

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

WALMART INC. and WALMART STORES TEXAS, LLC
Petitioners

v.

RAVENWHITE SECURITY, INC.,
Patent Owner

Case: IPR2025-00810
U.S. Patent No. 10,594,823

**PETITIONERS' SUR-REPLY TO PATENT OWNER'S REPLY BRIEF ON
DISCRETIONARY DENIAL**

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PETITIONER’S EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 10,594,823 (the “823 patent”).
1002	Declaration of Dr. Craig Wills
1003	File history of U.S. Patent No. 10,594,823.
1004	U.S. Patent No. 7,908,645 (“Varghese”).
1005	U.S. Patent Publication No. 2003/0115267 (“Hinton”)
1006	U.S. District Courts – Combined Civil and Criminal Federal Court Management Statistics (June 30, 2024).
1007	<i>Ravenwhite Licensing LLC v. The Home Depot, Inc.</i> , 2:24-cv-00688, Dkt. 1 (EDTX Aug. 21, 2024) (Complaint).
1008	<i>Ravenwhite Licensing LLC v. The Home Depot, Inc.</i> , 2:23-cv-00423, Infringement Contentions Cover Pleading (EDTX Dec. 4, 2023).
1009	<i>Ravenwhite Licensing LLC v. The Home Depot, Inc.</i> , 2:23-cv-00423, ’823 Infringement Contentions (EDTX Dec. 4, 2023).
1010	Provisional Application No. 60/732,025 (“Provisional”)
1011	<i>Ravenwhite Licensing LLC v. The Home Depot, Inc.</i> , 2:23-cv-00423, Plaintiff’s P.R. 4-1 Disclosures (EDTX Aug. 8, 2024).
1012	Balachander Krishnamurthy and Craig E. Wills, <i>Generating a privacy footprint on the Internet</i> , In Proceedings of the ACM SIGCOMM Internet Measurement Conference, pages 65-70, Rio de Janeiro, Brazil (Oct. 2006).
1013	Jon Purdy, <i>Session Management for Clustered Applications</i> (Feb. 2005) (available at https://www.oracle.com/technical-resources/articles/enterprise-architecture/session-management.html).
1014	“Local Shared Objects—‘Flash Cookies,’” Electronic Privacy Information Center (EPIC) (July 21, 2005) (available at https://archive.epic.org/privacy/cookies/flash.html).
1015	“The Pharming Guide (part 2)” (Dec. 14, 2004) (available at: http://www.technicalinfo.net/papers/Pharming2.html).
1016	“Misfortune Cookies: Adjusting Internet Explorer to Block Tracking Web Cookies,” Gibson Research Corporation (last modified Aug. 13, 2005) (available at https://www.grc.com/cookies.htm).
1017	Ileene Chernoff, “Cookie crumbs, an introduction to cookies,” SANS Institute (2005) (available at https://www.giac.org/paper/gsec/226/cookie-crumbs-introduction-cookies/100727).

1018	Michael Nelte and Elton Saul, “Cookies: Weaving the Web into a State,” Crossroads, The ACM Magazine for Students, Vol. 7, Issue 1, pp. 10-13, (Sept. 1, 2000) (available at https://dl.acm.org/doi/10.1145/351092.351097).
1019	Edward W. Felten and Michael A. Schneider, “Timing Attacks on Web Privacy” (Nov. 25, 2002) (available at https://web.archive.org/web/20021125051243/http://www.cs.princeton.edu/sip/pub/webtiming.pdf).
1020	SecuriTeam.com, “Timing Attacks of Web Privacy (Paper and Specific Issue)” (Feb. 20, 2002) (available at https://web.archive.org/web/20021020062537/http://www.securiteam.com/securityreviews/5GP020A6LG.html).
1021	Martin Pool, “meantime: non-consensual http user tracking using caches” (last revised March 29, 2000) (available at https://sourcefrog.net/projects/meantime).
1022	United Virtualities, “United Virtualities Develops ID Backup to Cookies” (March 31, 2005) (available at https://web.archive.org/web/20050408075600/http://www.unitedvirtualities.com/UV-Pressrelease03-31-05.htm).
1023	Antone Gonsalves, “Company Bypasses Cookie-Deleting Consumers,” Information Week (March 31, 2005) (available at https://www.informationweek.com/it-leadership/company-bypasses-cookie-deleting-consumers).
1024	Dr. Craig Wills, CS3013 Course Notes Week 4 (2004) (available at https://web.cs.wpi.edu/~cs3013/c04/week4-memmgmt.pdf).
1025	Prof. Howard Hamilton, CS330 Course Notes Week 4 (2003) (available at https://www2.cs.uregina.ca/~hamilton/courses/330/notes/memory/MemoryHierarchy.html).
1026	John Schwartz, “Giving Web a Memory Cost Its Users Privacy,” New York Times (Sept. 4, 2001) (available at https://www.nytimes.com/2001/09/04/business/giving-web-a-memory-cost-its-users-privacy.html).
1027	Thomas Chung, “HOWTO: Installing Flash Plugin in Firefox Way,” FedoraNEWS.ORG (Sept. 16, 2004) (available at https://fedoranews.org/tchung/firefox-flash/).
1028	Adrian Ludwig, “Macromedia® Flash® Platform Security and Macromedia Enterprise Solutions” (Sept. 2005) (available at https://www.adobe.com/platform/whitepapers/flashplatform security ent

