

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETSKOPE, INC.,
Petitioner,

v.

BITGLASS, INC.,
Patent Owner.

PGR2021-00092
Patent 10,855,671 B2

Before JAMES J. MAYBERRY, KEVIN C. TROCK, and
SHEILA F. McSHANE, *Administrative Patent Judges*.

MAYBERRY, *Administrative Patent Judge*.

DECISION
Denying Institution of Post-Grant Review
35 U.S.C. § 324

I. INTRODUCTION

Netskope, Inc. (“Petitioner”) filed a Petition requesting a post-grant review of claims 17–20 and 22–24 (the “Challenged Claims”) of U.S. Patent No. 10,855,671 B2 (Ex. 1001, the “’671 patent”). Paper 2, 1 (“Pet.” or “Petition”). Bitglass, Inc. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”). With our prior authorization, Petitioner and Patent Owner filed statements of additional legal authority directed to parallel petitions and written description. Papers 9, 10.

We may not institute a post-grant review “unless . . . the information presented in the petition filed under section 321, if such information is not rebutted, would demonstrate that it is more likely than not that at least 1 of the claims challenged in the petition is unpatentable.” 35 U.S.C. § 324(a). Upon consideration of the arguments and evidence, we exercise our discretion to deny the Petition.

A. Real Parties in Interest

Petitioner and Patent Owner state that they are the real parties-in-interest. Pet. 2; Paper 5, 2.

B. Related Matters

Petitioner identifies district court litigation styled, *Netskope, Inc. v. Bitglass, Inc.*, No. 3:21-cv-00916-EMC (N.D. Cal. Feb. 5, 2021), as a matter related to the ’671 patent. Pet. 2. Additionally, Petitioner identifies PGR2021-00091, which also challenges claims of the ’671 patent, and IPR2021-01045 and IPR2021-01046, which challenge claims of U.S. Patent No. 10,757,090 (the “’090 patent”), which is related to the ’671 patent. *Id.*; *see also* Ex. 1001, code (63) (indicating the relationship between the ’671 patent and ’090 patent); Paper 5, 2 (identifying the same related matters).

C. The '671 Patent

The '671 patent, titled “Secure Application Access System,” issued December 1, 2020, from U.S. Application 16/876,163 (the “'163 application”), filed May 18, 2020. Ex. 1001, codes (54), (45), (21), (22). The face of the patent indicates that the '163 application is a continuation of U.S. Application 14/954,989 (the “'989 application”¹), filed November 30, 2015, which itself is a continuation of U.S. Application 13/957,274 (the “'274 application”), filed August 1, 2013. *Id.* at code (63).

The '671 patent is directed “to securing data on client devices external to corporate infrastructures.” Ex. 1001, 1:21–23. The '671 patent identifies one such process for securing this type of data as proxy routing. *Id.* at 5:63–7:61. We reproduce Figure 3b, below, which illustrates a proxy in a network in an embodiment.

¹ The '989 application matured into the '090 patent. Ex. 1001, code (63).

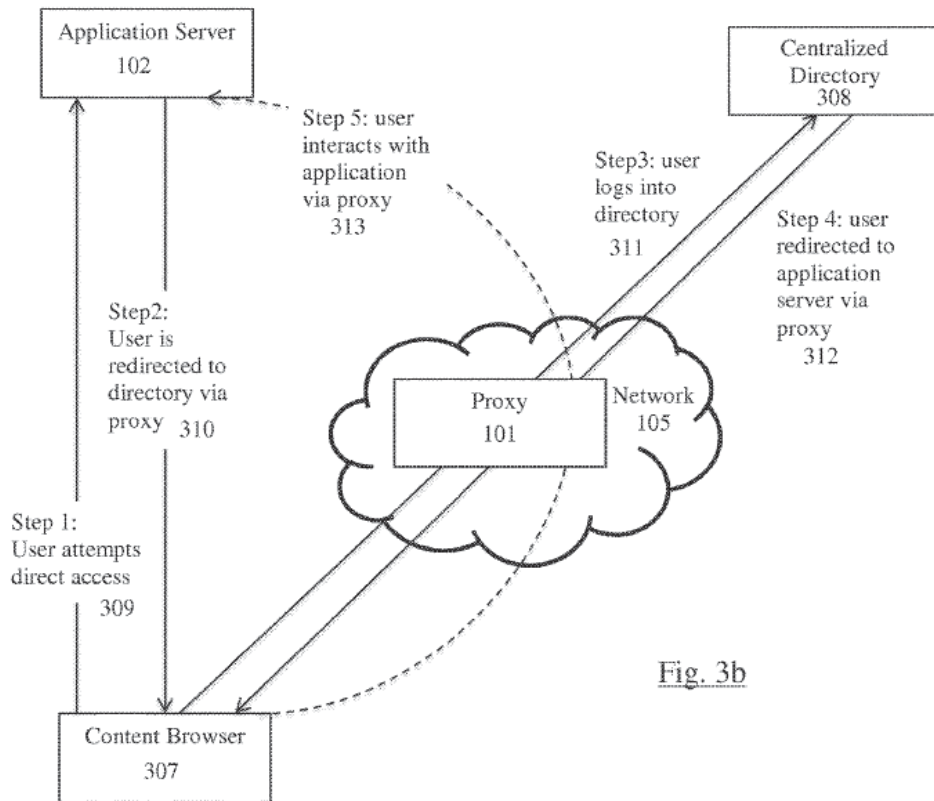


Fig. 3b

Figure 3b depicts a proxy in a network, including a content browser, application server, and centralized directory. Ex. 1001, 2:7, 6:27–39. A user using content browser 307 attempts to access (309) application server 102. *Id.* at 6:27–28. Server 102 redirects (310) the user to central directory 308 through proxy 101. *Id.* at 6:29–30. The user then provides its login credentials (311), which are authenticated by central directory 308. *Id.* at 6:30–32. Central directory 308 then redirects (312) the user to application server 102 through proxy 101. *Id.* at 6:32–33. “Such delegation to a central directory is useful in a corporation where replicating the login information for every employee at each application is difficult to manage.” *Id.* at 6:10–12. This type of authentication is referred to as single sign-on (“SSO”). *See* Pet. 5; Prelim. Resp. 16.

Another embodiment is shown in the '671 patent's Figure 11, which we reproduce below.

