

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARISTA NETWORKS, INC.,
Petitioner,

v.

CORRIGENT CORPORATION,
Patent Owner.

IPR2023-00837

Patent No. 6,957,369

PATENT OWNER'S PRELIMINARY RESPONSE

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37 C.F.R. § 42.104(b)(3)	10
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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 (2 Years) for Western District of Texas (Docket Navigator) (9/10/2023)
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, (W.D. Tex., Sept. 28, 2022)
2005	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Dkt. 37, Scheduling Order (W.D. Tex. Aug. 12, 2022)
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)
2007	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Dkt. 84, Amended Scheduling Order (W.D. Tex. June 27, 2023)
2008	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Cisco's Preliminary Claim Construction (W.D. Tex., Oct. 19, 2022)
2009	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Dkt. 44, Cisco's Opening Claim Construction Brief (W.D. Tex., Nov. 14, 2022)
2010	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Dkt. 49, Cisco's Reply Claim Construction Brief (W.D. Tex., Dec. 16, 2022)
2011	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Dkt. 58, Joint Claim Construction Statement (W.D. Tex., Jan. 3, 2023)

Exhibit Number	Description
2012	<i>Corrigent Corporation v. Dell Techs. Inc. and Dell Inc.</i> , Case No. 1:22-cv-00496, Dkt. 27, Scheduling Order (D. Del., May 1, 2023)
2013	<i>Corrigent Corporation v. Dell Techs. Inc. and Dell Inc.</i> , Case No. 1:22-cv-00496, Dkt. 49, Stipulation to Extend Time (D. Del., Aug. 22, 2023)
2014	<i>Corrigent Corporation v. Dell Techs. Inc. and Dell Inc.</i> , Case No. 1:22-cv-00496, Order Granting Extension of Time (D. Del., Aug. 22, 2023)
2015	<i>Corrigent Corporation v. Cisco Systems, Inc.</i> , Case No. 6:22-cv-00396, Dkt. 92, Joint Stipulation Regarding Second Amended Scheduling Order (W.D. Tex. Aug. 25, 2023)
2016	<i>Corrigent Corporation v. Arista Networks, Inc.</i> , Case No. 1:22-cv-00497, Dkt. 1, Complaint (D. Del., Apr. 19, 2022)
2017	<i>Corrigent Corporation v. Arista Networks, Inc.</i> , Case No. 1:22-cv-00497, Dkt. 25, Scheduling Order (D. Del., May 1, 2023)
2018	<i>Corrigent Corporation v. Arista Networks, Inc.</i> , Case No. 1:22-cv-00497, Dkt. 41, Stipulation to Extend Time (D. Del., Aug. 29, 2023)
2019	<i>Corrigent Corporation v. Arista Networks, Inc.</i> , Case No. 1:22-cv-00497, Order Granting Extension of Time (D. Del., Aug. 30, 2023)
2020	Time to Trial (6 Years) for Western District of Texas (Docket Navigator) (9/10/2023)
2021	Time to Trial (6 Years) for District of Delaware (Docket Navigator) (9/10/2023)
2022	<i>Dell Technologies Inc. et. al v. Corrigent Corp.</i> , IPR2023-00464, Paper 19 (P.T.A.B. Aug. 30, 2023)
2023	Comparison of “Motivation to Combine Ke and Lewis” Section Between Petition and Petition in Dell-Cisco IPR

I. INTRODUCTION

Petitioner Arista Networks, Inc. (“Petitioner”) attempted to ride on the coattails of an earlier-filed IPR proceeding, but now faces the consequences. In January, Dell Technologies, Inc. (“Dell”) and Cisco Systems, Inc. (“Cisco”) initiated IPR2023-00464 (“Dell-Cisco IPR”) to challenge the validity of the ’369 Patent. In April, Petitioner followed, presenting identical grounds based on the same prior art references, and substantially identical arguments and evidence in its challenge to the same patent and claims as in the Dell-Cisco IPR. *Compare* EX1016, Dell-Cisco IPR, Paper 1, *with* Petition. Petitioner explicitly acknowledges the “substantial overlap” between the two Petitions and even proposes a joinder, with Dell’s counsel taking the lead on shared issues. *See* Petition at 72. However, this Board recently denied institution in the Dell-Cisco IPR on its merits, which compels a parallel denial of institution in this proceeding.

