

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 SUR-REPLY

TABLE OF CONTENTS

	Page
I. INTRODUCTION	1
II. THE 2009 PARENT APPLICATION PROVIDES WRITTEN DESCRIPTION SUPPORT FOR ALL CHALLENGED CLAIMS.....	2
A. Petitioner Does Not Dispute That the 2009 Parent Provides Written Description Support for the Vast Majority of the Claimed Subject Matter.....	2
B. Petitioner Does Not Dispute That the 2009 Parent Discloses Providing an Alert to “At Least One External Device”	2
C. The 2009 Parent Provides Written Description Support for “Determining a Notification Method” and “Generating a Notification Alert” Under Either Party’s Construction.....	3
1. Claim Construction: Petitioner’s Narrowing Constructions are Inconsistent With the Intrinsic Record and its Previous Arguments	3
a) “Determining a Notification Method” Does Not Require Determining How to Present the Alert on the External Device.....	3
b) Petitioner’s Expert’s Inconsistent Opinions Warrant a Finding of Patentability	6
2. The 2009 Parent Provides the Necessary Written Description Support For “Determining a Notification Method” Under Any Construction.....	8
a) Petitioner’s Predefined Alert Delivery Process Argument is Flawed Because it Disregards that Aspects 2 and 3 Are Determined from User Preferences.....	9

b)	Petitioner’s Reply Roots its Written Description Challenge in the ’948 Patent’s Non-Limiting Embodiments and Irrelevant Inactive Device	14
D.	The 2009 Parent Provides Written Description Support for “Alert” Term Since Both Parties Agree that “Alert” Encompasses Without Requiring a Particular Alert Type and the 2009 Parent Provides Alert Examples.....	15
1.	Petitioner’s Alleged Lack of Written Description Conclusion Fails as a Matter of Law	16
2.	Petitioner Does Not Address the Articulated Factors for Evaluating the Adequacy of Disclosure for a Generic Claim Term	18
E.	The 2009 Parent Provides Written Description Support for “User-Centric Information”	21
III.	CONCLUSION.....	21

TABLE OF AUTHORITIES

	Page(s)
Cases	
<i>3Shape Inc. v. Align Tech., Inc.</i> , No. IPR2021-01120, Paper 15 (P.T.A.B. Jan. 11, 2022)	15, 16, 17, 18
<i>Application of Smythe</i> , 480 F.2d 1376 (C.C.P.A. 1973)	16
<i>Ariad Pharms., Inc. v. Eli Lilly & Co.</i> , 598 F.3d 1336 (Fed. Cir. 2010)	18, 19
<i>Bilstad v. Wakalopulos</i> , 386 F.3d 1116 (Fed. Cir. 2004)	17, 18
<i>C.R. Bard, Inc. v. Medline Indus., Inc.</i> , No. IPR2019-00208, Paper 57 (P.T.A.B. June 3, 2020)	6
<i>Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.</i> , 93 F.3d 1572 (Fed. Cir. 1996)	16
<i>Falkner v. Inglis</i> , 448 F.3d 1357 (Fed. Cir. 2006)	16, 17
<i>Hologic, Inc. v. Smith & Nephew, Inc.</i> , 884 F.3d 1357 (Fed. Cir. 2018)	16
<i>Home Diagnostics, Inc. v. LifeScan, Inc.</i> , 381 F.3d 1352 (Fed. Cir. 2004)	5
<i>Indivior Inc. v. Dr. Reddy's Labs., S.A.</i> , 930 F.3d 1325 (Fed. Cir. 2019)	12
<i>Key Pharms. v. Hercon Labs. Corp.</i> , 161 F.3d 709 (Fed. Cir. 1998)	7
<i>LizardTech, Inc. v. Earth Res. Mapping, Inc.</i> , 424 F.3d 1336 (Fed. Cir. 2005)	13

