Paper No. 10
Filed: April 18, 2025

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESSELL, INC.,
Petitioner,

v.

NUTANIX, INC.,
Patent Owner.

Case IPR2025-00298
Patent No. 11,860,818

PATENT OWNER'S PRELIMINARY SUR-REPLY

Petitioner erroneously argues that *Koninklijke Philips N.V. v. Google LLC*, 948 F.3d 1330, (Fed. Cir. 2020) "disagree[d]" with the application of *Arendi S.A.R.L. v. Apple, Inc.*, 832 F.3d 1355 (Fed. Cir. 2016) to a gap-filler argument founded on "a POSA's background knowledge" instead of "common sense." Reply at 2. But neither case draws a distinction between "background knowledge" and "common sense" in deciding what can be used to supply a limitation missing from the prior art.

To the contrary, *Philips* correctly recognizes from *Arendi* that "(a) invoking 'common sense ... to supply a limitation that was admittedly *missing* from the prior art' should generally only be done when 'the [missing] limitation in question [is] unusually simple and the technology particularly straightforward;' and (b) references to common sense 'cannot be used as a wholesale substitute for reasoned analysis and evidentiary support.'" *Philips*, 948 F.3d at 1338 (quoting *Arendi*, 832 F.3d at 1361-62). *Philips* disagrees that its facts are analogous to *Arendi*. Instead of relying on "nothing more than 'conclusory statements and unspecific expert testimony,'" as the Board did in *Arendi*, the Federal Circuit found in *Philips* that the Board "relied on expert evidence, which was corroborated by [a prior art reference]." *Id.* 1338.

Further undercutting Petitioner's attempt to distinguish "background knowledge" and "common sense," in *DSS Technology Management, Inc. v. Apple Inc.*, the Federal Circuit clarified that *Arendi*'s two-part test for gap filling is not limited to "common sense." 885 F.3d 1367, 1374 (Fed. Cir. 2018) (citing *Arendi*, 822 F.3d at

1361)). In *DSS*, the missing limitation was not "unusually simple" because the challenged patent devoted significant written description to it and because the missing limitation "play[ed] a major role in the subject matter claimed." *Id*. at 1375 (quoting *Arendi*, 832 F.3d at 1362). And the technology was not "particularly straightforward" because the claimed technical improvement provided a technical advancement. *Id.*

Likewise, here, the challenged patents reference SLA selection on half of the pages of the written description and tie SLA selection to the reduction in database provisioning time from days to minutes. -00298 EX1001, 3:41-43; -00322 EX1001, 3:34-55. SLA selection was the reason for allowance of the '818 patent, which claims priority to the application issuing as the '336 patent. -00298 POPR at 6-7.

The Petition's cited "background" references fail to disclose SLA selection as claimed. -00298 POPR at 12-14; -00322 POPR at 13-14. Petitioner never argues otherwise. Thus, Petitioner's alleged "extensive reasoned analysis and evidentiary support" (Reply at 2) is lacking, and the Petition fails to demonstrate obviousness.

Notably, Petitioner also fails to reconcile its positions with *Intel Corp. v. PACT XPP Schweiz AG*, No. 2023-1537, 2024 WL 5068112, at *2 (Fed. Cir. Dec. 11, 2024), in which the Federal Circuit upheld the Board's refusal to consider art not part of any ground. Petitioner never explains why the Board should consider its deficient gap-filler argument. In view of these errors and for the reasons set forth in the POPRs, institution should be denied.

Respectfully submitted,

Dated: April 18, 2025

By: /Joshua L. Goldberg/
Joshua L. Goldberg
Reg. No. 59,369

CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Patent Owner's Preliminary Sur-Reply** was served electronically via email on April 18, 2025, in its entirety on the following:

Anant K. Saraswat
Elisabeth H. Hunt
WOLF, GREENFIELD & SACKS, P.C.
600 Atlantic Avenue
Boston, MA 02210-2206
ASaraswat-PTAB@wolfgreenfield.com
EHunt-PTAB@wolfgreenfield.com

Petitioner has consented to service by electronic mail.

Dated: April 18, 2025

/William Esper/
William Esper
Legal Assistant and PTAB Coordinator
FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER LLP