

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

METACLUSTERLT, UAB,
Petitioner,

v.

BRIGHT DATA LTD.,
Patent Owner.

PGR2022-00052
Patent 11,272,034 B2

Before THOMAS L. GIANNETTI, SHEILA F. McSHANE, and
RUSSELL E. CASS, *Administrative Patent Judge*.

McSHANE, *Administrative Patent Judge*.

JUDGMENT
Final Written Decision
Granting-in-Part and Denying-in-Part
Patent Owner's Revised Non-Contingent Motion to Amend
35 U.S.C. § 328(a)

I. INTRODUCTION

Metacluster LT, UAB (“Petitioner”)¹ filed a Petition requesting a post-grant review of claims 1–27 (the “challenged claims”) of U.S. Patent No. 11,272,034 B2 (Ex. 1001, the “’034 patent”). Paper 1, 1 (“Pet.” or “Petition”). Bright Data Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). We instituted post-grant review of the challenged claims on all asserted grounds. Paper 7 (“Inst. Dec.”).

After institution, Patent Owner filed a Non-Contingent Motion to Amend (Paper 15), and Petitioner filed an Opposition (Paper 16). We issued Preliminary Guidance on Patent Owner’s Motion. Paper 18. In the Preliminary Guidance, we provided information indicating our initial, preliminary, and non-binding views on whether Patent Owner had shown that it has satisfied the statutory and regulatory requirements for the proposed substitute claims. *See* Notice, 84 Fed. Reg. at 9,497; *see also* 35 U.S.C. § 326(d); 37 C.F.R. § 2.221; *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (“*Lectrosonics*”). The Preliminary Guidance concluded that, at that stage of the proceedings, and based on the then-current record, Patent Owner had not sufficiently shown that the subject matter of the claim amendments was

¹ At the time of the filing of the Petition, Metacluster LT, UAB identified Code200, UAB, Teso LT, UAB, Oxysales, UAB, and coretech lt, UAB as other real parties-in-interest. Pet. 2. In Updated Mandatory Notices, Petitioner states that:

Oxysales and [M]etacluster have been merged into Teso, with Teso succeeding to all of Oxysales and Metacluster’s assets, rights, and obligations. Teso is now operating as Oxylabs, UAB. Oxylabs, UAB is wholly owned by coretech.

Paper 9, 1.

adequately supported by the application for the '034 patent. Paper 18, 5–10. More specifically, the Preliminary Guidance concluded that there was insufficient support for the limitations reciting the use of a Cellular Service Provider (“CSP”). *Id.* at 6–8. The Preliminary Guidance also found that the provisional application for the '034 patent failed to provide written description support for the element of “third server” in the proposed substitute claims. *Id.* at 8–10.

Patent Owner then filed a Non-Contingent Revised Motion to Amend. Paper 19 (“RMTA or Rev. Mot.”). The Revised Motion seeks to cancel claims 1–27 and substitute the cancelled claims with substitute claims 28–51. *Id.* at 2. Petitioner filed an Opposition to Patent Owner’s Revised Motion to Amend (Paper 21, “RMTA Opp.”); Patent Owner filed a reply in support of its motion to amend (Paper 25, “RMTA Reply”); and Petitioner filed a sur-reply (Paper 26, “RMTA Sur-Reply”). Neither party filed an expert declaration in connection with the Motion to Amend. A hearing was conducted on January 18, 2024, and a hearing transcript (Paper 30, “Tr.”) is included in the record.

We have jurisdiction to hear this post-grant review under 35 U.S.C. § 6. This Final Written Decision is issued pursuant to 35 U.S.C. § 328(a). For the reasons discussed herein, we grant-in-part the Non-Contingent Revised Motion to Amend as to cancelling original claims 1–27 of the '034 patent. We also deny-in-part the Non-Contingent Revised Motion to Amend as to adding proposed substitute claims 28–51 to the '034 patent because Patent Owner has not demonstrated that there is adequate written description support for the proposed substitute claims.

