UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GOOGLE LLC,
Petitioner,

v.

K.MIZRA LLC,
Patent Owner.

Case IPR2025-01437
Patent 9,516,048

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I. INTRODUCTION 1

II. THE '048 PATENT 2

III. CLAIM CONSTRUCTION 6

IV. ANALYSIS 7

A. Petitioner Fails to Establish How Claim 1 is Obvious Over Freund, Ball, *and* Pujare 7

B. Petitioner's Competing and Contradictory Claim Construction Positions Also Require Denial 11

C. Petitioner's Motivation to Combine the Asserted References Suffers from Hindsight Reconstruction Bias 16

D. Independent Claims 10 and 17 and the Dependent Claims are also Patentable Over Petitioner's Challenge for the Same Reasons Stated Above 18

V. CONCLUSION 19

TABLE OF AUTHORITIES

Cases

Axonics, Inc. v. Medtronic, Inc.,
75 F.4th 1374 (Fed. Cir. 2023) 11

Canon Inc. v. WSOU Investment, LLC,
IPR2022-01532, Paper 14 (PTAB Apr. 14, 2023) 9

Cuzzo Speed Techs., LLC v. Lee,
579 U.S. 261 (2016)....................10

Duo Sec., Inc. v. Strikeforce Techs., Inc.,
IPR2017-01064, Paper 7 (PTAB Oct. 16, 2017).................... 12, 14

EBates Performance Mktg., Inc. v. IBM Corp.,
IPR2022-00439, Paper 11 (PTAB Oct. 3, 2022)....................14

EIK Eng'g SDN. BHD. V. Wilco Marsh Buggies & Draglines, Inc.,
IPR2020-00344, Paper 12 (PTAB Mar. 4, 2021)....................8

EIK Eng'g SDN. BHD. V. Wilco Marsh Buggies & Draglines, Inc.,
IPR2020-00344, Paper 7 (PTAB June 23, 2020) 8

E-One, Inc. v. OshKosh Corp.,
IPR2019-00161, Paper 16 (PTAB May 15, 2019) 12

Eton Pharms., Inc. v. Exela Pharma Scis., LLC,
PGR2020-00064, Paper 12 (PTAB Nov. 18, 2020) 10

Google LLC v. K.Mizra LLC,
IPR2025-01436, Paper 2 (PTAB Sept. 19, 2025)....................10

Innolux Corp. v. Phenix Longhorn LLC,
IPR2025-00044, Paper 11 (PTAB June 9, 2025) 15

Intuitive Surgical, Inc. v. Ethicon LLC,
25 F.4th 1035 (Fed. Cir. 2022) 7

Microchip Tech. Inc. v. Aptiv Techs. AG,
IPR2024-00558, Paper 12 (PTAB Oct. 7, 2024)....................13

MIM Software Inc. v. Progenics Pharms., Inc,
IPR2025-00725, Paper 13 (PTAB Oct. 8, 2025)....................12

