

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner.

IPR2024-01433
Patent 8,751,948

AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST

TABLE OF CONTENTS

	Page
I. CHRONOLOGY OF EVENTS.....	1
II. ARGUMENT.....	4
A. The Board Properly Analyzed Patent Owner’s <i>Revvo</i> Arguments And Found That SAP Took Consistent Positions on Claim Scope	4
1. Patent Owner Never Argued A <i>Tesla</i> -Like Inconsistency And Only Raised a <i>Revvo</i> Argument In Its Sur-Reply	5
2. The Board Properly Analyzed, And Correctly Rejected, The <i>Revvo</i> Issues Presented By Patent Owner	6
3. Neither <i>Revvo</i> Nor <i>Tesla</i> Provides A Basis To Vacate The Final Written Decision Or Institution Decision.....	9
B. The Board Decided The IPR’s Sole Ground, Based On The Claim’s Plain Meaning In View Of The Intrinsic Evidence, Consistent With The District Court’s Claim Construction Order.....	10
1. The Board’s Well-Supported Plain Meaning Construction Is Consistent With The Court’s Plain Meaning Construction ..	11
2. The Board Decided The Sole Ground Presented In The IPR ...	12
3. There Is No APA Violation Because The Board Addressed The Parties’ Arguments About What The Term Encompasses	13
4. The Board Did Not Decide Whether The Challenged Claims Would Be Entitled To An Earlier Priority Date Under Some Alternate Construction	15
CERTIFICATE OF SERVICE	16

TABLE OF AUTHORITIES

Page(s)

Cases

<i>Ingenico Inc. v. IOENGINE, LLC</i> , 136 F.4th 1354 (Fed. Cir. 2025)	12
<i>Kaneka Corp. v. Xiamen Kingdomway Grp. Co.</i> , 790 F.3d 1298 (Fed. Cir. 2015)	14
<i>Phillips v. AWH Corp.</i> , 415 F.3d 1303 (Fed. Cir. 2005)	11
<i>PowerOasis, Inc. v. T-Mobile USA, Inc.</i> , 522 F.3d 1299 (Fed. Cir. 2008)	14

Board Decisions

<i>Cambridge Mobile Telematics, Inc. v. Sfara, Inc.</i> , IPR2024-00952, Paper 12 (PTAB Dec. 13, 2024)	5
---	---

Other Authorities

USPTO, Director Review process, https://www.uspto.gov/patents/ptab/decisions/director-review-process..	9
--	---

Rules

37 C.F.R. § 42.6	16
------------------------	----

Patent Owner’s Request for Director Review (Paper 44, “Req.”) should be denied. Patent Owner’s belated *Revvo* arguments were thoroughly analyzed by the Board and properly rejected. The Board also addressed the sole unpatentability ground presented by the Petition, correctly finding that it rendered all challenged claims unpatentable. In doing so, the Board applied a plain and ordinary meaning interpretation of the disputed “determining” claim term that is consistent with the intrinsic evidence, party statements at oral argument, and the district court’s “plain and ordinary meaning” construction. The Board complied with the APA by squarely addressing Patent Owner’s contrary claim scope arguments in its final decision, after both parties had briefed the issue.

I. CHRONOLOGY OF EVENTS

On September 20, 2024, SAP filed its petition for IPR, challenging claims 1-7, 10-11, 13, 18-19, 23, 29, and 35-36 based on a single ground, as shown in this excerpt:

Petitioner requests *inter partes* review of claims 1-7, 10-11, 13, 18-19, 23, 29, and 35-36 (the “challenged claims”) of the ’948 patent, on the following statutory ground:

Ground	Reference(s)	Basis	Claims
1	The PCT publication (EX1104) and Austin-Lane (EX1105)	35 U.S.C. § 103	1-7, 10-11, 13, 18-19, 23, 29, and 35-36

Paper 1 at 2.

On March 5, 2025, SAP filed a responsive claim construction brief in district court, among other things arguing that certain terms of the '948 patent were indefinite. EX2025, 2-3.

On April 7, 2025, the Board instituted IPR. Paper 13.

On April 21, 2025, Patent Owner filed a Request for Director Review of the Institution Decision, which did not allege that SAP had raised any inconsistent claim construction positions. Paper 16.

On May 29, 2025, Acting Director Stewart denied Patent Owner's Request for Director Review. Paper 19.

