

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CODE200, UAB; TESO LT, UAB; METACLUSTER LT, UAB; AND
OXYSALES, UAB,
Petitioners
v.
LUMINATI NETWORKS LTD.,
Patent Owner

Case IPR2020-01266

Patent 10,257,319

**CORRECTED PATENT OWNER'S PRELIMINARY RESPONSE
UNDER 37 CFR §42.107**

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Patent Trial and Appeal Board
United States Patent and Trademark Office
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2001	Oxylabs' Motion To Stay Pending <i>Inter Partes</i> Reviews (public-redacted) in <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG ECF No. 131
2002	Joint Claim Construction and Prehearing Statement support in <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG ECF No. 105-1
2003	Plaintiff's Markman opening brief in <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG No. 126
2004	Defendants' Markman response brief in <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG ECF No. 138
2005	Plaintiff's Markman reply brief in the <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG ECF No. 145
2006	Intentionally left blank
2007	Oxysales' Answer (public-redacted) in <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG, ECF. No. 95
2008	October 18, 2018 response during '319 prosecution history LUM- at LUM-00149133-34
2009	Dr. Thomas Rhyne Markman Declaration in <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG, ECF No. 126-5
2010	Sur-reply on Motion to Dismiss in <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG ECF No. 47
2011	Order on Motion to Dismiss in <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG ECF No. 85
2012	Declaration of Dr. Thomas Rhyne
2013	Amended Rule 7.1 disclosure statement from <i>Luminati v. Teso Lt UAB et al.</i> , E.D. Texas, Case No. 2:19-cv-00395-JRG ECF No. 55

2014	Exhibit 2014 is a true and correct copy of Code200's Rule 7.1 Disclosure Statement in Luminati v. Code200 et al., E.D. Texas, Case No. 2:19-cv-00396-JRG ECF No. 28.
2015	Declaration of Thomas M. Dunham

I. INTRODUCTION

Patent Owner Luminati Networks, Ltd. (“Patent Owner”) hereby submits this Patent Owner Preliminary Response (“POPR”) in response to the Petition (Paper 5) filed by Code200, UAB; Teso LT, UAB; Metacluster Lt, UAB; and Oxysales, UAB (“Petitioners”) requesting *inter partes* review of claims 1, 2, 12, 14-15, 17-19, 21-22 and 24-29 of U.S. Patent No. 10,257,319 (“the ‘319 Patent”).

Patent Owner respectfully requests that the Patent Trial and Appeal Board (“Board”) exercise its discretion and deny institution for two separate reasons.¹

First, the Petition should be dismissed based upon the *Fintiv* factors governing parallel district court proceedings.² Specifically, the parallel district court litigation, which asserts exactly the same prior art as the Petition (Paper 14, paragraphs 1-2), begins jury selection on May 3, 2021, over seven months before a final determination would be expected in this IPR. Additionally, the claim construction

¹ In this POPR, Patent Owner is only addressing select issues demonstrating that review should not be instituted. In so doing, Patent Owner is not acquiescing to other issues raised by Petitioners and reserves the right to address all issues and to challenge all points raised by Petitioners in any future response if proceedings are instituted. See PTAB Office Trial Practice Guide, July 2019 Update, p. 18-21 (Docket No. PTO-P-2019-0025, Federal Register 33925-33926).

² *Apple Inc. v. Fintiv Inc.*, IPR2020-00019, Paper 11 (PTAB March 20, 2020) (precedential, designated May 5, 2020)

hearing in the district court litigation is set for November 17, 2020.³ Thus, the Court will have invested significant resources and will likely have issued its claim construction ruling before an institution decision would even issue in this proceeding. For at least these reasons, the *Fintiv* factors overwhelmingly support the Board's discretion to deny institution.

Second, the Challenged Claims of the '319 Patent are strongly novel and non-obvious when compared to the prior art relied on by Petitioners. As explained below, Petitioners' Grounds *all depend upon a common premise* – that the “plain and ordinary meanings” of the claim terms “second server,” “first client device,” and “first server” are such that each of these distinctly-claimed devices would be met by a “general purpose computer” such that a “server” and a “client” are broad enough to encompass one another. (Paper 5 at 14). Indeed, in discussing the Grounds, Petitioners equate these claim terms *to ignore the express limitations recited in the claims*.

Claim 1 (the only independent claim), recites a method for use with a specific architecture arranged as depicted below:

Second Server < - > First Client Device < - > First Server

³ Briefing on claim construction was completed on October 20, 2020. Copies of the opening, responsive and reply claim construction briefs are being submitted herewith as Exhibits 2003, 2004, and 2005 to this POPR.

Petitioners concede this point, expressly including a graphic in the Petition showing this precise arrangement:



(Paper 5 at 9-10).

Yet the three primary references relied upon by Petitioners operate using significantly different architectures (depicted below), each thereby failing to achieve the advantages realized by the method of the ‘319 claims:

Crowds: User computer⁴ < - > User computer < - > Web Server

Border: Client Device < - > Downstream Server < - > Upstream Server < - >

Web Server

⁴ As explained in Crowds, each participating user computer is called a *jondo*: “A *user* is represented in a crowd by a process *on her computer* called a jondo ...” Ex. 1011 at 8 (emphasis added).

Morphmix: Peer < - > Peer < - > Server

As explained below, because the primary references relied upon by Petitioners operate using different architectures than the method of Challenged Claim 1, they each fail to anticipate Claim 1. Further, the alleged combinations set forth in Grounds 2, 4 and 6 fail to render obvious Claim 1 for at least the same reasons.

II. THE PETITION SHOULD BE DENIED BECAUSE THE PARALLEL DISTRICT COURT LITIGATION, WHICH ASSERTS THE SAME PRIOR ART AS THIS PETITION, BEGINS JURY SELECTION ON MAY 3, 2021, OVER SEVEN MONTHS BEFORE A FINAL DETERMINATION WOULD BE EXPECTED IN THIS IPR

Petitioners voluntarily raised the parallel Eastern District of Texas proceedings (Case No. 2:19-cv-00395-JRG) (“the 395 District Court case”) (Paper 5 at page 6, Section III) as an issue, and argue that the *Fintiv* factors do not compel a decision to deny institution. The *Fintiv* factors, however, substantially favor a decision to deny institution because the 395 District Court case involves exactly the same prior art and all but four dependent claims of the ‘319 Patent challenged here are also asserted in the litigation. Paper 14, paragraphs 1-2. The Board should also consider the Petitioners’ two follow-on Petitions, filed after the present Petition, challenging the remaining two patents asserted in 395 District Court case (USP 10,484,510 challenged by Petitioners on August 28, 2020 in IPR2020-01358, and USP 10,469,614 challenged by Petitioners on September 4, 2020 in IPR2020-

01506). If IPRs were instituted, final determinations in those cases would not issue until approximately one month and two months, respectively, after a final determination is expected in this IPR, placing those determinations *more than nine months after trial will have occurred*.

Also, while Petitioners argue that petitioner Code200's status as not having been sued for infringement of the '319 Patent bodes in favor of institution, the close corporate relationship between Code200 and the remaining Petitioners has not been fully disclosed to the Board. When that close relationship is considered (they a parent and multiple sister subsidiaries, all with direct or indirect common or overlapping owners - Ex. 2007), it renders Petitioners' arguments unpersuasive, if not misleading.

A. FACTOR 1.

Fintiv factor 1 is "whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted."

The 395 District Court case has not granted a stay pending IPR petition. Patent Owner submits that it will not seek such a stay. On October 1, 2020, Petitioners filed a sealed opposed motion to stay the 395 District Court case pending the *inter partes* reviews in which they concede as a general rule that such stays are not granted. *See Ex. 2001* public/redacted version ("Oxylabs is aware that this Court

typically does not grant a stay pending IPRs not yet instituted.”) Further, Petitioners have also mischaracterized the briefing in the prior litigation proceeding. Patent Owner filed the complaint for the 395 District Court case on December 6, 2019. Patent Owner then filed a motion to consolidate in the then pending case of *Luminati Networks Ltd. v. UAB Tesonet et. al.*, Case No. 2:18-cv-299 (“Tesonet Case”), ECF 305 at 5, seeking a new trial date to be held as early as July 2020 to *accelerate* the date by which Patent Owner’s ‘319 Patent infringement claims would be tried. Petitioners Teso and Metacluster opposed that motion by arguing that a trial date for this action in 2021 was more realistic (Tesonet Case, ECF 317 at 5).

