

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OXYLABS, UAB,

Petitioner

v.

BRIGHT DATA LTD.,

Patent Owner

Case IPR2023-01425

Patent No. 11,206,317

PATENT OWNER PRELIMINARY RESPONSE

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-14

<u>PATENT OWNER'S LIST OF EXHIBITS</u>	
EX. 2001	Declaration of Dr. Tim A. Williams, previously submitted in IPR2022-00936 as Exhibit 2001 on Sept. 8, 2022
EX. 2002	Screenshot from the Internet Archive (2006), accessed at https://web.archive.org/web/20060515000000*/http://afs.eecs.harvard.edu/~goodell/thesis.pdf on December 17, 2023
EX. 2003	Screenshot from the Internet Archive (2007), accessed at https://web.archive.org/web/20070515000000*/http://afs.eecs.harvard.edu/~goodell/thesis.pdf on December 17, 2023
EX. 2004	Screenshot from the Internet Archive (2008), accessed at https://web.archive.org/web/20080701000000*/http://afs.eecs.harvard.edu/~goodell/thesis.pdf on December 17, 2023
EX. 2005	Screenshot from the Internet Archive (404 Error), accessed at https://web.archive.org/web/20081125083038/http://afs.eecs.harvard.edu/~goodell/thesis.pdf on December 17, 2023
EX. 2006	Screenshot from HOLLIS, Harvard University, accessed at https://hollis.harvard.edu/primo-explore/fulldisplay?docid=01_HVD_ALMA212110355720003941&context=L&vid=HVD2&lang=en_US&search_scope=everything&adaptor=Local%20Search%20Engine&tab=everything&query=any,contains,geoffrey%20goodell&offset=0 on December 17, 2023
EX. 2007	Visitor Access, Harvard University Library, accessed at https://library.harvard.edu/visitor-access on December 17, 2023
EX. 2008	Screenshot from WORLDCAT, accessed at https://search.worldcat.org/title/229431642?oclcNum=229431642 on December 17, 2023
EX. 2009	Screenshot for “Internet” search results from HOLLIS, accessed at https://hollis.harvard.edu/primo-explore/search?query=any,contains,Internet,AND&pfilter=dr_s,exact

	<u>00000101,AND&pfilter=dr_e,exact,20081008,AND&tab=books&search_scope=default_scope&vid=HVD2&mode=advanced&offset=0</u> on December 22, 2023
EX. 2010	Screenshot for “Information networks” search results from HOLLIS, accessed at <u>https://hollis.harvard.edu/primo-explore/search?query=any,contains,information%20networks,AND&pfilter=dr_s,exact,00000101,AND&pfilter=dr_e,exact,20081008,AND&tab=books&search_scope=default_scope&vid=HVD2&mode=advanced&offset=0&conVoc=false</u> on December 22, 2023
EX. 2011	Screenshot for “Information services” search results from HOLLIS, accessed at <u>https://hollis.harvard.edu/primo-explore/search?query=any,contains,information%20services,AND&pfilter=dr_s,exact,00000101,AND&pfilter=dr_e,exact,20081008,AND&tab=books&search_scope=default_scope&vid=HVD2&mode=advanced&offset=0&conVoc=false</u> on December 17, 2023
EX. 2012	Screenshot for “Information storage and retrieval systems” search results from HOLLIS, accessed at <u>https://hollis.harvard.edu/primo-explore/search?query=any,contains,information%20storage%20and%20retrieval%20systems,AND&pfilter=dr_s,exact,00000101,AND&pfilter=dr_e,exact,20081008,AND&tab=books&search_scope=default_scope&vid=HVD2&mode=advanced&offset=0&conVoc=false</u> on December 22, 2023
EX. 2013	Screenshot for “Wide area networks (Computer networks)” search results from HOLLIS, accessed at <u>https://hollis.harvard.edu/primo-explore/search?query=any,contains,wide%20area%20networks%20(computer%20networks),AND&pfilter=dr_s,exact,00000101,AND&pfilter=dr_e,exact,20081008,AND&tab=books&search_scope=default_scope&vid=HVD2&mode=advanced&offset=0&conVoc=false</u> on December 22, 2023
EX. 2014	Screenshot for Local Bibliography: BibTex, accessed at <u>https://web.archive.org/web/20060902121531/http://afs.eecs.harvard.edu/~goodell/blossom/bib/bibtex.html#goodell2006</u> on December 17, 2023

EX. 2015	U.S. District Courts–Combined Civil and Criminal Federal Court Management Statistics (September 30, 2023), accessed at https://www.uscourts.gov/statistics-reports/federal-court-management-statistics-september-2023 on December 17, 2023
EX. 2016	ISBN Search, accessed at https://isbnsearch.org/isbn/9781109837766 on December 17, 2023
EX. 2017	Google Scholar – ISBN Search, accessed at https://scholar.google.com/scholar?hl=en&as_sdt=0%2C47&q=978-1-109-83776-6&btnG= on December 17, 2023
EX. 2018	Declaration of Elizabeth A. O’Brien

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I. INTRODUCTION

Patent Owner respectfully submits this preliminary response to the petition regarding Patent No. 11,206,317 (“the ‘317 Patent”). The Board should deny institution for at least four reasons.

First, the petition sets forth only a single ground based on the Goodell reference and Petitioner fails to show that the Goodell reference was publicly available and even qualifies as a printed publication.

Second, the *General Plastic* factors favor denial at least because Petitioner fails to show that it performed a reasonably diligent search prior to the filing of the prior petition in the prior IPR.

Third, the *Fintiv* factors favor denial at least because the district court will likely resolve the validity challenges before a final written decision in this proceeding and there is a risk of conflicting decisions.

Fourth, contrary to the claimed inventions of the ‘317 Patent, which work within the existing infrastructure of the Internet, Goodell proposes operations and protocols that exist outside current Internet communications standards and practices. Goodell does not disclose or teach at least limitations 1[b] and 1[e] of the ‘317 Patent.

II. PETITIONER FAILS TO SHOW PUBLIC AVAILABILITY

A. LEGAL STANDARD¹

“[A]t the institution stage, the petition must identify, with particularity, evidence sufficient to establish a reasonable likelihood that the reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication.” *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 16 (PTAB Dec. 20, 2019) (precedential). “[T]here is no presumption in favor of institution or in favor of finding a reference to be a printed publication.” *Id.* at 16.

“Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a printed publication.” *In re Lister*, 583 F.3d 1307, 1311 (Fed. Cir. 2009) (quoting *In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986)). A reference will be considered publicly accessible if it was “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can

¹ See generally, e.g., *First Solar, Inc. v. Rovshan Sade*, IPR2023-00827, Paper 13 at 13-15 (PTAB Nov. 16, 2023).

locate it.” *Kyocera Wireless Corp. v. Int’l Trade Comm’n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008). The determination of whether a document was publicly accessible “involves a case-by-case inquiry into the facts and circumstances surrounding the reference’s disclosure to members of the public.” *Medtronic, Inc. v. Barry*, 891 F.3d 1368, 1380 (Fed. Cir. 2018). In certain situations, such as for manuscripts or dissertations stored in libraries, courts may inquire whether a reference was sufficiently indexed, catalogued, and shelved. *See, e.g., In re Hall*, 781 F.2d 897, 898–99 (Fed. Cir. 1986); *In re Lister*, 583 F.3d 1307, 1315 (Fed. Cir. 2009). Analogously, electronic documents may be publicly accessible if they were indexed or catalogued, or if there were other tools for customary and meaningful research. *See SRI Int’l, Inc. v. Internet Sec. Sys., Inc.*, 511 F.3d 1186, 1196 (Fed. Cir. 2008)(internal citation omitted). “[I]ndexing is no more or less important in evaluating the public accessibility of online references than for those fixed in more traditional, tangible media.” *Voter Verified, Inc. v. Premier Election Sols., Inc.*, 698 F.3d 1374, 1380 (Fed. Cir. 2012).