<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	7
<i>PNC Bank, N.A. v. United Services Auto. Ass’n</i> , No. IPR2021-01071, Paper 21 (P.T.A.B. Jan. 20, 2022)	2, 16
<i>PowerOasis, Inc. v. T-Mobile USA, Inc.</i> , 522 F.3d 1299 (Fed. Cir. 2008)	15, 17
<i>Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.</i> , No. IPR2025-00632, Paper 20 (P.T.A.B. Nov. 3, 2025)	7
<i>Rexnord Corp. v. Laitram Corp.</i> , 274 F.3d 1336 (Fed. Cir. 2001)	16, 21
<i>Robert Bosch LLC v. Westport Fuel Sys. Canada Inc.</i> , No. IPR2023-0022, Paper 37 (P.T.A.B. Feb. 3, 2025)	6
<i>Tronzo v. Biomet, Inc.</i> , 156 F.3d 1154 (Fed. Cir. 1998)	15, 18
<i>Vas-Cath Inc. v. Mahurkar</i> , 935 F.2d 1555 (Fed. Cir. 1991)	15
<i>Xilinx, Inc. v. Analog Devices, Inc.</i> , No. IPR2020-01564, Paper 34 (P.T.A.B. Mar. 11, 2022)	6

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>AmI</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
2029	Intentionally omitted
2030	Deposition transcript of Christopher Schmandt, <i>SAP America, Inc. v. Cyandia, Inc.</i> , No. IPR2024-01433, taken on November 6, 2025, with deposition Exhibit 2029

I. INTRODUCTION

The effective filing date of the Challenged Claims is no later than the filing date of the 2009 Parent (Ex. 1106), which disqualifies the related PCT publication as disqualified as prior art. Paper 25 (“Reply”) at 1. Petitioner’s Reply does not dispute that the 2009 Parent discloses nearly all the subject matter claimed in the ’948 Patent, including the requirement to provide an alert to “the at least one external device,” which is one of the four limitations alleged in the Petition to lack written description. Petitioner’s remaining arguments with respect to “determining a notification method,” “generating notification data,” and “provide an alert” depend on reading limitations into the claims and misapplying the law of written description.

Despite not challenging the Board’s initial conclusion that “determining a notification method” does not require the improvements disclosed in the 2011 CIP, Petitioner’s main argument in Reply faults the 2009 Parent for not disclosing these implementation details. See Reply at 2-6, 12, 15 (arguing that the claims variously require “a notification manager,” presenting information “in an intelligent manner,” and determining the “best” notification method). Not only would it be legal error to import these limitations into the claims, Petitioner’s already overly narrow express construction of the term does not include them. *Id.* at 1, 10-13. And even under Petitioner’s overly-narrow construction, the 2009 Parent discloses this limitation, because it discloses determining where to send an alert (to a user’s online devices),

how to send the alert (via HTTP, SMS or Email), and how to present the alert (via text, email, visually, or audibly) based on session data stored user preferences.

Petitioner in reply agrees that the “alert” term encompasses but does not require any particular alert type. Reply at 18-19; Paper 21, Patent Owner Response (“POR”) at 11-12. Petitioner’s argument that the term “alert” lacks written description because the specification did not list every possible alert known in the art fails as a matter of law because “a claim can be broader than the embodiments disclosed” in an application. *PNC Bank, N.A. v. United Services Auto. Ass’n*, No. IPR2021-01071, Paper 21 at 17 (P.T.A.B. Jan. 20, 2022) (collecting cases).

II. THE 2009 PARENT APPLICATION PROVIDES WRITTEN DESCRIPTION SUPPORT FOR ALL CHALLENGED CLAIMS

A. Petitioner Does Not Dispute That the 2009 Parent Provides Written Description Support for the Vast Majority of the Claimed Subject Matter

In its Reply, Petitioner does not dispute that Cyandia established written description support for each of the claim limitations not expressly mentioned in the Petition. See POR at 37-43; see *generally* Reply.

B. Petitioner Does Not Dispute That the 2009 Parent Discloses Providing an Alert to “At Least One External Device”

Petitioner also does not dispute that the 2009 Parent provides written description support for “the at least one external device.” See *generally* Reply. Thus, Petitioner does not dispute that the 2009 Parent discloses providing an alert to

external devices based on “session data” that indicates the “current state” of user’s active devices. See POR at 31-34; 2009 Parent at ¶¶ [0021], [0039]. Accordingly, the Board should reject Petitioner’s argument that the ’948 Patent does not disclose the this limitation. See Paper 1 (“Pet.”) at 29-30.

