

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,

Petitioner

v.

QPRIVACY USA LLC,

Patent Owner

Case IPR2025-00837

Patent No. 11,106,824

PATENT OWNER'S DISCRETIONARY DENIAL BRIEF

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EX. 2002	Docket Navigator - Time to Trial Statistics for E.D. Tex., accessed on July 11, 2025
EX. 2003	Appeal Statistics, Patent Trial and Appeal Board dated May 31, 2025, accessed at https://www.uspto.gov/sites/default/files/documents/appeal_stats_may2025.pdf on July 2, 2025
EX. 2004	PTAB Trial Statistics, May 2025 IPR, PGR, Patent Trial and Appeal Board, accessed at https://www.uspto.gov/sites/default/files/documents/ptabaia20250531.pdf on July 2, 2025
EX. 2005	PTAB Trial Statistics, May 2024 IPR, PGR, Patent Trial and Appeal Board, accessed at https://www.uspto.gov/sites/default/files/documents/ptab_aia_20240531.pdf on July 2, 2025
EX. 2006	Defendant Cisco Systems, Inc.'s Invalidity and Subject Matter Eligibility Contentions dated March 31, 2025 – Cover Document
EX. 2007	Order of Recusal, <i>QPrivacy USA LLC v. Cisco Systems Inc.</i> , No. 2:24-cv-00855, Dkt. 39 (E.D. Tex. May 15, 2025)
EX. 2008	U.S. Patent No. 11,816,249
EX. 2009	Summons Returned Executed, <i>QPrivacy USA LLC v. Cisco Systems Inc.</i> , No. 2:24-cv-00855, Dkt. 14 (E.D. Tex. Oct. 29, 2024)
EX. 2010	Cisco Systems, Inc. – List of Subsidiaries as of February 12, 2025, accessed at https://www.cisco.com/c/dam/en_us/about/

	doing_business/trust-center/docs/list-of-cisco-global-entities.pdf on July 2, 2025
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EX. 2015	Defendant Cisco Systems, Inc.’s Invalidation and Subject Matter Eligibility Contentions dated March 31, 2025 – Exhibit 6 for Burns
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EX. 2017	U.S. Patent No. 9,077,692
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EX. 2019	Excerpt from prosecution history of U.S. Patent No. 12,013,971 – List of References cited by applicant and considered by examiner filed on March 11, 2024
EX. 2020	U.S. Patent No. 7,797,411
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EX. 2025	<i>Ex Parte</i> Reexamination Historical Statistics, updated March 2025, accessed at https://www.uspto.gov/learning-and-resources/statistics/reexamination-information on July 8, 2025
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I. INTRODUCTION

Pursuant to the March 26 Stewart Memorandum¹, Patent Owner respectfully submits this discretionary denial brief.² As further discussed herein, the Director should discretionarily deny institution for at least two reasons:

First, the Director should deny institution of this IPR based on the *Fintiv*³ factors. The district court will begin trial in the Related Litigation⁴ before the PTAB's

¹ Acting Director Stewart, Memorandum, 'Interim Processes for PTAB Workload Management' dated March 26, 2025 ("March 26 Stewart Memorandum"), <https://www.uspto.gov/sites/default/files/documents/InterimProcesses-PTABWorkloadMgmt-20250326.pdf>.

² The Notice of Filing Date was entered on May 12, 2025. Paper 5. The two-month deadline of July 12, 2025 falls on a Saturday and so this brief is submitted on the following business day, July 14, 2025. 37 C.F.R. § 1.7.

³ *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) ("*Fintiv*").

⁴ *QPrivacy USA LLC v. Cisco Systems Inc.*, No. 2:24-cv-00855 (E.D. Tex.) ("Related Litigation"). The Related Litigation involves the '824 Patent challenged in this IPR and the related '249 Patent challenged in IPR2025-00836. EX. 1001; EX. 2008.

deadline for a final written decision in this IPR. Additionally, there is a significant overlap of issues in both forums and Petitioner's stipulation does not mitigate duplicative efforts. There are also many other circumstances that favor denial, including the petition's extensive reliance on expert testimony, the weakness of the merits, the workload of the PTAB in view of the increasing pendency of *ex parte* appeals, and the fact that the USPTO is already expending resources reviewing the related '249 Patent in reexamination.

Second, the Director should deny institution of this IPR based on the *Advanced Bionics*⁵ framework. The relied-upon disclosures were necessarily considered during prosecution of the '824 Patent and Petitioner fails to show any material error by the USPTO.

II. THE DIRECTOR SHOULD DENY INSTITUTION UNDER *FINTIV*

The following *Fintiv* factors are considered in determining whether to deny institution an IPR:

1. Whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;

⁵ *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”).

2. Proximity of the court's trial date to the PTAB's projected statutory deadline for a final written decision;
3. Investment in the parallel proceeding by the 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 exercise of discretion, including the merits.

Fintiv at 5-6.

As discussed below, the '824 Patent is involved in district court litigation in E.D. Tex. It is unlikely that the district court would stay the Related Litigation pre- or post-institution. Despite significant overlap, this IPR will not simplify issues for the district court and there is a high risk of duplicative efforts. The district court will begin trial in the Related Litigation before the PTAB's deadline for a final written decision in this IPR, which in and of itself favors denial. There are also many other circumstances that favor denial.

A. *Fintiv* factor 1 favors denial: Petitioner has not requested a stay and even so, a stay is unlikely.

Patent Owner submits *Fintiv* factor 1 favors denial. Petitioner has not requested a stay of the Related Litigation and there is no evidence that Judge Schroeder would stay the Related Litigation pre- or post-institution.⁶ Additionally, Patent Owner would oppose any motion to stay the Related Litigation.

A pre-institution stay is unlikely. Judge Schroeder has acknowledged that when a motion to stay is filed pre-institution, courts in E.D. Tex. will typically deny the motion without prejudice. *See, e.g., Sable Networks, Inc., et al. v. Splunk Inc. et al.*, No. 5:21-cv-00040, Dkt. 77 (E.D. Tex. Nov. 21, 2021).

A post-institution stay is also unlikely. According to Docket Navigator, Judge Schroeder has only granted thirteen motions to stay pending *inter partes* review, post grant review, or reexamination; but ten of those thirteen motions were stipulated, unopposed, or joint motions by the parties.⁷ The other two opposed

⁶ On May 15, 2025, Judge Gilstrap recused himself from the Related Litigation, which was then reassigned to Judge Schroeder. EX. 2007.

