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Table with columns: APPLICATION NO., FILING DATE, FIRST NAMED INVENTOR, ATTORNEY DOCKET NO., CONFIRMATION NO., EXAMINER, ART UNIT, PAPER NUMBER, MAIL DATE, DELIVERY MODE. Includes application details for Cherian LLP and examiner Adam L. Basehoar.

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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Unified Patents, LLC
4445 Willard Ave.
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Chevy Chase MD 20815

***EX PARTE* REEXAMINATION COMMUNICATION TRANSMITTAL FORM**

REEXAMINATION CONTROL NO. 90/019,896 .

PATENT UNDER REEXAMINATION 11816249 .

ART UNIT 3992 .

Enclosed is a copy of the latest communication from the United States Patent and Trademark Office in the above identified *ex parte* reexamination proceeding (37 CFR 1.550(f)).

Where this copy is supplied after the reply by requester, 37 CFR 1.535, or the time for filing a reply has passed, no submission on behalf of the *ex parte* reexamination requester will be acknowledged or considered (37 CFR 1.550(g)).

Order Granting Request For Ex Parte Reexamination	Control No. 90/019,896	Patent Under Reexamination 11816249	
	Examiner Adam L Basehoar	Art Unit 3992	AIA (FITF) Status Yes

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

The request for *ex parte* reexamination filed 04/01/2025 has been considered and a determination has been made. An identification of the claims, the references relied upon, and the rationale supporting the determination are attached.

Attachments: a) PTO-892, b) PTO/SB/08, c) Other: _____

1. The request for *ex parte* reexamination is GRANTED.

RESPONSE TIMES ARE SET AS FOLLOWS:

For Patent Owner's Statement (Optional): **TWO MONTHS** from the mailing date of this communication (37 CFR 1.530 (b)). **EXTENSIONS OF TIME ARE GOVERNED BY 37 CFR 1.550(c).**

For Requester's Reply (optional): **TWO MONTHS** from the **date of service** of any timely filed Patent Owner's Statement (37 CFR 1.535). **NO EXTENSION OF THIS TIME PERIOD IS PERMITTED.** If Patent Owner does not file a timely statement under 37 CFR 1.530(b), then no reply by requester is permitted.

/ADAM L BASEHOAR/
Primary Examiner, Art Unit 3992

cc:Requester (if third party requester)

DECISION

1. A substantial new question of patentability affecting claims 1-30 of United States Patent Number 11,816,249 B2 (hereafter “Koren ‘249”) is raised by the Request (hereafter the “Request”) for *Ex Parte* reexamination filed 04/01/2025.

The Request was filed by Third Party Requester (3PR), Unified Patents, LLC.

Information Disclosure Statement

2. Regarding Information Disclosure Statement (IDS) submissions, MPEP 2256 recites the following: “Where patents, publications, and other such documents are submitted by a party (patent owner or requester) in compliance with the requirements of the rules, the requisite degree of consideration to be given to such information will be normally limited by the degree to which the party filing the information citation has explained the content and relevance of the document. The initials of the examiner placed adjacent to the citations on the form PTO/SB/08 or its equivalent, without an indication to the contrary in the record, do not signify that the document has been considered by the examiner any further than to the extent noted above.”

Accordingly, the IDS submission filed by Third Party Requester (3PR) on 04/01/2025 has been considered by the Examiner only with the scope required by MPEP 2256, unless otherwise noted.

References Cited in the Request

3. A total of two references in specific combinations have been asserted in the Request as providing teachings relevant to claims 1-30 of the Koren ‘249 patent. The proposed references which make up the combinations are as follows:

- **Wing** – (U.S. Patent Application Publication No. 2015/0113588, filed on 10/22/2013 and published on 04/23/2015)
- **Mahaffey** – (U.S. Patent Application Publication No. 2015/0188949, filed on 12/30/2014 and published on 07/02/2015)

4. The Wing and Mahaffey references were not of record during the original prosecution history (i.e., application no. 18/095,238) of the Koren '249 patent, and therefore were not previously cited/considered by the original examiner or applied to any of the claims during the original prosecution history of the Koren '249 patent.

Additionally, the Wing and Mahaffey references were not cited in the petition for *Inter Partes* Review (IPR2025-00836) filed on 04/10/2025.

