

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. 11,726,504

Case No.: IPR2025-00653

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 <i>SitePro, Inc. v. TankLogix, LLC</i> , 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, <i>SitePro, Inc. v. TankLogix, LLC</i> , 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. 11,726,504 (the “’504 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 favors 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.

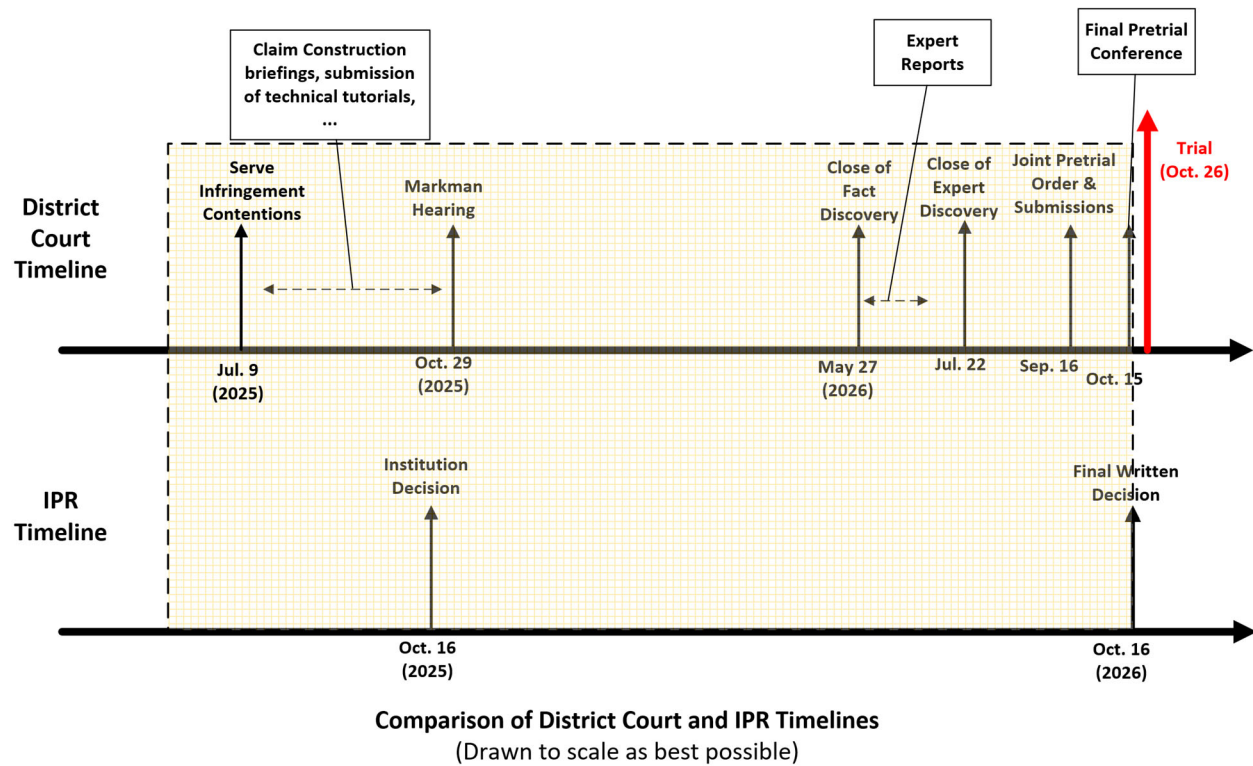
Petitioner has sought a stay in the District Court Proceeding, and to date, the district court has not issued a decision. While Judge Rodriguez has not previously ruled on any contested motions to stay pending IPR (Ex. 2001)¹, SitePro has opposed the motion to stay (Ex. 2005), which is expected to significantly 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.*



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 60. 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 implied that if the petition is instituted it will not pursue the same grounds for the '504 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 61. 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 '504 patent. Petition (Paper 1) at 61 (emphasis added). Petitioner has in fact filed a stipulation on file, 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 IPR2025-00653, 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 61. 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.

