IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

TANKLOGIX, LLC,

Petitioner,

v.

SITEPRO, INC.,

Patent Owner.

U.S. Patent No. 9,342,078

Case No.: IPR2025-00649

SITEPRO, INC.'S BRIEF FOR DISCRETIONARY DENIAL

TABLE OF CONTENTS

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

I. Introduction

Under the *Interim Process for PTAB Workload Management Memorandum* (the "Memorandum") issued on March 26, 2025, the decision whether to institute an *inter partes* review is bifurcated between: (i) discretionary denial; and (2) merits and other non-discretionary statutory decisions. Pursuant to the Memorandum, Patent Owner, SitePro Inc., requests that the Board discretionarily deny TankLogix's Petition for *Inter Partes* Review ("IPR") of U.S. Patent No. 9,342,078 (the "'078 patent") for the reasons below.

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

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

II. The *Fintiv* Factors Favor Denial

As established in the precedential case of *Apple v. Fintiv*, the Board considers six factors when exercising its discretion to deny an *inter partes* review in view of a parallel proceeding. *Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Those factors are: (1) whether the district court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the district court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits. *Id*. Here, there is a parallel district court proceeding pending in the United States District Court for the Western District of Texas between SitePro, Inc. and Petitioner TankLogix, LLC. The case is *SitePro, Inc. v. TankLogix, LLC*, 6:24-cv-00643-XR-DTG (the "District Court Proceeding"), and has been assigned to District Court Judge, Xavier Rodriguez. As discussed below, the *Fintiv* factors weigh in favor of the Board denying institution in view of the District Court Proceeding.

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

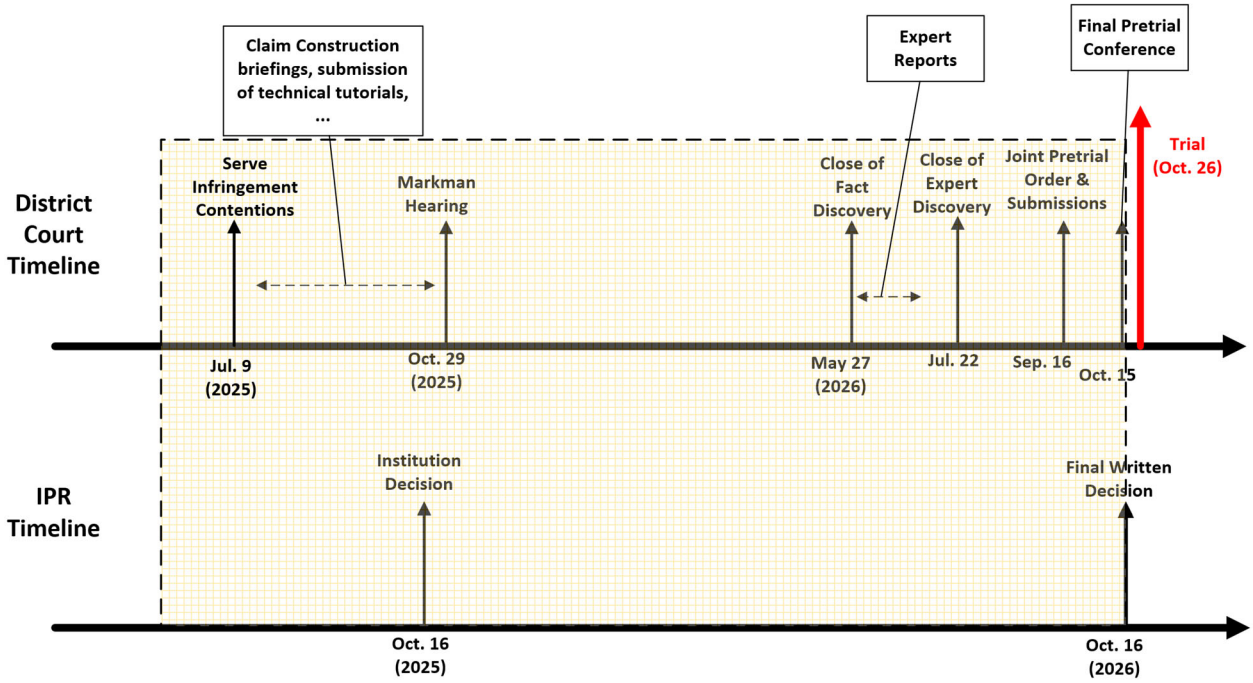
Petitioner has sought a stay in the District Court Proceeding, and to date, the district court has not issued a decision. While Judge Rodriguez has not previously ruled on any contested motions to stay pending IPR (Ex. 2001)[1], SitePro has opposed the motion to stay (Ex. 2005), which is expected to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

