

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TANKLOGIX, LLC,

Petitioner,

v.

SITEPRO, INC.,

Patent Owner.

PTAB Case No. IPR2025-00650

Patent No. 10,488,871

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

No.	Exhibit Description
Ex. 2001	Docket Navigator - Motion Success for Stay Pending IPR for Judge Xavier Rodriguez
Ex. 2002	Scheduling Order for <i>SitePro, Inc. v. TankLogix, LLC</i> , 6:24-cv-00643-XR-DTG, pending in the United States District Court for the Western District of Texas.
Ex. 2003	SitePro's Preliminary Infringement Contentions, 6:24-cv-00643-XR-DTG, pending in the United States District Court for the Western District of Texas.
Ex. 2004	U.S. Patent No. 12,019,461
Ex. 2005	SitePro's Response to TankLogix's Motion to Stay, <i>SitePro, Inc. v. TankLogix, LLC</i> , 6:24-cv-00643-XR-DTG, Dkt. 34.
Ex. 2006	File History of U.S. Patent Application No. 12/794,898
Ex. 2007	File History of U.S. Patent Application No. 14/579,141
Ex. 2008	Screenshots of Patent Center website of U.S. Patent Application No. 12/794,898
Ex. 2009	Declaration of Dr. Robert A. Durham, Ph.D., FIEEE

I. INTRODUCTION

TankLogix, LLC (“TankLogix” or “Petitioner”) filed a petition for *Inter Partes* Review (“IPR”) against Claims 18-32 and 34 (“Challenged Claims”) of U.S. Patent No. 10,488,871 B2 (the “’871 patent”) based on two grounds.

The ’871 patent is a continuation in a series of granted patents directed to the remote control of fluid-handling devices, such as valves, pumps, process chambers, process filters, level switches, and the like for various oil and gas industrial systems. *See* Ex. 1001, title, 1:66-2:2, 5:53-65. The systems and methods described in the ’871 patent provide the computing infrastructure for users to remotely receive and analyze data of monitoring and control equipment for fluid-handling devices and to remotely command and control them via a user interface over a network (e.g., web browser over a web-based network in some embodiments). *See id.*, 3:7-3:39, FIG. 1, Claim 18, Claim 22. The fluid-handling devices are thereby “controlled remotely without the need to install special-purpose software on the computing device through which remote control is exercised” (*id.*, 3:29-36), which solves several deficiencies in the art at the time of the ’871 patent, including manual on-site control or specialized software required for devices on a site-by-site basis. *See id.*, 1:40-69. Furthermore, the system and methods of the ’871 patent enable an advantageous user authorization and management scheme where certain users are allowed to monitor and control the fluid-handling devices, while other users are only permitted to view

data associated with the fluid-handling devices for a particular oil and/or gas facility or facilities. *See id.*, 4:24-44.

Claim 18, for instance, requires, *inter alia*, a method step for storing multiple user accounts corresponding to different groups of fluid-handling facilities, where each group has (1) user accounts authorized to send commands to remotely control fluid handling devices at the group's respective fluid-handling facilities and (2) user accounts authorized to view reports of data from these fluid handling devices. Claim 18 also requires one or more facility-interface modules and user-interface modules to manage the data and command communications, via network communications, between monitoring and control equipment at the fluid-handling facilities and user computing devices logged into the accounts. *See id.*, 19:4-67.

Petitioner's challenges to Claim 18 based on the disclosures of U.S. Patent No. 7,424,399 B2 ("Kahn," Ex. 1005) and U.S. Patent No. 9,709,995 B2 ("Gutierrez," Ex. 1006) fall woefully short since these references do not individually or collectively disclose, teach, suggest, or render obvious each claimed feature and the claimed method as a whole. The insufficient teaching of the '871 patent claims by these references is reflected in the Petition, which fails to identify any disclosure by Kahn and Gutierrez for several claim elements and limitations. Moreover, Petitioner does not present a sound case—much less a compelling one—for why a person of ordinary skill in the art (POSITA) would combine Kahn and Gutierrez.

The Petition is also fatally flawed by failing to meet the legal standards of invalidity under §§ 102 and 103, including reliance on a reference (Gutierrez) that is not prior art to the '871 patent.

Overall, the merits of the Petition are deficient, and its arguments are confusing and inconsistent for most, if not all, claim elements. As demonstrated below, Claim 18 is shown to be patentable over Kahn and Gutierrez alone and in combination. It is self-evident that the dependent Claims 19-32 and 34 are also patentable over Petitioner's asserted references for at least the same reasons. Petitioner has failed to show that any of Grounds 1 and 2 demonstrate a reasonable likelihood of invalidating any of the Challenged Claims. Institution should consequently be denied under 35 U.S.C. § 314.

A. Level of ordinary skill in the art and claim construction

The Petition does not describe a person of ordinary skill in the art (POSITA), but relegates this task to its Petitioner's expert declaration ("the Wooley declaration"), which describes a POSITA as a person having "at least a bachelor's degree in mechanical, chemical, or electrical engineering, computer science, or a related field and significant experience with remotely controlling fluid-handling devices, like SCADA systems." Ex. 1002, ¶25.

