

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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FORTINET, INC.,  
Petitioner,

v.

NETSKOPE, INC.,  
Patent Owner.

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U.S. Patent No. 8,543,710

Case No.: IPR2026-00042

**NETSKOPE, INC.'S BRIEF FOR DISCRETIONARY DENIAL**

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## **EXHIBIT LIST**

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

## **I. Introduction**

Under the October 17 *Open Letter* and *Memorandum* by the Director of the United States Patent and Trademark Office (the “October Memorandum”), the decision to institute an *inter partes* review is reclaimed by the Director who will decide, based on two briefings, whether (i) discretionary factors or (ii) merits and other non-discretionary issues warrant denial of the petition. Regarding the discretionary factors, the October Memorandum explained that “[t]he Office has issued more than 580 decisions under the Interim Processes, providing substantial guidance on how the Director will handle discretionary considerations.” October Memorandum at 5. Pursuant to the October Memorandum, Patent Owner, Netskope, Inc., requests that the Director discretionarily deny Petitioner’s, Fortinet Inc.’s, Petition for *Inter Partes* Review (“IPR”) of U.S. Patent No. 8,543,710 (the “’710 patent”) for the reasons below.

Discretionary denial is warranted here for several reasons. First, the ’710 patent was issued on September 24, 2013, and has been *in force for over twelve years*, creating strong settled expectations for Patent Owner. The Director’s office has made clear that “the longer the patent has been in force, the more settled expectations should be.” *Dabico Airport Sols. Inc. v. AXA Power ApS*, IPR2025-00408, Paper 21 at 2 (Director Decision, June 18, 2025).

Discretionary denial is also warranted because of Petitioner's inconsistent claim construction positions in the district court and IPR proceedings. While Petitioner argues that multiple claim limitations are indefinite in its district court preliminary invalidity contentions, Petitioner makes no assertions about indefiniteness of those claim limitations in the instant IPR and alleges that they are taught or suggested by the Petition's references. These types of inconsistent positions have been clearly called out by the Director's recent presidential and informative decisions, and warrant discretionary denial of the Petition.

Furthermore, institution would waste the Patent Office's valuable resources in a duplicable effort with the district court. The '710 patent's validity is being adjudicated in a parallel proceeding, *Netskope, Inc. v. Fortinet, Inc.*, Case No. 4-25-cv-02360 (N.D.Cal., Mar. 7, 2025) (the "District Court Litigation"), which will require the district court to evaluate many of the same validity questions raised in the Petition, regardless of the Director's decision on whether to institute an IPR trial or not. Notably, the District Court Litigation is already moving at a steady pace, with preliminary invalidity contentions having been served back in August 2025 and the *Markman* hearing on claim construction to be held in less than two months. Petitioner wants it both ways, as no *Sotera* stipulation has been filed in this IPR matter.

The Petition is also substantively flawed and lacking in merit. Grounds 1-2 and 3-4 are amalgamated in a way that fails to distinguish between § 102 and § 103 challenges, and Petitioner impermissibly relies on the knowledge of a person of ordinary skill in the art (“POSITA”) for limitations that the Petition’s references fall short of disclosing or teaching. Additionally, the Petition relies on sections of a reference, Roskind, that are not prior art with respect to the challenged claims because they were disclosed after the filing date of the ’710 patent.

Thus, the totality of circumstances strongly favors discretionary denial.

## **II. Strong Settled Expectations Favor Discretionary Denial**

Many prior decisions by the Office, in compliance with the Interim Process guidelines, have established that “[s]ettled expectations of the parties, such as the length of time the claims have been in force,” is a relevant factor when determining whether to deny institution. *See* Memorandum re: Interim Processes for PTAB Workload Management (Mar. 26, 2025) at 2. Here, this factor is not only relevant but compelling.