A. Related Matters

The parties state that there is no pending litigation involving the '034 patent. Pet. 3; Paper 17, 1. The parties identify several litigations, post grant reviews, and reexaminations for other patents that are related to the '034 patent. Pet. 2–8; Paper 17, 1–7.

B. The '034 Patent

The '034 patent is titled “System And Method For Improving Internet Communication By Using Intermediate Nodes” and issued on March 8, 2022, from an application filed on April 27, 2021. Ex. 1001, codes (22), (45), (54). The patent is subject to a terminal disclaimer. *Id.* at code (*). The patent is a continuation of Application No. 16/524,026 (now U.S. Patent No. 11,012,530); Application No. 16/214,451 (now U.S. Patent No. 10,440,146); Application No. 15/663,762 (now U.S. Patent No. 10,277,711); and Application No. 14/930,894 (now U.S. Patent No. 9,742,866); as well as a divisional of Application No. 14/468,836 (now U.S. Pat. No. 9,241,044); and which claims priority to U.S. Provisional Application No. 61/870,815. *Id.* at code (60).

The '034 patent is directed to a method for fetching content from a web server to a client device using tunnel devices serving as intermediate devices. Ex. 1001, code (57). The client device accesses an acceleration server to receive a list of available tunnel devices. *Id.* Requested content may be partitioned into slices, with the client device sending a request for the slices to the available tunnel devices. *Id.* The tunnel devices may, in turn, fetch slices from the data server and send the slices to the client device, where the content is reconstructed from the received slices. *Id.*

A client device may also serve as a tunnel device, which serves as an intermediate device to other client devices. Ex. 1001, code (57). The

selection of tunnel devices to be used by a client device may be made in the acceleration server, in the client device, or in both. *Id.* Partitions into slices may be overlapping or non-overlapping, and the same slice, or the whole content, may be fetched via multiple tunnel devices. *Id.*

C. Original Claims

The Petition relies on grounds of unpatentability under 35 U.S.C. § 103, to challenge original claims 1–27 of the '034 patent. *See* Pet. 12. The grounds are:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–27	103 ²	Mithyantha ³
19	103	Mithyantha, RFC 2616 ⁴
1–27	101	patent-ineligible subject matter

The Revised Motion to Amend includes a non-contingent request to cancel original claims 1–27 of the '034 patent, which are all of the claims challenged in the Petition. *See* RMTA 1–2. Petitioner presents no opposition to the portion of the Revised Motion to Amend seeking cancellation of the original claims. *See generally* RMTA Opp. Accordingly, we grant Patent Owner's request to cancel original claims 1–27. As a result, we need not reach the grounds of unpatentability asserted in the Petition against these original claims.

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 287–88 (2011), which amended 35 U.S.C. § 103, was effective on March 16, 2013 and applies here.

³ U.S. Patent No. 8,972,602 B2, issued March 3, 2015, application date June 15, 2013 (Ex. 1009).

⁴ Hypertext Transfer Protocol—HTTP/1.1, Network Working Group, RFC 2616, The Internet Society, 1999 (Ex. 1005).

D. Substitute Claims

The Revised Motion to Amend proposes substitute claims 28–51.

RM TA 2. Claim 28 is the only independent claim. Claim 28 is illustrative, and reproduced below, with identifiers included in brackets.

