

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 B2

Before JEFFREY S. SMITH, MITCHELL G. WEATHERLY, and
GREGG I. ANDERSON, *Administrative Patent Judges*.

SMITH, *Administrative Patent Judge*.

JUDGEMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
35 U.S.C. § 318(a)

I. INTRODUCTION

Petitioner, SAP America, Inc., filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–7, 10, 11, 13, 18, 19, 23, 29, 35, and 36 of U.S. Patent No. 8,751,948 B2 (Ex. 1101, “the ’948 patent”). We issued an Institution Decision (Paper 13, “Dec.”) instituting the petitioned review. Patent Owner, Cyandia, Inc., filed a Patent Owner’s Response (Paper 21, “PO Resp.”). Petitioner filed a Reply (Paper 25, “Reply”) and Patent Owner filed a Sur-Reply (Paper 30, “PO Sur-Reply”). Petitioner and Patent Owner filed supplemental briefs (Papers 39, 40) addressing the impact of the *Revvo* decision (*Revvo Techs. v. Cerebrum*, IPR2025-00632, Paper 20 (PTAB Nov. 3, 2025) (precedential)) on this proceeding. A hearing was held and a transcript was entered into the record. Paper 42 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6(b)(4) and § 318(a). This Decision is a final written decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73 as to the patentability of claims 1–7, 10, 11, 13, 18, 19, 23, 29, 35, and 36 of the ’948 patent. We determine Petitioner has shown by a preponderance of the evidence that claims 1–7, 10, 11, 13, 18, 19, 23, 29, 35, and 36 are unpatentable.

II. REAL PARTIES-IN-INTEREST

Petitioner identifies itself and SAP SE as real parties in interest. Pet. xi. Patent Owner identifies itself as the real party in interest. Paper 5, 1.

III. RELATED MATTERS

Petitioner and Patent Owner identify *Cyandia, Inc. v. SAP America, Inc. et al.*, Case No. 2:24-cv-00096-JRG (E.D. Tex. Feb. 12, 2024) (“Texas litigation”) as a related matter involving the ’948 patent. Pet. xi; Paper 5, 1.

IV. THE '948 PATENT (EX. 1101)

The '948 patent is titled “Methods, Apparatus and Systems for Providing and Monitoring Secure Information via Multiple Authorized Channels and Generating Alerts Relating to Same” and relates “generally to monitoring secure sources of information to determine particular aspects, trends, and/or values associated with the information, and providing one or more alerts in connection with same.” Ex. 1101, code (54), 1:66–2:3. The Specification describes “an information delivery system for, and methods of, eventing and alerting using multiple information forms and sources across multiple types and/or brands of electronic devices, such as televisions, mobile devices, and computing device.” *Id.* at 5:42–46. The information delivery system provides “the display of and access to secure user-centric information via the construct of a channel grid framework serving as a desktop on a user device.” *Id.* at 5:47–50. “The channel grid framework includes multiple user-selectable items that provide access to corresponding ‘channels’ by which respective portions of user-centric information are delivered to a user.” *Id.* at 5:50–53.

The user and the user device are first authenticated to receive the secure user-centric information, and the user-selectable items included in the channel grid framework on the desktop for the user device are based on information access rights and security protocols defined for the corresponding channels, the user, and the user device.

Id. at 5:54–59.

Figure 3 of the '948 patent is reproduced below.

