

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

OXYLABS LT, UAB,

Petitioner

v.

BRIGHT DATA LTD.,

Patent Owner

Case IPR2024-00126

Patent No. 11,616,826

PATENT OWNER'S SUR-REPLY

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Patent Trial and Appeal Board
United States Patent and Trademark Office
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<u>LIST OF ABBREVIATIONS</u>	
FWD	Final Written Decision
687 IPR	<i>Metacluster LT, UAB v. Bright Data Ltd.</i> , IPR2022-00687 of Patent No. 11,190,622
‘622 Patent	Patent No. 11,190,622 (EX. 1025)
PO	Patent Owner

I. INTRODUCTION

In the Reply, Petitioner argues for collateral estoppel for certain claim limitations based on the Final Written Decision (“FWD”) in IPR2022-00687 (“687 IPR”) of related Patent No. 11,190,622 (“’622 Patent”). However, as discussed below, the issues in the 687 IPR and this IPR are not the same at least because the patents recite different claim language and have different prosecution histories, both of which materially affect the patentability determinations in this IPR. Patent Owner (“PO”) respectfully submits that the Board should evaluate the grounds based on the evidence of record in this IPR.

This paper will further show that Petitioner has failed to meet its burden and that the challenged claims of the ‘826 Patent should be confirmed patentable.

II. CLAIM CONSTRUCTION

Petitioner argues that PO is estopped from advancing claim construction arguments in this IPR. Reply at 4-5, 10. Petitioner is incorrect at least because the ‘622 Patent and the ‘826 Patent have different claim language and different prosecution histories. *MasterObjects, Inc. v. Meta Platforms, Inc.*, 2024 U.S. App. LEXIS 3528, *13 (Fed. Cir. 2024) (explaining “a court cannot impose collateral estoppel to bar a claim construction dispute solely because the patents are related” and must consider any material differences in the intrinsic record for each patent).

A. “SELECTING, AN IP ADDRESS” MEANS “MAKING A CHOICE IN PREFERENCE TO ANOTHER OR OTHERS”

Both experts’ testimony supports PO’s construction for this term. POR at 7-9. 5. Petitioner’s expert stated that selecting means “[y]ou have to be able to choose among a set” and “[t]here’s no selecting if there’s only one answer”. EX. 2013 at 50:6-12.

PO’s construction is consistent with the intrinsic evidence, including the specification and the *parent prosecution history statement* distinguishing the Yu reference based on its predefined selection in the client device.¹ POR at 7-9. Petitioner ignores multiple citations to the specification, with supporting admissions from Petitioner’s own expert, and the prosecution history. *See* Reply at 4. Petitioner also ignores the cited extrinsic evidence. *See* Reply at 4-5.

Estoppel does not apply at least because the relevant claim limitation is materially different in the ‘826 patent. In the 687 IPR, the parties’ disputed whether the alleged selection occurred in response to the receiving of the first URL as required by claim 1 of the ‘622 Patent. This temporal limitation is not present in claim 1 of the ‘826 Patent. Petitioner cites to the Board’s prior analysis of this temporal limitation in the FWD in the 687 IPR. *See, e.g.*, EX. 1028 at 36 (“Patent

¹ The parent prosecution history statement is at least one material difference in the intrinsic record of the ‘826 Patent such that estoppel does not apply.

Owner contends that the selection of proxies in the chain cannot be performed *in response to* the proxy server 17 receiving the internet request comprising the first/second URL”) (emphasis added).

Further, estoppel does not apply at least because PO disavowed a broader interpretation of this claim term in the 687 IPR, which shows the Board should adopt PO’s construction in this IPR. EX. 1028 at 35 (“Patent Owner further contends that Kocherlakota’s proxy server 17... does not perform the ‘selecting’ steps, in particular, because Kocherlakota does not include a disclosure or teaching of any intelligent selection by proxy server 17.”) (citing EX. 1026 at 48); EX. 1028 at 36 (“According to Patent Owner, ‘the disclosure of the ’622 Patent shows that the ‘selecting’ of an IP address requires some intelligent decision-making by the first server to determine, for example, the numerical closeness of the possible proxy IP addresses relative to the destination web server.’”) (citing EX. 1026 at 49).

