

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TESSELL, INC.,
Petitioner,

v.

NUTANIX, INC.,
Patent Owner.

Case IPR2025-00322
Patent No. 11,010,336

PATENT OWNER'S PRELIMINARY RESPONSE

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I. Introduction

The story of this IPR begins in an unusual way. Petitioner's founders and employees recognized a problem in the art. They invented a solution. And they marketed the solution. They did all of this while employed by Patent Owner Nutanix.

After profiting a first time from their invention by assigning their rights in the '336 patent to their employer at the time, Nutanix, Balasubrahmanyam Kuchibhotla and Kamaldeep Khanuja left Nutanix and founded Petitioner Tessell, hiring away two other Nutanix employees, Sujit Menon and Maneesh Rawat. Then, these inventors sought to use their new company, Petitioner Tessell, to profit from their invention a second time by using it to compete with Nutanix. Having been sued for infringement of the '336 patent, they now challenge their own patent in this IPR.

Rather than allowing the inventors of the '336 patent to unjustly have their cake and eat it too, the Board should deny institution for both substantive and discretionary reasons.

Starting with the substance, before the '336 patent, provisioning a database was a labor-intensive manual process that “involve[d] creating and/or associating databases with the database system for management and use.” EX1001, 3:32-34. The complex steps required for this creating and associating often took a user days to complete because they involved working with separate entities for several database provisioning and usage steps. *Id.*, 3:34-55. In the words of inventor Kuchibhotla in

October 2019 while he was Vice President and General Manager for Nutanix Era and Business Critical Apps, “I still see provisioning is one of the biggest pain point[s] that it takes like three to five weeks to kind of even create a database for some of our big customers and it kind of spans across multiple teams.” EX2006, 1:54-2:05; EX2007, 1:54-2:05.

With the invention of the ’336 patent, Nutanix changed the game. By allowing users to input a series of parameters to provision and manage a database, the database could be provisioned in a matter of minutes instead of days. EX1001, 4:3-11. In claim 1, the input parameters include a database engine and a selection of a Service Level Agreement (“SLA”) and a protection schedule for protecting a database. *Id.*, 40:2-23. In May 2019, while VP/GM at Nutanix, inventor Kuchibhotla marketed how easily a user can input parameters to provision a database within minutes. EX2008, 2:20-4:46; EX2009, 2:20-4:46.

Now, Kuchibhotla has changed his tune. His new company, Petitioner Tessell, challenges claims 1-23 of the ’336 patent as being obvious over (i) the combination of Sivasubramanian (EX1005) and Zha (EX1006), and (ii) the combination of Sivasubramanian, Shekar (EX1007), and Zha.

Tessell’s Petition has fatal flaws and should be denied. No reference forming either ground discloses selecting an SLA and protection schedule for protecting a database, as required by all of the claims. Pet., 29-30, 32, 45-46. Instead, Petitioner

asserts that selecting an SLA to provision a database was well-known. *Id.*, 32-35. This assertion is defective for at least two reasons. First, Petitioner fails to cite any prior art reference demonstrating that the claimed selection of an SLA for protecting a database was known in the art. Petitioner must therefore resort to impermissible hindsight. Second, Petitioner fails to provide an adequate motivation to incorporate this missing limitation into the asserted combinations. Petitioner argues that including a UI element to receive selection of an SLA was within a POSA's skill. *Id.*, 34. But at best, Petitioner's argument suggests that a POSA *could* combine a limitation missing from Petitioner's prior art with the references in Petitioner's grounds, not that a POSA *would have been motivated* to do so. As such, Petitioner's argument that selection of an SLA would have been obvious is both factually and legally defective. The Board should deny institution for these substantive reasons.

Turning to the Board's discretion under 35 U.S.C. § 325(d), compounding Petitioner's error, the Examiner allowed the '336 patent and its continuation grandchild, the '818 patent, over the Sivasubramanian and Zha disclosures. In allowing the '818 patent, the Examiner specifically pointed to a missing SLA limitation. Both the Sivasubramanian and Zha disclosures were also cited in an Examiner's search report in an application to which the '336 patent is terminally disclaimed. Yet Petitioner presents no error in the Examiner's decision to allow the

'336 patent over these references. The Board should therefore deny institution using its discretion under 35 U.S.C. § 325(d).