What constitutes a printed publication “must be determined in light of the technology employed.” *Samsung Elecs. Co. v. Infobridge Pte. Ltd.*, 929 F.3d 1363, 1369 (Fed. Cir. 2019) (internal citation omitted). Public accessibility requires more than technical accessibility. *Id.* (internal citation omitted). “[A] work is not

publicly accessible if the only people who know how to find it are the ones who created it.” *Id.* at 1372.

In sum, “[a] given reference is ‘publicly accessible’ upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *SRI*, 511 F.3d at 1194 (internal citation omitted).

B. THE GOODELL REFERENCE

The Goodell reference (EX. 1005) is a dissertation by Geoffrey Goodell entitled “Perspective Access Networks.” The cover page of the dissertation shows a date of July 2006. EX. 1005 at 1.² Petitioner alleges that Dr. Goodell’s dissertation qualifies as a printed publication under pre-AIA 35 U.S.C. § 102(b). Paper 1 at 25.

Petitioner alleges support for public availability based on (1) the online copy of the dissertation, relying on the Harvard University’s EECS Department’s website for Dr. Goodell; (2) the hard copy of the dissertation in Harvard

² All cites herein are to the exhibit page number except as otherwise identified. It is noted that the exhibit page number (i.e., PDF page number) is 17 digits higher than the internal page number.

University’s library, relying on the HOLLIS card catalog; (3) the ProQuest “Dissertation Abstracts International” publication, relying on the ProQuest database; (4) a November 2006 citing reference; and (5) the website for the “Blossom” project. As will be discussed below, there are fatal deficiencies for each of (1)-(5) and Petitioner ultimately fails to show any reasonable likelihood that the dissertation was publicly available. *Contra* Paper 1 at 23-25.

1. The Online Copy Of The Dissertation, Relying On The Harvard University’s EECS Department’s Website For Dr. Goodell

Petitioner submits a declaration from Dr. Goodell, stating that he posted a PDF version of his dissertation in 2006 at the following link: <http://afs.eecs.harvard.edu/~goodell/thesis.pdf> (“the Goodell Thesis Link”). EX. 1033 at ¶4. Dr. Goodell admits the Goodell Thesis Link is no longer active. *Id.* Dr. Goodell states that the Goodell Thesis Link can be found on the Internet Archive’s Wayback Machine, for the date September 2, 2006. EX. 1033 at ¶5.

Patent Owner independently searched the Internet Archive for the Goodell Thesis Link, which returned three results. There is a first result for September 2, 2006 (EX. 2002); a second result for February 5, 2007 (EX. 2003); and a third result for November 25, 2008 (EX. 2004). Notably, the third result returns a “404 Error” that the requested URL was not found.

At best, Petitioner's evidence shows that the PDF version of Dr. Goodell's dissertation was posted via the Goodell Thesis Link for a total of approximately five months (156 days from September 2, 2006 to February 5, 2007).

Petitioner cites no evidence to suggest that the Goodell Thesis Link was publicly searchable or otherwise indexed. There is no evidence that interested persons would have been independently aware of the Goodell Thesis Link, or even of Dr. Goodell. The name of the author bears no relevance to the subject of the dissertation. *See generally In re Cronyn*, 890 F.2d 1158 (Fed. Cir. 1989). There is no evidence that an interested person exercising reasonable diligence could have known of the dissertation's relevance and located it via the Goodell Thesis Link, particularly during the five month period of September 2006 to February 2007.

***2. The Hard Copy Of The Dissertation In Harvard University's
Library, Relying On The HOLLIS Card Catalog***

As discussed below, there is no online copy of the dissertation available via the HOLLIS Card Catalog. HOLLIS does not mention the Goodell Thesis Link discussed above in section II.B.1. Thus, it appears that Petitioner is merely relying on the hard copy of the dissertation in Harvard University's Library. However, there is no evidence regarding when the hard copy was purportedly catalogued in the library or in HOLLIS. There is no evidence showing that the dissertation was

catalogued in a meaningful way. There is no evidence showing that an interested person could have located the dissertation and reviewed it.

Petitioner suggests the dissertation was available at the Harvard University Library. Dr. Goodell references “HOLLIS”, the University Library’s card catalog, including a link: <http://id.lib.harvard.edu/alma/990105789390203941/catalog> . EX. 1033 at ¶¶8-9. Patent Owner visited the provided link and there is no information in HOLLIS on when the dissertation was available in the University’s library or catalogued in the HOLLIS system. EX. 2006. In fact, it is noted that the hard copy of the dissertation is located in “Offsite Storage”. EX. 2006. HOLLIS states that “Harvard affiliates” must “sign in to see all request options”. *Id.* This statement does not suggest that even a Harvard affiliate would be able to view an online copy of the dissertation via HOLLIS. Patent Owner has been unable to access an online version of the dissertation via HOLLIS.³

Dr. Goodell admits that he has no knowledge of the University’s library cataloguing practices. EX. 1033 at ¶7. Dr. Goodell has no knowledge as to when the dissertation was made available in the University’s library or searchable via HOLLIS.

³ There is reference on HOLLIS to WorldCat, which merely refers back to Harvard University. EX. 2008.

Additionally, Petitioner does not submit a declaration from any library employee to describe the library's routine cataloguing practices for dissertations. *See generally In re Hall*, 781 F.2d 897 (Fed. Cir. 1986). For example, there is no evidence showing the amount of time it would have taken to receive the dissertation and make the dissertation available to interested persons in the library. There is also no evidence showing when the dissertation appeared in HOLLIS.

Further, HOLLIS identifies five search terms for the dissertation: "Internet"; "Information networks"; "Information services"; "Information storage and retrieval systems"; and "Wide area networks (Computer networks)". EX. 2006; *see also* EX. 1033 at 299. Searching HOLLIS for "Library Catalog" published before Oct. 8, 2008⁴ provides the following results:

- "Internet" – 93,167 results (EX. 2009);
- "Information networks" – 10,894 results (EX. 2010);
- "Information services" – 44,867 results (EX. 2011);
- "Information storage and retrieval systems" – 6,436 results (EX. 2012);
- "Wide area networks (Computer networks)" – 412 results (EX. 2013).

⁴ It is noted that the date search criteria is set as day/month/year.

These results are purely from searching the “Library Catalog” and not “Catalog & Articles” which substantially increases the results to 6,831,184 results; 9,090,220 results; 19,670,553 results; 194,527 results; and 573,236 results, respectively. There is also no evidence of when these search categories were created by the library.

Petitioner fails to address how many results these keyword searches would have returned and also fails to show how an interested person would have found, specifically, Dr. Goodell’s dissertation. Petitioner also fails to show that an interested person would have used these or any other keyword searches.

Overall, Petitioner does not explain the level of diligence that would have been necessary to locate a copy of the dissertation. Petitioner fails to show that the dissertation was catalogued/indexed in a meaningful way. Petitioner fails to show an interested person could have located the dissertation and reviewed it.

Moreover, there is no evidence to suggest that materials in the Harvard University Library could be reviewed by an interested person. In fact, Harvard University Library website states that a member of the public (e.g., independent researcher) must (1) apply for a “Library Access Card” which is \$50 for 1 month or \$100 for 3 months and (2) schedule an appointment. EX. 2007 at 4-7. Petitioner does not show that interested persons would have known about the dissertation such that they would have known to request access.