C. The 2009 Parent Provides Written Description Support for “Determining a Notification Method” and “Generating a Notification Alert” Under Either Party’s Construction

Although the parties dispute whether “determining a notification method” requires a specific determination of *how* to present an alert on an external device, written description support for this limitation exists in the 2009 Parent regardless of which construction is chosen.

1. Claim Construction: Petitioner’s Narrowing Constructions are Inconsistent With the Intrinsic Record and its Previous Arguments
 - a) *“Determining a Notification Method” Does Not Require Determining How to Present the Alert on the External Device*

In the POR, Cyandia argued that Petitioner’s express construction of this term, which requires determining (1) where to send an alert, (2) how to send the alert, and (3) how to present the alert, was overly narrow because it improperly excludes embodiments and because how an alert is presented is often implicit once the notification protocol is chosen. POR at 23 (citing Ex. 1108 at 23, Ex. 2022 (“Schmandt Tr. 1”) at 26:5-27:1). Petitioner does not dispute either of these points,

claiming instead that the claim language excludes this embodiment. Reply at 11 (“Patent Owner points to an embodiment disclosed in the 2009 application that the challenged claims do not cover.”); *id.* at 12 (acknowledging that “the server necessarily determines how to present the alert as part of determining which type of alert to use”).

Petitioner's contention that its construction is necessitated by the plain language of the claims is circular because it **assumes** that “determining a notification method” requires determining how to present the alert on the external device. *Id.* at 11 (“The claims, however, require that the apparatus (server), not the external device, determines the notification method.”). Without that assumption, nothing about the claim language demands that the server must determine how the external device will present the alert even if some embodiments disclose that approach.

Petitioner also agrees that the determination of how an alert is presented on an external device is often implicit in the protocol chosen to send the alert. *See* POR at 22-23; Reply at 12 (“[I]f 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.”). For example, where the user preference indicates that the user wishes to receive alerts by e-mail, the notification type (*i.e.* an e-mail message) is implicit in the protocol

chosen to send the alert. POR at 23 (citing Schmandt Tr. 1 at 26:5-27:1).¹ Accordingly, Petitioner's proposed construction also improperly excludes notification methods where the determination of how the alert is presented on the external device is implicit in the determination of how to alert the user.

Failing to meaningfully dispute these dispositive arguments, Petitioner attempts to further limit the claims to providing an alert "in an intelligent manner." Reply at 11-12 ("Ignoring how an alert is presented . . . is inconsistent with the '948 patent's teachings to present the alerts 'in an intelligent manner.'"). The Board should reject Petitioner's attempts to read even more limitations into the broad language of the claims because "[a]bsent a clear disavowal or contrary definition in the specification or the prosecution history, the patentee is entitled to the full scope of its claim language." *Home Diagnostics, Inc. v. LifeScan, Inc.*, 381 F.3d 1352, 1358 (Fed. Cir. 2004).

¹ Petitioner's expert in the district court case interpreted "determining a notification method" as simply being "based on user preferences" indicating the channel protocol to pass the alert through. Ex. 2023 at ¶ 534 (interpreting "determining a notification method" as being "based on the ***user preferences***" that "generate[s] an alert . . . through different channels, e.g., emails, SMS") (emphasis added).

b) Petitioner's Expert's Inconsistent Opinions Warrant a Finding of Patentability

The Board should also find the Challenged Claims patentable because Petitioner's expert has provided contradictory testimony on this dispositive issue. *See Robert Bosch LLC v. Westport Fuel Sys. Canada Inc.*, No. IPR2023-0022, Paper 37 at 18 (P.T.A.B. Feb. 3, 2025) (rejecting expert testimony due to “contradictions that undermine the weight of that testimony”); *Xilinx, Inc. v. Analog Devices, Inc.*, No. IPR2020-01564, Paper 34 at 14 (P.T.A.B. Mar. 11, 2022) (similar); *C.R. Bard, Inc. v. Medline Indus., Inc.*, No. IPR2019-00208, Paper 57 at 22 (P.T.A.B. June 3, 2020) (similar).

