

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

CORRIGENT CORPORATION,
Patent Owner.

IPR2023-00447

Patent No. 9,118,602

PATENT OWNER'S PRELIMINARY RESPONSE

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Other Authorities

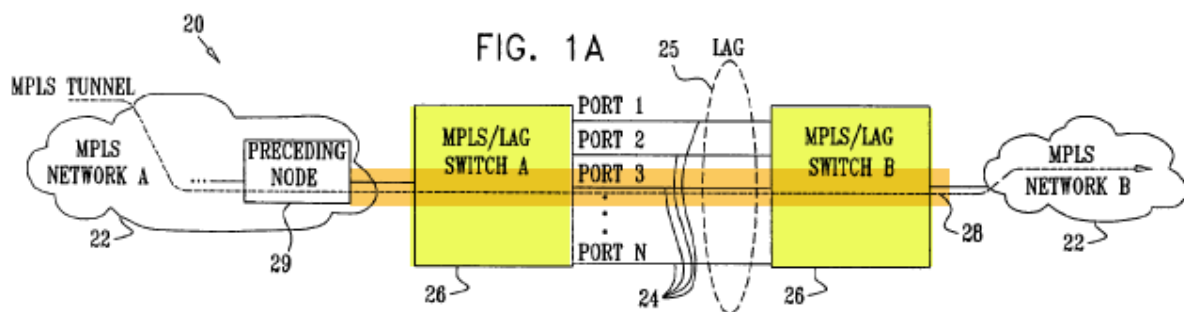
37 C.F.R. § 42.6(a)(3)	15, 16
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EXHIBIT LIST

Exhibit Number	Description
2001	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Dkt. No. 69, Claim Construction Order (W.D. Tex., Mar. 21, 2023).
2002	Time to Trial for Western District of Texas (Docket Navigator) (4/11/2023)
2003	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Dkt. No. 1, Complaint (W.D. Tex., Apr. 19, 2022).
2004	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Cisco's Preliminary Invalidity Contentions, and Exs. E-2 and E-4 thereto (W.D. Tex., Sept. 28, 2022).
2005	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Order Denying Cisco's Motion to Transfer (W.D. Tex. March 16, 2023) (ECF No. 70).
2006	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Corrigent's Preliminary Infringement Contentions (W.D. Tex., Aug. 3, 2022).

I. INTRODUCTION

The '602 Patent claims a novel and non-obvious apparatus and methods to process a data packet *between* two MPLS/LAG switches using specific and innovative tunnel provisioning techniques between those switches. Specifically, the '602 Patent employs a physical tunnel port of a link aggregation group (LAG) to ensure that data is properly and efficiently transmitted between a first and second MPLS/LAG switch using a single physical port. As the patent explains, the invention involves “receiving, by [a] first MPLS/LAG switch, a data packet including [a] data packet label at said first MPLS/LAG switch, and switching, by said first MPLS/LAG switch, said data packet to said single physical tunnel port according to said serial port number, and sending said data packet to a second MPLS/LAG switch via said single physical tunnel port.” EX1001 at 2:44-49.



In the example shown, Port 3 (highlighted in orange) is used as a tunneling port between MPLS/LAG switches A and B (highlighted in yellow).

Cisco's Petition only furnishes two grounds of unpatentability, both of which are solely based on obviousness. The Petition, therefore, concedes that none

of the references used in the Petition disclose any invention claimed in the '602 Patent because it admits that none of the references anticipate any of the claims.

Petitioner challenges all of the '602 Patent's independent claims (claims 1, 15, 26) under Ground 1 based on the Raz reference. The Raz reference, by Cisco's own admission, has nothing to do with conveying a data packet *between* first and second MPLS/LAG switches in the claimed manner, but instead is about transmitting a data packet on a particular subport *within* a router. It is directed toward a fundamentally different problem from the claimed invention, and Cisco relies solely on conclusory, hindsight-driven testimony to assert that each of the independent claims of the '602 Patent would have been obvious. *Telemac Cellular Corp. v. Topp Telecom, Inc.*, 247 F.3d 1316, 1329 (Fed. Cir. 2001) (holding that conclusory statements offered by experts are not evidence). Cisco does not explain *how* or *why* the POSA would have been motivated to modify Raz to coincidentally arrive at the claimed invention, let alone how the POSA would have had a reasonable expectation of success in doing so. This failure to meet "petitioner's 'burden to demonstrate both that a skilled artisan would have been motivated to combine the teachings of the prior art references to achieve the claimed invention, and that the skilled artisan would have had a reasonable expectation of success in doing so,'" is fatal to Cisco's obviousness arguments and Petition. *Apple Inc. v.*

Uniloc USA, Inc., 2017 WL 2304694, at *5 (P.T.A.B. May 25, 2017) (quoting *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1381 (Fed. Cir. 2016)).

