

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ERICSSON INC.,
Petitioner,

v.

KONINKLIJKE KPN N.V.,
Patent Owner.

Case IPR2023-00581
Patent 8,886,772

PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S EXHIBIT LIST

Exhibit	Description
2001	Declaration of Mr. Regis J. (Bud) Bates, Jr. in Support of Patent Owner
2002	Curriculum Vitae of Regis J. (Bud) Bates, Jr.
2003	U.S. Patent No. 9,838,256 (“the Child ‘256 Patent”)
2004	U.S. Patent No. 8,089,953 (“Angelot Patent”)
2005	First Amended Docket Control Order in <i>Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson</i> , 22-cv-00282 (E.D. Tex.) (D.I. 101)
2006	United States District Courts – National Judicial Caseload Profile, https://www.uscourts.gov/sites/default/files/data_tables/fcms_na_distp rofile0331.2023.pdf
2007	Docket Sheet for <i>Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson</i> , 22-cv-00282 (E.D. Tex.)
2008	Ericsson’s P.R. 3-3 Invalidity Contentions in <i>Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson</i> , 22-cv-00282 (E.D. Tex.) (information designated confidential in Texas Action redacted)

I. INTRODUCTION

Patent Owner Koninklijke KPN N.V. (“KPN”) submits this Preliminary Response to the Petition for *Inter Partes* Review filed by Petitioner seeking review of Claims 2-6, 11, 14, and 16 of U.S. Patent No. 8,886,772 (EX1001) (“the ’772 Patent”). The Board has already denied two previous petitions against the ’772 Patent,¹ and KPN respectfully requests that the Board do so again.

The Petition’s arguments with respect to Claims 2-6, 11, 14, and 16 (“Challenged Claims”) ignore previous claim constructions and lack support. The Petition presents one proposed anticipation ground and two proposed obviousness grounds against the Challenged Claims. Contrary to Petitioner’s arguments, the Challenged Claims each recite limitations not disclosed, taught, or suggested by the alleged prior art Angelot and Zakurdaev.

Angelot does not disclose, teach, or suggest at least one limitation in each of the Challenged Claims. As a preliminary matter, “relaying” is a different form of

¹ *Samsung Elecs. Co. v. Koninklijke KPN N.V.*, IPR2016-00808, Paper 6 (PTAB Sep. 19, 2016); *Xiaomi Communications Co., Ltd. v. Koninklijke KPN NV*, IPR2022-00025, Paper 6 (PTAB Apr.19, 2022) (KPN disclaimed claims 1, 7-10, 12, 13 and 15; not instituted).

sending a message than merely “forwarding.” As recognized by the U.S. District Court in the Eastern District of Texas, “relay” recited in the Challenged Claims has a very specific meaning distinct from “forward” and means to “change, process, or otherwise manage a request based at least in part on its payload.”

With that in mind, with respect to Claims 2-6, 11, 14, and 16 and Petitioner’s first ground, Angelot does not disclose “relay the request to the identified ACS” or “relay the reply to the manageable electronic device.” Angelot never discloses sending a message via relaying. At most, Angelot discloses that a central server may “redirect” or “forward” configuration settings—but not “relay” those settings. Petitioner’s repeated attempts to substitute the term “relay” for the term “forward” in Angelot are improper and do not transform Angelot’s pervasive teaching of “forwarding” into “relaying.” Rather, they stand out as a failed sleight of hand.

Further, with respect to Claims 2, 11, 14, and 16, Angelot does not disclose “wherein the ACSMD is further configured to receive a reply from the identified ACS, and relay the reply to the manageable electronic device.” First, Petitioner attempts to combine multiple embodiments of Angelot, i.e., the embodiment of ¶¶[0043]-[0054] with the embodiment of ¶[0062], to arrive at the Challenged Claims. This is a violation of *Net MoneyIN v. Verisign*, 545 F.3d 1359, 1371 (Fed. Cir. 2008), and related cases that hold that, for anticipation, “it is not enough that the

prior art reference discloses . . . distinct teachings that the artisan might somehow combine to achieve the claimed invention.”

Second, Petitioner’s combination of Angelot embodiments is not technically possible. In the ¶[0062] embodiment, the redirect server 14 “directly request[s],” acquires, and then *forwards* configuration setting data to the network entity. In contrast, in all *other embodiments* in Angelot, configuration setting data, after being requested by the network entity, is sent *directly* to the network entity, without any intermediate action by the redirect server 14. The Petition did not present any argument or evidence that a POSITA would “at once envisage” the proposed combination of Angelot embodiments. *Chamberlain Grp., Inc. v. Techtronic Indus. Co.*, 935 F.3d 1341, 1350 (Fed. Cir. 2019) (quotation omitted).

Third, with respect to the ¶[0062] embodiment of Angelot, this embodiment does not disclose what triggers the redirect server to “directly request” configuration settings from the configuration server. In contrast, the Challenged Claims require that the ACSMD make that request responsive to receiving a request for configuration data from a manageable electronic device.

Fourth, with respect to the ¶[0062] embodiment of Angelot, this embodiment does not disclose that the server 14 does any type of “processing” of a reply when “forwarding” configuration settings. Petitioner once again improperly mixes elements of the ¶[0062] embodiment with elements of the ¶¶[0043]-[0054]

embodiment. Further, there is simply no teaching or suggestion in ¶[0062] or anywhere else in Angelot of “in response to receiving a configuration file named iphone12a-mac-00-a1-b2-b3-c4-d5.cfg, the server 14 looks to database 22 to determine the MAC address of the phone where the configuration file will be provided/relayed,” as asserted by Petitioner and its expert.

Further, with respect to Claims 3-6 and Petitioner’s first ground, Angelot does not disclose “wherein the ACSMD is further configured to identify the type of the manageable electronic device by comparing a network address of the manageable electronic device in the request with a predetermined plurality of network addresses in the at least one database.” The claimed “network address” is, for example, an IP address, and Angelot discloses at most using a MAC address, which is a hardware identifier on a data link, not a network address at a network layer. Further, although Angelot discusses that a MAC address can be used to identify the manufacturer of a network device or a “class” of network device (i.e., “enterprise device” or “consumer device”), Angelot fails to disclose that a MAC address can be used to identify the “type” of network device as required by Challenged Claims 3-6.

With respect to Challenged Claims 2-6, 11, 14, and 16 and Petitioner’s second ground, Petitioner’s attempts to replace Angelot’s disclosure of “redirecting” and “forwarding” with “relaying” fall flat. Petitioner’s attempt to rely on Jin is improper under *Advanced Bionics, LLC v. Med-El Elektromedizinische Gerate GMBH*,

IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential). Petitioner also mischaracterizes the '772 Patent's statement "as known in the art" as an admission that "'relaying' information" was not new, when, in fact, KPN never made or relied on any contrary assertion to begin with. KPN even secured allowance of the '772 Patent by citing numerous references during prosecution explicitly discussing how "relaying" differs from "forwarding." Accordingly, Jin's general discussion of a "Subnet Relay Agent" is merely cumulative to references already cited by KPN and considered by the Examiner.

In any case, Petitioner fails to provide proper motivation to modify Angelot to use "relaying" instead of "forwarding." The Petition's assertions regarding modifying Angelot amount to no more than suggesting Angelot could be modified to use relaying, and are based on a solution to a problem that simply does not exist in Angelot. Forwarding works perfectly well in Angelot—indeed, forwarding is a principle of operation in Angelot—so why the need to relay? POSITAs do not solve non-existent problems (and are not motivated to change the principle of operation of a purported invention).

In addition, with respect to Challenged Claims 2-6, 11, 14, and 16 and Petitioner's third ground, Zakurdaev also fails to teach "relay the request" or "relay the reply" as recited in the Challenged Claims. In Zakurdaev, the "relay" is a device—not an action; Zakurdaev describes only a relay device that forwards—not

relays. As with Angelot, Petitioner's numerous repeated attempts to substitute the term "relay" for the term "forward" in Zakurdaev are improper and unavailing.

Further, with respect to Claims 2-6, 11, 14, and 16 and all of Petitioner's grounds, Angelot does not teach or suggest "identify an ACS from the plurality of ACSs in accordance with the identification of the manageable electronic device." In view of ¶[0054], Angelot might be interpreted as teaching at most to "identify [*a service provider*] from the plurality of [*service providers*] in accordance with the identification of the manageable electronic device." But a "service provider" cannot be equated with a "configuration server" in Angelot, something made clear by Fig. 3a, which shows that a "service provider" may host multiple "configuration servers." Thus, Petitioner's interpretation of the "configuration server" in Angelot as the "ACS" of Claims 2-6, 11, 14, and 16 fails to align Angelot's teaching with "identify an ACS from the plurality of ACSs in accordance with the identification of the manageable electronic device."

Additionally, the Board should deny institution under § 325(d) because the USPTO used Angelot in a rejection against what Petitioner itself has characterized as "nearly identical claims" and "substantially similar claims to those at issue here" in a child application of the '772 Patent. In that rejection, the Examiner (who also allowed the application that granted as the '772 Patent) conceded that Angelot did not disclose one of the claim limitations shared by that application and the '772

Patent. Petitioner is now urging that the Board take a contrary position to what the Examiner concluded on that claim term, without demonstrating that the USPTO materially erred—violating *Advanced Bionics*.

Lastly, the parties are involved in co-pending litigation, *Koninklijke KPN N.V. v. Telefonaktiebolaget LM Ericsson*, 22-cv-00282 (E.D. Tex.) (“Texas Action”), and the Board should deny institution under § 314(a) given the advanced stage of the Texas Action. The *Fintiv* factors weigh in favor of discretionary denial, including that trial in the Texas Action will occur five-to-six months before a final written decision would be due in an IPR. Further, in view of the Petition’s substantive deficiencies discussed herein, the Petition has failed to present compelling evidence of unpatentability (and never even asserts that it has done so).

For at least these reasons, the Board should deny the Petition and not institute trial.

II. THE ’772 PATENT

The ’772 Patent describes a system and method for remote device management. With the growth of the Internet and related technologies, there are now billions of electronic devices that connect to the Internet and/or private networks. According to the ’772 Patent, many of these devices may be remotely managed over such networks by a dedicated auto-configuration server (“ACS”). EX1001, 1:34-45. This management may relate “to auto-configuration and

dynamic service provisioning, software management, status and performance monitoring and diagnostics.” *Id.* 1:35-37.

A. The ’772 Patent’s Discussion of the Prior Art

The ’772 Patent states that “typically” each manageable electronic device was pre-configured with a specific address or uniform resource locator (“URL”) of its dedicated ACS. *Id.* 1:46-60. Manageable electronic devices were assigned to dedicated ACSs based on the characteristics or uses of the device, such as “a certain level of services (e.g. premium, best effort),” “type of device (e.g. Home Gateway, Voice over IP telephone, or Set TopBox),” or “a specific customer group (e.g. business or residential).” *Id.* 1:46-49.

Figure 1 of the ’772 Patent, reproduced below, shows an example of such an arrangement found in the prior art. *Id.* 3:46-47.

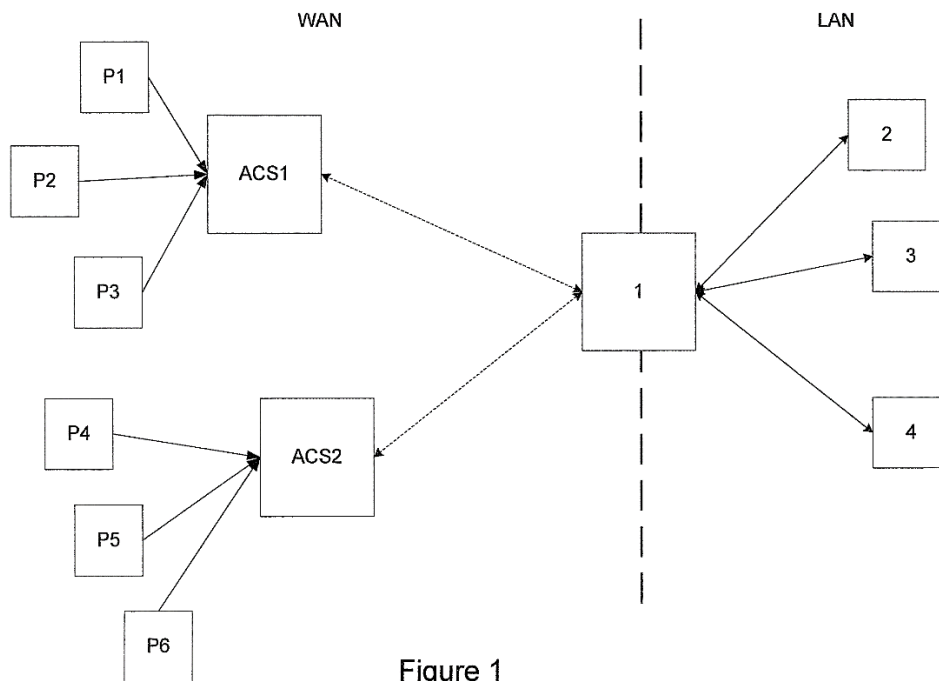


Figure 1

In Figure 1, a manageable electronic device 1 connects a local area network (LAN) to a wide area network (WAN). *Id.* 3:64-67. The LAN communicatively couples devices 2, 3, and 4 (which may also be manageable electronic devices) with manageable electronic device 1. *Id.* 3:67-4:4. In some scenarios, the LAN may be a home network or an office network, but can be distributed over multiple geographic locations. *Id.* 4:5-9.