Affidavits, Declarations, or Other Written Evidence

5. The Examiner recognizes that a declaration by Darrell D. E. Long, Ph.D. (executed on 03/30/2025 - hereafter the "Long Dec.") has been referenced in support of Third Party Requester. The declaration has been considered and made of record.

The Examiner further notes that affidavits or declarations or other written evidence which explain the contents or pertinent dates of prior art patents or printed publications in more detail may be considered in reexamination (see: MPEP 2258(I)(E)), but any rejection must be based upon the prior art patents or printed publications as explained by the affidavits or declarations or other written evidence. The rejection in such circumstances cannot be based on the affidavits or declarations or other written evidence as such, but must be based on the prior art patents or

printed publications. In the instant case, the submitted Long Dec. at least further explains the contents of the Wing and Mahaffey references in more detail.

Identification of Every Claim for Which Reexamination is Requested

6. The two references cited above are discussed in the Request regarding claims 1-30 of the Koren '249 patent. Pages 1-9 of the Request discuss and detail out proposed substantial new questions of patentability in light of the specific combinations of said two references.

Prosecution History

7. The Koren '249 patent was originally assigned serial number 18/095,238 and was filed on 01/10/2023 with 30 claims. The Examiner generally agrees with the Request's characterization of the original prosecution history of the Koren '249 patent (see: Request, pp. 3-4).

More specifically, the examiner during the original prosecution history of the Koren '249 patent mailed a Non-Final Action on 05/17/2023 indicating that claims 1-30 would be allowable when the applied non-statutory double patenting rejection was overcome. The Non-Final Action including at least the following excerpt (regarding independent claims 1, 12, and 19) from the statement of reasons for the indication of allowable subject matter:

However, Gunter et al. and Ahmed et al. either alone or in combination fail to teach or suggest A method/system dynamic management of encrypted data during communication between a remote server and a user's device, that determines a content of an encrypted data packet of the communication in accordance with characteristics of the at least one data packet, and wherein the content of the at least one data packet is not decrypted, and the determination of the content is performed by the remote server in real time during a communication session between the remote server and the user's device with these and other claim elements as a whole.

Therefore, in light of the original prosecution history of the Koren '249 patent, at least the following features are considered important to the patentability of representative independent claim 1:

“determining, by the remote server, a content of at least one data packet of the communication in accordance with characteristics of the at least one data packet, and wherein the content of the at least one data packet is not decrypted by the remote server,
and the determination of the content is performed by the remote server in real time during a communication session between the remote server and the user's device” (emphasis added).

8. On 04/10/2025 a petition for *Inter Partes* Review (IPR2025-00836) was filed that specifically concerned, as shown directly below, claims 1-30 of the Koren '249 patent.

A. Challenged Claims

Petitioner challenges claims 1-30, which are all claims of the '249 patent. A finding that the Challenged Claims are unpatentable in this proceeding will resolve the parties' dispute in the co-pending litigation and obviate any need for a trial regarding the '249 patent.

XII. Statutory grounds

Grounds	Claims	Basis
#1	1-30	35 U.S.C. § 103 over Burns and Yang
#2	4, 7, 13, 15, 22, 24, 30	35 U.S.C. § 103 over Burns, Yang, and Guruswamy

The Examiner notes that the IPR2025-00836 proceeding is currently pending and at an early stage. That is to say, the Patent Trial and Appeal Board (PTAB) has yet to decide whether or not to institute a trial in the proceeding.

IPR2025-00836 was filed by Petitioner, Cisco Systems, Inc.

Substantial New Question of Patentability

9. The presence or absence of “a substantial new question of patentability” determines whether or not reexamination is ordered. For a substantial new question of patentability to be present, it is only necessary that: (A) the prior art patents and/or printed publications raise a substantial question of patentability regarding at least one claim, i.e., the teaching of the (prior art) patents and printed publications is such that a reasonable examiner would consider the teaching to be important in deciding whether or not the claim is patentable; and (B) the same question of patentability as to the claim has not been decided by the Office in an earlier concluded examination or review of the patent, raised to or by the Office in a pending

reexamination or supplemental examination of the patent, or decided in a final holding of invalidity (after all appeals) by a federal court in a decision on the merits involving the claim. If a reexamination proceeding was terminated/vacated without resolving the substantial question of patentability question, it can be re-presented in a new reexamination request. It is not necessary that a “prima facie” case of unpatentability exist as to the claim in order for a substantial new question of patentability to be present as to the claim. Thus, a substantial new question of patentability as to a patent claim could be present even if the examiner would not necessarily reject the claim as either fully anticipated by, or obvious in view of, the prior art patents or printed publications (see: MPEP 2242(I)).

