

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DOCUSIGN, INC.,
Petitioner,

v.

PAUL C. CLARK,
Patent Owner.

IPR2022-00924
Patent 9,391,957 B2

Before MICHAEL R. ZECHER, JASON W. MELVIN, and
MICHAEL T. CYGAN, *Administrative Patent Judges*.

CYGAN, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Determining All Challenged Claims Unpatentable
Denying Petitioner's Motion to Exclude
35 U.S.C. § 318(a); 37 C.F.R. § 42.64(c)

I. BACKGROUND

A. Background and Summary

DocuSign, Inc. (“Petitioner”) filed a Petition for *inter partes* review (“IPR”) of claims 1–3 of U.S. Patent No. 9,391,957 B2 (Ex. 1001, “the ’957 patent”). Paper 2 (“Pet.”). The Petition was accompanied by a declaration by Dr. John Black. Ex. 1003 (“Black Declaration”). Paul C. Clark (“Patent Owner”), filed a Preliminary Response. Paper 5. Dr. Clark filed a declaration in support of his Preliminary Response. Ex. 2002 (“Clark Declaration”). Additional briefing was authorized for a reply to the Preliminary Response by Petitioner (Paper 6) and a sur-reply by Patent Owner (Paper 7). We instituted an *inter partes* review as to claims 1–3 of the ’957 patent on all grounds raised in the Petition. Paper 8 (“Dec. on Inst.”).

Patent Owner filed a Response (Paper 11, “PO Resp.”), accompanied by a second declaration by Dr. Clark (Ex. 2006, “Second Clark Declaration”). Petitioner filed a Reply (Paper 17, “Pet. Reply”), accompanied by a second declaration by Dr. Black (Ex. 1025, “Second Black Declaration”) and a transcript of a deposition of Dr. Clark (Ex. 1024, “Clark Deposition”). Patent Owner filed a Sur-reply (Paper 21, “PO Sur-reply”). The parties requested an oral hearing, and we held such a hearing on August 1, 2023. Papers 22, 23. A transcript of the oral hearing has been entered into the record. Paper 31.

Petitioner filed a Motion to Exclude certain portions of the Second Clark Declaration (Paper 25, “Mot. Exclude”), which was opposed by Patent Owner (Paper 26, “Opp. Mot. Exclude”); Petitioner filed a response to that opposition (Paper 27, “Resp. Opp. Mot. Exclude”).

We have jurisdiction under 35 U.S.C. § 6. This decision is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claims 1–3 of the ’957 patent. For the reasons we identify below, we hold that Petitioner has demonstrated by a preponderance of the evidence that this challenged claims is unpatentable. We also *deny* Petitioner’s Motion to Exclude.

B. Real Party in Interest

Petitioner identifies DocuSign, Inc. as the sole real party in interest to this IPR petition. Pet. 1. Patent Owner identifies Paul C. Clark as a real party in interest. Paper 4, 1.

C. Related Matters

The parties indicate that the ’957 patent is involved in *Paul C. Clark v. DocuSign, Inc.*, No. 21-cv-01007 (D.D.C), and *DocuSign v. Paul C. Clark*, No. 21-CV-04785 (N.D. Cal.). Paper 4, 1. In addition, there are two other *inter partes* review proceedings filed by Petitioner challenging related patents owned by Patent Owner, IPR 2022-00923 relating to U.S. Patent No. 8,695,066, and IPR 2022-00925 relating to U.S. Patent No. 10,129,214. *Id.*

D. The ’957 Patent

The ’957 patent (Ex. 1001) generally relates to providing “high assurance security services to network applications” through services “placed in front of existing applications without modification to the original interface or back-end data processing.” Ex. 1001, 1:62–66. The claimed invention provides secure communication between first and second domains through a logical system having first and second logical units. *Id.* at 2:26–28. The first logical unit receives data from the node of the first domain and translates the data to a target protocol. *Id.* at 2:26–30. An example of a logical unit that translates client/server transactions to or from target or

source protocols is a protocol gateway, which may be connected to an X.25 network. *Id.* at 4:60–63. The protocol gateway may calculate and insert timestamps, “used to prevent replay and repudiation,” and hashes. *Id.* at 10:45–47. The second logical unit receives and filters the translated data. *Id.* at 2:30–34. For example, a second logical unit such as a firewall may receive enhanced data from the protocol gateway, filter the enhanced data, and pass it to a cryptographic gateway. *Id.* at 4:45–46, 5:65–6:2. A third logical unit transmits the filtered data to a node of the second domain. *Id.* at 2:34–36.

A security client, which may be deployed as hardware, software, or firmware, provides a combination of authentication, integrity, confidentiality, and non-repudiation services. *Id.* at 4:21–28. The services are provided in an “algorithm and mechanism independent fashion.” *Id.* at 4:31–33. The security client “is preferably designed to interact with existing user interface applications and apply enhancement services in a manner known to those of skill in the art.” *Id.* at 4:43–45.

E. Challenged Claim

Petitioner challenges claims 1–3 of the ’957 patent, each independent and having similar limitations. Claim 1 is representative, and reproduced below (with bracketed identifying labels added):

1. [1.0] A method for secure communication between first and second domains comprising:
 - [1.1] in a first logical unit:
 - [1.2] periodically calculating timestamps and hashes;
 - [1.3] transmitting a web form to a node of a first domain responsive to a request where the web form is displayed to a user;
 - [1.4] receiving data input to the web form by the user;
 - [1.5] enhancing the data by adding one or more security services;

- [1.6] translating the received data from a first network application level protocol to a target network application level protocol while preserving said data security enhancements;
- [1.7] transmitting the translated data across a public network, the first logical unit including a firewall and a protocol gateway that comprise a VPN server;
- [1.8] in a second logical unit:
- [1.9] de-enhancing the translated data;
- [1.10] filtering the translated data to block unauthorized transmissions;
- [1.11] authorizing the filtered data and transmitting the filtered data to a node of the second domain for use in an application;
- [1.12] whereby the one or more security services are added without apparent modification of the application.

Ex. 1001, 13:48–14:9.

F. Prior Art Relied Upon

1. *Overview*

Petitioner relies upon the prior art references listed below. Pet. 3.

U.S. Patent No. 6,163,844 to Duncan *et al.* (“Duncan”), filed March 6, 1998, and issued on December 19, 2000 (Ex. 1004);

German Patent No. DE 19645 006 A1 to Grosser (“Grosser”), filed October 31, 1996, and published on May 7, 1998 (Ex. 1005).

U.S. Patent No. 6,173,399 B1 to Gilbrech (“Gilbrech”), filed June 12, 1997, and issued on January 9, 2001 (Ex. 1008).