On June 30, 2025, Patent Owner filed its Patent Owner Response (POR). Paper 21. With the POR, Patent Owner submitted SAP's district court claim construction briefing and noted SAP's indefiniteness argument in a footnote. *Id.* at 32 n.5 (citing Ex. 2025 at 23-24). The POR did not allege SAP's indefiniteness argument, or any other positions, were inconsistent with SAP's IPR positions.

On August 7, 2025, the district court issued a *Markman* Order that among other things rejected SAP's indefiniteness argument and gave the disputed term a "plain and ordinary meaning." EX3002, 33-34.

On September 22, 2025, SAP filed its Reply to the POR. Paper 25.

On November 13, 2025, Patent Owner filed its Sur-Reply, which, for the first time, alleged that SAP had taken inconsistent claim construction positions in district court and in the IPR. Paper 30 at 7. Those allegations were not based on any contention that SAP's indefiniteness argument triggered *Revvo* or *Tesla. Id.*

On January 15, 2026, the Board held an oral hearing. Paper 33 at 2.

On January 29, 2026, the Board authorized the parties to file two-page briefs addressing the *Revvo* issue raised in Patent Owner's Sur-Reply.

On February 5, 2026, Petitioner filed its *Revvo* brief (Paper 39) and on February 12, 2026, Patent Owner filed its response brief (Paper 40).

On February 23, 2026, prior to trial in district court, Patent Owner dropped from the district court case its assertion of the patent at issue in this IPR proceeding (U.S. Patent No. 8,751,948). Paper 41.

On March 13, 2026, the Board issued its Final Written Decision (FWD), finding all challenged claims unpatentable based on the sole ground presented by the Petition, as reflected in this excerpt:

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	

Paper 42 at 30.

II. ARGUMENT

A. The Board Properly Analyzed Patent Owner's *Revvo* Arguments And Found That SAP Took Consistent Positions on Claim Scope

In this IPR, SAP applied the plain and ordinary meaning of the disputed claim term “determining a notification method,” consistent with the district court’s construction of that term. *E.g.*, Paper 1 at 16-19; Paper 39; Ex. 3002 at 33-34. Indeed, from before institution through most of this IPR proceeding, Patent Owner never raised an argument suggesting otherwise, under *Revvo* or *Tesla* or any other rule or precedent. Patent Owner first raised its *Revvo* argument in the Sur-Reply, based on an alleged claim interpretation supposedly reflected in two isolated paragraphs of a district court invalidity report submitted by SAP expert Dr. Clark. Paper 30 at 7.

The Board thoroughly considered Patent Owner’s 11th-hour *Revvo* argument and even granted Patent Owner’s request for post-hearing briefing on the issue. Paper 42 (FWD) at 17-21; *see also* Papers 41-42. The Board properly rejected that argument, finding that “Dr. Clark’s invalidity report provides an analysis of whether the determining limitation is taught by the prior art [system], not a proposed construction” and that “Dr. Clark’s analysis is consistent with the plain and ordinary meaning advanced by Petitioner in this proceeding.” Paper 42 at 18-19.

Though not mentioned in the FWD, prior to the oral hearing Patent Owner dropped all asserted claims of the ’948 patent in district court. Paper 41. Thus, neither party currently maintains any position on that patent in district court.

**1. Patent Owner Never Argued A *Tesla*-Like Inconsistency
And Only Raised a *Revvo* Argument In Its Sur-Reply**

Prior to institution on April 7, 2025, Patent Owner did not allege that Petitioner took any inconsistent claim construction position. On April 21, 2025, Patent Owner filed a request for Director Review of the Institution Decision but did not allege any inconsistent claim construction positions. Paper 16.¹

With its Patent Owner Response of June 30, 2025, Patent Owner submitted SAP's district court responsive claim construction brief as an exhibit and included a footnote noting SAP's argument "that the Challenged Claims were indefinite." Paper 21 at 32 n.5 (citing Ex. 2025 at 23-24). But Patent Owner still did not suggest, much less argue, that this or any other district court position was inconsistent with SAP's IPR positions. Patent Owner's Exhibit 2025 shows that it was on notice of these indefiniteness arguments since well before institution, at least as early as March 5, 2025. EX2025 at 26. Its failure to allege any inconsistency—either in its POR or Request for Director Review of the Institution Decision or its POPR—shows that SAP's indefiniteness arguments were consistent with its IPR positions.²

¹ The Acting Director denied that request on May 29, 2025. Paper 19.

² Before this IPR, decisions made clear that inconsistent indefiniteness arguments could be a basis for denial of institution. *E.g., Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12 at 7 (PTAB Dec. 13, 2024) (informative).

