

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

METACLUSTERLT, UAB,
Petitioner,

v.

BRIGHT DATA LTD.,
Patent Owner.

PGR2022-00061
Patent 11,349,953 B2

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

GIANNETTI, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *The Petition*

Metacluster LT, UAB (“Petitioner”) filed a Petition requesting post-grant review of claims 1–34 (the “challenged claims”) of U.S. Patent No. 11,349,953 B2 (Ex. 1001, the “’953 patent”). Paper 1 (“Pet.” or “Petition”). Bright Data Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

In our Institution Decision (Paper 8, “Institution Dec.”), we first determined that the ’953 patent is eligible for post-grant review. Institution Dec. 11–12. After analyzing Petitioner’s challenges and Patent Owner’s response, we determined that Petitioner had demonstrated a reasonable likelihood that it is more likely than not that at least one of the challenged claims is unpatentable. *Id.* at 28. *See* 35 U.S.C. § 324(a). We, therefore, instituted post-grant review as to all of the challenged claims of the ’953 patent and all of the asserted grounds of unpatentability in the Petition. Institution Dec. 28.

B. *The Motion to Amend*

After institution, Patent Owner filed a non-contingent Motion to Amend (Paper 13, “Mot. Amend”). The Motion requested that the Board “cancel claims 1–34, and substitute claims 35–66.” Mot. Amend 2. The Motion further requested that we provide preliminary guidance in accordance with the Board’s pilot program concerning motion to amend practice and procedures. *Id.*; *see* 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) (“Notice”).

C. Petitioner's Opposition

Petitioner filed an Opposition to the Motion to Amend. Paper 16 (“Pet. Opp.”). Petitioner’s Opposition asserts that the Board should deny the Motion because Patent Owner failed to demonstrate the necessary written description support for several claim limitations sought to be added to the claims by the Motion, namely the “determining” limitations and the “removing” limitation. Pet. Opp. 6, 8. These limitations will be further discussed, *infra*.

Patent Owner filed a Reply to Petitioner’s Opposition (Paper 18, “PO Reply”) and Petitioner filed a Sur-reply (Paper 22, “Pet. Sur-reply”).

A hearing on the Motion to Amend was held on February 14, 2024, and a transcript of that hearing has been entered in the record as Paper 26 (“Hearing Tr.”).

D. The Preliminary Guidance

After considering Patent Owner’s Motion to Amend and Petitioner’s Opposition, we provided the requested Preliminary Guidance. Paper 20 (“Prelim. Guidance”). 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 associated with filing a motion to amend in a post-grant review and whether Petitioner (or the record) established that the substitute claims are unpatentable. *See* Notice, 84 Fed. Reg. at 9,497; *see also* 35 U.S.C. § 326(d) (providing statutory requirements for a motion to amend); 37 C.F.R. § 2.221 (providing regulatory requirements and burdens for a motion to amend); *Lectrosonics, Inc. v Zaxcom, Inc.*, IPR2018-01129, Paper 15 (PTAB Feb. 25, 2019) (precedential) (providing information and guidance regarding motions to amend).

In our Preliminary Guidance, we concluded that at that stage in the proceedings, and based on the then-current record before us, Patent Owner had shown that it has satisfied the statutory and regulatory requirements associated with filing a motion to amend. Prelim. Guidance 3. We further concluded that on that record, Patent Owner had shown sufficiently that the subject matter of the claim amendments was adequately supported by the application for the '953 patent. *Id.* at 5. More specifically, we determined that both the “determining” limitations and the “removing” limitation were adequately supported by the '953 patent application. *Id.* at 5–6 (“determining” limitations), 6–8 (“removing” limitation). As noted, Petitioner’s Opposition to the Motion to Amend was limited to challenging Patent Owner’s showing of written description support for the “determining” and “removing” limitations. *See* PO Opp. 2, 6, 8. On a preliminary basis, we concluded at that stage, that Petitioner had failed to demonstrate that proposed substitute claims 35–64 are not patentable. Prelim. Guidance 8.¹

II. DISCUSSION

A. Legal Standard

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*, Paper 15 at 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* describes “new matter” as follows:

¹ Aside from its arguments based on lack of written description for the amendments, Petitioner presents no other challenges to the proposed substitute claims.

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, Paper 15 at 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).

