

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NORTONLIFELOCK INC.,
Petitioner,

v.

KAJEET, INC.,
Patent Owner.

IPR2022-00001
Patent 8,667,559 B1

Before MEREDITH C. PETRAVICK, JULIET MITCHELL DIRBA, and
IFTIKHAR AHMED, *Administrative Patent Judges*.

PETRAVICK, *Administrative Patent Judge*.

DECISION
Granting Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. *Background and Summary*

NortonLifeLock Inc. filed a Petition to institute *inter partes* review of claims 1, 2, 5–15, 18–21, and 27–29 of U.S. Patent No. 8,667,559 B1 (Ex. 1001, “the ’559 patent”). Paper 1 (“Pet.”). Patent Owner Kajeet, Inc. filed a Preliminary Response. Paper 13 (“Prelim. Resp.”). We authorized and Petitioner filed a Preliminary Reply. Papers 15, 16 (“Prelim. Reply”). Patent Owner filed a Preliminary Sur-Reply. Paper 18 (“Sur-Reply”).

We have authority under 35 U.S.C. § 314, which provides that an *inter partes* review may not be instituted unless the information presented in the Petition shows that “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) (2018); *see also* 37 C.F.R. § 42.4(a) (2021) (“The Board institutes the trial on behalf of the Director.”).

After considering the Petition, the Preliminary Response, the Preliminary Reply, the Preliminary Sur-Reply, and the evidence of record, we institute an *inter partes* review as to all of the challenged claims of the ’559 patent on the grounds of unpatentability presented.

B. *Real Parties in Interest*

Petitioner indicates it is the real party-in-interest to this Petition. Pet. 1. Patent Owner indicates it “is the owner by assignment of all substantial interests” in the ’559 patent. Paper 3, 2.

C. *Related Matters*

The ’559 patent is the subject of litigation between Patent Owner and Petitioner in *Kajeet, Inc. v. NortonLifeLock Inc.*, Case No. 1:20-cv-01339-MN, pending in the United States District Court for the District of Delaware. Pet. 1; Paper 3, 2.

The parties also indicate the patent is or has been the subject of several other lawsuits in Delaware, Texas, and California. Pet. 1–2; Paper 3, 2.

D. The '559 Patent

The '559 patent is titled “Feature Management of a Communication Device” and directed to “the real-time management of a device, and more particularly to the establishment and enforcement of policies or rules associated with the feature or functions that may be performed with the device.” Ex. 1001, code (54), 1:47–50; *see also id.* at 4:11–12 (“[t]he present invention is directed to the real-time management of a device in general”).

Figure 2 of the '559 patent is reproduced below.

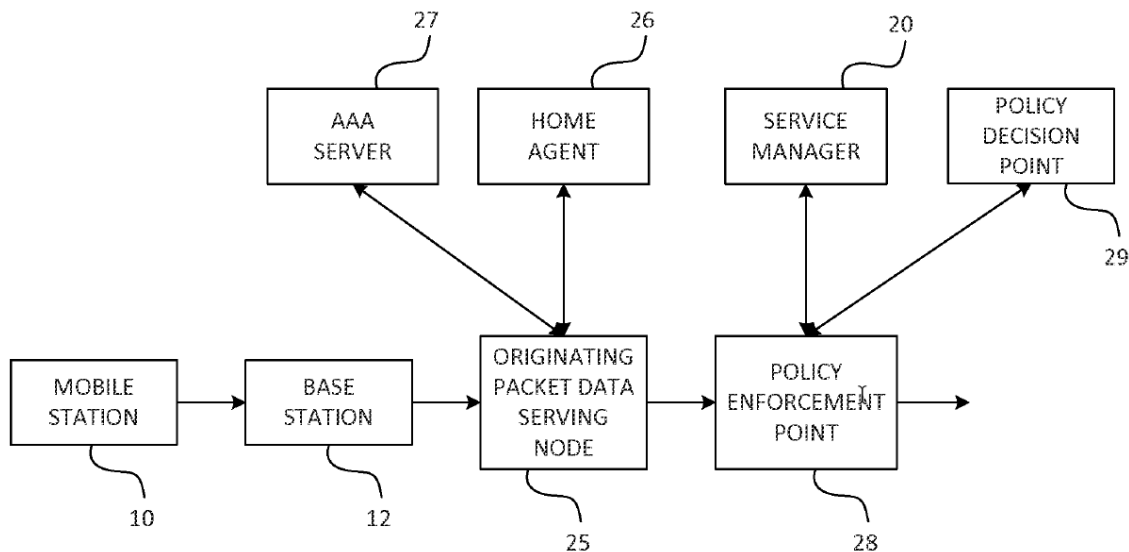


Figure 2 “is a flow chart illustrating the process of initiating a data session for a mobile device, checking the data policies associated with that device, and enforcing those data policies.” *Id.* at 3:65–67. Figure 2 depicts the components of the data service feature management system, including mobile station 10, originating packet data serving node (“O-PDSN”) 25,

policy enforcement point (“PEP”) 28, and policy decision point (“PDP”) 29. *Id.* at 8:19–47.

Mobile station 10 “originates” a session by sending a request to O-PDSN 25, which is a gateway providing access to the Internet, intranets and applications servers for mobile station 10. *Id.* at 8:19–25. “Upon receipt of an origination request for a service” and validation of mobile station 10, O-PDSN 25 routes mobile station 10 to the appropriate PEP 28. *Id.* at 8:30–41. PDP 29 “maintains or stores a list of policies that have been established to control the features and functions of the mobile station 10 and decides, based on those policies, to either accept or reject the service request.” *Id.* at 8:55–59. “If the subscriber [of mobile station 10] is valid, PEP 28 will enforce the provisioned policies for the particular subscriber.” *Id.* at 9:18–20; *see also id.* at 8:45–47, 9:18–20. The policies can include wallet state/status, provisioned services/features, user selected service controls, URL restrictions, content type restrictions, time-of-day restrictions, quality/class of serviced restrictions. *Id.* at 9:23–29. PEP 28 enforces the policies by, for example, terminating the session or transaction, degrading the session or transaction to a lower quality or class of service, or redirecting or rewriting the session or transaction. *Id.* at 9:30–35

The PEP 28 is a logical element that can be physically housed in another packet data serving node or a gateway device, depending on the service request, such as a wireless application protocol (WAP) gateway, instant messaging gateway, email gateway, multimedia messaging service gateway, etc. *Id.* at 8:40–45. “The PDP 29 is also a logical element that can be physically housed in the service manager 20 or in another server accessible to either the service manager 20 or the PEP 28.” *Id.* at 8:53–55.

