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. 12,019,461

Case No.: IPR2025-00761

SITEPRO, INC.'S BRIEF FOR DISCRETIONARY DENIAL

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EXHIBIT LIST

No.	Exhibit Description
Ex. 2001	Docket Navigator - Motion Success for Stay Pending IPR for Judge Xavier Rodriguez
Ex. 2002	Scheduling Order for *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	Tanklogix's Preliminary Invalidity Contentions
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	Select Sections of File History of '461 Patent

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. 12,019,461 (the "'461 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. And, the district court litigation trial is scheduled to occur almost a month before the written decision of this IPR, warranting discretionary denial under 35 U.S.C. § 314(a). In addition, all four references relied upon in the Petition were already before the patent examiner during the original examination of the '461 patent, and three (out of four) references were in fact cited by the examiner himself. These facts strongly favor discretionary denial under 35 U.S.C. § 325(d).

The Petition is also substantively flawed and severely lacks in merit. Furthermore, the Gutierrez reference used in the four-reference invalidity combination ground of this Petition does not even qualify as prior art.

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

II. The *Fintiv* Factors Favor Denial

As established in the precedential case of *Apple v. Fintiv*, the Board considers six factors when exercising its discretion to deny an *inter partes* review in view of a parallel proceeding. *Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Those factors are: (1) whether the district court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court's trial date to the Board's projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the district court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the Board's exercise of discretion, including the merits. *Id*. Here, there is a parallel district court proceeding pending in the United States District Court for the Western District of Texas between SitePro, Inc. and Petitioner TankLogix, LLC. The case is *SitePro, Inc. v. TankLogix, LLC*, 6:24-cv-00642-XR-DTG (the "District Court Proceeding"), and has been assigned to District Court Judge, Xavier Rodriguez. As discussed below, the *Fintiv*

factors weigh in favor of the Board denying institution in view of the District Court Proceeding.

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

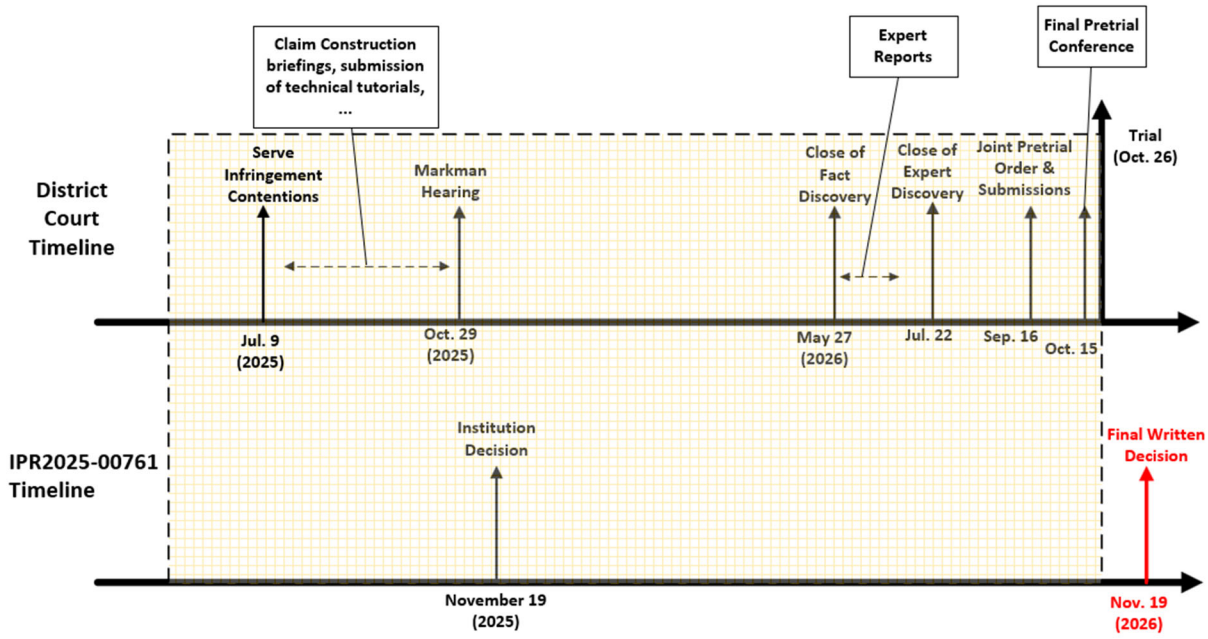
Petitioner has sought a stay in the District Court Proceeding, and to date, the district court has not issued a decision. While Judge Rodriguez has not previously ruled on any contested motions to stay pending IPR (Ex. 2001)[1], SitePro has opposed the motion to stay (Ex. 2005), which is expected to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

