

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORTINET, INC.,

Petitioner,

v.

NETSKOPE, INC.,

Patent Owner.

U.S. Patent No. 8,327,426

PTAB Case No. IPR2026-00026

PATENT OWNER'S PRELIMINARY RESPONSE

TABLE OF CONTENTS

I. INTRODUCTION 1

II. LEVEL OF ORDINARY SKILL IN THE ART 3

III. PETITION’S CLAIM CONSTRUCTION CONTRADICTS
DISTRICT COURT POSITIONS 4

IV. GROUND 1: HINTON DOES NOT ANTICIPATE THE
CHALLENGED CLAIMS 7

 A. Ground 1 Fails to Meet the Legal Standard of Anticipation..... 7

 B. Independent Claims 1 and 8 Are Not Anticipated Because
 Hinton Fails to Disclose Several Claim Features In The
 Respective Claims 8

 1. Independent Claim 1 8

 2. Independent Claim 8 13

 3. Dependent Claims 2-4, 6, 7, 9-11, and 13 Are Not
 Anticipated By Hinton For At Least the Same Reasons as
 Claim 1 15

V. GROUND 2: HINTON DOES NOT RENDER THE CHALLENGED
CLAIMS OBVIOUS 15

 A. Independent Claims 1 And 8 Recite Nonobvious Methods
 Which Are Completely Different Than Hinton 15

 1. Hinton does not disclose, teach, suggest, or render
 obvious the claimed “*determination as to whether to use
 a single interaction or multiple interactions for
 authentication of the principal to the other services is
 automatically communicated in the new authentication
 response*” in 1[i] of Claim 1..... 16

TABLE OF CONTENTS (CONTINUED)

	Page
2. Hinton does not disclose, teach, suggest, or render obvious the claimed “ <i>detecting, by a machine and from an identity service, an instruction, which is represented in the authentication response</i> ” in 8[g] of Claim 8	18
VI. GROUND 3: THE COMBINATION OF HINTON AND BURCH DOES NOT RENDER THE CHALLENGED CLAIMS OBVIOUS.....	21
A. Ground 3 Necessarily Fails Because Burch Cannot Preclude Patentability Of The '426 Patent Under Pre-AIA 35 U.S.C. § 103(c).....	21
VII. PETITION FAILS TO MEET MULTIPLE LEGAL REQUIREMENTS OF UNPATENTABILITY	23
A. The Grounds Fail To Delineate Between § 102 And § 103 Arguments Or Properly Assert Either Category	23
B. Petitioner Improperly Relies On POSITA Knowledge Instead Of Disclosure Or Teaching In The Prior Art Reference	26
VIII. CONCLUSION.....	29

EXHIBIT LIST

No.	Exhibit Description
Ex. 2001	EXPUNGED
Ex. 2002	Fortinet Inc.’s Preliminary Invalidation Contentions in <i>Netskope, Inc. v. Fortinet, Inc.</i> , Case No. 4:25-cv-02360-HSG, pending in the United States District Court for the Northern District of California.
Ex. 2003	Exhibit E-1 of Fortinet Inc.’s Preliminary Invalidation Contentions in <i>Netskope, Inc. v. Fortinet, Inc.</i> , Case No. 4:25-cv-02360-HSG, pending in the United States District Court for the Northern District of California.
Ex. 2004	Exhibit E-5 of Fortinet Inc.’s Preliminary Invalidation Contentions in <i>Netskope, Inc. v. Fortinet, Inc.</i> , Case No. 4:25-cv-02360-HSG, pending in the United States District Court for the Northern District of California.
Ex. 2004	Exhibit Appendix C of Fortinet Inc.’s Preliminary Invalidation Contentions in <i>Netskope, Inc. v. Fortinet, Inc.</i> , Case No. 4:25-cv-02360-HSG, pending in the United States District Court for the Northern District of California.
Ex. 2005	Plot from Docket Navigator – Profile of Judge Haywood S. Gilliam Motion Success To Stay Pending IPR
Ex. 2006	Plots from Docket Navigator – Profile of Judge Haywood S. Gilliam Time to Milestones (annotated)
Ex. 2007	Website blog on Fortinet.com, titled: “Fortinet is Leading Innovation in the Security Industry with More Than 1,500 Patents” https://www.fortinet.com/blog/business-and-technology/fortinet-is-the-security-innovation-leader-more-than-1500-patents-either-awarded-or-pending
Ex. 2008	Website article on Wikipedia.org, titled: “Fortinet” https://en.wikipedia.org/wiki/Fortinet

Ex. 2009	Inventor assignment to Novell, Inc. of U.S. Patent Application No. 11/395,725, that is Petitioner's asserted reference "Burch"
Ex. 2010	Inventor assignment to Novell, Inc. of U.S. Patent Application No. 11/444,944, that was granted as U.S. Patent No. 8,327,426
Ex. 2011	Scheduling Order for <i>Netskope, Inc. v. Fortinet, Inc.</i> , Case No. 4:25-cv-02360-HSG, pending in the United States District Court for the Northern District of California.
NEW EXHIBIT	
Ex. 2012	Declaration of Dr. Michael Franz, Sc.D.

I. INTRODUCTION

Fortinet, Inc. (“Fortinet” or “Petitioner”) filed a petition for *Inter Partes* Review (“IPR”) against Claims 1-13 (“Challenged Claims”) of U.S. Patent No. 8,327,426 B2 (the “’426 patent”) based on three grounds. As this Patent Owner Preliminary Response shows, Petitioner has failed to show a reasonable likelihood that any of the Challenged Claims is invalid.