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

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

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

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



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

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

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

The Petition argues that "[t]he expected trial date based on the court's median time-to-trial date statistics is approximately September 2027." Petition (Paper 2) at 66. But this statistic is now irrelevant since, after the filing of the Petition, the district court set a trial date for October 26, 2026. And, there are no situations in connection with the case that would merit the district court moving the trial date.

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

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

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

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

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

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

All claims challenged in this Petition are also at issue in the District Court Proceeding. Petitioner had implied stated that if the petition is instituted it will not pursue the same grounds for the '078 patent in the district court, per *Sand Revolution*, arguing that "the Grounds presented in the instant IPR will be materially different from the grounds that will be presented in the district court," and this factor therefore favors institution. Petition (Paper 2) at 67. Petitioner has further recently filed what appears to be a *Sotera* stipulation in the IPR, stating that Petitioner will not pursue in litigation "any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications," and "in the Litigation, it will not rely on any product or system art that is "based on the same evidence presented" in this IPR." *See* Ex. 1009.

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

Court Proceeding, including those based on prior art systems that are not based on the references used in the IPR. Furthermore, the Petition states "that if the IPR is instituted, Petitioner will not pursue the same grounds for the **'909 patent** in the district court litigation"—not the grounds for the '078 patent. (emphasis added) *See* Petition (Paper 2) at 66. Petitioner has in fact filed a stipulation on file, which only references another IPR (the one filed against the '909 patent)—"the specific grounds [asserted in IPR2025-00647]" (Ex. 1009 at 2)—and not the instant IPR2025-00649, which includes different prior art references.

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

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

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

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

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

As discussed above, *Fintiv* factors 2–5 weigh in favor of denial, with Factor 1 being neutral (or favoring Patent Owner). Petitioner's only additional argument under Factor 6 is that "the evidence of unpatentability is compelling, as evidenced by Grounds laid out [in the Petition]." Petition (Paper 2) at 67. On the contrary, Petitioner's Grounds crumble even under a cursory review and are significantly flawed when examined closely. While those shortcomings are described in more

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

1. The purported § 102/§ 103 arguments in each Ground fail to account for all elements of the challenged claims.

Each of Grounds 1, 2, and 3 of the Petition argues that its sole reference either anticipates or renders obvious the majority of the challenged claims under (pre-AIA) 35 U.S.C. § 102 or § 103, respectively. Petition (Paper 2) at 10-11 (Ground 1), 39 (Ground 2), 57-58 (Ground 3). A claim, however, is only unpatentable under § 102 if "each and every element as set forth in the claim is found . . . in a single prior art reference." MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987). 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*.,

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

550 U.S. 398, 416 (2007). Not only do Grounds 1-3 fail to satisfy both standards, the grounds do not even *attempt* to identify each claim element and its limitation(s).

In particular, ***Ground 1***, based on U.S. Patent No. 8,667,091 to Almadi ("Almadi"), either fails to map or provides unclear or incorrect element mappings for at least ***five*** limitations among the seven claim sections of Claim 1 (parsed [1.1] to [1.7]).

Similarly, ***Ground 2***, based on U.S. Patent No. 9,709,995 to Gutierrez ("Gutierrez"), includes at least ***six*** instances of missed element mappings or unclear or incorrect element mappings for Claim 1.

Ground 3, based on non-patent literature (NPL) publication titled "Supervisory Control and Data Acquisition, 4th Edition" ("SCADA"), also includes at least ***four*** instances of missed element mappings or unclear or incorrect element mappings for Claim 1.