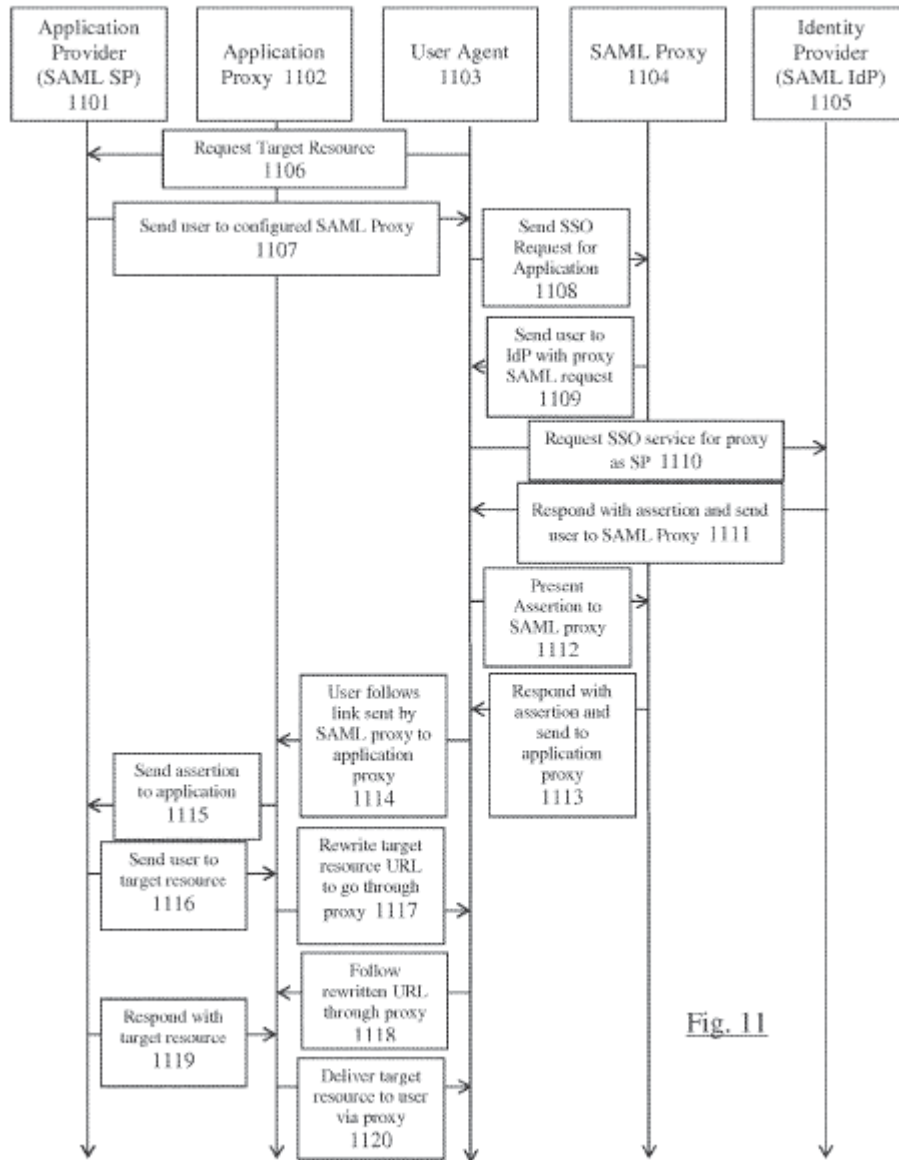


Fig. 11

Figure 11 depicts “an automatic routing and failover embodiment,” and includes interactions between a user agent, application provider, application proxy, Security Assertion Markup Language (SAML) proxy, and identity provider (“IdP”). Ex. 1001, 2:26–27, 6:48–56. In this configuration, “all login attempts are redirected to the SAML proxy 1104.”

Id. at 6:59–60. IdP 1105 authenticates requests from SAML proxy 1104. *Id.* at 6:62–64. The steps illustrated in Figure 11 are described as follows:

[T]he user agent 1103 sends a request for a target resource 1106 to the application 1101. The application [service provider] 1101 directs the user agent 1107 to the SAML proxy 1104. Using the IP address received in the received direction, the user agent 1103 sends a single sign on (SSO) request for the application 1108 to the SAML proxy 1104. The SAML proxy 1104 receives the request and directs 1109 the user agent 1103 to the IdP 1105. The user agent 1103 uses the IP address of the IdP 1105 to send an SSO request 1110 to the IdP 1105. The IdP 1105 validates the SSO request and responds with an assertion of a valid SSO 1111 for the SAML proxy. The user agent 1103 sends the assertion 1112 to the SAML proxy 1104. The SAML proxy 1104 creates an assertion for the application proxy and sends the assertion and the IP address of the application proxy 1113 to the user agent 1103.

The user agent 1103 passes the assertion to the application proxy 1114 using the IP address of the application proxy 1102. The application proxy 1102 forwards the assertion 1115 to the application service provider (SP) 1101. The application SP 1101 provides the target resource [Uniform Resource Locator (“URL”)] to the user 1116, in this case the application proxy 1102 sits in front of the application SP 1101 and receives the target resource URL. The application proxy 1102 rewrites the target resource URL to redirect the URL to the application proxy. The application proxy 1102 sends the rewritten URL 1117 to the user agent 1103.

The user agent 1103 receives the URL and accesses the application using the target resource URL 1118[,] which happens to be redirected through the application proxy 1102. The application proxy 1102 forwards any accompanying request to the application SP 1101. The application SP 1101 responds to the accompanying request 1119. The application proxy 1102 receives the response and forwards the response 1120 to the user agent 1103.

Id. at 7:8–42.

D. Challenged Claims

Petitioner challenges the patentability of claims 17–20 and 22–24 of the '671 patent. Pet. 1, 4. Claim 17, the sole challenged independent claim, is illustrative, and reproduced below.

17. A system that improves secure access to cloud-based application programs, comprising:

an identity provider, implemented at least partially in hardware, configured to receive a single-sign-on request from a user device for access to a cloud-based application program, the user device sends a request for access to the cloud-based application program to an application server and receives the cloud network location of the identity provider from the application server, the identity provider configured to authenticate computer security validation requests for the application program;

an application proxy server, implemented at least partially in hardware, configured to direct all accesses to cloud-based application programs provided by an application provider to itself;

wherein the identity provider validates the single-sign-on request;

wherein, in response to validating the single-sign-on request, the identity provider directs the user device to a cloud network location of an application proxy server with a valid identification assertion, the user device thereafter communicates with the application program via a URL rewritten to go through the application proxy server, the URL originally addressed to the application program, the application proxy server not co-located with the application server.

