UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TANKLOGIX, LLC,

Petitioner,

v.

SITEPRO, INC.,

Patent Owner.

PTAB Case No. IPR2025-00649

Patent No. 9,342,078

PATENT OWNER'S PRELIMINARY RESPONSE

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EXHIBIT LIST

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

I. INTRODUCTION

TankLogix, LLC ("TankLogix" or "Petitioner") filed a petition for *Inter Partes* Review ("IPR") against Claims 1-8, 11-13, and 15-19 ("Challenged Claims") of U.S. Patent No. 9,342,078 B2 (the "'078 patent") based on three grounds. Petitioner's grounds do not demonstrate a likelihood of prevailing, as demonstrated in the sections below. Therefore, Patent Owner requests the Board deny institution of this IPR.

The '078 patent is the second in a series of granted patents directed to the remote control of fluid-handling devices, such as valves, pumps, process chambers, process filters, level switches, and the like for various oil and gas industrial systems. *See* Ex. 1001, title, 1:57-60, 5:40-52. The systems and methods described in the '078 patent provide the infrastructure for users to remotely receive and analyze data of monitoring and control equipment for fluid-handling devices and to remotely command and control them over a network. *See id*., 2:62-3:28, FIG. 1, Claim 1. The fluid-handling devices are "controlled remotely without the need to install special-purpose software on the computing device through which remote control is exercised" (*id*., 3:17-24), which solves several deficiencies in the art at the time of the '078 patent, including manual on-site control or specialized software required for devices on a site-by-site basis. *See id*., 1:31-50. Furthermore, the system and methods of the '078 patent advantageously enable remote management of different

target states for fluid-handling devices based on user-directed instructions. *See id*., abstract, 8:14-31.

The method of Claim 1, for instance, includes, *inter alia*, receiving user-directed instructions that are encoded in a shared protocol to control fluid-handling devices, and determining different target states corresponding to different times for a fluid-handling device. The method further includes selecting one or more protocol(s) different than the shared protocol to which the fluid-handling device is responsive, and translating the received instructions to be encoded in the selected protocol(s) to provide to the fluid-handling device and cause it to attempt to achieve a target state. *See id.*, Claim 1.

Petitioner's invalidity allegations against Claim 1 based on the disclosures of U.S. Patent No. 8,667,091 B2 ("Almadi," Ex. 1005), U.S. Patent No. 9,709,995 B2 ("Gutierrez," Ex. 1006), and non-patent literature publication titled "SCADA: Supervisory Control and Data Acquisition, 4th Edition" ("SCADA," Ex. 1007) all fall woefully short since these references do not disclose, teach, or even suggest each claimed feature and the claimed system as a whole in the '078 patent. Not only is the claimed system patentably distinct from Petitioner's cited references, the Petition lacks a full, genuine showing that each reference actually anticipates or renders obvious each feature of the claim. For numerous claim elements and limitations of Claim 1, the Petition fails to show what disclosure in Almadi, Gutierrez, and

SCADA corresponds to or would be understood as the claimed feature in the '078 patent. In many cases, Petitioner does not even address the claim element in the arguments.

The Petition is also fatally flawed by failing to meet the legal standards of invalidity under §§ 102 and 103, including reliance on a reference (Gutierrez) that is not prior art to the '078 patent.

Overall, the merits of the Petition are deficient, and its arguments are confusing and inconsistent for most, if not all, claim elements. As demonstrated below, Claim 1 is shown to be patentable over each of Almadi, Gutierrez, and SCADA. With Claim 1 being patentable, it is self-evident that the dependent Claims 2-8, 11-13, and 15-19 are also patentable over Petitioner's asserted references for at least the same reasons. Petitioner has failed to show that any of Grounds 1-3 demonstrate a reasonable likelihood of invalidating any of the Challenged Claims. Institution should consequently be denied under 35 U.S.C. § 314.

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

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

devices, like SCADA systems." Ex. 1002, ¶25.

Patent Owner believes a POSITA would have had at least a bachelor's degree in engineering (electrical, chemical, petroleum or mechanical), computer science, or a related field and at least two years of experience designing control systems for remotely controlling fluid-handling devices, like SCADA systems. Ex. 2009, ¶48. Alternatively, a POSITA would have had at least six years of experience in designing control systems for remotely controlling fluid-handling devices, such as SCADA systems. *Id*.

