

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FORTINET, INC.,

Petitioner,

v.

NETSKOPE, INC.,

Patent Owner.

U.S. Patent No. 8,356,336

Case No.: IPR2026-00040

NETSKOPE, INC.'S PRELIMINARY RESPONSE

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EXHIBIT LIST

No.	Exhibit Description
Ex. 2001	Scheduling Order for Netskope, Inc. v. Fortinet, Inc., Case No. 4:25-cv-02360-HSG, pending in the United States District Court for the Northern District of California.
Ex. 2002	Fortinet Inc.'s Preliminary Invalidity Contentions in Netskope, Inc. v. Fortinet, Inc., Case No. 4:25-cv-02360-HSG, pending in the United States District Court for the Northern District of California.
Ex. 2003	Exhibit A-1 of Fortinet Inc.'s Preliminary Invalidity Contentions in Netskope, Inc. v. Fortinet, Inc., Case No. 4:25-cv-02360-HSG, pending in the United States District Court for the Northern District of California.
Ex. 2004	Plot from Docket Navigator – Profile of Judge Haywood S. Gilliam Motion Success To Stay Pending IPR
Ex. 2005	Plots from Docket Navigator – Profile of Judge Haywood S. Gilliam Time to Milestones (annotated)
Ex. 2006	Website blog on Fortinet.com, titled: “Fortinet is Leading Innovation in the Security Industry with More Than 1,500 Patents” https://www.fortinet.com/blog/business-and-technology/fortinet-is-the-security-innovation-leader-more-than-1500-patents-either-awarded-or-pending
Ex. 2007	Website article on Wikipedia.org, titled: “Fortinet” https://en.wikipedia.org/wiki/Fortinet
NEW EXHIBIT	
Ex. 2008	Declaration of Dr. Angelos Stavrou, Ph.D.

I. INTRODUCTION

Patent Owner Netskope, Inc. (“Patent Owner”) respectfully submits this Preliminary Response to the Petition for *Inter Partes Review* (“IPR”) filed by Fortinet, Inc. (“Petitioner”) challenging claims 1-20 (“Challenged Claims”) of U.S. Patent No. 8,356,336 (“the ’336 patent”) based on three grounds.

The ’336 patent provides a novel network access control solution that lets anonymous users browse a curated set of destinations—the walled garden—while providing a seamless, token-triggered path to authentication and broader access, improving user experience and operator control on shared networks. ’336 patent, Abstract. The network control system described by the ’336 patent provides a network access controller that intercepts browser requests and determines whether the target resource is within a “walled garden”: if it is, the network access controller directs the browser to the network resource, and if it is not, the browser is redirected to a pre-authentication capture destination in the shared network. *Id.* The specification illustrates garden servers using ordinary Internet hostnames and HTTP URLs (e.g., “wg1.com,” “wg2.com”) and does not require on-premises hosting. *Id.*, 4:38-44.

The architecture provided by the ’336 patent offers clear advantages over prior systems. For example, it enables seamless network entry because any attempt to reach a non-walled-garden site is automatically intercepted and redirected to a

pre-authentication destination, eliminating the need to know a specific garden URL. '336 patent, 2:47-55. The walled-garden content is decoupled from the authentication portal through the token mechanism, so walled-garden pages need not hard-code or even know the login URL, allowing the same walled garden to serve multiple controllers with different portals. *Id.*, 2:41-53. The solution provided by the '336 patent also enhances security and granularity by containing unauthenticated users while granting authenticated users broader, user-specific access. *Id.*, 5:36-39.

Accordingly, the claims of the '336 patent properly capture the network architecture and solution provided by the '336 patent. Independent Claim 1, for instance, requires, *inter alia*, “a shared network,” “a set of network destinations hosted on the plurality of server computers,” and “redirecting the browser application running on the client device within the shared network associated with the anonymous user to a pre-authentication capture destination hosted on a first server computer.” Claims 9 and 16, the other independent claims of the '336 patent, recite similar features as Claim 1 and are respectively corresponding computer-readable medium and apparatus claims.

