

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TANKLOGIX, LLC,

Petitioner,

v.

SITEPRO, INC.,

Patent Owner.

PTAB Case No. IPR2025-00652

Patent No. 11,294,403

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I.	INTRODUCTION	1
A.	Level of Ordinary Skill in the Art and Claim Construction.....	3
II.	THE CHALLENGED CLAIMS ARE PATENTABLE OVER THE TEACHINGS OF KAHN, ALMADI, AND GUTIERREZ.....	4
A.	Multiple Claimed Elements and Limitations of Claim 1 Lack any Mapping or Clear Mapping to Kahn in Ground 1	4
1.	Kahn Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “remote control of the first pump of the first valve” in [1.2] of Claim 1.....	5
2.	Kahn Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “receiving, with the server system, from the first client computing device, a first command to change a state of the first pump” in [1.8] of Claim 1.....	8
3.	Kahn Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “causing, with the server system, the first computer system disposed at the first fluid handling site to effectuate the command by changing the state of the first pump to a sequence of different target states that change over time” in [1.9] of Claim 1.....	9
4.	Several Additional Claim Elements and Limitations of Claim 1 are Not Disclosed, Taught, Suggested, or Rendered Obvious by Kahn.....	10
B.	Multiple Claimed Elements and Limitations of Claim 1 Lack any Mapping or Clear Mapping to Kahn-Almadi-Gutierrez Combination in Ground 2.....	11

TABLE OF CONTENTS (CONTINUED)

	Page
1. The Kahn-Almadi-Gutierrez Combination Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “remote control of the first pump of the first valve” in [1.2] of Claim 1.	12
2. The Kahn-Almadi-Gutierrez Combination Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “server system remote from the fluid handling site, wherein the server system has memory storing instructions that, when executed, effectuate operations” in [1.3] of Claim 1.	14
3. The Kahn-Almadi-Gutierrez Combination Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “obtaining, with the server system, credentials from a first client computing device” in [1.5] of Claim 1.....	15
4. Several Additional Claim Elements and Limitations of Claim 1 are Not Disclosed, Taught, Suggested, or Rendered Obvious by the Combination.....	16
C. Multiple Claimed Elements and Limitations of Claim 30 also Lack any Mapping or Clear Mapping to the Combination in Ground 2.....	17
III. THERE IS NO MOTIVATION TO COMBINE KAHN, ALMADI, AND GUTIERREZ	18
IV. PETITION FAILS TO MEET MULTIPLE LEGAL REQUIREMENTS OF UNPATENTABILITY	23
A. Ground 1 fails to Delineate Between § 102 and § 103 Arguments and Fails to Properly Assert Either Category.....	23
B. Petitioner Relies on Incorrect Section of pre-AIA § 102 for Ground 2.....	26
C. Ground 2 Fails Because Gutierrez is Not Prior Art.	27
V. CONCLUSION.....	31

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 1-23 and 25-30 (“Challenged Claims”) of U.S. Patent No. 11,294,403 (the “’403 patent”) based on two grounds. Petitioner’s grounds do not demonstrate a likelihood of prevailing, as demonstrated in the sections below. Patent Owner requests the Board deny institution of this IPR.

The ’403 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, 2:6-9, 5:59-6:4. The systems described in the ’403 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 web-based interface (*e.g.*, web browser) over a web-based network. *See id.*, 3:13-4:21, FIG. 1, Claim 1. 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.*, 3:35-42), which solves several deficiencies in the art at the time of the ’403 patent, including manual on-site control or specialized software required for devices on a site-by-site basis. *See id.*, 1:48-67. Furthermore, the systems of the ’403 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.*, 3:13-60, 4:30-50.

Petitioner's challenges to Claim 1, based on the disclosures of U.S. Patent No. 7,424,399 B2 ("Kahn," Ex. 1005), U.S. Patent No. 8,667,091 ("Almadi," Ex. 1006), and U.S. Patent No. 9,709,995 B2 ("Gutierrez," Ex. 1007), all fall woefully short since these references do not individually or collectively disclose, teach, suggest, or render obvious each claimed feature and the claimed system as a whole. The insufficient teaching of the '403 patent claims by these references is reflected in the Petition, which fails to identify any disclosure by Kahn, Almadi, 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, Almadi, 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 '403 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 1 is shown to be patentable over Kahn, Almadi, and Gutierrez alone and in combination. It is self-evident that the dependent claims 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, ¶48. 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.*, ¶73.