3. The ProQuest “Dissertation Abstracts International”

Publication, relying on the ProQuest Database

Petitioner cites to EX. 1009 alleging that vol. 67, no. 12, supplement B of the ProQuest “Dissertation Abstracts International” publication included the abstract of the Goodell dissertation. Paper 1 at 24.⁵ Petitioner does not address dissemination of this publication. For example, Petitioner does not explain whether this publication was online⁶ or in hard copy, who received this particular publication, how many people received/reviewed this publication, whether the publication itself needed to be purchased, and how an interested person could access the publication.

Moreover, Petitioner admits that the publication only included the abstract and then invited readers ***to purchase*** the full dissertation. Paper 1 at 24. Petitioner does not address the purchase price. Petitioner’s cited exhibit also shows that the publication included 275 pages. EX. 1009 at 1. The abstract is only 1 paragraph

⁵ Petitioner also cites to EX. 1010 which is irrelevant at least because it is a different publication (vol. 65, no. 5) and also incomplete.

⁶ It appears that Petitioner is only relying on the 8/25/2008 date that the publication was loaded into the “ProQuest SciTech Premium Collection” database. See EX. 1038 at ¶7; Paper 1 at 24.

and it is assumed that it would not even take up one full page. It appears that each monthly publication includes approximately 3,500 abstracts. EX. 1010 at 4. Petitioner does not explain how many other abstracts were included in the publication, or how an interested person would have found the abstract and subsequently reviewed the Goodell dissertation.

With reference to the ProQuest database allegedly cataloguing the dissertation, the ProQuest declarant states that the ProQuest database is accessible online only by authenticated subscribers. EX. 1038 at ¶¶4-5. There is no mention of subscription pricing.⁷ The ProQuest database is not searchable through commercial search engines, *e.g.*, Google. The fact that special authorization is required for inspection suggests that the reference is not publicly available. *See generally In re Lister*, 583 F.3d 1307 (Fed. Cir. 2009).

Additionally, Petitioner's cited exhibit shows that the record for the dissertation was catalogued in the ProQuest database under "Classification: 88: Space Sciences (General)(AH)" and in the "Subfile: Aerospace & High Technology Database (AH)". EX. 1009 at 1-2. Petitioner does not explain why an

⁷ It appears from the ProQuest website that a subscription needs to be purchased. *See* <https://about.proquest.com/en/products-services/pqdtglobal/> . There is no pricing information listed online and the only option is to "Contact Sales".

interested person would have searched subject matter in this classification or subfile. It is noted that the record appears to have changed over time and Petitioner does not explain these discrepancies in the record or explain when the record changed.⁸ It is noted that EX. 1009 shows “Last updated: 2012-12-05”. EX. 1009 at 2.

Further, the ProQuest declarant states that “[a]n interested party with access to the Record of the Dissertation could have contacted ProQuest to request a copy of the full Dissertation” (EX. 1038 at ¶11); however, Petitioner fails to show that an interested party could have even accessed the record on the ProQuest database.

⁸ The record shown in EX. 1009 is not the same as the record provided in EX. 1038 (declaration of ProQuest employee, Thomas Hyatt, dated 9/11/2023). There is no “Last updated” date in the record provided in EX. 1038. The record provided in EX. 1038 shows “Classification: 0984: Computer Science”. EX. 1038 at 5. Petitioner does not explain when the record changed and when the classification of Computer Science was created. The record provided in EX. 1038 also shows different keywords and identifies an ISBN number. EX. 1038 at 4. The ISBN number “978-1-109-83776-6” is not searchable on Google or related websites. *E.g.*, EX. 2016; EX. 2017.

Petitioner does not show that an interested person would have known about the abstract for the dissertation such that they would have known to request a copy.

Petitioner states that the database record included keywords “Internet,” “Overlay routing,” “peer-to-peer,” and “perspective access networks”. Paper 1 at 24. However, these keywords are not identified in the record of EX. 1009, and only appear in the record provided in EX. 1038. Petitioner does not explain this discrepancy.⁹ Even so, Petitioner fails to show how many results these keyword searches would have returned and how an interested person would have found, specifically, the abstract for the Goodell dissertation. Petitioner also fails to show that an interested person would have used any of these keyword searches. For example, Dr. Goodell states that his associate H. T. Kung coined the term “perspective access network”. EX. 1005 at 16. Thus, this is not understood to be a term of art and is not a keyword that would have been used by an interested person.

⁹ EX. 1009 shows “Subject: Algorithms; Filtering; Infrastructure; Internet; Networks; Position (location); Propagation”. EX. 1009 at 1. Petitioner does not explain if these subjects are searchable, like keywords. Petitioner does not address the search results for these keywords or why an interested person would have used any of these terms.

Ultimately, Petitioner does not explain the level of diligence that would have been necessary to locate a copy of the dissertation.

Moreover, there is no evidence that the ProQuest publication or the ProQuest database is well-known in the community interested in the subject matter of the Goodell dissertation.

4. The November 2006 Citing Reference

Petitioner cites to EX. 1011, a November 2006 paper that cited to the Goodell dissertation. Paper 1 at 25. This paper cites to the Goodell Thesis Link discussed above in section II.B.1 and thus suffers from the same deficiencies. Even if an interested person further pursued the Goodell dissertation based on title/author, Petitioner does not explain how the interested person would have been able to obtain a copy of the Goodell dissertation, for example, without having Harvard credentials or subscribing to ProQuest, and paying all the requisite fees.

Petitioner provides no evidence that an interested person would have found the November 2006 paper and/or been motivated to find the Goodell dissertation out of the 27 cited references in the November 2006 paper. EX. 2011 at 23-25.

Moreover, the November 2006 paper was authored by Roger Dingledine and Nick Mathewson. EX. 1011.¹⁰ These particular gentlemen were referenced in the

¹⁰ Mr. Dingledine and Mathewson were related to “The Tor Project”.

acknowledgements of the Goodell dissertation as having “spent many hours working with [Dr. Goodell] to determine the right abstractions for the interface between [his] Perspective Access Network tool and their onion routing system”.

EX. 1005 at 16. The fact that these gentlemen cited the Goodell dissertation does not show dissemination of the Goodell dissertation.

Additionally, Tor is distinguished from the claimed invention at least because Tor is based on the principles of onion-routing and selecting a randomly chosen route for each connection. Each node can only see the node before it and the node after it. The “exit node” sends the data to the web server and as such, the web server cannot determine the identity of the “initiating node”. See EX. 1011 at 4. In contrast, the routing in the claimed inventions of the ‘317 Patent is not random. An interested person would not have looked to Tor to arrive at the claimed inventions of the ‘317 Patent.

5. The Website for the “Blossom” project

Lastly, Petitioner alleges support from the website for the “Blossom” project. Patent Owner notes that the Blossom project was the prototype for the Goodell dissertation. EX. 1005 at 22. Dr. Goodell citing to his own dissertation is not evidence of dissemination.

Even so, the website for the Blossom project cites to the Goodell Thesis Link discussed above in section II.B.1 and thus suffers from the same deficiencies.

EX. 1020.¹¹ The bibliography also cites to the Goodell Thesis Link discussed above in section II.B.1 and thus suffers from the same deficiencies. EX. 1018 at 15. Patent Owner provides the BibTex entry showing the hyperlinked URL is the Goodell Thesis Link discussed above. EX. 2014 at 11.

Petitioner also provides no evidence that the website for the Blossom project was known to interested persons.

C. PETITIONER’S ADMISSIONS REGARDING LACK OF PUBLIC AVAILABILITY

In addition to the failures of alleged support discussed above in section II.B, Petitioner’s own admissions further show that the Goodell reference was not publicly available.

