

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 REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

I. INTRODUCTION.....	1
II. LEGAL STANDARD FOR DIRECTOR REVIEW	2
III. BACKGROUND OF THE CHALLENGED PATENT.....	2
IV. ARGUMENT	4
A. THE ONLY REQUIREMENT FOR PROSECUTION HISTORY DISCLAIMER IS A CLEAR AND UNMISTAKABLE STATEMENT BY THE PATENTEE/APPLICANT	4
1. The patentee/applicant is bound by disclaimer in later proceedings even without commentary by the PTAB or the Examiner.	5
2. The public notice function of disclaimer is satisfied without commentary by the PTAB or the Examiner.	5
3. Different panels have different requirements for disclaimer which necessitates clarification by the Director.	7
B. PO DISCLAIMED BROADER CONSTRUCTIONS FOR THE “CLIENT DEVICE” AND “SERVER” TERMS	7
1. Disclaimer in related IPR preliminary responses binds and protects the PO in this IPR.....	9
2. Disclaimer in related IPR patent owner responses binds and protects the PO in this IPR.....	11
3. Disclaimer in related reissue application binds and protects the PO in this IPR.....	12
C. PO DISCLAIMED A BROADER CONSTRUCTION FOR THE “SELECTING” PHRASE	13
V. CONCLUSION	15

TABLE OF AUTHORITIES

Cases

<i>Aylus Networks, Inc. v. Apple Inc.</i> , 856 F.3d 1353 (Fed. Cir. 2017)	4, 6
<i>CUPP Computing AS v. Trend Micro Inc.</i> , 53 F.4th 1376 (Fed. Cir. 2022).....	4
<i>Nikon Corp., et al. v. Optimum Imaging Technologies LLC</i> , IPR2024-01372, Paper 17 (PTAB Apr. 23, 2025).....	7
<i>Omega Eng’g, Inc. v. Raytek Corp.</i> , 334 F.3d 1314 (Fed. Cir. 2003).....	4, 6, 11

Regulations

37 C.F.R. § 42.75	1
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I. INTRODUCTION

Pursuant to 37 C.F.R. § 42.75¹, Patent Owner Bright Data Ltd. (“PO”) respectfully requests Director Review of the Final Written Decision (“FWD,” Paper 25) in IPR2024-00126 for at least three reasons:

First, this paper presents an important issue of law/policy regarding whether prosecution history disclaimer requires commentary from the PTAB or the Examiner. PO submits the answer is “no” because the only requirement for prosecution history disclaimer is a clear and unmistakable statement by the patentee/applicant. As further explained below, if a patentee makes a clear and unmistakable statement in an IPR preliminary response narrowing the scope of a claim, the patentee is bound by the narrowing statement in later proceedings. The narrowing statement in an IPR preliminary response satisfies the public notice function underpinning disclaimer, even when there is no commentary from the PTAB due to, for example, discretionary denial of institution.

Second, the panel abused its discretion in the FWD by disregarding prosecution history disclaimer narrowing the scope of the “client device” and

¹ This request is timely submitted within 30 days of entry of the FWD and the fee set forth in 37 C.F.R. § 42.15(f) is concurrently submitted herewith.

“server” terms, which refer to different types of hardware. PO consistently and repeatedly rejected the broader constructions adopted by the panel in the FWD.

Third, the panel abused its discretion in the FWD by disregarding prosecution history disclaimer narrowing the scope of the “selecting” phrase. The panel did not analyze PO’s disclaimer in the parent prosecution history and the panel entirely ignored PO’s disclaimer in the related IPR.

II. LEGAL STANDARD FOR DIRECTOR REVIEW

“Requests for Director Review of a Board’s final decision under 35 U.S.C. §§ 135, 318, or 328... shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law.” Director Review Process § 2(B).²

III. BACKGROUND OF THE CHALLENGED PATENT

Patent No. 11,616,826 (“’826 Patent,” EX. 1001) contains 25 claims with only claim 1 being independent.³ Claim 1 is reproduced below with annotations:

[1 preamble] A method for use with a web server that stores a first content identified by a first content identifier, and for use with a first client device that is addressed over the Internet using first Internet Protocol (IP) address, for use with a list of IP addresses stored in the first server, the method by the first server comprising:

[1a] storing, operating, or using, a server operating system;

² <https://www.uspto.gov/patents/ptab/decisions/director-review-process>

³ The ’826 Patent has never been involved in district court litigation.