28 [28.pre] A method for use with a first content identified by a first content identifier and stored in a first web server, for use with a second content identified by a second content identifier and stored in a second web server, for use with a group of more than one intermediary client devices wherein each intermediary client device in the group is connected to the Internet using a Cellular Service Provider (“CSP”) and wherein there is more than one CSP used by the more than one intermediary client devices in the group and wherein each intermediary client device in the group is associated with a physical geographical location and wherein there is more than one physical geographical location associated with the more than one intermediary client devices in the group, and for use with a third server, the method comprising:

[28.a] determining, by each intermediary client device in the group, its status as not-congested or congested, wherein the status is determined to be not-congested if the intermediary client device detects a resource utilization is below a set threshold, wherein the status is determined to be congested if the intermediary client device detects a resource utilization is above a set threshold;

[28.b] in response to the determining, sending, by each intermediary client device in the group to the third server, a message identifying its status as not-congested or congested;

[28.c] identifying, by a first requesting client device, a first CSP that is used by at least one intermediary client device in the group;

[28.d] identifying, by the first requesting client device, a first geographical location that is associated with at least one intermediary client device in the group;

[28.e] in response to the identifying of the first CSP and the identifying of the first geographical location, selecting, by the first requesting client device or by the third server, an intermediary client device from the group based on its status, its use of the first CSP to connect to the Internet, and its association with the first geographical location;

[28.f] sending, by the first requesting client device to the third server, the first content identifier;

[28.g] receiving, by a selected intermediary client device from the third server, the first content identifier;

[28.h] sending, by the selected intermediary client device to the first web server, the first content identifier;

[28.i] receiving, by the selected intermediary client device from the first web server, the first content;

[28.j] sending, by the selected intermediary client device to the third server, the first content;

[28.k] receiving, by the first requesting client device from the third server, the first content;

[28.l] sending, by the first requesting client device to the third server, the second content identifier;

[28.m] receiving, by the selected intermediary client device from the third server, the second content identifier;

[28.n] sending, by the selected intermediary client device to the second web server, the second content identifier;

[28.o] receiving, by the selected intermediary client device from the second web server, the second content;

[28.p] sending, by the selected intermediary client device to the third server, the second content; and

[28.q] receiving, by the selected intermediary client device from the third server, the second content,

[28.r] wherein each intermediary client device in the group is a portable cellular telephone device that stores, operates, or uses, a mobile operating system.

Ex. 2024 (RMTA App'x A2), 1–4.

E. Petitioner's Assertions

Petitioner asserts that Patent Owner bears the burden for compliance with the legal requirements set forth in 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121, and that Patent Owner fails to ensure that its motion sets forth written description support for the proposed revised substitute claims. RMTA Opp. 2, 5–20 (citing *Lectrosonics* at 4, 7–8).

II. ANALYSIS OF THE MOTION TO AMEND

A. *PGR Eligibility*

As a threshold issue, we must determine if the '034 patent is eligible for post-grant review. The post-grant review provisions of the America Invents Act (AIA) apply to a patent that contains a claim with an effective filing date on or after March 16, 2013. *See* AIA, Pub. L. No. 112-29, 125 Stat. 284 (2011), §§ 3(n)(1), 6(f)(2)(A). The statute defines the “effective filing date” as:

(A) if subparagraph (B) does not apply, the actual filing date of the patent or the application for the patent containing a claim to the invention; or

(B) the filing date of the earliest application for which the patent is entitled, as to such invention, to a right of priority under section 119, 365(a), 365(b), 386(a), or 386(b) or to the benefit of an earlier filing date under section 120, 121, 365(c), or 386(c).

35 U.S.C. § 100(i)(1).

Determining whether a patent is subject to the first-inventor-to-file provisions of the AIA, and therefore eligible for post-grant review, is straightforward when the patentee filed the application from which the patent issued on or after March 16, 2013, without any priority claim to an

application filed prior to March 16, 2013. The application that matured into the '034 patent is such an application. The earliest priority claim for the '034 patent is an application filed August 28, 2013. Ex. 1001, code (60). Accordingly, the effective filing date of the '034 patent is no earlier than August 28, 2013, making it eligible for post-grant review.

Additionally, “[a] petition for a post-grant review may only be filed not later than the date that is 9 months after the date of the grant of the patent.” 35 U.S.C. § 321(c). The '034 patent issued March 8, 2022, and the Petition was accorded a filing date of July 21, 2022, just over 4 months after the grant of the '034 patent. Ex. 1001, code (45); Paper 5, 1. Accordingly, Petitioner timely filed the Petition.