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

A. Multiple Claimed Elements and Limitations of Claim 1 Lack any Mapping or Clear Mapping to Kahn in Ground 1

Petitioner asserts Kahn alone anticipates and/or renders obvious Claims 1, 2, 4-5, and 7 under (pre-AIA) 35 U.S.C. § 102 or § 103. *See* Petition (Paper 2), 10. Petitioner's assertions are incorrect because, as shown in this section, Kahn fails to disclose, teach, suggest, or make obvious several claimed features and therefore do not anticipate or render obvious the whole of Claim 1.

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 does

Ground 1 fail to satisfy these legal standards (discussed later in **Section IV**), the ground does not even *attempt* to identify each claim element and its limitation(s).

In particular, Ground 1 based on Kahn either fails to map or provides unclear or incorrect element mappings for at least several limitations among the nine claim sections of Claim 1 (parsed [1.1] to [1.9])).

1. Kahn Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “remote control of the first pump of the first valve” in [1.2] of Claim 1

In Ground 1, Petitioner fails to present a proper mapping of Kahn to the claimed feature of “*the first computer system being configured to provide **remote control** of the first pump of the first valve,*” as recited in limitation [1.2]. Kahn is directed toward “sensor systems and methods for fluid monitoring.” Ex. 1005, 1:27-29, title, abstract. Petitioner misinterprets Kahn when alleging “Kahn discloses ... separate control systems for designated location, i.e. fluid handling site,” citing multiple columns of Kahn’s disclosure that do not support Petitioner’s allegation.¹ See Petition, 11. Petitioner aims to rely on Kahn to supposedly show that Kahn’s

¹ The Petition cites Kahn (Ex. 1005) at 16:40-18:52), which describes the distribution of sensor elements and does not disclose, teach, or suggest “*remote control*” as claimed in the ’403 patent.

sensor systems and methods **control** fluid-handling devices, like the claimed “*first pump*” and “*first valve*.” However, this is incorrect because the specification of Kahn does not disclose teach control of fluid actuation devices. Ex. 2009, ¶78 (“Kahn is directed toward [fluid monitoring], not control”). Importantly, there is nothing in Kahn that even suggests remote control from a computer system that is remote from the fluid-handling device, e.g., pump or valve. Ex. 2009, ¶79 (“[t]here is no disclosure, mention or suggestion of a “remote control”).

The Petition also does not show remote control in Kahn’s disclosure when discussing fluid-handling devices, i.e., stating “Kahn discloses that [Kahn’s] fluid-handling site includes a first pump ... and a first valve, citing numerous disparate sections of Kahn.² See Petition, 11. Here, Petitioner cites one portion of Kahn (Ex. 1005, 10:62-67) disclosing a communications unit that initiates on-site alerts such as optical (indicator lights), audible alerts (e.g. alarm sounds), tactile (e.g., vibration of the unit) or can be interfaced to a control valve that locally controls shut off of fluid upon the detection of emergency events. This quote merely points to

² The Petition cites Kahn (Ex. 1005) at 8:6-7, 8:19-30; 10:62-67, 11:2-5, 11:18-13:58, 13:34-36, 15:50-16:5, 16:56, 20:64-67, 21:1, FIG. 1C-1D., FIG. 1F, and FIG. 1G.

local indicators (i.e., “on-site alerts) and, at most, “interfacing” these alerts with a local control valve. There is no disclosure, teaching or suggestion of a “remote control,” nor would it be obvious to provide “remote control” based on this or anything in Kahn. Ex. 2009, ¶79.

