

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KEYSIGHT TECHNOLOGIES, INC.
Petitioner,

v.

CENTRIPETAL NETWORKS, LLC,
Patent Owner.

Case IPR2023-00445
Patent No. 10,785,266

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

I. THE *GENERAL PLASTIC* FACTORS WEIGH IN FAVOR OF DISCRETIONARY DENIAL

Keysight's contention that the other *General Plastic* factors need not be considered "[g]iven the absence of any relationship" fails. Paper 8 ("Reply") at 4-5. Keysight created a relationship with prior petitioner PAN sufficient to weigh in favor of discretionary denial, as established below, but the lack of a significant relationship does not end the *General Plastic* inquiry.

Even when no relationship exists between petitioners, *General Plastic* Factor 3 restricts follow-on petitions that use earlier proceedings as a roadmap. *United Fire Protection Corp., v. Engineered Corrosion Sols., LLC*, No. IPR2018-00991, Paper 18 at 10-11 (P.T.A.B. Oct. 10, 2019) (exercising discretion to deny institution of a second petition that used an earlier IPR "'as a roadmap' in an effort to find a successful challenge"); see also *Samsung Elecs. Co. v. Elm 3Ds Innovations, LLC*, No. IPR2017-01305, Paper 11 at 17-19, 20-21 (P.T.A.B. Oct. 17, 2017) (denying institution where petitioner used information from prior petitions to its benefit).

Keysight's identification of the Board's institution decision in IPR2021-01154 ("the '1154 decision") and its attempts to fill in the gaps in the prior petitioner's case constitutes improper roadmapping under *General Plastic*. Paper 2 ("Pet.") at 8 (identifying the deficiencies noted in the '1154 decision); *Am. Well Corp. v. Teladoc Health, Inc.*, No. IPR2022-00038, Paper 10 at 19 (P.T.A.B. Apr.

19, 2022) (denying institution where petitioner used the institution decision to correct “unintentional” errors because it “raises the roadmapping concerns, i.e., fairness and inefficiencies, that *General Plastic* counsels against”); *Google LLC v. Uniloc Luxembourg S.A.*, No. IPR2017-01665, Paper 10 at 22 (P.T.A.B. Jan. 11, 2018) (denying institution where “[p]etitioner [Google] took the opportunity to attempt to correct deficiencies alleged by Patent Owner in Amazon’s petition.”).

In addition to the fairness and efficiency concerns discussed in *General Plastic*, roadmapping of this kind results in impermissible hindsight where petitioners use the institution decision to find specific features in the art and develop a *post hoc* rationale for why it would have been obvious to modify the already considered art to incorporate that feature. *Cf. Ruiz v. A.B. Chance Co.*, 357 F.3d 1270, 1275 (Fed. Cir. 2004) (“This form of hindsight reasoning, using the invention as a roadmap to find its prior art components . . .”). Keysight’s substitution of Law for Jungck along with addressing Law’s bypass embodiment supports a conclusion that Keysight employed the ’1154 decision as a form of hindsight to correct the faults of the prior petition, which raises the fairness concerns *General Plastic* counsels against. *See* Paper 7 (“POPR”) at 9-10 (identifying Keysight’s attempt at substituting Law for Jungck to overcome the bypass embodiment deficiencies in Jungck); *see also* Reply at 4-5 (acknowledging that it had the “*benefit*” of using the prior IPR information) (emphasis added).

Keysight's allegation that any "benefit" came from Centripetal's timing in filing suit (*see* Reply at 5) ignores that its delay allowed it to study Centripetal's arguments regarding Law in a related European proceeding and strategically wait for the European opposition panel's preliminary opinion ("EP opinion"). *See* POPR at 7-8, 15-19. In its reply, Keysight does not deny that the related patent in the European proceeding has many of the same claim limitations, such as "malicious host tracker service, nor that it tailored its arguments here to address the deficiencies noted by Centripetal in the European proceeding. *See* Reply at 5; POPR at 15 (adding here the additional ground of Law and Wood to address the claimed "malicious host tracker service"). Thus, giving the outward appearance of filing the instant Petition at a certain time in order to have strongest post-hoc rationale for why Law allegedly meets the claimed parameters of the '266 Patent. The circumstances here are similar to those in *United Fire* where the instant petitioner had close to two years to study IPR information and used it "as a roadmap" to substitute the deficient references with new references. *United Fire*, No. IPR2018-00991, Paper 10 at 13-16 (P.T.A.B. Nov. 15, 2018). The *United Fire* decision concluded that these circumstances provided a "substantial potential benefit" to the petitioner, weighing in favor of discretionary denial. *Id.* at 15-16. That same conclusion applies here.