Patent Owner believes a POSITA would have had at least a bachelor's degree in engineering (electrical, chemical, petroleum or mechanical), computer science, or

a related field and at least two years of experience designing control systems for remotely controlling fluid-handling devices, like SCADA systems. Ex. 2009, ¶46. Alternatively, a POSITA would have had at least six years of experience in designing control systems for remotely controlling fluid-handling devices, such as SCADA systems. *Id.*

Patent Owner believes all claim terms should be interpreted in their plain and ordinary meaning. *Id.*, ¶71.

II. THE CHALLENGED CLAIMS ARE PATENTABLE OVER THE TEACHINGS OF KAHN AND GUTIERREZ

A. Multiple claimed elements and limitations of Claim 18 lack any mapping or clear mapping to Kahn in Ground 1

Petitioner asserts the Challenged Claims are (1) anticipated and/or rendered obvious by (1) Kahn alone (Ground 1) and (2) Kahn in combination with Gutierrez (Ground 2) under (pre-AIA) 35 U.S.C. § 102 or § 103. *See* Petition (Paper 2), 9-10 (anticipation or obviousness Ground 1); *id.*, 34 (obviousness Ground 2). Petitioner's assertions are incorrect because, as shown in this section, Kahn and Gutierrez, individually or in combination, fail to teach or suggest several claimed features and do not anticipate or render obvious the whole of Claim 18.

A claim is only unpatentable under § 102 if “each and every element as set forth in the claim is found . . . in a single prior art reference.” MPEP 2131; *Verdegaal*

Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, (Fed. Cir. 1987). And, in *KSR International Co. v. Teleflex Inc.* (“KSR”), the Court reaffirmed the principles of obviousness based on the precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” MPEP 2141; *KSR.*, 550 U.S. 398, 416 (2007). Not only do Grounds 1 and 2 fail to satisfy these legal standards (discussed later in Section III), these grounds do not even *attempt* to identify each claim element and its limitation(s).

In particular, the Petition’s Ground 1 based on Kahn alone either fails to map or provides unclear and/or incorrect element mappings for several limitations among the fourteen claim sections of Claim 18 (parsed [18.1] to [18.14]). And similarly, the Petition’s Ground 2 based on the combination of Kahn with Gutierrez also includes multiple instances of missed element mappings or unclear and/or incorrect element mappings for Claim 18. For brevity, just a handful of these deficiencies are demonstrated below.

1. Kahn and the Kahn-Gutierrez Combination do not disclose, teach, suggest, or render obvious the claimed “first account” and “second account” in [18.10]-[18.12] of Claim 18.

In Ground 1, Petitioner incorrectly maps two accounts in Kahn to Claim 18’s “*first account*” and “*second account*” recited in [18.10]-[18.12], which are accounts specifically “*authorized to send commands to remotely control fluid handling*

devices” for different groups of oil or gas facilities. Notably, Petitioner’s analysis ignores that the accounts must be “*authorized to send commands*.”¹

Kahn does not disclose, teach, or suggest remote control of fluid handling devices or the ability to send commands to such devices. *See* Ex. 2009, ¶83, ¶¶90-91, ¶97, ¶99 (“*Kahn* does not disclose, teach, or suggest remote control”). Rather, Kahn teaches a system and method for accessing, analyzing, and visualizing fluid sensing data from remote sensors. *See* Ex. 1005, title, abstract, 25:3-26:67. Kahn’s system involves user accounts that can be given different levels of authorization for such data viewing activities, which Kahn discloses as “authorized Account A” and “authorized Account B.” *See* Ex. 1005, 25:48-61. Petitioner falsely asserts these accounts in Kahn would correspond to Claim 18’s “*first account*” and “*second account*.”

A careful reading of Kahn shows that Kahn’s accounts A and B, which Petitioner solely relies upon for the claimed “*accounts*” in [18.10]-[18.12], are associated with “fluid test data”—not commands to control devices. *See* Ex. 1005,

¹ Petitioner maps Kahn’s “authorized account A” to the claimed “*first account*” and Kahn’s “authorized account B” for the claimed “*second account*.” *See* Petition, 16-18, stating at p. 16: “Kahn discloses an “authorized account A” for “a first entity” [and] “authorized account B” for “a second entity”.”

25:48-26:67. The only aspect of ‘control’ associated with Kahn’s accounts is the “control [of] access to data generated by their respective sensors.” *Id.*, 25:63-26:2. Put simply, Kahn’s accounts A and B are for providing users the ability to “visualize” the data and “grant authorization” to others, e.g., sharing, providing service fees or contracts, etc. *Id.*, 26:3-61. Thus, Kahn does not disclose nor teach the claimed “*first account*” and “*second account*” in [18.10]-[18.12].

It thereby should come as no surprise that Petitioner does not make any showing in the Petition that Kahn’s accounts A and B are “*authorized to send commands to remotely control fluid handling devices*.” See Petition, 17-18, lacking any statement about “*commands*” or authorizing the sending thereof. It is not just the Petition; Petitioner’s expert also does not even mention any “*authoriz[ation] to send commands*” feature in his analysis of Kahn and arguments for [18.11]-[18.12]. See Ex 1002, ¶¶63-64. Instead, Petitioner appears to conflate controlling access to accounts as taught by Kahn with controlling fluid devices using commands as claimed in the ’871 patent. Importantly, the Petition recognized that these “plurality of accounts” features were stated in the Examiner’s reasons for allowance (Petition, 8 (citing Ex. 1004 at 85-90)), but nevertheless made no showing of these features as having been disclosed, taught, or suggested by Kahn in the grounds.