	erprise.pdf).
1029	Order Granting Motion to Stay, <i>RavenWhite Licensing LLC v. The Home Depot, Inc. et al</i> , Case No. 2:24-cv-00688-JRG-RSP, Dkt. No. 96 (E.D. Tex. June 18, 2025).
1030	Plaintiff's Response to Home Depot's Motion to Stay Pending IPR, <i>RavenWhite Licensing LLC v. The Home Depot, Inc. et al</i> , Case No. 2:24-cv-00688-JRG-RSP, Dkt. No. 76 (E.D. Tex Feb. 11, 2025).
1031	Plaintiff's Notice of Readiness for Scheduling Conference, <i>RavenWhite Licensing LLC v. The Home Depot, Inc. et al</i> , Case No. 2:24-cv-00688-JRG-RSP, Dkt. No. 22 (E.D. Tex Oct. 21, 2024).

I. PATENT OWNER ADVANCED AN INCORRECT ARGUMENT WHICH IT FAILED TO CORRECT FOR A MONTH

Patent Owner concedes that its *Fintiv* argument based on the status of the Eastern District Case was incorrect when Patent Owner submitted its brief. Given the importance of this representation to a *Fintiv* discretionary analysis (it is the first *Fintiv* factor and impacts many others), Petitioner necessarily called out this misrepresentation. While Patent Owner suggests that all work had already been submitted to paralegals when the Stay Order was entered (Paper 17 at 2), that does not change this inaccurate submission, nor excuse the party/counsel's duty of candor and correction to the Board. *See, e.g.*, 37 CFR §§ 11.303 and 42.11. Indeed, § 11.303 includes an *ongoing* requirement to “correct a false statement of material fact or law previously made to the tribunal by the practitioner” which Patent Owner never did during the month period between Patent Owner's Brief and Petitioner's Response. This failure to correct this important misrepresentation should not be taken lightly.

II. PATENT OWNER'S “SETTLED EXPECTATIONS AND EFFICIENCY” ARGUMENTS MISS THE MARK

Rather than addressing the issue date of the '823 Patent – which is insufficiently short to support “settled expectations” under Petitioner's cited authority in *Cambridge* – Patent Owner now changes its analysis to focus on other patents which are not subject to the IPR and were not asserted in the earlier Eastern District Case. That is not the proper framework for this analysis and recent decisions

counsel against this argument including the *Cambridge* decision which focused on issue dates, not purported priority dates. Patent Owner’s argument is misplaced.

In *Amgen, Inc. v. Bristol-Myers Squibb Co.*, the Director analyzed whether “the patent challenged in [the IPR] has [] been in force for a significant amount of time” based on the issue date of that specific patent. *See* Nos. IPR2025-00601, IPR2025-00602, IPR2025-00603, Paper 9 at 2 (July 24, 2025). There, the Director granted institution of a patent that was three years old because “Patent Owner has not demonstrated that it has developed strong settled expectations that favor discretionary denial for the patent challenged [in the IPR].” *Id.* at 2-3. Neither the priority date nor the familial relationship of other patents factored in this analysis. Aside from the infancy of the subject patent, Patent Owner does not even attempt to suggest that it has spent an “extraordinary amount of investment, time, and resources dedicated to research, development, trials, and regulatory approval [which] correlates to settled expectations” which the Director required in *Amgen. Id.* at 2.

III. PATENT OWNER’S RELIANCE ON *REALTEK* IS DISTINGUISHABLE

Patent Owner’s final argument relies on the recent *Realtek* discretionary denial based on a lack of “exceptional circumstances” and “fairness” which Patent Owner argues favor denial. Setting aside the overall strength of Petitioner’s arguments weighing against discretionary denial—specifically every *Fintiv* factor

favoring institution as well as the recency of the challenged patent—this is clearly an “exceptional” case and “fairness” favors institution unlike in *Realtek* because:

- Petitioner here was unfairly subjected to 11+ months of baseless litigation (taking the vast majority of the one-year statutory window) by Patent Owner’s licensee, which eventually required dismissal based on acknowledged standing issues regarding patent ownership (Paper 16 at 6, citing EX1030 at 3). Fairness clearly favors Petitioner’s understudy joinder in this exceptional instance, which lacked “settled expectations” about fundamental issues including patent ownership;¹
- The Eastern District Case has been stayed pending resolution of both IPRs (Home Depot’s and Petitioner’s) based on Petitioner’s *Sotera* stipulation and thus Petitioner should be given a fair opportunity to participate in an “understudy role”;
- Patent Owner actually requested that the court in the Eastern District Case “consolidate this [Walmart] case with [the Home Depot case] to *alleviate* burden on the Court” but now suggests that IPR consolidation with Home Depot will result in *more* burden (EX1031 at 2);
- Petitioner immediately filed its Petition and joinder motion within four business days of Institution whereas the petitioner in *Realtek* waited a month; and
- Petitioner has not been accused of any “gamesmanship” like the petitioner in *Realtek*, which weighed against the “fairness” issue for the *Realtek* petitioner.

¹ Patent Owner did not provide a timely response to Petitioner’s joinder motion pursuant to 37 C.F.R. § 42.25(a)(1).

Date: August 1, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on August 1, 2025, a copy of the foregoing Petitioner's Sur-Reply to Patent Owner's Reply Brief on Discretionary Denial has been served via electronic mail upon the following, who has agreed to accept service on behalf of Patent Owner:

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