Starting with the first substantive claim element in Ground 1, Petitioner fails to cogently map any disclosure or teaching in Almadi to Claim 1's limitation in [1.2] on the received instructions "*being … encoded in a shared protocol*." Petition (Paper 2) at 11-12. Instead, the Petition cursorily describes Almadi's system architecture and then handwaves a completely unsubstantiated conclusory statement that "[a] POSITA would understand that Almadi discloses the recited limitation" without

mentioning the claimed limitation. *Id*. In fact, the terms "*encoded*" or "*shared protocol*" do not even appear in the Petition's perfunctory analysis in [1.a]. *Id*.

On the other hand, Petitioner's expert presented a mapping for this limitation—albeit inadequate—to Almadi's "disclosure of receiving commands, like instructions from a user through remote host 110, which connects through integrated node 100 to … subsystems 120 for controlling operation of well site components," citing four separate sections of Almadi. *See* Ex. 1002 at ¶50. Importantly, none of the cited sections in Almadi support the expert's conclusion.[3] Only 14:4-14:9 of Almadi refers to communication "according to protocols standardized," listing an example like FieldBus type 61158. However, Almadi's mere mention of standardized protocols is not a disclosure or teaching of the claimed received instructions "*being … encoded in a shared protocol*;" and to the extent it even could

[3] Almadi at 11:31-35 disclosed the interconnection of the integrated node 100 with other computers or remote subsystems. Almadi at 12:10-15 disclosed integrated node 100's support of a local programming interface through a computer, such as remote host computer 110. Almadi at 12:55-59 disclosed the remote host 110 can be a SCADA host. Finally, Almadi at 13:51-14:9 disclosed embodiments and functions of input/output unit 104.

be, neither the Petition nor Petitioner's expert identified or explained how a standardized protocol is read upon by the claimed feature.

Petitioner's failure from [1.2] is compounded in [1.5]. Petitioner goes so far as to state that "Almadi discloses protocols different than the shared protocol, above," but never identifies what in Almadi is the "*shared protocol*." *See* Petition (Paper 2) at 14-15. Petitioner's reference to Almadi's "disclosure of various protocols" and equivocation of Almadi's translation of communications with the claimed "*selecting*" element (*id*.) completely ignores the "*shared protocol*" limitation of this element. Petitioner's expert notably leaves out any mention of the "*shared protocol*" in his brief paragraph about [1.5]. *See* Ex. 1002 at ¶55.

Grounds 2 and 3 suffer the same missed mapping for Gutierrez and SCADA. In Ground 2 for Gutierrez, Petitioner again fails to even mention the terms "*encoded*" or "*shared protocol*" in the Petition's discussion of [1.2] and [1.5]. Petition (Paper 2) at 40-41, 43-44. And, again, Petitioner's expert provides no technical analysis to support a plain conclusory statement attributing the claim language of [1.2] and [1.5] to Gutierrez's disclosure. *See* Ex. 1002 at ¶100, ¶42-43.

The same pattern is repeated in Ground 3 for SCADA. Petitioner maps some structural elements in Claim 1 to structural elements in SCADA, but does not discuss what and how operations by these structural elements meet the claimed limitations, such as the received instructions "*being … encoded in a* ***shared protocol***" in [1.2] or

a selected protocol[s] being "*different from the **shared protocol***" in [1.5]. Petition (Paper 2) at 58-59, 61.

As these isolated examples illustrate, the merits of the Petition are far from compelling, and these examples are far from exhaustive. The Petition lacks a complete element mapping as required to meet the §§ 102 and 103 standards; and for what mapping is provided, it is difficult to track and is confusing and inconsistent for several claim limitations (one example demonstrated above).

The Board has previously discretionarily denied Petitions with weak invalidity grounds that could only meet the "reasonable likelihood of prevailing" threshold for a handful of claims ("RLP claims"). For instance, the Board has exercised its statutory discretion elucidated by the court in *SAS Inst. v. Iancu*, 138 S. Ct. 1348 (2018) on multiple occasions. *See*, IPR2018-00923, *Chevron Oronite Company LLC v. Infineum USA L.P.*, Paper 9, Institution Decision at 10-11, and IPR2018-01310, *Deeper, UAB v. Vexilar, Inc.*, Paper 7, Institution Decision at 42-43, both denying institution despite two RLP claims for "not [being] an efficient use of the Board's time and resources."[4] Here the Petition fails to meet the threshold for ***any*** claim, which strongly favors discretionary denial.