The ’426 patent is directed to network security techniques for establishing single sign on with proxy services. *See* Ex. 1001, title, 1:5-7. The systems and methods described in the ’426 patent provide a compatible and convenient way for users to achieve a single sign on for securely transacting across multiple Internet services. *Id.*, 1:11-55. For instance, the methods of the ’426 patent use identity services to manage and supply authentication services and authentication information for users (principals) and for other network services. *Id.*, 1:59-2:3, 11-55, 2:22-46, Claims 1 and 8. These identity services described and claimed in the ’426 patent “are enhanced and modified versions of the identity services” that were described beforehand. *Id.*, 2:47-59.

Claim 1, for instance, recites a method from the perspective of a “machine” that acts as a first identity service to proxy a user (principal), whereas the “machine” in Claim 8 acts as a second identity service to proxy target services for access to an “original” identity service that acts as a proxy on behalf of a principal. The first or

original identity service proxying for the principal, i.e., the “machine” in Claim 1—not the separate second identity service—makes “a determination as to whether to use a single interaction or multiple interactions for authentication of the principal to the other services,” which is “automatically communicated in the new authentication response.” *See id.*, 11:66-12:2. In Claim 8, the “machine” from the second identity service (i) “detect[s] an instruction [received from the original identity service], which is represented in the authentication response” that authenticates the principal for a single sign-on transaction and (ii) “tak[es] an action in response to the instruction to authenticate the principal for access to targeted services,” which occur via proxied sessions through the second identity service, which are transparent to the principal. *See id.*, 12:58-13:3

Claims 1 and 8 precisely claim unique configurations and functionalities of the identity services that are completely different than anything in the prior art—which the Office already acknowledged in the ’426 patent’s Notice of Allowance (Ex. 1002, 411-417), and which are certainly technically distinct from Petitioner’s main reference (Hinton) relied upon in each of the grounds of the Petition.

As discussed in detail below, among its many failures, the Petition fundamentally lacks merit by its missing, incorrect, and inconsistent mapping of Hinton’s federated network domains to the identity services in the ’426 patent claims. The Petition is also fatally flawed by failing to meet the legal standards of

invalidity under pre-AIA 35 U.S.C. §§ 102 and 103, including impermissible reliance on knowledge of a person of ordinary skill in the art (“POSITA”) and a reference (Burch) that is not assertable in an obviousness ground under pre-AIA 35 U.S.C. § 103(c).

All in all, the Petition falls woefully short of presenting a sound and compelling case that should disrupt Patent Owner’s strong settled expectations or that should utilize the Patent Office’s valuable resources in redundantly adjudicating patentability alongside the U.S. district court in the ongoing, active case of *Netskope, Inc. v. Fortinet, Inc.* (“Parallel Litigation”). See Patent Owner’s Brief for Discretionary Denial (Paper 6), 3-9.

Petitioner has failed to show that any of the Petition’s grounds demonstrate a reasonable likelihood of invalidating any of the Challenged Claims. Institution should consequently be denied under 35 U.S.C. § 314.

II. LEVEL OF ORDINARY SKILL IN THE ART

The Petition describes a POSITA as a person, as of June 2006, having “either (1) at least a bachelor's degree in computer science or computer engineering or an equivalent field plus at least one year of experience working on computer security, or (2) at least three years of experience working in the field of computer security, even without a formal degree. EX1003, ¶¶62-63.” Petition, 11.

For the purposes of this Preliminary Response, Patent Owner relies on the definition proposed by Petitioner because Petitioner has not shown that any challenged claim is unpatentable even under this level of skill. Ex. 2012, ¶33.

III. PETITION'S CLAIM CONSTRUCTION CONTRADICTS DISTRICT COURT POSITIONS

In the Petition, Petitioner contends that all claims should be interpreted under their plain an ordinary meaning, and no claim term needs a specific construction. Petition, 11. Yet, this is an inconsistent position with Petitioner's preliminary invalidity contentions filed in the Parallel Litigation that list thirteen claim terms (reproduced below) as allegedly being indefinite—eight indefinite term allegations in Claim 1 alone. Ex. 2002, 62-63. Petitioner's district court position states:

[v]arious Asserted Claims identified below do not comply with the requirements pre-AIA 35 U.S.C. § 112, ¶ 2, for failing to particularly point out and distinctly claim "the subject matter which the applicant regards as his invention" for the following reasons.... The following chart identifies the claims in which the identified terms and phrases explicitly appear, although those identified terms and phrases are also incorporated into additional dependent Asserted Claims.

Id., 60.

Petitioner, however, fails to mention any such assertions of indefiniteness in

its IPR filing and instead explains how the cited references in the grounds disclose or render obvious all limitations of the claims including all of the terms that Petitioner deemed indefinite in the Parallel Litigation. *See* Petition *passim*, e.g., 14, 30, 39.

Patent	Claim(s)	Indefinite Term and/or Phrase
'426	1	"receiving, by the machine, an authentication request from a principal, the request directed by the principal to an external service and intercepted by the method for receipt"
'426	1	"the authentication message serves as a new authentication request and as a new authentication response for single sign-on access of the principal to the identity service and other services external or internal to the identity service"
'426	1	"the identity service acts as a proxy for access sessions to the other services on behalf of the principal"
'426		"the principal's access sessions occur indirectly through the identity service and transparently to the principal"
'426	1	"wherein the authentication message includes the new authentication request made on behalf of the principal and the authentication message also includes a new authentication response that satisfies the new authentication request"
'426	1	"that response vouches for authentication of the principal to the identity service for the single sign-on access of the principal"
'426	1	"which is one of the other services that the identity service controls access to"
'426	1	"a determination as to whether to use a single interaction or multiple interactions for authentication of the principal to the other services is automatically communicated in the new authentication response"

