

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETNUT LTD.,
Petitioner,

v.

BRIGHT DATA LTD,
(f/k/a LUMINATI NETWORKS, LTD.),
Patent Owner.

IPR2021-00465
Patent 9,742,866 B2

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

McSHANE, *Administrative Patent Judge*.

PRELIMINARY GUIDANCE
PATENT OWNER'S MOTION TO AMEND

I. INTRODUCTION

On August 12, 2021, we instituted trial as to claims 15–20, 23, 24, 27, and 28 of U.S. Patent No. 9,742,866 B2 (“the ’866 patent”). Paper 11 (“Decision” or “Dec.”). After institution, Patent Owner filed a Non-Contingent Motion to Amend in which it proposes substitute claims 29–38 to replace original claims 15–20, 23, 24, 27, and 28. Paper 17 (“Motion” or “Mot.”). Patent Owner “requests non-binding preliminary guidance on the proposed, substitute claims.” Mot. 7. Petitioner filed an Opposition to the Motion. Paper 18 (“Opposition” or “Opp.”).

In the Motion, Patent Owner requests that we provide preliminary guidance concerning the Motion in accordance with the Board’s pilot program concerning motion to amend practice and procedures. Mot. 7; *see also* Notice Regarding a New Pilot Program Concerning Motion to Amend Practice and Procedures in Trial Proceedings under the America Invents Act before the Patent Trial and Appeal Board, 84 Fed. Reg. 9,497 (Mar. 15, 2019) (providing a patent owner with the option to receive preliminary guidance from the Board on its motion to amend) (“Notice”). We have considered Patent Owner’s Motion and Petitioner’s Opposition.

In this Preliminary Guidance, we provide information indicating our initial, preliminary, non-binding views on whether Patent Owner has shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend in an *inter partes* review, and whether Petitioner (or the record) establishes a reasonable likelihood that the substitute claims are unpatentable. *See* 35 U.S.C. § 316(d); 37 C.F.R. § 42.121; *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential); *see also* Notice, 84

Fed. Reg. at 9,497 (“The preliminary guidance . . . provides preliminary, non-binding guidance from the Board to the parties about the [motion to amend].”); Rules of Practice to Allocate the Burden of Persuasion on Motions to Amend in Trial Proceedings Before the Patent Trial and Appeal Board, 85 Fed. Reg. 82,923 (Dec. 21, 2020).

Patent Owner’s Motion is non-contingent.¹ Mot. 5. For purposes of this Preliminary Guidance, we focus on the amendments reflected in the substitute claims proposed in the Motion. *See* Notice, 84 Fed. Reg. at 9,497. We do not address the patentability of the originally challenged claims. *Id.* Moreover, in formulating our preliminary views on the Motion and Opposition, we have not considered the parties’ other substantive papers on the underlying merits of Petitioner’s challenges. We emphasize that the views expressed below may change upon consideration of the complete record. Additionally, the views expressed below may not apply to any revised motion to amend that Patent Owner may file in response to this Preliminary Guidance. Thus, this Preliminary Guidance is not binding on the Board when rendering its final written decision. *See id.* at 9,500.

II. PRELIMINARY GUIDANCE

A. Statutory and Regulatory Requirements

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Patent Owner has not shown a reasonable likelihood that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend.

¹ We note that Patent Owner has not filed a Patent Owner Response. Mot. 5, n.1.

1. Reasonable Number of Substitute Claims

Does Patent Owner propose a reasonable number of substitute claims? (35 U.S.C. § 316(d)(1)(B))

Yes. Patent Owner proposes one substitute claim to replace each of challenged claims 15–20, 23, 24, 27, and 28. Mot. 7. Petitioner does not argue this is unreasonable. *See generally* Opp. Patent Owner thus proposes a reasonable number of substitute claims, because there is a one-to-one relationship of claims between proposed substitute claims 29–38, and original claims 15–20, 23, 24, 27, and 28.

2. Respond to Ground of Unpatentability

Does the Motion respond to a ground of unpatentability involved in the trial? (37 C.F.R. § 42.121(a)(2)(i))

Yes. Patent Owner contends the “Board’s analysis shows the scope of the claims has been interpreted more broadly than anticipated.” Mot. 8. Thus, Patent Owner “submits the proposed, substitute claims to further narrow the challenged claims commensurate with Patent Owner’s understanding of the proper scope of the invention, specifically reciting that the claimed method uses the novel and nonobvious tunnel device (not a proxy server) to fetch fresh content (not cached content) from a web server; thereby improving content access to avoid blocking or spoofing by the web server, while also providing anonymity.” *Id.*

Petitioner does not argue otherwise. *See generally* Opp.