[4] *See* Q9 in FAQs for Interim Processes for PTAB Workload Management (https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-

2. The Grounds fail to delineate between § 102 and § 103 arguments or 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 (Paper 2) at 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),[5] thereby favoring discretionary denial.

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management), stating that "the Board panel will not address discretionary considerations, except where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources, as explained in *Chevron* … and *Deeper* … ."

[5] 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)

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

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 one'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 uses boilerplate language to assert the dual anticipation-obviousness theory and follows a robotic pattern. Specifically, the Petition recites the limitation, lists paraphrased disclosure from the reference, then presents a conclusory statement for

each element that "[a] POSITA would have understood" and, for each claim, that the claim "is anticipated by [reference] or would be obvious to a POSITA in view of [reference]." *See, e.g.*, Petition (Paper 2) at 18, 57, and 63. The Petition lacks any explanation as to ***why*** the prior art disclosure would render a limitation obvious to a POSITA. These boilerplate 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 within the limited word count requirements, 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, which warrants dismissal of the Petition based on discretionary considerations.

3. Additional shortcomings of the Petition.

a. Gutierrez Is Not Prior Art.

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

The Petition cites U.S. Patent No. 9,709,995 B2 (referred to as "Gutierrez") as prior art under § 102(a)[6]. Petition (Paper 2) at 9. Gutierrez cannot be § 102(a) prior art because this document's publication date is July 18, 2017 (issue date), nearly four and a half years after the '078 patent's priority date of December 7, 2012. And, Gutierrez cannot be prior art under § 102(e) either because ***Gutierrez's priority chain was broken*** at the time of Gutierrez's filing due to Gutierrez's parent application having gone abandoned.

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

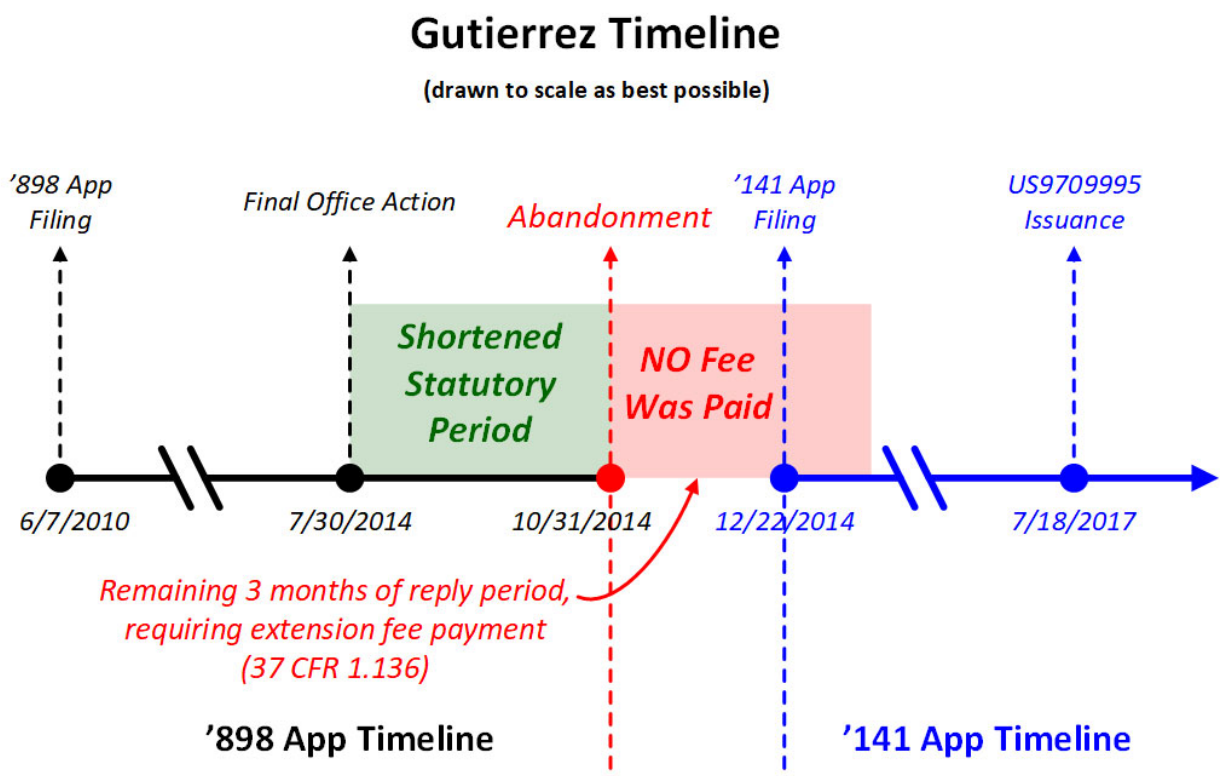
[6] Petitioner purports this was a "typographical" error and seeks permission from the Board to correct (discussed in next section).