Statutes

35 U.S.C. § 312(a)(3) 8, 14, 15

Rules

37 C.F.R. § 42.104 .... 6, 8, 11, 15

37 C.F.R. § 42.107 1

37 C.F.R. § 42.6 13

PATENT OWNER'S EXHIBIT LIST

Exhibit No.	Description
2001	Complaint for Declaratory Judgment of Non-Infringement of U.S. Patent Nos. 8,144,717 and 8,438,120, *Google LLC v. K.Mizra LLC*, No. 3:25-cv-08107-JCS (N.D. Cal.) (ECF No. 1)
2002	U.S. Patent No. 9,420,065 to Mayo *et al*.
2003	Screenshot of web page "Cisco Systems Inc. Be The Bridge to Possible" (https://www.cloud.google.com/find-apartner/partner/cisco-systems-inc, last accessed Nov. 21, 2025) and "Cisco and Googler partner on a new open hybrid cloud solution spanning on-premises environments and Google Cloud Platform" (https://www.cloud.google.com/find-apartner/partner/cisco-systems-inc, last accessed Nov. 21, 2025)
2004	Screenshot of web page "Hewlett Packard Enterprise Delivering true hybrid cloud for containers" (https://cloud.google.com/find-apartner/partner/cloud-technology-partners-ctp-an-hpe-company, last accessed Nov. 21, 2025) and "Enterprise partner to deliver hybrid cloud solutions to customers" (https://cloud.google.com/blog/topics/partners/google-cloudpartners-with-hpe-on-hybrid-cloud-next19, last accessed Nov. 21, 2025)
2005	Declaration of Charles J. Hausman in Support of Patent Owner's Request for Discretionary Denial
2006	Patent and Trademark Office, Notice of Proposed Rulemaking - Revision to Rules of Practice before the Patent Trial and Appeal Board, https://federalregister.gov/d/2025-19580, Oct. 17, 2025
2007	Scheduling Order, *K.Mizra LLC v. Google LLC*, 1:25-cv-00236-ADA (W.D. Tex.) (ECF No. 39)
2008	Standing Order Governing Proceedings (OGP) – Patent Cases, J. Albright (W.D. Tex.)
2009	Screenshot of Trial Statistics 01/01/2009 – 10/16/2025, U.S. District Court for the Western District of Texas
2010	Order Denying Motion to Dismiss, *K.Mizra LLC v. Google LLC*, 1:25-cv-00236-ADA (W.D. Tex., Oct. 22, 2025)

2011	Claim Construction Order and Memorandum in Support Thereof, *K.Mizra LLC v. Google LLC*, 1:25-cv-00236-ADA (W.D. Tex.) (ECF No. 57)
2012	Order Setting Trial Date & Discovery Deadlines, Referring Case to Mediation & Referring Discovery Motions to United States Magistrate Judge, *K.Mizra LLC v. Citrix Systems, Inc. et al*., No. 0:25-cv-60803-WPD (S.D. Fla.) (ECF No. 46)
2013	Screenshot of Judge William P. Dimitrouleas Median Time-to-Trial Statistics, U.S. District Court for the Southern District of Florida
2014	Clerk's Notice of Judge Assignment to Judge William P. Dimitrouleas, *K.Mizra LLC v. Citrix Systems, Inc. et al*., No. 0:25-cv-60803-WPD (S.D. Fla.) (ECF No. 20)
2015	Order Denying Defendant's Motion to Dismiss, *K.Mizra LLC v. Citrix Systems, Inc. et al*., No. 0:25-cv-60803-WPD (S.D. Fla.) (ECF No. 34)
2016	Google, LLC's Invalidity Contentions, *K.Mizra LLC v. Google LLC*, 1:25-cv-00236-ADA (W.D. Tex.) (July 15, 2025)
2017	Defendants' Amended Answer and Affirmative Defenses to Plaintiff's Complaint, *K.Mizra LLC v. Citrix Systems, Inc. et al*., No. 0:25-cv-60803-WPD (S.D. Fla.) (ECF No. 44)
2018	Patent and Trademark Office, Interim Director Discretionary Process, https://www.uspto.gov/patents/ptab/interim-directordiscretionary-process, Nov. 21, 2025
2019	Complaint for Patent Infringement, *K.Mizra LLC v. Google LLC*, 1:25-cv-00236-ADA (W.D. Tex.) (ECF No. 1)

Pursuant to 37 C.F.R. § 42.107, Patent Owner K.Mizra LLC ("K.Mizra" or "Patent Owner") files this preliminary response to the Petition, setting forth reasons why the Petition for *inter partes* review ("IPR") of claims 1-20 of U.S. Patent No. 9,516,048 (the "'048 patent"), as requested by Google LLC ("Petitioner"), should be denied on the merits.