E. Illustrative Claim

Of the challenged claims, claims 1, 13, and 27 are independent. Claims 1 and 13, reproduced below, are representative of the challenged claims. Claims 2 and 5–12 depend from claim 1. Claims 14, 15 and 18–21 depend from claim 13, and claims 28 and 29 depend from claim 27.

1. A non-transitory computer readable storage medium comprising instructions that, when executed on a computing device configured to perform a function on a communication network managed by a service provider, cause the computing device to at least:

send to a server a request to communicate with a remote computing device over the communication network;

receive in real-time from the server a response indicative of a decision granting or denying the request, the decision being based on one or more policies that are stored at the server and based at least in part on input from an administrator; and

enforce the response by enabling the requested communication with the remote computing device over the communication network when the decision grants the request and by disabling the requested communication when the response denies the request, the requested communication being enabled or disabled without accessing the one or more policies by the computing device.

Ex. 1001, 16:2–22.

13. A computing device configured to execute a function using a communication network managed by a service provider, the computing device comprising a memory bearing instructions that, when executed on the computing device, cause the computing device to at least:

process a request to run a function on the computing device, the function comprising enabling a current

communication with a remote computing device over the communication network;

access a decision stored on the computing device, the decision having been received from a server and being based on a policy that is stored at the server and that determines whether the function is permitted to run on the computing device, the determination being based on a previous communication with the computing device, the policy being managed by an administrator;

receive from the server an update to the decision;

determine whether the request is granted or denied based on the decision and the update; and

enable or disable the communication with the remote computing device over the communication network based on the determination.

Id. at 17:15–36.

F. Prior Art and Asserted Grounds

Petitioner asserts that the challenged claims would have been unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 2, 5–12, 27–29	103	Putzolu ¹
2, 7, 8	103	Putzolu, Rothman ²
13–15, 18–21	103	Bhat ³

Pet. 4. Petitioner also relies upon the Declaration of Dr. Vijay K. Madiseti (Ex. 1003).

¹ US Patent No. 6,578,076 B1 (issued June 10, 2003) (Ex. 1005) (“Putzolu”).

² US Patent No. 7,826,835 B2 (issued Nov. 2, 2010) (Ex. 1007) (“Rothman”).

³ US Patent Application No. 2005/0021978 A1 (published Jan. 27, 2005) (Ex. 1006) (“Bhat”).

II. DISCRETIONARY DENIAL

A. § 314(a)

The '559 patent is subject of a number of pending district court litigations. Pet. 1–2; Paper 3, 2. Patent Owner requests that we exercise discretion under 35 U.S.C. § 314(a) to deny institution in light of the pending district court litigations. Prelim. Resp. 32–35 (citing, *e.g.*, *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential) (“*Fintiv*”)); Sur-Reply 1–5. In particular, Patent Owner’s § 314 arguments specifically mention the following litigations concerning the '559 patent.

- *Kajeet, Inc. v. NortonLifeLock Inc.*, Case No. 1:20-cv-01339-MN, pending in the United States District Court for the District of Delaware (“the Norton litigation”);
- *Kajeet, Inc. v. Gryphon Online Safety, Inc.*, Case No. 1:19-cv-02370-MN, pending in the United States District Court for the District of Delaware (“the Gryphon litigation”); and
- *Kajeet, Inc. v. Trend Micro, Inc.*, Case No. 6:21-cv-00389-ADA, pending in the United States District Court for the Western District of Texas, Waco Division (“the Trend Micro litigation”).

Prelim. Resp. 32–35.

Fintiv sets forth the factors that we weigh in determining whether to exercise our discretion to deny institution of the *inter partes* review proceeding here under 35 U.S.C. § 314(a). *See Fintiv*, Paper 11 at 5–6.

These factors are:

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

2. proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board's exercise of discretion, including the merits.

Id. “These factors relate to whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. “[T]he Board takes a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Id.*

For the reasons discussed below, we decline to exercise discretion to deny institution under 35 U.S.C. § 314(a).

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

Fintiv Factor 1 recognizes that a stay of litigation pending resolution of a PTAB trial allays concerns about inefficiency and duplication of efforts, which strongly weighs against exercising the authority to deny institution. *Fintiv*, Paper 11 at 6.

Petitioner argues that a motion to stay has not yet been filed in the Norton litigation and argues that “[i]f an IPR is instituted, a stay of the co-pending litigation would be appropriate.” Pet. 63. Petitioner contends that “the Board should not infer or attempt to predict the outcome if such as motion is later filed” and that this factor is neutral. *Id.*; Prelim. Reply 5.

Patent Owner speculates that it is highly unlikely that a stay will be entered in any of the district court litigations. Prelim. Resp. 33. According to Patent Owner, a stay in the Norton litigation is unlikely because allegedly the Gryphon and Norton litigations follow a common schedule and the Gryphon litigation involves infringement of a second patent. *Id.* Patent Owner argues that a stay in the Norton litigation is unlikely because it “would undermine the Court’s efforts to maintain those cases on a common schedule.” *Id.* Additionally, Patent Owner argues that because “[t]he *Trend Micro* litigation is expected to proceed to trial at approximately the same time as a final written decision would be due in this proceeding,” a stay would be unlikely in the Trend Micro litigation. *Id.*

On this record, it is unclear how the district courts would proceed should a stay be requested, and we decline to speculate regarding whether the district courts will grant a stay if this proceeding is instituted. Accordingly, this factor is neutral.

2. *Proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.*

Fintiv Factor 2 looks to the “proximity of the court’s trial date to the Board’s projected statutory deadline.” *Fintiv*, Paper 11 at 9. “If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Id.*

Petitioner states that, in the Norton litigation, the date for the *Markman* hearing is November 2, 2022 and the trial date is August 28, 2023. Pet. 64. As “[t]he expected date for a Final Written Decision in this case is Q1 2023,” Petitioner argues that this fact weighs against discretionary denial. *Id.* Patent Owner does not dispute that trial in the Norton litigation

is set for after the expected date for a final written decision in this *inter partes* review. *See generally* Prelim. Resp. 33–34; Sur-Reply 2.

