

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETSKOPE, INC.,
Petitioner,

v.

BITGLASS, INC.,
Patent Owner.

IPR2021-01046
Patent 10,757,090 B2

Before JAMES J. MAYBERRY, KEVIN C. TROCK, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

TROCK, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

A. *Background*

Netskope, Inc. (“Petitioner”) filed a petition (Paper 2, “Pet.” or “Petition”) to institute an *inter partes* review of claims 17–21 and 24 (the “challenged claims”) of U.S. Patent No. 10,757,090 B2 (Ex. 1001, “the ’090 patent”). Bitglass, Inc. (“Patent Owner”) timely filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

An *inter partes* review may not be instituted “unless . . . there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). As part of this analysis, we may consider whether Petitioner has filed more than one petition directed to the ’090 patent. For the reasons discussed below, we determine that Petitioner has not justified an additional petition directed to the ’090 patent. Accordingly, we exercise our discretion under § 314(a) and do not institute an *inter partes* review in this case.

B. *Real Party in Interest*

Petitioner identifies itself, Netskope, Inc., as the only real party-in-interest. Pet. 1. Patent Owner identifies itself, Bitglass, Inc., as the only real party in interest. Paper 4, 2.

C. *Related Matters*

According to the parties, the ’090 patent is the subject of the following action: *Netskope, Inc. v. Bitglass, Inc.*, No. 3:21-cv-00916 (N.D. Cal.). Pet. 2; Paper 4, 2.

The parties also acknowledge that Petitioner has filed another petition (IPR2021-01045) challenging claims 1–5, 8–13, and 16 of the ’090 patent. Pet. 2; Paper 4, 2.

Further, the parties identify a continuation of the '090 patent (U.S. Patent No. 10,855,671 B2, “the '671 patent”) and further acknowledge that Petitioner has filed two petitions (PGR2021-00091 and PGR2021-00092) challenging claims of the '671 patent. Pet. 2; Paper 4, 2.

D. The '090 Patent (Ex. 1001)

The '090 patent relates, in relevant part, to providing secure user access to applications which are hosted by a remote server, e.g., “cloud applications.” Ex. 1001, 2:28–29, 5:61–62, 6:23–24; *see id.* 3:5–9. In particular, the '090 patent describes using network proxies to route user access requests and provide secure access. *See id.* at 5:60–6:22. Figure 3b of the ‘090 patent is reproduced below.

