IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TANKLOGIX, LLC,
Petitioner,

v.

SITEPRO, INC.,
Patent Owner.

U.S. Patent No. 11,175,680
Case No.: IPR2025-00651

SITEPRO, INC.'S BRIEF FOR DISCRETIONARY DENIAL

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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 *SitePro, Inc. v. TankLogix, LLC*, 6:24-cv-00642-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-00642-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, *SitePro, Inc. v. TankLogix, LLC*, 6:24-cv-00642-XR-DTG, Dkt. 33
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

I. Introduction

Under the *Interim Process for PTAB Workload Management Memorandum* (the "Memorandum") issued on March 26, 2025, the decision whether to institute an *inter partes* review is bifurcated between: (i) discretionary denial; and (2) merits and other non-discretionary statutory decisions. Pursuant to the Memorandum, Patent Owner, SitePro Inc., requests that the Board discretionarily deny TankLogix's Petition for *Inter Partes* Review of U.S. Patent No. 11,175,680 (the "'680 patent") for the reasons below.

In short, discretionary denial is warranted here for several reasons. First, the schedule in the district court proceeding will require the court to evaluate many of the same validity questions raised here regardless of the Board's institution decision. The district court litigation will be nearly complete before any written decision would issue from the Board as to this challenge, and will be fully complete before any Board decision as to IPR 2025-00761, challenging a related continuation patent. The Petition is also substantively flawed and severely lacking in merit. It fails to distinguish between § 102 and § 103 challenges and fails to identify any prior art disclosures for several claim limitations in the challenged patent. Furthermore, several of the references relied upon in the Petition either do not qualify as prior art or were already considered by the Patent Office during the prosecution.

Therefore, the totality of circumstances strongly favor discretionary denial of the Petition.

II. The *Fintiv* Factors Favor Denial

As established in the precedential case of *Apple v. Fintiv*, the Board considers six factors when exercising its discretion to deny an *inter partes* review in view of a parallel proceeding. *Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Those factors are: (1) whether the district court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the district court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits. *Id*. Here, there is a parallel district court proceeding pending in the United States District Court for the Western District of Texas between SitePro, Inc. and Petitioner TankLogix, LLC. The case is *SitePro, Inc. v. TankLogix, LLC*, 6:24-cv-00642-XR-DTG (the "District Court Proceeding"), and has been assigned to District Court Judge, Xavier Rodriguez. As discussed below, the *Fintiv* factors weigh in favor of the Board denying institution in view of the District Court Proceeding.

A. The evidence is unclear as to whether the district court is likely to grant a stay.

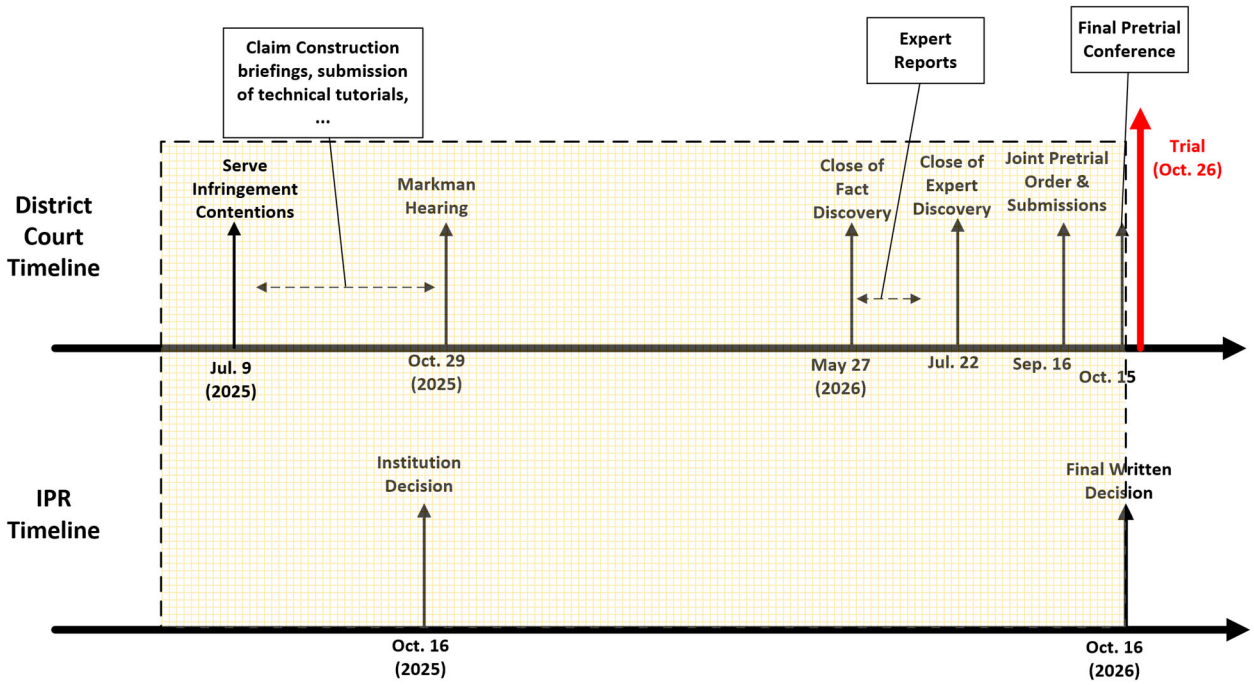
Petitioner has sought a stay in the District Court Proceeding, and to date, the district court has not issued a decision. While Judge Rodriguez has not previously ruled on any contested motions to stay pending IPR (Ex. 2001)[1], SitePro has opposed the motion to stay (Ex. 2005), which is expected to significantly reduce the likelihood of a stay. Therefore, this factor likely favors Patent Owner, but conservatively, it can be considered neutral.