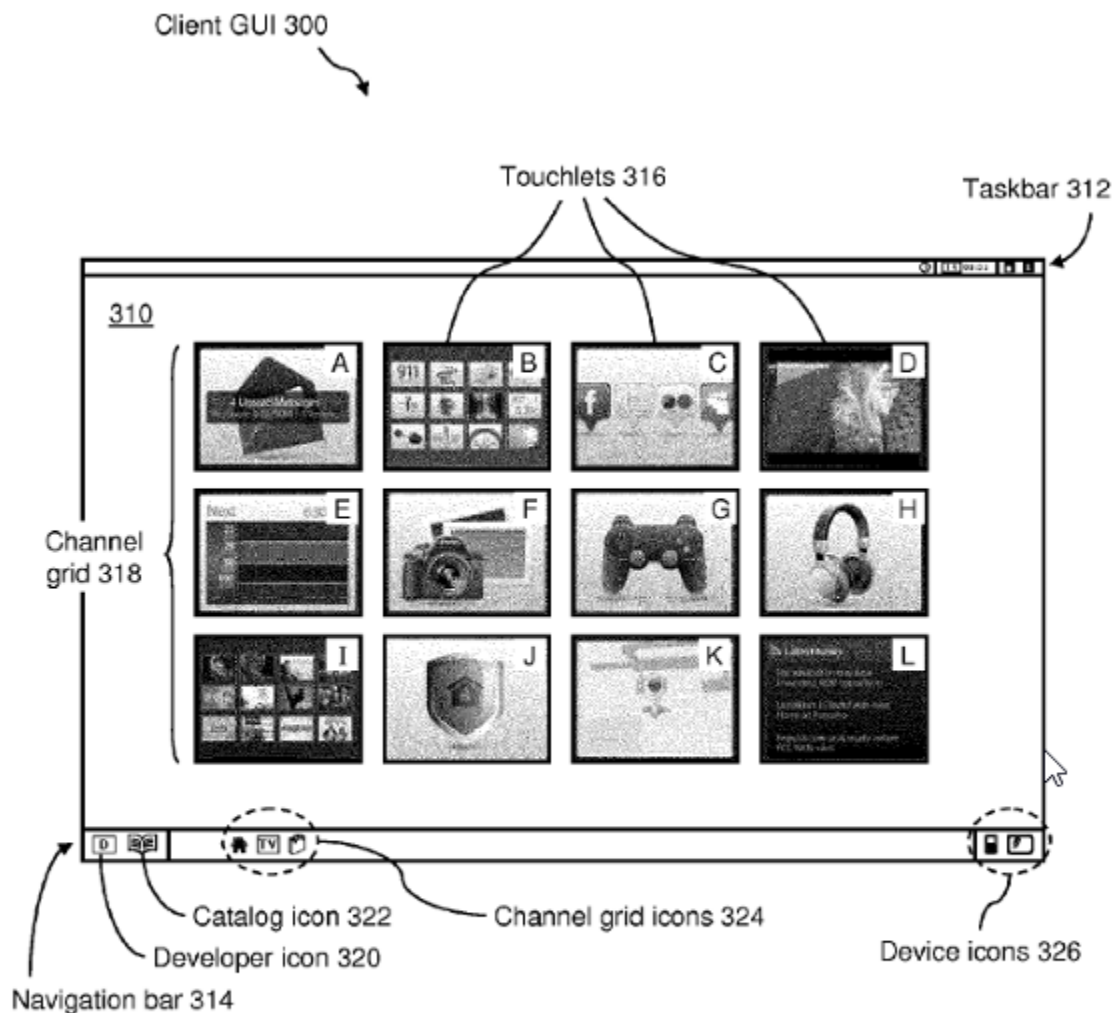


FIG. 3

Figure 3 above illustrates a screenshot of an example of a client GUI 300 that shows an example of a channel grid which is one example of a presentation framework of PID (personal information delivery) application 112. *Id.* at 11:13–16. Client GUI 300 includes main viewing panel 310, a taskbar 312 provided along the top of main viewing panel 310, and a navigation bar 314 provided along the bottom of main viewing panel 310. *Id.* at 11:16–20. Multiple touchlets 316A through 316L are presented in a

3x4 channel grid 318 in the main viewing panel 310 of client GUI 300. *Id.* at 11:38–40. Each touchlet 316 in the 3x4 channel grid 318 of client GUI 300 represents a channel 200 of a specific purpose and/or function. *Id.* at 11:42–44.

The system evaluates user-centric information using the PID application. Ex. 1101, 18:21–23. For example, the system may perform a method of alerting based on sensor data of a home security system, where the sensor data includes door sensor data, window sensor data, motion sensor data, and smoke detector data. *Id.* at 19:53–58. In this example, “Home Security” touchlet 316J of channel grid 318 of client GUI 300 of Figure 3 is associated with a “Home Security” channel. *Id.* at 19:64–66. The system collects and stores sensor data, and an event manager monitors the collected data for an event such as a triggering of a door sensor, a window sensor, a motion sensor, or a smoke detector. *Id.* at 20:6–8, 20:22–29. When the event manager detects an event, such as the triggered door sensor, it notifies a notification manager. *Id.* at 20:49–53.

The notification manager then queries a configuration server for the user’s notification preferences and correlates the notification preferences with a session manager in order to determine a notification method. *Id.* at 20:60–65. That is, the notification manager queries the configuration server and determines that the user has certain online notification preferences and certain offline notification preferences. *Id.* at 20:65–21:1. The notification manager also queries the session manager to determine the user’s connectedness. *Id.* at 21:6–8. For example, if the user has an active session on a laptop, and has an online notification preference of “notify by the user’s active session,” the notification manager determines that the notification

method is via the active session on the user's laptop. *Id.* at 21:8-15; *see id.* at 21:1-4.

V. ILLUSTRATIVE CLAIM

Claim 1 is independent and is reproduced below¹:

- [1.1] 1. An apparatus to provide secure user-centric information on at least one user platform operated by a user, and to evaluate at least some of the secure user-centric information, the apparatus comprising:
 - [1.2] at least one communication interface facilitating wired and/or wireless communications with the at least one user platform via one or more transmission media;
 - [1.3] at least one memory storing processor-executable instructions; and
 - [1.4] at least one processor communicatively coupled to the at least one communication interface and the at least one memory, retrieving processor-executable [sic] instructions from the at least one memory, and executing the processor-executable instructions to provide and evaluate at least some of the secure user-centric information by:
 - [1.5] A) implementing a channel grid framework including a matrix of a plurality of authorized channels through which the user receives and/or interacts with, via the at least one user platform, respective portions of the secure user-centric information based at least in part on information access rights and/or security protocols respectively associated with the plurality of authorized channels, the plurality of authorized channels including at least a first channel through which the user receives and/or interacts with first channel information constituting a

¹ We adopt the brackets added by Petitioner. Pet. 12-13.

- first portion of the secure user-centric information;
- [1.6] 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;
 - [1.7] C) receiving configuration data indicating one or more user preferences regarding alerts transmitted via the first channel based on the user profile;
 - [1.8] D) receiving session data indicating a current state of at least one external device of the user;
 - [1.9] E) monitoring at least the first channel information so as to determine one or more events, conditions, logical workflows, discrete information values or 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):
 - [1.10] 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;
 - [1.11] G) generating notification data according to the determined notification method, wherein the notification data is configured to cause the at least one external device to provide the at least one alert on the at least one external device; and
 - [1.12] H) controlling the at least one communication interface to transmit the notification data to the

at least one external device via the first channel without being requested by the user, wherein the transmission of the notification data to the at least one external device is based at least in part on information access rights and/or security protocols respectively associated with the corresponding plurality of authorized channels, the user, and the at least one user platform.