⁷ *realZoom LLC v. Nike, Inc.*, No. 5:18-cv-00139, Dkt. 36 (E.D. Tex. Jan. 13, 2020) (joint motion); *realZoom LLC v. Staples, Inc.*, No. 5:19-cv-00063, Dkt. 30 (E.D. Tex. Jan. 13, 2020) (joint motion); *Hitachi Maxell, Ltd. v. Huawei Technologies Co., Ltd. et al.*, No. 5:16-cv-00178, Dkt. 411 (E.D. Tex. May 31, 2018) (joint

motions and one opposed-in-part motion were granted based on circumstances not applicable here.⁸

motion); *Realtime Data LLC d/b/a IXO v. Riverbed Technology, Inc., et al.*, No. 6:15-cv-00468, Dkt. (E.D. Tex. Dec. 22, 2017) (joint motion); *General Access Solutions, Ltd. v. Sprint Corporation, et al.*, No. 2:16-cv-00465, Dkt. 39 (E.D. Tex. Apr. 17, 2017) (joint motion pending final written decision(s)); *SynQor, Inc. v. Vicor Corp.*, No. 2:14-cv-00287, Dkt. 282 (E.D. Tex. May 23, 2016) (stipulated); *DSS Technology Management, Inc. v. Intel Corporation et al.*, No. 6:15-cv-00130, Dkt. 232 (E.D. Tex. Mar. 18, 2016) (unopposed); *Oil States Energy Services, LLC f/k/a Stinger Wellhead Protection, Inc. v. Trojan Wellhead Protection, Inc. f/k/a Guardian Wellhead Protection, Inc., et al.*, No. 6:12-cv-00611, Dkt. 198 (E.D. Tex. May 20, 2015) (joint motion); *Oil States Energy Service, LLC f/k/a Stinger Wellhead Protection, Inc. v. JK Red Dirt Rentals, Inc.*, No. 6:14-cv-00796, Dkt. 39 (E.D. Tex. May 20, 2015) (joint motion); *Wingard, et al. v. Pete Mankins Nissan, et al.*, No. 5:14-cv-00149, Dkt. 17 (E.D. Tex. Feb. 20, 2015) (unopposed).

⁸ *Fall Line Patents, LLC v. Zoe's Kitchen, Inc., et al.*, No. 6:18-cv-00407, Dkt. 110 (E.D. Tex. Aug. 9, 2019) (opposed); *Papst Licensing GmbH & Co., KG, v. Apple, Inc.*, No. 6:15-cv-01095, Dkt. 388 (E.D. Tex. Jun. 16, 2017) (opposed); *General*

Regarding the one opposed motion, the plaintiff had asserted different claims of the same patent in previous litigation and Judge Schroeder stayed the current litigation after the PTAB (a) entered a final written decision invalidating all claims that were asserted in the previous litigation and (b) entered an institution decision regarding all claims that were asserted in the current litigation. *Fall Line Patents, LLC v. Zoe's Kitchen, Inc., et al.*, No. 6:18-cv-00407, Dkt. 110 (E.D. Tex. Aug. 9, 2019). Here, the Related Litigation involves two patents that have not been previously asserted and no claims have been invalidated.

Regarding the other opposed motion, various claims of the four asserted patents were challenged in multiple IPRs filed by the defendant, Apple, Inc., and by other parties involved in other litigations⁹; the defendant, Apple, Inc., agreed to be bound by statutory estoppel for all instituted IPRs regardless of which party filed the petition; and all asserted claims against the defendant, Apple, Inc., were

Access Solutions, Ltd. v. Sprint Corporation, et al., No. 2:16-cv-00465, Dkt. 53 (E.D. Tex. Jan. 10, 2020) (opposed-in-part).

⁹ There were at least three IPRs filed against the '399 Patent; five IPRs against the '437 Patent; nine IPRs against the '746 Patent; and ten IPRs against the '144 Patent. *See Papst*, Dkt. 170 (E.D. Tex. Nov. 17, 2016).

subject to instituted IPRs¹⁰. *Papst Licensing GmbH & Co., KG, v. Apple, Inc.*, No. 6:15-cv-01095, Dkt. 388 (E.D. Tex. Jun. 16, 2017). Here, none of the asserted patents in the Related Litigation are subject to multiple, instituted IPRs filed by multiple parties.

Regarding the opposed-in-part motion, a final written decision had been entered for each asserted patent; the parties agreed the case should be stayed as to two patents where the final written decisions invalidated all asserted claims and the parties disputed whether the case should be stayed as to a third patent where the final written decision upheld all asserted claims. *General Access Solutions, Ltd. v. Sprint Corporation, et al.*, No. 2:16-cv-00465, Dkt. 53 (E.D. Tex. Jan. 10, 2020). The court granted the motion to stay as to the two invalidated patents and denied the motion to stay as to the third upheld patent. *Id.* Here, none of the asserted patents in the Related Litigation are subject to final written decisions invalidating the claims and as discussed herein, the trial will occur before the final written decision would even be entered.

¹⁰ There were two instituted IPRs against the '399 Patent; two instituted IPRs against the '437 Patent; four instituted IPRs against the '746 Patent; and five instituted IPRs against the '144 Patent. *See Papst*, Dkt. 351 (E.D. Tex. Apr. 27, 2017).

Overall, Judge Schroeder's history shows that a post-institution stay is also unlikely. As discussed below, this IPR will not simplify issues for the district court and Petitioner did not act diligently in filing the petition in this IPR, which further show that a post-institution of the Related Litigation is unlikely; Petitioner waited approximately six months after the filing of the complaint and three months after the service of infringement contentions to file the petition in this IPR.

B. *Fintiv* factor 2 favors denial: Trial in the Related Litigation will occur before the deadline for a final written decision in this IPR.

Patent Owner submits *Fintiv* factor 2 favors denial. If instituted, a final written decision in this IPR would not be due until November 12, 2026.

But for Judge Gilstrap's recusal, the trial in the Related Litigation would have begun on June 22, 2026. EX. 1009 at 1. Now, with reassignment to Judge Schroeder, the trial in the Related Litigation is set to begin on October 19, 2026. EX. 2001 at 1. As such, it is unlikely that a final written decision would issue before the trial in the Related Litigation, which favors denial. *See, e.g., Full-Metal-Power B.V. v. Infocus Downhole Solutions USA LLC*, IPR2025-00391, Paper 14 (Director June 25, 2025) (denying institution where the trial date was approximately one month before the deadline for a final written decision).