Overall, the merits of the Petition are deficient, and its arguments are confusing and inconsistent for most, if not all, claim elements. The Petition fails to demonstrate a reasonable likelihood that Petitioner would prevail in showing that any of the Challenged Claims is unpatentable. Rather than presenting a coherent,

evidence-based obviousness or anticipation case, the Petition relies on strained reinterpretations of the prior art, conclusory expert assertions, and a piecemeal reconstruction of the '336 patent using hindsight. As explained below, Subbiah does not anticipate or render obvious the core claim requirements of the '336 patent. Accordingly, the Board should deny the Petition under 35 U.S.C. § 314.

II. LEVEL OF ORDINARY SKILL IN THE ART

The Petition and its Petitioner's Expert Declaration, describes a person of ordinary skill in the art (POSITA) as "an individual with either (1) at least a bachelor's degree in computer science or computer engineering or an equivalent field plus at least one year of experience working on computer networking or computer security, or (2) at least 3 years of experience working on computer networking or security, even without a formal degree." Petition, 12-13, Ex. 1003, ¶¶13-23.

For the purposes of this Preliminary Response, Patent Owner relies on the definition proposed by Petitioner because Petitioner has not shown that any challenged claim is unpatentable even under this level of skill.

III. CLAIM CONSTRUCTION

For the purposes of this Preliminary Response, Patent Owner believes all claim terms should be interpreted in their plain and ordinary meaning, and no claim term needs a specific construction.

IV. THE CHALLENGED CLAIMS ARE PATENTABLE OVER THE TEACHINGS OF SUBBIAH

A. Subbiah fails to anticipate or render obvious multiple claimed elements and limitations of independent Claims 1, 9, and 16 in Grounds 1 and 2

Petitioner contends that independent claims 1, 9, and 16 are anticipated and/or rendered obvious by Subbiah alone under pre-AIA 35 U.S.C. § 102 or § 103. *See* Petition, 19. These assertions are incorrect. As demonstrated below, Subbiah fails to teach or suggest several claimed features, and therefore cannot anticipate or render obvious any of the challenged claims. Ex. 2008, ¶¶39-40.

A claim is only unpatentable under 35 U.S.C. § 102 if “each and every element as set forth in the claim is found . . . in a single prior art reference.” MPEP 2131; *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, (Fed. Cir. 1987). For obviousness, the Supreme Court in *KSR International Co. v. Teleflex Inc.* reaffirmed that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” MPEP 2141; *KSR.*, 550 U.S. 398, 416 (2007). Grounds 1 and 2 fail as a matter of law to satisfy these standards, as discussed further in Section V, and they do not even attempt to identify each claim element and its corresponding limitations, relying instead on conclusory, ipse dixit mappings.

Grounds 1 and 2, which rely on Subbiah alone, either ignore numerous elements or offer opaque and incorrect mappings. For brevity, we highlight only a few of the most glaring deficiencies below.

- 1. Subbiah does not disclose, teach, suggest, or render obvious the claimed “*intercepting a request to access a network resource*” in limitations 1[b], 9[a], and 16[c]¹ of Claims 1, 9, and 16, respectively.**

Petitioner contends that Subbiah satisfies the “*intercepting a request to access a network resource*” limitation merely because Subbiah’s wireless access point 330 “receives” a request for network access. Petition at 27-29. That contention misses the mark. The Petition never engages with what “*intercepting*” means in the context of the ’336 patent, much less explaining how the cited receipt-and-redirection behavior amounts to “*intercepting*.” Instead, the Petition merely string-cites paragraphs from Subbiah without any explanation of how those passages disclose “*intercepting*.” *Id.*, 28-29. Ex. 2008, ¶41.

¹ The Petition misidentifies the cross-references for limitations 9[a] and 16[c] by directing them to limitation 1[a], which addresses a different claim element—“*providing a network access controller in a shared network...*” Patent Owner treats this as a clerical error and construes limitations 9[a] and 16[c] as referring back to limitation 1[b].

Petitioner conflates the access point's receipt of a client request with "*intercepting*." Petition at 27-29. Subbiah describes a wireless access point that receives a client's request and may redirect the browser, but it neither uses the term "*intercept*" nor demonstrates, for example, that the request is captured and stopped in transit before reaching its intended destination in the sense understood in the captive-portal art. At a minimum, Petitioner was required to articulate why a POSITA would equate Subbiah's receipt of requests for network access with the claimed "*intercepting*," and it did not. Ex. 2008, ¶42.

