

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,

Petitioner

v.

UMBRA TECHNOLOGIES LTD.,

Patent Owner

IPR2024-00270

U.S. Patent No. 11,108,595

**PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW
OF PANEL DECISION GRANTING INSTITUTION**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
Submitted Electronically via PTAB E2E

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I. INTRODUCTION

Patent Owner UMBRA Technologies Ltd. (“Patent Owner”) respectfully request that the Director vacate the Board’s Preliminary Decision (“Decision”) granting institution of *inter partes* review of U.S. Patent No. 11,108,595 (“the ’595 patent”) and deny review. Vacatur is warranted in view of the Board Panel’s abuse of discretion. See Revised Interim Director Review Process §§ 4.B, 5.A.¹ The Panel makes a critical error by conflating a request for “services” with a request for “list”. This error resulted in the Panel finding a reasonable likelihood that the Petitioner would prevail on its asserted grounds of unpatentability with respect to at least one of claims 15–20 of the ’595 patent in view of a primary prior reference known as “Hankins” (Ex. 1005).

II. BACKGROUND

Here is the language of claim 15 of the ’595 patent, which the Panel found illustrative, with relevant portions emphasized:

[15.0] A network system for managing a global virtual network, comprising:

[15.1] an access point server configured to connect to one or more endpoint devices via one or more first tunnels; and

[15.2] a control server connected to the access point server via a second tunnel, the control server storing one or more records associated with each of the one or more endpoint devices,

¹ Available online at <https://www.uspto.gov/patents/ptab/decisions/revised-interim-director-review-process>.

[15.3] wherein *the control server is configured to:*

receive a request for a list of available servers from a first endpoint device among the one or more endpoint devices, *the list of available servers including the access point server;*

[15.4a] *retrieve the list of available servers;*

[15.4b] retrieve the one or more records associated with the first endpoint device;

[15.5] *dynamically order the list of available servers for the first endpoint device* based on the one or more records associated with the network device; and

[15.6] *transmit the ordered list of available servers to the first endpoint device.*

Ex. 1001 34:4-24.²

III. THE PANEL CONFLATES THE CLAIMED REQUEST FOR A “LIST” WITH A NON-CLAIMED REQUEST FOR “SERVICES”

A. The Record Shows that a General Request for “Services” from a Server Is Not the Same As a Specific Request for “a List of Available Servers”

The Panel makes a fatal error warranting vacatur by acquiescing to a flawed assertion by Petitioner. Specifically, Petitioner asserted that the ’595 patent’s claimed “*request for a list of available servers ... including the access point server*” is the same as the unspecified disclosure of a “*request [for] services*” from Hankins. There is no factual or technical basis in the record to conclude that “a request for a list of available servers ... including the access point server” is the

² Unless otherwise specified, all emphasis herein is added.

same as the cited “request [for] services” in Hankins. This error warrants vacatur and denial of review.

The Panel fails to point to any disclosure in Hankins to suggest that “request[ing] services” yields “a list of available servers”. Instead, the Decision simply quotes the Petition’s flawed attempt to make relevant an example from Hankins, wherein a gateway “*may request services available*” from another gateway. (Dec. at 16 (citing Pet. at 45).) The Decision then points to the: “First Annotated Figure 2 of Hankins, which [Petitioner] argues shows ‘tunnel servers 360 and 370 can be used to establish communications between gateway 311 and 321.’” (*Id.* (quoting Pet. at 45-46).)

Neither of these examples addresses a request for “a list of available servers”; instead, they address a request for “services”. Moreover, the second example is in Petitioner’s own “annotated” words, not that of Hankins. Hankins never discloses an option to select from *either* “tunnel server one 360” *or* “tunnel server two 370,” as Petitioner implies. Rather, the first mention in Hankins of “tunnel server two 370” explains that this server 370 is *in addition to—not instead of*—server 360:

A path or channel for communications may potentially be enhanced by controller 350 provisioning an additional tunnel server Controller 350 may provision tunnel server two 370. . . . Controller 350 may therefore initiate instructions to gateway devices 311, 321, 331, and 341 to additionally initiate communications with tunnel server two 370, while also continuing to be in communication with tunnel server one 360

Ex-1005 at 25:15-26.

The distinction between the '595 patent's claimed request for a "*list*" and Hankins disclosed request for "*services*" is not trivial. The "*list*" is repeatedly referenced throughout claim 15 of the '595 patent. It is the subject of the request that is "*receive[d]*" by the control server from a first endpoint device. It is what is "*retrieve[d]*" by that control server. It is what is "*dynamically order[ed]*" by that control server. And it is, once ordered, what is "*transmit[ted]*" by that control server back to the first endpoint device issuing the initial request for the list. (Ex. 1001 at 34:12-24.) One could not simply substitute the word "*services*" in place of "*list*" in claim 15 of the '595 patent and yield a claim that would make any reasonable sense.