Cisco attempts to cure the deficiencies of Raz alone in Ground 1 by combining it with a reference called Ferguson in Ground 2. Cisco relies on Ferguson to suggest that it would have been obvious to implement the invention of the '602 Patent for communications *between* switches. However, Ferguson was chosen based purely on hindsight and is directed not toward how a particular data packet might be transmitted, but instead toward *aggregate* data transmission and load balancing. Petitioner's analysis, as discussed below, is again conclusory. The Cisco Petition does not even perform a limitation-by-limitation analysis of the alleged Raz and Ferguson combination, explain *how* or *why* the two references would have been combined, address the fact that Ferguson is directed toward a different problem, or explain how there would have been a reasonable expectation of success to combine the two references in the unexplained manner. The cursory and conclusory nature of Cisco's second ground simply reinforces the fatal flaw of its Petition. Ultimately, because Grounds 1 and 2 of Cisco's Petition are deficient as to all of the challenged independent claims (claims 1, 15, and 26), institution should be denied on the Petition.

Separate and independent from the Petition's weakness on the merits, institution should also be denied under 35 U.S.C. § 314 based on the *Fintiv* factors.

As explained in detail below, four factors (2, 3, 5, and 6) weigh strongly in favor of discretionary denial, whereas one factor (1) is neutral and one factor (4) only marginally favors not exercising discretion to deny institution. Importantly, the district court trial between Corrigent and Cisco is currently set to occur approximately 5 months before the projected statutory deadline for a final written decision in this IPR, which weighs heavily against institution. Accordingly, *Fintiv* reinforces that the Board should exercise its discretion and deny institution.

II. THE PETITION SHOULD BE DENIED ON THE MERITS

A. GROUND 1 FAILS BECAUSE NONE OF THE CLAIMS OF THE '602 PATENT ARE OBVIOUS OVER RAZ

None of the claims of the '602 patent would have been obvious over the Raz reference. Raz (EX1006) is directed toward a “Link Multiplexing Mechanism Utilizing Path Oriented Forwarding.” It focuses on port assignment *within* a particular label switched router (or LSR). Figure 1 (which is relied on repeatedly in Cisco’s Petition) shows “an example LSR with label based subport assignment constructed in accordance with a first embodiment of [Raz’s] invention.” EX1006 at 4:8-10.

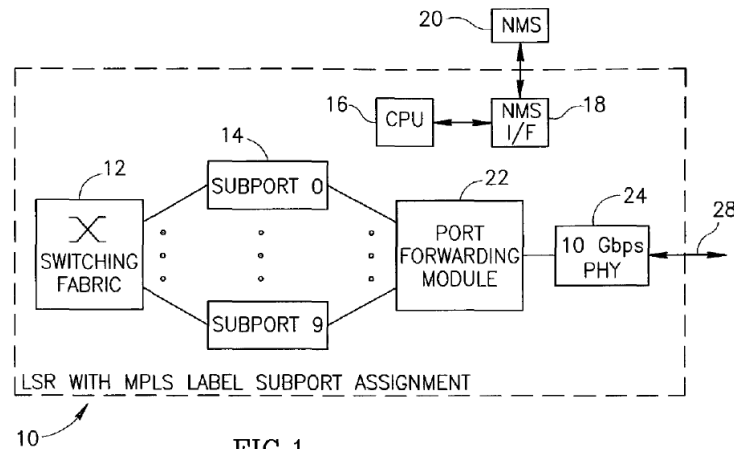


FIG.1

Figure 1 of Raz

The focus of Raz is to “provid[e] a subport forwarding and provisioning mechanism whereby a plurality of subports comprising slower speed processors are used to perform the packet processing for a higher speed packet stream.”

EX1006 at 6:24-27. Figure 1 shows that Raz focuses on the selection of subports *within* a single LSR based on a received label, and underscores that Raz does not anticipate or render obvious the claimed invention of the '602 Patent.

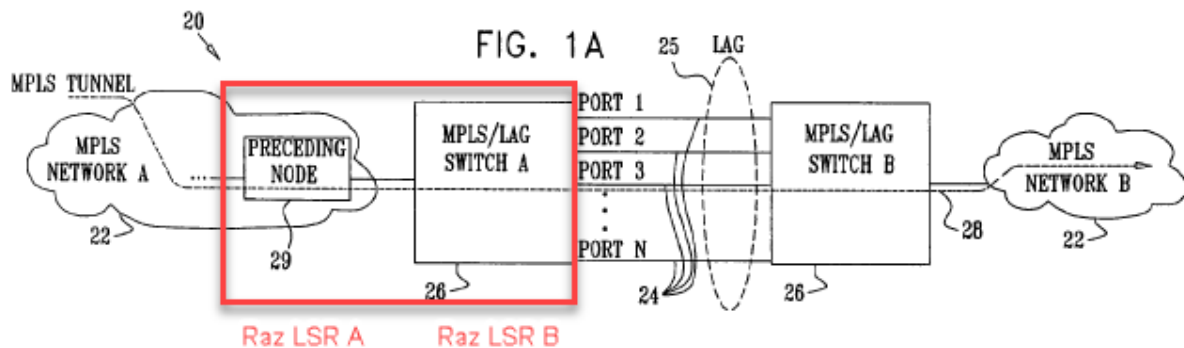
Indeed, the Petition concedes this central deficiency of Raz. It admits that “Raz discusses the utilization of subports in a LAG *within a LSR* to communicate high-speed packet streams in an MPLS network.” Petition at 15 (emphasis added). The Petition does not discuss *how* or *why* the POSA would have modified Raz so that it could be applied to communications between MPLS/LAG switches, let alone implemented in a way that implemented subport selection or tunnel provisioning as claimed. Instead, it points to a single conclusory paragraph of Dr.

