's location, time, and date. EX1101, 11:62, 21:4-5, 21:8-11, 23:21-23, 23:35-38. For example, if a phone call necessarily causes the user's phone to ring but the SMS protocol is configurable to present only a visual alert (text), a POSITA would understand based on the '948 patent's new matter that during daytime hours (when the user is awake) the server may call the user's phone but during nighttime hours (when the user is asleep) may send a silent text so as to not wake the user. Thus, just because some protocols may predefine the way the alert is presented does not mean the server ignores how the alert will be presented when "determining the notification method." Ignoring how an alert is presented (e.g., whether an alert may wake a user from sleep) is inconsistent with the '948 patent's teachings to present the alerts "in an intelligent manner," such as based on the time, date, location, etc. *Id.*

Thus, a POSITA would understand that “determining a notification method” requires determining how to present an alert, consistent with the ’948 patent’s new matter.

**b) The 2009 Application Does
Not Support Determining How To
Present The Alert Because It Discloses
Only One Predefined Alert (An In-Channel Alert)**

The 2009 application does not convey possession of determining how to present an alert in part because the server always presents an in-channel alert, regardless of the circumstances. It does not consider whether the user is online or offline. It simply provides the same predefined in-channel alert. This is the only option.

Though the 2009 application mentions that the alert is either visual or auditory (EX1106, [0039]), it includes no disclosure that the server determines which of these two types of alerts to present based on the current state of the external user devices. Thus, as correctly found by the Board in the institution decision (Paper 13 at 21), this mere mention of a visual or auditory alert is not enough to provide written description support for determining how to present an alert. To satisfy the written description requirement, the application must “unambiguously” and “necessarily disclose[]” every claim element (*Hyatt v. Boone*, 146 F.3d 1348, 1353–1354 (Fed. Cir. 1998)), such that a POSITA would “immediately discern” the claim elements

(*Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323 (Fed. Cir. 2000)) and “clearly conclude that the inventor invented the claimed invention as of the filing date sought” (*Lockwood*, 107 F.3d at 1572). Disclosure that merely renders a claim obvious is not enough. *Lockwood*, 107 F.3d at 1571-1572.

Patent Owner’s arguments that the 2009 application discloses determining how to present an alert because it “discloses user preferences that instruct the system of how information should be presented on various platforms” is wrong for two reasons. Paper 21 at 25; *see also id.*, 26-28.

First, it ignores the claim language, which requires “determining a notification method ... based on the current state of the at least one external device.”

Second, Patent Owner’s argument overstates the 2009 application’s disclosure. Unlike the ’948 patent, which expressly discloses correlating notification-specific preferences with the current state of the devices indicated by the session manager, the 2009 application discloses only generic preferences without tying them in any way to the alert or the current state of the user’s devices. *Compare*, e.g., EX1101, 20:60-21:5 (disclosing certain online and offline notification preferences that dictate how the alert is presented depending on whether the user is online or offline), *and id.*, 23:20-32 (same), *with* EX1106, [0021] (mentioning user preferences), *and id.*, [0039] (disclosing alerts). The 2009 application mentions user preferences and alerts in different parts of the specification (EX1106, [0021],

[0039]) and does not tie the preferences to the alerts. The '948 patent, on the other hand expressly identifies specific “notification preferences” and explains how the notification manager “correlates these notification preferences with session manager [] to determine the best notification method.” EX1101, 20:63-65; *see also id.*, 10:27, 20:60-21:15, 23:20-43, 26:4-7. For example, the notification preferences include specific online and offline preferences: “If online, notify by, for example, the user’s active session. If offline, notify by, for example, a txt message” EX1101, 21:1-4, 23:28-31.

Thus, the 2009 application’s mention of generic preferences, untethered from the alerts, cannot provide written description support for the claims “determining a notification method ... based on the current state of the at least one external device.”

Patent Owner also points to testimony from Mr. Schmandt (Petitioner’s expert) explaining how the '948 patent’s disclosed server consults user preferences when determining the optimal notification method. Paper 21 at 27 (quoting EX2022, 53:6-19). The '948 patent description that Mr. Schmandt was referencing (EX1101, 6:50-54), however, is new matter missing from the 2009 application. This new matter, Mr. Schmandt explained, discloses consulting user preferences when determining the notification method, leading a POSITA to understand that the claims require determining how to present the alert. EX2022, 39:24-52:6. Thus, Mr. Schmandt’s testimony only confirms that the challenged claims are not entitled to

the 2009 application's filing date because the claims encompass new subject matter added in the '948 CIP patent that is absent from the 2009 application.

