BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner

v.

VALTRUS INNOVATIONS LTD.,
Patent Owner

Case No. IPR2025-00415
Patent No. 6,691,139

PATENT OWNER'S BRIEF THAT INSTITUTION OF THE PETITION SHOULD BE DENIED ON DISCRETIONARY GROUNDS

PATENT OWNER'S EXHIBIT LIST

No.	Exhibit Description
2001	Memorandum for Interim Processes for PTAB Workload Management, dated March 26, 2025
2002	Order in *Valtrus Innovations Ltd. v. SAP America, Inc. et al.*, No. 2:24-cv-00021-JRG, Dkt. No. 146 (E.D. Tex. Apr. 26, 2025)

Pursuant to the Memorandum titled "*Interim Processes for PTAB Workload Management*," dated March 26, 2025 ("the Interim Processes Memo"; EX2001) and the Notice Extending Deadline for Discretion Briefing (Paper 6), Patent Owner respectfully submits this brief explaining why the Director, in consultation with a Board panel, should exercise her discretion to deny institution of Petitioner's Petition for *Inter Partes* Review (Paper 1).

In the Interim Processes Memo, the Director identified several considerations, including, among others, "[t]he strength of the unpatentability challenge," "[t]he extent of the petition's reliance on expert testimony," "[s]ettled expectations of the parties, such as the length of time the claims have been in force," and "[a]ny other considerations bearing on the Director's discretion." EX2001, 2-3. In accordance with the memo, the Director will also consider "its statutory deadlines for AIA proceedings, and other workload needs." EX2001, 3.

Against this backdrop, Patent Owner submits that discretionary denial is warranted.

First, the '139 Patent was filed on January 31, 2001, issued on February 10, 2004, and expired on November 30, 2021. EX1001, Cover Page. It was in full force for its entire term (20 years, 303 days). All maintenance fees were timely paid (including those paid prior to the enactment of the America Invents Act that created *inter partes* reviews). The first time the patent was asserted in litigation was in

January 2024, when Patent Owner filed suit against Petitioner. Although Patent Owner appreciates that pre-AIA patents are not, as a matter of law, immune from *inter partes* review proceedings, Patent Owner respectfully submits that the Director should exercise her discretion under the circumstances, based on the settled expectations of when the '139 Patent was filed (in 2001) and that the '139 Patent has already ran its full term. Nonetheless, as the Supreme Court has stated, "[e]lementary considerations of fairness dictate that individuals should have an opportunity to know what the law is and to conform their conduct accordingly; settled expectations should not be lightly disrupted." *Landgraf v. USI Film Prods.*, 511 U.S. 244, 265 (1994). That is why "[r]etroactivity is not favored by the law" and "congressional enactments and administrative rules will not be construed to have retroactive effect unless their language requires this result." *Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 208 (1988). This is particularly so for patents, where "fundamental alterations ... risk destroying the legitimate expectations of inventors in their property." *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 739 (2002). Here, those settled expectations—especially when considered in view of the circumstances discussed below and the Board's finite resources—counsel toward discretionary denial.

Second, Patent Owner is no longer asserting the '139 Patent against Petitioner in the underlying district court action, having recently dismissed with prejudice its

claims pertaining to the patent. EX2002, 1. Thus, Patent Owner is not (and cannot in the future) assert this patent against Petitioner. Patent Owner also is not asserting the '139 Patent in any other case. Patent Owner respectfully submits that it is not worth the Board's finite resources to address a 13,876-word Petition (with an accompanying 99-page expert declaration that is largely a copy-and-paste from the Petition and tracks, nearly verbatim, the arguments made in the Petition's Ground, with the same coloring, emphasis, and alterations, without additional analysis), filed three days before Petitioner's 35 U.S.C. §315(b) one-year bar, over an expired patent, when Petitioner no longer faces any risk of the patent being asserted against it. Indeed, if this IPR Petition is instituted, by the time of any final written decision (which would be due August 20, 2026), the '139 Patent will have been expired for nearly four years and nine months (4 years, 8 months, 21 days to be exact).

Accordingly, for the reasons explained above, Patent Owner respectfully submits that the Director should exercise her discretion to deny the Petition.

Dated: May 9, 2025

Respectfully submitted,

/Patrick Colsher/

Patrick Colsher (Reg. No. 74,955)
Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE

I hereby certify that this paper complies with the type-volume limitation of 37 C.F.R. §42.24 and the Interim Processes Memo (as determined by the Microsoft Word word-processing system used to prepare this paper) because it contains 639 words, excluding the parts of the paper exempted by 37 C.F.R. §42.24(a).

Dated: May 9, 2025

Respectfully submitted,

/Patrick Colsher/

Patrick Colsher (Reg. No. 74,955)
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Patent Owner's Brief that Institution of the Petition Should be Denied on Discretionary Grounds and Exhibits listed on the List of Exhibits were served on May 9, 2025, via electronic mail upon counsel of record for Petitioner at the following email addresses:

Louis L. Campbell (LLcampbell@winston.com)
Scott M. Border (SBorder@winston.com)
Samuel W. Riebe (SRiebe@winston.com)
Michael Bittner (MBittner@winston.com)
Matt R. McCullough (MRMcCullough@winston.com)
William Logan (WLogan@winston.com)
Patrick Clark (PClark@winston.com)
IPR-SAP-Val@winston.com

Dated: May 9, 2025

/Patrick Colsher/
Patrick Colsher (Reg. No. 74,955)
Counsel for Patent Owner