I. INTRODUCTION

The '048 patent, which is now expired and has a priority date going back to September 27, 2004, claims a technique to control access to secure computer networks by detecting the health and compliance status of a computer in a trusted manner and allowing remediation of the computer to ensure compliance with network security policies. See, e.g., Ex. 1001, Abst. The '048 patent's solution verifies that any device attempting to access a company's network meets standards for network security and will not introduce dangerous computer programs or viruses into the network. A novel aspect of the invention lies in this verification—an attestation of cleanliness transmitted from a trusted computing base associated with a trusted platform module. The inventors of the '048 patent recognized the potential risk of false attestations as a further significant security hole. Accordingly, they believed sending a secure message with an attestation from a trusted computing base associated with a tamper-resistant trusted platform module in a host to be a significant point of innovation.

The Petition challenges the claims of the '048 patent based on the proposed combination of Freund (Ex. 1005) in view of Ball (Ex. 1006) and Pujare (Ex. 1009). However, this combination is unsupported by credible and supportable motivation to combine these references, and instead the Petition relies on hindsight-based reasoning to recreate the challenged claims. Additionally, Petitioner's strategy for handling claim construction is improper, as is its disclosure of the nature of its specific challenges. These reasons each support a denial on the merits. No IPR should be instituted.

II. THE '048 PATENT

The '048 patent is titled "Contagion Isolation and Inoculation via Quarantine" and was issued by the United States Patent Office to inventors James A. Roskind and Aaron R. Emigh on December 6, 2016. The earliest application related to the '048 patent was filed on September 27, 2004. *See* '048 patent, cover.

The '048 patent is directed to methods and systems for securing a computer network by detecting viruses and/or vulnerabilities on a computer attempting to access a secure network, quarantining the computer by restricting access to the network upon detection of an infestation or vulnerability, and permitting limited access to the protected network for remedying the insecure condition on the computer. '048 patent, Abst., 11:35-12:35.

Prior art computer network security systems faced considerable challenges with protecting and maintaining up-to-date security software on mobile devices such as employees' personal laptops, which posed significant security risks that could allow attackers or viruses stealth access into a business's network, bypassing IT security measures. *Id.*, 1:22-37. While a network security appliance or hardware can adeptly keep out unwanted external intrusions into the network, the most exploitable vulnerabilities of a computer network are found on the end-user computers that roam throughout various other insecure public and private network domains and then access the presumably secure network day in and day out. *Id.*

The '048 patent closes this loophole by verifying that any device attempting to access a company's network meets its standards for network security and will not introduce dangerous computer programs or viruses into the network. As noted in the introduction, a novel aspect of the invention lies in this verification—a signed attestation of cleanliness from a trusted computing base associated with a trusted platform module. *See, e.g.*, '048 patent, Claim 1. The inventors of the '048 patent recognized the potential risk of false attestations as a further significant security hole. Accordingly, they believed providing a securely-signed attestation from a trusted computing base associated with a tamper-resistant trusted platform module to be a significant point of innovation.

Relevant to these disclosures, challenged claim 1 recites (with emphasis added):

> 1. A method, comprising:
>
> detecting an insecure condition on a first host that has connected or is attempting to connect to a protected network, wherein detecting the insecure condition includes ***contacting a trusted computing base associated with a trusted platform module within the first host***, receiving a response, and determining whether the response includes a valid digitally signed attestation of cleanliness, ***wherein the valid digitally signed attestation of cleanliness includes at least one attestation selected from the group consisting of an attestation that the trusted computing base has ascertained that the first host is not infested, and an attestation that the trusted computing base has ascertained the presence of a patch or a patch level associated with a software component on the first host***;
>
> when it is determined that the response does not include a valid digitally signed attestation of cleanliness, quarantining the first host, including by preventing the first host from sending data to one or more other hosts associated with the protected network, wherein preventing the first host from sending data to one or more other hosts associated with the

protected network includes receiving a service request sent by the first host, determining whether the service request sent by the first host is associated with a remediation request, and when it is determined that the service request sent by the first host is not associated with a remediation request, serving a quarantine notification page that provides remediation information to the first host if the service request sent by the first host comprises a web server request, wherein serving the quarantine notification page to the first host includes re-routing by responding to the service request sent by the first host with a redirect that causes a browser on the first host to be directed to a quarantine server configured to serve the quarantine notification page; and

permitting the first host to communicate with a remediation host configured to provide data usable to remedy the insecure condition.