Ex. 1101, 31:17–32:15. Claims 35 and 36 are also independent and recite limitations similar to those of claim 1. *Id.* at 36:1–38:19. The remaining challenged claims depend, either directly or indirectly, from claim 1. *Id.* at 32:16–35:12.

VI. PRIOR ART AND ASSERTED GROUND

Petitioner asserts the following ground of unpatentability:

Claim(s) Challenged	35 U.S.C. § ²	Reference(s)/Basis
1–7, 10, 11, 13, 18, 19, 23, 29, 35, 36	103	The PCT Publication ³ , Austin-Lane ⁴

VII. LEVEL OF ORDINARY SKILL

Petitioner contends that a person of ordinary skill in the art at the time of filing “would have had a bachelor’s degree in electrical engineering, computer science, or equivalent, with two or more years of experience developing and implementing graphical user interfaces for controlling server-based applications, including handling asynchronous notifications

² As discussed below, the challenged claims are entitled to the filing date of Application No. 13/086,165 (“The April 2011 CIP application”), which is April 13, 2011. Therefore, the pre-AIA statutes apply.

³ International Patent Application Publication No. WO 2009/140386 A1, pub. Nov. 19, 2009 (Ex. 1104).

⁴ U.S. Patent Application Publication No. 2004/0044736 A1, pub. Mar. 4, 2004 (Ex. 1105).

generated by those applications and web services, such as portal systems, or an equivalent amount of relevant work or research experience” and “would have been familiar with common approaches for presenting information on a graphical user interface, including various layouts for presenting multiple elements, such as icons, widgets, windows, etc.” Pet. 14–15. Petitioner describes further capabilities that such a person of ordinary skill in the art would have had. *Id.* at 15–16.

Patent Owner asserts that a person of ordinary skill in the art at the time of filing “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” and that “[a]dditional experience may make up for a lack of education and vice versa.” PO Resp. 9.

Because Petitioner’s proposed level of ordinary skill in the art appears to be consistent with the challenged patent and prior art, we adopt it and use “skilled artisans” to refer to people with such skill at the time the invention was filed. We do not perceive a substantive distinction between the parties’ definitions, but note that Petitioner’s definition provides more detail about the capabilities of skilled artisans. Also, the level of ordinary skill in the art can be evidenced by the references cited, and we find it commensurate with the cited references in this proceeding. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001); *In re GPAC Inc.*, 57 F.3d 1573, 1579 (Fed. Cir. 1995); *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

VIII. CLAIM CONSTRUCTION

Claim 1 recites “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.” (“The determining limitation”). This is the only claim term that we need to construe to in order to resolve the controversy between the parties. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Ltd.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (noting that “we need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy’” (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999))).

A. The contentions of the parties

Petitioner implicitly proposes construing “determining a notification method” as encompassing (1) determining the external device(s) to send the notification to, such as a phone or a desktop computer, (2) determining how to send the notification, such as by email, text, or HTTP, and (3) determining how to present the notification, such as in an email, text, or a pop-up window. Pet. 53. Petitioner implicitly construes “based on the current state of the at least one external device indicated by the session data” as encompassing presence information indicating whether and on which device(s) the user is online and/or whether and on which applications the user has an active session. *Id.* at 53–54.

Patent Owner proposes construing “determining a notification method” as encompassing “determining the device(s) to send the alert to and how to send the alert,” which, according to Patent Owner, satisfies aspects (1) and (2) of Petitioner’s proposed construction. PO Resp. 21 (emphasis omitted). Patent Owner contends that aspect (3), determining how to present the alert, is not a necessary part of determining a notification method, and that construing this term to include aspect (3) would exclude the disclosed embodiment of the mobile device determining how to present the alert. *Id.*

at 22–23 (quoting *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.”). Patent Owner further contends that aspect (3) is implicitly determined for some protocols, such as email or SMS text message, because how the alert is presented is implicitly determined by determining the protocol for sending the alert. *Id.* at 23.

In its proposed construction of the determining limitation, Patent Owner does not construe the phrase “based on the current state of the at least one external device indicated by the session data.” *See* PO Resp. 22–23. Later in its Response, however, Patent Owner contends that the scope of the determining limitation excludes “determining a notification method . . . based on the current state of the at least one external device” as offline, because, according to Patent Owner, session data would not indicate that the current state of the device is offline. PO Resp. 35; *see id.* at 30–34. For example, Patent Owner contends that “Petitioner’s written description challenge . . . 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.’” *Id.* at 31 (quoting Pet. 29–30) (emphasis omitted). According to Patent Owner, “Petitioner’s argument misinterprets the Challenged Claims by assuming that ‘session data’ can be received for a user’s inactive device(s).” *Id.* (emphasis omitted). In supporting this contention, Patent Owner relies on the specification’s disclosure of data indicating active sessions of the user’s devices, as well as extrinsic evidence asserting that session data is data about a session. *Id.* at 32–33 (citing Ex. 1101, 21:1–2, 23:28–29; Ex. 2007, 616; Ex. 2002, 475; Ex. 2008; Ex. 2026, 434; Ex. 2017 ¶ 91). In construing “based on the current state of

the at least one external device indicated by the session data,” Patent Owner contends that “[a]s claimed . . . 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.” *Id.* at 36; *see id.* at 3, 31.