Petitioner also alleges, without support,³ that a POSITA would recognize that Kahn discloses remote control since controllers are used in remote oil fields and fluid-handling management systems to control fluid-handling devices such as pumps, valves, filters, tanks, motor drive systems, and pump systems including actuators. *See* Petition, 13. This is inaccurate and not supported by Kahn's disclosure. There is just no suggestion that this is accomplished through “remote control,” much less through remote control of a first pump or first valve. Ex. 2009, ¶80. As such, Kahn does not disclose, teach, suggest, or render obvious limitation [1.2] of Claim 1.

³ The Petition cites Kahn (Ex. 1005) at 8:19-21, 10:62-67; 14:35-15:2, and 15:62-16:32 after making the allegation, but these portions of Kahn do not teach remote control.

2. Kahn Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “receiving, with the server system, from the first client computing device, a first command to change a state of the first pump” in [1.8] of Claim 1.

Petitioner incorrectly relies on Kahn for disclosing “receiving, with the server system, from the first client computing device, a first command to change a state of the first pump” in claim limitation [1.8]. As established above in **Section II.A.1**, Kahn is incapable of remote control. Therefore, it follows that Kahn does not disclose or teach receiving *any* command to *change the state* of a fluid-handling device, such as the claimed “*first pump*.”

The Petition alleges “[a] POSITA would recognize” from Kahn’s disclosure of sensors being in communication with actuators that “Kahn discloses receiving, with the server system, from the first client computing device, a first command to change a state of the first pump where the command to change a state of the fluid-handling devices is the recalibration solution.” Petition, 19-20. The allegation is incorrect and unsupported by Kahn. Petitioner only relies on Petitioner’s expert, Dr. Wooley, who makes a parroted statement in his declaration citing to the same portions of Kahn that do not support his opinion. *See* Ex. 1002, ¶¶58-60. The cited sections of *Kahn* (i.e., Ex. 1005, 8:3-11, 8:21-24, 10:62-67, 14:35-15:2, 15:62-16:32, and 34:7-12) discuss various equipment, some of which includes pumps, but

do not disclose or suggest receiving a command with the (remote) server system to change a state of a pump. Ex. 2009, ¶86. And as discussed above, Kahn's disclosure at 10:62-67 merely points to *local* indicators (i.e., "on-site alerts) and, at most, "interfacing" these alerts with a local control valve. There is no disclosure, teaching, or even suggestion of a remote server receiving a command to remotely change the state of a pump or any actuatable device. *Id.*

Thus, Kahn does not disclose, teach, suggest, or render obvious limitation [1.8] of Claim 1.

3. Kahn Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of "causing, with the server system, the first computer system disposed at the first fluid handling site to effectuate the command by changing the state of the first pump to a sequence of different target states that change over time" in [1.9] of Claim 1.

Petitioner does not show that Kahn anticipates or renders obvious limitation [1.9] either. First, Petitioner's mapping fails because, as discussed above in **Section II.A.2** for limitation [1.8], Kahn completely lacks disclosure about "*receiving ... a first command to change a state of the first pump.*" Petitioner thus does not cure this deficiency when mapping "*the command*" in [1.9]. As there was no teaching in Kahn to receive *a command* with a remote server system, Kahn equally fails to disclose, teach, suggest or render obvious the *effectuation* of "*the command by changing the state of the first pump*" in claim limitation [1.9].

Moreover, Petitioner fails to provide any mapping to the claimed limitation in [1.9] that “*the state of the first pump [be changed] to a sequence of different target states that change over time.*” See Petition, 20; see also Ex. 1002, ¶¶61-63. First off, there’s absolutely nothing in the Petition or the Wooley declaration that even mentions “*a sequence of different target states*” or those that “*change over time.*” *Id.* Instead, only a conclusory statement that “[a] POSITA would recognize” is made (1) without even mentioning “time” nor a “sequence” when referring to ‘changing the state’ and (2) without showing how such a conclusion is reached based on what Kahn discloses. *Id.* Without a mapping, Petitioner has failed to show anticipation and/or obviousness of limitation [1.9] of Claim 1.

4. Several Additional Claim Elements and Limitations of Claim 1 are Not Disclosed, Taught, Suggested, or Rendered Obvious by Kahn.