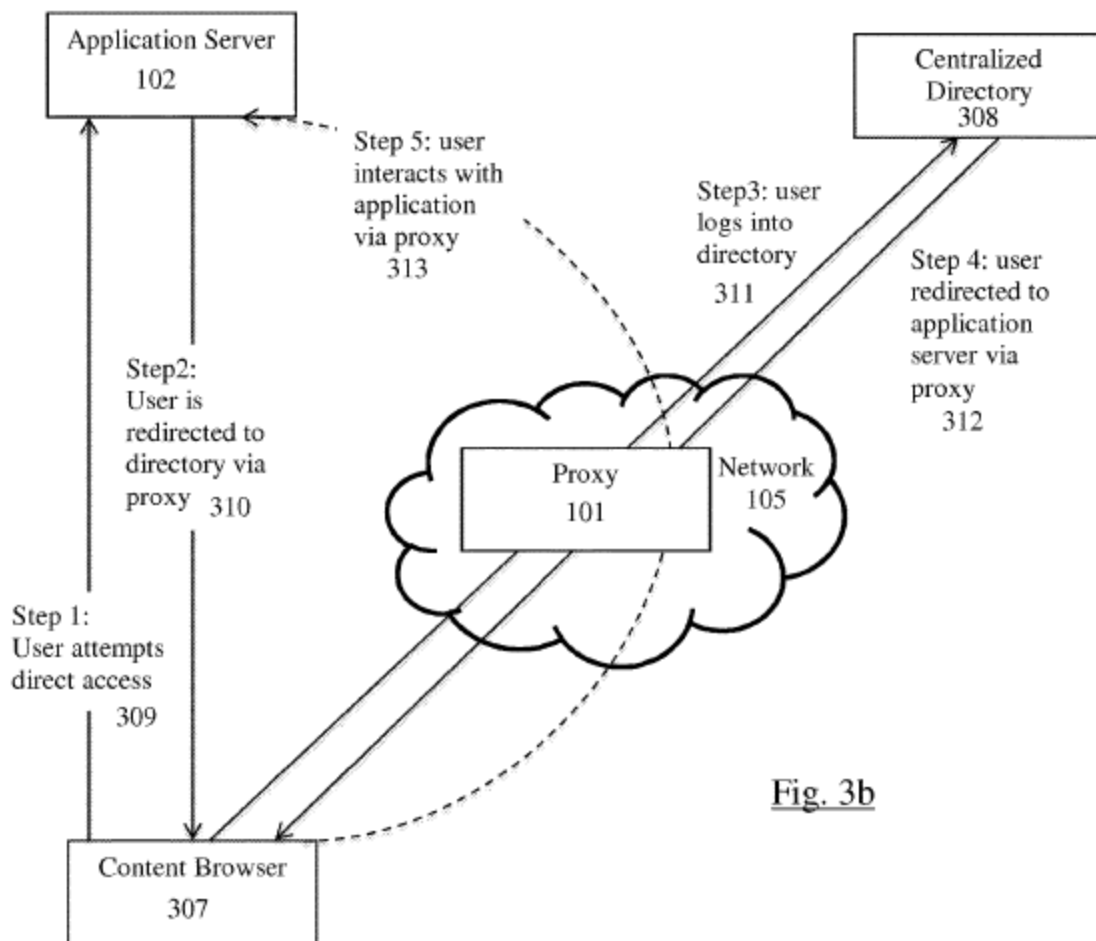


Fig. 3b

Figure 3b, above, shows a network having a proxy that enables a user's content browser access to an application hosted on an application server. *Id.* at 2:5–6, 6:23–24. In order to access an application hosted on an application server, a user must first login. *Id.* at 6:4–5, 6:23–24. In step 1, “a user attempts access 309 to the application [hosted on the application server] 102 via a content browser 307.” *Id.* at 6:23–24. In step 2, “application server 102 may redirect 310 the [access] request to point to the centralized directory 308 via the proxy 101.” *Id.* at 6:25–26. In step 3, centralized directory 308 receives the user's login credentials and performs a login process. *Id.* at 6:12–17, 6:26–28. After a successful login, the user's content browser 307 is directed to the application server 102 by the proxy 101 and the user's content browser 307 then interacts with the application hosted on application server 102. *Id.* at 6:28–39. As described above, proxy 101 “broker[s] all authentication requests and manipul[at]es the requests and responses” to provide access to resources. *Id.* at 6:39–41.

In another embodiment in which a proxy helps manage user content requests and security, a Security Assertion Markup Language (SAML) proxy is used to provide a user secure access to an application provided by an application provider. *Id.* at 2:23–24, 6:44–51. Figure 11 of the '090 patent is reproduced below.