B. The district court trial will begin only days after the Board's statutory deadline to issue a final written decision.

When the district court's trial date is earlier than the expected statutory deadline for Board's final written decision, "the Board generally has weighed this fact in favor of exercising authority to deny institution." *Fintiv*, IPR2020-00019, Paper 11 at 9. Here, the statutory final written decision deadline is October 16, 2026.

[1] In Ex. 2001, the option "Postures of Motion: Motion by a Party" is used in Docket Navigator to filter the results to only display opposed motions. Ex. 2001 shows Judge Rodriguez did not grant any opposed motions for stay pending IPR. Removing this filter would show that Judge Rodriguez has previously granted several motions for stay pending IPR when the motion was stipulated to by both parties (not relevant here).

In the District Court Proceeding, the final pretrial conference is set for October 15, 2026, with trial set to begin October 26, 2026, *See* Ex. 2002. Although this trial date falls slightly after the final written decision deadline, essentially all of the effort and resources required to litigate validity in district court would have been spent before the final written decision date, as illustrated in the below diagram. *Id*.



Comparison of District Court and IPR Timelines
(Drawn to scale as best possible)

As illustrated above, the two proceedings would have a significant amount of overlap, and all pretrial activities, including claim construction, fact discovery, expert discovery, and dispositive motions would be complete, with the parties only awaiting the trial itself, scheduled to begin 10 days after the final written decision deadline. As such, any IPR decision would provide little simplification to the district

court, and not only would the two proceedings continue at the same time, but the parties would also be likely litigating duplicative and overlapping issues in parallel, consuming unnecessary resources for both the parties, the district court, and the Board.

The petition argues that "[t]he expected trial date based on the court's median time-to-trial date statistics is approximately September 2027." Petition (Paper 1) at 65. But this statistic is now irrelevant since, after the filing of the Petition, the district court set a trial date for October 26, 2026. And, there are no situations in connection with the case that would merit the district court moving the trial date.

Because nearly all litigation work in the District Court Proceeding would be complete before issuance of a final written decision, with the trial to follow less than two weeks later, this factor favors discretionary denial.

C. The parties and the court have invested substantial resources in the district court case.

The District Court Proceeding was filed on December 20, 2024. Since that time, the parties have invested substantial resources in the case. Patent Owner has completed and served its initial infringement contentions on Petitioner. *See* Ex. 2003. Further, by the October 16, 2025 institution deadline, the parties will have

fully briefed their claim construction arguments, with the *Markman* hearing set for October 29, 2025.

Thus, this case is not at the very early stages of litigation, and it will be even further along by the Institution Deadline. Thus, this factor favors discretionary denial.

D. There is substantial overlap between the issues raised in the Petition and the parallel District Court Proceeding.

All claims challenged in this Petition are also at issue in the District Court Proceeding. Petitioner had initially stated that if the petition is instituted it will not pursue the same grounds for the '680 patent in the district court, per *Sand Revolution*, arguing that "the Grounds presented in the instant IPR will be materially different from the grounds that will be presented in the district court," and this factor therefore favors institution. Petition (Paper 1) at 66. Petitioner has further recently filed what appears to be a *Sotera* stipulation in the IPR, stating that Petitioner will not pursue in litigation "any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications," and "in the Litigation, [it will] not rely on any product or system art that is 'based on the same evidence presented' in this IPR." Ex. 1009.

As an initial matter, Petitioner's *Sotera* stipulation does not foreclose the possibility that Petitioner could pursue other invalidity challenges in the District

Court Proceeding, including those based on prior art systems that are not based on the references used in the IPR. Furthermore, the Petition states "that if the IPR is instituted, Petitioner will not pursue the same grounds for the **'909 patent** in the district court litigation"—not the grounds for the '680 patent. Petition (Paper 1) at 66 (emphasis added). Petitioner has in fact filed a stipulation, which only references another IPR (the one filed against the '909 patent) - "the specific grounds [asserted in IPR2025-00647]" (Ex. 1009 at 2) - and not the instant IPR2025-00651, which includes additional prior art references.