The Board recognized PO’s arguments for a requirement of intelligent decision-making, precluding predefined selection in the client device. EX. 1028 at 36. Even though the Board did not find sufficient evidence to interpret the ’622 Patent to include this requirement, these statements clearly put the public on notice that the ’826 Patent claims *do* include this requirement. *CUPP Computing AS v. Trend Micro Inc.*, 53 F.4th 1376, 1383 (Fed. Cir. 2022) (“To be clear, a disclaimer

in an IPR proceeding is binding in later proceedings, whether before the PTO or in court.”).

In view of at least the clear prosecution history disclaimer in at least the 687 IPR, PO’s construction of this term should be adopted in this IPR. *See, e.g., Sequoia Tech., LLC v. Dell, Inc.*, 66 F.4th 1317, 1327 (Fed. Cir. 2023) (affirming narrower claim construction based in part on patent owner statements in IPR distinguishing prior art).

B. “SENDING... THE SELECTED IP ADDRESS” MEANS SENDING AFTER SELECTING

Both parties initially seemed to agree on the plain and ordinary meaning of this phrase in claim 19. Petition at 20; POR at 9-10. The Petition clearly stated that “a POSITA would have understood sending the selected IP addresses to correspond to sending the IP address selected in claim 1.” Petition at 20. However, in the Reply, Petitioner takes an inconsistent position necessitating clarification by the Board. Reply at 19.

A POSA would have understood that the sending in claim 19 occurs *after* the selecting in claim 1. As a matter of logic and grammar, a POSA would not understand “sending the selected IP address” to occur before the IP address is selected. *See, e.g., In re Hyatt*, 708 F.2d 712, 714 (Fed. Cir. 1983) (“A claim must be read in accordance with the precepts of English grammar.”); *Altiris, Inc. v. Symantec Corp.*, 318 F.3d 1363, 1369 (Fed. Cir. 2003) (“[W]e look to the claim

language to determine if, as a matter of logic or grammar, they must be performed in the order written”).

Petitioner’s reply argument regarding antecedent basis is wrong. *Contra* Reply at 19. For example, claim 2 recites a “second client device” addressable using the “selected IP address”. Claim 5 depends from claim 2 and recites “storing an IP address of the second client device”. Claim 5 does not need to occur after the selecting in claim 1.

**C. “CLIENT DEVICE” MEANS “CONSUMER COMPUTER” AND
“FIRST SERVER” MEANS “SERVER THAT IS NOT A CLIENT
DEVICE”**

PO explained that the correct constructions should differentiate client devices and servers as different types of hardware. POR at 13-35. The wealth of intrinsic evidence consistently supports PO’s hardware-based constructions.

PO repeatedly disavowed Petitioner’s purely role-based constructions in multiple IPRs. PO expressly defined a “client device” as a “consumer computer” and confirmed a “server” is different hardware than a consumer computer. Thus, even were these terms otherwise capable of broader construction, PO disclaimed any scope of “client device” beyond consumer computer hardware. *Aylus Networks, Inc.*, 856 F.3d 1353, 1359-1361 (Fed. Cir. 2017). Similarly, PO disclaimed any scope of “server” beyond server hardware. *Id.*

Petitioner cannot argue that the public was not on notice of PO's hardware-based constructions for these terms. The below list is non-exhaustive, but shows multiple examples of disclaimer and lexicography before the '826 Patent issued on 3/28/2023 and before the Petition was filed in this IPR on 12/5/2023.

IPR2020-01266	POPR, Paper 12	Oct. 26, 2020
IPR2020-01358	POPR, Paper 9	Nov. 20, 2020
IPR2022-00103	POR, Paper 15	Sep. 4, 2022
IPR2022-00135	POR, Paper 16	Aug. 24, 2022
IPR2022-00138	POR, Paper 16	Aug. 5, 2022
IPR2022-00353	POR, Paper 13	Sep. 19, 2022
IPR2022-00915	POR, Paper 30	Jan. 6, 2023
IPR2022-00916	POR, Paper 30	Jan. 6, 2023
IPR2021-01492	POR, Paper 31	Jan. 6, 2023
IPR2021-01493	POR, Paper 30	Jan. 6, 2023
IPR2022-00687	POR, Paper 17	Jan. 20, 2023

