

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

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

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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. PETITIONER HAS FAILED TO ALLEGE THAT THE EXAMINER ERRED IN HIS EVALUATION OF VAN DER MERWE

The fifth *Becton Dickinson* factor asks “whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art.” *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, at 17–18 (PTAB Dec. 15, 2017) (emphasis added). This factor asks whether the Examiner erred in evaluating whether the asserted prior art which, in the present case, corresponds to whether the Examiner erred in finding that the distributed applications and APIs disclosed in Van der Merwe (of which Vasell is cumulative) failed to meet the “unified capabilities” limitation recited in claim 1 of the ‘823 Patent. Here, Petitioner fails to allege any such error, focusing instead on aspects of the prosecution history having nothing to do with the Examiner’s decision to allow claims over the distributed applications and APIs disclosed in Van der Merwe.

It is undisputed that, with the Van der Merwe reference squarely before him, the Examiner rejected pending independent claims 37 and 38 as anticipated by 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. Ex. 1002, 98-

99. Van der Merwe also disclosed APIs for such applications. Ex. 2001, [0021]. However, while Van der Merwe disclosed such distributed applications and APIs, 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. Ex. 1002, 100. Petitioner has failed to allege that the Examiner erred in any manner in reaching this conclusion. For example, Petitioner has not alleged that the Examiner erred in allowing claims reciting the claimed “unified capabilities” over Van der Merwe’s disclosure of distributed applications and APIs (to be clear, the Examiner committed no such error).

II. PETITIONER’S ALLEGATION OF ERROR BASED ON CLAIMS PRESENTED DURING PROSECUTION OF THE ‘624 APPLICATION IS IRRELEVANT

Petitioner’s allegation of “error” has nothing to do with the Examiner’s decision to allow claims reciting the claimed “unified capabilities” over Van der Merwe. For example, the Opposition alleges that:

... It appears that this Examiner was not aware that one of the Applicant’s statements, in the same July 2022 Amendment, was inaccurate, namely that “added new claims 19-38 ... **are not coextensive with the prior applications of this family.**” EX1002, 130 (emphasis added); *see also id.* at 124-129. It appears that this Examiner was also not aware of the reason for this statement’s inaccuracy, namely that, during the grandparent ‘624 Prosecution History, the original Examiner of the applications in this patent family rejected **virtually identical** claims to those Applicant added in July 2022 over prior art. (emphasis in original). Opposition, 19 (emphasis in original).

Petitioner fails to explain what this so-called error has do with the Examiner's decision to allow claims reciting the claimed "unified capabilities" over Van der Merwe's disclosure of distributed applications and APIs (of which Vasell is cumulative). Thus, this allegation misses the mark.

III. PETITIONER'S ALLEGATIONS FAIL TO EXPLAIN WHAT ERROR THE EXAMINER ALLEGEDLY COMMITTED

The Petitioner has failed to explain how its so-called error is any error at all. While Petitioner alleges that claims similar to those allowed in the '823 Patent file history were rejected based on Anderson, Kempf and Nickolov in the '624 Patent file history (Opposition, 23-24), the Examiner in the '823 Patent had all of these references in front of him. Ex. 1002, 192-193 (citing Anthony (US 2014/0241158), Kempf (US 2012/0300615) and Nickolov (US 2009/0276771)). More importantly, Petitioner fails to allege that the Examiner in the '823 Patent committed any error at all in allowing the '823 Patent over the combination of Anderson, Kempf and Nickolov. Completely lacking from Petitioner's Opposition is any allegation -- let alone the required analysis demonstrating --- that the combination of Anderson, Kempf and Nickolov renders the claims at issue unpatentable. In fact, Petitioner admits that it has no evidence demonstrating that Applicant's 2022 statement actually affected the Examiner in any way. Opposition, 23 ("It is unclear from the '823 Prosecution History how much influence the Applicant's July 2022 inaccurate

statement had” on the Examiner). The Petition fails to explain how a statement *by the Applicant* equates to error *by the Examiner*, particularly when Petitioner admits that it lacks evidence that the statement affected the Examiner in any way.

IV. PETITIONER’S SUGGESTION THAT THE EXAMINER WAS DECEIVED IS WITHOUT MERIT

Based on a statement quoted out of context, Petitioner wrongly suggests that the Applicant deceived the Examiner. In the first office action in the ‘823 Patent, the Examiner issued a statutory double patenting rejection based on the ‘095 and ‘871 Patents. Ex. 1002, 170-173. In the next Office Action, the Examiner maintained the statutory double patenting rejection based on the ‘095 Patent, noting that “[t]he filing a terminal disclaimer cannot overcome a [statutory] double patenting rejection.” *Id.*, 135-136. In Applicant’s response cancelling the rejected claims and adding new claims 19-38, the Applicant stated:

Claims 1-18 are rejected on the ground of statutory double patenting as being unpatentable over U.S. Patent No. 10,893,095.

Applicant has canceled claims 1-18 and added new claims 19-38 which are not coextensive in scope with the prior applications of this family. ... Ex. 1002, 130 (emphasis added).

In context, the Applicant remark that the new claims were “not coextensive in scope with the prior applications” was made to explain that the prior statutory double patenting rejection did not apply to the new claims. Petitioner’s suggestions to the contrary are wholly without merit.

As mentioned above, the Examiner in the ‘823 Patent considered the Anthony, Kempf and Nickolov references raised in the ‘624 prosecution history. *Id.*, 192-193 Moreover, subsequent to Applicant’s remarks about the new claims, and at the time the Examiner applied Van der Merwe, the Examiner identified and cited Kempf (US 2015/0071053), which has an identical disclosure and priority date to the Kempf reference relied on in the earlier rejection in the ‘624 Patent. *Id.*, 102. The most plausible explanation is that the Examiner was aware of the prior rejection of claims based on Anderson, Kempf and Nickolov, and in connection with updating his search of those references, found the newer version of Kempf. Thus, in addition to being totally irrelevant to the *Becton Dickinson* analysis at hand, Petitioner’s suggestion that the Examiner was deceived is wholly without merit.

In summary, the Petitioner has failed to explain how the Examiner erred in finding that the distributed applications and APIs disclosed in Van der Merwe (of which Vasell is cumulative) failed to meet the “unified capabilities” limitation recited in claim 1 of the ‘823 Patent. In addition, Petitioner has failed to explain how a statement by the Applicant untethered to the Examiner’s consideration of Van der Merwe equates to material error by the Examiner for purposes of the present *Becton Dickinson analysis*, particularly when Petitioner acknowledges the lack of evidence that the statement affected the Examiner in any way.

Respectfully submitted,

Dated: July 22, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S AUTHORIZED REPLY IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served via email (as consented to by counsel) on July 22, 2025 to lead and backup counsel of record for Petitioner as follows:

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