

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PALO ALTO NETWORKS, INC.

Petitioner

v.

BT AMERICAS INC.

Patent Owner.

Case IPR2023-00889
Patent 7,895,641

REQUEST FOR REHEARING

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LIST OF EXHIBITS

2001	Declaration of Wenke Lee
2002	Declaration of Bruce Schneier from IPR2019-01324
2003	Bruce Schneier's Wikipedia
2004	John Callas' Wikipedia
2005	Jeffay, et al., " <i>What TCP/IP Protocol Headers Can Tell Us About the Web</i> ," Proceedings of ACM SIGMETRICS 2001/Performance 2001 (June 2001)
2006	Stipulated Protective Order Confidentiality Agreement from Fortinet
2007	Deposition Transcript of Dr. Jeffay
2008	Bassham, et al, " <i>Threat Assessment of Malicious Code and External Attacks</i> ," NISTIR 4939, NIST (October 1992).
2009	Schneier, " <i>Counterpane and Managed Security Monitoring</i> ," Counterpane (April 2002)
2010	Markoff, " <i>Beyond Computers in Computer Security</i> ," The New York Times (April 2000)
2011	" <i>Counterpane Internet Security Delivers Industry's Most Comprehensive Managed Security Services</i> ," Help Net Security (August 2003)
2012	Woodie, " <i>Counterpane Brings OS/400 Into its Managed Security Fold</i> ," IT Jungle (March 2005)
2013	Pescatore, et al., " <i>2H01 Managed Security Service Provider Magic Quadrant</i> ", Gartner (February 2002)
2014	Hunt, et al., " <i>Market Overview: Managed Security Services</i> ," Giga Information Group (April 2001)

2015	Gonsalves, “ <i>Watchful Eyes – Outsourcing event-log monitoring saves health insurer money and provides early warnings on network intruders</i> ,” United Business Media
2016	Declaration of Wenke Lee in Support of Patent Owner’s Response
2017	Sturgeon, “ <i>BT snaps up Counterpane Internet Security</i> ,” CNET (October 2006)
2018	Excerpts of Deposition Transcript of Kevin Jeffay
2019	“The Shrinking Cost of a Megabit,” NCTA – The Internet & Television Association (March 2019)
2020	Curriculum Vitae of Wenke Lee, Ph.D.
2021	Joint Claim Construction Brief from <i>British Telecommunications plc et al. v. Palo Alto Networks, Inc.</i> , Case 1:22-cv-01538-CJB, dkt. 142.
2022	Supplemental Declaration of Wenke Lee in Support of Patent Owner’s Sur-Reply
2023	Daria Zhuravleva, “Most Common Spam Emails You Can Encounter in 2024,” May 8, 2022, available at https://selzy.com/en/blog/spam-email-examples/
2024	“The Worst Phishing Attacks in History,” January 05, 2023, available at https://www.graphus.ai/blog/worst-phishing-attacks-in-history/
2025	Micke Ahola, “The 7 most damaging phishing attacks of all time,” available at https://blog.usecure.io/famous-phishing-attacks
2026	Patchen Barss, “Ten indispensable technologies built by the pornography industry,” June 5, 2011, available at https://patchenbarss.com/2011/06/05/ten-indispensable-technologies-built-by-the-pornography-industry/

2027	Cezary Jan Strusiewicz, “5 Ways Porn Created the Modern World,” <i>Cracked</i> , December 11, 2010, available at https://www.cracked.com/article_18888_5-ways-porn-created-modern-world.html
2028	Doug Gross, “In the tech world, porn quietly leads the way,” <i>CNN</i> , April 23, 2010, available at https://edition.cnn.com/2010/TECH/04/23/porn.technology/
2029	Patent Owner’s Oral Hearing Demonstratives

Patent Owner (PO) respectfully requests rehearing on the Final Written Decision (FWD). The FWD manufactures alleged PO admissions/concessions, gives Petitioner a “free pass” after it failed to disclose litigation positions directly contrary to those it advanced in this proceeding, and avoids confronting actual admissions from Petitioner’s expert by mixing and matching arguments from different portions of the Petition and treating as talismanic a factually unembellished one-line reference to *KSR*—all in an effort to justify the legal conclusions of obviousness. These are instances where hard facts and key legal principles were misapprehended and/or overlooked.¹ All claims are patentable.²

I. THE FWD’S FALSE ATTRIBUTIONS OF “CONCESSIONS” AND “ADMISSIONS” MUST BE ADDRESSED.

The FWD alleges that PO at the oral hearing conceded or admitted various points. But the trial transcript and PO’s oral hearing demonstratives indicate that PO’s counsel explicitly stated the opposite of the alleged admissions/concessions.

