

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETNUT LTD.,

Petitioner

v.

BRIGHT DATA LTD.,

Patent Owner

Case IPR2021-00465

Patent No. 9,742,866

**PATENT OWNER'S NON-CONTINGENT,
REVISED MOTION TO AMEND**

Mail Stop PATENT BOARD
Patent Trial and Appeal Board
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

TABLE OF CONTENTS

I. INTRODUCTION	1
II. REASONABLE NUMBER OF SUBSTITUTE CLAIMS	3
III. RESPOND TO A GROUND OF UNPATENTABILITY	3
A. PERSON OF ORDINARY SKILL IN THE ART (“POSA”)	5
B. CLAIM CONSTRUCTION	5
C. RESPONSE TO GROUNDS	6
1. Original Amendments Re-Proposed in the RPSC.....	6
2. Newly Proposed Amendments in RPSC 29	8
IV. SCOPE OF THE CLAIMS.....	11
V. NO NEW MATTER.....	11
VI. CLAIM LISTING.....	16
VII. PATENTABILITY OF SUBSTITUTE CLAIMS	17
VIII. CONCLUSION	21

TABLE OF AUTHORITIES

Cases

<i>Intuitive Surgical, Inc. v. Ethicon LLC</i> , IPR2018-00933, Paper 31 (PTAB Dec. 3, 2019)	1
<i>Lectrosonics, Inc. v. Zaxcom, Inc.</i> , IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019)(precedential)	passim
<i>NXP USA., Inc. v. Impinj, Inc.</i> , IPR2020-00514, Paper 37 (PTAB Aug. 11, 2021) .	1

Statutes

35 U.S.C. § 316(d)	1
--------------------------	---

Other Authorities

MPEP § 2141	20
-------------------	----

Regulations

37 C.F.R. § 1.78	12
37 C.F.R § 42.11	3
37 C.F.R. § 42.121	1, 2, 3
37 C.F.R § 42.53(f)(7)	18

<u>LIST OF PATENT OWNER'S PREVIOUSLY SUBMITTED EXHIBITS REFERENCED HEREIN</u>	
EX. 2001	Declaration of Dr. V. Thomas Rhyne
EX. 2014	Teruya Deposition Exhibit (Paper 15)
EX. 2015	Teruya Deposition Transcript
EX. 2016	Jury Verdict, <i>Bright Data Ltd. (f/k/a Luminati Networks Ltd.) v. Teso LT, UAB, et al.</i> , Case No. 2:19-cv-395, Dkt. 516 (E.D. Tex. Nov. 5, 2021)
EX. 2017	Claim Construction Order, <i>Luminati Networks, Ltd. v. Teso LT, UAB, et al.</i> , Case No. 2:19-cv-395, Dkt. 191 (E.D. Tex. Dec. 7, 2020)
EX. 2018	Claim Construction Order, <i>Luminati Networks Ltd. v. Code200, UAB, et al.</i> , Case No. 2:19-cv-396, Dkt. 97 (E.D. Tex. Feb. 8, 2021)
EX. 2019	Supplemental Claim Construction Order, <i>Bright Data Ltd. (f/k/a Luminati Networks Ltd.) v. Teso LT, UAB, et al. and v. Code200, UAB, et al.</i> , Case Nos. 2:19-cv-395, Dkt. 453 and 2:19-cv-396, Dkt. 244 (E.D. Tex. Aug. 6, 2021)
EX. 2022	Provisional Application No. 61/870,815 – specification
EX. 2023	Provisional Application No. 61/870,815 – drawings
EX. 2024	Nonprovisional Application No. 14/468,836 – abstract
EX. 2025	Nonprovisional Application No. 14/468,836 – specification
EX. 2026	Nonprovisional Application No. 14/468,836 – drawings
EX. 2027	Nonprovisional Application No. 14/468,836 – claims

