

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION

Petitioner,

v.

EDGE NETWORKING SYSTEMS, LLC,

Patent Owner.

Case No. IPR2025-00618
U.S. Patent No. 11,695,823

**BRIEF IN SUPPORT OF PATENT OWNER'S REQUEST FOR
DISCRETIONARY DENIAL**

TABLE OF CONTENTS

PATENT OWNER’S EXHIBIT LIST iv

I. INTRODUCTION.....1

II. DISCRETIONARY DENIAL IS APPROPRIATE UNDER THE
ADVANCED BIONICS FRAMEWORK AND THE *BECTON
DICKINSON* FACTORS2

A. Distributed Application Development Environment Disclosed
In ‘823 Patent.....5

B. Prosecution History Of ‘823 Patent8

C. Differences Between The Disclosure Of Van der Merwe And
The Unified Capabilities Recited In The Final Wherein
Clause Of Claim 1 Of The ‘823 Patent.....12

D. With Respect To The Unified Capabilities Recited In Claim 1
Of The ‘823 Patent, The Vasell Reference Relied On In The
Petition Is Cumulative Of The Van der Merwe Reference
That Was Applied During Prosecution.....14

E. The *Advanced Bionics* And *Becton Dickinson* Factors Favor
Discretionary Denial Because The Vasell Reference Relied
On In The Petition Is Cumulative Of The Van der Merwe
Reference Applied During Prosecution, And The Petition
Has Failed To Allege That The Office Erred In Applying
Van der Merwe During Prosecution18

1. The Cumulative Nature Of The Art Asserted In The Petition
And The Prior Art Considered During Examination Favor
Discretionary Denial Under Factors (A) And (B)21

2. The Extent To Which The Asserted Art Was Evaluated
During Examination, Including Whether The Prior Art
Was The Basis For Rejection; The Extent Of The Overlap
Between The Arguments Made During Examination And
The Manner In Which Petitioner Relies On The Prior Art
Favor A Discretionary Denial Under Factors (C) And
(D).....21

3. Whether Petitioner Has Pointed Out Sufficiently How The
Examiner Erred In Its Evaluation Of The Asserted Prior
Art And The Extent To Which Additional Evidence And

	Facts Presented In The Petition Warrant Reconsideration Of Prior Art Or Arguments Favor A Discretionary Denial Under Factors (E) And (F).....	22
F.	Petitioner’s Feinted Ignorance Of The <i>Becton Dickinson</i> Factors Is Unavailing	22
G.	Petitioner’s Conclusory Assertion That The Art Presented In The Petition Describes The Claim Limitations Added To Gain Allowance Is False	24
III.	PETITIONER’S GAMESMANSHIP IN CONNECTION WITH CLAIM CONSTRUCTION WARRANTS DISCRETIONARY DENIAL.....	25
IV.	PETITIONER’S ATTEMPT TO PASS OFF A FABRICATED VERSION OF FIGURE 2 FROM VASELL AS REPRESENTING THE ACTUAL VERSION OF FIGURE 2 FROM THE REFERENCE WARRANTS DISCRETIONARY DENIAL.....	27
V.	THE EXPERT TESTIMONY ACCOMPANYING THE PETITION IS EXCESSIVE AND WARRANTS DISCRETIONARY DENIAL.....	28
VI.	THE UNRELIABILITY OF THE INFORMATION INCLUDED IN THE PETITION WARRANTS DISCRETIONARY DENIAL	29
VII.	CONCLUSION	32

PATENT OWNER'S EXHIBIT LIST

Ex. 2001	U.S. Patent Publ. 2013/0054763 (Van der Merwe)
Ex. 2002	<i>Ruckus Wireless, Inc. v. Hera Wireless SA et al.</i> , IPR2018-01739, Petition for Inter Partes Review, Paper 1,

I. INTRODUCTION

Pursuant to the Memorandum by the Acting Director dated March 26, 2025, setting forth the “Interim Processes for PTAB Workload Management” (the Memorandum), the Patent Owner hereby sets forth the applicable bases for discretionary denial of institution. This filing is being made within two months of the Notice of Filing Date Accorded To Petition (Paper #6). As explained more fully below, the *Advanced Bionics* framework and *Becton Dickinson* factors, as well as several additional factors, favor the discretionary denial of institution.

The Petitioner advances a combination of prior art that is, at best, cumulative of the art applied during prosecution. With respect to the claim limitation requiring “unified capabilities that enable a plurality of upper layer APIs” to perform a programming function -- which was critical to patentability -- the Petition relies on the Vasell reference which is, at best, cumulative of the Van der Merwe reference applied during prosecution. Simply put, discretionary denial under *Advanced Bionics* and *Becton Dickinson* is warranted, because the prior art relied on in the Petition is, at best, cumulative of the art applied during prosecution, and the Petition does not allege (let alone demonstrate) that the Office erred in allowing the application over such art.

The Petitioner’s gamesmanship also favors discretionary denial. While Petitioner maintains in the district court that the claimed “programmable network

device” recited in claim 1 of the ‘823 Patent requires a “sandboxing operating system” (which, in turn, requires a “kernel”), Petitioner’s mapping of Vasell to the claimed “programmable network device” in these proceedings makes no mention of a “sandboxing operating system” or a “kernel.” Ex. 1071, 2-3 and 7-8; Pet., 46-47. The fact that the Petitioner is engaging in this type of gamesmanship, without providing any reason for doing so, provides a further basis for discretionary denial.

Beyond such gamesmanship, the Petition attempts to pass off a fabricated version of Figure 2 of Vasell for the actual figure from the reference. The Petition performs this sleight of hand not once, not twice or three times - but *four times*. Pet., 5, 17, 24 and 44. In addition, the Petition’s extensive reliance on a voluminous 295-page expert declaration (Ex. 1003) comprising 579 paragraphs, as well as the use of such declaration for filling gaps in the prior art, favors discretionary denial.