¹ PO reserves the right to raise these and other issues if a subsequent Federal Circuit appeal becomes necessary. *See Voice Tech Corp. v. Unified Patents, LLC*, 110 F.4th 1331, 1339-41 (Fed. Cir. 2024).

² At the very least, the Board should vacate the portions of the FWD that set forth and rely on false PO concessions and admissions—and provide PO with a new opportunity for requesting rehearing based on a corrected record if a determination adverse to patentability is maintained.

PO did not agree that “residue data ‘doesn’t get filtered’ prior to becoming residue,” as the FWD asserts. The FWD on page 29 states that “any data as described in the ’641 patent and recited in claim 1 that the disclosed filters do not select or discard necessarily is data that is different than the status data that the filters do select or discard”—and references the trial transcript to suggest that PO agreed. That assertion is wrong; the transcript does not indicate PO’s agreement.

First, the transcript does not indicate PO’s agreement to the FWD’s contention. PO’s counsel in the cited portion was discussing Duvall, not the ’641 patent or claim 1. *See* FWD, 29 (citing Tr. 44:21-45:1). A relevant explanation actually appears a few lines earlier in the transcript: “[T]he word residue has to mean something.... [I]t’s all the same stuff, all going through all these filters and getting analyzed by the anomalous event detection subsystem or anomaly engine Box 2050, in Figure 2.... It has to be the same data, all parties agree on that.” Tr. 44:11-19. *See also* EX2029, 19 (quoting Petitioner’s litigation counsel as stating that “status data is filtered and any status data that does not match a filter is ‘post-filtering residue’”), 20 (tracing ’641 Patent Fig. 2), 27 (“Patent Owner and PAN’s litigation counsel are aligned in how the post-filtering residue limitation should be construed—e.g., separate stages of analysis operating on the same status data.”).

Similarly, although the FWD on page 29 uses quotation marks as if it were attributable to PO, the phrase “doesn’t get filtered” appears nowhere in the trial

transcript. The closest text is perhaps the statement at page 41, line 1, which follows the text on page 40 at lines 22 and 24, where PO's counsel was explaining that residue data "has to not be rejected" by a first set of filters and "has to not be allowed" by another set of filters. Based on the text in the FWD at page 29, it might be the case that the Board misapprehended the difference between "filtered" when used to describe the filtering processes, compared to when used to describe the outcome of the filtering processes. Regardless, PO's counsel repeatedly stated that the post-filtering residue had to be part of the same original set of data as the selected and discarded data. Residue data is status data that (1) has been subjected to positive and negative filtering processes, and (2) is not filtered in that it has not been filtered out and has not been filtered in (i.e., selected and discarded). That is the point of the colloquy at Tr. 40:4-41:1 and the discussion of Fig. 2.

Simply stated, the residue data is status data that "survives" positive and negative filtering operations; it is neither selected nor discarded, it is not filtered out and it is not filtered in. That understanding tracks the plain language of the independent claims ("neither discarded nor selected by filtering"), the prior litigation construction (EX1013, 4), Petitioner's current litigation position (EX2021, 17, 47-48), the Statement of Reasons for Allowance during original prosecution (EX1052, 7; EX1017, 328), and the construction currently being applied by the Central Reexamination Unit (CRU) in a related reexamination

proceeding (see 9/18/2024 Office Action issued in Control No. 90/019,422, pp. 5-6, issued about a month after the oral hearing). The Board appears to have overlooked the fact that it has credited one outlier position, namely, Petitioner's IPR counsel, with which not even Petitioner's own litigation counsel agrees.³

The FWD in the last full paragraph on page 30, and in the paragraph bridging pages 30-31, reproduces the “doesn’t get filtered” false quotation. PO should not be held accountable for something it plainly did not say. Nor should PO be held accountable for an argument that the Board misapprehended despite PO's clear statements to the contrary, particularly because it was already accepted in a separate district court proceeding, two other branches of the USPTO, and agreed to by Petitioner's litigation counsel.