failed to reply to an Office Action[7] within the fixed statutory period. *See* MPEP 711.04 ("the date of the abandonment is after midnight of the date on which the set shortened statutory period, including any extensions under 37 CFR 1.136, expired"). *Also see* MPEP 711.02 (citing 37 CFR 1.135(a): "[i]f an applicant of a patent application fails to reply within the time period provided under § 1.134 and § 1.136, the application will become abandoned unless an Office action indicates otherwise").

The applicant of the '898 Application did not pay an extension fee in accordance with § 1.136 between expiration of the shortened statutory period (October 31, 2014) and the filing of the '141 Application (December 22, 2014); and there was no further "Office action" indicating otherwise.[8] Ex. 2006, Ex. 2007. The diagram below illustrates these events chronologically.

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

[8] 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.[9]

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

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

In Ground 1, the Petition cites Almadi as prior art under § 102(a). Petition (Paper 2) at 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

[9] 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.

not issue until March 4, 2014. Therefore, the Almadi patent does not qualify as prior art under § 102(a).[10]

Petitioner's characterization of Gutierrez as § 102(a) prior art suffers the same problem. Gutierrez is not prior art under any subsection of § 102 (see discussion above in section II.F.3.a).

These mischaracterizations of Almadi and Gutierrez are reflective of the multitude of problems and overall inadequacy of the Petition, which should be denied.

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

c. SCADA Was Considered by the Patent Office During the Prosecution of the '078 Patent.

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

Here, the majority of factors weigh in favor of rejecting the Petition because the asserted SCADA reference[11] is substantially the same prior art as previously presented to the Patent Office.

Factor (a) favors Patent Owner because of the numerous similarities and few differences between the asserted SCADA reference and the prior art on SCADA technology proffered by Patent Owner to the Patent Office during prosecution of the '078 patent. The asserted SCADA reference is the 4th edition of a textbook, authored by Stuart A. Boyer, which was written for the purpose of "introduc[ing] student[s] to the basics of SCADA [technology] by providing overviews of relevant topics … and details where necessary." Ex. 1007 at 10. The asserted SCADA reference merely covers "introductory technical material about SCADA systems[, such as] the basic layout of SCADA systems and the parameters for system selection." *Id*. Thus, the asserted SCADA reference is merely a general reference covering common topics about SCADA technology that was ubiquitous at the time of the invention of the '078 patent.

[11] In this section of the Brief, the asserted prior art reference "SCADA" (Ex. 1007) will be referred to as "the asserted SCADA reference," and the subject or technology of SCADA will be referred to as "SCADA technology."

Patent Owner admitted SCADA technology was prior art through discussion in the Background section of the '078 patent specification, and discussed some of its shortcomings.[12] Ex. 1001 at 1:39-50. Patent Owner also submitted two non-patent literature references about SCADA technology in an Information Disclosure Statement (IDS) for the parent of the '078 patent.[13] *See* screenshot below (annotated) of the second page of U.S. Patent No. 8,649,909 (parent of the '078 patent) showing the two SCADA technology references considered by the Office for granting the '078 patent.