Bhattacharjee’s declaration to assert generically that link aggregation might be used to “connect different routers or switches” over Ethernet. Petition at 15 (citing and quoting EX1004, ¶ 82). In that paragraph, Cisco’s expert (like Cisco itself) also concedes that “Raz discusses the utilization of subports in a LAG *within a LSR*,” and does not explain *how* or *why* Raz would have been modified, other than to assert that Ethernet was well-known and that Raz discusses high-speed data transfer. EX1004, ¶ 82 (emphasis added).

These admissions are fatal to Cisco’s Petition, as they implicate key limitations of each of independent claims 1, 15, and 26 of the ’602 Patent, particularly limitation [1.5], which requires “sending said data packet *from said first MPLS/LAG switch to a second MPLS/LAG switch via said single physical tunnel port* having the port serial number encoded in the data packet label.”

EX1001 at 9:44-46 (emphasis added, claim 1), 10:59-64 (claim 15, mapper with same requirement), 12:33-35 (claim 26 with same requirement). For this particular limitation, the Petition provides a single page of analysis that is almost entirely conclusory. *See* Petition at 25. The Petition refers to an example discussed in Raz where the LSR shown in Raz’s Figure 1 (referred to as LSR B) receives a packet label from a preceding node (LSR A) and assigns subport number 3 to the data packet *within the LSR*. Petition at 25 (citing EX1006 at 7:39-45). In other words, the example relied on by Cisco relates not to communications between a first and

second MPLS/LAG switch, as limitation [1.5] requires, but instead to earlier-recited limitations ([1.3] and [1.4]) pertaining to the interaction between a first MPLS/LAG switch and a *preceding node*, as is shown below in the annotated Figure 1 of the '602 Patent with an overlay of Raz's teaching. Consistent with the annotation, the Petition admits that what Raz calls "LSR A" is the "Preceding Node," Petition at 23, and what Raz calls "LSR B" is "the claimed first MPLS/LAG switch." Petition at 25.



Annotated Figure 1A of the '602 Patent

Ultimately, then, the Petition admits that Raz has no discussion of communication of a data packet between a first and second MPLS/LAG switch as claimed, the role that a second MPLS/LAG switch would play in the invention, or any description of how or why a modification of Raz would be made such that there is a transmission of a data *"from said first MPLS/LAG switch to a second MPLS/LAG switch via said single physical tunnel port."* The example relied on by Cisco, consistent with the admissions above, says *nothing* about how Raz (or a

modified version of Raz) would handle data packets *after* they leave the first MPLS/LAG switch, let alone *how* or *why* those packets would be handled in the claimed manner.

To the extent that the Petition provides an obviousness argument for limitation [1.5], it is entirely based on conclusory lawyer argument and testimony.

The Petition simply states, without analysis, that “[a] POSA would have understood that the data packet in LSR B could be sent to another LSR (which would correspond to the second MPLS/LAG switch) via a physical tunnel subport (subport 3) having the port serial number encoded in the data packet label.”

Petition at 25 (citing EX1006 at 7:17-29, 7:39-45, 9:29-58, 14:23-26, Figs. 3-4; EX1004, ¶ 107). But again, none of the cited passages from Raz say anything about what would happen to a data packet *after* it leaves the LSR that is the focus of Raz, let alone which port the data would travel on in a subsequent hop.

Certainly, none of the passages suggest that the packet would be sent to the “second MPLS/LAG switch” on port 3, as Cisco blindly argues. Indeed, the expert testimony that Cisco relies on (in paragraph 107) simply reinforces the teaching of Raz pertaining to the port assignment *within* an LSR after it receives a label, in reference to Raz’s Figure 1. EX1004, ¶ 107 (citing and quoting EX1006 at 7:39-45, which discusses Figure 1). To the extent that the expert addresses “a second MPLS/LAG switch” in paragraph 108, the expert simply states (again in a

conclusory fashion) that “a POSA would also have been motivated to communicate packets from a first MPLS/LAG switch to a second MPLS/LAG switch in a MPLS network.” EX1004, ¶ 108. Such conclusory testimony is “entitled to little weight” and is “particularly problematic” where it attempts to “supply a limitation missing from the prior art,” and is alone a reason to deny institution. *Xerox Corp. v. Bytemark, Inc.*, IPR2022-00624, Paper 9, 2022 WL 3648989, at *6 (P.T.A.B. Aug. 24, 2022) (designated precedential Feb. 10, 2023) (citing *KSR Intern. Co. v. Teleflex Inc.*, 550 U.S. 398, 421 (2007)); *Magnum Oil*, 829 F.3d at 1380 (Petitioner cannot satisfy burden by “employ[ing] mere conclusory statements” and “must articulate specific reasoning, based on evidence of record”)