Note also that the transcript at 46:6-48:5 does not involve the Board “press[ing] Patent Owner as to how its disclosed filtering system in the '641 patent

³ The fact that Petitioner withheld its litigation construction from the Board, and then tried to have it excluded during a telephone hearing—and then doubled-down by complaining about having to defend it during the oral hearing—is problematic to say the least. Crediting a position that Petitioner's own litigation counsel finally contradicted, especially in spite of a district court and two different USPTO proceedings taking alternative views, guts the duty of disclosure and duty of candor requirements, and invites chaos into IPR proceedings.

differs from Duvall's system." There, PO's counsel was discussing, among other things, Duvall's implementation of patching code, its silence on packet-based analysis, and the improper liberties Petitioner's expert was taking with Duvall.

Given the clearly incorrect citations, it is difficult to discern what is meant in the paragraph bridging pages 30-31, and those that follow. What is clear, however, is that PO expressly stated "there are two differences [between Duvall and the disclosed filtering system in the '641 patent], and the two differences depend on whether you credit [PO's] explanation of how Duvall operates, or if you credit [Petitioner's] operation of Duvall." Tr. 41:16-19. And the Board replied, "I see where you're going. Okay. Thank you." Tr. 41:20-21. *See also* EX2029, 21-25 (identifying differences when Duvall is properly read), 26 (identifying differences when Duvall is improperly read), 27 (summarizing these two approaches).

Second, the FWD conflates the differences between the various subsets of data (i.e., selected, discarded, residue) with the *original* superset of data (i.e., the transmissions). *See* FWD, 29. The Board overlooks that while the **subsets** of selected and discarded data are necessarily different than the **subset** of residue data, they must still be subsets from the same original superset of status data under the prior litigation's construction of the "post-filtering residue." *Compare* FWD, 29, *with* FWD, 14 (prior litigation's construction). The "post-filtering residue" identified by Petitioner is not part of that same superset of status data from which

the selected/discarded subsets are produced. Rather, it is an entirely new set of transmissions. No status data from these new transmissions will ever be part of a selected or discarded subset. Likewise, for the superset of transmissions where Duvall's filtering process actually applies, the subset of surviving status data (i.e., neither selected nor discarded) is also never further analyzed. But that subset of surviving status data is the post-filtering residue under the construction from the prior litigation. Accordingly, the Board overlooks that "if [it] were to adopt [the] construction from the prior litigation" (FWD, 14), Petitioner fails to show that Duval as modified by Chu reads on any of the claims.

On the present record, there is nothing apparent that PO's counsel said during the oral hearing that could support the FWD's conclusions. To the extent that PO is being held accountable for alleged admissions/concessions, the record should be clarified to explain what they are and where in the record they appear, so that PO has an adequate basis for response and so that the record is set for appeal.

II. THE FWD ERRS IN ITS IMPLICIT CONSTRUCTIONS, EXPLICIT CONSTRUCTIONS, AND NON-CONSTRUCTIONS.

A. The Overall Approach to the Claims Is Flawed.

Neither claim 1 nor claim 18 includes optional language. And (although PO disagrees) only one term in claim 1 has been identified as involving "reasonable capability" pursuant to *ParkerVision*. Yet the FWD either implicitly construes

certain language as being merely optional or rewrites the claim language altogether. Neither approach is correct.

System “claims cover what a device *is*, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1468 (Fed. Cir. 1990). As a result, “[a]n invention need not operate differently than the prior art to be patentable, but need only be different”—or, rather, “*unobviously* different.” *Id.* at 1464 & n.2 (citations omitted). Claim 1 recites “a filtering subsystem *coupled to analyze status data to identify potentially security-related events represented in the status data....*” This “coupled to” language is different from the language that some courts have found to involve reasonable capability. *See ParkerVision, Inc. v. Qualcomm Inc.*, 903 F.3d 1354, 1361-62 (Fed. Cir. 2018) (surveying cases). Instead, the “coupled to” language of claim 1 is akin to the “configured to” language endorsed by *ParkerVision* as being fully limiting. *Id.*