Patent Owner, however, argues that trial in the Trend Micro litigation is expected to occur at about the same time as the final written decision would be due, “which the Court had indicated its expectation that trial will occur by April 2023.” Prelim. Resp. 33–34 (citing Ex. 2003, 13 (“this Court has been able to bring patent cases to trial in approximately two years after the filing of the complaint”)); *see also* Ex. 1015 (Patent Owner proposing an April 21, 2023 trial date). *But see* Sur-Reply 2 (arguing that trial is expected in January 2023). Petitioner responds that “any reliance on the *Trend Micro* schedule is speculative because “no actual trial date has been set.” Prelim. Reply 2.

Given the statutory deadlines, our latest possible date for issuance of a final written decision in this proceeding is April 25, 2023, one year and three months after the filing date of Patent Owner’s Preliminary Response.

35 U.S.C. §§ 314(b), 316(a)(11) (2018); *see also* 37 C.F.R. § 42.100(c).

Thus, the trial date in the Norton litigation is about four months after our projected statutory deadline for the final written decision. Patent Owner’s proposed trial date in the Trend Micro litigation is about at the same time as our latest possible date for issuance of the final written decision. Ex. 1015. Further, as Petitioner points out, the trial date in that case is not set but speculative. We recognize that trial dates may be subject to change. Therefore, we give this factor less weight in considering whether efficiency and integrity of the system are best served by denying or instituting review.

Under these circumstances, we find that this factor weighs against exercising discretion to deny institution.

3. *Investment in the parallel proceeding by the court and the parties.*

Fintiv Factor 3 considers the “investment in the parallel proceeding by the court and parties,” including “the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9.

Petitioner argues that the Norton litigation “is in its early stages, and the investment in it has been minimal” because “the fact discovery deadline is not set to close until September 27, 2022 and expert discovery is not set to close until March 17, 2023” and the *Markman* hearing is scheduled for November 2, 2022. Pet. 64; Prelim. Reply 3. Likewise, Petitioner argues that investment in the related cases, including the Trend Micro litigation, is minimal. Prelim. Reply 3. With regards to the Trend Micro litigation, Petitioner argues that discovery does not close until October 17, 2022 and no witnesses have been deposed. *Id.* Petitioner states that “neither court has made any determination on the merits other than at the pleading stage.” *Id.* at 4. Petitioner notes that, in the Trend Micro litigation, the court held a *Markman* hearing but “did not construe any terms because it viewed the parties’ dispute as not ripe.” *Id.* at 4 (citing Ex. 1014, 7:5–25).

Patent Owner argues that “significant resources have been expended by the Court and parties in the *Norton* litigation” because Petitioner “has already filed a Motion to Dismiss, a Motion for Reconsideration, and a Motion for Discovery Hearing,” “the parties have each served their respective infringement and invalidity contentions and nearly one million pages of discovery has been produced.” Prelim. Resp. 34; *see also* Sur-Reply 3–5. Patent Owner argues that “[h]ad Petitioner not waited until the last day to file its Petition, neither the Court nor the parties would have expended such considerable resources.” Prelim. Resp. 34 (emphasis

omitted); *see also* Sur-Reply 3–5. Patent Owner asserts that this is also true for the other related district court litigations, including the Trend Micro litigation. Prelim. Resp. 34.

Fintiv states that, “[i]f, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Fintiv*, Paper 11 at 10. In the Norton litigation, although some exchanges have taken place and some of the issues will have been briefed prior to institution, neither party asserts that the district court has issued any substantive orders addressing claim construction, validity, or infringement of the ’559 patent and the grounds asserted in the Petition. This is also substantially true for the Trend Micro litigation, where the only substantive ruling is a conclusion that the plain and ordinary meaning applies to two disputed limitations. *See* Ex. 1014; *see also* Prelim. Resp. 32–35; Prelim. Reply 3–4; Sur-Reply 3–4.

Further, as to Patent Owner’s assertion that Petitioner was not diligent in filing its Petition, Petitioner informs us that Patent Owner did not serve its Initial Infringement Contentions until July 8, 2021, and Petitioner filed its Petition less than three months later. It is often “reasonable for a petitioner to wait to file its petition until it learns which claims are being asserted against it in the parallel proceeding.” *Fintiv*, IPR2020-00019, Paper 11 at 11.

Accordingly, this factor weighs against exercising our discretion to deny institution.

4. *Overlap between issues raised in the petition and in the parallel proceeding.*

Fintiv Factor 4 considers whether “the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding.” *Fintiv*, Paper 11 at 12. If the issues in the Petition overlap substantially with those raised in the parallel proceeding, “this fact has favored denial.” *Id.* “Conversely, if the petition includes materially different grounds, arguments, and/or evidence . . . this fact has tended to weigh against exercising discretion to deny institution.” *Id.* at 12–13.

Petitioner argues that “there will be no overlap of prior art issues between this proceeding and the district court litigation between Petitioner and Patent Owner” (i.e., the Norton litigation) because:

To the extent the Board institutes trial, Petitioner will cease asserting in the co-pending litigation the combination of references on which trial is instituted for the claims, to the extent Petitioner even asserts the same combination in the district court.
Pet. 65.

Patent Owner argues that

while Petitioners avers that it will cease asserting any grounds for which institution is granted in the *Norton* litigation to which this Petition relates, it fails to mention that the same counsel represents the Defendant in the *Trend Micro* litigation and asserts virtually identical invalidity contentions which include both Putzolu and Bhat.

Prelim. Resp. 35. Patent Owner also argues that there is a “complete overlap of claim construction disputes which have already been fully briefed and argued in the *Trend Micro* litigation.” *Id.*

Concerns about the degree of overlap may be mitigated where a petitioner agrees not to pursue in the parallel district court litigation the

grounds advanced in the petition. *Sand Revolution II, LLC v. Continental Intermodal Grp. – Trucking LLC*, IPR2019-01393, Paper 24 at 11–12, 12 n.5 (PTAB June 16, 2020) (informative). A petitioner stipulating not to pursue “any ground raised or that could have been reasonably raised” weighs strongly in favor of not exercising discretionary denial. *Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 at 18–19 (PTAB Dec. 1, 2020) (precedential as to § II.A) (“*Sotera*”).