B. Level of Ordinary Skill in the Art

Petitioner contends a person of ordinary skill in the art “would have had at least a bachelor’s degree in Computer Science or related field (or equivalent experience), and at least two years’ experience working with and programming networked computer systems.” Pet. 13 (referencing Ex. 1002 ¶ 33).

In our Institution Decision, we adopted Petitioner’s proposed level of ordinary skill in the art, with the exclusion of “at least” because it introduces ambiguity. Inst. Dec. 8. Patent Owner “does not dispute the Board’s findings on the qualifications of a POSA [person of ordinary skill in the art] for purposes of this proceeding.” See RMTA 13.

We determine that Petitioner’s definition, with the exclusion of “at least,” is consistent with the prior art of record and the skill reflected in the Specification of the '034 patent and we use this level of skill here in the evaluation of the Revised Motion to Amend.

C. Claim Construction

In post-grant reviews, we interpret a claim “using the same claim construction standard that would be used to construe the claim in a civil action under 35 U.S.C. 282(b).” 37 C.F.R. § 42.200(b). Under this standard, we construe the claim “in accordance with the ordinary and customary meaning of such claim as understood by one of ordinary skill in the art and the prosecution history pertaining to the patent.” *Id.*

Patent Owner argues that “claim construction is not necessary” and that “the meaning of the claims would be easily understood by a POSA.” RMTA 13. In the Petition, Petitioner proposed constructions for the terms “client device” and “first server,” and the original claims were rendered obvious under this construction. Pet. 23–27. Petitioner does not assert that the substitute claims of the Revised Motion to Amend are anticipated or rendered obvious by prior art or are patent ineligible. *See generally* RMTA Opp. Nor does Petitioner’s patentability challenge of the substitute claims contend that express construction is needed. *See generally id.*

For purposes of this Decision, we determine that express claim construction is unnecessary. We need only construe terms that are necessary to resolve disputes. *See Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017); *Vivid Techs., Inc. v. Am. Sci. & Eng’g, Inc.*, 200 F.3d 795, 803 (Fed. Cir. 1999) (“[O]nly those terms need be construed that are in controversy, and only to the extent necessary to resolve the controversy.”).

D. Applicable Law

Patent Owner bears the burden to ensure that its Motion to Amend complies with the legal requirements set forth in 35 U.S.C. § 326(d) and 37 C.F.R. § 42.221. *Lectrosonics*, 4, 7–8. Specifically, Patent Owner must

show that the amendments do not enlarge the scope of the claims or introduce “new matter.” *See* 35 U.S.C. § 326(d)(3); 37 C.F.R. § 42.221(a)(2)(ii)).

Lectrosonics states:

New matter is any addition to the claims without support in the original disclosure. *See TurboCare Div. of Demag Delaval Turbomach. v. Gen. Elec. Co.*, 264 F.3d 1111, 1118 (Fed. Cir. 2001) (“When [an] applicant adds a claim . . . the new claim . . . must find support in the original specification.”). Normally, a claim element without support in the original disclosure (i.e., the application as originally filed) merits a rejection under 35 U.S.C. § 112 for lack of written description support. *See, e.g., In re Rasmussen*, 650 F.2d 1212, 1214 (CCPA 1981) (“The proper basis for rejection of a claim amended to recite elements thought to be without support in the original disclosure, therefore, is § 112, first paragraph . . .”).

Lectrosonics, 7.

Thus, Patent Owner must ensure that its motion sets forth written description support for the proposed substitute claims. *See* 35 U.S.C. § 326(a)(9); 37 C.F.R. § 42.221; *Lectrosonics*, Paper 15 at 7–8. The written description test is met when the original disclosure of the application relied upon reasonably conveys to a person of ordinary skill in the art that the inventor had possession of the claimed subject matter as of the filing date. *Ariad Pharms., Inc. v. Eli Lilly & Co.*, 598 F.3d 1336, 1351 (Fed. Cir. 2010) (en banc).