B. The final written decision date in this IPR is *after* the district court's trial date.

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

[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).

fact in favor of exercising authority to deny institution." *Fintiv*, IPR2020-00019, Paper 11 at 9. As is the case here, the statutory final written decision deadline is November 19, 2026, whereas the district court trial is scheduled to commence on October 26, 2026. *See* Ex. 2002. With the final written decision issuing more than three weeks after the trial date, all of the effort and resources required to litigate validity in district court would have been spent, as illustrated in the below diagram. *Id*.



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

As illustrated above, all pretrial activities, including claim construction, fact discovery, expert discovery, and dispositive motions would be complete, and the trial itself in all likelihood would end prior to the final written decision. As such, unless the IPR is denied, not only would the two proceedings would 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 67. 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 the District Court Proceeding would be completed before issuance of a final written decision, this factor strongly 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), and Petitioner has served its preliminary invalidity contentions along with all prior art and technical documents. *See* Ex. 2004. Further, by the November 19, 2025 Institution Decision deadline, the parties will have fully briefed their claim

construction arguments and have conducted the *Markman* hearing set for October 29, 2025. *See* Ex. 2002.

Thus, this case is not at the very early stages of litigation, and it will be even further along by the Institution Decision deadline. Thus, this factor strongly 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 has filed what appears to be a *Sotera* stipulation in the IPR, stating that Petitioner will not pursue in litigation "any ground that could be raised under §§ 102 or 103 on the basis of prior art patent or printed publications," and "in the Litigation, [it will] not rely on any product or system art that is 'based on the same evidence presented' in this IPR." Ex. 1013.

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.[2]

[2] Petitioner *Sotera* stipulation appears to refer to another IPR (the one filed against the US 8,649,909 patent) - "the specific grounds [asserted in IPR2025-00647]" (Ex.

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 November 19, 2025. In the meantime, Petitioner has already served its preliminary invalidity contentions, and the parties will complete claim construction briefing by October 15, 2025, and conduct the *Markam* hearing by October 29, 2025. *See* Ex. 2002. While Petitioner awaits the Board's institution decision, Petitioner has already raised overlapping invalidity grounds in the District Court Proceeding, and the parties will have to account for those overlapping grounds during the claim construction phase and the *Markman* hearing, requiring significant duplication of effort. In effect, the district court schedule eliminates much of the resource savings a *Sotera* stipulation might otherwise provide, and in this case, renders it largely meaningless. Thus, this factor weighs in favor of exercising discretion to deny institution.

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

Where the petitioner and the defendant in the parallel proceedings are the same party, this factor favors denial. *See Sotera Wireless, Inc. v. Masimo Corp*.,

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1013 at 2) - and not the instant IPR2025-00651, which includes additional prior art references.

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 68. On the contrary, Petitioner's single invalidity Ground, which is based on a combination of four different references, crumbles even under a cursory review and is significantly flawed when examined closely. While those shortcomings are described in more detail in the forthcoming Patent Owner Preliminary Response,[3] the following provides a few highlights that illustrate significant deficiencies of the Petition.

[3] *See* Q25 in FAQs for Interim Processes for PTAB Workload Management (https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-

1. The purported § 103 arguments in Ground 1 fail to account for all limitations of the challenged claims.

Petitioner asserts the combination of Kahn and Almadi in further view of Gutierrez and SCADA renders obvious the challenged claims under pre-AIA 35 U.S.C. § 103. Petition at 7. This is incorrect. The Petition fails to show the requisite disclosure, teaching, or suggestion in the prior art for several claimed features of independent Claims 1 and 17 and provides no explanation or reasoning for why these features or the claim as a whole would have been obvious.