B. Our Analysis

In construing the determining limitation, the district court stated that it “will give this term a ‘plain and ordinary meaning’ construction.” Ex. 3002, 34; *see id.* at 41. Therefore, we construe the determining limitation according to the plain and ordinary meaning construction used by the district court, which is articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b). Under *Phillips*, “the ordinary and customary meaning⁵ of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1313. “Because the meaning of a claim term as understood by persons of skill in the art is often not immediately apparent, and because patentees frequently use terms idiosyncratically,” we look “to those sources available to the public that show what a person of skill in the art would have understood disputed claim language to mean” (*id.* at 1314), starting with “the intrinsic evidence, including the claims themselves, the specification, and the prosecution history.” *Personalized Media Commc’ns, LLC v. Apple Inc.*, 952 F.3d 1336, 1340 (Fed. Cir. 2020).

We agree with Petitioner that the plain language of “determining a notification method . . . based on the current state of the at least one external

⁵ This is the same as the “plain and ordinary meaning” construction applied by the district court.

device indicated by the session data” encompasses “determining a notification method based on” session data indicating the current state of the external device, where the current state of the device encompasses an online state as well as an offline state. *See* Pet. 53–54; Tr. 55:3–10 (The Board: “Are there any other states of an external device other than online or offline?” Patent Owner: “As far as I know, Your Honor, those are the only two[.]”), Tr. 65:24–66:1 (The Board: “When the claim says current state, they mean it’s online or offline?” Petitioner: “Correct.”), Tr. 20:23–21:8. The specification is consistent with the plain language of the claim in disclosing two examples of the claimed “current state,” namely, online and offline. Ex. 1101, 21:1–4. The specification discloses that the notification manager “queries session manager 456 to determine the user’s connectedness.” *Id.* at 21:6–8. The specification discloses that if the user is “online, notify by, for example, the user’s active session. If offline, notify by, for example, a txt [sic] message, call the user’s landline, call a friend of the user, and the like.” *Id.* at 21:1–4, 23:28–31.

With respect to the claimed “at least one alert on the at least one external device,” we agree with Patent Owner that when the user has only one external device, the plain language of this claim term encompasses one alert on the user’s only external device. PO Resp. 35 (emphasis omitted). In this case, when the one external device is offline, the plain language of the claimed “determining a notification method . . . based on a current state of the . . . one external device,” read in view of the specification, encompasses determining, based on the current state of the one external device as offline, a notification method for the offline device, such as a text message. *See* Ex. 1101, 31:64–65.

If we were to interpret the claim to exclude determining a notification method based on the current state of the device as offline, then we would be adding restrictions to the claim not found in the claim language itself. That is, the plain claim language recites “determining . . . based on a current state,” where the current state encompasses online or offline. Further, in the case of the user having only one external device with a current state of offline, interpreting the claim to exclude determining a notification method based on the current state of the device as offline as proposed by Patent Owner would result in not performing the claimed steps of “generating notification data according to the determined notification method” and “transmit the notification data to the at least one external device,” which is inconsistent with the plain language of these claim terms.

We find that the plain claim language indicates that the claims cover determining a notification method based on the current state of the device, where the claimed “current state” encompasses more than an active, or online state. That is, the plain claim language “current state” encompasses an offline state, and the plain claim language “determining a notification method” for a device having a “current state” of offline encompasses determining a notification method by which to provide an alert to the offline device based on the current state of the device as offline. To construe the claims otherwise would ignore the plain meaning of the “words of the claims themselves.” *See Phillips*, 415 F.3d at 1314. “Had the patent drafter intended to limit the claim[ed]” determining limitation to occur only when the current state is online and to exclude determining when the current state is offline, “narrower language could have been used in the claim.” *Cyntec Co. v. Chilisyn Elecs. Corp.*, 84 F.4th 979, 986 (Fed. Cir. 2023). Federal

Circuit case law does “not support prescribing a more particularized meaning unless a narrower construction is required by the specification or prosecution history,” which is not required here as discussed in the following paragraph. *3M Innovative Props. Co. v. Tredegar Corp.*, 725 F.3d 1315, 1329 (Fed. Cir. 2013).

Turning to the specification, Patent Owner’s contention that the scope of the determining limitation excludes determining based on the current state of the device as offline is based on the premise that the claimed “session data” would not indicate the current state of the offline device as offline. *See* PO Resp. 3, 31–36. We disagree. The specification of the ’948 patent, contrary to Patent Owner’s contention, discloses that “notification manager . . . queries session manager 456 to determine the user’s connectedness.” Ex. 1101, 21:6–8. The specification also discloses that

the notification manager . . . queries the configuration server 454 for the user’s notification preferences and correlates these notification preferences with session manager 456 to determine [a] notification method. That is, the notification manager queries the configuration server 454 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.

Id. at 20:60–21:4. The specification’s disclosure of querying the session manager to determine the user’s connectedness, or “current state” as claimed, and to notify an offline device by text message based on the current state of the device as offline, contradicts Patent Owner’s contention that session data received from the session manager would not indicate the current state of an offline device as offline.