Petitioner's statements further ignore the timeline of the District Court Proceeding. Notably, Petitioner's *Sotera* stipulation is conditioned on the Board instituting review—a condition that may not be resolved until October 16, 2025. In the meantime, Petitioner's preliminary invalidity contentions will be due in the District Court Proceeding in July of 2025, and the parties will complete claim construction briefing by October 15, 2025. *See* Ex. 2002. While Petitioner awaits the Board's institution decision, Petitioner in fact will be *required* to raise overlapping invalidity grounds in the District Court Proceeding or waive them, and the parties will have to account for those overlapping grounds during the claim construction phase, requiring significant duplication of effort. In effect, the district court schedule eliminates much of the resource savings a *Sotera* stipulation might otherwise

provide, and in this case, renders it largely meaningless. Thus, this factor weighs in favor of exercising discretion to deny institution.

E. Petitioner and the defendant in the parallel District Court Proceeding are the same party.

Where the petitioner and the defendant in the parallel proceedings are the same party, this factor favors denial. *See Sotera Wireless, Inc. v. Masimo Corp*., IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to §II.A); *see also Comcast Cable Communications, LLC v. Touchstream Technologies, Inc*., IPR2024-00324, Paper 13 at 15 (PTAB July 24, 2024). Here, the parties in this proceeding and in the District Court Proceeding are the same. Indeed, Petitioner is the defendant in the District Court Proceeding. Thus, this factor weighs in favor of discretionary denial.

F. There are no other circumstances that would disfavor denial.

As discussed above, *Fintiv* factors 2–5 weigh in favor of denial, with factor 1 being neutral (or favoring Patent Owner). Petitioner's only additional argument under Factor 6 is that "the evidence of unpatentability is compelling, as evidenced by Grounds laid out [in the Petition]." Petition (Paper 1) at 66. On the contrary, Petitioner's Grounds crumble even under a cursory review and are significantly flawed when examined closely. While those shortcomings are described in more

detail in the forthcoming Patent Owner Preliminary Response,[2] the following provides a few highlights that illustrate significant deficiencies of the Petition.

1. The purported § 102 arguments in each Ground fail to account for all elements of the challenged claims.

Each Ground of the Petition argues that its primary reference anticipates the majority of the challenged claims under 35 U.S.C. § 102. Petition (Paper 1) at 12 (Ground 1), 32 (Ground 2), 51 (Ground 3), 59 (Ground 4). A claim, however, 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). Not only do Petitioner's Grounds fail to satisfy this standard, they do not even *attempt* to identify each claim limitation.

In particular, ***Ground 1***, based on U.S. Patent No. 8,667,091 to Almadi ("Almadi"), either fails to map or provides unclear or incorrect element mappings for at least ***three*** limitations among the eight claim sections of Claim 1 (parsed 1[pre] to 1[g]).

[2] *See* Q25 in FAQs for Interim Processes for PTAB Workload Management (https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management), stating that "a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits."

Similarly, ***Ground 2***, based on U.S. Patent Application No. 2015/0308244 to Cardamone ("Cardamone"), includes at least ***three*** instances of missed element mappings or unclear or incorrect element mappings for Claim 1.

Ground 3, based on U.S. Patent No. 9,709,995 to Gutierrez ("Gutierrez"), also includes at least ***five*** instances of missed element mappings or unclear or incorrect element mappings for Claim 1.

Ground 4, based on SCADA: Supervisory Control and Data Acquisition, 4th Edition ("SCADA"), also includes at least ***four*** instances of missed element mappings or unclear or incorrect element mappings for Claim 1.

For instance, in Ground 1, Petitioner fails to cogently map Claim 1's "*controller accesses a sensor to measure a fluid being handled by the fluid-handling device*." Ground 1's only cited disclosure in Almadi as to this limitation is Petitioner's assertion that "the integrated node 300 acquires data, including subsurface sensor and subsystem data, from the remote subsystem." Here, it appears to suggest the integrated node 300 is Claim 1's server. But elsewhere within Claim 1, Petitioner maps the same integrated node to Claim 1's server, a totally different component. Petition (Paper 1), at 14.

Yet even more egregious, Petition in Ground 1 provides no mapping in Cardamone to the claimed "*target value*" feature of 1[c]. Where Claim 1 requires "*sending, with the server, the target value to the network address via the network*,"

where the network address identifies a controller of fluid-handling devices, the Petition points to the transmission of "process data to a remote host server." Petition (Paper 1), at 15. But process data is not a target value, and a remote host server is not a controller. Petitioner then resorts to an "[a] POSITA would understand" argument that is not substantiated. *See* Petition (Paper 1) at 15.