Ground 2, based on the Kahn-Gutierrez combination, fares no better. Petitioner again fails to provide a proper mapping for Claim 1’s “*first account*” and

“*second account*” to the combination. First, Petitioner makes an unsubstantiated conclusion that “[a] POSITA would recognize” Gutierrez’s ‘accounts’², based on supposed disclosure in Gutierrez about the need for multiple systems and components, to transport fluids through Gutierrez’s conduit system, citing to five paragraphs in the Wooley declaration without citation to a single portion of Gutierrez. *See* Petition, 44-45. *See also* Ex. 1002, ¶¶153-157.³ Contrary to Petitioner’s view, “multiple systems and operational components to transport fluids”⁴ are not accounts—they are hardware at facilities. A POSITA would

² Petitioner incorrectly mapped the “*plurality of accounts*” in [18.3] to Gutierrez’s geographically disturbed fluid-handling facilities, which are not “*accounts*” stored in a datastore as required in the claim. *See* Petition, 38, lines 11-12.

³ Petitioner’s expert asserts that “[a] POSITA would recognize that Gutierrez *inherently discloses* a plurality of accounts” at ¶154 of Ex. 1002 (emphasis added). Not only is Dr. Wooley’s statement unsupported, it is also incorrect, as corroborated by Patent Owner’s expert, Dr. Durham. *See* Ex. 2009, ¶129.

⁴ *See* Petition, 47, stating “A POSITA would recognize that the recited plurality of accounts from the disclosure of Gutierrez, because the system described by Gutierrez requires multiple systems and operational components to transport fluids through the

certainly not recognize anything in Gutierrez that even generally corresponds to user accounts for sending commands to remote devices—let alone the claimed “accounts” recited in [18.10]-[18.12]. Thus, Petitioner failed to map the claimed “*accounts*” to Gutierrez’s teaching.

Then, after this failed mapping to Gutierrez, Petitioner “incorporate[s] by reference” the previous discussion about Kahn’s disclosure pertaining to the specific accounts A and B (*see* Petition, 45), but offers nothing from Gutierrez’s disclosure to compensate for the clear deficiencies of Kahn (discussed above).

Petitioner’s Ground 2 constantly repeats vacuous “[a] POSITA would recognize” conclusory statements⁵ that effectively require Patent Owner and the Board to carry the burden of mapping claim features to Kahn’s and Gutierrez’s disclosures in order to support Petitioner’s obviousness assertion. As shown above,

described conduit system, geographically distributed across the distance for monitoring and controlling fluids transported through the pipeline.”

⁵ Rather than attempt a showing in Kahn or Gutierrez of the claimed features in [18.10]-[18.12], the Petition unsupportively concludes “[a] POSITA would recognize” eight times for these three portions of Claim 18. *See* Petition, 44-47.

for the claimed “*accounts*,” neither Kahn nor Gutierrez teach or suggest the claimed features of [1.8]-[1.10].

2. Kahn and the Kahn-Gutierrez Combination do not disclose, teach, suggest, or render obvious the claimed “user-interface module[s]” in [18.6] of Claim 18.

In Ground 1, Petitioner incorrectly maps a “graphical user interface (GUI)” in Kahn to Claim 18’s “*user-interface module[s]*.”⁶ And, Petitioner fails to provide any mapping to the multiple limitations pertaining to the “*user-interface module[s]*” as required in [18.6]. These failures alone clearly undercut Petitioner’s assertions of anticipation or obviousness by Kahn.

First, a GUI is not a user-interface *module* or a module in general. This fact is evidenced by Petitioner’s own expert, who stated a “GUI is a form of a user

⁶ Petition’s alleged support for Kahn’s disclosure of this claim element provides no discussion of the claim limitations in [18.6] but rather states “Kahn discloses a system that includes a remote computing system with a processor displaying a graphical user interface (GUI) showing data from the system’s sensors. ... Kahn discloses that users log into the system on respective user computing devices. ... Kahn discloses a variety of users and entities having different levels of authorized access.” *See* Petition, 13 (citations omitted).

interface.” See Ex. 1002, ¶53. A GUI can be a result or output of an implementation of a computer-based module, such as the claimed “*user-interface module[s]*.” For example, the claimed “*control interface*” (presented on respective user-computing devices based on instructions sent by the claimed “*user-interface module[s]*”) could be in the form of a graphical user interface. But, a GUI is not a user-interface module. See Ex. 2009, ¶91; see also *id.*, ¶125-126.

Alternatively, if Petitioner intended to map Kahn’s GUI to the claimed “*control interface*” limitation in [18.6], not only is this unclear in the Petition, this is also faulty. Kahn’s GUI provides no “control” capability—only monitoring. See Ex. 1005, 2:48-3:2 (graphical computer interfaces “to visualize information” associated with fluid data). Petitioner effectively recognizes Kahn is limited to monitoring, demonstrated by the Petition and Petitioner’s expert both stating Kahn’s GUI “show[s] data from the system’s sensors,” while providing no example of an actuator control in Kahn. See Petition, 13; see also Ex. 1002, ¶57. Moreover, if mapping Kahn’s GUI to the “*control interface*” was Petitioner’s intention, this leaves nothing in the Petition mapped from Kahn to the “*user-interface module[s]*.” Regardless, either mapping fails to make a showing of anticipation or obviousness.