- [1b] receiving, from the first client device, the first content identifier;
- [1c] selecting, an IP address from the list according to a criterion;
- [1d] sending, in response to the receiving of the first content identifier, using the selected IP address, the first content identifier;
- [1e] receiving, in response to the sending of the first content identifier, the first content from the web server; and
- [1f] sending the received first content, or a part thereof, to the first client device.

As shown above, claim 1 recites a method performed by the “first server” within a “first client device” ↔ “first server” ↔ “web server” architecture. Paper 13 at 2. A person of ordinary skill in the art (“POSA”) would have understood that the “first client device” may correspond to a requesting client device and that the “first server” may correspond to an intermediary proxy server. *Id.* The “first server” stores a list of IP addresses, selects an IP address from the list, and uses the selected IP address to obtain content from the web server.

A POSA would have understood that there may be additional intermediaries located between the “first server” and the “web server.” Paper 13 at 3. For example, dependent claims 2-4 make clear that the selected IP address corresponds to a “second client device” in a “first client device” ↔ “first server” ↔ “second client device” ↔ “web server” architecture. *Id.* at 3-4. A POSA would have understood that this architecture involves an intermediary proxy **server** and an intermediary proxy **client device**. *Id.* at 4 (emphasis original).

IV. ARGUMENT

A. THE ONLY REQUIREMENT FOR PROSECUTION HISTORY DISCLAIMER IS A CLEAR AND UNMISTAKABLE STATEMENT BY THE PATENTEE/APPLICANT

Consistent with Federal Circuit precedent, PO submits that a clear and unmistakable statement by the patentee/applicant is sufficient to find disclaimer narrowing the scope of a claim in later proceedings. *See, e.g., Aylus Networks, Inc. v. Apple Inc.*, 856 F.3d 1353, 1359-1361 (Fed. Cir. 2017) (requiring a “clear and unmistakable” statement) (citing *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F.3d 1314, 1325-1326 (Fed. Cir. 2003)); *CUPP Computing AS v. Trend Micro Inc.*, 53 F.4th 1376, 1383 (Fed. Cir. 2022) (finding that “disclaimer in an IPR proceeding is binding in later proceedings, whether before the PTO or in court”).

PO submits that disclaimer does not require commentary from the PTAB or the Examiner. Contrary to the FWD, there is no requirement that disclaimer be accepted or expressly considered by the Board or the Examiner. FWD at 26 (“Patent Owner’s arguments [in related IPRs that were discretionarily denied institution] were made in the context of a contested proceeding and were never accepted or even considered by the Board.”); FWD at 28 (“Patent Owner’s arguments in the Reissue Application have not yet been considered by the Examiner.”). The Director’s clarification on whether prosecution history disclaimer requires commentary from the PTAB or the Examiner is an important issue of law/policy that significantly impacts patentees, the public, and other PTAB panels.

1. The patentee/applicant is bound by disclaimer in later proceedings even without commentary by the PTAB or the Examiner.

If a patentee makes a clear and unmistakable statement in an IPR preliminary response narrowing the scope of a claim, PO submits that alone is sufficient to find prosecution history disclaimer.

It is possible that the IPR is discretionarily denied institution such that the PTAB never expressly considers the patentee's narrowing statement in a merits-based analysis. PO submits that the patentee is bound by disclaimer regardless of whether or not the IPR was discretionarily denied institution.

A PTAB panel cannot impose additional requirements on disclaimer beyond a clear and unmistakable statement by the patentee/applicant. If the patentee makes a clear and unmistakable statement, the patentee is bound (and protected) by its narrowing statements in later proceedings. The same logic must be true for applicants in regular prosecution. If an applicant makes a clear and unmistakable statement in a preliminary amendment or other remarks, the applicant is bound (and protected) by its narrowing statements in later proceedings.