In a decision to order reexamination made on or after November 2, 2002, reliance on old art does not necessarily preclude the existence of a substantial new question of patentability that is based exclusively on that old art. See Public Law 107-273, 116 Stat. 1758, 1899-1906 (2002), which expanded the scope of what qualifies for a substantial new question of patentability upon which a reexamination may be based. Determinations on whether a substantial new question of patentability exists in such an instance shall be based upon a fact-specific inquiry done on a case-by-case basis. For example, a substantial new question of patentability may be based solely on old art where the old art is being presented/viewed in a new light, or in a different way, as compared with its use in the earlier examination(s), in view of a material new argument or interpretation presented in the request. Such material new argument or interpretation may be based solely on claim scope of the patent being reexamined (see: MPEP 2242(II)(A)).

10. For purposes of determination, independent claim 1 is used as a representative claim for the proposed rejections in the Request. The Examiner notes that independent claims 12 and 19

each contain substantially similar features as those disclosed in independent claim 1. The italicized/bolded section of claim 1, shown directly below, is utilized by the Examiner to show how specific teachings of the proposed references create a substantial new question of patentability in light of the original prosecution history discussed above.

Claim 1:

A method of dynamic management of encrypted data during communication between a remote server and a user's device, the method comprising:

receiving, by the remote server, a communication comprising encrypted data packets;

determining, by the remote server, a content of at least one data packet of the communication in accordance with characteristics of the at least one data packet, and wherein the content of the at least one data packet is not decrypted by the remote server, and the determination of the content is performed by the remote server in real time during a communication session between the remote server and the user's device;

storing, by the remote server, a preference list;

determining, by the remote server, based on a comparison of the determined content, whether to modify the at least one data packet, and if so, modifying the at least one data packet;

and

sharing, by the remote server, the modified communication.

Discussion of References that Raise a SNO

11. All of the proposed references raise a substantial new question as noted below.

Wing alone and/or Wing in view of Mahaffey

First, the relevant teachings of Wing have been appropriately summarized in the instant Request (see: Request, pp. 6-8). In general, the Wing reference discloses using a firewall to validate traffic of a media session against a preestablished intent (policy) for a media stream (e.g., see: Wing – Abstract; Figs. 1 and 3).