The WAN may be the Internet, as one example. *Id.* 4:10-13. The WAN communicatively couples auto-configuration server 1 (ACS1) and auto-configuration server 2 (ACS2) to manageable electronic device 1. *Id.* 4:22-29, 4:35-39. ACS1 and ACS2 contain configuration data for manageable electronic device 1 and manageable electronic device 2, respectively. *Id.* 4:22-29. This auto-

configuration data may have been delivered to ACS1 and ACS2 by one or more of provisioning systems P1, P2, P3, P4, P5, and P6. *Id.* 4:30-32.

A manageable electronic device, (such as manageable electronic devices 1 and 2) may require configuration data from its dedicated auto-configuration server (ACS 1 in the case of manageable electronic device 1 and ACS 2 in the case of manageable electronic device 2). *Id.* 4:22-29, 4:40-43. In order to communicate with the appropriate ACS, in this example, the manageable electronic device is pre-configured, prior to installation in the LAN, with the IP address or URL of the proper ACS. *Id.* 4:48-50, 4:55-57.

The pre-configuring of IP addresses or URLs of ACSs, however, is time consuming and sensitive to errors and mistakes. *Id.* 1:53-60. Given the large number of manageable electronic devices on various networks and the time required for pre-configuring, the errors and mistakes that result therefrom are multiplied accordingly. *See id.*

B. The '772 Patent's Advantages Over the Prior Art

In order to overcome at least these shortcomings, the '772 Patent discloses embodiments for remote device management that include an auto-configuration server managing device (ACSMD) communicatively coupled with at least one database and a plurality of ACSs by a network. *Id.* Abstract. According to the '772 Patent, this arrangement improves over the prior art by eliminating at least

some of the problems related to pre-configuring manageable electronic devices.

Id. 1:64-65. For example, in one embodiment, instead of pre-configuring a manageable electronic device with an IP address or URL of an ACS, the manageable electronic device can be configured with the IP address of the ACSMD instead. *Id.* 5:51-55.

Figure 2 of the '772 Patent, reproduced below, shows an example of such an arrangement. *Id.* 4:62-63.

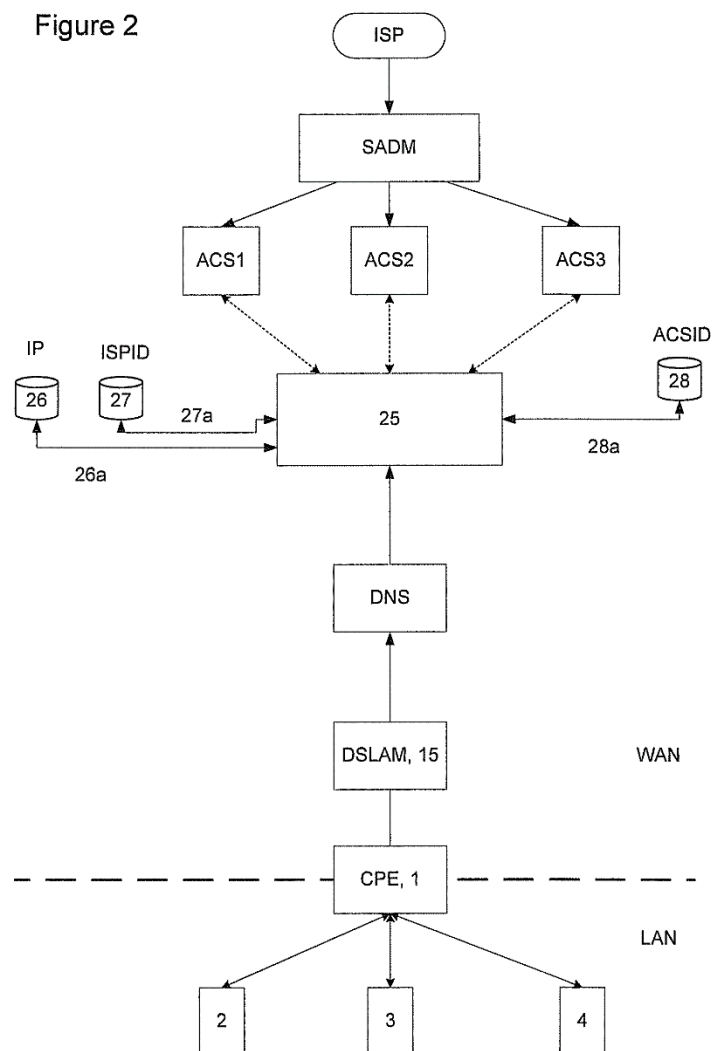


Figure 2 uses the same reference numerals as Figure 1 to refer to corresponding entities. *Id.* 4:64-65. But Figure 2 also includes, in the WAN, a digital subscriber line access multiplexer (DSLAM) 15, a domain name system (DNS) server, an auto-configuration server managing device (ACSMD) 25, and databases 26, 27, and 28. *Id.* 4:66-5:3. Further, a service activation device manager (SADM) may provide an Internet service provider (ISP) and/or other entities access to the ACSs. *Id.* 5:22-26.

In embodiments of the '772 Patent, an ACS can be selected for auto-configuration based on identifying information of manageable electronic device 1, e.g., an IP address of manageable electronic device 1. *Id.* 6:29-43. In this manner, ACSMD 25 can select an ACS that meets the configuration needs of manageable electronic device 1. *Id.* 6:52-55. Doing so dramatically reduces complexity and errors by allowing multiple manageable electronic devices to be pre-configured with the same ACSMD address. *See id.; compare id.* 1:53-60.

1. The ACSMD selects an ACS in response to a request from the manageable electronic device

In an embodiment, manageable electronic device 1 may include a pre-configured IP address or URL for ACSMD 25. *Id.* 5:51-55. Accordingly, in this arrangement, manageable electronic device 1 transmits a request for configuration data to ACSMD 25. *Id.* 5:56-59; *see also* Fig. 5 (M1). Such a request may include

identifying information of manageable electronic device 1, such as an IP address of manageable electronic device 1. *Id.* 6:5-6. Further, the request may include identification of the type of manageable electronic device. *Id.* 9:37-40.

After receiving the request, ACSMD 25 compares identifying information of the manageable electronic device 1 to a database (e.g., database 26). For example, the database may contain IP addresses that are valid for access to ACSMD 25. *Id.* 6:10-15. In such an embodiment, if the IP address of manageable electronic device 1 matches one of the IP addresses in the database, the auto-configuration process continues; otherwise it terminates. *Id.* 6:19-24.

Next, ACSMD 25 may determine the appropriate ACS based on identifying information of manageable electronic device 1. *Id.* 6:29-43. ACSMD 25 can do so by way of a lookup in one or more other databases (e.g., databases 27 and/or 28). *Id.*

2. The ACSMD functions as an intermediate in the system

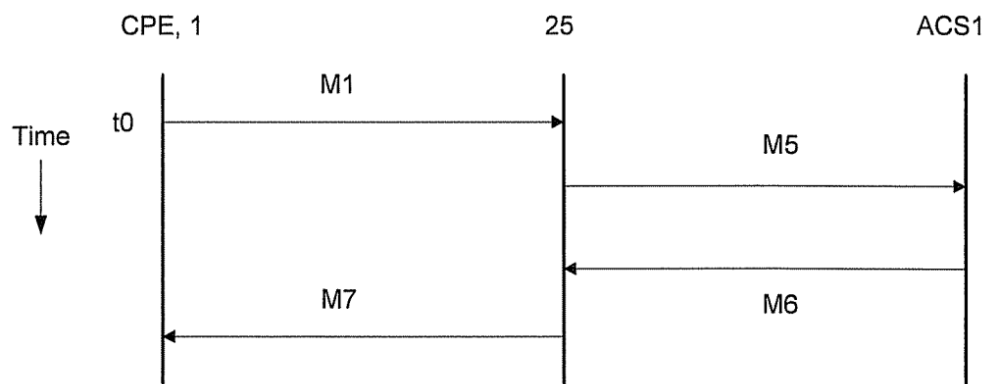
In some embodiments, ACSMD 25 “functions as an intermediate” between manageable electronic device 1 and the selected ACS. *Id.* 6:65-66, 8:9. For example, ACSMD 25 can relay the request to the selected ACS, receive a reply from the selected ACS containing configuration data for manageable electronic device 1, and relay the reply to manageable electronic device 1. *Id.* 6:63-7:3. Manageable electronic device 1 may use the configuration data to configure itself.

Id. 8:33-37.

Figure 5 of the '772 Patent, reproduced below, shows an example signal flow between manageable electronic device 1, ACSMD 25, and the selected ACS.

Id. 3:54-55.

Figure 5



In Figure 5, manageable electronic device 1 is represented by line CPE, ACSMD 25 is represented by line 25, and the selected ACS is represented by line ACS1. *Id.* 7:53-57.

In an embodiment, ACSMD 25 relays a first relayed message M5 to the selected ACS, the selected ACS receives the first relayed message M5 and transmits a reply M6 to ACSMD 25, and the ACSMD 25 receives the reply M6 and relays the reply M6 to manageable electronic device 1 as a second relayed message M7. *Id.* 8:8-31.

As set forth by KPN during prosecution of the application that issued as the '772 Patent, "relaying" is a different form of sending a message than merely "forwarding":

One of ordinary skill in the art would, in this case, recognize that *relaying* a request includes the possibility to change, process, or otherwise manage the request, all of which would require that the ACSMD unravel the incoming message to determine what action, if any, is required to be taken. By way of example, an incoming TR-069 message (e.g., a message generated according to the TR-069 protocol) could be translated into UPnP message (e.g., a message generated according to the UPnP protocol) as part of *relaying* the message to its destination. Such a translation is accommodated by an "ACSM[D] ... configured to relay" a request, as recited in claim 1, but could not occur for a message that is *forwarded*, as is the case for Acke [the cited reference discussing the TR-069 communication protocol (*see also* Pet., 6)].

EX1004, 85-86. "Forwarding," in contrast:

As one of ordinary skill in the art would readily understand, *forwarding* session requests and connection requests entails transferring messages from a receiving incoming port of a device to an appropriate transmitting outgoing port of the device, *without changing or processing the messages*. That is, the device, such as a proxy server, does not process or even read the payload of a message that is to be forwarded, but merely reads the message header to determine the correct outgoing port, and then substitutes the

previously used header - which will have, e.g., addressed the proxy server since that is where the message was delivered - with a new header indicating the new address, being the address to which the proxy server *forwards* the message.

Id. at 85. As set forth in the ServerWatch Tutorial “Back to Basics: The DHCP Relay Agent” submitted to the Examiner during prosecution:

This is because the concepts for Relay and Forwarding are quite different. Forwarding implies that the message is forwarded from one interface to another, without any special processing. Relay implies that the message is processed to a greater extent, which may include changes being made to the original packet.

Id. at 23, 38-42.