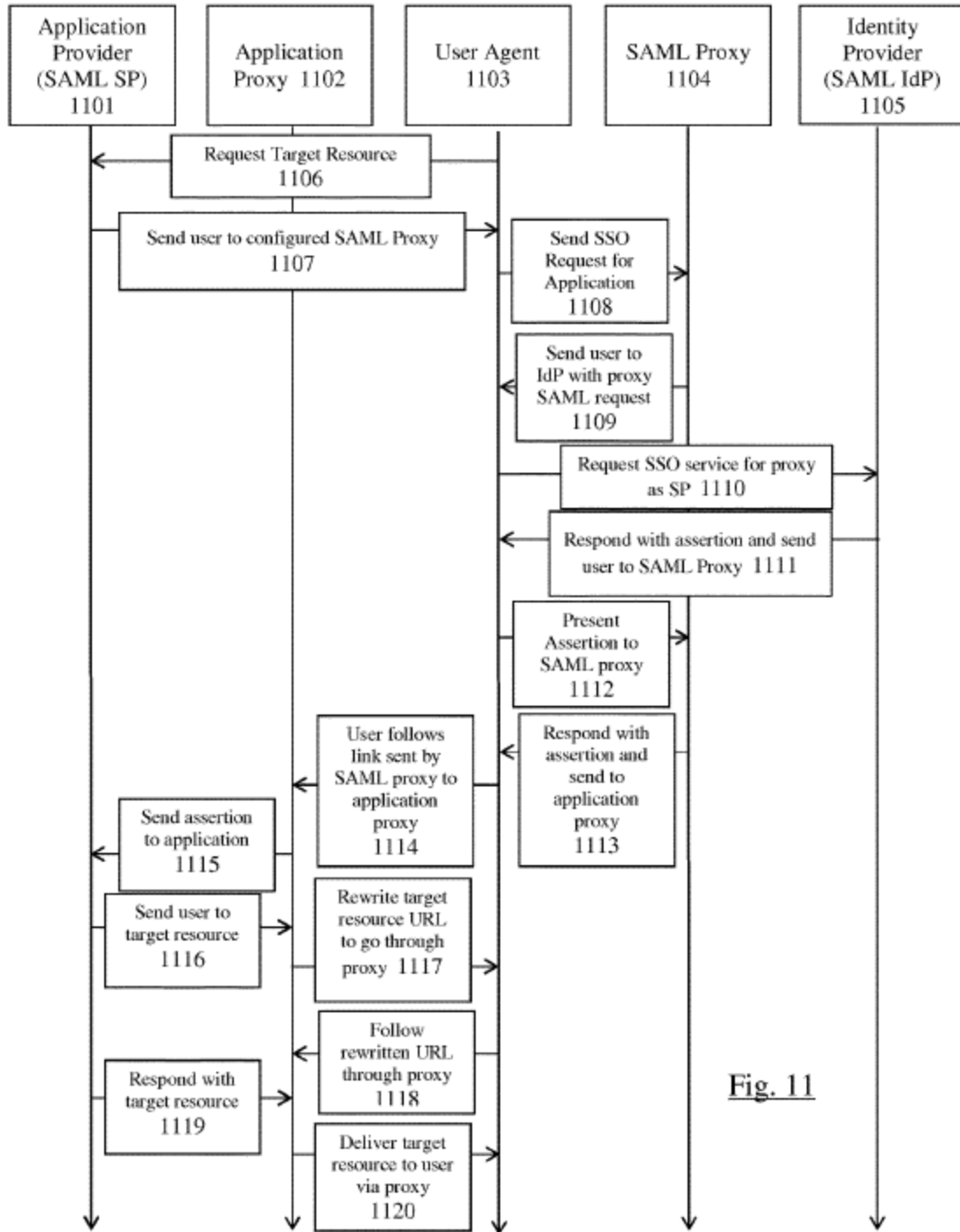


Fig. 11

Figure 11, above, depicts a flow diagram showing communication sequences and data exchanges between a SAML proxy and various “entities.” *Id.* at 2:23–24, 6:44–49. As shown in Figure 11, in order to provide users access to resources, a series of communication sequences and

data exchanges occur between SAML proxy 1104, application provider/application 1101, application proxy 1102, user agent 1103, and identity provider (IdP) 1105. *Id.* at 6:49–52. First, in block 1106, user agent 1103 sends a request to application provider 1101 for a target resource provided by application provider 1101. *Id.* at 7:4–5. In response, in block 1107, application provider 1101 directs user agent 1103 to SAML proxy 1104, and, in block 1108, “user agent 1103 sends a single sign on (SSO) request for the application” to SAML proxy 1104. *Id.* at 7:5–9. In block 1109, SAML proxy 1104 receives the SSO request and directs user agent 1103 to IdP 1105 so that, in block 1110, user agent 1103 sends an SSO request to IdP 1105. *Id.* at 7:9–13. Next, in block 1111, IdP 1105 validates and authenticates the SSO request and provides user agent 1103 “an assertion of a valid SSO . . . for the SAML proxy.” *Id.* at 6:58–59, 7:13–15. Following that, in block 1112, user agent 1103 sends the assertion to SAML proxy 1104 so that, in block 1113, SAML proxy 1104 creates an assertion for application proxy 1102 and sends that assertion and the location of application proxy 1102 (e.g., an IP address) to user agent 1103. *Id.* at 7:15–19. Having the assertion and location of application proxy 1102, user agent 1103 receives the target resource via application proxy 110. *See id.* at 7:20–38.

