

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

MICROSOFT CORPORATION

Petitioner,

v.

EDGE NETWORKING SYSTEMS, LLC,

Patent Owner.

Case No. IPR2025-00619
U.S. Patent No. 10,686,871

**PATENT OWNER'S AUTHORIZED REPLY IN SUPPORT OF PATENT
OWNER'S REQUEST FOR DISCRETIONARY DENIAL**

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PATENT OWNER'S EXHIBIT LIST

Ex. 2001	US Patent Publ. No. 2014/0317293 to Shatzkamer
Ex. 2002	McKeown et al, "Open Flow: Enabling Innovation in Campus Networks" March 14, 2008
Ex. 2003	US Patent Publ. No. 2013/0160147 to Draluk
Ex. 2004	US Patent Publ. No. 2004/0237081 to Homiller
Ex. 2005	<i>Ruckus Wireless, Inc. v. Hera Wireless SA et al.</i> , IPR2018-01739, Petition for Inter Partes Review, Paper 1
Ex. 2006	US Patent No. 10,496,387
Ex. 2007	Office Action dated April 3, 2019 issued during prosecution of US Patent No. 10,496,387 together with Notice of References cited accompanying same

I. PETITIONER HAS FAILED TO DEMONSTRATE THAT THE EXAMINER ERRED IN HIS EVALUATION OF SHATZKAMER

In Petitioner's Opposition To Patent Owner's Discretionary Denial Request ("Opposition"), Petitioner argues that "there was material error ... because none of the IPR prior art was considered by the Office." Opposition, 18. This allegation misses the mark. Discretionary denial is appropriate where the Examiner considered prior art cumulative of "the IPR prior art" and did not materially err in doing so. If failure to consider "the IPR prior art" standing alone was error, *Becton Dickinson's* focus on "the cumulative nature of the asserted art and the prior art evaluated during examination" would be meaningless. *Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8, at 17–18 (PTAB Dec. 15, 2017).

During prosecution, the Examiner in the '624 Patent mapped Shatzkamer's virtualized environments to a portal coupled to generic programmable network and cloud devices. Ex. 1005, 329-330 (mapping Shatzkamer's virtualized environments to "portal coupled to the programmable network device and the programmable cloud device"). The record clearly demonstrates that, with the knowledge of Shatzkamer's virtual environments squarely before him, the Examiner concluded that particular programmable network and cloud devices -- i.e., ones with "a sandboxing operating system" -- were distinguishable from the art before him and, after amending the claims to recite this limitation, allowed them. Petitioner has failed to allege that the

Examiner erred in any manner in finding the claims distinguishable over Shatzkamer. For example, Petitioner has not alleged that the Examiner overlooked the disclosure of a “sandboxing operating system” in Shatzkamer (to be clear, he did not), or that the Examiner erred in allowing claims reciting “a sandboxing operating system” over Shatzkamer’s virtualized application runtime environment (again, to be clear, the Examiner committed no such error).

II. PETITIONER’S FALSE ALLEGATIONS OF ERROR BASED ON *PENTIKOUSIS* ARE IRRELEVANT

The fifth *Becton Dickinson* factor asks “whether Petitioner has pointed out sufficiently how the Examiner erred *in its evaluation of the asserted prior art.*” *Becton, Dickinson*, IPR2017-01586, Paper 8, at 17–18 (emphasis added). This factor asks whether the Examiner erred in evaluating whether *the asserted prior art* which, in the present case, corresponds to *virtual runtime environments or JVMs* as disclosed in Shatzkamer (and Vasell which is cumulative thereof). Here, Petitioner fails to allege any such error, focusing instead on aspects of the prosecution history having *nothing to do with* the Examiner’s decision to allow claims reciting “a sandboxing operating system” over prior art disclosing virtual runtime environments or JVMs. For example, the Opposition (at 18-19) alleges that:

... the original examiner in the parent ‘871 Prosecution History erred by relying on a reference (*Pentikousis*) in prior art rejections whose publication date (July 2013) was after the claimed priority date (June 13, 2013) of the application that led to the ‘871 Patent, despite

identifying and acknowledging this grandparent ‘624 Patent, and without explaining whether reliance on the intervening *Pentikousis* reference was proper because, for example, the Examiner found that the claims were not supported by the priority provisional application (as found for the specification of the ‘871 Patent). EX1002, 181, 190-199 (§§ 112(a) and 112(b) rejections of the claims), 199-212 (§ 103(a) rejections relying on *Pentikousis* as the primary reference). The Applicant’s only response to these obviousness rejections was to argue that the primary reference *Pentikousis* was not prior art.

