

Nos. 25-132, 25-133

United States Court of Appeals for the Federal Circuit

In Re SAP AMERICA, INC.,

Petitioner.

On Petitions for Writs of Mandamus to the United States Patent and
Trademark Office in Nos. IPR2024-01495 and IPR2024-01496

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CERTIFICATE OF INTEREST

Counsel for Cyandia, Inc. certifies the following:

1. The full name of every entity represented by us is:

Cyandia, Inc.
2. The name of the real party in interest for the entity. Do not list the real party if it is the same as the entity:

Not applicable.
3. All parent corporations and any other publicly held companies that own 10 percent or more of the stock of the party or amicus curia represented by us are listed below:

Not applicable.
4. The names of all law firms, and the partners or associates that have not entered an appearance in the appeal, and (a) appeared for the entity in the lower tribunal; or (b) are expected to appear for the entity in this court:

Charles Keller, Herbert Smith Freehills Kramer (US) LLP
5. Other than the originating case number(s), any related or prior cases in this or any other court or agency that will directly affect or be directly affected by this court's decision in the pending appeal.

Cyandia, Inc. v. SAP America, Inc., Case No. 2:24-cv-00096-JRG (E.D. Tex.).
6. All information required by Fed. R. App. P. 26.1(b) and (c) in criminal cases and bankruptcy cases.

Not applicable.

Respectfully submitted,

Dated: July 14, 2025

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INTRODUCTION AND SUMMARY OF ARGUMENT

Mandamus “is a drastic and extraordinary remedy reserved for really extraordinary causes.” *Cheney v. U.S. Dist. Court for D.C.*, 542 U.S. 367, 380 (2004) (cleaned up). “[I]t is difficult to imagine a mandamus petition that challenges a denial of institution and identifies a clear and indisputable right to relief.” *Mylan Lab’s Ltd. v. Janssen Pharmaceutica, N.V.*, 989 F.3d 1375, 1382 (Fed. Cir. 2021). That is because “[t]he Director is permitted, but never compelled, to institute an IPR,” and “no petitioner has a right to such institution.” *Ibid.* Accordingly, a petitioner “lacks a clear and indisputable right to review of the Patent Office’s determination to apply the *Fintiv* factors” in declining to institute review. *Ibid.*

That is exactly what SAP America seeks here. SAP petitioned for *inter partes* review of claims in two patents that Cyandia, Inc., had asserted against SAP in an infringement action in district court. The Patent Trial and Appeal Board considered the *Fintiv* factors and, based on a holistic weighing of those factors, determined that it would be inefficient to institute *inter partes* review given the overlapping invalidity contentions raised by SAP in the parallel litigation. Disappointed with that result, SAP now seeks mandamus relief. But SAP has not even attempted to show a clear and compelling duty to institute *inter partes* review—because there isn’t one. The “agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.” *Cuoz’ok Speed Techs., LLC v. Lee*, 579 U.S. 261, 273 (2016). That is the *opposite* of a clear and compelling duty.

SAP cannot avoid that result by labeling its challenge a “constitutional” one. Its argument is still, at bottom, that the Board should not have applied the *Fintiv* factors in discretionarily denying institution—a determination that is unreviewable on direct review *or* mandamus. This Court should reject SAP’s attempt to “convert the mandamus procedure into a transparent means of avoiding the statutory prohibition on appellate review of agency institution decisions.” *In re Power Integrations, Inc.*, 899 F.3d 1316, 1321 (Fed. Cir. 2018). And SAP’s constitutional claims fail on the merits in any event: The Board did not retroactively apply its internal guidance here; SAP had no reasonable reliance interest on that interim guidance in any event; and SAP had no liberty or property interest in such procedures in the first place. This Court should deny SAP’s request for mandamus relief.

STATEMENT OF JURISDICTION

This Court has jurisdiction under the All Writs Act “to consider [a] request for mandamus” relief. *Mylan*, 989 F.3d at 1381; see 28 U.S.C. § 1651(a).

STATEMENT OF THE CASE

1. a. “Congress has committed the decision to institute inter partes review to the Director’s unreviewable discretion.” *United States v. Arthrex, Inc.*, 594 U.S. 1, 8-9 (2021); see 35 U.S.C. § 314(a), (d) (precluding appeal of institution decision). In *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, 2020 WL 2126495 (P.T.A.B. Mar. 20, 2020) (precedential), the Board articulated a six-factor framework for evaluating whether to exercise discretion to deny institution in light of a co-pending district court proceeding.

In “evaluating the factors, the Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.* at *2-3. The fourth factor looks to the “overlap between issues raised in the petition and in the parallel proceeding” in order to weigh “concerns of inefficiency and the possibility of conflicting decisions.” *Id.* at *5. That factor favors denial of institution where the petition includes “substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Ibid.*

In *Sotera Wireless, Inc. v. Masimo Corp.*, No. IPR2020-01019, 2020 WL 7049373 (P.T.A.B. Dec. 1, 2020) (precedential), the petitioner “filed in the District Court a stipulation that, if IPR is instituted, [it] will not pursue in the District Court litigation any ground raised or that could have been reasonably raised in an IPR.” *Id.* at *7. The Board stated that such a stipulation mitigates “concerns of duplicative efforts between the district court and the Board, as well as concerns of potentially conflicting decisions,” and thus weighs in favor of “not exercising discretion to deny institution” under *Fintiv* Factor 4. *Ibid.*

b. On June 21, 2022, then-Director Vidal issued a memorandum outlining an “interim procedure for discretionary denials” of institution. Appx25 (the “Vidal Memo”).¹ The memorandum stated that, “[c]onsistent with *Sotera Wireless, Inc.*, the

¹ “Pet.” and “Appx” refer to the petition and appendix in Appeal No. 25-132. “SAppx” refers to Cyandia’s supplemental appendix. Cyandia cites the documents in IPR2024-

PTAB will not discretionarily deny institution in view of parallel district court litigation where a petitioner presents a stipulation not to pursue in a parallel proceeding the same grounds or any grounds that could have reasonably been raised before the PTAB.” Appx27. That is because such a stipulation “mitigates concerns of potentially conflicting decisions and duplicative efforts.” Appx31.

The Vidal Memo stated that “[t]his interim guidance will remain in place until further notice” and that “[t]he Office expects to replace this interim guidance with rules after it has completed formal rulemaking.” Appx33.

c. On February 28, 2025, the Patent Office rescinded the Vidal Memo and directed parties to the *Fintiv* and *Sotera* decisions for guidance on discretionary denials. Appx81 (the “Rescission Decision”).

On March 24, 2025, Chief Administrative Patent Judge Boalick issued a memorandum providing guidance on the Rescission Decision. Appx82-84 (the “Rescission Guidance”). The Rescission Guidance noted that, in the absence of rulemaking after the Vidal Memo, the Patent Office “rescinded the Interim Procedure to restore policy in this area to the guidance in place before the Interim Procedure”—namely, that set forth in *Fintiv* and *Sotera*. Appx82. The Rescission Guidance stated that “the Interim Procedure’s rescission applies to any case in which the Board has not

01495 as representative. Unless necessary for completeness, the supplemental appendix includes only the relevant portions of the cited materials.

issued an institution decision, or where a request for rehearing or Director Review of an institution decision was filed and remains pending.” Appx83. It further stated that “[t]he Board will consider timely requests for additional briefing on the application of the Interim Procedure’s rescission on a case-by-case basis.” *Ibid.*

The Rescission Guidance clarified that a “timely-filed *Sotera* stipulation” will continue to be “highly relevant, but will not be dispositive by itself.” Appx83-84. “Instead, the Board will consider such a stipulation as part of its holistic analysis under *Fintiv*.” Appx84.

2. a. On February 12, 2024, Cyandia sued SAP in the Eastern District of Texas for infringement of four patents, including U.S. Patent Nos. 8,578,285 and 8,595,641. See *Cyandia, Inc. v. SAP America, Inc.*, No. 24-cv-00096, Dkt. 1 (E.D. Tex.). On May 15, 2024, Cyandia served its infringement contentions. SAppx4. On July 10, 2024, SAP served its invalidity contentions, in which it asserted IBM’s “WebSphere” product as alleged system prior art. SAppx20; SAppx49, ¶¶ 2-3.

b. On October 1, 2024, SAP filed petitions to institute *inter partes* review of claims in the ’285 and ’641 Patents. SAP argued that the challenged claims would have been obvious in light of the “WebSphere references,” a collection of “books describing aspects of the same IBM product: WebSphere.” SAppx5.

On January 9, 2025, Cyandia filed preliminary responses, arguing that that *Fintiv* factors supported denial of institution. See SAppx16-21. With respect to Factor 4, Cyandia noted that, “[i]n the parallel litigation, Petitioner has asserted the WebSphere

product and the WebSphere references as alleged prior art to the” asserted patents, and so “even a *Sotera*-style stipulation (which Petitioner has not provided) would result in the duplication of work and create the potential for inconsistent decisions.” SAppx20, (internal quotation marks omitted).

On January 14, 2025, SAP served a *Sotera*-style stipulation. Appx80. Although SAP filed a reply to Cyandia’s preliminary response on February 11, 2025, the reply did not address the *Fintiv* factors. See SAppx24-38.

On March 12, 2025, after the Rescission Decision was issued, the parties filed supplemental *Fintiv* briefs. SAP argued that the rescission of the Vidal Memo “has little impact on th[ese] IPR[s]” because its *Sotera* stipulation “still strongly favors institution,” as did other *Fintiv* Factors. SAppx40. Cyandia argued that *Fintiv* Factor 4 “weighs in favor of denying institution under the unique circumstances of th[ese] case[s] because Petitioner’s stipulation does not” mitigate concerns over duplicative efforts or conflicting decisions, given that SAP “intends to rely on the WebSphere system described in the Petition’s cited art” in the district court. SAppx45 (citing SAppx49, ¶¶ 2-3).

c. On April 7, 2025, the Board discretionarily denied institution of both petitions. Appx4-15. With respect to *Fintiv* Factor 4, the Board stated that SAP’s *Sotera* stipulation “has limited practical effect in reducing the overlapping efforts here and in the Litigation.” Appx11. That is because “Petitioner contends in the district court that the system described in the WebSphere materials renders at least some of the challenged

claims invalid.” Appx11-12. And “[b]ecause Petitioner cannot challenge claims in [the IPRs] based on a public use or sale of the WebSphere system,” the Board continued, “Petitioner’s *Sotera* stipulation would not prevent Petitioner from asserting an invalidity defense in the district court based on the public use or sale of the WebSphere system.” Appx12. Indeed, the Board stated, “Petitioner has relied upon the WebSphere publications as prior art” in the district court litigation, “presumably as evidence describing the WebSphere system that was publicly used and on sale.” *Ibid.* “Accordingly,” the Board found that the *Sotera* stipulation would not “ensure that *inter partes* review would be a ‘true alternative’ to the Litigation.” *Ibid.*

After the Board’s decisions, SAP requested authorization to submit a new *Sotera* stipulation that would have given up its reliance on the WebSphere system art in the district court litigation. The Director denied the request as untimely. See Appx92.

d. On April 17, 2025, SAP requested Director Review of the decisions denying institution. SAP argued that the Board failed to correctly apply *Fintiv* and *Sotera*. Appx92-100. SAP did not challenge the Rescission Decision or Rescission Guidance.

The Director denied SAP’s requests for Director Review. Appx1-2.

THIS COURT SHOULD DENY SAP'S PETITIONS FOR WRITS OF MANDAMUS

Mandamus “is a drastic and extraordinary remedy reserved for really extraordinary causes.” *Cheney*, 542 U.S. at 380 (cleaned up). “[O]nly exceptional circumstances amounting to a judicial usurpation of power, or a clear abuse of discretion will justify the invocation of this extraordinary remedy.” *Ibid.* (citations omitted). “As the writ is one of the most potent weapons in the judicial arsenal, three conditions must be satisfied before it may issue.” *Ibid.* First, the petitioner must show that he has “no other adequate means to attain the relief he desires.” *Ibid.* Second, “the petitioner must satisfy the burden of showing that his right to issuance of the writ is clear and indisputable.” *Id.* at 380-381. Third, even if the first two prerequisites are met, the reviewing court “must be satisfied that the writ is appropriate under the circumstances.” *Id.* at 381; see *Mylan*, 989 F.3d at 1381-1382.

SAP has not satisfied that standard. The decision to institute *inter partes* review is committed to the Director’s unreviewable discretion. No petitioner has a right to institution—let alone to the Board’s use of particular internal guidance in exercising its discretion. Accordingly, SAP has not shown a “clear and indisputable” right to relief. It also has failed to show that issuance of the writ “is appropriate under the circumstances”—particularly since SAP never even argued to the Board that application of the Rescission Guidance would be inappropriate or unconstitutional. SAP’s

constitutional arguments are little more than an attempt to end-run the statutory bar on appellate review of institution decisions. They are wrong in any event.

SAP has pointed to no case in which this Court has ever granted mandamus to overturn the Board’s discretionary denial of institution. This Court should deny SAP’s extraordinary request to do so here.

I. THE DIRECTOR NEVER HAS A DUTY TO INSTITUTE *INTER PARTES* REVIEW—AND SO SAP HAS FAILED TO SHOW A CLEAR AND INDISPUTABLE RIGHT TO RELIEF

In order to obtain mandamus relief, a petitioner must show that it is owed a “clear and compelling duty,” *In re Cheney*, 406 F.3d 723, 729 (D.C. Cir. 2005), that is “so plainly prescribed as to be free from doubt and equivalent to a positive command,” *Wilbur v. U.S. ex rel. Kadrie*, 281 U.S. 206, 218-219 (1930). Accordingly, mandamus is only appropriate where an official has violated a duty “that admits of no discretion, so that the official in question has no authority to determine whether to perform the duty.” *Swan v. Clinton*, 100 F.3d 973, 977 (D.C. Cir. 1996); see *Nat’l Corn Growers Ass’n v. Baker*, 840 F.2d 1547, 1552 (Fed. Cir. 1988). “The law must not only authorize the demanded action, but require it.” *U.S. ex rel. McLennan v. Wilbur*, 283 U.S. 414, 420 (1931).

