IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

LIONRA TECHNOLOGIES LTD.,
Patent Owner.

U.S. Patent 7,302,708
Issue Date: November 27, 2007

Title: ENFORCING COMPUTER SECURITY UTILIZING AN ADAPTIVE LATTICE MECHANISM

Inter Partes Review No.: IPR2023-00669

NOTICE OF FILING OF TWO *INTER PARTES* REVIEW PETITIONS

***Mail Stop* "*PATENT BOARD*"**
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

Pursuant to the Trial Practice Guide Update dated July 2019 ("2019 TPG"), Petitioner submits this paper to explain why two petitions merit consideration before the Board to challenge the claims of U.S. Patent No. 7,302,708 ("'708 Patent").

I. Ranking of the Two Petitions

Although both petitions have merit, Petitioner requests for the Board to consider institution of the petitions in the following order:

Rank	Petition	Claims
1	IPR2023-00669 ("First Petition")	Claims 1-6 and 9
2	IPR2023-00670 ("Second Petition")	Claims 10-14

II. Explanation of the Differences Between the Petitions

The petitions differ in that they challenge separate, non-overlapping groups of claims. Claims 1 and 9 are independent method claims, and claims 2-6 depend from claim 1. Claim 10 is an independent system claim and claims 11-14 depend from claim 10. The Board has favorably reviewed structuring multiple petitions in this fashion. *See, e.g., Apple, Inc. v. Seven Networks, LLC*, IPR2020-00156, Paper 10 at 27-28 (P.T.A.B. June 15, 2020). Additionally, all but one of the claims in the second-ranked petition (i.e., claim 12) may be subject to 35 U.S.C. § 112 paragraph 6, i.e., are "means-plus-function" claims, unlike the claims in the first-ranked petition. *See* EX-1001 claims 10-14. Finally, the claims in the second-ranked petition recite a "temporal access table" that is not recited in the claims in the first-

ranked petition. *Compare* EX-1001 claims 10-14 (reciting "a temporal access table") *with*, claims 1-6 and 9.

III. Justification for Filing Two Petitions

Petitioner is justified in submitting two separate petitions for *inter partes* review because only one set of the challenged claims in the '708 Patent may be subject to 35 U.S.C. § 112 paragraph 6, i.e., are "means-plus-function" claims. In particular, claim 1 and its dependents are each directed to a method for secure access to a computer system, comprising certain steps with no means-plus-function language. EX-1001 10:16-11:14.

In contrast, claims 10 and its dependents are each directed to a secure computer system (EX-1001 11:34-12:49), and claims 10, 11, 13, and 14 recite "processing means" terms that could invoke the means-plus-function provisions of pre-AIA 35 U.S.C. § 112, sixth paragraph. *See Williamson v. Citrix Online, LLC*, 792 F.3d 1339, 1350 (Fed. Cir. 2015). The Board's rules require Petitioner to construe any potentially means-plus-function terms, including identifying the corresponding structure disclosed in the specification. 37 C.F.R. § 42.104(b)(3). Given the substantial number of "processing means" terms recited in claims 10, 11, 13 and 14 and the lengthy associated functions, Petitioner is required to devote a substantial portion of its word count limit addressing the potential claim constructions for those claims. *See* 37 C.F.R. § 42.24(a)(1)(i). Although Petitioner

endeavored to address all challenged claims in one petition, Petitioner found it infeasible to comply with the claim construction rule, the word count rule, and its obligation to explain the grounds of unpatentability (*see* 37 C.F.R. § 42.104(b)(4) & (b)(5)) within a single petition. Accordingly, Petitioner presents its challenge to claims 10-14 in a second petition so that the Board may be presented with the complete claim analysis for all challenged claims. *See Apple, Inc.*, IPR2020-00156, Paper 10 at 27-28 (determining "two petitions together do not present an undue burden" where both petitions relied on substantially the same prior art).

Petitioner's filing of two petitions is also guided and justified by the Supreme Court's decision in *SAS Institute, Inc. v. Iancu*, 138 S. Ct. 1348 (2018). Under *SAS*, the Board is unable to issue an order to partially institute a requested *inter partes* review. Here, should the Board determine that the "processing means" terms of claims 10, 11, 13 and 14 invoke § 112, sixth paragraph, it is possible that the Board could find that the specification provides insufficient disclosure for the Board to construe claims 10-14 and evaluate claims 1-6 and 9 relative to the prior art. It would be unfair and counterproductive for the Board to be prevented from evaluating the unpatentability of the non-means-plus-function claims over the prior art simply because of the means-plus-function claims' potential invalidity under § 112. But if Petitioner submitted a single petition addressing claims 1-6 and 9 and claims 10-14,

the Board's inability to partially institute an IPR trial could lead to such a result. *See, e.g., Nikon Corp*, IPR2018-00220, Paper 8 at 19 (P.T.A.B. June 14, 2018).

Accordingly, Petitioner's presentation of separate petitions challenging claims 1-6 and 9 in the first-ranked petition and challenging claims 10-14 in the second-ranked petition facilitates the Board's consideration of each challenge.

IV. The Board Should Exercise Its Discretion to Institute Both Petitions

For the above reasons, Petitioner respectfully requests that the Board institute both *inter partes* reviews under 35 U.S.C. § 314(a).

Dated: March 9, 2023

Respectfully submitted,

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CERTIFICATION OF SERVICE ON PATENT OWNER

Pursuant to 37 C.F.R. §§42.6(e) and 42.8(b)(4), the undersigned certifies that on the 9th of March, 2023, a complete and entire copy of this Notice of Filing of Two *Inter Partes* Review Petitions served via Federal Express, postage prepaid, to the correspondence address of record for the '708 Patent:

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Dated: March 9, 2023

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