Even if the Board were to entertain the possibility of granting Petitioner a second bite at the apple, which it should not, there are compelling reasons for the Board to deny the Petition due to Petitioner’s lack of a reasonable likelihood of prevailing. The ’369 Patent is directed to the concept of failure testing and claims such novel and non-obvious methods to perform such testing, based on a series of steps, using loop back interfaces founded on various configurations of switching and routing components. In its attempt to invalidate the claims of this patent,

Petitioner readily acknowledges, just as Dell and Cisco have acknowledged, that no single prior art reference either anticipates or renders obvious the claims of the '369 Patent. Consequently, Petitioner solely resorts to four two- or three-reference obviousness combinations in its endeavor to invalidate the claims. However, the grounds presented are woefully deficient for several reasons.

First, the Petition is globally deficient as it fails to address claim constructions established in a co-pending district court proceeding. During claim construction in the related Western District of Texas *Corrigent v. Cisco* case, Cisco insisted on a specific “Order of Steps” claim construction for each of the independent claims of the '369 Patent. The Court held a *Markman* hearing on March 17, 2023, and adopted Cisco’s “Order of Steps” construction in its claim construction order on March 21, 2023—this occurred *a month prior* to Petitioner filing its Petition in April. Importantly, Petitioner expressly adopts the District Court’s claim constructions. Petition at 9. Nevertheless, Petitioner and its expert both completely disregard and consequently fail to address how their obviousness grounds and arguments apply to the “Order of Steps” construction. Petitioner’s decision to overlook the adopted construction alone is fatal to its Petition.

Second, even if the Board moves past Petitioner’s failure to address the “Order of Steps” construction, the obviousness grounds Petitioner presents against the '369 Patent’s independent claims are deficient on their face. Ground 1—Ke in

view of Lewis—is deficient for several reasons. The Petition ignores that Ke is directed toward specific types of testing that, by design, test the hardware interconnects of “*individual circuit boards in a system while remaining circuit boards in the system are disabled.*” EX1008, Abstract (emphasis added), 2:21–27 (“*test vectors are applied to circuit boards individually, while the remaining boards in the system are disabled*” (emphasis added))). In other words, Ke is focused on testing the hardware interconnections of individual boards throughout a system individually to ensure that the physical interconnections (e.g., pins) work; it does not concern testing that transmits data *between two or more subsidiary boards* or modules as the ’369 Patent’s claims require. The POSA would not be motivated to combine Ke and Lewis because the core purpose of Ke would be undermined by the combination, and there is no credible explanation of *how* the two references would be combined. Meanwhile, the limitation-by-limitation analysis of Ke and Lewis as a whole is conclusory, grounded in hindsight, and deficient as to several limitations. Lewis is relied on for nothing more than the concept of testing “loops,” and does little to cure the deficiencies of Ke.

Third, the Cook and Lewis ground (Ground 3) is also deficient on its face. Cook is directed to the problem of enhancing distributed control by employing individual line control processors (LCPs) and control lines for each peripheral device attached to its system. It is not concerned with interconnections between

peripherals or testing such connections, as it is concerned with the individualized control of the peripherals. Lewis does not address these concerns and is once again relied on by Petitioner based on pure hindsight. The generic references to loop testing in Lewis would do nothing to motivate the POSA to modify Cook and risk undermining its core purpose. And once again, even a perfunctory review of the Petition's limitation-by-limitation analysis confirms that, as with the Ke-Lewis ground (Ground 1), the Cook-Lewis ground (Ground 3) is deficient on its face. Because Grounds 1 and 3 implicate all of the independent claims and Grounds 2 and 4 (which add an additional reference, Sarkinen) simply address dependent claims, those grounds necessarily fail as well, confirming that the Petition should be denied in its entirety on the merits.

Finally, even if the Petition is not denied on the merits, it should be alternatively denied under *Fintiv* and *General Plastic* for the reasons discussed below because most factors weigh against institution.