Moreover, even if the conclusory arguments and testimony were considered, Cisco’s Petition presents no analysis of *how* or *why* Raz would be modified to transmit packets between a first and second MPLS/LAG switch in any way, let alone that uses tunnel provisioning in the claimed manner. The Petition does not use the word “modify” a single time, because it does not discuss how Raz would be modified to overcome its deficiency. Nor does the Petition discuss or mention how the POSA would have a “reasonable expectation of success” to attain any alleged modification, even if disclosed. Like the Petition, Dr. Bhattacharjee also never discusses how or why Raz would be modified, or why such modifications

would occur with a reasonable expectation of success in his declaration.¹ This reinforces that institution must be denied. *See, e.g., Avail Medsystems, Inc. v. Teladoc Health, Inc.*, IPR2022-00444, 2022 WL 2903454, at *11, *13 (P.T.A.B. July 21, 2022) (denying institution based on “conclusory statements” and noting that such statements, “even from a qualified expert, provide little, if any, evidentiary support”); *Triller, Inc. v. TikTok Pte. Ltd.*, IPR2022-00181, 2022 WL 1618056, at *11, *13 (P.T.A.B. May 16, 2022) (denying institution where “Petitioner provide[d] no evidence that an ordinary artisan would have had a reasonable expectation of success, and Petitioner’s assertions that the proposed combination would have been ‘desirable’ and ‘predictable’ are conclusory and entitled to little weight”); *Initiative for Medicines v. Gilead Pharmasset LLC*, IPR2018-00211, 2018 WL 3078715, at *6, *9 (P.T.A.B. June 20, 2018) (denying Petition where “Petitioner provides no analysis of the reasonable expectation requirement”). At most, the Petition articulates generic motivations of the POSA that are untethered from a clearly articulated modification of Raz. *See, e.g.,*

¹ Yet, Dr. Bhattacharjee’s declaration acknowledges that obviousness requires an explanation of any modifications that the POSA would have been motivated to make, along with why there would have been a reasonable expectation of success to make those modifications. EX1004, ¶ 14.

Petition at 19-20, 22.

Given the above deficiencies, the single reference Raz obviousness ground is deficient as a matter of law. The deficient analysis of limitation [1.5] for claim 1 is relied on expressly for claim element [26.6], *see* Petition at 52, and the analysis of limitation [15.8] is essentially identical and conclusory, *see* Petition at 48. At the point the Petition is deficient as to all of the independent claims, trial cannot be instituted on any challenged claim and therefore the entire Petition must be denied.

B. GROUND 2 ALSO FAILS BECAUSE THE COMBINATION OF RAZ AND FERGUSON IS DEFICIENT

Petitioner’s Ground 2 attempts to combine Raz with Ferguson to cure the deficiencies of Ground 1. Ferguson is titled “Distribution of Label Switched Packets.” The Ferguson reference is concerned with “techniques to distribute label switched packets . . . across the logically associated physical interconnects of an aggregated network link.” EX1007 at 2:44-53; *see also id.* at 6:15-31 (discussing distribution of packets “across physical interconnects 24 of aggregated link 26,” and “across aggregated link 12A”). Ferguson, in another words, is not concerned about the pathway taken by a particular “data packet” as discussed in claims 1, 15, and 26 of the ’602 patent. Rather, it is concerned about how data packets are distributed and allocated *in the aggregate*. Indeed, Dr. Bhattacharjee’s own explanation of Ferguson concedes that Ferguson is concerned with “load balancing” of packets in the aggregate. EX1004, ¶ 67-68 (citing EX1007 at 1:60-

63, 1:63-66, 2:57-60, which discuss “load balanc[ing] label switched packets of an LSP across an aggregated link” and “distribution” of traffic). To that end, Ferguson addresses the use of “ranges of MPLS labels to control the distribution of MPLS packets *across multiple physical paths*,” rather than a path pertaining to a particular data packet. EX1004, ¶ 75; EX1007 at 5:61-63 (emphasis added). Ferguson provides no meaningful guidance on how particular data packets such as those in Raz would be handled in the context of tunnel provisioning, let alone *how* or *why* Ferguson would be relevant to any modification of Raz.

Cisco’s discussion of Ferguson in Ground 2 does not cure the deficiencies of Ground 1 with respect to independent claims 1, 15, and 26. Petitioner generically asserts that “Ferguson teaches a POSA that the method of assigning a subport with appropriate bandwidth *within* the LSR that is disclosed in Raz could also be implemented *between* MPLS/LAG switches in an MPLS network.” Petition at 53 (citing EX1004, ¶ 245). However, the Petition, along with Dr. Bhattacharjee’s declaration and the cited portions of Ferguson on which he relies, simply confirm **Ferguson’s** teachings of aggregate packet distribution and load balancing.

Nowhere does the Petition explain *how* or *why* **Raz** would be modified in light of Ferguson. While the Petition asserts that “[t]he teachings of Ferguson are compatible with and readily implementable in the Raz system,” this conclusory statement is not supported by a citation and is unexplained—indeed, Petitioner

completely omits its citation. *See* Petition at 53 (simply showing the word “CITE,” without a citation, at the end of the sentence).

