

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

DOCUSIGN, INC.,
Petitioner,

v.

PAUL C. CLARK,
Patent Owner.

IPR2022-00925
Patent 10,129,214 B2

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

MELVIN, *Administrative Patent Judge*.

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

I. INTRODUCTION

DocuSign, Inc. (“Petitioner”) filed a Petition (Paper 2, “Pet.”) requesting *inter partes* review of claim 1 (the only claim, “the challenged claim”) of U.S. Patent No. 10,129,214 B2 (Ex. 1001, “the ’214 patent”), owned by Paul C. Clark (“Patent Owner”). After preliminary briefing, we instituted review. Paper 8 (“Institution Decision” or “Inst.”).

Patent Owner filed a Response (Paper 11, “PO Resp.”), Petitioner filed a Reply (Paper 16, “Pet. Reply”), and Patent Owner filed a Sur-Reply (Paper 19, “PO Sur-Reply”). Petitioner filed a Motion to Exclude certain evidence (Paper 23, “Mot. Exclude”), to which Patent Owner filed an Opposition (Paper 24, “Mot. Opp.”) and Petitioner filed a Reply (Paper 25, “Mot. Reply”). We held a hearing on August 1, 2023, and a transcript appears in the record. Paper 29 (“Tr.”).

We have jurisdiction under 35 U.S.C. § 6. This is a Final Written Decision under 35 U.S.C. § 318(a) as to the patentability of claim 1 of the ’214 patent. For the reasons discussed below, we hold that Petitioner has demonstrated by a preponderance of the evidence that claim 1 is unpatentable. We deny Petitioner’s Motion to Exclude.

A. REAL PARTIES IN INTEREST

The parties each identify themselves as the real party in interest. Pet. 1; Paper 4.

B. RELATED MATTERS

The parties both identify the following matters related to the ’214 patent: *Clark v. DocuSign, Inc.*, No. 1:21-cv-01007-DLF (D.D.C); *DocuSign, Inc. v. Clark*, No. 3:21-cv-04785-WHO (N.D. Cal.); IPR2022-00923 (relating to

U.S. Patent No. 8,695,066), and IPR2022-00924 (relating to U.S. Patent No. 9,391,957). Pet. 2; Paper 4.

C. THE '214 PATENT

The '214 patent is titled “System and Method for Secure Communication Between Domains” and is directed to a communication system with security enhancements that do not appear to modify the data being transmitted. Ex. 1001, codes (54), (57). Figure 2 of the '214 patent illustrates this system and is reproduced below.