Finally, 35 U.S.C. § 311(a) may not preclude the inventors from challenging their own patent, but the Board has discretion under 35 U.S.C. § 314(a) to stop them from doing so. The Board should act to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). Here, that means avoiding the injustice of the inventors making the invention while employed at Nutanix, assigning the '336 patent to their then-employer, and then using this proceeding to attack it through their new employer, Petitioner Tessell. For this additional reason, Nutanix asks the Board to deny institution using its discretion under 35 U.S.C. § 314(a).

II. Relevant Technical Background

A. The '336 Patent

The '336 patent is generally directed to systems and methods for provisioning a source database based upon a user request in a hyperconverged infrastructure system. For example, in claim 1, the user request is input via a dashboard (user interface), which allows a user to select a database engine type and a Service Level Agreement (“SLA”) and a protection schedule for protecting the database. EX1001, 40:2-23, 1:25-32. Based on the SLA and the protection schedule, a processor can automatically capture snapshots of the database. *Id.* The protection schedule comprises a first frequency at which the transactional logs are captured and a second

frequency at which the transactional logs are captured for protecting the source database. *Id.*

As admitted by Petitioner (Pet., 45), the '336 patent defines an SLA as “an **agreement** between a service provider (e.g., the owner of the database system 200) and the user (e.g., the owner of the database) that outlines, among other things, the protection scope of the database,” which “defines for how long data from the database being created or registered is retained” and “other or additional protection parameters.” EX1001, 19:12-23 (emphasis added). The protection schedule “allow[s] the user to define the frequency of snapshots and transactional logs to be captured each day, and the time-period for capturing daily, weekly, monthly, and/or quarterly snapshots based upon the SLA.” *Id.*, 5:64-67. The database system may either solicit a protection schedule and an SLA from the user or include “built-in defaults of the protection[] schedule and SLA levels that the user may select from.” *Id.*, 5:54-59.

Unlike prior art database provisioning systems and methods, the '336 patent's systems and methods greatly simplified database provisioning steps, “allow[ing] the user to quickly and conveniently create a new database and associate the database with the database system without the need for contacting and working with multiple entities.” *Id.*, 3:63-4:28. The '336 patent makes this improvement over the references cited in the Petition.

B. Prosecution History

During prosecution of the '336 patent, the applicant filed a terminal disclaimer over U.S. Patent No. 10,817,157 (“the '157 patent”). EX1002, 282, 294-95. The '336 patent has a continuation grandchild (U.S. Patent Application No. 18/113,528), which issued as U.S. Patent No. 11,860,818 (“the '818 patent”), which is the subject of a related IPR proceeding, IPR2025-00298. The prosecution histories of these patents demonstrate that the Patent Office already considered and dismissed the references forming Petitioner’s grounds.

1. The '336 Patent Prosecution History

During prosecution of the '336 patent, the Examiner issued a non-final rejection, finding the pending claims unpatentable as obvious over Weissman (EX1018) and Picard (EX1019). EX1002, 256-60. Additionally, the Examiner issued a double patenting rejection, finding that the pending claims are not patentably distinct over claims 1-19 of the '157 patent. *Id.*, 255.

In response, Nutanix disagreed with the Examiner that Weissman discloses “setting up, by the processor, automatic capturing of snapshots and transactional logs based upon the SLA and the protection schedule for protecting the source database.” *Id.*, 283. “To advance prosecution,” however, Nutanix amended pending claim 1 to incorporate the elements of pending claim 7, including “wherein the protection schedule comprises a first frequency at which the snapshots are captured and a

second frequency at which the transactional logs are captured for protecting the source database.” *Id.*, 284, 287. Nutanix explained that Weissman’s replication scheduler fails to meet this element because it takes a point-in-time snapshot of a source database at a specific point. *Id.*, 283. It fails to teach “**frequencies** for capturing snapshots and transaction[al] logs” as required by the amended claim 1. *Id.* (emphasis in original). To overcome the double patenting rejection, Nutanix also filed a terminal disclaimer over the ’157 patent. *Id.*, 282, 294-95.