II. DENIAL OF INSTITUTION IN DELL-CISCO IPR DICTATES THAT INSTITUTION ALSO BE DENIED IN THIS PROCEEDING

A. PETITIONER'S ARGUMENTS AND EVIDENCE ARE SUBSTANTIVELY IDENTICAL TO THE ARGUMENTS AND EVIDENCE IN DELL-CISCO IPR

The Petition should be denied due to its inclusion of identical grounds, based on the same prior art references, along with substantially similar arguments and evidence as presented in the Dell-Cisco IPR, where institution was previously

denied on its merits. Petitioner admits that the Petition is substantively identical to the Petition in the Dell-Cisco IPR:

- “There is substantial overlap between this petition and [Dell and Cisco’s] petition challenging the same claims and using overlapping prior art. Arista’s petition includes the same grounds as [Dell and Cisco’s] petition.” Petition at 72.
- “There is ***substantial overlap*** in our analysis of the prior art . . .” EX1003, ¶ 17.

In fact, Petitioner goes to the extent of proposing a joinder (albeit not accompanied by a motion for joinder), explicitly stating that it “agree[s] to allow Dell’s counsel to take the lead on overlapping issues.” Petition at 72. However, this Board, after thoroughly assessing the same grounds based on the same prior art references, as well as, substantially the same arguments and evidence, has already denied institution on the merits in the Dell-Cisco IPR. Specifically, the Board concluded that “Petitioner has not demonstrated a reasonable likelihood of prevailing in establishing unpatentability of at least one claim of the ’369 patent.” EX2022 at 2.

Recently, the Board has also denied institutions in a similar case. In *Amazon.com et. al. v. VOIP.PAL.com, Inc.*, IPR2022-01178, Paper 11 at 2 (P.T.A.B. Dec. 22, 2022), the Board held that “[t]he denial of institutions on the merits in the [earlier-filed IPR proceeding] dictates that institution also be denied in this proceeding,” where, as here, Petitioner’s arguments and evidence were

“substantively identical to the arguments and evidence in the [earlier-filed IPR proceeding].” *Id.* at 2–5. The Petitioners in *Amazon* similarly indicated that their Petition is “substantively identical” to the one in the earlier proceeding, challenging the same claims on the same grounds, and relying on the same prior art and evidence. *Id.* at 3.

Here, the Petition is nearly identical to that of the Dell-Cisco IPR. Specifically, the Petition has four grounds based on four prior art references that are identical to those in the Dell-Cisco IPR. *Compare* Petition at 10–33 with EX1016 at 11–38 (Ground 1: Ke-Lewis); *compare* Petition at 33–39 with EX1016 at 38–42 (Ground 2: Ke-Lewis-Sarkinen); *compare* Petition at 39–62 with EX1016 at 42–68 (Ground 3: Cook-Lewis); *compare* Petition at 62–67 with EX1016 at 68–72 (Ground 4: Cook-Lewis-Sarkinen). The arguments within each ground are nearly identical, with the only variations being in citations and accessory information, if any. For example, the section titled “Motivations to Combine Ke and Lewis” is nearly identical, with only minor revisions like changing “loopback” to “loop back” and updating citations. *See* EX2023. To the extent that there is any additional accessory information, it is of little consequence, as it pertains to the same grounds and arguments presented in the current proceeding. For example, Petitioner retained the same Ground 2 but made a minor addition under § VIII.B.3 for “Claim 6.” Petition at 36. However, Ground 2 of the Petition only addresses

specific dependent claims, including Claim 6, and does not address or rectify the numerous deficiencies related to the independent claims of the '369 Patent. *See infra* § III.C. The denial of institution is the natural consequence that Petitioner must face for attempting to replicate the earlier Dell-Cisco IPR without addressing the deficiencies identified therein.

Aside from the significant overlap and the fact that the grounds are nearly identical, the Petition does nothing to rectify the deficiencies that the Board identified in each of the obviousness combinations for which it has already denied institution. EX2022 at 8 (“[W]e agree with [Corrigent] that Petitioner has not shown adequate reasons for combining Ke and Le with reasonable expectation of success. Further, particularly in light of the teachings of Ke, Petitioner employs improper hindsight in suggesting that a POSITA would have combined Ke and Lewis to arrive at the combined invention.”); *id.* at 11–12 (“Petitioner has not adequately explained reasons for combining Cook and Lewis, ad we agree with [Corrigent] [] that Petitioner’s proposal to combine Cook and Lewis employs improper hindsight.”). The Petition, as explained below, repeats the same mistakes as the Petition in Dell-Cisco IPR and does nothing to rectify the fact that the references, on their face, would not have been combined for the POSA.