A finding of obviousness under § 103 requires an objective analysis of a claim within the framework 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). The Petition does not fulfill this obligation because it neglects the second *Graham* factor (ascertaining the differences between the claimed invention and the prior art) for each element of the challenged claims in Ground 1.

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management), stating that "a patent owner may direct attention to an anticipated POPR and evidence for a discussion of the merits."

Not only does the Petition fail to satisfy the requisite legal standard, Petitioner's element-by-element mappings are faulty. The combination of Kahn, Almadi, Gutierrez, and SCADA (hereinafter, the "Combination") does not disclose, teach, suggest, or otherwise render obvious each claimed limitation in Claims 1 and 17.

For ***Claim 1***, the Petition fails to map or provides an unclear and/or incorrect element mapping for several limitations among the nine claim sections (parsed as claim elements [1.1] to [1.9]).

For example, Petitioner fails to map any disclosure from each of Kahn, Gutierrez, Almadi, and SCADA to the claimed feature in [1.9] of "*changing the state of the first fluid-handling device* ***to a sequence of different target states that change over time***."[4] The Petition makes no showing of "*target states*" that are (1) in "*a sequence*," (2) "*different*," and (3) "*change in time*" in the four references. *See* Petition at 35-38. First, the Petition does not even mention the term "*sequence*" in

[4] As Petitioner acknowledges, element [1.5] was listed in the Examiner's reasons for allowance as not being described by the prior art (*see* Petition at 4; *see also* Ex. 1004 at 6-8), which included each reference in the combination: Kahn, Gutierrez, Almadi, and SCADA. *See* Ex. 1001 at Page 2 under U.S. PATENT DOCUMENTS and OTHER PUBLICATIONS.

its perfunctory analysis of the Kahn, Gutierrez, Almadi, and SCADA for [1.9]. *Id*. And, for what analysis is provided, Petitioner argues Gutierrez "discloses reducing the speed of the motor, i.e., to a different target state," based on Gutierrez's disclosure at 10:8-16. *Id*. at 36. However, Petitioner's sole example from Gutierrez mapped to the claimed "*different target states*" does not satisfy the claimed limitation since it is neither "*multiple*" nor "*different*" as required by the claim.[5] Moreover, the Petition points to Kahn—not Gutierrez—in its failed mapping of a target state changing over time. Petition at 36-37 ("Kahn discloses sensors having actuators controlling valves and pumps to change the target states (sensing, recalibrating) over time"). Not only does Kahn not disclose or teach changing different target states over time, Petitioner does not explain how this combines with Gutierrez's disclosure (i.e., stopping or reducing motor speed) to render obvious the claimed feature in full: ***different target states that change over time***. Nevertheless, Petitioner's assertion about Kahn is incorrect because Kahn does not teach remote

[5] Element [1.9] recites "*different target states*" (plural). Petitioner's only example attempting to map "different target states" to the Combination is from Gutierrez, which refers to a processor commanding a motor controller to undergo a single state change, i.e., "stop" or a "reduce[d] speed," in response to a sensed measurement indicative of a minimum threshold or pipeline break. Ex. 1007 at 10:8-16.

control of actuators, and any local actuator control is limited to emergency shut-off[6]—not multiple different target states over different times.

The Petition's remaining discussion of Almadi and SCADA about changing a device state does not cite any examples or even mention changing a state to multiple *target states*, let alone *different states* over *different times*. *See* Petition at 37-38.

Thus, Petitioner's mapping for element [1.9] fails on many levels because (i) the Petition does not address each feature in the limitation; (ii) for what is addressed, Petitioner relies on multiple references' disclosures to allege the feature but provides no explanation of why the feature is obvious in view of the combined teachings; and, most importantly, (iii) the references actually do not disclose, teach, suggest, or render obvious each feature in the claimed limitation.