Additionally, according to Docket Navigator, the median time-to-trial for E.D. Tex. is 24 months, which suggests trial will begin in October 2026. EX. 1008;

EX. 2002. These statistics further show that it is unlikely that a final written decision would issue before the trial in the Related Litigation, which favors denial.

Finally, as discussed below, nearly all of the work associated with trial will be completed by September 2026, over two months before the deadline for a final written decision in this IPR, which favors denial. *See, e.g., Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 15 (PTAB May 13, 2020) (informative) (denying institution where the trial date was approximately two months before the deadline for a final written decision).

C. *Fintiv* factor 3 favors denial: Significant resources have been and will continue to be invested in the Related Litigation.

Patent Owner submits *Fintiv* factor 3 favors denial. As explained below, the Related Litigation is ongoing and much of the work associated with trial will be completed by September 2026 in anticipation of trial in October 2026.

Additionally, Judge Schroeder is unlikely to stay the Related Litigation pre- or post-institution. *See supra*, section II.A. Therefore, there is a high risk of duplicative efforts and conflicting decisions which favors denial.

1. *Significant resources will already have been invested before the deadline for an institution decision.*

The parties completed briefing on a motion to dismiss in January 2025. That motion remains pending, but is seemingly moot given that infringement contentions have been served, the contentions will soon be amended to include

source code citations, and there is the possibility for leave to amend the complaint if necessary.

The Court entered a Docket Control Order and a Discovery Order in February 2025. The parties also completed briefing on a dispute regarding the Discovery Order as it relates to source code review, which has since been resolved by the Court.¹¹ Following Judge Gilstrap's recusal, the Court entered an Amended Docket Control Order (EX. 2001) and a Protective Order in May 2025.

The parties exchanged several discovery requests and responses, including 28 interrogatories. Petitioner also served six third-party subpoenas seeking discovery on system prior art.

The parties exchanged their infringement and invalidity contentions, with the current deadline to amend the infringement contentions with source code citations at the end of July 2025.

The parties exchanged initial and additional disclosures, identifying relevant witnesses. The parties have also exchanged their respective lists of the most significant e-mail custodians starting the e-discovery process.

¹¹ The parties disputed whether source code review could begin before a Protective Order was entered by the Court. Patent Owner argued it could not and the Court ultimately agreed.

The parties have now each produced documents and made their source code available for inspection. Most notably, Patent Owner has expended significant resources reviewing Petitioner's source code and addressing deficiencies therein. Patent Owner has spent approximately 17 days reviewing source code, starting on June 2, 2025,¹² and Patent Owner has sent six letters on June 3, 4, 9, 13 and July 2 and 3 regarding deficiencies in Petitioner's source code production. In response, Petitioner started making additional source code available for review and did not oppose a 30-day extension of time to amend infringement contentions by the end of July 2025. Petitioner cannot later argue any prejudice due to delay regarding amended infringement contentions.

In view of the above, the Court and the parties will have significantly invested in the Related Litigation before the deadline for an institution decision.

¹² Within one day of the issuance of the May 23, 2025 Protective Order, Patent Owner promptly served signed Protective Order acknowledgements for each of its two previously disclosed source code review experts and requested review starting on May 28, 2025. As it turns out, Petitioner's source code was not actually available for review until June 2, 2025, and even then, Petitioner's source code production was deficient for the reasons addressed in Patent Owner's deficiency letters.

The Court and the parties will continue to invest in the Related Litigation before the deadline for a final written decision, particularly given that a stay is unlikely.

2. Trial will be completed before the deadline for a final written decision.

The parties will complete claim construction briefing and a claim construction hearing by April 2026. EX. 2001 at 3.

The close of fact discovery is June 2026 and the close of expert discovery is July 2026. EX. 2001 at 3. All dispositive motions and motions to strike are also due in July 2026. EX. 2001 at 2-3. Pretrial disclosures and motions *in limine* are due in August 2026. EX. 2001 at 2.

Nearly all of the work associated with trial will be completed by September 8, 2026, which is over two months before the deadline for a final written decision on November 12, 2026. EX. 2001 at 2. The Joint Pretrial Order, Joint Proposed Jury Instructions, Joint Proposed Verdict Form, Responses to motions *in limine*, and updated pretrial disclosures are all due by September 8, 2026. *Id.* The Pretrial Conference is set for September 15, 2026. EX. 2001 at 1.

In anticipation of trial, Patent Owner's final election of asserted claims is due on October 9, 2026 and Petitioner's final invalidity theories, prior art references/combinations, and final equitable defenses are due by October 12, 2026. EX. 2001 at 1.

Jury selection is set for October 19, 2026. EX. 2001 at 1. As such, trial will be completed before the deadline for a final written decision.

3. *Petitioner was not diligent in filing the petition.*

Petitioner argues that it acted with diligence (Paper 2 at 76) but this argument is belied by the facts. The complaint in the related litigation was filed on October 21, 2024. EX. 1008. The summons was served on October 23, 2024. EX. 2009. Petitioner delayed nearly six months to file the petition in this IPR on April 10, 2025. *See generally* Paper 2. While Patent Owner understands that a petitioner may wish to see which claims are being asserted in district court before filing a petition, here, Patent Owner served its district court infringement contentions on January 7, 2025 and Petitioner delayed over three months to file the petition in this IPR on April 10, 2025. *See generally* Paper 2.

Additionally, Petitioner advocated to delay serving its invalidity contentions almost three months, from March 4, 2025 to May 29, 2025. After a meet and confer, the parties ultimately agreed to delay the infringement contentions to March 31, 2025. It seems that Petitioner is attempting to cause delay in the Related Litigation, including by failing to address the deficiencies in source code production as identified in Patent Owner's deficiency letters.

Moreover, Petitioner did not establish when it conducted a prior art search or became aware of the relied-upon prior art references. Petitioner was seemingly

aware of references relied-upon in this IPR at least by June 2020, which is long before the petition was filed in this IPR in April 2025.¹³

The Burns reference is cited on the face of at least two U.S. patents assigned to Petitioner, U.S. Patent No. 10,505,970 issued Dec. 10, 2019 and U.S. Patent No. 10,686,831 issued June 16, 2020. EX. 2011; EX. 2012. In both instances, the Burns reference was cited by the Examiner and it is untenable that Petitioner would not have reviewed a reference cited by the Examiner. *Id.*

The Yang reference is also cited on the face of at least two U.S. patents assigned to Petitioner, U.S. Patent No. 10,320,823 issued June 11, 2019 and U.S. Patent No. 10,659,324 issued May 19, 2020. EX. 2013; EX. 2014. Again, in both instances, the Yang reference was cited by the Examiner and it is untenable that Petitioner would not have reviewed a reference cited by the Examiner. *Id.* In fact, the Yang reference was cited on over thirty patents assigned to Petitioner, all of which issued before September 2023.¹⁴

¹³ The patents assigned to Petitioner and referenced below are more specifically assigned to Cisco Technology, Inc. which is a subsidiary of Cisco Systems, Inc. EX. 2010 at 7 (number 182).