C. The Challenged Claims

1. Claims 2, 11, 14, and 16

Claim 2 depends from disclaimed Claim 1, and therefore Claim 2 includes the limitations of disclaimed Claim 1. Claim 2 (rewritten in independent form) recites:

2. A system for remote device management comprising:
a plurality of auto-configuration servers (ACSs);
a manageable electronic device;
an auto-configuration server managing device (ACSMD) for
controlling access to the ACSs communicatively coupled
intermediately between the plurality of ACSs and the managed
electronic device; and

at least one database communicatively coupled to the ACSM
and storing information for the identification of electronic devices,
wherein the manageable electronic device is configured to send
a request for configuration data to the ACSMD,
wherein configuration data comprise data for configuring the
manageable electronic device, and
wherein the ACSMD is configured, responsive to receiving the
request, to:

identify the manageable electronic device by comparing
at least a portion of the request with the information for the
identification of electronic devices of the at least one database,
and

identify an ACS from the plurality of ACSs in
accordance with the identification of the manageable electronic
device to provide configuration data to the manageable
electronic device, and

wherein the ACSMD is further configured to relay the request
to the identified ACS,

wherein the ACSMD is further configured to receive a reply
from the identified ACS, and relay the reply to the manageable
electronic device.

Claims 11, 14, and 16, which depended from disclaimed Claims 10, 12, and
15, respectively, recite virtually identical claim elements as Claim 2. The Petition
does not distinguish between Claim 2 and Claims 11, 14, and 16. Instead, the

Petition refers to Claim 2 for its arguments against Claims 11, 14, and 16. Pet., 52, 54, 55, (each stating see “claim 2”).

2. Claims 3-6

Claim 3 depended from disclaimed Claim 1, and therefore Claim 3 includes the limitations of disclaimed Claim 1. Claim 3 (rewritten in independent form) recites:

3. A system for remote device management comprising:
 - a plurality of auto-configuration servers (ACSs);
 - a manageable electronic device;
 - an auto-configuration server managing device (ACSMD) for controlling access to the ACSs communicatively coupled intermediately between the plurality of ACSs and the managed electronic device; and
 - at least one database communicatively coupled to the ACSMD and storing information for the identification of electronic devices,
 - wherein the manageable electronic device is configured to send a request for configuration data to the ACSMD,
 - wherein configuration data comprise data for configuring the manageable electronic device, and
 - wherein the ACSMD is configured, responsive to receiving the request, to:
 - identify the manageable electronic device by comparing at least a portion of the request with the information for the

identification of electronic devices of the at least one database,
and

identify an ACS from the plurality of ACSs in
accordance with the identification of the manageable electronic
device to provide configuration data to the manageable
electronic device, and

wherein the ACSMD is further configured to relay the request
to the identified ACS,

wherein the ACSMD is further configured to identify the type
of the manageable electronic device by comparing a network address
of the manageable electronic device in the request with a
predetermined plurality of network addresses in the at least one
database.

Claims 4-6 depend from Claim 3.

III. THE ALLEGED PRIOR ART

The Petition presents three proposed grounds of unpatentability against the Challenged Claims. Ground 1 alleges the Challenged Claims are unpatentable as being anticipated by Angelot (U.S. Patent Publication No. 2009/0201830) (EX1006). Ground 2 alleges obviousness of the Challenged Claims in view of Angelot and the knowledge of a POSITA. And Ground 3 alleges obviousness of the

Challenged Claims in view of Angelot and Zakurdaev (U.S. Patent Publication No. 2002/0073182) (EX1007).

A. Angelot

Angelot discloses a “system for configuring a plurality of network entities . . . each of the network entities being associated with at least one service provider having configuration settings data therefor.” EX1006, Abstract. Angelot’s disclosure states that “[s]everal preferred embodiments of the present invention will now be described, by way of example only, with reference to the appended drawings.” *Id.* ¶[0034].

Figure 1 of Angelot, reproduced below, illustrates “a preferred embodiment” of the system. *Id.* ¶[0035].

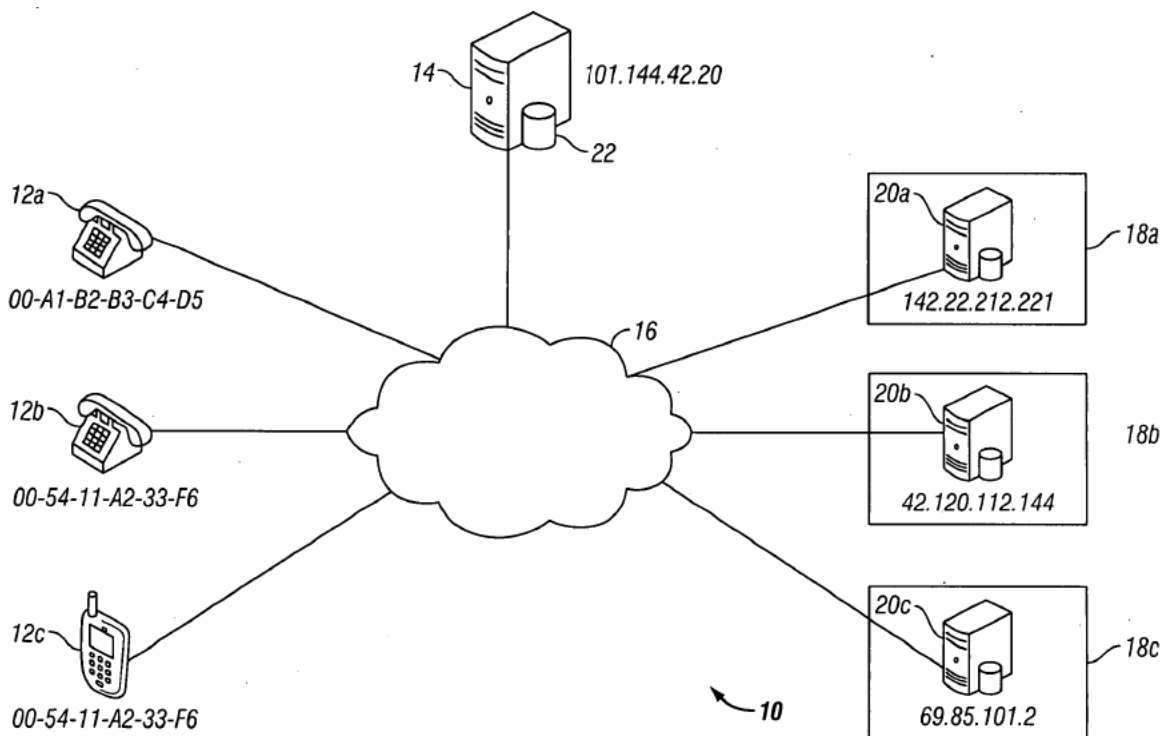


FIG. 1

As shown in Figure 1, the system in this embodiment for configuring network entities associated with service providers includes network entities 12a, 12b, and 12c (e.g., IP phones) that “send a request for configuration settings” to a “central server 14.” *Id.* ¶[0046]. “[T]he central server 14” then, in an embodiment cited by Petitioner (*see* Pet., 43 (incorrectly substituting the term “relays” for “forwards”)), “forwards [the] query to the appropriate configuration server.” EX1006, ¶[0047]. Accordingly, “the configuration settings are provided to the network entity 12a, 12b, or 12c, and so each of the network entities 12a, 12b, or 12c is automatically configured.” *Id.*

According to Angelot, with reference to Fig. 2, “a request for configuration settings from the IP phone 12a” can include “identity data of the IP phone 12a, such as the unique MAC address.” *Id.* ¶[0054]. “As part of the provisioning process the MAC address of the IP phone 12a, is associated with at least [one] of the service providers 18a, 18b, or 18c (step 104 [Fig. 2]), at the central server 14.” *Id.* ¶[0051].

According to Angelot, the central server 14 “[p]referably” includes “a database 22 for storing the records of the MAC addresses and the associated service provider 18a, 18b, or 18c, such as a first mapping table . . . , as shown in FIG. 3a.” *Id.* Figure 3a’s mapping table for mapping device MAC addresses to service providers is shown below:

IP Device MAC address	00-A1-B2-B3-C4-D5	00-54-11-A2-33-F6	00-54-11-A2-33-F6		XX-XX-XX-XX-XX
SERVICE PROVIDER ID	SP 18a	SP 18b	SP 18c		SP 18x
Configuration server(s) (IP address)	142.22.212.221 100.232.2.214 72.12.15.32 120.200.45.255 222.48.25.66	42.120.112.144 144.110.212.20	69.85.101.2		YY.YYY.Y.YYY

FIG. 3a

As disclosed in this embodiment, upon receipt of the request by the central server, “the central server 14 processes the request to determine whether the first mapping table comprises the unique MAC address associated with the request, and also determines which of the plurality of service providers 18a, 18b, 18c the MAC address belongs to.” *Id.* ¶[0054]. “[T]he central server 14 then redirects the request

to an appropriate service provider 18a, 18b or 18c, as per first mapping table (step 114).” *Id.*

As indicated in step 116 of the embodiment in Figure 2, “a configuration server 20a, 20b or 20c, associated with the appropriate service provider 20a, 20b or 20c [*sic*], selects the configuration settings for the IP phone 12a with that specific MAC address as per second mapping table, and forwards the relevant configuration settings data to the IP phone 12a.” *Id.*

Accordingly, in the embodiment of Angelot shown in Figures 1 and 2 and discussed in ¶¶[0043]-[0054], a configuration server, which Petitioner maps to an ACS in the Challenged Claims (*see* Pet., 45), “forwards the relevant configuration settings data to the IP phone 12a.” EX1006, ¶[0054]. In this embodiment, the configuration server neither “relays” the configuration settings nor sends the settings in any manner to the central server 14 (which Petitioner maps to the ACSMD in the Challenged Claims (*see* Pet., 45)) to send to the IP phone 12a. EX2001 (“BatesDec”), ¶98. Rather, the configuration server sends the settings directly to the phone. *Id.*

Angelot discloses several other embodiments at ¶¶[0055]-[0063], each reciting “[i]n another exemplary embodiment” or “[i]n yet another exemplary embodiment.” BatesDec, ¶¶99-100. Petitioner cites one of those embodiments (*see* Pet., 32-33) for the concept of the server 14 acting as “a proxy or intermediary, by

communicating with one of the configuration servers 20a, 20b or 20c to *directly* request and acquire the configuration settings data, and then forwarding the configuration setting data to the network entity 12a.” EX1006, ¶[0062] (emphasis added). That embodiment is silent, however, as to why the server 14 would make such a request and, if not actually made “directly” from the server, where such a request would have come from. BatesDec, ¶¶101-102.

Angelot does not refer to “relay” even once. *Id.* ¶103. In fact, in an Office Action in a child of the ’772 Patent, U.S. Patent Application No. 14/938,056 (“the Child ’056 Application”) (now U.S. Patent No. 9,838,256 (“the Child ’256 Patent”)), a USPTO Examiner found that Angelot does not disclose “the auto-configuration server manager further being arranged for . . . relaying the request to the identified auto-configuration server.” EX1019, 42; *compare to* EX1001, 10:9-10 (“wherein the ACSMD is further configured to relay the request to the identified ACS”).

B. Zakurdaev

Petitioner combines Angelot with Zakurdaev in Ground 3. Pet., 67; EX1007. Zakurdaev discloses a relay server that forwards IP address requests to ISPs: “A Smart DHCP Relay server is formed for receiving all IP address requests, to

determine the ISP to which the request should be forwarded, and then to forward the request to the ISP.” EX1007, Abstract. According to Zakurdaev:

ISP equipment responds, upon receiving the forwarded request, and generates an IP address for delivery to the user terminal that generated the request. The user terminal, upon receiving the one response, automatically loads the IP address for use whenever access to the Internet by way of the ISP equipment is desired.

Id. ¶[0012]. Zakurdaev does not disclose the operation of “relaying” a request, however. BatesDec, ¶¶110-111.

IV. LEVEL OF ORDINARY SKILL IN THE ART

For purposes of this Preliminary Response, KPN does not challenge the qualifications proposed by Petitioner for POSITA. Pet., 16; *see also Samsung Elecs. Co.*, IPR2016-00808, Paper 5, 21 (proposing a similar level of ordinary skill in the art); *Xiaomi*, IPR2022-00025, Paper 5, 20 (same); BatesDec, ¶50.

V. CLAIM CONSTRUCTION

The Board construed claim terms of the ’772 Patent when denying Samsung’s petition. *Samsung Elecs. Co.*, IPR2016-00808, Paper 6, at 8-12 (“a request” and “the request”). Further, the U.S. District Court for the Eastern District of Texas construed claim terms of the ’772 Patent in its Claim Construction Order.