Id. at 16:12–38. Claim 17 recites almost identical subject matter as compared to the other independent claims of the '671 patent—claims 1 and 9. *Compare id.* at 16:12–38 *with id.* at 13:65–14:17, 15:1–22. Claim 1 is written as a method claim, claim 9 is written to cover “[o]ne or more non-

transitory computer-readable storage media” storing instructions of the method of claim 1, and claim 17 is written as a system implementing the method of claim 1. *Id.* at 13:65–14:17, 15:1–22, 16:12–38. Petitioner challenges independent claims 1 and 9 in PGR2021-00091. PGR2021-00091, Paper 2, 1.

E. Asserted Grounds of Unpatentability

Petitioner asserts that the Challenged Claims would have been unpatentable on the following eight grounds (Pet. 4):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
17, 18, 22, 23	103	Sarukkai, ² Rowley ³
24	103	Sarukkai, Rowley, Song ⁴
19	103	Sarukkai, Rowley, Guccione ⁵
17, 18, 22, 23	102	Cronk, ⁶ Woelfel ⁷
24	103	Cronk, Woelfel, Song
19	103	Cronk, Woelfel, Guccione
17, 18, 20, 22, 23	103	Kahol, ⁸ Parla ⁹
19, 20	112	Written description, enablement

² Sarukkai et al., US 9,137,131 B1, issued September 15, 2015 (Ex. 1004, “Sarukkai”).

³ Rowley, US Pub. 2008/0189778 A1, published August 7, 2008 (Ex. 1005, “Rowley”).

⁴ Song, WO 2005/069823 A2, published August 4, 2005 (Ex. 1011, “Song”).

⁵ Guccione et al., US Pub. 2015/0319156 A1, published Nov. 5, 2017 (Ex. 1010, “Guccione”).

⁶ Cronk et al., US Pub. 2012/0008786 A1, published January 12, 2012 (Ex. 1006, “Cronk”).

⁷ Woelfel et al., US Pub. 2012/0278872 A1, published November 1, 2012 (Ex. 1007, “Woelfel”).

⁸ Kahol et al., US Pub. 2016/0087970 A1, published March 24, 2016 (Ex. 1008, “Kahol”).

⁹ Parla et al., US Pub. 2015/0200924 A1, published July 16, 2015 (Ex. 1009, “Parla”).

In addition to other evidence, Petitioner relies on declaration testimony of Dr. Michael Franz (Ex. 1002) in support of these grounds. In addition to other evidence, Patent Owner relies on declaration testimony of Dr. Seth James Nielson (Ex. 2001) to support its preliminary response.

The following subsections provide a brief description of the asserted prior art references.

1. Sarukkai

Sarukkai is titled “Network Traffic Monitoring System and Method to Redirect Network Traffic through a Network Intermediary.” Ex. 1004, code (54). Sarukkai discloses embodiments of a “network traffic monitoring system and method [that] implements reverse-proxying of the federated identity handshake used to authenticate user access to a cloud-based service,” employing a single sign-on scheme. *Id.* at 3:8–11, 3:40–41. “When the user is authenticated, the reverse proxy rewrites the redirect web address for accessing the cloud service so that network traffic between the client device and the cloud service is redirected through a network proxy.” *Id.* at 3:11–15. One such embodiment is depicted in Sarukkai’s Figure 4, which we reproduce below.

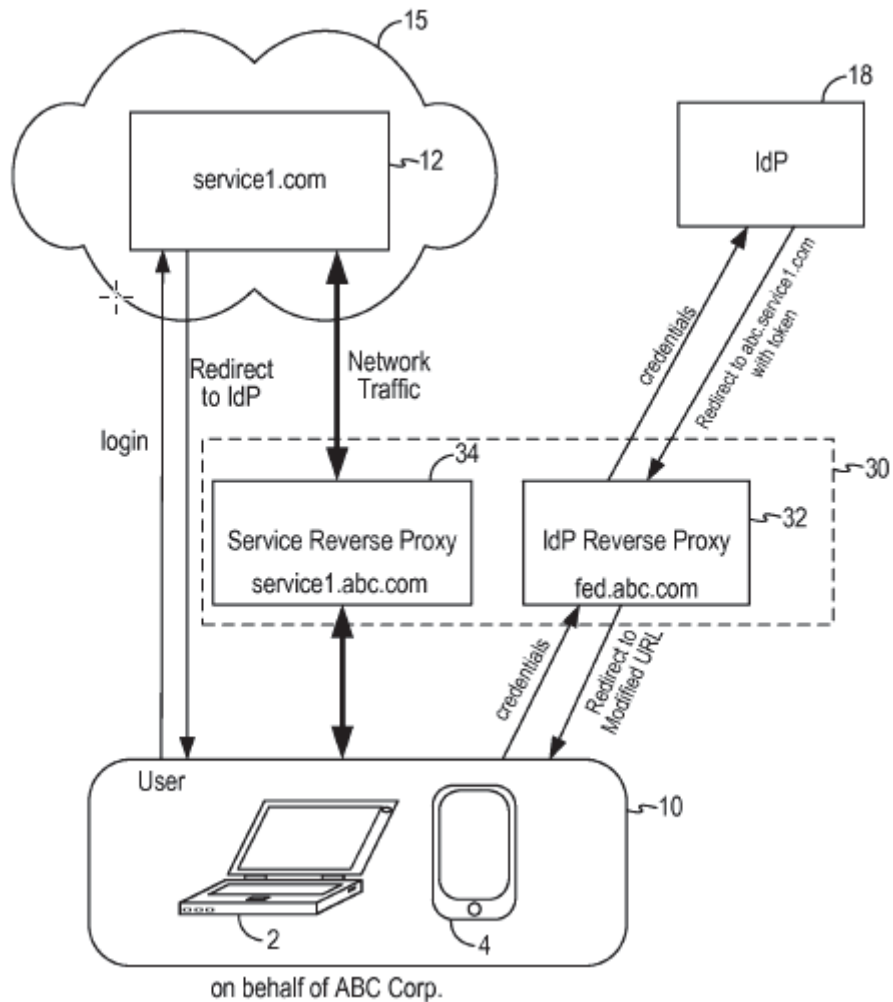


Figure 4 shows a user with client device 10 accessing cloud-based service 12. *See* Ex. 1004, 8:5–16. The user is redirected to IdP 18 through IdP Reverse Proxy 32 to authenticate log-in credentials. *Id.* at 8:16–19, 8:31–33. Upon authentication, IdP 18 redirects the user to the cloud-based service through Service Reverse Proxy 34. *Id.* at 8:38–42; *see also id.* at 8:66–9:60 (describing the steps in this process in connection with Figure 5), Fig. 5.