Petitioner admits that the Goodell reference is “relatively difficult to find.” Paper 1 at 50. Petitioner refers to the Goodell reference as a “relatively niche” dissertation. Paper 1 at 50. Petitioner admits that the Goodell reference was never published in an academic journal. Paper 1 at 50.

Petitioner admits that it conducted two separate prior art searches and still did not find the Goodell reference. Paper 1 at 50-51; EX. 1037 at ¶12.

¹¹ Patent Owner visited the same address identified in EX. 1020 for September 2, 2006 and hovered over the hyperlink, which showed the Goodell Thesis Link.

Petitioner states that only a few papers cite the Goodell reference. Paper 1 at 50 (citing EX. 1017 (Google Scholar)). However, EX. 1017 does not list any papers citing to the Goodell reference.

Ultimately, Petitioner fails to meet its burden to establish a reasonable likelihood that the Goodell reference was publicly available more than one year before the 10/8/2009 priority date of the ‘317 Patent and therefore, Petitioner fails to establish that there is a reasonable likelihood that the Goodell reference qualifies as a printed publication.

III. CIRCUMSTANCES FAVOR DISCRETIONARY DENIAL

A. BACKGROUND

As discussed below, there is a complicated litigation pattern, where the prior petition challenging the ‘317 Patent was filed before the ‘317 Patent was asserted in any litigation.

On January 7, 2022, **Petitioner** filed infringement claims against Patent Owner in Case No. 2:22-cv-11 (E.D. Tex.), referred to herein as the Oxylabs Litigation. Petitioner asserted Patent Nos. 10,601,948; 9,503,498, and 9,516,091 in the Oxylabs Litigation.

On April 29, 2022, Petitioner filed a first petition challenging claims 1-27 and 29-30 of the ‘317 Patent in IPR2022-00936 (“the -936 IPR”).^{12,13} The grounds were based on alleged obviousness over (i) Goldstein and Ling and (ii) Goldstein and Ling and RFC 1122. IPR2022-00936, Paper 1 at 10. **At that time, the ‘317 Patent was not asserted in any litigation.**

On December 1, 2022, the Board denied institution based on the merits. IPR2022-00936, Paper 8 at 20-25. Petitioner filed a request for rehearing. IPR2022-00936, Paper 9.

On February 2, 2023, the Board confirmed its denial of institution in its decision on rehearing. *See generally* IPR2022-00936, Paper 10.

On February 14, 2023, **Patent Owner** filed counterclaims for infringement of the ‘317 Patent in the Oxylabs Litigation.¹⁴ The court severed the counterclaims into a new action, Case No. 2:23-cv-171 (E.D. Tex.), referred to herein as the Bright Data Litigation.

¹² Petitioner challenged all claims of the ‘317 Patent, except for claim 28.

¹³ Metaccluster LT, UAB, the named petitioner in the -936 IPR, is effectively the same as Oxylabs, UAB, the petitioner in this IPR. Paper 1 at 7, note 1.

¹⁴ Petitioner incorrectly identifies the date as 2/24/2023. Paper 1 at 15.

On April 28, 2023, Petitioner filed counterclaims for infringement in the Bright Data Litigation. Petitioner asserted Patent Nos. 7,010,526 and 7,020,667 in the Bright Data Litigation.

On July 11, 2023, the parties exchanged invalidity contentions in the Bright Data Litigation. It is noted that “Petitioner relies on both Blossom and Goodell in the Bright Data [L]itigation.” Paper 1 at 51.

On September 18, 2023, Petitioner filed the instant petition challenging claims 1, 8, 16, 17, 22, 29, and 30 of the ‘317 Patent in this IPR. There is only one ground based on alleged obviousness over the Goodell reference.

B. THE GENERAL PLASTIC FACTORS

On balance, the *General Plastic* factors favor denial of institution for at least the reasons discussed below. *General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017)(“*General Plastic*”).

Petitioner also proposes two additional factors: (8) IPR efficiencies and (9) noncumulative art. Paper 1 at 52-55. Even so, these proposed factors favor denial of institution.

Ultimately, Petitioner already challenged validity of the ‘317 Patent in the -936 IPR. Petitioner fails to show that it performed a reasonably diligent search prior to the filing of the first petition in the -936 IPR. Petitioner also makes contradictory arguments regarding public availability of the Goodell reference in

this IPR. Petitioner cannot say that the reference is publicly available on one hand, and then say the reference was too hard to find on the other. Also, Petitioner should not be permitted to prejudice Patent Owner, the Board, and the district court with multiple successive challenges to the ‘317 Patent.

1. General Plastic Factor 1

It is not disputed that the same petitioner previously filed a petition directed to the same claims of the same patent. Petitioner agrees that factor 1 favors denying institution. Paper 1 at 49.

2. General Plastic Factor 2

Petitioner argues that the Goodell reference was publicly available more than one year before the 10/8/2009 priority date of the ‘317 Patent. Paper 1 at 23-25. **Petitioner cannot have it both ways.** Based on Petitioner’s own arguments regarding public availability, Petitioner should have known of the Goodell reference prior to filing the first petition in the -936 IPR. Petitioner provides no justifiable reason as to why Petitioner did not find the Goodell reference prior to 4/29/2022.

Petitioner states that it engaged a prior-art search “focusing on printed publications usable in IPRs” and that its search did not locate the Goodell reference. Paper 1 at 50; EX. 1037 at ¶12. Petitioner cannot be rewarded for having

conducted such a limited search in the first instance. An interested person would not have limited its search to only “printed publications usable in IPRs”. Petitioner cannot show that its first search exercised reasonable diligence.

In response to the counterclaims filed on 2/14/2023, Petitioner states that it engaged a second prior-art search that was “expanded” to include system art. Paper 1 at 50. Petitioner states that it learned of the Blossom system on 5/22/2023 as a result of the second search. Paper 1 at 50-51; EX. 1037 at ¶12. Notably, this second search still did not result in finding the Goodell reference. After learning of the Blossom system, Petitioner states it searched for works by its author and located the Goodell reference in June 2023.

Petitioner provides no evidence of the search terms used or the search criteria for performing the first and second searches. Petitioner cannot establish that these searches were reasonably diligent.

Accordingly, factor 2 favors denial.

3. General Plastic Factor 3

Petitioner admits there is a shift in the prior art asserted. Paper 1 at 51. Petitioner did not exercise a reasonably diligent search before filing the first petition in the -936 IPR and Petitioner should not be given a second bite at the apple in this IPR.

As noted in *General Plastic*, “[m]ultiple, staggered petitions challenging the same patent and same claims raise the potential for abuse.” *General Plastic* at 17. “The Board has addressed efficiency and potential prejudice induced by multiple petitions in multiple cases. See [*LG Elecs. Inc. v. Core Wireless Licensing S.A.R.L.*, IPR2016-00986, Paper 12 at 12 (PTAB Aug. 22, 2016)] (“The Board’s resources would be more fairly expended on first petitions rather than on a follow on petition like the Petition in this case.”). *General Plastic* at 17, note 14.

Additionally, Petitioner claims that Patent Owner is not prejudiced because Patent Owner must defend validity of the ‘317 Patent in the Bright Data Litigation. Paper 1 at 52. However, Petitioner admits to the significant overlap between the Blossom system and the Goodell reference. Even though Petitioner has submitted a stipulation not to pursue invalidity based on the Goodell reference in the district court case if this IPR is instituted, it appears that Petitioner would attempt to assert invalidity based on the Blossom system in the district court case.¹⁵ If so, Patent Owner would need to defend itself in this IPR as well as in the district court case in

¹⁵ The Blossom system is the prototype disclosed in the Goodell reference, and Petitioner repeatedly references the Blossom system in the petition. See, e.g., Paper 1 at 26, 27, 28, 29, 31, 35, 47, 50, 51, and 55. “Petitioner relies on both Blossom and Goodell in the Bright Data litigation.” Paper 1 at 51.

view of substantially similar prior art. This is not an efficient use of resources and causes significant prejudice to Patent Owner.