2. *Grosser*

Accompanying the Grosser translation filed with the Petition is a declaration by Fernando Castaneda (“Castaneda Declaration”). The Castaneda Declaration referred to a Certificate of Translation as attached Exhibit B, however, no Exhibit B was submitted. Ex. 1005, 18. Petitioner submitted a new translation of Grosser, accompanied by an affidavit and

Certificate of Translation attesting to the accuracy of the translation. Ex.

1019. Petitioner further submitted additional declarations regarding the Grosser translations to testify that no substantive difference in the content of the submitted translations exists. Exs. 1021–1023. Accordingly, Petitioner has met its burden to show Grosser is prior art.

3. *Conclusion*

Based on the fully developed trial record, we determine Petitioner has demonstrated that these references are prior art patents or printed publications under 35 U.S.C. § 102. *See* Pet. 3, 16; Ex. 1004, codes (22), (43); Ex. 1006, codes (22), (43).

G. Asserted Grounds of Unpatentability

Petitioner challenges the patentability of claims 1–3 of the '957 patent on the following grounds (Pet. ii–iii, 3–4, 19, 36, 43, 56):

Claim Challenged	35 U.S.C. §¹	Reference(s)
1	103(a)	Duncan, Gilbrech
2, 3	103(a)	Duncan
1	103(a)	Grosser, Duncan, Gilbrech
2, 3	103(a)	Grosser, Duncan

II. DISCUSSION

A. Legal Standard

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

¹ The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), revised 35 U.S.C. §§ 102 and 103, effective March 16, 2013. Because the application from which the '957 patent issued claims the benefit of an application that was filed before this date, the pre-AIA versions of §§ 102 and 103 apply.

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).² *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). We analyze the asserted grounds based on obviousness with these principles in mind.

B. Level of Skill in the Art

Petitioner offers an assessment as to the level of skill in the art as of the time the ’957 patent was filed. Pet. 13. Relying upon the Black Declaration, Petitioner asserts a person of ordinary skill in the art would have had

a bachelor’s degree in computer network security, computer science, computer engineering, or a related field, with at least two years of professional experience working in computer and network security. . . . With more education, such as additional graduate degrees or study, less professional experience is needed to attain the ordinary level of skill. . . . Similarly, with more experiential knowledge of computer and network security, such as experience developed while developing client-server networks, less professional experience is needed to attain the ordinary level of skill.

Id. (citing Ex. 1003 ¶ 26). Patent Owner does not contest Petitioner’s assessment of the level of ordinary skill in the art. PO Resp. 2. We accept

² Patent Owner does not identify any secondary considerations to be considered. *See* PO Resp.

the assessment offered by Petitioner and uncontested by Patent Owner as it is supported by the Black Declaration and is consistent with the '957 patent and the asserted prior art. We apply this assessment in our obviousness analysis below.

C. Claim Construction

“[W]e need only construe terms ‘that are in controversy, and only to the extent necessary to resolve the controversy.’” *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co. Matal*, 868 F.3d 1013, 1017 (Fed. Cir. 2017) (quoting *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999)). The sole term requiring construction in this proceeding is the term “network application level protocol.” For that term, we apply the same standard that is used to construe a patent claim in a civil action under 35 U.S.C. § 282(b), as articulated in *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). 37 C.F.R. § 42.100(b) (2019).

Petitioner submits that the term “network application level protocol” should be construed as “a network level protocol and/or an application level protocol.” Pet. 14. Petitioner asserts that the '957 patent gives two examples of protocol conversion. *Id.* First, conversion to and from SMTP (“Sendmail Transfer Protocol”), which is an application level protocol. *Id.* (citing Ex. 1003 ¶ 78). Second, that the '957 patent converts “from X.25 (a network level protocol) and X.400 (an application level protocol) to SMTP,” an application level protocol. *Id.* (citing Ex. 1003 ¶ 79). Dr. Black notes that the '957 patent operates “by encrypting session traffic at the network level,” but not between a web server and an application server. Ex. 1003 ¶ 30 (citing Ex. 1001, 1:21–23).

In its Response, Patent Owner asserts that the proper construction is instead, “a protocol that functions at the application level and is intended to transfer data over a network.” PO Resp. 2; *see also* Ex. 2002 ¶ 15.³

In our Institution Decision, we agreed with the Patent Owner’s construction of “network application level protocol” as “a protocol that functions at the application level and is intended to transfer data over a network.” Dec. on Inst. 16–18. Petitioner has applied that construction for purposes of this proceeding, although not agreeing with it. Pet. Reply 6–7. We are maintaining our preliminary construction of “network application protocol” for the reasons that follow.

Petitioner’s asserted alternative construction, that it could be either a network level or an application level protocol, is inconsistent with the prosecution history. During prosecution of a parent application, the Examiner pointed to Zarom’s conversion of certain instructions as converting from one network application level protocol to a target application level protocol. Ex. 1002, 93; Sur-reply 7 (citing Ex. 1009 (prosecution history of U.S. Application 09/568,215), 191, 371). However, during an interview with Dr. Clark (the applicant), the Examiner agreed with Dr. Clark that Zarom’s teaching was directed to VPN (“Virtual Private Network”) level protocols, which did not teach the newly amended “network application level protocol.” Ex. 2003 (prosecution history of U.S. Application 13/532,246), 41; Ex. 2002 ¶ 15. Therefore, we do not adopt Petitioner’s alternate construction.

³ Patent Owner seeks to incorporate argument from its Preliminary Response; however, our rules do not permit such incorporation by reference. 37 C.F.R. § 42.6(a)(3).

In adopting Patent Owner’s construction, we note that it does not explicitly exclude either a network level protocol or an application level protocol, so long as the protocol “functions at the application level and is intended to transfer data over a network.” Inventor and Declarant Dr. Clark indicated in an interview during prosecution that network application level protocols would include “SSL, SSH, SCP, X.400, SMTP, POP, HTTP, and Telnet.” Ex. 1009 (prosecution history of U.S. Patent Application No. 09/568,215 (“the ’215 application”)), 192; Ex. 1003 ¶ 71. Dr. Black states that SSL (Secure Sockets Layer) is not an application level protocol, although the other listed protocols are application level protocols. Ex. 1003 ¶ 78. We additionally note that, during prosecution of the ’215 application, the ultimate parent of the ’957 patent, Patent Owner stated that “network application level protocol” translation includes translating “http to https.” Ex. 1009, 200, 220–21. Patent Owner confirmed this statement at oral argument. Tr. 26:15–27:3.

D. Asserted Obviousness of Claim 1 over Duncan and Gilbrech

Petitioner contends that claim 1 of the ’957 patent is unpatentable as obvious under 35 U.S.C. § 103(a), over the combined teachings of Duncan and Gilbrech. Pet. 19. We begin our analysis with a brief overview of Duncan and Gilbrech.