Because the 2009 Parent discloses determining who to notify and how to notify them, Petitioner's expert retracted his previous testimony that determining how to present an alert could be satisfied merely by determining the “type” of alert to send, including texts and emails. *See* Pet. at 53 (requiring only the type of alert (“*text . . . an email*”)) (emphasis added). According to Mr. Schmandt, he originally used the term too “loosely” and now thinks that “[a] text itself is not an alert,” allegedly because “[a]n alert is something that a human can detect using sensory mechanisms” and requires “special handling.” Ex. 2030 (“Schmandt Tr. 2”) at 10:17-11:5, 17:6-23, 38:5-9, 39:10-21.

The Board should reject this new construction because Mr. Schmandt also admitted that his new ersatz definition of alert is not consistent with the intrinsic record. See Schmandt Tr. 2 at 41:7-42:17 (maintaining that an SMS text message is not an alert despite the patent explicitly claiming an SMS text message as a type of alert); *Phillips v. AWH Corp.*, 415 F.3d 1303, 1318 (Fed. Cir. 2005) (en banc) (“[A] court should discount any expert testimony ‘that is clearly at odds with the claim construction mandated by the claims themselves, the written description, and the prosecution history.’” (quoting *Key Pharms. v. Hercon Labs. Corp.*, 161 F.3d 709, 716 (Fed. Cir. 1998))).

Petitioner also does not provide any explanation whatsoever for why it has taken different claim construction positions between the PTAB and district court, which warrants vacatur of the institution decision, if not judgment in favor of Cyandia. *Revvo Techs., Inc. v. Cerebrum Sensor Techs., Inc.*, No. IPR2025-00632, Paper 20 at 4-5 (P.T.A.B. Nov. 3, 2025) (precedential); POR at 23. At district court, Petitioner's expert, Dr. Clark interpreted “determining a notification method” requiring session data and user preferences indicating how to send the alert. Ex. 2023 at ¶¶ 535-536. Petitioner should not be permitted to advance an extremely narrow construction before the PTAB while maintaining a broader construction before the district court.

In any event, the 2009 Parent discloses “determining a notification method” even under Petitioner’s construction.

2. The 2009 Parent Provides the Necessary Written Description Support For “Determining a Notification Method” Under Any Construction

The 2009 Parent discloses that “[u]sers may define the type and manner of delivery of information,” which includes “any appropriate type of content or data.” 2009 Parent at ¶ [0020]. These choices are stored in preferences “defined and managed for the user.” *Id.* at ¶ [0021]. Using such preferences, alerts may be defined that “cause the information channel to change its appearance or . . . take other actions that may be implemented by the developer.” *Id.* at ¶ [0023]. When “an established condition is met,” the system confirms the user’s identity, consults session data to determine which of the user’s devices are active, and provides “a visual or auditory alert in the channel.” *Id.* at ¶ [0039]. Accordingly, the 2009 Patent expressly discloses all three aspects of Petitioner’s proposed construction because the system determines who to send the alert to (active devices), how to send the alert (through the channel), and **how** to present the alert on the external device (visually or audibly). POR at 24-28.

a) *Petitioner's Predefined Alert Delivery Process Argument is Flawed Because it Disregards that Aspects 2 and 3 Are Determined from User Preferences*

In order to avoid the plain conclusion that the 2009 Patent discloses “determining a notification method,” Petitioner alleges that the 2009 Parent “does not consider whether the user is online or offline” and “simply provides the same predefined in-channel alert. This is the only option.” Reply at 13; *see also id.* at 7. Both allegations are false.

First, the 2009 Parent expressly describes considering “whether the user is online or offline” (*cf.* Reply at 13):

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.

2009 Parent at ¶ [0039] (emphasis added); *see also* POR at 24-25. As Petitioner admits elsewhere, this disclosure is sufficient to show that the 2009 Parent considers “whether the user is online or offline.” Reply at 3 (“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.”); 2009 Parent 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. Because the user is known and authenticated, ***preferences and rights to certain information types can be defined*** and managed for the user.") (emphasis added).