In finding that this language of claim 1 can be met by identifying potentially objectionable material that might perchance contain an unidentified potentially security-related event (as per the improper Duvall/Chu combination discussed below), the FWD apparently overlooked or misapprehended the import of this explicit claim language.⁴ That is, the undisputed evidence shows that Duvall is

⁴ Potentially security-related events should be construed pursuant to the parties’

only interested in identifying potentially objectionable material and never actually identifies any potentially security-related events. *See* POR 7-9; Sur-Reply 2-7; EX2016, 31. The undisputed evidence further shows that the transmission of objectionable material is actually less likely to implicate a security-related event compared to the transmission of non-objectionable material. *See* POR 7-9; Sur-Reply 6-7, 10; EX2016, 35-39; EX1046. Evidence cited by Petitioner confirms that malicious code is much more likely to be problematic when unaccompanied by objectionable material and when it looks trustworthy. *See* Sur-Reply 5-6; EX1026, EX1027. Accordingly, merely identifying objectionable material does not identify a potentially security-related event.

Importing filters from Chu into Duvall would not suddenly change Duvall's purpose. That is, filters that assess whether a given site is trustworthy would not turn Duvall into a system that looked for anything other than objectionable material. Indeed, blacklisting sites that are deemed "untrustworthy" would not alter Duvall's central purpose of checking for objectionable content.⁵

agreed litigation construction. But the grounds are flawed even under this improper, broader meaning of "potentially security-related events."

⁵ A person skilled in the art (POSA) would not implement those kinds of filters in Duvall, because doing so would undermine Duvall's operations by allowing more objectionable material into the system. *See* POR 9-12, 33-35; Sur-Reply 7-12.

Thus, the fact that identifying objectionable material might on occasion also happen to block security-related events does not mean that the Duvall/Chu combination would involve “a filtering subsystem *coupled to analyze status data to identify potentially security-related events represented in the status data...*” This language cannot be treated as optional, or discounted under *ParkerVision*.

Claim 18 is a method claim that recites “creating an event record for information received about an identified potentially security-related event occurring on the network.” Here, Petitioner needed to have presented evidence and argument that a POSA would have been motivated to operate Duvall/Chu in a manner that satisfied this limitation and, specifically, “identif[y]ing potentially security-related event.” *See InTouch Techs., Inc. v. VGO Commc’ns, Inc.*, 751 F.3d 1327, 1346-47 (Fed. Cir. 2014) (explaining that a party seeking to invalidate method claims on obviousness grounds must “demonstrate ... ‘that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so’”). The FWD does not do so here for reasons that parallel those above. Again, the fact that identifying objectionable material might on occasion also happen to block security-related events does not mean that the Duvall/Chu combination would involve “identif[y]ing potentially security-related event” as per claim 18.

Thus, even under the FWD's broader implicit interpretation, the language of the claims is not met. This error pervades all grounds.

B. The FWD's Implicit and Explicit Constructions Concerning Post-Filtering Residue Are Flawed.

As between original prosecution, the prior litigation, admissions from Petitioner's litigation counsel, and the ongoing reexamination, the clear through-line is the position advanced by PO: The term "post-filtering residue, wherein the post-filtering residue is neither discarded nor selected by filtering" means "status data that undergoes negative and positive filtering, but is neither discarded by such negative filtering nor selected by such positive filtering." The FWD apparently overlooked or misapprehended this consistency across parties and fora.

As shown above, the FWD's attempts to hold PO accountable for alleged admissions/concessions during the oral hearing that were never made are inappropriate, especially on this record. Moreover, the Board's findings regarding residue not needing to be status data and residue not needing to be filtered (and by implication not needing to survive both positive and negative filtering) are not only inconsistent with PO's counsel's repeated statements to the contrary at the hearing, but also inconsistent with the Fig. 2 embodiment, and associated description. *Cf. Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1583 (Fed. Cir. 1996) (an interpretation excluding "a preferred (and indeed only) embodiment in the

specification ... is rarely, if ever, correct....”). Indeed, these positions cannot be reconciled with the FWD’s own summary of the ‘641 patent subject matter on page 6, which states (with emphases added):

Figure 2 depicts “a system overview of an exemplary embodiment of a probe/sentry system.” Ex. 1001, 4:1–3. Sensors 1010, 1020, 1030, and 1040 collect status data first filtered by negative filtering subsystem 2020, which discards uninteresting information, and then filtered by positive filtering subsystem 2030, which selects potentially interesting information that it forwards to communications and resource coordinator 2060. *Id.* at 8:51–55. Status data that negative filtering subsystem 2020 does not discard and that positive filtering subsystem 2030 does not allow constitutes “residue” that flows to anomaly engine 2050 for further analysis. *Id.* at 8:55–59.