<u>LIST OF PATENT OWNER'S ADDITIONAL EXHIBITS</u>	
EX. 2028	Revised Appendix A-1: Written Description Support
EX. 2029	Revised Appendix A-2: Revised, Proposed, Substitute Claims

I. INTRODUCTION

Patent Owner Bright Data Ltd. respectfully moves under 35 U.S.C. § 316(d) and 37 C.F.R. § 42.121 to amend U.S. Patent No. 9,742,866 (“the ‘866 Patent”)(EX. 1001). Patent Owner is not asserting the ‘866 Patent against any entity in any pending district court case (*see* Paper 8 at 21) and as such, Patent Owner is mindful of the finite resources of the Board and wishes to efficiently reach conclusion of this trial.¹

Patent Owner previously submitted an original, Non-contingent Motion to Amend (Paper 17, “Original MTA”) and Petitioner submitted an Opposition (Paper 18, “Opposition”) thereto. The Board provided preliminary guidance (*see* Paper 19, “P.G.”) for which Patent Owner thanks the Board for its time and consideration.

¹ Accordingly, Patent Owner did not file a Patent Owner Response in this proceeding. *See, e.g., Intuitive Surgical, Inc. v. Ethicon LLC*, IPR2018-00933, Paper 31 at 3, note 5 (PTAB Dec. 3, 2019)(“Because we grant the Motion to Amend, which is a non-contingent motion, and substitute claims 21–40 for challenged claims 1–20, we need not address the patentability of claims 1–20.”); *NXP USA., Inc. v. Impinj, Inc.*, IPR2020-00514, Paper 37 at 9 (PTAB Aug. 11, 2021)(“As Patent Owner’s non-contingent Revised Motion to Amend cancels all of the challenged claims, we address only Patent Owner’s proposed substitute claims 22–36.”).

Now, Patent Owner respectfully submits this ***Non-contingent, Revised*** Motion to Amend (“Revised MTA”) and revised, proposed, substitute claims (“RPSC”).

The Revised MTA and RPSC meet all of the requirements of 37 C.F.R § 42.121. Patent Owner conferred with the Board on October 29, 2021, prior to filing the Original MTA, as required by 37 C.F.R. § 42.121(a). Paper 16 at 2; *see also* Paper 19 at 3 and 10 (indicating Patent Owner may file a revised motion to amend in response to the P.G.).

Further, consistent with the guidelines set forth in *Lectrosonics, Inc. v. Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (“*Lectrosonics*”); this Revised MTA explains (a) there is a reasonable number of proposed, substitute claims, (b) each amendment is responsive to a ground of unpatentability involved in the trial, (c) none of the amendments seeks to enlarge the scope of the claims or introduce new matter, and (d) this motion clearly shows the amendments sought and the support in the originally-filed application(s) for each proposed, substitute claim. *See also* 37 C.F.R § 42.121. Patent Owner has thus met its burden.²

² There has been a large body of cumulative art submitted in other proceedings (e.g., in Requests for Reexamination, *see* Paper 14 at 3) against other patents assigned to Patent Owner; however, Patent Owner is not aware of any prior art that alone, or in

As explained in further detail herein, Patent Owner respectfully requests the Board grant this Revised MTA, cancel challenged claims 15-20, 23-24, and 27-28, and substitute RPSC 29-38 as set forth in the Revised Appendix A-2 (EX. 2029).

II. REASONABLE NUMBER OF SUBSTITUTE CLAIMS

In this trial, there are 10 challenged claims: 15-20, 23-24, and 27-28 (“Challenged Claims”). *See* Paper 2 at 10. With this Revised MTA, Patent Owner requests cancellation of 10 claims and substitution of 10 claims, which is a one-to-one substitution presumed to be reasonable. *See Lectrosonics* at 4 (citing 37 C.F.R. § 42.121(a)(3)).

III. RESPOND TO A GROUND OF UNPATENTABILITY

The RPSC are responsive to one or more grounds of unpatentability at issue in this trial, in compliance with 37 C.F.R. § 42.121(a)(2)(i).

combination, anticipates, or renders obvious any of the RPSC. *See* 37 C.F.R. § 42.11.