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

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

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

Petitioner asserts Almadi alone anticipates and/or renders obvious Claims 1-8, 11-13, and 15-17 under (pre-AIA) 35 U.S.C. § 102 or § 103. *See* Petition (Paper 2), 10-11. Petitioner's assertions are incorrect because, as shown in this section, Almadi fails to disclose, teach, suggest, or make obvious several claimed features and therefore do not anticipate or render obvious the whole of Claim 1.

A claim is only unpatentable under § 102 if "each and every element as set forth in the claim is found . . . in a single prior art reference." MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987). And, in *KSR International Co. v. Teleflex Inc*. ("*KSR*"), the Court reaffirmed the principles of obviousness based on the precedent that "[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." MPEP 2141; *KSR*., 550 U.S. 398, 416 (2007). Not only does Ground 1 fail to satisfy these legal standards (discussed later in **Section III**), the ground does not even *attempt* to identify each claim element and its limitation(s).

In particular, Ground 1 based on Almadi either fails to map or provides unclear or incorrect element mappings for several limitations among the seven sections of Claim 1 (parsed [1.1] to [1.7]). For brevity, just a few of these deficiencies are demonstrated below.

1. Almadi does not disclose, teach, suggest, or render obvious the claimed features of [1.3] of Claim 1.

In Ground 1, the Petition fails to map the claimed "*target state of at least one of the fluid-handling devices*" to anything in Almadi's disclosure and instead makes unsupported conclusory statements that particular or different target states can be determined in Almadi based on drive commands used by local controllers or by monitoring or collecting data. Petition, 12-13. The Petition's ambiguous statements

cite multiple sections of Almadi[1] that pertain to general functionality of "intelligent field devices" (Ex. 1005, 1:28-57, 12:27-59) or stored predefined rules and conditions. *Id*., 25:26-37. Neither statement in the Petition identifies what in Almadi's disclosure corresponds to the claimed "*target state*," and neither addresses the claimed feature in the context of [1.3]: *obtaining a target state … based on at least some of the plurality of instructions*.

On the other hand, Petitioner's expert provides better clarity on what allegedly constitutes a "target state,"[2] although incorrect. As an initial matter, Petitioner's sole reliance on its expert declaration amounts to improper incorporation by reference. Furthermore, the Wooley declaration incorrectly equivocates a "target state" to present operating condition that is determined from monitored and collected data (i.e., sensor data). *See* Ex. 1002, ¶¶51-52. However, a "*target state*" is not a sensed

[1] The Petition cites Almadi (Ex. 1005) at 1:28-57, 1:18-57, 12:27-59, 25:26-37.

[2] Petitioner's Wooley declaration states "[a] target state is the particular operating condition that a device is in at a particular time[, and d]etermining the target state of the fluid-handling devices is necessary to understand whether a fluid-handling device is operating within the proper device parameters or whether the operating condition of the fluid-handling device should be changed." Ex. 1002, ¶51.

parameter or particular operating condition, but would be understood to be a desired state for the device to be in. *See* Ex. 2009, ¶87.

Suppose for the sake of argument that the Wooley declaration was correct—which Patent Owner does not concede—Petitioner's expert (and the Petition) still provides no mapping to Almadi's disclosure of the sensed parameter or particular operating condition being based on received instructions, as claimed. That is because the notion of obtaining the target state of the fluid-handling device based on the received instruction does not make sense when the target state is to be a sensed parameter or operating condition that comes from the fluid-handling device. Put simply, "collecting data, such as measurements of fluid pressure, temperature or flow," is not obtaining a target state, as Petitioner contends,[3] but instead is sensing the present state—not target state—of a fluid handling device. *See* Ex. 2009, ¶88.

Thus, Almadi does not disclose, teach, suggest, or render obvious the claimed features of [1.3].

2. Almadi does not disclose, teach, suggest, or render obvious the claimed features of [1.4] of Claim 1.

Petitioner incorrectly maps Almadi's disclosure of "process data" to the "*plurality of different target states of at least one of the fluid-handling device*"

[3] Petition, 13; Ex. 1002, ¶52.

recited in [1.4]. Specifically, the Petition and Petitioner's expert allege that Almadi discloses different states corresponding to different times through Almadi's disclosures related to the collection, storage, and retrieval of time-stamped **process data**. *See* Petition, 13; *also see* Ex. 1002, ¶¶53-54. Yet, Almadi's disclosure of "process data"[4] is about sensor data, which is evident from Almadi and from Petitioner's characterization of Almadi's process data. *Id*. That is, Petitioner notes that Almadi's process data is collected, stored, and retrieved. Importantly, Almadi's process data is not ***determined***, as specified in limitation [1.4].