Patent Owner’s expectations of the ’710 patent are clearly well settled. The ’710 patent was issued on September 24, 2013, making this patent more than 12 years old. The Office has consistently denied IPRs challenging such longstanding patents, making the age of the ’710 patent reason enough to warrant discretionary denial. *See Google LLC v. Cellular South, Inc.*, IPR2025-00875, Paper 10 at 2-3

(denying institution for a 7-year-old patent); *see also Amazon.com, Inc. et al. v. Soundclear Technologies LLC*, IPR2025-01067, Paper 15 at 2 (denying institution for a 10-year-old patent); *see also Intel Corp. et al. v. General Video, LLC*, IPR2025-01036, Paper 14 at 3 (denying institution for a 10-year-old patent). *See also TankLogix, LLC v. SitePro, Inc.*, IPR2025-00648, Paper 10 at 2-3 (denying institution for 11-year-old patent); *see also Microsoft Corp. v. TS-Optics Corp.*, IPR2025-00767, Paper 13 at 2 (denying institution for a 17-year-old patent despite having previously expired due to nonpayment of maintenance fee by prior owner and subsequent revival by the present patent owner TS-Optics Corporation<sup>1</sup>).

Moreover, discretionary denial due to a patent owner's settled expectations does not require a petitioner's prior knowledge or awareness of the patent. "Actual notice of a patent or of possible infringement is not necessary to create settled expectations." *Dabico*, Paper 21 at 3. There, the Director reminded parties, like Petitioner, that issued patents are always "publicly available to provide notice to the public, other inventors, competitors, and commercial interests" and capable of finding "using the Office's automated search systems as well as publicly available resources on the Internet." *Id.* Here, Petitioner, Fortinet, Inc., is a sophisticated

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<sup>1</sup> *Microsoft Corp. v. TS-Optics Corp.*, IPR2025-00767, Paper 13 at 2-3.

actor with a substantive patent portfolio in network communications and security,<sup>2</sup> having acquired more than a dozen companies and their IP in the relevant technology space since 2009 (Ex. 2007 at 2-3) and thus is likely aware of patent activity by its competitors in that technology area.

Therefore, all evidence supports Patent Owner's strong settled expectations for the '710 patent, which has been in force for more than 12 years.

### **III. Petitioner's Inconsistent Claim Construction Positions Favor Denial**

The Petition contends that only one claim term, "subordinate to," is to be construed under the plain and ordinary meaning. Petition at 14-15. The Petition then provides Petitioner's proposed construction for the above term, while at the same time arguing that this term cannot be found in the detailed description of the '710 patent. *Id.*

In contrast, Fortinet's preliminary invalidity contentions filed in the district court identifies as allegedly indefinite six claim limitations (reproduced below), only one of which contains the term "subordinate to." Ex. 2002 at 61. Petitioner's district court position states:

[v]arious Asserted Claims identified below do not comply with the requirements pre-AIA 35 U.S.C. § 112, ¶ 2, for failing to particularly

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<sup>2</sup> By their own account, Fortinet, Inc. has more than 1,500 patents. Ex. 2006 at 1.

point out and distinctly claim "the subject matter which the applicant regards as his invention" for the following reasons.... The following chart identifies the claims in which the identified terms and phrases explicitly appear, although those identified terms and phrases are also incorporated into additional dependent Asserted Claims.

*Id.* at 60.

**Excerpts from Petitioner's District Court Preliminary Invalidity Contentions**

| Patent | Claim(s)            | Indefinite Term and/or Phrase                                                                                                                                                                  |
|--------|---------------------|------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------------|
| '710   | 1                   | "at a network access gateway device between a local network and the Internet, selecting a client device in a first network segment of the network"                                             |
| '710   | 1, 6, 8, 12, 15, 20 | "restricting all network traffic emanating from the client device to one or more network destination addresses that are not in or subordinate to the first network segment"                    |
| '710   | 1, 8, 15            | "rendering a web page to display on the client device from the network access gateway device"                                                                                                  |
| '710   | 1, 8, 15            | "responsive to[the] implementation of one of the plurality of quarantine control function of the client device"                                                                                |
| '710   | 2, 9, 16            | "wherein the action requires the user to obtain and execute abnormal behavior scanning software from a server machine running at one of the one or more allowed network destination addresses" |
| '710   | 7, 14               | "perform[ing] all of the plurality of quarantine control functions over the client device"                                                                                                     |