[6] Kahn discloses "[f]inally, or in addition to, the communication unit 112B can include on-site alerts such as optical (indicator lights), audible alerts (e.g., alarm sounds), tactile (e.g., vibration of the unit) or can be interfaced to an appropriate control valve for simply shutting off the supply of fluid upon the detection of emergency events, for instance." Ex. 1005, 10:62-67, which is the only relevant citation in the Petition pertaining to actuation by Kahn. *See* Petition, 36.

As another example, Petitioner incorrectly maps the claimed "*causing, with the server system, the first computer system … to effectuate the command*" recited in [1.9] to the Combination. First off, Kahn does not teach remote control, so Petitioner's reliance on Kahn's disclosure to demonstrate this claimed feature fails from the start.[7] *See id*. at 36-37. That is, Kahn's server system does not cause the fluid-handling site computer to effectuate a command to a fluid handling device. Petitioner also points to Gutierrez as supposedly disclosing this feature. *See id*. at 35-36. However, Gutierrez does not teach a "*server system*" that is in communication with both a remote user computer and a fluid-handling site computer to control fluid-handling devices. The only mention of "server" in Gutierrez is for computer 305 (Ex. 1007 at 11:34-37), which Petitioner mapped to the claimed "*first client computing device*" in [1.8] (*see* Petition at 33-34) that is required to provide the claimed "*server system*" with the "*command*" later recited in [1.9]. Importantly, Petitioner directly maps Gutierrez's "central controller" to the server, which (1) it is

[7] It is noted that the Petition left Kahn out in its discussion of [1.4], which directly recites ***remote control*** of fluid-handling device: "*providing, with the first computer system disposed at a first fluid handling site, remote control of a first fluid-handling device of the one or more fluid-handling devices*."

not[8] and (2) does not fit with the previous mappings from Gutierrez. *See id*., stating "[t]he "central controller" disclosed in Gutierrez is a server."

Petitioner is silent about Almadi disclosing a server (*id.* at 37), but the Petition refers to SCADA's disclosure of an MTU as the claimed "*server system*." *Id*. at 37-38. Again, Petitioner is incorrect. A master terminal unit (MTU) is not a *server system* in the context of Claim 1. It is a "host computer," although sometimes colloquially referred to as the "SCADA Server." *See* Ex. 1008 at 131. Thus, Petitioner also failed to properly map the initial feature of claim element [1.9].

Furthermore, like for Claim 1, Petitioner also fails to make a sufficient obviousness showing for the other independent claim of the '461 patent. Claim 17 is directed to a method claim with similar limitations as elements [1.1]-[1.9] of Claim 1. For instance, for element [17.10] of Claim 17, Petitioner refers to the Petition's analysis of element [1.9] to assert the ground's obviousness contention. Petition at 66. Thus, for at least the same reasons discussed in the paragraphs above, the Petition fails to demonstrate the element [17.10] is disclosed, taught, suggested, or rendered obvious by the Combination.

[8] Gutierrez's "central controller" is not described as a server but rather an intelligent controller that interfaces between a remote computer and a local controller, like a motor drive. *See* Ex. 1007 at abstract, 2:9-25.

As these isolated examples illustrate, the merits of the Petition are far from compelling, and these examples are far from exhaustive. The Board has previously discretionarily denied Petitions with weak invalidity grounds that could only meet the "reasonable likelihood of prevailing" threshold for a handful 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."[9] Here the Petition fails to meet the threshold for ***any*** claim, which strongly favors discretionary denial.

[9] *See* Q9 in FAQs for Interim Processes for PTAB Workload Management (https://www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management), stating that "the Board panel will not address discretionary considerations, except where the petition presents an insufficient number of challenges that meet the reasonable likelihood standard indicating that institution is an inefficient use of resources, as explained in *Chevron* … and *Deeper* … ."

2. Additional shortcomings of the Petition.

a. Gutierrez Is Not Prior Art.

Petitioner's sole invalidity ground relies on Gutierrez as prior art for its obviousness assertion based on the four-reference combination of Kahn, Almadi, Gutierrez, and SCADA. However, Gutierrez is not prior art under any subsection of 35 U.S.C. § 102, leaving the invalidity ground, and thus the IPR effectively nullified.