The Examiner subsequently allowed the claims, stating that the “prior art does not teach or fairly suggest,” among other things, receiving “selection of a Service Level Agreement (‘SLA’) and a protection schedule,” and “setting up automatic capturing of snapshots and transactional logs based upon the SLA and the protection schedule for protecting the source database,” “wherein the protection schedule comprises a first frequency at which the snapshots are captured and a second frequency at which the transactional logs are captured for protecting the source database.” *Id.*, 325. In doing so, the Examiner considered the disclosures of Zha and Sivasubramanian. Petitioner concedes that “Zha and a descendant of Sivasubramanian [were] listed on an IDS signed by the examiner” during prosecution. Pet., 85 (citing EX1002, 239-40). The descendant of Sivasubramanian has the same disclosure as Sivasubramanian here.

2. The '818 Patent Prosecution History

The '818 patent received a first action allowance on September 19, 2023; was withdrawn from issuance to allow for consideration of a further IDS on October 19, 2023; and was allowed again without updated commentary on November 15, 2023. EX2002, 311-14, 327-38, 352, 359. As recognized by Petitioner, “Zha and a descendant of Sivasubramanian [were] listed on an IDS signed by the examiner” during prosecution. EX2001, 83 (citing EX1002, 281-84). The descendant of Sivasubramanian has the same disclosure as Sivasubramanian here. In the reasons for allowance, after considering Zha and the descendant of Sivasubramanian, the Examiner found that “[t]he prior art does not teach or fairly suggest receive/receiving a fourth input comprising a selection of a level of a Service Level Agreement (SLA) from a plurality of levels of the SLA to protect the database after provisioning” EX2002, 359.

3. The '157 Patent Prosecution History

During prosecution of the '157 patent, the Examiner conducted a search, which uncovered U.S. Patent Application Publication No. 2014/0229698 (EX2004), the publication of U.S. Application No. 14/257,927, a continuation of the application that issued as Sivasubramanian, which has the same disclosure. EX2003, 24-29. In the same search, the Examiner uncovered U.S. Patent Application Publication No. 2011/0093435 (EX2005), which is the publication of Zha. EX2003, 24-29.

Following this search, the Examiner issued an examiner's amendment and allowed the claims, finding that "the prior art fails to disclose or suggest the combination of limitations recited in the claims 1, 23, and 29" (*id.*, 8-23), which include creating a source database upon receiving, among other things, selection of an SLA. Notably, the Examiner also considered the Sivasubramanian and Zha publications before allowing the '336 patent. EX1001 at 2, (56).

III. The Petition Fails to Establish that the '336 Patent Would Have Been Obvious

Petitioner alleges that claims 1, 5-8, 10-15, and 19-21 of the '336 patent would have been obvious over Sivasubramanian (EX1005) in view of Zha (EX1006). Pet., 68. For the reasons explained below, Petitioner fails to show that there is a reasonable likelihood that it would prevail with respect to any of the challenged claims. Although Nutanix focuses on independent claim 1, Petitioner's grounds fail for the same reasons for the other independent claims because Petitioner concedes they all include the disputed element. *Id.*, 58, 61-62.

**A. Ground 1: Petitioner’s Combination Fails to Establish that
“Selection of a Service Level Agreement (‘SLA’) and a Protection
Schedule” Would Have Been Obvious**

Petitioner’s combination of Sivasubramanian and Zha fails to teach or suggest element [1C],¹ which requires selection of an SLA and a protection schedule for protecting a source database.

**1. Sivasubramanian and Zha, Whether Alone or in
Combination, Fail to Teach or Suggest the Claimed Selection
of an SLA**

For both Grounds 1 and 2, Petitioner relies on the combination of Sivasubramanian and Zha for this element. Pet., 46, 68. But neither Sivasubramanian nor Zha discloses the claimed SLA selection.

Petitioner acknowledges as much. Petitioner concedes that Sivasubramanian does not teach the claimed SLA and attempts to fill that gap by combining it with Zha. *Id.*, 29. Yet, Petitioner concedes that Zha does not teach this element because it “does not mandate a specific interface for specifying policies with snapshot or transaction[al] log retention periods.” EX2001, (’818 Pet.), 35. As such, Petitioner’s concessions undermine its conclusory assertion that “in Sivasubramanian+Zha,

¹ For convenience, Nutanix uses Petitioner’s labeling of the claim elements. This should not be construed as any concession that Petitioner’s labeling is correct or appropriate.

