UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner.

Case IPR2024-01496
U.S. Patent No. 8,595,641

PATENT OWNER'S SUPPLEMENTAL *FINTIV* BRIEFING

Under the "Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation," the PTAB was instructed not to deny a petition based on the *Fintiv* factors if the petitioner stipulated not to raise before the district court any grounds that it reasonably could have raised before the PTAB. Ex. 2005 at 7. Such stipulations are no longer dispositive, and portions of decisions relying on the Procedure are no longer informative or precedential. Despite Petitioner's *Sotera* stipulation, the *Fintiv* factors weigh in favor of denial.

Factor 1 weighs in favor of denying institution because there is little to no likelihood that the judge will stay this case. The judge overseeing the dispute between the parties recently denied a motion to stay under nearly identical circumstances. *Gen. Access Sols., Ltd., v. Cellco P'ship*, No. 2:22-cv-00394-JRG, Dkt. 225 at 3-4 (E.D. Tex. May 22, 2024) (denying a motion to stay where it would prejudice Patent Owner, "the PTAB decision is not due until over six months after jury trial is set to begin . . . . Jury selection was a mere five months away," and a *Markman* hearing had been held). Factor 1 is *at least* neutral. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 7-8, n.12 (P.T.A.B. Mar. 20 2020).

Factor 2 weighs moderately to strongly in favor of denying institution because trial is scheduled to begin in the co-pending district court litigation six months before a Final Written Decision is expected in this case. *Samsung v. Mojo*, IPR2023-01098 ("*Samsung*"), Paper 11 at 8, 31 (P.T.A.B. Feb. 9, 2024).

Factor 3 weighs in favor of denying institution (and is at least neutral) because the parties have expended significant fact discovery, and the *Markman* hearing will be held before institution. *Id.* at 8-9, 31. Petitioner also delayed filing this Petition for over four months after receiving Cyandia's infringement contentions. *AT&T Servs. v. ASUS Tech.*, IPR2024-00992, Paper 14 at 12 (P.T.A.B. Dec. 16, 2024) (five months between infringement contentions and the petition is a "substantial delay").

Factor 4 weighs in favor of denying institution under the unique circumstances of this case because Petitioner's stipulation does not "mitigate[] any concerns of duplicative efforts" or "potentially conflicting decisions." *Sotera* at 19. Despite Petitioner's *Sotera* stipulation, the issues raised in this IPR Petition will overlap with those raised in the district court because Petitioner intends to rely on the WebSphere system described in the Petition's cited art. Ex. 2007, ¶¶ 2-3. Nevertheless, the Board should deny institution because the balance of the *Fintiv* factors weigh in favor of denying institution. *Cisco v. Estech,* IPR2021-00332, Paper 11 at 12 (P.T.A.B. July 7, 2021) (denying a petition despite a *Sotera* stipulation).

Factor 5 weighs in favor of denial because the parties are identical.

Factor 6 weighs in favor of denial because there is a pending district court action that could resolve the entire four-patent dispute between the parties, and it would be inefficient to conduct up to four *inter partes* reviews to resolve only a subset of issues for a subset of patents in the dispute. *Samsung* at 31; Pet. at 3.

Respectfully submitted,

Dated: March 12, 2025

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

Date of service	March 12, 2025
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