Given that the Court has not granted a stay and would not likely grant a stay given the lateness of the Petition, this factor favors denial of institution.

B. FACTOR 2

Fintiv factor 2 is the “proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision.”

The date for jury selection in the 395 District Court case is May 3, 2021. (Ex. 1004 at 1). In contrast, the date for the Board’s projected final written decision is: (i) Patent Owner’s POPR deadline of October 24, 2020, (ii) plus an estimated two-to-three months for the Board to enter an institution decision, (iii) plus 12 months for a final determination, or December 24, 2021 or later. This is over *seven months*

after the district court's jury selection date of May 3, 2021, making this factor strongly favor denial of institution.

The Board should also consider final determination dates for the Petitions filed by Petitioners with respect to the other two patents asserted in the 395 District Court action, namely the '510 patent and the '614 patent. IPR2020-01358 challenging the '510 patent was filed on August 28, 2020, and has a POPR deadline of November, 20, 2020. Adding two-to-three months for an estimated institution decision and a year for a final determination, the final written decision is expected on January 20, 2022 or later. This is over *eight months after* jury selection in the 395 District Court case.

IPR2020-01506 challenging the '614 patent was filed on September 5, 2020, and has a POPR deadline of December 9, 2020. Adding two-to-three months for an estimated institution decision and a year for a final determination, the final written decision would be expected on February 9, 2022 or later. This is over *nine months after* jury selection in the 395 District Court case.

As discussed above in Factor 1, Petitioners' discussion about extensions requested by Patent Owner in prior district court cases mischaracterize the positions taken by Petitioner and Patent Owner in that proceeding. Moreover, Petitioners' one sentence reference to a potential COVID -19 trial delay (Paper 5 at 10) is also sheer

speculation at this point, more than six months before jury selection is scheduled.

The PTAB also declined to speculate on this point in another recent decision:

“Petitioner further argues that the trial date may change because the COVID-19 pandemic has “significantly disrupted docket schedules including in Texas, which may cause delay of the trial that is still months away.” (Citation omitted)

We understand Petitioner's position, but we decline to speculate whether that date will change due to COVID-19 disruptions...”

Google LLC f/k/a Google Inc. v. Personalized Media Communications, LLC PTAB-IPR2020-00719, Decision Denying Institution of *Inter Partes* Review, Paper 16 at 11, August 31, 2020.

Taking the timing of these two additional petitions into account, this factor strongly favors denial of institution.

C. FACTOR 3

Fintiv factor 3 is “investment in the parallel proceeding by the court and the parties.”

The case is *not* at a very early stage, as Petitioners allege. Quite to the contrary. As of the time that Patent Owner's POPR was filed in this case, the parties' district court *Markman* briefing was already completed (briefing was completed on October 20, 2020 – (Ex. 1004 at ECF 145)). Two months later, on or about December 24, 2020, when an institution decision would likely be expected, the

Markman hearing will have been conducted over a month earlier on November 17, 2020 (the Markman hearing was moved to November 17 from November 10, 2020 by a text entry in on the docket on October 7, 2020), and a Markman decision may be entered before December 24, 2020. The parties will certainly have invested heavily in the district court case by briefing the Markman issues and preparing for and attending the Markman hearing. The Court will as well, having reviewed the Markman briefing and prepared for and held the Markman hearing, and will undoubtedly be well on its way towards issuing a Markman decision if not having already done so.

Patent Owner has been a party in two other infringement actions before Judge Gilstrap in the Eastern District of Texas over the last two years. In one case, the Markman order issued *10 calendar days* after the Markman hearing.⁵ In the other case, the Markman order issued *20 calendar days* after the Markman hearing.⁶ Both

⁵ *Luminati v. Bi Science*, ED Texas case no. 2-18 cv 00483, Markman hearing on November 26, 2019 (ECF. No. 126); Claim Construction Memorandum Opinion and Order issued December 6, 2019. (ECF. No. 130).

⁶ *Luminati v. UAB Tesonet*, ED Texas case no. 2-18 cv 00299, Markman hearing on July 31, 2019 (ECF. No. 102); Claim Construction Memorandum Opinion and Order issued August 20-21, 2019 (on docket August 20, entered August 21) (ECF. No. 121).

of these times would have the Markman Order in this case issuing before the estimated institution date of December 24, 2020.

Moreover, in the IPR challenging the '510 patent which is also asserted in the 395 District Court case, an institution date would be expected approximately a month later (January 20, 2021). In the IPR challenging the '614 patent, which is also in the 395 District Court case, the institution decision would be expected even later (February 9, 2021) (see calculations several paragraphs above). Certainly, the Markman decision, which will address claim construction issues in all three of the '319, '510 and '614 asserted patents, will likely have issued long before February 9, 2021 given this court's promptness at issuing Markman orders.

Taking the timing of this and the other two petitions into account, this factor strongly favors denial of institution.

D. FACTOR 4

Fintiv factor 4 is “overlap between issues raised in the petition and in the parallel proceeding.”

The overlap between the issues raised in the petition and in the parallel proceeding is substantial. Petitioner challenges the claims based on three primary references, namely Crowds, Morphmix, and Border, and one Internet Request for Comments, namely RFC 2616. Petitioner identified all four of those pieces of prior

art as items 1-4 of its Invalidity Contentions served on Luminati on August 31, 2020 in the 395 District Court case. (Paper 14, paragraphs 1-2). In fact, Petitioners do not even contest that the exact same prior art is asserted in the 395 District Court case as in this Petition.

Petitioners' arguments are thus limited to stating that while Luminati asserts claims 1-2, 14-15, 17-18, 21-22, and 24-27 in the Lawsuit, the Petition also challenges dependent claims 12, 19, 28, and 29, which are not at issue in the Lawsuit. Paper 5 at 8. This is not a significant difference, however. Only claim 1 of the '319 Patent is independent. The Petition therefore does not challenge any other independent claim not asserted in the district court, because there are none. Moreover, resolution of the patentability of independent claim 1 in the district court is also likely to have an impact on dependent claims 12, 19 and especially claims 28 and 29, which recite, respectively:

28. A non-transitory computer readable medium containing computer instructions that, *when executed by a computer processor, cause the processor to perform the method according to claim 1.*

29. A client device comprising a non-transitory computer readable medium containing computer instructions that, *when executed by a computer processor, cause the processor to perform the method according to claim 1.*

(Emphasis added).

Because of the substantial overlap between the invalidity challenges in the 395 District Court case and the Grounds asserted in the Petition, Factor 4 strongly favors denial of institution.

E. FACTOR 5

The fifth *Fintiv* factor is “whether the petitioner and the defendant in the parallel proceeding are the same party.” Three of the four petitioners, namely, Teso LT, Metacluster LT and Oxysales, *are* the defendants in the parallel 395 District Court case. This strongly favors a decision not to institute. The fourth petitioner, Code200, has not been sued by Luminati for infringement of the ‘319 patent. However, the Petition’s suggestion that Code200 should therefore somehow be treated differently from the other Petitioners (Paper 5 at 9) is misleading in that it fails to acknowledge the close corporate relationship between Code200 and the other defendants/petitioners. Specifically, Coretech LT is the parent company of the sister Petitioners (Teso LT, Code200, Metacluster and Oxysales). They were formed when Lithuanian company Tesonet changed its name to Teso LT and reorganized in 2018. *See* Exhibits 2013 and 2014. (Ex. 2007 – “Oxylabs further admits that, in 2018, Tesonet underwent a corporate restructuring and, as a result of that restructuring, (i) Tesonet’s name was changed to Teso LT, UAB and (ii) Metacluster, Oxysales, code200, UAB (“Code200”), and coretech lt, UAB (“Coretech”) were created.