This failure is further compounded for the limitations in [18.6] of Claim 18. The Petition and the Wooley declaration are totally silent on what in Kahn corresponds to the claimed “*respective instructions*” that the “*user-interface*

module[s]” is/are configured to send. Also, for that matter, Petitioner fails to explain what in Kahn corresponds to the claimed “*commands*” that the “*user-interface module[s]*” is/are configured to receive. Other than a vague mention of “communication equipment” (as part of Kahn’s sensor unit 110) in the Petition⁷, Petitioner posits nothing even remotely related to the “*instructions*” and “*commands*” limitations in [18.6].

Therefore, Petitioner’s anticipation or obviousness assertions for [18.6] are incoherent and completely lack any underlying support in Kahn.

In Ground 2, the same fatal flaw is repeated for Gutierrez. Again, Petitioner points to a GUI, i.e., Gutierrez’s “GUI 315,” in the Petition’s discussion of the claimed “*user-interface module[s]*” and its limitations. *See* Petition, 41-42. First, as discussed above, a GUI is not a ***module*** and thus cannot map to a user-interface module. And, like discussed above, if Petitioner is mapping Gutierrez’s GUI to the claimed “*respective control interfaces*” to be presented on the “*respective user-computing devices*,” then the Petitioner provided no mapping to the claimed “*user-interface module[s]*.”

⁷ *See* Petition, 14; *see also* Ex. 1002, ¶54.

Gutierrez is silent about a user-interface module in general. The disclosure of Gutierrez teaches software located on computer 305 used to present GUI 315, but does not teach or suggest *sending instructions with processor(s) implementing a user-interface module to a user computing device* (e.g., Gutierrez's computer 305) to present a user interface (e.g., Gutierrez's GUI 315) or to receive commands from such user computing device. *See* Ex. 2009, ¶¶125-126. Gutierrez's lack of teaching of a user-interface module explains Petitioner's lack of mapping of this feature to Gutierrez's disclosure.

Thus, Gutierrez does not teach or suggest the claimed “*user-interface module[s]*” and related limitations, nor does Gutierrez compensate for Kahn's aforementioned deficiencies of [18.6]—which Petitioner does not argue anyway.

3. Kahn and the Kahn-Gutierrez Combination do not disclose, teach, suggest, or render obvious the claimed system feature of “receiv[ing], with the user-interface module or modules, a user command to actuate an actuator entered via a presented control interface” in [18.7] of Claim 18.

In [18.7] of Claim 18, the claimed “*user-interface module[s]*” is further invoked in the claimed method for receiving a user command to actuate an actuator via a presented control interface. Thus, the method requires the “*user-interface module[s]*” to be involved with the user command for actuating an actuator that is presented on the control interface. Neither Kahn nor Gutierrez disclose or teach this.

For Ground 1, the Petition and Petitioner's expert make no showing of these claimed features in Kahn. Instead, Petitioner reverts back to Kahn's GUI again, noting that the GUI *displays* data from the sensors, which include communication equipment to communicate with actuators (citing over ten sections in Kahn). *See* Petition, 14. Yet none of the Petitioner-cited sections in Kahn actually disclose or collectively teach receiving a user command for actuating an actuator that is presented on a user interface because Kahn does not teach user command-based control of the fluid monitoring equipment in Kahn's system. *See* Ex. 2009, ¶95.

Petitioner mischaracterizes Kahn as having “actuators configured to manipulate fluid flow at respective fluid-handling facilities[and] to facilitate the measurement of data requested through the graphical user interface,” citing to 10:62-67 and to 14:35-15:2, 15:62-16:32 of Kahn. *See* Petition, 14. However, Kahn's disclosure at these cited sections merely pertain to sending alerts or carrying out local shut-off of valves and to using actuators to reposition the fluid sensors, respectively. *See* Ex. 2009, ¶84. For instance, Kahn teaches communicatively interfacing the sensor units 110 with “on-site alerts such as optical[, audible[, and] tactile” alerts and physically placing the sensor units 110 at control valve locations for shutting off the supply of fluid upon the detection of emergency events. *See* Ex. 1005, 10:62-67; *also see id.*, 11:1-15, 20:58-67, 35:58-67. A POSITA would have understood that Kahn's system utilized alerts to inform users at the site to

handle detected events or to automatically shut off fluid devices based on alarm thresholds or local control—not remote control of actuator equipment based on user commands like in the '871 patent. Ex. 2009, ¶84.

In fact, Kahn's only disclosure of an actuator is at 14:35-15:2 and 15:50-16:32 (notably, cited by Petitioner), which describes an actuator mechanism that moves sensors toward the fluid that the sensors are to sense. That is, Kahn's actuators are for *positioning the sensors*—not actuating fluid control. None of Petitioner's "[a] POSITA would recognize" statements in the Petition or the Wooley declaration can fill in the numerous and large gaps in Kahn's disclosure with respect to the limitations in [18.7].