The Petition fails to properly map several other Claim 1 elements and limitations in addition to those discussed above in connection with [1.2], [1.8] and [1.9]. For example, Petitioner also fails to map the claimed “*determining ... based on the credentials ... authoriz[ation] to interact with the first fluid handling site*” feature of [1.6]. First, Kahn is directed to viewing or visualizing data from, not remote control of, a fluid handling site. Ex. 2009, ¶83. It lacks disclosure of a user authorized to “*interact*” with the first fluid handling site, because Kahn has no such

disclosure. Ex. 2009, ¶82. In other words, Kahn's users have a one-way relationship with Kahn's fluid-handling site—they have visibility for monitoring but not control, and thus they do not interact with the sites. *Id.*, ¶82.

Claim 1 cannot be anticipated or rendered obvious by Kahn when there are numerous claim elements and limitations absent in the cited reference. The fact that the Petition is unable to identify where and how multiple claim features are allegedly described in the references is indicative of the reference's lack of disclosure and overall teaching. Claim 1 is clearly patentable over Kahn, and therefore its dependent claims are too. Thus, *inter partes* review of the '403 patent based on Kahn is unwarranted.

B. Multiple Claimed Elements and Limitations of Claim 1 Lack any Mapping or Clear Mapping to Kahn-Almadi-Gutierrez Combination in Ground 2

Petitioner asserts a combination of “Kahn in view of Almadi and Gutierrez” (hereinafter, “Combination”) renders obvious Claims 1-3, 6, 8-23, and 25-30 under (pre-AIA) 35 U.S.C. § 103. *See* Petition, 25. Petitioner's assertions are incorrect because, as shown in this section, the Combination fails to disclose, teach, suggest, or make obvious several claimed features and therefore do not render obvious the whole of independent Claims 1 and 30.

As a threshold issue, Petitioner only discusses Almadi for each of the individual elements and limitations of Claims 1 and 30 and is completely silent on how Kahn's and Gutierrez's disclosures pertain to Petitioner's assertion that these claims are rendered obvious by the Combination. Petitioner fails to conduct a proper § 103 analysis (discussed later in **Section IV.A**), thus neglecting the requirement of explaining what any of the references in the combination do not teach and why it would be obvious in view of another reference's teaching. Nevertheless, Claims 1 and 30 are not obvious in view of Kahn, Almadi, and Gutierrez, whether considered in the Combination or alone. And, since Petitioner did not discuss Kahn and Gutierrez in the invalidity analysis against Claim 1 and 30, Petitioner has waived any reliance on Kahn's disclosure and Gutierrez's disclosure for at least these claims. Patent Owner therefore does not address Kahn and Gutierrez in the rebuttal against Ground 2.

1. The Kahn-Almadi-Gutierrez Combination Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “remote control of the first pump of the first valve” in [1.2] of Claim 1.

In Ground 2, Petitioner fails to present a proper mapping of the Combination to the claimed feature of “*the first computer system being configured to provide remote control of the first pump of the first valve,*” as recited in limitation [1.2]. First, Petitioner's mapping of the “first computer system” lacks clarity, but appears

to be directed to Almadi's remote subsystems 120, which include "intelligent field systems." See Petition, 29 and 31; see also Ex. 1006, 11:18-28. With this established, Petitioner vaguely maps the "control" limitation to controllers of these same intelligent field systems, which Petitioner states "local controller [uses commands] to drive the fluid handling device to a particular state." Petition, 31. This mapping fails the limitation of [1.2] because it does not demonstrate "remote control" when the computational component of the remote subsystem is not remote from the particular local controller, as is the case with Almadi's remote subsystems 120. See Ex. 1006, FIG. 1A-1B, 11:18-12:59.

Second, Petitioner also asserts that Almadi discloses remotely controlling "*the first pump of the first valve*." Petition, 29-30. This is also wrong. Almadi does not disclose a first fluid handling site that comprises a first valve. Not only does the word "valve" not appear anywhere in Almadi, Petitioner has not shown how Almadi discloses, teaches, suggests or otherwise makes obvious "*remote control*" of a pump by a computer system in the context of Claim 1. Almadi does not disclose anything similar to the claimed features of remotely controlling a pump having a valve. See Ex. 2009, ¶108. And, Petitioner fails to provide any rationale or analysis as to why any teaching of the Combination, particularly Almadi, would render a first fluid handling site comprising a first valve obvious.