While only claim 1 has been reproduced here, independent claims 10 and 17 include substantially similar limitations as those emphasized above, and are patentable over Petitioner's challenge for the same reasons presented in this POPR for claim 1.

III. CLAIM CONSTRUCTION

Petitioner presents the proposed and agreed-upon constructions for seven terms identified in the "Related Litigation."[1] Of relevance to the merits defects addressed in Section IV.C below, Petitioner notes that the parties have agreed that the claimed "trusted platform module" should be construed as "a secure cryptoprocessor that can store cryptographic keys and that implements the Trusted Platform Module specification from the Trusted Computing Group." Pet., 17.

Additionally, as explained in more detail below, Petitioner here improperly offers competing constructions for these terms, without setting forth which construction(s) it believes are correct. Petitioner's approach does not comply with its obligation to identify "[h]ow the challenged claim is to be construed." 37 C.F.R. § 42.104(b)(3).

---

[1] *K.Mizra LLC v. Google LLC,* Civ. Action No. 1:25- cv-00236 (W.D. Tex.). *See* Ex. 1014, Ex. 1015; *see also* Pet., 16-19.

IV. ANALYSIS

Petitioner's challenges are based on a combination of Freund, Ball, and Pujare references.[2] However, Petitioner's alleged motivation to combine these references is tainted by impermissible hindsight.

A. Petitioner Fails to Establish How Claim 1 is Obvious Over Freund, Ball, *and* Pujare

Petitioner has also failed to support its challenge because it does not explain how the asserted combination of Freund, Ball, *and* Pujare renders the claims obvious.

The Federal Circuit has often noted that the party seeking institution of *inter partes* review is "the master of its own petition." *See Intuitive Surgical, Inc. v. Ethicon LLC*, 25 F.4th 1035, 1041 (Fed. Cir. 2022). The Board has accordingly recognized that the "focus" of its analysis is "on what is asserted in the Petition."

[2] *See* Pet., 8:

Ground	Reference(s)	Basis	Claims
1	U.S. Patent Application Publication No. 2003/0055962 to G. Freund *et al.* ("Freund") (EX1005) in view of U.S. Patent Application Publication No. 2006/0005009 to C. Ball *et al.* ("Ball") (EX1006) and U.S. Patent Application Publication No. 2002/0083183 to Pujare *et al.* ("Pujare") (EX1009)	103	1-20

EIK Eng'g SDN. BHD. V. Wilco Marsh Buggies & Draglines, Inc., IPR2020-00344, Paper 7, 7 (PTAB June 23, 2020).

Here, Petitioner asserts a single ground based on Freund in view of Ball and Pujare. Pet., 8. To support this ground, Petitioner was required to "identify with particularity what disclosure is relied on from each of the references[], how it would be combined with the other disclosures, and why the proposed combination would have been obvious to a person of ordinary skill in the relevant technology." *EIK Eng'g*, IPR2020-00344, Paper 7, 14; *see also id.*, Paper 12, 9-10 (PTAB Mar. 4, 2021) (noting Petitioner needs to explain what each of the identified references contributed to the asserted unpatentability and "why it would have been obvious to combine selected disclosures from each of the three references.").

In at least two respects, Petitioner has failed to satisfy the statutory requirements for its Petition. *See* 35 U.S.C. § 312(a)(3) (requiring Petitioner to identify "with particularity . . . the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim."); *see also* 37 C.F.R. §§ 42.104(b)(3)-(5).

Petitioner completely fails to identify how Pujare allegedly discloses or suggests any element of the challenged claims, or how or why a POSITA would be motivated to combine Pujare with Freund and Ball. Indeed, except in the heading, Pujare is not mentioned by name at all in the section of the Petition that "detail[s]

how Claims 1-20 are [allegedly] obvious over the prior art." *See* Pet., 20. And the exhibit is not cited at all within the challenge. The Petition also does not address any motivation to combine Pujare with Freund, Ball, and/or Lewis.