Oxylabs admits that Teso, Metacluster, Oxysales, Code200 and Coretech share, directly or indirectly, common or overlapping owners.”) All of the petitioners, including Code200, are therefore under common direct or indirect ownership and control. *Id.* That may explain why Code200 inserted itself into the present IPR petition without having been sued for infringement of the ‘319 patent – it is under the control of the petitioners’ common owner, and thus presumably did so for the benefit of its parent Coretech Lt and sister subsidiaries Teso LT, Metacluster and Oxysales who were sued for infringement of the ‘319 patent. Exhibits 2013 and 2014. With that relationship in mind, the fact that Code200 has not been sued for infringement of the ‘319 patent does not bode in favor of institution, as the Petition alleges. To the contrary, it cuts against institution, inasmuch as Code200 is related to the other petitioners and all of them are under the control of their common parent company. That relationship, undisclosed by petitioners, is a substantial factual omission, and strongly favors denial of institution.

F. FACTOR 6

Fintiv factor 6 is: “other circumstances that impact the Board’s exercise of its discretion, including the merits.”

Petitioners argue that the merits are substantially in their favor, but this is not the case, as shown in the sections that follow. First, Petitioners’ reading of the claims

is unreasonable – an issue that will be resolved by the 395 District Court. Additionally, the asserted prior art is weak and does not render the ‘319 patent unpatentable. Indeed, institution should be denied not only because of parallel litigation but also on the merits.

III. OVERVIEW - THE ‘319 PATENT DISCLOSES AND CLAIMS METHODS USING A NOVEL NETWORK ARCHITECTURE THAT IS NOT DISCLOSED IN ANY OF THE PRIOR ART ADVANCED BY PETITIONERS

The ‘319 Patent describes a novel “system designed for increasing network communication speed for users ...” Ex. 1001 at Abstract. To achieve the advantages described in the specification, the ‘319 Patent claims methods utilizing a novel “second server – first client device - web server” architecture, whereby a “first client device” serves as a proxy between the “second server” and “web server.” As stated to the Patent Office during prosecution, “[i]t is respectfully submitted that the conventional arrangement involves fetching data by a client device from a server device, while the claims disclose a server receiving information from another server via a client device, which is unique and solves a specific problem such as anonymity when fetching information.” Ex. 2008 at pages 4-5.

A problem in the art was the fact that certain websites with public information nevertheless create technological roadblocks to obtaining that information from

certain requesting devices. For example, it is a routine practice of companies to obstruct their competitors from accessing the company's otherwise publicly available pricing information. To overcome these artificial hinderances, the proxy service of the claims sends requests through one or more of a large group of proxy "client devices," such as individual cell phone devices. As the proxy devices belong to real people who otherwise send such requests to target web servers as customers, the target will allow the queries and not artificially block them.

This problem was specifically mentioned in Plaintiff's Opening Markman brief in the '395 District Court case: "Using this novel service permits a user to access content from a server that might otherwise block the request or return a fake response. For example, a retailer can use this service to request pricing data from a competitor by appearing to that competitor as a potential customer." Ex. 2003 at 1.

The '319 Patent explains that previous "proxy servers" fail to provide a "comprehensive solution for Internet surfing," in part because they "would need to be deployed at every point around the world where the Internet is being consumed." *Id.* at 2:24-27; see also 2:8-23. Instead, to create a new type of consumer-based network that never existed before, the '319 Patent employs "client devices" that operate as proxies. *Id.* at 3:13-55.

Claim 1, the only claim expressly addressed in this POPR, recites a method for use over the unique “second server – first client device – web server” architecture recited in the claim:

1. A method for use with a **first client device**, for use with a **first server that comprises a web server** that is a Hypertext Transfer Protocol (HTTP) server that responds to HTTP requests, the **first server** stores a first content identified by a first content identifier, and for use with a **second server**, the method by the **first client device** comprising:

receiving, from the **second server**, the first content identifier;

sending, to the **first server** over the Internet, a Hypertext Transfer Protocol (HTTP) request that comprises the first content identifier;

receiving, the first content from the **first server** over the Internet in response to the sending of the first content identifier; and

sending, the first content by the **first client device** to the **second server**, in response to the receiving of the first content identifier.

It is clear from Claim 1 that the method, which is performed “**by the first client device**” comprises:

- “receiving, from the second server, ...”
- “sending, to the first server over the Internet, ...”

- “receiving, the first content from the first server ...”; and
- “sending, the first content by the first client device to the second server, ...”

The unique arrangement of the devices recited in the claim, together with the specific steps that are recited, serve to differentiate the ‘319 Challenged Claims from prior art systems and to achieve the advantages of the inventions.

A. THE CHALLENGED CLAIMS

The ‘319 Patent contains 29 claims, with only Claim 1 being independent. The Petition challenges claims 1-2, 12, 14-15, 17-18, 19, 21-22, and 24-29 of the ‘319 Patent. In the 395 District Court case, Patent Owner is asserting claims 1-2, 14-15, 17-18, 21-22, and 24-27. Thus, there is complete overlap regarding the independent claim. Further, only dependent claims 12, 19, and 28-29 are at issue in the Petition but not in the 395 District Court case.

B. PRIORITY DATE

The ‘319 Patent claims priority back through earlier continuation and divisional applications to provisional application number 61/249,624 filed October 8, 2009. Petitioners have not contested (for purposes of the Petition) this priority date. (Paper 5 at 12).

IV. PERSON OF ORDINARY SKILL IN THE ART

Patent Owner submits that a person of ordinary skill in the art (“POSA”) in the field of the ‘319 Patent (such as Dr. Thomas Rhyne whose declaration is concurrently submitted) would be an individual who, as of October 8, 2009, the filing date of the provisional application, 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.

Petitioner’s proposed qualifications of a POSA are not materially different (Paper 5 at 12-13), at least in terms of affecting a decision as to whether to institute *inter partes* review of the Challenged Claims.

V. CLAIM CONSTRUCTION

The Petition states that “[t]he claim terms at issue in the Challenged Claims require no express claim construction, as the plain and ordinary meanings apply.” (Paper 5 at 13). Patent Owner disagrees, as the meaning of a number of claim terms are in dispute in the 395 District Court claim construction proceedings, as addressed in detail in the briefings (now completed) in that case.⁷

⁷ See Exhibits 2003, 2004 and 2005. In addition, Dr. Rhyne’s Markman declaration in the 395 case is submitted as Ex. 2009.

Patent Owner respectfully submits that the issue of claim construction presents a threshold issue in connection with the determination of whether to institute. More specifically, in discussing claim construction, Petitioners misleadingly cite to a paper that Patent Owner filed in the 395 District Court case in opposition to a motion to dismiss. (Paper 5 at 13-14) Petitioners characterized the opposition paper as “confirm[ing] that Luminati [Patent Owner] views a ‘server’ and ‘client’ to be broad enough to encompass one another, and that Luminati [Patent Owner] equates the ‘client device’ with ‘the agent,’” (Paper 5 at 13-14).

What Petitioners’ *omitted from the record before the Board* was a subsequent paper (a sur-reply – Ex. 2010) that Patent Owner also filed in the 395 District Court case that further explained the annotated figure (Fig. 3) that Petitioners included and discussed in the Petition. (Paper 5 at 14). The sur-reply explained in detail the mischaracterizations regarding the figure:

Having ignored the claim language, Defendants attempt to mischaracterize the specification to read the server-client device-web server architecture out of the claims. Reply at 3-6. In the Opposition, Figure 3 of the ‘319 and ‘510 Patents and 12a of the ‘614 Patent are used to illustrate lines of communication showing the steps performed by the proxy client device. Defendants attempt to use these specific figures to improperly limit the express language *by mischaracterizing Luminati as “view[ing] a ‘server’ and ‘client’ to be broad enough to*

encompass one another.” Reply at 4, 5. *This is not true* as Luminati provided extensive support from the specifications of the Asserted Patents distinguishing between client devices and servers. *See e.g.*, Opp. at 3-5 and 17-19. (emphasis added)

Ex. 2010, pages 10-11 of the PDF.

