

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TANKLOGIX, LLC,
Petitioner

v.

SITEPRO, INC.,
Patent Owner

Case No. IPR 2025-00649

U.S. Patent No. 9,342,078

PETITIONER'S DISCRETIONARY DENIAL OPPOSITION BRIEF

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PETITIONER'S EXHIBIT LIST

<u>EXHIBIT</u>	<u>DESCRIPTION</u>
EX1001	U.S. Patent No. 8,649,909
EX1002	Declaration of Dr. Gary Wooley
EX1003	Curriculum Vitae of Wooley
EX1004	File Wrapper for U.S. Patent No. 8,649,909
EX1005	U.S. Patent Application No. 2015/0308244 to Cardamone
EX1006	U.S. Patent No. 8,667,091 to Almadi
EX1007	U.S. Patent Application No. 2008/0316048 to Abdallah
EX1008	Judicial Caseload for Western District of Texas
EX1009	Petitioner's Sotera Stipulation
EX1010	Notice of Errata
EX1011	DocketNavigator Identification of SitePro Matters
EX1012	Defendant's Motion to Stay Filed in the District Court

Patent Owner's request for discretionary denial of institution under 35 U.S.C. §§ 314(a) and/or 325(d) should be denied for at least the reasons below.

I. The Final Written Decision Will Precede the District Court Trial

Patent Owner's request for discretionary denial of institution under 35 U.S.C. §§ 314(a) and/or 325(d) should be rejected. The lawsuits against TankLogix were filed on December 20, 2024. The Petition was diligently prepared and filed on February 28, 2025. The February 28, 2025 filing date was not much more than two months after SitePro filed its complaint. The February 28, 2025 filing date was also *the same day* that former Director Vidal's 2022 Memorandum was rescinded, altering the landscape and past practice with respect to IPR submission and institution decisions. This IPR was filed before SitePro filed its First Amended Complaint, and before the parties had even negotiated a schedule. And based on the schedule, which is quite likely to slip, trial will not occur before October 26, 2026. *See* EX2002. A Notice of Filing Date Accorded was mailed April 16, 2025. Based on that date, a final written decision will issue not later than October 16, 2026 – at least ten days ***before the scheduled first day of trial***. And that scheduled trial date is not realistic. The average time to trial now in the Western District of Texas is now 33.1 months. EX1008. Applying that average time to trial to this case would result in a trial date of September, 2027 – roughly ***eleven months after*** a Final Written Decision would issue. Furthermore, in the district court case, the

investment of the parties and Court has been low, as there has been no *Markman* hearing, and discovery has not yet commenced. *See* EX2002.

II. Settled Expectations

This IPR was one of seven IPRs filed against seven of the eight patents Sitepro asserted in the district court cases filed on December 20, 2024. The eighth IPR was filed against the most-recently-issued patent asserted in the December 20, 2024 litigation on April 11, 2025 (IPR2025-00761). The eight patents have issuance dates as follows:

Patent No.	Issue Date
8,649,909	February 11, 2014
9,342,078	May 17, 2016
9,898,014	February 20, 2018
10,488,871	November 26, 2019
11,294,403	April 5, 2022
11,726,504	August 15, 2023
11,175,680	November 16, 2021
12,019,461	June 25, 2024

Most (five out of eight) of the patents issued within the past six years. One benchmark regarding settled expectations has analogized the relevant timeline to the six-year patent enforcement statute of limitations. *Dabico Airport Sols. Inc. v. Axa PowerAps*, IPR2025-00408, Paper 21 at 2–3 (Director June 18, 2025) (citing 35 U.S.C. § 286 (“Except as otherwise provided by law, no recovery shall be had for any infringement committed more than six years prior to the filing of the complaint or counterclaim for infringement in the action.”)). The midpoint of the issuance dates of the patents at issue is April 4, 2020, a date less than five years

before the filing date of seven of the IPRs, and approximately five years before the eighth IPR. Accordingly, the challenges patents at issue have an issuance midpoint five years ago, which is significantly less than the six-year statute of limitations referenced in the Director's *Dabico* guidance.