A similar situation was presented in *Canon Inc. v. WSOU Investment, LLC*, IPR2022-01532, Paper 14 (PTAB Apr. 14, 2023). In that proceeding, the Petitioner challenged claims as obvious over Sugitani and Kubo. *Id.*, 6. The Board found that the Petitioner had failed to establish a motivation to combine these references. *Id.*, 20. The Board acknowledged that for certain claims, the Petition "rel[ied] on Kubo sparingly, if at all." *Id.*, 20 n.8. However, the Board found that it "cannot deviate from the grounds in the petition and raise our own obviousness theory, e.g., obviousness based on Sugitani alone." *Id.* The Board therefore concluded that "even where Kubo might not be necessary for teaching the limitations of certain claims, we evaluate Petitioner's obviousness ground as it has been presented in the Petition, which necessarily includes Petitioner's rationale for combining Kubo with Sugitani." *Id.* Here, too, the Board should honor Petitioner's decision not to raise any obviousness theory based on Freund and Ball alone.

Similarly, the Petition does not disclose that Lewis (Ex. 1013) is part of the alleged grounds. But Petitioner explains that "Lewis discloses an alternative means

of re-routing service requests" in connection with element [1.10]. Pet., 43.[3] In making a similar argument in a IPR2025-01436 against a related patent, Petitioner included Lewis as part of the grounds. *See Google LLC v. K.Mizra LLC*, IPR2025-01436, Paper 2, 8 (PTAB Sept. 19, 2025). So is Petitioner's challenge based on Freund, Ball, Lewis, and Pujare? Or is it based on Freund, Ball, and Pujare, but not Lewis (as Petitioner claims)? Or perhaps just Freund and Ball? The Board's job is to evaluate the merits of the challenge presented. Neither Patent Owner nor the Board should be required to parse the Petition to figure out what the challenge actually being presented is.

Petitioner chose to allege obviousness based on Freund, Ball, and Pujare, and has failed to properly support that challenge. The Board should limit Petitioner to its theories and not adopt its own obviousness theory based on Freund and Ball alone. As Justice Alito has explained, "if the Patent Office institutes review on claims or grounds not raised in the petition[,] the patent owner is forced to shoot into the dark" when it files its response. *Cuzzo Speed Techs., LLC v. Lee*, 579 U.S. 261, 296 (2016) (Alito, J., concurring in part and dissenting in part). "The potential for unfairness is obvious." *Id.*

---

[3] *Eton Pharms., Inc. v. Exela Pharma Scis., LLC*, PGR2020-00064, Paper 12, 14 (PTAB Nov. 18, 2020) (noting that grounds that do not identify alternative references do not "allow[] Patent Owner the ability to respond and leaves Patent Owner, and the Board for that matter, to guess how the references are applied to each particular ground.").

B. Petitioner's Competing and Contradictory Claim Construction Positions Also Require Denial

Petitioner also chose to offer competing claim constructions rather than selecting one construction that it believes is correct for each identified term. Pet., 16-19. This choice not only presents unnecessary issues for the Board, but also resulted in Petitioner being unable to properly address the claims under the appropriate claim construction.

First, in this proceeding, Petitioner fails to take any position on claim construction. The Petition does not state what construction(s) the Board should apply; rather, it just notes that Petitioner and Patent Owner have proposed certain constructions in the district court, without advocating for a particular construction and without taking a position on which construction(s) should apply to the Board's validity analysis. Pet., 16. Indeed, the Petitioner also mentions there may be "other constructions." Pet., 19. This approach does not comply with Petitioner's obligation to identify "[h]ow the challenged claim is to be construed." 37 C.F.R. § 42.104(b)(3). As the Federal Circuit has explained, this rule "does not direct a petitioner to raise, address, and apply alternative possible constructions." *Axonics, Inc. v. Medtronic, Inc.*, 75 F.4th 1374, 1383 n.10 (Fed. Cir. 2023).