SAP has not even attempted to show a clear and compelling duty to institute *inter partes* review—because there isn’t one. The decision to institute is “a matter committed to the Patent Office’s discretion.” *Cuozzo*, 579 U.S. at 273. That is the exact *opposite* of clear and compelling duty. “Where a matter is committed to discretion, it cannot be

said that a litigant’s right to a particular result is ‘clear and indisputable.’” *Allied Chem. Corp. v. Daiiflon, Inc.*, 449 U.S. 33, 36 (1980).

Indeed, this Court has stated that “it is difficult to imagine a mandamus petition that challenges a denial of institution and identifies a clear and indisputable right to relief.” *Mylan*, 989 F.3d at 1382. “The Director is permitted, but never compelled, to institute an IPR. And no petitioner has a right to such institution.” *Ibid.* Thus, “the Director is free, as in this case, to determine that for reasons of administrative efficiency an IPR will not be instituted.” *Ibid.* Put simply, “where section 314(d) bars an appeal from a Board decision not to institute inter partes review, the petitioning party has no clear and indisputable right to challenge [the] non-institution decision directly in this court, including by way of mandamus.” *In re Power Integrations, Inc.*, 899 F.3d at 1320 (cleaned up).

This Court therefore held in *Mylan* that a petitioner “lacks a clear and indisputable right to review of the Patent Office’s determination to apply the *Fintiv* factors” in particular. *Mylan*, 989 F.3d at 1382. Yet that is exactly what SAP seeks here: review of the Board’s decision to apply the *Fintiv* factors (which the Rescission Guidance reaffirmed), rather than the Vidal Memo’s interim guidance regarding the application of those factors. *Mylan* squarely forecloses SAP’s mandamus claim.

SAP nevertheless attempts to shoehorn its mandamus petition into *Mylan*’s statement that “there is no reviewability of the Director’s exercise of his discretion to deny institution except for colorable constitutional claims.” See Pet. 3 (quoting *Mylan*,

989 F.3d at 1382). But a “disappointed petitioner cannot by-pass the statutory bar on appellate review simply by directing its challenge to asserted procedural irregularities rather than to the substance of the non-institution ruling.” *In re Power Integrations*, 899 F.3d at 1321. And that is the move that SAP makes here. It alleges that the Board’s decision denying institution was tainted by various “procedural irregularities”—namely, the Board’s decision to apply the Rescission Guidance that restored the *Fintiv* framework, rather than the Vidal Memo’s interim guidance. That is, at heart, a procedural challenge—notwithstanding SAP’s attempt to dress it up in constitutional garb. A petitioner might be able to seek mandamus relief in an edge case if the institution decision *itself* was unconstitutional—because, say, it was made pursuant to an unconstitutional delegation of legislative powers. But SAP’s complaint is simply that the Board, in exercising its unreviewable discretion to deny institution, followed one set of internal guidance rather than another set of internal guidance. That cannot form the basis of a mandamus claim.

SAP has therefore failed to show a clear and indisputable right to mandamus relief. Congress delegated the Director complete, unreviewable discretion to deny institution based on efficiency concerns—regardless of whether SAP *expected* the Vidal Memo to guide the Board’s exercise of that discretion. That alone deprives SAP of any clear and indisputable right to mandamus relief. See, e.g., *Heckler v. Ringer*, 466 U.S. 602, 616 (1984) (“The common-law writ of mandamus” can provide relief to a plaintiff “only if the defendant owes him a clear nondiscretionary duty.”). But as we next show, SAP

has failed to show any constitutional violation in the first place—and certainly no violation that would establish a clear and indisputable right to mandamus relief.

II. PETITIONER’S DUE PROCESS CLAIM LACKS MERIT

SAP contends that the Board erred in applying the Rescission Decision retroactively; that it “justifiably relied” on the Vidal Memo, Pet. 15; and that, as a result, the Board violated SAP’s Due Process rights. SAP’s arguments are flawed at every turn—and each error independently dooms SAP’s due process argument.

A. SAP Had No Property Or Liberty Interest In The Vidal Memo

In evaluating whether a party has suffered a due process violation, the Court must ask “whether there exists a liberty or property interest which has been interfered with by the State,” and “whether the procedures attendant upon that deprivation were constitutionally sufficient.” *Ky. Dep’t of Corr. v. Thompson*, 490 U.S. 454, 460 (1989). SAP flunks both steps.

1. The Vidal Memo does not concern any property or liberty interest, but rather a purported *procedural* right—the right to have a particular, interim rule applied in considering a petitioner’s request for institution. But “a statute [or rule] that merely establishes procedural requirements does not thereby create a liberty interest, because an expectation of receiving process is not, without more, a liberty interest protected by the Due Process Clause.” *Rodriguez v. McLoughlin*, 214 F.3d 328, 339 (2d Cir. 2000) (internal quotation marks omitted). Thus, “[p]rocess is not an end in itself”; its “constitutional purpose is to protect a *substantive* interest to which the individual has a

legitimate claim of entitlement.” *Olim v. Wakinekona*, 461 U.S. 238, 250 (1983) (emphasis added). Yet process is all that SAP invokes here: a purported entitlement to a particular internal procedure applied by the Board in determining whether to exercise its discretion to deny *inter partes* review. And, of course, neither SAP nor any other petitioner has a right to such review in the first place.

Because SAP “does not identify a deprivation of life, liberty, or property, . . . any procedural due process challenge is foreclosed.” *Mylan*, 989 F.3d at 1383 (cleaned up). Indeed, the only party with an *actual* property or liberty interest here is *Cyandia*—not SAP. Cyandia is the owner of the patents at issue, and thus the owner of the property right at stake. See 35 U.S.C. § 261 (“[P]atents shall have the attributes of personal property.”). And *inter partes* review constitutes a “reconsideration” of the government’s prior decision “to grant a patent” *to the patent holder*. *Oil States Energy Servs., LLC v. Greene’s Energy Grp., LLC*, 584 U.S. 325, 334-335 (2018) (emphasis omitted). SAP has no property or liberty interest in the procedures that the Patent Office uses when deciding whether to give such a “second look” at its own “earlier administrative grant of a patent” to a third party. *Cuozz*, 579 U.S. at 279; see *Oil States*, 584 U.S. at 343 n.5 (“inter partes review is not initiated by private parties” but by “the Director and committed to his unreviewable discretion”).

SAP’s reliance (Pet. 12) on cases such as *Goldberg v. Kelly*, 397 U.S. 254 (1970), is therefore misplaced. Those cases involved property interests that “stem[med] from an independent source such as state law.” *The Bd. of Regents of State Colleges v. Roth*, 408 U.S.

564, 577 (1972). Thus, the welfare recipient in *Goldberg* had “a claim of entitlement to welfare payments that was grounded in the statute defining eligibility for them,” *Roth*, 408 U.S. at 577—and was denied benefits without adequate process. *Goldberg*, 397 U.S. at 263-64. As noted, however, “no petitioner has a right to . . . institution.” *Mylan*, 989 F.3d at 1382; see *Roth*, 408 U.S. at 577 (to demonstrate property interest in a benefit, a party must “have a legitimate claim of entitlement to it”).

2. Even if SAP had a due process interest in the procedures applied by the Board, SAP does not argue (and cannot argue) that the particular procedures afforded by the Board under *Fintiv* and *Sotera* are not themselves “constitutionally sufficient.” *Thompson*, 490 U.S. at 460. SAP argues only that it *presumed* that a different set of internal procedures would be applied. But just as SAP has no entitlement to institution, it also has no entitlement to the Board’s use of particular procedures in making the institution decision. It is therefore beside the point whether, as SAP contends, filing a *Sotera* stipulation “was a *de facto* guarantee that an IPR petition would not be denied based on a parallel district court action.” Pet. 9.

But the Vidal Memo provided no such guarantee on the facts of this case in any event. The Board concluded that SAP’s *Sotera* stipulation was *inadequate* because, notwithstanding the stipulation, “Petitioner has relied upon the WebSphere publications as prior art” as “evidence describing the WebSphere system that was publicly used and on sale.” Appx12. Thus, the Board held that SAP’s stipulation did not, in fact, “mitigate[] concerns of potentially conflicting decisions and duplicative

efforts between the district court and the PTAB”—as the Vidal Memo expressly contemplated. Appx31. Nothing in the Vidal Memo required the Board to accept a *deficient* stipulation that, under the circumstances, had “limited practical effect in reducing the overlapping efforts here and in the Litigation.” Appx11. Indeed, Cyandia made that very point in its preliminary response to the petitions, explaining that a *Sotera* stipulation (which SAP had not yet filed) would do nothing to minimize duplicative efforts. SAppx20. Yet SAP responded only by filing just such a defective stipulation.

SAP suggests that the Board has accepted *Sotera* stipulations as a matter of course. See Pet. 9. But whether or not the Board accepted deficient *Sotera* stipulations in other cases, it was not *required* to do so here—even under the Vidal Memo’s interim guidance. In *Motorola Solutions, Inc. v. Stellar, LLC*, No. IPR2024-01205, Paper 11 (P.T.A.B. Feb. 13, 2025), for example, the Board cited the Vidal Memo’s “clarifications” regarding the *Fintiv* factors—but *still* engaged in a “weighing of [all] the factors” in deciding to institute review, even though the petitioner had submitted a *Sotera* stipulation. *Id.* at 9, 12. And even with respect to Factor 4, the Board did not rely solely on the stipulation, but also considered the “expenditure of time and effort” in preparing for trial. *Id.* at 11. That shows that the Vidal Memo was never a “guarantee” that a *Sotera* stipulation would short-circuit the *Fintiv* analysis in all cases.²

² The Director subsequently granted review and denied institution. *Motorola*, IPR2024-01205, Paper 19 (P.T.A.B. Mar. 28, 2025).

B. The Vidal Memo Did Not Create A Reasonable Reliance Interest

SAP contends that its due process rights were violated because it has a “reasonable reliance” on the Vidal Memo that was undermined by the Rescission Guidance. That contention also lacks merit.

1. SAP’s expectation that the Vidal Memo would apply to its petition is not a “settled expectation[]” “on which a party might reasonably place reliance.” *Qwest Servs. Corp. v. FCC*, 509 F.3d 531, 540 (D.C. Cir. 2007). The Vidal Memo expressly stated that it was “interim guidance” that would remain in effect only “until further notice.” Appx33. It further stated that the Patent Office “expects to replace this interim guidance with rules after it has completed formal rulemaking.” *Ibid*. Given those cautionary provisos, any reliance on the Vidal Memo would have been unreasonable. Indeed, agencies regularly revisit their internal guidance. Thus, even without the Vidal Memo’s “interim” label, “there was no reasonable assumption that the [Board] would keep its regulations static.” *Cox v. Kijakazj*, 77 F.4th 983, 993 (D.C. Cir. 2023).

SAP thus (doubly) misses the mark when it argues that an agency must “provide regulated parties fair warning of the conduct a regulation prohibits or requires.” Pet. 14 (quoting *Mexichem Fluor, Inc. v. EPA*, 866 F.3d 451, 462 (D.C. Cir. 2017)). For one thing, SAP is not a “regulated part[y],” like a manufacturer of hydrofluorocarbons subject to EPA regulations. See *Mexichem Fluor*, 866 F.3d at 457. The rescission of the Vidal Memo therefore did not affect SAP’s primary conduct or legal obligations. And SAP

did have “fair warning” here—namely, the Vidal Memo’s own statement that it was just “interim” guidance.

SAP’s reliance (Pet. 15) on *FDA v. Wages & White Lion Investments, L.L.C.*, 145 S. Ct. 898 (2025), is similarly misplaced.³ The Patent Office gave SAP “proper notice” of its rescission of the Vidal Memo (for the reasons stated) *and* “a reasonable opportunity for [SAP] to conform to the changed requirements.” *Ibid.* After the Rescission Decision was issued (and while SAP’s petitions remained pending), the Board allowed the parties to submit supplemental *Fintiv* briefs. And, after stating that the Rescission Decision “ha[d] little impact” on these IPRs—a concession that itself undermines any “clear and indisputable” right to relief—SAP went on to argue that the *Fintiv* factors weighed in favor of institution. SAppx40-41. SAP was thus able to make every argument that it would have made if the Rescission Decision and Guidance were in effect when it filed its petitions—and it did so *before* the Board issued its decisions denying institution.⁴

³ SAP cites a portion of *Wages* that characterizes the Fifth Circuit decision that the Supreme Court *vacated*. *Wages*, 145 S. Ct. at 918.

⁴ What is more, SAP never timely argued to the Board that application of the Rescission Guidance would be improper—even though the Rescission Guidance stated that “the Board will consider timely requests for additional briefing on the application of the Interim Procedure’s rescission on a case-by-case basis.” Appx83. As discussed further below, that is reason enough to deny mandamus.

Given that SAP had the opportunity to address the *Fintiv* factors after the rescission, SAP has failed to show that it has a “clear and indisputable” right to issuance of the writ. SAP was able to “conform to” the guidance, *Wages*, 145 S. Ct. at 918; it just failed to *convince* the Board to exercise its discretion to institute review based on the circumstances of this case. A “disappointed petitioner” is not entitled to mandamus relief. *In re Power Integrations*, 899 F.3d at 1321.

2. Even if it would have been reasonable to rely on the Vidal Memo’s guidance, SAP has not shown that it detrimentally relied on the guidance here.

To begin with, SAP’s petitions for *inter partes* review did not cite the Vidal Memo or include a *Sotera* stipulation. Instead, the petitions argued *under the Fintiv framework* that the Board should not deny review. That is not an argument that SAP would have made if it had relied solely on the Vidal Memo as dispositive. Indeed, SAP did not even serve a *Sotera* stipulation until January 14, 2025—more than three months after it filed its IPR petitions (on October 1, 2024). And that was only after Cyandia argued that “even a *Sotera*-style stipulation (which Petitioner has not provided) would result in the ‘duplication of work and create the potential for inconsistent decisions.’” SAppx20; see Appx80.