'426	2	"making, by the machine, a target service available to interactions between the principal and an external service"
'426	2	"the target service is directly accessible from an environment of the identity service"
'426	4	"the principal is currently already properly authenticated to the processing associated with the method"
'426	5	"supplying further includes adding a second authentication to a second redirection of the principal, wherein the second authentication represents authentication of the principal to the identity service and wherein the second redirection directs the principal to request a target service that is to be proxied on behalf of the principal from the identity service"
'426	6	"representing the new authentication response as an instruction to the identity service to enforce its own independent authentication with the principal before considering the principal authenticated to the identity service"

Petitioner's inconsistent claim constructions provide yet another reason for denying the Petition in addition to those discussed below. The Office has made its position regarding this issue clear in both *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 (Precedential) and *Tesla, Inc. v. Intellectual Ventures II LLC*, IPR2025-00340, Paper 18 (Informative). Similar to *Revvo* and *Tesla*, Petitioner has decided to pursue differing claim construction positions without any explanations whatsoever in the Petition about the reasons for such divergent constructions.

For the purposes of this Preliminary Response, Patent Owner agrees with Petitioner's position in the Petition that no specific claim constructions are needed. Ex. 2012, ¶38.

IV. GROUND 1: HINTON DOES NOT ANTICIPATE THE CHALLENGED CLAIMS

A. Ground 1 Fails to Meet the Legal Standard of Anticipation

Ground 1 of the Petition is purported as an anticipation ground of invalidity against Claims 1-4, 6-11, and 13 of the '426 patent. *See* § V.B.3 of Petition, 12. However, the Petition lacks an earnest effort to articulate the reasonings and show support for its anticipation allegations. Instead, Ground 1 is melded with an obviousness-based ground (Ground 2) in a single section of the Petition, i.e., § VI. *See* Petition, 12. The result is a bewildering mischaracterization of the '426 patent claims that lack the requisite showing in the alleged anticipatory reference (Hinton) and are impermissibly supplemented with alleged knowledge of a POSITA (discussed later in **Section VII.B**).

To prove anticipation “a prior art reference must disclose all elements of the claim within the four corners of the document, *and it must disclose those elements arranged as in the claim.*” *Microsoft Corp. v. Biscotti, Inc.*, 878 F.3d 1052, 1068 (Fed. Cir. 2017) (emphasis added). *See also, In re Bond*, 910 F.2d 831, 832 (Fed. Cir. 1990). The law further requires that the “prior art reference must *clearly and unequivocally disclose* the claimed invention or direct those skilled in the art to the invention *without any need for picking, choosing, and combining various disclosures not directly related to each other* by the teachings of the cited

reference.” *Net MoneyIN, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008) (emphasis added).

As demonstrated below, Petitioner completely failed to meet the requisite standard for anticipation of any claims of the '426 patent.

B. Independent Claims 1 and 8 Are Not Anticipated Because Hinton Fails to Disclose Several Claim Features In The Respective Claims

1. Independent Claim 1

In Ground 1, Petitioner fails to map any disclosure from Hinton to claimed features recited in 1[i], 1[f], and 1[d], among other features and limitations in Claim 1. This is explained below. But first, to level set, Petitioner maps the claimed “*machine*” in 1[pre] and 1[a] to Hinton’s point-of-contact (POC) and trust proxy (TP) server of Enterprise A (Petition, 14-15); and Petitioner maps the claimed “*identity service*” in 1[c] to the POC/TP server of Enterprise B. *Id.* 17-18 (stating “the POC/TP of Enterprise B (i.e., machine that runs the identity service)”)¹ This mapping of the claimed “*identity service*” to Hinton’s POC/TP of Enterprise B is

¹ The Petition also maps the same POC/TP server of Enterprise B to the claimed “*external service*” in 1[a] and 1[h]. *See* Petition, 15 (stating “... to access some resource hosted in the Enterprise B domain”) and 23 (stating “that resource in Enterprise B (the external service)”).

confirmed multiple times, e.g., in 1[d]², 1[e]³, and 1[f]⁴. As such, any features or functionalities of Hinton's POC/TP of Enterprise A must be consistently mapped to the claimed "*machine*", and any features or functionalities of Hinton's POC/TP of Enterprise B must be consistently mapped to the claimed "*identity service*." This is not the case in the Petition.

a. Hinton does not disclose the claimed "*determination*" feature in 1[i] of Claim 1

Hinton does not disclose the claimed features in 1[i] of "*a determination as to whether to use a single interaction or multiple interactions for authentication of the principal to the other services is automatically communicated in the new authentication response*." Accordingly, the Petition did not map anything equivalent or similar to this feature from Hinton's disclosure, thus failing anticipation. Ex. 2012, ¶61.

The claimed "*determination*" is made by the "*machine*," made clear by the

² For 1[d], Petition states "... to the POC/TP of Enterprise B (identity service) ..." at p. 18 and "from the POC/TP of Enterprise B (i.e., the identity service)" at p. 19.

³ For 1[e], Petition at p. 20 states "[t]he POC/TP of Enterprise B (machine running the identity service)."

⁴ For 1[f], Petition at p. 22 states "... the POC/TP of Enterprise B (identity service)."

recitation that the “*determination ... is automatically communicated in the new authentication response,*” which 1[g] states is included in the “*authentication message*” that 1[c] states is “*suppl[ied] by the machine ... for use by [the] identity service.*” Thus, the claimed “*identity service*” cannot make the “*determination [that] is automatically communicated [to it] in the new authentication response*”—instead, the “*identity service*” is supplied this “*determination*” made by the “*machine.*” Ex. 2012, ¶¶57-58.