Under Rule 42.121, the requirement is for the amendment to be responsive to “a ground of unpatentability.” 37 C.F.R. § 42.121(a)(2)(i). Patent Owner has met this requirement by amending the claims to attempt to overcome the asserted prior art with the amendments reflected in the proposed substitute claims.

3. Scope of Amended Claims

Does the amendment seek to enlarge the scope of the claims? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

No. Patent Owner contends “substitute independent claim 29 adds only narrowing limitations.” Mot. 13. Petitioner does not argue otherwise. *See*

generally Opp. Because none of the original limitations are removed along with the addition of additional limitations, other than changing “from” to “via,”² the amendment reflected in the proposed substitute claims does not seek to enlarge the scope of the claims.

4. New Matter

Does the amendment seek to add new subject matter? (35 U.S.C. § 316(d)(3); 37 C.F.R. § 42.121(a)(2)(ii))

Yes. On this record, Patent Owner has failed to sufficiently identify adequate written description support for all elements in the proposed substitute claims. Patent Owner argues that the proposed substitute claims have written description support in the nonprovisional application from which the patent issued (application number 14/930,894), which is a divisional of nonprovisional application number 14/468,836 (the “’836 application”), which claims priority from provisional application number 61/870,815 (the “’815 provisional”). Mot. 13–14. Patent Owner provides a table setting forth exemplary support for the proposed substitute claims in the ’815 provisional and the ’836 application.³ *Id.* at 14–17. Petitioner raises three arguments as to written description support, each of which we address in turn.

Provisional Application

First, Petitioner contends that Patent Owner’s reliance on the provisional application for the ’866 patent is improper, because, according to Petitioner, under 37 C.F.R. § 1.57, “a provisional patent application is not a ‘U.S. patent or U.S. patent application publication’ under this regulation and cannot not be used for written description support.” Opp. 3–4 (citing *ZTE (USA), Inc. v. CyWee Grp. Ltd.*, IPR2019-00143, Paper 87 at 116 (PTAB Feb. 17, 2021); *Nichia Corp. v. Emcore Corp.*, IPR2012-00005, Paper 27 at 3–4 (PTAB June 3, 2013); *Droplets, Inc. v. E*TRADE Bank*,

² This portion of the proposed substitute claim now reads “receiving the sent first request by the selected tunnel device, receiving over the Internet the content slice from the first server via the selected tunnel device.”

³ We note a typographical error in the table that refers to “US Application No. 14/468,863” when referencing the original Specification for the ’866 patent, rather than No. 14/468,836.

887 F.3d 1309, 1318 (Fed. Cir. 2018); *Nomadix, Inc. v. Second Rule LLC*, No. CV 07-01946, 2009 WL 10668158, at *26 (C.D. Cal. Jan. 16, 2009)).

Under 35 U.S.C. § 119, an application that contains a “specific reference” to its own provisional application in the required manner secures the benefit of the filing date and written description of the provisional. 35 U.S.C. § 119(e)(1); *see also* 37 C.F.R. § 1.78(a). The ’866 patent refers to the ’815 provisional, which provides the benefit of the provisional application’s filing date and disclosure. Ex. 1001, code (60).

Section 119(e)(1) requires that the invention be “disclosed in the manner provided by [35 U.S.C.] section 112(a).” This is discussed in the following section. The fact patterns in the cases cited by Petitioner either address incorporation by reference issues, which are distinguishable from the instance here, or otherwise are not binding precedent.

Complete URL

Petitioner next argues that there is insufficient written description support for the new claim term “complete URL,” proposed for independent claim 29. Opp. 4–5. Petitioner’s expert, Mr. Keith J. Teruya, presents additional supporting testimony on this issue in his January 2022 Declaration. Ex. 1101 ¶¶ 37–45. We agree with Petitioner that Patent Owner likely has not shown written description support for this term.