As of now, no patent assigned to Patent Owner has been invalidated based on any prior art. For example, on November 5, 2021, a jury issued a verdict finding that none of the asserted claims directed at improving internet communications was invalid over the asserted art in *Bright Data Ltd. (f/k/a Luminati Networks Ltd.) v. Teso LT, UAB, et al.*, Case No. 2:19-cv-395, Dkt. 516 (E.D. Tex.). EX. 2016 at 5.

In the Institution Decision, the Board found that Petitioner had demonstrated a reasonable likelihood of success as to Grounds 1-5 in view of two, asserted primary references – E.P. Pub. No. 2,597,869 (EX. 1018)(“Sharp”) and the textbook ‘WEB PROXY SERVERS’ by Ari Luotonen (EX. 1014)(“Luotonen”). *See* Paper 11 at 23-24, 26, 29, and 34-35. The Board’s analysis shows the scope of the Challenged Claims has been interpreted more broadly than anticipated.

In the Opposition, Petitioner alleged certain §112 issues, which are moot in view of the RPSC, and asserted Ground 6 based on the asserted primary reference Shribman alone and in combination with other references. *See* Paper 18 at 11-25. The P.G. considered the Original MTA and the Opposition and found that based on the preliminary record, there was a reasonable likelihood that the proposed, substitute claims were unpatentable. *See, e.g.,* Paper 19 at 2 and 9.

Patent Owner disagrees with Petitioner’s assertions given, for example, that the claimed method is performed within a specific, dedicated architecture (client device – tunnel device – web server) to fetch fresh content (not cached content) while also providing anonymity. *See generally,* EX. 2001. Patent Owner hereby submits the RPSC to further narrow the claimed methods, specifically reciting, for example, that the tunnel device must have an idle resource that satisfies a criterion. Patent Owner respectfully submits that none of the prior art references teach or suggest the novel and nonobvious use of a tunnel device as claimed.

A. PERSON OF ORDINARY SKILL IN THE ART (“POSA”)

Patent Owner does not dispute the Board’s definition of a POSA for the purposes of this trial. *See* Paper 11 at 11-12.³

B. CLAIM CONSTRUCTION

Patent Owner respectfully traverses the claim constructions in the Institution Decision (*see* Paper 11 at 13-15) and, in effort to save resources, submits that the RPSC include narrowing limitations such that the meanings of the claims would be easily understood by a POSA. Given the express limitations recited in the RPSC, Patent Owner respectfully submits that claim construction is not necessary and that further briefing would be an inefficient use of resources.⁴ For purposes of this trial,

³ Patent Owner agrees with the Board (*see* Paper 11 at 12) that its expert provided a similar definition of a POSA and Patent Owner submits the differences do not affect the analysis herein.

⁴ There has been a lot of claim construction activity (in addition to the Orders, EXS. 1023, 1033) for patents assigned to Patent Owner. *See, e.g.*, EXS. 2017, 2018, 2019.

the express limitations should moot any claim construction concerns.⁵

C. RESPONSE TO GROUNDS

The RPSC further narrow the Challenged Claims, including one independent claim, to incorporate additional limitations that are not disclosed in the prior art.

1. Original Amendments Re-Proposed in the RPSC

The Board agreed in the P.G. that the Original MTA proposed amendments that were responsive to a ground of unpatentability involved in the trial. Paper 19 at 4.

First, the RPSC specifically recite the use of a tunnel device to fetch fresh content from the second server. The narrowing limitations specify that the claimed tunnel device is a consumer electronic device with a client operating system. The narrowing limitations also recite that requests sent to the tunnel device use a tunneling protocol.