Yet that’s not how Petitioner tried to map the claimed “*determination*” feature of 1[i]. Rather than conceding Hinton does not disclose (or otherwise teach, suggest, or render obvious) the 1[i] features, Petitioner incorrectly asserted “[t]he POC/TP of Enterprise B determines whether one interaction or two interactions is required based upon the received single sign-on token,” Putting aside whether nor not Hinton’s POC/TP of Enterprise B actually makes this determination about one or two interactions, this feature of Hinton’s Enterprise B POC/TP does not meet the claimed “*determination*” feature because it is attributed to the “*machine*” and not the “*identity service.*” Ex. 2012, ¶60.

The Petition’s failures in 1[i] don’t stop there. For the “*automatically communicated*” limitation, Petitioner provides no mapping whatsoever to Hinton’s disclosure and instead relies on an allegation that Petitioner believes a POSITA would have understood this limitation. See Petition, 26 (“a POSITA would have

understood that the need for single or multiple interactions for authentication is automatically communicated in the single-sign-on token”).

The Petition's incorrect and missed mappings in 1[i] alone extinguishes Petitioner's anticipation ground.

b. Hinton does not disclose the claimed “transparently” feature in 1[f] of Claim 1

In addition to failures for 1[i], Hinton does not disclose the claimed features in 1[f], namely: “*the principal's access sessions occur indirectly through the identity service and transparently to the principal.*” Neither the Petition nor Petitioner's expert's declaration cite to Hinton even one time in their entire discussion about 1[f]. See Petition, 22; see also, Ex. 1003, ¶¶84-85. Instead, Petitioner again relies on alleged POSITA's understanding without any justification or support from Hinton. *Id.*

Specifically, the Petition merely asserts that Hinton's communication flow from the user to the principal's desired resources flow indirectly through the POC/TP of Enterprise B (*id.*) and therefore “would be transparent to users, and a user would not know that such access was indirect.” Yet, this assertion falsely and without support equivocates “indirect” with “transparent,” and neither term (let alone the

claimed concept) is expressly or inherently described in Hinton.⁵

Thus, Ground 1 also fails due to missed and incorrect mappings for 1[f].

c. Several additional claim features of Claim 1 are not disclosed by Hinton

In addition to the features discussed above in connection with 1[i] and 1[f], the Petition fails to properly map several other Claim 1 elements and limitations. For instance, Petitioner provides unclear, incorrect, and missed mappings of the claimed “*new authentication request*,” “*new authentication response*,” and “*other services external or internal to the identity service*” recited in 1[d]. See Petition, 18-20; see also, Ex. 1003, ¶¶78-81. For the “*new authentication response*,” the Petition relies on a POSITA’s understanding in equivocating this feature to Hinton’s “token” from trust proxy 414, discussed in Hinton at ¶[0156]. See Petition, 19 (“[a] POSITA would have further understood that the token itself serves as the new authentication response”). After that, Petitioner shifts the argument to allege that both the claimed “*new authentication request*” and “*new authentication response*” are Hinton’s “token.” *Id.* (“it would have been obvious to a POSITA that the token could serve as both a new authentication request and a new authentication response”). Yet,

⁵ Notably, Petitioner makes no argument to either express or inherent disclosure of “indirectly” or “transparently” by Hinton. Petition, 22.

neither of Petitioner's arguments demonstrate "each and every element as set forth in the claim is found . . . in a single prior art reference." *See* MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987). And furthermore, the Petition's entire argument for 1[d] completely neglects any showing of what the "other services external or internal to the identity service" map to in Hinton. 1[d] illustrates yet another failure of Ground 1.

Thus, Hinton cannot and does not anticipate Claim 1.

2. Independent Claim 8

The Petition's fatal anticipation defects for Claim 1 reoccur for Claim 8, except even more egregious. For this claim, the Petition and Petitioner's expert's declaration make no showing from the Hinton disclosure for six⁶ of the eleven parsed claim elements 8[a] to 8[k], i.e., no reliance on or citation to Hinton for 8[d]-8[g] and 8[j]-8[k]. *See* Petition, 31-35; *see also*, Ex. 1003, ¶¶106-117, which parrots the Petition nearly verbatim. Instead, Petitioner resorts to what "a POSITA would have understood" (Petition, 31-35) or, worse, what "would have been obvious to a POSITA" (Petition, 33)—both flunking the anticipation standard.

⁶ Petitioner's discussion in 8[a] to 8[k] cites to Hinton's disclosure only for 8[a], 8[b], 8[c], 8[h], and 8[i], which only includes citations to FIG. 4, ¶[0125], ¶[0139], ¶[0156], and ¶[0157] of Hinton.

a. Hinton does not disclose the claimed “*instruction ... represented in the authentication response*” feature in 8[g] of Claim 8

Hinton does not disclose the claimed features in 8[g] of “*detecting, by a machine and from an identity service, an instruction, which is represented in the authentication response.*” Ex. 2012, ¶¶63, ¶¶66. Petitioner’s terse discussion of this feature falsely states “Hinton discloses ... the single-sign-on token[] acts as an instruction to Enterprise B POC/TP” (Petition, 33) despite Hinton’s disclosure making no such statement whether expressly or implicitly. *Id.*, ¶¶64-65. Moreover, the Petition does not back up this mischaracterization, as there is not a single citation to Hinton in 8[g]. And to the extent Petitioner is relying on its parallel assertion that “it would have been obvious to a POSITA” that Hinton’s single-sign-on token acts as an “*instruction*” (which Patent Owner adamantly refutes in the next section, *see infra* **Section V.A.2**), that assertion is plainly deficient in establishing anticipation by Hinton under 35 U.S.C. § 102.

b. Hinton does not disclose the claimed “*transparent*” features in 8[c] and 8[j] of Claim 8