Subbiah does not use or define "*intercepting*" as a distinct step. In fact, the words "intercepting" or "intercept" are not even present in Subbiah. Rather, Subbiah describes receiving "a request for access to a communication network" from the client (Ex. 1004, 12:13-18) and redirecting a browser's first external request to a local Web server that serves a main/default page, and on subsequent external attempts redirecting to a BURP authentication server to log in (*id.*, 15:7-13). Its flow charts likewise depict receiving a request from a client (e.g., step 201 of Fig. 2 and step 701 of Fig. 7) and redirecting the browser to the local Web server 310 (step 709) or to the BURP server 320 (step 708) as part of the authentication flow. *See e.g.*, Ex. 1004, 12:13-18, 17:10-26, Figs. 2 and 7. Consistent with that disclosure, Subbiah's claims explicitly recite "receiving a request to access a communications network from a client," confirming that "receive" is the operative action—there is

no separate recitation of “*intercepting*.” Ex. 1004, Cls. 1, 9. Ex. 2008, ¶43.

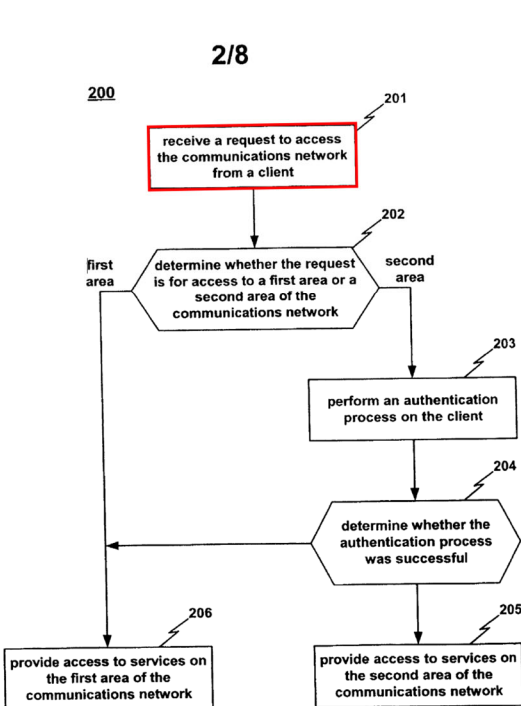


FIG. 2

Annotated Fig. 2 of Subbiah

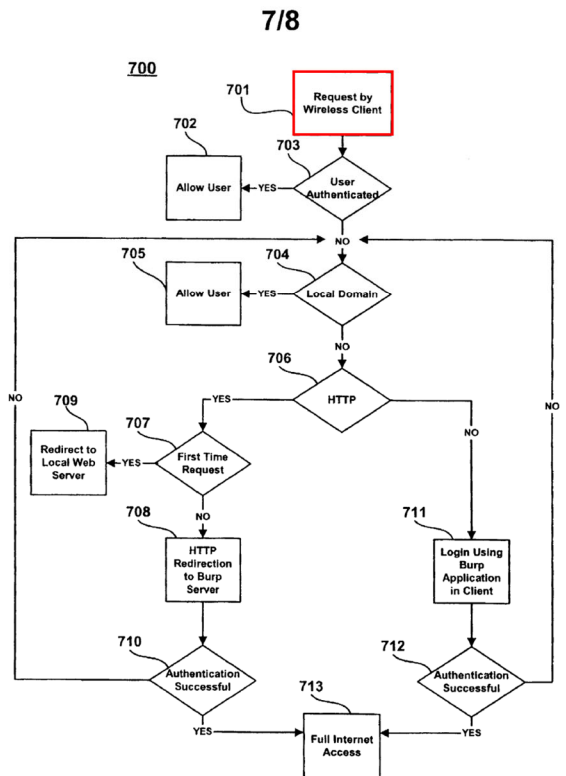


FIG. 7

Annotated Fig. 7 of Subbiah

By contrast, the '336 patent expressly recites an intercepting action: the Network Access Controller “intercepts” the requests and—depending on whether the Network Access Controller “recognizes the presence of the token”—“redirects” the browser either to a pre-authentication capture destination or to an authentication page. '336 patent, 4:50-62, 5:7-23. In other words, the '336 patent's request is intercepted in transit to allow recognition of the presence of the token before any redirection action. Indeed, as Patent Owner's expert Dr. Stavrou explains, this is an