A tunnel device is not a server or a proxy server. As claimed, a tunnel device is a very specific type of client device that is further configured to be a tunnel device, for example, by using proprietary software. A POSA would understand that, in

⁵ For example, the Institution Decision stated that “[t]he parties agree that the term “tunnel device” “is not a term of art.” Paper 11 at 19.

contrast to a server, a tunnel device is a client device that may be resource limited with lower bandwidth and limited storage. *See, e.g.*, EX. 1001, '866 Patent, 150:15-23. In contrast, a proxy server includes *a server operating system* and is configured to store large amounts of information. *See, e.g.*, EX. 1001, '866 Patent, 6:24-40; 42:22-25; *see also, e.g.*, EX. 2001 at ¶ 29, at ¶¶ 38-39 (citing EXS. 2010 and 2011), at ¶ 43 (citing EX. 2012). Unlike the RPSC, for example, Luotonen discloses the use of a traditional proxy server. *See, e.g.*, EX. 1014 at 22; *see also, e.g.*, EX. 2001 at ¶ 35. Luotonen does not disclose the use of a client device as a proxy.

Second, the RPSC specifically recite fetching fresh content, not cached content. The narrowing limitations further recite the first request is sent from a first device, identified in the Internet by a first identifier, to the selected tunnel device and that the requested content slice is received from the first server through the selected tunnel device. That is because, in the claimed methods, the first device is always requesting fresh content, not cached content.

In contrast to the RPSC, Sharp discloses providing cached content to the requesting client 4. *See* EX. 1018 at [0028]; *see also id.* at Abstract. Sharp teaches the cached content is already received/stored from the web server *before* there is any request from the client. *See, e.g.*, EX. 1018 at [0033]. However, the claimed method teaches receiving the requested content only *after* the first request is made.

Sharp discloses a content delivery network which is a closed-loop design

where all of the web traffic is *inside* the network. *See, e.g.*, EX. 1018 at [0006]. The network of Sharp is designed to “reduce[] an increase in load of the server and a network and for data transmission from the server”. *See id.* Sharp does not teach going *outside* the network in order to obtain fresh content. *See also* EX. 2001 at ¶¶ 42-46. Sharp therefore does not teach the claimed method, which is not directed to reducing the load on the web server and, just the opposite, ensures that all data comes from the web server at the time the content is requested.

Third, the RPSC recite an anonymity limitation “wherein the first device remains anonymous as to the first server” so as to prevent blocking or spoofing from the web server. For example, in contrast to the RPSC, in every embodiment of Sharp, the client 4 directly contacts the server 2 (*see, e.g.*, EX. 1018 at [0043]) and therefore, for example, there is no anonymity of client 4 with respect to server 2.

Fourth, the dependent RPSC are amended to re-number their dependency, as well as to clarify the use of “tunnel” devices to fetch “fresh” content.

For at least these reasons, the RPSC are responsive to one or more grounds of unpatentability at issue in this trial.

2. Newly Proposed Amendments in RPSC 29

In response to the Opposition and the P.G., the RPSC recite additional limitations to distinguish the claimed methods from at least Shribman. *See, e.g.*, Paper 19 at 9. As claimed, a tunnel device is selected from the group so long as the

tunnel device has an “idle resource” that satisfies a “criterion,” wherein the criterion is satisfied when an “idleness of the idle resource is above or below a set threshold value.” There is no disclosure in Shribman regarding the idleness of an idle resource of the alleged “tunnel device” being above or below a set threshold value as recited in the RPSC. Further, there is no disclosure in Shribman regarding the selection of the alleged “tunnel device” so long as an idle resource satisfies a criterion as claimed.

Additionally, to further clarify the “first request”, the RPSC recite that the first device sends a “first request... indicating that the content slice is to be fetched directly from the first server.” Also, the RPSC further clarify that, in response to receiving the first request, the selected tunnel device sends “the content slice identifier to the first server using the second identifier;” and then, the requested content slice is received “from the first server through the selected tunnel device.” The RPSC additionally recite that the tunnel device does not cache a copy of the requested content, e.g., for future requests.⁶ That is because, in the claimed methods, the first device is always requesting fresh content, not cached content.