1. Overview of Duncan

Duncan relates to a method for granting access to information in a distributed computer system, such as the World Wide Web. Ex. 1004, 1:6–32. One well known protocol for communication of computer systems to another, as well as within these systems, is Transmission Control Protocol/Internet Protocol (TCP/IP). *Id.* at 1:33–38. In such systems, servers may make hypertext documents, generated with HyperText Markup

Language (HTML), available to clients. *Id.* at 1:39–41. The HTML pages are transmitted between server and client with a specific transfer protocol, such as HTTP (Hypertext Transfer Protocol). *Id.* at 2:3–8. HTTP protocol defines a “GET” request that contains the requested URL (Universal Resource Locator), which indicates the actual name of the document and the server system from which the document can be accessed. *Id.* at 1:65–2:3, 1:11–15.

Client computers have a corresponding application program, a browser, that reproduces the content of the hypertext document, which may contain fields that are to be filled in by the client. *Id.* at 2:17–25, 2:39–40. Transmission from browser 30 to host computer 21 over network line 22 occurs via a transfer protocol, such as HTTP. *Id.* at 8:37–58. Host computer 21 receives the transmitted data by web server program 31, referred to as a server. *Id.* at 8:57–60. Server 31 contains a transfer protocol converter 61 that receives requests meeting the condition of the network protocol TCP/IP and the transfer protocol HTTP. *Id.* at 10:29–34. The requested document is “packaged according to the rules of the transfer protocol HTTP that is employed and is communicated to the browser”; the browser then displays the hypertext document. *Id.* at 9:17–39. The employed transfer protocol is indicated in the URL, and on the basis of that URL, the document can be requested by the browser, and can be found, packaged according to the rules of the transfer protocol, and communicated to the browser. *Id.* at 9:24–40.

Duncan provides three security classes for data packets. *Id.* at 4:39–5:35. The step of communicating an accessing party’s security-related properties may use a security protocol to communicate the access rights. *Id.* at 5:40–43. Transmission to the server embeds Security Protocol Data Units

that are embedded within the transfer protocol used to access the hypertext document. *Id.* at 7:10–15. The security measures may be applied through a proxy program on proxy server 36 that is inserted between network 25 and server 31. *Id.* at 11:47–51.

2. Overview of Gilbrech

Gilbrech is titled, “Apparatus for Implementing Virtual Private Networks.” Ex. 1008, code (54). Gilbrech relates to “techniques for implementing secure virtual private networks over public or otherwise insecure data communications in infrastructures.” *Id.* at 1:15–17.

3. Claim 1 Analysis

Upon review of Petitioner’s assertions in its Petition, Petitioner’s Reply, and its supporting evidence, and Patent Owner’s arguments in its Response, Sur-reply, and its supporting evidence, we are persuaded that Petitioner has met its burden to show that the combined teachings of Duncan, and Gilbrech render obvious the challenged claim. Petitioner provides claim mappings of each individual limitation of the challenged claim to the combined teachings. Pet. 19–35. Patent Owner argues only against Petitioner’s assertions for limitation [1.6]. *See* PO Resp. For the reasons stated below, we determine that the asserted prior art teaches each limitation of claim 1.

a) [1.0]

The preamble of the claim [1.0] recites, “[a] method for secure communication between first and second domains comprising.” Petitioner contends this claim language, if limiting, is met by teachings of the combination. Petitioner points to Duncan’s first and second logical units, each having a proxy browser, proxy server, and web server, and in communication with each other. Pet. 19–21. We determine that this

description sufficiently teaches the preamble, and therefore, need not determine whether the preamble is limiting.

b) [1.1]

Limitation [1.1] recites, “in a first logical unit.”

Petitioner points to Duncan’s teaching of a first logical unit in the form of proxy browser 35. *Id.* at 22. We determine that this description sufficiently teaches limitation [1.1]

c) [1.2]

Limitation [1.2] recites, “periodically calculating timestamps and hashes.”

Petitioner asserts that Duncan teaches using TCP protocol. *Id.* at 23 (citing Ex. 1004, 10:30–37). Petitioner, relying on Dr. Black, asserts that the TCP protocol includes periodically calculating timestamps and hashes. *Id.* (citing Ex. 1003 ¶¶ 97–112, 146). Dr. Black provides evidence-backed testimony showing that TCP, as far back as May 1992, used a timestamping mechanism and a hash function. Ex. 1003 ¶ 102 (citing Ex. 1006), ¶ 103 (citing Ex. 1007) ¶ 109 (citing Exs. 1006, 1007). Based upon the evidence of record, we determine that Duncan sufficiently teaches limitation [1.2].

d) [1.3]

Limitation [1.3] recites, “transmitting a web form to a node of a first domain responsive to a request where the web form is displayed to a user.”

Petitioner asserts that Duncan teaches web browser 38 that requests hypertext document 10, which is sent from server 31 to the web browser. Pet. 23–25. Petitioner asserts that web browser 38 is a node of first domain 35, and that the browser displays the hypertext document on the user’s screen. *Id.* at 24 (citing Ex. 1003 ¶¶ 147–149; Ex. 1004, 9:30–32). We determine that this description sufficiently teaches limitation [1.3].

e) [1.4]

Limitation [1.4] recites, “receiving data input to said web form by the user.”

Petitioner asserts that Duncan teaches that the hypertext documents contain fields to be filled by the client and to supply the server with the required information. *Id.* (citing Ex. 1003 ¶ 150; Ex. 1004, 2:39–45). We determine that this description sufficiently teaches limitation [1.4].

f) [1.5]

Limitation [1.5] recites, “enhancing the data by adding one or more security services.” Petitioner points to Duncan’s teaching of browser 30 having security measures performed by security control unit 75 within proxy browser 35. *Id.* at 26 (citing Ex. 1004, Fig. 9, 11:21–22). Petitioner specifically points to the browser’s “[GET][CREDS]” request that is enhanced with additional information; i.e., the additional credentials of the user being appended. *Id.* at 27 (citing Ex. 1004, Fig. 10, 12:47–48; Ex. 1003 ¶ 151). We determine that this description sufficiently teaches limitation [1.5].

g) [1.6]

Limitation [1.6] recites, “translating the received data from a first network application level protocol to a target network application level protocol while preserving said data security enhancements.” Petitioner asserts that Duncan teaches transfer protocol converter 71 within proxy browser 35. *Id.* at 28 (citing Ex. 1004, Fig. 9, 11:22–23). Petitioner argues that protocol converter 71, which is arranged between network 25 and security control unit 75, converts information according to the network protocol employed and according to the form of the presentation of the information employed in the browser. *Id.* (citing Ex. 1004, 11:42–46).