Though the Board previously adopted Petitioner's purely role-based constructions in the 687 IPR, there are compelling reasons for the Board to adopt PO's hardware-based constructions in this IPR. **The Board did not previously consider express disclaimer in at least IPR2020-01266 and IPR2020-01358 or express lexicography in Reissue Appln. No. 18/523,800.² Additionally, the**

² PO did not waive these arguments in the related IPRs. *See, e.g., Seabed Geosolutions (US) Inc. v. Magseis FF LLC*, 8 F.4th 1285, 1289 (Fed. Cir. 2021) ("The doctrine of waiver does not preclude a party from supporting its original claim construction with new citations to intrinsic evidence of record.").

express disclaimer in the 687 IPR itself is a material difference in this IPR. In view of the intrinsic evidence of record in this IPR, there is clear and unmistakable disavowal of Petitioner’s purely role-based constructions. The Board should adopt PO’s hardware-based constructions in this IPR.

In particular, in the 687 IPR, the Board did not consider prosecution history disclaimer in IPR2020-01266 and IPR2020-01358. POR at 20. Even though those two IPRs were denied institution, the Federal Circuit has made clear that “[w]e have stated on numerous occasions that a patentee’s statements during prosecution, whether relied on by the examiner or not, are relevant to claim interpretation.” *Microsoft Corp. v. Multi-Tech Sys.*, 357 F.3d 1340, 1350 (Fed. Cir. 2004) (citing collection of cases).

Additionally, in the 687 IPR, the Board did not consider express lexicography in Reissue Appln. No. 18/523,800.³ PO could not have been more clear regarding the correct meaning of these claim terms:

Applicant expressly notes for purposes of clear lexicography that the current claims recite the terms “client device” and “first server”. To be clear, Applicant understand “client device” to mean “consumer computer.” *See, e.g.*, specification at col. 2, ll. 44-46. Applicant understands “first server” to be a server, which is a type of hardware component as understood by persons skill in the art, and which is

³ Following the FWD in the 687 IPR, PO filed a reissue application based on the ‘622 Patent on 11/29/2023. EX. 2041 at ¶146; EX. 2048.

different from a client device, a router, or a switch.

EX. 2048 at 13-14.

This disclaimer in the reissue application is indeed relevant to the ‘826 Patent. *Microsoft Corp.*, 357 F.3d at 1350 ("[W]e conclude that Multi-Tech's statements made during the prosecution of the ’627 patent with regard to the scope of its inventions as disclosed in the common specification are relevant not only to the ’627 and the [later issued] ’532 patents, but also to the *earlier issued* ’649 patent.") (emphasis added).

Moreover, the disclaimer in the 687 IPR itself is relevant to the ‘826 Patent. *CUPP Computing AS*, 53 F.4th at 1383.

Lastly, contrary to Petitioner’s arguments, the district court did not have the benefit of the detailed discussion of prosecution histories in this IPR. *See* Reply at 9-10. Even so, the district court ***did not*** adopt Petitioner’s purely role-based constructions and instead, expressly rejected genericizing the claim terms to refer to a particular role. POR at 28-29.⁴

⁴ The district court did not adopt purely role-based constructions. *Contra* Reply at 9-10. The district court acknowledged hardware-based distinctions in its constructions reciting “communication device” versus “server.” POR at 26-29. The fact that the district court recognized that a client device can operate as a server

1. Petitioner's arguments are facially incorrect

Petitioner argues that there is no substantive difference between the previously rejected arguments in the 687 IPR and this IPR. Reply at 5. Petitioner is incorrect. Petitioner appears to have reviewed only the headings in the table of contents of the expert declaration, rather than the actual opinions. There is significant additional and materially different prosecution history evidence addressed by Dr. Williams in support of PO's constructions, including express disclaimer and lexicography. *See, e.g.*, EX. 2041 at ¶¶135-138 (analyzing prosecution history of grandparent patent); ¶¶139-142 (analyzing prosecution history of parent patent); ¶143 (analyzing prosecution history of '826 Patent including the fact that the examiner reviewed Kocherlakota, Cohen, and RFC1122 and allowed the issued claims); ¶¶144-147 (analyzing '622 Patent and reissue application); ¶¶148-152 (analyzing prosecution history of related patents including express disclaimer).

does not change the hardware. For example, an intermediary client device can operate in both client/server roles, but that does not change the fact that a client device is consumer computer hardware. POR at 22 (discussing agent 122 of FIG. 3).