Patent Owner cites several sections of both the ’815 provisional application and the ’866 Specification (in the originally-filed Disclosure⁴)⁵ Mot. 15; *see* Ex. 2020, 18–19; Ex. 2022–2027. The term “complete URL,” however, is not used or discussed in either reference. The cited sections include several examples of URL identifiers, such as the “URL of the file” (citing the ’815 provisional application at 20), a “URL with offset . . . (e.g., <http://www.youtube.com/watch?v=9MSB3P7CZIE?ST=1:48>)”

⁴ We note a typographical error, in that Exhibit 2025 refers to “US Application No. 14/468,863” when referencing the original Specification for the ’866 patent, rather than No. 14/468,836.

⁵ Patent Owner references Appendix A1, filed as Exhibit 2020, in the portion of the Motion supporting written description support for the proposed substitute claims. Mot. 14. Although we have reviewed Appendix A1, we rely on the arguments and citations presented in the Motion. *See* Consolidated Trial Practice Guide at 38 (“Motions to amend are limited to 25 pages.”), 69 (“Contents of Motion to Amend”).

(citing *id.* at Fig. 130, element 13008), and “specific files on the Internet (e.g. ‘Wikipedia.org/contact.html’)” (citing *id.* at 18–19).

A possible implication is that Patent Owner may be intending to propose that a “complete URL” includes at least a citation to a content file, in addition to a machine or web site identifier (such as *en.wikipedia.org*, as contrasted with *wikipedia.org/contact.html*). However, Patent Owner also cites a “URL with offset” (Ex. 2020 at 18), in addition to both the server identifier and content slice identifier, and does not indicate whether a content URL, or content URL with offset, or both, are “complete” URLs. The references to the sections of the ’866 patent’s original Specification also do not resolve this, because they include both “content, such as a URL” and a three-part youtube.com URL (“domain,” “video,” and “offset”). *Id.* at 18–19 (citing Ex. 2025, 145, 169).

We also note that in proposed substitute claim 29, “the second identifier is the complete URL,” where the “first server [is] identified in the Internet by a second identifier.” However, as Mr. Teruya testifies, Patent Owner includes some support for the term that includes a URL for content on a data server, but not a URL for a data server. Ex. 1101 ¶ 39 (citing Ex. 2020, 18–19).

On this record, Patent Owner has not provided sufficient written description which clearly identifies what a “complete URL” is, and, accordingly, has not sufficiently shown that Patent Owner had possession of the “complete URL” at the time of filing of the ’815 provisional or the ’866 Specification.

“the first device remains anonymous as to the first tunnel device”

Petitioner argues that, “though there is support for the first aspect, anonymity of the first device vis-à-vis the first server . . . there is no support for the second aspect (anonymity of the first device with respect to the first tunnel device).” Opp. 6–8. We agree with Petitioner that Patent Owner likely has not shown that this term has adequate written description support.

The last clause of proposed substitute independent claim 29 is “wherein the first device remains anonymous as to the first tunnel device and the first server.” We understand this to mean that the first [client] device is anonymous to *each* of the “first tunnel device” and the “first server” (the source of content). Patent Owner cites sections of the provisional and original Specifications that describe actions on behalf of the client device,

with the tunnel device acting as a “proxy,” where “the identity (such as the IP address) of the client device #1 31 a is concealed from the data server #1 22.” Mot. 15 (citing Ex. 2025, 117, 128; Ex. 2026, Fig. 13).

The references that Patent Owner provides, however, do not address or provide support for concealing the identity of the first [client] device from the first tunnel device. Accordingly, on this preliminary record, we agree with Petitioner that Patent Owner fails to adequately show that the introduction of anonymity of the first device to the first tunnel device is not new matter. In addition, to provide further guidance to the parties, we note that Patent Owner has not identified any supporting written description that provides an explanation of mechanisms by which the first [client] device *could* receive content from the first tunnel device, if the first tunnel device has no knowledge of the identity of the first [client] device, to which it must send the content in order that it be received.

B. Patentability

For the reasons discussed below, at this stage of the proceeding, and based on the current record, it appears that Petitioner, based on the current record, has shown a reasonable likelihood that proposed substitute claims are unpatentable.

Does the record establish a reasonable likelihood that the proposed substitute claims are unpatentable?

35 U.S.C. § 112(b) – Indefiniteness of “complete URL”

Yes. Petitioner contends the term “complete URL” is indefinite because the examples that Patent Owner provides indicate that URLs can have many formats and schemes, so it is not reasonably certain to a person of ordinary skill in the art what the term “complete URL” means. Opp. 9–10 (citing Ex. 1101 ¶¶ 53–56). At this point of the proceeding, we agree that, for similar reasons to those above addressing support for the term (e.g., the number of different URL identifiers disclosed), Petitioner is likely to prevail in showing the term is indefinite.