Petitioner’s stipulation is not a broad stipulation that includes “any ground raised or that *could have been reasonably raised*.” See *Sotera*, Paper 12 at 19 (emphasis omitted); see also *Sand Revolution*, Paper 24 at 12 n.5 (noting that a broad stipulation better addresses concerns of duplicative efforts and potentially conflicting decisions in a much more substantial way). The stipulation does, however, somewhat mitigate the concerns of inefficiency and the possibility of conflicting decisions with respect to the Norton litigation.

Petitioner’s stipulation, however, does not mitigate concerns of inefficiency and the possibility of conflicting decisions with respect to the other district court proceedings, including the Trend Micro litigation. As discussed below with respect to Factor 5, Patent Owner does not sufficiently show that Petitioner is related to the defendant in the Trend Micro litigation.

We find that this factor weighs marginally in favor of denying institution.

5. *Whether the petitioner and the defendant in the parallel proceeding are the same party.*

Fintiv Factor 5 looks to “whether the petitioner and the defendant in the parallel proceeding are the same party.” *Fintiv*, Paper 11 at 13. “If a petitioner is unrelated to a defendant in an earlier court proceeding, the

Board has weighed this fact against exercising discretion to deny institution.” *Id.* at 13–14.

Petitioner states that it “is a defendant in the *Norton* litigation, . . . but it is not a party to the other co-pending cases.” Prelim. Reply 2; Pet. 65. Petitioner argues that “[t]he Board must give little weight to *Trend* and the other Texas cases, because Petitioner is not involved in those cases nor are the defendants in those cases parties here.” Prelim. Reply 2.

Patent Owner contends this factor weighs strongly in favor of denial because Petitioner is the named defendant in the Norton litigation. Patent Owner also alleges Petitioner is not a defendant in the Trend Micro litigation, but alleges that Petitioner is working in concert through common counsel with Trend Micro. Prelim. Resp. 35, Sur-Reply 5 (arguing that the timing of Trend Micro’s mandamus petition to the Federal Circuit demonstrates cooperation between the parties).

If a petitioner is unrelated to a defendant in an earlier court proceeding, the Board has weighed this fact against exercising discretion to deny institution Even when a petitioner is unrelated to a defendant, however, if the issues are the same as, or substantially similar to, *those already or about to be litigated*, or other circumstances weigh against redoing the work of another tribunal, the Board may, nonetheless, exercise the authority to deny institution.

Fintiv, Paper 11 at 13–14 (emphasis added). Here, Patent Owner does not sufficiently establish that Petitioner is related to or working in concert with the defendant of the Trend Micro litigation because of common counsel. Further, as discussed above with respect to Factors 2 and 3, the Trend Micro litigation has not sufficiently progressed and has no scheduled trial date.

We find that factor 5 is neutral.

6. *Other circumstances that impact the Board’s exercise of discretion, including the merits.*

Fintiv Factor 6 looks to whether “other circumstances” exist that might “impact the Board’s exercise of discretion, including the merits.” *Fintiv*, Paper 11 at 14.

Petitioner asserts that “[t]he merits of Petitioner’s arguments are strong, and this factor weighs against discretionary denial.” Pet. 66. Patent Owner argues this factor favors denial because “no validity challenge presented in the Petition has merit.” Prelim. Resp. 35.

We have reviewed the asserted prior art references and the arguments of both Petitioner and Patent Owner. As discussed in more detail below, we find the evidence and arguments presented by Petitioner persuasive on this preliminary record and sufficient to meet our standard for instituting *inter partes* review.

We find that factor 6 is neutral.

7. *Conclusion on Discretionary Denial under 35 U.S.C. § 314(a)*

Based on a holistic review of the *Fintiv* factors, we decline to exercise discretion under § 314(a) to deny institution.

B. *§ 325(d)*

Section 325(d) provides that the Director may elect not to institute a proceeding if the challenge to the patent is based on matters previously presented to the Office. 35 U.S.C. § 325(d) states, in pertinent part, that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.”

The Board uses a two-part framework for evaluating arguments under § 325(d):

- (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and
- (2) if either condition of first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential) (“*Advanced Bionics*”). “[T]he *Becton, Dickinson* factors provide useful insight into how to apply the framework under 35 U.S.C. § 325(d).” *Id.* at 9 (footnote omitted). The non-exclusive *Becton, Dickinson* factors are:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination;
- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the Petition warrant reconsideration of the prior art or arguments.

Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph) (“*Becton, Dickinson*”). *Becton, Dickinson* factors (a), (b), and

(d) relate to the first part of the *Advanced Bionics* framework (whether the same or substantially the same art or arguments previously were presented to the Office), and *Becton, Dickinson* factors (c), (e), and (f) relate to the second part of that framework (previous Office error). *Advanced Bionics*, Paper 6 at 9–11.

Under § 325(d), the art or arguments must have been previously presented to the Office during proceedings, such as examination of the underlying patent application, pertaining to the challenged patent. *Advanced Bionics*, Paper 6 at 7. Previously presented art includes art made of record by the Examiner, and art provided to the Office by an applicant, such as on an Information Disclosure Statement (“IDS”), in the prosecution history of the challenged patent. *Id.* at 7–8.

Petitioner asserts that neither Putzolu nor Bhat was previously presented to the Office. Pet. 4–5.

Patent Owner argues that denial under § 325(d) is appropriate because Patent Owner distinguished the claims of the ’559 patent from Bales⁴ during prosecution and Putzolu and Bhat are cumulative to the disclosure of Bales. Prelim. Resp. 36. According to Patent Owner, the Examiner allowed claim 1 over Bales because “Bales does not describe a distributed architecture where policy decisions are performed at the server level and those policies are enforce on the phone itself” and Bales discloses systems residing entirely at the network level without any involvement by the mobile phone being controlled. *Id.* (emphasis omitted) (citing Ex. 1002, 10–11). Patent Owner alleges that Putzolu and Bhat are each like Bales because they “disclose systems in which enforcement of any purported policy-based control over an

⁴ U.S. Patent Application No. 2006/0025139 (Ex. 2006).

end user device is enforced at a server level component.” *Id.* at 37. Patent Owner, thus, argues that Putzolu and Bhat are substantially the same as art that was already considered by the Office during prosecution. Prelim. Resp. 36–37.