In *Dabico*, the Director stated "the challenged patent has been in force almost eight years." *Dabico* at 2. In *Proxense*, the Director stated "the challenged patents have been in force over nine years." *Intel Corp. v. Proxense LLC*, IPR2025-00327, Paper 12, at 2–3 (Director June 26, 2025). As explained above, most of the patents at issue in the eight IPRs have been in force for less than six years, and the midpoint of the issuance dates is about five years ago.

An additional consideration is the amount of time that the older patents had been in force without assertion. *Proxense* at 2-3 ("There may be persuasive reasons why the Board should review challenged claims several years after their issuance date... a patent may have been in force for years but may not have been commercialized, asserted, marked, licensed, or otherwise applied in a petitioner's particular technology space, if at all."). A review of district court cases involving SitePro reveals that SitePro's first district court litigation was filed on Feb. 13, 2023.¹ EX1011. Accordingly, TankLogix had a settled expectation, at least prior to 2023, that the patents would not be asserted against it.

¹ There was no litigation found for "Amplisine Labs," the name by which SitePro was formerly known.

A final consideration may be that TankLogix was unaware of the challenged patents until being sued on them. There is no record evidence that, for example, TankLogix cited to any SitePro patents in connection with any TankLogix prosecution activities. *See Ericsson and Verizon Wireless v. Procomm International*, IPR2024-01455, Paper 15, at 3 (Director June 25, 2025) (“Petitioner was aware of it as early as 2013—having been brought to Petitioner’s attention in a Notice of References Cited during the prosecution of one of its own patents.”).

III. *Sotera* Stipulation

The Petition presents strong invalidity grounds, and each claim that TankLogix believes may reasonably be asserted against it in the district court litigation has been challenged. Further, TankLogix has submitted a stipulation that goes beyond a typical *Sotera* stipulation, and which eliminates any potential overlapping invalidity issues between the litigation and the IPR upon institution. These are additional strong reasons why the Director should not discretionarily deny institution.

IV. Factors Analysis

1. *Advanced Bionics* Factors and 35 U.S.C. §325(d) Favor Institution

Advanced Bionics step one, and *Becton, Dickinson* factors (a), (b), and (d) favor institution because none of the references in this Petition were before the Office during prosecution. *See* EX1002, ¶¶30-35 (summary of prosecution history

in EX1004); EX1001, at Cover. The references are also not cumulative of the prosecution prior art, and they explicitly teach “translating the plurality of commands into a plurality of translated commands” which applicants argued was not present in the examined art (EX1004, at 50-51), and they disclose “a sending the translated commands to the local controllers,” which Examiner identified as part of the reasons for allowance. *Id.* at 110-12.

2. Discretionary Denial Under *Fintiv* and 35 U.S.C. §314(a) Is Not Appropriate

The six *Fintiv* factors guide against discretionary denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (precedential).

a. TankLogix Filed a Motion A Stay

Factor 1 favors institution. TankLogix filed motions to stay the district court cases on April 16, 2025. EX1012. The district court has not yet ruled on the motions. TankLogix agrees with SitePro’s statement that Judge Rodriguez has not previously ruled on any contested motions to stay pending IPR. Therefore, this factor likely favors Petitioner, but conservatively, it can be considered neutral.

b. Parallel Proceeding Trial Date

Factor 2 favors institution. based on the schedule, which is quite likely to slip, trial will not occur before October 26, 2026. A Notice of Filing Date Accorded was mailed April 16, 2025. Based on that date, a final written decision will issue not later than October 16, 2026 – at least ten days before the scheduled

first day of trial. And that scheduled trial date is not realistic. The average time to trial now in WDTX is now 33.1 months. EX1008. Applying that average time to trial to this case would result in a trial date of September, 2027 – roughly eleven months after a Final Written Decision would issue.