2. The public notice function of disclaimer is satisfied without commentary by the PTAB or the Examiner.

If a patentee/applicant makes a clear and unmistakable statement narrowing the scope of a claim in an official paper filed with the USPTO, then the public is on notice of the narrowing statement and the patentee/applicant is thereafter estopped

from asserting broader claim scope in later proceedings. The patentee is bound by the disclaimer even when there is no commentary by the PTAB or the Examiner.

“As a basic principle of claim interpretation, prosecution disclaimer promotes the public notice function of the intrinsic evidence and protects the public's reliance on definitive statements made during prosecution.” *Omega*, 334 F.3d at 1324 (citations omitted). As further explained by the Federal Circuit:

“A patent owner's preliminary response filed *prior* to an institution decision and a patent owner's response filed *after* institution are both official papers filed with the PTO and made available to the public. In both official papers, **the patent owner can define claim terms and otherwise make representations about claim scope to avoid prior art** ... Regardless of when the statements are made during the proceeding, the public is ‘entitled to rely on those representations when determining a course of lawful conduct, such as launching a new product or designing-around a patented invention.’”

Aylus, 856 F.3d at 1362 (italics original; emphasis added; citation omitted). The Federal Circuit has found that a narrowing statement in an IPR preliminary response can rise to the level of disclaimer and satisfy the public notice function. *Id.* An IPR may be discretionarily denied institution without the PTAB expressly considering the narrowing statement. However, commentary by the PTAB is not necessary for competitors to rely on the narrowing statement and estop the patentee from broadening claim scope in later proceedings.

3. Different panels have different requirements for disclaimer which necessitates clarification by the Director.

As noted above, the panel in this IPR interpreted disclaimer as requiring acceptance or express consideration by the PTAB or Examiner. FWD at 26, 28. PO respectfully disagrees with the panel's interpretation because the only requirement for disclaimer is a clear and unmistakable statement by the patentee/applicant.

Other panels have also attempted to impose additional requirements on disclaimer. For example, one other panel found that a patentee's statements in a related IPR preliminary response did not rise to the level of disclaimer because the PTAB did not: (a) adopt that construction in the institution decision in the related IPR, (b) issue a final written decision adopting that construction in the related IPR, or (c) determine the challenged claims were patentable based on that construction. *Nikon Corp., et al. v. Optimum Imaging Technologies LLC*, IPR2024-01372, Paper 17 at 33 (PTAB Apr. 23, 2025). PO respectfully disagrees with that other panel's interpretation of disclaimer.

Because PTAB panels are interpreting the requirement(s) for disclaimer differently, PO respectfully requests clarification from the Director.

B. PO DISCLAIMED BROADER CONSTRUCTIONS FOR THE “CLIENT DEVICE” AND “SERVER” TERMS

The panel abused its discretion in the FWD by disregarding prosecution history disclaimer narrowing the scope of the “client device” and “server” terms. In addition to supporting citations to the specification, the prosecution history, and the

express claim language, PO made three disclaimer arguments regarding (1) related IPR preliminary responses, (2) related IPR patent owner responses, and (3) disclaimer in a related reissue application. Paper 13 at 13-35; Paper 21 at 5-13.

Across various USPTO proceedings involving related patents, PO has consistently stated that these terms have hardware-based constructions where “client device” means “consumer computer” and “server” means “server that is not a client device.” Paper 13 at 13-35; Paper 21 at 5-13.⁴ PO made clear that the “client device” and “server” terms refer to different types of hardware. *Id.* However, in the FWD, the panel applied role-based constructions where a client device is any component that is capable of operating in the role of a client by sending requests/receiving responses; and a server is any component that is capable

⁴ Despite being on notice of PO’s disclaimer due to Petitioner’s involvement in related IPRs, Petitioner did not address PO’s hardware-based constructions in this IPR. Petitioner alleged and the panel concluded that Kocherlakota’s proxy server 17 corresponds to the “first server” and Kocherlakota’s proxy servers 19/21 correspond to the “second client device.” Paper 1 at 28, 36; FWD at 50-52. In the context of the ’826 Patent, it is an abuse of discretion to label one proxy server a “server” and another proxy server a “client device.” Paper 13 at 42-44.