Sivasubramanian’s GUI *receives selection of a Service Level Agreement (SLA) and a protection schedule*” in Zha. Pet., 46. Thus, based on Petitioner’s concessions alone, the combination of Sivasubramanian and Zha fails to render this element obvious.

Petitioner is right to concede that neither Sivasubramanian nor Zha discloses selection of an SLA level to protect a database after provisioning. The ’336 patent requires automatic data retention based on the selected SLA and a selected protection schedule. EX1001, 5:20-23, 33:3-7, 40:14-17. Sivasubramanian’s embodiments, on the other hand, rely on a request submitted by a user or customer to initiate a backup workflow. EX1005, 2:26-32, 19:21-25, 19:35-39. Nowhere does Sivasubramanian teach or suggest selection of a database protection setup based on selection of an SLA level. And, at best, Zha discloses a “log retention policy.” EX1006, 16:29-33. But, as Petitioner recognizes, disclosure of snapshot or transactional log retention periods alone does not render obvious a claim element requiring a specific interface for specifying those things. Pet., 32-33.

Recognizing that its obviousness combination lacks the SLA claim element, Petitioner attempts to fill that gap using more than a dozen references that are not part of Petitioner’s grounds without providing any motivation as to why a POSA would have combined any of these references with Sivasubramanian and/or Zha with a reasonable expectation of success. Under *Arendi S.A.R.L. v. Apple Inc.*, however, a POSA’s background knowledge should be invoked to supply a limitation

“admittedly *missing* from the prior art” only when “the [missing] limitation in question [is] unusually simple and the technology particularly straightforward.” 832 F.3d 1355, 1361-62 (Fed. Cir. 2016). And *Arendi* cautioned that a POSA’s background knowledge “cannot be used as a wholesale substitute for reasoned analysis and evidentiary support, especially when dealing with a limitation missing from the prior art references specified.” *Id.* at 1362. Here, Petitioner’s use of assertions about what is well-known to address a missing limitation, without adequate motivation to combine, falls short of this standard. Thus, Petitioner’s obviousness arguments are deficient as a matter of law and its additional references should not be considered.

Intel Corp. v. PACT XPP Schweiz AG is instructive in this regard. No. 2023-1537, 2024 WL 5068112, at *2 (Fed. Cir. Dec. 11, 2024). In *Intel*, as here, the petitioner relied on a reference not part of any ground to supply a limitation missing from its grounds. *Id.* at *1. Because the reference was used to supply a missing claim limitation, not “to describe the state of the art,” the Board found that the petitioner needed to include the reference in the asserted grounds and present an adequate motivation to combine. *Id.* The petitioner’s failure to do so meant the Board declined to consider the added reference. *Id.* The Federal Circuit affirmed, finding the Board’s conclusion that the reference was used to supply a missing claim limitation was supported by substantial evidence. *Id.* at *2.

Even if fully considered, none of Petitioner's many cited references teach selection of an SLA and a protection schedule to protect a database after provisioning, and Petitioner never argues otherwise. Pet., 32-35. Instead of confronting this directly, Petitioner makes several underlying assertions in support of its ultimate conclusion that it was well known in database creation to accept an SLA-level selection. *Id.*, 33-34. First, Petitioner asserts that "specify[ing] a 'service level' setting retention period[]" was known in the art. *Id.*, 32. Second, Petitioner asserts that SLAs unrelated to database retention policies could have multiple "levels," such as "gold" and "silver." *Id.* (quoting EX1003, ¶ 134). Third, Petitioner asserts that database users were familiar with selecting predefined options through a GUI. *Id.*, 33. But even if each of these assertions were fully supported by Petitioner's gap-filler references (they are not), Petitioner would still be unable to demonstrate that selection of an SLA and a protection schedule for protecting a database, as the claims require, was known in the art.