And even though SAP’s supposed detrimental reliance constitutes the entire basis of its due process claim, SAP devotes just two sentences to that argument in its mandamus petition. See Pet. 11, 15. Those cursory arguments are insufficient to show a “clear and indisputable” right to relief.

First, SAP states that it “took seven months to prepare and file its IPR petition[s]” in reliance on the Vidal Memo. Pet. 11. But SAP’s own IPR petitions say otherwise. Arguing against *Fintiv* denial, SAP stated that it “prepared and filed these petitions *promptly*, roughly four months after having received the infringement contentions on May 15, 2024.” SAppx4 (emphasis added). That (1) shows that SAP was well aware that the timeliness of its petitions could, in fact, factor into the Board’s institution decision under *Fintiv*; and (2) directly *undercuts* SAP’s argument that it took its time to file the petitions in reliance on the *Vidal Memo* (as opposed to the district court schedule).

Second, SAP states that it relied on the Vidal Memo’s guidance in asserting “related public-use and on-sale prior art in the parallel litigation.” Pet. 11; see *id.* at 15. But no one forced SAP to use the same evidence as prior art in both proceedings. SAP made that tactical choice in order to get two bites at the apple—relying on the WebSphere references both as invalidating printed publications in the IPR and as system art in the district court. What is more, SAP *could have* filed a broader stipulation after it learned of the Rescission Guidance, but while its petitions remained pending. It didn’t. Instead, SAP waited until the Board denied institution—and thus after SAP’s gambit had failed. SAP’s gamesmanship is not a reason to grant mandamus; it’s a reason that the writ is *not* “appropriate under the circumstances.” *Mylan*, 989 F.3d at 1382; see *NXP USA, Inc. v. Impinj, Inc.*, No. IPR2021-01556, 2022 WL 4116834, at *2 (P.T.A.B. Sept. 7, 2022) (“[P]ermitting a petitioner to wait and see if the Board denies institution

under *Fintiv*, and then offer such a stipulation for the first time on rehearing, frustrates these goals and would open the door to gamesmanship.”).

Indeed, SAP is still “free to litigate the . . . patent claims’ validity” based on the WebSphere references in “[the] district court case.” *Mylan*, 989 F.3d at 1383. That is yet another reason why issuance of the writ is inappropriate here. “A patent challenger does not have nearly as much to lose from an erroneous *denial* of inter partes review as a patent owner stands to lose from an erroneous *grant* of inter partes review.” *Cuozzo*, 579 U.S. at 294 n.6 (Alito, J., concurring in part). That is because a disappointed IPR petitioner “remains free to challenge the patent’s validity in litigation,” while “[a] patent owner, on the other hand, risks the destruction of a valuable property right.” *Ibid*.

For the same reason, SAP has failed to show that it lacks an “adequate means to attain the relief [SAP] desires.” *Cheney*, 542 U.S. at 380 (citation omitted). At bottom, SAP wants relief from liability in Cyandia’s *infringement action* against it. And there is no dispute that the district court will provide an adequate forum for SAP to challenge the validity of Cyandia’s patents.

C. The Rescission Guidance Was Not Retroactively Applied To SAP

SAP contends that the rescission of the Vidal Memo was impermissibly “retroactive.” Pet. 14. It wasn’t.⁵

“Changes in procedural rules may often be applied in suits arising before their enactment without raising concerns about retroactivity.” *Landgraf v. USI Film Prods.*, 511 U.S. 244, 275 (1994). “Because rules of procedure regulate secondary rather than primary conduct, the fact that a new procedural rule was instituted after the conduct giving rise to the suit does not make application of the rule at trial retroactive.” *Ibid.* And the Rescission Guidance is, at most, an internal rule of procedure guiding the Board’s exercise of its absolute discretion, delegated by Congress, regarding institution. SAP’s reliance (at 13) on *Landgraf* is thus misplaced, for two reasons: (1) the Rescission Guidance is a procedural rule, not a substantive rule; and (2) the relevant primary conduct at issue is SAP’s alleged *infringing conduct*—not the various decisions that SAP says that it made in seeking *inter partes* review.

SAP’s argument that “a statutory grant of legislative rulemaking authority will not, as a general matter, be understood to encompass the power to promulgate retroactive rules unless that power is conveyed by Congress in express terms” likewise fails. Pet. 10 (quoting *Bowen v. Georgetown Univ. Hosp.*, 488 U.S. 204, 208 (1988)). The

⁵ There is nothing inherently unconstitutional about a retroactive rule: “Congress has the power to enact laws with retrospective effect.” *I.N.S. v. St. Cyr*, 533 U.S. 289, 316 (2001). But the rescission not applied “retroactively” here, for the reasons explained.

Vidal Memo was not a “legislative” rule. See *Preminger v. Sec’y of Veterans Affs.*, 632 F.3d 1345, 1349 (Fed. Cir. 2011) (distinguishing between legislative and procedural rules). Thus, the presumption against retroactive effect would not even apply to the Rescission Guidance.⁶

But the Rescission Guidance was not impermissibly applied retroactively here in any event. Even with respect to substantive regulations (unlike the procedural Vidal Memo), “the general rule is that new law is applied to *pending* cases.” *Cox*, 77 F.4th at 991. And SAP’s petitions for *inter partes* review were still pending when the Board issued the Rescission Guidance. Indeed, SAP had the opportunity both to argue against application of the Rescission Guidance (which it declined to do) and to address how the *Fintiv* factors should be applied here (which it did do). There was nothing “retroactive” about the application of the Rescission Guidance (and *Fintiv* factors) here.⁷

⁶ Because the Vidal Memo was a procedural rule issued without notice-and-comment rulemaking, it could be rescinded without notice-and-comment rulemaking. *Perez v. Mortg. Bankers Ass’n*, 575 U.S. 92, 101 (2015); see 5 U.S.C. § 553(b)(A) (rules of procedure exempt from notice-and-comment requirements).

⁷ *Durr v. Nicholson*, 400 F.3d 1375 (Fed. Cir. 2005), is distinguishable. See Dkt. 9, US*Made Br. 2-3. *Durr* was not a due process case. Rather, the Veterans’ Court purported to alter jurisdictional filing requirements—and in so doing removed a statutory *right* to appeal. This Court therefore stated that applying the new requirements would “render invalid” the appellant’s notice of appeal. *Durr*, 400 F.3d at 1380. Here, however, there is no right to institution, which is committed to agency discretion by law. And even so, the Rescission Guidance did nothing to *bar* institution; it just restored the holistic *Fintiv* inquiry.

The only exception to the general rule that new substantive law applies to pending cases is where such application “would impair rights a party possessed when he acted, increase a party’s liability for past conduct, or impose new duties with respect to transactions already completed.” *Cox*, 77 F.4th at 991 (quoting *Landgraf*, 511 U.S. at 280). The rescission of the Vidal Memo did none of those things.

First, rescission did not impair SAP’s “vested rights,” because *no one* has a right to the Board’s use of particular procedures in the exercise of its discretion. *Cox*, 77 F.4th at 991. In *Cox*, for example, the court held that a claimant’s application for social security benefits in 2014 did not “vest her with any legal right to have her claim decided under the 2014 Listings [for determining disability], as opposed to the 2017 Listings.” *Ibid.*; see *Hispanic Info. & Telecomms. Network, Inc. v. FCC*, 865 F.2d 1289, 1294-1295 (D.C. Cir. 1989) (“The filing of an application creates no vested right to a hearing; if the substantive standards change so that the applicant is no longer qualified, the application may be dismissed.”). So too here. SAP protests that it believed that its petitions would be decided under the procedural framework outlined in the Vidal Memo. Even if true, however, “anticipation alone does not create a vested right,” and “[a] law that merely upsets expectations based in prior law is not retroactive on that basis.” *Cox*, 77 F.4th at 992 (internal quotation marks omitted).

What is more, SAP “overlooks” the fact that its inability to rely on the Vidal Memo was “not dispositive of [its] claim” of institution. *Ibid.* A petitioner “can still demonstrate,” *ibid.*, that the Board should not deny institution under the *Fintiv* factors

reaffirmed by the Rescission Guidance—which still considers a *Sotera* stipulation “highly relevant,” Appx84. Thus, the Rescission Guidance “did not deprive [SAP] of [its] ability to” show that institution was warranted on the facts. *Cox*, 77 F.4th at 992. It just removed a “presumption” that would (according to SAP) have made “further inquiry [into the remaining *Fintiv* factors] unnecessary.” *Ibid.* The rescission did not retroactively impair a vested right at all. *Ibid.*

Second, rescission of the Vidal memo did “not affect [SAP’s] primary conduct or legal obligations,” or increase its liabilities for past primary conduct. *Id.* at 993. Rather, it “regulate[d] how the [Board] makes its decisions about who is entitled to” *inter partes* review, *ibid.*, by returning institution decisions to the pre-Vidal Memo *status quo ante*. “While the [Board’s] rules affect its *own* obligations with respect to adjudicating [SAP’s petitions], they have no such effect on [SAP].” *Ibid.* (emphasis added).

* * *

This Court should reject SAP’s attempt to convert its challenge to the Board’s institution decision into a constitutional claim. SAP identifies no constitutional infirmity in either *the fact* of non-institution or the *particular procedures* that the Board applied to its IPR petitions. But even if this Court were to consider SAP’s due process argument on the merits, those arguments fail for multiple reasons. SAP has no property or liberty interest in the Board’s internal procedures; any reliance on the static application of those procedures would have been unreasonable; and the Rescission Guidance was not applied retroactively to SAP in any event. SAP has not shown any

constitutional violation—and certainly has not shown a “clear and indisputable” right to relief and that mandamus “is appropriate under the circumstances.” *Cheney*, 542 U.S. at 381.

III. SAP’S SEPARATION-OF-POWERS CLAIM LACKS MERIT

1. SAP also argues that “[t]he Board’s mandate that SAP accept a more expansive estoppel at institution than that imposed by the estoppel statute after a final written decision violates the separation of powers because it is inconsistent with the statute.” Pet. 16; see *id.* at 17 (citing 35 U.S.C. §§ 315(e)). That argument is foreclosed by *Mylan*.

In *Mylan*, the Board applied *Fintiv* and concluded that “it would be an inefficient use of resources to institute IPR” in light of the earlier trial date in a parallel district court proceeding and the overlap between the issues. *Mylan*, 989 F.3d at 1377-1378. The petitioner sought a writ of mandamus “based on two statutory challenges”: (1) that the Patent Office should have adopted the *Fintiv* factors through notice-and-comment rulemaking, and thus “exceeded the scope of its statutory authority”; and (2) that the *Fintiv* standard “unlawfully shortens the limitations period for filing an IPR” set forth in Section 315(b). *Id.* at 1381. This Court rejected both arguments. It held that “*Mylan* lacks a clear and indisputable right to review of the Patent Office’s determination to apply the *Fintiv* factors.” *Id.* at 1382. And, it continued, “*Mylan*’s time bar argument under § 315(b) fails for the same reason.” *Id.* at 1383.

Mylan compels denial of SAP’s mandamus petitions. Although SAP tries to repackage its estoppel argument as a “separation of powers” claim, its argument is that

the Board’s application of the *Fintiv* factors “is *inconsistent* with” Section 315—the same statute asserted in *Mylan*. Pet. 19 (emphasis added). But *Mylan* stands for the proposition that “inconsistency with” the IPR statute (Pet. 18) cannot justify mandamus relief. That is exactly the challenge that SAP brings here. SAP contends that the Board’s application of *Fintiv* Factor 4 to conclude that there would be “overlapping efforts here and in the [district court] Litigation,” Appx11, “was inconsistent with the statutory framework,” Pet. 19-20. But *Mylan* squarely held that the Board’s “determination to apply the *Fintiv* factors”—including Factor 4—“*cannot* be a basis for granting the petition for mandamus.” *Mylan*, 989 F.3d at 1382-1383 (emphasis added).

SAP cannot avoid that ineluctable result by renaming its statutory challenge a “separation of powers” claim. SAP’s objection is to the Board’s application of the *Fintiv* factors and its determination that those factors supported discretionary denial of institution on efficiency grounds. Section 314(b) expressly bars appeal of such determinations. SAP cannot use mandamus to end-run the statutory appeal bar—and this Court’s decision in *Mylan*.

Indeed, it is SAP that threatens the separation of powers. Congress committed the institution decision to the Director’s unreviewable discretion. Now, SAP asks this Court not only to review the Director’s decision (which is barred by statute), but also to micromanage *how* the Director exercises her unfettered discretion. SAP seeks to “convert the mandamus procedure into a transparent means of avoiding the statutory

prohibition on appellate review of agency institution decisions.” *In re Power Integrations*, 899 F.3d at 1321. This Court should decline the invitation to do so.

2. SAP is also wrong on the merits of its statutory claim. It contends that the Patent Office “has effectively rewritten th[e] estoppel statute by imposing a more expansive estoppel requirement at the institution stage than that imposed by the estoppel statute after a final written decision.” Pet. 18. That is because, according to SAP, Section 315(e) bars petitioners from asserting in district court that a patent claim is “invalid on any ground that the petitioner raised or reasonably could have raised during . . . inter partes review” and a petitioner cannot raise a “public use” invalidity ground in an IPR.

SAP gets it backwards. The Board never purported to limit what invalidity grounds SAP could assert *in the district court*. It simply concluded that it would be an inefficient use of the Board’s resources to institute review in this case, given that SAP relied on the same “WebSphere publications as prior art” in both proceedings. Appx12; see *ibid.* (noting that SAP could “continue to press an invalidity defense based on the same evidence presented here”). The Board was thus managing its *own* docket. SAP was free to assert whatever invalidity contentions that it wanted to assert in the district court (and remains free to do so). But that doesn’t mean that the Board had to turn a blind eye to those contentions when determining whether to exercise its discretion to deny institution based on efficiency concerns. Indeed, the fact that petitioners *can* rely on the same prior art in both tribunals provides an even greater reason for the Board

to consider the effect of overlapping evidence and issues. See *Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1366 (Fed. Cir. 2025).

