

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 11,616,826

**PETITIONER'S RESPONSE TO
PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW**

This is the *tenth*¹ proceeding in which the Board rejected PO's attempt to define the terms "client device" and "server" in a way the specification does not support. *See* FWD, 17-20; Reply, 4-6. In IPR2022-00687, the Board invalidated nearly identical claims and rejected PO's constructions of the terms in PO's Request. *See* Reply, 1-3. PO did not appeal and is now estopped from re-litigating the issue here. *See id.* Even if PO were not estopped, its arguments fail. At base, PO contends that it should be allowed to amend its claim scope simply by repeatedly urging a faulty construction. But that defies both the law and logic. First, PO has not identified a "clear and unmistakable" disclaimer. PO instead points to statements (1) encouraging discretionary denial and (2) seeking adjudication of its proposed constructions. Second, PO's proposed constructions do not *disclaim* a portion of a proper scope under the plain meaning. Rather, they attempt to *capture* a different scope the Board repeatedly rejected as lacking specification support. FWD, 17-19.

Ultimately, PO seeks to do by disclaimer what it could not do by amendment. But PO's desire to obtain claim scope to avoid prior art, particularly where that scope lacks written description support, does not present an important issue of law or policy. PO also recently raised this same argument on appeal, so the Federal Circuit is already weighing the issue. The request for Director Review should be denied.

¹ *See also* IPR2021-01492, -01493; IPR2022-00103, -00135, -00138, -00353, -00915, -00916, -00687.

I. PO DOES NOT MEET ITS BURDEN TO ESTABLISH DISCLAIMER

A. PO Does Not Identify Any “Clear and Unmistakable” Statements

A “party seeking to invoke prosecution history disclaimer bears the burden of proving the existence of a ‘clear and unmistakable’ disclaimer that would have been evident to one skilled in the art.” *Trivascular, Inc. v. Samuels*, 812 F.3d 1056, 1063-64 (Fed. Cir. 2016). PO cites three areas of the record. Req. 8. None is persuasive.

First, PO cites to its sur-reply (which could not raise new arguments) as including a “non-exhaustive” “list” of IPRs purportedly demonstrating “multiple examples of disclaimer and lexicography.” Paper 26, 11 (citing Paper 21, 6). The Board correctly rejected this list of proceedings—with no citations to specific passages—as “conclusory and undeveloped.” FWD, 27. Beyond this procedural failure, aside from IPR2020-1266 and -1358 discussed below, in every other cited proceeding the Board considered *and rejected* PO’s construction. This includes IPR2022-00687 in which the Board rejected PO’s proposed constructions of the terms “selecting,” “client device,” and “first server.” *See* EX1028, 26, 36; Sur-Reply, 3, 6 (PO conceding the “Board did not find sufficient evidence to interpret the ‘622 Patent to include this requirement”). The Federal Circuit has confirmed such rejection negates any purported disclaimer: “Because the Board rejected the Patent Owner’s arguments regarding the meaning of [the claim terms], the record before the Patent Office clearly put the public on notice that the meaning of [the

claim terms] with respect to [PO's] Patents is not limited to [the proposed construction that was rejected by the Board].” *Galderma Labs., L.P. v. Amneal Pharms. LLC*, 806 F. App'x 1007, 1010-1011 (Fed. Cir. 2020).

Second, PO points to its POPRs in IPR2020-1266 and -1358 (both discretionarily denied) where PO urged that “the Board *should decline to institute because the Court* has already addressed and *will soon be further addressing a number of the exact same [claim construction] issues* before the Board.” EX2050, 21 (emphasis added). PO continued that “*should the Board decide to proceed* and to address claim construction, Patent Owner provides the following proposed constructions” *Id.* 21-23 (emphasis added). The Board in those proceedings accepted PO's urging and denied on discretionary grounds. These are not clear and unmistakable statements disavowing claim scope; rather, the statements are ambiguous in at least two ways. First, PO urged a procedural action and encouraged the Board to *not* address the merits. Second, PO at most requested adjudication of claim constructions rather than expressly disclaiming any particular scope. *See Cupp Computing AS v. Trend Micro Inc.*, 53 F.4th 1376, 1383-84 (Fed. Cir. 2022) (distinguishing “the adjudicatory nature of IPR proceedings” from the “a specialized process for patentees to amend their claims in an IPR,” which PO did not use). “Even if an isolated statement appears to disclaim subject matter, the prosecution history as a whole may demonstrate that the patentee committed no clear and

unmistakable disclaimer.” *Elbex Video, Ltd. v. Sensormatic Elecs. Corp.*, 508 F.3d 1366, 1372-73 (Fed. Cir. 2007). When the Board did adjudicate PO’s constructions in later proceedings on those patents, it rejected them time and again as noted above.

Finally, the Board squarely addressed the reissue application PO cites and concluded that it was ambiguous as it “appear[s] to leave open the meaning, for instance, of a ‘first server’ to be a ‘server’ as would be understood by ‘persons [of] skill in the art.’ D.I., 28. Such ambiguity cannot support prosecution disclaimer. *CUPP*, 53 F.4th at 1382. Thus, PO cannot meet its burden to establish disclaimer.

B. PO Does Not Identify Any “Narrowing” of the Plain Meaning

The “doctrine of prosecution disclaimer” “narrows the ordinary meaning of the claim congruent with the scope of the surrender.” *Omega Eng’g, Inc. v. Raytek Corp.*, 334 F3d 1314, 1328 (Fed. Cir. 2003). Disclaimer therefore starts from the plain meaning to which the PO would have otherwise been entitled and *narrows* that scope by surrender. But that is not what PO demands. Rather than disavowing part of the proper scope, PO seeks to *capture* a different, unsupported scope. The Board expressly determined “that the ’826 Patent Specification fails to provide sufficient support for [PO’s] construction for “first server.” FWD, 20. Thus, PO’s proposed construction does not narrow the plain and ordinary meaning, but would instead capture claim scope that was not available by amendment. No case law supports this

absurd result. *See, e.g., Elbex*, 508 F.3d at 1372-73 (finding no disclaimer under a set of facts including “the absence of support in the specification or drawings”).

II. PO DOES NOT IDENTIFY ANY IMPORTANT ISSUE OR REASON WHY REVIEW WOULD BE A PRODUCTIVE USE OF RESOURCES

PO purports to create a legal issue by accusing the Board of “requiring acceptance or express consideration by the PTAB or Examiner” as a legal requirement of disclaimer. Req., 7. This mischaracterizes the FWD. The Board noted the lack of consideration of claim construction in those proceedings as a factual matter in concluding no unambiguous disclaimer. FWD, 26. The Board’s analysis is consistent with *Cupp*, which emphasized “the adjudicatory nature of IPR proceedings.” 53 F.4th at 1383-84. Here, the Board reasonably interpreted PO’s proposal of constructions as seeking adjudication rather than surrendering scope.

In any event, Director Review in this proceeding would not be a productive use of resources. PO should be estopped here based on its failure to appeal the final written decision in IPR2022-00687, and PO separately raised this same argument in Federal Circuit Case No. 23-2144 (argued June 2025, presently under submission). The Federal Circuit will either finally reject or accept the argument without the need for separate consideration here. PO’s Request should thus be denied.

Dated: July 18, 2025

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e) and 37 C.F.R. § 42.105(a), the undersigned certifies that on July 18, 2025, a complete copy of this Petitioner's Response to Patent Owner's Request for Director Review was served on Patent Owner via email (by consent) at:

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