Even if we assume the first part of the *Advanced Bionics* framework is satisfied because Putzolu and Bhat are substantially the same as prior art (i.e., Bales) previously considered by the Office, we determine that the second part of the *Advanced Bionics* framework is satisfied with respect to all of the grounds in the Petition based on Putzolu. *Becton, Dickinson* factors (c), (e), and (f) relate to the second part of that framework (previous Office error). The Office erred, in a way material to the patentability of the challenged claims, in as much as it allegedly allowed the claims because “Bales does not describe a distributed architecture where policy decisions are performed at the server level and those policies are enforce on *the phone itself*” and that “Bales discloses systems residing entirely at the network level without any involvement by the *mobile phone* being controlled.” See Ex. 1002, 10–11 (emphasis added) (applicant’s arguments immediately prior to allowance); Ex. 2007, 8–9 (reasons for allowance). As discussed in our analysis below, on this record, we are not persuaded that the claim term “computing device” should be construed to mean a user-level device, such as a mobile phone, for example, rather than a network-level device, such as a router, gateway, or the like. Also, as discussed below, we determine that Petitioner sufficiently shows that the ground based on Putzolu meets our standard for institution with respect to claim 1 given our adopted construction of the term “computing device.”

Because we find that the Examiner materially erred, we decline to exercise our discretion to deny under § 325(d).

III. PATENTABILITY ANALYSIS

A. Principles of Law

A petition must show how the construed claims are unpatentable under the statutory grounds it identifies. 37 C.F.R. § 42.104(b)(4). Petitioner bears the burden of demonstrating a reasonable likelihood that it would prevail with respect to at least one challenged claim for a petition to be granted. 35 U.S.C. § 314(a).

A claim is unpatentable under § 103(a) if the differences between the claimed subject matter and the prior art are such that the subject matter, as a whole, would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 406 (2007). The question of obviousness is resolved on the basis of underlying factual determinations, including (1) the scope and content of the prior art; (2) any differences between the claimed subject matter and the prior art; (3) the level of skill in the art; and (4) when in evidence, objective indicia of non-obviousness (i.e., secondary considerations). *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). The record at this stage of the proceeding does not include any argument or evidence directed to secondary considerations of nonobviousness.

B. Level of Ordinary Skill in the Art

Petitioner contends that a person of ordinary skill in the art (“POSITA”) at the time of the invention of the ’559 patent would have had the following education and experience: “a bachelor’s degree in computer science or a similar degree such as computer engineering, with at least two years of experience in the development of computer software systems.” Pet. 5 (citing Ex. 1003 ¶¶ 23–24). Petitioner adds that a “person could also

have qualified as a POSITA with some combination of (1) more formal education (such as a master's of science degree) and less technical experience or (2) less formal education and more technical or professional experience in the fields listed above.” *Id.* Patent Owner does not dispute this level of skill at this stage of the proceeding. *See generally* Prelim. Resp.

For purposes of this Decision, we adopt Petitioner's proposal as reasonable and consistent with the prior art. *See Okajima v. Bourdeau*, 261 F.3d 1350, 1355 (Fed. Cir. 2001) (the prior art may reflect an appropriate level of skill in the art).

C. Claim Construction

In an *inter partes* review, claims are construed using the same claim construction standard that would be used to construe the claims in a civil action under 35 U.S.C. § 282(b), including construing the claims in accordance with the ordinary and customary meaning of such claims as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent. 37 C.F.R. § 42.100(b). Thus, we apply the claim construction standard as set forth in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc).

If the specification “reveal[s] a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess[,] . . . the inventor's lexicography governs.” *Phillips*, 415 F.3d at 1316 (citing *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002)). Another exception to the general rule that claims are given their ordinary and customary meaning is “when the patentee disavows the full scope of a claim term either in the specification or during prosecution.” *Uship Intellectual Props., LLC v. United States*, 714 F.3d

1311, 1313 (Fed. Cir. 2013) (quoting *Thorner v. Sony Computer Entm't Am., LLC*, 669 F.3d 1362, 1365 (Fed. Cir. 2012)).

Petitioner proposes that the various instances of “based on a policy that is stored at the server,” recited in independent claims 1, 13, and 27, “require that the decision ‘results from the server applying the policy [or one or more policies] to the request sent by the computing device.’” Pet. 11. Patent Owner contends that no construction of this term is required at this stage of the proceeding. Prelim. Resp. 21.

Patent Owner first proposes that the claims “should be read in the context of the ‘computing device’ claimed” such that “the actions required within each claim would be understood by a POSITA to be performed by the claimed computing device unless another component is expressly identified.” Prelim. Resp. 16–17. Patent Owner next proposes that “computing device” means a “user-level devices, such as a mobile phone, for example, rather than a network-level device, such as a router, gateway, or the like.” *Id.* at 17. Patent Owner also proposes that “request” be construed as “a ‘communication seeking permission.’” *Id.* at 18–21.

We determine that for the purposes of this Decision, it is unnecessary to explicitly construe these claim terms except for the term “computing device.” *See Vivid Techs., Inc. v. Am. Sci. & Eng'g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (Only terms in controversy must be construed and only to the extent necessary to resolve the controversy); *see also Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (citing *Vivid Techs* in the context of an *inter partes* review).

“computing device”

Patent Owner proposes that the plain and ordinary meaning of “computing device” is “user-level devices, such as a mobile phone, for

example, rather than a network-level device, such as a router, gateway, or the like.” Prelim. Resp. 17. Patent Owner argues that “computing device” should be construed thus because “[t]hroughout the specification and claims, the control systems disclosed are consistently described as controlling use of features and functions of phones, PDAs, and other mobile computing platforms including tablets and laptops, for example.” *Id.* (citing Ex. 1001, code (57), 6:34–40, 8:10–18, 8:55–9:11, 10:56–11:4, 13:8–18, 14:5–23).

On this record, we do not agree that the term “computing device” should be construed to be limited to user-level devices and to preclude network-level devices. Initially, we note that the Specification does not refer to or define the term “computing device,” so it stands to reason that a person of ordinary skill in the art would have understood this term to have its ordinary meaning, which would include both user-level and network-level devices.