Furthermore, the claimed "*different target states*" in [1.4] stems from the claimed feature in [1.3] of "*obtaining a target state of at least one of the fluid-handling devices*." As discussed above, the Petition provides no mapping to the claimed "*target state*" in [1.3], and the Wooley declaration provides an incorrect analysis. *See* **Section II.A.1**. Petitioner's mapping in [1.4] fails to remedy the core "*target state*" feature from [1.3].

Also, Petitioner fails to address the full limitation of the "*different target states*" in [1.4], which specifies that "*the plurality of different states each*

[4] *See* Almadi's disclosure of "process data" at Ex. 1005, abstract, 2:28-30 ("… the storage of process data retrieved from the remote subsystems and instruments"), 3:13-20 ("integrated node can … transmit process data to a remote host server …").

corresponding to different times." The Petition's reference to Almadi's time-stamped process data being collected at different times is unrelated to *determining different target states corresponding to different times*. Petitioner has not shown that Almadi even discloses determining a single *target state* for a fluid-handling device, much less determining a plurality of target states that are different and correspond to different times. *See* Ex. 2009, ¶¶90-91.

Almadi therefore fails to disclose, teach, suggest, or render obvious the claimed features of [1.4].

3. Almadi does not disclose, teach, suggest, or render obvious the claimed features of [1.2] of Claim 1.

Petitioner fails to show that Almadi discloses, teaches, suggests, or otherwise renders obvious the claimed element "*receiving ... user-directed instructions to control fluid-handling devices*" and the claimed limitation of *"the instructions being received encoded in a shared protocol*" recited in [1.2].

The Petition and the Wooley declaration point to four sections in Almadi that allegedly disclose these claimed limitations. *See* Petition, 11-12 and Ex. 1002, ¶50, citing Almadi at (Ex. 1005) 11:31-35, 12:10-15, 12:55-59, and 13:51-14:9. However, these cited sections of Almadi do not support the allegations. Instead, this disclosure of Almadi simply describes communication between various components and particular protocols for communication without any discussion or suggestion of

receiving *user-directed instructions* to control fluid-handling devices. The only control described here in Almadi is, perhaps, controlling communication of the various components of Almadi's system (e.g., remote host 110, integrated node 100, remote subsystems 120). Furthermore, while communication protocols are discussed, the Petition and Petitioner's expert do not provide any rationale or explanation for why communication protocols disclosed in Almadi constitute a "shared protocol" as claimed. *See* Ex. 2009, ¶81.

Almadi therefore fails to disclose, teach, suggest, or render obvious the claimed features of [1.2].

4. Several additional claim elements and limitations of Claim 1 are not disclosed or taught by Almadi.

The Petition fails to properly map several other Claim 1 elements and limitations in addition to those discussed above in connection with [1.3], [1.4] and [1.2]. Petitioner also fails to map the claimed "*selecting a respective protocol or protocols*" feature of [1.5] and the claimed "*selected respective protocol or protocols*" feature of [1.6].

Almadi discloses that integrated node 100 includes a "protocol translator or translation server 102 to translate communications with each of the remote subsystems 120." Ex. 1005, 14:10-32. However, Almadi does not teach "*after determining the plurality of different target states, translating each received*

instructions into one or more translated instructions encoded in the selected respective protocol or protocols … including the determined plurality of different target states" as claimed in [1.6]. In addition to Petitioner's failed mapping of Almadi to the claimed "*target state*" and "*different target states*" (discussed above in **Sections II.A.1-II.A.2**), Petitioner fails to map anything in Almadi's disclosure to at least the "*selected respective protocol[s]*." *See* Petition, 15-17; *see also* Ex. 1002, ¶56.

Petitioner merely paraphrases claim language of [1.6] and attributes it to Almadi without showing the basis for the attribution. *Id*. Specifically, Petitioner cites FIG. 1B, 11:35-41, and 14:10-17 of Almadi, which disclose "protocol translator or translation server 102" and its ability to be configured to support communications in a variety of protocols. However, nowhere in these cited sections of Almadi, in the Petition or Wooley declaration, is there an explanation of a process for selecting a protocol to which the fluid-handling device is responsive from among multiple protocols different than the (shared) protocol that the received user-directed instructions are encoded in, where the different target states are included in the translated instructions encoded in the selected protocol.

Because Petitioner does not identify any disclosure in Almadi that meets this limitation or shows it to be obvious, Almadi does not anticipate or render obvious limitation [1.6].