Second, there is no basis for Petitioner's statement that the in-channel alert is the ***only*** type of alert contemplated in the 2009 Parent, which expressly describes the in-channel alert embodiment as "non-limiting." Cf. Reply at 13, 2 (wrongly asserting that the 2009 Parent "does not disclose multiple notification methods"), 5, 6.

The 2009 Parent describes the process for setting alert triggers and notifications methods far more broadly than Petitioner acknowledges and include any "actions that may be implemented by the developer." 2009 Parent at ¶ [0023]. Accordingly, for example, the 2009 Parent discloses multiple, such as "an email application" and "text application," that present diverse alert types via diverse protocols (e.g., **SMS (text message)**, **SMTP (email message)**). *Id.* at Claim 7, ¶ [0022]. Because the channels provide differing ways to present alerts, user preferences indicate the user's alert preference for interaction. *See id.* at ¶ [0032] ("[a] user may access specific channels 202 and interact with them based on the user's profile"), ¶ [0034] (disclosing that the user profile identifies user preferences). Certainly, by 2009, it was known that user preferences provide the "[a]bility to

monitor select data and send alerts to send email, SMS, RSS” channels, as the 2008 provisional corroborates. Ex. 1108 at 23.

Mr. Schmandt confirmed that the user preferences disclosed in the 2009 Parent included such alert information. He testified that “user preferences” disclosed in the 2009 Parent included “alert information” and that “the only reasonable way” for a system to work is to allow the user “to set those preferences” which is “respect[ed]” in the determination. Schmandt Tr. 1 at 50:3-51:20, 53:6-19, 101:18-102:13; *see also* Ex. 2023 at ¶ 534 (Petitioner’s district court expert confirming that as known in the art, a “server . . . determine[s] the notification method based on the preferences set by [] the user” which is used to “generate an alert . . . through different channels, *e.g.*, **emails, SMS**”) (emphasis added). Accordingly, the 2009 Parent discloses that the system consults user preferences (text, email) to determine the protocol (**SMS (text message), SMTP (email message)**) for sending the alert to the user’s active device(s) where it presented on the channel (which, in these examples, is “implicit in the protocol”). POR at 23 (quoting Schmandt Tr. 1 at 26:5-27:1). Given the foregoing, Petitioner’s assertion that “user preferences” disclosed in the 2009 Parent is “generic [], untethered from the alerts” is contradicted by its own expert and the evidence on record. Reply at 15; *see also id.* at 14 (asserting that the 2009 Parent “discloses only generic preferences without tying them in any way to the alert or current state of the user’s devices”).

Petitioner makes these unsupported, contradicted assertions on the premise that the '948 Patent “***expressly identifies specific*** notification preferences,” the 2009 Parent does not. Reply at 15 (emphasis added); *see also id.* at 14. Petitioner’s position effectively requires express, specific disclosure as in the '948 Patent to show written description support. But the 2009 Parent need not recite *in haec verba* the “specific” user preferences language in the '948 Patent to disclose “determining a notification method.” *See Indivior Inc. v. Dr. Reddy’s Labs., S.A.*, 930 F.3d 1325, 1349 (Fed. Cir. 2019) (stating that “[t]he specification need not recite the claimed invention *in haec verba*” so long as the specification reasonably conveys the claimed feature to a skilled artisan).

Moreover, Petitioner asserts that Austin-Lane reference—having substantially similar alert delivery disclosure as in the 2009 Parent—***discloses*** the “determining a notification method.” Ex. 1105 at ¶ [0019] (disclosing delivery instructions based on “***user preferences***”) (emphasis added), ¶¶ [0036]-[0039], [0046] (similar); *see also* POR at 28. Like the 2009 Parent, Austin-Lane discloses alert delivery instructions that include the communication protocol (“SMTP (for

email), SMS (for texts), HTTP (for web browsers)”) and the alert type (“text . . . an email, an audible”). Pet. at 53.²

Petitioner acknowledges these “similar alert delivery disclosures.” Reply at 16. Although Petitioner states that this only “show[s] why a POSITA would have reasonably expected success in combining the references’ teachings,” it confirms that techniques for determining a notification method were well-known long before 2009, and satisfying the written description requirement does not require recapitulating what was already known in the art because “a skilled artisan ‘comes to the patent [application] with the knowledge of’” determining how to send and present a notification. *LizardTech, Inc. v. Earth Res. Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005). Accordingly, if Austin-Lane discloses “determining a notification method” (see Pet. at 53), so does the 2009 Parent.