For all of these reasons, and as explained more fully below, the Director should exercise her discretion to deny institution.

II. DISCRETIONARY DENIAL IS APPROPRIATE UNDER THE ADVANCED BIONICS FRAMEWORK AND THE BECTON DICKINSON FACTORS

The specification of the ‘823 Patent discloses a distributed application that is formed from network and cloud applications running on different devices that communicate with each other, together with “tools to facilitate development, testing, debugging and verifications” of such applications. *Id.*, 10:25-31 and 16:39-42. The

tools facilitate the unified development of the components of the distributed application by providing a development environment in which multiple components forming the distributed application (e.g., the network and cloud applications) can be developed and tested together. *Id.*, 16:43-47 (the development kit “allows the developer to develop the components together to simplify the development and testing.”) (emphasis added). In keeping with this disclosure of a unified development environment in the specification, the Applicant presented claims during prosecution reciting “unified capabilities enabling a plurality of upper layer application programming interfaces (APIs) to program the plurality of network device applications and plurality of cloud applications.” As explained more fully below, the prosecution history demonstrates that, in the Examiner’s view, this limitation specifying such “unified capabilities” was what distinguished the claims over the prior art applied by the Examiner.

Turning to the prosecution of the ‘823 Patent, following a Final Rejection of all the original claims (1-18), the Applicant cancelled all of the pending claims and added new claims 19-38 (of which claims 19, 37 and 38 were independent). Ex. 1002, 124-129 and 133-137. New independent claim 19 included a final wherein clause substantially reciting the “unified capabilities” limitation described, while new independent claims 37 and 38 recited no such limitation. *Id.* In the next Office Action, the Examiner rejected independent claims 37 and 38 as anticipated by U.S.

Patent Publ. 2013/0054763 (Van der Merwe) (Ex. 2001) but found independent claim 19 allowable over the same reference. *Id.*, 94-100. While the Examiner understood that Van de Merwe disclosed distributed applications and APIs for developing such applications, the Examiner found that Van der Merwe *failed* to disclose or suggest the “unified capabilities” that enable APIs to perform programming as recited in the final wherein clause of claim 19. *Id.*, 10-11 and 100. Following claim amendments relating to 35 U.S.C. ¶112, the Examiner allowed the application, and claim 19 from the Application became claim 1 in the ‘823 Patent. *Id.*, 10-14 and 41-48.

With respect to the “unified capabilities” limitation recited in claim 1 of the ‘823 Patent, the Petition relies on provisional application no. 60/123,971 (the ‘971 Provisional Application) (Ex. 1016) which the Vasell Patent (Ex. 1004) purports to have incorporated by reference. Ex. 1004, 1:8-10. Consistent with the Examiner’s understanding that Van der Merwe disclosed the claimed “distributed application” and APIs for developing such applications, the ‘971 Provisional Application provides for the implementation of services as “distributed applications” that execute “over several infrastructure nodes,” and describes the use of APIs for developing such distributed applications. Ex. 1016, 4, 8. However, just like Van der Merwe, there is no disclosure in the ‘971 Provisional Application (or elsewhere in

the Vasell Patent) disclosing any “*unified capabilities*” that enable APIs to program a distributed application, as claimed.

Thus, with respect to the “unified capabilities” recited in claim 1 of the ‘823 Patent that formed the basis of patentability during prosecution, the disclosures from Vasell relied on in the Petition are cumulative of the Van der Merwe reference that was applied during prosecution and found wanting, i.e., both references lack the “unified capabilities that enable a plurality of upper layers APIs” to perform their stated programming function as claimed. As a result, and as explained more fully below, the *Becton Dickinson* factors favor discretionary denial because the prior art relied on in the Petition is, at best, cumulative of the art applied by the Examiner, and the Office did not err in allowing the application over that prior art during prosecution.

A. Distributed Application Development Environment Disclosed In ‘823 Patent

The ‘823 Patent disclosed a Distributed Software Defined Network (dSDN) that simplifies the programmability of an application distributed across multiple hardware elements in the network. Ex. 1001, 2:32-38. “A high-level overview of a dSDN system 300 is depicted in FIG. 3,” which is reproduced with colored annotations added by Patent Owner. *Id.*, 10:8-9. The dSDN system 300 includes,

inter alia, “a flexible network device (fxDevice) 302 [red box]” and “a flexible cloud platform (fxCloud) 304 [green box].” *Id.*, 10:9-11.

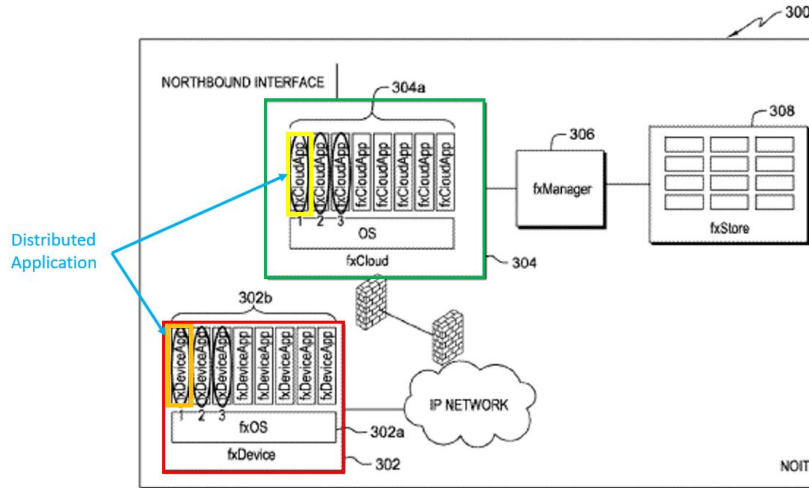


FIG. 3

In the dSDN system shown above, a FxDeviceApp 302b [orange box] can communicate with a fxCloudApp 304a [yellow box] to form a distributed application [identified with blue arrows and text]. As explained in the '823 Patent, an “fxDeviceApp 302 may have a sister app in the backend cloud infrastructure (i.e., flexible cloud platform 304) referenced here as fxCloudApp 304a. The fxCloudApp 304a in the cloud is paired with its fxDevice-App 302b in the fxDevice 302. The fxCloudApp 304a and the fxDeviceApp 302b collectively form a distributed application (dApp or fxApp).” *Id.*, 10:25-31