Patent Owner had filed the sur-reply on May 5, 2020, so Petitioners could have supplied the paper to the Board in their July 14, 2020 Petition to present a more complete, accurate accounting of the statements made in the 395 District Court case.

Additionally, in ruling on the motion to dismiss, the District Court concluded that “[t]he Court is persuaded that claim construction could be of benefit in addressing this issue as it is presented in this case.” (Ex. 2011 at 5). The Court therefore DENIED the motion to dismiss without prejudice to refiling after the Court issues its claim construction order.⁸ (*Id.*) The Court’s order issued on July 15, 2020 – one day after Petitioners filed the instant Petition – so Petitioners could not have submitted the order with the Petition.⁹

⁸ The Court noted that should Defendants elect to refile their motion, they must either address the eligibility of each asserted claim or make an adequate showing of the representativeness of any claims addressed as representative. (*Id.*)

⁹ Notably, Petitioners did not submit the Court’s order (Ex. 2009) in their Petition (Paper 5) seeking review of US Patent No. 10,484,510 (Case IPR2020-01358) which was submitted on July 28, 2020, even though Petitioners were advancing essentially the same arguments.

Patent Owner submits that the foregoing illustrates why, consistent with *Fintiv* factor 3, the Board should decline to institute because the Court has already addressed and will soon be further addressing a number of the exact same issues before the Board. Notwithstanding, should the Board decide to proceed and to address claim construction, Patent Owner provides the following proposed constructions and support for terms likely at issue in this proceeding, taken from ECF 105-1, chart attachment to Joint Claim Construction and Prehearing Statement filed August 18, 2020 (Ex. 2002):

Term	Proposed Construction	Support
Preamble	Is a limitation	
“Client device”	“Consumer computer”	Intrinsic Evidence: Figs. 1, 2, 3, 6 and associated discussion in specification; 2:8-23; 2:44-46; 2:40-52; 4:41-5:7; 5:21-41; 5:49-57; 9:12-9:50; 12:33-12:56; 12:62-13:3; 14:62-15:11; ‘319 Patent claim 1, 26; LUM-00149131-149135 [ATTACHED TO CLAIM CONSTRUCTION REPLY]; Extrinsic Support: Expert declaration/testimony; PC Mag Encyclopedia: Definition of “computing device”: “Any electronic equipment controlled by a CPU, including desktop and laptop computers, smartphones and tablets. It usually refers to a general-purpose device that can accept software for many purposes in contrast with a dedicated unit of equipment such as a network switch or router.” https://www.pcmag.com/encyclopedia/term/66551/computing-device LUM-00003575 RFC 1983 at 11: Definition of “client”: A computer system or process that requests a service of another computer system or process. A workstation requesting the contents of a file from a file server is a client of the file server. https://tools.ietf.org/html/rfc1983

		RFC 2828 at 39: Definition of "Client": (I) A system entity that requests and uses a service provided by another system entity, called a 'server.' https://tools.ietf.org/html/rfc2828 W3 Glossary of Terms for Device Independence at 2: Definition of "Client": The role adopted by an application when it is retrieving and/or rendering resources or resource manifestations. https://www.w3.org/TR/di-gloss/#ref-wca-terms W3 Hypertext Glossary: Definition of "Client": A program which requests services of another program. Normally the browser is a client of a data server. https://www.w3.org/History/19921103-hypertext/hypertext/WWW/Terms.html IEV ref 732-01-12 definition of "client": "functional unit that requests and receives services from a server." LUM-00003490-3491 RFC 2828 at 157: Definition of "Server": (I) A system entity that provides a service in response to requests from other system entities called client. https://tools.ietf.org/html/rfc2828 W3 Glossary of Terms for Device Independence at 4: Definition of "Server": The role adopted by an application when it is supplying resources or resource manifestations. https://www.w3.org/TR/di-gloss/#ref-wca-terms W3 Hypertext Terms: Definition of "Server": A program which provides a service to another, known as the client. In a hypertext system, a server will provide hypertext information to a browser." https://www.w3.org/History/19921103-hypertext/hypertext/WWW/Terms.html Merriam Webster: Definition of "server": A computer in a network that is used to provide services (such as access to files or shared peripherals or the routing of e-mail) to other computers in the network. https://www.merriam-webster.com/dictionary/server LUM-00003579 IEV ref 732-01-12 definition of server: "functional unit that provides services to workstations, to personal computers or to other functional units in a computer network" http://www.electropedia.org/iev/iev.nsf/display?openform&ievref=732-01-12 LUM-00003576
"First server"	"Web server"	Intrinsic evidence: '319 Patent Figs. 1, 3 and associated discussion in specification; 4:62-5:7; 5:21-34; 9:27-9:50; 19:16-32; claim 1; Extrinsic Support: Expert declaration/testimony; ATIS: Definition of "web server": A software program or server computer equipped to offer World Wide Web access. Note: A web server

		accommodates requests from users, retrieves requested files or applications, and issues error messages. https://glossary.atis.org/glossary/web-server/?search=WEB%20SERVER&page_number=&sort=ASC RFC 1983 at 49: Definition of “server”: A provider or resources (e.g. file servers and name servers). https://tools.ietf.org/html/rfc1983 RFC 2828 at 157: Definition of “Server”: (I) A system entity that provides a service in response to requests from other system entities called client. https://tools.ietf.org/html/rfc2828 W3 Glossary of Terms for Device Independence at 4: Definition of “Server”: The role adopted by an application when it is supplying resources or resource manifestations. https://www.w3.org/TR/di-gloss/#ref-wca-terms W3 Hypertext Terms: Definition of “Server”: A program which provides a service to another, known as the client. In a hypertext system, a server will provide hypertext information of a browser.” https://www.w3.org/History/19921103-hypertext/hypertext/WWW/Terms.html Merriam Webster: Definition of “server”: A computer in a network that is used to provide services (such as access to files or shared peripherals or the routing of e-mail) to other computers in the network. https://www.merriam-webster.com/dictionary/server LUM-00003579 IEV ref 732-01-12 definition of server: “functional unit that provides services to workstations, to personal computers or to other functional units in a computer network” http://www.electropedia.org/iev/iev_nsf/display?openform&ievref=732-01-12 LUM-00003576 RFC 1983 at 11: Definition of “client”: A computer system or process that requests a service of another computer system or process. A workstation requesting the contents of a file from a file server is a client of the file server. https://tools.ietf.org/html/rfc1983 RFC 2828 at 39: Definition of “Client”: (I) A system entity that requests and uses a service provided by another system entity, called a ‘server.’ https://tools.ietf.org/html/rfc2828 W3 Glossary of Terms for Device Independence at 2: Definition of “Client”: The role adopted by an application when it is retrieving and/or rendering resources or resource manifestations. https://www.w3.org/TR/di-gloss/#ref-wca-terms W3 Hypertext Glossary: Definition of “Client”: A program which requests services of another program. Normally the browser is a client of a data server. https://www.w3.org/History/19921103-hypertext/hypertext/WWW/Terms.html
“Second server”	“A server that is not the	Intrinsic evidence: ‘319 Patent Fig. 1 and associated discussion in specification; 19:16-32; claim 1 Extrinsic Support:

	client device or first server”	Expert declaration/testimony; RFC 1983 at 49: Definition of “server”: A provider or resources (e.g. file servers and name servers). https://tools.ietf.org/html/rfc1983 RFC 2828 at 157: Definition of “Server”: (I) A system entity that provides a service in response to requests from other system entities called client. https://tools.ietf.org/html/rfc2828 W3 Glossary of Terms for Device Independence at 4: Definition of “Server”: The role adopted by an application when it is supplying resources or resource manifestations. https://www.w3.org/TR/di-gloss/#ref-wca-terms W3 Hypertext Terms: Definition of “Server”: A program which provides a service to another, known as the client. In a hypertext system, a server will provide hypertext information to a browser.” https://www.w3.org/History/19921103-hypertext/hypertext/WWW/Terms.html Merriam Webster: Definition of “server”: A computer in a network that is used to provide services (such as access to files or shared peripherals or the routing of e-mail) to other computers in the network. https://www.merriam-webster.com/dictionary/server LUM-00003579 IEV ref 732-01-12 definition of server: “functional unit that provides services to workstations, to personal computers or to other functional units in a computer network” http://www.electropedia.org/iev/iev.nsf/display?openform&ievref=732-01-12 LUM-00003576 RFC 1983 at 11: Definition of “client”: A computer system or process that requests a service of another computer system or process. A workstation requesting the contents of a file from a file server is a client of the file server. https://tools.ietf.org/html/rfc1983 RFC 2828 at 39: Definition of “Client”: (I) A system entity that requests and uses a service provided by another system entity, called a ‘server.’ https://tools.ietf.org/html/rfc2828 W3 Glossary of Terms for Device Independence at 2: Definition of “Client”: The role adopted by an application when it is retrieving and/or rendering resources or resource manifestations. https://www.w3.org/TR/di-gloss/#ref-wca-terms W3 Hypertext Glossary: Definition of “Client”: A program which requests services of another program. Normally the browser is a client of a data server. https://www.w3.org/History/19921103-hypertext/hypertext/WWW/Terms.html
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See Dr. Rhyne’s Markman declaration (Exhibit 2009) which is part of the
“Expert declaration/testimony.”

Patent Owner also respectfully notes that the “plain and ordinary meanings” advanced by Petitioners are at complete odds with the express language of the claims. For example, Petitioners have advanced a theory that a “client device” and a “server” refer only to the *role* that a device is currently performing. Thus, even though claim 1 expressly recites “[a] method *by the first client device* comprising ...,” under Petitioners’ theory the client device would (presumably) switch between the role of “client” (when requesting content) and “server” (when responding to a request from another device). Patent Owner submits that any such interpretation of the claims would be nonsensical and “unreasonable.” *See* July 2019 PTAB Trial Practice Guide Update at 19.

VI. THE ART CITED IN THE ALLEGED GROUNDS

The Grounds identify three primary references, plus one Network Working Group “Request for Comments” and the “knowledge of a POSA.” (Paper 5 at 5-6). A brief summary of each of the primary references follows.

A. CROWDS

Crowds (Ex. 1011) describes a system comprised of groups (“crowds”) of user computers that can interact with one or more web servers. (Ex. 1011 at 8-9, Dr. Rhyne Dec. Ex. 2012 at ¶22). In order to participate in a crowd, a user installs

software on his/her computer to initiate a process called a “jondo.” (Ex. 1011 at 8, Ex. 2012 at ¶22) “When the jondo is started, it contacts a server called the *blender* to request admittance to the crowd.” (Ex. 1011 at 8, Ex. 2012 at ¶22)(emphasis original) If a jondo gets admitted to a crowd, “the blender reports to [the new] jondo the current membership of the crowd and information that enables this jondo to participate in the crowd.” (Ex. 1011 at 8, Ex. 2012 at ¶22)

The user can “select[] this jondo as her web proxy by specifying its host name and port number in her web browser as the proxy for all services. Thus, any request coming from the browser is sent directly to the jondo.” (Ex. 1011 at 8, Ex. 2012 at ¶23) “Upon receiving the first user request from the browser, the jondo initiates the establishment of a random *path* of jondos that carries its users’ transactions to and from their intended web servers.” (Ex. 1011 at 8, Ex. 2012 at ¶23)(emphasis original) “More precisely, the jondo picks a jondo from the crowd (*possibly itself*) at random, and forwards the request to it.” (Ex. 1011 at 8, Ex. 2012 at ¶23)(emphasis added) “When this jondo receives the request, it flips a biased coin to determine whether or not to forward the request to another jondo; the coin indicates to forward with probability p_f .” (Ex. 1011 at 8, Ex. 2012 at ¶23) “So, each request travels from the user’s browser, through some number of jondos, and finally to the end server.” (Ex. 1011 at 8, Ex. 2012 at ¶23) “[S]erver replies traverse the same path as the

requests, only in reverse.” (Ex. 1011 at 8, Ex. 2012 at ¶23) Figure 2 of Crowds depicts various members of a crowd and a possible set of paths:

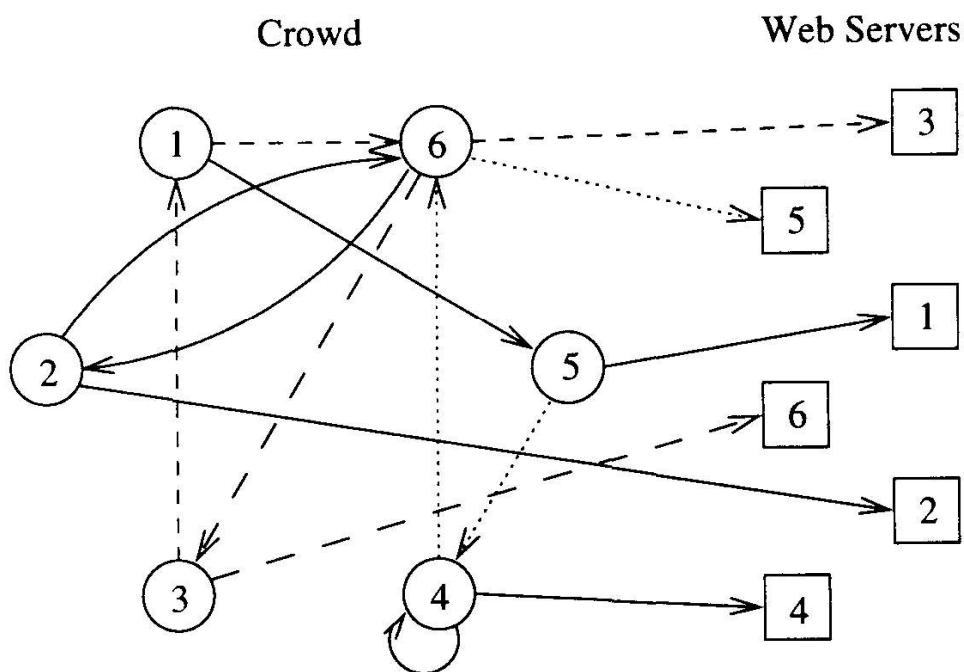


Fig. 2. Paths in a crowd (the initiator and web server of each path are labeled the same).

Notably, each jondo is merely a process running on a user's computer. Thus, the only disclosed architecture(s) is/are as follows:

- (i) User Computer <-> Web Server
- (ii) User Computer <-> User Computer <-> Web Server

As explained above, because a user's jondo may (when it “flips the coin”) decide to transmit the user's request directly to the appropriate web server (without sending the request to another jondo), the identity(s) of the members of the crowd

do not (necessarily) remain anonymous to the web server. Rather, the system of Crowds offers a user “some degree of deniability” (that it *originated* a particular request) – not necessarily anonymity. (Exhibit 1011 at 2, Ex. 2012 at ¶26).