IV. SAP HAS FORFEITED ITS CLAIM FOR RELIEF

For the reasons stated, SAP has failed to show a “clear and indisputable” right to mandamus relief and that issuance of the writ “is appropriate under the circumstances.” *Cheney*, 542 U.S. at 381. Issuance of the writ is particularly inappropriate here for yet another reason. SAP failed to timely press its claims before the Board—despite having every chance to do so. To recap:

(1) *The IPR petitions.* SAP did not argue in its IPR petitions that denial of institution would be improper in light of the Vidal Memo. Rather, SAP argued that “[t]he Board should not discretionarily deny institution under *Fintiv* because the district court case is still in its early stages.” SAppx4. SAP thus urged the Board to apply the very *Fintiv* standard that it now says is constitutionally infirm.

(2) *The Rescission Guidance.* The Rescission Guidance stated that the Board “will consider timely requests for additional briefing on the application of the Interim Procedure’s rescission on a case-by-case basis.” Appx83. Yet SAP never requested additional briefing to argue that application of the Rescission Guidance would be unlawful.

(3) *The supplemental Fintiv briefing.* The Board allowed the parties to file supplemental *Fintiv* briefs after the Rescission Decision. But SAP still did not argue in its supplemental brief that it detrimentally relied on the Vidal Memo, or that the

application of the *Fintiv* factors was unconstitutional as applied to its case. Instead, SAP simply stated that the rescission “has little impact on th[ese] IPR[s],” and again argued that the *Fintiv* factors weighed against discretionary denial. SAppx40-41.

(4) *SAP’s requests for Director Review*. SAP did not challenge the validity or application of the Rescission Guidance in its requests for Director Review. To the contrary, it emphasized that “*Fintiv* and *Sotera*” remain “binding precedents governing discretionary denial” *after the rescission* of the Vidal Memo—and faulted the Board for failing to apply the Rescission Guidance’s statement “that a *Sotera* stipulation is ‘highly relevant.’” Appx92, Appx95. That is the opposite of an argument that the Board should have applied the Vidal Memo.⁸

“It is well-established that a party generally may not challenge an agency decision on a basis that was not presented to the agency.” *In re DBC*, 545 F.3d 1373, 1378 (Fed. Cir. 2008); see *United States v. L. A. Tucker Truck Lines, Inc.*, 344 U.S. 33, 37 (1952) (“[O]rderly procedure and good administration require that objections to the proceedings of an administrative agency be made while it has opportunity for

⁸ As noted, SAP did not request authorization to submit a modified stipulation addressing the WebSphere references until *after* the Board’s decisions denying institution. SAppx51; Appx4. SAP’s request cited the rescission as a reason for its request. See SAppx53-54. But SAP could have submitted such a stipulation when it filed its supplemental *Fintiv* briefing—or indeed, at any point after the Rescission Guidance and *before* the institution decision. What is more, SAP then *withdrew* its proposed modified stipulation before its request for Director Review. Appx92. And SAP’s request for Director Review did not challenge the Director’s denial of the modified stipulation—or the constitutionality of the Rescission Guidance.

correction.”). This Court therefore routinely “decline[s]” a party’s “invitation to consider a challenge it failed to timely raise,” including constitutional challenges, on direct appeal. *In re DBC*, 545 F.3d at 1380; see *ibid.* (“To permit litigants . . . to raise such issues for the first time on appeal would encourage what Justice Scalia has referred to as sandbagging.”).

The fact that SAP’s challenge comes in the form of a petition for a writ of mandamus makes it even *less* deserving of this Court’s consideration of its new arguments—an “exceptional measure” even on direct appeal. *Ibid.* SAP knew that this Court lacks appellate jurisdiction to review the Board’s institution decision—and that the only chance to have its arguments heard in the ordinary course would thus be to press them before the Board. It didn’t do so. Instead, it raises those claims for the first time in its mandamus petitions. Issuance of the writ would not be “appropriate under the circumstances” where, as here, SAP sat on its (alleged) rights at every turn. *Cheney*, 542 U.S. at 380.

CONCLUSION

The Court should deny the petitions for writs of mandamus.

Respectfully submitted.

Dated: July 14, 2025

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CERTIFICATE OF COMPLIANCE

1. This brief complies with the type-volume limitation of Fed. R. App. P. 21(d)(1) because this brief contains 7,728 words, exclusive of the items exempted by Fed. R. App. P. 21(a)(2)(C) and Fed. Cir. R. 32(b)(2).

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Dated: July 14, 2025

/s/ Daniel N. Lerman
Daniel N. Lerman

Nos. 25-132, 25-133

United States Court of Appeals for the Federal Circuit

In Re SAP AMERICA, INC.,

Petitioner.

On Petitions for Writs of Mandamus to the United States Patent and
Trademark Office in Nos. IPR2024-01495 and IPR2024-01496

**SUPPLEMENTAL APPENDIX IN SUPPORT OF
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7	02/11/2025	Petitioner’s Reply to the Patent Owner Preliminary Response – IPR2024-01495	SAppx24
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner.

Case IPR2024-01495
U.S. Patent No. 8,578,285
Issued: November 5, 2013
Application No. 13/086,274
Filed: April 13, 2011

Title: Methods, Apparatus And Systems For Providing Secure Information Via
Multiple Authorized Channels To Authenticated Users And User Devices

PETITION FOR
INTER PARTES REVIEW OF U.S. PATENT NO. 8,578,285

SAP America, Inc. (“Petitioner”) respectfully requests *inter partes* review (“IPR”) of the claims currently asserted in the district court case (claims 1-10, 13, 17-18, and 36-42) (“challenged claims”) of U.S. Patent No. 8,578,285 (“’285 patent”) (EX1001), allegedly assigned to Cyandia, Inc. (“Patent Owner”), but with a security interest assigned to HPCF Litigation Finance US I LLC. For the reasons below, these claims should be found unpatentable and cancelled.

I. INTRODUCTION

The challenged claims relate to two concepts well-known in the prior art: (1) implementing a grid framework of “channels,” through which users receive and/or interact with secure information across user platforms, and (2) authenticating users, user platforms, and channels based on a user profile. The prior art IBM WebSphere references (EXS1004-1009) describe providing secure information to a user across user platforms with a grid of portlets (channels) and authentication of the users, platforms, and channels using a user profile. These references’ combined disclose every element of the challenged claims and render each challenged claim obvious.

II. GROUNDS FOR STANDING PER 37 C.F.R. § 42.104(a)

Petitioner certifies that the ’285 patent is available for IPR and that Petitioner is not barred or estopped from requesting an IPR challenging the patent claims on the ground identified in this petition.

III. IDENTIFICATION OF CHALLENGE**A. Statement Of The Precise Relief Requested / Statutory Ground**

Petitioner requests IPR of the challenged claims of the '285 patent, on the following statutory ground:

Ground	References	Basis	Claims
1	WebSphere-Portal (EX1004), Ben-Natan (EX1005), WebSphere-Everyplace ¹ (EXS1006-1009)	§ 103	1-10, 13, 17-18, 36-42

B. Denial Under § 325(d) Is Improper

None of the prior art references relied on herein were cited or substantively addressed on the record during prosecution, and nothing suggests that their teachings relied on herein—much less the combination of those teachings as informed by a POSITA's knowledge and expert testimony—were considered by the Examiner. *See, e.g., Mylan Pharm. Inc., v. Regeneron Pharm., Inc.*, IPR2022-01226, Paper 22 at 27-29 (PTAB Jan. 11, 2023). Accordingly, this petition should not be denied under Section 325(d).

¹ “WebSphere-Everyplace” is a four-volume set consisting of WebSphere-Everyplace-1 (EX1006), WebSphere-Everyplace-2 (EX1007), WebSphere-Everyplace-3 (EX1008), and WebSphere-Everyplace-4 (EX1009).

C. Fintiv Denial Is Improper

The Board should not discretionarily deny institution under *Fintiv* because the district court case is still in its early stages (only infringement and invalidity contentions have been exchanged). And even though a trial date is currently set for before the 18-month final written decision (FWD) deadline, that trial date may be postponed at least because: (1) Petitioner is filing four IPRs on three of the four asserted patents and plans to file a motion to stay in the district court, and (2) there is a pending motion and a cross-motion to transfer the case. Moreover, Petitioner prepared and filed these petitions promptly, roughly four months after having received the infringement contentions on May 15, 2024. This petition also presents compelling merits, as explained in Section VII.

IV. LEVEL OF SKILL IN THE ART, AND STATE OF THE ART**A. Person Of Ordinary Skill In The Art**

A person of ordinary skill in the art for purposes of the '285 patent in May 2008 ("POSITA") would have had a bachelor's degree in electrical engineering, computer science, or equivalent, with two or more years of experience developing and implementing graphical user interfaces for controlling server-based applications, including handling asynchronous notifications generated by those applications and web services, such as portal systems, or an equivalent amount of relevant work or research experience. A POSITA would have been familiar with

**VII. GROUND 1: THE CHALLENGED CLAIMS
ARE OBVIOUS OVER THE WEBSHERE REFERENCES**

As explained below, the challenged claims are obvious over the WebSphere references. The WebSphere references disclose or suggest every element of the challenged claims. EX1003, ¶55.

A. The WebSphere References

The WebSphere references—WebSphere-Portal (EX1004), Ben-Natan (EX1005), and WebSphere-Everyplace (EXS1006-1009)—are books describing aspects of the same IBM product: WebSphere. *E.g.*, EX1004, (a); EX1005, xxvi, 4; EX1006, (a); EX1007, (a); EX1008, (a); EX1009, (a). They primarily explain how to design, develop, and implement WebSphere Portal, an aspect of the WebSphere product that allows users to access information from a plurality of sources on a single user interface (a Portal Page). EX1004, xix, 4-51; EX1005, xxvi-xxx, 3-4, 7-12, 276, 473-480; EX1006, xi, 5-6, 25. Ben-Natan and WebSphere-Everyplace also describe another aspect of the WebSphere product, Everyplace Access (aka “WEA”), which “extend[s] [P]ortal functionality to mobile devices,” allowing users to leverage Portal functionality from virtually everywhere, hence the name “Everyplace.” EX1005, 473-480; EX1006, 1-5, 25, 27-29. EX1003, ¶¶56-57.

20. Claim 42

Claim 42 is substantively identical to claim 1 except claim 42 recites “At least one non-transitory computer readable storage medium storing processor-executable instructions that, when executed by at least one processor, perform a method,” rather than an “An apparatus,” and does not require a “communication interface.” Thus, claim 42 is obvious for the same reason claim 1 is obvious. *Supra* Section VII.B.1-3; *see* EX1040. EX1003, ¶¶218-227.

VIII. NO OBJECTIVE INDICIA OF NON-OBVIOUSNESS

Petitioner does not expect Patent Owner to argue for any objective indicia of non-obviousness that have a nexus to the difference between the claimed invention and the disclosure in the prior art cited herein (e.g., the IBM references and Austin-Lane). *Novartis AG v. Torrent Pharms. Ltd.*, 853 F.3d 1316, 1331 (Fed. Cir. 2017) (affirming PTAB obviousness decision). EX1003, ¶228.

IX. CONCLUSION

Petitioner requests institution for claims 1-10, 13, 17-18, and 36-42 on the ground specified in this petition.

Respectfully submitted,

October 1, 2024

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IPR2024-01495
Patent 8,578,285

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Patent 8,578,285

CERTIFICATE OF SERVICE
IN COMPLIANCE WITH 37 C.F.R. § 42.6(E)(4)

The undersigned certifies that the **Petition for *Inter Partes* Review of U.S. Patent No. 8,578,285 and Exhibits 1001 – 1044** were served on October 1, 2024, via **Express Mail** on the Patent Owner at the following address of record as listed on the USPTO Patent Center:

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**PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 C.F.R. § 42.107**

I. INTRODUCTION

Patent Owner respectfully requests that the Board deny the Petition because even with a combination of six different references, Petitioner is unable to identify all limitations of the Challenged Claims¹ in the prior art. In order to account for the significant gaps between the art and the claims, Petitioner resorts to ignoring the plain language of the claims and mischaracterizing the disclosures of the art. Given the lack of compelling merits, the fact that trial is scheduled to conclude in the co-pending litigation six months before a Final Written Decision is due in this case, and Petitioner's failure to supply a *Sotera*-style stipulation, Cyandia respectfully requests that the Board decline to institute trial pursuant to the *Fintiv* framework.

The Board should also deny the Petition on the merits. The '285 Patent claims a system that presents users with an interactive "matrix" of authorized channels, each of which presents and enables a user to interact with "secure user-centric information." This approach collects users' most important information from across different platforms and puts it at their fingertips while maintaining strict security measures. The art of record is an amalgam of documents related, more or less, to

¹ Petitioner, SAP America, Inc., disputes the patentability of Claims 1-10, 13, 17-18, and 36-42 ("the Challenged Claims") of U.S. Patent No. 8,578,285 (the "'285 Patent").

various different products developed by IBM under the “Websphere” marketing name. None of these documents disclose a matrix of channels that display and enable interaction with “secure user-centric information.” At best, the Websphere References disclose a set of static links or icons that a user may select in order to open a corresponding application.

The Websphere References also fail to disclose “synchroniz[ing] functions and features of one or more of the plurality of channels across two or more of the plurality of user platforms.” Instead, the Websphere References disclose the ability to access certain data from different devices without any indication that any “functions or features” are synchronized between those devices. Finally, Petitioner fails to identify with particularity “service support instructions that determine how the secure user-centric information behaves on at least one platform of the plurality of user platforms.” The disclosures that Petitioner cites with respect to this limitation—the synchronization of **data** across different devices—facially do not meet the claims.