important functional distinction because interception takes place to inspect requests to access network resources for e.g., HTML links and whether they include special tokens within the “query” portion of the link’s target HTTP URL. *See e.g.*, ’336 patent, 2:20-40; Ex. 2008, ¶44. Thus, the interception step is a functional action regardless of the presence of a token. *Id.*

Additionally, as Dr. Stavrou explains, intercepting network access requests involves actively capturing or stopping network access requests during transit to perform packet inspection. Ex. 2008, ¶45. Because interception is an active action, a network controller may decide whether to intercept or *not* intercept the network request. *Id.* The specification of the ’336 patent confirms this. Indeed, the ’336 patent explains that the controller uses a firewall function to recognize an unauthenticated attempt to reach the external Internet, “*intercepts* the request,” and then sends an HTTP redirect to the pre-authentication URL. ’336 patent, 4:55-61 (“The Network Access Controller 2 uses its internal Firewall 3 function to recognize the attempt by an unknown user to access an ‘external’ location (represented by the Internet cloud 4 in FIG. 1), *intercepts the request*, and sends an HTTP redirect to the Client's browser, specifying the Pre-Authentication Capture URL ‘http://wg1.com/welcome.html’”). Alternatively, the Network Access Controller may choose *not* to intercept the request. For example, after authentication, the controller “would *no longer intercept*” requests to external sites—underscoring

“intercepting” as an active gating capture step distinct from “receiving.” *Id.*, 5:30-35 (“As shown in FIG. 2, the Client now has access to the Internet 4 (‘External Network’). If the user now enters ‘www.yahoo.com’ in the Web browser's address bar, the Network Access Controller 2 **would no longer intercept this request**, and the welcome page from the Yahoo web site would be displayed”) (emphasis added). Ex. 2008, ¶¶45-46.

Conversely, “receiving” at most denotes the arrival or acceptance of a packet, and Subbiah nowhere teaches or suggests that its wireless access point can choose to receive—or **not** receive—the network access request. Indeed, the Petitioner has only identified a receiving event in Subbiah, and nothing more. *See* Petition at 27-29, citing e.g., Ex. 1004, 4:15-18 (“The method includes the step of **receiving a request to access** a communication network from a client”), 12:14-17 (“**requests for network access** are received wirelessly from clients”), (emphasis all in Petition); Ex. 2008, ¶47.

In short, the ’336 patent recites “*intercepting*” as a distinct, explicit, and active step at the controller that precedes “redirecting.” Subbiah does not teach interception. Ex. 2008, ¶48. Petitioner offers no theory or evidence that Subbiah teaches interception, or that mere receipt of a request is the same as interception. Therefore, Petitioner’s anticipation or obviousness assertions for “*intercepting a request to access a network resource*” of 1[b], 9[a], and 16[c] of Claims 1, 9, and

16, respectively, are deficient and lack underlying support in Subbiah. This failure confirms that Petitioner has not met its burden to show a reasonable likelihood of prevailing on this ground, and institution should be denied. Ex. 2008, ¶¶48-49.

2. Subbiah does not disclose, teach, suggest, or render obvious the claimed “*pre-authentication capture destination hosted on a first server computer*” in limitations 1[e], 9[d], and 16[f] of Claims 1, 9, and 16 respectively.

Subbiah does not disclose, teach, suggest, or render obvious at least the claimed “*pre-authentication capture destination hosted on a first server computer*” in limitations 1[e] of Claim 1, and similarly in parallel limitations 9[d] and 16[f]² of Claims 9 and 16, respectively. Ex. 2008, ¶50.