Grounds 1 and 2 of the Petition argue that their primary reference anticipates the majority of the challenged claims under 35 U.S.C. § 102. Petition (Paper 1) at 9 (Ground 1), 37 (Ground 2). 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 Application No. 2015/0308244 to Cardamone (“Cardamone”), either fails to map or provides unclear or incorrect element mappings for at least five limitations among the ten claim sections of Claim 1 (parsed 1[pre] to 1[i]).

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 No. 7,424,399 to Kahn (“Kahn”), includes at least **seven** instances of missed element mappings or unclear or incorrect element mappings for Claim 1.

Ground 3, based on a combination of Cardamone or Kahn in view of SCADA: Supervisory Control and Data Acquisition, 4th Edition (“SCADA”), includes at least **three** instances of missed element mappings or unclear or incorrect element mappings for the three claims challenged (Claims 2, 8, and 13).

For instance, in Ground 1, Petitioner fails to cogently map Claim 1’s “*obtaining, with the server system, credentials from a first client computing device*” for 1[e] (Petition (Paper 1) at 11-12). Petition’s only cited disclosure for this element describes a user logging into an application on a “GUI computer,” which authenticates the credentials on the control and communication computer, not the server, as 1[e] requires.³ Cardamone nowhere discloses the server obtaining user credentials.

In addition, Ground 1 provides no mapping in Cardamone to the claimed “*determining*” feature of 1[f]. This limitation claims “determining, with the server

³ Petition states “application 131 queries user 101 for a username and password. Ex. 1005, ¶ 0042. The user queries GUI computer which, as discussed above, is connected to data server 134.” (Petition (Paper 1) at 13 (emphasis added)).

system, based on the credentials, that a user of the first client computing device is authorized to interact with the first fluid handling site, wherein the server system hosts data about other fluid handling sites the user is not authorized to interact.” Petition in Ground 1 does not attempt to map any disclosure to “other fluid handling **sites** the user is not authorized to interact.” The most the Petition does is assert via expert opinion that “A POSITA would readily understand that, after querying a user for a username and password ‘for authentication,’ the system would only provide information about a fluid-handling **device** a user is authorized to interact with, and not provide access to information about a fluid-handling device a user is not authorized to interact with.” Petition (Paper 1) at 14. Even this unsubstantiated “[a] POSITA would understand” argument does not address the requirement for other fluid handling **sites**; at most it discloses other fluid handling **devices**. *See* Petition (Paper 1) at 14.

Similarly, Ground 2, based on Kahn, fails to provide any mapping for Claim 1’s “*provide remote control*” or “*receiving commands from a client computing device*.” As for “*provide remote control*,” the Petition only cites instances of sensor units with actuators or valves that open or close off fluid flow to a sensor.⁴ These

⁴ Petition states: “sensor unit 110 includes communication equipment with actuators configured to manipulate fluid flow at respective fluid-handling

actuators and valves, however, are not controlled remotely by a user command, but instead by the processor in the local sensor unit. Furthermore, the actuators in Kahn are used to move sensors into position to sense water quality, not to control the flow of fluid. As for “*receiving commands from a client computing device*,” Ground 2 relies on Kahn’s “sensor unit 110, including a processor that connects via a network to centralized data collection points.” Petition (Paper 1) at 45. But this still does not describe any sort of command. In fact, Kahn does not teach user commands at all; it is entirely focused on monitoring data.