Although there are a variety of reasons why the '285 Patent is valid over Petitioner's asserted prior art references, this Preliminary Response focuses on only limited reasons why *inter partes* review should not be instituted. See *Travelocity.com L.P. v. Cronos Techs., LLC*, No. CBM2014-00082, Paper 12 at 10 (P.T.A.B. Oct. 16, 2014) (“[N]othing may be gleaned from the Patent Owner's

challenge or failure to challenge the grounds of unpatentability for any particular reason.”).

II. BACKGROUND

A. Cyandia

Cyandia was founded on the idea of helping users manage and display information coming from an increasing number of different applications. Rather than force the user to chase down relevant information, the inventors conceived of a platform built on the premise that important information should be curated and served directly to the user. Their solution involved a novel system architecture that improved the management and utilization of the users’ computers and also of the servers hosting applications and users’ secure information.

After investing significant time and resources into research and development, Cyandia pioneered using an architecture that included a matrix of channels that provides a “cockpit” type view of the information important to the particular user that gives intelligent insights into a variety of different applications relevant to the user. These channels can be authorized to display secure information tailored to that particular user without needing them to open up individual applications. Cyandia developed a suite of technologies related to this concept, including those described and claimed in the ’285 Patent.

B. The State of the Art at the Time of the Invention

At the time of the invention of the '285 Patent, technology had made significant strides in creating digital content of many varieties. '285 Patent at 1:34-38. A common problem was the need to use dissimilar tools with many different types of data on different platforms, such as desktop computers and mobile devices. *Id.* at 1:40-47. Prior technologies were focused on creating different “windows” or “portals” containing icons that link to separate applications. *Id.* at 1:48-58. These traditional systems were poorly suited for complex cross-platform information management because they required users to hunt down the information that was most important to review at that moment. *Id.* at 1:59-2:3.

C. The '285 Patent

The '285 Patent describes technology for presenting, managing, and interacting with different types of information from multiple information sources across multiple computer devices. *Id.* at 2:9-18. In one embodiment, the '285 Patent describes a channel grid framework that presents a matrix of channels specifically authorized for the user. Each channel in the matrix displays and enables a user to interact with secure user-centric information. *Id.* at Abstract (“Multiple channels are configured and implemented, through which information relevant to a given user is presented for user interaction”); *see also id.* at 2:21-37. Figure 3 from the '285

Patent, reproduced below, shows an exemplary channel grid framework, including a matrix of channel 201:

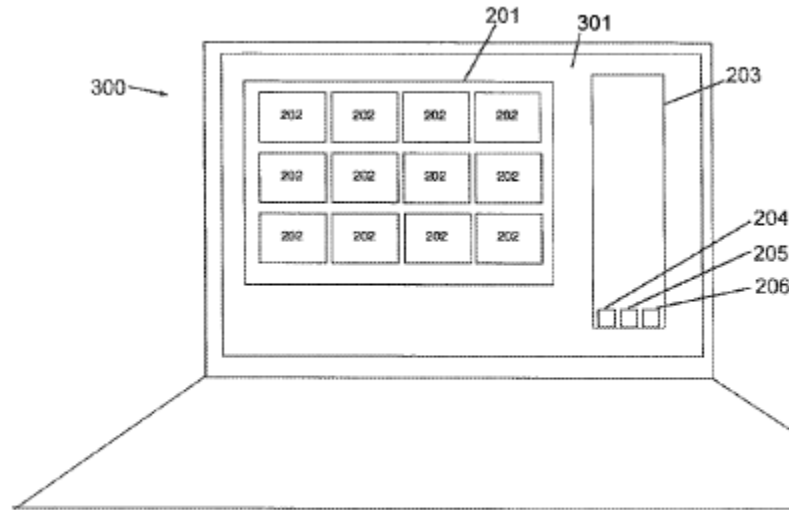


FIG. 3

Id. at Fig. 3.

These channels display different types of information such as “streaming video, audio, voice-over-IP communication, environmental monitoring information, financial services information, enterprise resource planning information,” etc. *Id.* at 4:16-30. “Each channel may be configured to perform complex functions both in how the information is synthesized and delivered as well as what the user may do with it (as may be driven by the identify [sic] and authorization granted to the user).” *Id.* at 4:30-34. Furthermore, U.S. Patent No. 8,751,948 (Ex. 1036, the “’948 Patent”), which is related to the ’285 Patent, describes how “the channel is a conduit

for delivering information to a user (e.g., providing access to and interaction with information).” ’948 Patent at 8:63-66.

The ’285 Patent describes using a web services gateway to generate the channel grid framework. ’285 Patent at 5:41-52. As noted, the ’285 Patent provides many different examples of application information that can be used with a channel. *Id.* at 4:16-30. The system is disclosed to integrate with different applications in order to expose functionality to the user through the visual component of the channel. *Id.* at 6:28-40 (“The channel grid framework 201 may also provide development, display, security, integration, and related feature implementation of services delivered through and coupled with the web-services gateway 207, . . .”).

The ’285 Patent also discloses exemplary embodiments for creating channels that access and present “secure” information, noting that this information is stored in a secure database and that the security of the user is confirmed before providing access:

When a user is associated with a channel 202 or specific services that may be enabled by the channel 202, access and security protocols may be identified for each condition and action to be performed by the user. **This information may be stored in a secure and specific database 219.** Every time the channel 202 is invoked or interrogated, **both the security of the applications affected as well as the security of the user may be confirmed.** Once authorized, the channel 202 services

may be performed, and the content provided by the computer application on the channel 202 may be evaluated.

Id. at 8:31-41 (emphasis added).

The '285 Patent also discloses synchronizing the functions and features of the channels across different devices, noting that “functions and features may remain operable and synchronized across all registered devices or platforms.” *Id.* at 7:30-32. The '285 Patent states that this is an advantage for when a user interacts with more than one device or platform because it may “allow full engagement of the functions provided by the channel 202.” *Id.* at 7:36-42.

III. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. § 314(a)

The Board should exercise its discretion to deny institution under 35 U.S.C. § 314(a) and *Apple Inc. v. Fintiv, Inc.*, No. IPR2020-00019, Paper 11 (P.T.A.B. Mar. 20, 2020) (precedential) (“*Fintiv*”) because the *Fintiv* factors overwhelmingly support denying institution. Moreover, the Board “retains discretion to deny institution for proceedings where abuse has been demonstrated.” Ex. 2005 at 4. The Board should exercise its discretion to deny institution.

A. *Fintiv* Factor 1: There is Little to no Likelihood that a Stay Would be Granted in District Court

Fintiv Factor 1 weighs in favor of discretionary denial because no motion to stay the case is pending, and Petitioner has presented no evidence that Judge Gilstrap would grant a stay if a trial is instituted. In fact, Judge Gilstrap frequently denies

stays in such cases. Ex. 2001, *Netlist, Inc. v. Micron Tech., Inc.*, No. 2:22-cv-00294-JRG, Dkt. 72 (E.D. Tex. Mar. 12, 2024) (denying motion to stay pending instituted IPRs); Ex. 2002, *Netlist, Inc. v. Samsung Elecs. Co.*, No. 2:22-cv-00293-JRG (“*Netlist-Samsung*”), Dkt. 180 (E.D. Tex. Oct. 17, 2023) (denying motion to stay pending instituted IPRs); Ex. 2003, *Netlist-Samsung*, Dkt. 689 (E.D. Tex. Mar. 11, 2024) (same).

B. *Fintiv* Factor 2: The District Court’s Scheduled Trial Date is Roughly Six Months Before the Expected Date of Any Final Written Decision

Fintiv Factor 2 weighs in favor of discretionary denial because trial is scheduled to begin in the co-pending litigation on October 6, 2025, six months before a final written decision is due in the case. Ex. 2006 at 1. The median time to trial in the Eastern District of Texas, where the parallel proceeding is pending, is 21.9 months. Ex. 2004. According to that metric, the parties can expect trial to begin on December 12, 2025, which is roughly four months before a Final Written Decision would be expected in this case. Accordingly, the Board should exercise its discretion to deny institution in order to avoid duplication of efforts and “potentially conflicting outcomes.” Ex. 2005 (June 21, 2022, PTAB Interim Procedure for Discretionary Denials) at 5.

The Board routinely exercises its discretion to deny institution even when the period between the scheduled trial date and the projected deadline for a final written

decision is far less than the four- or six-month period in this case. *See Samsung Display Co. v. Pictvia Displays Int'l Ltd.*, No. IPR2024-00855, Paper 12 at 2, 8-9 (P.T.A.B. Nov. 19, 2024); *see also, e.g., NXP USA, Inc. v. Impinj, Inc.*, No. IPR2021-01556, Paper 10 at 7-8 (P.T.A.B. Apr. 21, 2022) (two months between the scheduled trial and the deadline to reach a final written decision weighed in favor of discretionary denial); *eClinicalWorks, LLC v. Decapolis LLC*, No. IPR2022-00229, Paper 10 at 9 (P.T.A.B. Apr. 13, 2022) (one to two months between the scheduled jury trial and the deadline to reach a final decision weighed in favor of denial); *Immersion Sys. LLC v. Midas Green Techs., LLC*, No. IPR2021-01176, Paper 16 at 12-13 (P.T.A.B. Jan. 6, 2022) (three months between the scheduled trial date and the deadline to reach a final decision weighed in favor of exercising discretionary denial).

Given the trial schedule, it does not make sense to have the Board address patentability when it will have already been addressed at the District Court trial, particularly given the overlap of issues and the possibility of conflicting outcomes. Therefore, *Fintiv* factor 2 weighs in favor of the Board exercising its discretion to deny institution.

C. *Fintiv* Factor 3: Significant Investment in the Parallel Litigation Will Have Occurred by the Time the Board's Institution Decision is Due

The parties have already expended a significant amount of investment in the parallel litigation, having served infringement and invalidity contentions and claim construction terms. By the projected institution date, the parties would have already expended significant time in discovery and will have also filed their joint claim construction statement and have completed the claim construction hearing. *See* Ex. 2006 at 3 (Scheduling Order). In nearly identical circumstances, the Board recently found Factor 3 to be neutral. *Samsung Elecs. Co. v. Empire Tech. Dev. LLC*, No. IPR2024-00896, Paper 15 at 13-14 (P.T.A.B. Dec. 13, 2024).

D. *Fintiv* Factor 4: There is Substantial Overlap between the IPR Proceeding and the Parallel Litigation

Fintiv factor 4 weighs in favor of discretionary denial because “some of the claims challenged in the petition are also at issue in district court,” and the “petition includes the same or substantially the same claims, grounds, arguments, and evidence” as included in the parallel District Court litigation. *Fintiv* at 12-13. Here, Petitioner challenges every claim of the '285 Patent asserted in the parallel District Court litigation. Ex. 2007, Hannah Decl., ¶¶ 2-3. The Petition also “includes the same or substantially the same claims, grounds, arguments, and evidence” because there is substantial overlap between the primary references and arguments asserted in both forums. *Fintiv* at 12-13.

In the parallel litigation, Petitioner has asserted the WebSphere product and the WebSphere references as alleged prior art to the '285 Patent. Ex. 2007, Hannah Decl., ¶¶ 2-3. Given Petitioner's litigation strategy, even a *Sotera*-style stipulation (which Petitioner has not provided) would result in the "duplication of work and create the potential for inconsistent decisions." *Cf. Apple Inc. v. Maxell, Ltd.*, No. IPR2020-00407, Paper 12 at 12 (P.T.A.B. Aug. 11, 2020). Thus, despite Petitioner's statutory inability to raise the WebSphere product in this IPR, a substantial overlap of issues would remain even if Petitioner filed a *Sotera*-style or any other narrower case narrowing stipulation.

In view of the foregoing, *Fintiv* Factor 4 weighs strongly in favor of the Board exercising its discretion to deny institution.

E. *Fintiv* Factor 5: Petitioner is the Defendant in the Parallel Proceeding

Fintiv factor 5 weighs in favor of exercising discretionary denial because the parties are the same in both proceedings. *Fintiv* at 13-14.

F. *Fintiv* Factor 6: The Petition is Without Merit and SAP has Abused the Process

Fintiv factor 6 weighs in favor of discretionary denial because Petitioner fails to present a likelihood of success, much less "compelling evidence of unpatentability." *See* § VII, *infra*; Ex. 2005 (June 21, 2022 PTAB Interim Procedure for Discretionary Denials) at 4-5, 9. Despite relying on thousands of pages of

references, Petitioner fails to show a reasonable likelihood that any one of the Challenged Claims is unpatentable and, as such, the Board “has the authority . . . to exercise discretion to deny institution.” Ex. 2005 at 4.

In view of the foregoing, *Fintiv* Factor 6 weighs in favor of the Board exercising its discretion to deny institution.

* * * *

Each of the *Fintiv* factors is neutral or weighs in favor of denying institution, some strongly so. Cyandia respectfully requests, therefore, that the Board deny institution pursuant to 35 U.S.C. § 314(a).

IV. DESCRIPTION OF ALLEGED PRIOR ART

A. The WebSphere References

Petitioner relies on an amalgamation of different references for its Petition. For the independent claims alone, it relies on six different separate references, with many developed at different times, by different parties, and related to different products. These references, combined, account for over three thousand pages. Of the six references relied on by Petitioner for its combination, six² are related to the “WebSphere” marketing name, including:

² Although Petitioner states that it relies on “three WebSphere references,” it actually relies on six because the different volumes of WebSphere Everyplace

Respectfully submitted,

Dated: January 9, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the P-TACTS constitutes electronic service if Patent Owner send an email notifying Petitioner of the filing, service was made on the Petitioner as detailed below.