Setting aside the term containing "subordinate to," the Petitioner fails to mention any assertions of indefiniteness for other claim limitations (highlighted in red boxes) in the IPR and instead explains how the various prior art references teach or suggest those terms that Petitioner deemed indefinite in district court. *See, e.g.*, Petition at 22-24, 28-32.

Petitioner's inconsistent claim constructions are yet another reason for denying the Petition. The Office has made its position regarding this issue clear in both *Revvo Technologies v. Cerebrum*, IPR2025-000632, Paper 20 (Precedential) and *Tesla v. Intellectual Ventures II LLC*, Paper 18 (Informative). Similar to *Revvo Technologies* and *Tesla*, Petitioner, Fortinet Inc., has decided to pursue differing claim construction positions without any explanations whatsoever in the Petition about the reasons for such divergent constructions. Therefore, the Petition should be discretionarily denied.

#### **IV. The *Fintiv* Factors Favor Denial**

As established in the precedential case of *Apple v. Fintiv*, the Director considers six factors when exercising discretion whether to deny an *inter partes* review in view of a parallel proceeding. *Apple v. Fintiv*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (precedential). Those factors are: (1) whether the district court granted a stay or evidence exists that one may be granted if a proceeding is instituted; (2) proximity of the court's trial date to the projected statutory deadline for a final written decision; (3) investment in the parallel proceeding by the district court and the parties; (4) overlap between issues raised in the petition and in the parallel proceeding; (5) whether the petitioner and the defendant in the parallel proceeding are the same party; and (6) other circumstances that impact the exercise of discretion, including the merits. *Id.*

The majority of these *Fintiv* factors, i.e., factors 3-6, strongly weighs in favor of the Director denying institution of this IPR in view of the ongoing District Court Litigation.

**A. *Fintiv* Factors 1-2**

Factors 1 and 2 are either neutral or favor Petitioner. The district court case has been assigned to District Court Judge, Haywood S. Gilliam, who has demonstrated propensity to stay the litigation pending IPR institution. *See* Ex. 2004. Here, Petitioner's motion to stay the litigation is opposed by Patent Owner, with a hearing scheduled on this issue, *inter alia*, on January 8, 2026. Ex. 2001 at 2. Yet, in prior decisions, even for IPR cases in which the parallel district court case has already been stayed, the Office has denied institution due to Patent Owner's strong settled expectations, as is the case here for the '710 patent. *See again Amazon*, IPR2025-01067, Paper 15 at 2-3 (discretionarily denying institution based on holistic assessment of all arguments and evidence, including a stay in parallel district court proceeding and the patent owner's "strong settled expectations" of three patents in force for ten, eight, and ten years).

Also, it is possible—albeit not certain—that the district court trial would begin after a final written decision ("FWD") by the PTAB if an IPR trial was instituted. *See* Ex. 2005, showing Judge Gilliam's average time to trial of 2 years, 10.6 months. Regardless of that potential outcome, the Director's office has shown this factor is

not weighted as heavily when there are strong settled expectations. *See again TS-Optics*, IPR2025-00767, Paper 13 at 2 (where Director discretionarily denied IPR based primarily on “strong settled expectations” despite the petitioner’s arguments on the anticipated trial date in the parallel district court proceeding being “nearly 8-10 months after the anticipated final written decision” (*id.*, Paper 12 at 28-29)).

**B. *Fintiv* Factors 3-5**

Factors 3-5 strongly favor Patent Owner because the two parallel proceedings deal with the same parties, substantial investment by both, and multiple overlapping issues.

The parties are the same (factor 5). Patent Owner is the plaintiff that brought an action for patent infringement of nine patents, including the '710 patent, in the district court against the defendant, Petitioner.