The Petition cites U.S. Patent No. 9,709,995 B2 (referred to as "Gutierrez") as prior art under § 102(e). Petition (Paper 2) at 5-6. 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.

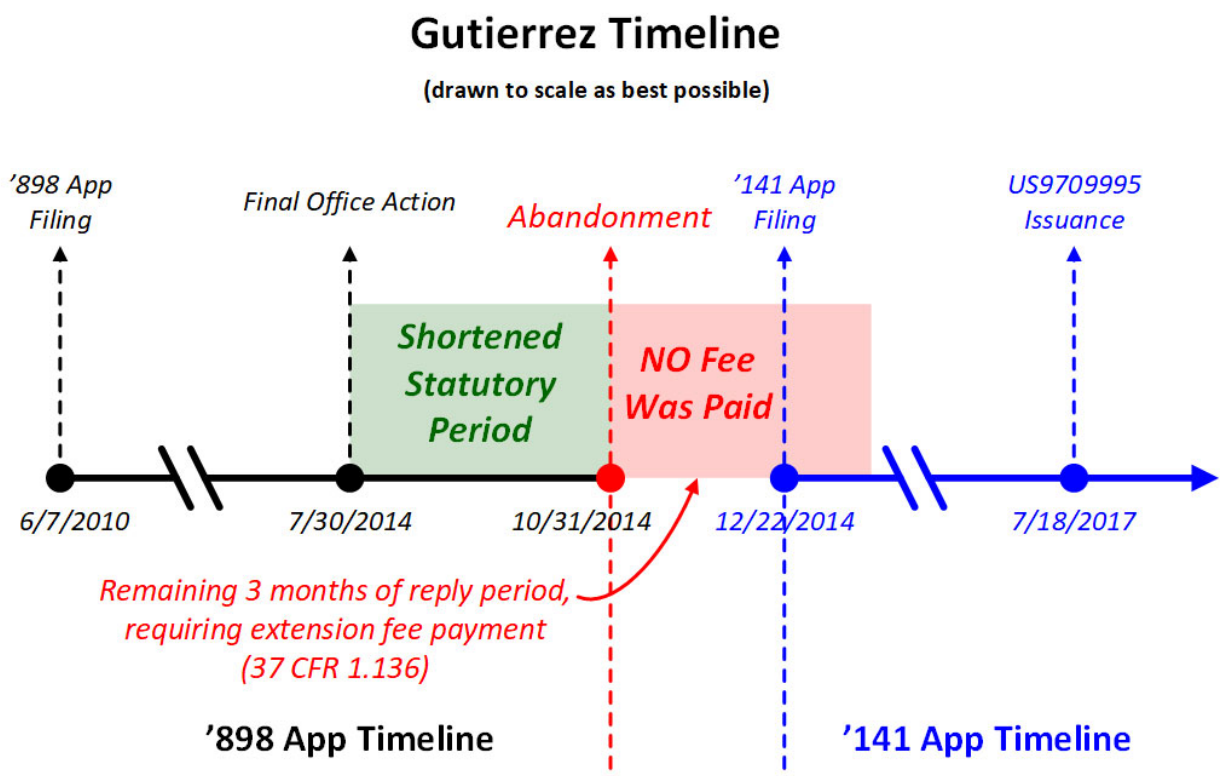
Gutierrez is the U.S. patent issued from U.S. Application No. 14/579,141 ("the '141 Application"), which was filed December 22, 2014 as a continuation of U.S. Application No. 12/794,898 ("the '898 Application"), which was filed June 7, 2010. The '898 Application went abandoned on October 31, 2014 after the applicant failed to reply to an Office Action[10] within the fixed statutory period. *See* MPEP 711.04(a) ("the date of the abandonment is after midnight of the date on which the

[10] 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.

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."). *See also* 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.[11] Ex. 2006; Ex. 2007. The diagram below illustrates these events chronologically.

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



As the above diagram illustrates, the '141 Application (which issued as Gutierrez) was filed after the parent '898 Application was abandoned. Therefore, the '141 Application (and the patent that issued as Gutierrez) is only entitled to a priority date of December 22, 2014, which is after the December 7, 2012 priority date of '461 patent.