<i>Date of service</i>	January 9, 2025
<i>Manner of service</i>	Electronic Filing with the Board (roy.chamcharas@klarquist.com; andrew.mason@klarquist.com; todd.siegel@klarquist.com; samuel.thacker@klarquist.com; SAP_Cyandia_IPRs@klarquist.com)
<i>Documents served</i>	PATENT OWNER'S PRELIMINARY RESPONSE
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**PETITIONER'S REPLY TO
THE PATENT OWNER PRELIMINARY RESPONSE**

LIST OF EXHIBITS**LIST OF NEWLY FILED EXHIBITS**

Exhibits concurrently filed with Petitioner's Reply To The Patent Owner's Preliminary Response:

No.	Description
1045	Correspondence to Cyandia's Counsel (dated January 14, 2025) (<i>Sotera</i> stipulation)
1046	Plaintiff's Supplemental Preliminary Infringement Contentions Claim Chart for U.S. Patent No. 8,578,285 (Appendix B), <i>Cyandia, Inc. v. SAP America, Inc. et al.</i> , Case No. 2-24-cv-00096 (E.D. Tex.)

LIST OF PREVIOUSLY FILED EXHIBITS

No.	Description
1001	U.S. Patent No. 8,578,285 ("285 Patent")
1002	File History of U.S. Patent No. 8,578,285
1003	Declaration of Chris Schmandt, dated September 30, 2024
1004	<i>IBM Rational Application Developer V6 Portlet Application Development and Portal Tools</i> (August 2005) ("WebSphere-Portal")
1005	Ron Ben-Natan et al., <i>Mastering IBM WebSphere Portal</i> (2004) ("Ben-Natan")
1006	<i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume I: Installation and Administration</i> (May 2005) ("WebSphere-Everyplace-1")
1007	<i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume II: Application Development</i> (March 2005) ("WebSphere-Everyplace-2")

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No.	Description
1008	<i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume III: E-Mail and Database Synchronization</i> (April 2005) (“ WebSphere-Everyplace-3 ”)
1009	<i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume IV: Advanced Topics</i> (March 2005) (“ WebSphere-Everyplace-4 ”)
1010	<i>IBM Workplace Web Content Management for Portal 5.1 and IBM Workplace Web Content Management 2.5</i> (January 2006)
1011	<i>IBM WebSphere Portal Collaboration Security Handbook</i> (December 2004)
1012	<i>IBM WebSphere Everyplace Access Version 4.3 Handbook for Developers</i> (2nd ed. Nov. 2003)
1013	<i>IBM WebSphere Portal V5: A Guide for Portlet Application Development</i> (January 2004)
1014	U.S. Provisional Application No. 61/052,765
1015	U.S. Patent No. 7,376,907 (“ Santoro ”)
1016	U.S. Patent Application Pub. No. 2008/0256643 (“ Jones ”)
1017	<i>Microsoft Computer Dictionary</i> (5th ed.) (excerpts)
1018	U.S. Patent No. 5,548,692 (“ Cok ”)
1019	<i>Microsoft Internet Explorer ResourceKit</i> , Microsoft (1998)
1020	U.S. Patent Application Pub. No. 2007/0174782 (“ Russo ”)
1021	David Pogue, <i>iPhone The Missing Manual</i> (excerpts) (2007) (“ Pogue 2007 (iPhone) ”)
1022	David Pogue, <i>Mac OS X Leopard The Missing Manual</i> (excerpts) (2007) (“ Pogue 2007 ”)
1023	Harry Newton, <i>Newton’s Telecom Dictionary</i> (20th ed. 2004) (excerpts) (“ Newton 2004 ”)
1024	U.S. Patent Application Pub. No. 2004/0044736 (“ Austin-Lane ”)

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No.	Description
1025	Affidavit of Nathaniel Frank-White, Records Request Processor at the Internet Archive, dated August 16, 2024
1026	IBM Redbooks, <i>WebSphere Application Server V6 – System Management and Configuration Handbook</i> (February 2005)
1027	Copyright Office Public Catalog: detailed record catalog entry for <i>IBM Rational Application Developer V6, Portlet Application Development and Portal Tools</i> , 1st ed., Registration Number/Date: TX0006234319 / 2005-09-13
1028	Library of Congress Catalog: detailed record catalog entry for <i>IBM Rational Application Developer V6, Portlet Application Development and Portal Tools</i> , LCCN number: 2005284159
1029	Copyright Office Public Catalog: detailed record catalog entry for <i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume I: Installation and Administration</i> (May 2005), Registration Number/Date: TX0006244913 / 2005-08-12
1030	Library of Congress Catalog: detailed record catalog entry for <i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volumes I-IV</i> , LCCN number: 2005280318
1031	Copyright Office Public Catalog: detailed record catalog entry for <i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume II: Application Development</i> (March 2005), Registration Number/Date: TX0006170514 / 2005-05-20
1032	Copyright Office Public Catalog: detailed record catalog entry for <i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume III: E-Mail and Database Synchronization</i> (April 2005), Registration Number/Date: TX0006169440 / 2005-06-17
1033	Copyright Office Public Catalog: detailed record catalog entry for <i>IBM WebSphere Everyplace Access V5 Handbook for Developers and Administrators Volume IV: Advanced Topics</i> (March 2005), Registration Number/Date: TX0006170517 / 2005-05-20

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Patent 8,578,285

No.	Description
1034	U.S. Patent Application Pub. No. 2007/0283020 (“ Chowdary ”)
1035	U.S. Patent Application Pub. No. 2007/0033251 (“ Mandalia ”)
1036	U.S. Patent No. 8,751,948 (“ 948 Patent ”)
1037	WSRP standard 1.0 specification
1038	WSRP standard 2.0 specification
1039	U.S. Patent Application Pub. No. 2007/0130541 (“ Louch ”)
1040	Claims Listing
1041	U.S. Patent Application Pub. No. 2005/0159823
1042	Copyright Office Public Catalog: detailed record catalog entry for <i>Mastering IBM WebSphere Portal</i> (2004), Registration Number/Date: TX0006003513 / 2004-08-02
1043	Library of Congress Catalog: detailed record catalog entry for <i>Mastering IBM WebSphere Portal</i> (2004), LCCN number: 2004274459
1044	Affidavit of Nathaniel Frank-White, Records Request Processor at the Internet Archive, dated September 20, 2024

Pursuant to the Board email of January 28, 2025, Petitioner SAP America, Inc. submits this Reply to the POPR (Paper 6).

I. THE POPR’S IMPLIED CLAIM CONSTRUCTIONS ARE WRONG AND THE PRIOR ART RENDERS THE CLAIMS OBVIOUS¹

The POPR tries to distinguish the Petition’s prior art by importing limitations into three claim elements and alleging that certain prior art embodiments do not teach the elements under overly narrow constructions. The claim elements are not so narrow. Even if they were, the prior art discloses examples that teach them.

A. “a matrix of a plurality of channels through which the user receives and/or interacts with, via the plurality of user platforms, respective portions of the secure user-centric information” (EX1001, claims 1, 37, 42)

1. The POPR’s Implied Constructions Are Wrong And The Petition Explains Why The Prior Art Teaches This Element

Interacts: While the patent describes “interacts” with an example of clicking an icon to call up a native application, the POPR argues for a narrower implied construction excluding this embodiment. The POPR argues that to “interact” with a channel (Paper 6 at 24) requires more than “clicking on an icon to call up a separate application” (*id.* at 18-19). Nothing in the specification or claims requires more. The

¹ While the boundary of several of the claim terms is unclear, that indefiniteness does not prevent comparing the asserted prior art teachings to the challenged claims.

specification indicates the opposite because it describes channel interaction as clicking an icon that opens a separate native application apart from the channel. EX1001, 6:42-44 (“examples include static icons which may activate further functions”), 8:60-67 (“When the user interacts ... by ... clicking, ... interactions with information ... may be displayed in native applications or through a channel 202.”), 10:51-52. Moreover claim 13 recites that the patent’s channels are represented by “user-selectable items,” indicating selecting by a user (i.e., clicking) is encompassed. *Id.*, 17:40-44. The 2008 provisional, which the POPR cites in support of its implied construction (Paper 6 at 19), confirms that “channels can be animated or static and can display images and/or text” and “launch an application” (EX1014, 19-20, 24). Similarly, Patent Owner’s infringement contentions point to clickable “links” that “launch the corresponding apps” (EX1046, 3, 9 (“Each of the links is a secure user-centric channel”), 11).

User-centric: The POPR argues that “user-centric” requires that the visual component of the channels cannot be the same for different users of a system (i.e., not generic icons or links) (*see, e.g.*, Paper 6 at 20, 25). However, the patent states that “channels may be representative of any form of information or content” including “static icons.” EX1001, 6:41-44; *see also id.*, 10:51-52. The 2008 provisional explains that a channel “can be represented as static icons” (EX1014, 11; *see also id.*, 19-21, 24) and can be generic (*id.*, 27, 56). Static icons encompass

generic icons and are not necessarily user-specific. Patent Owner’s infringement contentions similarly point to links that “always look the same,” and thus are not user-specific representations. (EX1046, 11 (pointing to “Links are a different visual representation of a tile and always look the same: they consist of a title and an optional subtitle”).

“*Secure*”: Although the intrinsic evidence’s disclosure of “secure user-centric information” includes public information such as news or stocks, the POPR implies a narrower definition excluding these embodiments. *See* Paper 6 at 14, 23-24, 28-30. The POPR argues that for information to be “secure,” it must be “sensitive or other confidential information” (*id.* at 28) that is “securely maintained” (*id.* at 24) in “a secure and specific database” where “both the security of the applications affected as well as the security of the user may be confirmed” (*id.* at 28)—thus excluding a user’s selection of news and stocks. The intrinsic evidence refutes this narrow, implied construction in part by describing “secure user-centric information” as including RSS reader information, which is a news aggregator. EX1001, 4:14-24, 16:1-23 (claim 2: “the secure user-centric information includes ... RSS (Really Simple Syndication) reader information”). And the 2008 provisional identifies “news and stocks” as channel information. EX1014, 23, 28, 44-45. Moreover, the POPR argues that “just because the WebSphere references disclose a login screen, does not mean the data displayed is ‘secure’....” Paper 6 at 29. But Patent Owner’s

infringement contentions point to a single sign-on mechanism that prevents unauthorized access to secure user-centric information. EX1046, 23-24, 73-77.

Thus, the POPR's implied constructions are wrong, and the prior art teaches this limitation for at least the reasons in the Petition. *E.g.*, Paper 1 at 27-30, 34-40.

2. Prior Art Teaches Element Under POPR's Constructions

Interacts: The WebSphere references describe interacting with channels while in the channel grid framework in more ways than just clicking a link or icon to open a separate display (e.g., an application) (e.g., Paper 1 at 34-39), as alleged in the POPR. Paper 6 at 2, 14-15, 24-26. The stock portlet allows the user to interact with dynamic stock information while in the channel grid framework by entering a specific stock in a search box and selecting a "Get Quote" button. EX1005, 276 (cited by Paper 1 at 14); EX1006, 43 (cited by Paper 1 at 19). A poll portlet allows a user to interact with dynamic poll information while in the channel grid framework by voting for one or more poll options and viewing the results of the poll. EX1005, 276 (cited by Paper 1 at 14), 277 (cited by Paper 1 at 35, 38-39). Each portlet displays an edit icon within the channel grid framework that, when selected, allows the user to configure the portlet (e.g., set the city from which they receive dynamic weather information) while in the channel grid framework. EX1004, 50 (cited by Paper 1 at

43, 46); EX1005, 245 (cited by Paper 1 at 73, 89).² Each channel (portlet) is further interactive in that it responds to user input in another channel within the matrix. “In ‘live’ portals ... the user is presented with one portlet on a page that presents a choice of data, a list of stocks for example, and choosing from the list causes another portlet to be updated with the details of the choice.” EX1004, 152 (cited by Paper 1 at 27, 35, 38-39, 44, 61, 86), 39 (cited by Paper 1 at 41, 54, 61).

User-centric: As explained in the Petition (Paper 1), the WebSphere references’ channels (portlets) are “user-specific” at least because each user’s preferences and access rights determine which channels are displayed in the channel grid and which information is displayed within each channel. *E.g.*, Paper 1 at 27-30, 54. “Personalization enables the portal to deliver user-specific information targeting a user based on their unique information.” EX1004, 2 (quoted by Paper 1 at 27). “Base customization, such as choosing which portlets are desired on a page, is accomplished by the user via administration functionality. Advanced personalization

² Reliance on these portlets is permissible because 1) the Petition cites to the pages where these portlets are disclosed, 2) they are part of the same embodiment (portlets on a portal page) relied on in the Petition, 3) they are raised in direct response to the POPR’s new claim construction arguments, and 4) Cyandia can respond. *Cf. Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1379, 1384 (Fed. Cir. 2023).

via rules engines, user preferences and profiles is accomplished by the provided personalization services.” EX1004, 16 (cited by Paper 1 at 46).

Secure: The channels display sensitive or confidential information sent from a secure server. The channels display internal (non-public) company news, such as “Your Co Cafeteria Serving 64oz Diet Coke for 99 cents,” and the URL indicates a user has logged in. EX1004, 49 (quoted by Paper 1 at 36). The channels also include a user’s secure email account, notes, calendar, and contacts. Paper 1 at 29, 35 (citing, e.g., EX1005, 141). The channels also allow user interaction with bank accounts (EX1004, 632 (cited by Paper 1 at 73, 78, 84), 418-419) and other non-public corporate information, including human resources, enterprise resource planning, and customer relationship management information. EX1004, 4, 41 (cited by Paper 1 at 4, 73); EX1005, xxv, 392-397, 439, 462-463, 469. This information is sent from a secure server (e.g., a producer portal server) that is authenticated using a certificate. EX1004, 899-900 (cited by Paper 1 at 4-5, 10, 21, 26, 28-29, 39, 54, 65).