Kahn clearly lacks the requisite disclosure to teach the claim limitations in [18.7], and therefore Ground 1 fails.

Ground 2 suffers similar problems. As discussed above for [18.6], Gutierrez does not disclose or teach a user-interface module. So, it simply follows that Gutierrez cannot teach or suggest receiving a user command *with* a user-interface module[s] for actuating an actuator that is presented on a user interface. While Gutierrez teaches user control, via GUI 315, of components in Gutierrez's chemical injection system 310 based on received data (*see* Ex. 1006, 13:9-26), Gutierrez does so over a private network that is does not involve a user-interface module like that claimed. *See* Ex. 2009, ¶¶105-106, ¶¶114-115.

And it follows that because Gutierrez does not teach or suggest the claimed “*user-interface module*,” the Petition and Petitioner’s expert do not make any mapping of this feature to Gutierrez. The Petition merely refers to Gutierrez’s disclosure about the GUI receiving user commands for sending to a fluid handling system, but does not point to anything in Gutierrez about how that process is carried out. Instead, the Petition provides a copout argument that “[a] POSITA would recognize” the steps carried out by a user interface module without any citation to Gutierrez’s actual disclosure. *See* Petition, 42-43. Instead, the Petition cites to the Wooley declaration, which makes its own “[a] POSITA would recognize” conclusory statement that Gutierrez discloses a user interface module based on the Gutierrez’s disclosure about the GUI. *See id.*; *also see* Ex. 1002, ¶146. This is the same faulty argument discussed above. Gutierrez does not disclose, teach, or suggest a user-interface module like that claimed in the ’871 patent, and Petitioner has made no showing otherwise. Nor does Kahn, which Petitioner did not mention in regards to [18.7] in Ground 2.

Thus, the Kahn-Gutierrez combination fails to teach [18.7].

4. Several additional claim elements and limitations of Claim 18 are not disclosed or taught by Kahn and the Kahn-Gutierrez Combination.

The Petition fails to properly map several other claim elements and limitations in addition to those discussed above from [18.10]-[18.12], [18.6], and [18.7] of

Claim 18. For instance, in both Grounds 1 and 2, Petitioner fails to provide a mapping of the claimed “*addresses*” of [18.4] to anything relevant in Kahn’s disclosure—instead pointing to Kahn’s sensor unit 110, which is at odds since the claimed “*addresses*” that is stored among the claimed “*records*,” and pointing to nothing in Gutierrez. *See* Petition, 11-12 and 38-40; *see also* Ex. 1002, ¶¶47-50, ¶141. Also, for example, the claimed “*network connections*” limitation is completely missing in Petitioner’s discussion of Kahn and Gutierrez for [18.4] of Claim 18. *Id.* Further examples of incorrect or missed mappings include the claimed limitation in [18.5] of the “*facility-interface module[s]*” to “*send commands to the actuators*,” which, in Ground 1, Petitioner points to Kahn’s disclosure of alerts and actuators that lacks teaching or suggestion of *sending commands*. *See* Petition, 13; *see also* Ex. 1002, ¶¶51-52. Also, Petitioner fails to map anything in Kahn or Gutierrez to the claimed limitation in [18.8] of “*identifying ... an address ... corresponding to a facility at which the actuator is located*,” and instead handwaved an unsubstantiated conclusion that “[a] POSITA would recognize” this feature without citation to Kahn or Gutierrez. *See* Petition, 15 and 43; *see also* Ex. 1002, ¶58 and ¶147-148.

Claim 18 cannot be anticipated by or obvious to Kahn or obvious to the Kahn-Gutierrez combination when there are numerous claim elements and limitations absent in the cited references. The fact that the Petition does not identify multiple

claim features in the references is indicative of the references' individual and collective lack of teaching. Claim 18 is clearly patentable over Kahn and Gutierrez, and therefore its dependent claims are too. Thus, *inter partes* review of the '871 patent is unwarranted.

III. THERE IS NO MOTIVATION TO COMBINE KAHN AND GUTIERREZ

There is no motivation to combine Kahn and Gutierrez because the systems and methods of Kahn and Gutierrez are fundamentally different. *See* Ex. 2009, ¶¶105-115. Kahn is directed to displaying, in a web application, sensor data collected at water handling sites belonging to different entities, without any capability for remote control of the equipment at the handling sites. Gutierrez is a completely different type of system that has both monitoring and control capabilities of fluid handling devices, but through a private network that is not web-based at all. *See* Ex. 2009, ¶105. While Gutierrez's disclosure notes that Gutierrez's system may communicate on "a portion of the global computer network known as the Internet" (Ex. 1006, 12:53-64), Gutierrez makes it clear that this is through the use of a virtual private network (VPN), rather than a web browser-based system as disclosed by

Kahn. *See* Ex. 2009, ¶106. While the Internet⁸ facilitates both VPN and the World Wide Web (known as the “web”), they are completely different networks.