In the embodiment of Figure 11, as shown in blocks 1114–1120, user agent 1103 accesses the resources of application provider 1101 using application proxy 1102 as an intermediary. *See id.* However, user agent 1103 may also access application provider 1101 directly. In the case that “application proxy 1102 goes down or its functionality deteriorates . . . SAML proxy 1104 routes the user directly to the application 1101,

bypassing the application proxy 1102” in order to provide “failover” protection. *Id.* at 6:64–7:1.

E. Challenged Claims

Petitioner challenges claims 17–21 and 24 of the ’090 patent. Pet. 1. Claim 17 is an independent claim and is reproduced below.

- 17[pre] A system that improves secure access to application programs, comprising:
- 17[a] a proxy server, the proxy server configured to authenticate computer security validation requests for application programs;
- 17[b] an application proxy server, the application proxy server directs all accesses to application programs from an application service provider to itself;
- 17[c][i] a device request receiver, implemented at least partially in hardware at the proxy server, that receives from a device a single-sign-on request for access to an application program,
- 17[c][ii] the device directed by the application proxy server to a cloud network location of the proxy server;
- 17[d][i] a device redirector, implemented at least partially in hardware at the proxy server, that directs the device to an identity provider by sending the device a network location of the identity provider,
- 17[d][ii] the identity provider configured to authenticate computer security validation requests for the proxy server,
- 17[d][iii] the device communicates directly with the identity provider using the network location of the identity provider,
- 17[d][iv] the identity provider redirects the device to the cloud network location of the proxy server with a single-sign-on validation after validation of the single-sign-on request;

- 17[e] wherein the device request receiver receives the single-sign-on validation from the device;
- 17[f] an assertion generator, implemented at least partially in hardware at the proxy server, that creates a valid identification assertion;
- 17[g][i] wherein the device redirector directs the device to the application proxy server by sending the device a network location of the application proxy server and the valid identification assertion,
- 17[g][ii] the device communicates directly with the application server using the network location of the application server and the valid identification assertion,
- 17[g][iii] the device thereafter communicates directly with the application proxy server for subsequent accesses to the application program.

Ex. 1001, 16:22–60 (bracketed labeling designated by Petitioner; see Pet. 23–43).

F. Evidence

Petitioner relies upon the following evidence:

- (1) U.S. Patent Application Publication No. US 2015/0319156 A1, published November 5, 2015 (“Guccione”) (Ex. 1004);
- (2) Jill Gemmill *et al.*, *Cross-domain Authorization for Federated Virtual Organizations Using the myVocs Collaboration Environment*, Concurrency and Computation: Practice and Experience (2008) (“Gemmill”) (Ex. 1005);
- (3) U.S. Patent Application Publication No. US 2012/0278872 A1, published November 1, 2012 (“Woelfel”) (Ex. 1006);
- (4) WIPO Publication No. WO 2005/069823 A2, published August 4, 2005 (“Song”) (Ex. 1007); and

(5) Declaration of Michael Franz, Ph.D. (Ex. 1002).

Patent Owner relies upon the Declaration of Seth James Nielson, Ph.D. (Ex. 2001).

G. Asserted Grounds of Unpatentability

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
17–21	103	Guccione, Woelfel
24	103	Guccione, Woelfel, Song
17–21	103	Gemmill, Woelfel
24	103	Gemmill, Woelfel, Song

Pet. 4.