Accordingly, factor 3 favors denial.

4. General Plastic Factor 4

Petitioner purportedly filed the petition within approximately three months of finding the Goodell reference. However, this does not change the fact that, based on Petitioner's own arguments regarding public availability, Petitioner should have found the Goodell reference before the first petition was filed on 4/29/2022 in the -936 IPR.

Accordingly factor 4 favors denial or at minimum, is neutral.

5. General Plastic Factor 5

None of the declarations provided by Petitioner's counsel address when the first prior art search was conducted, prior to filing the first petition in the -936 IPR. *See* EXS. 1037, 1039, 1040, and 1041. Similarly, the declarations do not address when the second prior art search was conducted, only that the Blossom system was uncovered on 5/22/2023. EX. 1037 at ¶12.

Petitioner has not sufficiently explained the time between the filing of the counterclaims on 2/14/2023 and the filing of the instant petition on 9/18/2023. For

example, Petitioner has not explained when the second prior art search began and how it was conducted.

Also, as addressed above, based on Petitioner's own arguments regarding public availability, Petitioner should have found the Goodell reference before the first petition was filed in the -936 IPR.

Accordingly factor 5 favors denial or at minimum, is neutral.

6. General Plastic Factor 6

Petitioner argues that circumstances favor institution because "Petitioner only challenges the claims at issue in the [Bright Data Litigation]." Paper 1 at 49; *see also* Paper 1 at 52. In fact, this favors **denial**.

Based on the current docket control order (EX. 1035), jury selection is set for 12/9/2024 in the Bright Data litigation. Thus, the trial is expected to occur approximately 3.5 months **before** a final written decision is expected in this IPR. The patentability of the challenged claims will be resolved in district court. Instituting this IPR is not a good use of the Board's resources.

Accordingly, factor 6 favors denial.

7. General Plastic Factor 7

This factor is neutral.

8. *Petitioner's Proposed Factor 8*

For at least the reasons discussed above with respect to *General Plastic* Factors 3 and 6, Petitioner's arguments regarding IPR efficiencies fail.

Patent Owner has already had to defend validity of the '317 Patent in the -936 IPR. The Board denied institution based on the merits. Petitioner already wasted the Board's resources by requesting rehearing of that institution decision.

If this IPR is instituted, Patent Owner could be forced to defend validity against the Goodell reference in this IPR and against the Blossom system in the district court case.

Additionally, as discussed further below with respect to *Fintiv* factor 1, it is speculative to guess whether the district court will enter a stay in the Bright Data Litigation. Petitioner fails to mention that it asserted two counterclaim patents in the Bright Data Litigation.

Thus, Petitioner's proposed Factor 8 favors denial.

9. *Petitioner's Proposed Factor 9*

Petitioner's arguments regarding noncumulative art do not justify institution. It is no surprise that Petitioner conducted another search after institution was denied in the -936 IPR.

Additionally, if Petitioner was aware of the deficiencies of Goldstein and Ling (see Paper 1 at 54-56), then Petitioner should not have wasted the Board's resources in the -936 IPR, let alone, by requesting rehearing on the institution decision.

C. THE FINTIV FACTORS

On balance, the *Fintiv* factors favor denial of institution for at least the reasons discussed below. See *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5-16 (PTAB Mar. 20, 2020) (“*Fintiv*”); see also Director Katherine K. Vidal, ‘Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation’ (June 21, 2022) (“Vidal Memorandum”).

Petitioner presents a “Sotera-style” stipulation as a means to obviate the *Fintiv* factors. See Paper 1 at 56. However, as discussed above with respect to *General Plastic* Factor 3, this stipulation is misleading. If this IPR is instituted, Patent Owner could be forced to defend itself against the Goodell reference in this IPR and against the Blossom system in the district court case. This result cannot be the intention of the Vidal Memorandum.

Ultimately, because the instant petition challenges the same claims involved in the district court case, and because the district court case is expected to go to trial before the final written decision is issued, instituting this IPR is not a good use of the Board's resources. Also, the merits are not compelling.

1. *Fintiv* Factor 1

As discussed above, determining whether Judge Gilstrap would grant a motion to stay in the Bright Data Litigation is highly speculative. Petitioner has not requested a stay based on its petition as of the filing of this paper. Also, Petitioner fails to mention that it asserted two counterclaim patents in the Bright Data Litigation, which suggests that Judge Gilstrap would not grant a motion to stay regardless of institution.

Accordingly, this factor favors denial.

2. *Fintiv* Factor 2

Petitioner states that *Fintiv* factor 2 favors denial. Petitioner analyzes the current docket control order (EX. 1035) which shows jury selection is currently set for 12/9/2024 in the Bright Data Litigation. An institution decision is expected in this IPR by 3/26/2024 and the final written decision is expected by 3/26/2025. As such, the trial in the Bright Data Litigation is expected to occur approximately 3.5 months **before** a final written decision is expected in this IPR. Based on the docket control order, factor 2 favors denial.

Based on the most recent statistics (dated 9/30/2023), the median time-to-trial for civil cases in E.D. Tex. is 19 months. EX. 2015 at 35. The Bright Data Litigation was opened on 4/14/2023. Thus, the trial would statistically occur

around 11/14/2024. Based on the statistics, factor 2 weighs against denial.

However, Director Vidal has instructed that “when other relevant factors weigh against exercising discretion to deny institution or are neutral, the proximity to trial should not alone outweigh all of those other factors.” Vidal Memorandum at 8.

3. *Fintiv Factor 3*

Based on the current docket control order (EX. 1035), this factor weighs against denial.

4. *Fintiv Factor 4*

Patent Owner has addressed Petitioner’s stipulation above and with respect to *General Plastic* Factor 3. Moreover, Patent Owner notes that the same exact claims and prior art is at issue in the Bright Data Litigation. Therefore, institution would lead to duplicative efforts and risks conflicting decisions with respect to the same claims.

5. *Fintiv Factor 5*

The Bright Data Litigation involves the same parties and accordingly, this factor favors denial.

6. *Fintiv Factor 6*

The petition fails to establish public availability of the Goodell reference and Petitioner’s own admissions contradict such a finding as discussed above in section

II. Patent Owner also disputes allegedly compelling merits in the petition for at least the reasons discussed below in section V. Moreover, Patent Owner incorporates its arguments regarding the *General Plastic* factors herein.

IV. OVERVIEW OF THE TECHNOLOGY

A. PERSON OF ORDINARY SKILL IN THE ART (“POSA”)

Patent Owner submits that a POSA would be an individual who, as of October 8, 2009, the filing date of the provisional application to which the ‘317 Patent claims priority, had a Master’s Degree or higher in the field of Electrical Engineering, Computer Engineering, or Computer Science or as of that time had a Bachelor’s Degree in the same fields and two or more years of experience in Internet Communications. EX. 2001 at ¶24.

Petitioner’s proposed qualifications of a POSA (Paper 1 at 20-21) are not materially different at least in terms of affecting an institution decision in this IPR.