As Dr. Durham discusses in his expert declaration, VPN is a technology that, in addition to keeping a user's identity private and anonymous, allows a user to “tunnel” through the Internet and log in to a private network (such as an enterprise or secure network) as if the user was physically present and connected to the network. Ex. 2009, ¶106. The World Wide Web is a service that displays information on ‘pages’ in a web browser using the hypertext transfer protocol (HTTP), allowing anyone with Internet access to vast amounts of information stored on public web servers or other web data storage structures. Ex. 2009, ¶108-109. A VPN utilizes the physical infrastructure of the Internet to establish a private network, but unlike the web, information is not stored on public web servers or similar structures and instead on private servers that are not accessible to anyone outside of authorized users. *See* Ex. 2009, ¶107; *see also id.*, ¶¶109-111. Thus, as Dr. Durham has stated, there is a “distinction between a private network, such as a VPN, and a

⁸ The Internet is the physical structure of a global network linking various computers. Ex. 2009, ¶108.

web-based system [that] is important in understanding the technology behind references such as Kahn and Gutierrez, as well as the '871 Patent.” Ex. 2009, ¶110.

Thus, for a POSITA to be motivated to combine the technologies of Kahn and Gutierrez, the POSITA would need to make significant changes to one or both systems to even attempt to harmonize their differences. As Dr. Durham attests, “turning over control of industrial processes [like in Gutierrez] to web-based systems [like in Kahn] was a vastly different endeavor.” See Ex. 2009, ¶111. For instance, a POSITA would have had to modify the core communication architecture of Gutierrez's system with Kahn's web approach, which would constitute a change in its principle of operation. This is contrary to obviousness. As MPEP 2143.01.VI states, “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious,” citing *In re Ratti*, 270 F.2d 810, 813 (CCPA 1959).

In addition to critical and fundamental modifications, the implications of such a combination would dissuade a POSITA from making such modifications. Notably, as Dr. Durham explains, the security risks of Petitioner's hindsight-created Kahn-Gutierrez combination would be very significant. For instance, if an unauthorized user accessed Kahn's system, that intruder would become aware of water quality information at various locations, which constitutes a security breach, but likely poses

no physical danger to the system as Kahn lacks any remote control. In contrast, unauthorized access to Gutierrez's system poses extreme risk due to its control capability, which could result in production loss from the various facilities to far worse, such as terrorism. *See* Ex. 2009, ¶112. This is why, prior to the '871 patent, no such system or method as Claim 18 was shown in prior art, and why Kahn and Gutierrez both are starkly different in their architectures and functionalities.

Petitioner posits no meaningful reasons why a POSITA would combine the teachings of Kahn and Gutierrez. Petitioner's arguments can be distilled to three mirrored⁹ conclusory statements in the Petition and the Wooley declaration. First, Petitioner argues it "would have been obvious to try" (alleging both Kahn and Gutierrez describe similar systems for remote monitoring and control of fluid handling). *See* Petition, 34, line 14 to 35, line 15. *See also* Ex.1002, ¶¶120-125. Next, Petitioner argues a POSITA's motivation to combine would be drawn from presumed desire to "achieve the security, efficiency, and safety benefits" that Petitioner argues would be gained in Gutierrez's system due to Kahn's user access

⁹ Petition and the Wooley declaration are a simple 'copy-paste job' of each other for the "Motivation to Combine Gutierrez and Kahn" section. *Compare* Petition, 36-38 with the Wooley declaration (Ex. 1002), ¶¶124-128.

differentiation. *See* Petition, 35, line 16 to 36, line 1. *See also* Ex.1002, ¶126. Finally, Petitioner argues the combination “would lead to predictable results” with no difficulty because “Gutierrez and Kahn do not describe alternative systems or methods, but rather the disclosure of Kahn merely provides additional detail.” *See* Petition, 36, lines 2-8. *See also* Ex.1002, ¶127-128.

Petitioner's arguments for alleging motivation to combine fall flat because they are not based on the actual knowledge and skill level of a POSITA at the time of the '871 patent and do not address, let alone overcome, the incompatibilities between Kahn's and Gutierrez's respective approaches. Moreover, Patent Owner's expert, Dr. Durham, has reviewed and considered Petitioner's motivation to combine Gutierrez and Kahn and concluded that it is “simply wrong.” *See* Ex. 2009, ¶105. Unlike Petitioner, Dr. Durham substantiates his expert opinion with thorough analysis of the references' respective teachings.

All in all, a POSITA would have multiple reasons not to combine Kahn and Gutierrez if attempting to create a system like Claim 18 of the '871 patent. Because there is no motivation to combine, Ground 2 necessarily fails.

IV. PETITION FAILS TO MEET MULTIPLE LEGAL REQUIREMENTS OF UNPATENTABILITY

A. Ground 1 fails to delineate between § 102 and § 103 arguments and fails to properly assert either category

For Ground 1, the Petition asserts unpatentability under both the anticipation standard of § 102 and the obviousness standard of § 103 but fails to fully or clearly articulate either theory. *See* Petition, 9-10. Due to this lack of clarity, the grounds of the Petition are substantively deficient and noncompliant with 35 U.S.C. § 312(a)(3),¹⁰ and therefore institution of *Inter Partes* Review should be denied.

For anticipation under § 102, Petitioner fails to map each element of the claim to Kahn's disclosure, as described above, so any § 102 argument fails from the start.