Second, to the extent Petitioner is offering alternative constructions, it is apparently asking that the Board determine the proper construction of the claims. But Petitioner acknowledges that these are the same issues that were before the

district court. Pet. at 16 ("In Related Litigation, Petitioner and PO proposed certain constructions."). The district court has already resolved all those issues. *See* Ex. 2011. Thus, Petitioner is really asking the Board to re-do claim construction that has already been done by the district court. This is not a good use of the Board's limited resources. *E-One, Inc. v. OshKosh Corp.*, IPR2019-00161, Paper 16, 7 (PTAB May 15, 2019). Indeed, such duplicative claim construction is either a waste of the Board's resources, if the Board agrees with the district court, or guarantees inconsistent results, if the Board adopts different constructions.

Third, the claim construction proposals offered by Petitioner are not properly supported. Petitioner must "explain, in detail, how the challenged claim is to be construed with supporting factual and legal analysis." *Duo Sec., Inc. v. Strikeforce Techs., Inc.*, IPR2017-01064, Paper 7, 8 (PTAB Oct. 16, 2017). Rather than provide the necessary analysis, Petitioner merely identifies multiple potential constructions without any arguments that would help the Board determine how to construe the seven identified terms even if the Board wanted to construe them. This approach to claim construction is improper. *MIM Software Inc. v. Progenics Pharms., Inc*, IPR2025-00725, Paper 13, 7-8 (PTAB Oct. 8, 2025) (rejecting multiple constructions without explanation of "under what circumstances one construction should be applied over the other [] construction.").

Fourth, to the extent Petitioner argues that its claim construction positions are supported by the referenced exhibits from the district court action, this too is improper. "Arguments must not be incorporated from one document into another document." 37 C.F.R. § 42.6(a)(3). Offloading claim construction to district court briefs, as Petitioner does here, violates this rule. *Microchip Tech. Inc. v. Aptiv Techs. AG*, IPR2024-00558, Paper 12, 10-11 (PTAB Oct. 7, 2024). It is an end run around the word limits and independently justifies denial of the Petition. *See* Pet., 85 (showing that the Petition includes 13,964 words).

Fifth, the competing claim constructions required Petitioner to adopt confusing and contradictory interpretations of what element of the prior art meets the claim limitations. For example, Petitioner proposes competing constructions of "trusted computing base" ("TCB") that disagree about whether the TCB must be within the first host. Pet., 17. This forces Petitioner to take the position that "Freund's router-side CMP and/or client-side security module satisfy the claimed TCB under Petitioner's and PO's constructions." Pet., 24. But because the CMP appears to be on the "router-side" rather than within the alleged first host, this leaves it completely unclear how Petitioner alleges the limitation is met. Is it Petitioner's contention that only a part of the TCB has to be within the first host under its construction? If not, is it Petitioner's contention that the CMP may or may not be a part of the TCB (and, if so, how should the Board make that

decision)? Neither Patent Owner nor the Board should be required to guess how Petitioner believes the claim is invalid under the proposed constructions. At the very least, Petitioner fails to describe evidence supporting its grounds "with particularity" as required by 35 U.S.C. § 312(a)(3).

Last, the competing claim constructions also resulted in Petitioner failing to properly develop its obviousness arguments for some limitations. For example, Petitioner improperly alleged that "remediation host" is a mean-plus-function term and thus indefinite. Pet., 18. Petitioner also identified, without explanation, certain corresponding structure. Pet., 18-19. But Petitioner is clear that it is only identifying "***purported*** corresponding structure," and "[m]erely for compliance with 37 C.F.R. § 42.104(b)(3) ***in this IPR***." Pet. at 19 (emphasis added). This is improper. *EBates Performance Mktg., Inc. v. IBM Corp.*, IPR2022-00439, Paper 11, 11 (PTAB Oct. 3, 2022) (denying IPR where structure identified "for the purpose of the present invalidity analysis only").