⁶ This limitation was originally proposed only in the related proceeding IPR2021-00458 and has now been added to RPSC 29 in this proceeding. For at least the reasons discussed in section III.C.1., this amendment is responsive to at least Sharp and therefore, responsive to the Opposition. *See, e.g.*, Paper 18 at 14.

Regarding these limitations, Petitioner has primarily relied on Fig. 9 and/or paragraphs 81, 89-92, 94, and/or 106-110 of Shribman in the Opposition (*see* Paper 18 at 13-14 and 21-22) which do not disclose the method as claimed in the RPSC. For example, Petitioner alleges block 360 of Fig. 9 corresponds to the claimed “first request.” *See* Paper 18 at 13. Shribman describes:

“As shown by block 360, the client module 224 then sends the original request (e.g., “GET http://www.aol.com/index.html HTTP/1.1”) to all the agents in the list received from the acceleration server 162 in order to find out which of the agents in the list is best suited to be the one agent that will assist with this request.”

EX. 1017 at [0081]. In contrast to the claimed “first request” of the RPSC, as further explained by Shribman:

“FIG. 10 is a flowchart continuing the flowchart 380 of FIG. 9 and ***focused on agent response to the request***. As shown by block 382, upon receiving the request from the client 200, each agent that received the request from the client responds to the client 200 with whether it has information regarding the request, which can help the client to download the requested information from peers in the network. ***Specifically, each agent responds with whether the agent has seen a previous request for this resource that has been fulfilled***. In such a case, the agent may then provide the client with the list of peers and checksums of the chunks that each of them have.”

EX. 1017 at [0083] (emphasis added). This method of Shribman, cited by Petitioner, is not the same as the claimed methods in the RPSC at least because the alleged “first request” shown in block 360 of Fig. 9 does not indicate that the “content slice” is to be fetched directly from the web server. In view of the foregoing, Patent Owner respectfully submits that the newly proposed amendments are responsive to the

Opposition and/or the P.G.

IV. SCOPE OF THE CLAIMS

“A substitute claim will meet the requirements of § 42.121(a)(2)(i) and (ii) if it narrows the scope of at least one claim of the patent, for example, the challenged claim it replaces, in a way that is responsive to a ground of unpatentability involved in the trial.” *Lectrosonics* at 6-7.

None of the original limitations in the Challenged Claims have been deleted in the RPSC. As discussed above, the independent RPSC 29 adds only narrowing limitations that are responsive to one or more grounds of unpatentability involved in the trial. For at least the same reasons as independent RPSC 29, the dependent RPSC include only narrowing limitations that are responsive to a ground of unpatentability involved in the trial.

V. NO NEW MATTER

“[T]he Board requires that a motion to amend set forth written description support in the originally filed disclosure of the subject patent for each proposed substitute claim[.]” *Lectrosonics* at 7 (citing *See* 37 C.F.R. §§ 42.121(b)(1), 42.121(b)(2)).

The ‘866 Patent issued from Nonprovisional Application No. 14/930,894 filed

November 3, 2015, which is a divisional⁷ of Nonprovisional Application No. 14/468,836 (EXS. 2024-2027) filed August 26, 2014, which claims priority from Provisional Application No. 61/870,815 (EXS. 2022-2023) filed August 28, 2013. *See, e.g.*, EX. 1001, ‘866 Patent, codes (21), (22), (62). Patent Owner respectfully submits that the RPSC are entitled to the earlier priority date, August 28, 2013. Supporting citations to both applications are provided in the table below. For ease of review, Patent Owner also prepared Revised Appendix A-1 attached hereto, with quoted language showing written description support in both applications. EX. 2028.⁸

⁷ As a divisional, Nonprovisional Application No. 14/930,894 has the same specification as Nonprovisional Application No. 14/468,836 with no new matter added. *See* 37 C.F.R. § 1.78.