Additionally, Petitioner argues that the expert declaration's paragraphs 106-120 don't cite to the detailed description (Reply at 8-9), but this section of the declaration is discussing the figures of the specification and how Petitioner's purely role-based constructions fail to differentiate an intermediary **server** from an intermediary **client device**.⁵ As explained, proxy server 6 of FIG. 1 would meet both of Petitioner's constructions because proxy server 6 operates in both client/server roles; and agent 122 of FIG. 3 would meet both of Petitioner's constructions because agent 122 operates in both client/server roles. Petitioner's constructions cannot be correct. There is necessarily a difference between using an intermediary **server** versus an intermediary **client device** in the context of the '826 Patent.

Indeed, PO repeatedly explained how the specification supports PO's hardware-based constructions. POR at 14-15 (discussing lexicography); 21-23 (discussing specification); and 25 (discussing claim language). PO's constructions are also consistent with the extrinsic evidence. POR at 23-25.

⁵ This is particularly relevant to, for example, dependent claim 4, which recites the use of an intermediary server as well as an intermediary client device. *See also* EX. 2041 at ¶62 (discussing the specification and the use of both an intermediary server and an intermediary client device).

In the Reply, Petitioner still cannot explain how its constructions differentiate an intermediary client device and an intermediary server. *See* Reply at 9. Petitioner relies on the Board’s findings in the 687 IPR, but for at least the reasons discussed above, the Board should adopt PO’s constructions in this IPR.

2. A POSA would have understood that server hardware is different from consumer computer hardware

Petitioner cannot dispute that a POSA would have known what a server hardware component is. Petitioner itself has characterized server hardware components as “network servers”, “a specialized data-center class device”, “higher-powered devices (such as data center servers)”⁶; “dedicated server hardware”⁷; and further admitted that a POSA would have been aware, in 2009, of equipment commonly used as “servers”, such as a “133-MHz SGI workstation running Irix 5.3 and an Apache web server”⁸.

PO does not propose a “checklist” of attributes to determine whether a component is or is not server hardware. *Contra* Reply at 12. This determination is within the skillset of a POSA.

⁶ *E.g.*, IPR2022-00861, Paper 1 at 39 (PTAB Aug. 18, 2022).

⁷ *E.g.*, *id.* at 72.

⁸ *E.g.*, *id.* at 39 (citing IPR2022-00861, EX. 1006 at 82).

Dr. Williams’ testimony supports PO’s hardware-based constructions distinguishing “client devices” and “servers” in the context of the ‘826 Patent. Dr. Williams additionally provided testimony about the different attributes of these different components, known to a POSA. *See, e.g.*, EX. 2041 at ¶¶168-169, 178-179. These attributes differentiate client devices and servers in the context of the ‘826 Patent. Dr. Williams used relative terms because the specification discloses two types of network components: client devices (including clients, peers, and agents) and servers (including acceleration servers, proxy servers, and web servers).⁹ Petitioner ignores the context of the patent itself.

Indeed, many of the attributes discussed by Dr. Williams are drawn directly from the intrinsic record (*e.g.*, EX. 2028 at 163-164); they are also consistent with extrinsic materials that further support Dr. Williams’ testimony regarding the understandings of a POSA. POR at 23-25.

During deposition, Petitioner’s questioning failed to consider the context of the ‘826 Patent. For example, Petitioner asked *incomplete hypotheticals* without

⁹ *See, e.g.*, EX. 1029 at 36:3-40:22 (comparing memory, speed, power supply/consumption, threads, processors, ports, routers, PCB boards, and I/O capabilities for user interface for consumer computer hardware versus server hardware).

any details as to context such as the context provided in the claims. *See, e.g.*, EX. 1029 at 37:4-6 (“You can’t discuss this at the level of abstraction that you’re trying to discuss it at.”). Dr. Williams did not testify that hardware-based constructions “ultimately rely on the role of that hardware”. *Contra* Reply at 6. Dr. Williams explained that consumer computer hardware can be configured to operate in the role of a server, but that still does not change the hardware. *See also, e.g.*, EX. 2041 at ¶159 (“Regardless of the role being performed, a client device is not a server.”).