Therefore, Petitioner has failed to meet its burden, and in any case, the Combination and each of its references fail to disclose, teach, suggest or render obvious the claimed feature of [1.2].

2. The Kahn-Almadi-Gutierrez Combination Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “server system remote from the fluid handling site, wherein the server system has memory storing instructions that, when executed, effectuate operations” in [1.3] of Claim 1.

Petitioner fails to show how or why limitation [1.3] is obvious in view of the Combination because there is no showing that the Combination, particularly Almadi, discloses or teaches a “server system remote from the fluid handling site” based on Petitioner’s mapping. Notably, Petitioner maps the claimed “server system” to Almadi’s integrated node 100. Petition, 31-32; Ex. 1002, ¶87. However, Almadi’s “integrated node 100” cannot be the claimed “server system” because it is not “*remote from the fluid handling site,*” as required by the claim. Almadi discloses that “integrated node 100 is a programmable logic controller (PLC), meaning any programmable logic controller (PLC), remote terminal unit (RTU), PLC with RTU functionality, RTU with PLC functionality, or any type of computer, terminal, server, system, node, or unit or other machine.” Ex. 1006, 11:21-26. A POSITA would understand that the integrated node 100 would have been located at the fluid handling site, not remote from it. *See* Ex. 2009, ¶108. While it would be understood

that the remote subsystems 120 are physically separated from the integrated node 100, they are separated at the fluid handling site. Almadi does not disclose that “remote subsystems 120” is located at a different fluid handling site than integrated node 100, therefore, the PLC would not be considered remote. *See* Ex. 1006 11:18-12:15.

Thus, there is no support that the Combination teaches, suggests, or renders obvious limitation [1.3].

3. The Kahn-Almadi-Gutierrez Combination Does Not Disclose, Teach, Suggest, or Render Obvious the Claimed System Feature of “obtaining, with the server system, credentials from a first client computing device” in [1.5] of Claim 1.

Petitioner fails to make a proper showing that limitation [1.5] is taught, suggested, or rendered obvious by the Combination. Petitioner contends that in Almadi's disclosure the integrated node 100 (mapped to the claimed “*server system*”) allows remote host 110 to interface with a plurality of remote subsystems 120 and thereby obtain credentials of a client computer. *Petition*, 34. This is incorrect. Almadi does not disclose any type of credentials exchange between the first client computing device and the server system. There is no mention of the term “credential” in Almadi, or anything that could be reasonably interpreted as an exchange of credentials, such as “username” or “password.” *See* Ex. 2009, ¶112.

Thus, there is no support that the Combination teaches, suggests, or renders obvious limitation [1.5].

4. Several Additional Claim Elements and Limitations of Claim 1 are Not Disclosed, Taught, Suggested, or Rendered Obvious by the Combination.

The Petition fails to properly map several other Claim 1 elements and limitations in addition to those discussed above in connection with [1.2], [1.3] and [1.5]. As discussed in **Section II.B.3** for limitation 1.5, Almadi does not disclose “*credentials*,” so Almadi’s system therefore cannot implement the features recited in limitation [1.6], including determining that a user of the first client computing device is authorized to interact with the first fluid handling site. *See* Ex. 2009, ¶114. Also, Petitioner fails to demonstrate limitation [1.9] is obvious to the combination. Almadi fails to disclose, teach, suggest, or render obvious “*different target states*” that change over time, as required by Claim 1. While Almadi’s field devices “can perform actuator functions to receive information, such as commands, from the system level to thereby affect or control the operation of an automated process, for example, through motors and pumps,” they do not address a “sequence of different target states that change over time” as in limitation [1.9]. *See* Ex. 2009, ¶123.

Thus, Claim 1 cannot be rendered obvious by the proposed combination when there are numerous claim elements and limitations absent in the cited references.