E. Written Description Support for Proposed Substitute Claims
28–51

For the reasons set forth below, we determine that the original disclosure fails to set forth sufficient support for the proposed substitute claims.

Patent Owner contends that the original disclosure supports the proposed substitute claims 28–51. RMTA 17–24. Patent Owner includes a table that identifies supporting passages for each proposed limitation of these claims.⁵ *Id.* at 18–24 (citing Appendix A-1, Exs. 2012–2019, 2023). Patent Owner further includes an overview of disclosures of the ’034 patent, as well as a discussion and overview of the proposed substitute claims. *Id.* at 2–10.

Petitioner contends proposed substitute claims fail to comply with the written description requirement. RMTA Opp. 5–20.

1. “Cellular Service Provider” Limitations

Proposed substitute independent claim 28 recites a method that includes the following steps (specific new limitations references to “CSP” in the RMTA additions in bold):

[28.pre] for use with a group of more than one intermediary client devices wherein **each intermediary client device in the group is connected to the Internet using a Cellular Service Provider (“CSP”)** and wherein there is more than one CSP used by the more than one intermediary client devices in the group;

...

⁵ The ’034 patent issued from Application Ser. No. 17/241,119 (“the ’119 Application”), which through a series of continuations, is a continuation of Application Ser. No. 14/930,894, which itself is a divisional of Application Ser. No. 14/468,836 (“the ’836 Application”). Ex. 1001, code (21), (60). In its Revised Motion to Amend, Patent Owner relies upon portions of the ’119 Application specification (Ex. 2017, “Spec.” or “Specification”), as well as its figures (Ex. 2018), original claims (Ex. 2019), and abstract (Ex. 2016). Patent Owner also provides similar citations to the ’836 Application, which is contained in Exhibits 2012–2015. *See* RMTA 18–24.

[28.c] **identifying, by a first requesting client device, a first CSP that is used by at least one intermediary client device in the group;**

. . .

[28.e] **selecting, by the first requesting client device or by the third server, an intermediary client device from the group based on its status, its use of the first CSP to connect to the Internet,** and its association with the first geographical location. . . .

Ex. 2024 (RMTA App’x A2), 1–2 (underlining omitted, bolding added).

Patent Owner contends that written description support for these particular limitations (collectively, “the CSP Limitations”) is present in the Specification which supports the ’034 patent. RMTA 18–19 (citing Spec. at 27, 32, 57, 68, 69, 70, 72–74, 78, 79, 82, 85, 88, 91, 100, 110, 111, 113, 114, 117, 118, 121–124, 160, 163–165, and 184; Ex. 2018 (Figures) at Figs. 5a, 5b, 6, 11, 13, 15, 25a, 28a, 30, 31, 35, 77, and 78; Ex. 2016 (Abstract); Ex. 2019 (Original Claims) at claims 1, 8).

Petitioner disputes whether Patent Owner has identified adequate written description support in the original disclosure to support the CSP Limitations recited in proposed substitute claim 28. RMTA Opp. 5. More specifically, Petitioner contends that the relied-upon portions of the ’034 patent do not mention a CSP, and instead describe an Internet Service Provider (“ISP”), which Petitioner contends is not interchangeable with a CSP. *Id.* at 6–15. Petitioner further contends that, even if the ISP disclosures were relevant to CSPs, the ’034 patent does not provide support for the use of CSP information in the manner claimed in proposed substitute claim 28. *Id.* at 16–20.