Petitioner asserts that converter 71 translates received data from a first network application level protocol (the application protocol of the browser) to a target network application level protocol (the network protocol of the network). *Id.* (citing Ex. 1004, 10:30–41; Ex. 1003 ¶ 153). Petitioner further asserts that data security enhancements are preserved during protocol translation, because the browser sends security enhanced get requests. *Id.* at 28 (citing Ex. 1003 ¶ 154).

(1) Arguments concerning Petitioner's assertions

Patent Owner argues that Duncan teaches only a single transfer protocol, i.e., HTTP. PO Resp. 3. Patent Owner argues that Duncan's protocol converter simply adds access control to its network application level protocol, which is a modification of a single protocol and not translation from one protocol to another. *Id.* (citing Ex. 2006 ¶¶ 22 (citing Ex. 1004, 7:8–14), 23). Patent Owner argues that there is no second network application level protocol in Duncan. *Id.*

With respect to Duncan's protocol converter 61, Patent Owner argues that its conversion of "incoming requests into such a form that they can be further processed in the server" does not suggest translation from one protocol to another. *Id.* (citing Ex. 1004, 10:34–37).

With respect to Duncan's protocol converter 71, Patent Owner argues that its conversion, via browser functionality, of "the information according to the network protocol employed and according to the form of the presentation of the information employed in the browser" does not suggest translation from one protocol to another. *Id.* at 4 (quoting Ex. 1004, 11:41–46). Patent Owner argues that this is a description of how information is

converted, “i.e., according to the network protocol employed,” but does not describe that the information is converted from one protocol to another. *Id.*

Petitioner argues that its assertions that the above-quoted language in Duncan teaches limitation [1.6] are supported by its declarant, Dr. Black, whereas Patent Owner’s contrary position is conclusionary and contrary to the record evidence. Pet. Reply. 11–12 (citing Ex. 1025 ¶¶ 19–21). Petitioner points to the ’957 patent as using the terms “convert” and “translate” interchangeably, contrary to Patent Owner’s argument that Duncan teaches converting, not translating. *Id.* at 11–12 (citing Ex. 1001, 2:14–18, 4:63–5:2, 5:4–7, 7:9–11, 8:1–3, 9:29–32). Petitioner further points to Dr. Clark’s interchangeable use of the terms during his testimony. *Id.* at 17–18 (citing Ex. 2006 ¶¶ 18, 20; Ex. 1024, 34:19–35:2). Petitioner further argues that the testimony of Dr. Clark relied upon to differentiate “translate” from “convert,” at best, represents a conclusion that has no underlying factual support, and at worst, is contradicted by Dr. Clark’s own interchangeable usage of the terms, and should therefore be entitled to little weight. *Id.* at 12.

With respect to the construction of the claimed “translating the received data from a first network application level protocol to a target network application level protocol,” Petitioner focuses on portions of the ’957 patent that Dr. Clark testified as sufficient for a person of ordinary skill in the art to practice the invention. *Id.* at 18–19. Petitioner argues that Dr. Clark testified that the ’957 patent’s description that the “translation . . . encodes the data payload of the source protocol data unit (PDU) to the common transaction PDU” provides sufficient description for the claimed translating. *Id.* (citing Ex. 1001, Abstr., 2:14–3:2, 5:8–10; Ex. 1024, 99:11–23). Petitioner asserts that such testimony indicates that a person of ordinary

skill in the art would have possessed a significant amount of knowledge as to what translation is and how it may be performed. *Id.* at 18–19.

With respect to whether Duncan’s “protocol converter” converts from one protocol to another, Petitioner points to Duncan’s description of protocols that can “differ fundamentally” from each other in its Figure 2, arguing that a protocol translation from one protocol to another is explicitly described in Duncan. *Id.* at 14 (citing Ex. 1004, 8:44–9:4; Ex. 1025 ¶¶ 26–27). Petitioner further points to Dr. Clark’s testimony to support its argument. *Id.* at 18. When asked why a “protocol converter” would be named such if it did not convert protocols, Dr. Clark answered that he did not know. *Id.* (citing Ex. 1024, 65:22–66:8). Moreover, Dr. Clark answered that a person of ordinary skill in the art would consider the name of the structure in assessing its function. *Id.* (citing Ex. 1024, 65:22–66:8).

Addressing Patent Owner’s discussion of protocol converter 61, Petitioner argues that Duncan explicitly describes conversion of incoming requests into a form that can be processed in the server, and conversion of outgoing requests from the server relies on a form transmittable on the network, according to the transfer protocol employed. *Id.* at 11 (citing Ex. 1004, 10:34–41).

Addressing Patent Owner’s discussion of protocol converter 71, Petitioner points out that it is located between network 25 and security unit 75 of browser 35. *Id.* at 13 (citing Ex. 1004, 11:42–46). Petitioner highlights Dr. Black’s testimony that the protocol converter would have been understood by a person of ordinary skill in the art to convert from the protocol of the network to the protocol of the browser. *Id.* (citing Ex. 1003 ¶¶ 130, 147).

Patent Owner, in its Sur-reply, addresses Petitioner's discussion of protocol converter 71. Patent Owner argues that Petitioner has not shown that the protocol used by network 25 is a protocol that functions "at the application level that is intended to transfer data over a network." Sur-reply 10. Patent Owner argues that "Duncan simply refers to an unspecified protocol used by network 25." *Id.* Patent Owner additionally argues that "Dr. Black provides no explanation as to how the protocol of the network 25 is a network application level protocol." *Id.* Moreover, Patent Owner points out that Petitioner's Reply refers to browser 35 as the target protocol, whereas Dr. Black refers to browser 30 as the target protocol. *Id.* at 10–11 (citing Pet. Reply 20; Ex. 1003 ¶ 147).

Patent Owner also addresses Petitioner's assertion that Figure 2 of Duncan illustrates protocol translation as claimed. *Id.* at 11–12. Patent Owner argues that Duncan does not describe that data would go from back-end 34 to browser 38, and therefore does not teach any translation therebetween. *Id.* at 11. Patent Owner instead argues that Duncan describes that "data is transmitted from browser 30 to host computer 21 and that server 31 can access data bank 34." *Id.* at 12 (citing Ex. 1004, 8:55–9:1). Patent Owner further argues that, although network protocol 33 differs from network protocol 32, Duncan does not describe that protocol 33 is an application level protocol that is intended to transfer data over a network. *Id.* at 11–12. Patent Owner argues that Dr. Black's testimony that a translation due to the different protocols is required by Duncan is no substitute for the lack of any such description in Duncan of a translation. *Id.* at 12.

Patent Owner further notes that, although Duncan describes the use of HTTP protocol, Duncan does not disclose translation of HTTP protocol to

HTTPs protocol, although Patent Owner clarifies that “HTTP and HTTPS are not the same protocol.” *Id.* at 13.