B. “service support instructions that determine how the secure user-centric information behaves” (EX1001, claims 1, 37, 42)

1. The POPR’s Implied Construction Is Wrong And The Petition Explains Why The Prior Art Teaches This Element

In contradiction to the specification and infringement contentions, the POPR argues that “service support instructions” exclude “user preferences” dictating “a consistent look and feel” across platforms. Paper 6 at 35-36. The specification,

however, expressly describes “service support instructions” as “instructions as to how the user wishes information to behave” (EX1001, 7:53-54) (i.e., user preferences), and Patent Owner’s infringement contentions point to “instructions allowing the user to have the same or personalized experience (such as same design) across all the devices he is using” (EX1046, 14) (i.e., a consistent look and feel). The POPR construction also improperly requires dictating how the information behaves *in a channel displayed in a matrix* (Paper 6 at 36), while the claim language more broadly refers to how “information behaves on at least one platform.” EX1001, 15:30-31. Thus, the POPR’s narrow construction is wrong, and the prior art teaches this limitation for at least the reasons in the Petition. Paper 1 at 42-46.

1. Prior Art Teaches Element Under POPR’s Construction

Even under the POPR’s improper construction, the WebSphere references teach this claim element. WebSphere’s page aggregation dictates how information behaves in a channel while displayed in a matrix, using device and portlet information, and user preferences: “Page aggregation is the process that collects information about the user’s choices, the device being used and the selected portlets, then takes that information and combines it to create a display that is appropriate for the device.” EX1004, 27 (cited by Paper 1 at 44, 46). A portal page is “the product of the aggregation of several information sources, which include the portal page ..., page theme, skins, and the screen.” EX1005, 143-163 (cited by Paper 1 at 19, 45);

see also Section I.A.2 (describing information behavior within in the matrix). Moreover, as explained in Petition and above, the information delivered to the user is screened based on the user's role / access rights (*e.g.*, Paper 1 at 21, 53-58) and preferences (*supra* Section I.A.2). Further, channels behave dynamically in response to user inputs made to other channels. *Supra* Section I.A.2. (citing, *e.g.*, EX1004, 39 (cited by Paper 1 at 41, 54, 61), 152 (cited by Paper 1 at 27, 35, 38-39, 44, 61, 86).

C. “synchronize functions and features of one or more of the plurality of channels” (EX1001, claims 1, 37, 42)

1. The POPR's Implied Construction Is Wrong And The Petition Explains Why The Prior Art Teaches This Element

Despite the claim language stating that “synchroniz[ing] functions and features” is caused “by deploying the secure user-centric information” (EX1001, 15:23-26), the POPR instead argues that “synchroniz[ing] functions and features” is “separate and distinct from the ‘information’ presented in a channel” and refers to “how information is synthesized and delivered to a user.” Paper 6 at 33-34. Nothing in the specification so alters the express claim language. Moreover, Patent Owner's infringement contentions contradict POPR's implied construction: “The Accused Instrumentalities synchronize *data* [i.e., information] that is contained within SAP Fiori between different platforms via a processor.” (EX1046, 9 (emphasis added)). Thus, the POPR's construction is wrong, and the prior art teaches this limitation for at least the reasons in the Petition. Paper 1 at 41-42.

2. Prior Art Teaches Element Under POPR's Construction

Even under the POPR's improper construction, the WebSphere references still teach this claim element. The POPR is wrong that the WebSphere references' synchronization is limited to data synchronization or deployment of information. The WebSphere references describe synchronization of settings, which control how information is synthesized and delivered, based on at least controls and restrictions for date, priority, conflict resolution, privacy, time zone, and scope—all functions and features of synchronized contacts, tasks, calendars, memos, etc. *E.g.*, EX1008, 2, 38, 43, 50, 55, 101, 116, 144³; Paper 1 at 41-42, 60, 75-76, 79. The POPR also ignores the Petition's citations to the WEA references which describe synchronization of portlets across devices. EX1005, 479-480 (describing "synchronization functionality with Microsoft Exchange and Lotus notes").

II. CONCLUSION

Patent Owner's arguments should be rejected and trial instituted.

Dated: February 11, 2025

Respectfully submitted,

By: /Roy Chamcharas/
Roy Chamcharas (Reg. No. 61,735)
Lead Counsel for Petitioner

³ See *supra* fn. 2 (explaining why reliance on this disclosure is permissible).

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Patent 8,578,285

CERTIFICATE OF SERVICE
IN COMPLIANCE WITH 37 C.F.R. § 42.6(e)(4)

The undersigned certifies that on February 11, 2025, Petitioner emailed copies of **Petitioner's Reply To The Patent Owner Preliminary Response and Exhibits 1045 and 1046** to the following email addresses, which Patent Owner has agreed constitutes service. *See* Paper 4 (Patent Owner's Mandatory Notices).

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Lead Counsel for Petitioner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner.

IPR2024-01495
Patent 8,578,285

**PETITIONER'S SUPPLEMENTAL BRIEF REGARDING *FINTIV*,
PURSUANT TO THE BOARD EMAIL OF MARCH 5, 2025**

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Even if the Vidal Memo no longer controls, its rescission has little impact on this IPR. Petitioner's *Sotera* stipulation (EX1045) (factor 4), though not *Fintiv*-dispositive, still strongly favors institution, and factors 3 and 6 also favor institution. These factors outweigh the others, including factor 2 (trial date), especially since Petitioner was diligent in filing its Petitions roughly four months after being served the infringement contentions. The Board should thus institute IPR, as it has done in situations with an even earlier trial date and far more district court investment. *E.g.*, *Samsung Elecs. Co. v. Acorn Semi, LLC*, IPR2020-01183, Paper 17 at 38-47 (PTAB Feb. 10, 2021) (instituting IPR, despite Judge Gilstrap having set trial ten months before the FWD deadline and the parties having completed invalidity expert reports and expert discovery, because of Petitioner's *Sotera* stipulation and diligence in filing petitions about four months after the infringement contentions).

Factor 1 (stay) is neutral as Petitioner will move to stay the litigation if IPR is instituted. *E.g.*, *Samsung*, IPR2020-01183, Paper 17 at 36-37.

Factor 2 (trial date) only slightly favors Petitioner. The trial date is set for about six months before a FWD is due (Oct. 6, 2025 vs. Apr. 9, 2026) (EX2006, 1; Paper 3 at 1), but that date is uncertain due to the pending transfer motion and cross-motion. *Zynga Inc. v. IGT*, IPR2022-00199, Paper 11 at 13-14 (PTAB Jun. 14, 2022).

Factor 3 (investment) favors institution or, at best, is neutral (as argued by the POPR, Paper 6 at 10) because significant work remains on the prior art invalidity

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issues in district court. While a *Markman* hearing is set for April 2nd, the court has not issued any substantive orders, held any hearings, or otherwise invested resources on prior art invalidity issues. Opening expert reports are not due until May 12th and expert discovery closes June 23rd. EX2006, 2-3. *Samsung Elecs. Am., Inc. v. Proxense, LLC*, IPR2021-01439, Paper 11 at 10-12 (PTAB Feb. 28, 2022). Petitions were filed diligently, roughly four months after infringement contentions (May 15 vs. Oct. 1) (EX2006, 4; Paper 3 at 1). *Samsung*, IPR2020-01183, Paper 17 at 40.

Factor 4 (overlap) strongly favors institution given the *Sotera* stipulation (EX1045). *Samsung*, IPR2020-01183, Paper 17 at 40-45. Also, most of the challenged claims will be dropped from district court. *See Cyandia, Inc. v. SAP Am., Inc.*, No. 2:24-cv-00096-JRG, ECF No. 68 at 2 (E.D. Tex. Jan. 23, 2025); *cf. Apple Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 17 (PTAB Jun. 15, 2020).

Factor 6 favors institution because the obviousness grounds are compelling, as confirmed by Patent Owner relying on strained claim constructions that contradict its infringement contentions and raising apparent anticipation arguments (that a single prior art embodiment allegedly does not disclose every claim element) without squarely addressing obviousness. Paper 6 at 15-37; Paper 8 at 2-9.

Dated: March 12, 2025

Respectfully submitted,

By: /Roy Chamcharas/
Roy Chamcharas (Reg. No. 61,735)
Lead Counsel for Petitioner

CERTIFICATE OF SERVICE
IN COMPLIANCE WITH 37 C.F.R. § 42.6(e)(4)

The undersigned certifies that on March 12, 2025, Petitioner emailed copies of **Petitioner's Supplemental Brief Regarding *Fintiv*** to the following email addresses, which Patent Owner has agreed constitutes service. *See* Paper 4 (Patent Owner's Mandatory Notices).

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner.

Case IPR2024-01495
U.S. Patent No. 8,578,285

PATENT OWNER'S SUPPLEMENTAL *FINTIV* BRIEFING

Under the “Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation,” the PTAB was instructed not to deny a petition based on the *Fintiv* factors if the petitioner stipulated not to raise before the district court any grounds that it reasonably could have raised before the PTAB. Ex. 2005 at 7. Such stipulations are no longer dispositive, and portions of decisions relying on the Procedure are no longer informative or precedential. Despite Petitioner’s *Sotera* stipulation, the *Fintiv* factors weigh in favor of denial.

Factor 1 weighs in favor of denying institution because there is little to no likelihood that the judge will stay this case. The judge overseeing the dispute between the parties recently denied a motion to stay under nearly identical circumstances. *Gen. Access Sols., Ltd., v. Cellco P’ship*, No. 2:22-cv-00394-JRG, Dkt. 225 at 3-4 (E.D. Tex. May 22, 2024) (denying a motion to stay where it would prejudice Patent Owner, “the PTAB decision is not due until over six months after jury trial is set to begin Jury selection was a mere five months away,” and a *Markman* hearing had been held). Factor 1 is *at least* neutral. *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 7-8, n.12 (P.T.A.B. Mar. 20 2020).

Factor 2 weighs moderately to strongly in favor of denying institution because trial is scheduled to begin in the co-pending district court litigation six months before a Final Written Decision is expected in this case. *Samsung v. Mojo*, IPR2023-01098 (“*Samsung*”), Paper 11 at 8, 31 (P.T.A.B. Feb. 9, 2024).

Factor 3 weighs in favor of denying institution (and is at least neutral) because the parties have expended significant fact discovery, and the *Markman* hearing will be held before institution. *Id.* at 8-9, 31. Petitioner also delayed filing this Petition for over four months after receiving Cyandia’s infringement contentions. *AT&T Servs. v. ASUS Tech.*, IPR2024-00992, Paper 14 at 12 (P.T.A.B. Dec. 16, 2024) (five months between infringement contentions and the petition is a “substantial delay”).

Factor 4 weighs in favor of denying institution under the unique circumstances of this case because Petitioner’s stipulation does not “mitigate[] any concerns of duplicative efforts” or “potentially conflicting decisions.” *Sotera* at 19. Despite Petitioner’s *Sotera* stipulation, the issues raised in this IPR Petition will overlap with those raised in the district court because Petitioner intends to rely on the WebSphere system described in the Petition’s cited art. Ex. 2007, ¶¶ 2-3. Nevertheless, the Board should deny institution because the balance of the *Fintiv* factors weigh in favor of denying institution. *Cisco v. Estech*, IPR2021-00332, Paper 11 at 12 (P.T.A.B. July 7, 2021) (denying a petition despite a *Sotera* stipulation).

Factor 5 weighs in favor of denial because the parties are identical.

Factor 6 weighs in favor of denial because there is a pending district court action that could resolve the entire four-patent dispute between the parties, and it would be inefficient to conduct up to four *inter partes* reviews to resolve only a subset of issues for a subset of patents in the dispute. *Samsung* at 31; Pet. at 3.

Respectfully submitted,

Dated: March 12, 2025

/James Hannah/

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the P-TACTS constitutes electronic service if Patent Owner send an email notifying Petitioner of the filing, service was made on the Petitioner as detailed below.

<i>Date of service</i>	March 12, 2025
<i>Manner of service</i>	Electronic Filing with the Board (roy.chamcharas@klarquist.com; andrew.mason@klarquist.com; todd.siegel@klarquist.com; Samuel.thacker@klarquist.com; SAP_Cyandia_IPRs@klarquist.com)
<i>Documents served</i>	PATENT OWNER’S SUPPLEMENTAL <i>FINTIV</i> BRIEFING
<i>Persons Served</i>	KLARQUIST SPARKMAN, LLP, Roy Chamcharas, Andrew M. Mason, Todd M. Siegel, Samuel B. Thacker

/James Hannah/
James Hannah
Registration No. 56,369
Lead Counsel for Patent Owner

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SAP AMERICA, INC.,
Petitioner,

v.

CYANDIA, INC.,
Patent Owner.

Case IPR2024-01495
U.S. Patent No. 8,578,285

**DECLARATION OF JAMES HANNAH IN SUPPORT OF
PATENT OWNER'S PRELIMINARY RESPONSE**

I, James Hannah, declare as follows:

1. I am partner at the law firm of Kramer Levin Naftalis & Frankel LLP, attorneys for Patent Owner Cyandia, Inc. (“Patent Owner”), in the above-captioned *inter partes* review proceeding involving Petitioner SAP America, Inc. and its associated entities (“Petitioner”). I provide this Declaration in support of Patent Owner’s Preliminary Response based upon my personal knowledge.

2. In the co-pending litigation, *Cyandia, Inc., v. SAP America, Inc. and SAP SE*, C.A. No. 2:24-cv-00096-JRG, Patent Owner asserted infringement of Claims 1-7, 10, 11, 13, 18, 19, 21, 29, 35, and 36 of U.S. Patent No. 8,751,948, Claims 1-10, 13, 17, 18, 36-40, and 42 of U.S. Patent No. 8,578,285, and Claims 1-11, 13, 16, 18, and 31-34 of U.S. Patent No. 8,595,641.

3. Petitioner served its invalidity contentions under Eastern District of Texas Patent Local Rule 3-3 on July 10, 2024. Within the invalidity contentions, Petitioner asserts the Websphere product and the six IBM WebSphere references that are also asserted in IPR2024-01495.

