

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

IRIUSRISK, INC.,
Petitioner

v.

THREATMODELER SOFTWARE INC.,
Patent Owner

Case IPR No. IPR2023-00656

U.S. Patent No. 10,713,366

SUPPLEMENTAL DECLARATION OF ROBERT HURLBUT

I. INTRODUCTION

I, Robert Hurlbut, declare as follows:

1. I previously submitted a Declaration in this matter and incorporate that Declaration by reference.

2. I have been asked by Petitioner IriusRisk Inc. to provide further analysis on the proper priority date for U.S. Patent No. 10,713,366 (the “’366 patent,” EX-1001). I also have been asked by Petitioner to provide further analysis on whether Keenan can rely on the date of its provisional application for purposes of determining whether Keenan is prior art.

II. PRIORITY DATE OF THE ‘366 PATENT

3. I understand that the priority date for a continuation-in-part patent can be different for each claim. I understand that a claim of a continuation-in-part patent is entitled to the filing date of its parent application if the parent adequately describes the invention recited in the claim such that the parent conveys to a person of ordinary skill that the inventor had possession at that time of the later claimed subject matter. I also understand that a claim in a continuation-in-part patent is not entitled to the filing date of its parent application if the claim recites a feature that is not adequately disclosed in the parent application such that the parent does not convey to a person of ordinary skill that the inventor had possession at that time of the later claimed subject matter including that feature.

4. The '366 patent is a continuation-in-part of U.S. Patent Application No. 16/228,738, filed on December 20, 2018 (the "Parent Application") and issued as U.S. Patent No. 10,699,008. A copy of the '008 patent is included as EX-1017.

5. Claims 1-20 of the '366 patent all require a "mapping file" used for "correlating the threat model components with visual diagram components of a third party software application." EX-1001.

6. Included as EX-1018 is a redline between the '008 and '366 patent. As shown in EX-1017 and EX-1019, figures 23-29 of the '366 patent and their related descriptions are entirely new to the '366 patent. EX-1001, 35:21-43:11, Figs. 23-29. These figures and descriptions relate to the concept of a "mapping file" used for "correlating the threat model components with visual diagram components of a third party software application" claimed by all claims of the '366 patent. The Parent Application does not contain the words "mapping file," nor does the Parent Application disclose the concept of a mapping file using other words. Additionally, the Parent Application also does not disclose "visual diagram components of a third party software application." In my opinion, the Parent Application does not convey to a person of ordinary skill in the art that the inventor had possession at the time the Parent Application was filed of the "mapping file" or "visual diagram components of a third party software application" recited in claims 1-20 of the '366 patent. My understanding is that this means that claims 1-

20 of the '366 are not entitled to the filing date of the Parent Application as their priority date and that their priority date instead is the filing date of the '366 patent or August 15, 2019.

III. KEENAN AND THE KEENAN PROVISIONAL

7. Because the priority date of claims 1-20 of the '366 patent is August 15, 2019, U.S. Patent No. 11,200,228 ("Keenan") is prior art against those claims because Keenan was filed on April 19, 2018.

8. In case the Board disagrees with my conclusion as to the priority date of the '366 patent, I have been asked to determine whether Keenan is entitled to rely on the filing date of April 19, 2017, of U.S. Provisional Patent Application No. 62/487,370 (the "Keenan Provisional") to which Keenan claims priority, for purposes of determining whether Keenan is prior art against the '366 patent. Keenan's Provisional is included as EX-1019.

9. I understand that a published patent or patent application qualifies as prior art under pre-AIA 102(e) as of its provisional filing date if at least one claim in the published patent or patent application finds written description support in the disclosure of its provisional application. I further understand that the subject matter relied on from the published patent or patent application must be present in and supported by its provisional.

10. I have compared claim 1 of Keenan against the disclosure of the Keenan Provisional and have concluded that claim 1 of Keenan does find written description support in the Keenan Provisional. Included as EX-1020 is a claim chart containing my analysis on this issue.

11. I have also compared claims 1-20 of the '366 patent against the disclosure of the Keenan Provisional and have concluded that the Keenan Provisional anticipates claims 1-20 in the same way that Keenan does. Included as EX-1021 is a claim chart containing my analysis on this issue.

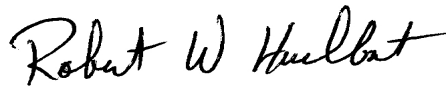
12. I have also reproduced the claim chart of Keenan attached as Exhibit B to my first declaration, EX-1003, except the claim chart now includes cites to Keenan's Provisional. This chart is included as EX-1022. This chart demonstrates that the prior art portions of Keenan's non-provisional relied upon for anticipation are supported by Keenan's Provisional.

13. In conclusion, Keenan is prior art against the '366 patent for two reasons. First, the '366 patent is not entitled to the priority date of the Parent Application, and Keenan itself therefore is prior art against the '366 patent. Second, even if the Board disagrees with me on this point, Keenan is entitled to rely on the priority date of the Keenan Provisional, which means that Keenan is prior art against '366 patent even if the '366 patent is entitled to the earliest

possible priority date of May 17, 2017 (which is the filing date of the earliest provisional application to which the Parent Application claims priority).

14. I hereby declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct, and that all statements made of my own knowledge are true and that all statements made on information and belief are believed to be true. I understand that willful false statements are punishable by fine or imprisonment or both under Section 1001 of Title 18 of the United States Code.

Executed on March 28, 2024 at 5:24 PM EDT.

A handwritten signature in black ink, reading "Robert W. Hurlbut". The signature is written in a cursive style with a horizontal line underneath it.

ROBERT HURLBUT