IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

AKAMAI TECHNOLOGIES, INC.,
Petitioner

v.

EQUIL IP HOLDINGS LLC,
Patent Owner

Case IPR2023-00332
U.S. Patent No. 9,158,745

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

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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

Exhibit No.	Description
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	U.S. Patent No. 8,381,110 to Barger et al.
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, *Equil IP Holdings LLC v. Akamai Technologies, Inc.*
2011	U.S. Patent No. 6,483,851 to Neogi

I. INTRODUCTION

The Board should deny institution of *inter partes* review of claims 1-7 of U.S. Patent No. 9,158,745 ("the '745 patent") because (1) Petitioner's primary reference in four of the six 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 four of Petitioner's six asserted grounds are facially deficient is a waste of the Board's and the parties' resources.

Petitioner's primary reference in four of its six grounds, Samaniego, is not prior art. Samaniego is the pre-issuance publication of an earlier application in the '745 patent's priority chain. Petitioner's argument that the '745 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 claims, are met.

Under Section 314(a), the Board should apply its informative *Chevron/Deeper* decisions and deny institution because four of Petitioner's six 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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