B. Real Parties-in-Interest

Petitioner initially identified Metacluster LT, UAB; Code200, UAB; Teso LT, UAB; Oxysales, UAB; and Coretech LT, UAB as the real parties-in-interest. Pet. 2. Petitioner’s updated mandatory notices state that “Oxysales and [M]etacluster have been merged into Teso, with Teso succeeding to all of Oxysales and Metacluster’s assets, rights, and obligations.” Paper 7, 1. Further, “Teso is now operating as Oxylabs, UAB. Oxylabs, UAB is wholly owned by [C]oretech.” *Id.*

Patent Owner identifies Bright Data Ltd. as the real party-in-interest. Paper 4, 1.

C. Related Patents and Matters

The parties state that there are no pending litigations or post-grant reviews involving the '953 patent. Pet. 3; Paper 7, 2. The parties identify numerous litigations, post-grant reviews, and reexaminations involving patents that are related to the '953 patent. Pet. 2–8; Paper 7, 1–4.

D. The '953 Patent

The '953 patent is titled “System and Method For Improving Internet Communication by Using Intermediate Nodes,” and issued on May 31, 2022, from an application filed on October 5, 2019. Ex. 1001, (54), (45), (22). The '953 patent claims priority to U.S. Provisional Application No. 61/870,815, filed on August 28, 2013. *Id.* at 1:14–15.

The '953 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, (57). The client device accesses an acceleration server to receive a list of available tunnel devices. *Id.*

Requested content is 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 a 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. *Id.* Similarly, a tunnel device may also serve as a client device for fetching content from a data server. *Id.*

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.*

E. Proposed Substitute Claims

As noted, Patent Owner requests cancellation of claims 1–34 and proposes to substitute claims 35–66 for the cancelled claims. Mot. Amend
2. Claim 35, the only independent claim of the proposed substitute claims, is illustrative, and is reproduced below.²

35. [preamble] A method for use with a first group of intermediary client devices and a resource in each of the intermediary client devices that is associated with a criterion, wherein each of the intermediary client devices communicates with a first server over the Internet, wherein each of the intermediary client devices is identified in the Internet using an associated device identifier and is associated with first and second states according to a utilization of the resource, and for fetching over the Internet a first content identified by a first content identifier, the method comprising:

[35a] connecting, by each intermediary client device in the first group, to the Internet;

[35b] sending, by each intermediary client device in the first group responsive to the connecting to the Internet, the associated device identifier to the first server over the Internet;

[35c] while connected to the Internet, periodically or continuously determining, by each intermediary client device in the first group, whether the resource utilization satisfies the criterion;

[35d] responsive to the determining that the utilization of the resource satisfies the criterion, shifting to the first state or staying in the first state, by the intermediary client device;

[35e] responsive to the determining that the utilization of the resource does not satisfy the criterion, shifting to the second

² The paragraph identifiers in brackets have been added to track those used by the parties.

state or staying in the second state, by the intermediary client device;

[35f] determining a number of intermediary client devices in the first group in the second state;

[35g] determining whether the number is greater than zero;

[35h] responsive to the number being greater than zero, removing the intermediary client devices in the second state from the first group and replacing the removed intermediary client devices with new intermediary client devices in the first state from a second group of intermediary client devices to form a third group of intermediary client devices;

[35i] responsive to being in the first state, receiving, by a selected intermediary client device in the third group, the first content identifier from the first server; and

[35j] sending, by the selected intermediary client device in response to the receiving of the first content identifier, the first content to the first server.

Ex. 2014 (App. A-2) (omitting strike-outs and underlining indicating changes to original claim 1).

F. Original Claims

The Petition asserts that the original claims are unpatentable on the following grounds (Pet. 12–13):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–34	103 ³	Mithyantha ⁴
31	103	Mithyantha, RFC 2616 ⁵

³ 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, before the earliest effective filing date of the ’953 patent. As a consequence, the amended version of § 103 applies here. *See infra*.

⁴ U.S. Patent No. 8,972,602 B2, issued March 3, 2015, application date June 15, 2013 (Ex. 1009).

⁵ *Hypertext Transfer Protocol – HTTP/1.1*, Network Working Group Request for Comments 2616, June 1999 (Ex. 1005).

The Motion to Amend requests cancellation of claims 1–34. Mot. Amend 2. Petitioner does not oppose. We therefore cancel those claims and do not address Petitioner’s original challenges.

Petitioner does not assert that the proposed substitute claims are unpatentable based on the references asserted in the Petition or any other prior art references. Petitioner’s challenge to the proposed substitute claims rests entirely on the alleged lack of written description support for the proposed amendments. Pet. Opp. 2-12; Pet. Sur-reply 2–12. As discussed in Section II.A, *supra*, Patent Owner bears the burden to ensure that its Motion to Amend sets forth adequate written description support for the amendments. *See* 35 U.S.C. § 326(d)(3); 37 C.F.R. § 42.221(d); *Lectrosonics*, Paper 15 at 7–8.