If we were to interpret the claim to exclude determining a notification method based on the current state of the device as offline, the “embodiment in the specification” of determining a notification method by which to provide an alert on the offline device “would not fall within the scope of the claim. Such an interpretation is rarely, if ever, correct and would require highly persuasive evidentiary support, which is wholly absent in this case.” *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996); *see Oatey Co.*, 514 F.3d at 1276. We find that “it is highly unlikely that an inventor would define the invention in a way that excluded [this disclosed] embodiment, or that persons of skill in this field would read the specification in such a way.” *Hoechst Celanese Corp. v. BP Chems. Ltd.*, 78 F.3d 1575, 1581 (Fed. Cir. 1996).

With respect to the extrinsic evidence cited by Patent Owner, “while extrinsic evidence can shed useful light on the relevant art,” the Federal Circuit has “explained that it is less significant than the intrinsic record in determining the legally operative meaning of claim language.” *Phillips*, 415 F.3d at 1317. “We need not consider the extrinsic evidence that limits the claim scope in a manner not contemplated by the intrinsic record.” *Genuine Enabling Tech. LLC v. Nintendo Co.*, 29 F.4th 1365, 1372–73 (Fed. Cir. 2022). We are not persuaded by the extrinsic evidence cited by Patent Owner because the extrinsic evidence “is less significant than the intrinsic record” and “limits the claim scope in a manner not contemplated by the intrinsic record.”

The plain language of the claim, read in view of the specification, recites that “determining” is “based on the current state,” does not limit “determining” to occur only when the current state is online, and does not

exclude “determining” when the current state is offline. The claim term’s recitation of broad language “compels a similarly broad result.” *Malvern Panalytical Inc. v. TA Instruments-Waters LLC*, 85 F.4th 1365, 1372 (Fed. Cir. 2023). We interpret the scope of the claimed “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,” read in view of the specification, to encompass at least determining a notification method by which to provide an alert on an external device based on the current state of the external device indicated by the session data from the session manager, where the current state of the external device encompasses at least an offline state as well as an online state. This is the scope of the determining limitation that must be supported by the written description of the 2009 Parent in order for the challenged claims of the ’948 patent to be entitled to the filing date of the 2009 Parent.

IX. WHETHER A DISCRETIONARY ISSUE EXISTS

Patent Owner contends that Petitioner’s expert Dr. Clark construed “determining a notification method” in the invalidity report to the district court as requiring session data and user preferences indicating how to send the alert. PO Sur-Reply 7 (citing Ex. 2023 ¶¶ 535–536 (Dr. Clark’s invalidity report)). Patent Owner contends that, in contrast to Dr. Clark’s invalidity report, Petitioner contends in Reply that “determining a notification method” requires determining how to present an alert. Paper 40, 1. Patent Owner contends that “[b]ecause SAP took a different position on claim construction in the District Court and in its Reply, the institution decision should be vacated under *Revvo*.” *Id.*

Petitioner contends that the two paragraphs cited by Patent Owner in Dr. Clark’s invalidity report include only an excerpted prior art analysis submitted to the district court prior to the district court’s *Markman* Order, and did not include a proposed construction of the determining limitation. Paper 39, 1. Petitioner contends that Dr. Clark’s report assumed the construction of Patent Owner’s infringement contentions, and that the Petition applied the plain and ordinary meaning to the determining limitation. *Id.* at 1–2. Petitioner contends that Petitioner’s Reply explained how the plain meaning of the determining limitation encompasses determining how to present the alert, and therefore, the Reply “explained the ‘ordinary meaning [of the determining limitation] in the context of the [patent].’” *Id.* at 2. Petitioner contends that this explanation is consistent with Dr. Clark’s invalidity report and the district court’s *Markman* Order, “although [at the district court] the ‘parties’ dispute’ has thus far not required clarification of the plain and ordinary meaning.” *Id.*

Patent Owner contends that the district court “held that the [determining limitation] should be given its ‘plain and ordinary meaning,’ which required only consulting ‘session information and a user’s preferences to determine how to notify the user.’” Paper 40, 1. Patent Owner contends that Dr. Clark applied the plain and ordinary meaning of the determining limitation in his invalidity report. *Id.* Patent Owner contends that SAP should not advance a plain and ordinary meaning before the Board that is different than the plain and ordinary meaning before the district court. *Id.* at 2.

We agree with Petitioner. Dr. Clark’s invalidity report provides an analysis of whether the determining limitation is taught by the prior art, not a

proposed construction of the determining limitation. Dr. Clark’s analysis is consistent with the plain and ordinary meaning advanced by Petitioner in this proceeding. That is, the scope of the determining limitation encompasses determining a notification method by which to provide one alert on one external device based on the current state of the at least one external device indicated by the session data as online (as well as offline) as discussed in our claim construction. Dr. Clark’s analysis explains how the prior art determines a notification method, such as email or SMS, by which to provide the alert to the device based on the current state of the device as online. *See* Ex. 2023 ¶¶ 533–536. As discussed in our claim construction of the determining limitation, the determining limitation also encompasses determining a notification method based on the device’s current state as offline. The fact that Dr. Clark did not apply a prior art analysis to every possible embodiment that falls within the scope of the determining limitation does not mean that he applied a different construction than Petitioner applied in this proceeding.