Petitioner's assertions are individually deficient and cannot be combined to demonstrate that the claimed selection was known because they are based on unrelated prior art references. As to Petitioner's first and third assertions, neither choosing a service level "specifying [a] retention period" (*id.*, 32) nor "letting users [select] from predefined sets of parameter values" (*id.*, 33) demonstrates that selection of an SLA (i.e., service level **agreement** level) to protect a database after

provisioning was known in the art. And as to Petitioner’s second assertion, the fact that “multiple SLA ‘levels’ [could have] name[s like] ‘gold,’ ‘silver,’ etc.” (*id.*, 32 (quoting EX1003, ¶ 134)), does not disclose selection of an SLA to protect a database after provisioning. Indeed, that inventor Kuchibhotla touted the ease with which a database can be provisioned using this feature suggests that it was not known in the art. EX2008, 2:20-4:46; EX2009, 2:20-4:46.

Dr. Bhattacharjee’s conclusory testimony, which is little more than a verbatim recitation of the Petition’s arguments, adds no support for the Petition’s assertions and fails to demonstrate that they render this element obvious. *See Xerox Corp. v. Bytemark, Inc.*, No. IPR2022-00624, Paper 12, at 5 (PTAB Feb. 10, 2023) (Director Review) (precedential) (finding the Board “correct in giving little weight” to the expert testimony because the “declaration merely offered conclusory assertions without underlying factual support and repeated, *verbatim*, [Xerox’s] conclusory arguments”).

Thus, the Petition fails to demonstrate that selection of an SLA and a protection schedule to protect a database after provisioning was known in the art or obvious.

2. Petitioner Fails to Prove Motivation to Combine

Even if Petitioner somehow shows that Zha teaches selection of an SLA (it cannot), Petitioner’s obviousness argument still fails because Petitioner failed to

articulate a proper motivation to combine. Petitioner argues that “POSAs understood [that] it was typical to collect snapshots, logs, and other database-backup information at user-configurable frequencies and times and retain such information for user-configurable durations.” Pet., 29. Beyond this conclusory statement, Petitioner does little to offer any legitimate motivation as to why a POSA would have modified Sivasubramanian with Zha’s teachings with a reasonable expectation of achieving the claimed invention, including the claimed selection of an SLA.

It is well established that the “obviousness inquiry does not merely ask whether a skilled artisan could combine the references, but instead asks whether ‘they would have been motivated to do so.’” *Adidas AG v. Nike, Inc.*, 963 F.3d 1355, 1359 (Fed. Cir. 2020) (quoting *InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014)). Petitioner’s bald statements about what is supposedly known without directly addressing motivation and reasonable expectation of success for the claimed selection of an SLA are legally deficient. *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016) (holding that the “reasonable expectation of success” inquiry is not about “whether one would reasonably expect the prior art references to operate as those references intended once combined,” but rather about whether a POSA had “a motivation to combine accompanied by a reasonable expectation of achieving what is claimed in the patent-at-issue”).

Petitioner's expert, Dr. Bhattacharjee likewise offers conclusory opinions without any supporting evidence (EX1003, ¶¶122-125), which cannot be used to overcome Petitioner's failure to articulate a proper motivation to combine. *TQ Delta, LLC v. CISCO Sys., Inc.*, 942 F.3d 1352, 1359-61 (Fed. Cir. 2019) (refusing to credit conclusory expert testimony that a POSA "*could* combine these references, not that they *would* have been motivated to do so," because doing so "risks allowing the challenger to use the challenged patent as a roadmap to reconstruct the claimed invention using disparate elements from the prior art—i.e., the impermissible *ex post* reasoning and hindsight bias that *KSR* warned against" (citation omitted)). Dr. Bhattacharjee cites to several references that are not part of Petitioner's obviousness combination as purportedly corroborating his motivation testimony. EX1003, ¶¶ 123-125. As explained above, however, these references do not teach or suggest selecting an SLA for protecting a database after provisioning, as the '336 patent's claims require, so they would not have motivated a POSA to modify Sivasubramanian and/or Zha with a reasonable expectation of achieving the '336 patent's claims.