Residue is status data. And the residue must be the same data that is neither selected nor discarded, i.e., data that “survives” positive and negative filtering.

The FWD at page 31 further bases its disagreement on a desire to avoid reading into the claims an anomaly engine or anomalous event detection subsystem. But there is a “distinction between using the specification to interpret the meaning of a claim and importing limitations from the specification”—and the former is entirely acceptable. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005). POSAs “rarely would confine their definitions of terms to the exact representations depicted in the embodiments” and, thus, *in haec verba* support is

not necessary to interpret the meaning of a claim term. *Id.*

Claim language is not read in isolation. *See* 37 C.F.R. § 42.100(b). And where there is a dispute about the plain and ordinary meaning of a claim term, that dispute must be resolved. *See O2 Micro Intern. Ltd. v. Beyond Innovation Technology Co.*, 521 F. 3d 1351, 1361 (Fed. Cir. 2008). PO's construction is consistent with what was understood by the Examiner during original prosecution, what was done in the prior litigation, what was admitted to by Petitioner's litigation counsel, and what is being done in the ongoing reexamination. This unified construction should be adopted here, as well.

C. The Board Should Have Construed the Claims in Accordance with Petitioner's Admissions.

There is one construction for infringement and invalidity. And the PTAB, in IPR proceedings, is supposed to apply the same construction as in district court proceedings. 37 C.F.R. § 42.100(b). There is therefore no justifiable reason for the Board declining to construe (1) identifying/identified potentially "security-related events" in accordance with the agreed construction from the litigation between PO and Petitioner, and (2) "post-filtering residue, wherein the post-filtering residue is data neither discarded nor selected by filtering" in accordance with the admissions from Petitioner's litigation counsel.

First, the Board appears to have overlooked or misapprehended the

importance of the agreed construction of identifying/identified potentially security-related events. Specifically, Petitioner’s litigation counsel initially sought to define this term as “potentially intrusive activity happening on a network.” EX2021, 49-54, 60-62. But Petitioner’s litigation counsel subsequently disclaimed this construction and instead agreed to construe “security-related events” as “attacks or intrusions against the computer network.” *Id.* Petitioner’s litigation counsel thus initially sought a construction narrower than proposed by Petitioner’s IPR counsel, and narrower than that adopted in the FWD—but then disclaimed it in view of a yet narrower construction. That yet narrower agreed construction actually reflects the technology at issue and drives a further wedge between what Duvall does (and what the alleged Duvall/Chu combination presumably would do), and what is to be understood from the properly construed claims. That is, identification of potentially objectionable material is in no way reflective of identifying potential attacks or intrusions against the computer network—even if that identification is “aided” by the blacklist/whitelist from Chu.

Second, the Board clearly should hold Petitioner to its litigation counsel’s statement that “status data is filtered and any status data that does not match a filter is ‘post-filtering residue.’” *Id.*, 47-48. That is, the Board clearly should find that post-filtering residue is status data—and, specifically, the specific status data that was “neither discarded nor selected by filtering.” *Id.*, 17. This approach accords

with constructions from the USPTO and a prior district court litigation.

III. THE FWD SHOULD HAVE FOLLOWED THE PETITION—AND THE EVIDENCE—IN FINDING THE CHALLENGES DEFICIENT.

The FWD on page 27 incorrectly states that “[t]he term ‘potentially security-related events’ is broad enough to encompass the objectionable material that Duvall monitors and/or those that Chu monitors.” It compounds this error by crediting testimony that “Duvall’s and Chu’s similar technique for identifying objectionable material identifies potential and virus- and malware-related risks.”