(2) *Analysis*

For Petitioner to prevail on limitation [1.6], Petitioner must show (1) that Duncan teaches translating received data, (2) that the translation occurs from one protocol to a target protocol, and (3) that both protocols are network application level protocols. Patent Owner has argued that Duncan does not teach any of these three requirements of limitation [1.6]. We address each in turn, and then address whether Petitioner shows that Duncan teaches all three in combination.

With respect to translating received data, Petitioner points to Duncan’s teaching of protocol converter 71, arranged between network 25 and security control unit 75, which converts information “according to the network protocol employed.” Pet. 28 (citing Ex. 1004, 11:42–46) (emphasis omitted). Petitioner asserts, and the weight of the evidence supports, that Duncan’s aforementioned conversion of information according to a network protocol teaches the claimed translating of data. *Id.* First, Dr. Black testifies that, “when data is sent out by the standard browser 38 and proxy browser 35 to the server, the protocol converter 71 converts the data from an application protocol of the browser (in this case HTTP) to a network protocol of Duncan’s network.” Ex. 1003 ¶ 153. Dr. Black also points to a definition of protocol conversion as “the process of translating the protocol native to an end-user device (e.g. a terminal) into a different protocol.” Ex. 1025 ¶ 20 (citing Ex. 1026).

Second, the ’957 patent uses the term “convert” interchangeably with “translate.” Ex. 1001, 2:14–18, 4:63–5:2, 5:4–7, 7:9–11, 8:1–3, 9:29–32.

Third, the inventor of the '957 patent, Dr. Clark, has used the term “convert” interchangeably with “translate” in his testimony in this proceeding. Ex. 2006 ¶¶ 18, 20; Ex. 1024, 34:19–35:2. In his deposition, Dr. Clark clearly describes the action of conversion in the '957 patent as supporting the “translation” limitation:

Q. Can you point to me here any explanation of how the translation from the -- the first protocol to the target protocol is performed [in column 2 of the '957 patent]?

A. It starts around line 14, talking about preserving the data again and converting it to a target protocol that is compatible with the firewall.

. . . .

. . . It says take the data exchange and treat it as a transaction and convert it to a target protocol.

Ex. 1024, 74:20–75:5. Although Patent Owner argues that there is a distinction between “convert” and “translate” in this context, the weight of the evidence strongly points to the interchangeability of these terms, and thus, by a preponderance of the evidence, supports Petitioner’s contention that Duncan teaches the claimed translating of data.

With respect to the translation occurring from one protocol to a target protocol, Petitioner points to Duncan’s teaching of “protocol converters,” including protocol converters 61 and 71. Pet. 27–28; Pet. Reply 12. Petitioner’s assertion that a protocol converter would be understood by a person having ordinary skill in the art as converting between protocols is corroborated by Dr. Black, who emphasizes that Duncan’s protocol converter is “*converting* the information according to *the network protocol employed*,” and opines that the protocol converter converts the data from the HTTP application protocol of the browser to a network protocol of the server. Ex. 1003 ¶ 153. Dr. Black’s testimony is supported by Duncan’s

description that, at least in one embodiment, network protocol 32 such as HTTP, used by a browser, can “differ fundamentally” from another network protocol 33 that is used by a server. Ex. 1004, 8:55–9:3. Although this description does not specifically address the interactions at protocol converters 61 and 71, we credit Dr. Black’s testimony as supporting that Duncan contemplates conversion to a different protocol in appropriate circumstances.

Although Dr. Clark argues that Duncan does not suggest translation from one protocol to another (PO Resp. 4), Dr. Clark acknowledges that the term “protocol converter” as used in Duncan carried some meaning to the reader. Ex. 1024, 65:22–25 (“Why do you think Duncan used the words ‘protocol converters’ if they weren’t converting anything? A. I don’t know.”), 66:1–8 (“I certainly considered it when I read it.”). Dr. Clark stated that rather than translating, Duncan’s protocol converter “modified” the network transfer protocol by adding access control information. Ex. 2006 ¶ 22 (citing Ex. 1004, 7:8–14, Fig. 7); Ex. 1024, 64:15–25. Dr. Clark testified that “converting” has its plain meaning in this context. Ex. 1024, 35:13–36:6.

Duncan, however, does not use the term “modified”; it uses the term “converted,” which the record shows to be interchangeable with the claimed “translating.” *See* Ex. 1004, 11:56–57 (“At the network side, the proxy server 36 contains the protocol converter 61 by which requests and replies are converted.”).

Furthermore, Dr. Black testified that “Dr. Clark’s own demonstration of HTTP to HTTPS is a similar ‘modification,’ that Dr. Clark himself used as an example of ‘translating from a first network application level protocol to a target network application level protocol.’” Ex. 1025 ¶ 29 (referring to

Dr. Clark’s statement in the prosecution of the ’215 application, the ultimate parent of the ’957 patent). Dr. Black further states that “translations may be necessary even where two processes or devices nominally use the same protocol, e.g., due to differences in implementation of that protocol.” *Id.* (citing Ex. 1027, 23:8–17).

Thus, although Patent Owner argues that there is a distinction between “modified” and “translate” in this context, the weight of the evidence strongly points to Duncan teaching that a network control protocol becomes something different by the conversion performed by its protocol converter. Thus, the entirety of the evidence supports, by a preponderance of the evidence, Petitioner’s contention that Duncan teaches the claimed translating of data from one protocol to a target protocol.⁴

With respect to the protocols being network application level protocols, we have construed that term as meaning, “a protocol that functions at the application level and is intended to transfer data over a network.” *Supra* at §II (C). Petitioner’s first asserted protocol is Duncan’s HTTP application protocol of the browser. Pet. 27. There appears to be no dispute that this is a network application level protocol, as Dr. Clark admits that the ’957 patent uses HTTP as an example of a network application level protocol. Ex. 2005 ¶ 18; Ex. 1024, 36:7–13.

Patent Owner argues that Petitioner has not shown Duncan to teach the claimed target network application level protocol. PO Resp. 3–5. However, Patent Owner is also arguing that Duncan’s protocol converter

⁴ For this reason, we need not address the parties’ discussion as to whether construction of the term “target protocol” requires the two claimed protocols to be the same protocol. *See* Pet. Reply 7–10; Sur-reply 1–4.

still utilize[s] the same network transfer protocol as the HTTP application protocol of the browser, merely adding access control information. *Id.* at 3. Patent Owner clearly states, “Duncan describes a single transfer protocol, i.e., HTTP.” *Id.* Because the HTTP application protocol of the browser is uncontestedly a network application protocol, Duncan’s modified-yet-same network protocol is, in Patent Owner’s view, also a network application protocol. Thus, although Patent Owner argues that there is no evidence showing Duncan to teach a target network application protocol, Patent Owner, in its discussion of the nature of Duncan’s “modification,” has confirmed exactly such evidence.