Ultimately, it appears that Cisco relies on Ferguson primarily for its Figures 2A-2C, which stand for the unremarkable proposition that communications can occur between routers in an aggregated interface. *See* Petition at 53-54. The sheer fact that Ferguson might illustrate, at a high-level, communication between routers in an aggregated interface (such as those shown in Figs. 2A-2C of Raz) does nothing to explain *how* or *why* **Raz** would be modified in view of Ferguson to meet the requirements of the claims (such as element [1.5]), let alone why there would be a reasonable expectation of success in doing so. In fact, across several pages of this obviousness ground, Petitioner never explains exactly what the modification of Raz would be. *See* Petition at 52-59. Nor could it, because it is impossible to reconcile Raz’s focus on transmitting particular data packets between MPLS/LAG switches with Ferguson’s focus on data transmission in the aggregate. This reinforces why Ground 2, like Ground 1, must fail.

The Petition’s section on “motivation to combine” Raz and Ferguson in Ground 2 reinforces Cisco’s problem. *See* Petition at 56-59. Cisco generically refers to the prior art’s use of “MPLS” networks and notes that the references each address certain issues pertaining to “bandwidth.” These generic motivations “bear[] no relation to any specific combination of prior art elements” described in

the petition and are insufficient as a matter of law. *ActiveVideo Networks, Inc. v. Verizon Commc'ns, Inc.*, 694 F.3d 1312, 1327-28 (Fed. Cir. 2012). Unsurprisingly, even with the alleged motivation, there still is no explanation of *how* or *why*, in view of the generic motivation, Ferguson would be modified in view of Raz. The Petition simply states in a generic fashion—consistent with the generic motivations—that the “POSA would have known that the techniques disclosed in Raz for using subports to transmit data packets within a router or switch would also have been applicable to an Ethernet physical data port in a LAG that communicates data packets between routers or switches in an MPLS network.” Petition at 59. Aside from the conclusory nature of the argument, stating that the techniques of Raz “would have been *applicable*” to some other context does not demonstrate that the POSA *would have* modified Raz in any particular way in light of Ferguson as the law requires. *Auris Health, Inc. v. Intuitie Surgical Operations, Inc.*, 32 F.4th 1154, 1158 (“The motivation-to-combine inquiry asks whether a skilled artisan ‘*not only could have made but would have been motivated to make the combinations . . . of prior art to arrive at the claimed invention.*’” (emphasis added) (quoting *Belden Inc. v. Berk-Tek LLC*, 805 F.3d 1064, 1073 (Fed. Cir. 2015))).

Ultimately, Cisco does not “explain why a person of ordinary skill in the art would have combined elements from specific references *in the way the claimed*

invention does.” ActiveVideo, 694 F.3d at 1328 (citing *KSR*, 550 U.S. at 418).

Once again, as a nonlimiting example, nothing in the Petition addresses how the combination would fulfill the requirements of limitation [1.5], *i.e.*, “sending said data packet from said first MPLS/LAG switch to a second MPLS/LAG switch via said single physical tunnel port having the port serial number encoded in the data packet label,” as claimed. EX1001 at 9:44-46 (claim 1). Indeed, consistent with its generic discussion of motivation, the Petition does not address individual claim limitations ***at all*** in Ground 2.

In fact, the only possible way that the Petition could arguably address individual claim limitations for Ground 2 would be by incorporating broad swaths of the declaration of Dr. Bhattacharjee (EX1004), which is improper. The Board should ignore those portions of his declaration pertaining to Ground 2 (whether cited or not) because considering the testimony would violate 37 C.F.R.

§ 42.6(a)(3), which prohibits incorporating by reference arguments from an expert declaration to a petition, particularly where the arguments in the petition are “skeletal.” *See, e.g., 3M Co. v. Evergreen Adhesives, Inc.*, 860 Fed. App’x 724, 728 (Fed. Cir. 2021) (affirming PTAB decision that not consider expert arguments based in the fact that any discussion of the issue in the briefing was “skeletal at best.”). Ultimately, in Ground 2 of the ***Petition***, Cisco provides only a high-level, “skeletal” discussion of the challenged claims, fails to analyze the arguments claim

limitation by claim limitation, and provides a simplistic analysis. *See, e.g.*, Petition at 52. That is the analysis to which Cisco must be held. *3M Co.*, 860 Fed. App'x at 728; 37 C.F.R. § 42.6(a)(3). Doing otherwise would permit an end-run around the word-limit requirements of a Petition.² Accordingly, the Board should ignore any discussion of Ground 2 contained in Dr. Bhattacharjee's declaration.³

The foregoing discussion reaffirms that Ground 2 is deficient and should be rejected as a matter of law.

² The Petition has 13,994 words, just 6 words short of the 14,000 requirement. Of those 13,994 words, less than 2,000 relate to Ground 2. Dr. Bhattacharjee's declaration, on the other hand, is nearly 200 pages in length and contains upwards of 40,000 words. Of these, approximately 14,000 appear in the declaration's discussion of Ground 2 alone.

³ To be clear, even if considered, there is nothing in Dr. Bhattacharjee's declaration that cures the deficiencies of Ground 2 discussed above, particularly in terms of the lack of discussion of *how* or *why* Raz and Ferguson would have been combined, the generic nature of the proffered motivations, and the lack of evidence that there would have been a reasonable expectation of success to modify Raz in the claimed manner in light of the teachings of Ferguson directed toward a different problem.