Finally, in addition to numerous security risks described in Crowds, the system suffers from a number of additional weaknesses such as: (i) unpredictable or “particularly pronounced” latency (Ex. 1011 at 19, Ex. 2012 at ¶27); and (ii) an inability to handle firewalls (“Firewalls present a problem for Crowds.”) (Ex. 1011 at 25, Ex. 2012 at ¶27). Because of the limitations associated with the Crowds architecture and implementation, “Crowds will be most useful across academic institutions, as a service provided by Internet service providers, and within large corporations.” (Ex. 1011 at 25, Ex. 2012 at ¶27)

B. BORDER

Border (Ex. 1017) describes “a communication system for receiving web content.” (Border at Abstract, Ex. 2012 at ¶28) As shown in Border Figs. 1 and 2 (below), “[a] downstream proxy server receives a URL request message from a web browser, in which the URL request message specifies a URL content that has an embedded object.” (Ex. 1017 at 3:34-38, Ex. 2012 at ¶28) “An upstream proxy server receives the URL request message from the downstream proxy server.” (Ex. 1017 at 3:34-38, Ex. 2012 at ¶28) “The upstream proxy server selectively forwards

the URL request message to a web server and receives the URL content from the web server. (Ex. 1017 at 3:34-38, Ex. 2012 at ¶28) “The upstream proxy server forwards the URL content to the downstream proxy server and parses the URL content *to obtain the* embedded object prior to receiving a corresponding embedded object request message initiated by the web browser.” (Ex. 1017 at 3:34-38, Ex. 2012 at ¶28)(emphasis added)

FIG. 1

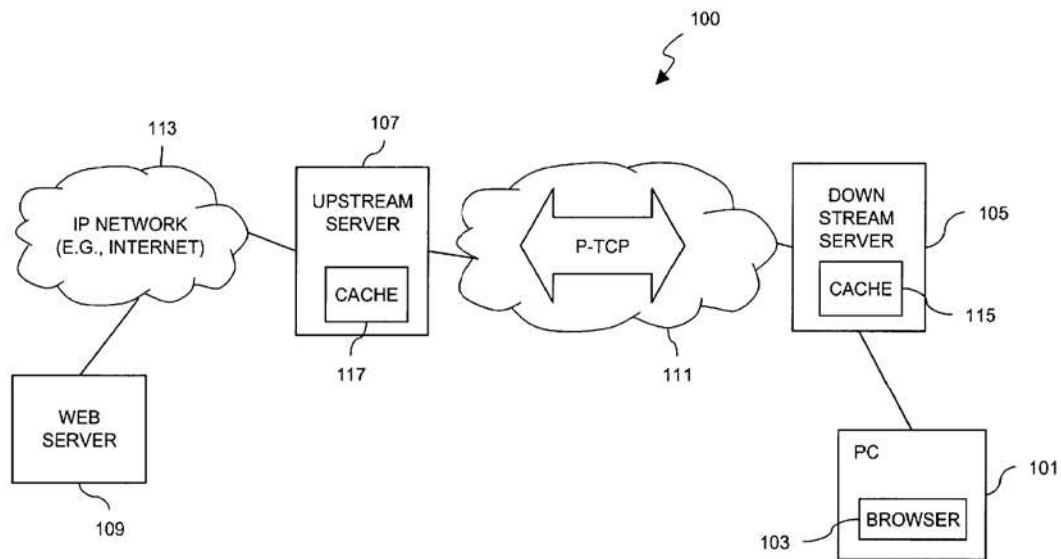
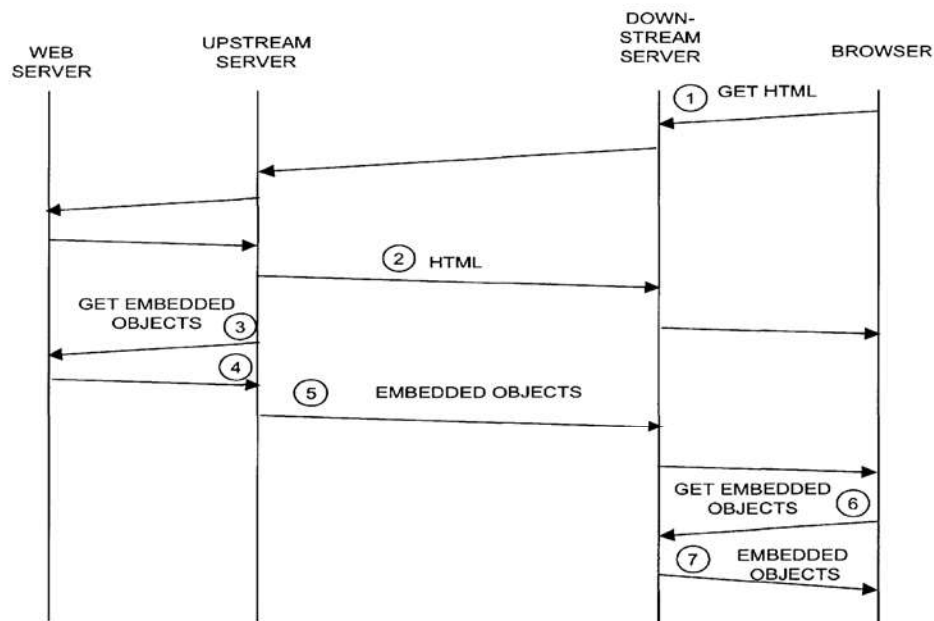


FIG. 2



As described in the specification, the system of Border relates to obtaining “embedded objects” from a web server (or from a local cache) “prior to receiving corresponding embedded object requests initiated by [a] web browser.” (Ex. 1017 at 5:45-49, Ex. 2012 at ¶29)

To that end, the disclosed system incorporates two servers, each having its own cache (“downstream server 105 checks its cache 115 to determine whether the requested URL has been previously visited” (Ex. 1017 at 5:19-21, Ex. 2012 at ¶30) and “upstream server 117 in turn searches for the URL HTML in its cache 117”). “[I]f the HTML page is not found in cache 117, the server 117 issues the GET URL HTML request [to-sic] web server 109 for the HTML page.” (Ex. 1017 at 5:34-36, Ex. 2012 at ¶30) “[U]pstream server 117 parses the HTML page and requests the

embedded objects within the HTML page from the web server 109; the embedded objects are requested prior to receiving corresponding embedded object requests initiated by the web browser 103.” (Ex. 1017 at 43-48, Ex. 2012 at ¶30)

“[D]ownstream proxy server 105 initiates and maintains a TCP connection to the upstream proxy server 107 as needed to carry HTTP transactions.” (Ex. 1017 at 7:50-53, Ex. 2012 at ¶31) “The persistent TCP connection may also be set up when the first transaction is required and torn down after the connection has been idle for some period.” (Ex. 1017 at 7:56-58, Ex. 2012 at ¶31)

The disclosed architecture over which the system operates is:

Border:

User Computer <-> Downstream Server <-> Upstream Server <-> Web Server

C. MORPHMIX

MorphMix (Ex. 1013) discloses “a peer-to-peer-based dynamic mix network ...” (MorphMix at 115, Ex. 2012 at ¶33) Fig. 5 of MorphMix depicts the “Basic Idea of MorphMix”:

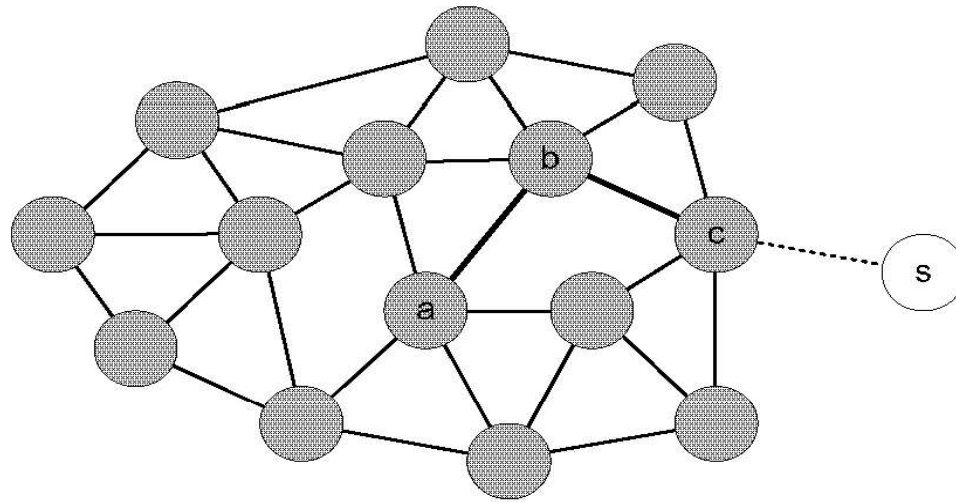


Figure 5.1: *Basic idea of MorphMix.*

In the disclosed system, “[a]t any time, Morphmix consists of a set of participating nodes.” (Ex. 1013 at 118, Ex. 2012 at ¶34) Nodes can join and leave the system at any time and must therefore not necessarily participate in the MorphMix protocol all the time.” (Ex. 1013 at 118, Ex. 2012 at ¶34) “We assume that at any time, a node knows about some other nodes, i.e., their IP addresses, the ports on which the MorphMix application is listening for incoming connection requests, and their public keys.” (Ex. 1013 at 118, Ex. 2012 at ¶34) “Learning about other nodes requires a peer discovery mechanism ...” (Ex. 1013 at 118, Ex. 2012 at ¶34)