For obviousness under § 103, not only does Petitioner fail to show the requisite teaching or suggestion in the prior art of each claimed feature, Petitioner fails to explain any reasoning for why any claim would be obvious within the framework for objective analysis articulated in *Graham v. John Deere Co.*, 383 U.S.

¹⁰ 35 U.S. Code § 312(a) Requirements of Petition.—A petition filed under section 311 ***may be considered only if***— . . . (3) the petition identifies, in writing ***and with particularity***, each claim challenged, ***the grounds on which the challenge to each claim is based***, and the evidence that supports the grounds for the challenge to each claim, . . . (emphasis added)

1 (1966) and reiterated in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The court has “repeatedly emphasized that an obviousness inquiry requires examination of all four *Graham* factors and that an obviousness determination can be made only after consideration of each factor.” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016).

Here, for every claim element of the challenged claims in Ground 1 using Kahn, the Petition lacks any articulation of the second *Graham* factor (ascertaining the differences between the claimed invention and the prior art). While arguing such differences risks undercutting Petitioner’s anticipation arguments, Petitioner in this case chose to avoid taking the risk at the expense of ignoring the legal standard of obviousness. The Petition uses boilerplate language to assert the dual anticipation-obviousness theory and follows a robotic pattern. Specifically, the Petition recites the limitation, lists paraphrased disclosure from the reference, then presents a conclusory statement for each element and claim that “[a] POSITA would recognize.” *See, e.g.*, Petition, 19. The Petition lacks any explanation as to *why* the prior art disclosure would render a limitation obvious to a POSITA. These boilerplate assertions of anticipation and obviousness do not fully articulate either invalidity theory.

These improper grounds not only require Patent Owner to respond to multiple incomplete arguments but also impel the Board to analyze multiple unarticulated

invalidity grounds under multiple legal standards. The gaps in Petitioner's claim mapping (discussed above) raise doubts that any § 102 argument was made in good faith. Yet Patent Owner is forced to respond to both anticipation and obviousness arguments, despite neither theory being sufficiently explained for Patent Owner to appropriately rebut. The Board is also burdened with sifting through Petitioner's positions to look for hidden obviousness assertions. While the Petition includes no credible obviousness explanations, Petitioner has improperly shifted the burden to the Board and to Patent Owner.

Accordingly, the Petition has failed to conduct the proper anticipation and obviousness analyses, which warrants denial of institution of this IPR.

B. Ground 2 fails to properly assert § 103 arguments

Like Ground 1, the Petition also lacks any articulation of the second *Graham* factor in Ground 2 for the combination of Kahn and Gutierrez. First, the Petition's element-by-element analysis in Claim 18 does not even mention Kahn in any way for [18.1]-[18.9]. *See* Petition, 36-44. Instead, Petitioner presents only a perfunctory and error-plagued mapping of Gutierrez's disclosure to these claimed features. *Id.* Moreover, Petitioner makes a vague and inoperable claim of "incorporate[ing] by reference" Kahn's disclosure "into each challenged claim [in Ground 2]." *See* Petition, 45. Yet, clearly missing in Petitioner's obviousness assertions is what is different between the claimed elements/limitations and Kahn and/or Gutierrez.

Conversely, Section II of this paper, above, identifies several differences between the claimed invention and the cited references, which Patent Owner contends are both profound and too numerous for a POSITA to determine the claims as obvious to a combination of Kahn's and Gutierrez's teachings.

Petitioner's neglect of the obligation to present a proper case for obviousness in accordance with the law should not be disregarded.

C. Ground 2 fails because Gutierrez is not prior art

Ground 2 relies on Gutierrez as prior art in its combination with Kahn for its obviousness ground. However, Gutierrez is not prior art under any subsection of 35 U.S.C. § 102, leaving Ground 2 effectively nullified.

The Petition cites U.S. Patent No. 9,709,995 B2 (referred to as "Gutierrez") as prior art under "pre-AIA §§ 102(a) and 102(e)." *See* Petition, 9. Gutierrez cannot be § 102(a) prior art because this document's publication date is July 18, 2017 (issue date), nearly four and a half years after the '871 patent's priority date of December 7, 2012. And, Gutierrez cannot be prior art under § 102(e) because ***Gutierrez's priority chain was broken*** at the time of Gutierrez's filing due to Gutierrez's parent application having gone abandoned.

Gutierrez is the U.S. patent issued from U.S. Application No. 14/579,141 ("the '141 Application"), which was filed December 22, 2014 as a continuation of U.S. Application No. 12/794,898 ("the '898 Application"), which was filed June 7,

2010. The '898 Application went abandoned on October 31, 2014 after the applicant failed to reply to an Office Action¹¹ within the fixed statutory period. *See* MPEP 711.04(a) (“the date of the abandonment is after midnight of the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired. This is normally the end of the 3-month shortened statutory period.”). *Also see* MPEP 711.02 (citing 37 CFR 1.135(a): “[i]f an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise”).