Koninklijke KPN N.V. v. Samsung Elecs. Co., 14-cv-01165-JRG, 2016 WL 2610649, at *18-31 (E.D. Tex. May 6, 2016) (preambles of disclaimed Claims 10,

12, and 15, “manageable electronic device,” “plurality of auto-configuration servers (ACSs),” “auto-configuration server managing device (ACSMD),” “computer,” “processing unit,” “controlling access,” “configuration data,” “configuration data comprises data for configuring the manageable electronic device,” “request for configuration data,” “request from a manageable electronic device for configuration data,” and “relay”).

Notably, the Eastern District of Texas adopted KPN’s construction of “relay” from prosecution of the ’772 Patent, which differentiated “relay” from “forward” and found “relay” means “change, process, or otherwise manage a request based at least in part on its payload.” EX1005, 60-61 (“The above statement to the Examiner reflects that ‘forwarding’ refers to modifying a message header, ‘relaying’ refers to changing or processing the content of a request or otherwise managing the request based on its payload content.”). The court also construed the term “auto-configuration server managing device (ACSMD)” to require relaying—not forwarding: “hardware and/or software that relays configuration requests to the auto-configuration servers.” *Id.* at 48. KPN’s expert agrees with the district court’s constructions, BatesDec, ¶¶75-79, and KPN

requests that the Board adopt these definitions for the purposes of deciding institution.

Although KPN agrees that Petitioner has accurately set forth the constructions from the Eastern District of Texas in a table on pages 13-15 of the Petition, Petitioner makes an additional, incorrect claim that KPN's "current understanding" is that "relay" means "send" or "pass." Pet., 16. Petitioner points to an out-of-context footnote in a joint claim construction brief from another litigation that was dismissed before the court conducted a *Markman* hearing or construed any claims, in a section directed to potential construction of the claim term "wherein the ACSMD is further configured to relay the request to the identified ACS," as support. EX1009, 51-54.

In that section, KPN urged the court not to construe the term "wherein the ACSMD is further configured to relay the request to the identified ACS" but to give the term its plain meaning. *Id.* at 51 ("This straightforward term does not require construction."). In fact, the parties apparently agreed on the meaning of the term "relay" (in the words of the defendants, "Defendants' proposed construction clarifies which request is relayed, the destination to which the request is relayed,

and the information regarding ACSs which determines the relay destination.”). *Id.* at 54.²

KPN, in turn, alternatively suggested that should the court decide not to give the term its plain meaning, “wherein the ACSMD is further configured to relay the request to the identified ACS” should mean, at most: “wherein the ACSMD is further configured to send the request to the identified ACS”. *Id.* at 52 (“At bottom, this term does not require construction.”). Neither party asked for a construction of the term “relay,” and neither party construed the term as part of its primary claim construction positions.

Further, KPN never suggested that “relay” does not mean “change, process, or otherwise manage a request based at least in part on its payload.” *Id.* Rather, in an effort to simplify the claim terms for a jury, KPN merely suggested that, as relevant to the parties’ dispute, a jury could read “relay” as “send,” as prior steps of “relaying,” such as steps of “change, process, or otherwise manage a request based at least in part on its payload,” were not important to a jury’s understanding of that

² Defendants’ proposed construction of the term was: “the ACSMD must be configured to relay the request for configuration data received from the electronic device to a specific ACS based on the identity of the electronic device and the information regarding the ACSs contained in the database.” EX1009, 54.

particular dispute or that particular claim term. *Id.* (KPN stating that “[t]he Court should reject Xiaomi’s incorrect paraphrasing of the surrounding claim terms, which will only confuse and mislead the jury.”).

Petitioner’s attempts to equate “send” with “forward”—in order to equate embodiments of Angelot with the Challenged Claims—are equally unavailing. As shown during prosecution and as decided by the Eastern District of Texas, “relaying” is a different form of sending a request than merely “forwarding.” BatesDec, ¶¶64-69, 75-79. In any case, the dispute giving rise to KPN’s use of “send” in the brief cited by Petitioner (EX1009) settled before any claim construction rulings issued.

For purposes of this Preliminary Response, KPN submits that each other term recited in the Challenged Claims can be given its plain and ordinary meaning, and that no express constructions of these terms are needed. *Compare* Pet., 15-16.

VI. GROUND 1: ANGELOT DOES NOT ANTICIPATE THE CHALLENGED CLAIMS

A. Claims 2-6, 11, 14, and 16: Angelot uses the terms “forward” and “redirect” interchangeably and never once refers to “relay”

Claim 2 requires both that “the ACSMD is further configured to relay the request to the identified ACS” and “the ACSMD is further configured to receive a reply from the identified ACS, and relay the reply to the manageable electronic device.” Both claim limitations require that the ACSMD “relay” a request or

reply. Angelot never discloses sending a message via relaying. BatesDec, ¶114.

At most, Angelot discloses that a central server may “redirect” or “forward” configuration settings. *Id.*

Angelot uses the terms “redirect” and “forward” interchangeably. *Id.* ¶¶104-106. For example, in the embodiment disclosed in Figures 1-2 and ¶¶[0043]-[0054], Angelot states:

Alternatively, the central server 14 **forwards** the query to the appropriate configuration server 20a, 20b, 20c based on the identity of the network entity 12a, 12b, or 12c. As such, the central server 14 **redirects** any configuration related queries from the network entity 12a, 12b, or 12c to the configuration server 20a, 20b, 20c, therefore the central server 14 may be also be termed a ‘**redirect** server’.

EX1006, ¶[0047] (emphasis added). And as another example, in the embodiment disclosed in ¶[0062], Angelot states:

In yet another exemplary embodiment, the **redirect** server 14 serves as a proxy or intermediary, by communicating with one of the configuration servers 20a, 20b or 20c to directly request and acquire the configuration settings data, and then **forwarding** the configuration setting data to the network entity 12a.

Id. ¶[0062] (emphasis added).

This is not the same as “relay,” however. BatesDec, ¶¶106, 113-119. As set forth by KPN during prosecution of the application that issued as the ’772 Patent, “relaying” is a different form of sending a request than merely “forwarding”:

One of ordinary skill in the art would, in this case, recognize that *relaying* a request includes the possibility to change, process, or otherwise manage the request.

EX1004, 85-86; *see also* BatesDec, ¶¶64-65. “Forwarding,” in contrast:

As one of ordinary skill in the art would readily understand, *forwarding* session requests and connection requests entails transferring messages from a receiving incoming port of a device to an appropriate transmitting outgoing port of the device, *without changing or processing the messages*.

EX1004, 85; *see also* BatesDec, ¶¶66-69; EX1004, 23, 38-42 (“[T]he concepts for Relay and Forwarding are quite different.”).

The Eastern District of Texas made this clear by adopting KPN’s construction of “relay” from prosecution of the ’772 Patent, which differentiated “relay” from “forward” and found “relay” means “change, process, or otherwise manage a request based at least in part on its payload.” EX1005, 60-61 (citing EX1004, 85-86). The court also construed the term “auto-configuration server managing device (ACSMD)” to require relaying—not forwarding: “hardware and/or software that relays configuration requests to the auto-configuration servers.” *Id.* at 48.

Accordingly, Petitioner's allegations that Angelot's discussions of "forwarding" or "redirecting" are the same as "relaying" are completely unsupported. BatesDec, ¶¶106, 113-119. For example, Petitioner accurately quotes Angelot as follows:

- the "server [ACSM] **redirect[s]** the request to an appropriate configuration server having the configuration settings data specific to the identifier." ([EX1006], ¶19.)
- "[T]he request [is] **redirected** to an appropriate configuration server based on the identifier, the configuration server having configuration settings data associated with the identifier and specific to the network entity." (*Id.* ¶25.)
- The "server 14 **redirects** any configuration related queries from the network entity 12a, 12b, or 12c to the configuration server 20a, 20b, 20c." (*Id.* ¶47.)
- "The configuration servers 20a, 20b, 20c are coupled to the central server 14a, such that queries for configuration settings may be **redirected** thereto based on the first mapping table." (*Id.* ¶52 (emphasis added).)
- "[T]he **redirect** server 14 serves as a proxy or intermediary, by communicating with one of the configuration servers 20a, 20b or 20c to directly request and acquire the configuration settings data..." (*Id.* ¶62.)
- "The request is subsequently **forwarded** to ... configuration server 20b which selects the appropriate configuration settings for the IP phone 12b using the second mapping table..." (*Id.* ¶55)

Pet., 39-42 (emphasis added).

Petitioner then, however, improperly ignores the meaning of the term “relay” and merely replaces the inconvenient terms “redirect” and “forward” with “relay” when characterizing Angelot:

- “As shown in step 114 of Fig. 2, the server 14 (ACSMD) redirects (*relays*) the request for configuration settings (the request) to the configuration server 20a corresponding to the requesting phone 12a (the request is *relayed* to the identified ACS).” Pet., 38-39 (emphasis added).
- “Thus, the server 14 ‘*relays*’ the phone 12a’s request to the configuration server (identified ACS) identified in the first mapping table.” Pet., 40 (emphasis added).
- “The same is true for IP phone 12a’s request being *relayed* to configuration server 20a by the central server 14.” Pet., 42 (emphasis added).

BatesDec, ¶¶116-117.

Petitioner also claims that ¶[0054] of Angelot discloses “relaying” as understood by the Eastern District of Texas based on that paragraph’s use of the term “process.” Pet., 40-41. But the district court’s definition of “relay” is more than “process”: “process . . . a request based at least in part on its payload.” EX1005, 60-61. ¶[0054] never refers to “payload” or processing based on payload and merely describes “forwarding” based on the MAC address of a device being found in a mapping table “maintained in a memory associated with the central server 14” (EX1006, ¶[0051]):

In step 112, the central server 14 receives a request for configuration settings from the IP phone 12a. The request includes the identity data of the IP phone 12a, such as the unique MAC address. Upon receipt of the request, the central server 14 processes the request to determine whether the first mapping table comprises the unique MAC address associated with the request, and also determines which of the plurality of service providers 18a, 18b, 18c the MAC address belongs to. Once such a determination has been established, the central server 14 then *redirects* the request to an appropriate service provider 18a, 18b or 18c, as per first mapping table (step 114).

EX1006, ¶[0054] (emphasis added).

In sum, all of the Challenged Claims require “wherein the ACSMD is further configured to *relay* the request to the identified ACS,” and Claims 2, 11, 14, and 16 further require that “wherein the ACSMD is further configured to receive a reply from the identified ACS, and *relay* the reply to the manageable electronic device” (emphasis added). Angelot, however, fails to provide any disclosure, teaching, or suggestion of sending a message via “relaying” and thus fails to disclose, teach, or suggest the Challenged Claims. The Petition has thus failed to show a reasonable likelihood that the Challenged Claims are unpatentable over Angelot as presented in Ground 1.

B. Claims 2, 11, 14, and 16: Angelot does not disclose “wherein the ACSMD is further configured to receive a reply from the identified ACS, and relay the reply to the manageable electronic device”

1. Petitioner’s combination of different embodiments of Angelot (¶[0062] + other embodiments) is legally improper

To show anticipation, a prior art reference must disclose not only all elements of a claim, but that reference must disclose those elements “arranged as in the claim.” *Finisar Corp. v. DirecTV Group, Inc.*, 523 F.3d 1323, 1334 (Fed. Cir. 2008). Further, for anticipation, “it is not enough that the prior art reference discloses . . . distinct teachings that the artisan might somehow combine to achieve the claimed invention.” *Net MoneyIN*, 545 F.3d at 1371.

At issue in *Net MoneyIN* was a claim directed to a payment system that included five communication “links” between computers. *Id.* at 1368-69. The defendant’s anticipation argument relied on a reference that disclosed two protocols for processing transactions. *Id.* at 1371. Neither protocol, however, contained all five “links” as arranged in the claim, and the Federal Circuit concluded “[t]he district court was . . . wrong to combine parts of the separate protocols . . . in concluding that [the claim] was anticipated.” *Id.* Similar to *Net MoneyIN*, Petitioner attempts to rely on “distinct teachings” of Angelot for anticipation. *Id.*

Here, with respect to the elements in the Challenged Claims found in Claim 1, Petitioner’s anticipation argument relies on the ¶¶[0043]-[0054] embodiment of

Angelot. Pet., 20-42 (claim limitations 1pre-1h). Dependent Claim 2, however, recites the additional element: “wherein the ACSMD is further configured to receive a reply from the identified ACS, and relay the reply to the manageable electronic device.” Even Petitioner cannot find this disclosure in ¶¶[0043]-[0054], however.