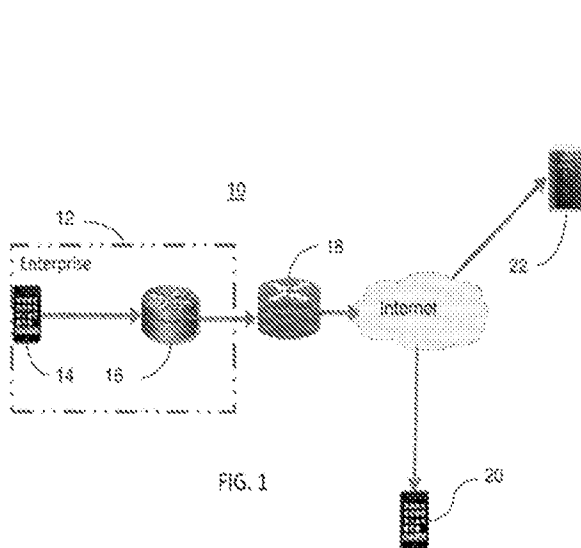


FIG. 1

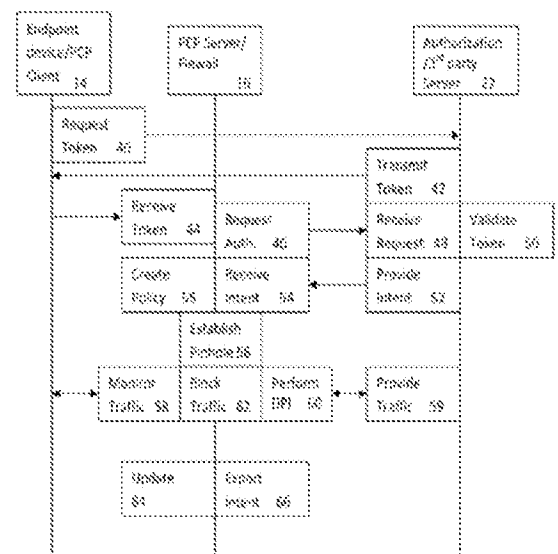


FIG. 3

Wing is cited in the Request as a reference used to at least read on independent claim 1. As shown in the Request (e.g., see: Request, pp. 6-8 and 12-14) and discussed above, Wing alone appears to at least teach or suggest:

(Claim 1)

“determining, by the remote server, a content of at least one data packet of the communication in accordance with characteristics of the at least one data packet, and wherein the content of the at least one data packet is not decrypted by the remote server” (e.g., see:

Wing – Paragraphs 12-15: “intent for 5-tuples (e.g., source IP address, destination IP address, protocol number, source port number, and destination port number) of a media session... Traffic

for the media session through the firewall server is monitored for a violation of the policy...verify that the traffic for the media session satisfies the expected characteristics”;

Paragraph 41: “This technique may be used by any other application function trusted by the network to permit time-bound, encrypted, peer-to-peer traffic”; Paragraph 56: “the intent may be a type of media stream. A given 5-tuple may be for audio, another for video, another for data”;

Paragraphs 72-81: “One or more characteristics of the traffic are compared to the intent-based policy. The policy dictates expected or allowable characteristics”; Paragraph 78: “The characteristics may be found without knowing the protocol, with the data encrypted, or with different connections through different firewalls. For example, the properties of the traffic (audio, SSRC, application identity, payload type, or combinations thereof) may be extracted from a RTP header without having to decrypt the RTP data”; Paragraph 97; Figs. 1 and 3).

Second, the relevant teachings of Mahaffey have been appropriately summarized in the instant Request (see: Request, pp. 8-9). In general, the Mahaffey reference discloses managing user traffic on a path between a user computing device and a destination computing device based on a policy associated with the user (e.g., see: Mahaffey – Abstract). More specifically, Mahaffey teaches that in response to a trigger detected based on an analysis of network traffic, a server may perform one or more actions or operations specified by a policy. For example, an operation performed by the server may include providing a user with a notification, dropping a packet, dropping all packets or information sent through the tunnel, or terminating the SNC connection (e.g., see: Mahaffey – Paragraphs 284-297).

Mahaffey is cited in the Request (e.g., see: Request, pp. 8-9 and 34-37) as a reference used in combination with Wing to more precisely teach additional limitations of at least independent claim 1 (e.g., “determining, by the remote server, based on a comparison of the

determined content, whether to modify the at least one data packet, and if so, modifying the at least one data packet; and sharing, by the remote server, the modified communication.”).

Further, Mahaffey is also cited in the Request (e.g., see: Request, p. 41) to explicitly teach substantially similar dependent claims 11, 18, and 29 (e.g., see: Mahaffey – Paragraphs 294: “An operation performed by the server may include providing a user with a notification...the user of the computing device may be provided with a notification that displays the text, ‘We have found malware on your device. We have stopped all connections”).

As noted above, the Wing and Mahaffey references were neither previously cited/considered nor applied in a rejection to any of the claims during the original prosecution history of the Koren ‘249 patent. The Wing and Mahaffey references were also not cited and thus have not been considered in IPR2025-00836.

It is agreed that the consideration of Wing alone and/or Wing in view of Mahaffey raises an SNQ as to representative independent claim 1 of the Koren ‘249 patent as pointed out above. There is a substantial likelihood that a reasonable examiner would consider these teachings important in deciding whether or not claims 1-30 are patentable.

Accordingly, Wing alone and/or Wing in view of Mahaffey raises a substantial new question of claims 1-30 which question has not been decided in a previous examination of the Koren ‘249 patent nor was there a final holding of invalidity by the Federal Courts regarding the Koren ‘249 patent.

