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'S SUR-REPLY TO PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

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PATENT OWNER'S UPDATED 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
2012	Decision Granting Petition to Correct Inventorship Under § 1.324 for U.S. Patent No. 6,964,009
2013	Decision on Certificate of Correction for U.S. Patent No. 6,964,009

Petitioner's arguments in its Reply ignore the plain language of 35 U.S.C. § 256 and Board precedent regarding § 325(d). The Board should deny institution.

I. THE INVENTORSHIP CORRECTION CONFIRMS SAMANIEGO IS NOT PRIOR ART.

Patent Owner filed a petition under 37 C.F.R. § 1.324(a) and 35 U.S.C. § 256 to correct inventorship of the '009 patent. POPR, 11-13. The Office granted this petition, EX2012, and approved the request to issue a Certificate of Correction ("COC"), which was forwarded to the Certificate of Corrections Branch, EX2013. Samaniego, thus, is not prior art to the challenged claims. POPR, 9-20.

A. The effect of correction under § 256 is not limited to the patent being corrected.

Petitioner is incorrect that § 256(b) "limits its effects to only inventorship errors in the patent being corrected." Reply, 1. The statutory language highlighted by Petitioner does not include any limit on the effect of correction under § 256(a). *See id.*, 2 (quoting § 256(b), with emphasis on "the patent *in which such error occurred*"). Rather, § 256(b) provides that an inventorship error "shall not invalidate" that patent if the error can be corrected, even in the ongoing case. 35 U.S.C. § 256(b).[1] Section 256(a) more broadly allows for correction of named

[1] Petitioner's arguments directed to § 256(b) being a "savings provision" are inapposite. Reply, 2. Petitioner's argument implies that the application of § 256(b) to avoid invalidity under § 102(f) limits correction under § 256(a) to only such

inventors: "Whenever through error a person is named in an issued patent as the inventor, or through error an inventor is not named in an issued patent, the Director may … issue a certificate correcting such error." Nothing in the statute indicates that the effect of such corrections are limited solely to the patent being corrected.

B. Correction of inventorship under § 256 has retroactive effect.

Petitioner argues, incorrectly, that the correction of inventorship cannot have retroactive effect. Reply, 2-3. Petitioner quotes language from §§ 254-255, arguing that COCs only have a prospective effect on "the trial of actions for causes thereafter arising." Reply, 2-3 (quoting §§ 254-255). But Petitioner ignores that the *relevant statute*—§ 256, the statute under which Patent Owner requested a COC—does not include this language. Statutory interpretation "begins with the 'language of the statute.'" *Hughes Aircraft Co. v. Jacobson*, 525 U.S. 432, 438 (1999). Petitioner cannot read a requirement into § 256 that is not there. This is particularly true where the requirement Petitioner attempts to include is expressly recited in a related section of the statute, yet *not* in the relevant statute. *Res-Care, Inc. v. United States*, 735 F.3d 1384, 1389 (Fed. Cir. 2013) ("A cardinal doctrine of statutory interpretation is the presumption that Congress's use of different terms within related statutes generally implies that different meanings were intended.").

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effect. *Id.* But the statute simply does not contain such limiting language. Nor does *Pannu v. Iolab Corp.*, 155 F.3d 1344 (Fed. Cir. 1998), support this position.

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