III. ANALYSIS

A. “Determining” Limitations

Proposed claim elements 35f and 35g recite, respectively, “determining a number of intermediary client devices in the first group in the second state” and “determining whether the number is greater than zero.” *See supra*, Section II.E. We refer to these as the “determining limitations.” Prelim. Guidance 5–6. These limitations were not in the original claims but appear in all the proposed substitute claims. Patent Owner must show that they do not introduce “new matter.” *See* 35 U.S.C. § 326(d)(3); 37 C.F.R. § 42.221(a)(2)(ii)). That is, Patent Owner must demonstrate that the amendments are supported by the written description in the application for ’953 patent. *Lectrosonics*, Paper 15 at 7.

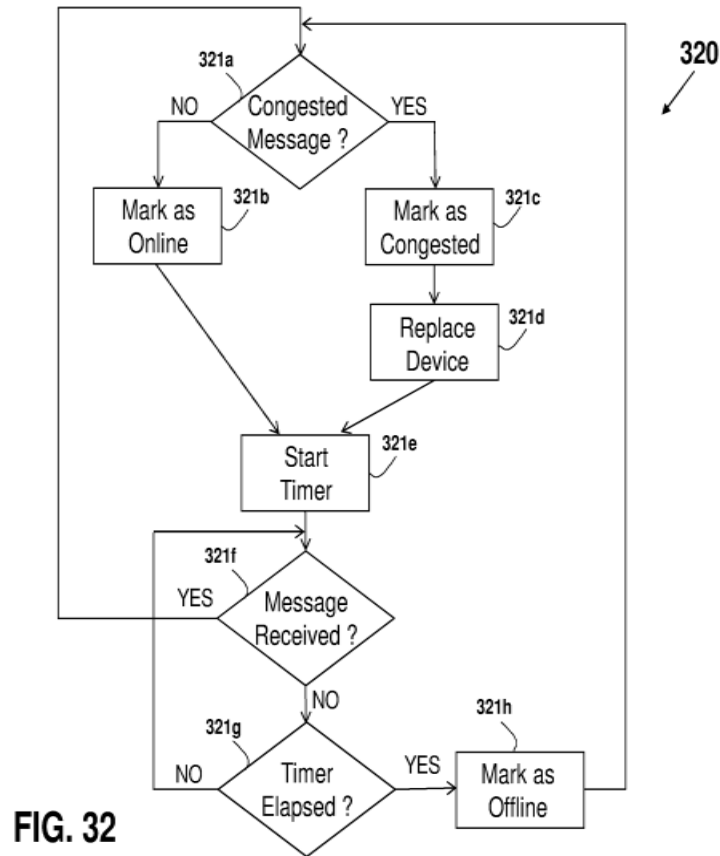
We preliminarily determined that these limitations are supported by U.S. Application No. 16/593,996, the application for the ’953 patent. Prelim. Guidance 5–6 (citing Ex. 2022 (specification), Ex. 2023

(drawings)).⁶ Specifically, Patent Owner cites as support page 165 of the specification (Ex. 2022) and Figure 32 (Ex. 2023). Mot. Amend 12 (claim elements 35f, 35g). We reasoned that “[t]he ‘determining’ limitations merely recite that a determination is made as to the number of intermediary client devices in the first group that are in the second [congested] state, and whether that number is greater than zero.” Prelim. Guidance 6 (citing Ex. 2014, 2). Citing page 165, we decided that the ’953 patent specification “disclose[s] determining whether and how many resources are ‘congested’ or ‘offline’ (in a second state).” *Id.* (citing Ex. 202[2] at 165).⁷ We concluded that Patent Owner had demonstrated sufficiently that “the full scope of the ‘determining’ limitations are adequately disclosed.” *Id.*

Patent Owner’s analysis of these limitations refers to the Figure 32 flowchart, reproduced below.

⁶ The Preliminary Guidance also addresses Patent Owner’s contention that that ’953 patent is entitled to the benefit of the filing dates of Provisional Application No. 61/870,615 (Exhibits 2015, 2016) and Application No. 14/468,836 (Exhibits. 2017–2020), the great-great grandparent of the ’953 patent. Mot. Amend 11; PO Reply 10–11; Prelim. Guidance 5–6. We do not address those contentions here, as the earlier filing dates are not material to the outcome of this Decision. *See, e.g.,* Hearing Tr. 39:20–40:2.