⁸ Patent Owner understands that the Board will rely only on the citations presented in the Revised MTA. *See* Paper 19 at 6, note 5. The citations in the Revised MTA are the same as the citations in the appendix.

Claim I.D.	Exemplary Support in Provisional App. No. 61/870,815 (EXS. 2022-2023)⁹	Exemplary Support in Nonprovisional App. No. 14/468,836 (EXS. 2024-2027)¹⁰
29 pre, pt. 1	See, e.g., Figs. 50, 55, 58, 69, and 70 See, e.g., pages 1-2 and 7-8	See, e.g., original claim 134 See, e.g., Figs. 5, 5a, 5b and Figs. 11, 11a, 11b See, e.g., Abstract See, e.g., pages 73, 81-82, 114, and 118
29 pre, pt. 2	See, e.g., Figs. 69, 73, and 136 See, e.g., pages 2, 7, 21, 23, and 33-34	See, e.g., original claim 134 See, e.g., Fig. 10, 11, 11a, 11b and 21 See, e.g., pages 81, 125, and 138
29a	See, e.g., Figs. 158, 160, 214, 610, and 700 See, e.g., pages 2, 5, 7, 26-27, 30-31, 40, 69, 84,	See, e.g., original claim 134 See, e.g., Figs. 5, 5a, 5b, 6, 30, 77, and 94 See, e.g., pages 76, 81, 97, 112-114, 118, 146, 160-161, 195, 210-212, and 223
29b	See, e.g., Figs. 58, 61-62, 69, 70, 136, 138, and 226	See, e.g., original claim 134 See, e.g., Figs. 5, 5a, 5b, 7, 10a, 11, and 33

⁹ Page citations herein refer to the page of the specification (EX. 2022).

¹⁰ Page citations herein refer to the page of the specification (EX. 2025).

	See, e.g., pages 1-3, 7-8, 23, and 44	See, e.g., pages 34-35, 69, 81, 85, 88, 99, 114, 117-119, 145, and 167-168
29c	See, e.g., Figs. 58, 62, 69, and 70 See, e.g., pages 2, 4, and 7-8	See, e.g., original claim 108 and original claim 120 See, e.g., Figs. 5, 5a, 5b, and 7 See, e.g., pages 76-77, 81, and 114
29d	See, e.g., Figs. 58, 62, 69, and 70 See, e.g., pages 2, 4, and 7-8	See, e.g., original claim 134 See, e.g., Figs. 5, 5a, 5b, and 7 See, e.g., pages 81, 114, and 118
29e	See, e.g., Figs. 62, 69, 70, and 73 See, e.g., pages 4, 7-8, 13, 21, and 33-34	See, e.g., original claim 134 See, e.g., Figs. 5, 5b, and 21 See, e.g., pages 81, 126, and 139
29f	See, e.g., Fig. 234 See, e.g., pages 1 and 46-48	See, e.g., Abstract See, e.g., pages 56, 100, and 167
29g	See, e.g., Figs. 158, 160, 214, 610, and 700 See, e.g., pages 26-27, 30-31, 40, 69, and 84	See, e.g., Figs. 30, 77, and 94 See, e.g., pages 97, 113-114, 146, 160-161, 195, 210-212, and 223
29h	See, e.g., Figs. 61 and 62 See, e.g., pages 3, 8, and 17-18	See, e.g., pages 94, 117, and 129-130