Consistent with the statutory purpose of Section 112, PO respectfully submits that the public is on notice of the scope of the claimed inventions of the ‘826 Patent. *Nautilus, Inc. v. Biosig Instruments, Inc.*, 572 U.S. 898, 909-910 (2014).

D. “SERVER OPERATING SYSTEM” MEANS “AN OPERATING SYSTEM THAT RUNS ON A SERVER, A TYPE OF HARDWARE”

PO’s construction for this term properly differentiates a server operating system from a client operating system. POR at 10-13.¹⁰

As discussed above, an intermediary client device is capable of operating in the role of a server by receiving requests/sending responses. Based on Petitioner’s

¹⁰ At least because the Board used a different construction for “server” in the 687 IPR, estoppel is not applicable to PO’s arguments in this IPR.

construction, the intermediary client device would use a server operating system.

Petitioner's construction cannot be correct. A POSA would have understood that in the context of the specification, an intermediary client device uses a client operating system, not a server operating system.

For Petitioner's alternative construction, Petitioner has previously argued that a POSA would understand "UNIX" refers to a client operating system. IPR2020-01266, Paper 5 at 29 (PTAB July 14, 2020). Here, however, Petitioner argues that UNIX is a server operating system. Petition at 20. Petitioner's construction cannot be correct in the context of the '826 Patent. Petitioner does not differentiate a client operating system and a server operating system.

It was Petitioner that relied on the Masters reference for its alternative construction. POR at 12-13. Petitioner cannot dispute that Masters refers to a general purpose server operating system employed on **server computer 202**, which a POSA would understand is server hardware. *Id.*

In the Reply, Petitioner refers to Masters' disclosure of "clients 128," but does not explain how Masters' disclosure supports Petitioner's construction for "server operating system"; and regardless, Masters' disclosure does not define "client device" in the context of the '826 Patent. *Contra* Reply at 11.

III. GROUND 1: KOCHERLAKOTA

PO's constructions are correct and should be adopted in this IPR. At least because the Board used different constructions in the 687 IPR, estoppel is not applicable.

A. CLAIM 1[PRE]

The language in the claim 1 preamble of the '826 and '622 Patents is different and Petitioner relies on different evidence in this IPR than the 687 IPR.¹¹ EX. 1002 at ¶¶83-84 and 98-103.

Petitioner's expert opined that "a POSITA would understand that devices on the Internet are addressed by IP address[es]", "proxy 17 must store the IP address of client computer 11," and that "in order to establish sessions with proxies 19 and 21, proxy 17 must store a list of IP addresses associated with proxies 19 and 21". EX. 1002 at ¶¶83 and 103.

PO rebutted Petitioner's evidence and arguments regarding whether proxy 17 "store[s] a list of IP addresses" based on the disclosure of Kocherlakota. POR at 36-39. PO explained that session and permission information are set/stored in the client computer 11. *Id.* The user of client computer 11 will enter the URL, port,

¹¹ For example, the claim 1 preamble of the '826 Patent requires "a first client device that is addressed over the Internet using first Internet Protocol (IP) address".

user name, and password for a proxy in the applet window. *Id.* Petitioner itself admits that Kocherlakota does not disclose identifying each proxy by IP address. Petition at 26, note 11. Petitioner relies on DNS resolution to obtain a corresponding IP address. *Id.* PO explained there is no DNS resolution performed by proxy 17. POR at 38. PO also explained that there is nothing to suggest proxy 17 would store the IP addresses for re-use. *Id.*

Additionally, Petitioner’s citation to Kocherlakota where proxy 17 receives/analyzes the applet information from client computer 11 does not show that proxy 17 performs DNS resolution or stores IP addresses. *Contra* Reply at 13. PO properly rebutted Petitioner’s arguments and evidence. *Contra* Reply at 14.

Ultimately, Petitioner fails to meet its burden.

B. CLAIM 1[A]

Petitioner argues that “the claims do not require a specific operating system” (Reply at 14) which is demonstrably false. The claims require a *server* operating system. As discussed above, Petitioner does not distinguish a server operating system from a client operating system. *See infra*, section II.D.

In both the Petition and Reply, Petitioner fails to establish, or even argue, that Kocherlakota’s proxy 17 is server hardware under PO’s constructions. As such, Petitioner fails to meet its burden under PO’s construction.