II. ANALYSIS

A. Discretionary Denial under 35 U.S.C. § 314(a)

Patent Owner argues that institution should be denied “under 35 U.S.C. §§ 314(a) . . . given the Petitioner’s . . . filing of multiple petitions on the ’090 patent.” Prelim. Resp. 19. Because we determine that the circumstances here warrant discretionary denial of institution under § 314(a), this threshold issue is dispositive.

Under 35 U.S.C. § 314(a), we have discretion to deny institution of an *inter partes* review. *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion”); *cf. Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), a provision nearly identical to § 324(a) and governing *inter partes* review proceedings, “the PTO is permitted, but never compelled, to institute an IPR proceeding”).

The Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019)¹ (“TPG”) provides guidance on deciding whether to institute *inter partes* review. The TPG states that “one petition should be sufficient to challenge the claims of a patent in most situations.” TPG 59. The TPG explains that “[t]wo or more petitions filed against the same patent at or about the same time . . . may place a substantial and unnecessary burden on the Board and the patent owner and could raise fairness, timing, and efficiency concerns.” *Id.*

The TPG explicitly states that

if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions, identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).

Id. at 59–60 (footnote omitted).

Patent Owner argues that the “Petition should be denied because Petitioner has filed *multiple* . . . [p]etitions on the ‘090 patent . . . without explaining why multiple petitions are required.” Prelim. Resp. 1. Patent Owner argues that “Petitioner has engaged in a pattern of filing *multiple* petitions on each of Bitglass’s patents asserted against Petitioner in the district court.” Prelim. Resp. 2. Patent Owner asserts that Petitioner filed two IPR petitions on the ’090 patent on the same day without explaining why two petitions are necessary. *Id.* at 4. Indeed, the petition in IPR2021-

¹ Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

01045 was filed on June 7, 2021, and challenges the patentability of claims 1–5, 8–13, and 16 of the '090 patent, and the petition in IPR2021-01046 was also filed on June 7, 2021, and challenges the patentability of claims 17–21 and 24 of the '090 patent, with the same prior art being asserted in both cases. Pet. 4; *see* IPR2021-01045, Paper 2, 4. Patent Owner argues that because the “Petition is absolutely silent” on why multiple petitions are needed, the Petition should be denied. Prelim. Resp. 5.

The TPG explains that “the Board recognizes that there may be circumstances in which more than one petition may be necessary, including, for example, when the patent owner has asserted a large number of claims in litigation or when there is a dispute about priority date requiring arguments under multiple prior art references.” TPG 59.

Patent Owner, however, argues that it “has only asserted 18 claims from the '090 patent in the corresponding litigation, hardly a large number that would justify two petitions.” Prelim. Resp. 8. Patent Owner argues that “there is a substantial overlap of claim language of the asserted claims as reflected by the fact that Petitioner’s expert, Dr. Michael Franz, submitted a *single* declaration . . . and a large portion of his analysis for later claims referred back to his analysis to earlier claims.” *Id.* at 8.

Patent Owner concedes that “there is a priority issue raised by the Petition.” *Id.* at 17. Patent Owner argues, however, “Petitioner is not proposing alternate grounds based on the priority date of the patent claims.” *Id.* Patent Owner asserts that “Petitioner has circumvented the word count [limit] by splitting the claims of the '090 patent into two separate petitions, each petition having the exact same Grounds.” *Id.* at 18.

The petition in this case asserts that we “should institute the review of the '090 Patent notwithstanding [our] discretion under § 325(d),” but does

not discuss § 314(a) or why multiple petitions were filed challenging the claims of the '090 patent with the same prior art references. Pet. 91.