For the reasons explained below, Patent Owner fails to provide sufficient written description support for a CSP, and the use of the CSP, as recited in proposed substitute claims 28–51.

a) An ISP is Not Interchangeable with a CSP

It is not in dispute that the '034 patent does not use the term “cellular service provider” or mention CSPs. RMTA Opp. 5; *see generally* RMTA; RMTA Reply 6–12. Patent Owner instead argues that the term CSP is interchangeable with an ISP, which is mentioned in the patent. *See, e.g.* RMTA 5–6, 8; RMTA Reply 7, 10, 12; Tr. 28:14–16, 29:12–13. According to Patent Owner, the '034 patent discloses that an ISP “‘is an organization that provides services for accessing, using, or participating in the Internet 113.’” RMTA Reply 6 (quoting Ex. 1001, 24:46–48). Patent Owner contends that because a CSP “provides access to the Internet,” a “CSP is the ISP.” *Id.* at 7; *see also* Tr. 28:21–29:6.

Petitioner responds that a person of ordinary skill would have considered a CSP and an ISP to be two distinct entities, as evidenced by two technical publications from Telektronikk.⁶ *See* RMTA Opp. 9–12 (citing Exs. 1024, 1025).

The CSP Limitations need not be recited *in haec verba* to satisfy the written description requirement. *In re Wright*, 866 F.2d 422, 425 (Fed. Cir. 1989); *All Dental Prodx LLC v. Advantage Dental Prods.*, 309 F.3d 774, 779 (Fed. Cir. 2002). The issue here, however, is whether the disclosure of the '034 patent would have reasonably conveyed to a person of ordinary skill that the inventors had possession of the CSP Limitations. *Ariad*, 598

⁶ Patent Owner has not objected to or filed a motion to exclude the Telektronikk publications or references to these publications.

F.3d at 1351. Because Patent Owner relies upon descriptions in the '034 patent of an ISP to support the CSP Limitations, *see e.g.* RMTA 8; Tr. 29:12–24, we must determine whether the ISP descriptions would have reasonably conveyed to an ordinarily skilled artisan that the inventor had possession of CSP subject matter recited in the claims.

Patent Owner's argument that a person of ordinary skill would have understood the term "ISP" as used in the Specification to be interchangeable with a CSP is unpersuasive. Patent Owner provides no supporting evidence for this contention, other than attorney argument. *See* RMTA 8 (citing Ex. 1001, 21:21–25, 24:46–48, 138:64–67); Tr. 26:16–27:4; *see also Elbit Systems of America, LLC v. Thales Visionix, Inc.*, 881 F.3d 1354, 1359 (Fed. Cir. 2018) (“'[a]ttorney argument is not evidence' and cannot rebut other admitted evidence” (quoting *Icon Health & Fitness, Inc. v. Strava, Inc.*, 849 F.3d 1034, 1043 (Fed. Cir. 2017))). Patent Owner's reliance on the '034 patent itself is equally unpersuasive, as the '034 patent does not use the term “cellular service provider” or otherwise make a suggestion that an ISP is the same as a CSP.

To the contrary, Petitioner has submitted evidentiary support for its contentions in the form of technical publications, articles published in *Telektronikk*, that support that there is “an explicit distinction between ISPs and mobile network operators (cellular service providers or CSPs).” RMTA Opp. 9–13; Exs. 1024, 1025. More specifically, the *Telektronikk* articles (Exs. 1024 and 1025) draw a distinction between a “Mobile network operator” on one hand and an “ISP” on the other. Ex. 1024, 19, Fig. 2; Ex. 1025, 28, Fig. 1 (depicting distinct “Internet Service Provider” separate from “Mobile Operator”).

We are also unpersuaded by Patent Owner's assertion that a CSP is interchangeable with an ISP because a CSP provides access to the Internet. RMTA Reply 6–9. For this assertion, Patent Owner relies upon the '034 patent's disclosures relating to a portable mobile device's use of a mobile browser connecting to the Internet using a cellular network. *Id.* at 6. The patent discloses that the cellular network infrastructure provides a Wireless Wide Area Network (“WWAN”), and that the communication may be a cellular communication. *Id.* at 6–7 (citing Ex. 1001, 21:8–11, 21:21–25, 24:46–48, 24:50–51, 138:59–67).