¹⁴ U.S. Patent No. 9,967,158; U.S. Patent No. 10,033,766; U.S. Patent No. 10,089,099; U.S. Patent No. 10,116,559; U.S. Patent No. 10,142,353; U.S. Patent

As noted by Petitioner's expert, the relied-upon disclosure of Wittenberg regarding a web-based login with a username and password was well-known. EX. 1003 at ¶ 153. Petitioner's expert cites at least four other patents/publications with the same general disclosure. At least one of those patents was cited by Petitioner before April 2010.¹⁵

Overall, Petitioner did not explain the delay in filing its petition, which favors denial. *Fintiv* at 11.

No. 10,171,357; U.S. Patent No. 10,177,977; U.S. Patent No. 10,250,446; U.S. Patent No. 10,289,438; U.S. Patent No. 10,374,904; U.S. Patent No. 10,523,541; U.S. Patent No. 10,523,512; U.S. Patent No. 10,554,501; U.S. Patent No. 10,574,575; U.S. Patent No. 10,594,542; U.S. Patent No. 10,594,560; U.S. Patent No. 10,680,887; U.S. Patent No. 10,708,152; U.S. Patent No. 10,708,183; U.S. Patent No. 10,764,141; U.S. Patent No. 10,798,015; U.S. Patent No. 10,826,803; U.S. Patent No. 10,873,593; U.S. Patent No. 10,873,794; U.S. Patent No. 10,917,438; U.S. Patent No. 10,931,629; U.S. Patent No. 10,972,388; U.S. Patent No. 10,999,149; U.S. Patent No. 11,128,700; U.S. Patent No. 11,233,821; and U.S. Patent No. 11,765,046.

¹⁵ U.S. Pub. No. 2007/0124458 (abandoned April 28, 2010).

D. *Fintiv* factor 4 favors denial: Overlapping issues raise significant concerns of inefficiency and Petitioner’s stipulation does not mitigate these concerns.

Claims 1-20 of the ‘824 Patent are challenged in this IPR and asserted in the Related Litigation. As further discussed below, “the same claims, grounds, arguments, and evidence” are at issue in this IPR and in the Related Litigation which favors denial. *Fintiv* at 12-13.

1. *Petitioner relies on the same IPR references and combinations in its district court invalidity contentions.*

Petitioner identified the Burns, Yang, and Wittenberg references at issue in this IPR in its district court invalidity contentions. EX. 2006 at 8. Petitioner expressly incorporated by reference “the prior art, invalidity grounds, and expert testimony submitted in connection with any related proceedings related to the Asserted Patents, including ... any post grant proceedings (e.g., *inter partes* review) involving the Asserted Patents...” EX. 2006 at 19. Petitioner additionally prepared invalidity charts for Burns (EX. 2015) and Yang (EX. 2016).

At least because the district court is unlikely to stay the Related Litigation, and because the district court will begin trial in the Related Litigation before there would be a final written decision in this IPR, it is most efficient for the district court to evaluate validity of the ‘824 Patent. As such, institution should be denied.

2. Petitioner’s stipulation carves out the ability to rely on its own prior art patents and printed publications in district court.

At first blush, it appears that Petitioner submits a *Sotera*-style stipulation. Paper 2 at 76. However, upon closer review, Petitioner’s stipulation fails to materially reduce overlap in this IPR and in district court. *See* FAQ¹⁶ #14. Petitioner carves out and expressly reserves the right to rely on “Cisco’s own prior art” including patents and publications, as well as system art. Paper 2 at 76.

It seems highly probable that Petitioner will rely on its own alleged prior art patents and printed publications in district court even if this IPR is instituted. Indeed, Petitioner sent a letter to Patent Owner in November 2024 highlighting the importance of Petitioner’s own alleged prior art, which Patent Owner wholly disputes. *See* EX. 2006 at 14. In its district court invalidity contentions, Petitioner identifies over 25 of its own patents and publications and at least 2 systems. EX. 2006 at 9-14. Petitioner also alleges that at least some of its own products, services, or functionalities, invalidate the asserted claims under 35 U.S.C. § 273. EX. 2006 at 12.

To the extent Petitioner later attempts to revise its stipulation, it is too late. *See* FAQ #14 (“A petitioner should file a *Sotera* or *Sand* stipulation as soon as

¹⁶ FAQs for Interim Processes for PTAB Workload Management (“FAQ”), www.uspto.gov/patents/ptab/faqs/interim-processes-workload-management.

practicable, so that a patent owner may address the impact of the stipulation in its discretionary denial brief.”) Petitioner cannot engage in gamesmanship and revise its stipulation after reviewing Patent Owner’s brief.

3. Petitioner relies on system art alone and in combination with the same IPR references in its district court invalidity contentions.

Petitioner’s stipulation expressly reserves the right to rely on system art in district court. Paper 2 at 76. Thus, there is a high risk of duplicative efforts in this IPR and district court even if this IPR is instituted. *See* FAQ #14 (“Where the petitioner is relying on corresponding system art in a co-pending proceeding and/or several other invalidity theories, a stipulation may not be particularly meaningful because the efficiency gained by any AIA proceeding will be limited.”)

Petitioner’s district court invalidity contentions identify at least 28 systems including Cisco SAFE and Cisco NetRanger. EX. 2006 at 9-11. Petitioner also reserves the right to rely on additional systems and/or functionality not yet disclosed. EX. 2006 at 11.

In its district court invalidity contentions, Petitioner expressly identifies Burns alone or in combination with various systems, as well as Yang alone or in combination with various systems. EX. 2006 at 18. In its invalidity claim charts, Petitioner also reserves the right to rely on Burns in combination with any system identified in the invalidity contentions and the same is true for Yang. EX. 2015 at

1; EX. 2016 at 1; *see also* EX. 2006 at 26 (alleging motivations to combine Burns and/or Yang with various systems). Petitioner further reserves the right to rely on additional obviousness combinations not expressly identified. EX. 2006 at 6.