2. Rowley

Rowley is titled “Secure Authentication in Browser Redirection Authentication Schemes.” Ex. 1005, code (54). Rowley relates “to

authenticating users of a redirected web browser.” *Id.* ¶ 1. Rowley discloses that a single sign-on scheme allows “a user to authenticate once and gain access to the resources of multiple computing systems.” *Id.* ¶ 3. Rowley adds that such a scheme is vulnerable to “man in the middle”¹⁰ attacks. *Id.* We reproduce Rowley’s Figure 4, as redrawn by Petitioner for clarity, below.

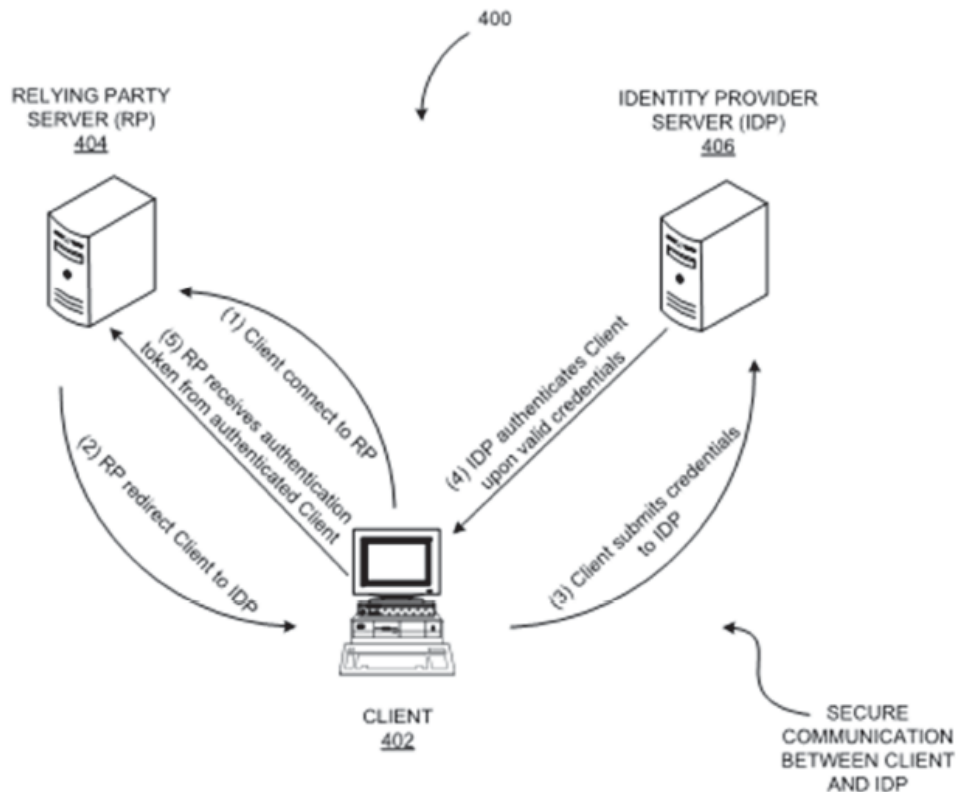


FIG. 4

Pet. 37–38. Figure 4 depicts an exemplary architecture 400 for an embodiment of Rowley’s invention, including client 402, relying party (“RP”) server 404, and identity provider (“IDP”) server 406. Ex. 1005 ¶ 26.

¹⁰ In a “man-in-the-middle” attack, “a malicious party intercepts a user’s credentials; for example, the malicious party may occupy a proxy residing between a client and IdP and impersonate the IdP.” Pet. 9.

At step 1, “client 402 connects to RP server 404 and attempts to log in using . . . single sign on.” *Id.* ¶ 30. At step 2, RP server 404 redirects client 402 to IDP server 406, such as by redirecting a web browser operating on client 402 that was used to access RP server 404. *Id.* At step 3, client 402 submits its log-in credentials to IDP server 406. *Id.* At step 4, IDP server 406 authenticates the credentials and, upon a successful authentication, sends an authentication token to client 402. *Id.* ¶ 39. At step 5, client 402 forwards the authentication token to RP server 404. *Id.* ¶ 40.

3. *Song*

Song is titled “Centralized Transactional Security Audit for Enterprise Systems.” Ex. 1011, code (54). *Song* discloses “a method to achieve centralized security audit for an authentication and authorization and access control system.” *Id.*, code (57). Relevant to Petitioner’s unpatentability contentions, *Song* discloses logging network requests. *Id.* ¶¶ 29, 50, 80–84, 127, 129, 135, 137, Fig. 8. For example, *Song*’s Figure 8 depicts an authentication process within a security proxy server. *Id.* ¶ 119; Fig. 8. The process includes logging log-in parameters, such as a “Userid, Domain Name, Remote IP address and Remote Hostname.” *Id.* ¶ 127. Additionally, “[t]he authentication status information is . . . logged.” *Id.* ¶ 129.

4. *Guccione*

Guccione is titled “Independent Identity Management Systems.” Ex. 1010, code (54). *Guccione* discloses “[s]ystems, methods and apparatus embodiments . . . for authenticating a user and/or a user[’s] equipment (UE).” *Id.* ¶ 4. Relevant to Petitioner’s unpatentability contentions, *Guccione* discloses using multiple identity providers in a single sign-on scheme. *See, e.g., id.* ¶ 52 (describing, in the embodiment of Figure 4, that

mobile network operator (MNO) 408 can function as a second IdP, in addition to a user IdP proxy).

5. *Cronk*

Cronk is titled “Apparatus and Methods for Content Delivery and Message Exchange Across Multiple Content Delivery Networks.” Ex. 1006, code (54). Cronk discloses “[m]ethods and apparatus for providing protected content to subscribers of a managed . . . network.” *Id.*, code (57). In certain embodiments, Cronk employs a single sign-on scheme to authenticate the subscriber. *See, e.g., id.* ¶ 60 (“In another variant, the service provider and [multiple systems operator (“MSO”)] accounts for a particular user may be linked or federated. In other words, a trust relationship is established between the service provider and MSO, which is used to verify subscriber information.”), Figs. 3, 4. We reproduce Cronk’s Figure 4, below.

