

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORCA SECURITY LTD,
Petitioner,

v.

WIZ, INC.,
Patent Owner.

IPR2025-01087
Patent 12,003,529

**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’s belated arguments are fatally untimely and, even if they were (improperly) 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—a year after service of Wiz’s counterclaim. Compare Paper 1 (“Pet.”) (filed June 4, 2025) 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 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 Shua Is Too Late

Orca misstates the problem and ignores its burden. Orca asserts the preliminary response (Paper 9, “POPR”) overlooked that the petition was relying on Shua and its provisional together. Paper 11 (“Reply”), 1. Not so, the POPR expressly notes Orca’s reliance “on both the Shua patent...and the Shua

provisional application...as ground references.” POPR, 2. The POPR notes, however, that the provisional is not available as a reference under 35 U.S.C. 311(b). POPR, 2-3, *also citing* 37 C.F.R. §42.104(b). Orca makes no attempt to rebut this argument. Reply, passim (no mention of §311(b)). Neither the Director nor Wiz should be left to guess how this combination satisfies §311(b).

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, Orca provides new authorities—underscoring Orca’s failure to make these arguments in its petition—yet they address different problems. *Konda*, for example, addresses whether the provisional itself is a reference, something Orca insists it is not doing. *Bruckelmyer* and *DuoDecad* likewise address whether a patent’s file history is itself prior art, again something Orca denies doing here. Instead, Orca insists the Shua provisional is part of the Shua reference without doing the work to show it is true *in this case*.

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, 3-4; *see also Penumbra, Inc. v. RapidPulse*, IPR2021-01466, Paper 34, 33 (PTAB 2025) (distinguishing case where “the petitioner failed to show that the provisional application provided sufficient

support ***for the subject matter relied upon in the reference patent.***” (emphasis added)). In short, Orca is playing a shell game: relying on incorporating the provisional to avoid a §311(b) problem, yet also shirking its burden to show the provisional sufficiently supports disclosures relied upon in the Shua reference. Again, neither the Director nor Wiz should be left guessing at Orca’s theory for institution.

B. Orca Cannot Justify Combining Shua and Shua’s Provisional

Orca also shirks its burden by failing to explain how or why the ***different*** disclosures in Shua 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 (PTAB 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 Wiz failed to make this showing. Indeed, the 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.

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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