Petitioner "provides no analysis directed to rebutting the [] presumption, under governing Federal Circuit precedent, that § 112(6) is inapplicable" in the absence of the word "means." *Duo Sec.*, IPR2017-01064, Paper 7, 8-9. Additionally, Petitioner is clear that it contends that any corresponding structure for "remediation host" must include an algorithm. *See* Ex. 1014, 28. However, the "purported corresponding structure" identified by Petitioner does not include any

such algorithm. Pet., 18-19. Therefore, Petitioner's own arguments undermine any suggestion that it has satisfied 37 C.F.R. § 42.104(b)(3). *See Innolux Corp. v. Phenix Longhorn LLC*, IPR2025-00044, Paper 11, 22 (PTAB June 9, 2025).

Turning next to Petitioner's analysis of the prior art, Petitioner fails to develop any argument about how the prior art allegedly discloses the corresponding structure. Instead, the entirety of Petitioner's argument about how the '048 Patent is allegedly invalid under its proposed "means plus function" construction is the conclusory statement that "Freund allows a non-compliant computer to download appropriate corrective software from a remediation host through the sandbox server itself acting as a remediation host." Pet., 44. But this sentence does not explain why Freund's "sandbox server" meets Petitioner's alleged structure or function. This argument violates 35 U.S.C. § 312(a)(3) (requiring Petitioner to explain its grounds "with particularity"). Nowhere does Petitioner explain how any "corresponding structure" in Freund is equivalent to the structure described in Petitioner's proposed construction, and nowhere does Petitioner address the function according to its construction of this term..

For these reasons, Petitioner's approach for handling claim construction is wholly improper and warrants denial on the merits.

C. Petitioner's Motivation to Combine the Asserted References Suffers from Hindsight Reconstruction Bias

Finally, Petitioner's combination of references is clearly guided by impermissible hindsight and fails. Element [1.2] requires in part "a trusted computing base associated with a trusted platform module within the first host." According to Petitioner, Freund contacts a "trusted computing base (TCB) configured as Freund's 'client monitoring protocol software' (CMP) and/or 'client-side security component/module' associated with a TPM within the first host." Pet., 23. Petitioner goes on to describe the operation of Freund's client-side security module, including the use of digital signatures, to conclude that "Freund's disclosure of the client-side security module constitutes a TCB given that the client-side security module is hardware and/or software within the first host that provides security to the host." Pet., 24.

Petitioner next concedes that Freund fails to disclose that Freund's client-side security module is a "trusted platform module" as required by the claim, and argues that "a substitution of known TPM hardware to implement enhanced functionality of Freund's TCB would have achieved predictable results with a reasonable expectation of success … ." Pet., 25. But Petitioner offers no advantage or improvement that would be achieved through this substitution, and no credible motivation to much such a change.

Rather, Petitioner's litany of alleged reasons to replace Freund's TCB with a TPM "based on Ball's teachings" (*id.*) reads like a list of features that Freund's TCB already achieves. For example, Petitioner alleges that this substitution "would have allowed Freund's client-side host to verify its trustworthiness by securely communicating accurate information regarding antivirus versions, anti-virus status, security compliance, and digitally signed applications using cryptographic data keys to generate digital signatures and encryption/decryption." Pet., 25-26. But these are all features that Petitioner alleged were already present in Freund's TCB. Aside from the clear attempt to recreate the challenged claim, Petitioner offers no reason why a POSITA would have been motivated to make this proposed swap-out of Freund's client-side security module for Ball's TPM.

At best, Petitioner contends that Ball's TPM would have provided "enhanced" security and trust, but Petitioner fails to explain why that it is, or what would be allegedly "enhanced" relative to what Freund already achieves. *See* Pet., 26 (alleging that "Ball's TPM would have provided enhanced hardware-based security," "enhanced trust in the security configuration of Freund's client-side device," and "enhanced hardware-based security features."). Undercutting any claim that Ball's TPM would have been an improvement to Freund, Petitioner concedes that "Ball and Freund disclose similar goals of enhanced trust and

security and similar mechanisms of a challenge/response protocol to determine the trustworthiness of a device.” Pet., 26.