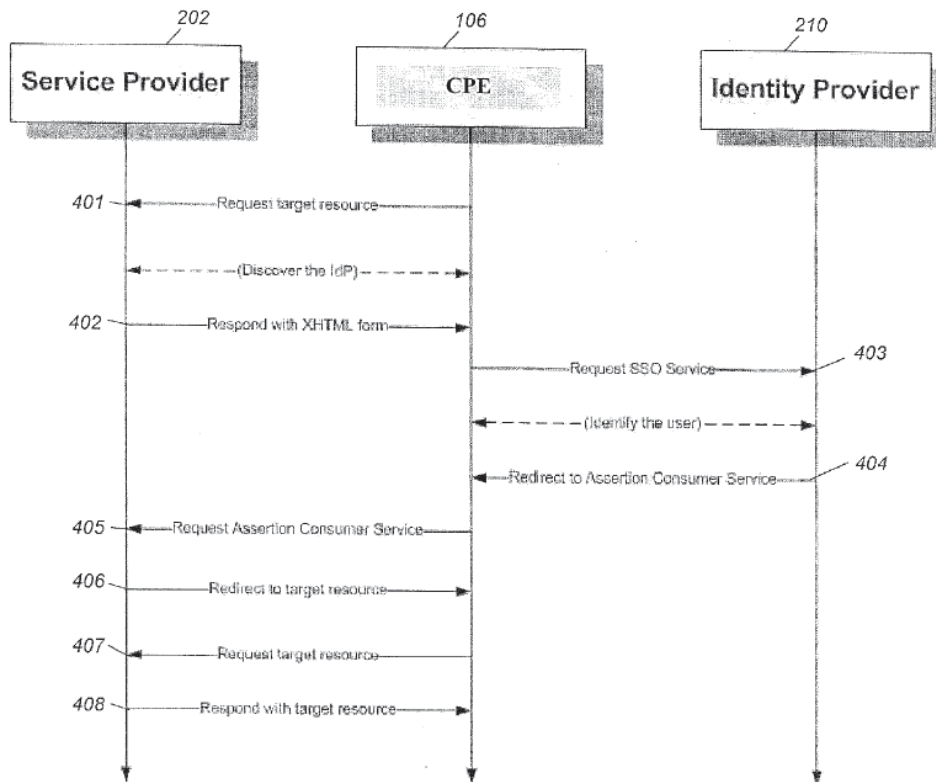


FIG. 4

Figure 4 depicts “exemplary communication flow for providing content delivery across one or more content delivery networks.” Ex. 1006 ¶ 29. This exemplary process begins with a client device requesting a target resource from service provider 202 (step 401). *Id.* ¶ 133. Service provider 202 performs a security check on behalf of the target resource and, if necessary, responds to the request (step 402), such as with an XHTML form. *Id.* ¶ 135. The client device then requests to sign on to the MSO network of identity provider 210 at step 403, such as by using a single sign-on scheme, using authentication credentials. *Id.* ¶¶ 136, 137.

Identity provider 210 redirects the client device to the assertion consumer service (step 404), which validates SAML responses. Ex. 1006 ¶ 138. The client device then request assertions from service provider 202 (step 405). *Id.* The assertion consumer service processes the response,

creates a security context at service provider 202, and redirects the client device to the target resource (step 406). *Id.* ¶ 139. The client device requests the target resource at service provider 202 (step 407). *Id.* Service provider 202 returns the requested resource (step 408). *Id.* ¶ 140.

6. *Woelfel*

Woelfel is titled “System and Method of Federated Authentication with Reverse Proxy.” Ex. 1007, code (54). Woelfel’s disclosed system and method employs an enhanced reverse proxy server to intercept a SAML conversation during an authentication of a user accessing a cloud application service. *Id.*, code (57). We reproduce Woelfel’s Figure 2, below.

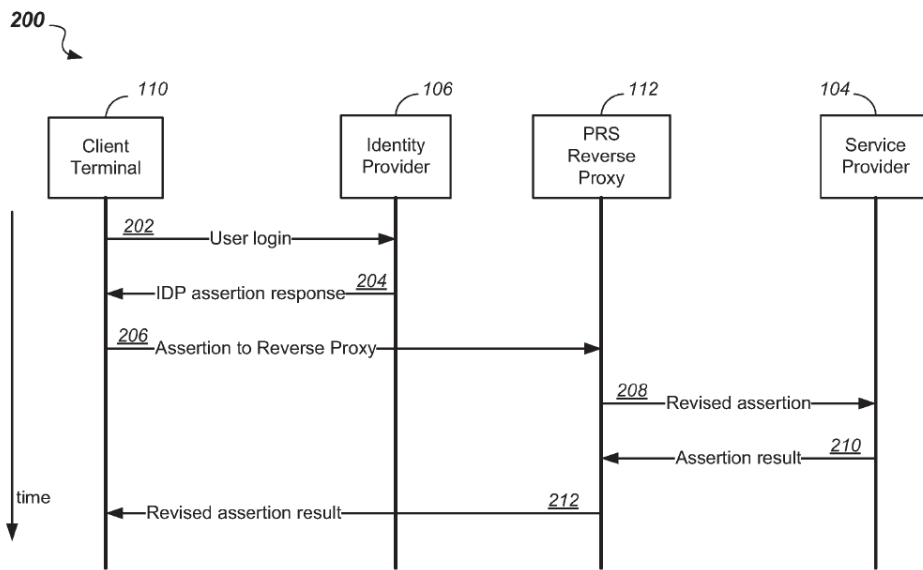


Fig. 2

Figure 2 depicts “‘Identity Provider-Initiated’ login as an example operation of SAML federated authentication with a Reverse Proxy.”

Ex. 1007 ¶ 73.

The message sequence 202 to 212 illustrates “‘Identity Provider-Initiated’” login in which the login of the client 110 to the SP 104 is first directed to the IDP 106[,], which provides the client 110

with an authentication certificate with which the client 110 is then able to assert his identity with the SP 104 through the PRS-RP 112. Each of the messages 202 to 212 is shown as a single message in FIG. 2 in this high-level view.

Id. ¶ 134.

7. *Kahol*

Kahol is the published version of the '989 application, which is the parent application to the '163 application, which matured into the '671 patent. As Petitioner indicates, “Kahol share[s] the same detailed description and figures with the '671 patent.” Pet. 96; *see also* Prelim. Resp. 73 (“Both Kahol (Ex. 1008) and the '671 patent claim priority to the same application ('274 Application).”). Petitioner contends that the Challenged Claims are not entitled to a priority date earlier than the filing date of the '163 application, making Kahol prior art to the '671 patent. Pet. 16–23. Patent Owner disputes this contention. Prelim. Resp. 21–36.