Patent Owner also repeats the losing argument from its POPR that the 2009 application (which is the same as the prior art PCT publication) discloses determining how to present an alert because the Petition compares how the PCT publication and the Austin-Lane prior art reference both present an alert. Paper 21 at 27-28; Paper 7 at 35. As correctly found by the Board, however, "simply delivering an alert does not necessarily mean the notification method for that alert was determined." Paper 13 at 21. Moreover, the petition pointed to these similar alert delivery disclosures in the PCT publication and Austin-Lane to show why a POSITA would have reasonably expected success in combining the references' teachings. Paper 1 at 42-43. The Petition never admitted nor suggested in any way that the 2009 application discloses *determining a notification method*, as intimated by Patent Owner. Paper 21 at 27-28. On the contrary, the petition pointed to Austin-Lane's teachings for this aspect of the claims. Paper 1 at 41-43, 53-54.

Thus, the 2009 application's disclosures of a visual or auditory in-channel alert and generic user preferences do not provide written description support for determining how to present an alert.

**3. Sending An Alert To Active Devices
Does Not Provide Written Description
Support For Determining A Notification Method**

Determining which device(s) to send the alert to is necessary but not sufficient to determine a notification method. The server must also determine how to send the alert (i.e., which protocol to use) and how to present the alert. *Supra* Sections II.B.1, II.B.2; EX1101, 6:50-56, 15:4-19, 20:60-21:15, 23:20-43, 27:38-42. Otherwise, the server won't know how to send the alert, and the user device won't know how to present the alert. Thus, even if the 2009 application discloses determining where to send the alert, it does not provide written description support for determining a notification method.

Moreover, the '948 CIP patent's new matter explains that determining where to send the alert requires more than just determining which devices are active. EX1101, 15:4-13, 20:60-21:15, 23:20-43, FIGS. 7B, 11; *PowerOasis*, 522 F.3d at 1309 (construing claim term based on new matter added in CIP application). For example, if none of the user's devices are online, the server needs to determine, based on user preferences, which offline device to send the alert to. EX1101, 21:1-4, 23:28-31. Sending only an in-channel alert risks unsuccessful delivery if the user's devices are offline, which is inconsistent with the '948 CIP patent's teachings to ensure the user receives the alert. *See id.*, 6:54-56; *Kaneka Corp.*, 790 F.3d at 1304 (rejecting construction of claim term because it was inconsistent with specification).

And even if the user is online on their laptop, the user preferences may dictate something other than an in-channel alert (e.g., a phone call). EX1101, 21:1-4, 23:28-31. Further, the '948 patent's new matter discloses how “notifications may be based on user identity, user role, user location, time, date, and the like,” suggesting that, even if the user is logged in on their laptop, for example, they may receive a silent text on their phone instead of a loud, audible in-channel alert on their laptop during sleeping hours. EX1101, 21:4-5, 23:31-32; *see also id.*, 10:22-29, 12:26-30, 16:11-19, 21:8-11, 23:35-38.

Thus, a POSITA would have understood that sending an in-channel alert to the user's active/logged-in devices is necessary but not sufficient to determine a notification method.

III. THE 2009 APPLICATION DOES NOT PROVIDE WRITTEN DESCRIPTION SUPPORT FOR THE “ALERT” AND “SECURE USER-CENTRIC INFORMATION”

Patent Owner has not satisfied its burden of production to show that the 2009 application described the full scope of the CIP patent's later-claimed invention. *See, e.g., Natural Alternatives Int'l, Inc. v. Iancu*, 904 F.3d 1375, 1380 (Fed. Cir. 2018). As explained by the petition (Paper 1 at 25-27), the CIP patent added new matter expanding the scope of the claims' “alert” and “information” to encompass tactile information and alerts. While the PCT publication's disclosure of visual and auditory embodiments is sufficient to show that the claims are obvious under Section 103,

that same disclosure in the 2009 application fails to show *full-scope* support for the claims under Section 112. *Lockwood*, 107 F.3d at 1571-1572; *In re Meyer Mfg. Corp.*, 411 F. App'x 316, 319 (Fed. Cir. 2010) (non-precedential). Patent Owner and its expert overlook this fundamental difference between Sections 103 and 112(a). Paper 21 at 12-15, 19; EX2017, ¶¶66, 97, 104.