Instead, to attempt to show that Angelot allegedly anticipates Claim 2, Petitioner turns to ¶[0062]—which Angelot specifically refers to as “yet another exemplary embodiment” (*see also* BatesDec, ¶¶100, 120-122)—and alleges:

[T]he server 14 (ACSMD) serves as an “intermediary” and communicates “with one of the configuration servers 20a... to directly request and acquire the configuration settings data, and then forwarding the configuration setting data to the network entity 12a.” (Ex. 1006, ¶62.)

Pet., 43 (omitting the first five words of the quoted sentence of ¶[0062]: “In yet another exemplary embodiment”). Petitioner then turns back to the ¶¶[0043]-[0054] embodiment to allege that Angelot discloses other elements from Claim 1 that Claim 2 includes. Pet., 43-46 (citing EX1006, ¶¶[0047], [0051]-[0052], Fig. 1, and Fig. 3a).

In a particularly egregious example in which Petitioner openly cites both the ¶¶[0043]-[0054] embodiment and the ¶[0062] embodiment in the same citation, Petitioner alleges:

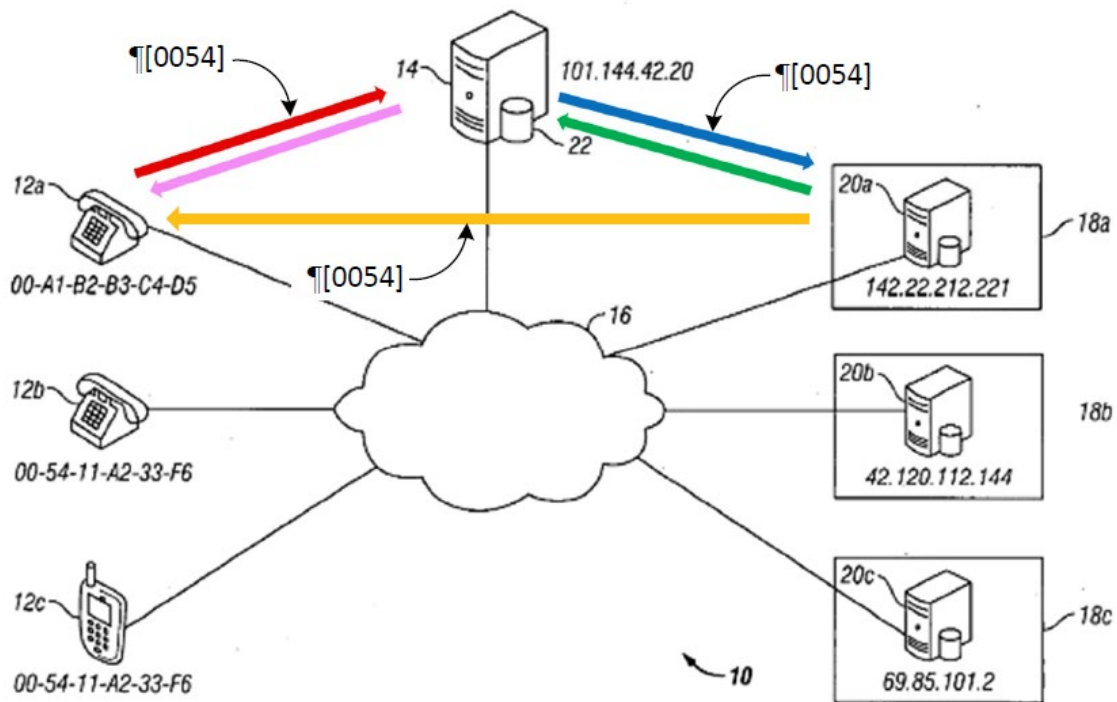
Specifically, the configuration setting data (reply) from the identified configuration server 20a is (1) acquired by the server 14 from the configuration server 20a and then (2) “*provided to the IP phone 12a based on the MAC address.*” (*Id.* ¶¶52, 62. (emphasis added).) Pet., 44 (emphasis omitted). The ¶[0052] cite appears to apply to Petitioner’s point (1), while the ¶[0062] citation appears to apply to Petitioner’s point (2).

Petitioner’s combining of Angelot’s embodiments is well-illustrated in its annotated version of Angelot’s Figure 1 (Pet., 23-24), reproduced below in three versions modified by KPN, each having annotations additional to Petitioner’s red, blue, green, and pink arrows. KPN’s annotations include Angelot paragraph numbers “¶[0054]” and “¶[0062]” to show how each is a distinct embodiment and to show how neither embodiment discloses all of Petitioner’s red, blue, green, and pink arrows.

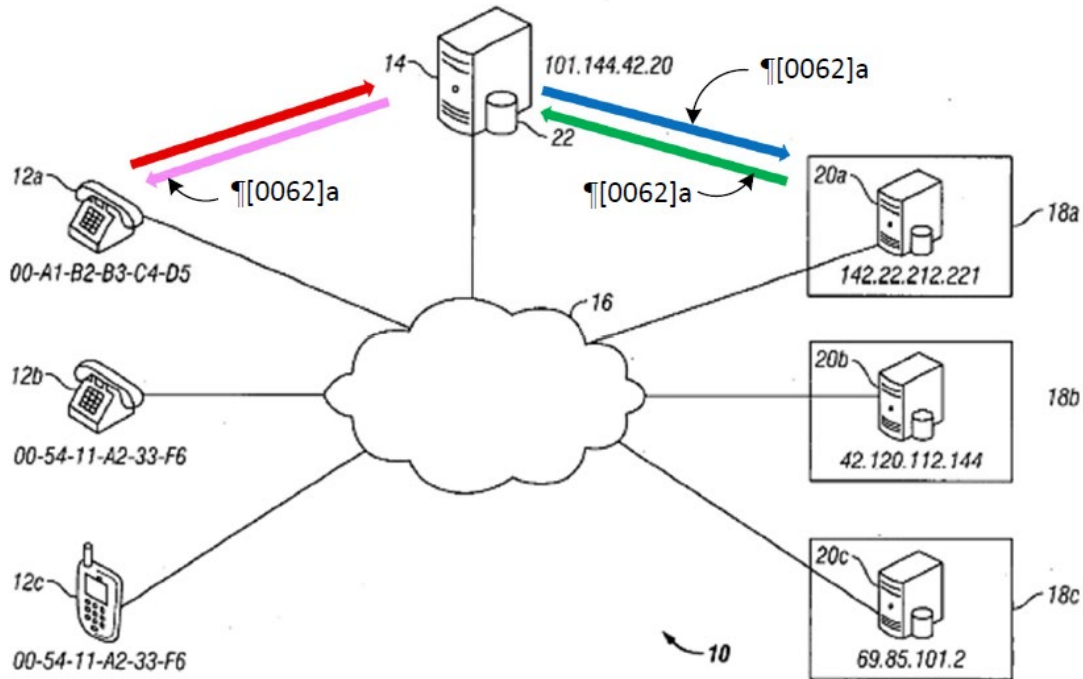
While all of Petitioner’s added arrows are retained in each of the three reproductions below, only those arrows with an additional annotation of a paragraph number are relevant to the particular embodiment disclosed in the paragraph. Thus, arrows without paragraph annotations correspond to a *different* embodiment—demonstrating Petitioner’s combining of embodiments. Two of three annotated versions below include an additional arrow that corresponds to one or more steps that Petitioner omitted or misrepresented in its annotated version. Also, ¶[0062] actually describes two different embodiments, which, in the present discussion only

(and the figures below), are distinguished as “¶[0062]a” and “¶[0062]b.” Elsewhere herein, “¶[0062]” corresponds to “¶[0062]a.”

The first modified version of Petitioner’s annotated Figure 1 corresponds to the ¶[0054] embodiment. In this embodiment, network entity 12a sends a request for configuration data to central server 14 (red arrow), which redirects (forwards) the request to service provider 18a (blue arrow). In a step omitted by Petitioner, configuration data are forwarded from service provider 18a to network entity 12a (yellow-orange arrow). Contrary to Petitioner’s green and pink arrows (with no paragraph annotations), the configuration settings are not forwarded to the network entity via the central server in the ¶[0054] embodiment— they do not correspond to the embodiment in ¶[0054]. BatesDec, ¶125.

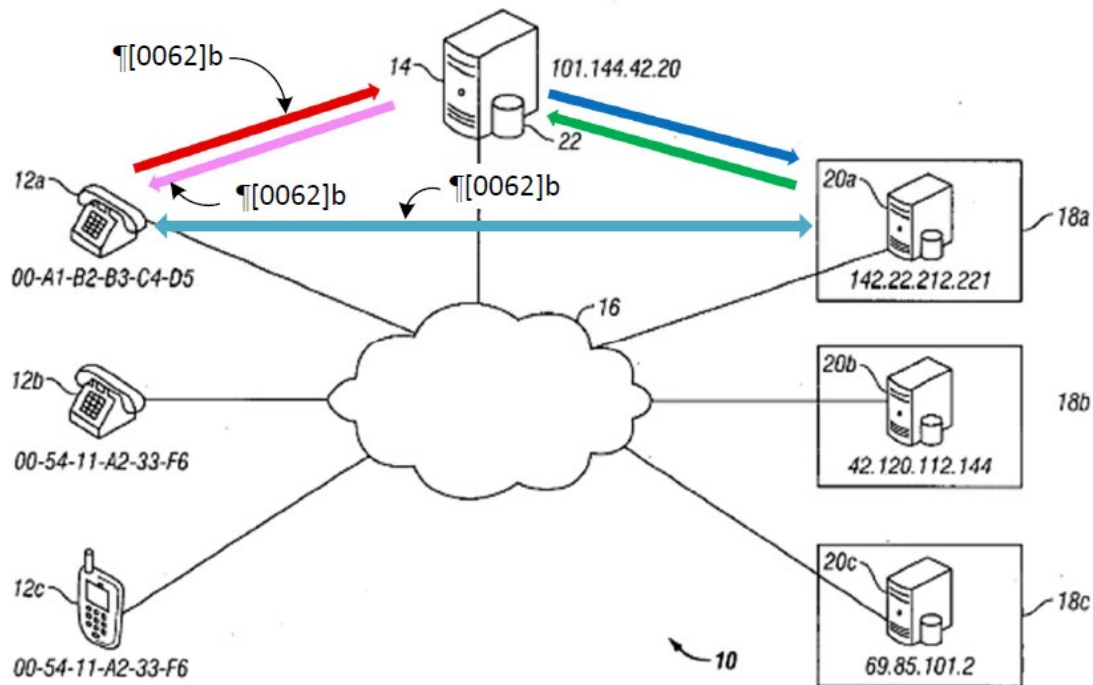


The second modified version of Petitioner’s annotated Figure 1 corresponds to the first embodiment of ¶[0062], labeled “¶[0062]a” here. This embodiment *begins* with the central server 14 “directly” requesting configuration settings from a configuration server (blue arrow). The central server then acquires the configuration settings (green arrow) and forwards them to the network entity (pink arrow). Contrary to Petitioner’s red arrow (with no paragraph annotation), the ¶[0062]a embodiment does not disclose a request for configuration data from the network entity 12a to the central server 14. BatesDec, ¶126.



The third modified version of Petitioner’s annotated Figure 1 corresponds to the second embodiment of ¶[0062], labeled “¶[0062]b” here. In this embodiment, the network entity 12a contacts the central server 14 with a request for configuration information (red arrow), and the central server 14 responds with a URI of a configuration server (pink arrow). Then—in steps omitted by Petitioner—the network entity contacts the configuration server directly to obtain configuration settings (light-blue arrow). Contrary to Petitioner’s blue and green arrows (with no paragraph annotations), the ¶[0062]b embodiment does not disclose any communication between the central server and the service provider / configuration server. And the paragraph-annotated pink arrow merely informs the network entity

12a where to find configuration data; it is not a forwarding of such data from the configuration server. BatesDec, ¶127.



As shown above regarding the ¶[0054] and ¶[0062] embodiments (and other variations omitted herein for the sake of brevity), *none* incorporate all the limitations of any of Claims 2, 11, 14, or 16. BatesDec, ¶123-124, 128. Petitioner, accordingly, is improperly combining parts of separate embodiments of Angelot to form its anticipation argument. *Net MoneyIN*, 545 F.3d at 1371; *see also* BatesDec, ¶¶120-128. Even assuming *arguendo* Petitioner’s allegations that parts of Angelot actually do disclose each element of Claim 2, Angelot certainly does not disclose those elements “arranged as in the claim” as required. *Finisar*, 523 F.3d at 1334.