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

[13] References submitted in an IDS of the parent of the '078 patent were considered in the examination of the '078 patent's application in accordance with MPEP 609.II.A.2: "[t]he examiner will consider information which has been considered by the Office in a parent application … when examining: (A) a continuation application filed under 37 CFR 1.53(b),"

(56) **References Cited**

U.S. PATENT DOCUMENTS

2004/0088115	A1	5/2004	Guggari et al.	
2004/0231851	A1	11/2004	Silvers	
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2005/0096846	A1*	5/2005	Koithan et al.	702/6
2005/0108504	A1	5/2005	Cowin et al.	
2006/0240818	A1	10/2006	McCoy et al.	
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"SCADALynx—the ultimate solution for oil and gas production intelligence," @eLynx Technologies, LLC, 2011, <www.eLynx Tech.com.> 2011, p. 1, US.

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

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

* cited by examiner

Both the nature and content of the SCADA technology discussed in the patent itself, as well as the IDS submissions, are substantially similar to the asserted SCADA reference, that is, general in scope covering common features and limitations of SCADA technology for its most prolific applications. For instance, the IDS submissions disclosed SCADA technology for oil and/or gas applications (*see* image above); and the asserted SCADA reference disclosed elements and layout of SCADA systems for pipeline systems, oil or gas fields, etc. *See*, e.g., Ex. 1007 at 15-17. Also, for instance, the discussion in the '078 patent specification related to SCADA technology highlights some of the shortcomings and failures of existing SCADA systems (Ex. 1001 at 1:39-50); and the asserted SCADA reference similarly disclosed warnings, pitfalls, and risks with SCADA technology. *See* Ex. 1007 at 6, 159, 170 (e.g., "What Not to SCADA").

The main difference between the asserted SCADA reference and the information brought forth to the Patent Office during prosecution of the '078 patent is the size—not scope—of the information. There was no reason to submit larger or more references describing conventional SCADA technology, like the asserted SCADA reference, since the claimed invention of the '078 patent was unique and distinct. If anything, Patent Owner's discussion of SCADA technology in the specification and IDS submissions demonstrated respect for patent examiners' time and knowledge of the state of the relevant technology that they examine. Thus, Factor (a) weighs in favor of exercising discretion.

Factors (b) and (c) are neutral or favor Petitioner. While an exact copy of the asserted SCADA reference was not in front of the Examiner during prosecution, SCADA technology was discussed in the patent itself, and two SCADA-related references were presented to the Examiner. And, regarding Factor (c), the Examiner did rely on patent prior art[14] that disclosed SCADA technology to initially reject

[14] The Non-Final Office Action mailed August 13, 2014 rejected original claims 10 and 18 using a combination of patent references including PCT Patent Publication WO2008/124765 ("Roberson"), which describes SCADA technology (mentioning "SCADA" about 18 times). Roberson is included in the file wrapper of Ex. 1004 at 271-314.

some original claims during the prosecution of the '078 patent. *See* Ex. 1004 at 253. This prior art used during the prosecution described SCADA technology in a similar manner, i.e., generally, to that in the asserted SCADA reference.

Factor (d) favors Patent Owner because of the substantial overlap among the arguments made during examination (e.g., regarding claim elements/limitations [1.3], [1.4], and [1.6]) and the manner in which Petitioner relies on the asserted SCADA reference. During prosecution of the '078 patent, Patent Owner had argued that any combination of the prior art in the record, which included disclosures about SCADA technology, "does not teach or suggest … the claim feature of "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," as recited by each independent claim." Ex 1004 at 99. The Examiner noted this very detail in the reasons for allowance. *Id*. at 23-24. Petitioner alleges the asserted SCADA reference teaches these claim features [1.3], [1.4], [1.6], but completely lacks a proper showing of these features in that reference. For instance, as discussed above in section II.F.1, Petitioner's arguments failed to map the "***shared protocol***" limitation in [1.5], which is part of the claimed "selecting" process that results in the "***selective respective protocol***" limitation in the "translating" process of [1.6]—none of which are taught by SCADA and demonstrated in the Petition.