1. No Support For Generic “Alert”

The 2009 application discloses only “a visual or auditory alert.” EX1106, [0039]. The claims, however, recite an “alert,” generically, which the parties do not dispute encompasses at least the tactile alerts expressly added by the CIP’s new matter. Paper 21 at 11-12; EX1101, 15:15-16 (The alerts “may include, but are not limited to, visual alerts, auditory alerts, tactile alerts.”).

Thus, as explained in the petition, the 2009 application’s limiting disclosure does not provide full-scope written description support for the claims’ “alert.” Paper 1 at 25-27 (citing, *e.g.*, *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299 (Fed. Cir. 2008)). Patent Owner’s cited *Falkner v. Inglis* opinion (Paper 21 at 12) is inapposite because, there, the priority application disclosed the broad genus of poxviruses that were later claimed. *Falkner v. Inglis*, 448 F.3d 1357, 1364 (Fed. Cir. 2006). Here, the 2009 application narrowly disclosed only two specific types of alerts, but years later Applicant broadly claimed a generic alert that encompasses much more. EX1106, [0039]. Indeed, the portion of the 2009 application that

discloses the alerts (paragraph 39) does not disclose the visual and auditory alerts as mere examples; it limits the alert to only a “visual or auditory alert.” *Id.* Unlike the patent specification in *Falkner v. Inglis*, for example, paragraph 39 of the 2009 application does not say “provide an alert, e.g. a visual or auditory alert.” *Falkner*, 448 F.3d at 1364 (“[T]he specification states that ‘[t]ypically members of the pox virus family, e.g. vaccinia virus, are used as vaccine vectors.’”). Instead, it defines the alert as being only a “visual or auditory alert,” using the words “visual” and “auditory” as adjectives limiting the alert to only these two types of alerts. EX1106, [0039]. The last sentence of paragraph 39 provides an even narrower disclosure, implying only a visual alert because the “alert [] *appear[s]* as defined on other platforms.” *Id.* (emphasis added)¹; *see also* EX2022, 33:9-35:8 (“[T]his sentence applies only to visual alerts.”).

Thus, the 2009 application conveys that Applicant possessed only visual or auditory alerts, not generic alerts encompassing tactile alerts. *Tronzo*, 156 F.3d at 1159 (Fed. Cir. 1998) (finding no written description support in original application for later claims that were generic as to the shape of a cup because original application

¹ Patent Owner and its expert quote this same sentence from paragraph 39 but omit that the alert only “*appear[s]*” on the other platforms. Paper 21 at 12 (citing EX2017, ¶51).

disclosed only conical-shaped cups); *D Three Enterprises, LLC v. SunModo Corp.*, 890 F.3d 1042, 1050-51 (Fed. Cir. 2018) (finding no written description support in original application for later claims reciting an attachment bracket because the original application disclosed only one type of attachment bracket (attachment bracket 1700 having W-shaped prongs))²; *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479-1480 (Fed. Cir. 1998) (finding no written description support in original application for later claims agnostic to the recliner controls' location because the original application disclosed the controls only in the console).

Patent Owner's cited Board decision in *3Shape* is distinguishable because there, the priority chain did not include a CIP application that expressly added new matter expanding the scope of the disputed claim term. *3Shape A/S v. Align Tech., Inc.*, IPR2021-01120, Paper 15 at 10-11 (PTAB Jan. 11, 2022). Instead, Petitioner argued for a broader interpretation of the term based on claim differentiation. *Id.*, 14-15. Here, as in *PowerOasis*, the CIP application expressly added a new

² The POR mischaracterizes *D Three*. Paper 21 at 14. The claims at issue in *D Three* recited "an attachment bracket" (see, e.g., U.S. Patent No. 9,068,339 at 10:64 (cited by *D Three* at 1047-1048)), not "any attachment bracket," and the opinion indicates this claim language encompasses, not requires, any attachment bracket. *D Three*, 890 F.3d at 1050.

embodiment missing from the 2009 application. *PowerOasis*, 522 F.3d at 1302, 1307, 1309; *see also* Paper 1 at 26-27.

Patent Owner's argument that tactile alerts were allegedly known is wrong for three reasons. Paper 21 at 15-19.

First, it ignores that the 2011 CIP expressly adds tactile alerts. *See PowerOasis*, 522 F.3d at 1309-1310; *Lockwood*, 107 F.3d at 1572; *Tech. Licensing*, 545 F.3d at 1332-1334; *Tronzo*, 156 F.3d at 1159 (each finding no written description support for new matter added in a CIP). If tactile alerts were so well known in 2009, why did Applicant add express mention of them in the 2011 CIP?