Similarly, Ground 3, based on Gutierrez, fails to provide any mapping for Claim 1's "*determining, with the controller, whether the measurement satisfies the target value*." For this limitation, Petitioner points to Gutierrez's disclosure of "monitoring and control equipment including sensors configured to measure fluid handled at respective fluid-handling facilities." Petition (Paper 1) at 55. But this limitation doesn't describe measuring; it requires determining whether the measurement satisfies a target value. Petitioner fails to identify any disclosure in Gutierrez for this determining step. Similarly, Petitioner fails to provide disclosure for Claim 1's "obtaining" step, which requires "*obtaining, with the controller, a set point based on the command*." Instead, Petitioner cites the same sections of Gutierrez as for the determining step, none of which disclose obtaining a set point based on the command. Petition (Paper 1) at 56. For most of the claim limitations, Petitioners conclude with a statement that "*a POSITA would recognize*" without any further citation to the reference, instead referring to Petitioner's expert declaration (e.g.,

citing Ex. 1002), which similarly lacks any citations to the reference regarding the claim limitations. *Id*.

As for Ground 4, Petitioner maps Claim 1's "sending, with the server, the target value to the network address via the network" (e.g., sending a target value from the server to the local controller) to SCADA's disclosure of sending information the other direction—from field devices to the master terminal unit (the remote terminal unit "must put together a message that includes all of the information requested by the [master terminal unit]." Petition (Paper 1) at 62.

As these isolated examples illustrate, the merits of the Petition are far from compelling, and these examples are far from exhaustive. The Board has previously discretionarily denied Petitions with weak invalidity grounds that could only meet the "reasonable likelihood of prevailing" threshold for a handful of claims ("RLP claims"). For instance, the Board has exercised its statutory discretion elucidated by the court in *SAS Inst. v. Iancu*, 138 S. Ct. 1348 (2018) on multiple occasions. *See*, IPR2018-00923, *Chevron Oronite Company LLC v. Infineum USA L.P.*, Paper 9, Institution Decision at 10-11, and IPR2018-01310, *Deeper, UAB v. Vexilar, Inc.*, Paper 7, Institution Decision at 42-43, both denying institution despite two RLP

claims for "not [being] an efficient use of the Board's time and resources."[3] Here the Petition fails to meet the threshold for ***any*** claim, which strongly favors discretionary denial.

2. The Grounds fail to delineate between § 102 and § 103 arguments or properly assert either category.

Each Ground of the Petition appears to assert 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 (Paper 1) at 12 (Ground 1), 32 (Ground 2), 51 (Ground 3), and 59 (Ground 4). Due to this lack of clarity, the grounds of the Petition are substantively deficient and noncompliant with 35 U.S.C. § 312(a)(3),[4] thereby favoring discretionary denial.

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[3] *See* Q9 in FAQs for Interim Processes for PTAB Workload Management (https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management), stating that "the Board panel will not address discretionary considerations, except where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources, as explained in *Chevron* … and *Deeper* … ."

[4] 35 U.S. Code § 312 – Petitions

(a) Requirements of Petition.—A petition filed under section 311 ***may be***

As for § 102, the Petition fails to map each element of the claim to the disclosures in the cited prior art reference, as described above, so any § 102 arguments fail from the start. As for § 103, the Petition adds nothing but bare "a POSITA would understand" arguments to support its obviousness claims. It does not analyze the *Graham* factors—for example, the differences between the prior art and the claims at issue. And it lacks any explanation as to ***why*** the disclosure would render a limitation obvious to a POSITA. These boilerplate assertions of anticipation and obviousness do not fully articulate either invalidity theory.

Second, the improper Grounds require Patent Owner to respond to multiple incomplete arguments, and the Board to analyze multiple unlisted invalidity grounds. In particular, the gaps in Petitioner's claim mapping raise doubts that any § 102 claim was made in good faith, yet Patent Owner is forced to respond to both anticipation and obviousness arguments within the limited word count requirements, even as neither theory is sufficiently explained for Patent Owner to appropriately rebut. The Board is also burdened with sifting through Petitioner's positions to look

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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)

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, which warrants dismissal of the Petition based on discretionary considerations.

3. Additional shortcomings of the Petition.

a. Gutierrez Is Not Prior Art.

Ground 2 relies completely on Gutierrez as prior art for its dual anticipation-obviousness ground. However, Gutierrez is not prior art under any subsection of 35 U.S.C. § 102, leaving Ground 2 is effectively nullified.

The Petition cites U.S. Patent No. 9,709,995 B2 (referred to as "Gutierrez") as prior art under § 102(a)[5]. Petition (Paper 2) at 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 '680 Patent's priority date of December 7, 2012. And, Gutierrez cannot be prior art under § 102(e) either because ***Gutierrez's priority chain was broken*** at the time of Gutierrez's filing due to Gutierrez's parent application having gone abandoned.