III. THE PETITION SHOULD BE DENIED ON THE MERITS

A. THE PETITION FAILS BECAUSE IT NEVER DISCLOSES OR ADDRESSES THE “ORDER OF STEPS” CONSTRUCTION

The Petition should fail on all grounds because it fails to address or account for the adopted “Order of Steps” claim construction in co-pending District Court proceedings in *Corrigent Corporation v. Cisco Systems, Inc.*, No. 22-cv-00396 (W.D. Tex.) (“*Cisco* case”). This “Order of Steps” construction applies to each independent Claims 1, 8, 15, and 21 of the Patent, was adopted by the Court in the co-pending litigation, and requires the following:

The instruct[ing] step must be performed after completion of the first selection; the configure[ing/e] step must be performed after the completion of both selections; and the transmit[ting] step must be performed after both selections.

EX2001 at 2.

In the Petition, Petitioner repeatedly indicates the adoption of the District Court’s claim construction from the *Cisco* case. For example, Petitioner states: “Claim construction proceedings have been completed in the *Cisco* litigation. . . . The claims are invalid ***under the constructions adopted by the district court in the Cisco litigation.***” Petition at 5. Petitioner’s expert also acknowledges that “Cisco Systems, Inc., another party that was also sued by Corrigent, has gone through the process of claim construction in the Western District of Texas, where litigation involving the ’369 patent was filed.” EX1003, ¶ 69. He further adds: “The prior

art teaches and/or renders obvious these limitations *under the existing claim construction* from the district court. As such, these constructions at best support the case for unpatentability of the Challenged Claims, or have no impact on the patentability of the Challenged Claims.” *Id.* at ¶ 71. Nevertheless, Petitioner and its expert both entirely ignore the “Order of Steps” construction in their obviousness arguments, rendering their arguments deficient.

Crucially, this construction was actively under discussion in the District Court well over five months before Petitioner filed this Petition and explicitly adopted it on April 18, 2023. *See* Petition at 5. Cisco first served Corrigent with the proposed “Order of Steps” construction on October 19, 2022 (EX2008), submitted its Opening Claim Constructions advocating for the “Order of Steps” construction on November 14, 2022, and its Reply Claim Construction Brief on December 16, 2022 (EX2009 at 10–14 and EX2010 at 4–7), and filed a joint claim construction statement reiterating the construction on January 3, 2023 (EX2011). However, in the Petition’s statement titled “How the Challenged Claims Are To Be Construed Under 37 C.F.R. § 42.100(b)(3),” Petitioner attaches the District Court’s Claim Construction Order as EX1017 but vaguely states that “[t]he plain and ordinary meaning was adopted for several terms that appear in the ’369 Patent.” Petition at 5. Notably, the Petition does not explicitly mention the construction of

the “Order of Steps” above.¹ Petitioner then states that “Petitioner does not believe any express construction of the claim terms in the ’369 Patent is necessary for any of the grounds presented in this IPR.” *Id.* at 5; *see also* EX1003, ¶ 69 (“it is my opinion that no formal claim construction is necessary”). This is important as 37 C.F.R. § 42.100(b) recognizes that the Board now applies the same claim construction standard as the federal district court, and that “[a]ny prior claim construction determination” from such courts “will be considered” by the Board.

Petitioner’s failure to address the District Court’s construction is fatal to the Petition for at least two reasons. *First*, Petitioner’s failure reflects a violation of the Board’s regulations. Specifically, the Petition reflects a failure to provide any showing of “how the challenged claims are to be construed in accordance with 37 C.F.R. § 42.104(b)(3),” and also does not show how, as so construed, they are unpatentable under the statutory grounds identified in the Petition. *See* 37 C.F.R. § 42.104(b)(4).” *Orthopediatrics Corp. v. K2M, Inc.*, IPR2018-01546, Paper 10 (P.T.A.B. Feb. 14, 2019) at 12. In *Orthopediatrics*, the Board denied institution under similar circumstances, where the Petitioner failed to set forth how the limitations should be construed, and merely stated that it “does not believe any

¹ The only passing mention of District Court’s claim construction is in Petitioner’s expert declaration. EX1003, ¶ 70.

specific claim term of the Challenged Claims requires construction for the purposes of this petition.” *Id.* at 10. As the Board clarified, “[k]eeping in mind that Petitioner has the burden to show a reasonable likelihood of prevailing in showing that at least one claim is unpatentable, ***it is incumbent upon Petitioner to address substantively the District Court’s claim construction of a limitation when construction of that limitation is likely to be a focal point of the inter partes review proceeding.***” *Id.* at 12 (emphasis added). In this case, Petitioner’s failure to address the District Court’s construction appears to be a deliberate choice on its part. Nowhere does Petitioner explain why the “Order of Steps” construction would be relevant in the District Court but not in the IPR decision, nor do they justify their departure from the District Court’s construction. Petitioner should be held accountable for its decision, just as the Petitioner was in *Orthopediatrics*.