Petitioner, however, did submit a statement of additional relevant legal authority (Paper 9) regarding § 314(a) referencing five previous Board decisions:

1. *Platform Science, Inc. v. Omnitrac, LLC*, IPR2020-01518, Paper 14 at 15–18 (PTAB April 15, 2021) (“*Platform*”).
2. *Adobe Inc. v. Synkloud Technologies, LLC*, IPR2020-01392, Paper 8 at 8–10 (PTAB March 11, 2021) (“*Adobe*”).
3. *3Shape A/S et. al. v. Align Technology, Inc.*, IPR2020-01642, Paper 9 at 5–6 (PTAB May 10, 2021) (“*3Shape*”).
4. *Flex Logix Technologies, Inc. v. Venkat Konda*, IPR2020-00261, Paper 22 at 22–24 (PTAB Aug. 3, 2020) (“*Flex*”).
5. *Square, Inc. v. 4361423 Canada Inc.*, IPR2019-01653, Paper 9 at 48–51 (PTAB May 12, 2020) (“*Square*”).

Paper 9, 1.

In all five of the cases referenced above, the respective Petitioners followed the guidelines outlined in the TPG and filed a separate paper ranking the petitions and explaining the differences between them. See *Platform*, Paper 14 at 15–16 (petitioner challenged 37 claims because patent owner asserted all the claims in the parallel litigation so two petitions were required); *Adobe*, Paper 8 at 8; *3Shape*, Paper 9 at 5 (two petitions were reasonable given the length of the claims and the difference in scope of the independent claims, where each petition challenged one of the independent and associated dependent claims); *Flex*, Paper 22 at 23 (two petitions based on the same priority date were reasonable given the length of the claims and the complexity of the subject matter); *Square*, Paper 9 at 49 (two petitions

were reasonable where petitioner challenged all 42 claims of the patent because patent owner had not identified the specific asserted claims in the parallel litigation and the petitions asserted unique prior art combinations). In the present case, however, Petitioner did not follow guidelines, did not rank the petitions, did not explain the differences between the Petitions, and did not attempt to explain or justify the need for a second Petition challenging the claims of the '090 patent. *See generally*, Pet.

We agree with Patent Owner, that on this record, two petitions from Petitioner challenging the claims of the '090 patent are not warranted. First, as Patent Owner points out, and we have noted, Petitioner has not provided us with any explanation as to why multiple petitions are necessary, despite the guidance in the TPG. *See* TPG 59–61. As such, we are left with no justification for the two petitions from Petitioner to weigh against Patent Owner's arguments.

Second, we do not discern, based on our own review of the petitions, why one petition would not have been sufficient to challenge the claims of the '090 patent, given the substantial overlap in the subject matter of the claims. The '090 patent has three independent claims. Ex. 1001, 13:55–18:22. Claim 1 is written as a method claim, claim 9 is written to cover “[a] non-transitory computer readable medium” storing software instructions of the method of claim 1, and claim 17 is written as a system implementing the method of claim 1. *Id.* at 13:56–14:19, 14:65–15:30, 16:22–60. The claims depending from these independent claims recite similar subject matter. As Patent Owner argues, Dr. Franz's testimony is repetitive, often referencing analysis directed to claim 1 and its challenged dependent claims in analyzing claim 17 and its challenged dependent claims. *See* Prelim. Resp. 8–16.

We recognize that the petition raises a priority date issue, and Patent Owner concedes as much. *See* Pet. 16–19; Prelim. Resp. 17; TPG 59 (indicating a priority date dispute could justify multiple petitions). The petition, however, does not differentiate the petitions based on this issue—both petitions have identical grounds, most of which do not turn on a priority date issue. *See* Prelim. Resp. 17 (“[A]lthough there is a priority issue raised by the Petition, the Petitioner is not proposing alternate grounds based on the [different] priority date[s] of the patent claims. Both petitions raise the same grounds and have the same exact prior art combinations.” (footnote omitted)).

Thus, the particular circumstances of this proceeding do not warrant multiple petitions.

III. CONCLUSION

For the foregoing reasons, Petitioner has not demonstrated a need for multiple petitions to challenge the claims of the ’090 patent and we exercise our discretion under 35 U.S.C. § 314 to deny the petition requesting *inter partes* review in IPR2021-01046.

IV. ORDER

Accordingly, it is

ORDERED that an *inter partes* review is not instituted as to all challenged claims on the grounds raised in the petition.

IPR2021-01046
Patent 10,757,090 B2

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