Kocherlakota’s proxy servers 17/19/21 are all the same type of server hardware.

of operating in the role of a server by receiving requests/sending responses. *See*, e.g., FWD at 11-29 (claim construction), 46-48 (analyzing claim 1[d]), 50-52 (analyzing dependent claims).

The panel abused its discretion by applying role-based constructions in the FWD when the role-based constructions have been repeatedly disclaimed by PO. It is unambiguous that the '826 Patent claims use narrower, hardware-based constructions to distinguish the “client device” and “server” terms.

1. Disclaimer in related IPR preliminary responses binds and protects the PO in this IPR.

In briefing, PO highlighted two related IPR preliminary responses that were discretionarily denied institution over two years before the '826 Patent issued and before the petition in this IPR was filed. Paper 13 at 19-20. PO's statements in the related IPR preliminary responses unambiguously support PO's hardware-based constructions and reject Petitioner's role-based constructions for the “client device” and “server” terms.⁵

In those related IPR preliminary responses, PO stated “client device” means “consumer computer.” Paper 13 at 20 (citing EX. 2050 at 21-22). PO made clear that a client device is not a server and a server is not a client device. *Id.* (citing EX.

⁵ PO notes it was the same petitioner in the related IPRs and in this IPR. EX. 2050 at 1; EX. 2051 at 1; Paper 1 at 2.

2050 at 18-20, 25). PO explained that the specification distinguishes between proxy client devices and proxy servers. EX. 2050 at 14-15, 19-20.

Moreover, in those related IPR preliminary responses, PO expressly rejected a role-based interpretation of the claim terms. Paper 13 at 20. PO stated:

“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 ... under Petitioners’ theory the [proxy] 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.’”

EX. 2050 at 25 (*italics original*; citation omitted).

In the FWD in this IPR, the panel applied the very role-based constructions that PO disclaimed in the related IPR preliminary responses. *See, e.g.*, FWD at 14, 46-48 (analyzing claim 1[d]), 50-52 (analyzing dependent claims). The panel did not construe “client device” as “consumer computer” despite PO’s clear and unmistakable statement in the related IPR preliminary responses. *Id.* The panel did not distinguish between proxy client devices and proxy servers. *Id.*

For at least these reasons, PO submits that the panel abused its discretion by disregarding PO’s disclaimer. FWD at 26-27. As discussed below, PO repeatedly disclaimed the role-based constructions and made clear that the claim terms refer to different types of hardware.

2. Disclaimer in related IPR patent owner responses binds and protects the PO in this IPR.

In briefing, PO provided a non-exhaustive list of nine related IPR patent owner responses where PO argued for narrower, hardware-based constructions and PO argued against broader, role-based constructions. Paper 21 at 6. All of those related IPR patent owner responses were filed before the '826 Patent issued and before the petition in this IPR was filed. *Id.* There can be no dispute that that the public was on notice of PO's disclaimer of the broader role-based constructions regarding the scope of the '826 Patent claims.

Like in *Omega*, “[PO] repeatedly insisted that its invention differed from the prior art... the patentee has rejected the examiner's broad assessment of the claim scope and stated in a public record what his invention could not be. That statement is a deliberate surrender of claim scope, unmistakable in its effect because it is not suitable to multiple interpretations.” *Omega*, 334 F.3d at 1327.

In the FWD, the panel stated that PO's arguments regarding disclaimer in the related IPR patent owner responses are “conclusory and undeveloped.” FWD at 27. PO respectfully disagrees. In this IPR, PO consistently repeated the same arguments for the same constructions as in the related IPRs **and PO further added additional citations to the intrinsic record** that were not previously considered in the related IPRs. Paper 21 at 6-7. The panel abused its discretion by disregarding PO's disclaimer, consistently repeated across various USPTO proceedings.

3. Disclaimer in related reissue application binds and protects the PO in this IPR.

In briefing, PO highlighted a reissue application that was filed before the petition in this IPR. Paper 21 at 7-8. In the preliminary amendment for that reissue application, PO unambiguously stated:

“Applicant expressly notes for purposes of clear lexicography that the current claims recite the terms “client device” and “first server”. To be clear, Applicant understands “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 skilled in the art, and which is different from a client device, a router, or a switch.”