2. Petitioner’s combination of different embodiments of Angelot is technically improper as the ¶[0062] embodiment cannot work with the other embodiments

Petitioner’s proposed combination of Angelot embodiments also cannot be combined technically. BatesDec, ¶129. Accordingly, a POSITA, reading Angelot, would not “‘at once envisage’ the claimed combination,” and Petitioner and its expert failed to present any argument or evidence to the contrary. *Chamberlain*, 935 F.3d 1341 (quotation omitted); BatesDec, ¶136.

In contrast to the ¶[0062] embodiment, in every other embodiment of Angelot in which the server 14 forwards or redirects a request for configuration data from the network entity, the configuration server sends the configuration data directly to the network entity. BatesDec, ¶¶130-134. In the ¶[0062] embodiment, however, the redirect server 14 “directly request[s]” and acquires configuration setting data—and then the redirect server 14 forwards that data to the network entity. BatesDec, ¶130-134.

For example, in the ¶¶[0043]-[0054] embodiment, the configuration server sends configuration data directly to the network entity—not via the redirect server 14:

In step 116, a configuration server 20a, 20b or 20c, associated with the appropriate service provider 20a, 20b or 20c, selects the configuration settings for the IP phone 12a with that specific MAC

address as per second mapping table, *and forwards the relevant configuration settings data to the IP phone 12a.*”

EX1006, ¶[0054] (emphasis added). Further, Step 116 in Figure 2 states: “Cause the *configuration server to provide* the configuration settings *to the identified network entity 12a.*” *Id.* at Fig. 2 (emphasis added). Similarly, in the “another exemplary embodiment” of ¶[0055], the configuration server sends configuration data directly to the network entity:

The request is subsequently forwarded to the appropriate service provider 18 b with configuration server 20 b which selects the appropriate configuration settings for the IP phone 12 b using the second mapping table, and the *configuration settings data is subsequently sent to the IP phone 12b via a suitable protocol.*”

Id. ¶[0055] (emphasis added). And in the “yet another exemplary embodiment” of ¶[0057]:

Having received the request from the central server 14, the configuration server 20a may require authentication of the IP phone 12a, and thus sends an acknowledgment of receipt to the IP phone, along with a request for a Username and/or Password, or other credentials (as provided by the service provider 18a). After validation of the user credentials, the *configuration settings data is then sent to the IP phone 12a.*”

Id. ¶[0057] (emphasis added).

Thus, Angelot teaches quite specifically that in all but one embodiment the configuration server 20 provides configuration data directly to the network entity 12. BatesDec, ¶135. And only in the ¶[0062] embodiment are the configuration data acquired by the central server from the configuration server—apparently only because the central server makes a “*direct request*” to the configuration server for that data in this particular embodiment. And in this embodiment, the central server *forwards* the configuration data to the network entity. BatesDec, ¶135.

Accordingly, for reasons in the preceding section, the ¶[0062] embodiment cannot legally be combined with other embodiments to arrive at the claimed invention. Further, the ¶[0062] embodiment cannot be combined with other embodiments because, in the other embodiments, the request always originates from the network entity and the configuration server always sends the configuration data directly to the network entity. In the ¶[0062] embodiment, however, the request does not originate from the network entity and the configuration server thus cannot forward the configuration data to it.

3. ¶[0062] of Angelot does not disclose what triggers the redirect server to “directly request” configuration settings from the configuration server

Claim 2 requires (emphasis added):

wherein the manageable electronic device is configured to send a request for configuration data to the ACSMD, . . .

wherein the ACSMD is configured, *responsive to receiving the request*, to:

identify the manageable electronic device by comparing at least a portion of the request with the information for the identification of electronic devices of the at least one database, and

identify an ACS from the plurality of ACSs in accordance with the identification of the manageable electronic device to provide configuration data to the manageable electronic device, and

wherein the ACSMD is further configured to relay the request to the identified ACS,

wherein the ACSMD is further configured to receive a reply from the identified ACS, and relay the reply to the manageable electronic device.

As set forth in Claim 2, the above-recited sequence is triggered by the ACSMD receiving a request for configuration data from the manageable electronic device.

As discussed, in an attempt to show that Angelot allegedly teaches “wherein the ACSMD is further configured to receive a reply from the identified ACS, and relay the reply to the manageable electronic device,” Petitioner turns to ¶[0062] for the proposition that:

[T]he redirect server 14 serves as a proxy or intermediary, by communicating with one of the configuration servers 20a, 20b or 20c to

directly request and acquire the configuration settings data, and then forwarding the configuration setting data to the network entity 12a. Pet., 43 (quoting EX1006, ¶[0062]).

In the ¶[0062] embodiment, however, the server 14 communicates with one of the configuration servers 20 to “directly request” and acquire configuration settings data. EX1006, ¶[0062]; BatesDec, ¶¶138-139. In direct contrast to this disclosure, Claim 2 requires that the ACSMD only request and receive configuration data “responsive” to receiving a request for that data from a manageable electronic device. BatesDec, ¶¶138-139. Accordingly, even if the “[y]et another embodiment” of ¶[0062] is combined with other Angelot embodiments (such as the ¶¶[0043]-[0054] embodiment), Angelot still fails to anticipate Claim 2. BatesDec, ¶¶138-139.

4. Angelot does not disclose that the server 14 does any type of “processing” of a reply when “forwarding” configuration settings

Here, once more, Petitioner’s arguments rest on combining distinct embodiments of Angelot disclosed in ¶¶[0052] and [0062]. Specifically, Petitioner, at page 45, cites to ¶136 of Petitioner’s expert declaration (errantly labeled ¶135 in the Petition), stating:

For example, the phone “12a is typically identified by its MAC address” and “the configuration files on the configuration server 20a may be named using this information, for example, a configuration

file named *iphone12a-mac-00-a1-b2-b3-c4-d5.cfg* would correspond to the IP phone 12 a having *00-a1-b2-b3-c4-d5* as its MAC address.” (*Id.* ¶52 (emphasis added).) Thus in response to receiving a configuration file named *iphone12a-mac-00-a1-b2-b3-c4-d5.cfg*, the server 14 looks to database 22 to determine the MAC address of the phone where the configuration file will be provided/relayed. (Ex. 1002, ¶135.)

However, the citation to a MAC address in “¶52” of Angelot refers to the “second mapping table” of configuration settings at the configuration server—not to database 22 at the central server 14. BatesDec, ¶¶141. As set forth in ¶[0052]:

The configuration server 20a, 20b or 20c includes configuration settings specific to the IP phone 12a with specific MAC addresses. Each service provider 18a, 18b or 18c thus includes a second mapping table with MAC addresses and associated configuration settings data in a database associated with each of the configuration servers 20a, 20b or 20c. As each IP phone 12a is typically identified by its MAC address, the configuration files on the configuration server 20a may be named using this information, for example, a configuration file named *iphone12a-mac-00-a1-b2-b3-c4-d5.cfg* would correspond to the IP phone 12a having *00-a1-b2-b3-c4-d5* as its MAC address.

EX1006, ¶[0052].

That is, ¶[0052] of Angelot is concerned only with the association of configuration settings in the “second mapping table” with MAC addresses.

BatesDec, ¶¶141. Nothing in ¶[0052] supports Petitioner’s and its declarant’s

assertion that:

Thus in response to receiving a configuration file named iphone12a-mac-00-a1-b2-b3-c4-d5.cfg, the server 14 looks to database 22 to determine the MAC address of the phone where the configuration file will be provided/relayed.

Pet., 45; EX1002, ¶¶135-36. As described above, ¶[0062], alone, discloses the server 14 “forwarding the configuration setting data to the network entity 12a.” Thus, Petitioner and Petitioner’s expert have again mixed and matched distinct embodiments of Angelot in making a conclusory and erroneous assertion.

But even putting aside Petitioner’s and Petitioner’s expert’s reliance on ¶[0062] for disclosing “forwarding the configuration setting data to the network entity 12a,” there is simply no teaching or suggestion in ¶[0062] or anywhere else in Angelot of “in response to receiving a configuration file named iphone12a-mac-00-a1-b2-b3-c4-d5.cfg, the server 14 looks to database 22 to determine the MAC address of the phone where the configuration file will be provided/relayed.” BatesDec, ¶¶141-142. This assertion by Petitioner’s expert, repeated by Petitioner, is pure invention on the part of Petitioner’s expert, and should be afforded no weight. 37 C.F.R. § 42.65(a).

C. Claims 3-6: Angelot does not disclose “wherein the ACSMD is further configured to identify the type of the manageable electronic device by comparing a network address of the manageable electronic device in the request with a predetermined plurality of network addresses in the at least one database”

Claim 3 requires that the ACSMD be configured to identify the type of the manageable electronic device by comparing a network address of that device with network addresses in a database. The '772 Patent identifies an IP address as an example of a network address. For example:

In the local area network LAN and the wide area network WAN, electronic devices are arranged to have an address for identification on the respective network (i.e., communication is address based). A well known address scheme is the Internet Protocol address system that provides a so-called IP address to each electronic device coupled to the network.

EX1001, 4:14-19; Fig. 3b. This is consistent with well-known network architecture models, in which a network layer (e.g., characterized by IP addressable devices) is distinct from a link layer (e.g., a medium access layer with devices identified according to MAC addresses). BatesDec, ¶143.

Petitioner claims that Angelot discloses Claim 3 by alleging that the MAC address used in Angelot is a “network address.” Pet., 46-48. Petitioner further alleges that because in Angelot the MAC address can identify the manufacturer of the network entity, Angelot somehow discloses that the ACSMD is configured to

identify the type of the manageable electronic device. *Id.* Petitioner is incorrect on both points.

As a preliminary matter, Petitioner's expert claims that the "USPTO appears to agree" that Angelot discloses this feature and cites an Office Action in the Child '056 Application. EX1002, ¶[0137]. In that application, however, KPN overcame the Examiner's rejections under Angelot and that application issued as the Child '256 Patent. EX1019, 1, 42 (Examiner conceding that Angelot does not disclose "the auto-configuration server manager further being arranged for . . . relaying the request to the identified auto-configuration server").

KPN, however, did not specifically address the merits of the Examiner's rationale regarding whether Angelot discloses identifying "the type of the manageable electronic device by comparing a network address of the manageable electronic device in the request with a predetermined plurality of network addresses in the at least one database." EX1019, 30 (KPN's Response expressly ruling out acquiescing to any assertion by the Examiner that was not specifically addressed, including any relating to "network address").

In any case, a POSITA would have known that the MAC address in Angelot is at most a link layer identifier unique to a device. BatesDec, ¶¶144-145. Angelot itself confirms that a MAC address identifies and is specific to hardware, such as an IP phone 12, and is not a network address:

An exemplary method for configuring the IP phone 12 comprises the step(s) of assigning an identifier to the IP phone 12a, the identifier may be a unique identifier, or a class identifier. One form of unique identification is provided by a globally unique network interface identifier (media access control (MAC) address). The unique MAC address is assigned to the IP phone 12a by the manufacturer or the network equipment provider (step 100). The MAC address is associated with the IP phone 12a's network interface adapter for coupling to the network 16

EX1006, ¶¶[0049]; BatesDec, ¶145.

Accordingly, the MAC address as used in Angelot is not a network address. BatesDec, ¶¶145-148. Petitioner's expert provides no support for Petitioner's position, other than citing various paragraphs of Angelot that simply refer to a device's MAC address. EX1002, ¶¶[0137]-[0140]; BatesDec, ¶¶146-148.

Further, although Angelot discusses that a MAC address can be used to identify the manufacturer of a network device or a "class of device" of that network device, Pet. 46-48, Angelot nowhere discloses that the MAC address can be used to identify the "type" of network device. BatesDec, ¶147. Identifying a manufacturer of a device is not identifying a type of device, and Angelot clarifies that "class of device" refers only to whether certain devices are for personal use or work (i.e., "enterprise devices" or "consumer devices"). EX1006, ¶[0059]; BatesDec, ¶148. Dr. Blumenthal confirms this point. EX1002, ¶140 (opining that Angelot discloses

“class of device 12 (whether the manageable electronic device is from manufacturer A or C and what service provider 18 the device should receive configuration data from”); BatesDec, ¶148.

For the foregoing reasons, Claims 2-6, 11, 14, and 16 recite limitations not disclosed by Angelot, and therefore the Petition has failed to establish a reasonable likelihood that Claims 2-6, 11, 14, and 16 are unpatentable over Angelot.