4. I declare that all statements made herein of my knowledge are true, and that all statements made on information and belief are believed to be true, and that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

/James Hannah/

James Hannah

From: [Director_PTABDecision_Review](#)
To: ["Price, Jeffrey H."; Roy Chamcharas; andrew.mason@klarquist.com; Todd M. Siegel; Samuel Thacker; Hannah, James; Fuller, Jenna; Kastens, Kris; Keller, Charles](#)
Subject: RE: IPR2024-01432, -01495, 01496 - Request for Authorization to Submit New Evidence with Director Review Request
Date: Thursday, April 10, 2025 3:34:00 PM

Counsel,

Petitioner's request is denied as untimely.

Thank you.

From: Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>
Sent: Wednesday, April 9, 2025 9:52 PM
To: Roy Chamcharas <Roy.Chamcharas@klarquist.com>; Director_PTABDecision_Review <Director_PTABDecision_Review@uspto.gov>
Cc: andrew.mason@klarquist.com; Todd M. Siegel <todd.siegel@klarquist.com>; Samuel Thacker <Samuel.Thacker@klarquist.com>; Hannah, James <JHannah@KRAMERLEVIN.com>; Fuller, Jenna <JFuller@KRAMERLEVIN.com>; Kastens, Kris <KKastens@KRAMERLEVIN.com>; Keller, Charles <CKeller@KRAMERLEVIN.com>
Subject: RE: IPR2024-01432, -01495, 01496 - Request for Authorization to Submit New Evidence with Director Review Request

CAUTION: This email has originated from a source outside of USPTO. **PLEASE CONSIDER THE SOURCE** before responding, clicking on links, or opening attachments.

Dear Director Stewart,

Cyandia respectfully requests that Petitioner's request to file this stipulation be denied as untimely under *NXP USA, Inc. v. Impinj, Inc.*, IPR2021-01556, Paper 13 (September 7, 2022) (precedential). Petitioner had an opportunity to brief the *Finitiv* factors and submit this stipulation post-rescission of the Vidal Memo, but it waited until after the Decision Denying Institution in IPR2024-01432 to make this stipulation.

To the extent that Petitioner's request is granted, Patent Owner respectfully requests the Director to: (1) treat this argumentative email as Petitioner's Request for Director Review and (2) grant Cyandia a five-page response consistent with the Director Review Process guidelines.

Kind regards,
Jeff Price
Counsel for Patent Owner, Cyandia Inc.

Jeffrey H. Price
Special Counsel

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From: Roy Chamcharas <Roy.Chamcharas@klarquist.com>

Sent: Wednesday, April 9, 2025 7:34 PM

To: Director_PTABDecision_Review@uspto.gov

Cc: Andrew M. Mason <andrew.mason@klarquist.com>; Todd M. Siegel <todd.siegel@klarquist.com>; Samuel Thacker <Samuel.Thacker@klarquist.com>; Hannah, James <JHannah@KRAMERLEVIN.com>; Price, Jeffrey H. <JPrice@KRAMERLEVIN.com>; Fuller, Jenna <JFuller@KRAMERLEVIN.com>; Kastens, Kris <KKastens@KRAMERLEVIN.com>; Keller, Charles <CKeller@KRAMERLEVIN.com>

Subject: [EXTERNAL] IPR2024-01432, -01495, 01496 - Request for Authorization to Submit New Evidence with Director Review Request

Dear Director Stewart,

In each of IPR2024-01432, -01495, and -01496, Petitioner SAP America, Inc. (“Petitioner”) respectfully requests authorization to submit as a new exhibit a copy of the stipulation made by Petitioner on April 7, 2025 (“the *Sotera*-plus stipulation”) to support a forthcoming request for Director Review of the decisions denying institution in the three above-noted IPRs. IPR2024-01432, Paper 14; IPR2024-01495, Paper 13; IPR2024-01496, Paper 13. Petitioner makes this request pursuant to Office guidance on the Director Review process. *See* § 3.E at <https://www.uspto.gov/patents/ptab/decisions/director-review-process>; 37 C.F.R. § 42.75(c)(3).

The *Sotera*-plus stipulation expands upon Petitioner’s earlier-filed *Sotera* stipulation (IPR2024-01432, EX1045; IPR2024-01495, EX1045; IPR2024-01496, EX1045) and agrees to drop all IBM WebSphere-based prior art invalidity defenses, including such defenses based on IBM system art, from the district court litigation for each patent for which IPR is instituted.

Petitioner should be allowed to file this stipulation because of intervening changes in USPTO procedures, guidance, and decisions, including changes in how the Board treats *Sotera* stipulations and conducts a *Fintiv* analysis post-rescission of former Director Vidal’s June 21, 2022 Memorandum titled *Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation* (“Vidal memo”).

Specifically, in the roughly one-and-half-month period since Petitioner filed its *Sotera* stipulation (from February 11 to March 28), the USPTO went from treating *Sotera* stipulations as *Fintiv*-dispositive (Vidal memo at 3) to only “mitigat[ing] some concern of duplication.” *Motorola Sol. ’s, Inc. v. Stellar, LLC*, IPR2024-01205 to -01208, Paper 19 at 4 (Mar. 28, 2025). Thus, where the Board before would end its *Fintiv* analysis at the *Sotera* stipulation, the intervening change in guidance not only reverted to a full-blown *Fintiv* analysis, but also seemingly adopted a new “true alternative” test that gives a *Sotera* stipulation significantly less weight when corresponding system art may be at issue in the district court litigation. *Id.* at 3-4. This marked change in USPTO guidance unfairly prejudices Petitioner, and warrants allowing Petitioner to file its *Sotera*-plus stipulation with its request for Director review of the institution decisions.

Factual Background

On February 12, 2024, Patent Owner Cyandia (“Patent Owner”) sued Petitioner in the Eastern District of Texas for alleged infringement of four patents: U.S. 8,499,250 (“the ’250 patent”), 8,595,641 (“the ’641 patent”), 8,578,285 (“the ’285 patent”) and 8,751,948 (“the ’948 patent”).

Roughly four months after being served the infringement contentions, Petitioner diligently filed four IPR petitions (IPR2024-01432, -01433, -01495, -01496) challenging the ’641, ’285, and ’948 patents (two challenging the ’948 patent). Notices according filing dates to the petitions were filed on October 9, 2024. *See* IPR2024-01432, Paper 4; IPR2024-01433, Paper 4; IPR2024-01495, Paper 3; IPR2024-01496, Paper 3. Three of the four petitions (IPR2024-01432, -01495, and -01496) rely on the same printed publications describing the IBM WebSphere system. The fourth petition, IPR2024-01433 (the second petition challenging the ’948 patent), makes a priority-break argument and relies on one of Patent Owner’s own intervening patent publications.

In response to Patent Owner raising *Fintiv* arguments in its POPRs, Petitioner served a *Sotera* stipulation on Cyandia's counsel on January 14, 2025, and filed this stipulation as exhibits with the PTAB on February 11, 2025. IPR2024-01432, EX1045; IPR2024-01433, EX1131; IPR2024-01495, EX1045; IPR2024-01496, EX1045. The *Sotera* stipulations stated "should IPR be instituted ... SAP will not pursue in the E.D. Tex. district court litigation any ground of unpatentability that is raised or reasonably could have been raised in any instituted IPR." *Id.*

Soon after the USPTO rescinded the Vidal memo on February 28, 2025, the Board granted additional briefing addressing the impact of this rescission on the *Fintiv* issues. These supplemental *Fintiv* briefs were filed on March 12, 2025. IPR2024-01432, Papers 10, 11; IPR2024-01433, Papers 9, 10; IPR2024-01495, Papers 9, 10; IPR2024-01496, Papers 9, 10.

On April 7, 2025, the Board issued institution decisions in all four IPRs. The Board instituted the IPR2024-01433 (based on a priority break) but denied the three IBM WebSphere IPRs (IPR2024-01432, -01495, and -01496) because, unlike the priority-break defense in district court—which does not rely on any system art—"Petitioner would remain free to pursue a system-based invalidity challenge in the district court based on essentially the same prior art relied upon" in the IBM WebSphere IPRs. IPR2024-01432, Paper 14 at 11; IPR2024-01495, Paper 13 at 11; IPR2024-01496, Paper 13 at 11. Ultimately, the Board found that factor 4 weighed in favor of denial despite Petitioner's *Sotera* stipulation because it found the stipulation had "limited practical effect." IPR2024-01432, Paper 14 at 9; IPR2024-01495, Paper 13 at 8; IPR2024-01496, Paper 13 at 8.

On April 7, 2025, Petitioner served its *Sotera*-plus stipulation on Cyandia's counsel. This stipulation states that "should IPR be instituted in IPR2024-01432, IPR2024-01495, or IPR2024-01496, SAP will not pursue in any district court litigation the IBM WebSphere-based prior art invalidity defenses, including all IBM WebSphere system art and printed publications describing this system."

Intervening Changes in USPTO Procedures and Guidance

When Petitioner filed its *Sotera* stipulation on February 11, 2025, that stipulation was *Fintiv*-dispositive—the Board could not deny under *Fintiv* even if all the other *Fintiv* factors favored denial. *See* Vidal memo at 7.

On February 28, 2025, the USPTO issued a Notice rescinding the Vidal memo and directed parties to refer to PTAB precedent for guidance, including *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential as to § II.A). Though no longer *Fintiv*-dispositive, *Sotera* stipulations still strongly weighed against discretionary denial under PTAB precedent, as Petitioner noted in its supplemental *Fintiv* briefs. *E.g.*, *Samsung Elecs. Co. v. Acorn Semi, LLC*, IPR2020-01183, Paper 17 at 40-45 (PTAB Feb. 10, 2021).

On March 28, 2025, roughly one week before the Board issued the institution decisions in these IPRs, the Director review decision in *Motorola* was issued, which provided guidance on how the PTAB should weigh a *Sotera* stipulation and conduct a *Fintiv* analysis subsequent to the rescission of the Vidal memo. *Motorola v. Stellar*, Paper 19.

Unlike prior Board decisions indicating that a *Sotera* stipulation weighs against discretionary denial even where Petitioner relies on overlapping system art in the parallel district court litigation (*see, e.g.*, *PNC Bank, NA v. United Serv. Auto. Ass'n*, IPR2021-01073, Paper 25 at 27-29 (PTAB Feb. 7, 2022); *Meta Platforms, Inc. v. Eight KHZ, LLC*, IPR2023-01022, Paper 10 at 6-7 (PTAB Jan. 9, 2024)), the Director review decision in *Motorola* stated that a *Sotera* stipulation may only "mitigate some concern of duplication" where the corresponding defense in district court also relies on unpublished system prior art. *Motorola v. Stellar*, Paper 19 at 4. The decision also noted that in such an instance, a *Sotera* stipulation "does not ensure that the[] IPR proceedings would be a 'true alternative' to the district court proceeding" and found that the *Sotera* stipulation was not enough to outweigh the other *Fintiv* factors (1-3 and 5). *Id.* at 3-4 (quoting *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 19 (PTAB Dec. 1, 2020)).

Before the Director review decision in *Motorola*, USPTO guidance and decisions indicated that a *Sotera* stipulation should make factor 4 weigh in favor of institution, especially in view of later Board decisions confirming that this is what the *Sotera* decision stood for. *See, e.g.*, *PNC Bank*, Paper 25 at 27-29; *Meta Platforms*, Paper 10 at 6-7. The "true alternative" language from the *Motorola* decision comes from a footnote in the *Sand Revolution* decision that speaks to a *Sotera* stipulation's strength, not its weakness. Specifically,

this footnote discusses how Petitioner's narrower *Sand* stipulation, though still marginally weighing against discretionary denial, would have weighed more conclusively in Petitioner's favor had Petitioner filed a broader *Sotera* stipulation because such a stipulation would "help ensure that an IPR functions as a true alternative to litigation in relation to grounds that could be at issue *in an IPR*." *Sand Revolution II, LLC v. Cont'l Intermodal Group – Trucking LLC*, IPR2019-01393, Paper 24 at 12 n.5 (PTAB June 16, 2020) (emphasis added). This "in an IPR" language is key. *Id.* It does not say that a *Sotera* stipulation is effective because it ensures that the IPR is a true alternative to *all* corresponding grounds in district court (including system art). Nor does it impose any requirement that, to weigh in favor of Petitioner, a stipulation *must* provide such a "true alternative" to *all* corresponding district court grounds.

The Institution Decisions, however, adopt this "true alternative" language from the *Motorola* Director review decision, and materially differ from prior Office guidance, finding that Petitioner's *Sotera* stipulation had "limited practical effect" and that factor 4 weighed in favor of denial because the stipulation "would not ensure that *inter partes* review would be a 'true alternative' to the [district court] litigation". *E.g.*, IPR2024-01432, Paper 14 at 10; *see also* IPR2024-01495, Paper 13 at 9; IPR2024-01496, Paper 13 at 9. Where prior guidance would have afforded Petitioner's *Sotera* stipulation at least some weight (*see, e.g., PNC Bank*, Paper 25 at 27-29; *Meta Platforms*, Paper 10 at 6-7), the institution decisions appeared to give it essentially no weight. *E.g.*, IPR2024-01432, Paper 14 at 10-11; *see also* IPR2024-01495, Paper 13 at 9, 11; IPR2024-01496, Paper 13 at 9, 11. Further, where prior guidance would have weighed factor 4 in favor of Petitioner because of the *Sotera* stipulation (*see, e.g., PNC Bank*, Paper 25 at 27-29; *Meta Platforms*, Paper 10 at 6-7), the institution decisions found this factor weighed against Petitioner (in favor of denial). *E.g.*, IPR2024-01432, Paper 14 at 10; IPR2024-01495, Paper 13 at 9; IPR2024-01496, Paper 13 at 9.

Given this intervening shift in how the Board treats *Sotera* stipulations, Petitioner should be allowed to file its *Sotera*-plus stipulation with its request for Director review of the decisions denying institution in IPR2024-01432, -01495, and -01496. Petitioner is willing to present its IBM WebSphere invalidity grounds at the PTAB, not district court. It should not be prevented from doing so because of intervening changes in PTO decisions that were out of Petitioner's control. Finding otherwise unfairly prejudices Petitioner and runs counter to the purpose of the AIA.

Respectfully submitted,

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