B. Ground 2: Petitioner Concedes that Shekar Does Not Relate to SLAs

Petitioner alleges that claims 1-23 of the '336 patent would have been obvious over Sivasubramanian in view of Zha. Petitioner concedes that the combination in Ground 2 (Sivasubramanian+Shekar+Zha) "is identical to Sivasubramanian+Zha,"

except that Shekar discloses HCIs and that the UIs in the Ground 2 combination “accept additional parameters.” Pet., 68.

Notably, Petitioner does not rely on Shekar to cure any of the deficiencies discussed above. Thus, Petitioner’s combination in Ground 2 is deficient for the same reasons discussed above for Ground 1 in Section III.A.

IV. The Board Should Exercise Its Discretion to Deny Institution as a Matter of Fundamental Fairness and to Avoid Unnecessary Waste of Resources

The Board should deny institution under 35 U.S.C. § 314(a) because this challenge comes from the inventors of the ’336 patent themselves, who previously assigned the patent to Nutanix and touted its benefits.

Additionally, the Board should deny institution under 35 U.S.C. § 325(d) at least because Petitioner (1) presents the same art previously considered by the Office but (2) fails to demonstrate that the Office erred in a manner material to the patentability of the challenged claims. *See Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, at 8-9 (PTAB Feb. 13, 2020) (precedential); *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, at 17-18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph).

A. Petitioner Should Not Be Allowed to Challenge the '336 Patent

The Board should exercise its discretion to deny institution of this proceeding to “secure the just, speedy, and inexpensive resolution of every proceeding.” 37 C.F.R. § 42.1(b). Specifically, to secure the just and inexpensive resolution of this proceeding, and to secure the speedy resolution of other proceedings (by not wasting any more time on this proceeding), the Board should exercise its discretion to deny institution based on the inventors’ unfair dealing.²

Discretionary denial is justified on fairness grounds based on the inventors’ attempt to profit twice from their invention. *Minerva Surgical, Inc. v. Hologic, Inc.*, 594 U.S. 559, 574-75 (2021). As the Supreme Court has explained, when “a person sells his patent rights, he makes an (at least) implicit representation to the buyer that

² The Board and the Federal Circuit have previously held that assignor estoppel does not apply in IPRs based on the language of 35 U.S.C. § 311(a). *Athena Automation Ltd. v. Husky Injection Molding Sys. Ltd.*, IPR2013-00290, Paper 18, at 12-13 (PTAB Oct. 25, 2013) (precedential as to § II.A); *Arista Networks, Inc. v. Cisco Sys., Inc.*, 908 F.3d 792, 804 (Fed. Cir. 2018). But Nutanix is not arguing that assignor estoppel applies based on § 311(a). Nutanix is arguing that the Board should exercise its discretion under § 314(a) in view of the inventors’ unfair dealing, something neither *Athena Automation* nor *Arista Networks* addressed.

the patent at issue is valid—that it will actually give the buyer his sought-for monopoly. In later raising an invalidity defense, the assignor disavows that implied warranty. And he does so in service of regaining access to the invention he has just sold.” *Id.* at 575 (footnote omitted). That is “unfair dealing—enough to outweigh any loss to the public from leaving an invalidity defense to someone other than the assignor.” *Id.*

In this case, the Board should deny institution based on the actions of inventors Balasubrahmanyam Kuchibhotla, Kamaldeep Khanuja, Sujit Menon, and Maneesh Rawat. While working at Nutanix, these inventors assigned their rights to the inventions of the ’336 patent to Nutanix. EX1002, 18-20. After profiting from Nutanix by doing so, Kuchibhotla and Khanuja left Nutanix to found Petitioner Tessell. EX2010; EX2011. They subsequently hired Menon and Rawat away from Nutanix. EX2012; EX2013. At Petitioner Tessell, the inventors sought to profit from their invention a second time by using it to compete with Nutanix. But as the Supreme Court stated, they should not be allowed to “profit doubly—by gaining both the price of assigning the patent and the continued right to use the invention it covers.” *Minerva Surgical*, 594 U.S. at 575. They should not be allowed to challenge the validity of the ’336 patent. *See id.* The same goes for Petitioner. *Mentor Graphics Corp. v. Quickturn Design Sys., Inc.*, 150 F.3d 1374, 1379 (Fed. Cir. 1998) (treating

like assignors parties in privity with the assignors). The Board should exercise its discretion under 35 U.S.C. § 314(a) to deny institution.