III. THE BOARD SHOULD ALSO EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER THE *FINTIV* FACTORS

Efficiency, fairness, integrity of the system, and the merits support the Board’s exercise of its discretionary denial authority under 35 U.S.C. § 314(a). Seeking to minimize duplication of work, the Board has set forth a set of non-exclusive factors for determining whether to deny a petition in view of parallel litigation (*i.e.*, the “*Fintiv* factors”). *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper No. 11 (P.T.A. B. March 20, 2020) (“*Fintiv I*”). As explained in detail below, the *Fintiv* factors weigh heavily in favor of discretionary denial in this case.

A. ***Fintiv* Factor 1: The district courts have not granted a stay**

Patent Owner agrees with Petitioner that this factor is neutral because no motion to stay has been filed, so the Board should not infer the outcome of such a motion. *Sand Revolution II LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper No. 24 at 7 (P.T.A. B. June 16, 2020) (informative).

B. ***Fintiv* Factor 2: The *Cisco* trial is expected to take place approximately 5 months before the projected statutory deadline for a final written decision**

Fintiv Factor 2 weighs heavily against institution because the *Cisco* case⁴ is set to go to trial approximately 5 months before the projected statutory deadline for

⁴ *Corrigent Corporation v. Cisco Systems, Inc.*, Case No. 6:22-cv-00396 (W.D. Tex.).

a final written decision. The projected statutory deadline for a final written decision in this IPR is August 10, 2024. 37 C.F.R. § 42.100(c). Meanwhile, the *Cisco* case is set for trial on March 18, 2024. *See* EX1011 at 4 (trial beings 52 weeks after *Markman* Hearing, and March 17, 2024 falls on a Sunday); EX2001 at 1 (*Markman* hearing held on March 17, 2023). The timeframe set by the district court is consistent with the statistical median time to trial for the Western District of Texas. *See* EX2002. Those statistics indicate that, over the past two years, despite the COVID pandemic, the median time to trial for the district was 23 months after filing. *Id.* Here, trial is also set approximately 23 months after the case was filed. *See* EX1011 at 4; EX2001 at 1; EX2003 (case filed April 19, 2022). Thus, the district court trial is set to occur approximately 5 months before the projected statutory deadline for a final written decision. This weighs heavily against institution. *See Fintiv I*, IPR2020-00019, Paper No. 11 at 9 (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK.*”).⁵

⁵ Petitioner asserts that “a trial date has not been set in the litigation,” but this is misleading as Petitioner admits that the Scheduling Order would take place “52 weeks after the Markman hearing (or as soon as practicable).” Petition at 62

Indeed, the Board has denied institution on account of similar, or even smaller, gaps between the final written decision and trial. *See, e.g., EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper No. 10 at 9 (P.T.A. B. Apr. 13, 2022) (finding this factor weighed in favor of discretionary denial and denying institution where “the beginning of the jury trial in the WDTX Cases is roughly **one or two months** before any final decision would have been due had *inter partes* review been instituted”) (emphasis added); *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper No. 15 at 13 (P.T.A. B. May 13, 2020) (informative) (finding this factor weighed in favor of discretionary denial and denying institution where the district court trial was scheduled to occur **two months** before the deadline for the Board to reach a final written decision) (emphasis added); *Google LLC v. Ikorongo Tech. LLC*, IPR2021-00204, Paper No. 13 at 7 (P.T.A. B. June 7, 2021) (denying institution of IPR and finding this factor weighed in favor of denial

(citing Ex. 1011 at 4). There is no dispute that the Markman hearing occurred on March 17, 2023, and that March 18, 2024 is “as soon as practicable” one year after that date. Petitioner also asserts that the trial “may become moot” due to Cisco’s motion to transfer, but that argument is also incorrect because the Court denied Cisco’s transfer motion on March 16, 2023. EX2005 at 30.

when “the [district court] trial is now scheduled for approximately *three months* prior to the final determination date”) (emphasis added).

In asserting that the Western District of Texas has a “median time-to-trial for patent cases of 28.3 months,” Petitioner wrongly focuses only on the most recent twelve-month period in their cited statistics. *See* Petition at 63 (citing EX1014, EX1017). Petitioner ignores the variations in time to trial periods over the past six years. *Id.* In so doing, Petitioner ignores time to trial statistics from the pre-COVID period that are likely a more accurate reflection of how quickly the court can get cases to trial. If you average out the median time-to-trial statistics for the past 6 years, the average median time-to-trial is 23.6 months, which is consistent with Patent Owner’s median time-to-trial evidence and the trial date in the *Cisco* case.

Petitioner also fails to disclose that it filed their Petition approximately nine *months* after the district court lawsuit was filed in April 2022. That is not expeditious, as Petitioner could have filed its IPR Petition at any time within a year of being served with the Complaint in this action. The fact that the district court trial is projected to occur well before the deadline for a Final Written Decision in this proceeding is therefore a problem of Petitioner’s own making.⁶

⁶ Petitioner also asserts that no trial date has been set in the separate Arista litigation. However, Arista is not a party to this proceeding and the Arista trial is

In sum, because the district court trial is currently set and expected to occur approximately 5 months before the projected statutory deadline for a final written decision in this IPR, this factor weighs heavily against institution.