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

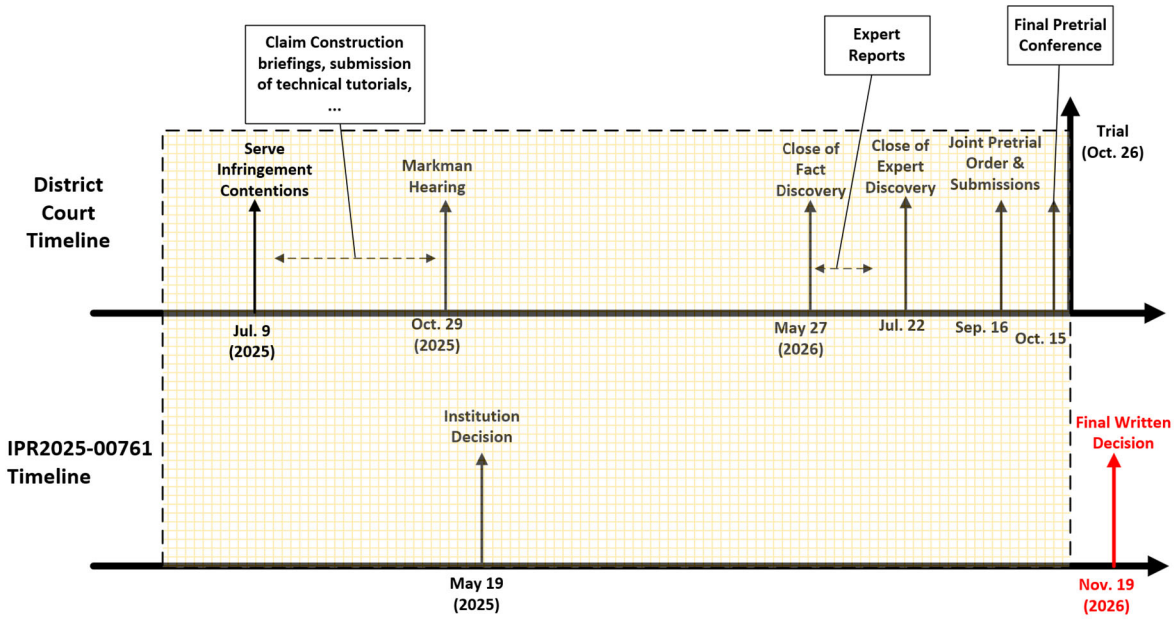
In sum, the tally of *Becton* factors favors the use of discretion, which should deny the Petition for reliance on prior art previously considered during examination of the '078 patent.

III. Additional Considerations Favor Denial

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

The District Court Proceeding asserts eight patents against TankLogix, including U.S. Patent No. 12,019,461 (the "'461 patent"), which is related to the '078 patent through a series of continuations. *See* Ex. 2004, front page. Petitioner is challenging all claims of the '461 patent in IPR2025-00761 by relying on a combination involving Almadi, Gutierrez, and SCADA, each of which is also used

in the present Petition against the '078 patent. The Petition against the '461 patent was accorded a filing date of April 19, 2025 (*see* IPR2025-00761, Paper 6), and therefore its final written decision will issue *after* the trial date of the District Court Proceeding, as shown in below.



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

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

and adjudicating similar invalidity issues, which can be avoided by denying the institution of the present IPR.

B. Settled Expectations.

The '078 patent was issued in 2016 and claims priority to December of 2012. Given that the '078 patent has been in force for close to 10 years, Patent Owner has the settled expectation that it can rely on its patent for enforcing its rights so many years after the patent issued. Therefore, this discretionary consideration favors Patent Owner.

IV. Conclusion

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

Dated: June 13, 2025

Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 C.F.R. § 42.24(d)

Under 37 C.F.R. § 42.24(d), the undersigned certifies that the word count for this *Brief on Discretionary Denial* totals 6,042 words, excluding the parts exempted by 37 C.F.R. § 42.24(a). The word count was made using the built-in word count function in the Microsoft® Word software used to prepare this document.

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CERTIFICATE OF SERVICE

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

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