B. BACKGROUND TO THE FIELD OF TECHNOLOGY

A POSA would understand that network component devices, such as client devices and web servers, communicating over the Internet are identified by Internet Protocol (“IP”) addresses. EX. 2001 at ¶40. A web server, one type of network component, typically stores content that may be identified by a uniform

resource locator (“URL”). *Id.* IP addresses include certain information that can be used to geolocate a network component with a particular IP address. *Id.*

A POSA would understand that an IP packet sent over the Internet to, for example, a web server includes an IP header and payload. EX. 2001 at ¶41. The IP header includes a Source IP Address (the IP address of the sending network component) and a Destination IP Address (the IP address of the receiving network component, for example, the IP address of the web server). *Id.* The payload includes the data being transmitted, such as a request for content stored on the web server. *Id.*

A POSA would understand that, normally, a request for content is sent from a device, such as a client device, to a web server. EX. 2001 at ¶42. For example, a customer that is considering buying a product from a store may use the customer’s client device to request content associated with that particular product from the store’s website. *Id.* That same customer may also request content associated with that same product at a different store’s website. *Id.* As one example, a customer may request content to see if the product is on sale. *Id.* Therefore, a POSA would understand that the IP packet would include the Source IP Address associated with the customer’s client device. *Id.*

A POSA would understand that, normally, the web server responds to a request for content by sending the requested content back to the Source IP Address

of the request. EX. 2001 at ¶43. However, in some cases, the web server may block or send fake content (“spoof”) in response to a request based upon the Source IP address of the request. *Id.* For example, the web server may determine that the geographic location of the Source IP Address of the request is outside the geographic area in which the web server operates. *Id.* As another example, the web server may perceive large numbers of requests having the same Source IP Address as suspicious activity possibly associated with a competitor’s web scraping. *Id.*

A POSA would understand that, at the time of invention, an additional network component device such as a proxy server may be used as an intermediary between a client device and web server in order to conceal the original Source IP Address for a request for content. EX. 2001 at ¶44; *see also* EX. 1001 at Fig. 1. The IP packet will be sent from the original requestor to the proxy server and from the proxy server to the web server. *Id.* Because an intermediary proxy server is used in sending the request to the web server, the web server receives a request with the Source IP Address identifying the proxy server, not the client device. *Id.* Consequently, the web server cannot identify the original requestor based upon the Source IP Address of the request. *Id.* Instead of being blocked or spoofed, the requested content may be sent back to the original requesting network component via the proxy server. *Id.*

C. INTRODUCTION TO THE '317 PATENT

The specification of the '317 Patent provides several exemplary embodiments in the detailed description and the figures showing that both servers and client devices can be configured to operate as intermediaries. EX. 2001 at ¶45; *e.g.*, Figures 1, 3 and 2:8-18; 4:43-5:7. Figure 1 shows a network 2 with a proxy server 6 as an intermediary between, for example, client device 16 and web server 32. EX. 2001 at ¶45. Figure 3 shows an exemplary embodiment of network 100 with an agent 122 as an intermediary between a client 102 and web server 152. EX. 2001 at ¶45.

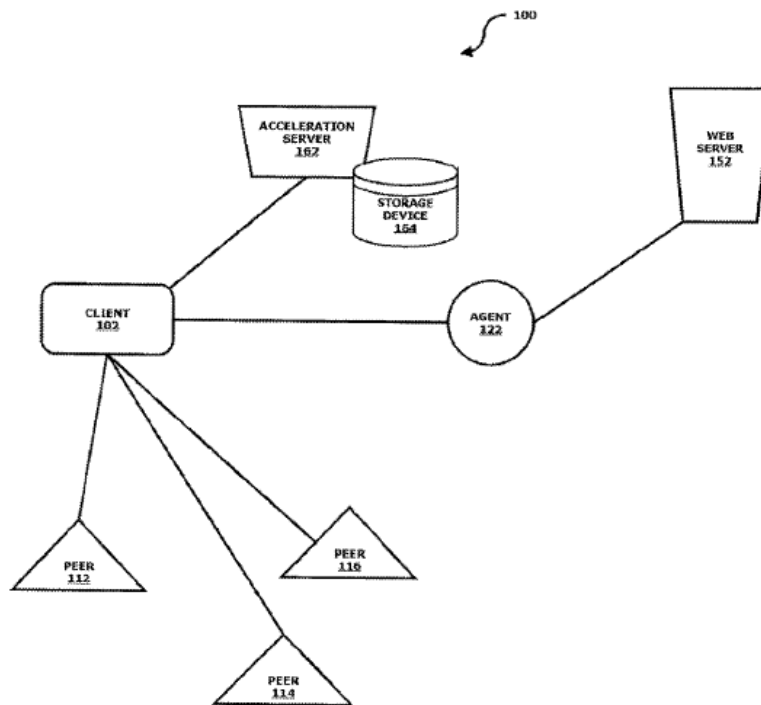


FIG. 3

As described in the specification, the communication network comprises communication devices that can serve as a client, peer, or agent, as well as separate servers and web servers:

“An example of such a communication network 100 is provided by the schematic diagram of FIG. 3. The network 100 of FIG. 3 contains multiple communication devices. Due to functionality provided by software stored within each communication device, which may be the same in each communication device, each communication device may serve as a client, peer, or agent, depending upon requirements of the network 100, as is described in detail herein. It should be noted that a detailed description of a communication device is provided with regard to the description of FIG. 4.

....

The communication network 100 also contains a Web server 152. The Web server 152 is the server from which the client 102 is requesting information and may be, for 65 example, a typical HTTP server, such as those being used to deliver content on any of the many such servers on the Internet. It should be noted that the server 152 is not limited to being an HTTP server. In fact, if a different communication protocol is used within the communication network, the server may be a server capable of handling a different protocol. It should also be noted that while the present description refers to the use of HTTP, the present invention may relate to any other communication protocol and HTTP is not intended to be a limitation to the present invention.”

EX. 1001 at 4:43-5:7.

As each communication device is configured to operate as a client, agent or peer as necessary, a POSA would understand client 102 and agent 122 to both be client devices. EX. 2001 at ¶47.

As shown in Figure 3, agent 122, in some embodiments, is a client device which can receive requests for content intended for web server 152. *See, e.g.*, EX. 1001 at 5:23-34; EX. 2001 at ¶48. The specification also describes that the ‘agent’ can request this content directly from the web server. *See, e.g.*, EX. 1001 at 14:62-15:12; EX. 2001 at ¶48.

The specification further explains:

“The communication network 100 further contains an acceleration server 162 having an acceleration server storage device 164. As is described in more detail herein, the acceleration server storage device 164 has contained therein an acceleration server database. The acceleration server database stores Internet protocol (IP) addresses of communication devices within the communication network 100 having acceleration software stored therein. Specifically, the acceleration server database contains stored therein a list of communication devices having acceleration software stored therein that are currently online within the communication network 100. For each such agent, the acceleration server assigns a list of IP addresses.

EX. 1001 at 5:8-20.

In one embodiment, an application running on a client device, such as client 200, can initiate a request for a resource, which is intercepted by a client module (*e.g.* client module 224). EX. 1001 at 12:62-13:3; EX. 2001 at ¶50. The client module 224 looks up the IP address of web server 152 that is the target of the content request and sends the IP address to a server (*e.g.* acceleration server 162). EX. 1001 at 13:8-15; EX. 2001 at ¶50. In one embodiment, “acceleration server

162 prepares a list of agents that may be suitable to handle the request from this IP address (block 358)... The list of agents is created by the acceleration server 162 by finding the communication devices of the communication network 100 that are currently online, and whose IP address is numerically close to the IP of the destination Web server 152.” EX. 1001 at 13:19-30; *see also id.* at 10:32-36; *see also id.* at Fig. 7; EX. 2001 at ¶50.

D. THE ‘317 PATENT CLAIMS

The ‘317 Patent contains 30 claims, with only claim 1 being independent.