The ‘823 Patent discloses a “flexible Software Development Kit (fxSDK)” that includes “tools to facilitate development, testing, debugging and verifications” of distributed applications. *Id.*, 16:39-42. As the ‘823 Patent explains, “since the

dSDN applications may have a device component (fxDevice 302) and cloud component (fxCloud 304), the fxSDK allows the developer to develop the components together to simplify the development and testing.” *Id.*, 16:43-47 (emphasis added). Thus, with respect to a distributed application comprising a FxDeviceApp 302b together with a fxCloudApp 304a, the tools facilitate the unified development of the device component (residing on fxDevice 302) and the cloud component (residing on fxCloud 304) of the distributed application by providing a development environment in which both components can together be developed and tested.

The software development tools simplify the usage of upper layer APIs that “abstract out the hardware dependencies for the upper layers and programmers.” *Id.*, 12:20-21 (emphasis added) and 16:51-52. As explained in the ‘823 Patent, this development environment “simplifies the usage [of] system created APIs and application created APIs,” including providing “system level APIs with remote accessibility.” *Id.*, 16:47-48 and 16:51-52. Consistent with “abstracting out” of the division of the distributed application’s functionality as deployed on different devices, the remote API accessibility allows “the APIs in the fxDevice 302” to “be accessed via the applications in the fxCloud (fxCloudApps) and vice versa.” *Id.*, 16:49-51.

B. Prosecution History Of '823 Patent

Following a Final Rejection of all claims (1-18) based on a nonstatutory double patenting rejection, the Applicant cancelled all of the previous claims and added new claims 19-38 (of which claims 19, 37 and 38 were independent). Ex. 1002, 124-129 and 133-137. Independent 19 recited as follows:

19. (New) A system comprising a plurality of network elements, said network elements comprising:

a programmable network device adapted to host a plurality of first network applications;

a programmable cloud device adapted to host a plurality of second network applications, wherein the plurality of first network applications in the programmable network device and the plurality of second network applications in the programmable cloud device are in secure communication with each other to form distributed applications; and

wherein the programmable network device and programmable cloud device form unified capabilities enabling a plurality of upper layer application programming interfaces (APIs) that allow for simultaneous programming of the programmable network device and programmable cloud device independent of network device hardware and cloud device hardware. *Id.*, 125.

Three aspects of claim 19 are worthy of note.

First, claim 19 specifies that a “plurality of first network applications in the programmable network device and the plurality of second network applications in the programmable cloud device are in secure communication with each other *to form distributed applications.*” These limitations correspond to the disclosures in the specification where a FxDeviceApp 302b (which corresponds to one of the “first

network applications in the programmable network device”) and a fxCloudApp 304a (which corresponds to one of the “second network applications in the programmable cloud device”) together form a distributed application. Ex. 1001, 10:25-31.

Second, claim 19 recites that “the programmable network device and programmable cloud device form unified capabilities enabling a plurality of upper layer application programming interfaces (APIs)” that allow” for “programming of the programmable network device and programmable cloud device independent of network device hardware and cloud device hardware.” These limitations correspond to the software development tools disclosed in the specification that provide a unified environment that allows a developer to develop the components of a distributed application together. *Id.*, 12:20-21 (emphasis added) and 16:43-52.

Third, the plain language of the limitation reciting “unified capabilities enabling a plurality of upper layer application programming interfaces (APIs) ...” makes clear that the “unified capabilities” and the “plurality of upper layer APIs” are not one and the same. More specifically, the claim language specifies that the “unified capabilities” are what enable the “upper layer APIs” to perform their stated programming function. Thus, the claim language makes clear that the “unified capabilities” are not one and the same as the “plurality of upper layer APIs” -- rather, the two are different.

In contrast to new independent claim 19, new independent claims 37 and 38 lacked the limitations in the final wherein clause of claim 19 relating to the unified capabilities and the APIs described in the paragraph immediately above. More specifically, new independent claims 37 and 38 recited:

37. (New) A system comprising a plurality of network elements, said network elements comprising:

a programmable cloud device having a plurality of virtual machines, wherein of the virtual machines has at least one of a plurality of first network applications; and

a programmable network device adapted to process data flows having at least one of a plurality of second network applications, wherein the first and second network applications are in secure communication to form a distributed application.

38. (New) A system comprising a plurality of network elements, said network elements comprising:

a programmable cloud device having a plurality of zones, wherein of the plurality of zones has at least one of a plurality of first network applications; and

a programmable network device adapted to process data flows having at least one of a plurality of second network applications, wherein the first and second network applications are in secure communication to form a distributed application. Ex. 1002, 128-129.

In the next Office Action, the Examiner rejected independent claims 37 and 38 as anticipated by U.S. Patent Publ. 2013/0054763 (Van der Merwe) but found independent claim 19 allowable over the same reference. Ex. 1002, 94-100. The Examiner found that *Van der Merwe disclosed* first and second network applications on different hardware where “*the first and second network applications* are in secure communication *to form a distributed application*” -- a requirement *common to each*

*of independent claims 19, 37 and 38.*¹ Ex. 1002, 98-99. However, while the Examiner found that Van de Merwe disclosed such distributed applications, the Examiner found that Van der Merwe *failed* to disclose or suggest the “*unified capabilities*” that enable APIs to program a distributed application recited in the final wherein clause of claim 19 which, as explained in the specification, provide a *unified* development environment in which *multiple components* (deployed on different hardware) of the distributed application are developed and tested *together*. Ex. 1001, 16:43-47 (emphasis added). In this regard, the Examiner explained that the prior art (which included Van de Merwe) failed to teach or render obvious the recitation of such “unified capabilities” in the final wherein clause in claim 19:

Claims 19-36 are allowed over the prior art.