35 U.S.C. 325

35 USC 325(d) states in part that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account

whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”. Thus, in order for the Director to exercise discretion as to whether to Order a reexamination proceeding under chapter 30, the request must first be determined to be based on the same or substantially the same prior art or arguments that previously were presented to the Office.

A review of the Office post grant history for the ‘249 patent indicates that the patent is the subject of one prior Office post grant challenge, which was filed after the filing of the instant reexamination request.

On April 10, 2025, subsequent to the filing of the instant Request, Petitioner, Cisco Systems Inc., filed a petition requesting *inter partes* review of claims 1-30 of the ‘249 patent. The petition asserted the following grounds as raising a reasonable likelihood in prevailing (RLP).

IPR2025-00836

RLP #	Claims	Basis	Prior Art
1	1-30	35 USC § 103	Burns, Yang
2	4, 7, 13, 15, 22, 24 and 30	35 USC § 103	Burns, Yang

As of the date of mailing of this Order, the Patent Trial and Appeal Board (PTAB) has yet to make a decision on institution of this petition.

A comparison between the prior art and arguments presented in the instant Request *for ex parte* reexamination of the ‘249 patent (90/019,896) indicates that the neither the prior art nor arguments are the same or substantially the same as the art or arguments presented in the prior pending *inter partes* review petition (IPR2025-00836).

As stated above, the instant reexamination request (90/019,986) asserts the following grounds a raising a substantial new question of patentability (SNQ):

SNQ #	Claims	Basis	Referenccs
1	1-10, 12-18, 19-28 and 30	103(a)	Wing
2	1-30	103(a)	Wing, Mahaffey

As an initial matter, none of the grounds asserted as raising an SNQ in the current *ex parte* reexamination request (90/019,896) (which was filed prior to the IPR petition) are based on identical grounds presented in the prior IPR petition. In addition, there are no common prior art references the two challenges. Further, each of the prior art references presented in the reexam request has different disclosures from the prior art presented in the IPR and the arguments in the Request assert different teachings relative the claims of the '249 patent.

Thus, because the IPR petition was filed after the filing of this reexam request and because neither the art nor arguments presented in the Request are neither the same nor substantially the same as any art or arguments previously presented to the Office, the statutory threshold under 35 USC 325(d) for the Director to exercise discretion to reject this Request is not met.

Accordingly, *ex parte* reexamination of the '249 patent is Ordered based on the determination above that the Request raises an SNQ.

Scope of Reexamination

12. Claims 1-30 **will be** reexamined as requested in the Request.

Conclusion

13. Extensions of time under 37 CFR 1.136(a) will not be permitted in these proceedings because the provisions of 37 CFR 1.136 apply only to "an applicant" and not to parties in a reexamination proceeding. Additionally, 35 U.S.C. 305 requires that reexamination proceedings "will be conducted with special dispatch" (37 CFR 1.550(a)). Extension of time in *ex parte* reexamination proceedings are provided for in 37 CFR 1.550(c).

The patent owner is reminded of the continuing responsibility under 37 CFR 1.565(a) to apprise the Office of any litigation activity, or other prior or concurrent proceeding, involving Patent No. 11,816,249 throughout the course of this reexamination proceeding. The third party requester is also reminded of the ability to similarly apprise the Office of any such activity or proceeding throughout the course of this reexamination proceeding. See MPEP §§ 2207, 2282 and 2286.

14. All correspondence relating to this *Ex Parte* reexamination proceeding should be directed:

Electronically: Registered users may submit via Patent Center at <https://patentcenter.uspto.gov/>.

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For electronic transmissions, 37 CFR 1.8(a)(1)(i)(C) and (ii) states that correspondence (except for a request for reexamination and a corrected or replacement request for reexamination) will be considered timely filed if (a) it is transmitted via the USPTO patent electronic filing system in accordance with 37 CFR 1.6(a)(4), and (b) includes a certificate of transmission for each piece of correspondence stating the date of transmission, which is prior to the expiration of the set period of time in the Office action.

Any inquiry concerning this communication should be directed to Adam Basehoar at telephone number 571-272-4121.

/Adam L Basehoar/
Primary Examiner, Art Unit 3992

Conferees:

/JOSHUA D CAMPBELL/
Primary Examiner, Art Unit 3992

/ALEXANDER J KOSOWSKI/
Supervisory Patent Examiner, Art Unit 3992