Finally, confirming Petitioner’s shotgun approach to this motivation analysis, Petitioner concludes that “it would have been ***obvious to try*** the TPM from among the finite number of identified, predictable hardware solutions for executing software security modules of the type disclosed by Freund with a reasonable expectation of success.” Pet., 27-28. Of course the Petition makes no effort to enumerate these alleged “finite number of identified, predictable hardware solutions,” thus reinforcing that Petitioner is just regurgitating pejorative obviousness theories in an effort to brush past the lack of meaningful analysis.

For all these reasons, Petitioner’s proposal to modify Freund in view of Ball in an effort to satisfy element [1.2] is unsupported and fails.

D. Independent Claims 10 and 17 and the Dependent Claims are also Patentable Over Petitioner’s Challenge for the Same Reasons Stated Above

Claims 10 and 17 contain similar limitations as claim 1 and therefore survive Petitioner’s unsupported challenges for the same reasons presented above. Additionally, dependent claims 2-9 depend from independent claim 1, dependent claims 11-16 depend from independent claim 10, and dependent claims 18-20 depend from independent claim 17. For the same reasons set forth for independent

claim 1 above, all of the remaining challenged claims are also patentable over the combination of Freund, Ball, and Pujare.

V. CONCLUSION

For the reasons presented above, Patent Owner respectfully asks that the Director deny the Petition on the merits. No *inter partes* review should be instituted.

Dated: December 23, 2025

/*Wayne M. Helge*/
Wayne M. Helge, Reg. No. 56,905
James T. Wilson, Reg. No. 41,439
BUNSOW DE MORY LLP
277 S. Washington St., Suite 210 #1088
Alexandria, VA 22314
T: (571) 208-0186
Email: whelge@bdiplaw.com
Email : jwilson@bdiplaw.com

Counsel for Patent Owner

CERTIFICATE OF WORD COUNT

The undersigned certifies that the foregoing PATENT OWNER'S PRELIMINARY RESPONSE complies with the type-volume limitation in 37 C.F.R. § 42.24(b)(1). According to the word-processing system's word count, the brief contains 3,823 words, excluding the parts of the brief exempted by 37 C.F.R. § 42.24(a).

By: */Wayne M. Helge/*
Wayne M. Helge (Reg. No. 56,905)
Counsel for Patent Owner

CERTIFICATE OF SERVICE

I hereby certify that on December 23, 2025, a true and correct copy of the foregoing document was served via email, by consent, to Petitioner by serving the correspondence email addresses of record as follows:

Lead Counsel Patrick C. Keane (Reg. No. 32,858) BUCHANAN INGERSOLL & ROONEY PC 1737 King Street, Suite 500 Alexandria, Virginia 22314 Direct Telephone (703) 838-6522 Main Facsimile (703) 836-2021 patrick.keane@bipc.com	**Backup Counsel** Roger H. Lee (Reg. No. 46,317) BUCHANAN INGERSOLL & ROONEY PC 1737 King Street, Suite 500 Alexandria, Virginia 22314 Telephone (703) 838-6545 Facsimile (703) 836-2021 roger.lee@bipc.com
Backup Counsel Andrew J. Koopman (Reg. No. 65,537) BUCHANAN INGERSOLL & ROONEY PC 2200 Renaissance Blvd., Suite 350 King of Prussia, PA 19406 Telephone (610) 993-4217 Facsimile (610) 407-0701 andrew.koopman@bipc.com	**Backup Counsel** Samuel Harrod (Reg. No. 79,148) BUCHANAN INGERSOLL & ROONEY PC Union Trust Building 501 Grant Street Suite 200 Pittsburgh, PA 15219 Telephone (412) 562-8805 Facsimile (412) 562-1041 samuel.harrod@bipc.com

/Wayne M. Helge/
Wayne M. Helge (Reg. No. 56,905)
Counsel for Patent Owner