The following is an examiner’s statement of reasons for allowance:

The prior art does not teach or render obvious to one of ordinary skill in the art, before the earliest effective filing date of the claimed invention, in the specific combinations and manner recited within the claims, the features of:

“...wherein the programmable network device and programmable cloud device form unified capabilities enabling a plurality of upper layer application programming interfaces (APIs) that allow for simultaneous programming of the programmable network device and programmable cloud device independent of network device hardware and cloud device hardware.” Id., 100.

¹ Patent Owner does not concede that the Examiner’s findings as set forth herein are correct.

In the next response, the Applicant deleted claims 37-38 from the Application. *Id.*, 100. Following claim amendments relating to 35 U.S.C. ¶112, the Examiner allowed the application. *Id.*, 41-48 and 10-14. Claim 19 from the Application became claim 1 in the ‘823 Patent.

By way of summary, during the prosecution history the Examiner applied the Van der Merwe reference to the pending claims and found that, while claims 37 and 38 were anticipated by the reference, the final wherein clause in claim 19 distinguished that claim from the reference. Thus, the prosecution history demonstrates that, in the Examiner’s view, while the Van der Merwe reference disclosed first and second network applications on different hardware devices that communicated to form a distributed application, the reference failed to teach or render obvious the final wherein clause of claim 19 specifying that “the programmable network device and programmable cloud device form *unified capabilities enabling a plurality of upper layer application programming interfaces (APIs)*” to perform their stated programming function.

C. Differences Between The Disclosure Of Van der Merwe And The Unified Capabilities Recited In The Final Wherein Clause Of Claim 1 Of The ‘823 Patent

As explained above, the Examiner found that Van der Merwe disclosed the “distributed applications” recited in the claims of the application. In addition, Van

der Merwe provided API functionality for developing, creating or deploying its applications. For example, Van der Merwe disclosed the following:

To enable client administrators to provide coupling information and/or create, modify, and/or deploy enterprise applications, the example client coupler 130 includes an API interface 708. The example API interface 708 includes a web-based interface that enables client administrators to specify which VPMNs are to be coupled to which client VPNs and/or virtual machines. ...

The example API interface 708 of FIG. 7 also enables client administrators to develop, deploy, and/or modify enterprise applications through a MPaaS. This enables clients to utilize virtual machines within the cloud computing data center 134 to deploy their own services (e.g., a service deployment platform configured for mobility and cloud computing environments) and use the security of the virtual routes coupling these virtual machines to VPMNs and VPNs to provide custom control capabilities. In some examples, the client administrators have third parties develop and/or deploy the applications within the virtual machines. Ex. 2001, ¶¶[0119]-[0120].

Thus, while the Examiner found that Van der Merwe disclosed the claimed “distributed application” (i.e., first and second network applications on different hardware that communicated to form a distributed application), and Van der Merwe disclosed APIs for creating such an application, Van der Merwe lacked the “unified capabilities” that enable APIs to program multiple devices as recited in the final wherein clause of claim 19 which, as explained in the specification, provide a unified development environment in which multiple components (e.g., the first and second network applications to be deployed on different devices) of the distributed application are developed and tested together. Ex. 1001, 16:43-47. In the context of

the prosecution history as a whole, the Examiner's reasons for allowance demonstrate that, in the Examiner's view, the absence of any disclosure of such "unified capabilities" that enable APIs to perform their stated programming function in Van der Merwe distinguished claim 19 from the reference. Ex. 1002, 100.

D. With Respect To The Unified Capabilities Recited In Claim 1 Of The '823 Patent, The Vasell Reference Relied On In The Petition Is Cumulative Of The Van der Merwe Reference That Was Applied During Prosecution

With respect to the "unified capabilities" limitation recited in claim 1 of the '823 Patent, the Petition relies on provisional application no. 60/123,971 (Ex. 1016) (the '971 Provisional Application) (Ex. 1016) which the Vasell Patent (Ex. 1004) purports to have incorporated by reference. Ex. 1004, 1:8-10. Like the Examiner's view that Van der Merwe disclosed the claimed "distributed application," the '971 Provisional Application provides for the implementation of services as "distributed applications" that execute "over several infrastructure nodes," and described the use of APIs for developing such distributed applications. Ex. 1016, 4, 8. However, just like Van der Merwe, there is no disclosure in the '971 Provisional Application (or elsewhere in the Vasell Patent) disclosing any "unified capabilities" that enable APIs to program a distributed application as claimed. For example, there is no disclosure in the '971 Provisional Application (or elsewhere in the Vasell Patent) of anything akin to the unified development environment disclosed in the specification of the

‘823 Patent where *multiple components* of a distributed application are developed, tested and deployed *together*. Ex. 1001, 16:43-47.

Simply put, with respect to the “unified capabilities” recited in claim 1 of the ‘823 Patent, the disclosures from Vasell relied on in the Petition are cumulative of that of the Van der Merwe reference that was applied during prosecution and found wanting, i.e., both references lack the “unified capabilities that enable a plurality of upper layers APIs” to perform their stated programming function as claimed. Set forth below are the portions of Vasell (specifically, the ‘971 Provisional Application of Vasell) relied on in the Petition for the claimed “*unified capabilities that enable a plurality of upper layer APIs*” to perform their stated programming function:

The development environment must follow the “write-once, run-everywhere” maxim and should be based on Java standards. New applications will interact with the e-service infrastructure through Java application program interfaces (API) that comply with mainstream Java development. By leveraging the Java development, the application software environment can be taken to a higher level of abstraction, allowing nonspecialists to develop service applications more easily. Ex. 1016, 4.

* * *

Boxlets are created using a standard Java development environment. For instance, the Java development kit (JDK) from Sun Microsystems can be used as well as other development environments. The only parts that are specific to boxlet development are the libraries that contain APIs for the main services and system services layers. Ex. 1016, 8.