Further, contrary to the Patent Owner’s argument, the ’559 patent describes both network-level devices, such as packet data service nodes or gateway devices, and user-level devices. For example, the ’559 patent states:

This type of device is referenced herein as a communication device, not because the device is used for communication with the control network. Hence, the device could be a PDA, a photocopier, a game, a computer, *a network device*, a bicycle, or *any type of device that one could image that is capable of being remotely controlled by logical rules*. Also, the types of items that could be purchased or used by the device or ways in which the device can be controlled are only limited by the nature of the device.

Ex. 1001, 6:24–34 (emphases added). “The present invention is directed to the real-time management of a device in general.” *Id.* at 4:11–12.

Further, Patent Owner’s proposed construction would require a user-level device, such as a mobile phone, to perform the enforcing step. Claim 1 requires the computing device to

enforce the response by enabling the requested communication with the remote computing device over the communication network when the decision grants the request and by disabling the requested communication when the response denies the request, the requested communication being enabled or disabled without accessing the one or more policies by the computing device.

Ex. 1001, 16:15–22. The ’559 patent, however, describes PEP 28 as enforcing the response and states: “The PEP 28 is a logical element that can be physically housed in another packet data serving node or a gateway device, depending on the service request.” *Id.* at 8:40–47. A packet data serving node or a gateway device is a network-level device.

Patent Owner also broadly asserts that its proposed construction “aligns with remarks made by Patent Owner to distinguish the inventions claimed during prosecution . . . over Bales.” Prelim. Resp. 18 (citing *id.* at 10–13 (reproducing Ex. 1002, 10–11)). On this record and at this stage of the proceeding, Patent Owner does not sufficiently explain how statements made by the applicants during prosecution limit the term to user-level devices as proposed by Patent Owner.

For these reasons, on this record, we decline to adopt Patent Owner’s construction of “computing device” and determine that, as described in the ’559 patent, the term “computing device” does not exclude network-level devices.

D. Overview of the Prior Art

1. Summary of Putzolu (Ex. 1005)

Putzolu is a reference titled “Policy-Based Network Management System Using Dynamic Policy Generation.” Ex. 1005, code (54). Putzolu describes that automated policy-based network management (PBNM) improved on manual console-based network management, but still has shortcomings due to substantial administrator time to establish all the policies necessary to manage all resources, and substantial processing time to evaluate requests against the policies. *Id.* at 1:19–63. To address this, Putzolu describes that:

One existing approach to policy-based network management applies a client-server paradigm, and assumes that individual network devices outsource policy decisions to management devices, called policy servers. Under this model, one or more policy servers are responsible for applying established policies to requests for use of network resources. Network devices, such as routers and switches, act as policy clients, relying on the policy server for policy-based admission control.

Id. at 2:40–52.

Figure 1, reproduced below, shows Putzolu’s architecture.

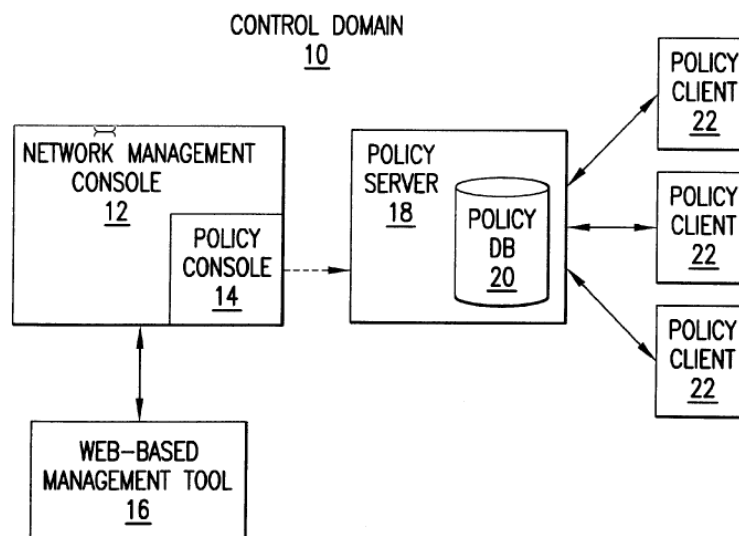


Figure 1 illustrates Putzolu's architecture, where "when policy client 22 receives a request for access to a resource under its control, it simply sends a query to policy server 18." *Id.* at 3:34–38. Then, "[p]olicy server 18 determines whether to allow the access, and communicates the decision to policy client 22. Policy client 22 may also cache responses from policy server 18 for future use." *Id.* at 3:38–41.

2. *Summary of Rothman (Ex. 1007)*

Rothman is a reference titled "Mobile Phone Policy Management." Ex. 1007, code (54). Rothman relates "attempting to turn a specific feature, such as, for example, the ability to take pictures, on or off based upon a set policy scheme." *Id.* at 1:6–10.

Rothman provides an example of use, where "a company may wish to restrict or forbid the use of cameras at the company's site. In order to facilitate this policy, a cell transceiver located at the company's site may be configured to broadcast a request to disable the camera feature on any policy management compliant mobile phones." *Id.* at 2:18–23. Rothman describes a mobile phone receives a control command, and determines the command is requesting that a feature of the mobile phone be altered. *Id.* at 2:52–62. The command may "request an enumeration of the features supported," or may request information from the mobile phone, such as the ownership of the phone. *Id.* at 2:64–3:10. The command may involve, for example, disabling a feature, enabling a feature, limiting the quality of a feature "(e.g. quality of recording, volume level, etc.)," or altering the behavior of a feature "(e.g. who the mobile phone may contact, changing the user interface, switching to vibrate mode, disabling incoming calls, etc.)." *Id.* at 3:22–30.

3. *Summary of Bhat (Ex. 1006)*

Bhat is a reference titled “Remote Interface for Policy Decisions Governing Access Control.” Ex. 1006, code (54). Bhat “relates to computer-implemented policies for controlling access to private resources.” *Id.* ¶ 2.

Bhat describes inefficiencies of prior-art access control to remote resources, which require a server where the requested resource resides (such as addressed by a Uniform Record Locator, or URL) to access a “policy server” to evaluate the request against a “defined policy,” to grant or deny access to that resource. *Id.* ¶¶ 6–8. This design leads to many requests for resources, where each request to the resource server results in back-and-forth communication between the resource server and the policy server. *Id.* ¶ 8.

To address this, Bhat proposes caching the policy decision at the resource server, so that the resource server “can then evaluate subsequent requests from the user for the resource using the stored policy decision instead of having to communicate again with the policy server.” *Id.* ¶ 10.