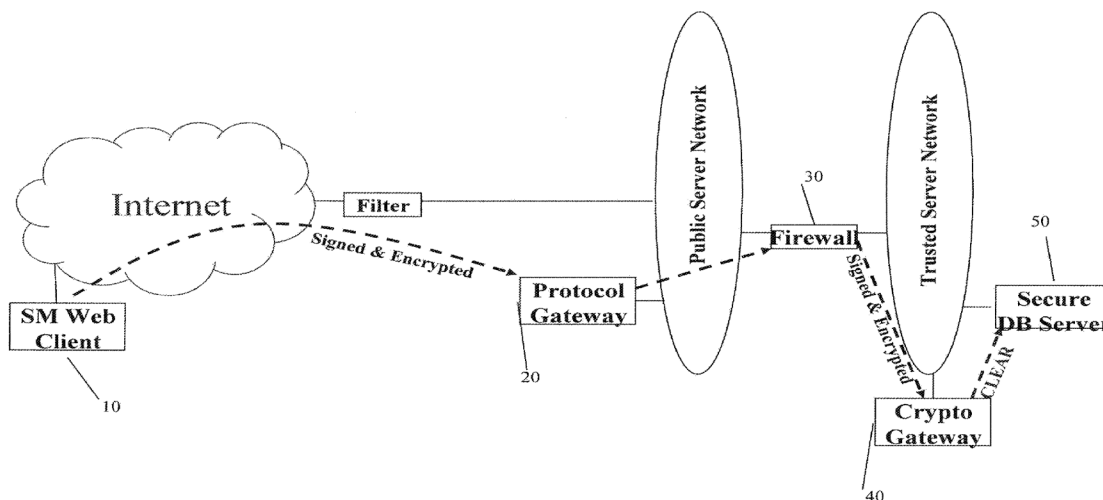


Figure 2

Id., Fig. 2. Figure 2 discloses SM Web Client 10 in communication with Protocol Gateway 20 that connects to Firewall 30 over a Public Server Network; Firewall 30 connects to Crypto Gateway 40 over a Trusted Server Network, which allows communication with Secure DB Server 50. *Id.* at 4:4–10.

The '214 patent describes that protocol gateway 20 “is a logical unit that preferably translates client/server transactions to and from target/source protocols.”

Id. at 4:65–67. It states that “[p]rotocol gateway 20 generally receives enhanced data including transactions and converts all enhanced data to/from a single transaction protocol such as SMTP [(“Simple Mail Transfer Protocol”)] as illustrated in FIG. 4.” *Id.* at 5:9–12. To that end, the specification states that the conversion “allows new protocols to be supported with little effort; all that is required is a translation that encodes the data payload of the source protocol data unit (PDU) to the common transaction PDU.” *Id.* at 5:12–15.

D. CHALLENGED CLAIM

Claim 1 is the only claim in the ’214 patent and is reproduced below, with bracketed numbering and formatting added to identify limitations.

- 1.[0] A system for secure communication between first and second domains comprising:
 - [1.1] a first logical unit including circuitry configured to
 - [1.1.1] periodically calculate timestamps and hashes,
 - [1.1.2] transmit a web form to a node of a first domain responsive to a request where the web form is displayed to a user,
 - [1.1.3] receive data input to said web form by the user,
 - [1.1.4] enhance the data by adding one or more security services,
 - [1.1.5] translate the received data from a first network application level protocol to a target network application level protocol while preserving said data security enhancements, and
 - [1.1.6] transmit the translated data across a public network; and
 - [1.2] a second logical unit including circuitry configured to
 - [1.2.1] de-enhance the translated data,
 - [1.2.2] filter the translated data to block unauthorized transmissions,
 - [1.2.3] authorize the filtered data, and transmit the filtered data to a node of the second domain for use in an application;

[1.3] whereby the one or more security services are added without apparent modification of the application.

Ex. 1001, 14:22-41.

E. ASSERTED GROUNDS

Petitioner asserts the following unpatentability grounds:

Claim	35 U.S.C. §	References/Basis
1	103(a)	Duncan ¹
1	103(a)	Grosser, ² Duncan

Pet. 3–4. Petitioner also relies on the Declarations of Dr. John R. Black, Jr.

See Ex. 1003; Ex. 1025.

F. LEGAL STANDARDS

A patent claim is unpatentable as obvious 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. 35 U.S.C. § 103(a). 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 ordinary skill in the art; and (4) when in evidence, objective evidence of non-obviousness.³ *Graham v. John Deere Co.*, 383 U.S. 1, 17–18 (1966). “In an [*inter partes* review], the petitioner has the burden from the onset to show with particularity why the patent

¹ U.S. Patent No. 6,163,877, issued Dec. 19, 2020, filed Mar. 6, 1998 (Ex. 1004).

² German Patent App. No. DE 19645 006 A1, published May 7, 1998, filed Oct. 31, 1996 (Ex. 1005 (English translation and German original)).

³ Patent Owner has not submitted such objective evidence here.

it challenges is unpatentable.” *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016).

II. ANALYSIS

A. LEVEL OF ORDINARY SKILL IN THE ART

Petitioner contends, and Patent Owner does not contest, that 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.” Pet. 14; PO Resp. 2. We adopt that definition, as it is consistent with the ’214 patent’s description and the asserted prior art.