C. CLAIM 1[C]

Petitioner fails to meet its burden under the correct construction for the “selecting” term. *See infra*, section II.A. At least because PO’s construction should be adopted in this IPR, and because the claim language is different, estoppel does not apply.

Kocherlakota’s proxy 17 does not make a choice in preference to another or others – the decision as to which proxy server and features are to be used for a particular URL is made by the user of client computer 11. POR at 39-41. Thus, there is only one pre-defined option for proxy 17. *Id.* As made clear by Petitioner’s own expert, “[t]here’s no selecting if there’s only one answer.” EX. 2013 at 50:6-12.

There is no intelligent-decision making by proxy 17 and “routing” by proxy 17 does not satisfy this claim limitation. *Contra* Reply at 17. In the 687 IPR, PO expressly stated that “[a] POSA would understand that ‘selecting’ in the context of the specification is not simply routing a request to a predefined proxy IP address.” IPR2022-00687, Paper 26 at 20 (PTAB May 19, 2023).

D. CLAIMS 2-5, 12, AND 18

Petitioner still fails to explain its inconsistent analysis of the purely role-based constructions, which do not distinguish an intermediary **client device** from an intermediary **server**. POR at 42-43. Petitioner’s expert testified that, for

example, proxy 19 is always “both”. EX. 2006 at 84:14-85:1. This testimony shows that Petitioner’s constructions cannot be correct as they directly contradict the express claim language.

Kocherlakota’s proxies 19 and 21 are not client devices under PO’s constructions. POR at 43-44. In both the Petition and Reply, Petitioner fails to address PO’s constructions. At least because PO’s constructions should be adopted in this IPR, estoppel does not apply. *Contra* Reply at 18.

E. CLAIM 5

The claim language, and claim dependencies, of claim 5 in the ‘826 Patent and claim 7 of the ‘622 Patent are different. The issues are not the same. Estoppel does not apply. *Contra* Reply at 18.

In the Reply, Petitioner fails to address PO’s arguments regarding the inconsistent analysis of claim 5 in the Petition. POR at 44-45. Petitioner fails to meet its burden.

F. CLAIM 18¹²

As discussed above, there is no “selecting” by proxy 17. Moreover, there is no “selecting” as recited in claim 18. POR at 45. For example, in the context of the

¹² Petitioner does not allege estoppel applies to claims 18 and 19 and it does not at least because the claim language is different.

'826 Patent, a POSA would have understood that multiple intermediary client devices may be selected to fetch different chunks (parts) of the requested content. *See, e.g.*, EX. 1001 at 8:31-33; 11:17-24.

Petitioner introduces a new theory in the Reply and appears to now rely on Kocherlakota processing two separate URLs. Reply at 18. The Petition relied on “selecting the IP address of proxy 19 and 21 from the list of those IP addresses to route *the URL* through the proxy chain.” Petition at 43 (emphasis added). The Petition additionally relied on the analysis of claims 1[c] and 1[d] which relate to the alleged “first content identifier”, i.e., the URL (singular). Petition at 43-44.

Petitioner fails to meet its burden and cannot rely on a new theory.

G. CLAIM 19

Petitioner's analysis is inconsistent and uses hindsight bias. POR at 46-47. And PO did/does dispute a POSA would have sent an IP address to the client computer 11 as alleged by Petitioner. *Contra* Reply 18.

As discussed above, the sending occurs *after* the selecting. *See infra*, section II.B. Petitioner fails to meet its burden.

IV. GROUND 2: KOCHERLAKOTA + RFC 1122

The language and dependencies of claims 6-9 of the '826 Patent are different from any of the claims of the '622 Patent. The issues are not the same. Estoppel does not apply. *Contra* Reply at 19.

Petitioner fails to meet its burden in Ground 2. POR at 47-48. PO rebutted Petitioner's arguments and evidence to modify Kocherlakota based on RFC 1122.

*Id.*¹³

In the Reply, Petitioner attempts to shift the burden to Patent Owner. Reply at 19. This is improper. 35 U.S.C. § 316(e).

V. COHEN-BASED GROUNDS 3 AND 4¹⁴

Cohen does not invalidate claim 1 under Petitioner's purely role-based constructions. POR at 48-49. PO has clearly and consistently stated that "operating in the role of a server" does not mean that the proxy redirector 104 is a server in the context of the '826 Patent. *See id.*; *see also* POR at 21-23; EX. 1026 at 67-68.