8. *Parla*

Parla is titled “Redirect to Inspection Proxy using Single-Sign-On Bootstrapping.” Ex. 1009, code (54). Parla “relates to single-sign-on techniques for service provider applications.” *Id.* ¶ 1. We reproduce Parla’s Figure 2, below.

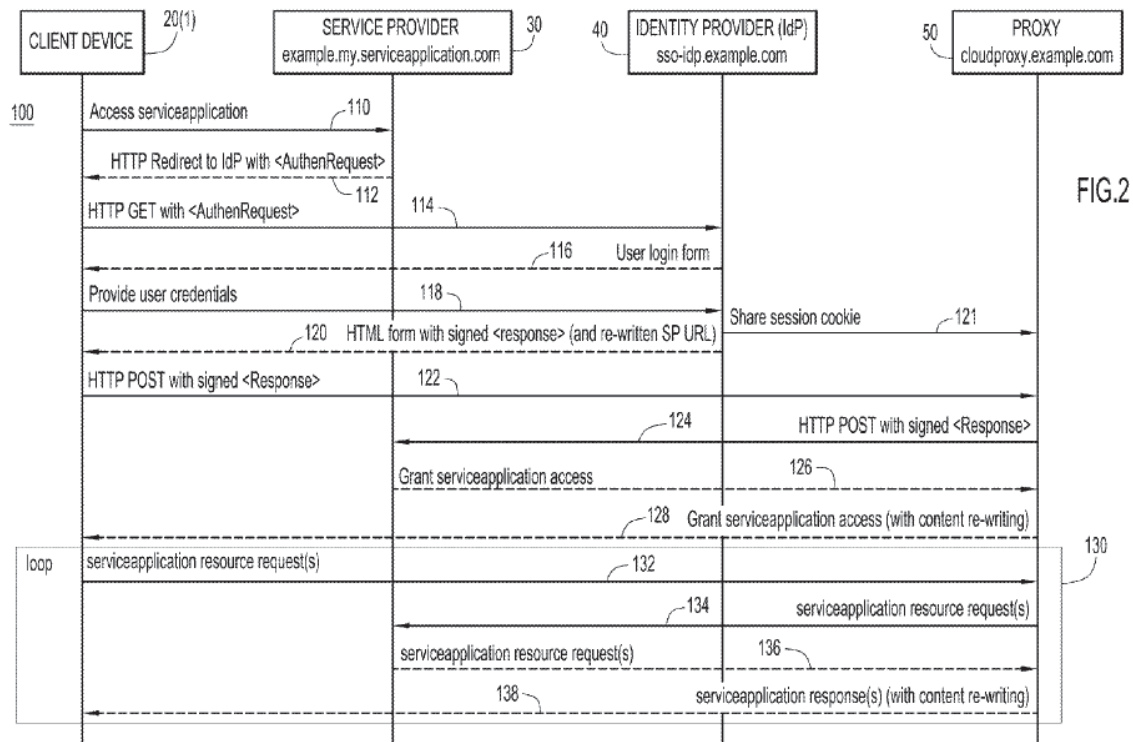


Figure 2 depicts “a ladder sequence diagram illustrating the operational flow according to [Parla’s] techniques.” Ex. 1009 ¶ 6. A user accesses a service provider using a browser (step 110), and is redirected to the identity provider (step 112) for authentication (step 114). *Id.* ¶ 18. The identity provider responds to the authentication request with a user login form (step 116). *Id.* The user provides log-in credentials into the form and sends the credentials in the browser application to the identity provider (step 118). *Id.*

Upon authentication, the identity provider responds with an assertion and rewrites a delivery resource locator for the assertion to a resource locator of a proxy (step 120). Ex. 1009 ¶ 19. The client device sends the assertion to the proxy (step 122). *Id.* ¶ 20. The proxy decodes re-written resource locator and sends the assertion to the service provider (step 124).

Id. ¶ 21. Thereafter, the proxy receives responses from the service provider (step 126). *Id.* ¶ 22.

II. ANALYSIS

A. PGR Eligibility

As a threshold issue, we must determine if the '671 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 '671 patent is such an application. The earliest priority claim for the '671 patent is an application filed August 1, 2013. Ex. 1001, code (63).

Accordingly, the effective filing date of the '671 patent is no earlier than August 1, 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 '671 patent issued December 1, 2020, and the Petition was accorded a filing date of June 7, 2021, just over 6 months after the grant of the '671 patent. Ex. 1001, code (45); Paper 3, 1. Accordingly, Petitioner timely filed the Petition.

B. Discretionary Denial under 35 U.S.C. § 324(a)

As we indicated above in our discussion of related matters, Petitioner filed two post-grant review petitions challenging claims of the '671 patent. Patent Owner argues that we should exercise discretion to deny the Petition in this proceeding, as a second petition challenging the '671 patent is not warranted. Prelim. Resp. 1, 3–15.¹¹

1. Policies governing discretionary denial under 35 U.S.C. § 324(a) and multiple petitions

The Board has discretion not to institute a post-grant review. *See* 35 U.S.C. § 324(a) (authorizing institution of a post-grant review under particular circumstances, but not requiring institution under any circumstances); 37 C.F.R. § 42.208(a) (stating “the Board *may* authorize the review to proceed”) (emphasis added); *see also* *Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion. *See* [5 U.S.C.] § 701(a)(2); 35 U.S.C. § 314(a) (no mandate to institute review).”)

¹¹ We enter a Decision instituting trial in PGR2021-00091 concurrent with entering the present Decision.

(additional citation omitted); *cf. Harmonic Inc. v. Avid Tech, Inc.*, 815 F.3d 1356, 1367 (Fed. Cir. 2016) (explaining that under § 314(a), a provision nearly identical to § 324(a) and governing *inter partes* review proceedings, “the PTO is permitted, but never compelled, to institute an IPR proceeding”). In determining whether to exercise our discretion not to institute a trial, we consider “[t]he purpose of the ‘America Invents Act,’ as reported by the Committee on the Judiciary, [which] is to . . . establish a more efficient and streamlined patent system that will improve patent quality and limit unnecessary and counterproductive litigation costs.” H.R. REP. 112–98, pt. 1 at 40 (2011).