B. CLAIM CONSTRUCTION

We construe claims according to the *Phillips* standard used in the federal courts in civil actions under 35 U.S.C. § 282(b). *Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005) (en banc). *See* 37 C.F.R. § 42.100(b). Under *Phillips*, the “words of a claim ‘are generally given their ordinary and customary meaning,’” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention, i.e., as of the effective filing date of the patent application.” *Phillips*, 415 F.3d at 1312–13. “[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)). Other than as discussed below, no term requires construction at this stage.

The Petition asserts that “network application level protocol” should mean “a network level protocol and/or an application level protocol.” Pet. 15. Patent

Owner asserts the term should be given its plain and ordinary meaning, which Patent Owner describes as “a protocol that functions at the application level and is intended to transfer data over a network.” PO Resp. 2. We adopted Patent Owner’s construction in the Institution Decision, noting that it “does not exclude a network level protocol or an application level protocol, as long as the protocol ‘functions at the application level and is intended to transfer data over a network.’” Inst. 9–11. The parties both proceeded with trial using that construction. Pet. Reply 7; PO Sur-Reply 1.

The ’214 patent’s prosecution history confirms the correct construction for “network application level protocol.” The applicant argued that an interview during prosecution of U.S. Patent Application No. 09/568,215 (“the ’215 application”)⁴ established that the prior art at issue, Zarom,⁵ “discusses operations at the VPN level, not the application level.” Ex. 1002, 47–48. The examiner allowed the claim, expressly accepting the applicant’s characterization of Zarom’s protocols. *Id.* at 34. Thus, the ’214 patent’s claim was issued based on its scope requiring an application-level protocol.

In adopting Patent Owner’s construction, we note that it does not 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.” Named inventor and Patent Owner’s expert, Dr. Clark, indicated in an interview during prosecution of the ’215 application that “network application level protocols include but are not limited to SSL, SSH, SCP, X.400, SMTP, POP, HTTP, and Telnet.” Ex. 1009, 192; Ex. 1003 ¶ 73. Petitioner’s expert, Dr. Black,

⁴ The ’214 patent claims priority to the ’215 application through a chain of continuations. Ex. 1001, code (63).

⁵ US 6,356,529. *See* Ex. 1002, 48, 59.

states that SSL is not an application-level protocol, although the other listed protocols are application-level protocols. Ex. 1003 ¶ 73. We note additionally that, during prosecution of the '215 application, Patent Owner stated that translating a “network application level protocol” includes “translation from http to https.” Ex. 1009, 220–21. Patent Owner confirmed this statement at oral argument. Tr. 26:15–27:3.

C. OBVIOUSNESS OVER DUNCAN

Petitioner asserts that Duncan teaches claim 1 of the '214 patent. Pet. 20–34. 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 communicating within and between computer systems is Transmission Control Protocol/Internet Protocol (“TCP/IP”). *Id.* at 1:33–38. In such systems, servers make hypertext documents available to clients. *Id.* at 1:39–41. The documents are transmitted between server and client with a specific transfer protocol, such as Hypertext Transfer Protocol (“HTTP”). *Id.* at 2:3–8. HTTP defines a “GET” request that contains the requested Universal Resource Locator (“URL”) that 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 and contains fields 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 a 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. *Id.* at 10:29–33. 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. *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 within the transfer protocol used to access the hypertext document. *Id.* at 7:10–15. The security measures may be applied through proxy programs on proxy browser 35, inserted between browser 38 and network 25, and proxy server 36, inserted between network 25 and server 31. *Id.* at 11:47–51, 12:11–22.