⁷ The Preliminary Guidance refers to the ’953 patent specification as Exhibit 2021. *See* Prelim. Guidance 6. The correct citation is Exhibit 2022. *See* Mot. to Amend 10 & n.10.



Mot. Amend 12 (claim elements 35f, 35g); PO Reply 9. Figure 32 is “a simplified flowchart for determining a network element status of a connected device.” Ex. 2022, 106. Patent Owner contends this figure and the accompanying text “explain that in a group of multiple intermediary devices, when a single device or multiple devices in the group become unavailable (due to shifting to an ‘offline’ or ‘congested state’), a new intermediary device (or devices) may be selected as a substitute as part of a ‘Replace Device’ step 321d.” PO Reply 9 (citing Ex. 2022, 165). Patent Owner explains, still referring to page 165 and Figure 32, that “[f]or example, where five intermediaries were assigned to a particular data server, and three operative intermediaries are needed, if three of the five assigned intermediaries become unavailable, rendering only two intermediaries in an operational state, then at least one new intermediary will be selected as part

of the “Replace Device” step 321d.” *Id.* Patent Owner concludes by relating this disclosure to the language of the claim: “Thus, the [’953 patent application] disclose[s] determining a number of intermediary client devices that are in the ‘second state’ and determining how many intermediary client devices are in the ‘second state’, the [application] disclose[s] proposed claim elements 35[f] and 35[g].” *Id.*

Petitioner contends that the Motion to Amend “fails to provide support for the added ‘determining’ limitations.” Pet. Opp. 6–8; Pet. Sur-reply 11–12. Petitioner contends that “it is unclear what element or other elements of the claim performs the newly added ‘determining’ steps.” Pet. Opp. 6. We do not agree with this argument. The substitute claims recite method steps. There is nothing in the claims that requires identifying specific apparatus. In any event, the specification discloses tracking of client devices in connection with Figure 31 and relates that activity to the selection of tunnel devices subject to “replacement” in Figure 32. *See* Ex. 2022, 163–165, Figs. 31, 32. According to the specification, tracking can be done by all devices, including the servers. Ex. 2022, 163.

Petitioner’s additional arguments are unavailing. For example, Petitioner argues that the two examples presented at page 165 of the ’953 patent specification and Figure 32 do not support these limitations. Pet. Sur-reply 11–12. Petitioner contends that the first example on page 165 discloses that a client device looks at “one device . . . at a time” to determine whether that device is in the “second” (congested) state, rather than determining *a number* of intermediary devices in the “second” state. *Id.* at 11 (emphasis added). We disagree with this argument and find that Figure 32 and the accompanying description are not limited to a single device but to selecting and replacing members of a group. In discussing Figure 32, page

165 of the specification describes “a tunnel device that may be selected (alone or as *part of a group*) by a client device as part of the ‘Select Tunnels’ step 101a in the flowchart 100.” Ex. 1022, 165 (emphasis added). We find that the first example on page 165 of the specification describes substituting “new” tunnel devices for devices in a group that are in a “second” state, i.e., congested or offline. Ex. 2022, 165 (first full paragraph). In this respect, this disclosure tracks the claims. Hearing Tr. 44:12–19. This example, therefore, illustrates determining that devices in a group are placed in the “second” (“congested”) state by tracking them. Ex. 2022, 164–165, Fig. 31.

Petitioner contends that second example on page 165 of the ’953 patent specification “is directed to determining the number of devices in the ‘first state’ (non-congested) rather than making a determination based on the number of devices in the ‘second state’” (congested) as required by [35f].” Pet. Sur-reply 11–12. We disagree. This example hypothesizes that five tunnel devices are assigned to a single client device, and that three or more tunnel devices must remain available. Ex. 2022, 165 (second full paragraph). If a third tunnel device is unavailable, a “new” tunnel device will be used as a replacement. *Id.* We find that it is a matter of simple arithmetic to “determine” that if only two of five devices are available, three are unavailable because congested or offline. *See* Hearing Tr. 25:12–16 (THE BOARD: “It’s five items. Three are available, two are not. If two are available, then three are not. That’s – it’s a simple set theory, isn’t it?” COUNSEL FOR PETITIONER: “That is, it’s simple arithmetic, Your Honor.”). We find, therefore, that in this example, determining the number of devices in the “second” state also determines the number of devices in the first state.