35 U.S.C. § 112(a) – Enablement of “anonymous as to the first tunnel device”

Yes. Petitioner argues there is no enablement of the “claimed anonymity as to the tunnel device.” Opp. 9. Petitioner contends that the “core of the ‘866 claims concerns ‘partitioning’ ‘fresh content into a plurality of content slices’ and serving the content slices responsive to requests therefor,” and that “the devices in the ’866 patent not only know who is making what requests, but what content they received responsive thereto.” *Id.* (citing Ex. 1001, 93:63–95:16).

For the reasons discussed above in regard to support for this element, we agree that, at this point of the proceeding, Petitioner is likely to prevail in showing the proposed claim language “anonymous as to the first tunnel device” is non-enabled. More specifically, “[t]he enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed invention without undue experimentation.” *AK Steel Corp. v. Sollac & Ugine*, 344 F.3d 1234, 1244 (Fed. Cir. 2003). As Mr. Teruya testifies, the ’866 patent functions require keeping track of which devices in the system have cached which content. Ex. 1101 ¶ 51 (citing Ex. 1011, 93:63–95:16). Mr. Teruya testifies, however, that the written description fails to enable the proposed claim limitation of anonymity as to the tunnel device in the view of one of ordinary skill in the art. *Id.* ¶¶ 51–52

35 U.S.C. § 103(a) — Obviousness

Yes. Petitioner contends the proposed substitute claims are unpatentable as obvious. Opp. 11–24.

A difficulty in addressing the obviousness issues here is that we are unclear on the meaning of “complete URL,” as well as on the mechanism whereby “the first device remains anonymous as to the first tunnel device.” Therefore, in light of these uncertainties, we are unable to ascertain whether the prior art discloses these two features of the proposed substitute claims at this stage of the proceedings. Nevertheless, Petitioner makes assumptions about what the “complete URL” encompasses,⁶ and essentially disregards the disputed “anonymous as to the first tunnel device” language in its arguments. Opp. 23–24. In order to provide the

⁶ Petitioner assumes a “‘complete URL’ is of the form ‘<https://www.youtube.com/watch?v=9mSb3P7cZIE?ST=1:48>,’ or at least <http://www.youtube.com> (or contains the latter)” Opp. 23.

parties guidance, we consider Petitioner’s obviousness assertions under these same assumptions.

Petitioner contends proposed substitute claim 29 would have been obvious over Shribman U.S. Publication No. US 2011/0087733 A1 (“S733,” Ex. 1017), either alone or in combination with “Sharp KK, Prince, Reed, and VIP72.com.” Opp. 11. Petitioner accounts for each limitation under the assumptions noted. *Id.* at 11–24.

On this record, we agree with Petitioner that the “thrust of [Patent Owner’s] amendments—to add tunneling to the claims—does nothing to save them under § 103,” and that the Motion to Amend “points to nothing about tunneling or the use of consumer electronic devices that changes the architecture or procedural steps being claimed. These are all differences with no operational significance.” Opp. 11–12. Thus, at a minimum, Petitioner is likely to demonstrate that the art advanced in Ground 6 of the Opposition renders obvious proposed substitute claim 29.

For example, as Petitioner contends, under the Board’s previous “interpretation of ‘tunnel’ in [our] institution decision, the ‘second device’ in the original claims would already have been regarded as a ‘tunnel.’” Opp. 11 (citing Ex. 1101 ¶ 59). Further, S733 discloses loading “fresh” content from the server when it is not already cached. Ex. 1017 ¶ 89 (cited at Opp. 12). Petitioner also provides support that in view of the S733’s description of the interchangeable functions of devices and the disclosures regarding these devices, S733’s tunnel devices are disclosed to be consumer devices. Opp. 22–23. Finally, S733 discloses anonymity of the client to the server, as the “agent” requests and receives data from the server, without the server knowing the identity of the requesting client. Ex. 1017 ¶ 89.

We acknowledge that Patent Owner has not yet had the opportunity to address Petitioner’s arguments and newly asserted prior art. Patent Owner will have the opportunity to do so in its Reply to Petitioner’s Opposition (or in a revised motion to amend).

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