Furthermore, Dr. Black’s testimony supports the target protocol of network 25 as being “a protocol that functions at the application level and is intended to transfer data over a network.” Dr. Black states that the claimed translation is taught between the protocol of browser 30 and the protocol of network 25. Ex. 1003 ¶ 153. Dr. Black states that Duncan illustrates, in Figure 9, a “proxy with a security module [that] is used to allow browsers that do not themselves have security modules to securely communicate over a network.” Ex. 1025 ¶ 23 (citing Ex. 1004, 8:18–20, 12:11–22). Petitioner, at oral argument, clarified that Duncan’s security module “is providing the security enhancements, but then you have to get [it] into a protocol that allows it to go over the network 25, and that’s what happens in the [protocol converter 71].” Tr. 11:5–13. Dr. Black’s testimony indicates that the target protocol operates over a network; i.e., at the application level, and comports with Duncan’s statement that its protocol converter converts replies from the server according to the demands of the network, according to the transfer protocol employed. Ex. 1004, 10:34–41.

In addition to determining that Petitioner has shown Duncan to teach each of the contested elements of limitation [1.6], we determine that Petitioner also shows Duncan teaches the entirety of the above-discussed limitations when considered as a whole. Taking the above determinations together, Petitioner shows Duncan to teach that its protocol converter converts replies from a browser protocol to a network protocol. Duncan's conversion of data, in view of the evidence from the declarants and the '957 patent, teaches a translation of data. Duncan's first protocol is different from the second protocol because (1) in the view of Dr. Clark, it has been modified by the protocol converter, (2) according to Duncan, it has been converted according to the demands of the network, and (3) according to Dr. Black, differences in implementation of that protocol result in a translation even where the protocol is nominally the same. Duncan's browser protocol is a network application level protocol because it is taught by Duncan to be HTTP, which, as Patent Owner admits, is an example of a network application level protocol in the '957 patent. Duncan's network protocol is a network application level protocol because it is a modified version of a HTTP protocol, according to Dr. Clark. Combined with both Dr. Clark's and Dr. Black's characterization of Duncan's protocol converter as functioning at the application (HTTP) level to convert and transfer data over a network, Duncan's network protocol teaches a network application level protocol, i.e., "a protocol that functions at the application level and is intended to transfer data over a network."

In view of the above, the weight of the evidence strongly points to Duncan's protocol converter performing the claimed step of translating data from one protocol to another, in which both protocols are network

application level protocols. Consequently, a preponderance of the evidence supports Petitioner’s assertion that Duncan teaches limitation [1.6].

h) [1.7]

Limitation [1.7] recites, “transmitting the translated data across a public network.” Petitioner asserts that this limitation is taught by browsers 38 and 35 transmitting the output of the protocol converter 71 via the network 25, wherein the network architecture is a public network in the form of the World Wide Web. Pet. 29 (citing Ex. 1004, Fig. 9; Ex. 1003 ¶ 156). We determine that this description sufficiently teaches limitation [1.7]

i) [1.8]

Limitation [1.8] recites, “the first logical unit including a firewall and a protocol gateway that comprise a VPN server.” Petitioner asserts this limitation is taught by Gilbrech’s VPN unit, which connects the Internet and routers, processing the data packet from the sending side to ensure that is encrypted and authenticated, and a VPN unit that correspondingly decrypts and authenticates when received. Pet. 20 (citing Ex. 1008, 6:33–36, 6:49–53, 6:56–60; Ex. 1003 ¶ 200). Petitioner further points to Gilbrech’s protocol gateway within the VPN server in the form of “multi-protocol transceivers.” *Id.* (Ex. 1008, 11:7–9, 9:26–30; Ex. 1003 ¶ 201). Petitioner further points to Gilbrech’s description of a firewall configured in a box with the VPN unit. *Id.* at 21 (citing Ex. 1008, 9:30–35).

Petitioner asserts that a person of ordinary skill in the art would have used a VPN such as taught by Gilbrech “because Duncan [was] in possession of a firewall and just needed to know how to incorporate a VPN with that firewall to provide added security.” *Id.* at 18–19 (Ex. 1003 ¶¶ 151, 202). Petitioner further points to Duncan’s teaching that its security is “capable of working in concert with traditional Internet security mechanisms

such as corporate firewalls.”) *Id.* at 18 (citing Ex. 1008, 9:30–32).

Petitioner further points to Duncan’s expressed need for network security as a “critical factor for the success” of its systems, arguing that such a need would be met by Gilbrech’s “techniques for implementing secure virtual private networks over private or otherwise insecure data communications infrastructures.” *Id.* at 17–18 (citing Ex. 1004, 1:11–14; Ex. 1008, 1:15–18). Consequently, we determine that these descriptions sufficiently teach limitation [1.8].

j) [1.9]–[1.13]

Limitation [1.9] recites, “in a second logical unit.” Limitation [1.10] recites, “de-enhancing the translated data.” Limitation [1.11] recites, “filtering the translated data to block unauthorized transmissions.” Limitation [1.12] recites, “authorizing the filtered data and transmitting the filtered data to a node of the second domain for use in an application.” Limitation [1.13] recites, “whereby the one or more security services are added without apparent modification of the application.”

Petitioner asserts that Duncan’s proxy server 36 and web server 37, considered together, form a second logical unit. *Id.* at 32; Ex. 1003 ¶ 158. Petitioner asserts that the [GET][CREDS] request is decrypted by an access control unit in proxy server 36, which is a de-enhancement of the translated data. *Id.* at 32–33; Ex. 1003 ¶ 159. Petitioner asserts that the access control unit checks to see what access privileges must be present for accessing the hypertext document. *Id.* (citing Ex. 1004, 16:17–21, Fig. 9). Petitioner asserts that the security control unit 85 decides whether it should forward a request for a hypertext document to server 31, and transmitting the data to server 37. *Id.* at 34 (citing Ex. 1004, 11:58–62). Petitioner asserts that Duncan describes its procedure as being performed “without having to

undertake modifications at the side of existing browsers, servers, hypertext document, and corresponding programs.” *Id.* at 35 (citing Ex. 1004, 7:60–64). We determine that these descriptions sufficiently teach limitations [1.9]–[1.13].

k) *Determination*

Accordingly, Petitioner has shown, by a preponderance of the evidence, that claim 1 would have been obvious over the combination of Duncan and Gilbrech.

4. *Claims 2 and 3*

Claims 2 and 3 have similar limitations as claim 1. Neither claim 2 nor claim 3 requires a firewall and a protocol gateway that comprise a VPN server, limitations for which Petitioner relied upon Gilbrech.