The fact that the Petition is unable to identify where and how multiple claim features are allegedly described in the references is indicative of the references' lack of disclosure and overall teaching. Claim 1 is clearly patentable over the Combination and each reference it comprises (Kahn, Almadi, and Gutierrez), and therefore its dependent claims are too. Thus, *inter partes* review of the '403 patent based on the Combination is unwarranted.

C. Multiple Claimed Elements and Limitations of Claim 30 also Lack any Mapping or Clear Mapping to the Combination in Ground 2.

Like for Claim 1 in Ground 2, Petitioner also fails to make a sufficient obviousness showing for the other independent claim of the '403 patent. Claim 30 is directed to a system claim with similar limitations as [1.1]-[1.9] of Claim 1.

As discussed above in **Sections II.B.1-II.B.4**, the limitations of [1.2], [1.3], [1.5], [1.6], and [1.9] are not disclosed, taught, suggested, or rendered obvious by the Combination (including Almadi), and the Petition and the Wooley declaration each do not make a showing to the contrary. Therefore, Claim 30, which recites similar features as Claim 1 fails for the same or similar reasons discussed above.

As a result of the above, Ground 2's invalidity assertions against Claim 30 necessarily fails.

III. THERE IS NO MOTIVATION TO COMBINE KAHN, ALMADI, AND GUTIERREZ

There is no motivation to combine Kahn, Almadi, and Gutierrez because the systems of these references are fundamentally different. *See* Ex. 2009, ¶93.

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. It lacks *remote control* features, thus, the Petitioner's assertions that the proposed combined system using Kahn would have "remote monitoring and control" is simply wrong. *Id.*

Gutierrez is a completely different type of system that has both monitoring and control capabilities of fluid handling devices. It operates through a private network that is not web-based at all. *See* Ex. 2009, ¶94. While Gutierrez discloses a control and monitoring system on an "enterprise or secured network" and suggests that the system may utilize portions of the Internet (Ex. 1007, 12:55-57), Gutierrez makes it clear that this is through the use of a virtual private network (VPN) (*id.*, 12:48-64), rather than a web browser-based system as disclosed by Kahn (Ex. 1005, 26:3-19). *See* Ex. 2009, ¶¶93-95. While the Internet facilitates both VPN and the World Wide Web (known as the "web"), they are completely different networks. *See id.*, ¶96.

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. *Id.*, ¶¶95, 98. The key to a VPN is that it is “private.” *Id.* In other words, “The traffic originating and terminating within a private network traverses only those nodes that belong to the private network. Further, there is traffic isolation. That is, the traffic corresponding to this private network does not affect nor is it affected by other traffic extraneous to the private network.” *Id.* On the contrary, the World Wide Web is a service that displays information on ‘pages’ in a web browser using, for example, 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. *Id.*, ¶97.

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. *Id.*, ¶¶98-101. Thus, there is a “distinction between a private network, such as a VPN, and a web-based system [that] is important in understanding the technology behind references such as Kahn and Gutierrez, as well as the ’403 Patent.” *Id.*, ¶98.

Further, there is no discussion of using the World Wide Web, or even an internet infrastructure, for communications. Although Almadi references using an “Internet Protocol” (IP)⁴, it does not disclose using the internet. *Id.*, ¶100. IP is a protocol for communications between networked devices and is equally applicable to “the internet” and to a corporate intranet, including private Local Area Networks. *Id.* There is no requirement for IP communications to use the public internet infrastructure, and there is no description of using the public internet infrastructure in Almadi’s system. *Id.* Importantly, there is no reference to the World Wide Web, the web, or any suggestion that Almadi’s system would have been implemented using the web. *Id.* Almadi simply discloses a system for using “corporate networks” (*e.g.*, an intranet) for communications between its various components. *Id.*

Thus, for a POSITA to be motivated to combine the technologies of Kahn, Almadi, and Gutierrez, the POSITA would need to make significant changes to one or all three systems to even attempt to harmonize their differences. 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

⁴ “Internet Protocol,” or IP is referred to as the “internet protocol suite” when combined with the Transmission Control Protocol (TCP). Ex. 2009, ¶100.