Petitioner's mapping fails because it conflates distinct destinations in Subbiah and never shows a single “*pre-authentication capture destination*” from which an anonymous user is free to visit any of the set of network destinations without authentication. Petitioner points to both the local Web server's main/default

² The Petition misidentifies the cross-references for limitations 9[d] and 16[f] by directing them to limitation 1[d], which addresses a different claim element—“*the network resource is in the set of network destinations...*” Patent Owner treats this as a clerical error and construes limitations 9[d] and 16[f] as referring back to limitation 1[e].

“splash” page and the BURP server’s login page as if either could satisfy the claim. They cannot. The BURP login page exists to initiate authentication—it is not a free-browsing page and therefore cannot be the claimed pre-authentication capture destination. *See e.g.*, Ex. 1004, 5:4-16 (“the authentication can be performed in accordance with the standardized Web based authentication protocols or with a basic user registration protocols (BURP)”). While Subbiah states that users “surfing the local, or internal, domain can do so freely,” Subbiah does not tie any function of the BURP server to realize the user’s surfing of the internal domain. Ex. 2008, ¶51. Rather, the BURP server’s “authentication process” is used to “ensure those users accessing external content pay for such content.” *See e.g.*, Ex. 1004, 5:4-16. Subbiah’s BURP server does not perform the actual function of local browsing, nor does Subbiah satisfy the “free to visit” clause for all non-local requests while unauthenticated. For example, Subbiah sends a first non-local browser request to the local splash page, but subsequent non-local requests are redirected to the BURP login server, not to a page from which the user can freely visit any of the set of destinations without authenticating. Ex. 2008, ¶51.

Petitioner also introduces an unresolved “first server computer” versus “second server computer” problem. Claim limitation 1[e] requires the “*pre-authentication capture destination*” to be “*hosted on a first server computer*” that is “*one of the plurality of server computers in the shared network.*” Petitioner

improperly alternates between mapping that “first server” to the local Web server (splash page) and to the BURP server’s login page-even though BURP is a different server whose role is authentication, not free-browsing capture. Such shifting in the mapping underscores the deficiency and confirms that Petitioner has not identified a single “*first server*” that meets the claim limitation. At most, the splash/home page on the local Web server could enable unauthenticated browsing of local informational pages, but that does not rescue Petitioner’s theory. Subbiah identifies local Web server 310 as the content host, while the BURP/AAA server performs authentication rather than content hosting. Counting the BURP/AAA server toward the claimed “plurality of server computers” that host the set of destinations improperly pads the mapping and contradicts the claim’s free-browsing premise. Ex. 2008, ¶52.

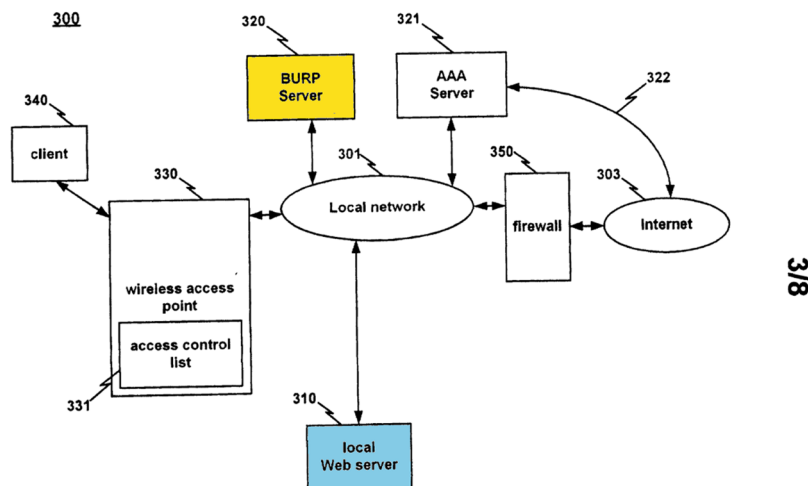


FIG. 3

Annotated Fig. 3 of Subbiah

Accordingly, Claims 1, 9, and 16 cannot be anticipated by or rendered obvious by Subbiah when there are numerous claim elements and limitations absent in the cited reference. The fact that the Petition does not identify multiple claim features in the reference is indicative of the reference's individual and collective lack of teaching. Claims 1, 9, and 16 are patentable over Subbiah, and therefore their dependent claims are too. Thus, *inter partes* review of the '336 patent is unwarranted. Ex. 2008, ¶53.