Given the recent Federal Circuit decision regarding IPR estoppel, Petitioner will likely attempt to rely on systems in combination with patents and/or printed publications even if this IPR is instituted. *See Ingenico Inc. v. IOENGINE, LLC*, 136 F.4th 1354, 1367 (Fed. Cir. 2025). Petitioner's stipulation in this IPR does not cure inefficiencies in either forum.

4. It is most efficient for the district court to resolve all validity disputes.

Petitioner's district court invalidity contentions are expansive - Petitioner also challenges written description, enablement, indefiniteness, and eligibility. EX. 2006 at 30-44. The district court will necessarily have to evaluate validity on these issues.

Patent Owner submits that this the Director should deny institution of this IPR and allow the district court to resolve all alleged validity issues. *See* FAQ #14.

E. Fintiv factor 5 favors denial: The parties in the Related Litigation are the same.

The parties in this IPR and in the Related Litigation are the same, which favors denial.

F. *Fintiv* factor 6 favors denial: Other circumstances should influence the Director’s exercise of discretion.

As discussed below, there are other circumstances that favor denial of institution in this IPR, including the petition’s extensive reliance on expert testimony, the weakness of the merits, the increasing pendency of *ex parte* appeals, and the fact that the USPTO is already expending resources reviewing the related ‘249 Patent in reexamination. Patent Owner additionally incorporates by reference the discussion below regarding discretionary denial under *Advanced Bionics* as an additional circumstance that favors denial of institution in this IPR. *See infra*, section III. All of these circumstances, taken individually or together, show that instituting this IPR would not be a good use of the PTAB’s resources.

1. *Extensive reliance on expert testimony favors denial.*

The March 26 Stewart Memorandum states that “[t]he extent of the petition’s reliance on expert testimony” may be relevant to discretionary denial of institution.

As discussed below, Petitioner is using its expert to gap-fill the prior art and provide implicit claim constructions which favors denial. As will be further discussed in the forthcoming merits brief, there are also disputes between experts on dispositive issues which further favors denial. Ultimately, the validity of the ‘824 Patent should be resolved in district court. *See* FAQ # 21 (“...extensive reliance on expert testimony and/or reasonable disputes between experts on

dispositive issues may suggest that the questions are better resolved in an Article III court.”).

a. Gap-filling the prior art favors denial

“The statute and our reviewing court require that petitions be based on prior art patents and printed publications.” FAQ # 21. However, Petitioner is using its expert to gap-fill the prior art to support its obviousness allegations. Below are some specific examples showing Petitioner is using its expert to gap-fill the prior art, which will be further elaborated upon in the forthcoming merits brief.

As one example, Petitioner relies on its expert to allege that the proposed combination of Burns + Yang renders obvious an IDS analyzing traffic “in real time” as required by limitation [17.10]. Paper 2 at 37-40.¹⁷ However, neither Burns nor Yang disclose this limitation and Petitioner is relying on its expert to gap-fill the prior art.

First, Petitioner cites and quotes Yang, but this cited quote refers to a different configuration for a line-rate buffering approach that is not relied upon in

¹⁷ Petitioner refers back to its analysis of limitation [17.10] for limitations [1.5] and [9.5]. Paper 2 at 53-54, 67-68.

Petitioner's analysis of claim 1. *See* Paper 2 at 39.¹⁸ In context, the full quote from Yang reads:

“Once configured, IDS 20 monitors network traffic 24 (72). In some configurations, stateful inspection engine 28 of forwarding plane 22 may receive network traffic and mirror the network traffic for purposes of analysis. Forwarding component 31 seamlessly forwards the original network traffic. In other embodiments, traffic is not mirrored, rather a line-rate buffering approach is used to analyze the traffic in real-time prior to forwarding.”

EX. 1006 at 11:63-12:3. Thus, Yang distinguishes a mirrored approach and a line-rate buffering approach, while Burns refers to the mirrored approach. *See, e.g., id.;*

EX. 1005 at 10:18-22 (“...stateful inspection engine 28 of forwarding plane 22 may receive network traffic and mirror the network traffic for purposes of analysis...”) and 11:63-67 (same). As will be further discussed in the forthcoming merits brief, Burns' IDS performs its analysis on mirrored (e.g., reconstructed, reassembled, copied data). *See, e.g.,* EX. 1005 at 7:65-8:02 (discussing reassembly module 50) and 8:11-34 (same). Therefore, the quote from Yang does not show that the proposed combination of Burns + Yang renders obvious limitation [1.4] as alleged.

¹⁸ Petitioner cites to its expert declaration at ¶ 120, but Petitioner's expert does not discuss the cited quote of Yang. Paper 2 at 39; EX. 1003 at ¶¶ 118-121 (discussing limitation [17.10]).

Acknowledging this weakness in Burns + Yang, Petitioner’s expert offers several alternative theories for limitation [17.10]. Petitioner’s expert goes on to opine that monitoring traffic “transparently” means “in real time” but this opinion has no support and contradicts a term of art. *See* Paper 2 at 38-39; EX. 1003 at ¶ 119. In computer networking, “transparently” means invisibly or unknowingly – it does not mean in real time.¹⁹ Petitioner’s expert also opines that an IDS’ forwarding plane operates “in real time” but again, this opinion has no support. *See* Paper 2 at 39-40; EX. 1003 at ¶ 120. Petitioner’s expert further opines that most IDS run “in real time” but the expert fails to distinguish network-based IDS and host-based IDS and how they relate to Burns’ IDS or Burns’ number of passive sensors. *See* Paper 2 at 40; EX. 1003 at ¶ 121 (citing EX. 1036 at 38).²⁰

¹⁹ Whether the “remote server” operates in real time highlights a significant difference between the prior art and the ‘824 Patent as will be further discussed in the forthcoming merits brief. The ‘824 Patent protects private user data from being collected by, e.g., Facebook, while the user is browsing the website. *See, e.g.*, EX. 1001 at 1:40-59. The claimed invention of the ‘824 Patent operates in real time by allowing the user to continue browsing the website.

²⁰ It is also noted that EX. 1036 does not discuss encrypted communications.

As another example, Petitioner relies on its expert to allege that Burns' disclosure meets the "modifying" and "sharing" steps of claim 1.²¹ See Paper 2 at 44-46, 55; EX. 1003 at ¶¶ 108, 115. However, Burns does not disclose these limitations of claim 1 and Petitioner is relying on its expert to gap-fill the prior art.