VII. GROUND 2: ANGELOT DOES NOT RENDER OBVIOUS THE CHALLENGED CLAIMS

A. Claims 2-6, 11, 14, and 16: Petitioner cannot rely on Jin and misapplies the phrase “as known in the art” as set forth in the ’772 Patent

Angelot never refers to sending messages by “relaying,” but is expressly limited to sending messages by “forwarding” or “redirecting.” Accordingly, Petitioner would like to modify Angelot to simply replace the terms “forwarding” and “redirecting” with “relaying” to allege that the Challenged Claims are obvious in light of Angelot. Pet., 55-57. As purported support, Petitioner cites to Jin (EX1008 (U.S. Patent Appl. Publ. 2003/0061315)) and bizarrely claims that “the ’772 patent admits that ‘relaying’ information was known in the prior art.” Pet., 57.

Jin, however, was disclosed by KPN and considered by the Examiner during prosecution of the Child ’056 Application, which has substantially the same claim elements as the Challenged Claims. *Infra* p.62; EX2004. Thus, at the very least,

Petitioner’s argument fails under the two-part *Advanced Bionics* test. IPR2019-01469, Paper 6 at 8. First, Jin is “substantially the same art” as considered by the USPTO during prosecution—the USPTO considered Jin itself. EX1019, 94, 292. Second, Petitioner makes no attempt to demonstrate that the USPTO materially erred. Accordingly, Petitioner’s argument regarding Jin should be ignored.

Jin, in any case, is no more than cumulative of art cited by KPN and considered by the Examiner during prosecution of the ‘772 Patent. And what makes Petitioner’s claim that “the ’772 patent admits that ‘relaying’ information was known in the prior art” so bizarre is that KPN cited numerous references during prosecution—ones of which Jin is cumulative—specifically relating to relaying.

Indeed, Petitioner conflates the ’772 Patent’s statement “as known in the art” with an admission of something that was never denied or relied on in the contrary in the ’772 Patent or during prosecution. Specifically, asserting that “the ’772 patent admits that ‘relaying’ information was known in the prior art,” Pet., 57, Petitioner quotes the following passage:

In case the request comprises the IP address of the auto-configuration server manager, the DSLAM transmits the request to the network

switch (not shown) that will relay the request to the auto-configuration server manager (as known in the art).

EX1001, 5:56-61.

But neither the '772 Patent nor KPN ever claimed that “relaying” information” was *not* known “in the prior art.” KPN even secured allowance of the '772 Patent by citing numerous references during prosecution explicitly discussing “relaying”—and how it differs from “forwarding.” EX1004, 21-62, 3-9. Prior art relating to “relaying” was known to and considered by the Examiner, and Jin’s general discussion of a “Subnet Relay Agent” (Pet., 57) adds nothing to what KPN had already disclosed to the Examiner.

B. Claims 2-6, 11, 14, and 16: Petitioner fails to provide proper motivation to modify Angelot to use “relaying” instead of “forwarding”

Petitioner claims that it would have been obvious to modify Angelot such that Angelot's “forwarding” and “redirecting” were instead KPN’s claimed “relaying.” Pet., 55-56 (citing EX1002, ¶150 (claiming that “a person having ordinary skill in the art would have found it routine and conventional to modify Angelot to relay the request and reply.”)). For support, Petitioner’s expert points to the phrase “known in the art” and makes the same mistake as Petitioner and claims “*Nothing about “relaying” information from one server to another or from a server to a device is innovative. The '772 patent admits as much, when it teaches that “relaying”*

information was known in the prior art.” *Id.* ¶151 (quoting EX1001, 5:56-61). As shown above, however, Dr. Blumenthal has made a fundamental error—the ’772 Patent’s statement of “as known in the art” is not an admission of anything otherwise proffered to have been unknown. Dr. Blumenthal essentially conflates what a POSITA could have done with obviousness. This is wrong.

Dr. Blumenthal next makes another mistaken assumption: “Also, as I previously mentioned, Patent Owner asserts that relaying is simply sending or passing.” EX1002, ¶152 (citing EX1009, 54 [sic] n.10); Pet., 57. For reasons discussed *supra* pp.30-34, Dr. Blumenthal’s understanding here is also incorrect.

Dr. Blumenthal next asserts that “[i]n my opinion, a person having ordinary skill in the art would have recognized limited options for supplying the consumer device 12a with configuration data.” EX1002, ¶152; Pet., 57. This is simply not true, however. BatesDec, ¶¶150-151.

Angelot itself provides several different ways to do so in its various embodiments. *Id.* For example, ¶[0056] states “the IP phone 12a initiates the discovery process automatically to look for a configuration server 20a 20b or 20c to retrieve its configuration data and/or its firmware.” EX1006, ¶[0056]. ¶[0058] discusses obtaining configuration settings via a browser with a default homepage as part of its factory settings. *Id.* ¶[0058]. And ¶[0060] discusses a configuration server providing configuration data after automatically detecting connection of an IP

phone to the network. *Id.* ¶[0060]. Thus, “limited options” are not true, and would not have been a source of motivation. BatesDec, ¶151.

In further attempting to create motivation, Dr. Blumenthal alleges that “the claimed relaying of ‘the request to the identified ACS’ and relaying of ‘the reply to the manageable electronic device’ is, at most, a predictable variation of Angelot’s system.” EX1002, ¶153; Pet., 58. But that is not motivation. BatesDec, ¶152. Dr. Blumenthal is simply replacing Angelot’s “forwarding” and “redirecting” with KPN’s claimed concept of “relaying” when there is absolutely no reason or advantage to do so. *Id.* That is hindsight—not motivation.

The Petition does likewise. For example, the Petition states:

Indeed, processing (i.e., modifying) the request before sending it to the proper configuration server *would have beneficially provided a mechanism* for straightforward and accurate automatic configuration of the network entity 12a “***without user intervention except to power-on and connect the at least one network entity to the network in order to contact the central server.***” (Ex. 1006, ¶21; Ex. 1002, ¶155.)

Pet., 60 (emphasis added); EX1002, ¶156. Petitioner and Dr. Blumenthal are just quoting Angelot and identifying what Angelot’s embodiments are purporting to achieve—without “relaying.” BatesDec, ¶153. How can this be motivation to use relaying instead?

The Petition argues further that motivation can be found among the advantages of preventing “unauthorized devices from being configured.” Pet., 65; EX1002, ¶164. But Angelot already discloses such an embodiment in ¶[0057], and no relaying is involved:

Having received the request from the central server 14, the configuration server 20a may require authentication of the IP phone 12a, and thus sends an acknowledgment of receipt to the IP phone, along with a request for a Username and/or Password, or other credentials (as provided by the service provider 18a).

After validation of the user credentials, the configuration settings data is then sent to the IP phone 12a.

EX1006, ¶[0057]; BatesDec, ¶154. After authentication, configuration settings data can be sent by forwarding; relaying is not described or an advantage.

Petitioner’s and its expert’s attempts to modify Angelot to use “relaying” amount to no more than suggesting Angelot *could* be modified to use relaying, and do not support a POSITA being motivated to make such a modification. First, whether a reference “could” be modified is not the test for obviousness. *Personal Web Techs., LLC v. Apple, Inc.*, 848 F.3d 987, 993-94 (Fed. Cir. 2017) (such reasoning is “not enough: it does not imply a motivation to pick out those two references and combine them to arrive at the claimed invention”).

Second, Petitioner’s assertions regarding modifying Angelot are based on a solution to a problem that simply does not exist in Angelot. A POSITA would not have modified Angelot as proposed in the Petition to solve a non-existent problem. *Arctic Cat Inc. v. Polaris Indus., Inc.*, 795 F. App’x 827, 833 (Fed. Cir. 2019) (“In this case, Arctic Cat tried to create a problem with the prior art in hopes of creating a motivation to combine references, but it failed,” and “Arctic Cat’s case was doomed when it failed to prove the premise it offered for combining Sundahl with Suzuki.”). Rather, modifying Angelot as proposed to replace one perfectly acceptable method of sending requests (“forwarding” and “redirecting”) with a completely different method of sending requests (“relaying”) as recited in the Challenged Claims would be “superfluous,” which indicates “improper hindsight reasoning.” *In re NTP, Inc.*, 654 F.3d 1279, 1299 (Fed. Cir. 2011) (reversing obviousness rejection).

For all of these reasons, the Petition has failed to establish a reasonable likelihood that Claims 2-6, 11, 14, and 16 are obvious over Angelot.

VIII. GROUND 3: ANGELOT IN VIEW OF ZAKURDAEV DOES NOT RENDER OBVIOUS THE CHALLENGED CLAIMS

Zakurdaev discloses a “Smart DHCP Relay server” and Petitioner cites it for the concept of relaying a message. Pet., 68. Zakurdaev, however, does not teach “relay the request” or “relay the reply” as recited in the Challenged Claims. In

Zakurdaev, the “relay” is a device—not an action; Zakurdaev describes only a relay device that forwards—not relays.

As set forth in Zakurdaev:

A Smart DHCP Relay proxy server is placed between the user terminal and the ISP formed forto [sic] receiving receive all IP address requests, and more particularly, DHCP address requests, to determine the ISP to which the request should be *forwarded*, based on the user preferences and supplied credentials and then to *forward* the request to the ISP. Accordingly, the ISP equipment responds, upon receiving the *forwarded* request, and generates an IP address for delivery to the user terminal that generated the request.

EX1007, ¶[0012] (emphasis added). As forwarding a request is well-known and taught by Angelot, Zakurdaev is merely cumulative of other references. BatesDec, ¶¶156-158. Zakurdaev does not teach anything beyond what Angelot teaches regarding forwarding. *Id.*

By way of example, the Petition misleadingly cites to ¶[0014] of Zakurdaev and states: “the ISP ‘responds by generating and transmitting an IP address’ which is sent to the DHCP Relay that *relays* the IP address ‘to the subscriber equipment.’” Pet., 68 (emphasis added). The actual quote from Zakurdaev, however, never refers to a DHCP Relay or “relaying” at all, but reads: “The ISP then responds by generating and *transmitting* an IP address to the subscriber equipment.” EX1007, ¶[0014] (emphasis added). In other words, Petitioner just

drops the concept of “relaying” into the middle of a sentence that has nothing to do with “relaying.”

Petitioner does not stop there. Petitioner cites to ¶[0027] of Zakurdaev and states: “The DHCP Relay then *relays* the DHCPDISCOVER (blue) to the DHCP server at the ISP. (Ex. 1007, ¶27.)” Pet., 68. The actual ¶[0027], however, at most discloses “forwarding”:

The corresponding ISP 216, upon receiving the DHCPDISCOVER signal, generates a DHCPOFFER signal that is transmitted back to the Smart DHCP Relay 212. The Smart DHCP Relay 212, upon receiving the DHCPOFFER signal, stores (maps) an IP address for the ISP server 216 to a subscriber MAC address. Thereafter, the IP address 216 is *forwarded* to the user computer terminal 204 for automatic loading.

EX1007, ¶[0027] (emphasis added). It is actually unclear how ¶[0027] supports the statement “The DHCP Relay then relays the DHCPDISCOVER (blue) to the DHCP server at the ISP. (Ex. 1007, ¶27.)” at all, but perhaps Petitioner meant to actually cite ¶[0026] of Zakurdaev, which reads:

The Smart DHCP Relay 212, upon receiving the DHCPDISCOVER signal, analyzes it to discover one of a user ID, a user terminal ID or a terminal MAC address to determine the IP address of the DHCP Server of a the corresponding ISP. Once the Smart DHCP Relay 212 determines the IP address of the corresponding ISP, it *forwards* the DHCPDISCOVER signal to the corresponding ISP 216.

Id. ¶[0027] (emphasis added). That paragraph too, like all of Zakurdaev, discloses forwarding—not relaying. Petitioner just changed the word “forwards” to the word “relays” to suit its needs.

One more example: Petitioner cites to ¶[0027] of Zakurdaev and states: “After this processing, the DHCP Relay *relays* the DHCPOFFER signal (pink) to the terminal 204.” Pet., 69 (emphasis added). ¶[0027] actually states (in its last sentence): “Thereafter, the IP address 216 is *forwarded* to the user computer terminal 204 for automatic loading.” EX1007, ¶[0027] (emphasis added). Once again, Petitioner changed the word “forwarded” to the word “relays” despite the actual teaching of Zakurdaev.

Petitioner provides absolutely no support or justification for revising the actual words of Zakurdaev to make the reference more convenient for Petitioner’s positions. For all of these reasons, the Petition fails to establish a reasonable likelihood that Claims 2-6, 11, 14, and 16 are obvious over Angelot in view of Zakurdaev.