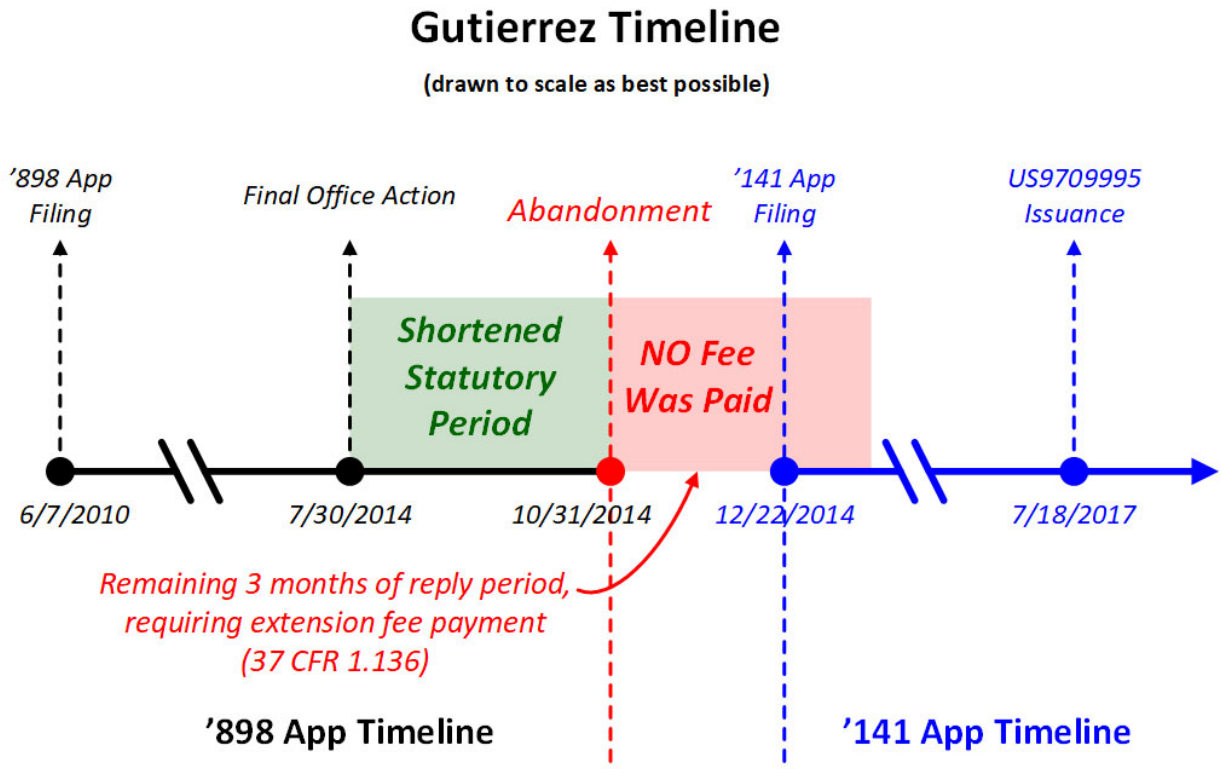
[5] Petitioner purports this was a "typographical" error and seeks permission from the Board to correct (discussed in next section).

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 Action[6] within the fixed statutory period. *See* MPEP 711.04 ("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"). *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

[6] 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 at 199.

there was no further "Office action" indicating otherwise.[7] Ex. 2006; Ex. 2007. The diagram below illustrates these events chronologically.



As the above diagram illustrates, the '141 Application (which issued as Gutierrez) was filed after the parent '898 Application was abandoned. Therefore, the '141 Application (and the patent that issued as Gutierrez) is only entitled to a priority

[7] 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 App, which was mailed on February 4, 2015.

date of December 22, 2014, which is after the December 7, 2012 priority date of '680 patent.

Notably, 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.[8]

[8] 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.

Thus, Gutierrez's actual priority date is December 22, 2014, more than two years after the '680 Patent. Ground 2 fails because Gutierrez is not prior art.

b. Reliance on Incorrect Section of pre-AIA § 102

In Ground 1, the Petition cites Almadi as prior art, and identifies Almadi as prior art under § 102(a). Petition (Paper 1) at 9, 12. Pre-AIA 35 U.S.C. § 102(a), applicable here, renders a patent invalid when "the invention was . . . patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent." However, the '680 patent has a priority date of December 7, 2012, and the Almadi patent did not issue until March 4, 2014. Therefore, the Almadi patent does not qualify as prior art under § 102(a).[9]

[9] Petitioner purports this was a "typographical" error, and is attempting to correct this and numerous other purportedly "typographical" errors in its filings. *See* Petitioner's email to the Board, dated May 15, 2025. Petitioner, however, had ample time to review and correct any "typographical" errors, from the time it was served with the Complaint on January 7, 2025, until Petitioner filed this Petition on February 28, 2025. Petitioner's actions are even more egregious considering that the current Petition is a virtual copy-cat of a petition filed by another petitioner in April 2024 (*see* IPR 2024-00724, Paper 2), and therefore Petitioner did not spend any time developing technical or legal arguments of the Petition.