There has already been significant investment by the parties in the parallel district court proceeding to date with significantly more investment by the time of the institution decision in April 2026 (factor 3). For instance, both parties have served their initial claim constructions on the opposing party months ago, and the *Markman* hearing will be concluded by February 6, 2026. *See* Ex. 2001 at 2. Moreover, Petitioner already challenged the validity of the challenged claims of the '710 patent in the District Court Litigation (*see* Ex. 2003) and served their preliminary invalidity contentions on Patent Owner on August 15, 2025 (Ex. 2002

at 2, 80), nearly two months before filing the Petition for *inter partes* review at the PTAB on October 13, 2025. Critically, Petitioner did not file any stipulations per *Sand Revolution* or *Sotera* for this IPR matter and continues the pursuit of the same and additional invalidity challenges in the District Court Litigation. Therefore, the institution of this IPR proceeding would result in duplicative adjudication of the same issues, risks divergent results, and would amount to waste of judicial resources and the parties' investments in both the district court and at the PTAB.

With respect to factor 4, the Petition's invalidity grounds substantially overlap with Petitioner's preliminary invalidity contentions served on Patent Owner. Petition at 10; Ex. 2002 at 16-17; *see also* Ex. 2003. In the District Court Litigation, Petitioner contends that the same claims challenged in the IPR are invalid based on the same grounds in the Petition.<sup>3</sup> *See* Petition at 10; Ex. 2003 at 1-52.

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<sup>3</sup> Petitioner's invalidity contention charts in Ex. 2003 assert, on pg. 1: "[a]s illustrated in the chart below, Roskind anticipates the asserted claims of the '710 Patent. To the extent Roskind is found not to expressly disclose certain limitations in the asserted claims, such limitations are inherent. To the extent Roskind is found not to anticipate any asserted claims or claim elements of the '710 Patent, the reference nevertheless renders those claims or claim elements obvious under 35 U.S.C. § 103, either alone or in combination with other art identified in the cover

Because Petitioner is asserting the same grounds (Roskind or Gleichauf alone or in combination with Short) in both proceedings, Petitioner has created redundancy that risks divergent results and amount to a waste of resources—avoidable through discretionary denial.

**C. *Fintiv* Factor 6**

Finally, for factor 6, there are other circumstances that should impact the Director's exercise of discretion to deny the IPR. The Petition's invalidity grounds lack merit even under a cursory review, and close examination reveals significant flaws that cause each ground to fail. While those shortcomings will be described in detail in the forthcoming Patent Owner Preliminary Response, the following provides a few highlights that illustrate significant deficiencies of the Petition.

**1. The Grounds fail to delineate between § 102 and § 103 arguments or properly assert either category.**

Grounds 1-2 and 3-4 of the Petition assert unpatentability under the anticipation standard of § 102 and the obviousness standard of § 103, respectively, but are presented together in a manner that fails to fully or clearly articulate either

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pleading or herein.” Ex. 2003 at 1. Petitioner makes similar statements regarding Gleichauf and alleges that Short can be combined with any of the above references. *See id.* at 53, 94.

theory. *See* Petition at 17 (“A. Grounds 1 and 2: Claims 1-20 Are Anticipated Or At Minimum Rendered Obvious Over Roskind”); *see also id.* at 46 (“B. Grounds 3 and 4 – Claims 1-20 Are Anticipated Or At Minimum Rendered Obvious Over Gleichauf.”). Due to this lack of clarity, the grounds of the Petition are substantively deficient and noncompliant with 35 U.S.C. § 312(a)(3),<sup>4</sup> thereby favoring discretionary denial.

First, it is unclear whether the Petition intends to raise both § 102 and § 103 arguments. Within this combined hetero-ground, the Petition impermissibly conflates anticipation and obviousness, shifting theories across the same parsed claim elements without coherent analysis.

