
BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner

v.

VALTRUS INNOVATIONS LTD.,
Patent Owner

Case No. IPR2025-00417
Patent No. 6,823,409

**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	Joint Claim Construction and Prehearing Statement in <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 96 (E.D. Tex. Dec. 20, 2024)
2003	Joint Claim Construction Chart in <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 123 (E.D. Tex. Feb. 28, 2025)
2004	Opening Claim Construction Brief in <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 110 (E.D. Tex. Jan. 31, 2025)
2005	Responsive Claim Construction Brief in <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 117 (E.D. Tex. Feb. 14, 2025)
2006	Reply Claim Construction Brief in <i>Valtrus Innovations Ltd. v. SAP America, Inc.</i> , No. 2:24-cv-00021-JRG, Dkt. No. 118 (E.D. Tex. Feb. 21, 2025)
2007	Order in <i>Valtrus Innovations Ltd. v. SAP America, Inc. et al.</i> , 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), 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, 2-3.¹ 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 ’409 Patent was filed on September 28, 2001, issued on November 23, 2004, and expired on November 16, 2022. EX1001, Cover Page. It was in full

¹ With the exception of any patents (cited by column and line number) and the expert declaration (cited by paragraph number), Patent Owner uses the exhibit page numbering in the lower righthand corner of the Exhibits.

force for its entire term (20 years, 414 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 '409 Patent was filed (in 2001) and that the '409 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 ’409 Patent against Petitioner in the underlying district court action, having recently dismissed with prejudice its claims pertaining to the patent. EX2007, 1. Thus, Patent Owner is not (and cannot in the future) assert this patent against Petitioner. Patent Owner also is not asserting the ’409 Patent in any other case. Patent Owner respectfully submits that it is not worth the Board’s finite resources to address a 11,775-word Petition (with an accompanying 254-page expert declaration that the Petition extensively relies upon throughout its Grounds), 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 September 10, 2026), the ’409 Patent will have been expired for nearly four years (3 years, 9 months, 25 days to be exact).

Third, and perhaps most importantly here, although the district court case no longer involves the ’409 Patent, Petitioner previously took inconsistent positions in district court and in its IPR Petition, asserting in district court that various “module” terms are subject to 35 U.S.C. §112 ¶6 and indefinite for failure to disclose

corresponding structure, EX2002, 21-24; EX2005, 26-34;² *see also* EX2003, 6; but in its IPR Petition, Petitioner took the opposite position, asserting instead that they are subject to “plain and ordinary meaning.” Petition (Paper 1), 17-18. This both hobbles Petitioner’s merits position and confirms denial is warranted for failure to comply with the requirements under 37 C.F.R. §42.104(b)(3). *See, e.g., Cambridge Mobile Telematics, Inc. v. Sfara, Inc.*, IPR2024-00952, Paper 12, 5-9 (PTAB Dec. 13, 2024) (informative as to the majority) (denying institution for failure to comply with 37 C.F.R. §42.104(b)(3) where petitioner asserted in district court a term was means-plus-function but asserted it was plain and ordinary meaning in its IPR petition); *see also 10x Genomics, Inc. v. Pres. and Fellows of Harvard Coll.*, IPR2023-01299, Paper 15, 2, 7-8, 12-13 (PTAB Mar. 14, 2024) (denying institution under 37 C.F.R. §42.104(b)(3) because a petitioner “must” provide a construction for 35 U.S.C. §112 ¶6 terms) (citing Consolidated Trial Practice Guide, 45).

For example, prior to filing the Petition, Petitioner argued in the district court action that several “module” terms—including “coherency control module,” “request module,” and “static RAM interface module”—are means-plus-function

² For the parties’ claim construction briefing, Patent Owner again cites to the exhibit page numbering (*e.g.*, exhibit page number 26 corresponds to labeled page 20 of the brief in EX2005).

terms and indefinite. EX2002, 21-24. Petitioner continued this argument in its claim construction briefing (without any expert reliance), EX2005, 26-34. Patent Owner disagreed and, like in *Cambridge Mobile*, argued for plain and ordinary meaning or alternatively, means-plus-function with corresponding structure. EX2004, 23-29; EX2006, 9-12; EX2002, 6-8; *see also Cambridge Mobile*, IPR2024-00952, Paper 12, 8 (“Even though Patent Owner argued for the plain and ordinary meaning of the ‘component’ terms in the litigation, it also set forth an alternative means-plus-function claim construction position. Thus, both parties previously indicated the importance of considering whether the ‘component’ terms are means-plus-function limitations, further implicating the applicability of 37 C.F.R. §42.104(b)(3).”).