Similarly, In Ground 2, the Petition cites Cardamone, which the Petition identifies as prior art under § 102(a). Petition (Paper 1) at 10, 32. However, the '680 patent has a priority date of December 7, 2012, and Cardamone was not published until October 29, 2015. Therefore, Cardamone does not qualify as prior art under § 102(a).

c. Lack of *Dynamic Drinkware* Analysis:

Even if Petitioner intended to assert that Cardamone is prior art under pre-AIA § 102(e), it failed to conduct a *Dynamic Drinkware* analysis to establish that Cardamone is entitled to an early priority date. Notably, Cardamone is a U.S. Patent Publication published on October 29, 2015—close to three years after the December 7, 2012 priority date of the '680 patent—and claims priority to provisional application 61/729,815, filed November 26, 2012. Ex. 1005, front page. But the Petition fails to satisfy its burden of showing that at least one claim of Cardamone is supported by its earlier provisional application, and that the portions of the references relied upon were in the provisional application. *Dynamic Drinkware, LLC v. Nat'l Graphics*, Inc., 800 F.3d 1375, 1378-79, 1381-82 (Fed. Cir. 2015); *Ex parte* Mann, Appeal No. 2015-3571, 2016 WL 7487271, at *5-6 (PTAB Dec. 21, 2016); *Huawei Device Co. v. Optis Cellular Tech.*, LLC, Case No. IPR2018-00658, Paper 14 at 26-27 (PTAB Oct. 9, 2018).

d. SCADA Was Considered by the Patent Office During the Prosecution of the '680 Patent.

The Board may also exercise its discretion in denying petitions for *inter partes* review when the same or substantially the same prior art or arguments previously were presented to the Patent Office under 35 U.S.C. § 325(d). *Becton, Dickinson & Co. v. B. Braun Melsungen AG* ("*Becton*"), IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph). The *Becton* case sets forth six factors to weigh when considering discretionary denial, which are: (a) the similarities and material differences between the asserted art and the prior art involved during examination; (b) the cumulative nature of the asserted art and the prior art evaluated during examination; (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection; (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art; (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. *Id*.

Here, the majority of factors weigh in favor of rejecting the Petition because the asserted SCADA reference[10] is substantially the same prior art as previously presented to the Patent Office.

Factor (a) favors Patent Owner because of the numerous similarities and few differences between the asserted SCADA reference and the prior art on SCADA technology proffered by Patent Owner to the Patent Office during prosecution of the '680 patent. The asserted SCADA reference is the 4th edition of a textbook, authored by Stuart A. Boyer, which was written for the purpose of "introduc[ing] student[s] to the basics of SCADA [technology] by providing overviews of relevant topics … and details where necessary." Ex. 1008 at 10. The asserted SCADA reference merely covers "introductory technical material about SCADA systems[, such as] the basic layout of SCADA systems and the parameters for system selection." *Id*. Thus, the asserted SCADA reference is merely a general reference covering common topics about SCADA technology that was ubiquitous at the time of the invention of the '078 patent.

[10] In this section of the Brief, the asserted prior art reference "SCADA" (Ex. 1008) will be referred to as "the asserted SCADA reference," and the subject or technology of SCADA will be referred to as "SCADA technology."

Patent Owner admitted SCADA technology was prior art through discussion in the Background section of the '680 patent specification, and discussed some of its shortcomings.[11] Ex. 1001 at 1:39-50. Patent Owner also submitted two non-patent literature references about SCADA technology in an Information Disclosure Statement (IDS) for the parent of the '680 patent.[12] *See* screenshot below (annotated) of the second page of U.S. Patent No. 8,649,909 (parent of the '680 patent) showing the two SCADA technology references considered by the Office for granting the '680 patent.

[11] *McCoy v. Heal Sys., LLC*, 850 Fed. Appx. 785, 789 (Fed. Cir. 2021) ("By characterizing certain parts as conventional in the specification, the patentee effectively admits that such things would be known to a POSA").

[12] References submitted in an IDS of the parent of the '680 patent were considered in the examination of the '680 patent's application in accordance with MPEP 609.II.A.2: "[t]he examiner will consider information which has been considered by the Office in a parent application … when examining: (A) a continuation application filed under 37 CFR 1.53(b),"

(56) **References Cited**

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2010/0326654	A1	12/2010	Hemblade	
2011/0231024	A1*	9/2011	Medizade	700/282
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"SCADALynx—the ultimate solution for oil and gas production intelligence," @eLynx Technologies, LLC, 2011, <www.eLynx Tech.com.> 2011, p. 1, US.