We find that for the reasons given, Patent Owner demonstrates by a preponderance of the evidence that the “determining” limitations are supported by the ’953 patent application.

B. “Removing” Limitation

Proposed substitute claim element 35h recites “removing the intermediary client devices in the second state from the first group” responsive to the number of intermediary client devices in the first group in the second state being greater than zero. Ex. 2014, 2. We refer to this as the “removing” limitation. Prelim. Guidance 6–8. This limitation, like the “determining” limitations, was not in the original claims.

We determined preliminarily that this limitation is supported by the ’953 patent application. Prelim. Guidance 7. Our analysis again referred to selecting a “substitute” tunnel device as described at page 165 of the ’953 patent specification (Ex. 2022) and to the “Replace Device” step in Figure 32 of the drawings (Ex. 2023). Prelim. Guidance 6; Mot. Amend 12 (claim element 35h).

Referring to Figure 32, *supra*, Patent Owner contends that “when in an ‘offline’ or ‘congested’ state, the intermediary may be unavailable or less effective to use. In such a case, a new intermediary, that was not formerly selected, may now be selected as a substitute for the ‘offline’ or ‘congested’ intermediary.” PO Reply 12 (citing Ex. 2022, 165). Patent Owner observes that “[a]s noted by the Board, although the disclosure does not use the term ‘removing,’ the subject matter need not be described *in haec verba* to satisfy the written description requirement.” PO Reply 12 (citing *In re Wright*, 866 F.2d 422, 425 (Fed. Cir. 1989)).

Petitioner responds by acknowledging that “[w]hen a tunnel device in a group becomes congested, the ’953 Patent discusses embodiments in

which that congested device will be ‘replaced’ or a ‘substitute’ will be added to the group.” Pet. Sur-reply 6. But Petitioner argues that “[t]he specification does *not* say the congested device is removed.” *Id.* Petitioner asserts, “in context, ‘replacing’ and ‘substituting’ do *not* mean ‘removing’ the congested device because the congested device may still be functioning (i.e., capable of providing service, if in a less effective way), and may resume normal operation once the congestion has elapsed.” *Id.* Referring to Figure 32, Petitioner supports its argument by asserting “there is no ‘removing’ step between ‘Mark as Congested’ step 321c and the ‘Replace Device’ step 321d.” *Id.* at 8. Petitioner contends that “[i]nstead, the ’9[53] Patent’s ‘replacing’ adds a new device to the group to replace the congested capacity.” *Id.* at 6.

We disagree with this argument because it is not consistent with the ’953 patent specification or the plain meaning of “replace.” Neither party requested a special construction of the term “replace.” We see no merit in Petitioner’s contention that the plain meaning of “replace” in Figure 32 does not require removal of the device being replaced. The contention that the plain meaning of “replace” does not require “removing” was explored with Petitioner’s counsel at the oral argument:

THE BOARD: If you replace a player in a football game or baseball game, a new player goes in and replaces that player. You don't add a 12th, a 12th player or a 10th player to a baseball team. You replace the player that's there with a different player. Isn't that what replacement is all about?

COUNSEL FOR PETITIONER: Your Honor, in that context, *it absolutely is*. Because there's no other way to understand that. You know, but we're not talking about baseball or people here obviously.

Hearing Tr. 18:23–19:3 (emphasis added).

Petitioner argues that Figure 32 does not support Patent Owner because it “depicts a flowchart of a process that is performed for a single device, which continues after its status becomes congested, indicating that the congested (‘replaced’) device is not removed from the group, but continues to operate.” *Id.* at 9. As discussed *supra*, in connection with the “determining” limitations, we disagree with Petitioner and find that Figure 32 is not limited to a single device. *See* discussion in Section III.A, *supra*. In discussing Figure 32, page 165 of the specification describes “a tunnel device that may be selected (alone *or as part of a group*) by a client device as part of the ‘Select Tunnels’ step 101a in the flowchart 100.” Ex. 1022, 165 (emphasis added). Confirming that this figure is not limited to “a process that is performed for a single device,” as Petitioner asserts, flowchart 100, referred to in the discussion of Figure 32 at page 165 cited by Petitioner, shows selection of a group comprising multiple tunnel devices. *See* Ex. 2023, Fig. 10 and accompanying description at Ex. 2022, 118 (“A flowchart 100 relating to the client device #1 31a when employing *three tunnel devices* is shown in FIG. 10.”) (emphasis added).

