

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

KEYSIGHT TECHNOLOGIES, INC.,
Petitioner,

v.

CENTRIPETAL NETWORKS, LLC,
Patent Owner.

Case IPR2023-00446
U.S. Patent No. 10,567,343

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

**I. PETITIONER'S ROAD-MAPPING FROM PRIOR PROCEEDINGS
WARRANTS DISCRETIONARY DENIAL**

Petitioner denies using the prior proceeding IPR2021-01155 (“the ’1155 IPR”) as a road map for its petition but fails to address the substantive evidence laid before it. See Paper 7 (“Reply”) at 2-3; Patent Owner’s Preliminary Response (“POPR”) at 12-13, 15-17. The Petition asserts the same reference (Ex. 1004, “Sourcefire”) and the same unpatentability theory from the ’1155 IPR—that it would have been obvious to use the Sourcefire product to run rules to prevent exfiltration—but refines its theory based on lessons learned from the Board’s institution decision in the ’1155 IPR. *Id.* Petitioner appears to have specifically sought an additional reference (Ex. 1020, “the Emerging Threats reference”) after studying the Board’s reasons for denial in the ’1155 IPR and after understanding how Patent Owner had previously argued how the ’343 Patent was distinguishable over Sourcefire. Ex. 1084 at 40-47 (Patent Owner’s ’1155 IPR preliminary response arguing that *Sourcefire* does not disclose rules for preventing an exfiltration operation).

Petitioner does not dispute that it was aware of the prior IPR proceeding and that it had possession of the prior petition, Patent Owner’s preliminary response, a preliminary reply, a preliminary sur-reply, and the Board’s institution decision when preparing its own Petition. What’s more, Petitioner’s expert acknowledges that he studied these filings and even tries to rebut arguments from the prior proceeding’s Patent Owner’s preliminary response. Ex. 1003 at ¶¶ 77-81 (citing Ex. 1084 at 40-

49), 145-150, 199, 209, 232-233 (citing Ex. 1084 at 19, 31, 40-43, 47-49, 58). Petitioner's expert also admits to studying the prior petitioner's declaration for its weaknesses. Ex. 1003 at ¶ 73 (citing Ex. 1076 at 89) (noting the Akl declaration "did not identify an explicit teaching in Sourcefire of an exfiltration method"); *id.* at ¶ 72 (noting that the expert "Akl did not . . . note the Examiner's consideration of the exfiltration term in the independent claims"); *id.* at ¶ 75 (citing Ex. 1076 at 15-18) (finding it "noteworthy that the Akl declaration didn't discuss or cite to any discussion of the '193 IPR 2018-01559" and criticizing the expert for "a lack of understanding or discussion of factors the Board and the Patent Office had found relevant in deciding to uphold the '193 patent during various prior proceedings").

Petitioner's Preliminary Reply does little to assuage the road-mapping concerns present in this case. Petitioner argues that it could not have "strategically staged" its arguments because of the timing between the prior institution decision in the '1155 IPR and the patent lawsuit with Patent Owner. Reply at 2. But, Petitioner fails to address its own conduct since the '343 Patent was asserted against it. Petitioner fails to explain why it waited nearly an entire year to file the instant Petition. POPR at 17-21. There seems little doubt that Petitioner strategically filed its Petition, so as to take full benefit from studying the papers from the '1155 IPR and to monitor for any further developments in Patent Owner's pending litigation with PAN, which also involves the '343 Patent.

As explained in the POPR, Petitioner created an implicit relationship with PAN when it used the '1155 IPR filings as a roadmap. POPR at 12-13. Petitioner argues for the absence of a significant relationship with the prior petitioner, PAN (Reply at 1-2). But even if true, it would not end the *General Plastic* inquiry because “the remaining factors take into account the knowledge of the second petitioner irrespective of a specific relationship.” *Google LLC, v. Uniloc 2017, LLC*, No. IPR2019-01584, Paper 9 at 5 (P.T.A.B. Oct. 16, 2020) (“As such, the relationship between the different petitioners certainly has some bearing on what the second petitioner knew, when they knew it, and when they acted upon it, but the consideration of the second through seventh factors does not require a showing of a specific relationship between the petitioners to consider those factors.”).

