

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

SECURITYPROFILING, LLC,
Patent Owner.

IPR2021-01428
Patent 10,609,063

Before DEBRA K. STEPHENS, TREVOR M. JEFFERSON, and SHARON FENICK, *Administrative Patent Judges*.

STEPHENS, *Administrative Patent Judge*.

DECISION

Denying Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

I. INTRODUCTION

A. *Background and Summary*

Cisco Systems Inc. (“Petitioner”) filed a petition for *inter partes* review (Paper 2 (“Pet.” or “Petition”)) challenging claims 1 and 5 of U.S. Patent 10,609,063 B1 (Ex. 1001 (“’063 Patent”)). SecurityProfiling, LLC (“Patent Owner”) timely filed a Preliminary Response (Paper 7 (“Prelim.

Resp.”)) and a statutory disclaimer. Pursuant to our prior authorization, Petitioner filed a Petitioner’s Reply to Patent Owner’s Preliminary Response (Paper 9 (“Pet. Reply” or “Reply”)). Patent Owner filed a Patent Owner’s Sur-reply to Petitioner’s Reply (Paper 11 (“PO Sur-reply” or “Sur-reply”)).

Petitioner challenges claims 1 and 5 as unpatentable under 35 U.S.C. § 103 (Pet. 11). In light of Patent Owner’s statutory disclaimer, we decline to institute an *inter partes* review.

B. Real Parties in Interest

Petitioner represents that Cisco Systems, Inc. is the real party-in-interest (Pet. 70).

Patent Owner represents that SecurityProfiling, LLC is the real party-in-interest (Paper 5, 1).

C. Related Matters

The ’063 has also been challenged in *inter partes* review IPR2022-00259 (Paper 10, 2).

The ’063 Patent is presently involved in the following litigations:

SecurityProfiling, LLC v. Cisco Systems, Inc., 6-21-cv-01106, W.D.

Tex., Oct. 25, 2021; and

SecurityProfiling, LLC v. Trend Micro Incorporated, 6-21-cv-01105,

W.D. Tex. Oct. 25, 2021

(Paper 6, 2).

The ’063 Patent has been involved in the following litigations, none of which remain pending:

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SecurityProfiling, LLC v. Cisco Systems, Inc., 6-21-cv-00337, W.D.
Tex., April 7, 2021; and

SecurityProfiling, LLC v. Trend Micro Incorporated, 6-21-cv-00330,
W.D. Tex. April 6, 2021

(Paper 5, 2; Pet. 70).

Patent Owner also indicates, “[t]he following matters would affect, or
be affected by, a decision in the present proceeding based on the” ’063
Patent:

U.S. Patent No. 9,100,431, challenged in *inter partes* review
IPR2021-01242;

U.S. Patent No. 8,266,899 challenged in *inter partes* review IPR2017-
02191;

U.S. Patent No. 8,984,644 challenged in *inter partes* review IPR2017-
02192; and

U.S. Patent No. 10,893,066 challenged in *inter partes* review
IPR2022-00035

(Paper 5, 2; Paper 10, 2).

D. The ’063 Patent

The ’063 Patent is directed to a “computer program product and
apparatus for multi-path remediation.” (Ex. 1001, (54)). The ’063 Patent has
70 claims, four of which are independent (*id.* at 28:20–53:8).

E. Evidence

Reference	Exhibit
Willebeek-LeMair, et al., US 7,359,962 B2 (“W-L”)	1005
Gupta, et al., US 2003/0004689 A1, published January 2, 2003 (“Gupta”)	1006
Graham, et al., US 7,237,264 B1 (“Graham”)	1007

(Pet. 11).

F. Prior Art and Asserted Grounds

Petitioner asserts that claims 1 and 5 are unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1, 5	103	W–L
1, 5	103	Gupta, Graham

(*id.*).

II. ANALYSIS

Patent Owner asserts it strongly disagrees with Petitioner’s contentions; however, Patent Owner “statutorily disclaimed claims 1 and 5 pursuant to 35 U.S.C. § 253(a) to conserve its resources as well of those of the Board” (Prelim. Resp. 1). Patent Owner additionally asserts this would “allow more efficient resolution of the parties’ disputes regarding infringement and validity of the asserted claims of the ’063 patent, which do not include claims 1 or 5” (*id.*). Patent Owner asserts “[b]inding precedent precludes institution of a review proceeding where all challenged claims are disclaimed pre-institution” (Prelim. Resp. 4–5 (citing *Gen. Elec. Co. v. United Techs. Corp.*, IPR2017-00491, Paper 9 at 2–3 (PTAB July 6, 2017))

(precedential); 37 C.F.R. § 42.107(e); 37 C.F.R. § 42.207(e) (“No post-grant review will be instituted based on disclaimed claims.”); 37 C.F.R. § 42.72; *Am. Honda Motor Co., Inc. v. Intellectual Ventures II LLC*, IPR2018-00350, Paper 12 at 4–5 (PTAB June 21, 2018); Consolidated Trial Practice Guide, November 2019 (“Practice Guide”) at 52)). Patent Owner further asserts “[t]he Board is not required to interpret pre-institution disclaimer of all challenged claims as a request for adverse judgment (*id.* at 5 (citing *Gen. Elec. Co.*, IPR2017-00491, Paper 9 at 2–3 (precedential); *Rekor Systems Inc. v. Vigilant Solutions, LLC*, IPR2020-01584, Paper 9 at 5–6 (PTAB Dec. 23, 2020); *Am. Honda Motor Co., Inc.*, IPR2018-00350, Paper 12 at 4–5)).

