

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORCA SECURITY LTD,
Petitioner,

v.

WIZ, INC.,
Patent Owner.

IPR2025-01086
Patent 12,001,549

**PATENT OWNER WIZ, INC.'S SURREPLY
IN SUPPORT OF ITS PRELIMINARY RESPONSE**

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I. INTRODUCTION

Patent Owner (“Wiz”) requests denial of inter partes review (IPR) of the involved patent. Petitioner (“Orca”) attempts to shift attention from its failures of proof with belated arguments that it does not (and cannot) show were made in its petition. Orca bears the burden on all aspects of its unpatentability argument, yet Orca now insists it has no burden on the key points it failed to prove. Orca’s belated arguments are fatally untimely and, even if they were considered, still fail to meet Orca’s facial burden. Orca’s petition should be denied on the merits.

II. BELATED ARGUMENTS CANNOT SALVAGE ORCA’S PETITION

Orca waited until the last minute to file its petition—nearly a year after service of Wiz’s counterclaim. Compare Paper 1 (“Pet.”) (filed June 4, 2005) with EX2001, EX2002 (counterclaim service on June 4, 2024). Orca’s delay left it no time for curing material error. 35 U.S.C. 315(b). Moreover, Orca at all times retains the burden of proof for its unpatentability arguments. 35 U.S.C. 316(e). Orca was the master of its petition. *SAS Institute v. Iancu*, 584 U.S. 357, 363 (2018). Orca is not entitled to try to complete its petition now through reply, but even if it were, such a revised petition would be statutorily barred.

A. Orca’s Attempt to Revive Lal Is Too Late

Orca misstates the problem and ignores its burden. Orca does not dispute that it has the burden to establish its reference is prior art. Paper 9 (“POPR”), 3.

Rather, Orca now belatedly argues that merely stating a provisional is incorporated is sufficient (Paper 11, Reply, 1-2) but does not and cannot point to where it made these arguments in its petition. Indeed, the petition provided no argument at all, forcing Wiz to look to **another** petition (IPR2025-01087) for any hint of an argument. POPR, 4 & n.2. There Orca cited MPEP 2163.07(b), which it now supplants with entirely new authorities. Reply, 2-3. Wiz addressed Orca's petition arguments in good faith, explaining MPEP 2163.07 dealt with correcting specifications not prior art: Orca's switching theories in reply is not responsive.

Moreover, even if Orca's incorporation argument were apt, it is not sufficient because incorporations are not automatically sufficient. Wiz explained how incorporations may fail citing the same authority Orca previously cited and additional authority, none of which Orca addresses. POPR, 4-6.

In effect, Orca contends that its bare assertion about incorporation satisfies its burden, but none of Orca's belatedly-cited authorities supports this. Indeed, as Orca recognizes (Reply, 2), *Penumbra* holds that even for post-AIA prior art a petitioner must carry its burden on at least one of the *Dynamic Drinkware* requirements to show that the underlying provisional application "describes the subject matter relied upon ***in the reference patent document as prior art.***" (emphasis added)). This actually proves Wiz's point: the relevant disclosure must be in the non-provisional reference, with supporting parallel citations showing the

same subject matter disclosed in the provisional. Orca's argument flips that requirement and vitiates it. Orca's reliance on the provisional alone for disclosure is unsupported in—indeed contrary to—precedent and makes no logical sense. Orca's sleight-of-hand to turn provisional disclosure into reference disclosure continues to be error into which the Director should not be drawn.

B. Orca Cannot Justify Combining Lal and Lal's Provisional

Once again, Orca shirks its burden of proof by arguing that it need not explain how or why the **different** disclosures in Lal and its provisional would be combined. Instead, Orca relies on a distinguishable **nonprecedential** panel decision in which the panel found that the patentee had failed to show the embodiments were different. *TVision Insights v. Nielson Co.*, IPR2023-01014, Paper 10, 32 (2024). Even assuming the *TVision* panel did not improperly shift the burden from the petitioner to show the embodiments were the same, Orca never argues that Wiz failed to show the embodiments were different. Indeed, the very fact that the disclosed embodiments are facially distinct—including extensive omissions of provisional disclosure from the reference—satisfies whatever burden of production Wiz might have had. Orca cannot satisfy **its burden** (§316(e)) by making the Director and Wiz guess its theory of obviousness.

III. CONCLUSION

Orca still fails to meet its burden. Institution should be denied.

Respectfully submitted,

Date: November 14, 2025

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CERTIFICATE OF SERVICE

I certify a true and correct copy of this paper was served today to the email correspondence addresses of the patent owner as follows:

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