In the IPR Petition, Petitioner argues (as does its expert) the *opposite*, contending that the terms have their “plain and ordinary meaning”: “Because a POSITA would find the challenged claims unpatentable under any interpretation consistent with their plain and ordinary meaning in the context of the ’409 Patent, the Board need not expressly construe the claim terms.” Petition (Paper 1), 17-18. Neither Petitioner, nor its expert, mentions or attempts to reconcile the contradictory positions, when applying the prior art to the challenged claims. *See generally* Petition (Paper 1) (including, *e.g.*, 30-31 (discussing “coherency control module” in claim 1), 31-35 (discussing “request module” in claim 1), 39-41 (discussing “static

RAM interface module” in claim 1)); *see also, e.g.*, EX1006 ¶¶83-85 (coherency control module), ¶¶86-95 (request module and static RAM interface module).³

Petitioner’s omissions are significant. Beyond failing to comply with the rules (which alone demonstrates the Petition is deficient on its face), Petitioner asserts—without support or explanation—that the “coherency control module” corresponds to the “switching agent 140” in *Khare*. Petition (Paper 1), 30 (citing EX1006 ¶85; EX1002, 5:21-24, 3:28-29). Paragraph 85 of the expert declaration simply states:

Khare’s description above confirms the understanding that, in the preceding figure, Khare discloses a coherency control module, highlighted in green, operably coupled to the two processor buses, highlighted in yellow, via communication channels highlighted in slightly darker green. For example, in the passages above, Khare states, “the processors in nodes 110, 120 and 130 each have one or more caches (e.g., Level 1 and Level 2 caches), and these caches are kept coherent using the switching agent 140,” which indicates that the processors are operably coupled to the coherency control module (switching agent 140) over their processor buses.

EX1006 ¶85.

³ Petitioner refers back to independent claim 1 for its analysis of these limitations in independent claim 10. Petition (Paper 1), 58-59 (citing EX1006 ¶¶148-167).

An examination of the expert’s “Khare’s description above” reveals that it is an extended block quote from *Khare*, EX1006 ¶84, and provides *no* analysis or explanation as to a POSITA’s alleged understanding of the reference or claim. Petitioner may point to its expert’s statement quoting *Khare* that includes the term “coherent,” but that fails to explain how the “switching agent 140” actually meets the “coherency control module” limitation, or what a “coherency control module” is. Nor does it explain or address the means-plus-function position that Petitioner took in district court.

Having argued in district court the claims are means-plus-function but provided no positions on corresponding structure, and provided in the IPR Petition no actual analysis or explanation as how *Khare* meets the claim limitations under its unexplained “plain and ordinary meaning,” Petitioner has both failed to comply with 37 C.F.R. §42.104(b)(3) and show a reasonable likelihood of prevailing. *See Cambridge Mobile*, IPR2024-00952, Paper 12, 5-9; *10x Genomics*, IPR2023-01299, Paper 15, 2, 8; Consolidated Trial Practice Guide, 45; *see also Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 15-16 (PTAB Aug. 24, 2022) (precedential) (denying institution where petitioner’s expert did not provide any supporting evidence or technical reasoning).

In sum, with Petitioner having failed to address its district-court claim construction positions—or inform the Board of the same—Patent Owner

respectfully submits that discretionary denial is warranted for this additional reason. There is simply no reason for the Board to expend resources to address these inconsistent positions (where Petitioner failed to comply with the governing rules) over an expired patent that is not being asserted (and will not be asserted in the future) against Petitioner.

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 1603 words, excluding the parts of the paper exempted by 37 C.F.R. §42.24(a).

Dated: May 9, 2025

Respectfully submitted,

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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:

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