Figure 3, reproduced below, shows the architecture of Bhat's system.

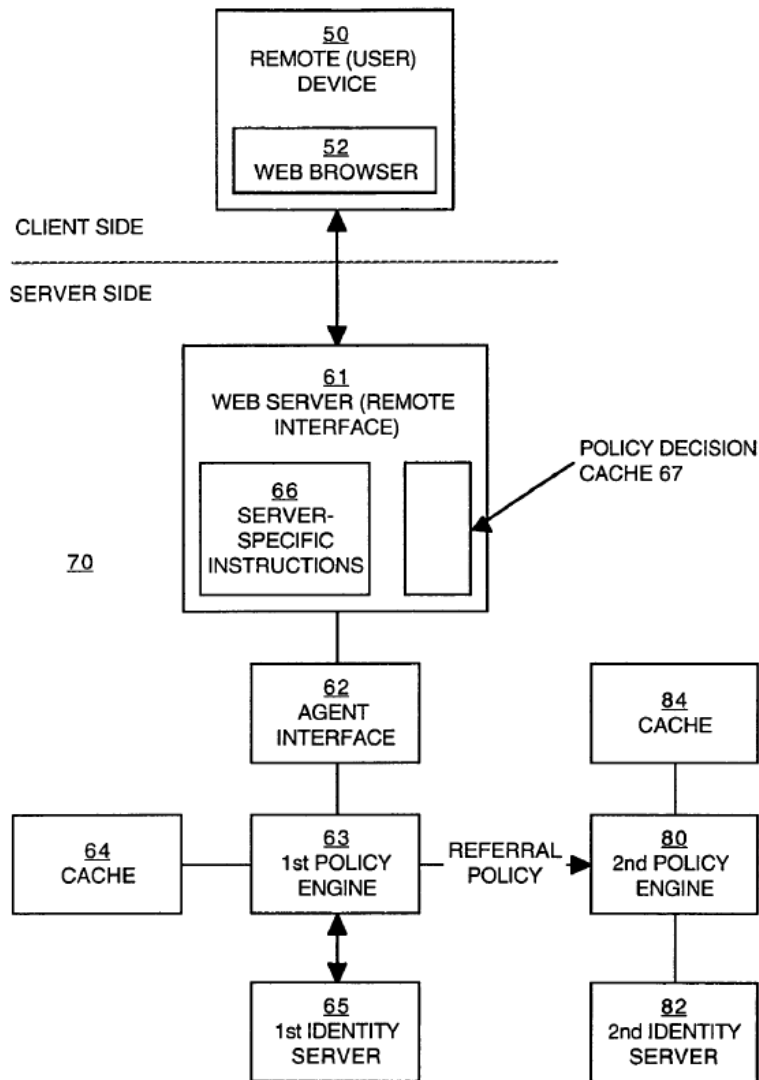


Figure 3 shows a client computer with web browser, which attempts to access resources on web server 61, which in turn communicates with a policy server, such as policy engine 63 on server 65. *Id.* ¶¶ 48–55. Server-specific instructions module 66, on the web server 61, intercepts requests from the user, and communicates with the policy engine if the request is covered by a policy. *Id.* ¶ 55. The policy engine determines the policy decision and sends this back to the server 61, which uses the policy decision. *Id.* ¶¶ 56–57. The policy decision is stored in policy decision cache 67. *Id.*

¶ 58. Future requests from the user for a resource on web server 61 can then be evaluated by the web server itself. *Id.*

E. Obviousness over Putzolu – Claims 1, 2, 5–12, 27–29

1. Analysis of Claims 1 and 27

Petitioner contends that independent claim 1 is unpatentable over Putzolu. Pet. 21–32. Petitioner equates the claimed computing device to Putzolu’s policy client 22. *See, e.g., id.* at 21–24.

The first step of claim 1 requires that the computing device “send to a server a request to communicate with a remote computing device over the communication network.” Ex. 1001, 16:7–8.

As the Petition points out (Pet. 24–25), when Putzolu’s policy client 22 receives a request for use of a network resource policy client 22 sends a query to policy server 18 using an appropriate protocol. Ex. 1005, 3:34–38 (“simply sends a query to policy server 18 using an appropriate protocol”), 4:56–57 (“sends a query with relevant information to policy server 18”), 5:57–61 (describing a Request Query), 6:2–4 (“In its query, policy client 22 includes objects that describe the bandwidth requirements and the requesting user’s identity”), 6:16–17 (“client sends query asking whether reservation can be accepted.”). On this record, we determine that the request sent by policy client 22 to policy server 18 can reasonably be considered a request to communicate with a remote computing device. *See* Ex. 1003 ¶¶ 91–92 (testimony of Dr. Madisetti).

Patent Owner responds that policy client 22 cannot be the claimed “computing device” because “the Request Query is not a request that relates to the policy client 22 attempting to communicate with a remote computing device.” Prelim. Resp. 47–48. Patent Owner contends “the policy client 22 does not communicate with either of the network resource or the component

attempting to access or use it. It merely communicates with the policy server 18 to solicit network access and bandwidth related decisions.” *Id.* at 47. Patent Owner’s argument is unpersuasive because it is premised on its proposed claim construction that the term “computing device” must be a user-level device. *See* Prelim. Resp 49 (“The policy client 22 is not the computing device”). For the reasons discussed above, we do not adopt Patent Owner’s proposed construction of “computing device.”

Patent Owner’s argument is also unpersuasive because it implies that the claimed communication, which is the subject of the claim request, must be between the computing device and the remote computing device. In other words, Patent Owner assumes that the request to communicate originates at the computing device. However, claim 1 recites “a request to communicate with a remote computing device over the communication network” and does not specify that the computing device originates the request or attempts to communicate with the remote device. Thus, for example, the first step of claim 1 does not preclude the computing device from sending to the server a request to communicate that originates with another device. We note that the ’559 patent describes a mobile station 10 or another device originating or initiating a request to communicate, which is received at PEP 28. Ex. 1001, 6:41–56, 8:60–65.

Patent Owner argues that we should give no weight to the testimony of Dr. Madisetti because Dr. Madisetti’s testimony is conclusory and insufficiently supported by the prior art. Prelim. Resp 37–43. On this record, we determine that Dr. Madisetti’s testimony sufficiently cites to and is supported by Putzolu’s disclosure. *See, e.g.*, Ex. 1003 ¶¶ 89–91. We note that during trial, Patent Owner will have an opportunity to cross-examine Dr. Madisetti.