We find that Dr. Clark’s prior art analysis is consistent with Petitioner’s contention that the determining limitation requires how to present the alert based on the current state of the user’s devices as online or offline. For example, in the Reply, Petitioner contends that the 2009 Parent does not disclose “how to present the alert, much less determining how to present the alert based on the external devices’ current states.” Reply 2. Petitioner contends that the 2009 Parent “does not disclose . . . how to present the alert based on the current state of the user’s devices.” *Id.* at 5–6. Petitioner contends that “the claim[ed] ‘determining a notification method’ requires determining how to present the alert[.] 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.* at 10 (internal citations omitted). Petitioner contends that Patent Owner, in arguing that the 2009 Parent discloses determining how to present an alert, contends that Patent Owner “ignores the claim language, which requires ‘determining a notification method . . . based on the current state of the at least one external device.’” *Id.* at 14. Petitioner then cites to portions of the specification that disclose certain online and offline notification preferences that dictate how the alert is presented depending on whether the user is online or offline. *Id.* at 14–15 (citing Ex. 1101, 20:60–21:5, 23:20–32). We find that, throughout the Reply, in contending that the determining limitation requires how to present the alert, Petitioner argues that the plain language of the claim recites “determining a notification method . . . based on the current state of the at least one external device” where the scope of the claimed “current state” encompasses online as well as offline.

As discussed in our claim construction of the determining limitation, we agree with the Petitioner that the plain language of the determining limitation, read in view of the specification, encompasses determining a notification method based on the current state of the device as either online or offline. Dr. Clark analyzed the prior art for the specific case of the external device having a current state of online. This is not a different construction. The fact that Dr. Clark did not also include an analysis of the prior art for the case of the external device having a current state of offline relates to whether the invalidity report persuasively shows invalidity, rather than whether the invalidity report construed the claim properly, if at all. We

find that Dr. Clark, in showing that the prior art teaches the claimed “determining a notification method . . . based on the current state of the . . . device” as online (or what Petitioner calls how to present the alert based on the current state of the user’s device as online), applies the “ordinary and customary meaning” of the determining limitation in his prior art analysis. We agree with Petitioner that Petitioner’s Reply applies the same “ordinary and customary meaning” to the determining limitation. Therefore, contrary to Patent Owner’s contention, Petitioner did not take different position on claim construction in the district court and in its Reply, and the discretionary issue from *Revvo* does not apply here.

X. WRITTEN DESCRIPTION REQUIREMENT

Application of the written description requirement to the determining limitation is central to the resolution of this dispute. If the 2009 Parent provides written description support for the determining limitation, then the challenged claims are entitled to the benefit of the filing date of the 2009 Parent, which is May 13, 2009. If so, then the PCT publication, which was published November 19, 2009, would not qualify as prior art. On the other hand, if the 2009 Parent does not provide written description support for the determining limitation, then the challenged claims would not be entitled to the filing date of the 2009 Parent, and the PCT publication would qualify as prior art to the challenged claims under 35 U.S.C. § 102(b).

A. Legal Standards

Compliance with the written description requirement is a question of fact. *Invitrogen Corp. v. Clontech Labs., Inc.*, 429 F.3d 1052, 1072–73 (Fed. Cir. 2005). “It is elementary patent law that a patent application is entitled to the benefit of the filing date of an earlier filed application only if

the disclosure of the earlier application provides support for the claims of the later application, as required by 35 U.S.C. § 112.” *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1306 (Fed. Cir. 2008) (quoting *In re Chu*, 66 F.3d 292, 297 (Fed. Cir. 1995)). “Different claims of [a CIP] application may therefore receive different effective filing dates. . . . Subject matter that arises for the first time in a CIP application does not receive the benefit of the filing date of the parent application.” *Id.* (quoting *Augustine Med., Inc. v. Gaymar Indus., Inc.*, 181 F.3d 1291, 1302–03 (Fed. Cir. 1999)).

To satisfy the written description requirement, the disclosure of the earlier filed application “must describe the invention sufficiently to convey to a person of skill in the art that the patentee had possession of the claimed invention at the time of the [earlier filed] application, i.e., that the patentee invented what is claimed.” *LizardTech, Inc. v. Earth Resource Mapping, Inc.*, 424 F.3d 1336, 1345 (Fed. Cir. 2005) (citing *O’Reilly v. Morse*, 56 U.S. (15 How.) 62, 112–13, 14 L.Ed. 601 (1853) (denying a claim for use of “electro-magnetism, however developed for marking or printing intelligible characters . . . at any distances” because others “may discover a mode of writing or printing at a distance . . . without using any part of the process or combination set forth in the plaintiff’s specification”)). The “scope of the right to exclude may be limited by a narrow disclosure.” *Gentry Gallery, Inc. v. Berkline Corp.*, 134 F.3d 1473, 1479 (Fed. Cir. 1998). “[C]laims may be no broader than the supporting disclosure, and therefore . . . a narrow disclosure will limit claim breadth.” *Id.* at 1480; *see PowerOasis*, 522 F.3d at 1311.

B. The Contentions of the Parties

Patent Owner contends that the 2009 Parent (Ex. 1106) provides written description support for the determining limitation recited in claim 1 of the '948 patent because, according to Patent Owner, 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)." PO Resp. 24 (citing Ex. 1106 ¶¶ 20, 21, 23, 26, 27, 21, 33, 39). Patent Owner also contends, however, that the 2009 Parent does not disclose providing an alert to a device that is not active. *Id.* at 31–37. In particular, Patent Owner contends that "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. That is precisely what is disclosed in the 2009 Parent." *Id.* at 36–37 (internal citations omitted).