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).

Moreover, the implications of a combination of Kahn, Almadi, and Gutierrez would dissuade a POSITA from making such modifications. Notably, there would have been serious security risks to Petitioner's hindsight-created Kahn-Almadi-Gutierrez combination. *See* Ex. 2009, ¶101. The Gutierrez and Almadi systems describe a private network-based system for an individual entity to monitor and control equipment owned by that entity, which is entirely different from the system in Kahn, where the public nodes of the web are used. 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. *Id.* This is why, prior to the '403 patent, no such system as Claim 1 and Claim 30 was shown in prior art, and why Kahn, Almadi, and

Gutierrez are starkly different in their architectures and functionalities.

Petitioner posits no meaningful reasons why a POSITA would combine the teachings of the prior art references. Petitioner's arguments can be distilled to four conclusory statements in the Petition and the Wooley declaration. 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, p. 26; *see also* Ex.1002, ¶¶75-78. Also, Petitioner argues "the references do not describe alternative systems or methods, but rather [disclose] additional detail rather than a different approach to solving problems in the underlying technology addressed by Kahn." *See* Petition, 28. *see also* Ex.1002, ¶78. Petitioner also argues a POSITA's motivation to combine would be drawn from presumed desire to "achieve the efficiency and safety benefits" that Petitioner argues would be gained in Almadi's or Gutierrez's system due to Kahn's user access differentiation. *See* Petition, 28. Finally, Petitioner argues the combination "would lead to predictable results" with no difficulty because "combining Kahn with Almadi or Gutierrez do not describe alternative systems or methods, but rather the disclosures of Almadi or Gutierrez [merely] provide[] additional detail." *See* Petition, 27-28. *see also* Ex.1002, ¶78.

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 '403 patent and do not address, let alone overcome, the incompatibilities between Kahn's, Almadi's, and Gutierrez's respective approaches. Moreover, Dr. Durham, has reviewed and considered Petitioner's motivation to combine Almadi and Gutierrez with Kahn and disagrees with Petitioner's contention. *See* Ex. 2009, ¶93. Unlike Petitioner, Dr. Durham substantiates his expert opinion with thorough analysis of the references' respective teachings. *Id.*, ¶¶93-104.

All in all, a POSITA would have multiple reasons not to combine Kahn, Almadi, and Gutierrez if attempting to create a method and system like in the '403 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

Ground 1 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, 10. Due to this lack of clarity, at least Ground 1 of the Petition is substantively deficient and noncompliant with

35 U.S.C. § 312(a)(3),⁵ 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. 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

⁵ 35 U.S. Code § 312 – Petitions

(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)

be made only after consideration of each factor.” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016).

First, it is unclear whether the Petition intends to raise both § 102 and § 103 arguments. Ground 1 is titled “Kahn Anticipates Claims 1-2, 4-5, 7,” indicating only § 102 arguments. However, within the Ground, the Petition also uses boilerplate language to assert an obviousness theory. *See, e.g.*, Petition, 10 (“Independent claims 1 and dependent claims 2, 4-5, 7 are anticipated by U.S. Patent No. 7,424,399 (“Kahn”) under 35 U.S.C. § 102, or would be obvious to a POSITA in view of Kahn under 35 U.S.C. § 103.”). The Petition then follows a robotic pattern. For many claim, the Petition recites the limitations, lists paraphrased disclosure from the reference, then presents a conclusory statement that a POSITA would understand the Kahn discloses the limitation, or the claim “is anticipated by Kahn or would be obvious to a POSITA in view of Kahn.” *See, e.g.*, Petition, 15, 23.

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 argument fails from the start. As for § 103, the Petition fails to map the prior art to particular features or terms within the claim limitation. 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 Ground 1 requires 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, 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 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 dismissal of the Petition.