Claim 1 cannot be anticipated or rendered obvious by Almadi when there are numerous claim elements and limitations absent in the cited reference. The fact that the Petition is unable to identify where and how multiple claim features are allegedly described in the references is indicative of the reference's lack of disclosure and overall teaching. Claim 1 is clearly patentable over Almadi, and therefore its dependent claims are too. Thus, *inter partes* review of the '078 patent based on Almadi is unwarranted.

B. Multiple claimed elements and limitations of Claim 1 lack any mapping or clear mapping to Gutierrez in Ground 2.

Petitioner asserts Gutierrez alone anticipates and/or renders obvious Claims 1, 2, 6, and 16-19 under (pre-AIA) 35 U.S.C. § 102 or § 103. *See* Petition, 39. Petitioner's assertions are incorrect because, as shown in this section, Gutierrez fails to disclose, teach, or suggest several claimed features and does not anticipate or render obvious independent Claim 1.

1. Gutierrez does not disclose, teach, suggest, or render obvious the claimed features of [1.3] and [1.4] of Claim 1.

In Ground 2, Petitioner incorrectly maps Gutierrez's disclosure to the claimed "*target state*" of limitation [1.3] and "*different target states*" of limitation [1.4]. Similar to the Almadi ground, Petitioner posits the same faulty analysis that a target state of a fluid-handling device is a sensed parameter associated with a present condition of the device. Specifically, Petitioner maps the claimed "*target state*"

feature recited in [1.3] to Gutierrez's sensed values for operational parameters of system components. *See* Petition, 41. This mapping not only misses the mark, it is unexplained and unsupported by Gutierrez's disclosure. Gutierrez's values for operational parameters are not "target states" because a target state pertains to a desired state for the fluid-handling device to be in. *See* Ex. 2009, ¶102. Despite citing nearly a dozen sections of Gutierrez's disclosure,[5] none of them describe determining or otherwise obtaining information for a desired state for chemical injection system based on a user-directed instruction. Therefore, it comes as no surprise that Petitioner failed to explain how any of these eleven sections cited in Gutierrez relate to the claimed "*target state*." Petition, 41-42; Ex. 1002, ¶101.

Turning to limitation [1.4], Petitioner is silent on what in Gutierrez's disclosure corresponds to the claimed "*different target states*" or what in Gutierrez determines them. Instead, Petitioner focused on Gutierrez's graphical user interface (GUI) that operates on a computer remote from the chemical injection system components and that a user utilizes the GUI to control these components. Petition 42-43. Petitioner draws a link between the previous incorrect mapping of Gutierrez's sensed values for operational parameters and Gutierrez's user-

[5] The Petition cited Gutierrez (Ex. 1006) at 3:40-45, 5:58-67, 6:1-10, 6:13-23, 6:24-44, 9:21-25, 9:55-64, 10:27-30, 10:39-43, 11:18-26, 13:9-26.

commanded GUI by stating the transmitted commands to control the system components can be based on these operational parameters, over time as they develop. *Id*., 43. But this point fails to show "*different target states*" "*corresponding to different times*" and how such "*different target states*" are "*determine[ed]*." Petitioner cites to the same eleven sections as cited in limitation [1.3] (*id*.), which basically show that Gutierrez discloses sending real time commands to the system components in reaction to the detected operation parameters of those components. Ex. 2009, ¶103. Nothing in Petitioner's analysis shows that Gutierrez disclosed [1.4] or would have rendered [1.4] obvious.

2. Gutierrez does not disclose, teach, suggest, or render obvious the claimed features of [1.2] of Claim 1.

Petitioner fails to show that Gutierrez discloses, teaches, suggests, or otherwise renders obvious the claimed limitation of *"the instructions being received encoded in a shared protocol*" recited in [1.2]. It's completely absent. *See* Petition, 40-41. The Petition doesn't even paraphrase this feature in [1.2] and attributes it to Gutierrez, which is Petitioner's modus operandi. Instead, for [1.2], Petitioner describes Gutierrez's system generally, noting the GUI, sensors, components of the chemical injection system (e.g., pump, motor, motor controller, etc.), and its network

communication scheme, citing nearly ten sections.[6] *Id*. None of these cited sections support Petitioner's allegation that Gutierrez discloses or teaches [1.2] because nothing in these sections or elsewhere in Gutierrez discloses, teaches, suggests, or renders obvious the claimed limitation of *"the instructions being received encoded in a shared protocol*." Ex. 2009, ¶¶98-100.