Hinton does not disclose the claimed “*transparent*” features in 8[c] and 8[j], namely “*actions of that original identity service are transparent to the principal*” in 8[c] and “*access to the target services occur ... transparent to the principal*” in 8[j]. For 8[c], Petitioner again ignores Hinton’s disclosure and impermissibly relies

on what a “POSITA would have understood” without any justification or support from Hinton. Petition, 32. For 8[j], the Petition refers to its prior faulty, unsupported comments for 1[f] of Claim 1 that “Hinton discloses and/or renders obvious” that the POC/TP of Enterprise B would be transparent to users based solely—not on Hinton’s disclosure—but on what Petitioner presumes a POSITA would have understood without any underpinning for this presumption in any reference. *See* Petition, 35 (referring to 1[f] of Petition at p. 22, which cites no references). *See also* Ex. 2003, ¶116 (similarly referring to prior discussion for 1[f] at ¶¶84-85 of Dr. Almeroth’s declaration, also citing no references to support his analysis).

Thus, Hinton cannot and does not anticipate Claim 8.

3. Dependent Claims 2-4, 6, 7, 9-11, and 13 Are Not Anticipated By Hinton For At Least the Same Reasons as Claim 1

For at least the reasons articulated above for independent Claims 1 and 8, dependent Claims 2-4, 6, 7, 9-11, and 13 are also novel over Hinton.

V. GROUND 2: HINTON DOES NOT RENDER THE CHALLENGED CLAIMS OBVIOUS

A. Independent Claims 1 And 8 Recite Nonobvious Methods Which Are Completely Different Than Hinton

In the Petition’s confounding hybrid Ground 1-2, Petitioner asserts the Challenged Claims are rendered obvious by Hinton alone under (pre-AIA) 35 U.S.C. § 103. This is far from correct, as Petitioner fails to show each claimed feature in

the Hinton reference and fails to provide an articulated reasoning for why the claimed feature and claim as a whole are obvious. *See KSR International Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007), holding a determination of unpatentability on a ground of obviousness must include “articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Also see In re Kahn*, 441 F.3d 977, 986 (Fed. Cir. 2006), “mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole.”

Not only Ground 2 fails to satisfy the legal standard of obviousness (discussed later in **Section VII**), the Petition does not *attempt* to identify each claim element and its limitation(s) in the prior art.

- 1. Hinton does not disclose, teach, suggest, or render obvious the claimed “*determination as to whether to use a single interaction or multiple interactions for authentication of the principal to the other services is automatically communicated in the new authentication response*” in 1[i] of Claim 1**

As explained above in **Section IV.B.1.a**, the claimed “*determination*” in 1[i] is made by the “*machine*” implementing the claimed method of Claim 1. This “*determination*” therefore is not made by “*identity service*,” which Petitioner repeatedly describes is akin to Hinton’s POC/TP of Enterprise B. *See supra Section IV.B.1*. This is evident from at least Claim 1’s recitation that the “*machine*”

“supply[the] authentication message for use by [the] identity service.” Ex. 1001, 11:47-48.

With it clearly established that the “*machine*”—not the “*identity service*”—makes the “*determination*” in 1[i], Petitioner’s obviousness assertion necessarily fails because Petitioner’s entire explanation is based on the accusation that Hinton’s POC/TP of Enterprise B makes the determination and thus the claim feature is obvious. Petition, 26 (“[t]he POC/TP of Enterprise B determines whether one interaction or two interactions is required based upon the received single sign-on token,)”

Irrespective of whether Hinton’s POC/TP of Enterprise B determines if one or two interactions is required, Hinton does not disclose, teach, suggest, or otherwise render obvious the claimed “*determination*” feature in 1[i] because this feature and its limitations are attributed to the “*machine*” (that Petitioner maps to POC/TP of Enterprise A in 1[a]) and not the “*identity service*” (that Petitioner maps to POC/TP of Enterprise B throughout the Petition). Petitioner makes no showing why this profound distinction could still render the claim as a whole obvious because no such assertion could be made—the identity services of the ’426 patent are fundamentally different. Ex. 2012, ¶¶72-73.

For at least these reasons, Claim 1 is patentable over Hinton.

2. Hinton does not disclose, teach, suggest, or render obvious the claimed “detecting, by a machine and from an identity service, an instruction, which is represented in the authentication response” in 8[g] of Claim 8

As discussed above in **Section IV.B.2.a**, the claimed “*instruction*” in 8[g] is clearly not disclosed, taught, suggested or implied in Hinton. And it is not obvious either because the claimed “*instruction*” and “*authentication response*,” within which the “*instruction*” is “*represented*” as recited in Claim 8, are not the same as or similar to Hinton’s singular “federated single-sign-on token” that Petitioner maps to both claimed features. *See* Petition, 33 for 8[g] (“the single-sign-on token, which acts as an instruction to Enterprise B POC/TP”); *also see id.* for 8[e] (“the “federation single-sign-on token” (authentication response)”). Petitioner further maps Hinton’s federated single-sign-on token to the claimed “*authentication request*” too—thereby equivocating this single, individual token to three distinct claim features. *Id.*, 31 (“this token would include a new authentication request and authentication response as a single-sign-on transaction”). Hinton’s token cannot serve as the claimed “*instruction*,” “*authentication response*,” and “*authentication request*.” Ex. 2012, ¶¶75-76.