IX. ALL GROUNDS: ANGELOT DOES NOT DISCLOSE, TEACH, OR SUGGEST LIMITATION [1G], WHICH IS RECITED IN CLAIMS 2-6, 11, 14, AND 16

Referring again to the summary above, Angelot teaches:

Upon receipt of the request, the central server 14 processes the request to determine whether the first mapping table comprises the unique

MAC address associated with the request, and also determines which of the plurality of service providers 18a, 18b, 18c the MAC address belongs to. Once such a determination has been established, the central server 14 then redirects the request to an appropriate *service provider* 18a, 18b or 18c, as per first mapping table (*step 114*).

EX1006, ¶[0054] (emphasis added).

“[S]tep 114” in FIG. 2, however, reads “Redirect request to appropriate *configuration server* 20a.” *Id.* Fig. 2 (emphasis added). While this apparent interchangeable use of “service provider” and “configuration server” might at first seem inconsequential, consideration of FIG. 3a strongly suggests otherwise.

In particular, each of “service provider[s] 18a and 18b” are shown in FIG. 3a to include multiple “configuration servers.” EX1006, Fig. 3a. This fact, together with the redirection of the request to “an appropriate *service provider* 18a, 18b or 18c” disclosed in ¶[0054] indicates that there is more to determining the “appropriate configuration server” than finding the MAC address in the “first mapping table.” BatesDec, ¶¶159-160. For example, if a request is redirected to “service provider 18a,” which of the five “configuration servers” shown in FIG. 3a receives the request?

Adopting, *arguendo*, Petitioner’s interpretation of the “configuration server” in Angelot as the “ACS” of Claims 2-6, 11, 14, and 16 (Pet., 25), there is at least an ambiguity as to whether Angelot actually teaches “identify an ACS from the

plurality of ACSs in accordance with the identification of manageable electronic device.” BatesDec, ¶161. That is, on the basis of ¶[0054], Angelot at most might be interpreted as teaching “identify [*a service provider*] from the plurality of [*service providers*] in accordance with the identification of manageable electronic device.” If the identified “service provider” happens to be “service provider 18a,” then, according to FIG. 3a, an extra, undisclosed step appears to be required to further identify a “configuration server” from among the five configuration servers in the “first mapping table.” BatesDec, ¶162. With or without the extra, undisclosed step, this fails to teach limitation [1g]: “identify an ACS from the plurality of ACSs in accordance with the identification of manageable electronic device to provide configuration data to the manageable device.”

X. THE BOARD SHOULD DENY INSTITUTION UNDER § 325(d)

The Petition does not satisfy the two-part test of *Advanced Bionics*, IPR2019-01469, Paper 6 at 8, in light of Angelot being used in a rejection by the USPTO during examination of the Child ’056 Application.

Petitioner characterizes the Child ’256 Patent as having “nearly identical claims” to the ’772 Patent and “substantially similar claims to those at issue here.” Pet., 19. For example, both the ’772 and ’256 Patents include the following “nearly identical” and “substantially similar” claim elements:

'772 Patent (EX1001)	'256 Patent (EX2003)
wherein the ACSMD is further configured to relay the request to the identified ACS (EX1001, 10:11-13)	the auto-configuration server manager further being arranged for . . . relaying the request to the identified auto-configuration server (EX2003, 10:13-14, 25-26)

Further, KPN filed a terminal disclaimer during prosecution of the Child '056 Application to obviate a double patenting rejection over the '772 Patent. EX1019, 100-01.

Turning to part one of the *Advanced Bionics* test, the Angelot publication asserted in the Petition issued as the Angelot patent cited by the USPTO in an obviousness rejection during prosecution of the Child '056 Application. EX1019, 39-47 (citing U.S. Patent No. 8,089,953 (“the Angelot Patent”)); EX2004 (the Angelot Patent). KPN overcame that rejection. EX1019, 21-31 (Response), 7-15 (Notice of Allowance).

The rejection was made by the same Examiner that examined the application that became the '772 Patent, and, when making that rejection, the Examiner conceded that “Angelot does not specifically disclose: [the auto-configuration server manager further being arranged for:] relaying the request to the identified auto-configuration server.” EX1019, 42, 46 (identifying Examiner Arvin Eskandarnia), *compare with* EX1004, 3, 10 (identifying Examiner Arvin Eskandarnia). The

Petition, now, attempts to directly refute that position. Pet., 38 (“Angelot discloses this feature [wherein the ACSMD is further configured to relay the request to the identified ACS].”). Accordingly, the USPTO considered (and rejected) **both** “substantially the same art” **and** “substantially the same arguments” during prosecution. *Advanced Bionics*, IPR2019-01469, Paper 6 at 8.

Turning to part two of the *Advanced Bionics* test, Petitioner offers no explanation why the Examiner materially erred in evaluating Angelot during prosecution. Pet., 38-42 (not even addressing the Examiner’s conclusion that “Angelot does not specifically disclose: relaying the request to the identified auto-configuration server”). Further, KPN has shown *supra* sections VI-IX, that Angelot and Petitioner’s proposed modifications or combinations do not anticipate or render obvious the Challenged Claims.

Accordingly, KPN has shown that the Petition fails both parts of the two-part *Advanced Bionics* test, and the Board should deny institution.

XI. THE BOARD SHOULD DENY INSTITUTION UNDER § 314(a)

Institution would be an inefficient use of the Board’s resources in view of the advanced state of the parallel Texas Action. *Apple v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 13-14 (PTAB Mar. 20, 2020) (precedential).

Each of the *Fintiv* factors, as clarified by the *Interim Procedure For Discretionary Denials in AIA Post-Grant Proceedings With Parallel District Court*

Litigation, at 3-4 (Jun. 21, 2022) (“Interim Procedure”), and subsequent authority, weigh in favor of discretionary denial. Further, because the Challenged Claims recite limitations not disclosed, taught, or suggested by the asserted references for the reasons discussed above, the Petition has not presented compelling evidence of unpatentability. Interim Procedure, at 3-5; *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper 23 at 5 (PTAB Feb. 27, 2023) (precedential).³

Post-Interim Procedure, the Board has denied petitions under § 314(a) from this Petitioner and should do so here as well. *Ericsson Inc. v. Collision Communications, Inc.*, IPR2022-01233, Paper 12 (PTAB Jan. 19, 2023) (“*Collision*”); *Ericsson Inc. v. Godo Kaisha IP Bridge 1*, IPR2022-00725, Paper 10 (PTAB Nov. 2, 2022) (“*Godo*”).

A. Factor 1: A stay is unlikely even if IPR were instituted

The parallel Texas Action has not been stayed. Petitioner has not even moved for a stay; and there is no indication that, even if the IPR was instituted, the district court would grant a stay given the advanced stage of that case.

District courts in the Eastern District of Texas traditionally do not grant a stay until after an IPR is instituted. Even if the Board were to institute in mid-

³ The Petition did not cite the Interim Procedure or any subsequent authority on discretionary denials. Pet., 19 (addressing § 314(a)).

September (6.5 months before trial is scheduled to begin) and Petitioner moved for a stay, there is no indication that the district court would grant Petitioner's motion.

The Board has recognized that the Eastern District of Texas and Judge Gilstrap (presiding judge in the Texas Action), in particular, generally do not grant a stay pending an IPR. *Samsung Elecs. Co., Ltd. et al., v. Clear Imaging Rsch., LLC*, IPR2020-01402, Paper 7 at 13-21 (PTAB Mar. 4, 2021) (discussing Judge Gilstrap). Indeed, in another case involving the same parties before Judge Gilstrap, the district court denied Petitioner's motion to stay. *Koninklijke KPN N.V. v. Telefonaktiefbolaget LM Ericsson*, 21-cv-00113-JRG, 2022 WL 17484264, at *1-3 (E.D. Tex. July 7, 2022).

The first *Fintiv* factor thus favors denying institution.

B. Factor 2: Trial in the Texas Action will occur before the Board's final written decision

The Petition should be denied because trial in the Texas Action will occur five-to-six months before a final written decision would be due in an IPR. *Fintiv*, Paper 11 at 6; Interim Procedure, at 3. Trial in the Texas Action is set to start on April 1, 2024. Pet., 19; EX2005, 1. Further, under the median-time-to-trial statistics for Eastern District of Texas, trial would be expected to start on February 25, 2024. EX2006, 35 (19 months for civil trials); EX2007, 1 (complaint filed on

July 25, 2022).⁴ By contrast, the Board’s anticipated one-year statutory deadline for issuing a final written decision here would be September 2024. Accordingly, trial in the Texas Action would commence at least five months before the expected date of the Board’s final written decision.

The second *Fintiv* factor also favors denying institution.

C. Factor 3: The district court and the parties have invested substantially in the Texas Action

The Petition also should be denied because the parties and the district court have already invested—and will continue to invest—significantly in the Texas Action. *Fintiv*, Paper 11 at 10. Claim construction briefing will be complete on September 12, 2023 (which would be before the expected mid-September institution decision), the *Markman* hearing is scheduled for early October, fact discovery is scheduled to close in October, and expert discovery is scheduled to close in December. EX2005, 3-4.

Further, to date, many substantive events have occurred in the Texas Action, including:

- KPN has served both initial and supplemental infringement contentions;

⁴ EX2006 is available through <https://www.uscourts.gov/statistics-reports/analysis-reports/federal-court-management-statistics>. Interim Procedure, 3 n.4.

- Petitioner has served invalidity contentions;
- Each party has served interrogatories and requests for production, to which the other has responded;
- KPN has served requests for admissions, to which Petitioner has responded;
- Petitioner has deposed KPN's Chief Intellectual Property Officer;
- Each party has produced a large volume of documents;
- KPN has conducted several hundred hours of source code review; and
- The *Markman* process has started.

The third *Fintiv* factor favors denying institution.

D. Factor 4: There is substantial overlap between issues in the petition and the Texas Action

The Petition should also be denied because Petitioner's invalidity contentions in the Texas Action include the same references that it relies upon in its Petition: Angelot and Zakurdaev. *See* EX2008, 10-11, 28-34. Because the prior art that Petitioner intends to assert in the Texas Action includes all of the references asserted in the Petition, the fourth *Fintiv* factor favors denying institution. *Fintiv*, Paper 11 at 13.

E. Factor 5: The parties are the same in both proceedings

The parties in the Texas Action and this case are the same. Accordingly, the fifth *Fintiv* factor favors denying institution. *Fintiv*, Paper 15 at 15.

F. Factor 6: The merits of the Petition are weak

In view of the Petition's substantive deficiencies, as set forth herein, the Petition has failed to establish a reasonable likelihood that any of the Challenged Claims is unpatentable. Accordingly, the Petition has also failed to present compelling evidence of unpatentability, which is a higher standard than reasonable likelihood for institution. Interim Procedure, at 4-5; *Commscope*, Paper 23 at 5.

The Petition did not even assert that it has presented compelling evidence of unpatentability. Pet., 19. In any case, KPN's arguments and evidence have raised substantial issues with the Petition, which shows Petitioner's evidence is not compelling, namely, would not "plainly lead to a conclusion that one or more claims are unpatentable." Interim Procedure, at 3-4; *Commscope*, Paper 23 at 3.

The *Fintiv* factors favor discretionary denial, and the Petition fails to present compelling evidence of unpatentability. Accordingly, similar to the post-Interim Procedure cases in which the Board has denied this Petitioner's petitions (*Collision* and *Godo*), the Board should deny institution under § 314(a).

XII. CONCLUSION

Because the Challenged Claims recite limitations not disclosed, taught, or suggested by the proposed grounds of unpatentability, Petitioner has not established a reasonable likelihood that the Challenged Claims are unpatentable. Further,

discretionary denial of institution is warranted. For these reasons, KPN respectfully requests the Board deny the Petition and not institute trial.

Dated: June 17, 2023

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

The undersigned certifies pursuant to 37 C.F.R. § 42.24 that the foregoing Patent Owner's Preliminary Response, excluding any table of contents, mandatory notices under 37 C.F.R. § 42.8, certificates of service or compliance, or appendix of exhibits, contains 14,000 words according to the word-processing program used to prepare this document (Microsoft Word).

/Bradley J. Hulbert/
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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on June 17, 2023 the foregoing Patent Owner's Preliminary Response is being served electronically by agreement of the parties, by email to the following counsel of record.

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