

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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AKAMAI TECHNOLOGIES, INC.,  
Petitioner

v.

EQUIL IP HOLDINGS LLC,  
Patent Owner

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Case IPR2023-00330  
U.S. Patent No. 8,495,242

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**PATENT OWNER PRELIMINARY RESPONSE  
UNDER 37 C.F.R. § 42.107(a)**

***Mail Stop "PATENT BOARD"***  
Patent Trial and Appeal Board  
U.S. Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

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**PATENT OWNER'S EXHIBIT LIST**

<b>Exhibit No.</b>	<b>Description</b>
2001	Declaration of Dr. Mark T. Jones in Support of Patent Owner's Preliminary Response
2002	Curriculum Vitae of Dr. Mark T. Jones
2003	Petition Under 37 C.F.R. § 1.324(a) to Correct Inventorship in a Patent
2004	<i>Intentionally Left Blank</i>
2005	U.S. Patent No. 8,656,046 to Barger et al.
2006	U.S. Patent No. 6,964,009 to Samaniego et al.
2007	WO 98/43177 (International Publication of PCT/US98/05304) to Tso et al.
2008	Redline comparison of specifications of PCT/US98/05304 (Tso PCT) and U.S. Patent No. 6,421,733 (Tso)
2009	U.S. Patent No. 5,902,846 to Feret et al.
2010	First Amended Complaint for Patent Infringement, 22-677-RGA, <i>Equil IP Holdings LLC v. Akamai Technologies, Inc.</i>
2011	U.S. Patent No. 6,483,851 to Neogi

## I. INTRODUCTION

The Board should deny institution of *inter partes* review of claim 9 of U.S. Patent No. 8,495,242 (“the ’242 patent”) because (1) Petitioner’s primary reference in three of the four asserted grounds is not prior art and (2) combined discretionary considerations under Sections 314(a) and 325(d) strongly favor denying institution. Instituting review when three of Petitioner’s four asserted grounds are facially deficient is a waste of the Board’s and the parties’ resources.

Petitioner’s primary reference in three of its four grounds, Samaniego, is not prior art. Samaniego is the pre-issuance publication of an earlier application in the ’242 patent’s priority chain. Petitioner’s argument that the ’242 patent is not entitled to the earlier priority date is premised on a lack of overlapping inventors. Patent Owner, however, has petitioned for correction of inventorship of the priority application, which eliminates Petitioner’s argument. Further, Patent Owner demonstrates herein that the requirements of 35 U.S.C. § 120, including that the priority applications provide the required § 112 support for the claim, are met.

Under Section 314(a), the Board should apply its informative *Chevron/Deeper* decisions and deny institution because three of Petitioner’s four grounds are facially deficient, and Board precedent disfavors instituting review when the majority of the challenges fail to satisfy the threshold for institution. Section 325(d) and the precedential *Advanced Bionics* decision compound the case

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