Even if the above was a “statement of error” (it is not), the allegation misses the mark because it fails to pertain to “how the Examiner erred in its evaluation of the asserted prior art,” which, in the present case, corresponds to virtual runtime environments or JVMs. Here, it is not enough for Petitioner to point to any alleged “error” untethered to the Examiner’s decision to allow claims reciting “a sandboxing operating system” over prior art disclosing virtual runtime environments or JVMs. Petitioner fails to tie the Examiner’s treatment of *Pentikousis* to the issue at the heart of the present *Becton, Dickinson* analysis, namely, whether Petitioner has shown that the Examiner erred in finding “a sandboxing operating system” patentable over a virtual runtime environment or JVM.

Moreover, the Examiner did not err in his evaluation of *Pentikousis*. Despite Petitioner’s allegation to the contrary, the Examiner never “found that the claims were not supported by the priority provisional application.” See Opposition, 20 (emphasis added). The Opposition cites to EX1002, 181, 190-199 and 199-212 for this proposition, but nowhere on those pages does the Examiner even discuss

whether the claims were supported by the priority provisional application.

In addition, Petitioner has failed to show that the Examiner erred in deciding to withdraw the rejection based on *Pentikousis* for the reason that the reference was not prior art. For example, Petitioner has failed to allege or demonstrate that the claims that were before the Examiner lacked support in the provisional application.

III. PETITIONER’S FALSE ALLEGATIONS OF ERROR BASED ON THE EXAMINER “SUMMARILY” WITHDRAWING §112 REJECTIONS ARE ALSO IRRELEVANT

The Opposition (at 19-20) argues that:

... the new Examiner erred by summarily withdrawing all of the original examiner’s prior art rejections and §112 rejections, and allowing the claims after Applicant submitted a terminal disclaimer over the grandparent ‘624 Patent (with its narrower claims relative to the parent ‘871 Patent claims), without any further discussion EX1002, 263-269, 325, 331-335 and 352-353.

As explained above, the fifth *Becton Dickinson* factor asks whether the Examiner erred in evaluating whether the asserted prior art which, in the present case, corresponds to virtual runtime environments or JVMs as disclosed in Shatzkamer (and Vasell which is cumulative thereof). Again, Petitioner’s allegation of error with respect to rejections under §112 focus on aspects of the prosecution history having nothing to do with the Examiner’s decision to allow claims reciting “a sandboxing operating system” over prior art disclosing virtual runtime environments or JVMs.

Moreover, the Petitioner has failed to explain how the Office's treatment of the rejections under §112 was erroneous. After the claims were rejected based on §112 (Ex. 1002, 123-135), the Applicant responded by deleting some claims, amending others, and addressing in remarks each of the §112 rejections raised in the prior office action. Ex. 1002, 252-261. After reviewing Applicant's response, the Examiner stated:

Applicant's arguments ... with respect to the previous rejection of claims 1-2, 5, 7, and 11-18 under 35 USC 112(a) and/or 112(b), and 103 have been fully considered and are persuasive. The rejection of claims 1-2, 5, 7, and 11-18 under 35 USC 112(a), 112(b), and 103 have been withdrawn. Ex. 1002, 265 (emphasis added).

Contrary to Petitioner's allegations, there is no evidence that the Examiner "summarily" withdrew the §112 rejections. Rather, the record reflects that the Examiner considered Applicants arguments with respect to those rejections and found them persuasive. Significantly, Petitioner fails to explain that the Examiner's decision to withdraw the §112 rejections was erroneous in any way. For example, Petitioner fails to allege that the Examiner allowed claims that were defective under §112.

For the foregoing reasons, Petitioner has failed to demonstrate that the Examiner erred in any respect, let alone with respect to his "evaluation of the asserted prior art" -- namely virtual runtime environments like that shown in Shatzkamer (and Vasell which is cumulative thereof).

Respectfully submitted,

Dated: July 22, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing **PATENT OWNER'S AUTHORIZED REPLY IN SUPPORT OF PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL** was served via email (as consented to by counsel) on July 22, 2025 to lead and backup counsel of record for Petitioner as follows:

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