EX. 2048 at 13-14. PO again put the public on notice of PO’s hardware-based constructions for the “client device” and “server” terms.

In the FWD, the panel stated that PO’s statements in the reissue application “appear to leave open the meaning” of a “first server”. FWD at 28. PO respectfully disagrees. PO provided a clear and unmistakable statement regarding claim scope in the reissue application. Paper 21 at 7-8. PO stated that the “client device” is a “consumer computer” and that the “first server” is a “server, which is a type of hardware component as understood by persons skilled in the art, and which is different from a client device, a router, or a switch.” *Id.* A POSA would have understood that, in the context of the ‘826 Patent, the claim terms refer to different types of hardware, known to have different attributes. *See, e.g.*, Paper 13 at 23-25.

To the extent the panel relied on the fact that PO's statements in the reissue application "have not yet been considered by the Examiner" (FWD at 28,) PO requests that the Director provide clarification on the requirement(s) for disclaimer as discussed above. *See supra*, section IV.A. PO submits that the statements in the reissue application are clear and unmistakable and therefore qualify as disclaimer without any express consideration by the Examiner.

For at least these reasons, the panel abused its discretion and the FWD should be vacated.

**C. PO DISCLAIMED A BROADER CONSTRUCTION FOR THE
"SELECTING" PHRASE**

The panel abused its discretion in the FWD by disregarding prosecution history disclaimer for the "selecting" phrase in claim 1[c]. The panel did not analyze PO's disclaimer in the parent prosecution history and the panel entirely ignored PO's disclaimer in the related IPR. FWD at 7-10 (claim construction), 43-46 (analyzing claim 1[c]).

In briefing, PO argued that "selecting, an IP address" means "making a choice in preference to another or others." Paper 13 at 7-9; Paper 21 at 2-4. PO explained that "selecting" requires some intelligent decision-making, for example, to determine the numerical closeness of the IP addresses in the list relative to the web server. *Id.* PO further explained that "selecting" is not simply routing a request to a predefined proxy IP address. Paper 13 at 40; Paper 21 at 17.

First, PO argued disclaimer in the prosecution history of the parent patent. Paper 13 at 9. During prosecution of the parent patent, PO stated the cited Yu reference did not teach a server performs the “selecting” and PO disclaimed predefined selection by the requesting client device. EX. 1008 at 128 (“In fact, the Yu reference teaches away from any selecting by any server... the selecting is made in the requesting client device.”) (underline original). Similarly, in this IPR, PO distinguished the Kocherlakota reference because there is no selecting by proxy server 17, the selecting is made by the user of client computer 11 and predefined. Paper 13 at 39-41. The panel did not analyze this disclaimer argument in the FWD.

Second, PO argued disclaimer in a related IPR. Paper 21 at 3-4, 17. In the related 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.” Paper 21 at 17. PO disclaimed a broader interpretation of the “selecting” phrase and made clear that in the context of the common specification, “selecting” an IP address requires intelligent decision-making. Paper 21 at 3 (citing EX. 1026 at 48-49). The panel entirely ignored this disclaimer argument in the FWD.

In the FWD, the panel rejected PO’s arguments for “a requirement that the selection of the IP address cannot be predefined” and “a requirement of ‘intelligent decision-making’ in the selection of the IP address.” FWD at 46. The panel cannot

be correct. PO's disclaimer in at least the related IPR unambiguously narrowed the scope of the "selecting" phrase and put the public on notice of the scope of the "selecting" phrase in the '826 Patent.

For at least these reasons, the panel abused its discretion and the FWD should be vacated.

V. CONCLUSION

For at least the reasons discussed herein, the Director should vacate the FWD and remand to the panel with instructions to analyze the obviousness allegations under PO's narrower constructions for the disputed terms.

Respectfully submitted,

Date: July 11, 2025

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CERTIFICATE OF COMPLIANCE

This paper consists of no more than 15 pages and complies with the applicable formatting requirements of 37 C.F.R. § 42.6(a). 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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