We do not find persuasive Patent Owner's argument that this description of a cellular network communicating with the Internet is sufficient disclosure of a CSP or shows that a CSP and an ISP are interchangeable. First, as explained above, Petitioner has submitted un rebutted evidence that cellular service providers were considered to be distinct from ISPs. *See* RMTA Sur-Reply 7 (citing Exs. 1024, 1025). In contrast, Patent Owner provides no evidence to support its assertions beyond attorney argument. *America, LLC*, 881 F.3d at 1359. Moreover, as Patent Owner acknowledges, cellphone service providers may rely on “other entities” “behind the scenes” to provide a cellphone user access to the Internet. RMTA Reply 7–8. But while a cellular service provider or mobile phone browser may have been used in a user connection, the evidentiary record supports that Internet access would have required the browser or phone connection to go through an ISP. Ex. 1024, 19, Fig. 2; Ex. 1025, 28, Fig. 1. Patent Owner fails to provide evidence to explain why an application that indirectly provided Internet access, such as a mobile browser or a cellular communications network, would itself have been considered an ISP by a person of ordinary skill in the art.

Additionally, in arguing that a CSP is an ISP, Patent Owner relies on the '034 patent Specification. *See* RMTA Reply 6–9; Tr. 28:23–26 (citing Ex. 1001, 24:46–48, 24:50–51). However, as noted, the Specification does not use the term “CSP,” and while portions of the Specification that Patent Owner references discuss or refer to ISP services, mobile browsers, and local networks, there are no disclosures or support in the Specification of how the term “CSP” might be construed to apply to them. There is also no expert testimony or other extrinsic evidence provided by Patent Owner on the meaning of the term “CSP.”

Moreover, even if Patent Owner is correct that a CSP may provide access to the Internet, that alone does not suggest an ISP is a CSP. Although Patent Owner asserts that a CSPs and ISPs are coextensive (see RMTA Reply 10; Tr. 28:17–19), Patent Owner provides no evidence that an ISP provides *cellular* telephone service, as would a *cellular* service provider (CSP). *See* Tr. 30:4–8. Additionally, there is no evidence provided by Patent Owner that voice-only cellular service plans would enable customers to access the Internet. Accordingly, we agree, as Petitioner argues in its Opposition, that “a provider of internet service and a provider of cellular service are simply not the same thing.” RMTA Opp. 9.

For the reasons given, we agree with Petitioner that a person of ordinary skill in the art would have considered an ISP as described in the '034 patent to be separate, and distinct from, a CSP. Accordingly, we find that the discussions in the patent of ISPs in the disclosures does not show possession of or provide written description support for the subject matter of the CSP Limitations.

b) Identifying A CSP Used by an Intermediary Client Device

Proposed substitute claim 28 recites “identifying, by a first requesting client device, a first CSP that is used by at least one intermediary client device.” Ex. 2024 (RMTA App’x A2), 1–2 (underlining omitted). Patent Owner argues that the ’034 patent discloses identifying an intermediary client device’s CSP during a “sign-in” process. RMTA Reply 9–10 (citing Ex. 1001, 83:64–84:10, 92:63–93:3, 93:27–30).

Petitioner asserts that the ’034 patent does not disclose a client device identifying a CSP. RMTA Sur-Reply 8–10. We agree with Petitioner that none of passages cited by Patent Owner in the ’034 patent describe “identifying, by a first requesting client device, a first CSP” as recited in the substitute claims. At most, the ’034 patent discloses determining whether devices “share the same *ISP*.” Ex. 1001, 93:27–30 (emphasis added).