At the outset, the Board clearly overlooked or misapprehended the proper meaning of potentially security-related events—including the fact that Petitioner expressly disclaimed a construction including “potentially intrusive activity happening on a network.” EX2021, 49-54, 60-62. As explained above, the proper construction involves “attacks or intrusions against the computer network” as Petitioner agreed. *Id.* There is no way objectionable material *per se* constitutes “attacks or intrusions against the computer network” per the agreed construction.

The Board also clearly overlooked or misapprehended that Dr. Jeffay’s analysis was fatally flawed because he conducted no independent study of his own and could cite to no relevant studies linking objectionable material to potentially security-related events (especially not when properly construed). *See* POR 7-9; Sur-Reply 2-7; EX2007, 68:22-69:8, 67:5-9; 69:14-70:4. Differently stated, Dr.

Jeffay's methodology cannot be credited because there was no methodology at all.

Even so, as shown above, claims 1 and 18 do not involve optional language or language that can be met by reasonably capability. Thus, even if Dr. Jeffay's testimony is credited, the proper approach to examining these claims confirms that a mere happenstance occurrence is insufficient to demonstrate the obviousness of this language of these claims. And even if Chu's filters were for some reason incorporated into Duvall (which would not have been done by a POSA), they still would be used for Duvall's fundamental purpose of identifying potentially objectionable material, not potentially security-related events. To find otherwise would require a fundamental change to Duvall's principle of operation, and the legal conclusion of obviousness cannot exist under such circumstances. The fact that a potentially security-related event might be picked up as a coincidence when looking for objectionable material is insufficient to render obvious the specific system configuration of claim 1 or the parallel language of claim 18.

The FWD at page 28 also misapprehends what would result by "modifying Duvall's filtering techniques based on Chu's teachings." There would have been no improvements. To the contrary, a POSA would understand that following Chu's teachings regarding trustworthiness would undermine Duvall's purpose by allowing more objectionable material to reach the end user. *See* POR 9-12, 33-35; Sur-Reply 7-12. A POSA would further understand that prompting an end-user (or

even a trained security analysis) each time a decision could not be reached would overwhelm that person and lead to problems the ‘641 patent solves. And still further, the proposed modification relies on changing a multi-use, multi-user default filter based on one of these one-off decisions—which absolutely would be problematic in the technological context in which the ‘641 patent operates.

In a related regard, the Board apparently misapprehended or overlooked Dr. Jeffay’s backtracking on the alleged benefit of introducing Chu to “more accurately resolv[e] residue data to ensure transmissions are correctly blocked or allowed.” Dr. Jeffay testified that there was no need for any additional techniques beyond those set forth in Duvall to address the problem of filtering too much or too little—and that “given the operation of Duvall, a [POSA] would understand that nothing more is needed.” EX2007, 133:17-22; POR 1-2, 9-12; Sur-Reply 7-8.

The FWD also places too much credit on the citation to *KSR* regarding the use of known techniques to improve similar devices. As shown above, the proposed combination would harm Duvall, not improve it. And the concepts of identifying objectionable content vs. identifying potentially security-related events are orthogonal, meaning that the device of Duvall and the device of Chu are not “similar.” Thus, this catchall motivation does not help establish obviousness.

IV. THE BOARD OVERLOOKS AND MISAPPREHENDS PETITIONER’S FAILURE TO SHOW THE DYNAMIC

MODIFICATION LIMITATION.

The Board (1) overlooks the lack of evidence and argumentation from Petitioner about whether Duvall is “reasonably capable” of “dynamically modifying an analysis capability of said probe during operation thereof” and (2) misapprehends PO’s expert testimony regarding the same.

First, although the Board credits Dr. Jeffay’s testimony, Dr. Jeffay only discusses whether the database itself can be dynamically modified. *See* FWD, 56-57. But neither Dr. Jeffay nor Petitioner explains how Duvall’s analysis capabilities would be dynamically modified as a result. Indeed, whether Duvall’s analysis capabilities can be dynamically modified depends on whether Duvall’s disclosed methodologies are compatible with dynamic modification and whether the way Duvall’s patching code uses the database is compatible with dynamically reflecting changes to the database.⁶ Duvall’s own disclosure suggests that it is not “reasonably capable” absent significant and undisclosed modifications. *See, e.g.*, Duvall, 8:12-13 (only recognizing “a user can copy URLs for later editing” (emphasis added)); 3:46-49 (disclosing database “copied to RAM during

⁶ They are not compatible, which the Board itself already at least implicitly recognized. *See* Institution Decision at 40 (implicitly recognizing that Duvall’s general methodology is incompatible with dynamic modification once the data stream has already been opened). Petitioner never addressed that incompatibility.

operation”). Accordingly, in finding this limitation met based upon the evidence in the record, the Board effectively finds that Duvall’s mere use of a dynamically modifiable database inherently enables dynamic modification of the analysis capabilities of patching code that uses the database.