3. Several additional claim elements and limitations of Claim 1 are not disclosed or taught by Gutierrez.

The Petition fails to properly map several other claim elements and limitations in addition to those discussed above from [1.3], [1.4] and [1.2] of Claim 1. Petitioner also fails to map the claimed "*translating each received instructions*" feature because Gutierrez's disclosure on translating does not occur "*after determining the plurality of different target states*" as required by [1.6]. As noted above in **Section II.B.1**, Gutierrez is silent on the claimed "*different target states*" and the process for "*determining*" them. The claimed "*translating*" feature includes "*translating each received instructions into one or more translated instructions [that include] the determined plurality of different target states*." Thus, Gutierrez cannot

[6] The Petition cites Gutierez (Ex. 1006) at 2:26-29, 6:55-7:2, 6:46-49, 8:15-19, 8:39-9:3, 6:28-35; 10:22-24, 10:34-38, 10:43-59. Petition, 40.

disclose or teach this feature, and Petitioner understandably makes no showing in Gutierrez of [1.6]. Ex. 2009, ¶105.

Because Gutierrez's disclosure does not meet this limitation or shows it to be obvious, Gutierrez does not anticipate or render obvious limitation [1.6].

Thus, Claim 1 cannot be anticipated or rendered obvious by Gutierrez when there are numerous claim elements and limitations absent in the cited reference. Like Ground 1, Ground 2 fails, so the Petition for *inter partes* review should not be instituted.

C. Multiple claimed elements and limitations of Claim 1 lack any mapping or clear mapping to SCADA in Ground 3.

Petitioner asserts SCADA alone anticipates and/or renders obvious Claims 1, 11, and 12 under (pre-AIA) 35 U.S.C. § 102 or § 103. *See* Petition, 57-58. Petitioner's assertions are incorrect because, as shown in this section, SCADA fails to disclose, teach, or suggest several claimed features and does not anticipate or render obvious independent Claim 1.

1. SCADA does not disclose, teach, suggest, or render obvious the claimed features of [1.4] of Claim 1.

Like Grounds 1 and 2, for Ground 3, Petitioner fails to properly maps the cited reference (here, SCADA) to the claimed "*plurality of different target states of [a] fluid-handling device[, where], each correspond[s] to different times*" in limitation [1.4]. For the claimed "*target state*" feature introduced in [1.3], Petitioner mapped

this to SCADA's disclosure of "a remote set point of a PID (proportional/integral/derivative) controller" and the "output from the controller," i.e., "the serial transmission of bits for each pulse output." *See* Petition, 59-60; and Ex. 1002, ¶145. Yet, this mapping is merely repeated for [1.4] without a discussion about of the "*plurality*" of the "*different target states*" or that the "*different target states*" correspond to "*different time*." *See id*, 60; and *id*., ¶147. Petitioner failed to map these limitations of the claimed "different target states" because such a disclosure is absent from SCADA. *See* Ex. 2009, ¶115.

The only difference between Petitioner's discussion of [1.4] and [1.3] is mention of "the pulse control method" disclosed in section 7-6 of SCADA (Ex. 1007, 100-101) that "allows a stepper motor to be incremented or decremented by a specific number of steps." Petitioner provides no analysis of this disclosure in SCADA. *See* Petition, 60; *also see* Ex. 1002, ¶¶145-146. Again, Petitioner's silence is telling because this disclosure doesn't illustrate "*different target states*" at all, much less different target states that correspond to different times. *See* Ex. 2009, ¶116, describing how a controlling a stepper motor cannot have multiple target states.

Thus, SCADA does not disclose, teach, suggest, or render obvious the claimed features of [1.4].

2. SCADA does not disclose, teach, suggest, or render obvious the claimed features of [1.2] of Claim 1.

Petitioner also fails to show that SCADA discloses, teaches, suggests, or renders obvious the claimed limitation of *"the instructions being received encoded in a shared protocol*" recited in [1.2]. It's completely absent—there is no mention in the Petition or Wooley declaration.[7] *See* Petition, 58-59; Ex. 1002, ¶¶140-144. Instead, for [1.2], Petitioner describes the "major elements of a SCADA system: including input/output (I/O) device, master terminal unit (MTU), and remote terminal units (RTUs), which communicate with sensors and actuators. *Id*. None of these cited sections support Petitioner's allegation that SCADA discloses or teaches [1.2] because nothing in these sections or elsewhere in SCADA discloses, teaches, suggests, or renders obvious the claimed limitation of *"the instructions being received encoded in a shared protocol*." Ex. 2009, ¶¶112-114.