B. Petitioner Relies on Incorrect Section of pre-AIA § 102 for Ground 2.

In Ground 2, the Petition cites Almadi as prior art under § 102(a). Petition (Paper 1) at 9. Pre-AIA 35 U.S.C. § 102(a), which is 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 '403 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).⁶

C. Ground 2 Fails Because Gutierrez is Not Prior Art.

Ground 2 relies completely on Gutierrez as prior art 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”)

⁶ Petitioner purports this was a “typographical” error, and is attempting to correct this and numerous other purportedly “typographical” errors in its filings. *See* Notice of Errata (Paper 8) filed July 8, 2025. Out of courtesy, Patent Owner did not oppose Petitioner’s proposed correction. However, Patent Owner notes that Petitioner 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), therefore, Petitioner did not spend anytime developing technical or legal arguments of the Petition.

as prior art under § 102(a)⁷. 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 '078 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.

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 Action⁸ 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,

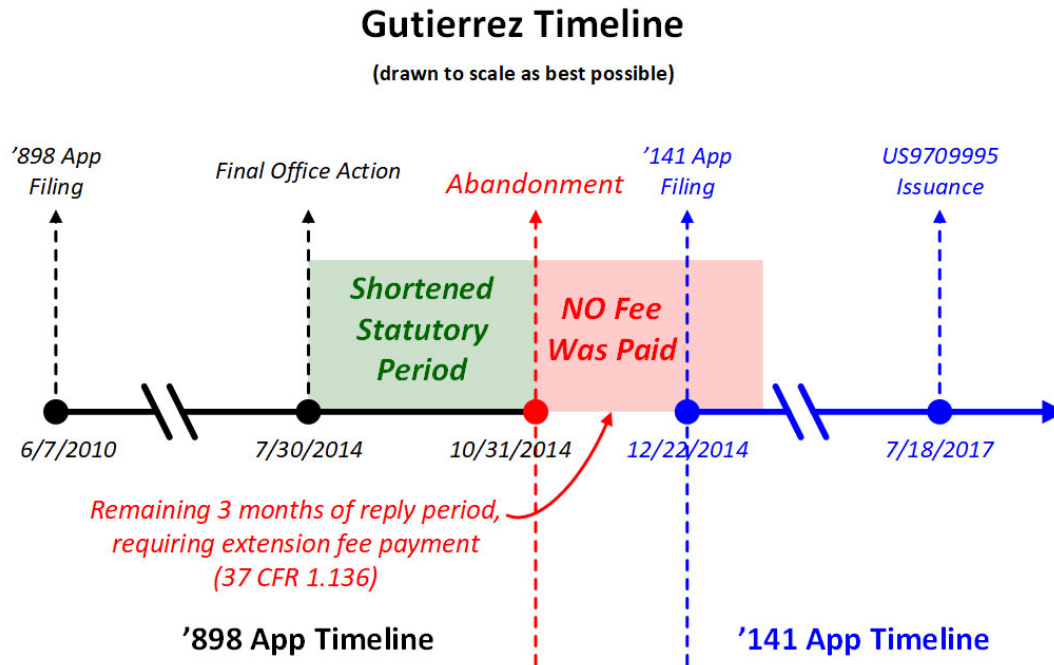
⁷ Petitioner purports this was a "typographical" error and seeks permission from the Board to correct (discussed in next section).

⁸ 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.

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.⁹ Ex. 2006, Ex. 2007. The diagram below illustrates these events chronologically.

⁹ 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.



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 date of December 22, 2014, which is after the December 7, 2012 priority date of '078 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.¹⁰

Furthermore, the prosecution file history of the parent '898 Application includes no statements or authorizations for payment of extensions of time anywhere within the prosecution record. *See* Ex. 2006.

Thus, Gutierrez's actual priority date is December 22, 2014, more than two years after the '078 Patent. Ground 2 fails because Gutierrez is not prior art.

V. CONCLUSION

For the reasons discussed above, Patent Owner respectfully requests that the

¹⁰ 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.

Patent Owner's Preliminary Response
Case No. IPR2025-00652
U.S. Patent No. 11,294,403

Board deny Petitioner's Petition for *Inter Partes* Review of the '403 patent.

Dated: July 16, 2025

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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 6,278 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.

Dated: July 16, 2025

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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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