EX. 1001 at 19:18-22:27. Claim 1 recites:

“[1 preamble] A method for fetching, by a first device, a first web-page that is identified by a first Uniform Resource Locator (URL) and is stored in a first web server and a second web-page that is identified by a second URL and is stored in a second web server, for use with a second device that stores a group of Internet Protocol (IP) addresses, each of the IP addresses is associated with a respective geographical location, the method comprising:

[1a] identifying, at the first device, the first URL and a first geographical location that is associated with at least one of the IP addresses in the group;

[1b] sending, by the first device to the second device, the first URL and the first geographical location;

[1c] receiving, by the first device from the second device, the first web-page, in response to the sending of the first URL and the first geographical location;

[1d] identifying, at the first device, the second URL and a second geographical location that is associated with at least one of the IP addresses in the group;

[1e] sending, by the first device to the second device, the second URL and the second geographical location; and

[1f] receiving, by the first device from the second device, the second web-page, in response to the sending of the second URL and the second geographical location.”

EX. 1001 at 19:18-21.

Upon reviewing the specification, a POSA would understand that the ‘317 Patent discloses a first device may send multiple content requests for multiple webpages. EX. 2001 at ¶52. For example, a first device may send a first content request for a first webpage identified by a first URL and stored in a first web server. *Id.* That same device may send a second content request for a second webpage identified by a second URL and stored in a second web server. *Id.*

A POSA would understand that the ‘317 Patent discloses a second device that stores a plurality of IP addresses associated with a plurality of devices such as, for example, proxy client devices that may be used as intermediaries. EX. 2001 at ¶53. Each of these proxy client devices may be located in a different geographical location. *Id.* For example, the plurality of proxy client devices may be located in different cities, states, or countries all over the world. *Id.* A POSA would understand that a particular proxy device can be used as an intermediary to fetch content from a particular web server, based on the geographic proximity of the proxy device to the web server. *Id.*

A POSA would understand that the ‘317 Patent discloses that, for example, a proxy client device can be selected based on the geographic proximity of the proxy

client device to the web server. EX. 2001 at ¶54. For example, “[t]he list of agents is created by the acceleration server 162 by finding the communication devices ... whose IP address is numerically close to the IP of the destination Web server 152.” EX. 1001 at 13:25-29; *see also id.* at 5:25-24 (“the agent 122 receives the request from the client 102 as the communication device closest to the Web server 152”); EX. 2001 at ¶54. In one embodiment, “the client then decides which of the agents in the list to use as its agent for this particular information request.” EX. 1001 at 13:62-64. In another embodiment the agent selects itself. EX. 1001 at 15:6-12; EX. 2001 at ¶54.

As another example, in response to a client’s request for content, “[t]he acceleration server then searches the agent database for the next 5 active agents whose IP address is closest to the IP address of the server who is targeted in the request (block 562). In this context, 192.166.3.103 is closer to 192.166.3.212 than to 192.167.3.104. The acceleration server then sends this agent list to the client (block 564).” EX. 1001 at 16:65-17:6; *see also id.* at Fig. 13; EX. 2001 at ¶55.

A POSA would understand that the ‘317 Patent discloses a request sent from a first device to a web server via a second device and possibly a third device, such as a proxy client device. EX. 2001 at ¶56. A POSA would understand that using the claimed methods would prevent the web server from seeing the source address as that of the first device. *Id.* A POSA would understand that using the claimed

methods allows the first device to remain anonymous as to the web server. *Id.* This also allows the first device to avoid blocking/spoofing by the web server. *Id.*

1. Practical Example Of Using The Claimed Methods Of The ‘317 Patent

As a practical example, if a customer wanted to compare the price of a product sold by Amazon in the UK and the price of the same product sold by Amazon in the US, the customer could use the methods disclosed and claimed in the ‘317 Patent. EX. 2001 at ¶57. The customer’s first device may identify the first URL as “https://www.amazon.co.uk” and the second URL as “https://www.amazon.com”. *Id.* A second device may store a group of IP addresses, where each IP address is associated with a proxy client device and the geographical location of the proxy client device. *Id.* The first device may identify the first geographical location for a desired proxy client device as the UK and the second geographical location for another desired proxy client device as the US. *Id.* The first device may send the identified URLs and geographical locations to the second device. *Id.* In this way, proxy client devices at the first and second geographical locations can be selected. *Id.*

Continuing this same example, the second device may send the first URL to a third device, *e.g.*, a proxy client device in the UK; and the second device may send the second URL to a fourth device, *e.g.*, a proxy client device in the US. EX.

2001 at ¶58. The third device may then send the first URL to the first web server to obtain the requested content, with UK pricing information, and send it back to the first device via the second device. *Id.* The fourth device may then send the second URL to the second web server to obtain the requested content, with US pricing information, and send it back to the first device via the second device. *Id.* This method allows the customer to avoid blocking/spoofing from the Amazon web servers and to obtain accurate pricing information. *Id.*

E. CLAIM CONSTRUCTION

As noted by the petitioner, the district court issued claim construction orders (EXS. 1007, 1021, 1023) for related patents. Patent Owner expressly reserves the right to address any claim construction disputes in any future response if proceedings are instituted. However, Patent Owner does not believe that the construction disputes will affect the Board’s institution determination.¹⁶ Patent Owner briefly addresses certain claim constructions below.

¹⁶ In IPR2022-00936, the Board stated that “we determine that it is not necessary to provide an express interpretation of any claim terms.” IPR2022-00936, Paper 8 at 9.

1. “Client Device” And “Server”

The claim construction disputes as to “client device” and “server” do not affect the analysis herein for purposes of institution. EX. 2001 at ¶60.

For the record, Patent Owner disagrees that the correct claim constructions for “client device” and “server” refer to the role being performed at given moment in time. *Contra* Paper 1 at 21-23. The intrinsic evidence informs a POSA that a “client device” is not a “server” and that a “server” is not a “client device”. Patent Owner also disagrees that the correct claim constructions are limited to the “roles” of clients and servers as defined by RFC 2616. *See id.*; *contra* Paper 1 at 23.

2. “First Device” And “Second Device”

Independent claim 1 recites “first device” and “second device” which a POSA would understand to be separate and distinct components. *See, e.g.*, EX. 1010 at 14 (“To begin, they are recited separately in the claims, suggesting that they are distinct components. *Becton, Dickinson & Co. v. Tyco Healthcare Grp.*, LP, 616 F.3d 1249, 1254 (Fed. Cir. 2010) (“Where a claim lists elements separately, the clear implication of the claim language is that those elements are distinct components of the patented invention.” (quotation and modification marks omitted))”); *see also, e.g.*, EX. 1021 at 13-14 and 16; EX. 2001 at ¶62. Based on the analysis in the Petition, Petitioner agrees these are separate and distinct components. *See, e.g.*, Petition at 34. This understanding is supported by the

language of claim 1 itself, as well as the dependent claims (*e.g.*, claims 16 and 18), and the ‘317 Patent specification (*e.g.*, Figure 3 and associated description discussed above). EX. 2001 at ¶62.

V. ANALYSIS OF THE GROUND

A. THE GROUND

Petitioner asserts only one ground in the petition (Paper 1 at 27):

Ground 1	Claims 1, 8, 16, 17, 22, 29, and 30	Obvious based on Goodell (EX. 1005)
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B. GOODELL DOES NOT RENDER CLAIM 1 OBVIOUS

Patent Owner disagrees with Petitioner’s summary of Goodell, but it is not necessary to resolve those disagreements for purposes of institution. *See* Paper 1 at 26-33. Patent Owner addresses independent claim 1 herein and expressly reserves all rights as to the challenged dependent claims. As will be shown below, because Goodell does not invalidate claim 1, Goodell cannot invalidate the challenged dependent claims as Petitioner alleged.