Petitioner also argues that the '1155 IPR institution decision “could not[] provide any ‘roadmap’” because the Board denied that IPR under 35 U.S.C. § 325(d). Reply at 3. This is contrary to the Director’s precedential review in *Code200, UAB v. Bright Data Ltd.*, No. IPR2022-00861, Paper 18 (P.T.A.B. Aug. 23, 2022) (precedential), which Petitioner itself cites in its Reply. Reply at 3. The Director’s guidance expressly contemplates the possibility of road-mapping “[w]here the first-filed petition under factor 1 was discretionarily denied or otherwise was not evaluated on the merits.” *Code200*, Paper 18 at 5.

Petitioner's assertion that the *General Plastic* factors tilt away from denial when the prior proceeding "was not evaluated on the merits" is misplaced. Reply at 3 (citing *Code200*, Paper 18 at 4-5). The outcome in *Code200* is distinguishable from the instant case for two reasons. First, the prior proceedings at issue in *Code200* were denied institution under 35 U.S.C. § 314(a) based on *Fintiv* and the parallel proceedings in district court. *Code200*, Paper 18 at 2 n.3. In contrast, the Board denied in the '1155 IPR because the Patent Office had already considered the substance of the prior petitioner's challenge during prosecution of the '343 Patent, and also "extensively" considered the merits of similar arguments during the re-examination of a related '193 Patent. Ex. 1077 at 18. That is, the Patent Office already evaluated the substance of the prior petition on its merits.

Second, *Code200* states that "'road-mapping' concerns are minimized when, as in [that] case, a petitioner files a later petition that raises unpatentability challenges substantially overlapping with those in the previously-filed petition and ***the later petition is not refined based on lessons learned from later developments.***" *Code200*, Paper 18 at 5 (emphasis added). In contrast, Petitioner has refined its Petition "based on lessons learned from later developments," namely by adding an additional reference based on lessons learned from the Board's reasoning. *Id.*; Pet. at 2. Despite being given the opportunity to address these road-mapping concerns head-on, the Petitioner's preliminary reply is silent as to when Petitioner became

aware of the Emerging Threats reference, or the circumstances surrounding its discovery. POPR at 44.

Petitioner's Reply also repeats the assertion that the Emerging Threats reference was known to Patent Owner but not disclosed. Reply at 4 (citing Ex. 1082, "Centripetal Press Release"). Petitioner's suggestion of a lack of candor with the Office is baseless. Even though the Centripetal Press Release mentions the Emerging Threats **organization**, the document says nothing about the reference cited by Petitioner. See Ex. 1082. The Centripetal Press Release also post-dates the effective priority date of the '343 Patent and therefore does not constitute information "material to patentability" that should be disclosed to the Office. See POPR at 46-47; see also Manual of Patent Examining Procedure § 2001; 37 C.F.R. § 1.56.

As the Board has previously reasoned, "[i]f we were to institute, Patent Owner would be forced to defend its patent in an iterative fashion against challenges based on the same prior art, and newly shifted arguments as a result of the aforementioned roadmapping." *Am. Well Corp. v. Teladoc Health, Inc.*, No. IPR2022-00038, Paper 10 at 19 (P.T.A.B. Apr. 19, 2022) This use of the Board's finite resources to repeatedly consider similar invalidity theories with incremental adaptations is unfair and inefficient. *Id.* On balance, the *General Plastic* factors weigh in favor of discretionary denial under 35 U.S.C. § 314(a).

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>	REED SMITH LLP Gerard M. Donovan Peter J. Chassman Walter M. Egbert Jonathan I. Detrixhe Sidharth Kapoor gdonovan@reedsmith.com pchassman@reedsmith.com wegbert@reedsmith.com jdetrixhe@reedsmith.com skapoor@reedsmith.com

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