Petitioner relies on its expert to allege that "it would have been obvious for Burns' IDS to analyze and modify packets containing a webpage form (such as a login webpage)" and "it would have been obvious for Burns' IDS to modify such packets to the extent that they are disallowed by the administrative user." Paper 2 at 55. **Petitioner does not explain how Burns alone or in combination renders obvious "sharing" the modified packets.** *Id.* Petitioner only cites to its expert declaration at ¶¶ 191-194.²²

Petitioner's expert alleges that Burns' disclosure of "dropping packets" and "logging information" meets the "modifying" and "sharing" steps of claim 1. However, Burns discloses dropping **all** packets associated with a communication session if a security risk is detected. See, e.g., EX. 1005 at 7:45-50. If Burns were

²¹ Petitioner relies on its analysis of independent claim 1 for independent claim 9. Paper 2 at 67-68.

²² Petitioner engaged in improper incorporation by reference for at least limitation [1.9]. See Paper 2 at 55.

to drop all packets in limitation [1.8], then there is no sharing of the modified packets as required by limitation [1.9].²³ For at least this reason, Burns does not disclose the limitations of claim 1 as alleged. Petitioner is relying on its expert to gap-fill the prior art.

Furthermore, “logging” information about the communication session does not correspond to “sharing” the modified packets as claimed. Burns discloses that “logging” means “security management module 44 records the source port, destination port, source IP address, destination IP address, time of discovery, packet size, a copy of the packet, other actions taken in response to the detection, or any other information that administrator 42 may find useful.” EX. 1005 at 20:60-65. Logging this information does not satisfy sharing the modified packets

²³ Burns and the ‘824 Patent are directed at different problems in networking as will be further discussed in the forthcoming merits brief. Burns’ goal is to protect nodes on the private network from security risks. As such, if there is a detected security risk, Burns will drop all packets and/or close the session altogether. *See, e.g.*, EX. 1005 at 7:45-50. In contrast to Burns, the ‘824 Patent’s goal is to protect private user data while keeping the session open. The ‘824 Patent makes clear that the communication may comprise, e.g., 10 packets, and only one of those 10 packets may be modified to prevent the collection of private user data.

as claimed. Neither Petitioner nor its expert even identify the “modified data packets” that are allegedly shared.

For at least these reasons, Petitioner is using its expert to gap-fill the prior art and institution should be denied. *See* FAQ # 21.

b. Implicit claim constructions violate the statutory requirements for IPR petitions and favor denial

In this IPR, Petitioner is relying on its expert’s implicit claim constructions to support its obviousness allegations. Despite Petitioner alleging indefiniteness of at least 11 terms/phrases in the ‘824 Patent in its district court invalidity contentions (EX. 2006 at 41,) Petitioner relies on its expert to opine on the scope of the claims in this IPR. However, neither Petitioner nor its expert identified any claim terms/phrases for construction in this IPR. Paper 2 at 12; EX. 1003 at ¶ 53.

Petitioner’s expert is implicitly construing claims without expressly opining on the correct construction in the context of the ‘824 Patent with supporting evidence. Implicit claim constructions violate 37 C.F.R. § 42.104(b)(3) which requires a petitioner to “[p]rovide a statement of the precise relief requested for each claim challenged,” which must include “[h]ow the challenged claim is to be construed.” The purpose behind this statutory requirement is particularly important if the validity of the ‘824 Patent is to be evaluated in multiple forums. Petitioner’s

inconsistent positions regarding claim construction will likely to lead to inefficiencies and potentially conflicting results.

Below are exemplary terms/phrases identified in Petitioner’s invalidity contentions and corresponding testimony from Petitioner’s expert in this IPR.

For the claimed step of “determining, by the remote server, at least one communication data type...,” Petitioner’s expert opines that “Burns’s IDS (*remote server*) identifies an application or protocol (*data type*) based on mapping port numbers from TCP packet headers (*characteristics*).” EX. 1003 at ¶ 176 (italics original). Thus, Petitioner’s expert implicitly construes the claimed “data type” as an application or protocol and the claimed “characteristics” as a port number. *Id.* Petitioner’s expert does not opine on the correct construction in the context of the ‘824 Patent with supporting evidence.²⁴

For the claimed “privacy preference,” Petitioner’s expert opines that (a) “Burns allows a system administrator to ‘configure IDS 10 to explicitly allow all identifiable applications, allow all applications except for a specified list of identifiable applications, or prevent all communications’” (EX. 1003 at ¶ 180 (citing Burns, 5:30-34)); and (b) “[a] POSITA would have appreciated that,

²⁴ The ‘824 Patent shows exemplary data types (content) in FIG. 3C including audio, location (country), contact name, password. EX. 1001 at FIG. 3C.

because the configuration information allows administrator to tailor the IDS to their preferences, the configuration information specified by the administrator corresponds to a ‘*preference list.*’” (EX. 1003 at ¶ 181) (italics original). Thus, Petitioner’s expert implicitly construes the claimed “privacy preference” as configuration information. *Id.* Petitioner’s expert does not opine on the correct construction in the context of the ‘824 Patent with supporting evidence.

For at least these reasons, Petitioner fails to meet its burden under § 42.104(b)(3) which favors denial of institution. Petitioner is relying on its expert’s implicit claim constructions in this IPR instead of proposing express constructions and providing supporting evidence. At the same time, Petitioner is alleging indefiniteness in district court. It is more efficient to evaluate the claim construction and validity issues of the ‘824 Patent in district court. As such, institution should be denied.

c. Disputes between experts favor denial

The forthcoming merits brief with supporting testimony from Patent Owner’s own expert will show there are disputes on dispositive issues which favors denial. *See* FAQ # 21 (“...extensive reliance on expert testimony and/or reasonable disputes between experts on dispositive issues may suggest that the questions are better resolved in an Article III court.”).

As previously mentioned, Petitioner is using its expert to gap-fill the prior art. As will be shown, the experts dispute whether the proposed combination of Burns + Yang operates “in real time” or satisfies the “modifying” and “sharing” steps of claim 1.

Additionally, as will be further discussed in the forthcoming merits brief, a person ordinarily skilled in the art in 2017 would not have been motivated to incorporate Yang’s static port mapping technique at least because Yang itself teaches away from doing so. Yang warns that “many hackers or other malicious individuals utilize software application that employ dynamic or randomized port assignments rather than conform to the static port assignments in order to evade detection and containment” and that “[s]uch techniques render it difficult for IDSs to correctly identify the type of application and protocol.” EX. 1006 at 1:36-42.

Moreover, by 2017, the use of port 443 for encrypted communications had become common. Therefore, Yang’s static port mapping technique would not have been useful for identifying the application or protocol as alleged.