For at least three reasons, the above disclosures relied on in the Petition are no better than, and therefore cumulative of, the Van der Merwe reference that was applied during prosecution.

First, the fact that “the development environment must follow the ‘write-once, run-everywhere’ maxim” speaks to the characteristics of software output by the development environment -- lacking is any disclosure of “unified capabilities” within that environment “that enable a plurality of upper layer APIs” to perform a programming function, as claimed. For example, the fact that “the development environment must follow the ‘write-once, run-everywhere’ maxim” does not equate with the unified development environment disclosed in the specification of the ‘823 Patent where multiple components of a distributed application are developed and tested together. Ex. 1001, 16:43-47.

Second, the fact that “[n]ew applications will interact with the e-service infrastructure through Java application program interfaces (API) that comply with mainstream Java development” speaks only to the characteristics of software output by the development environment. Absent from the fact that new applications will interact using Java APIs is any disclosure of “unified capabilities that enable” such APIs to perform a programming function, as claimed. As explained above, the “unified capabilities” recited in the claim are not one and the same as the “plurality of upper layer APIs” recited in the claim. Specifically, the claim language specifies

that the “unified capabilities” are what *enable* the “upper layer APIs” to perform their stated programming function “to program the plurality of network device applications and plurality of cloud applications independent of network device hardware and cloud device hardware.” Thus, Vasell’s disclosure of “Java application program interfaces (API)” standing alone fails to meet the claim language -- what is lacking is any disclosure of “*unified capabilities that enable*” such APIs to perform a programming function.

Third, the fact that “Boxlets are created using a standard Java development environment” is not a disclosure that such a development environment includes “*unified capabilities that enable*” APIs to perform a programming function. For example, the fact that the Java development environment is “standard” does not translate to such an environment having characteristics like the *unified* development environment disclosed in the specification of the ‘823 Patent where *multiple components* of a distributed application are developed, tested and deployed *together*. Ex. 1001, 16:43-47. In this respect, Vasell’s “standard” Java development environment is cumulative of “API interface 708” in Van der Merwe that “enables client administrators to develop, deploy, and/or modify enterprise applications.” Ex. 2001, [0120]. In both cases, common API interfaces are provided for developing applications that will run on a given platform. And in both cases, the fact that the common (or standard) APIs are used for developing multiple applications on a given

platform fails to disclose “*unified capabilities that enable*” APIs to perform a programming function, as claimed.

For at least these reasons, it is clear that the disclosures relied on in the Petition for the “unified capabilities” recited in the claims of the ‘823 Patent are no better than, and cumulative of, the Van der Merwe reference that was applied during prosecution.

E. The *Advanced Bionics* And *Becton Dickinson* Factors Favor Discretionary Denial Because The Vasell Reference Relied On In The Petition Is Cumulative Of The Van der Merwe Reference Applied During Prosecution, And The Petition Has Failed To Allege That The Office Erred In Applying Van der Merwe During Prosecution

As explained in *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GMBH*, IPR2019-01469, Paper #6, 7-8 (P.T.A.B. 2020) (Precedential):

... 35 U.S.C. § 325(d) identifies two separate issues for the Director to consider in exercising discretion to deny institution of review: whether the petition presents to the Office the same or substantially the same art previously presented to the Office, or whether the petition presents to the Office the same or substantially the same arguments previously presented to the Office. ...

Under § 325(d), the art and arguments must have been previously presented to the Office during proceedings pertaining to the challenged Patent. Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS), in the prosecution history of the challenged patent. ... If the “same or substantially the same prior art or arguments previously were presented to the Office,” then the Board’s decisions generally have required a showing that the Office erred in evaluating the art or arguments. See, e.g., *Becton, Dickinson*, Paper 8 at 24 (considering whether the petitioner has pointed out

sufficiently how the examiner erred in its evaluation of the asserted prior art). If the petitioner fails to show that the Office erred, the Director may exercise his discretion not to institute inter partes review. *Id.* (exercising discretion where “Petitioner has not pointed to error by the Examiner”).

In the present case, Van der Merwe’s disclosure was previously applied by the Office and, with respect to the “unified capabilities” limitation that was critical to patentability, Vasell is cumulative of Van der Merwe in that both references lack any disclosure of “unified capabilities that enable a plurality of upper layer APIs” to perform a programming function, as claimed. It was, therefore Petitioner’s burden to demonstrate that the Office erred. Petitioner utterly failed to meet this burden. Petitioner has not even alleged (let alone demonstrated) that the Office erred in applying Van der Merwe during prosecution. Accordingly, discretionary denial of the Petition is warranted under the *Advanced Bionics* framework.

Simply put, institution of inter partes review is not warranted in this case because the Petition relies entirely on prior art that was cumulative of prior art applied by the Patent Office during prosecution. As set forth in *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential), the Board considers six non-exclusive factors in determining whether to exercise discretion under 35 U.S.C. § 325(d) based on the prior consideration of art and arguments. When applied to the record here, each of these factors, enumerated below, weighs in favor of discretionary denial.

- (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 prior art or arguments.

Specifically, the Van der Merwe reference -- which the Examiner understood as disclosing both distributed applications and API interfaces for developing such applications -- was applied by the Office during prosecution, and the prosecution history demonstrates that the Office concluded that the “*unified capabilities*” limitation claimed in the ‘823 Patent was neither shown nor suggested by such disclosures. With respect to the “unified capabilities” limitation recited in the ‘823 Patent, the Petition relies on Vasell’s distributed applications and API interfaces for developing such applications which are cumulative of Van der Merwe which was found wanting. The Petition fails to identify any error in the Office’s analysis and offers no material new evidence warranting reconsideration. As detailed below, under the totality of the circumstances, institution should be denied pursuant to 35 U.S.C. §325(d).