For at least the foregoing reasons, the 2009 Parent discloses a system with “several possible notification methods and performs steps to decide which one to

² As discussed above, an alert type is implicit in SMTP and SMS protocols, so no extra alert type determination step is necessary with respect to these alert delivery methods. See POR at 23.

use” based on the session information (aspect 1) and user preferences (aspects 2 and 3). Reply at 7.

*b) Petitioner's Reply Roots its Written Description
Challenge in the '948 Patent's Non-Limiting
Embodiments and Irrelevant Inactive Device*

Petitioner in reply roots its written description challenge in the '948 Patent's non-limiting embodiments and irrelevant inactive devices. *See, e.g.*, Reply at 2-6, 10, 11, 12-15, 17-18.

The '948 Patent's added matter has no bearing on the 2009 Parent's written description support because the new matter does not limit the construction of “determining a notification method.” *See id.* at 4-5, 12, 14-15, 17-18. Whether the Board adopts Cyandia's or Petitioner's “determining” construction, neither one is limited by the '948 Patent's added matter (e.g., determining a “best” notification method, using a “notification manager,” and providing an alert in “an intelligent manner”). At institution, the Board recognized that the CIP's added matter was not part of Petitioner's “determining a notification method” construction:

Petitioner notes that certain disclosures added to the April 2011 CIP application describe a “notification manager” to “determine the best alert notification method” [but] [t]hat ***does not mean that Petitioner construes the claim language to require determining the best method.***

Paper 13 at 20 (emphasis added). Petitioner does not challenge that finding here.

Based on the foregoing, Petitioner's assertion that the "facts here are similar to those in *PowerOasis*, *Tronzo*, and *Tech Licensing* . . . because the claims were supported by only new matter added in a CIP" is simply untrue. Reply at 5. Unlike in those cases where the claims required the CIP's added matter, neither parties' construction of "determining a notification method" requires the '948 Patent's added matter for which support need "appear in the specification." *3Shape Inc. v. Align Tech., Inc.*, No. IPR2021-01120, Paper 15 at 20 (P.T.A.B. Jan. 11, 2022) (quoting *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008)).

* * *

At bottom, the 2009 Parent conveys to a POSITA that the Applicant had possession of "determining a notification method" at the time of the 2009 Parent filing. See *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64 (Fed. Cir. 1991) (asserting that "the applicant must [] convey with reasonable clarity to those skilled in the art that, as of the filing date sought, [the inventor] was in possession of the invention.").

D. The 2009 Parent Provides Written Description Support for "Alert" Term Since Both Parties Agree that "Alert" Encompasses Without Requiring a Particular Alert Type and the 2009 Parent Provides Alert Examples

Both parties agree that the "alert" term encompasses but does not require a particular type of alert and that the 2009 Parent provides alert examples. POR at 11-

12; Reply at 19-20. Accordingly, written description support is shown, and Petitioner's conclusion otherwise fails as a matter of law. Reply at 18-19.

1. Petitioner's Alleged Lack of Written Description Conclusion
Fails as a Matter of Law

Petitioner's Reply assumes two premises, namely (1) that the "generic alert" term is broad enough to encompass tactile alerts and (2) the 2009 Parent does not expressly describe a tactile alert. *Id.* at 18-21. Even granting these premises, Petitioner's written description challenge fails as a matter of law.