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

v. Prostalund AB, 227 F. Supp. 2d 1033, 1035-1040 (E.D. Wis. 2002). The *Urologix* court also made clear that the burden is on the applicant to have "evidence" of the extension of time. *Id.*, 1038. Here, like in *Urologix*, the record shows no payment or petition for an extension of time after expiration of the shortened statutory period for the '898 Application (*see* Ex. 2006), thus cementing its abandonment immediately after the period's three-month duration elapsed.[12]

Thus, Gutierrez's actual priority date is December 22, 2014, more than two years after the '461 Patent's priority date of December 7, 2012. Accordingly, the Petition, and its sole invalidity ground, fail because Gutierrez is not prior art.

III. Discretionary Considerations under Section 325(d) Strongly Favor Denial.

The Board should exercise its discretion in denying petitions for *inter partes* review under 35 U.S.C. § 325(d) because all four references used in the Petition—

[12] 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.

Kahn, Gutierrez, Almadi and SCADA—were already known to, and considered by, the Patent Office during the prosecution of the '461 patent.

The Board may exercise its discretion in denying institution when the same or substantially the same prior art or arguments previously were presented to the Patent Office. *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, if not all, of factors weigh in favor of rejecting the Petition.

A. All Four References Used by the Petition Were Known to, and Already Considered by, the Patent Office.

The Board should exercise its discretion in denying institution under 35 U.S.C. § 325(d) because all four references that the Petition uses in its single invalidity ground were considered during the original prosecution that led to the allowance of the '461 patent.

1. Kahn, Gutierrez and Almadi were cited by the examiner.

As the below screenshot from the prosecution file illustrates (Ex. 2009 at 106), Kahn, Gutierrez and Almadi were cited by the Examiner himself during the prosecution. Notably, the screen shot is part of the document titled "*Notice of References Cited*," and the asterisks in the left column indicate that these references were cited by the Examiner.

Notice of References Cited	Application/Control No. 18/212,131	Applicant(s)/Patent Under Reexamination Phillips, Aaron	
	Examiner CHRISTOPHER E EVERETT	Art Unit 2116	Page 1 of 1