Second, apart from the procedural violation, Corrigent submits, as it did in the Dell-Cisco IPR, that the “Order of Steps” construction should be considered by the Board on the merits. Once considered, it is plain that the ordering of steps is not addressed anywhere in any way by the Petition or by Petitioner’s expert, Dr. Min. There is no discussion in either document of how the Ke and Lewis combination or the Cook and Lewis combination teaches that the “instruct[ing] step [is] performed after completion of the first selection” of a line or trace, how the “configur[ing/e] step” to link first and second ports “must be performed after

completion of both selections” of lines or traces in each combination, or how “the transmit[ting] step” pertaining to must be performed after both selections” for any of the independent claims of the ’369 Patent. *See generally* Petition at 15–23 & 39–52 (Claim 1), 27–28 & 56–57 (Claim 8), 30–32 & 59–60 (Claim 15), and 32–33 & 61 (Claim 21). There is no discussion about the sequence of testing steps in the references because (1) the Petition simply ignores the “Order of Steps” claim construction and, (2) as discussed below, the references do not discuss testing methodologies akin to that in the ’369 Patent, and the Petition relies on hindsight to cobble together various disclosures of the references. Assuming that the Board agrees (even preliminarily) that adoption of claim construction from the District Court is appropriate, it is not at all likely, let alone “reasonably likely,” that Petitioner could prove unpatentability on the merits with respect to any independent claim challenged in the Petition. This simply reinforces why Petitioner’s decision to ignore and hide the ball on the Court’s “Order of Steps” construction should be fatal to the Petition.

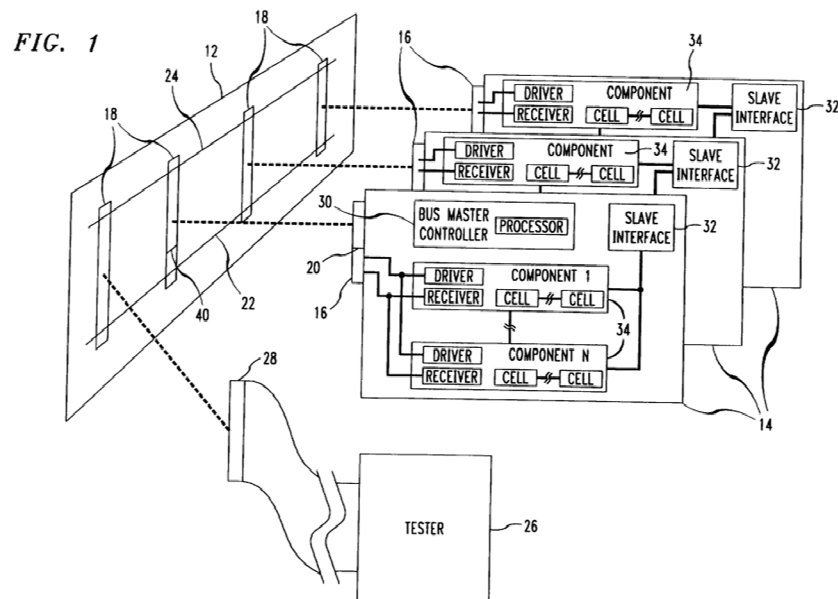
B. GROUNDS 1 AND 3 ARE DEFICIENT

1. Ground 1 is Deficient on its Face

a) The POSA Would Not Have Combined Ke and Lewis

In addition to the failure to address the “Order of Steps” construction, Ground 1 is deficient because the POSA would not have been motivated to

combine Ke and Lewis. Notably, the Board in the Dell-Cisco IPR rejected this identical combination and argument. *See* EX2022 at 5–8 (“Petitioner has not shown adequate reasons for combining Ke and Lewis with a reasonable expectation of success.”) Ke is titled “Methods for Backplane Interconnect Testing,” and is directed toward the testing of the hardware interconnects of *individual* circuit boards on a backplane to make sure they function correctly. Thus, testing is “applied to *individual circuit boards in a system while remaining circuit boards in the system are disabled.*” EX1008, Abstract (emphasis added). Figure 1, which Petitioner annotates and relies on heavily, is shown below without annotations and shows “a perspective view of a multiboard electronic system having *a backplane to be tested* in accordance with the present invention.” EX1008, 2:54–56 (emphasis added).