Petitioner concludes that the 2009 Parent does not provide written description support for the alert term merely because the scope of the claim encompasses tactile alerts not disclosed in the parent document. *See* Reply at 18-19. "But this reflects a misunderstanding of the law—a claim *can* be broader than the embodiments disclosed therein." *PNC Bank*, Paper 21 at 17 (citing *Rexnord Corp. v. Laitram Corp.*, 274 F.3d 1336, 1344 (Fed. Cir. 2001); *Ethicon Endo-Surgery, Inc. v. U.S. Surgical Corp.*, 93 F.3d 1572, 1582 n.7 (Fed. Cir. 1996); *Application of Smythe*, 480 F.2d 1376, 1384 (C.C.P.A. 1973)).

The written description test does not require disclosing every embodiment within the scope of the claim. *Falkner v. Inglis*, 448 F.3d 1357, 1366 (Fed. Cir. 2006); *Hologic, Inc. v. Smith & Nephew, Inc.*, 884 F.3d 1357, 1361-63 (Fed. Cir. 2018). This test was reflected in *3Shape A/S v. Align Tech., Inc.*, No. IPR2021-

01120, where the claim “*encompass, without requiring*” using an unfiltered white light and the Board found written description support in an ancestral application despite the application not disclosing an unfiltered white light embodiment. *3Shape A/S*, Paper 15 at 19-20; *see also* POR at 12-14. That is, because unfiltered white light was ***not a limitation***, it need not “appear in the specification” of the ancestral document. *3Shape A/S*, Paper 15 at 20 (quoting *PowerOasis*, 522 F.3d at 1306). So too here, because a tactile alert is not a limitation, it need not “appear in the specification” of the 2009 Parent. *Id.*; POR at 13-15.

Petitioner's only response is that the '948 Patent is a CIP that adds alert examples, unlike in *3Shape*. Reply at 21-22; *see also id.* at 19-20 (similarly relying on the CIP's added matter in trying to distinguish *Falkner*). That the '948 Patent identifies other alert examples does not change the written description test. *See id.* at 5 (identifying “IM, email, text messages, and tactile alerts” as examples described in the 2011 CIP). The general rule requires only the “disclosure of a species” to sufficiently provide written description support for the broader claimed genus. *Bilstad v. Wakalopulos*, 386 F.3d 1116, 1124 (Fed. Cir. 2004). The 2009 Parent discloses an “alert” broadly as well as particular alert species like those disclosed in the '948 Patent. 2009 Parent at ¶¶ [0032], [0039] (disclosing visual and auditory alerts); § II.C.2.a, *supra* (discussing the 2009 Parent's disclosure of text and email messages given the text and email channels). And because the alert term

“encompass[es], without requiring” a tactile alert, the 2009 Parent meets the written description test, just as the ancestral application did in *3Shape*. *3Shape A/S*, Paper 15 at 19-20.

Petitioner's reliance on *Tronzo* does not change the conclusion because *Tronzo* is the “exception[] to the general rule that disclosure of a species provides sufficient written description support for a later filed claim directed to the genus.” *Bilstad*, 386 F.3d at 1124-25; Reply at 20-21, 22 (citing *Tronzo v. Biomet, Inc.*, 156 F.3d 1154, 1159 (Fed. Cir. 1998)). In *Tronzo*, the ancestral document expressly stated it “discloses *only* conical shaped cups and nothing broader.” *Tronzo*, 156 F.3d at 1159. Thus, the *Tronzo* specification unambiguously limited the scope of the invention to one species. The 2009 Parent does not.

Tronzo is also inapt here because for a generic claim term, adequacy of disclosure is evaluated based on a number of factors, which discussed below further confirm support for the broader genus of alerts.

2. Petitioner Does Not Address the Articulated Factors for
Evaluating the Adequacy of Disclosure for a Generic Claim
Term

Petitioner does not address any of the articulated factors set forth by the Federal Circuit in evaluating the adequacy of disclosure for generic claim terms, including “the existing knowledge in the particular field, the extent and content of the prior art . . . [and] the predictability” of the technology. *Ariad Pharms., Inc. v.*

Eli Lilly & Co., 598 F.3d 1336, 1351 (Fed. Cir. 2010). Petitioner instead argues that the “Applicant possessed only visual or auditory alerts, not encompassing tactile alerts.” Reply at 20; *see also id.* at 24 (alleging that “Patent Owner fails to show that server-driven tactile alerts were well known”).