C. *Fintiv* Factor 3: The parties will have invested significant resources in at least the *Cisco* trial

Fintiv factor 3, which considers the resources invested in the parallel district court proceeding, weighs strongly in favor of the Board's exercising its discretionary denial authority.

Petitioner wrongly limits its analysis of the parties' investment in the district court proceedings to the stage of those proceedings at the time the petition was filed. Petition at 64. However, *Fintiv* dictates that the proper timeframe for this factor is the investment in the parallel proceeding at the time of the institution decision. *Fintiv I*, IPR2020-00019, Paper No. 11 at 9–10. The institution decision in this proceeding is not expected until August 10, 2023.

By August 10, 2023, the parties will have (and, indeed, already have) expended significant resources. The district court conducted a *Markman* hearing on March 17, 2023 and issued its final claim construction order on March 21, 2023. EX2001. This included constructions of claim terms in the '602 Patent, such as

thus irrelevant for purposes of deciding whether this Petition solely involving Cisco should be instituted.

Claim 15's preamble and the term "RSVP-TE." *Id.*⁷ As other panels have found, this fact alone makes this factor weigh in favor of denial: "If, at the time of the institution decision, the district court has issued substantive orders related to the challenged patent, *such as a claim construction order, this fact weighs in favor of denial.*" *Nokia of Am. Corp. v. Good Kaisha IP Bridge 1*, IPR2022-00755, Paper No. 9 at 11 (P.T.A. B. Nov. 2, 2022) (citing *Fintiv I*, Paper No. 11 at 9–10) (emphasis added). Additionally, the parties have exchanged infringement and invalidity contentions for the '602 Patent, in August 2022 and September 2022, respectively. *See* EX2006; EX2004. Fact discovery on the '602 Patent has already begun under the district court's schedule and will conclude a mere 3 months after the institution decision is projected to be issued in this case. *See* EX1011 (fact discovery opened on March 20, 2023 and fact discovery is set to close on Oct. 13, 2023). Indeed, both Corrigent and Cisco have already propounded initial sets of requests for production and interrogatories, and there have been substantive responses to the initial requests for production and interrogatories from each side. Furthermore, the parties will have to serve final infringement and invalidity contentions a mere month after the projected institution decision date, as well as

⁷ Therefore, the Petition is wrong to state that "the Court has not issued any substantive rulings relating to the '602 patent." Petition at 64.

opening technical expert reports just a few weeks later. *See id.* (contentions will be due on Sept. 15, 2023).

Accordingly, because the parties will have (and already have) expended *significant* resources by the time the Board issues an institution decision in case, this factor weighs heavily against institution.

D. *Fintiv* Factor 4: The issues in the petition and district court proceeding significantly overlap

Fintiv Factor 4 only marginally favors not exercising discretion to deny institution because the issues in the Petition and the parallel district court proceeding overlap and Petitioner has not provided a *Sotera*-style stipulation.

Fintiv Factor 4 considers the overlap between issues raised in the petition and in the parallel proceeding. *Fintiv I*, IPR2020-00019, Paper No. 11 at 6. The prior art references Petitioner asserts in its petition are identical to prior art being litigated to trial in the *Cisco* Case. EX2004 at 16, 25 & Exs. E-2 and E-4 (identifying Raz and Ferguson as charted, primary references). In a half-hearted attempt to address the redundancy of this proceeding, Petitioner provides only a limited stipulation, rather than a *Sotera*-style stipulation, stating they will not rely on “the prior art obviousness combinations on which trial is instituted for the claims on which trial is instituted.” Petition at 64. Therefore, Petitioner’s stipulation is incredibly narrow in scope—so narrow, in fact, that Cisco might attempt to run the very same prior art in slightly modified (albeit substantially similar) combinations in the

District Court proceeding, even if trial is instituted here. The PTAB has previously held that, at most, narrower stipulations weigh only “marginally in favor of not exercising discretion to deny institution.” *Sand Revolution II*, IPR2019-01393, Paper No. 24 at 9–10. Accordingly, based on Petitioner’s *Sand Revolution*-style stipulation, this factor only marginally favors not exercising discretion to deny institution.

E. *Fintiv* Factor 5: Petitioner is a defendant in the district court proceedings

Fintiv Factor 5 favors denial of institution because Petitioner Cisco is the defendant in the parallel district court proceedings. *Fintiv* Factor 5 considers whether the petitioners and the defendants in the parallel proceeding are the same party. *Fintiv I*, IPR2020-00019, Paper No. 11 at 6. Petitioner Cisco is a defendant in the *Cisco* case in which Patent Owner asserts infringement of the ’602 Patent—the only parallel district court proceeding that is relevant here. EX2003. Thus, Factor 5 weighs in favor of denial.