B. Subbiah fails to anticipate or render obvious at least dependent Claims 3, 10, and 18 in Grounds 1 and 2

1. Subbiah does not disclose, teach, suggest, or render obvious Claims 3 and 10

Petitioner also asserts that Claims 3 and 10 are anticipated and/or rendered obvious by Subbiah. *See* Petition at 38, 52. Claims 3 and 10 recite, *inter alia*, “*sending from the network access controller to the client device a response containing an identifier identifying the pre-authentication capture destination.*” ’336 patent, cls. 3 and 10 (emphasis added.) Petitioner’s theory fails because it presumes any Subbiah “redirect” means the controller “*send[s]...a response containing an identifier identifying the pre-authentication capture destination.*” Ex. 2008, ¶54. Inherency must be proved, not presumed, and obviousness needs a reasoned motivation tied to a controller implementation. *See, e.g., Trintec Indus., Inc. v. Top U.S.A. Corp.*, 295 F.3d 1292, 1295 (Fed. Cir. 2002) (inherency requires

demonstrating that a limitation is “‘necessarily present,’ not merely probably or possibly present, in the prior art.”); *In re Magnum Oil Tools Int’l, Ltd.*, 829 F.3d 1364, 1380 (Fed. Cir. 2016) (declaring that “a petitioner cannot employ mere conclusory statements”).

Petitioner cites Subbiah’s redirection and claims a POSITA “would have understood that such redirection necessarily requires sending the URL,” e.g., “http://www.futuremall.com/.” Petition at 39. As Dr. Stavrou explains, that is not an express disclosure that the controller’s response contains the identifier. Rather, it is speculation about generic HTTP behavior. Ex. 2008, ¶55.

Subbiah states that “the wireless access point 330 redirects the browser ... to the local web server 310,” and “[t]he web server 310 ... pushes the main, or default, Web page.” Ex. 1004, 15:7-13. Such disclosure attributes content delivery to the server, not the controller, and does not disclose a controller response “*containing an identifier identifying the pre-authentication capture destination.*” Notably, Petitioner identifies no Subbiah passage where the controller returns a Location header or other identifier. It instead relies on what a POSITA “would have understood,” not what Subbiah says the controller’s response contains. Petition at 39. Even Petitioner’s own expert offers only a conjectural scenario and still failing to demonstrate that the claimed feature is necessarily present. *See e.g.*, Ex. 1003, ¶115. Ex. 2008, ¶56.

In conclusion, Petitioner identifies no express disclosure that the “*network access controller...sen[ds]...a response containing an identifier identifying the pre-authentication capture destination,*” and its inherency theory is improper. Nor does the Petition supply a reasoned obviousness rationale for a controller-side response expressly including the identifier. Accordingly, Grounds 1 and 2 fail for Claims 3 and 10. Ex. 2008, ¶57.

2. Subbiah does not disclose, teach, suggest, or render obvious Claim 18

Claim 18 requires the network access controller to “*continuously monitor for network access from client devices on the first network interface*” (emphasis added). Petitioner’s reliance on Subbiah’s statement that an access point “waits for a wireless client...to connect” does not satisfy the claim’s requirement to “*continuously monitor for network access*” on the first network interface. Petitioner cites no explicit disclosure of continuous monitoring, and its obviousness rationale reduces to mere capability to receive—insufficient to meet the claim’s ongoing operational requirement. Ex. 2008, ¶58.

The intrinsic records support that “*continuously monitor*” is not mere capability or passive readiness. For example, the specification of the ’336 explains “*continuously monitor...on the first network interface*” by stating that the Network Access Controller “continuously monitors for network access from network access

client devices 1 on its first network interface at step 18,” and then acts when “a network packet is received (step 19),” initiating the decision flow in Figure 3. Ex. 1001, 5:40-47. This process flow provides that after detection via the continuous monitoring, the controller determines whether the client is authenticated and whether the destination is inside the walled garden, then either allows the packet, redirects to a pre-authentication destination, or redirects to an authentication page depending on token presence. *Id.*, 5:45-67. As Dr. Stavrou confirms, the functional role of this always-on monitoring is to enable immediate interception of client-originated access attempts on the client-facing interface so the controller can apply access-control logic and redirects. Ex. 1001, 5:45-54. The need for continuous monitoring would align with the motivation and design of the Network Access Controller in the '336 patent and would have been obvious to a POSITA. Ex. 2008, ¶59. The narrative example matches this behavior: the controller's internal firewall recognizes attempts by unknown users to reach external destinations, intercepts them, and issues HTTP redirects accordingly. *Id.*