To the contrary, the 2009 Parent discloses other alert types and supports the broader category of alert types, including tactile alerts, given the existing knowledge in the field, content of the prior art, and the predictability. For example, Mr. Schmandt testified that a POSITA is someone who “would have been familiar with common approaches for presenting information” and “languages commonly used for transmitting information.” Ex. 1103 at ¶¶ 36-37. Mr. Schmandt also testified that in 2009, a POSITA was “familiar with visual, auditory, and tactile” alerts used in these common approaches. *Id.* at ¶ 47. Indeed, before the 2009 Parent’s filing, tactile alerts were presented on a user’s device with either the user device or the server determining such presentation. *See* POR at 15-17 (citing Goodrich Decl. at ¶¶ 59-64 (discussing server-driven APIs in Ex. 2020 (“Barney”) that caused tactile alerts to be presented on user devices)); Schmandt Tr. 2 at 65:24-66:10 (acknowledging that Austin-Lane (published 2004) “discloses that alerts can be tactile and that through a notification mechanism alerts can be generated on end user devices”).

Barney and Austin-Lane show that server-driven tactile APIs existed in the art before the 2009 Parent filing, which Petitioner and Mr. Schmandt overlook in reply. Ex. 2017, Goodrich Decl. at ¶ 63 (discussing that Barney “had confirmed vibration functionality for both iPhones and Android smartphones on **February 23, 2009**”) (citing Barney at 183 (Appendix C, Table C.1)) (emphasis added); Schmandt Tr. 2 at 35:17-36:23. Instead, Petitioner and Mr. Schmandt single-mindedly focus on Barney’s publication date. Reply at 24 (asserting that the Barney “exhibit was allegedly first printed in June 2009”); Ex. 1133 at ¶ 24 (similar). The publication date does not change the critical fact that server-driven vibrate functionality existed in commonly used JavaScript packages prior to the 2009 Parent. Ex. 2017, Goodrich Decl. at ¶ 61 (APIs existed in the “***the two most commonly used*** open-source JavaScript software packages for writing [device] applications.”) (quoting Barney at xiii, Preface) (emphasis added). As Dr. Goodrich stated, these commonly used packages “notif[ied] users of important pieces of information, [by] insert[ing] them into an HTML div or another element”” such as the “Device.vibrate () element.” *Id.* at ¶¶ 61-62 (quoting Barney at 3); *see also* Barney at 97.

Accordingly, because a POSITA was familiar with the common approaches for presenting alerts—which included server-driven tactile APIs by the filing of the 2009 Parent—they would appreciate that the Applicant had possession of tactile alerts. But even assuming *arguendo* this was not the case (it was), there is no written

description inadequacy because “an applicant is not required to describe in the specification every conceivable ***and possible future embodiment of his invention.***” *Rexnord Corp.*, 274 F.3d at 1344 (emphasis added).

Based on the foregoing, the 2009 Parent's disclosure of several species of alerts conveys to a POSITA that the Applicant was in possession of the broader genus of alerts.

E. The 2009 Parent Provides Written Description Support for “User-Centric Information”

Because Petitioner's analysis for user-centric information is also based on tactile information, the 2009 Parent provides written description support for the same reasons it provides support for the “alert” term. *See* § II.D, *supra*; POR at 19.

III. CONCLUSION

For the abovementioned reasons and those advanced in the POR, the Board should hold patentable the Challenged Claims because the PCT publication reference is disqualified as prior art.

Respectfully submitted,

Dated: November 13, 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) 715-9100
Facsimile: (212) 715-8000
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 foregoing **PATENT OWNER'S SUR-REPLY** has 4,679 words in compliance with the 5,600 word limit set forth in 37 C.F.R. § 42.24(c)(4). This word count was prepared using the Microsoft Word word-processing system used to prepare this paper.

Dated: November 13, 2025

/James Hannah/
James Hannah (Reg. No. 56,369)
Attorneys for Patent Owner

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>	November 13, 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 SUR-REPLY
<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