For example, in Claim 1, the Petition uses the phrase “Roskind discloses, or at minimum renders obvious, [the claim limitation]” for each of elements [1a],

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<sup>4</sup> 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)

[1b(a)], [1b(b)] and [1(c)] (Petition at 22, 28, 32),<sup>5</sup> provides quotations from certain sections of Roskind, and then repeats the same statement that “Roskind discloses, and at minimum renders obvious [the claim limitation].” *See e.g., id.* at 34. While, in some instances, the Petition goes on to provide a contrived rationale for obviousness based on practically identical statements in Fortinet’s expert declaration (*see e.g., id.* at 34-45; Ex. 1003 at ¶100), there is no explanation as to why those claim limitations are anticipated, or what is the deficiency in Roskind that prompted the Petitioner to shift to obviousness rationale.

Petitioner cannot have it both ways. If it proceeds on anticipation, it must identify where Roskind or Gleichauf disclose **each and every element and limitation** of the challenged claim. It does not. That failure is dispositive under § 102, and the anticipation theory collapses at the threshold. If instead Petitioner proceeds on obviousness, it must do far more than gesture at the prior art. It must demonstrate a clear teaching, suggestion, or motivation in the art for every claimed feature and supply a coherent rationale explaining why a POSITA would have

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<sup>5</sup> Petitioner’s strategy of using “[Reference] discloses, or at minimum renders obvious” persists throughout the Petition for both Roskind and Gleichauf, and for both independent and dependent claims. *See e.g.,* Petition at 37, 42, 43, 49-50, 52-53, 55, 57, 60-61, 64-66.

combined those teachings to arrive at the claimed invention with a reasonable expectation of success. Petitioner does neither. Its obviousness case is devoid of a feature-by-feature showing and untethered to the factors articulated in *Graham v. John Deere Co.*, 383 U.S. 1 (1966) and reiterated in *KSR International Co. v. Teleflex Inc.*, 550 U.S. 398 (2007). The court has “repeatedly emphasized that an obviousness inquiry requires examination of all four *Graham* factors and that an obviousness determination can be made only after consideration of each factor.” *Nike, Inc. v. Adidas AG*, 812 F.3d 1326, 1335 (Fed. Cir. 2016). Here, the Petition lacks articulation of the second *Graham* factor (ascertaining the differences between the claimed invention and the prior art). While arguing such differences risks undercutting one’s anticipation arguments, Petitioner in this case chose to avoid taking the risk at the expense of ignoring the legal standard of obviousness.

The improper ground not only requires Patent Owner to respond to multiple incomplete arguments but also would impel the Board, if the Petition is instituted, to analyze multiple unarticulated invalidity grounds under multiple legal standards. Thus Patent Owner is forced to respond to both anticipation and obviousness arguments within the limited word count requirements, despite neither theory being sufficiently explained for Patent Owner to appropriately rebut. Petitioner has improperly shifted the burden to the Board and to Patent Owner, which warrants dismissal of the Petition based on discretionary considerations.

**2. Petition's invalidity grounds based on Roskind fail because they rely on sections of Roskind patent that are not prior art.**

The '710 patent was filed on March 10, 2005, claiming priority to a provisional application filed on March 10, 2004. Ex. 1001 at front page. The Petition asserts that the challenged claims have a priority date of no earlier than March 10, 2005, and are not entitled to early priority date of the provisional application. Petition at 11-12. Patent Owner does not agree with Petitioner's assertions regarding the priority date of the challenged claims. But even if Petitioner is assumed to be correct, the Petition relies on sections of Roskind that were not part of the Roskind Provisional, and thus Petitioner's invalidity grounds based on Roskind necessarily fail.