Petitioner maps the “first logical unit” to Duncan’s browser-side components, including browser 38 and proxy browser 35; it maps the “second logical unit” to Duncan’s server-side components, including proxy server 36 and web server 37. Pet. 21; *see* Ex. 1004, 12:11–22, 13:25–28, Figs. 2, 8, 9. Petitioner maps the various claim elements to Duncan’s described functionality for those components. Pet. 20–34. Patent Owner disputes only whether Duncan teaches the translating limitation—“translate the received data from a first network application level protocol to a target network application level protocol while preserving said data security enhancements.” PO Resp. 3–5.⁶

For the translating limitation, Petitioner relies on Duncan’s protocol converter. Pet. 28–29. Petitioner submits that “protocol converter 71 converts the data from an application protocol of the browser (in this case HTTP) to a network

⁶ While Patent Owner expresses the claim language as “translating data from a first network application level protocol to a second network application level protocol while preserving data security,” that does not affect the arguments or analysis.

protocol of Duncan’s network.” *Id.* at 28 (citing Ex. 1004, 11:41–43; Ex. 1003 ¶ 149); *accord* Pet. Reply 10. Duncan states that protocol converter 71 converts “information according to the network protocol employed and according to the form of the presentation of the information employed in the browser 30.” Ex. 1004, 11:42–46. Petitioner additionally relies on Duncan’s descriptions of its other protocol converters, which act in conjunction with protocol converter 71. Pet. Reply 15 (citing Ex. 1004, 10:34–41). As Duncan states, “protocol converter 61 is in the position, on the basis of its ‘parser functionality,’ to convert incoming requests into such a form that they can be further processed in the server” and “to convert replies proceeding from the server according to the demands of the network 25 into a form transmittable thereat, according to the transfer protocol employed.” Ex. 1004, 10:34–41. We agree with Petitioner that Duncan discloses a protocol converter in the first logical unit that operates as claimed.⁷

Patent Owner contends that Duncan’s protocol converter does not disclose the translating limitation and, instead, “modifies a single network application level protocol by adding access control information.” PO Resp. 3 (emphasis omitted). As an initial matter, while Duncan undoubtedly discloses adding access control information, that process relates to Petitioner’s assertions regarding the claim language “enhance the data by adding one ore more security services.” Pet. 26–28 (citing Ex. 1004 11:21–22, 11:31–41, 12:26–27, 12:30–34, 12:47–48, Fig. 10). Petitioner’s contentions regarding the translating limitation do not rely on

⁷ Because we agree with Petitioner as discussed below, we do not address Petitioner’s separate argument that the claims do not require the “target network application level protocol” differ from the “first network application level protocol.” *See* Pet. Reply 8–10.

Duncan’s access-control information but instead rely on Duncan’s “protocol converter 71.” Pet. 28–29 (citing Ex. 1004, 11:42–46).

Patent Owner recognizes Duncan’s protocol converters but submits that Duncan does not disclose that those protocol converters “translate data from a first network application level protocol to a second network application level protocol.” PO Resp. 3–4. According to Patent Owner, when Duncan describes its protocol converter as able “to convert incoming requests into such a form that they can be further processed in the server,” that does not relate to the claimed translating. *Id.* (quoting Ex. 1004, 10:34–37).⁸

Petitioner contends the record shows that “convert” is synonymous with “translate.” Pet. Reply 12 (citing Ex. 1024, 34:19–35:2; Ex. 2006 ¶¶ 18, 20; Ex. 1025 ¶¶ 19–21). We agree. Patent Owner’s expert and the ’214 patent’s named inventor, Dr. Clark, testified unambiguously that he used “convert” and “translate” synonymously. Ex. 1024, 34:19–36:6; *see also* Ex. 2006 ¶¶ 18, 20 (using “convert” to describe the ’214 patent’s process). Petitioner’s expert, Dr. Black, explains that the ’214 patent and other record evidence support understanding conversion and translation as synonyms. Ex. 1025 ¶¶ 19–24. Thus, we find that Duncan’s protocol converters act to translate protocols used for requests and replies between Duncan’s browser and server.