Because the focus of the testing is on the backplane itself and the integrity of its connections, the focus of Ke is expressly *not* on performing testing *between* hardware modules or boards that are connected to the backplane, just on boards that are inserted into the backplane one-at-a-time, so as to ensure the integrity of each of the *backplane's* interconnects. Thus, Ke repeatedly and consistently emphasizes that it individually tests boards one-at-a-time and disables all other hardware so as to achieve the “objects” and “principles of the present invention.” See, e.g., EX1008, Abstract (“[T]est vectors are *applied to individual circuit boards in a system while remaining circuit boards in the system are disabled.*”); 2:21–27 (“This and other objects of the invention are accomplished in accordance with the principles of the present invention by providing a backplane testing method in which test vectors *are applied to circuit boards individually, while the remaining boards in the system are disabled*”); 7:27–34 (“The walking enable and intraboard counting techniques are both satisfactory techniques for generating test vectors. If desired, other techniques for providing test vectors to circuit boards 14 can be used, *provided that test vectors are applied to drivers on a single board at a time while the remaining boards in the system are disabled and provided that the signals on all the receivers in the system are monitored simultaneously.*”); see also EX2022 at 6–7 (determining in Dell-Cisco IPR that “Ke describes techniques

for testing backplane interconnects in which ‘test vectors are applied to circuit boards *individually, while the remaining boards in the system are disabled.*’”).

Moreover, Figures 11 and 13 (highlighted and shown below) and the corresponding discussion of those figures show that both the “walking enable” and the “intraboard counting” testing techniques perform such individualized board testing that disables *all boards other than the single board being tested at any given time*. See EX1008, Figs. 11, 13, 3:7–8, 3:11–12; 5:42–44 (“The steps involved in performing a walking enable test are shown in FIG. 11. At step 42, disable vectors are applied *to each board 14 in system 10.*”); see also *id.* 7:15–34. The figures each show that testing is performed by disabling all boards first, enabling one board (“J” as an example), and then disabling that board before checking if other boards connected to the backplane should be tested; see also EX2022 at 7 (determining in Dell-Cisco IPR that “Ke describes two testing techniques . . . both of which begin with a step of disabling all boards and then enabling only one individual board for testing.”).

FIG. 11

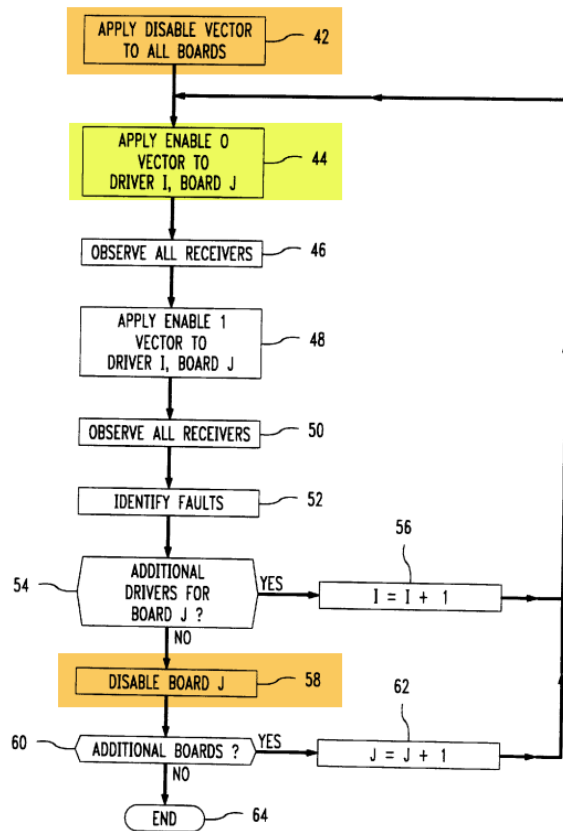
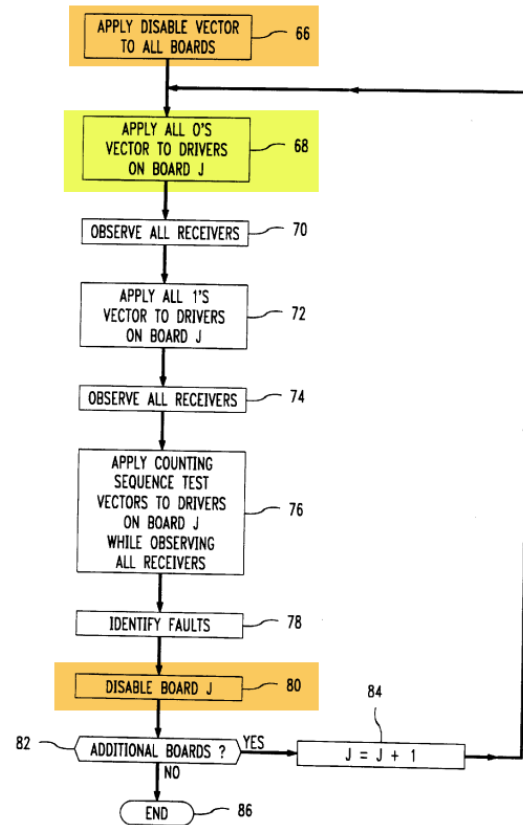