Second, it disregards that in the POR's cited *Falkner* case, the original application disclosed the broad genus of poxviruses. *Falkner*, 448 F.3d at 1364. While Applicant need not disclose every known species when they have conveyed possession of the broad genus, they cannot rely on what was known by others to broaden their original disclosure. *Tronzo*, 156 F.3d at 1159; *D Three Enterprises*, 890 F.3d at 1050-51; *Gentry Gallery, Inc.*, 134 F.3d at 1480 (“[C]laims may be no broader than the supporting disclosure....”). As in *Tronzo*, *D Three*, and *Gentry Gallery*, Patent Owner should not be permitted to back-date the overbroad claims covering generic alerts in view of the limited 2009 disclosure.

Third, whether it was known for user devices to provide tactile alerts is irrelevant because the claims of the CIP patent require *server-driven* tactile alerts.

For example, claim 1 recites:

An apparatus to provide ... information on at least one user platform operated by a user ... comprising: ... at least one processor ... executing [] processor-executable instructions ... by: ... determining a notification method by which to provide at least one alert on the at least one external device ... [and] generating notification data ... configured to cause the at least one external device to provide the at least one alert on the at least one external device

EX1101, 31:17-32:15. As explained above in Section II.B.2.a, when “determining a notification method,” the server (“apparatus”) must determine how to present the alert (e.g., as tactile, visual or auditory alert). Per the claims, if the server determines that a tactile alert should be provided, the server generates notification data that causes the user device to provide that tactile alert. Thus, the server, not the end user device, decides how to present the alert and instructs the user device to present the alert that way. As such, even if it was known for mobile devices to provide tactile alerts, as preliminarily found in the Institution Decision (Paper 13 at 18-19), the 2009 application still does not support the full scope of the challenged claims’ *server-driven* alerts.

Patent Owner fails to show that server-driven tactile alerts were well known, let alone that the 2009 Application conveyed that Applicant was in possession of an alleged invention including server-driven tactile alerts. Only one of Patent Owner's proffered exhibits, EX2020, suggests a server-driven tactile alert, and this exhibit was allegedly first printed in June 2009 (EX2020, 2), one month after the 2009 application was filed in May (EX1106, 54). This one belated publication is hardly sufficient to show that server-driven tactile alerts were well known—or known to Applicant. EX1133, ¶¶6-24 (discussing EX1132 and explaining how Patent Owner's cited exhibits fail to demonstrate that server-driven tactile alerts were well known in May 2009).

**2. No Support For Generic
“Secure User-Centric Information”**

In addition to expanding the scope of the alerts, the CIP patent expands the scope of secure user-centric information recited throughout the claims. As with the alerts, the 2009 application discloses audio and visual information (EX1106, [0022], [0039]). The CIP, however, states that “[t]he invention is not limited to presenting information to users [] in a visual fashion” and that “[o]ther ways ... of conveying information to users [] may be, for example ... tactile indicators (e.g., vibration).” EX1101, 9:38-43; EX1110, [0057]. The petition explained this disclosure discrepancy (Paper 1 at 25-26) and Patent Owner and its expert do not dispute this.

Thus, the 2009 application does not provide full-scope written description support for the claimed “provid[ing],” “evaluat[ing],” “receiv[ing],” or “interact[ing]” with “secure user-centric information,” including information encoded as vibrations. EX1101, 31:17-32:15, 36:1-38:19.

IV. CONCLUSION

The challenged claims of the ’948 patent are not entitled to the filing date of the 2009 application, the PCT publication is prior art, and the PCT publication in combination with Austin-Lane render all challenged claims obvious.

Respectfully submitted,

Dated: September 22, 2025

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**CERTIFICATE OF COMPLIANCE WITH
TYPE-VOLUME LIMITATION PURSUANT TO 37 C.F.R. § 42.24**

This brief complies with the type-volume limitation of 37 C.F.R. § 42.24(a)(1)(i).

The brief contains 5,523 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

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

The undersigned certifies that on September 22, 2025, Petitioner emailed copies of **Petitioner's Reply To Patent Owner's Response and Exhibits 1132-1133** to the following email addresses, which Patent Owner has agreed constitutes service. *See* Paper 20 (Patent Owner's Mandatory Notices Under 37 C.F.R. § 42.8(a)(3)).

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