1. The Cumulative Nature Of The Art Asserted In The Petition And The Prior Art Considered During Examination Favor Discretionary Denial Under Factors (A) And (B)

The only prior art asserted in the Petition for the “unified capabilities” limitation is Vasell. Since Vasell’s disclosure with respect to this limitation is at best cumulative of that in Van der Merwe, factors (a) and (b) from *Becton, Dickinson* support discretionary denial.

2. The Extent To Which The Asserted Art Was Evaluated During Examination, Including Whether The Prior Art Was The Basis For Rejection; The Extent Of The Overlap Between The Arguments Made During Examination And The Manner In Which Petitioner Relies On The Prior Art Favor A Discretionary Denial Under Factors (C) And (D)

Van der Merwe was applied by the Office during the prosecution of the ‘823 Patent, where the reference formed the basis of a rejection. *See*, Section II(B), *supra*. Moreover, with respect to the claimed “unified capabilities” limitation there is complete overlap between the question presented by Van der Merwe and Vasell: namely, whether the distributed applications in combination with common (or standard) APIs used for developing multiple applications on a given platform discloses “unified capabilities that enable” APIs to perform a programming function, as claimed - a question that the Office has already answered in the negative. Given this overlap, factors (c) and (d) from *Becton, Dickinson* support discretionary denial.

3. Whether Petitioner Has Pointed Out Sufficiently How The Examiner Erred In Its Evaluation Of The Asserted Prior Art And The Extent To Which Additional Evidence And Facts Presented In The Petition Warrant Reconsideration Of Prior Art Or Arguments Favor A Discretionary Denial Under Factors (E) And (F)

The Petitioner bears the burden of showing that the Office erred in finding that the distributed applications in combination with common (or standard) APIs for developing multiple applications on a given platform as disclosed in Van der Merwe and Vasell teaches or renders obvious “unified capabilities that enable” APIs to perform a programming function, as recited in the claims of the ‘823 Patent. In the present case, the Petition has not alleged, let alone demonstrated, that the Office erred. Thus, factors (e) and (f) from *Becton, Dickinson* support discretionary denial.

In sum, all six *Becton, Dickinson* factors—(a) through (f)—support discretionary denial of institution under 35 U.S.C. § 325(d). This is precisely the type of case that the *Becton, Dickinson* factors were intended to address: a Petition that merely repackages art that is cumulative of that already vetted by the Office, without identifying error or providing sufficient justification for a second look. Accordingly, the Director should decline to institute inter partes review in the exercise of her discretion under § 325(d).

F. Petitioner’s Feinted Ignorance Of The *Becton Dickinson* Factors Is Unavailing

The Petition alleges:

Petitioner is unaware of any authority holding *Advanced Bionics* to be satisfied where (like here) the prosecution history lacks discussion of any reference relied upon in this petition. In such situations, the Board routinely does not decline institution on §325 grounds. Pet., 79 (emphasis added).

As *Becton Dickinson* makes clear, the prosecution history does not need to include a discussion of the reference(s) relied on in the Petition in order to meet the standard for discretionary denial. Rather, the *Becton Dickinson* factors focus on “the similarities and material differences between the asserted art and the prior art involved during examination” as well as “the cumulative nature of the asserted art and the prior art evaluated.” *Becton, Dickinson*, IPR2017-01586, Paper 8 at 17–18 (emphasis added). It strains credulity that Petitioner was unaware that discretionary denial is appropriate where, as here, instead of relying on the same art discussed in the prosecution history, the Petition relies on art that is cumulative of that applied in the prosecution history.²

² For example, in another IPR Petition filed by Petitioner’s counsel, Petitioner’s counsel engages in an analysis of the *Becton Dickinson* factors, including “the similarities and material differences between the asserted art and the prior art involved during examination” and “the cumulative nature of the asserted art and the prior art evaluated.” *Ruckus Wireless, Inc. v. Hera Wireless SA et al.*, IPR2018-01739, Petition for Inter Partes Review, Paper 1, at 71-74. Ex. 2002.

G. Petitioner’s Conclusory Assertion That The Art Presented In The Petition Describes The Claim Limitations Added To Gain Allowance Is False

In its discretionary denial analysis, the Petition sets forth the conclusory allegation that “the prior art presented describes the claim limitations that were added to gain allowance.” Pet., 79-80 (emphasis added). In an attempt to support this allegation, the Petition obfuscates by providing a cross-citation to “§V.A-§VII.A.6” of the Petition -- which corresponds to pages 6-43 of the Petition. Nowhere in those pages (or elsewhere) does the Petition identify any “claim limitations that were added to gain allowance.” The discussion of the prosecution history in the Petition is limited to a single sentence which fails to mention any “claim limitations that were added to gain allowance.” Pet., 10. Simply put, the Petition contains no analysis whatsoever to support its position that the prior art presented in the Petition “describes the claim limitations that were added to gain allowance.”

In summary, the *Becton*, *Dickinson* factors support discretionary denial because the Petition merely repackages art that is cumulative of that already vetted by the Office, without identifying error. Petitioner’s feinted ignorance of the *Becton Dickinson* factors, which focus on whether the Petition relies on art that is cumulative of that discussed in the prosecution history, provides no justification for allowing this IPR challenge to continue. Moreover, Petitioner’s conclusory allegation that

“the prior art presented describes the claim limitations that were added to gain allowance” lacks any support in the record and therefore is entitled no weight. Accordingly, the Director should exercise her discretion and decline to institute *inter partes* review.

III. PETITIONER’S GAMESMANSHIP IN CONNECTION WITH CLAIM CONSTRUCTION WARRANTS DISCRETIONARY DENIAL

The Petition should be denied under the Director's discretionary authority because the Petition is predicated on claim construction positions that cannot be reconciled with those advanced by Petitioner in the district court. In the district court, Petitioner has taken the position that key claim terms of the ‘823 Patent require specific technical structures, such as the presence of a “sandboxing operating system” (which, in turn, requires a “kernel”) in the “programmable network device.” Ex. 1071, 2-3 and 7-8. Yet, without providing any reason for doing so, the Petitioner has abandoned those positions in these IPR proceedings in favor of giving every term its “plain and ordinary meaning” to a person of ordinary skill in the art. Pet., 10.