Petitioner contends that, during prosecution, when applicant amended the claims of the April 2011 CIP application (Ex. 1110, which became the '948 patent) to add the determining limitation, "Applicant cited as support ten paragraphs in the April 2011 CIP application . . . [n]one of [which] is the in the May 2009 [] application." Reply 3–4. Petitioner contends that "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." *Id.* at 4 (quoting Ex. 1110 ¶¶ 130, 145 (corresponding to the '948 patent at 20:60–21:5, 23:20–33)).

Petitioner contends that the '948 patent "expressly identifies specific 'notification preferences' and explains how the notification manager 'correlates these notification preferences with session manager [] to

determine the . . . notification method.” Reply 14–15 (citing Ex. 1101, 20:60–21:15). Petitioner contends that in the ’948 patent, “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.’” *Id.* at 15 (quoting Ex. 1101, 21:1–4). Petitioner contends that the ’948 patent’s new matter explains that determining where to send the alert requires more than determining which devices are active. *Id.* at 17. Petitioner contends that, “[f]or 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.” *Id.* (citing Ex. 1101, 21:1–4, 23:28–31). Petitioner contends that “[s]ending 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.” *Id.*

Petitioner contends that the “2009 application does not convey possession of determining how to present an alert in part because . . . [i]t does not consider whether the user is online or offline.” Reply 13. Petitioner contends that the “2009 [Parent] mentions user preferences and alerts in different parts of the specification and does not tie the preferences to the alerts.” *Id.* at 14–15. Petitioner contends that the “2009 [Parent’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.’” *Id.*

Although the parties present additional written description contentions for other claim limitations, we find that addressing the determining limitation is sufficient to resolve the dispute between the parties.

C. Our Analysis

Although the 2009 Parent and the corresponding testimony from Patent Owner’s expert witness, Dr. Goodrich, show written description support for providing a notification to an active external device, Patent Owner has not cited any portion of the 2009 Parent, nor any portion of the testimony of Dr. Goodrich, to show that the 2009 Parent provides written description support for determining a notification method by which to provide an alert to an external device based on the current state of the external device as offline. We highlight that Paragraphs 130 and 131 of the 2011 CIP Application disclose offline notification preferences for determining a notification method by which to provide an alert to an external device based on the current state of the external device as offline. Ex. 1110

¶¶ 130–131. Specifically, paragraphs 130 and 131 describe that:

the notification manager of the eventing and alerting subsystem 452 queries the configuration server 454 for the user's notification preferences and correlates these notification preferences with session manager 456 to determine the best notification method. That is, the notification manager queries the configuration server 454 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. . . .

The notification manager of the eventing and alerting subsystem 452 then queries session manager 456 to determine the user's connectedness.

Id. That is, if the user’s connectedness, or “current state” of the claimed external device, is offline, and the user’s offline notification preferences are “notify by txt message,” the notification manager will determine that the notification method for the external device having a current state of offline is

by txt message. *See id.* Thus, the 2011 CIP Application describes a notification manager that queries a session manager to determine whether an external device is offline, and if the external device is offline, determines a notification method for providing an alert on the external device based on the current status of the external device as offline and the user's offline notification preferences. Although we find this written description support for the determining limitation in the 2011 CIP Application, we do not find this written description support in the 2009 Parent.

We highlight that, during prosecution, applicant cited only to language first introduced in the 2011 CIP Application to show support for the determining limitation. Ex. 1102, 316. In addition, Patent Owner's contentions here do not allege that the 2009 Parent describes "determining a notification method by which to provide at least one alert" on an offline external device, but rather, that the determined notification method provides the alert only to online devices. *See* PO Resp. 31 ("[P]roviding an alert on 'at least one external device' refers to the user's external device(s) that are **active**, which is disclosed in the 2009 Parent.") (emphasis in original); *see id.* at 31–37 (Patent Owner contending that the 2009 Parent describes that only active devices receive notifications).

Even though the 2009 Parent may support a narrower scope of "determining a notification method" for an active, or online, external device, the 2009 Parent does not provide written description support for the broader limitation of "determining a notification method . . . based on the current state of the at least one external device," where the current state of the external device encompasses an offline state as well as an online state. Therefore, we find that the 2009 Parent does not provide written description

support for the claim 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” as offline within the scope of challenged claims 1, 35, and 36, which are the only independent claims of the ’948 patent. Because the 2009 Parent does not provide written description support for the determining limitation of the challenged independent claims, the challenged claims are not entitled to the filing date of the 2009 Parent⁶. *Gentry Gallery*, 134 F.3d at 1480; *PowerOasis*, 522 F.3d at 1311.

XI. THE OBVIOUSNESS GROUND

Petitioner submits that the challenged claims are obvious over the PCT Publication and Austin-Lane. Pet. 30–65.