Petitioner does not show that Cohen invalidates claim 1 under PO's hardware-based constructions either. POR at 49-53. PO has clearly and consistently stated that Cohen's proxy redirector 104 is not a server under PO's constructions. *See id.*; *see also* EX. 1026 at 67-68. PO has made clear that a

¹³ Some of PO's arguments are based on the HTTP Definitive Guide (EX. 1023) which was not an exhibit in the 687 IPR and therefore not considered by the Board in the 687 IPR.

¹⁴ The Board did not evaluate the Cohen-based grounds in the 687 IPR. Estoppel does not apply and Petitioner does not argue otherwise.

router/switch is not a server. This understanding is also consistent with Petitioner's expert's testimony. POR at 50.

Petitioner effectively concedes that Cohen's proxy redirector 104, as disclosed, is not implemented on server hardware. Reply at 21. Petitioner argues, without expert testimony, that a POSA *could have* implemented proxy redirector 104 on server hardware with a server operating system. *See id.* Petitioner does not provide any motivation for a POSA to do so. Petitioner is using hindsight bias and fails to meet its burden. *See, e.g., Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015) (explaining "obviousness concerns whether a skilled artisan not only *could have made* but *would have been motivated to make* the combinations or modifications of prior art to arrive at the claimed invention.") (emphasis in original).

Cohen does not invalidate challenged dependent claims under either set of constructions for additional reasons. POR at 55-57.

A. TEACHING AWAY

PO's teaching away arguments directly relate to the claimed use of a "first server" and the resulting benefits therefrom. POR at 53-55. Petitioner fails to consider each claimed invention as a whole and instead, focuses only on the proposed modifications. Reply at 21-22. A POSA reading Cohen would not arrive at the claimed inventions of the '826 Patent.

A reference may be said to teach away when a POSA, upon reading the reference, “would be led in a direction divergent from the path that was taken by the applicant.” *See, e.g., Millennium Pharm., Inc. v. Sandoz Inc.*, 862 F.3d 1356, 1366 (Fed. Cir. 2017).

PO maintains that a POSA would not arrive at the claimed inventions upon reading Cohen and instead, would be led in a divergent direction at least because Cohen requires every request go through a proxy cache, unbeknownst to the requesting client, and Cohen discourages fetching content directly from the target web server. These teachings are opposite to the claimed inventions.

VI. SECONDARY CONSIDERATIONS

The Board’s findings in the 687 IPR were necessarily specific to the claims of the ‘622 Patent and not the claims of the ‘826 Patent. Also, for at least the reasons discussed above, the Board should adopt PO’s hardware-based constructions in this IPR and analyze secondary considerations under the correct constructions.

VII. ESTOPPEL DOES NOT APPLY AND AT MINIMUM, PO INVOKES THE FAIRNESS EXCEPTION

It is noted that the FWD in the 687 IPR was entered 62 days before the Petition was filed in this IPR. Petitioner had the opportunity to address the Board’s

prior findings in the Petition, but chose not to do so.¹⁵ Petitioner did not even address PO's hardware-based constructions in the Petition and ignored relevant prosecution history statements.

The issues are not the same in the 687 IPR and this IPR at least because there are material differences in the intrinsic record that show PO's constructions should be adopted in this IPR. Estoppel is not applicable.¹⁶ For example, the prosecution history disclaimer in IPR2020-01266 and IPR2020-01358 was not considered in the 687 IPR, but is relevant to determining patentability of the '826 Patent in this IPR. Additionally, the express lexicography in Reissue Application No. 18/523,800 is relevant to determining patentability in this IPR. Finally, the prosecution history disclaimer in the 687 IPR itself is relevant to determining patentability in this IPR.

The Board should deviate from its prior constructions and its prior findings in the 687 IPR because there are compelling reasons to do so. *See infra*.

¹⁵ In fact, Petitioner merely listed the 687 IPR as having an "instituted" status. Petition at 5.

¹⁶ To the extent Petitioner attempts to rely on 37 C.F.R. 42.73(d)(3), that rule does not apply to maintaining an existing claim. *SoftView LLC v. Apple Inc.*, 2024 U.S. App. LEXIS 18472, *13 (Fed. Cir. 2024).