Petitioner points to Subbiah's statement that an access point “waits for a wireless client...to connect,” but that language does not disclose continuous

monitoring.³ Petition at 57. A POSITA would have understood that “waiting” describes a passive state, and in contrast, “*continuously monitor*” imposes an active, persistent observation loop on the first interface. Ex. 2008, ¶60. The Petition points to no passage in Subbiah that the controller performs ongoing monitoring as claimed. Its Expert Declaration fares no better. It offers only a bare, conclusory assertion that “[a] POSITA would have understood that, to do so, the wireless access point necessarily must be continuously monitoring for communication and network requests from the client devices.” Ex. 1003, ¶155. Without providing any objective evidence, such statement is attorney argument masquerading as expert opinion and the Board should give such arguments little weight.

Nor does Petitioner carry its obviousness burden. The Petition’s rationale reduces to the truism that a device must be able to receive requests. *See e.g.*, Petition at 57. That is not a motivation to implement, nor an explanation of how to implement, a *continuously monitoring* process at the controller’s first interface as claimed.

³ Throughout the discussion of Claim 18, the Expert’s declaration purports to incorporate its arguments as to Claims 1 and 16 but, due to a clerical error, fails to identify the particular sections of those claims to which it refers. *See e.g.*, Petition at 56-57 (“*See* [16]”); Ex. 1003, ¶155 (“*Supra*, ____.”).

Capability to receive is not continuous monitoring. Accordingly, the Petition's and the Expert Declaration's arguments are therefore conclusory and insufficient. Ex. 2008, ¶¶61-62.

V. GROUNDS 1 AND 2 FAIL TO DELINEATE BETWEEN § 102 AND § 103 AND FAIL TO PROPERLY ASSERT EITHER CATEGORY

Grounds 1 and 2 assert unpatentability under § 102 (anticipation) and § 103 (obviousness), but the Petition presents them in a single, blended discussion that obscures both theories. *See* Petition at 19 (“A. Grounds 1 and 2: Claims 1—18 Are Anticipated, Or At Least Rendered Obvious By, Subbiah”). Due to this lack of clarity, the grounds of the Petition are substantively deficient and noncompliant with 35 U.S.C. § 312(a)(3),⁴ and therefore institution of *Inter Partes* Review should be denied.

⁴ 35 U.S. Code § 312(a) “Requirements of Petition.—A petition filed under section 311 *may be considered only if*— . . . (3) the petition identifies, in writing *and with particularity*, each claim challenged, *the grounds on which the challenge to each claim is based*, and the evidence that supports the grounds for the challenge to each claim, ...” (emphasis added).

At the threshold, it is unclear whether the Petition actually advances both § 102 and § 103 theories for each of the claims. In this merged presentation, the Petition mixes the two standards, shifting back and forth across the same parsed elements without coherent analysis.

With respect to Claim 3, the Petition first attempts to cure Subbiah's deficiency through inherency—asserting that a POSITA “would have understood” that redirection “*necessarily*” requires sending the target URL—then, in the next breath, pivots to obviousness, asserting that “a POSITA would have found it obvious to do so for the same reason,” while providing no substantive rationale. *See* Petition at 39 (emphasis added); *see also id.* at 52 (Claim 10). The problem is exacerbated by the lack of any corresponding statement or analysis in the Expert Declaration. *See* Ex. 1003, ¶115.