3. Several additional claim elements and limitations of Claim 1 are not disclosed or taught by SCADA.

The Petition fails to properly map several other Claim 1 elements and limitations in addition to those discussed above in connection with [1.4] and [1.2]. For example, Petitioner also fails to map the claimed "*translating each received*

[7] The word "protocol" or any like term does not appear in the Petition or Wooley declaration for their respective analysis of [1.2] in the SCADA ground.

instructions" feature because SCADA's disclosure about translating does not occur "*after determining the plurality of different target states*" as required by [1.6]. As noted above in **Section II.C.1**, SCADA is silent on the claimed "*plurality of different target states*" and the process for "*determining*" them. The claimed "*translating*" step results in "*translated instruction[s] [that include] the determined plurality of different target states*," which SCADA does not disclose, teach or render obvious. Ex. 2009, ¶118. Petitioner makes no showing in SCADA pertinent to this feature of [1.6] and actually incorporates the faulty analysis of [1.4] as the sole manner of addressing the claimed "*plurality of different target states*" feature. Petition, 62.

Because SCADA's disclosure does not meet this limitation or shows it to be obvious, SCADA does not anticipate or render obvious limitation [1.6].

Thus, Claim 1 cannot be anticipated or rendered obvious by SCADA when there are numerous claim elements and limitations absent in the cited reference. Like Grounds 1 and 2, Ground 3 also fails, so institution of *inter partes* review should be denied.

III. PETITION FAILS TO MEET MULTIPLE LEGAL REQUIREMENTS OF UNPATENTABILITY

A. Grounds 1-3 fail to delineate between § 102 and § 103 arguments and fail to properly assert either category.

Each Ground of the Petition asserts unpatentability under both the anticipation standard of § 102 and the obviousness standard of § 103 but fails to fully or clearly articulate either theory. *See* Petition, 10-11 (Ground 1), 39 (Ground 2), 57-58 (Ground 3). Due to this lack of clarity, the grounds of the Petition are substantively deficient and noncompliant with 35 U.S.C. § 312(a)(3),[8] and therefore institution of *Inter Partes* Review should be denied.

First, it is unclear whether the Petition intends to raise both § 102 and § 103 arguments. Each Ground is titled "[Reference] Anticipates Claims [list of claim numbers]," indicating only § 102 arguments. Petition, 10 (Ground 1), 29 (Ground 2), 52-53 (Ground 3). However, within each Ground, the Petition also uses boilerplate language to assert an obviousness theory. *See id., e.g.*, Petition, 10-11

[8] 35 U.S. Code § 312(a) Requirements of Petition.—A petition filed under section 311 ***may be considered only if***— . . . (3) the petition identifies, in writing ***and with particularity***, each claim challenged, ***the grounds on which the challenge to each claim is based***, and the evidence that supports the grounds for the challenge to each claim, ... (emphasis added)

(The challenged claims "are anticipated by [reference] under 35 U.S.C. § 102 or would be obvious to a POSITA in view of [reference] under 35 U.S.C. § 103."). The Petition then follows a robotic pattern. For each claim limitation, the Petition recites the limitation, lists paraphrased disclosure from the reference—often out of context, and then presents a conclusory statement that the reference "[claim] is anticipated by [reference] or would be obvious to a POSITA in view of [reference]." *See, e.g.*, Petition, 18.

For anticipation under § 102, Petitioner fails to map each element of the claim to the disclosures in the cited reference, as described above, so any § 102 argument fails from the start.

For obviousness under § 103, not only does Petitioner fail to show the requisite teaching or suggestion in the prior art of each claimed feature, Petitioner fails to explain any reasoning for why any claim would be obvious within the framework for objective analysis articulated in *Graham v. John Deere Co*., 383 U.S. 1 (1966) and reiterated in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The court has "repeatedly emphasized that an obviousness inquiry requires examination of all four *Graham* factors and that an obviousness determination can be made only after consideration of each factor." *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016).

Here, for every claim element of the Challenged Claims, the Petition lacks any articulation of the second *Graham* factor (ascertaining the differences between the claimed invention and the prior art). While arguing such differences risks undercutting Petitioner's anticipation arguments, Petitioner in this case chose to avoid taking the risk at the expense of ignoring the legal standard of obviousness. The Petition asserts the dual anticipation-obviousness theory without a clear mapping of claim features to the cited references and with hollow conclusions that "[a] POSITA would recognize" or "understand." *See, e.g.*, Petition, 18. The Petition lacks any explanation as to ***why*** the prior art disclosure would render a limitation obvious to a POSITA. These unsubstantiated assertions of anticipation and obviousness do not fully articulate either invalidity theory.