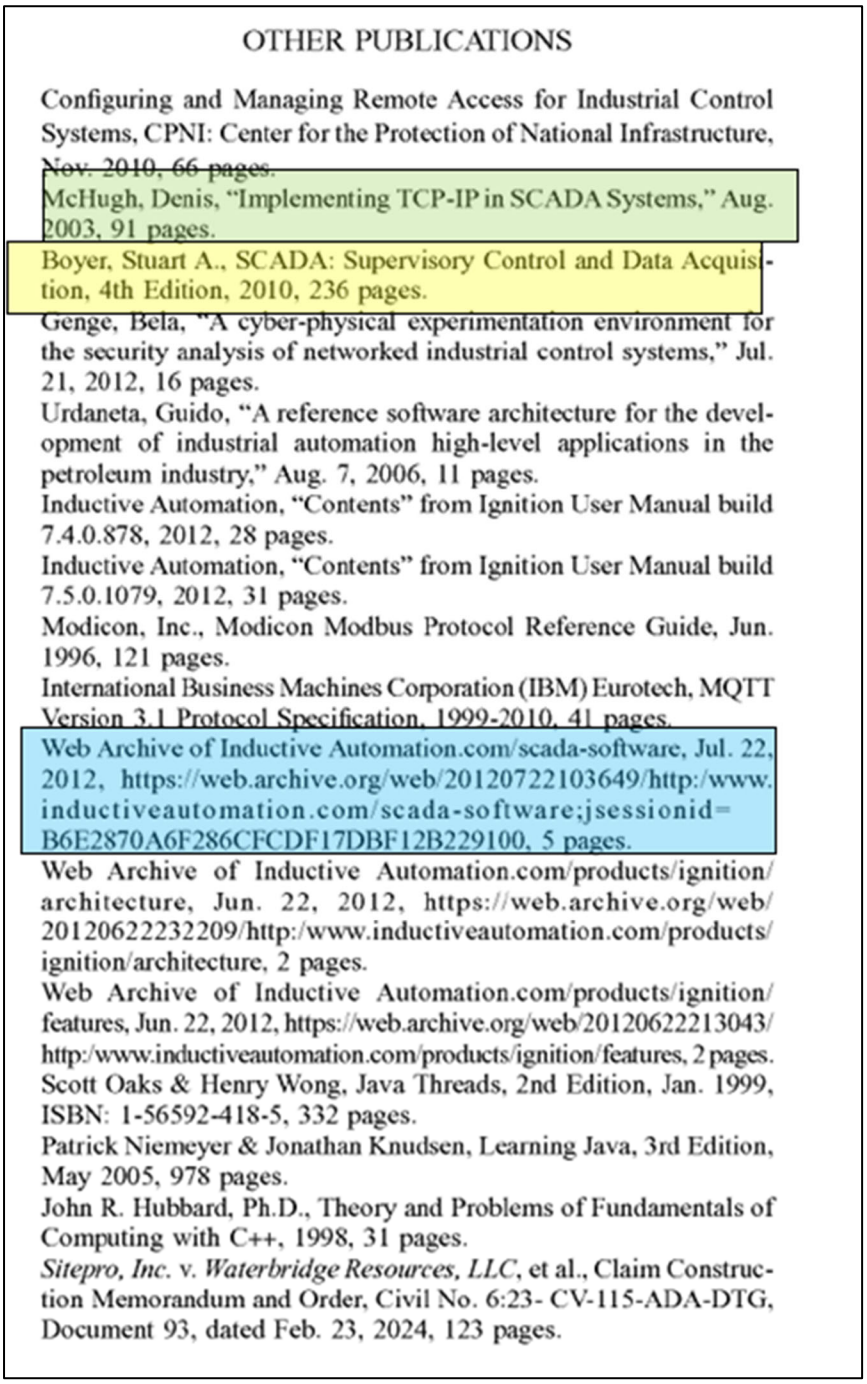
U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date YYYY-MM-DD	Name	CPC Classification	US Classification
*	A	US-20150308244-A1	2015-10-29	Cardamone; David P.	E21B47/008	700/282
*	B	US-20080316048-A1	2008-12-25	Abdallah; Raed H.	G01V11/002	340/854.6
*	C	US-8667091-B2	2014-03-04	Almadi; Soloman M	H04L67/10	709/219
*	D	US-9709995-B2	2017-07-18	Gutierrez; Francisco M.	G05B15/02	1/1
*	E	US-7424399-B2	2008-09-09	Kahn; Malcolm R.	G01N33/18	702/50
	F					
	G					

This is further confirmed on page 2 of the '461 patent, where Kahn, Gutierrez and Almadi appear under the "References Cited" section with an asterisk next to each reference; the explanation at the bottom of page 2 indicates asterisk means "cited by examiner." Ex. 1001 at 2.

2. The SCADA reference was considered by the Patent Office and also discussed in the '461 Patent.

The SCADA reference used in this Petition was submitted by Patent Owner, along with two other SCADA-related references, in an IDS to the Patent Office during the prosecution of the '461 patent. *See* Ex. 2009 at 6-16. The below screenshot shows a portion of the second page of the '461 patent and is annotated to highlight the SCADA references; the yellow-highlighted reference is indeed the same SCADA reference used in this Petition, while the other two SCADA-related references are highlighted in green and blue.



OTHER PUBLICATIONS

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Web Archive of Inductive Automation.com/scada-software, Jul. 22, 2012, https://web.archive.org/web/20120722103649/http:/www.inductiveautomation.com/scada-software;jsessionid=B6E2870A6F286CFCDF17DBF12B229100, 5 pages.

Web Archive of Inductive Automation.com/products/ignition/architecture, Jun. 22, 2012, https://web.archive.org/web/20120622232209/http:/www.inductiveautomation.com/products/ignition/architecture, 2 pages.

Web Archive of Inductive Automation.com/products/ignition/features, Jun. 22, 2012, https://web.archive.org/web/20120622213043/http:/www.inductiveautomation.com/products/ignition/features, 2 pages.