Patent Owner recognizes Duncan’s disclosure that protocol converter 71 “convert[s] the information according to the network protocol employed and according to the form of the presentation of the information employed in the

⁸ Although that quoted passage relates to Duncan’s server-side protocol converter 61 rather than the browser-side protocol converter 71, Duncan describes its various protocol converters similarly and Patent Owner has not argued that those converters functionally differ. *See, e.g.*, Ex. 1004, 10:30–41, 11:41–46, 11:56–58.

browser 30” (Ex. 1004, 11:41–46), but submits that disclosure does not show converting “from one network protocol to a second network protocol.”

PO Resp. 4–5. Petitioner’s expert, Dr. Black, testifies that Duncan’s quoted passage (Ex. 1004, 11:41–46) describes that “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 ¶ 149. That testimony supports that Duncan’s protocol converters translate from one protocol to another.

Dr. Clark’s testimony does not undermine Petitioner’s view of Duncan’s protocol converters. Dr. Clark could not explain his view that Duncan’s protocol converters operate other than as claimed. 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.”). He accepted Duncan’s wording but asserted that Duncan discloses modifying a protocol rather than converting it. *Id.* at 64:15–25, 66:1–8; Ex. 2006 ¶ 22–23. As discussed above, that position fails to address the functionality of Duncan’s protocol converter, because it relies on Duncan’s separate process of adding access-control information. *See* Ex. 1004, 7:8–14, 11:1–3, 11:31–41.

Petitioner points out that “Duncan does not use the term ‘modify’ when discussing its protocol converters; it uses the term ‘convert.’” Pet. Reply 11 (citing Ex. 1004, 10:34–41, 11:41–46, 11:57–58, 12:5–6, 12:16–21). Moreover, Dr. Clark testifies that “converting” has its plain meaning in Duncan. Ex. 1024, 35:13–36:6. Thus, Duncan’s disclosures regarding its protocol converter support Petitioner’s contentions. Regardless, we credit Dr. Black’s testimony 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 during prosecution of the ’215 application (Ex. 1009, 220–21)). 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). Based on Dr. Black’s testimony, Dr. Clark’s testimony, and the cited record evidence, even a “modified” protocol differs from the original in some respects and is therefore translated. Thus, Dr. Clark’s view of Duncan supports that it discloses the translating limitation. Stated otherwise, even if one views Duncan’s protocol converters as making changes only to accommodate the access-control information added by Duncan’s other elements, those modifications satisfy the claimed translation.

Additionally, other aspects of Duncan reinforce that its protocol converters involve multiple different protocols. Duncan discusses that the server may access data-bank computers over a network connection, and the protocol for such communication “can differ fundamentally” from the protocol used for browsers. Ex. 1004, 8:66–9:3; *see* Pet. Reply 14; Ex. 1025 ¶ 27–28. Although that aspect of Duncan does not directly speak to the browser–server protocol, it supports that Duncan contemplates conversion to a different protocol in appropriate circumstances.

To the extent Patent Owner challenges whether Duncan’s protocol converter operates on “network application level protocols,” we find that it does. We construe that term as “a protocol that functions at the application level and is intended to transfer data over a network.” *See supra* at 6 (§ II.B). Petitioner’s first asserted protocol is Duncan’s HTTP application protocol of the browser. Pet. 28. There appears to be no dispute that this is a “network application level protocol,” as Dr. Clark testifies that the ’214 patent uses HTTP as an exemplary “network

application level protocol.” Ex. 2006 ¶ 18. Dr. Black’s testimony supports that the target protocol of network 25 is 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 ¶ 149. Dr. Black states that Duncan’s Figure 9 illustrates 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 further clarifies 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 via a browser; 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.

Patent Owner does not otherwise challenge Petitioner’s assertions regarding Duncan. We find that Duncan teaches the uncontested limitations for the reasons given by Petitioner. Pet. 20–34; *see* Inst. 11–17. We have reviewed Petitioner’s contentions in light of the full record, and conclude that Petitioner has demonstrated by a preponderance of the evidence that Duncan renders claim 1 obvious.