B. There Is No Reason to Second Guess the Examiner

1. Sivasubramanian and Zha Were Considered

Petitioner concedes that “Zha and a descendant of Sivasubramanian [were] listed on an IDS signed by the examiner” during prosecution. Pet., 85 (citing EX1002, 239-40). Thus, part (1) of the Board’s two-part framework under *Advanced Bionics* is satisfied by the Examiner’s acknowledgement of the Applicant’s list of cited references alone. Under *Becton, Dickinson* factor (a), Sivasubramanian and Zha have the same disclosures as the Zha reference and descendant of Sivasubramanian (EX2004) cited to the Office during prosecution of the ’336 patent (EX1002, 175-76, 239-40, 312-13). There are thus no material differences between these references. Similarly, under *Becton, Dickinson* factor (b), Sivasubramanian and Zha are not merely cumulative of the references considered during prosecution, they are substantively identical. Finally, because substantively identical art was presented to the Office during prosecution of the ’336 patent, *Becton, Dickinson* factor (d) is irrelevant to the analysis. *See Becton, Dickinson*, IPR2017-01586, Paper 8, at 17-18, 23-24; *Nokia of Am. Corp. v. Soto*, IPR2023-00680, Paper 18, at 4 (PTAB Mar. 28, 2024) (Director Review) (“[T]he first part of the *Advanced Bionics* framework is

satisfied if either substantially the same prior art *or* substantially the same arguments were previously presented to the Office . . .”).

Petitioner erroneously argues that *Advanced Bionics* part (1) “weighs against discretionary denial” because “the examiner did not articulate any consideration” of Sivasubramanian and Zha in the record. Pet., 85-86. Petitioner’s argument is flawed because Petitioner relies on a notice of proposed rulemaking to present the previous Patent Office Director’s intent for discretionary denial determinations. Notices of proposed rulemaking, however, are not law and are not binding. Because no rule has been promulgated following the notice, Petitioner’s reliance on the apparent standard set forth in it is incorrect. *See Advanced Bionics*, IPR2019-01469, Paper 6, at 7-8 (“Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent.”). Under the correct standard, and as Petitioner concedes, Sivasubramanian and Zha were both before the Office during prosecution of the ’336 patent, and part (1) of the *Advanced Bionics* framework favors denial.

2. Petitioner Fails to Demonstrate Any Material Error in the Office’s Review of Sivasubramanian and Zha

“If, after review of factors (a), (b), and (d), it is determined that the same or substantially the same art or arguments previously were presented to the Office, then

[*Becton, Dickinson*] factors (c), (e), and (f) relate to whether the petitioner has demonstrated a material error by the Office.” *Advanced Bionics*, IPR2019-01469, Paper 6, at 10. *Becton, Dickinson* describes these factors as follows: “(c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection”; “(e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.” IPR2017-01586, Paper 8, at 17-18.

With respect to *Becton, Dickinson* factor (c), Petitioner asserts that the mere fact that the Examiner did not use Sivasubramanian or Zha in a rejection weighs against denial. Petitioner’s assertion, however, overlooks that Sivasubramanian and Zha were first cited by the Office during prosecution of a related application. The Office first cited the descendant of Sivasubramanian, U.S. Patent Application Publication No. 2014/0229698, in a Notice of References Cited during prosecution of the ’157 patent. EX2003, 26. In the same Notice of References Cited, the Office also cited Zha’s publication, U.S. Patent Application Publication No. 2011/0093435. *Id.*, 25. And the ’336 patent is terminally disclaimed over the ’157 patent. EX1002, 282, 294-95. Thus, the Patent Office introduced and substantively considered the teachings of Sivasubramanian and Zha and (correctly) determined that they were not material to patentability. *Becton, Dickinson* factor (c) favors denial.