The next step of claim 1 requires the computing device to

receive in real-time from the server a response indicative of a decision granting or denying the request, the decision being based on one or more policies that are stored at the server and based at least in part on input from an administrator.

Ex. 1001, 16:9–14. As the Petition points out (Pet. 26–28), Putzolu’s disclosure of policy client 22 receiving a response from policy server 18 teaches this step. Ex. 1005, 3:38–4:9, 5:16–22. In its Preliminary Response, Patent Owner does not dispute that Putzolu teaches this step. *See generally* Prelim. Resp. 4–50.

The last step of claim 1 requires the computing device to

enforce the response by enabling the requested communication with the remote computing device over the communication network when the decision grants the request and by disabling the requested communication when the response denies the request, the requested communication being enabled or disabled without accessing the one or more policies by the computing device.

Ex. 1001, 16:15–22.

As the Petition points out (Pet. 29–31), Putzolu discloses that after receiving a response from policy server 18, policy client 22 enforces the decision by allowing or disallowing the request. Ex. 1005, 3:26–28, 4:57–62, 5:16–22. For example, Putzolu discloses that “policy server sends a response to policy client 22. Policy client 22 then either admits or denies the request as appropriate.” *Id.* at 4:60–62.

Patent Owner responds that Putzolu does not teach this step because “policy client 22 does not enforce a decision or response by enabling or disabling a communication *between itself and remote device.*” Prelim.

Resp. 48–49 (emphasis in original). Patent Owner’s argument again is unpersuasive because it implies that the claimed communication, which is being enabled, must be between the computing device and the remote computing device. Claim 1, however, contains no such requirement. We note that the ’559 patent describes a mobile station 10 or another device originating or initiating a request to communicate which is or is not enabled by PEP 28. Ex. 1001, 6:41–56, 8:60–65, 9:12–35.

On this record and for these reasons, we determine that Petitioner shows a reasonable likelihood that claim 1 is unpatentable over Putzolu. Petitioner relies upon the same analysis to show that independent claim 27 is unpatentable over Putzolu (Pet. 21–32) and, on this record and for the same reasons, determine that Petitioner shows a reasonable likelihood that claim 27 is unpatentable over Putzolu.

2. Dependent Claims 2, 5, 9–12, 28, and 29

Petitioner contends that Putzolu discloses the limitations of these dependent claims. Pet. 32–43. Patent Owner relies on the same contentions as for claim 1. *See generally* Prelim. Resp. 37–56. We reviewed Petitioner’s contentions and evidence cited for these dependent claims and find them to be sufficient for institution.

F. Obviousness over Putzolu and Rothman – Claims 2, 7, 8

Petitioner contends that the combination Putzolu and Rothman disclose the limitations of these dependent claims. Pet. 44–48. Patent Owner relies on the same contentions as for claim 1. *See generally* Prelim. Resp. 1, 37–56. We reviewed Petitioner’s contentions and evidence cited for these dependent claims and find them to be sufficient for institution.

G. Obviousness over Bhat – Claims 13–15 and 18–21

Unlike claim 1, independent claim 13, from which claims 14–15 and 18–21 depend, requires that the computing device “process a request to run a function on the computing device, the function comprising enabling a current communication with a remote computing device over the communication network.” Ex. 1001, 17:20–23. Claim 13 also requires a decision stored on the computer device “that determines whether the function is permitted to run on the computer device.” *Id.* at 17:24–28.

Petitioner equates the claimed computing device to Bhat’s Web server 61 and the claimed function to “enabling a current communication with a remote computing device over the communication network, *e.g.* the ‘remote (user) device’ ‘50’ as shown in Figure 3.” Pet. 52. In Petitioner’s analysis, the function run on the computing device is enabling communication with a remote computing device. *Id.* Petitioner points to Bhat’s paragraph 58 as disclosing the decision that determines whether the function is permitted to run on the computer device, and Bhat’s paragraph 58 discloses policy decisions. *Id.* at 53. But, as Patent Owner points out (Prelim. Resp. 53–54), Bhat’s policy decisions relate to determinations to permit remote (user) device 50 to access a network resource, rather than whether to permit a *function to run* on Web server 61. Prelim. Resp. 53–54; Ex. 1006 ¶ 41 (describing a running policy engine returns a “policy decision” used to allow access to a resource if the resource is subject to an access control policy). As a result, we question whether Bhat discloses processing a request to run a function on Web server 16 or that the policy decisions in Bhat determine whether Web server 16 is permitted to run the function of enabling communication with a remote computing device, as would be required by the claim. We invite the parties to further address this issue at trial.

IV. CONCLUSION

After considering the evidence and arguments presented in the Petition, the Preliminary Response, Preliminary Reply, and Preliminary Sur-Reply, we determine that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to at least one of the challenged claims, and thus, we institute an *inter partes* review of all challenged claims on all presented challenges. *SAS Inst. Inc. v. Iancu*, 138 S. Ct. 1348, 1359–60 (2018); *PGS Geophysical AS v. Iancu*, 891 F.3d 1354, 1360 (Fed. Cir. 2018) (interpreting the statute to require “a simple yes-or-no institution choice respecting a petition, embracing all challenges included in the petition”).

At this stage of the proceeding, the Board has not made a final determination as to the patentability of any challenged claim or any underlying factual and legal issues.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1, 2, 5–15, 18–21, and 27–29 of the ’559 patent is instituted with respect to all grounds set forth in the Petition;

FURTHER ORDERED that, pursuant to 35 U.S.C. § 314(c) and 37 C.F.R. § 42.4(b), *inter partes* review of the ’559 patent shall commence on the entry date of this Order, and notice is hereby given of the institution of a trial.

IPR2022-00001
Patent 8,667,559 B1

For PETITIONER:

Charanjit Brahma
Manish Mehta
Samuel Ruggio
BENESCH FRIEDLANDER COPLAN & ARNOFF LLP
cbrahma@beneschlaw.com
mmehta@beneschlaw.com
sruggio@beneschlaw.com

For PATENT OWNER:

Richard Wojcio
FRIEDMAN, SUDER & COOKE
wojcio@fsclaw.com