D. OBVIOUSNESS OVER GROSSER AND DUNCAN

Although Petitioner asserts additionally that claim 1 is unpatentable as obvious over Grosser and Duncan, we do not reach this ground as it would not change our ultimate conclusion. *See Boston Sci. Scimed, Inc. v. Cook Grp. Inc.*, 809 F. App’x 984, 990 (Fed. Cir. 2020) (recognizing that the “Board need not

address issues that are not necessary to the resolution of the proceeding” and, therefore, agreeing that the Board has “discretion to decline to decide additional instituted grounds once the petitioner has prevailed on all its challenged claims”).

III. PETITIONER’S MOTION TO EXCLUDE

Petitioner moves to exclude portions of Exhibit 2006, the Second Clark Declaration. Specifically, Petitioner seeks to exclude paragraphs 1–21, 24–28, 30, and 31, because those paragraphs were never cited by Patent Owner in the Response. Mot. Exclude 2. In Petitioner’s view, because those paragraphs were not cited, they are not relevant and should be excluded. *Id.* Petitioner asserts prejudice from the uncited paragraphs remaining in the record—Patent Owner cites certain paragraphs only in the Sur-Reply. *Id.* (identifying Ex. 2006 ¶¶ 24–28, 30, 31). Petitioner further asserts that, even if we do not rely on the uncited paragraphs, the Motion to Exclude would not be moot because “Patent Owner could continue to rely upon them on appeal, and Petitioner would be unfairly forced to address them again.” *Id.* at 1.

Petitioner’s motion is not persuasive. We see nothing wrong with Patent Owner citing portions of a declaration for the first time in its Sur-Reply. Petitioner had the opportunity to cross examine Dr. Clark on the contents of his declarations, including portions that were not cited in the Patent Owner Response. And while our rules prohibit most new evidence in a sur-reply, they do not prohibit relying on evidence already of record. 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.”).

Additionally, Petitioner itself cited some of the paragraphs it now seeks to exclude. Pet. Reply 9 (citing Ex. 2005 ¶ 20), 12 (citing Ex. 2006 ¶¶ 18, 20), 17

(same), 23 (citing Ex. 2006 ¶ 30). Petitioner acknowledges that the standard for relevant evidence is that which “has a tendency to make a fact more or less probable than it would be without the evidence” and “the fact is of consequence in determining the action.” Mot. Exclude 2 (citing Fed. R. Evid. § 401). At a minimum, Petitioner’s own citations show that some of the information it seeks to exclude is relevant.

Accordingly, we *deny* Petitioner’s Motion to Exclude.

IV. CONCLUSION⁹

For the reasons discussed, we conclude that Petitioner has shown by a preponderance of the evidence that claim 1 is unpatentable as obvious over Duncan. In summary:

Claim(s)	35 U.S.C. §	Reference(s)/Basis	Claims Shown Unpatentable	Claims Not shown Unpatentable
1	103(a)	Duncan	1	
1	103(a)	Grosser, Duncan ¹⁰		
Overall Outcome			1	

⁹ 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).

¹⁰ As discussed above, we do not reach this ground because we hold claim 1 unpatentable as obvious over Duncan.

V. ORDER

Accordingly, it is

ORDERED that Petitioner has shown by a preponderance of the evidence that claim 1 of the '214 patent is unpatentable;

FURTHER ORDERED that Petitioner's Motion to Exclude 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.

IPR2022-00925
Patent 10,129,214 B2

PETITIONER:

Jennifer Bush
John Kind
Michael J. Sacksteder (*pro hac vice*)
FENWICK & WEST LLP
Jbush-ptab@fenwick.com
Jkind@fenwick.com
Msacksteder@fenwick.com

PATENT OWNER:

Frederick Samuels
Maurice Cahn
George Metzenthin
Cahn & Samuels, LLP
Frederick.samuels@cahnsamuels.com
Maurice.cahn@cahnsamuels.com
George.metzenthin@cahnandsamuels.com