In its Sur-Reply of November 13, 2025, Patent Owner for the first time alleged that SAP's district court expert system prior art mapping reflected an interpretation of the claimed "determining a notification method." Paper 30 at 7. On this alone, Patent Owner argued that "Petitioner should not be permitted to advance an extremely narrow construction before the PTAB while maintaining a broader construction before the district court." *Id.* The Board granted post-hearing briefing and each party filed an additional brief on this *Revvo* issue. Papers 39-40.

Patent Owner's *Revvo* theory thus depended on treating a system prior-art mapping in Dr. Clark's district court report as though it were a formal claim construction. The Board correctly rejected that premise and found no inconsistency.

**2. The Board Properly Analyzed, And Correctly
 Rejected, The *Revvo* Issues Presented By Patent Owner**

The Final Written Decision spent nearly four pages carefully analyzing and addressing Patent Owner's *Revvo* argument, finding that "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." Paper 42 at 18-19. The Board further explained why Dr. Clark's "analysis is consistent with the plain and ordinary meaning advanced by Petitioner in this [IPR]" because it maps the claims to system prior art that is encompassed by the disputed claim term as argued by SAP and interpreted by the Board in this IPR. *Id.* at 19. Acknowledging

the difference between mapping the prior art and providing a claim construction, the Board explained that Dr. Clark’s failure to “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.” *Id.* The Board reviewed the positions taken by SAP in its Reply brief and found them consistent with the “plain language of the determining limitation, read in view of the specification.” *Id.* at 20; *see also* Paper 39. It concluded that Dr. Clark’s invalidity report “applies the ‘ordinary and customary meaning’ of the determining limitation” just as Petitioner’s Reply did in the IPR. Paper 42 at 21.

Thus, contrary to Patent Owner’s arguments (Req. at 7), the Board conducted the appropriate inquiry and compared SAP’s IPR Reply claim scope arguments with the opinions of SAP’s district court expert. The Board did not “overlook” any constructions but instead carefully considered them. Req. at 7. That Patent Owner disagrees with the Board’s findings and conclusion is no basis for Director Review.

Patent Owner also characterizes an isolated exchange at the oral hearing as “prophetic,” implying that it somehow shows the Board’s failure to engage this issue. Req. at 7. Contrary to PO’s implications, however, at the hearing the panel invited the parties to consider the issue further: “Our guidance for dealing with the issue is likely to evolve. It would be helpful if the parties would think about whether something more should be submitted to the panel to assist us in unraveling that

issue.” Paper 43 at 61:18-20. And then, the Board granted Patent Owner’s request for additional briefing. *See* Papers 39-40. Thus, the Board engaged the parties and gave them ample opportunity to be heard on this issue, despite Patent Owner belatedly raising it in its Sur-Reply.

Patent Owner’s attacks on the Board for not considering SAP’s indefiniteness arguments (*e.g.*, Req. at 7) are particularly misplaced given that Patent Owner did not allege any inconsistency or issue with those indefiniteness arguments, either in its first Request for Director Review (Paper 16) or thereafter. The sur-reply never mentioned indefiniteness and Patent Owner’s *Revvo* Reply did not argue that the indefiniteness position itself triggered *Revvo* or *Tesla*. Paper 40 at 1-2. To be sure, the *Revvo* Reply referenced SAP’s indefiniteness positions, but only as background to Patent Owner’s actual *Revvo* argument. *Id.* at 1. The Board did not fail to address a preserved *Tesla*-like issue, because Patent Owner never actually presented one.

Moreover, the district court rejected SAP’s indefiniteness argument before SAP filed its IPR Reply, construing the term to have its plain and ordinary meaning. EX3002 at 33-34. Patent Owner never presented the Board with a developed argument that the rejected indefiniteness position created a *Tesla*-like inconsistency.

The Board ultimately decided the IPR based on a plain-meaning reading of the disputed term. After considering arguments from both sides on the claimed “external device state,” the Board explained why the term encompasses both online

and offline devices (not restricting it to *require* just online/active devices, as Patent Owner had argued). *Infra* Section II.B.1.