“Based on the Board’s experience, one petition should be sufficient to challenge the claims of a patent in most situations.” Consolidated Trial Practice Guide, 59 (Nov. 2019), *available at* <https://www.uspto.gov/sites/default/files/documents/tpgnov.pdf> (“CTPG”). The Board recognizes that some situations may warrant multiple petitions, such as a large number of challenged claims or a dispute as to the priority date for the patent at issue. *Id.*

To aid the Board in determining whether more than one petition is necessary, if a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions, identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 3[2]4(a).

Id. at 59–60 (footnote omitted). For the reasons discussed below, we exercise our discretion to deny the Petition under § 324(a).

2. *Analysis under 35 U.S.C. § 324(a)*

Patent Owner argues that “Petitioner does not even address the issue of why a second petition is necessary” to challenge the claims of the ’671 patent. Prelim. Resp. 4. Patent Owner explains that the CTPG instructs petitioners who file multiple petitions challenging the same patent to rank the multiple petitions, and to explain why the multiple petitions are warranted. *Id.* at 4–5. Patent Owner argues that, despite this instruction, “[t]he Petition is absolutely silent on any of these issues.” *Id.* at 5.

Patent Owner argues that prior Board decisions have denied parallel petitions, including when a petitioner fails to explain adequately the need for multiple petitions challenging the same patent. Prelim. Resp. 5–7. Also, Patent Owner argues that two petitions are not necessary under the facts here—that the parallel petitions challenging the ’671 patent do not meet the criteria that justify a second petition. *Id.* at 7.

Patent Owner argues that, in the district court litigation, Patent Owner asserts 21 claims from the ’671 patent, which is “hardly a large number that would justify two petitions.” Prelim. Resp. 7. Patent Owner adds that “there is a substantial overlap of claim language of the asserted claims.” *Id.* Patent Owner argues that this overlap is evidenced by the fact that Dr. Franz submitted a single declaration covering both PGR2021-00091 and PGR2021-00092. *Id.* Patent Owner adds that “a large portion of his analysis for later claims referred back to his analysis to earlier claims.” *Id.* at 8. Patent Owner explains that “Dr. Franz’s grouping of claims and repetitive analysis . . . shows the substantial overlap in Dr. Franz’s analysis

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of the challenged claims for the Sarukkai-Rowley combination.” *Id.*; *see also id.* at 8–10 (providing a table highlighting the overlap in Dr. Franz’s analysis for claims challenged in PGR2021-00091 and PGR2021-00092). Patent Owner notes that all but two limitations for claims 17, 18, 19, and 22–24, challenged in PGR2021-00092, reference the analysis for comparable claims challenged in PGR2021-00091. *Id.* at 10. Patent Owner argues that a similar situation exists for the Cronk-Woelfel combination. *Id.* at 10–13.

Patent Owner concludes that “Petitioner could have easily submitted a single Petition given the substantial overlap of its expert’s analysis for the challenged claims.” Prelim. Resp. 13. Patent Owner adds that “Petitioner has circumvented the word count by splitting the claims of the ’671 patent into two separate petitions, each petition having the exact same eight Grounds.” *Id.* at 15.

We agree with Patent Owner that two petitions challenging the claims of the ’671 patent are not warranted under these circumstances. First, as Patent Owner argues, Petitioner has provided us with no explanation as to why multiple petitions are necessary here, despite our guidance in the CTPG, which states that such an explanation should be provided at the time the multiple petitions are filed. *See* CTPG 59–61. As such, we are left with no justification for the two petitions from Petitioner to weigh against Patent Owner’s arguments.

Second, we do not discern, based on our own review of the petitions, any reason why one petition would not have been sufficient to challenge the claims of the ’671 patent, given the substantial overlap in the subject matter of the claims. The ’671 patent has three independent claims. Ex. 1001, 13:61–17:9. Claim 1 is written as a method claim, claim 9 is written to

cover “[o]ne or more non-transitory computer-readable storage media” storing instructions of the method of claim 1, and claim 17 is written as a system implementing the method of claim 1. *Id.* at 13:65–14:17, 15:1–22, 16:12–38. The claims depending from these independent claims recite similar subject matter. *Compare, e.g.*, 14:51–53 (claim 7), *with* 15:60–63 (claim 15) *and* 16:42–44 (claim 19) (reciting subject matter directed to the identity provider monitoring the operating status of the application proxy server).¹² As Patent Owner argues, Dr. Franz’s testimony is repetitive, often referencing analysis directed to claim 1 and its challenged dependent claims in analyzing claim 17 and its challenged dependent claims. *See, e.g.*, Ex. 1002¹³ ¶¶ 140, 141, 143–146 (referencing the analysis of elements of claim 1 for elements of claim 17), ¶¶ 147–149 (referencing the analysis of claims 4 and 5 for claims 22 and 18/23).

We recognize that Petitioner challenges the priority date of the ’671 patent. *See* Pet. 16–23; CTPG 59 (indicating a priority date dispute could justify multiple petitions). Also, one set of grounds depends, in part, on the priority date of the Challenged Claims. *See* Pet. 96–120 (challenging claims based on a reference in the priority chain of the ’671 patent). Petitioner does not, however, differentiate its petitions based on this issue—both petitions have identical grounds, most of which do not turn on the priority date of the Challenged Claims. *See* Prelim. Resp. 13–14 (“[A]lthough there is a priority

¹² Additional overlap exists—as evidenced in a comparison of the combined recitations of claims 18 and 23 with claims 5 and 13, claim 19 with claims 7 and 15, claim 20 with claims 8 and 16, claim 22 with claims 4 and 12, and claim 24 with claims 6 and 14. Ex. 1001, 13:61–17:9.

¹³ Ex. 1002 is the same exhibit filed in both PGR2021-00091 and PGR2021-00092. *See* Ex. 1002, title page.

issue raised by the Petition, the Petitioner is not proposing alternate grounds based on different priority dates of the patent claims. Both petitions raise the same ground and have the same exact prior art combinations.”).

Thus, the particular circumstances of this proceeding do not appear to warrant multiple petitions.