The PCT Publication is titled “Apparatus and Methods for Interacting with Multiple Information Forms Across Multiple Types of Computing Devices.” Ex. 1104, code (54). The PCT publication relates “generally to user-centric information convergence and, more particularly, to apparatus and methods for interacting with multiple information forms across multiple types of computing devices and platforms.” Ex. 1104 ¶ 2. Petitioner relies on the PCT Publication for most limitations and asserts that skilled artisans

⁶ The effective filing date of the challenged claims of the ’948 patent is April 12, 2011, which is the filing date of the ’948 patent. We recognize that the ’948 patent claims the benefit of the filing date of several provisional applications. However, “the Board has no basis to presume that [the ’948] patent is necessarily entitled to the filing date of its provisional application[s].” *Dynamic Drinkware, LLC v. National Graphics, Inc.*, 800 F.3d 1375, 1380 (Fed. Cir. 2015). Nor does Patent Owner contend that the ’948 patent is entitled to the filing date of any of its provisional applications. *See generally* PO Resp.

would have had reason to apply Austin-Lane’s teachings to “(1) determine a notification method for the alert based on the user’s presence information and (2) generate the notification based on the determined notification method.” Pet. 41.

Austin-Lane is titled “Cascaded Delivery of an Electronic Communication” and “relates to systems and methods of delivering information to a delivery mechanism.” Ex. 1105, code (54), ¶ 2. Austin-Lane describes that “selecting a delivery mechanism to be used for delivering an electronic communication (e.g., a notification) includes determining actual availability of an intended recipient presently to receive the electronic communication using at least one candidate delivery mechanism before attempting to deliver the electronic communication using the candidate delivery mechanism.” *Id.* ¶ 6. “Selecting the delivery mechanism also includes deciding whether to send the electronic communication using the candidate delivery mechanism based on the determined actual availability.” *Id.*

Petitioner asserts that skilled artisans would understand from Austin-Lane that “selecting a notification method that sends the alert to a device (such as a notebook computer) and, optionally, an application (such as instant messaging) on that device that the user is currently using ensures the user receives the alert ‘without significant delay.’” Pet. 41 (citing Ex. 1105 ¶¶ 6–9, 19, 21, 23, 24, 27, 29, 35, 39, 46, 55). Thus, Petitioner reasons, skilled artisans would have had reason to modify the PCT application’s approach with Austin-Lane’s teachings “to ensure the user receives the alert promptly.” *Id.* (citing Ex. 1103 ¶ 73).

As to the “determining a notification method” limitation (1.10),
Petitioner asserts that Austin-Lane teaches determining:

(1) the user device(s) to send the notification to (e.g., phone, PDA, notebook computer, desktop computer); (2) the communication protocol to use to send the notification, i.e., how to send the notification (e.g., SMTP (for email), SMS (for texts), HTTP (for web browsers)); and (3) the type of alert to provide, i.e., how to present the notification, (e.g., text, an icon, a pop-up window, a video, an email, an audible or tactile alarm), based on the current state of the at least one external device indicated by the session data (“presence information”), which may include whether and on which device(s) the user is online and/or whether and on which applications the user has an active session.

Id. at 53 (internal citations omitted) (citing Ex. 1105 ¶¶ 4, 5, 29, 32, 33, 39, 46, 48, 61, 79, Fig. 1). We highlight that paragraph 61 of Austin-Lane discloses that:

The type preferences 650 may include preferences for various notification types. . . . [A]uction alert #1 660 defines the following delivery precedence 663: (1) a web browser (if the user is online), (2) an IM client (if the user is online), (3) a mobile phone #1, (4) a PDA, (5) a mobile phone #2, (6) a pager, and (7) an email inbox.

Ex. 1105 ¶ 61; *see id.* ¶¶ 74–77 (Describing that one of several notification methods for delivering an alert to a user’s device is determined based on the current state of the user’s device as online or offline). Thus, Austin-Lane describes determining a notification method by which to provide an alert on an external device based on the current state of the external device as online as well as offline.

Petitioner asserts that skilled artisans would have further understood that, once the system determines a notification method, “the content and/or format of the notification data for a visual alert is different than for an audible alert, and that even for visual alerts, the notification data is different

for text (e.g., instant message) than graphics (e.g., flashing icon).” *Id.* at 42; *accord id.* at 56–57. Thus, reasons Petitioner, skilled artisans would have had reason to incorporate Austin-Lane’s teachings to “generate notification data according to the determined notification method to ensure the alert is successfully and properly provided on the user’s device(s).” *Id.* at 42 (citing Ex. 1103 ¶ 74); *accord id.* at 57 (“to conform to the requirements/specifications of the determined notification method”).

Patent Owner does not dispute that the asserted combination renders the claims unpatentable if the asserted combination is prior art. *See generally*, PO Resp. We agree with Petitioner and find that challenged claims 1–7, 10, 11, 13, 18, 19, 23, 29, 35, and 36 are unpatentable over the combination of the PCT Publication and Austin-Lane for the reasons given in the Petition as supported by the evidence cited by Petitioner including the testimony of Dr. Schmandt. Pet. 30–65; Ex. 1103 ¶¶ 71–104.

XII. CONCLUSION

In summary, we determine that a preponderance of the evidence establishes that challenged claims 1–7, 10, 11, 13, 18, 19, 23, 29, 35, and 36 are unpatentable, as shown in the following table:

Claim(s)	35 U.S.C. §	Reference(s)/ Basis	Claims Shown Unpatentable	Claims Not Shown Unpatentable
1–7, 10, 11, 13, 18, 19, 23, 29, 35, 36	103	PCT publication, Austin-Lane	1–7, 10, 11, 13, 18, 19, 23, 29, 35, 36	

XIII. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claims 1–7, 10, 11, 13, 18, 19, 23, 29, 35, and 36 of the '948 patent have been proven by a preponderance of evidence to be unpatentable; and

FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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