The Panel also cites approvingly to Petitioner's bald assertion—without actual support—that a POSITA would equate a request for "*services*" with a request for "*a list of available servers*":

Thus, a POSITA understood that a request from gateway 311 for services available from gateway 321 is a request for available tunnel servers that can provide a tunnel between gateway 311 and 321. This is consistent with the disclosure of the '595 Patent that when a device makes a request to a server, what it is really asking for is a list of available servers, and specifically an IP and port which it could utilize to in the build a tunnel.

Pet. at 46 (cited by Dec. at 18). As explained below, the teachings of the '595 patent cannot be used as a roadmap to reconstruct the prior art.

Other than the aforementioned reliance on the teachings of the '595 patent,

the Panel provides no rationale for equating the claimed request for options via a “*list of available servers*” with the request for the actual provisioning of “*services*” from a server. In fact, Petitioner’s expert explains the ‘*available server list request*’ in the context of ’595 patent as a: “custom-made ***list*** of IP addresses and ports . . . [which] are contextually designed to provide ***best options*** for endpoint devices to utilize.” Ex. 1003 at ¶ 48 (citing EX-1001 27:20-31). By contrast, Hankins defines “***services***” very generally as: “. . . ***provisioning*** a capability for use, such as via a particular private network, which may, for example, include provisioning of resources and/or applications for use.” EX-1005 16:11-15 (emphasis added).

In sum, there is no factual or technical basis in the record to conclude that the ’595 patent’s claimed “***request for a list of available servers***” is the same as Hankin’s “***request*** [for] **services**”. This conflation error, alone, warrants vacatur and denial of review.

B. The Panel Improperly Relies on the Teachings of the ’595 Patent as a Roadmap to the Claimed Invention

The Panel’s conflation of “*list*” with “*services*” appears to stem from another error the Panel made. The Panel determined that the unspecified “*request [for] services*” recited in Hankins necessarily constitutes “*a request for a list of available servers*,” based on statement the Panel misquotes from the ’595 patent. Here is the Panel’s erroneous statement:

At this stage there does not appear to be material difference between Hankins’s gateway device 311 making a “request” for available services from another gateway device 321, which results in controller 350 providing a “list of available servers,” and gateway device 311 making a direct “request” to controller 350 for a “list of available servers. Limitation 15.3 recites that the “request [is] for a list of available servers.” This conclusion is directly supported by the ’595 patent’s statement that, when “a device makes a request to a server, what it is really asking for is a list of available servers.” See Pet. 46 (citing Ex. 1001, 23:11–24; Ex. 1003 ¶¶ 139, 140).”

Dec. at 18 (emphasis added).

First, both Petitioner and the Panel violated Federal Circuit law by impermissibly using the teachings of the ’595 patent itself “as a roadmap to reconstruct the claimed invention using disparate elements from the prior art.” *TQ Delta, LLC v. Cisco Sys.*, 942 F.3d 1352, 1361 (Fed. Cir. 2019) (citations omitted).

Second, the Panel inaccurately quotes the ’595 patent, which actually says:

“[w]hen a device makes a request to the server availability module, what it is really asking for is a list of available servers” Ex. 1001 23:17-19. A “**server availability module**”—a special module within a control server as disclosed in the ’595 patent—is a component for which the Petition offers no analogue in the prior art. The ’595 patent gives this characterization of the list generated by this module:

FIG. 14 illustrates, in accordance with certain embodiments of the disclosed subject matter, **the importance of a server availability list** and how IP addresses and ranges are assigned for various devices.

(Ex. 1001 at 15:43-46.) Again, Petitioner’s own expert recognizes the special

functionality associated with the “*server availability module*” when summarizing the ’595 patent with respect to this component:

. . . the server availability module’s main benefit is ***to catalog*** the resources usage, IP addresses and ports of access point servers and to ***look at which devices***, such as end point devices that ***would like to connect to server access points*** to build tunnels with them. The server availability module ***calculates and compiles a custom-made list*** of IP addresses and ports which are contextually designed ***to provide best options*** for endpoint devices to utilize.

Ex. 1003 at ¶ 48 (citing EX-1001 27:20-31). The Panel provides no support for the suggestion that a “*server availability module*” was a term of art—let alone a concept—known to a POSITA prior to its disclosure in the ’595 patent.

There is no factual or technical basis in the record to conclude that Hankins’ unspecified “*request [for] services*” is the same as the special *server availability list* request disclosed and claimed in the ’595 patent.

IV. CONCLUSION

For all the reasons stated above, Patent Owner respectfully requests that the Director deny review, vacate the Decision, and terminate IPR2024-00270 with prejudice.

Dated: September 19, 2024

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CERTIFICATE OF WORD COUNT

Pursuant to 37 C.F.R. § 42.24(d), the undersigned certifies that this Request for Director Review complies with the 15-page limit exclusive of the parts exempted as provided in 37 C.F.R. § 42.24(a).

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. §§ 42.6(e), 42.8(b)(4) and 42.105, the undersigned certifies that on the 19th of September, 2024, a complete and entire copy of this Request was served in its entirety by filing this document through the PTAB P-TACTS System, as well as by email to counsel of record for the Petitioner. Concurrently, notification is being provided to the Director of the USPTO at Director_PTABDecision_Review@uspto.gov.

/ Jason M. Shapiro /

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