In light of this, Patent Owner asserts Petitioner’s “Petition should be denied as no challenged claim remains” and “denial rather than adverse judgment is warranted” (Prelim. Resp. 6–7 (citing *Gen. Elec. Co.*, IPR2017-00491, Paper 9 at 2–3)). According to Patent Owner, “given the substantially similar issues and facts” to those in *General Electric*, the Board should deny Petitioner’s Petition (*id.* at 7). Additionally, Patent Owner asserts, Petitioner appears to be “gam[ing] the system and harass[ing]” Patent Owner (*id.*). In particular, Patent Owner notes Petitioner is challenging claims not asserted in the District Court Litigation (*id.* (citing Ex. 2001)). Moreover, Patent Owner contends, its “disclaimer was . . . to allow for more efficient resolution of issues pertaining to infringement and validity of the disputed claims of the ’063 patent and to conserve resources” (*id.* at 8).

Petitioner, citing 37 C.F.R. § 42.73(b)(3), argues because “the disclaimer occurred ‘during a proceeding,’ it must—by rule—be ‘construed to be a request for adverse judgment’” (Pet. Reply 2). Petitioner further

contends, “[t]he Federal Circuit has affirmed the Board’s authority to enter adverse judgment when (as here) ‘a patent owner cancels all claims at issue after an IPR petition has been filed, but before an institution decision’” (*id.* (citing *Arthrex, Inc. v. Smith & Nephew, Inc.*, 880 F.3d 1345, 1350 (Fed. Cir. 2018))). According to Petitioner, Patent Owner “cannot avoid entry of adverse judgment by simply requesting the Board not to do so” (*id.*). Petitioner also asserts Patent Owner’s accusation of Petitioner “engaging in ‘vexatious behavior’ is unavailing and misdirected” (*id.* at 3 (citing Prelim. Resp. 8)).

As set forth in the Board’s precedential *General Electric* decision, “[u]nder 37 C.F.R. § 42.107(e), ‘patent owner may file a statutory disclaimer under 35 U.S.C. 253(a) in compliance with § 1.321(a) of this chapter, disclaiming one or more claims in the patent’ and ‘[n]o *inter partes* review will be instituted based on disclaimed claims’” (*Gen. Elec. Co.*, IPR2017-00491, Paper 9 at 2). “A disclaimer under 35 U.S.C. § 253(a) is ‘considered as part of the original patent’ as of the date on which it is ‘recorded’ in the Office” (*id.* at 2–3 (citing (35 U.S.C. § 253(a))).

Patent Owner filed a statutory disclaimer, disclaiming claims 1 and 5, the two claims challenged in this proceeding (Ex. 2003). Based on our review of Exhibit 2003 and Office public records, we conclude a disclaimer of claims 1 and 5 of the ’063 Patent, under 35 U.S.C. § 253(a) has been recorded in the Office as of December 16, 2021 (Ex. 2003). *Vectra Fitness, Inc. v. TNWK Corp.*, 162 F.3d 1379, 1382 (Fed. Cir. 1998) holds that a disclaimer filed under 35 U.S.C. § 253 and meeting the requirements of 37 C.F.R. § 1.321(a), is immediately “recorded” on the date the Office receives the disclaimer without any requirements of further action.

With respect to Petitioner’s contention that the disclaimer “must—by rule—be ‘construed to be a request for adverse judgment,’” we are not persuaded (*see* Pet. Reply 2). Rather, the rule states “[a] party *may* request judgment against itself” (37 C.F.R. § 42.73(b) (emphasis added)). Thus, the rule does not require adverse judgment. Additionally, we do not read *Arthrex* as requiring adverse judgment be entered (*see Arthrex, Inc.*, 880 F.3d 1345). Rather, we read *Arthrex* as permitting, but not requiring, adverse judgment when a patent owner cancels all claims at issue prior to institution (*id.* at 1350).

The statutory disclaimer was filed before institution. In view of this disclaimer, consistent with 37 C.F.R. § 42.107(e) and the Board’s precedential *General Electric* decision, we determine a denial of institution is sufficient to dispose of this case (*see Gen. Elec. Co.*, IPR2017-00491, Paper 9). Thus, we decline to institute an *inter partes* review.

III. CONCLUSION

Based on the review of Exhibit 2003 and Office public records, we conclude that a disclaimer of claims 1 and 5 of the ’063 Patent under 35 U.S.C. § 253(a) has been recorded in the Office as of December 16, 2021 (Ex. 2003). Because all the claims challenged by Petitioner have been disclaimed under 35 U.S.C. § 253(a), no *inter partes* review is instituted in this proceeding (37 C.F.R. § 42.107(e)).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, no *inter parties* review is instituted on claims 1 and
5.

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