As explained above, disclosure of an ISP fails to adequately support the claim’s recitation of identifying a CSP. For this reason, and on the record before us, the original disclosure fails to provide adequate written description support for the “identifying” a CSP limitation in substitute independent claim 28. Patent Owner provides no additional written description support for proposed dependent claims 29–51 that remedies the deficiencies in written description support for this CSP limitation of claim 28. RMTA 21–24. Accordingly, Patent Owner has not shown that the original disclosure provides adequate written description support for proposed substitute claims 28–51.

c) Selecting an Intermediary Client Device Based on Its Use of the CSP

Proposed substitute claim 28 recites,

selecting, by the first requesting client device or by the third server, an intermediary client device from the group based on its status, its use of the first CSP to connect to the Internet, and its association with the first geographical location.

Ex. 2024 (RMTA App'x A2), 1–2 (underlining omitted). Patent Owner argues that the '034 patent discloses selection of an intermediary client device based on various attributes of an intermediary client device, including its use of a CSP to connect to the Internet. RMTA Reply 10–12 (citing Ex. 1001, 53:2–4, 64:11–42, 90:54–57, 90:62–63, 93:22–30).

Petitioner contends that the '034 patent does not disclose selection of an intermediary client device based on its use of a CSP. RMTA Sur-Reply 10–12. We agree with Petitioner that none of passages cited by Patent Owner in the '034 patent describe selecting an intermediary client device based on its use of a specific CSP. At most, the '034 patent discloses a selection based on “the *ISP* used to connect the second device to the Internet.” Ex. 1001, 64:40–42 (emphasis added).

As explained above, disclosure of an ISP fails to adequately support the claim's recitation of selecting an intermediary client device based on a CSP. For this reason, and on the record before us, the original disclosure fails to provide adequate written description support for the “selecting” based on a CSP limitation in substitute claim 28. Patent Owner provides no additional written description support for proposed dependent claims 29–51 that remedies the deficiencies in the written description support cited for this CSP limitation of claim 28. RMTA 21–24. Accordingly, Patent Owner has not shown that the original disclosure provides adequate written description support for proposed substitute claims 28–51.

2. Sufficiency of the Argument and Evidence for Written Description Support

Petitioner argues that Patent Owner’s reliance on “string citations without any explanation as to why these citations support the limitations of each revised substitute claim” fails to meet Patent Owner’s obligation to demonstrate that the ’034 patent’s original disclosure supports the substitute claims. RMTA Opp. 2–5; RMTA Sur-Reply 2–6. Petitioner further argues that Patent Owner’s citations “cover a variety of distinct embodiments” from the ’034 patent, and fail to explain how the embodiments are being combined. RMTA Opp. 4–5.

As explained above, we determine that Petitioner has shown that the ’034 patent fails to provide sufficient written description support for claims 28–51. Accordingly, we need not reach the issue of whether Patent Owner has met its obligations to adequately identify and provide explanations for its arguments regarding written description support.

III. CONCLUSION

For the foregoing reasons, we *grant-in-part* the Motion to Amend as to cancelling claims 1–27; and *deny-in-part* the Motion to Amend as to proposed substitute claims 28–51. In summary:

Motion to Amend Outcome	Claim(s)
Original Claims Cancelled by Amendment	1–27
Substitute Claims Proposed in the Amendment	28–51
Substitute Claims: Motion to Amend Granted	
Substitute Claims: Motion to Amend Denied	28–51
Substitute Claims: Not Reached	

IV. ORDER

Accordingly, it is

ORDERED that Patent Owner's Revised Non-Contingent Motion to Amend is *granted-in-part* and claims 1–27 of U.S. Patent No. 11,272,034 B2 are cancelled;

FURTHER ORDERED that Patent Owner's Non-Contingent Revised Motion to Amend is *denied* in all other respects; and

FURTHER ORDERED that, because this is a final written decision, parties to this proceeding seeking judicial review of our decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

PGR2022-00052
Patent 11,272,034 B2

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