With respect to *Becton, Dickinson* factor (e), Petitioner fails to point out specifically how the Examiner erred in evaluating Sivasubramanian and Zha. *See Advanced Bionics*, IPR2019-01469, Paper 6, at 21 (“Petitioner must demonstrate that the Examiner erred in the evaluation of the prior art, for example, by showing that the Examiner misapprehended or overlooked specific teachings in the relevant prior art such that the error by the Office was material to the patentability of the challenged claims.”); *see id.* at 8-9 n.9. Instead, Petitioner simply disagrees with the Examiner’s consideration and rejection of Sivasubramanian and Zha, an “error” that the Board has repeatedly rejected. *See Siemens Mobility, Inc. v. Metrom Rail, LLC*, IPR2024-00947, Paper 12, at 17-19 (PTAB Nov. 19, 2024); *Fitesa Simpsonville, Inc. v. Procter & Gamble Co.*, IPR2023-01450, Paper 11, at 20 (PTAB Mar. 20, 2024) (“Petitioner merely disagrees with the Examiner’s findings and conclusions[,] which [are] insufficient to establish material error by the Office.”). To satisfy its burden under *Becton, Dickinson* factor (e), it is not sufficient for Petitioner to merely point to its proposed Grounds’ mapping of claim limitations to applied references. *See Advanced Bionics*, IPR2019-01469, Paper 6, at 9 (“If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability. At bottom, this framework reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.”).

Moreover, Petitioner's analysis overlooks the Examiner's Reasons for Allowance of the '336 and '818 patents. For the '336 patent, the Examiner generally stated that "[t]he prior art does not teach or fairly suggest" a combination of limitations including "receive(ing) [sic] selection of a Service Level Agreement ('SLA') . . . and setting up automatic capturing of snapshots and transactional logs based upon the SLA and the protection schedule for protecting the source database." EX1002, 325. For the '818 patent, the Examiner more specifically stated that "[t]he prior art does not teach or fairly suggest receive/receiving a fourth input comprising a selection of a level of a Service Level Agreement (SLA) from a plurality of levels of the SLA to protect the database after provisioning" EX2002, 359. In its analysis under § 325(d), Petitioner fails to even address the SLA element, much less show that the Examiner misapprehended or overlooked specific teachings in Sivasubramanian or Zha such that the error by the Office was material to patentability of this element. Yet, this is the exact limitation that Petitioner concedes is missing from the Sivasubramanian+Zha combination. Pet., 29-30, 32; EX2001 ('818 Pet.), 35. And Petitioner concedes that Shekar does not cure this deficiency in Sivasubramanian+Zha. Pet., 66. Here, just as in *Fitesa*, the Examiner of the '336 patent had full access to the Examiner's search results and analysis from the related patents and performed the same analysis. IPR2023-01450, Paper 11, at 20. Petitioner presents no error in the Examiner's analysis. Instead, Petitioner's own statements

demonstrate that the Examiner did not materially err in finding the claims patentable over Sivasubramanian and Zha. *Becton, Dickinson* factor (e) thus favors denial.

With respect to *Becton, Dickinson* factor (f), Petitioner asserts only that the Examiner was not presented with “the expert testimony and evidence of a POSA’s background knowledge presented in this Petition regarding why the claims are obvious.” Pet., 87. But this conclusory assertion fails to explain what facts or evidence the Examiner supposedly overlooked and fails to explain how they demonstrate material error by the Office. *Becton, Dickinson* factor (f) thus favors denial.

In sum, the Board should exercise its discretion under 35 U.S.C. § 325(d) to deny institution of this Petition based on the Board’s *Advanced Bionics* decision.

V. Conclusion

For these reasons, Petitioner has failed to establish a reasonable likelihood of showing that any of claims 1-23 are unpatentable. Accordingly, the Board should deny institution of an *inter partes* review.

Respectfully submitted,

Dated: March 31, 2025

By: /Joshua L. Goldberg/
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CERTIFICATE OF COMPLIANCE

Pursuant to 37 C.F.R. § 42.24(d), I, Joshua L. Goldberg, certify that **Patent Owner's Preliminary Response** contains 5,605 words, excluding those portions identified in 37 C.F.R. § 42.24(a), as measured by the word-processing system used to prepare this paper.

Dated: March 31, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that a copy of the foregoing **Patent Owner's Preliminary Response** was served electronically via email on March 31, 2025, in its entirety on the following:

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