

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKAMAI TECHNOLOGIES, INC.,
Petitioner

v.

EQUIL IP HOLDINGS LLC,
Patent Owner

Case IPR2023-00332
U.S. Patent No. 9,158,745

**PATENT OWNER’S SUR-REPLY TO PETITIONER’S REPLY TO
PATENT OWNER’S PRELIMINARY RESPONSE**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I.	THE INVENTORSHIP CORRECTION CONFIRMS SAMANIEGO IS NOT PRIOR ART.	1
A.	The effect of correction under § 256 is not limited to the patent being corrected.	1
B.	Correction of inventorship under § 256 has retroactive effect.	2
C.	Public notice concerns are not an issue here.	3
II.	THE OFFICE ALREADY CONSIDERED THE RELEVANT TEACHINGS OF TSO AND HUANG.	5
A.	Tso’s relevant teachings were previously presented to the Office.	5
B.	Huang’s relevant teachings were also previously presented to the Office.	6
C.	Petitioner has not shown material error.	7
III.	CONCLUSION	7

PATENT OWNER'S UPDATED EXHIBIT LIST

Exhibit No.	Description
2001	Declaration of Dr. Mark T. Jones in Support of Patent Owner's Preliminary Response
2002	Curriculum Vitae of Dr. Mark T. Jones
2003	Petition Under 37 C.F.R. § 1.324(a) to Correct Inventorship in a Patent
2004	U.S. Patent No. 8,381,110 to Barger et al.
2005	U.S. Patent No. 8,656,046 to Barger et al.
2006	U.S. Patent No. 6,964,009 to Samaniego et al.
2007	WO 98/43177 (International Publication of PCT/US98/05304) to Tso et al.
2008	Redline comparison of specifications of PCT/US98/05304 (Tso PCT) and U.S. Patent No. 6,421,733 (Tso)
2009	U.S. Patent No. 5,902,846 to Feret et al.
2010	First Amended Complaint for Patent Infringement, 22-677-RGA, <i>Equil IP Holdings LLC v. Akamai Technologies, Inc.</i>
2011	U.S. Patent No. 6,483,851 to Neogi
2012	Decision Granting Petition to Correct Inventorship Under § 1.324 for U.S. Patent No. 6,964,009
2013	Decision on Certificate of Correction for U.S. Patent No. 6,964,009

Petitioner's arguments in its Reply ignore the plain language of 35 U.S.C.

§ 256 and Board precedent regarding § 325(d). The Board should deny institution.

I. THE INVENTORSHIP CORRECTION CONFIRMS SAMANIEGO IS NOT PRIOR ART.

Patent Owner filed a petition under 37 C.F.R. § 1.324(a) and 35 U.S.C.

§ 256 to correct inventorship of the '009 patent. POPR, 11-13. The Office granted this petition, EX2012, and approved the request to issue a Certificate of Correction ("COC"), which was forwarded to the Certificate of Corrections Branch, EX2013.

Samaniego, thus, is not prior art to the challenged claims. POPR, 9-20.

A. The effect of correction under § 256 is not limited to the patent being corrected.

Petitioner is incorrect that § 256(b) "limits its effects to only inventorship errors in the patent being corrected." Reply, 1. The statutory language highlighted by Petitioner does not include any limit on the effect of correction under § 256(a).

See id., 2 (quoting § 256(b), with emphasis on "the patent *in which such error occurred*"). Rather, § 256(b) provides that an inventorship error "shall not invalidate" that patent if the error can be corrected, even in the ongoing case.

35 U.S.C. § 256(b).¹ Section 256(a) more broadly allows for correction of named

¹ Petitioner's arguments directed to § 256(b) being a "savings provision" are inapposite. Reply, 2. Petitioner's argument implies that the application of § 256(b) to avoid invalidity under § 102(f) limits correction under § 256(a) to only such

inventors: “Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may ... issue a certificate correcting such error.” Nothing in the statute indicates that the effect of such corrections are limited solely to the patent being corrected.

B. Correction of inventorship under § 256 has retroactive effect.

Petitioner argues, incorrectly, that the correction of inventorship cannot have retroactive effect. Reply, 2-3. Petitioner quotes language from §§ 254-255, arguing that COCs only have a prospective effect on “the trial of actions for causes thereafter arising.” Reply, 2-3 (quoting §§ 254-255). But Petitioner ignores that the *relevant statute*—§ 256, the statute under which Patent Owner requested a COC—does not include this language. Statutory interpretation “begins with the ‘language of the statute.’” *Hughes Aircraft Co. v. Jacobson*, 525 U.S. 432, 438 (1999).