These improper grounds not only require Patent Owner to respond to multiple incomplete arguments but also impel the Board to analyze multiple unarticulated invalidity grounds under multiple legal standards. The gaps in Petitioner's claim mapping (discussed above) raise doubts that any § 102 argument was made in good faith. Yet Patent Owner is forced to respond to both anticipation and obviousness arguments, despite neither theory being sufficiently explained for Patent Owner to appropriately rebut. The Board is also burdened with sifting through Petitioner's positions to look for hidden obviousness assertions. While the Petition includes no

credible obviousness explanations, Petitioner has improperly shifted the burden to the Board and to Patent Owner.

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

B. Ground 2 fails because Gutierrez is not prior art.

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

The Petition cites U.S. Patent No. 9,709,995 B2 (referred to as "Gutierrez") as prior art under "pre-AIA §§ 102(a)." Petition, 9. Gutierrez cannot be § 102(a) prior art because this document's publication date is July 18, 2017 (issue date), nearly four and a half years after the '078 patent's priority date of December 7, 2012. And, Gutierrez cannot be prior art under § 102(e) because ***Gutierrez's priority chain was broken*** at the time of Gutierrez's filing due to Gutierrez's parent application having gone abandoned.

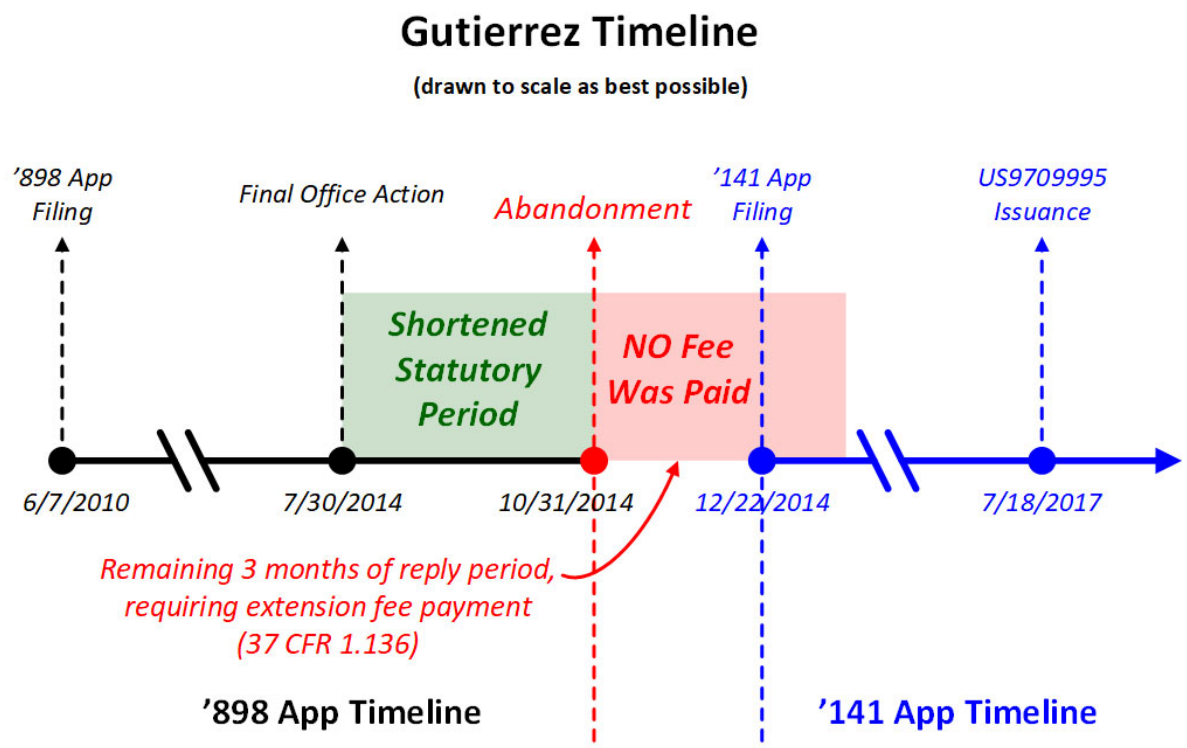
Gutierrez is the U.S. patent issued from U.S. Application No. 14/579,141 ("the '141 Application"), which was filed December 22, 2014 as a continuation of U.S. Application No. 12/794,898 ("the '898 Application"), which was filed June 7, 2010. The '898 Application went abandoned on October 31, 2014 after the applicant

failed to reply to an Office Action[9] within the fixed statutory period. *See* MPEP 711.04(a) ("the date of the abandonment is after midnight of the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired. This is normally the end of the 3-month shortened statutory period."). *Also see* MPEP 711.02 (citing 37 CFR 1.135(a): "[i]f an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise").