“A node that is participating in MorphMix has established a *virtual link* to one or more other MorphMix nodes at any time.” (Ex. 1013 at 119, Ex. 2012 at

¶35)(emphasis original) “In MorphMix, a virtual link means that (1) there is a TCP connection between the two nodes and (2) they share a symmetric key that is only known to these two nodes.” (Ex. 1013 at 119, Ex. 2012 at ¶35) “In Figure 5.1, *a* has five neighbors because it has established virtual links to five other nodes.” (Ex. 1013 at 119, Ex. 2012 at ¶35)

“Since MorphMix is basically a circuit-based mix network, a node establishes a circuit via some other nodes to access servers in the Internet anonymously.” (Ex. 1013 at 119, Ex. 2012 at ¶36). A node can be established by “[a]nyone who has access to a computer that is connected to the Internet should be able to join and use MorphMix after having installed the MorphMix software.” (Ex. 1013 at 116, Ex. 2012 at ¶36)

MorphMix operates by creating one or more anonymous tunnels – “[A]n anonymous tunnel is set up hop-by-hop in the sense that the initiator picks the first intermediate node and establishes the layer of encryption with it.” (Ex. 1013 at 134, Ex. 2012 at ¶37) “Then the initiator tells the first intermediate node to append another node to the tunnel and establishes the layer of encryption with the second intermediate node.” (Ex. 1013 at 134, Ex. 2012 at ¶37) “This continues until the initiator decides the tunnel is long enough.” (Ex. 1013 at 134, Ex. 2012 at ¶37) “The key is that the initiator selects only the first intermediate node and each node along

the anonymous tunnel then picks the following node.” (Ex. 1013 at 134, Ex. 2012 at ¶37)

The architecture and configuration of MorphMix suffers from a number of problems. For example, “a centralized lookup service that keeps track of the nodes that are currently participating in MorphMix is out of the question.” (Ex. 1013 at 135, Ex. 2012 at ¶37) “Free riding” is also a problem in MorphMix, where “users only consume but do not provide the files that they download to others.” (Ex. 1013 at 143, Ex. 2012 at ¶37) “MorphMix suffers from the same problem.” (Ex. 1013 at 143, Ex. 2012 at ¶37)

The disclosed architecture over which MorphMix operates is:

MorphMix: Peer < - > Peer < - > Server

VII. THE FAILED GROUNDS OF ALLEGED INVALIDITY

As mentioned above, this POPR is limited to select reasons why institution should be denied. Consistent with the limited nature of this paper, only select distinctions between Independent Claim 1 and the references cited in the Grounds are discussed below. Patent Owner expressly reserves the right to address all issues and to challenge all points raised by Petitioners in any future response if proceedings are instituted.

A. GROUND 1: FAILURE OF CROWDS TO ANTICIPATE CLAIM 1

As discussed above, Crowds generally discloses a system comprised of a “crowd” of user computers that can interact with one or more web servers. Each user computer runs a process called a “jondo” that allows the computer to (if admitted) join a crowd. Crowds does not disclose – and Petitioners do not allege that Crowds discloses - any “second server” outside of the various members of the crowd. Instead, Petitioners allege that a member of the Crowd – “jondo 4” would be the “second server” recited in Challenged Claim 1 (“the ‘second server’ would be jondo ‘4’”) (Paper 5 at 19-20).

When describing Crowds, Petitioners also allege that “[i]n Crowds, a user’s request to a web server is *not passed directly to the web server*, but instead to a random member of the crowd, who either submits the request directly to the web server or forwards it again.” (Paper 5 at 17)(emphasis added). This allegation is untrue, and misrepresents the disclosure of Crowds. As discussed above, the forwarding of requests from jondo-to-web server or from jondo-to-jondo-to-web server is based on the flip of a (logical) biased coin. (Crowds Exhibit 1011 at 8). Crowds expressly states that when a jondo receives a request from a user’s browser, “the jondo picks a jondo from the crowd (*possibly itself*) at random, and forwards the request to it.” (*Id.*)(emphasis added). Thus, a jondo may decide to forward a

user’s request directly to a web server, without forwarding the request to any other user/jondo.

Because of the architecture and operation of Crowds, the *initiator* of a request does not (necessarily) enjoy anonymity as to the target web server. Rather, the system of Crowds merely offers an initiator “some degree of deniability” that it originated a particular request. (Crowds Ex. 1011 at 2). Moreover, the architecture of Crowds leads to unpredictable or “particularly pronounced” latency (*Id.* at 19). Contrary to the deficiencies of Crowds, even Petitioners acknowledged that Crowds fails to achieve the claimed benefits of the ‘319 Patent – “congestion and latency reduction and anonymity ...” (Paper 5 at 51).

Comparing Crowds to the express limitations of Challenged Claim 1, a number of the express limitations are neither taught nor suggested, including:

Preamble: “second server”	Crowds fails to disclose a “second server” Crowds fails to disclose a “second server” that does not communicate directly with a web server
“receiving, from the second server ...”	Crowds fails to disclose a “second server”

	Crowds fails to disclose “receiving, from the second server ...”
“sending, the first content by the first client device to the second server, in response to the receiving of the first content identifier.”	Crowds fails to disclose sending the first content by the first client device to the second server Crowds fails to disclose that the first content is sent to the second server in response to receiving of the first content identifier [from the second server]

Because the architecture and operation of Crowds differs from the “second server – client first device – web server” architecture/operation of the ‘319 patent, Crowds neither teaches nor suggests the method of Challenged Claim 1. At least for the above reasons, Ground 1 fails.

B. GROUND 2: FAILURE OF CROWDS + RFC 2616 + GENERAL KNOWLEDGE TO RENDER OBVIOUS CLAIM 1

Petitioners allege that “Ground 2 combines the teaching of Crowds with the general knowledge of a POSA with regard to HTTP and TCP/IP Internet communications.” (Paper 5 at 30). As to Claim 1, Petitioners offer no evidence

beyond hindsight that “[e]ven if Crowds were deemed not to disclose a ‘server’ as a jondo – despite the express disclosure – it would have been obvious to a POSA that any of the commonly understood types of ‘servers’ that have IP addresses could be used.” (Paper 5 at 33).

First, this is pure hindsight analysis, as evidenced by Petitioners use of the term “*could have been used.*” (emphasis added) (*See KSR Int’l Co. v. Teleflex, Inc.* 550 U.S. 398, 421, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007) (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.”)).

Second, although Petitioners used the phrase “despite the *express disclosure*” (emphasis added) to argue that a “second server” was disclosed, Petitioners cite no authority for that proposition. Because there is none.

At least for the above reasons, Ground 2 fails.