Keysight's cited cases are inapposite. *See* Reply at 4-5. For instance, Petitioner cites *Western Digital* to argue that factors 2-5 bear little relevance because

of different petitioners. *Id.* (citing *W. Digital Corp. v. SPEX Techs., Inc.*, No. IPR2018-00084, Paper 14 at 17 (P.T.A.B. Apr. 25, 2018)). However, this decision was before the precedential *Valve Corp.* decision holding that the application of the *General Plastic* factors is not limited to “instances when multiple petitions are filed by the same petitioner” as the Board considers “any relationship between [] petitioners” who challenge the same patent and the potential benefits. *Valve Corp. v. Elec. Scripting Prods., Inc.*, Paper 11 at 2 (P.T.A.B. Apr. 2, 2019). And besides being nonprecedential, the *Volkswagen* and *Sony* decisions did not involve strategic filing delays. *See Volkswagen Grp. Of America, Inc. v. Neo Wireless LLC*, IPR2022-01537, Paper 8 at 10-11 (P.T.A.B. May 5, 2023); *Sony Mobile Commc'ns AB v. Ancora Techs., Inc.*, IPR2021-00663, Paper 17 at 13 (P.T.A.B. Jun. 10, 2021).

II. KEYSIGHT CREATED AN IMPLICIT RELATIONSHIP WITH THE PRIOR PETITIONER

In choosing to use the prior IPR information to its benefit, Keysight created an implicit relationship with prior petitioner PAN, weighing in favor of discretionary denial. In reply, Keysight alleges that it was an “unremarkable fact that Keysight explained in detail” the “entire boundary” and “all network traffic” limitations. Reply at 2-3. To the contrary, this fact is quite remarkable as Keysight spends nearly 20 pages addressing the deficiencies of the '1154 petition. *See* Pet. at 8, 14-32.

Addressing the deficiencies of the prior petition with substitute art is no different from using the same art, as each uses the prior petition as a roadmap to

modify the deficiencies. Reply at 3. Keysight admits as much. *Id.* (acknowledging that roadmapping involves “a later petitioner incorporating content from the prior IPRs, *modified to address deficiencies.*”) (emphasis added). In fact, the Board has found such substitution of references indicative of roadmapping. *See United Fire*, Paper 10 at 13-15 (finding roadmapping where instant petitioner “substitut[ed] new references to create new combinations and attempt[ed] to make up for the deficiencies in the earlier petition.”); *see also Unified Patents Inc. v. Finjan, Inc.*, No. IPR2019-01611, Paper 18 at 13-16 (P.T.A.B. Apr. 13, 2020); *Samsung Elecs. Co.*, Paper 11 at 17-19, 20-21.

The Board should, therefore, follow the *Ericsson* decision, which found that similar roadmapping created a significant relationship with the prior petitioner. *See Ericsson Inc. v. Uniloc 2017, LLC*, No. IPR2019-01550, Paper 8 at 12 (P.T.A.B. Mar. 17, 2020). Where a Petitioner uses the prior petitioner’s work as a roadmap to modify its petition, either with alternative art or recrafted arguments, the petitioner “ties the interests of all of the petitioners together.” *See id.* By using the work of prior petitioner PAN as a starting point to identify the deficiencies of Jungck and replace with Law, Keysight created a relationship with prior petitioner PAN similar to the one in *Valve Corp. Id.* Accordingly, Factor 1 weighs in favor of discretionary denial.

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies, in accordance with 37 C.F.R. § 42.6(e), and pursuant to agreement by the parties that filing with the Board through the Patent Trial and Appeal Case Tracking System (P-TACTS) constitutes electronic service, that service was made on Petitioner as detailed below.

<i>Date of service</i>	June 16, 2023
<i>Manner of service</i>	Electronic Filing with the Board
<i>Documents served</i>	PATENT OWNER'S PRELIMINARY SUR- REPLY TO PETITIONER'S PRELIMINARY REPLY
<i>Persons served</i>	Gerard M. Donovan Peter J. Chassman Jonathan I. Detrixhe Sidharth Kapoor REED SMITH LLP gdonovan@reedsmith.com pchassman@reedsmith.com jdetrixhe@reedsmith.com skapoor@reedsmith.com

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