Petitioner cannot read a requirement into § 256 that is not there. This is particularly true where the requirement Petitioner attempts to include is expressly recited in a related section of the statute, yet *not* in the relevant statute. *Res-Care, Inc. v. United States*, 735 F.3d 1384, 1389 (Fed. Cir. 2013) (“A cardinal doctrine of statutory interpretation is the presumption that Congress’s use of different terms within related statutes generally implies that different meanings were intended.”).

effect. *Id.* But the statute simply does not contain such limiting language. Nor does *Pannu v. Iolab Corp.*, 155 F.3d 1344 (Fed. Cir. 1998), support this position.

In fact, correction of inventorship under § 256 *has been* applied retroactively. *See Emerson Elec. Co. v. SIPCO, LLC*, IPR2016-00984, Paper 52, 17-21 (P.T.A.B. Jan. 24, 2020) (on remand) (finding that a COC issued under § 255 does not have retroactive effect; contrasting that “certificates issued under ... section [256] have retroactive effect in general”); *Roche Palo Alto LLC v. Ranbaxy Labs Ltd.*, 551 F. Supp. 2d 349, 357-359 (D.N.J. 2008) (comparing the prospective effect of corrections under § 254 with the retroactive effect of corrections under § 256); *Viskase Corp. v. Am. Nat’l Can Co.*, 261 F.3d 1316, 1329 (Fed. Cir. 2001) (“Absent fraud or deceptive intent, the correction of inventorship does not affect the validity or enforceability of the patent for the period before the correction.”); *LendingTree, LLC v. Zillow, Inc.*, 656 Fed. Appx. 991, 998-99 (Fed. Cir. 2016) (remanding in view of post-judgment COC changing inventorship to permit patent owner to file a motion to vacate judgment of invalidity based on improper inventorship).

C. Public notice concerns are not an issue here.

Petitioner argues that public notice concerns mean that the correction should not have retroactive effect. Reply, 3-4. But here, there is no concern that the public was not aware of the priority claim. The ’745 patent claims priority to the ’009 patent *on its face*. EX1001, (60); *see also* EX1002, 84 (ADS with priority claim).²

² Petitioner contends “correction of inventorship through reissue ... would have

The requirements of § 120 are met for the '745 patent's claim of priority to the '009 patent. *See* POPR, 9-20. The inventorship correction is simply an administrative correction to list the proper inventors on the '009 patent. *See Egenera, Inc. v. Cisco Systems, Inc.*, 972 F.3d 1367, 1379 (Fed. Cir. 2020) (inventorship corrections under § 256 are “a matter of formality”); *Winbond Elecs. Corp. v. Int’l Trade Comm’n*, 262 F.3d 1363, 1371 (Fed. Cir. 2001) (“‘Incorrect inventorship is a technical defect in a patent that may be easily curable.’ ... Rule 324 permits such an easy cure.” (quoting *Canon Comput. Sys., Inc. v. Nu-Kote Int’l, Inc.*, 134 F.3d 1085, 1089 (Fed. Cir. 1998))) (opinion corrected, 275 F.3d 1344 (Fed. Cir. 2001)).

Petitioner's discussion of *Southwest Software, Inc. v. Harlequin Inc.*, 226 F.3d 1280 (Fed. Cir. 2000) is not relevant. Reply, 3-4. *Southwest Software* dealt with a correction under § 254, and the decision focuses on the “for causes thereafter arising” statutory language. 226 F.3d at 1292-1297. As discussed above, § 256 does not include similar language. Further, the correction in *Southwest Software* changed the substance of the patent (adding a 330 page “Program provided public notice through a republished revised inventive entity.” Reply, 4 n.4. Yet, cited MPEP 1402(II) states: “If the only change being made in the patent is correction of the inventorship, this can be accomplished by filing a request for a certificate of correction under the provisions of 35 U.S.C. 256 and 37 CFR 1.324.”

Printout Appendix” to the specification), *id.* at 1296, not inventorship.

Correction of inventorship here is more analogous to when a patent owner of a pre-AIA patent antedates or swears behind an asserted reference. *See Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d 1004, 1007 (Fed. Cir. 2016) (“Pre–AIA section 102(g) allows a patent owner to antedate a reference by proving earlier conception and reasonable diligence in reducing to practice.”). In such a case, the public is likely to have no notice at all that the reference is not prior art, yet here the priority claim is listed on the face of the patent.

Each of Petitioner’s arguments against determining that Samaniego is not prior art fails. Accordingly, four of Petitioner’s six grounds also fail.