As for Ground 3, Petitioner relies upon obviousness combinations of either Cardamone + SCADA or Kahn + SCADA that purportedly render obvious Claims 2, 8, and 13 of the ’504 patent. Petition (Paper 1) at 54. But Claim 2 depends from Claim 1, and the Petition in Ground 3 does not explain how the limitations of Claim 1 are obvious. Similarly, for Claim 8, Petitioner cites Kahn in view of SCADA, but Claim 8 depends from Claim 7, which in turn depends from Claim 1. The Petition does not explain how Claims 1 or 7 are obvious based on this combination, and in fact, the Petition nowhere maps Kahn or SCADA to Claim 7, even within other grounds. As for the combination of Cardamone and SCADA, the Petition completely

facilities.” (Petition (Paper 1) at 39).

ignores Claim 8's "*steps for translating commands*" limitation; it simply does not map it to any disclosure in Kahn, Cardamone, or SCADA.

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 ("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."⁵ Here the Petition fails to meet the threshold for *any* claim, which strongly favors discretionary denial.

⁵ *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*"

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 10 (Ground 1), 29 (Ground 2), 52–53 (Ground 3). Due to this lack of clarity, the grounds of the Petition are substantively deficient and noncompliant with 35 U.S.C. § 312(a)(3),⁶ thereby favoring discretionary denial.

First, it is unclear whether the Petition intends to raise both § 102 and § 103 arguments. Grounds 1 and 2 are titled “[Reference] Anticipates Claims [list of claim numbers],” indicating only § 102 arguments. However, within each of these Grounds, the Petition also uses boilerplate language to also assert an obviousness theory. *See, e.g.*, Petition (Paper 1), at 9 (The challenged claims “are anticipated by

⁶ 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)

[reference] under 35 U.S.C. § 102, or would be obvious to a POSITA in view of [reference].”). The Petition then follows a robotic pattern. For each claim limitation, the Petition recites the limitation, lists paraphrased disclosure from the reference, then presents a conclusory statement that the claim “is anticipated by [the reference] or would be obvious to a POSITA in view of [the reference].” *See, e.g.*, Petition (Paper 1) at 19.

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

Grounds 1 and 3 of the Petition rely on Cardamone as prior art, which the Petition asserts is prior art under § 102(a). Petition (Paper 1) at 8-9. 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 '504 patent has a priority date of December 7, 2012, and Cardamone is a U.S. Patent Publication published on October 29, 2015. Therefore, the Cardamone patent publication does not qualify as prior art under § 102(a).⁷

⁷ 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

b. Lack of *Dynamic Drinkware* Analysis:

Even if Petitioner intended to assert that Cardamone were 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. As discussed above, 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 '504 patent—and claims priority to provisional application 61/729,815, filed November 26, 2012. Ex. 1005, front page. The Petition fails to satisfy its burden of showing that at least one claim of the Cardamone publication is supported by the earlier provisional, and that the portions of the Cardamone publication 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).

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 2024-00740, Paper 2), and therefore Petitioner did not spend anytime developing technical or legal arguments of the Petition.

c. SCADA Was Considered by the Patent Office During the Prosecution of the '504 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 reference⁸ 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 '504 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. 1007 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 '504 patent.

⁸ In this section of the Brief, the asserted prior art reference “SCADA” (Ex. 1007) 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 '504 patent specification, and discussed some of its shortcomings.⁹ Ex. 1001 at 1:58-2:2. Patent Owner also submitted two non-patent literature references about SCADA technology in an Information Disclosure Statement (IDS) for the parent of the '504 patent.¹⁰ *See* screenshot below (annotated) of the second page of U.S. Patent No. 8,649,909 (parent of the '504 patent) showing the two SCADA technology references considered by the Office for granting the '504 patent.

⁹ *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”).

¹⁰ References submitted in an IDS of the parent of the '504 patent were considered in the examination of the '504 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),”

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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. 1007 at 15-17. Also, for instance, the discussion in the '504 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. 1007 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 '504 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 '504 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 two SCADA-related references were presented to the Examiner. Factor (c) is neutral, as the Examiner did not issue any rejections based upon prior art during the prosecution of the '504 patent. *See* Ex. 1004 at 1654-64.