Second, the Board misapprehends the purpose of the PO’s expert’s discussion in paragraphs 134-141. *See* FWD, 58-59 (citing PO Resp. 37 and EX2016, ¶¶134-141). The Board is correct that PO’s line of argument does not undermine Petitioner’s showing that a database can be dynamically modified. *See* FWD, 59. But that is not the point. Indeed, PO is not disputing whether a database itself can be dynamically modified. Rather, regardless of whether the database itself can be dynamically modified, PO presents evidence that Duvall’s analysis capabilities cannot be dynamically modified without significant modification based on its disclosure. The addition of a cache coherency solution is just one example of the many significant modifications that would have to be made by Duvall’s system to make it compatible with a dynamically modified database. PO therefore shows that the ability to dynamically modify Duvall’s analysis capabilities is not an inherent aspect of Duvall’s use of a database—regardless of whether that database is capable of being dynamically modified.

Because Petitioner and its expert never provide any evidence or argumentation besides showing a database can be dynamically modified, Petitioner

has failed its burden of persuasion. *See Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378 (Fed. Cir. 2015) (holding burden of persuasion never shifts to patent owner).

V. THE BOARD INCORRECTLY CONCLUDED THAT PO DID NOT DISPUTE A SHOWING DESPITE THE PO'S ENTIRE ARGUMENT FOCUSING ON DISPUTING THAT VERY SHOWING.

The Board incorrectly concluded that PO “did not dispute” Petitioner’s showing that Duvall’s alleged multi-stage analysis includes analysis at the probe and at a secure operations center. To the contrary, the Board overlooks that the entirety of Petitioner’s argument for claim 6 is dedicated to disputing this very “showing.” Although PO did not directly dispute intervening claim 2, PO never conceded that Duvall’s multi-stage analysis included analysis at a secure operations center.⁷ Rather, PO explained that the only analyses Petitioner has shown at a SOC occurs following limitation 1(c). *See* POR, 38-40.

The FWD relies on these same portions of Petitioner’s argument. But the

⁷ Indeed, claim 2 makes no mention of a secure operations center. PO’s alleged failure to respond directly to claim 2 cannot be taken as a concession that it does not dispute anything stated by Petitioner in connection with claim 2. Rather, PO has merely chosen not to contest claim 2 independently from claim 1. PO is unaware of any rule stating that arguments cannot be made for a dependent claim unless each intervening claim also is separately argued.

FWD interprets the references as disclosing that *residue* is sent to the SOC, which is then analyzed by the analyst. *See* FWD, 86 (citing Pet. 46). The Board overlooks that such a mapping would completely undo Petitioner’s mapping for claim 1. Indeed, Petitioner relies on that very same disclosure and transmission to show that information about an already identified event is transmitted to the analyst—thus satisfying limitation 1(c). This same disclosure of the same transmissions cannot both be the residue of limitation 1(b) (to satisfy claim 6), while also being an already identified event (for limitation 1(c)). Indeed, the Board acknowledged that limitation 1(c) must occur after limitation 1(b). *See* FWD, 86.

Accordingly, regardless of whether “information flow[s] both ways” (*see* FWD, 86), Petitioner does not show—and references cited by Petitioner neither teach nor suggest—that information flows both ways *before* identified events are transmitted to the analyst as required by limitation 1(c). Because Petitioner never even attempts to make such a showing, Petitioner has failed its burden of persuasion. *See Dynamic Drinkware*, 800 F.3d at 1378.

VI. CONCLUSION

The Board should find all claims patentable.

Respectfully submitted,

Dated: December 9, 2024

/Nolan M. Goldberg/

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true copy of the foregoing Request for Rehearing, was served on Petitioner on 12/9/2024, by emailing a copy to counsel at the email addresses listed below:

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