Hinton’s “federated single-sign-on token” is not a versatile construct that the Petition attempts to portray. It is an authentication token, which Hinton describes can be a Kerberos token, i.e., a digital credential, in some examples. *See* Ex. 1004,

¶[0062]. Particularly, Hinton teaches that this authentication token is produced by POC/TP of Enterprise A and serves to communicate to Enterprise B that the user is trusted. *See* Ex. 1004, FIG. 4 (reproduced and annotated below) and ¶[0156]⁷. Trust proxy 414 first generates the federated single-sign-on token and provides it to POC server 412 of Enterprise A, which *sends the token with the user's request* to domain 420 (Enterprise B). *See id.* Enterprise B's POC server 422 receives the token and provides it to trust proxy 424, which simply validates it (or not) and subsequently generates a new token for a validated user. *Id.*, ¶[0157]⁸.

⁷ “Point-of-contact server 412 sends a request to trust proxy 414 to generated (*sic*) a federation single-sign-on token for the user that is formatted to be understood or trusted by domain 420.” Ex. 1004, ¶[0156].

⁸ “Point-of-contact server 422 receives the request together with the federation single-sign-on token and invokes trust proxy 424. Trust proxy 424 receives the federation single-sign-on token, validates the token, and assuming that the token is valid and trusted, generates a locally valid token for the user.” Ex. 1004, ¶[0157].

Hinton, FIG. 4
(annotated by Patent Owner based on description of ¶¶[0156]-[0157])

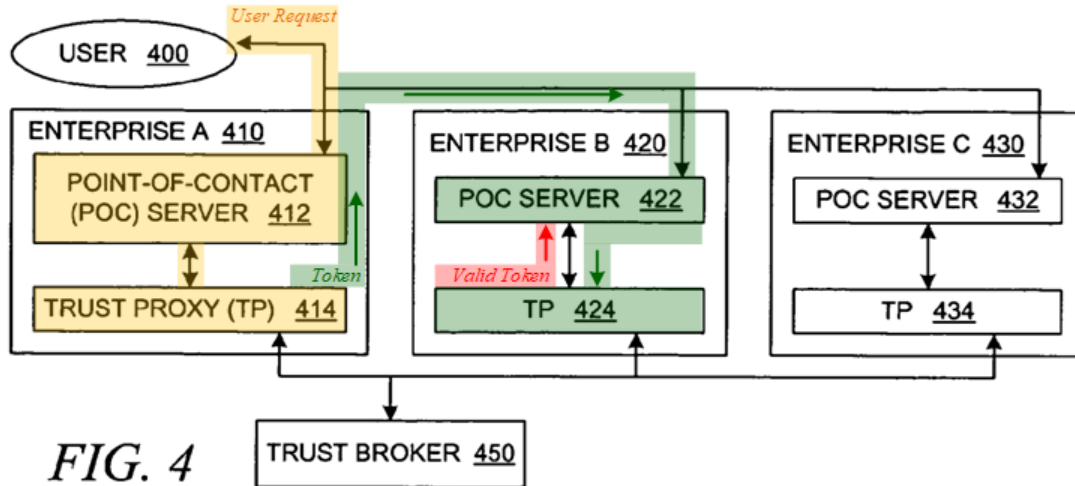


FIG. 4

Contrary to Petitioner's assertion, the token itself is not an "instruction" and does not act as an "instruction" in the manner recited in Claim 8 or its dependent claims. Claim 8's "instruction" is part of the "authentication response" and can be "an assertion ... that the principal is currently already authenticated to the identity service" (see Ex. 1001, dependent Claim 9 at 13:4-7) or can be "an identity service request ... to independently authenticate the principal" (see Ex. 1001, dependent Claim 9 at 13:13-16). The claimed "instruction" of Claim 8 is a distinct construct that is not exclusively an "authentication response" as claimed and certainly **not both** an "authentication response" **and** "authentication request" as claimed. As such, Petitioner did not make a showing of the 8[g] claimed features in Hinton.

Accordingly, Petitioner's overly expansive and unsupported assertion that Hinton's token renders the claimed "*instruction*" and "*authentication response*" features of 8[g] obvious is unfounded. Claim 8 is therefore patentable over Hinton.

Thus, Ground 2 thereby fails.

VI. GROUND 3: THE COMBINATION OF HINTON AND BURCH DOES NOT RENDER THE CHALLENGED CLAIMS OBVIOUS

A. Ground 3 Necessarily Fails Because Burch Cannot Preclude Patentability Of The '426 Patent Under Pre-AIA 35 U.S.C. § 103(c)

Ground 3 relies on Burch in its combination with Hinton for its other obviousness ground. However, Ground 3 of the Petition necessarily fails because Burch does not qualify as prior art for assertion of invalidity under § 103.

The Petition asserts Burch *qualifies* as prior art under pre-AIA 35 U.S.C. § 102(e). *See* Petition, 12 (“[Burch] is prior art to the '426 patent under at least 35 U.S.C. §102(e).”). However, the Petition ignored the statutory exception of § 102(e) prior art “owned by the same person or subject to an obligation of assignment to the same person” under pre-AIA 35 U.S.C. § 103(c).⁹

⁹ “Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102, shall not preclude patentability under this section where the subject matter and the claimed invention

Here, both Burch and the invention claimed in the '426 patent were owned by the same person, Novell Inc., at the time when the claimed invention was made. Burch is a publication of U.S. Patent Application No. 11/395,725 (“’725 Burch Application”) filed on March 31, 2006 and published as US 2007/0234408 A1 on October 4, 2007. Ex. 1005, 2 (Burch’s cover sheet). The ’725 Burch Application lists co-inventors **Lloyd Leon Burch** and Stephen R. Carter, who both assigned their rights in the ’725 Burch Application to assignee Novell, Inc. on March 30, 2006. *See* Ex. 2009, 3-4.