Specifically, Roskind was filed on September 27, 2005, claiming priority to a provisional application, filed September 27, 2004. Ex. 1005 at front page. Because Roskind was filed after the '710 patent, only those portions of Roskind that were described in the Roskind Provisional can be prior art against the challenged claims. In evaluating the prior art status of Roskind, Petitioner conducts an unnecessary

*Dynamic Drinkware* analysis (Petition at 4-9)<sup>6</sup> and asserts that Roskind is prior art under pre-AIA 35 U.S.C. § 102(e). *Id.* at 9, 17. Petitioner then incorrectly asserts: “Roskind Provisional “also provide[s] written description support for the specific portions of the patent specification identified and relied on in the prior art rejection” and exemplary cites thereto will be included in the analysis below.” *Id.* at 9.

The Petition, however, contradicts Petitioner's statement. Roskind includes numerous sections that were not described in the Roskind Provisional, including 2:54-58, 3:10-23, 3:24-31, 4:11-15, 4:43-51, 5:21-65, 6:27-36, 6:57-7:59, 11:57-12:13, 16:34-38, 18:38-43, and 19:21-51, and Figures 2B, 3B, 3C, 3D, 4B, 4C, 10B and 19B.<sup>7</sup> The Petition relies on some of these very same sections of Roskind (“non-prior art sections of Roskind”) to argue anticipation/obviousness of the challenged claims. While the Preliminary Patent Owner Response will provide additional explanations, the following are a few examples of Petition's use of non-prior art sections of Roskind:

- Grounds 1-2, Claim [1a]: relies on Roskind, 11:57-12:3 (Petition at 22);

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<sup>6</sup> This type of analysis is only relevant to AIA patents and not to pre-AIA patents like the '710 patent. *See Penumbra, Inc. v. RapidPulse, Inc.*, IPR2021-01466, Paper 34 at 32-33 (Mar. 10, 2023).

<sup>7</sup> The citations are col./line numbers, e.g., 2:54-58 represents col. 2, lines 54-58.

- Grounds 1-2, Claim [1c]: relies on Roskind, 6:63-7:23 (*id.* at 34);
- Grounds 1-2, Claim [1c]: relies on Roskind, 11:57-12:13 (*id.*); and
- Grounds 1-2, Claim 2: relies on Roskind, 6:63-7:23 (*id.* at 38).

The flaws in Grounds 1-2 that stem from relying on non-prior art sections of Roskind carry over to Petition's Ground 5 that uses Roskind in combination with Short (*id.* at 67-72), further illustrating the weakness of the Petition and warranting its discretionary denial to avoid waste of PTAB resources.

**3. Petitioner improperly relies on POSITA's knowledge instead of disclosures or teachings in the prior art references.**

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, as the Petition impermissibly relies on the knowledge of a POSITA to substitute for significant gaps in the references used against the challenged claims.

For example, in Claim 4, Petitioner cites to no sections of Roskind, and while referring to Claim 1, entirely backfills the required operations in Claim 4 with the knowledge of a POSITA. Petition at 40-41. The use of a POSITA to substitute for missing teachings of the references continues in Grounds 1-2 for Claim 5 (*id.* at 41) and Claim 6 (*id.* at 42), and further in Grounds 3-4 for Claim 1, element [1(a)] (*id.* at 55), element [1b(b)] (*id.* at 57), element [1c] (*id.* at 59-60), Claim 6 (*id.* at 64-65), and others.

The July Memorandum was clear that failures like this cannot be covered up by reliance on a POSITA's knowledge. Petitioner's disregard for Rule 104(b)(4) provides a compelling reason for discretionary denial of the Petition.

## **V. Conclusion**

Patent Owner's settled expectations alone warrant discretionary denial of instituting *inter partes* review of the '710 patent. Yet, this taken together with the *Fintiv* factors and other considerations discussed herein further weigh in favor of the Director exercising discretion to deny this IPR.

Dated: December 22, 2025

Respectfully submitted,

/Babak Tehranchi/

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**CERTIFICATE OF SERVICE**

I hereby certify that on this 22<sup>nd</sup> day of December, 2025, true and correct copies of the foregoing NETSKOPE, INC.'S BRIEF FOR DISCRETIONARY DENIAL and EXHIBITS were served via electronic mail on Petitioner's counsel at the following address:

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