29i	See, e.g., Figs. 58, 61-62, 69, 234, and 236 See, e.g., pages 2-3, 7, and 46-47	See, e.g., Fig. 13 See, e.g., pages 117 and 128
30	See, e.g., Figs. 70 and 73 See, e.g., pages 2, 7-8, 13, 18-19, 68	See, e.g., original claim 135 See, e.g., Fig. 21 See, e.g., pages 82 and 138
31	See, e.g., Figs. 69 and 73 See, e.g., pages 7, 18-19, and 23	See, e.g., original claim 136 See, e.g., Fig. 21 See, e.g., pages 82 and 138
32	See, e.g., Figs. 69 and 73 See, e.g., pages 7, 18-19, 23, 80	See, e.g., original claim 137 See, e.g., Fig. 21 See, e.g., pages 82 and 138
33	See, e.g., Figs. 70 and 136 See, e.g., pages 7-8, 23, and 50	See, e.g., original claim 138 See, e.g., pages 82, 84, 126, and 139
34	See, e.g., Fig. 69 See, e.g., pages 7, 13, and 33	See, e.g., original claim 139 See, e.g., pages 82, 84, 126, and 139

35	See, e.g., pages 2, 7, 13, and 33	See, e.g., original claim 142 See, e.g., pages 76, 82, 101, 120, 139, and 224
36	See, e.g., pages 7 and 13	See, e.g., original claim 143 See, e.g., pages 76, 82, 101, 120, and 139
37	See, e.g., Figs. 70 and 136 See, e.g., pages 7-8, 13, 23, 33-34	See, e.g., original claim 146 See, e.g., Fig. 21 See, e.g., pages 82, 84, and 126
38	See, e.g., Fig. 136 See, e.g., pages 7, 23, 33-34, and 50	See, e.g., original claim 147 See, e.g., Fig. 21 See, e.g., pages 82, 84, 126

VI. CLAIM LISTING

“A motion to amend must include a claim listing reproducing each proposed substitute claim. *See* 37 C.F.R. § 42.121(b) ... The claim listing may be filed as an appendix to the motion to amend, and shall not count toward the page limit for the motion.” *Lectrosonics* at 8.

Patent Owner respectfully refers the Board to Revised Appendix A-2 attached

hereto. EX. 2029.

VII. PATENTABILITY OF SUBSTITUTE CLAIMS

“[A] patent owner does not bear the burden of persuasion to demonstrate the patentability of substitute claims presented in a motion to amend. Rather, as a result of the current state of the law and USPTO rules and guidance, the burden of persuasion ordinarily will lie with the petitioner to show that any proposed substitute claims are unpatentable by a preponderance of the evidence.” *Lectrosonics* at 4.

Regarding 35 U.S.C. § 102 and § 103, Patent Owner respectfully submits that no prior art of record or known to it, discloses, teaches or suggests the subject matter of the RPSC.

Moreover, the RPSC provide only narrowing limitations to the Challenged Claims and Patent Owner maintains the Challenged Claims are valid over the prior art, particularly in light of Petitioner’s reliance on expert testimony. On October 29, 2021, Patent Owner cross-examined Petitioner’s expert, Mr. Teruya regarding

Grounds 1-5, including Shribman.^{11, 12}

During that deposition, Mr. Teruya revealed his backwards analysis of the asserted references, replete with hindsight bias. Mr. Teruya expressly admitted that he started with the claim elements and then went to a reference to see if there was an exact or analogous disclosure. *See, e.g.*, EX. 2015 at 39:9-17 (reproduced below)(discussing analysis of Shribman) and 155:1-19 (discussing analysis of Prince).

¹¹ In accordance with 37 CFR § 42.53(f)(7), the Teruya deposition transcript was previously submitted as Exhibit 2015. The Notice of Deposition (Paper 15) was used as an exhibit during the deposition and was previously submitted as Exhibit 2014. All other exhibits used during the deposition were already of record and in possession of the deponent.

¹² Patent Owner notes that the subject matter for both this proceeding and the related proceeding IPR2021-00458 were covered during the same deposition.

9 Q Okay. And just to help me
10 understand, then, the way you did that
11 was you would start with a claim, read
12 the elements of the claim, and then go
13 back to look at Shribman to see if you
14 could find either the exact disclosure or
15 something you felt was analogous; is that
16 fair?
17 A Yes.