The ’426 patent stems from U.S. Patent Application No. 11/444,944 (“’944 Application”) filed on June 1, 2006. Ex. 1001, 2 (’426 patent cover sheet). The ’944 Application lists co-inventors Stephen Hugh Kinser, **Lloyd Leon Burch**, and Cameron Craig Morris, who each assigned their rights in the ’944 Application to assignee Novell, Inc. on either May 30, 2006 or June 1, 2006. *See* Ex. 2010, 3-5. The assignment of the ’944 Application to Novell, Inc. was recorded with USPTO on June 1, 2006, evidenced by the annotated footer noting the date and reel/frame number 017947/0326 on the assignment (*id.*, 5), as well as by the Patent Office’s

were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.” Pre-AIA 35 U.S.C. § 103(c)(1).

Assignment Center database.¹⁰ The recordation date, June 1, 2006, is the filing date of the '426 patent. *See* Ex. 1001, 1 ('426 patent cover sheet).

As demonstrated by the evidence, the “same person,” Novell, Inc., owned both the subject matter of the Burch reference and the claimed invention of the '426 patent on June 1, 2006, when the claimed invention was made. Therefore, Burch does not qualify as prior art for assertion of obviousness under § 103, and thus Ground 3 of the Petition necessarily fails.

VII. PETITION FAILS TO MEET MULTIPLE LEGAL REQUIREMENTS OF UNPATENTABILITY

A. The Grounds Fail To Delineate Between § 102 And § 103 Arguments Or Properly Assert Either Category

Grounds 1 and 2 of the Petition assert unpatentability under the anticipation standard of § 102 and the obviousness standard of § 103, respectively, but are presented together in a manner that fails to fully or clearly articulate either theory, particularly for independent Claims 1 and 8 of the '426 patent. *See* Petition, 12 (“VI. Grounds 1 and 2 – Claims 1-4, 6-11, 13 are anticipated by Hinton and Claims 1-13 are rendered obvious by Hinton alone”). Due to this lack of clarity, the grounds of

¹⁰ <https://assignmentcenter.uspto.gov/search/patent/abstract%3FapplicationNumber%3D11444944>

the Petition are substantively deficient and noncompliant with 35 U.S.C. § 312(a)(3),¹¹ thereby favoring dismissal of the Petition.

First, it is unclear whether the Petition intends to raise both § 102 and § 103 arguments. Within this combined hetero-ground, the Petition uses boilerplate language to imply—but not specify—both anticipation and obviousness theories for the parsed claim elements, e.g., for element 1[b]: “Hinton discloses” and/or “it would have been obvious to a POSITA.” *Id.*, 17. Yet, for anticipation under § 102, Petitioner fails to map **each element and limitation** of the claim to the disclosures in the cited prior art reference, i.e., Hinton, so any § 102 argument fails from the start. And, for obviousness under § 103, not only does Petitioner fail to show the requisite teaching or suggestion in the prior art of each claimed feature, Petitioner fails to explain any reasoning for why any claim would be obvious within the framework for objective analysis articulated in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and reiterated in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398

¹¹ 35 U.S. Code § 312(a) Requirements of Petition.—A petition filed under section 311 ***may be considered only if***— . . . (3) the petition identifies, in writing ***and with particularity***, each claim challenged, ***the grounds on which the challenge to each claim is based***, and the evidence that supports the grounds for the challenge to each claim, . . . (emphasis added)

(2007). The court has “repeatedly emphasized that an obviousness inquiry requires examination of all four *Graham* factors and that an obviousness determination can be made only after consideration of each factor.” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016).

Here, for every claim element of the challenged claims, the Petition lacks any articulation of the second *Graham* factor (ascertaining the differences between the claimed invention and the prior art). While arguing such differences risks undercutting one’s anticipation arguments, Petitioner in this case chose to avoid taking the risk at the expense of ignoring the legal standard of obviousness.

The improper ground not only requires Patent Owner to respond to multiple incomplete arguments but also would impel the Board, if the Petition is instituted, to analyze multiple unarticulated invalidity grounds under multiple legal standards. Furthermore, gaps in Petitioner’s claim mapping (discussed in **Section IV.B**) raise doubts that any § 102 argument was made in good faith. Yet Patent Owner is forced to respond to both anticipation and obviousness arguments, despite neither theory being sufficiently explained for Patent Owner to appropriately rebut. Petitioner has improperly shifted the burden to the Board and to Patent Owner, which warrants dismissal of the Petition for its lack of merit in establishing a “reasonable likelihood” of its invalidity challenges to prevail on §§ 102 and 103 grounds. Institution is thus not warranted under 35 U.S.C. § 314.

B. Petitioner Improperly Relies On POSITA Knowledge Instead Of Disclosure Or Teaching In The Prior Art Reference

On July 31, 2025, the Director's office issued a memorandum (the "July Memorandum") putting all practitioners on notice that the Office "will enforce and no longer waive the requirement of 37 C.F.R. § 42.104(b)(4) (Rule 104(b)(4)) that a petition for inter partes review (IPR) "must specify where each element of the claim is found in the prior art patents or printed publications relied upon" and prohibiting reliance on "applicant admitted prior art (AAPA), expert testimony, common sense, and other evidence that is not "prior art consisting of patents or printed publications" ... to supply a missing claim limitation." July Memorandum, 1. The July Memorandum makes clear that reliance on a "general knowledge," such as by a POSITA, to fill in missing claim limitations from prior art reference(s) was impermissible and is limited to supporting motivation to combine and demonstrating the knowledge of a POSITA. *Id.*, 1-2. This change applies to any petition filed on or after September 1, 2025 (*id.*, 3) and, thus, applies to the instant Petition.