"iSCADA Gas Well Support," <www.vipondcontrols.ca/index+com_content&view+article&id=142:iscada-gas-well-support,> Sep. 2, 2012, pp. 1-2, Calgary, Alberta, Canada.

"Field Data Capture for Oil and Gas, "Merrick—Oil & Gas Technology Solutions, <www.merricksystems.com/oil-and-gas-software/field-operations-management/evin.html?phpMyAdmin . . . ,> Sep. 2, 2012, pp. 1-4, Houston, Texas, US.

Vipond, Darryl, "Cloud Computing for the Oil and Gas Industry," Vipon Controls, <www.automation.com/content/cloud-computing-for-the-oil-and-gas-industry,> Sep. 2, 2012, pp. 1-4, US.

* cited by examiner

Both the nature and content of the SCADA technology discussed in the patent itself, as well as the IDS submissions, are substantially similar to the asserted SCADA reference, that is, general in scope covering common features and limitations of SCADA technology for its most prolific applications. For instance, the IDS submissions disclosed SCADA technology for oil and/or gas applications (*see* image above); and the asserted SCADA reference disclosed elements and layout of SCADA systems for pipeline systems, oil or gas fields, etc. *See*, e.g., Ex. 1008 at 15-17. Also, for instance, the discussion in the '680 patent specification related to SCADA technology highlights some of the shortcomings and failures of existing SCADA systems (Ex. 1001 at 1:39-50); and the asserted SCADA reference similarly disclosed warnings, pitfalls, and risks with SCADA technology. *See* Ex. 1008 at 6, 159, 170 (e.g., "What Not to SCADA").

The main difference between the asserted SCADA reference and the information brought forth to the Patent Office during prosecution of the '680 patent is the size—not scope—of the information. There was no reason to submit larger or more references describing conventional SCADA technology, like the asserted SCADA reference, since the claimed invention of the '680 patent was unique and distinct. If anything, Patent Owner's discussion of SCADA technology in the specification and IDS submissions demonstrated respect for patent examiners' time and knowledge of the state of the relevant technology that they examine. Thus, Factor (a) weighs in favor of exercising discretion.

Factors (b) and (c) are neutral or favor Petitioner. While an exact copy of the asserted SCADA reference was not in front of the Examiner during prosecution, SCADA technology was discussed in the patent itself, and at least two SCADA-related references were presented to the Examiner. And, regarding Factor (c), the Examiner did rely on patent prior art[13] that disclosed SCADA technology to initially reject some original claims during the prosecution of the '078 patent. *See* Ex. 1004

[13] The Non-Final Office Action mailed February 23, 2021 rejected original claim 4 using a combination of patent references including U.S. Patent No. 7,967,066 ("McStay"), which describes SCADA technology. McStay is included in the file wrapper of Ex. 1004 at 314-315.

at 253. This prior art used during the prosecution described SCADA technology in a similar manner, i.e., generally, to that in the asserted SCADA reference.

Factor (d) favors Patent Owner because of the overlap among the arguments made during examination (e.g., regarding claim 4) and the manner in which Petitioner relies on the asserted SCADA reference. During prosecution of the '680 patent, the Examiner noted in the reasons for allowance that the prior art as described in the prosecution history, which included references describing SCADA technology, did not describe . . . "sending, with the server, the target value to the network address via the network". Ex. 1004, at 22. Petitioner relies on SCADA in Ground 4, mapping this same limitation to SCADA's disclosure of sending information from field devices to the master terminal unit (the remote terminal unit "must put together a message that includes all of the information requested by the [master terminal unit]." Petition (Paper 1) at 62. However, as discussed above, Petitioner's argument is severely flawed, first because the cited portion of SCADA involves transmitting values from remote devices to a master terminal unit, rather than the other way around, as claimed in Claim 1. But also, Petitioner relies on SCADA technology after the examiner had already considered SCADA technology during prosecution.

Finally, Factors (e) and (f) favor Patent Owner because, as discussed in multiple sections above, the Petition provided little more than a perfunctory

evaluation of the challenged claims with respect to the asserted SCADA reference that was plagued with multiple flaws on the merits. For Factor (e), Petitioner provided no discussion of any potential errors made by the Office during examination of the prior art. For Factor (f), no additional evidence or facts were presented in the Petition with respect to SCADA. In fact, Petitioner's discussion on § 325(d) did not even attempt to address Factors (e) and (f), thereby effectively waiving any claim that these factors favor Petitioner. *See* Petition (Paper 2) at 65.