Indeed, Mr. Teruya expressly admitted he did not review the references in their entirety and therefore, did not consider any teaching away. *See, e.g.*, EX. 2015 at 155:16-19 (reproduced below)(discussing Prince); *see also* 51:16-22 (discussing Shribman) 93:1-5 (discussing Sharp); 105:6-8 (discussing Sharp).

16 Q Well, when you reviewed the
17 Prince reference did you read all of the
18 reference?
19 A Not in its entirety.

“This form of hindsight reasoning, using the invention as a roadmap to find its prior art components, would discount the value of combining various existing features or principles in a new way to achieve a new result - often the very definition of invention.” *Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004).

Moreover, Mr. Teruya expressly admitted he performed his analysis based on

his knowledge/experience at the time the declaration was drafted (i.e., 2020, approximately 7-8 years after the time of invention), rather than at the time of invention. *See* EX. 2015 at 133:18-134:3 and 135:10-19. "It is difficult but necessary that the decisionmaker forget what he or she has been taught . . . about the claimed invention and cast the mind back to the time the invention was made (often as here many years), to occupy the mind of one skilled in the art. ..." MPEP § 2141 (citing *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984).)

Accordingly, Patent Owner respectfully submits that Mr. Teruya's analysis is improper and Petitioner's reliance thereon is misplaced. Thus, Petitioner's analysis of at least Grounds 1-5 as to the Challenged Claims should be given little weight. Neither Petitioner nor Mr. Teruya addressed this issue of hindsight bias in the Opposition or Supporting Declaration (EX. 1101). Still, Mr. Teruya incorporates much of his earlier testimony into the Opposition's Supporting Declaration. *See, e.g.*, EX. 1101 at ¶ 30 and ¶ 93; *see also generally* citations to Petition's Supporting Declaration (EX. 1003). Patent Owner intends to further investigate this issue of hindsight bias if Mr. Teruya submits another declaration in support of Petitioner's Opposition to this Revised MTA. Regardless of the weight ultimately given to Mr. Teruya's declarations, Patent Owner has added more narrowing limitations in the RPSC in an effort to expedite this trial.

VIII. CONCLUSION

In view of the foregoing, Patent Owner respectfully requests the Board grant this motion, cancel challenged claims 15-20, 23-24, and 27-28, and substitute RPSC 29-38 as set forth in the Revised Appendix A-2.

Respectfully submitted,

Date: March 14, 2022

By: /s/ Thomas M. Dunham

Thomas M. Dunham

Reg. No. 39,965

RuyakCherian LLP

1901 L Street NW, Suite 700

Washington, D.C. 20036

(202) 838-1567

ATTORNEY FOR PATENT OWNER,
BRIGHT DATA LTD.

CERTIFICATE OF COMPLIANCE

The undersigned hereby certifies that PATENT OWNER'S NON-CONTINGENT, REVISED MOTION TO AMEND is within the 25 page-limit, in compliance with 37 C.F.R. §§ 42.24(a)(1)(vi).

Respectfully submitted,

Date: March 14, 2022

By: /s/ Thomas M. Dunham

Thomas M. Dunham

Reg. No. 39,965

RuyakCherian LLP

1901 L Street NW, Suite 700

Washington, D.C. 20036

(202) 838-1567

ATTORNEY FOR PATENT OWNER,
BRIGHT DATA LTD.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), the undersigned hereby certifies PATENT OWNER'S NON-CONTINGENT, REVISED MOTION TO AMEND was served on the undersigned date via email, as authorized by Petitioner, at the following email addresses:

ron.abramson@listonabramson.com

ari.jaffess@listonabramson.com

michael.lewis@listonabramson.com

Respectfully submitted,

Date: March 14, 2022

By: /s/ Thomas M. Dunham

Thomas M. Dunham

Reg. No. 39,965

RuyakCherian LLP

1901 L Street NW, Suite 700

Washington, D.C. 20036

(202) 838-1567

ATTORNEY FOR PATENT OWNER,
BRIGHT DATA LTD.