2. The weakness of the merits favors denial.

The March 26 Stewart Memorandum states that “[t]he strength of the patentability challenge” may be relevant to discretionary denial of institution.

In the forthcoming merits brief, Patent Owner will further detail the weakness of the merits of the petition, which favors denial. *See* FAQ # 8 (“When

parties present arguments regarding the strength of the merits, the Director will consult with USPTO personnel with relevant technical expertise.”); FAQ # 11 (“The ‘merits’ considerations refer to whether there is a reasonable likelihood that a petitioner would prevail with respect to at least one of the claims challenged in an IPR petition...”).

Patent Owner respectfully requests the Director to consider the forthcoming merits brief regarding the weakness of the merits of the petition. *See* FAQ # 12 (“[T]he Director will consider the merits in the merits briefing if the parties ask the Director to do so.”). Any belated attempt by Petitioner to bolster the merits of the petition should be disregarded.

3. The increasing pendency of ex parte appeals favors denial.

The March 26 Stewart Memorandum states that “the ability of the PTAB to comply with pendency goals for *ex parte* appeals” may be relevant to discretionary denial of institution.

Chief Judge Boalick has explained that “our goal is to decide *ex parte* appeals within 12 months of the time the Board docketed the appeal with limited

exceptions.” May 7 USPTO Hour at 42:13-42:25.²⁵ However, the most recent publication of May 2025 PTAB Appeal Statistics shows that there is an inventory of 4,392 pending appeals (EX. 2003 at 4) and that the overall pendency of decided appeals is 13.5 months (EX. 2003 at 7). In fact, the overall pendency of decided appeals **increased** from 12.1 months in 2024 to 13.5 months in 2025. EX. 2003 at 7.²⁶

Patent Owner also notes that there were 979 petitions filed thus far in FY2025 compared to only 825 petitions during the same time period in FY2024. EX. 2004 at 3; EX. 2005 at 3. The PTAB Trial Statistics also show that institution rates have stayed approximately the same – 63% in 2025 and 66% in 2024. EX. 2004 at 6; EX. 2005 at 6.

Patent Owner submits that instituting this IPR is not a good use of the PTAB’s limited resources, which would be better spent reducing pendency for *ex parte* appeals. *See generally* March 26 Stewart Memorandum. As such, the

²⁵ Webinar, ‘USPTO Hour: Patent Trial and Appeal Board basics and priorities’ on May 7, 2025 (“May 7 USPTO Hour”), <https://rev-vbrick.uspto.gov/#/videos/f51a6f65-6fea-4a3a-bd52-25d52dbc9b34> .

²⁶ The pendency of decided appeals is increasing in most technology centers in 2025. EX. 2003 at 7.

Director should deny institution in this IPR. This is particularly true given that the trial in the Related Litigation is scheduled to begin trial before the PTAB's deadline for a final written decision in this IPR.

4. *The USPTO is already expending resources reviewing the related '249 patent which favors denial.*

On April 1, 2025, Unified Patents, LLC filed a request for *ex parte* reexamination of claims 1-30 of the '249 Patent in Control No. 90/019,896. On July 1, 2025, the Central Reexamination Unit ("CRU") ordered reexamination.

Because the CRU is already expending resources reviewing the related '249 Patent, the PTAB should not expend additional resources conducting IPR of either the '249 Patent in IPR2025-00836 or the '824 Patent in this IPR. There is a high risk of duplicative efforts and inconsistent decisions among the different forums which favors denial.

Below, Patent Owner addresses additional reasons that institution of this IPR should be denied to conserve PTAB resources.

a. Petitioner must explain its awareness of and/or involvement in the co-pending reexamination.

Unified Patents, LLC filed the reexamination request before the petition was filed in this IPR. Petitioner must explain when it became aware of the reexamination request, whether it was involved in preparing the reexamination request, when it became aware of which art was being used in the reexamination,

and whether the art used in the reexamination affected its choice of relied-upon art in this IPR. Patent Owner reserves all rights to seek supplemental briefing on this issue.

It goes against the principles of fairness if Petitioner is essentially hiding behind Unified Patents, LLC and getting three bites at the invalidity apple – one in reexamination, one in IPR, and one in district court. Because evaluating overlapping validity issues in multiple forums is inefficient, institution of this IPR should be denied.

b. Despite awareness of the co-pending reexamination at the time of filing the petition, Petitioner did not provide any stipulation regarding the reexamination references and combinations which creates inefficiencies.

Despite Petitioner’s awareness of the reexamination at least as of the filing date of the petition in this IPR on April 10, 2025 (Paper 2 at 84,) Petitioner did not stipulate, for example, if reexamination is ordered, then Petitioner would not pursue invalidity based on patents or printed publications as prior art in the Related Litigation. Because reexamination was ordered, there is a high risk of duplicative efforts and inconsistent decisions in multiple forums. *See also supra*, section II.D.

In its district court invalidity contentions, Petitioner expressly incorporated by reference “the prior art, invalidity grounds, and expert testimony submitted in connection with any related proceedings related to the Asserted Patents, including

any future *ex parte* reexamination proceedings...” EX. 2006 at 19. Thus, there is a high likelihood of duplicative efforts at least between the CRU and the district court. The policies supporting broad stipulations in IPR equally apply to broad stipulations in reexamination proceedings. Petitioner could have filed a stipulation regarding the co-pending reexamination, but Petitioner chose not to.

Moreover, the primary reference in the reexamination is assigned to Cisco Technology, Inc.²⁷ Therefore, even if this IPR were instituted, Petitioner’s stipulation in this IPR carved out and reserved the right to rely on the same primary reference from the reexamination in the Related Litigation. Paper 2 at 76.

Furthermore, even though Petitioner did not file the reexamination request itself, Petitioner benefits from the reexamination, prejudicing Patent Owner. Petitioner can use Patent Owner’s responses to prior art challenges in the reexamination as a road map to shape its invalidity challenges. Petitioner could attempt filing another reexamination against the related ‘249 Patent or the ‘824 Patent to try to cure deficiencies in the prior art patents and publications. Petitioner could also attempt to use the reexamination references in combination with system art in district court.

²⁷ U.S. Pub. No. 2015/0113588.

c. It is not a good use of resources to conduct this IPR when the reexamination is likely to conclude much sooner.