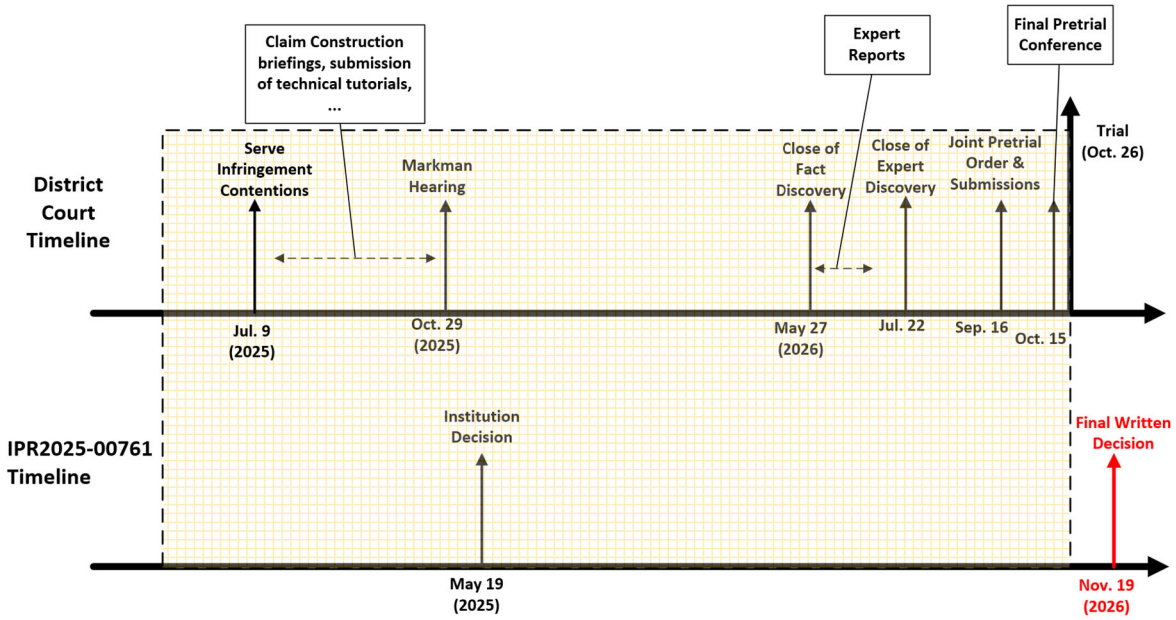
In sum, the tally of *Becton* factors favors the use of discretion, which should deny the Petition for reliance on prior art previously considered during examination of the '078 patent.

III. Additional Considerations Favor Denial

A. Evaluation of Almadi, Gutierrez, and SCADA references at PTAB amounts to waste of judicial resources.

The District Court Proceeding asserts eight patents against TankLogix, including U.S. Patent No. 12,019,461 (the "'461 patent"), which is related to the '680 patent through a series of continuations. *See* Ex. 2004, front page. Petitioner is challenging all claims of the '461 patent in IPR2025-00761 by relying in-part on Almadi, Gutierrez, and SCADA, which are also used in the present Petition. The Petition against the '461 patent was accorded a filing date of April 19, 2025 (*see*

IPR2025-00761, Paper 6), and therefore its final written decision will issue *after* the trial date of the District Court Proceeding, as shown in below.



Comparison of District Court and IPR2025-00761 Timelines
(Drawn to scale as best possible)

Due to the late filing of the Petition against the '461 patent, the District Court Proceeding will be concluded when the final written decision issues on November 19, 2026, making the likelihood of a stay even less at the District Court Proceeding. Therefore, the relevance of Almadi, Gutierrez, and SCADA in connection with the claims of the related '461 patent would be determined at the District Court Proceeding regardless of the status of the present Petition. This results in duplicative work at the PTAB and waste of judicial resources in analyzing the same references and adjudicating similar invalidity issues, which can be avoided by denying the institution of the present IPR.

B. Patent Owner is considering disqualifying Cardamone as a prior art reference.

Cardamone's priority date is no earlier than November 26, 2012 (Ex. 1005, front page), which predates the December 7, 2012 priority date of the claims of the '680 patent by 11 days. Patent Owner is considering filing a declaration under 37 C.F.R. §1.131 and associated evidence to antedate Cardamone. As noted in Section II.F above, the Petition's invalidity grounds are already weak on technical merits, and disqualification of Cardamone leaves an even weaker Petition with fewer invalidity grounds having significant flaws.

C. Settled Expectations.

The '680 patent was issued in 2021 and claims priority to December of 2012. Given that the '680 patent has been in force for close to 4 years, Patent Owner has the settled expectation that it can rely on its patent for enforcing its rights many years after the patent issued. Therefore, this discretionary consideration favors Patent Owner.

IV. Conclusion

Taken together, the *Fintiv* and other factors discussed herein weigh in favor of the Board exercising its discretion to deny institution.

Dated: June 13, 2025

Respectfully submitted,

/Babak Tehranchi/

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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 *Brief on Discretionary Denial* totals 5,901 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

I hereby certify that on this 13th day of June, 2025, true and correct copies of the foregoing SITEPRO, INC.'S BRIEF FOR DISCRETIONARY DENIAL and EXHIBITS were served via electronic mail on Petitioner's counsel at the following address:

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