The applicant of the '898 Application did not pay an extension fee in accordance with § 1.136 between expiration of the shortened statutory period (October 31, 2014) and the filing of the '141 Application (December 22, 2014); and there was no further "Office action" indicating otherwise.[10] Ex. 2006, Ex. 2007. The diagram below illustrates these events chronologically.

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

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



As the above diagram shows, the '141 Application (which issued as Gutierrez) was filed after the parent '898 Application was abandoned. Therefore, the '141 Application (and thereby the U.S. patent that issued as Gutierrez) is only entitled to a priority date of December 22, 2014, which is after the December 7, 2012 priority date of '078 patent.

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

v. Prostalund AB, 227 F. Supp. 2d 1033, 1035-1040 (E.D. Wis. 2002). The *Urologix* court also made clear that the burden is on the applicant to have "evidence" of the extension of time. *Id.*, 1038. Here, like in *Urologix*, the record shows no payment or petition for an extension of time after expiration of the shortened statutory period for the '898 Application (*see* Ex. 2006), thus cementing its abandonment immediately after the period's three-month duration elapsed.[11]

Thus, Gutierrez's actual priority date is December 22, 2014, more than two years after the '078 patent. Ground 2 therefore fails because Gutierrez is not prior art. Notably, Patent Owner, in the Discretionary Denial Brief (Paper 7), provided similar analyses regarding Gutierrez's lack of eligibility as prior art. *See* Paper 7, 17-20. Petitioner did not address Gutierrez's status as prior art in its Discretionary Denial Opposition Brief (Paper 8). *See* Paper 8. Petitioner's complete silence strengthens Patent Owner's position, which is based on straightforward assessment of the facts, and remains unrebutted.

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

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

C. Grounds 1 and 2 rely on incorrect section of pre-AIA § 102.

In Ground 1, the Petition cites Almadi as prior art under § 102(a). Petition, 9. Pre-AIA 35 U.S.C. § 102(a), applicable here, renders a patent invalid when "the invention was . . . patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for patent." However, the '078 patent has a priority date of December 7, 2012, and the Almadi patent did not issue until March 4, 2014. Therefore, the Almadi patent does not qualify as prior art under § 102(a).[12]

[12] Petitioner purports this was a "clerical or typographical" error and is attempting to correct this and numerous other purportedly "typographical" errors in its filings. *See* Petitioner's Notice of Errata (Ex. 1010) filed July 8, 2025 (referring to "error" #1 for Almadi and #2 for Gutierrez). Out of courtesy, Patent Owner did not oppose Petitioner's proposed correction. However, Patent Owner notes that Petitioner had ample time to review and correct any "typographical" errors, from the time Petitioner was served with the complaint on January 7, 2025 (in *SitePro, Inc. v. TankLogix, LLC*, 6:24-cv-00642-XR-DTG litigation), until Petitioner filed this Petition on February 28, 2025. Petitioner's actions are even more egregious considering that the current Petition is a virtual copy-cat of a petition filed by another

In Ground 2, Petitioner also mischaracterizes Gutierrez as § 102(a) prior art. Petition, 9. Gutierrez is not prior art under any subsection of § 102 (see discussion above in **Section III.B**).

These mischaracterizations of Almadi and Gutierrez are reflective of the multitude of problems and overall inadequacy of the Petition, which impels denial of institution of this IPR.

IV. CONCLUSION

For the reasons discussed above, Patent Owner respectfully requests that the Board deny Petitioner's Petition for *Inter Partes* Review of the '078 patent.

Dated: July 16, 2025

Respectfully submitted,

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petitioner in April 2024 (*see* IPR 2024-00724, Paper 2), and therefore Petitioner did not spend anytime developing technical or legal arguments of the Petition.

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

Under 37 C.F.R. § 42.24(d), the undersigned certifies that the word count for this Patent Owner's Preliminary Response to the Petition for *inter partes* review totals 5,851 words, excluding the parts exempted by 37 C.F.R. § 42.24(a). The word count was made using the built-in word count function in the Microsoft® Word software used to prepare this document.

Dated: July 16, 2025

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CERTIFICATE OF SERVICE

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

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