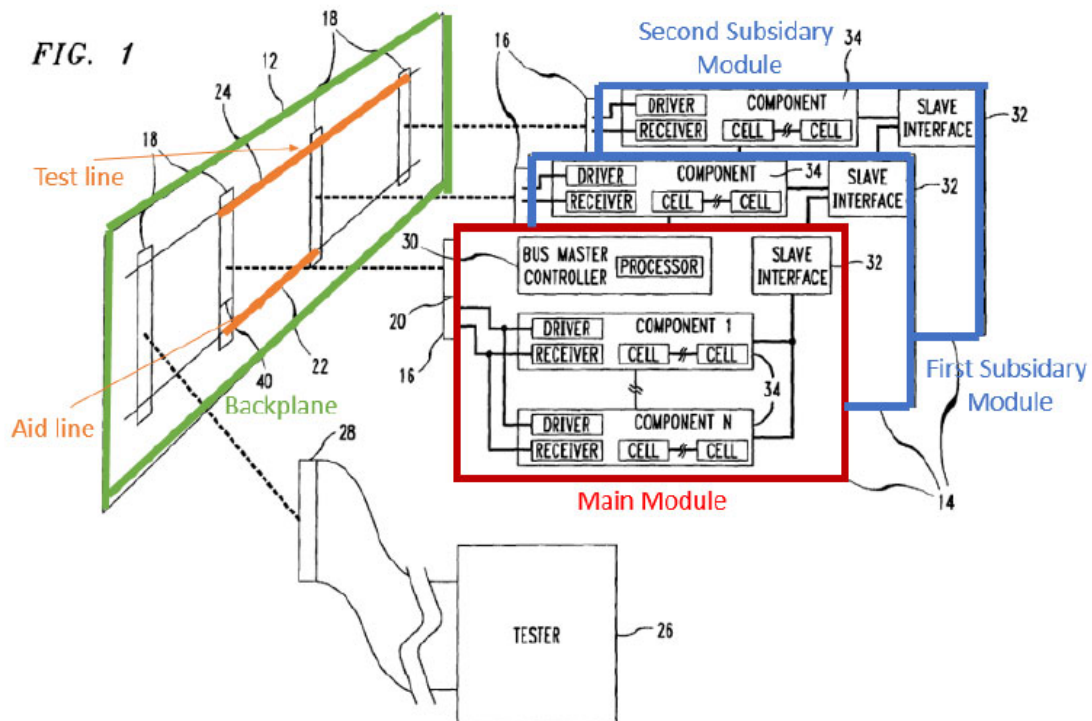
FIG. 13



Ultimately, Petitioner mostly ignores all the portions of Ke discussed above, but even the Petitioner slips and notes that the “backplane connections are tested one at a time.” Petition at 11; EX1016 at 13 (making the identical slip in Dell and Cisco’s Petition); *see also* EX2022 at 7 (noting that “[i]n one instance, Petitioner acknowledges these teachings of Ke . . . [b]ut Petitioner does not reconcile these teachings with its arguments.”).