Factor (d) favors Patent Owner because of the overlap among the arguments made during examination (e.g., regarding claim elements/limitations [1.4]-[1.10]) and the manner in which Petitioner relies on the asserted SCADA reference. In the reasons for allowance, the Examiner noted that the prior art did not disclose limitations [1.4]-[1.10], and that each of the pending dependent claims (including

claims 2, 8, and 13) were allowable for the same reasons, even after considering SCADA technology as discussed above. *Id.* at 567-68. Petitioner nevertheless alleges that SCADA teaches dependent claims 2, 8, and 13, despite the examiner's previous consideration of SCADA technology during prosecution.

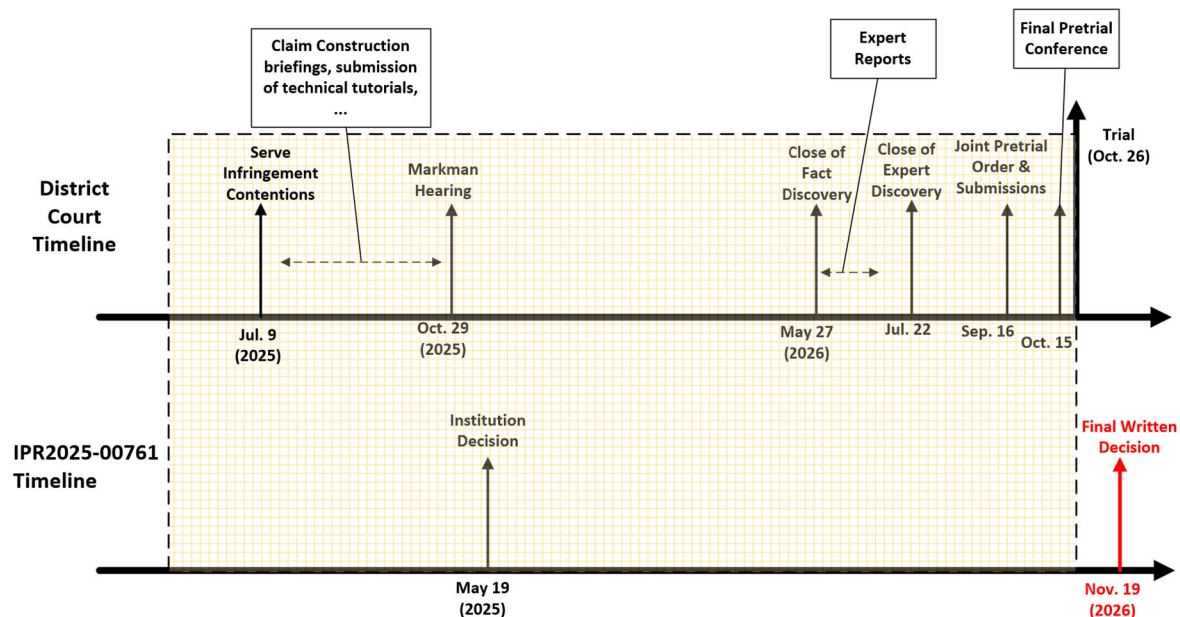
Finally, Factors (e) and (f) favor Patent Owner because, as discussed in multiple sections above, the Petition provided little more than a perfunctory evaluation of the challenged claims with respect to the asserted SCADA reference that was plagued with multiple flaws on the merits. For Factor (e), Petitioner 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 1) at 59-60.

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 '504 patent.

III. Additional Considerations Favor Denial

A. Evaluation of SCADA and Kahn 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 a continuation of the ’504 patent. *See* Ex. 2004, front page. Petitioner is challenging all claims of the ’461 patent in IPR2025-00761 by relying in-part on SCADA and Khan, 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 SCADA and Kahn 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.

Even if Petitioner intended to cite Cardamone as prior art under § 102(e) (and ignoring the lack of the requisite *Dynamic Drinkware* analysis), 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 '504 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 one or two remaining invalidity grounds with significant flaws.

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,

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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 5,275 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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