3. Neither *Revvo* Nor *Tesla* Provides A Basis To Vacate The Final Written Decision Or Institution Decision

Patent Owner’s reliance on *Revvo* and *Tesla* is also procedurally misplaced. The Request expressly asks the Director to “vacate the FWD and Institution Decision under *Revvo*,” arguing that SAP allegedly took inconsistent positions between the district court and the PTAB. Paper 44 at 1, 3-8. But *Revvo* and *Tesla* address whether an IPR should be instituted where a petitioner failed to adequately explain inconsistent positions across forums; in both cases, the remedy was to vacate the institution decision and deny institution, not to revisit a final written decision. And the USPTO’s Director Review guidance expressly provides that, “[a]s a general matter, a request for Director Review of a final decision is not an opportunity to raise issues related to the Board’s decision on institution.” USPTO, Director Review process, <https://www.uspto.gov/patents/ptab/decisions/director-review-process>.

Revvo and *Tesla* therefore do not furnish a proper basis to disturb the Board’s FWD in this proceeding. Patent Owner’s request is therefore procedurally improper insofar as it asks the Director to rely on those decisions to vacate both the FWD and the underlying institution decision.

B. The Board Decided The IPR's Sole Ground, Based On The Claim's Plain Meaning In View Of The Intrinsic Evidence, Consistent With The District Court's Claim Construction Order

The Request does not meaningfully challenge the Board's plain meaning construction but instead lodges collateral allegations that the "Board did not decide all grounds" (Req. at 8-9) and that the district court somehow gave a narrowing construction to this term (Req. at 10-11). These attacks fail because the Board decided the sole ground presented by the Petition (*e.g.*, Paper 1 at 2; Paper 42 at 30) and because the district court gave the disputed term its plain and ordinary meaning and expressly deferred as a non-infringement matter the question of "whether a device in an 'off' or 'inactive' state provides an alert" (Ex. 3002 at 34).

Patent Owner's APA argument (Req. at 12-15) fails because both parties briefed the meaning of the claimed external device and whether it included offline/inactive devices or just online/active devices. The Board carefully considered these arguments, the intrinsic evidence, and statements made at the oral hearing (Paper 42 at 12-17) in providing a non-limiting explanation of what is *encompassed* by the plain language of the claims. It properly found the disputed term "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." *Id.* at 17.

1. The Board's Well-Supported Plain Meaning Construction Is Consistent With The Court's Plain Meaning Construction

The court gave the term its plain and ordinary meaning (EX3002 at 34, 41) and the Board stayed true to that meaning. *E.g.*, Paper 42 at 12 (“[W]e construe the determining limitation according to the plain and ordinary meaning construction used by the district court.”) (citing *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc)). Patent Owner incorrectly suggests that the district court narrowly construed the “determining” term to require alerts only to “active devices.” Req. at 10-11. The district court made no such construction but rather declined to find the term fatally ambiguous, expressly deferred as a non-infringement matter “whether a device in an ‘off’ or ‘inactive’ state provides an alert,” and gave the term its plain and ordinary meaning. Ex. 3002 at 33-34, 41.

By its own language, the disputed term requires that the determining be made “based on the current state of the external device.” At the IPR hearing, counsel for Patent Owner agreed that the “states of an external device” included “online or offline.” Paper 43 at 47:22-48:2. The ’948 patent (but not the ancestor application to which it alleges CIP priority) includes a passage mirroring this claim language, explaining that the system uses different notification methods depending on whether the user is online or offline; if “online” it provides notifications through an “active session” and, if “offline” it provides notifications through “txt message” or other

alternative methods. EX1101, 20:65-21:4. The patent then explains that the “notification manager” determines “the user’s connectedness” in deciding “the best alert notification method.” *Id.*, 21:6-15; *see also id.*, 23:20-43, 15:14-19.

The Board properly relied on this intrinsic evidence—and noted Patent Owner’s agreement that device state included online and offline—in deciding what the claims encompass. As the Board determined in rejecting Patent Owner’s arguments, to “interpret the claim to exclude determining a notification method based on the current state of the device as offline [] would be adding restrictions to the claim not found in the claim language itself.” Paper 42 at 14.

2. The Board Decided The Sole Ground Presented In The IPR

As noted, the Petitioner raised only one unpatentability ground and the Board decided that ground. Patent Owner takes issue with this outcome, apparently because the Board did not evaluate *all* reasons why the challenged claims are not entitled to a priority date of May 13, 2009. But a lack-of-priority argument is not a ground. *E.g., Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1365 (Fed. Cir. 2025) (“[G]rounds are the theories of invalidity available to challenge a claim under §§ 102 and 103.”) And no rule or precedent required the Board to evaluate all aspects of the claims that the petition shows are unsupported by the earlier application to which the ’948 patent alleges CIP priority. Thus, the Board complied with the July 29, 2025, memorandum (Req. at 8-10), which forms no basis for Director Review.