II. THE OFFICE ALREADY CONSIDERED THE RELEVANT TEACHINGS OF TSO AND HUANG.

A. Tso’s relevant teachings were previously presented to the Office.

There is no dispute that Tso PCT was cited in an IDS during prosecution of the ’745 patent. Reply, 6; POPR, 27 (citing EX1002, 71-80); *see also* EX1027, 533-578 (copy of Tso PCT provided to Office in parent application 12/238,842). Thus, under the Board’s *Advanced Bionics* precedent, Tso PCT was unquestionably “presented to the Office” and satisfies Part 1 of the *Advanced Bionics* framework. *Advanced Bionics v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, 7-8 (P.T.A.B. Feb. 13, 2020) (precedential).

Petitioner’s claim that “it was ‘not reasonably foreseeable for Petitioner to

have anticipated this connection since the references themselves do not point to each other,” Reply, 7 (citing *Google LLC v. Valtrus Innovs. Ltd.*, IPR2022-01197, Paper 12, 5 (P.T.A.B. Mar. 29, 2023)), is unconvincing and shows a lack of diligence. Both Tso and Tso PCT claim priority to the same US provisional application and it was reasonably foreseeable to anticipate the connection between these references. *See* POPR, 27 n.9. In any event, *Valtrus* did *not* require the Board to institute on remand; it simply authorized Petitioner to file a reply on remand, and instructed the Board to re-evaluate the § 325(d) issue. *See Valtrus*, Paper 12, 6-7. Here, Petitioner has been given an opportunity to file a reply addressing Tso PCT and admits that Tso and Tso PCT have the same disclosure. Reply, 6.

B. Huang’s relevant teachings were also previously presented to the Office.

Relevant teachings of Huang were likewise previously presented to the Office. POPR, 28-29. On reply, Petitioner points out Huang’s teaching of “using ‘RHI’ information to track ‘partially rendered’ and cached content,” Reply, 5, and argues that “Neogi does not discuss caching, storing, or reusing ... transcoded content,” *id.*, 6. Huang’s “RHI” or “receiver hint information” is described as “specific device capabilities” associated with the requesting client device. EX1005, 5:44-55, 7:46-48. The object rendering in Huang is “based on the associated RHI” and “can be partitioned into two or more steps,” with the object being passed from proxy server to proxy server. *Id.*, 6:9-23. Similarly, in Neogi, transcoding the data

flow is done by intermediate filtering stages 22 that are determined based on

“control parameters contained in the coded instructions sent to it by a user.”

EX2011, 1:53-60, 2:52-3:4, FIG. 3. Like Huang, which can store a copy of a

“partially rendered” object in the cache for use by a subsequent proxy server for

“further rendering,” EX1005, 7:43-45, 7:53-57, 8:4-11, Neogi also stores the data

flow in buffer pools between the transcoding functions performed at multiple

intermediate stages 22, EX2011, 2:52-56, 2:65-3:4, 3:18-30.

C. Petitioner has not shown material error.

Petitioner’s allegation of error under *Advanced Bionics* Part 2 is premised on the Examiner not issuing any rejections before allowance. Reply, 7. This is not required to deny the Petition under § 325(d). POPR, 28. Petitioner alleges nothing more than disagreement with the Examiner’s allowance of the claims in view of the combination of Tso and Huang. Reply, 4-5, 7. Petitioner does not argue—as required under *Advanced Bionics* Part 2—that the Office “misapprehend[ed] or overlook[ed]” any specific teachings of Tso PCT or Neogi, which were considered, or “misconstru[ed]” any claim terms. *Advanced Bionics*, Paper 6, 8-9 n.9.

III. CONCLUSION

Samaniego is not prior art and the relevant teachings of Tso and Huang were previously considered by the Office. For these reasons and all other reasons in the POPR, the Board should deny institution.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jason A. Fitzsimmons/

Jason A. Fitzsimmons
Registration No. 65,367
Counsel for Patent Owner

Date: June 8, 2023

1100 New York Avenue, N.W.
Washington, D.C. 20005-3934
(202) 371-2600

CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e))

I certify that the above-captioned **PATENT OWNER'S SUR-REPLY TO
PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE** and **EXHIBIT 2013** were served in their entireties on June 8, 2023
upon the following parties via electronic mail:

Scott McKeown (Lead Counsel) scott.mckeown@ropesgray.com
James L. Davis (Back-Up Counsel) james.l.davis@ropesgray.com
Daniel W. Richards (Back-Up Counsel) daniel.richards@ropesgray.com
akamai-equil-ropes-ipr-service@ropesgray.com

ROPES & GRAY LLP

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Jason A. Fitzsimmons/

Jason A. Fitzsimmons
Registration No. 65,367
Counsel for Patent Owner

Date: June 8, 2023

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