Petitioner disregarded the Director's instructions. The Petition impermissibly relies on the knowledge of a POSITA to substitute for missing '426 patent claim limitations in the cited references, namely Hinton. Particularly, the Petition fails to show that Hinton discloses, teaches, or suggests multiple claim elements and limitations in Claim 1, including but not limited to 1[i], 1[f], and 1[d] (discussed

above in **Sections IV.B.1 and V.A.1**).

For 1[f], the Petition does not provide any mapping in Hinton's disclosure for the claimed "*the principal's access sessions occur ... transparently to the principal.*" Instead, Petitioner relies solely on a POSITA to substitute for Hinton's silence on this feature, stating "[a] POSITA would have further understood that, in the context of Hinton, Enterprise B POC/TP would be transparent to users, and a user would not know that such access was indirect," citing Petitioner's expert's declaration at ¶85. Petition, 22. Importantly, neither the Petition nor Petitioner's expert's declaration make a single citation to Hinton. *See id.*; *see also* Ex. 1003, ¶¶84-85. As such, Petitioner makes no showing of what in Hinton corresponds to transparently-occurring access sessions for the principal. The July Memorandum was clear that failures like this cannot be covered up by reliance on a POSITA knowledge.

The same problem occurs in 1[d]. Earlier in the ground, Petitioner maps the claimed "*authentication message*" introduced in 1[c] to Hinton's teaching of a "federation single-sign-on token ...that is formatted to be understood or trusted." Petition at 17. The claimed "*authentication message*" is recited in 1[d] as "*serv[ing] as a new authentication request and as a new authentication response for single sign-on access of the principal.*" Petitioner maps nothing in Hinton's disclosure to the "*new authentication request*" and the "*new authentication response*" for the principal's single sign-on access. *See id.*, 18-19.

Instead and impermissibly, Petitioner substitutes a POSITA's knowledge for the missing limitations in Hinton, explaining first "[a] POSITA would have understood that the user's request to the POC/TP of Enterprise A is a first request and the subsequent request from the POC/TP of Enterprise A sent to the POC/TP of Enterprise B would be a new, different message." *Id.*, 18. Putting aside that this explanation is unclear, the Petition provides no support in Hinton to substantiate this assumption of what a POSITA would understand. *See id.*, 18-19, notably citing only to Petitioner's expert's declaration at ¶¶78-79, which just parrots the Petition. Ex. 1003, ¶¶78-79.

Then, the Petition states "[a] POSITA would have further understood that the token itself serves as the new authentication response." Petition, 19. Again, Petitioner fails to point to any disclosure in Hinton to support these suppositions about a POSITA's knowledge, and the Petition's citations to the expert declaration do not compensate in any way since the expert also pointed to nothing in Hinton. *See* Ex. 1003, ¶¶80-81. In fact, the Petition goes so far to even expressly state that it is "using that general knowledge [of a POSITA about] authentication messages." Petition, 19.

Like 1[f], Petitioner fails to map the claimed limitations of 1[d] to anything other than what Petitioner claims a POSITA would understand. And in 8[g] (as discussed above in **Section IV.B.2**), the totality of Petitioner's argument is based on

a POSITA's knowledge without any showing of the claimed "*instruction*" in Hinton reference. This also applies to other claim elements in Claim 8, i.e., sole reliance on a POSITA's understanding instead of Hinton's disclosure, such as for 8[c], 8[e], and 8[i]. *See* Petition, 32-33, 35; *see also*, Ex. 1003, ¶¶108, 110, 115. This cannot stand.

Petitioner's disregard for Rule 104(b)(4) should not be disregarded and warrants denial of the Petition for IPR.

VIII. CONCLUSION

For the reasons discussed above, Patent Owner respectfully requests that the Director deny Petitioner's Petition for *Inter Partes* Review of the '426 patent.

Dated: January 9, 2026

Respectfully submitted,

/Babak Tehranchi/

Lead Counsel

Babak Tehranchi, Reg. No. 55,937

PERKINS COIE LLP
11452 El Camino Real, Ste. 300
San Diego, CA 92130

Back-Up Counsel

Fareid Asphahani, Reg. No. 72,217

Kyle Canavera, Reg. No. 72,167

Thomas Millikan, Reg. No. 72,316

Ashlee Sherman, (To be admitted – *Pro Hac Vice*)

Attorneys for Netskope, Inc.

CERTIFICATE OF WORD COUNT UNDER 37 CFR § 42.24(d)

Under 37 C.F.R. § 42.24(d), the undersigned certifies that the word count for this Patent Owner's Preliminary Response to the Petition for *inter partes* review totals 5,921 words, excluding the parts exempted by 37 C.F.R. § 42.24(a). The word count was made using the built-in word count function in the Microsoft® Word software used to prepare this document.

Dated: January 9, 2026

Respectfully submitted,

/Babak Tehranchi/

Lead Counsel
Babak Tehranchi, Reg. No. 55,937

PERKINS COIE LLP
11452 El Camino Real, Ste. 300
San Diego, CA 92130

Back-Up Counsel
Fareid Asphahani, Reg. No. 72,217
Kyle Canavera, Reg. No. 72,167
Thomas Millikan, Reg. No. 72,316
Ashlee Sherman, (To be admitted – *Pro Hac Vice*)

Attorneys for Netskope, Inc.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served a true and correct copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE and accompanying exhibit by email to the electronic service addresses for Petitioner on the date indicated below:

Andrew D. Gish (Reg. # 67,562)
andrew@gishpllc.com
Ryan Iwahashi (Reg. # 63,378)
ryan@gishpllc.com

Dated: January 9, 2026

Respectfully submitted,

PERKINS COIE LLP
1888 Century Park East, 17th Floor
Los Angeles, CA 90067

/Anita Chou/
Anita Chou
Patent Paralegal