Scott Oaks & Henry Wong, Java Threads, 2nd Edition, Jan. 1999, ISBN: 1-56592-418-5, 332 pages.

Patrick Niemeyer & Jonathan Knudsen, Learning Java, 3rd Edition, May 2005, 978 pages.

John R. Hubbard, Ph.D., Theory and Problems of Fundamentals of Computing with C++, 1998, 31 pages.

Sitepro, Inc. v. *Waterbridge Resources, LLC*, et al., Claim Construction Memorandum and Order, Civil No. 6:23- CV-115-ADA-DTG, Document 93, dated Feb. 23, 2024, 123 pages.

The IDS listing the SCADA references was acknowledged and signed by the examiner, Christopher E. Everett, on January 31, 2024, as shown in the screenshot below. Ex. 2009 at 26.

		[illegible]	
	14	Web Archive of Inductive Automation.com/products/ignition/features, 22 June 2012, https://web.archive.org/web/20120622213043/http:/www.inductiveautomation.com/products/ignition/features, 2 pages.	☐
If you wish to add additional non-patent literature document citation information please click the Add button			Add
EXAMINER SIGNATURE			
Examiner Signature	/Christopher E. Everett/ (01/31/2024)	Date Considered	01/31/2024
*EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609. Draw line through a citation if not in conformance and not considered. Include copy of this form with next communication to applicant.			

Additionally, Patent Owner discussed some of the features and shortcomings of the SCADA technology in the Background and Detailed Description sections of the '461 patent, and specifically identified it as a prior system. Ex. 1001 at 1:63-2:7, 3:22-26. *See 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"). Thus, the discussion of SCADA in the specification of the '461 patent, the submission of multiple SCADA-related references to the patent office, and the examiner's acknowledgement of the IDS filings are collectively a strong indicator that the examiner was aware of and had considered SCADA when examining the '461 patent.

As further explained below, all factors under 35 U.S. 325(d) are strongly in favor of institution denial.

B. Factor (a): Similarities and material differences between the asserted art and the prior art involved during examination.

This factor strongly favors Patent Owner because Kahn, Gutierrez and Almadi—the same references used in this Petition—were cited by the examiner during the prosecution of the '461 patent. And, the same SCADA reference used in this Petition was presented to and acknowledged by the examiner during the original prosecution.

C. Factor (b): The cumulative nature of the asserted art and the prior art evaluated during examination.

This factor strongly favors Patent Owner because the same Kahn, Gutierrez, Almadi, and SCADA references used in the Petition were before the examiner. SCADA was further discussed in the specification of the '461 patent, and the prior art in front of the examiner included at least two other SCADA-related references (See Section III.G.A above), making the use of SCADA yet again in the Petition clearly cumulative over the prior examination.

D. Factor (c): The extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection.

Factor (c) also favors Patent Owner because, while the only basis for rejection of claims during the prosecution of the '461 patent was a non-statutory double-patenting rejection (*see* Ex. 2009 at 30-48), the examiner had himself cited Kahn, Gutierrez and Almadi as prior art, which is a clear indication that the examiner had

evaluated the merits of those references, and had determined that the then-pending claims were patentable over those references.

E. Factor (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.

This factor is neutral or favors Patent Owner because there were no arguments made during the original examination regarding the Petition's references, *despite* the fact that the examiner was in possession of all four references, and had actually cited three of them.

F. Factor (e): Whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art.

This factor favors Patent Owner because Petitioner has not set forth any discussions of how and whether the examiner erred.

G. Factor (f): the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

This factor strongly favors Patent Owner because Petitioner does not set forth any discussion of Section 325(d) considerations, and as explained in Section III.F.1, the technical merits of the proposed invalidity ground are weak.

In sum, the *Becton* factors favor discretionary denial of the Petition for reliance on prior art previously considered during examination of the '461 patent.

IV. Conclusion

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

Dated: July 18, 2025

Respectfully submitted,

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

Under 37 C.F.R. § 42.24(d), the undersigned certifies that the word count for this *Brief on Discretionary Denial* totals 4,406 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 18th day of July, 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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