While in the district court, Petitioner maintains that the “programmable network device” recited in claim 1 of the ‘823 Patent requires a “sandboxing operating system” (which, in turn, requires a “kernel”), Petitioner’s mapping of Vasell to the claimed “programmable network device” in these proceedings makes

no mention of a “sandboxing operating system” or a “kernel.” Ex. 1071, 2-3 and 7-8; Pet., 46-47. This type of procedural gamesmanship—advancing narrow claim constructions to avoid infringement in district court while simultaneously asserting broad constructions to support invalidity at the PTAB while providing no reason for doing so—is precisely the type of conduct that favors denial of institution. The Board should not permit a petitioner to exploit the IPR process in this manner. Petitioner’s failure to present a consistent and legally sound claim construction, and its reliance on claim interpretations it has elsewhere disparaged, undermine the integrity of this proceeding and provide ample basis for discretionary denial.

Petitioner asserts that “the Petition Grounds render the claims unpatentable under either party’s construction.” (Pet., 11) This assertion is demonstrably *false*, because, in Petitioner’s mapping of the “programmable network device” recited in claim 1 of the ‘823 Patent to Vasell, the Petition does not allege, let alone demonstrate, that Vasell has a “*sandboxing operating system*” that, in turn, includes a *kernel*. Pet., 46-47. The purpose of an IPR is not to provide an accused infringer with a mechanism for simultaneously advancing a narrow claim construction in district court that suits Petitioner’s non-infringement arguments and a broad claim construction in the PTAB that suits Petitioner’s invalidity arguments. Such gamesmanship favors a discretionary denial of the Petition.

Under 37 C.F.R. § 42.104(b)(3), a petitioner must provide a clear articulation of “[h]ow the challenged claim is to be construed.” Here, the Petitioner failed to meet this burden by basing the Petition on claim constructions that Petitioner believes are incorrect. These aspects of the Petition favor discretionary denial.

IV. PETITIONER’S ATTEMPT TO PASS OFF A FABRICATED VERSION OF FIGURE 2 FROM VASELL AS REPRESENTING THE ACTUAL VERSION OF FIGURE 2 FROM THE REFERENCE WARRANTS DISCRETIONARY DENIAL

Without alerting the PTAB that it had made substantive changes to the diagram, the Petition attempts to pass off a fabricated version of Figure 2 of Vasell for the actual figure from the reference. The Petition performs this sleight of hand not once, not twice or three times - but four times. Pet., 5, 17, 24 and 44.

Set forth below is the actual version of Figure 2 from Vasell (without any changes or annotations):

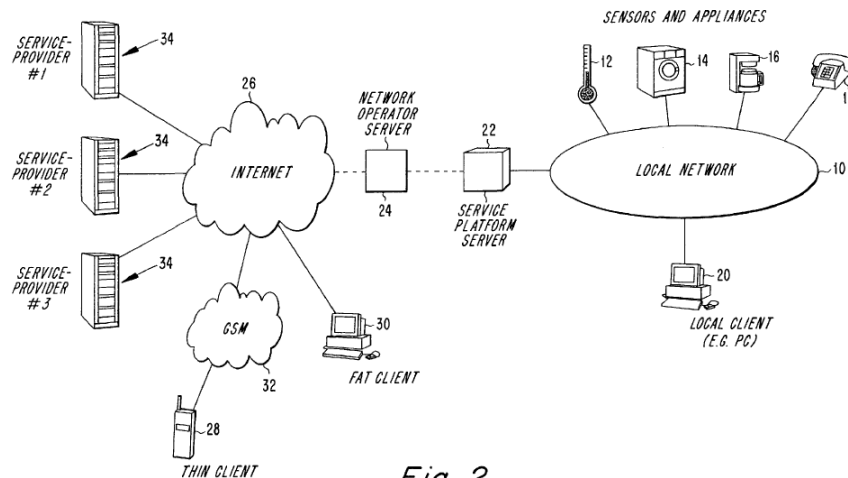
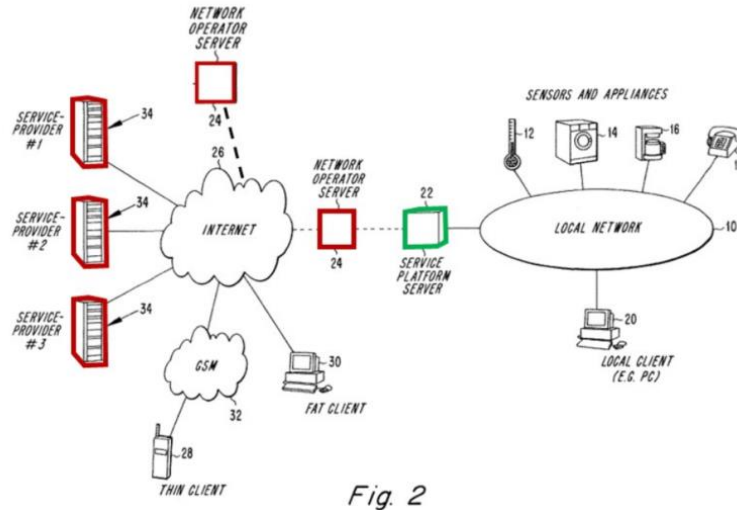


Fig. 2

As shown above, the space above Internet 26 is completely blank.

Set forth below is the fabricated version of Figure 2 of Vasell that the Petition (at page 5) attempts to pass off as the real thing:



Pet., 5. As shown above, in the Petition, the space above Internet 26 is no longer blank. Instead, the Petition has inserted a fabricated “Network Operator Server” 24 into the previously blank space above Internet 26. The Petition never alerts the Board to this issue, essentially passing off the Petition’s fabricated version of Figure 2 of Vasell for the real one. The Petition repeats its fabricated version of Figure 2 of Vasell again on pages 17, 24 and 44.