For the similar limitations of claim 2, Petitioner’s arguments and evidence with respect to claim 1 equally apply to claim 2. *Compare* Pet. 36–34 (addressing limitations 2.0-2.7), *with id.* at 19–29 (addressing limitations 1.0-1.7). Petitioner additionally focuses on the limitations ([2.8] and [2.12]) that the logical units reside on respective logical platforms. With respect to those elements Petitioner points to Duncan’s browser 30 being part of a logical unit that is “loaded on the personal computer PC and therefore resides on the personal computer,” in which the personal computer is a physical platform. Pet. 37–38 (citing Ex. 1004, 8:48–51, 8:1–2; Ex. 1003 ¶¶ 165–167). Petitioner further points to Duncan’s web server 31 residing on the host computer 21, which is also a physical platform. *Id.* at 39–40 (citing Ex. 1004, 8:55–60; Ex. 1003 ¶ 169). For claim 3, Petitioner repeats its assertions relating to Duncan for claim 1. Pet. 41–43.

Patent Owner argues against Petitioner’s assertions for claims 2 and 3 on the same reasoning as for claim 1. PO Resp. 5. For the same reasons

provided in our analysis of claim 1, we do not agree with Patent Owner's arguments. *See supra* Section II.D.g.2.

We find that Petitioner has persuasively shown that Duncan teaches that its logical units reside on respective logical platforms. Because we have also found Petitioner to have shown in its discussion of claims 1–3 that Duncan teaches all of the limitations of claims 2 and 3, we determine that Petitioner has shown by a preponderance of the evidence that claims 2 and 3 would have been obvious over Duncan.

E. Asserted Obviousness over Grosser, Duncan, and Gilbrech

Petitioner further asserts that claim 1 is obvious over the combined teachings of Grosser, Duncan, and Gilbrech. Patent Owner does not dispute Petitioner's contentions except as to limitation [1.6], stating that Grosser does not cure the deficiencies of Duncan. PO Resp. 6–7. Patent Owner argues that Grosser does not teach the properly construed “translation from a first network application level protocol to a second network application level protocol.” *Id.*; PO Sur-reply 14–15. With respect to that limitation, Petitioner relies, at least in the alternative, upon the same teachings of Duncan as discussed above for Ground 1, which we have addressed in our analysis of that Ground. Pet. 50; *supra* at II(D)(3)(g).

Because we determine that claims 1–3 are obvious over the combination of Duncan and Gilbrech, we do not address the parties' arguments regarding this alternate ground that additionally relies upon Grosser. *See Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App'x 984, 990 (Fed. Cir. 2020) (“We agree that the Board need not address issues that are not necessary to the resolution of the proceeding.”).

F. Petitioner's Motion to Exclude Evidence

Petitioner seeks to exclude portions of Exhibit 2006, the Second Clark Declaration. Mot. Exclude (arguing for exclusion of paragraphs 1–21, 24–28, 30, and 31). Petitioner asserts that these portions contain irrelevant information under Federal Rules of Evidence §§ 401, 402, and 403. *Id.* at 1. Petitioner argues that these sections are irrelevant because they were not relied upon in Patent Owner's Response. *Id.* Petitioner further states, without further explication, that the probative value of those portions is “substantially outweighed by unfair prejudice, undue delay, and waste of time, due to Patent Owner's failure to timely cite such evidence in its Response, thereby preventing any opportunity for Petitioner to respond thereto.” *Id.* at 3. For these reasons, Petitioner requests the exclusion of those portions of Exhibit 2006 and any reliance upon those sections in its Sur-reply. *Id.* (citing *St. Jude Med. Cardiology Div., Inc. v. Bd. of Regents of the Univ. of Mich.*, IPR2013-00041, Paper 65 at 2–3 (PTAB Jan. 27, 2014) (explaining that “new” evidence includes evidence already of record but not previously discussed in any paper of record)).

Patent Owner argues that Petitioner would create, out of whole cloth, a rule that a party “cite to every paragraph of its expert's declaration in an accompanying brief or risk exclusion of the uncited portions.” Opp. Mot. Exclude 2. Patent Owner further argues that the disputed portions of Dr. Clark's declaration were made in response to Petitioner's Reply; specifically, challenges to the weight to be accorded to Dr. Clark's Declaration. *Id.* (citing Pet. Reply 2–6). Patent Owner further argues that the burden to show inadmissibility of evidence is to be borne by the moving party. *Id.* at 3 (citing 37 C.F.R. §§ 42.20(c), 42.62(a); *Amerigen Pharm. Ltd. v. Janssen Oncology, Inc.*, IPR2016-00286, Paper 86 at 43 (PTAB January

17, 2018)). Patent Owner argues that Petitioner has not met this burden because it has failed to explain why the substance of the challenged paragraphs are irrelevant. *Id.* at 4. Patent Owner further points out that Petitioner deposed Dr. Clark regarding the disputed declaration. *Id.*

Petitioner responds by citing further nonprecedential cases in support of its position that evidence not cited in a party's brief may be excluded as irrelevant. Resp. Opp. Mot. Exclude 1–3. Petitioner further argues that the citation to the disputed portions of Exhibit 2006 was for a different purpose; because it is a new argument asking for consideration of new evidence to which Petitioner has no ability to respond, Petitioner argues that it violates the prohibition upon new evidence in a Sur-reply set forth in 37 C.F.R. § 42.23(b). *Id.* at 5. Finally, Petitioner argues that those paragraphs are prejudicial because Petitioner had no opportunity to respond to those paragraphs as relied upon in the Sur-reply. *Id.* at 6.

Petitioner has not made a persuasive case for exclusion of the identified paragraphs of Exhibit 2006. A motion to exclude is filed to “preserve” an objection to evidence that was timely made. 37 C.F.R. § 42.64(c). Such a motion must “identify the objections in the record in order and must explain the objections.” *Id.* Petitioner's motion preserves its objection that was timely made following the filing of Patent Owner's Response. Paper 12. Petitioner's objection was based upon allegations of inherent bias, confusion of the issues in this proceeding with the issues of district court litigation, and that “[m]uch of the declaration also is irrelevant to the issues presented here.” *Id.* Only the latter objection is preserved by the motion.

In its motion, Petitioner does not attempt to explain its objection. Rather, Petitioner argues that any portion of submitted evidence is inherently

irrelevant to the proceeding if it is not specifically cited in the brief accompanying that evidence. Petitioner acknowledges that the Federal Rules of Evidence sets the standard for relevant evidence as that which “has a tendency to make a fact more or less probable than it would be without the evidence” and that “the fact is of consequence in determining the action.” Paper 25, 2 (citing Fed. R. Evid. § 401). Yet, Petitioner has not attempted to explain why any particular statement in the portions that it identifies as irrelevant meets that standard.