For Claim 18, the Petition again oscillates between theories, treating Subbiah as anticipatory while relying on what amounts to an obviousness rationale. It stitches together disparate disclosures but never makes the required element-by-element showing that Subbiah expressly or inherently discloses every limitation of Claim 18 arranged as claimed. *See* Petition at 57. The resulting gaps are then backfilled with generic “would have understood” assertions—classic obviousness notions, not anticipation. *Id.* The Petition's ipse dixit that a POSITA “would have” supplied

what Subbiah does not disclose cannot rescue anticipation and is equally inadequate for obviousness.

Petitioner advances murky § 102 and § 103 grounds that blur the governing standards. This improper hybrid ground forces Patent Owner to address multiple incomplete arguments and, if instituted, would require the Board to parse unarticulated invalidity theories under multiple legal standards. In addition, gaps in the claim mapping discussed above cast doubt on whether any § 102 argument was submitted in good faith. Yet Patent Owner must respond to both anticipation and obviousness within strict word limits, even though neither theory is sufficiently articulated to permit a focused rebuttal. Petitioner's approach improperly shifts the burden to the Board and to Patent Owner, and the Board should deny this Petition.

VI. PETITIONER IMPROPERLY RELIES ON POSITA'S KNOWLEDGE INSTEAD OF DISCLOSURE OR TEACHING IN THE PRIOR ART REFERENCE.

On July 31, 2025, the Director's office issued a memorandum (the "July Memorandum") putting all practitioners on notice that the Office "will enforce and no longer waive the requirement of 37 C.F.R. § 42.104(b)(4) (Rule 104(b)(4)) that a petition for inter partes review (IPR) "must specify where each element of the claim is found in the prior art patents or printed publications relied upon" and prohibiting reliance on "applicant admitted prior art (AAPA), expert testimony, common sense, and other evidence that is not 'prior art consisting of patents or printed publications'

... to supply a missing claim limitation.” July Memorandum at 1. The July Memorandum makes clear that reliance on a “general knowledge,” such as by a POSITA, to fill in missing claim limitations from prior art reference(s) was impermissible and is limited to supporting motivation to combine and demonstrating the knowledge of a POSITA. *Id.* at 1-2. This change applies to any petition filed on or after September 1, 2025 (*id.* at 3) and, thus, applies to the instant Petition.

Petitioner disregarded the Director’s instructions. The Petition impermissibly relies on the knowledge of a POSITA to substitute for missing ’336 patent claim limitations in the cited references, namely Subbiah. Particularly, the Petition fails to show that Subbiah discloses, teaches, or suggests multiple claim elements and limitations.

For example, in Claim 18, Petitioner identifies passages in Subbiah stating that an access point “waits for a client to connect” in an attempt to satisfy the claimed “continuously monitor for network access from client devices on the first network interface.” Perhaps recognizing that “waiting” is not “continuously monitoring,” Petitioner tries to gloss over the glaring gap with a generic POSITA “understanding,” asserting that a POSITA would have recognized—or at minimum found it obvious—that a wireless access point must continuously monitor connection requests by client devices to facilitate network access. Petition at 57 (citing Ex. 1003 ¶155). The declaration merely parrots the Petition and, more tellingly, neither the

Petition nor the expert's declaration provides a single citation to Subbiah or any evidence for this limitation. See Petition at 57; *see also* Ex. 1003 ¶¶154–55. The July Memorandum was clear that failures like this cannot be covered up by reliance on a POSITA knowledge. Petitioner's disregard for Rule 104(b)(4) provides a compelling reason for the Director to deny institution.

VII. CONCLUSION

For the reasons discussed above, Patent Owner respectfully requests that the Board deny Petitioner's Petition for *Inter Partes* Review of the '336 patent.

Dated: January 20, 2026 Respectfully submitted,

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CERTIFICATE OF WORD COUNT UNDER 37 CFR § 42.24(d)

Under 37 C.F.R. § 42.24(d), the undersigned certifies that the word count for this Patent Owner's Preliminary Response to the Petition for *inter partes* review totals 4,510 words, excluding the parts exempted by 37 C.F.R. § 42.24(a). The word count was made using the built-in word count function in the Microsoft® Word software used to prepare this document.

Dated: January 20, 2026

Respectfully submitted,

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I certify that I caused to be served a true and correct copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE and accompanying exhibit by email to the electronic service addresses for Petitioner on the date indicated below:

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