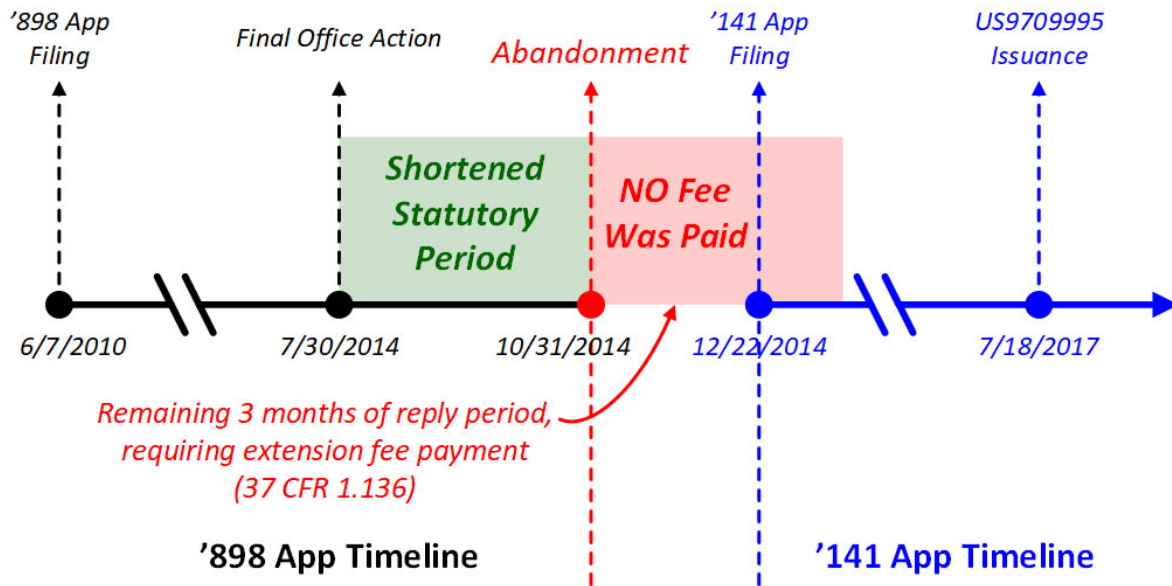
The applicant of the '898 Application did not pay an extension fee in accordance with § 1.136 between expiration of the shortened statutory period (October 31, 2014) and the filing of the '141 Application (December 22, 2014); and there was no further “Office action” indicating otherwise.¹² Ex. 2006, Ex. 2007. The diagram below illustrates these events chronologically.

¹¹ The '898 Application received a Final Office Action dated July 30, 2014, to which no response was filed and no extension fees were paid after the three-month shortened statutory period expired. *See* Ex. 2006, 199.

¹² The only action by the U.S. Patent and Trademark Office after the July 30, 2014 Final Office Action was the Notice of Abandonment of the '898 Application, which was mailed on February 4, 2015.

Gutierrez Timeline

(drawn to scale as best possible)



As the above diagram shows, the '141 Application (which issued as Gutierrez) was filed after the parent '898 Application was abandoned. Therefore, the '141 Application (and thereby the U.S. patent that issued as Gutierrez) is only entitled to a priority date of December 22, 2014, which is after the December 7, 2012 priority date of '871 patent.

The consequence of the applicant's non-responsiveness to the Office Action within the shortened statutory period for reply rendered the '898 Application abandoned, and any continuation application filed after abandonment, i.e., the '141 Application that resulted in the Gutierrez patent, is not entitled to an earlier priority date for failing the copendency requirement of 35 U.S.C. § 120. *See Urologix, Inc.*

v. Prostalund AB, 227 F. Supp. 2d 1033, 1035-1040 (E.D. Wis. 2002). The *Urologix* court also made clear that the burden is on the applicant to have “evidence” of the extension of time. *Id.*, 1038. Here, like in *Urologix*, the record shows no payment or petition for an extension of time after expiration of the shortened statutory period for the '898 Application (*see* Ex. 2006), thus cementing its abandonment immediately after the period's three-month duration elapsed.¹³

Thus, Gutierrez's actual priority date is December 22, 2014, more than two years after the '871 patent. Ground 2 therefore fails because Gutierrez is not prior art. Notably, Patent Owner, in the Discretionary Denial Brief (Paper 7), provided similar analyses regarding Gutierrez's lack of eligibility as prior art. *See* Paper 7, 17-20. Petitioner's complete silence in addressing Gutierrez's status as prior art in its Discretionary Denial Opposition Brief (Paper 8) strengthens Patent Owner's position, which is based on straightforward assessment of the facts, and remains un rebutted.

¹³ Patent Center website for the '898 Application shows no evidence of payment or petition for an extension of time after the July 30, 2014 Final Office Action: <https://patentcenter.uspto.gov/applications/12794898/ifw/docs?application=>

See also, Ex. 2008, which shows screen captures of the Documents and Transactions listing for the '898 Application.

V. CONCLUSION

For the reasons discussed above, Patent Owner respectfully requests that the Board deny Petitioner's Petition for *Inter Partes* Review of the '871 patent.

Dated: July 16, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 CFR § 42.24(d)

Under 37 C.F.R. § 42.24(d), the undersigned certifies that the word count for this Patent Owner's Preliminary Response to the Petition for *inter partes* review totals 6,360 words, excluding the parts exempted by 37 C.F.R. § 42.24(a). The word count was made using the built-in word count function in the Microsoft® Word software used to prepare this document.

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served a true and correct copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE and accompanying exhibits by email to the electronic service addresses for Petitioner on the date indicated below:

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