Instead, Petitioner asks that we infer a lack of relevance because the Patent Owner did not cite particularly to those sections of the evidence in its Response. We decline to create such an inference to replace the fact-specific analysis of § 401. None of Petitioner’s PTAB citations, which as non-precedential decisions we need consider for their persuasive value but are not bound by, set forth such a rule. Each of those cases instead addressed the evidence on its facts.

For example, in *St. Jude*, the Board explained that demonstrative exhibits, although in the record, were not evidence, and “as such, the exhibits cannot add new evidence to the proceeding.” *St. Jude*, IPR2013-00041, Paper 65, at 2. The Board in *St. Jude* was explaining that demonstrative exhibits are not an opportunity for additional briefing. *Id.* at 2–3. Petitioner’s objections are not made with respect to demonstrative exhibits. Further, the disputed portions of Exhibit 2006 were admittedly relied upon in Patent Owner’s Sur-reply. Therefore, the reasoning of *St. Jude* is inapposite to the instant situation.

Petitioner’s reliance on *SK Innovation* is also inapposite. *SK Innovation* involved a situation in which the patent owner did not rely on certain exhibits in any of its briefings. *SK Innovation Co., Ltd. v. Celgard*,

LLC, IPR2014-00679, Paper 58, 49 (P.T.A.B. Sept. 25, 2015). Unlike *SK Innovation*, Patent Owner in this proceeding has relied on the disputed sections in its Sur-reply. Further, the patent owner in that *SK Innovation* argued only that the disputed exhibits provided “useful background”; however, Patent Owner in this proceeding provides a more particular reason for the relevance of the disputed exhibits; i.e., that they respond to arguments against Dr. Clark’s credibility made in Petitioner’s Reply. Thus, *SK Innovation* does not provide support for Petitioner’s contentions.

The parties dispute the effect of other PTAB cases, arguing as to whether the facts in those cases are similar or distinguishable. Opp. Mot. Exclude 3–4; Resp. Opp. Mot. Exclude 2–3. Such discussion merely underscores the fact-specific nature of the relevance analysis. Petitioner has not explained, as a legal or policy matter, why we should replace this fact-specific analysis with a rigid rule that would act to scrub the evidentiary record of any sentence not specifically cited in an accompanying brief.

Petitioner fares no better on its factual showing. Petitioner attempts to move the burden of showing that it is entitled to relief onto Patent Owner. Resp. Opp. Mot. Exclude 3 (“Patent Owner’s Opposition does not address why these never-cited paragraphs could be relevant”). However, that burden is squarely placed upon Petitioner. 37 C.F.R. § 42.20(c). Notably, Petitioner has not attempted to explain why, for example, Dr. Clark’s statement that he is the inventor of the ’957 patent and his statements as to his credentials relating to the field of invention are irrelevant such that they should be expunged. *See* Ex. 2005 ¶¶ 1, 3–16.

Nor are Petitioner’s arguments persuasive as to Patent Owner’s alleged “new” reliance on evidence in its Sur-reply. Mot. Exclude 2–3; Resp. Opp. Mot. Exclude 3–6. The content of a sur-reply is set by 37 C.F.R.

§ 42.23(b): “A sur-reply may only respond to arguments raised in the corresponding reply and may not be accompanied by new evidence other than deposition transcripts of the cross-examination of any reply witness.” Patent Owner has argued that the disputed section of its Sur-reply responds to arguments made in Petitioner’s Reply contesting Dr. Clark’s credibility. Opp. Mot. Exclude 2 (citing Pet. Reply 2–6).

We agree with Patent Owner. Petitioner’s Reply argues that Dr. Clark’s declarations should be given little or no weight because they comprise unsupported, conclusory opinions. Pet. Reply 2. Patent Owner’s Sur-reply argues that “[i]n analyzing Duncan and Grosser, Dr. Clark cites to relevant paragraphs of those references.” Sur-reply 15 (citing Ex. 2006 ¶¶ 22–31). We agree that such argument in the Sur-reply is properly responsive to arguments set forth in the Reply. Moreover, § 42.23(b) does not prohibit reliance on evidence that is already of record.

Finally, Petitioner attempts to style its arguments under Federal Rule of Evidence § 403, arguing that citing previously entered evidence in a Sur-reply wastes time, and prevents any opportunity for Petitioner to respond thereto. Mot. Exclude 3. We do not agree that Patent Owner wasted time by responding to Petitioner’s attack on Dr. Clark in its next available opportunity. Nor has Petitioner explained why Patent Owner should have preemptively addressed Petitioner’s specific concerns as to Dr. Clark’s credibility in its Patent Owner’s Response. Regarding the opportunity for a Petitioner to respond to Patent Owner’s arguments, 37 C.F.R. § 42.23 represents a balance between a full opportunity for each party to participate, and the logical necessity for some party to have the last substantive filing. Petitioner has not shown any reason why the facts presented in this proceeding have caused application of that rule to be unfair or prejudicial.

Consequently, for the above-discussed reasons, Petitioner's motion to exclude evidence is *denied*.

CONCLUSION⁵

For the foregoing reasons, we conclude that Petitioner has demonstrated by a preponderance of the evidence the unpatentability of claim 1 of the '957 patent is obvious over Duncan and Gilbrech, and that claims 2 and 3 of the '957 patent are obvious over Duncan.

In summary:

Claims	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1	103	Duncan, Gilbrech	1	
2, 3	103	Duncan	2, 3	
1 ⁶	103	Grosser, Duncan, Gilbrech		
2, 3 ⁷	103	Grosser, Duncan		
Overall Outcome			1–3	

⁵ Should Patent Owner wish to pursue amendment of the challenged claims in a reissue or reexamination proceeding subsequent to the issuance of this decision, we draw Patent Owner's attention to the April 2019 *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*. See 84 Fed. Reg. 16,654 (Apr. 22, 2019). If Patent Owner chooses to file a reissue application or a request for reexamination of the challenged patent, we remind Patent Owner of its continuing obligation to notify the Board of any such related matters in updated mandatory notices. See 37 C.F.R. § 42.8(a)(3), (b)(2).

⁶ As explained above, because we determine that claim 1 is unpatentable as obvious over the combined teachings of Duncan and Gilbrech, we decline to address that claim on this ground.

⁷ As explained above, because we determine that claims 2 and 3 are unpatentable as obvious over Duncan, we decline to address that claim on this ground.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, Petitioner has shown by a preponderance of the evidence that claims 1–3 of the '957 patent are unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude Evidence is *denied*; and

FURTHER ORDERED that because this is a Final Written Decision, parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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