Citing no authority, Petitioner argues that even if it is the same party that is the defendant in the parallel litigation, this factor should only be neutral because “most petitioners in IPR proceedings” are also in a parallel District Court proceeding against the Patent Owner. Petition at 65. Petitioner’s argument is without merit for numerous reasons. First, Petitioner’s argument is contrary to numerous other Board decisions. For example, in *Nokia*, the Board unequivocally

held that “Petitioner is the defendant in the parallel proceeding. Thus, this factor weighs in favor of exercising our discretion to deny the Petition.” *Nokia*, IPR2022-00755, Paper No. 9 at 13. Accordingly, consistent with Board decisions in other proceedings, this factor favors denial of institution because Petitioner is the defendant in the parallel district court proceedings.

Second, Petitioner’s argument that this factor should be neutral despite the Petitioner being the same as the defendants in the related District Court proceeding fails a simple logic test. Specifically, if Petitioner’s argument were true, then this factor could *never* favor denial. Factors by their very nature lie along a scale of: weighing in favor, being neutral, or weighing against. Petitioner would have this Board remove this factor’s ability to weigh in favor of Patent Owners entirely and only provide potential benefits to Petitioner. Such a determination is contrary to the very nature of factors, is bad public policy, and likely only a power available to the Director.

For these reasons, *Fintiv* Factor 5 favors denial of institution.

F. *Fintiv* Factor 6: Petitioner’s grounds do not rise to the level of “compelling evidence of unpatentability”

Factor 6 weighs against institution because, as shown above, the merits of the petition are weak, solely rely on obviousness, and include critical deficiencies, which cannot meet the high compelling merits standard needed to overcome *Fintiv* Factors 1–5 strongly favoring denial of institution.

To meet the standard for a compelling unpatentability challenge, the Petition must present challenges “in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR 2022-01242, Paper No. 23 at 3 (P.T.A. B. Feb. 27, 2023) (citing Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation at 4. (June 21, 2022) (“Guidance Memo”).) “[T]he compelling merits standard is a higher standard than the standard for institution set by statute.” *Commscope Techs.*, IPR 2022-01242, Paper No. 23 at 3 (citing Guidance Memo at 4–5). Under the compelling merits standard, “[a] challenge can only ‘plainly lead to a conclusion that one or more claims are unpatentable’ if it is **highly likely** that the petitioner would prevail with respect to at least one challenged claim.” *Id.* at 3-4 (quoting *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper No. 102 at 49–50 (P.T.A. B. Oct. 4, 2022) (precedential)) (emphasis added).

The compelling merits determination does not replace a *Fintiv* analysis; rather, “PTAB panels ... only consider compelling merits if they first determine[] that *Fintiv* factors 1-5 favor[] a discretionary denial.” *Commscope Techs, LLC*, IPR2022-01242, Paper No. 23 at 4 (P.T.A. B. Feb. 27, 2023). Where the Board finds compelling merits, it “must provide reasoning to explain and support its

determination as to compelling merits sufficient to allow the parties to challenge that finding and sufficient to allow for review of that decision.” *Id.* at 5–6. Here, *Fintiv* Factors 1-5 plainly favor discretionary denial, requiring Petitioner to show compelling merits, which they cannot do. Indeed, Petitioner only provides a conclusory statement, without any analysis or explanation, that “the analysis in Grounds 1-2 provides a compelling unpatentability challenge,” and that “[t]he merits of Petitioners’ arguments are strong.” Petition at 65. The Petition presents ***no analysis*** that explains why it is “***highly likely***” that Petitioner would prevail, as is required. Therefore, the Petition has failed to provide any basis that its arguments are “compelling” on the merits, which reinforces that the Petition should be denied under *Fintiv*. As discussed above (*see supra* Sections I, II.A, and II.B.), the Petition does not assert any grounds of anticipation, let alone any strong obviousness grounds. The Petition instead uses a primary reference, Raz, that is deficient on its face because it solely focuses on the allocation of data packets ***within*** a router, and merely provides conclusory analysis and argument to assert that the reference would be modified in some unspecified way. The Petition then brings in a secondary reference—Ferguson—in a futile and inadequately explained attempt to cure the deficiency, even though Ferguson relates to “load balancing” and distribution of data packets in the aggregate, and has little to do with the particular tunnel provisioning application that the ’602 Patent is concerned with.

Meanwhile, the Petition's motivation to combine analysis, including any analysis of reasonable expectation of success, is all but nonexistent. The merits of the Petition are therefore weak and nowhere close to compelling, which reinforces that, at a minimum, the Petition should be denied under *Fintiv* even if the Board declines to independently dismiss the Petition on its merits.

In sum, four factors (2, 3, 5, and 6) weigh strongly in favor of discretionary denial, whereas one factor (1) is neutral and one factor (4) only marginally favors not exercising discretion to deny institution. Accordingly, Patent Owner respectfully requests that the Board exercise its discretion under *Fintiv* and deny institution.

IV. CONCLUSION

For the foregoing reasons, the Board should deny institution.

Date: May 10, 2023

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24

Under the provisions of 37 C.F.R. § 42.24, the undersigned hereby certifies that the foregoing document contains 6,462 words, and thus complies with the word-count limits of 37 C.F.R. § 42.24.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE was served on May 10, 2023 by filing this document through the P-TACTS platform as well as by delivering a copy via the delivery method indicated to the attorneys of record for the Petitioner as follows:

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