

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORCA SECURITY, LTD.,
Petitioner

v.

WIZ, INC.,
Patent Owner

Inter Partes Review Case No. IPR2025-01087
U.S. Patent No. 12,003,529

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Petitioner submits this authorized reply (*see* EX3001) to address Patent Owner's ("PO") failed attempts to avoid institution by suggesting that material incorporated by reference into a prior art patent is not available as prior art. As explained below, PO is incorrect on the facts and the law.

PO first characterizes the Petition as relying on EX1005 ("the Shua Provisional") "as a ground reference" in combination with EX1004 ("Shua") and EX1006 ("Lang"). Patent Owner's Preliminary Response ("POPR"), Paper 9, at 1. This directly contradicts both the Petition's grounds statement ("Shua in view of Lang"; *see* Petition, Paper 1, at 6) and the Petition's clear statement relying on the combined disclosures as a single reference: "[the] Petition relies on the disclosures of Shua and the Shua Provisional as a single prior art reference." *Id.* at 7.

PO argues that Shua's incorporation by reference is ineffective to render the Shua Provisional's disclosures prior art (POPR, 3), but PO is wrong. The "subject matter of ... provisional ... applications, referred to in a prior art U.S. patent ... may be relied on in a 35 U.S.C. 102(a)(2) ... rejection based on that patent ... if the disclosure of the [provisional] application is actually included or **incorporated by reference in the patent.**" MPEP 2127 (emphasis added). MPEP 2127 is in accord with Federal Circuit precedent and previous Board decisions. *See, e.g., Konda v. Flex Logix Techs., Inc.*, 2022 WL 1436144 (Fed. Cir. May 6, 2022) (affirming Board decision finding provisional application was prior art when it became publicly

available); *Bruckelmyer v. Ground Heaters, Inc.*, 445 F. 3d 1374, 1377-80 (Fed. Cir. 2006) (drawings in file history of issued patent were prior art); *Duodecad IT Services Luxembourg S.A.R.L, et al. v. WAG Acquisition, LLC*, IPR2015-01036, Paper 17 at 18-19 (P.T.A.B. Oct. 20, 2016) (issued patent's file history contents were prior art). Thus, the Shua Provisional's disclosures became prior art when the Shua patent issued on an equal basis with the disclosures in Shua.

PO attacks the Petition's reliance on MPEP 2163, but PO misapprehends its import: MPEP 2163.07(b) speaks to the legal effect when a document is incorporated by reference, and the underlying legal principle (incorporation by reference of a document into a host renders the entire contents of that document's disclosure part of the host) is well-established. PO's own cited case confirms MPEP 2163.07(b)'s harmony with precedent: "[p]atents that are incorporated by reference are 'effectively part of the host [patents] as if [they] were explicitly contained therein.'" *Finjan LLC v. ESET, LLC*, 51 F.4th 1377, 1382 (Fed. Cir. 2022) (quoting *X2Y Attenuators, LLC v. U.S. Int'l Trade Comm'n*, 757 F.3d 1358, 1362–63 (Fed. Cir. 2014)). "Incorporation by reference of a patent 'renders "the entire contents" of that patent's disclosure a part of the host patent.'" *Id.* (also citing *Ultradent Prods., Inc. v. Life-Like Cosmetics, Inc.*, 127 F.3d 1065, 1069 (Fed. Cir. 1997) and MPEP § 608.01(p) (6th ed. 1996)); see also *TVision Insights, Inc. v. The Nielsen Company (US), LLC*, IPR2023-01014, Paper 10, 32-33 (PTAB Jan. 8, 2024) ("material in a

second document is considered incorporated by reference in a host document if the context makes clear that the material is effectively part of the host document as it were explicitly contained therein”) (cleaned up). Because Shua expressly incorporates the Shua Provisional’s contents, each Petition citation to the Shua Provisional is therefore also a citation to Shua, the relied upon and eligible prior art reference. This ends the inquiry. The Shua Provisional is treated “as if [it] were explicitly contained” in Shua; PO’s arguments fail. *Finjan*, 51 F.4th at 1382.

Finally, PO argues the Petition is deficient because it doesn’t provide a motivation-to-combine or reasonable-expectation-of-success analysis for combining Shua and the Shua Provisional. POPR at 5. The Board has considered and rejected this, finding a patent owner’s argument alleging that “combining features from a reference that is incorporated by reference is akin to combining two embodiments of a single reference for which the case law requires a motivation to combine” was “factually and legally deficient.” *TVision v. Nielsen*, Paper 10 at 32-24. Furthermore, contrary to PO’s “very different disclosures” characterization, Shua’s disclosures are facially a development of the Shua Provisional’s technology, describing substantially the same concepts: both the Shua and Shua Provisional Background and “disclosed embodiments” are in common. *Cf.* EX1005, [001] *with* EX1004, 1:33-42 (describing the technical field in virtually identical language) *and* 78:27-84:10 *with* EX1005, pp. 45-72 (disclosing substantially similar exemplary claims).

Respectfully submitted,

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CERTIFICATION OF COMPLIANCE

The undersigned certifies pursuant to 37 C.F.R. §42.24 that foregoing Petitioner's Reply to Patent Owner's Preliminary Response to Petition for *Inter Partes* Review, excluding those portions excepted by 37 C.F.R. § 42.24(a)(1), complies with the three-page limit specified by the Board.

Dated: November 10, 2025

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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing Petitioner's Reply to Patent Owner's Preliminary Response was served on November 10, 2025, by email on the following counsel of record for Petitioner:

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