Additionally, with our authorization, Petitioner identified legal citations that Petitioner contends supports its multiple petitions.¹⁴ Paper 9, 1. We determine that the additional legal citations do not persuade us that Petitioner’s challenge to the ’671 patent warrants multiple petitions. We address the identified citations, in turn, below.¹⁵

a) *Platform Science, Inc. v. Omnitracs, LLC, IPR2020-01518, Paper 14 at 15–18 (PTAB April 15, 2021)*

In *Platform Science, Inc.*, the Board determined that the petitioner’s challenges warranted multiple petitions. *Platform Science, Inc. v. Omnitracs, LLC, IPR2020-01518, Paper 14 at 15–18 (PTAB April 15, 2021)*. The Board found that the petitioner was forced to challenge 37 claims because the patent owner asserted all of the claims in the parallel litigation, and that the 37 claims were a “large number.” *Id.* at 17. This case is distinguishable from the facts here. First, in *Platform Science, Inc.*, the

¹⁴ On October 12, 2021, we conducted a conference call with the parties, where we allowed Petitioner to explain why good cause existed to allow Petitioner to file a reply to the Preliminary Response to address the multiple petitions issue (among other issues). Paper 8, 2. Specifically, Petitioner argued that the cases relied on by Patent Owner in its preliminary response were distinguishable. *Id.* at 3. We determined that Petitioner did not provide good cause to warrant a reply, but authorized the parties to submit additional relevant legal authority on the issue of multiple petitions. *Id.*

¹⁵ We note that none of the cases identified by Petitioner are precedential or informative.

Board had the benefit of an explanation from the petitioner. *See, e.g., id.* at 16 (stating that the petitioner explained that the claims of the challenged patent fell into two groups, such that the claims were the equivalent of challenging two patents). Additionally, in comparison with Board’s findings in *Platform Science, Inc.*, under the specific claim structure of the ’671 patent and on the record before us, we do not consider the total number of claims challenged in the two proceedings to constitute a “large number” of claims. *See* CTPG 59.

b) *Adobe Inc. v. Syncloud Technologies, LLC, IPR2020-01392, Paper 8 at 8–10 (PTAB March 11, 2021)*

In *Adobe Inc.*, the Board determined that two petitions challenging the patent at issue were reasonable given “the length of the claims, and the difference in scope of independent claims 1 and 12” (where each petition challenged one of these independent claims and associated dependent claims). *Adobe Inc. v. Syncloud Technologies, LLC, IPR2020-01392, Paper 8 at 9 (PTAB. March 11, 2021)*. The Board also found that “some of the dependent claims [were] lengthy or complex, necessitating several pages of explanation.” *Id.* at 9–10.

Adobe Inc. is distinguishable from the facts here. There, the petitioner provided an explanation for why two petitions were needed, guiding the panel. *See Adobe, Inc.*, Paper 8 at 8. Also significant is that the patent owner in *Adobe Inc.* did not request that the Board exercise discretion not to institute trial because of the multiple petitions. *Id.* at 9. Finally, we do not find, on the record before us, that the number of claims, or the length or complexity of the challenged claims of the ’671 patent warrants multiple petitions.

c) *3Shape A/S et al. v. Align Technology, Inc., IPR2020-01642, Paper 9 at 5-6 (PTAB May 10, 2021)*

In *3Shape A/S*, the Board determined that two petitions were warranted given “the number of claims, their detail and specificity, and the nature of the subject matter.” *3Shape A/S et al. v. Align Technology, Inc., IPR2020-01642, Paper 9 at 6 (PTAB May 10, 2021)*. Similar to *Adobe, Inc., 3Shape A/S* is distinguishable as the panel was guided by an explanation from the petitioner and, significantly, the patent owner did not respond to the petitioner’s contentions justifying multiple petitions. *Id.* at 5–6. Also, the panel found that the detail and specificity of the challenged claims weighed in favor of allowing two petitions. We do not find that the claims in the present case are so detailed or specific as to warrant multiple petitions.

d) *Flex Logix Technologies, Inc. v. Venkat Konda, IPR2020-00261, Paper 22 at 22–24 (PTAB Aug. 3, 2020)*

In *Flex Logix*, the Board allowed a petitioner to file three petitions, two based on one priority date of the challenged patent and one based on another priority date. *See Flex Logix Technologies, Inc. v. Venkat Konda, IPR2020-00261, Paper 22 at 23 (PTAB Aug. 3, 2020)*. With respect to the two petitions based on the same priority date, the panel found that “the length of the claims in the [challenged] patent, the complexity of the subject matter of the claims, and their relative detail persuad[ed the panel] that [p]etitioner’s filing of multiple petitions challenging the [patent at issue] [did] not weigh in favor of exercising discretion to deny institution in this proceeding.” *Id.* at 24. Again, as with the other cases we have discussed here, the Board’s findings, and ultimate determination, was guided by the petitioner, who filed a paper ranking the petitions, and explaining the reason for multiple petitions. *See id.* at 23.

Flex Logic is distinguishable from the present proceeding, because, in addition to not having the benefit of an explanation from Petitioner, we do not find that the length or complexity of the claims warrant multiple petitions.

e) *Square, Inc. v. 4361423 Canada Inc., IPR2019-01653, Paper 9 at 48-51 (PTAB. May 12, 2020)*

Finally, in *Square, Inc.*, the Board determined that the circumstances in that proceeding warranted two petitions to challenge the same patent. *Square, Inc. v. 4361423 Canada Inc., IPR2019-01653, Paper 9 at 50–51 (PTAB. May 12, 2020)*. The panel found that the petitioner needed to challenge all 42 claims of the challenged patent, given that the patent owner had not identified the specific asserted claims in the parallel district court litigation. *Id.* The panel also found that the two petitions asserted unique prior art combinations. *Id.* at 51.

Square, Inc. is distinguishable from the present proceeding, as, in addition to not having the benefit of an explanation from Petitioner, we do not find that the number of claims warrants multiple petitions in the present proceeding. Also, the two petitions here do not have different grounds of unpatentability. Indeed, for the most part, the grounds of the present Petition challenge the same technical subject matter in the same way using the same prior art as the challenges in the PGR2021-00091 petition.

3. *Conclusion*

For all of the reasons discussed above, we determine that the specific circumstances of the PGR2021-00091 and PGR2021-00092 proceedings do not support Petitioner challenging the '671 patent with two petitions.

III. CONCLUSION

After considering the evidence and arguments presently before us, we exercise our discretion to deny the Petition.

IV. ORDER

In consideration of the foregoing, it is:

ORDERED that, pursuant to 35 U.S.C. § 324(d), the Petition is *denied*.

PGR2021-00092
Patent 10,855,671 B2

FOR PETITIONER:

Thomas N. Millikan
Babak Tehranchi
Kyle R. Canavera
PERKINS COIE LLP
millikan-ptab@perkinscoie.com
tehranchi-ptab@perkinscoie.com
canavera-ptab@perkinscoie.com

FOR PATENT OWNER:

Ben J. Yorks
Babak Redjaian
IRELL & MANELLA LLP
byorks@irell.com
bredjaian@irell.com