C. GROUND 3: FAILURE OF BORDER TO ANTICIPATE CLAIM 1

As discussed above, Border generally discloses a communication system for receiving web content containing embedded objects. (Border Ex. 1017 at Abstract) The disclosed system utilizes two proxy servers (each including local cache) disposed between a “user computer” and a “web server.” (Border Ex. 1017 at 3:34-38) The alleged advantage of the system of Border is that “the upstream proxy server

forwards the URL content to the downstream proxy server and parses the URL content to obtain the embedded object *prior to the web browser having to issue an embedded object request message.*" (Border Ex. 1017 at 2:54-58)(emphasis added)

Because Border addresses completely different issues than the issues solved by the '319 Patent, the architecture and operation of Border is completely different than Challenged Claim 1. Comparing Border to the express limitations of Challenged Claim 1, a number of the express limitations are neither taught nor suggested, including:

Preamble: "first client device"	Border fails to disclose a "first client device" that communicates with a "first server" (a "web server")
"receiving, from the second server ..."	As the claimed method is performed by the "first client device," Border fails to disclose a "first client device" that performs "receiving, from a second server ..."
"sending, to the first server"	Border fails to disclose a "first client device" that performs "sending, to the first server ..."

“receiving, the first content from the first server”	Border fails to disclose a “first client device” that performs “receiving, the first content from the first server ...”
“sending, the first content by the first client device to the second server, in response to the receiving of the first content identifier.”	Border fails to disclose sending the first content by the first client device to the second server Border fails to disclose that the first content is sent to the second server in response to receiving of the first content identifier [from the second server]

Like the arguments advanced in each Ground, Petitioners' argument, in large part, is based on unreasonable interpretation of the claim language. By way of example, Petitioners' position as to how “the preamble [of claim 1] maps onto Border” is as follows:

“First **client device**: Upstream **server** 107” (Petition at 40)(emphasis added)

Petitioners' entire discussion and analysis of Challenged Claim 1 repeats this same false premise – that the claimed “first *client* device” is somehow met by “Upstream *server* 107.” (*Id.*) Petitioners ignore the express limitations of the claims regarding the identity of specific elements *and the claimed communications therebetween*.

Because the architecture and operation of Border differs from the “second server – first client device – web server” architecture of the ‘319 Patent, Crowds neither teaches nor suggests the method of Challenged Claim 1. At least for the above reasons, Ground 3 fails.

D. GROUND 4: FAILURE OF CROWDS + RFC 2616 + GENERAL KNOWLEDGE TO RENDER OBVIOUS CLAIM 1

Petitioners allege that “Ground 4 is based upon a combination of the teaching of Border with the general knowledge of a POSA with regard to HTTP and TCP/IP Internet communications.” (Paper 5 at 49). As to Claim 1, Petitioners offer no evidence beyond hindsight that “[e]ven if ‘first client device’ is construed to refer to a consumer computer instead of a device acting in the role of a client, it would have been obvious to a POSA, in view of RFC 2616 and a POSA’s knowledge of Internet communications in 2009 to modify upstream server 107 to operate on a consumer computer.” (Paper 5 at 50-51).

Again, this is pure hindsight analysis, as evidenced by Petitioners use of the term “*it would have been obvious ... to modify ...*” (emphasis added) The Federal Circuit has cautioned that hindsight analysis – as engaged in by Petitioners – is unacceptable and cannot form the basis for obviousness pursuant to 35 USC 103. (See *KSR Int’l Co. v. Teleflex, Inc.* 550 U.S. 398, 421, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007) (“A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.”)).

At least for the above reasons, Ground 4 fails.

E. GROUND 5 FAILURE OF MORPHMIX TO ANTICIPATE CLAIM 1

As discussed above, MorphMix generally discloses “a peer-to-peer-based dynamic mix network ...” (MorphMix Ex. 1013 at 115) The network of MorphMix consists of a set of participating nodes, where “[a] node that is participating in MorphMix has established a *virtual link* to one or more other MorphMix nodes at any time.” (*Id.* at 119)(emphasis original) “Since MorphMix is basically a circuit-based mix network, a node establishes a circuit via some other nodes to access servers in the Internet anonymously.” (*Id.*).

MorphMix operates by creating one or more anonymous tunnels. (*Id.* at 134) However, the architecture and configuration of MorphMix suffers from a number of

problems. For example, “a centralized lookup service that keeps track of the nodes that are currently participating in MorphMix is out of the question” (*Id.* at 135) “Free riding” is also a problem in MorphMix, where “users only consume but do not provide the files that they download to others.” (*Id.* at 143) “MorphMix suffers from the same problem.” (*Id.*) Additionally, MorphMix suffers from poor performance and increased latency: “Compared to Figure 8.1, the download times are significantly longer. The better the bandwidth of the node, the more severe the performance penalty from which it suffers.” (Ex. 1013 at 227). Finally, a MorphMix tunnel completely fails when any node along a tunnel fails or leaves: “The most significant limitation of MorphMix is that if any node along a tunnel can no longer be reached for any reason, the tunnel fails.” (Ex. 1013 at 256).

The disclosed architecture over which MorphMix operates is:

Morphmix: Peer < - > Peer < - > Server

In advancing Ground 5, Petitioners ignore the express disclosure of MorphMix and instead redefine the nodes – to equate “client devices” with “servers” - in the following way:

First **client device**: last **node** (c).

Second **server**: intermediate **node** (b).

(Petition at 57)(emphasis original)

Petitioners *re-imagined* architecture of MorphMix is simply not what is disclosed. MorphMix unambiguously discloses a different architecture and operation than the method of Challenged Claim 1. And because of these differences, MorphMix suffers from the problems discussed above – problems which are not present in the invention of Challenged Claim 1.

Comparing MorphMix to the express limitations of Challenged Claim 1, a number of the express limitations are neither taught nor suggested, including:

Preamble: “second server”	MorphMix fails to disclose a “second server”
“receiving, from the second server ...”	MorphMix fails to disclose a “second server” MorphMix fails to disclose “receiving, from the second server ...”
“sending, the first content by the first client device to the second server, in response to the receiving of the first content identifier.”	MorphMix fails to disclose sending the first content by the first client device to the second server MorphMix fails to disclose that the first content is sent to the second server in

	response to receiving of the first content identifier [from the second server]
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Because the architecture and operation of MorphMix differs from the “second server – first client device – web server” architecture of the ‘319 Patent, MorphMix neither teaches nor suggests the method of Challenged Claim 1. At least for the above reasons, Ground 5 fails.

F. GROUND 6 FAILURE OF MORPHMIX + RFC 2616 + GENERAL KNOWLEDGE TO RENDER OBVIOUS CLAIM 1

Petitioners allege that “the rationale for combining Crowds with the same general knowledge of a POSA and RFC 2616” “is the same for MorphMix as for Crowds ...” (Paper 5 at 69). Thus, Ground 6 (pertaining to MorphMix) fails for at least the same reasons explained above as to Ground 2 (pertaining to Crowds).

In advancing Ground 6, Petitioners again rely on pure hindsight to allege that “it would have been obvious” to incorporate a “second server” into MorphMix. (Petition at 69-70). And again, the Federal Circuit has cautioned that hindsight analysis – as engaged in by Petitioners – is impermissible and cannot form the basis for obviousness pursuant to 35 USC 103. (*See KSR Int’l Co. v. Teleflex, Inc.* 550 U.S. 398, 421, 127 S. Ct. 1727, 167 L. Ed. 2d 705 (2007) (“A factfinder should be

aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.").

At least for the above reasons, Ground 6 fails.

VIII. CONCLUSION

For at least the reasons explained above, Patent Owner respectfully requests that the Board deny institution of this *inter partes* review. The *Fintiv* factors, alone, strongly weigh against institution. Moreover, the lack of merit of the Petition coupled with the fact that the 395 District Court already has the very same claim construction and prior art issues squarely before it further dictates that the requested institution should be denied.

Respectfully submitted,

Date: December 9, 2020

By: /s/ Thomas M. Dunham/

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CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Preliminary Response “POPR” consists of no more than - 9622 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The POPR complies with the type-volume limitation of 14,000 words 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).

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