We find further that the citation to the ’953 specification relied on by Patent Owner does not describe a congested device that is “still functioning” after being replaced. *See* Ex. 2022, 165. That discussion of Figure 32 at page 165 of the specification describes the situation where a selected agent device shifts to an offline state or a congested state, and “thus respectively becomes unavailable or less effective to use.” *Id.* at 165. As the specification explains, “[i]n such a case, a new agent device, that was not formerly selected, may be now selected as a *substitute for the ‘offline’ or ‘congested’ agent device* as part of a ‘Replace Device’ step 321d.” *Id.* (emphasis added). We find no suggestion that the “replaced” device referred

to in this description continues to provide services. In fact, the specification states that when a device is marked as “congested,” “the system or the tracking device may hold any further workload, or request for any service, relating to the tracked device.” *Id.* at 163.

We are not persuaded by Petitioner’s principal argument that the ’953 specification discloses that “replacing” involves only adding “a new device to the group to replace the congested capacity.” *See, e.g.,* Pet. Sur-reply 6; Hearing Tr. 17:1–15. As discussed *supra*, we find that this contention is contrary to the disclosures of substituting and replacing devices in the specification relied on by Patent Owner. To support its argument, Petitioner turns to eight lines from a section of the ’953 patent that relates to tracking the status of devices. Pet. Sur-reply 6 (citing Ex. 1001, 121:8–10; 121:39–45). These citations relate to a “heartbeat” mechanism for allowing devices to sense the status of other devices in the system. *See* Ex. 1001, 121:33–37. They do not suggest that a tracked device that has been “replaced” because it is in the “congested” state would continue to provide services.

Nor are we persuaded by Petitioner’s argument that the ’953 patent uses “remove” to describe the situation where non-congested devices are removed from a group that has excess capacity but not replaced. *See* Pet. Sur-reply 6 (citing Ex. 1001, 74:60–75:1); Hearing Tr. 21:10–22 (citing Ex. 2022, 99).⁸ Petitioner contends this demonstrates “the difference between ‘replacing’ and ‘removing.’” Pet. Sur-reply 6. This argument is unavailing. We find that while a device can be removed from a group without being replaced, the opposite is not true. *See* Hearing Tr. 21:25–23:5. Thus, when

⁸ The citations to Exhibit 1001 in the Sur-reply and to Exhibit 2022 at the hearing refer to the same disclosure.

Figure 32 and the accompanying text describe “replacing” devices that become congested, they also disclose removing them. *See* Ex. 2022, Fig. 32, step 321d. Therefore, we see no inconsistency between Petitioner’s citations to the ’953 patent and Patent Owner’s contention that “replacing” a device in Figure 32 also involves removing it.

Similarly, we find no merit in Petitioner’s argument that “replacing” and “substituting” do not mean “removing” because “the congested device . . . may resume normal operation once the congestion has elapsed.” Pet. Sur-reply 6. We agree instead with Patent Owner and find that even if a replaced device might ultimately become available again, that does not mean that it was not removed from the “first [non-congested] group” and replaced. PO Reply 12 n.4.⁹

We have considered Petitioner’s other arguments (including Patent Owner’s alleged misuse of “string citations” in its Appendix A-1)¹⁰ and find them unavailing. We find, therefore, that for the reasons given, Patent Owner demonstrates support in the ’953 patent application for the “removing” limitation.

IV. CONCLUSION

After considering the evidence and arguments before us, we *grant* Patent Owner’s Motion to Amend, as well as Patent Owner’s request to cancel original claims 1–34 and replace them with substitute claims 35–66.

⁹ Petitioner’s argument based on an alleged admission by Patent Owner in another proceeding that a “congested” device may still be able to provide services (*see* Pet. Sur-reply 11) fails for a similar reason. We find that even if a congested device may still function, albeit at a lower level, that does not mean it was not removed from a group and replaced as shown in Figure 32.

¹⁰ At the oral argument, Patent Owner stated that it is not relying on this Appendix, but on the citations in the briefing. Hearing Tr. 27:8–19.

In summary:

Motion to Amend Outcome	Claim(s)
Original Claims Cancelled by Amendment	1–34
Substitute Claims Proposed in the Amendment	35–66
Substitute Claims: Motion to Amend Granted	35–66
Substitute Claims: Motion to Amend Denied	None

V. ORDER

In consideration of the foregoing, it is:

ORDERED that Patent Owner’s Motion to Amend is *granted*;

FURTHER ORDERED that claims 1–34 of the ’953 patent are *cancelled* and replaced by substitute claims 35–66, respectively; and

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

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