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Subject: IPR2025-01010 – Request for Reply to Patent Owner Preliminary Response

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Dear PTAB,

Petitioner requests authorization to file a six-page Reply to the Preliminary Response to address Patent Owner's implicit claim constructions for the "modified embedded resource," "application programming interface (API)," and "tag" limitations that were unforeseeable because they improperly incorporate limitations from the specification and overly rely on new extrinsic evidence. *See, e.g.*, POPR at 18 ("Petitioner fails to show ... a 'modified **embedded** resource' as claimed—e.g., as a modified resource embedded *within the client's HTML page*") (second emphasis added); 19 ("[A]s the '322 patent describes and claims, the 'modified **embedded** resource' is a resource embedded within *another* resource, such as an HTML document.") (second emphasis added); 22 (citing extrinsic evidence to argue "an API acts as an interface that allows the client to communicate with an application executing on the server—it is *not* the application itself") (emphasis original); 22 ("In the context of the '322 patent, the 'API' acts as a bridge between the origin server and the compute engine"); 28 ("The '322 patent further explains that '[t]he embedded resource may include a **tag indicating that a resource address computing engine should be contacted....**'") (emphasis original).

Counsel for Petitioner and Patent Owner have conferred, and Patent Owner opposes this request and responds as follows:

Patent Owner opposes Petitioner's request as there were no "implicit claim constructions" in the POPR. The arguments presented in the POPR address the express language of the claims under their plain and ordinary meaning. It was not unforeseeable that Patent Owner would argue that the prior does not teach the limitations of the challenged claims based on their ordinary meanings, including the "modified embedded resource," "application programming interface (API)," and "tag" limitations. *See, e.g., Micron Tech., Inc. v. Yangtze Memory Techs. Company, LTD.*, IPR2024-00792, Paper 12 at 2 (PTAB Sep. 11, 2024). The Board is capable of evaluating Petitioner's and Patent Owner's arguments for purposes of an institution decision based on the Petition and POPR, and Petitioner's disagreement with Patent Owner's arguments does not amount to good cause for allowing additional briefing on the merits. Should the Board grant Petitioner leave to file a reply addressing the merits of Patent Owner's arguments, Patent Owner requests a sur-reply of the same length.

If the Board requires a conference call, the parties can provide availability as requested.

Respectfully,

Dan Tucker
Counsel for Petitioner

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Partner

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