V. THE EXPERT TESTIMONY ACCOMPANYING THE PETITION IS EXCESSIVE AND WARRANTS DISCRETIONARY DENIAL

One of the relevant considerations for discretionary denial under 35 U.S.C. § 314(a), as identified in the Memorandum, is “[t]he extent of the petition’s reliance on expert testimony.” Memorandum, at 1. In this case, the Petition relies heavily on a 295-page expert declaration (Ex. 1003) comprising 579 paragraphs — well beyond

what is appropriate. In addition, the Petition impermissibly and excessively relies on expert testimony to fill gaps in the prior art. For example, the Petition relies extensively on the testimony of Petitioner's expert for the assertion that Vasell discloses the “unified capabilities enabling a plurality of upper layer application programming interfaces (APIs) to program the programmable network device and programmable cloud device” Ex. 1003, ¶¶453-463.

The voluminous expert declaration is also unreliable, as it contains multiple instances of the same fabricated versions of Figure 2 of Vasell set forth in the Petition. *See*, Section III, *supra*; and Ex. 1003, ¶¶ 190, 302 and 398.

Given the extensive and improper use of expert testimony, the Petition fails to comply with statutory requirements and undermines the integrity of the IPR process. Accordingly, this factor further supports discretionary denial under 35 U.S.C. § 314(a) and the guidance of the Memorandum.

VI. THE UNRELIABILITY OF THE INFORMATION INCLUDED IN THE PETITION WARRANTS DISCRETIONARY DENIAL

As explained above, Petitioner’s assertion that “the Petition Grounds render the claims unpatentable under either party’s construction” is demonstrably *false*, because, while in the district court, Petitioner maintains that the “programmable network device” recited in claim 1 of the ‘823 Patent requires a “sandboxing operating system” (which, in turn, requires a “kernel”), Petitioner’s mapping of

Vasell to the claimed “programmable network device” in these proceedings makes no mention of a “sandboxing operating system” or a “kernel.” Ex. 1071, 2-3 and 7-8; Pet., 46-47.

Petitioner’s false statement that the Petition renders “the claims unpatentable under either party’s construction” is not the only evidence demonstrating that the information in the Petition is unreliable. For example, as explained above, both the Petition and the expert declaration attempt multiple times to pass off a fabricated version of Figure 2 of Vasell for the actual figure from the reference. *See*, Sections IV and V, *supra*.

Petitioner’s assertions with respect to discretionary denial discussion further demonstrate that the information in the Petition is unreliable. Specifically, Petitioner’s assertion that it is “unaware of any authority holding *Advanced Bionics* to be satisfied where (like here) the prosecution history lacks discussion of any reference relied upon in this petition,” is suspect. *See*, note 2, *supra*. As the *Becton Dickinson* decision makes clear, the prosecution history does not need to include a discussion of the reference(s) relied on in the Petition in order to meet the standard for discretionary denial. Rather, the *Becton Dickinson* factors support discretionary denial where, instead of relying on the same art discussed in the prosecution history, the Petition relies on art that is cumulative of that discussed in the prosecution history.

In yet a further example of unreliability, the Petition sets forth the conclusory (and completely unsupported) allegation that “the prior art presented describes the claim limitations that were added to gain allowance,” and then obfuscates the lack of support for the proposition by providing a cross-citation to “§V.A-§VII.A.6” of the Petition -- which corresponds to pages 6-43 of the Petition. Pet., 79-80; *see also*, Section III(F), *supra*.

Given this pattern of incorrect statements and obfuscations, it is clear that the information in the Petition cannot be taken at face value. Instead, the only way to separate fact from fiction would be to engage in the time-consuming exercise of checking the accuracy of each and every citation in the 82-page Petition. Engaging in such an exercise is not a good use of the Board’s resources. The unreliability of the information set forth in the Petition provide yet an additional reason favoring discretionary denial.

VII. CONCLUSION

For the reasons set forth above, the Director should exercise her discretion and deny institution.

Respectfully submitted,

Dated: June 15, 2025

By: /Daniel H. Golub/
Daniel H. Golub
Registration No. 33,701

*Counsel for Patent Owner
Edge Networking Systems, LLC*

CERTIFICATE OF COMPLIANCE WITH WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), I certify that this **BRIEF IN SUPPORT OF PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL** complies with the type-volume limits set forth in the Memorandum and 37 C.F.R. § 42.24 because it contains 6,985 words, excluding the parts of the Brief that are exempted by 37 C.F.R. § 42.24(a), according to the word processing system used to prepare this Brief.

Respectfully submitted,

Dated: June 15, 2025

By: /Daniel H. Golub/
Daniel H. Golub
Registration No. 33,701

*Counsel for Patent Owner
Edge Networking Systems, LLC*

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **BRIEF IN SUPPORT OF PATENT OWNER’S REQUEST FOR DISCRETIONARY DENIAL** was served via email (as consented to by counsel) on June 15, 2025 to lead and backup counsel of record for Petitioner as follows:

Christopher J. Tyson
DUANE MORRIS LLP
901 New York Avenue N.W., Suite 700 East, Washington, D.C. 20001
CJTyson@duanemorris.com

John M. Baird
DUANE MORRIS LLP
901 New York Avenue N.W., Suite 700 East, Washington, D.C. 20001
JMBaird@duanemorris.com

Glenn D. Richeson
DUANE MORRIS LLP
1075 Peachtree Street NE, Suite 1700, Atlanta, GA 30309
GDRicheson@duanemorris.com

Patrick D. McPherson
DUANE MORRIS LLP
901 New York Avenue N.W., Suite 700 East, Washington, D.C. 20001
PDMcPherson@duanemorris.com

Respectfully submitted,

Dated: June 15, 2025

By: /Daniel H. Golub/
Daniel H. Golub
Registration No. 33,701

*Counsel for Patent Owner
Edge Networking Systems, LLC*