1. Limitations 1[b] and 1[e]: sending ... the first/second URL

Petitioner alleges that Godell's clients correspond to the claimed "first device" and that Goodell's directory server corresponds to the claimed "second device". Paper 1 at 34.

Limitation 1[b] recites "...sending, by the first device to the second device, the first URL and the first geographical location...".

Limitation 1[e] recites "...sending, by the first device to the second device, the second URL and the second geographical location...".

Petitioner admits that "[b]ecause Goodell discloses that exit policies are expressed in the terms of a set of IP addresses... a POSITA would expect the client to transmit information sufficient to identify the target web server by IP address." Paper 1 at 37. The cited portion of Goodell explains that a "descriptor" for a forwarder specifies a set of IP addresses to which a forwarder is willing to provide access as an exit node. EX. 1005 at 80 (internal page 63).

In order to meet the claim language, Petitioner argues that it would have been obvious to send a URL (rather than an IP address) because a POSA would understand that converting URLs to IP addresses is known in the art. Paper 1 at 37. This argument directly contradicts the disclosure of Goodell and would change its principle of operation.

As discussed above, a forwarder specifies a set of IP addresses for which it can be an exit node. It would not make sense in the context of Goodell to specify a URL (rather than an IP address) because URLs mean different things to different forwarders. Goodell expressly distinguishes and disavows a global unique naming scheme for resources.¹⁷ Instead, Goodell discloses that “[a] resource need not have only one DNS name within a PAN. In this example, the target host is known to F3 and F4 as bar.target.org and to F5 as baz.other.com. Meanwhile, bar.target.org from the perspective of F6 describes an entirely different resource.” EX. 1005 at 111 (internal page 94). Accordingly, a POSA would NOT be motivated to send a URL (rather than an IP address) to the directory server.

Goodell explains that the Domain Name Service (“DNS”) is a widely used directory service for resolving URLs to IP addresses. EX. 1005 at 87 (internal page

¹⁷ See, e.g., EX. 1005 at 53 (internal page 36)(“ Thus, we abandon global uniqueness of names in favor of flexibility.”); EX. 1005 at 150-151 (internal pages 133-134)(“ Since we do not require a global unique naming scheme for resources, we need a way to uniquely identify a resource. We therefore require forwarders to generate unique, self-certifying identifiers and a PAN client specifies a particular resource by concatenating the forwarder ID with the resource name as resolved by the forwarder.).

70). Goodell expressly distinguishes and disavows use of DNS by the directory server. Goodell explains that “PAN directory servers” cannot take advantage of the hierarchical approach of DNS. *Id.*^{18,19} Instead, Goodell discloses that each forwarder must generate their own self-certifying ID and then concatenate the ID with a local name to identify the resource.²⁰ Accordingly, a POSA would NOT be motivated to send a URL (rather than an IP address) to the directory server.

¹⁸ See, e.g., EX. 1005 at 56 (internal page 39)(“PAN seeks to provide a means by which the Internet can grow without requiring the consent of third parties such as Internet service providers and DNS registrars. In particular, we want to afford users the ability to add an arbitrary namespace outside the hierarchy and then connect it to the rest of the Internet.”);

¹⁹ Because of this, Goodell notes that “one significant business concern” is how the provider of an Internet resource will refer to the resource. EX. 1005 at 58 (internal page 41).

²⁰ EX. 1005 at 58 (internal page 41)(“For this reason, we require forwarders to generate unique, self-certifying identifiers and concatenate these identifiers with the local names of resources to uniquely identify the resources, and these identifiers of forwarders must be propagated with directory entries through the PAN overlay.”)

2. Limitation 1[e]: sending...to the second device...

As noted above, Petitioner alleges that Goodell's clients correspond to the claimed "first device" and that Goodell's directory server corresponds to the claimed "second device". Paper 1 at 34.

Limitation 1[e] recites the same "second device" as limitation 1[b]. Petitioner alleges that Goodell's client would use the same directory server for fetching the second web page. Paper 1 at 42.

However, Goodell discloses that there are multiple directory servers and a POSA would have understood that a different directory server would be used for fetching the second webpage.

For example, Goodell discloses that "PAN consists of a pairwise-connected overlay network of forwarders, each of which has access to some set of Internet resources. Some resources may be available to some nodes but not others." EX. 1005 at 152 (internal page 135).

Goodell also discloses that "directories are not required to explicitly fetch information on behalf of their clients, a client that queries a directory for information can expect to be referred to a specific neighboring directory server." EX. 1005 at 155 (internal page 138).

Goodell further discloses that "each directory maintains a set of directory records, each uniquely corresponding to one of its peers. Scalability dictates that

each individual directory server need not know everything about the entire network, so there is no guarantee that each directory server contains a record for each other directory server in the entire network.” EX. 1005 at 155 (internal page 138). For example, “[w]hen a client issues a query for a forwarder record, but a directory server has no corresponding forwarder record, the directory server may refer the client to a set of directory servers that have previously indicated knowledge of forwarder records matching the request of the client.” EX. 1005 at 155 (internal page 138).

Accordingly, a POSA would understand that a different directory server would be used for fetching the second webpage.

Petitioner alleges that an HTTP proxy can automatically append the same metadata query to successive web content requests to make sure that links that are clicked on are viewed from the same perspective. Paper 1 at 42. Petitioner then attempts to apply this same logic to Goodell’s client. However, there is no evidence cited by Petitioner or Petitioner’s expert supporting this proposed modification to meet limitation 1[e]. *Id.*; EX. 1003 at ¶86. Goodell’s client is the “original sender”, not a proxy. *See, e.g.*, EX. 1005 at 137 (internal page 120)(“First, the proxy parses HTTP requests from the client...”).

Moreover, Goodell teaches away from this proposed modification. If the Goodell client includes “forwarder-specific” path information in the metadata, then

“the path is not actually guaranteed to work; inconsistency resulting from slow routing convergence may allow forwarding paths that are no longer applicable to persist for some time.” EX. 1005 at 157 (internal page 140).

VI. CONCLUSION

For at the reasons set forth herein, the Board should deny institution.

Respectfully submitted,

Date: December 22, 2023

By: /s/ Thomas M. Dunham

Thomas M. Dunham

Reg. No. 39,965

Cherian LLP

1901 L Street NW, Suite 700

Washington, D.C. 20036

(202) 838-1567

ATTORNEY FOR PATENT OWNER,
BRIGHT DATA LTD.

CERTIFICATE OF COMPLIANCE

This Patent Owner Preliminary Response (“POPR”) consists of 9,880 words, which is no more than 14,000 words, in compliance with the type-volume requirements as mandated in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Respectfully submitted,

Date: December 22, 2023

By: /s/ Thomas M. Dunham

Thomas M. Dunham

Reg. No. 39,965

Cherian LLP

1901 L Street NW, Suite 700

Washington, D.C. 20036

(202) 838-1567

ATTORNEY FOR PATENT OWNER,
BRIGHT DATA LTD.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies the
PATENT OWNER PRELIMINARY RESPONSE and all exhibits thereto was
served on the undersigned date via email, as authorized by Petitioner, at the
following email addresses:

agarza@ccrglaw.com

cbovenkamp@ccrglaw.com

jscott@ccrglaw.com

Respectfully submitted,

Date: December 22, 2023

By: /s/ Thomas M. Dunham

Thomas M. Dunham

Reg. No. 39,965

Cherian LLP

1901 L Street NW, Suite 700

Washington, D.C. 20036

(202) 838-1567

ATTORNEY FOR PATENT OWNER,
BRIGHT DATA LTD.