Conducting two separate USPTO proceedings on overlapping validity issues is not a good use of resources. Based on the most recent March 2025 operational statistics for reexamination, the average number of months from filing to Notice of Intent to Issue a Reexamination Certificate (“NIRC”) is 14.99 months. EX. 2025 at 2. This data suggests a NIRC will be entered by July 2026, which is before the deadline for a final written decision in this IPR in November 2026. It does not make sense for the PTAB to conduct IPR of the ‘824 Patent when the reexamination will likely be completed before the deadline for a final written decision in this IPR. It is most efficient to allow the CRU to conduct reexamination of the related ‘249 Patent and conserve the PTAB’s resources for other workload needs, including, e.g., *ex parte* appeals. *See supra*, section II.F.3.

d. Staying the reexamination would not resolve the inefficiencies.

Assuming *arguendo* that the PTAB were to institute the related IPR and stay the reexamination of the ‘249 Patent, there would still be inefficiencies at least because the district court is unlikely to stay the Related Litigation and institution will not simplify issues for the district court. *See supra*, section II.A (stay) and section II.D (overlap). It is not efficient to evaluate the validity of the related

patents in multiple forums, especially if there are overlapping validity issues and overlapping references/combinations.

Additionally, when the claims of the related '249 Patent are ultimately upheld, the USPTO must still expend resources to re-open and conduct the reexamination. If Patent Owner and the CRU were to reach an impasse, then the PTAB would again have to be involved to evaluate the related '249 Patent on appeal. This would not be an efficient process for the USPTO as a whole.

III. THE DIRECTOR SHOULD DENY INSTITUTION UNDER *ADVANCED BIONICS*

Denial of institution is appropriate if (1) the same or substantially the same prior art or argument was previously presented to the USPTO and (2) the petitioner fails to demonstrate that the USPTO erred in a manner material to the patentability of the challenged claims. *See Advanced Bionics* at 8.

As discussed below, the relied-upon disclosures in this IPR were necessarily considered during prosecution of the '824 Patent. Additionally, the disclosure of Burns was expressly presented to the USPTO. Neither Yang's disclosure of static port mapping nor Wittenberg's disclosure of a web-based login with username and password would impact the Examiner's analysis of the prior art as a whole. Petitioner fails to show any material error by the USPTO and as such, denial of institution is appropriate.

A. The same or substantially the same prior art or argument was previously presented to the USPTO.

1. The Burns Reference

The disclosure of the Burns reference relied-upon in this IPR was presented to the USPTO and considered by the Examiner during prosecution of a related patent.

U.S. Patent No. 9,077,692 (“Burns’ Child Patent”) is a child of Burns and issued from a continuation application, thus sharing the same disclosure as Burns. EX. 2017 at code (63); EX. 1005.

U.S. Patent No. 12,013,971 (“’824 Child Patent”) is child to the ‘824 Patent and parent to the related ‘249 patent. EX. 2018 at codes (21) and (63); EX. 2008 at code (63).

The Burns’ Child Patent was submitted on an Information Disclosure Statement and considered by the Examiner during prosecution of the ‘824 Child Patent. EX. 2019. As shown below, the ‘824 Child Patent cites the Burns’ Child Patent. EX. 2018 at code (56). The claims of the ‘824 Child Patent were allowed over the Burns’ Child Patent.

Wolfowitz, On a Test Whether Two Samples are from the Same Population, 11 Ann. Math. Statist. 147 (1940).

Also, during prosecution of Burns, the Examiner cited Stenfelt and explained that the use of statistical tests (*e.g.*, runs test) to determine a degree of randomness of the data for an encrypted packet was known. *See, e.g.*, EX. 2022 at 6. Stenfelt claims priority to a PCT application filed in 2008. EX. 2023 at code (22).

The priority application of the ‘824 Patent was filed in 2017, almost eighty years after Wald-Wolfowitz and almost ten years after Stenfelt. EX. 1001 at code (30). The conventional techniques regarding the use of statistical tests to determine a degree of randomness were certainly known and considered during prosecution of the ‘824 Patent. Still, the claims of the ‘824 Patent were allowed. There was no error by the USPTO in allowing the claims.

2. The Yang Reference

Yang’s relied-upon techniques for identifying applications and protocols were not previously considered by the USPTO. Petitioner specifically relies on Yang’s techniques regarding “static port mapping.” Paper 2 at 21. Patent Owner submits that static port mapping was well-known before the priority date of the ‘824 Patent and necessarily considered by the Examiner during prosecution of the ‘824 Patent.

Yang was filed in 2007. EX. 1006 at code (22). Yang admits that, as of 2007, conventional systems “associate[d] applications with a static port assignment and used these static port assignments to determine the type of application and protocol associated with a given data stream.” EX. 1006 at 1:33-36. Yang also admits that static port mapping was “well known” as of 2007. EX. 1006 at 9:64-65 (“...application identification module 51 may use the **well-known** static port binding as a default application selection...” (emphasis added)).

Additionally, RFC 1700 published in 1994 and lists port numbers used for many applications to support static port mapping. EX. 1033.

The priority application of the ‘824 Patent was filed in 2017, over twenty years after RFC 1700 and ten years after Yang. EX. 1001 at code (30). The conventional techniques regarding static port mapping were certainly well-known and considered during prosecution of the ‘824 Patent. Still, the claims of the ‘824 Patent were allowed. There was no error by the USPTO in allowing the claims.

3. The Wittenberg Reference

Petitioner relies on Wittenberg for describing a web-based login with a username and password. Paper 2 at 48. As noted by Petitioner’s expert, the relied-upon disclosure of Wittenberg regarding a web-based login with a username and password was well-known. EX. 1003 at ¶ 153. Petitioner’s expert cites at least four other patents/publications with the same general disclosure.

The conventional techniques regarding the use of a web-based login with a username and password was certainly known and considered during prosecution of the '824 Patent. Still, the claims of the '824 Patent were allowed. There was no error by the USPTO in allowing the claims.

B. Petitioner fails to demonstrate that the USPTO erred in a manner material to the patentability of the challenged claims.

The USPTO did not err in a manner material to patentability and Petitioner fails to show otherwise. As such, Patent Owner submits that institution should be denied.

To the extent the Petitioner later attempts to show material error by the Examiner, Patent Owner reserves all rights to seek supplemental briefing on this issue.

IV. CONCLUSION

For at least the reasons discussed herein, Patent Owner respectfully requests the Director deny institution of this IPR.

Respectfully submitted,

Date: July 14, 2025

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CERTIFICATE OF COMPLIANCE

Consistent with 37 C.F.R. § 42.24, this paper consists of no more than 14,000 words. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies this paper and all exhibits thereto were served on the undersigned date via email, as authorized by Petitioner, at the following email addresses:

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