3. There Is No APA Violation Because The Board Addressed The Parties' Arguments About What The Term Encompasses

Patent Owner's argument that it was blindsided by the Board's construction (Req. at 12-15) ignores that Patent Owner itself spent pages arguing the meaning of this term and whether it was supported by the 2009 application. After institution, the Patent Owner Response alleged that the Petition "misinterprets the Challenged Claims by assuming that 'session data' can be received for a user's *inactive* device(s)." Paper 21 at 31 (emphasis original). Patent Owner spent several pages arguing that the claimed external device was "the User's Active Device(s)." *Id.* at 31-34. This included arguments that the plain and ordinary meaning excluded a "device that is off" and assertions that this meaning was supported by "intrinsic and extrinsic records support." *Id.* at 31-32. It spent several more pages arguing what the "plain language of the claims contemplates" for the term "at least one external device." *Id.* at 34-37; *see also id.* at 36 ("As claimed, and as explained in the 2009 Parent, the system collects session data that indicates whether one or more of a user's devices are active and causes alerts to be presented on the active devices.").

The Final Written Decision addressed these arguments, including Patent Owner's cited extrinsic evidence (Paper 42 at 15-16) and explained how its ultimate findings were supported by Patent Owner's own hypothetical about what the plain language encompasses (*id.* at 13).

And contrary to the Request's assertions (Req. at 12), the district court gave the term its plain and ordinary meaning, and did not narrowly construe it to require that "session data is only received for active devices." *Supra* Section II.B.1.

Moreover, SAP's IPR Reply disputed the claim scope arguments raised in the Patent Owner Response and explained why the term should not be narrowly limited to exclude offline devices. *E.g.*, Paper 25 at 3-4 & 17-18. For example, the Reply referenced an embodiment of the '948 patent and explained a scenario that would require the claimed apparatus to determine "which offline device to send the alert to." Paper 25 at 17 (citing *PowerOasis, Inc. v. T-Mobile USA, Inc.*, 522 F.3d 1299, 1309 (Fed. Cir. 2008) (construing claim term based on new matter added in CIP application)). The Reply further rebutted Patent Owner's arguments by explaining how "[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.* (citing *Kaneka Corp.*, 790 F.3d 1298, 1304 (Fed. Cir. 2015) (rejecting construction of claim term because it was inconsistent with specification)); *see also id.* at 4 (explaining how the CIP application added new matter describing "a notification method based on the user's alert preferences *and the current statuses of their devices*") (emphasis added). Thus, the course of briefing flatly refutes the argument that the Board committed an APA violation.

**4. The Board Did Not Decide Whether
The Challenged Claims Would Be Entitled To An
Earlier Priority Date Under Some Alternate Construction**

Patent Owner suggests that the Board “acknowledged written description support” for the claims under Patent Owner’s narrowing construction that would limit the claims to “active (online) devices.” Req. at 15. This is incorrect and the Request falls far short of proving its point. Indeed, this argument is disproved by the Request’s other arguments, which maintain that the Board did not evaluate all possible ways in which the claims were unsupported by the earlier application (Req. at 8-12), any of which alone would be a basis for finding the challenged claims cannot claim priority to the earlier 2009 application, and were thus unpatentable under the unpatentability ground presented by the Petition.

Respectfully submitted,

Dated: April 21, 2026

By: /Andrew M. Mason/

Andrew M. Mason (Reg. No. 64,034)

andrew.mason@klarquist.com

KLARQUIST SPARKMAN, LLP

Tel: 503-595-5300

Fax: 503-595-5301

Counsel for Petitioner

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

The undersigned certifies that on April 21, 2026, Petitioner emailed copies of **AUTHORIZED RESPONSE TO DIRECTOR REVIEW REQUEST** to the following email addresses, which Patent Owner has agreed constitutes service. *See* Paper 20 (Patent Owner's Updated Mandatory Notices Under 37 C.F.R. § 42.8(a)(3)).

James.Hannah@hsfkramer.com

Jeffrey.Price@hsfkramer.com

Kris.Kastens@hsfkramer.com

Jenna.Fuller@hsfkramer.com

Charles.Keller@hsfkramer.com

svdocketingus@hsfkramer.com

By: /Andrew M. Mason/

Andrew M. Mason (Reg. No. 64,034)

andrew.mason@klarquist.com

KLARQUIST SPARKMAN, LLP

One World Trade Center, Suite 1600

121 S.W. Salmon Street

Portland, Oregon 97204

Tel: 503-595-5300

Fax: 503-595-5301

Counsel for Petitioner