A. FAIRNESS EXCEPTION TO ESTOPPEL

At minimum, PO invokes the fairness exception to estoppel. As explained by the Federal Circuit:

“Preclusion does not apply when: There is a clear and convincing need for a new determination of the issue . . . (b) because it was not sufficiently foreseeable at the time of the initial action that the issue would arise in the context of a subsequent action, or (c) because the party sought to be precluded, as a result of the conduct of his adversary or other special circumstances, did not have an adequate opportunity or incentive to obtain a full and fair adjudication in the initial action.”

Oren Techs., LLC v. Proppant Express Invs. LLC, 2021 U.S. App. LEXIS 21859, *8 (Fed. Cir. 2021) (internal citation omitted). “The purpose of the equitable exceptions to issue preclusion is to serve the twin goals of fairness and efficient use of private and public litigation resources... The exceptions assure fairness and flexibility as circumstances warrant.” *Id.* at *8-9 (internal citation omitted).

1. This IPR was not foreseeable

It was not foreseeable that Petitioner would challenge another unasserted patent in this IPR for at least three reasons.

First, PO relied on the prosecution history disclaimer in at least the 687 IPR to resolve any claim construction disputes.

Second, on 11/29/2023, PO filed the reissue application based on the ‘622 Patent. On the same day, PO filed updated mandatory notices in the 687 IPR

putting Petitioner on notice of express lexicography. *See* IPR2022-00687, Paper 39 (PTAB Nov. 29, 2023). As discussed below, PO was trying to be efficient of court and party resources. In view of at least the express lexicography in the reissue application, it was not foreseeable that Petitioner would file the Petition in this IPR based on the purely role-based constructions.

Third, many FWD in related IPRs¹⁷ with overlapping claim construction issues were all appealed to the Federal Circuit by 9/27/2023 and fully consolidated on 10/3/2023.¹⁸ The Federal Circuit is expected to decide the correct claim constructions for “client device” and “server”. It was not foreseeable that Petitioner would file another IPR with overlapping claim construction issues before the Federal Circuit reaches its decision.

¹⁷ IPR2022-00103, IPR2022-00135, IPR2022-00138, IPR2022-00353, IPR2022-00915, IPR2022-00916, IPR2021-01492, IPR2022-00861, IPR2021-01493, and IPR2022-00862.

¹⁸ The IPRs on appeal involved the same patents or the same prior art references. The IPRs on appeal also relied on the same product, PO’s residential proxy services, for secondary considerations analysis. None of the IPRs involved the ‘622 Patent, Kocherlakota, Cohen, or relied on secondary considerations analysis for PO’s data center proxy services.

For at least these reasons, this IPR was not foreseeable.

2. PO lacked incentive to appeal the FWD in the 687 IPR

Additionally, PO lacked incentive to appeal the FWD in the 687 IPR for at least three reasons.

First, the ‘622 Patent was/is an unasserted patent. *See, e.g., Soverain Software LLC v. Victoria's Secret Direct Brand Mgmt., LLC*, 778 F.3d 1311, 1316 (Fed. Cir. 2015) (explaining there is a lack-of incentive to litigate when the stakes are so small that extensive effort is not reasonable).

Second, as emphasized by the Board (EX. 1028 at 59, note 6), PO was able to file a reissue application after the FWD in the 687 IPR.

Third, given the timing of the consolidated Federal Circuit appeals, PO chose to file a reissue application instead of another appeal.¹⁹ The 687 IPR involved a different patent and different references than the IPRs on appeal. In the 687 IPR, PO also relied on a different product for secondary considerations analysis than the IPRs on appeal. PO believed that filing a reissue application was the most efficient use of court and party resources, particularly given that the ‘622 Patent was/is an unasserted patent.

¹⁹ *See infra*, notes 17 and 18.

For at least these reasons, PO lacked incentive to appeal the FWD in the 687 IPR and instead chose to file a reissue application.

VIII. CONCLUSION

For at least the reasons discussed in the POR and this Sur-reply, Petitioner fails to meet its burden.

Respectfully submitted,

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CERTIFICATE OF COMPLIANCE

This paper consists of 5,550 words, which is no more than 5,600 words, and complies with the type-volume 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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CERTIFICATE OF SERVICE

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