c. Investment in Parallel Proceeding

Factor 3 favors institution. The co-pending litigation is in its early stages, and the investment in it has been minimal. The parties have not exchanged preliminary positions on claim construction and discovery has not opened. *See PEAG LLC v. Varta Microbattery GmbH*, IPR2020-01214, Paper 8, 17 (Jan. 6, 2021).

d. Overlapping Issues with Parallel Proceeding

Factor 4 favors institution consistent with *Sotera Wireless, Inc.*, Petitioner hereby stipulates “that if the PTAB institutes *inter partes* review, Petitioner ‘will not pursue in [*SitePro, Inc. v. TankLogix, LLC*, No. 6:24-cv-00642; -643 (W.D. Tex.) (“Litigation”)] the specific grounds [asserted in IPR2025-00649], or . . . any other ground . . . that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications).” *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 13-14 (PTAB Dec. 1, 2020) (precedential). For the avoidance of doubt, if the PTAB institutes *inter partes* review, Petitioner will not, in the Litigation, rely on any product or system art that is “based on the same evidence

presented” in this IPR. *Cf. SAP America, Inc. v Cyandia, Inc.*, IPR2024-01496, Paper 13 at 9 (PTAB Apr. 7, 2025) As such, the Grounds presented in the instant IPR will be materially different from the grounds that will be presented in the district court.

Patent Owner points out a clerical error in the reference to the IPR number, but Patent Owner’s observation is a distinction without a difference because the stipulation includes “or . . . any other ground . . . that was raised or could have been reasonably raised in an IPR (i.e., any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications).”. *See* EX1009. Furthermore, the stipulation also states “For the avoidance of doubt, if the PTAB institutes inter partes review, Petitioner will not, in the Litigation, rely on any product or system art that is ‘based on the same evidence presented’ in this IPR.” *See* EX1009.

e. Identity Of Parties

Factor 5 is neutral. Petitioner is the defendant in the co-pending litigation.

f. Other Circumstances, Including the Merits

Factor 6 guides against discretionary denial. Here, the evidence of unpatentability is compelling, as evidenced by the grounds in the Petition. Patent Owner posits that the incorrect section of pre-AIA § 102 was cited in the Petition. However, Petitioner addressed this issue by filing its Notice of Errata. EX1010. Patent Owner also argues that the distinction between “a user account” and “multiple user accounts” somehow

undermines the integrity of the Petition. It does not, and Petitioner will, given the opportunity, establish the strong merits of its argument during IPR trial.

3. *General Plastic* Factors Favor Institution

The '078 patent was previously challenged in an earlier IPR petition by a different petitioner, but there, the parties settled before Patent Owner filed its preliminary response. Accordingly, none of the *General Plastic* factors apply to this Petition and the *General Plastic* Factors favor institution.

V. Factors Summary

	Conclusion	Explanation
Factor 1	Neutral or slightly favors institution	Stay is likely if IPR is instituted, because courts in WDTX grant motions to stay pending IPR slightly more than denying
Factor 2	Favors institution	Trial date will likely change given the district court's current and increasing congestion and average time to trial
Factor 3	Favors institution	No significant investment in substantive issues has occurred; claim construction has not commenced; discovery has not commenced
Factor 4	Favors institution	Petitioner's stipulation removes all

		potential overlapping invalidity issues— including any product or system art that is “based on the same evidence presented” in this IPR
Factor 5	Neutral	Same parties in the IPR and litigation, but should be afforded little to no weight
Factor 6	Favors institution	Compelling merits and other factors favor institution

VI. Conclusion

Trial should be instituted, and discretionary denial should be denied.

Dated: July 11, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that the PETITIONER'S DISCRETIONARY DENIAL
OPPOSITION BRIEF was served, by consent of the parties, by emailing a copy
thereof to counsel of record for the Patent Owner on July 11, 2025 by filing the
documents through P-TACTS and by sending via electronic mail to the following:

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