Despite the above disclosures, Petitioner seeks to use Ke as the primary reference in a combination with Lewis that would allegedly perform failure testing

between multiple, interconnected boards, using a loop back interface. As shown in the section that Petitioner labels “Motivation to Combine Ke and Lewis,” it seeks to use Ke’s Boards (labeled 14) as the “Main Module,” “First Subsidiary Module,” and “Second Subsidiary Module” that are involved in the testing recited in the claims of the ’369 Patent. Petition at 12–13; EX1016 at 18 (having identical argument in Dell and Cisco’s Petition); *see also* EX2023. These Boards are shown in the annotated version of Ke’s Figure 1 provided by Petitioner (which are identical to the annotations Dell and Cisco presented in the Dell-Cisco IPR).



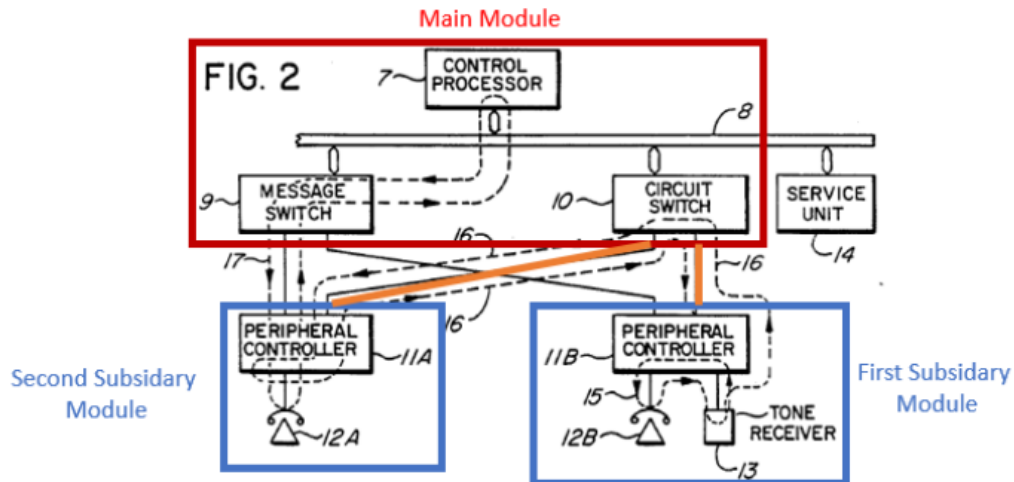
Petition at 13; EX1016 at 18 (having identical annotations in Dell and Cisco’s Petition). All of the colored annotations are notably from Petitioner, not

from the Ke reference. Petitioner then states, in reference to the combination of Ke and Lewis, that testing would occur in the combination “between the first and second subsidiary modules”:

The main module would set up an aid line with the first subsidiary module and a test line with the second subsidiary module, as disclosed in Lewis. The backplane modules in Ke would then perform the loop back test described in Lewis set forth above, where the main module routes the test packet between the first and second subsidiary modules over the test and aid lines. EX1009, 4:42-54. This

Petition at 13; EX1016 at 15 (having identical statements in Dell-Cisco’s Petition).

This argument from the Petition underscores that Petitioner seeks to implement loop back testing allegedly disclosed in Lewis in Ke’s system. Such testing in Lewis, according to Petitioner, is shown in Lewis’s Figure 2 (shown with Petitioner’s annotations below, which are the identical to the annotations Dell and Cisco presented in the Dell-Cisco IPR). Lewis’s testing sets up communication loops between interconnected peripherals, and according to Petitioner has the “same basic structure” as Ke. Petition at 16–17 (citing EX1009, Fig. 2); EX1016 at 18 (having identical argument in Dell and Cisco’s Petition).



Petitioner relies on Lewis’s disclosure in Figure 2, along with disclosures about test loops being established that allow “control messages” to be sent *“between peripheral interfaces.”* EX1009, 4:23–54. At no point does Lewis suggest or permit that interconnected peripherals or boards can be disabled during testing—if anything, the teachings referenced above suggest that all of the Boards must be enabled for interboard communications.

The POSA would have never been motivated to combine Ke and Lewis because doing so in the manner suggested by Petitioner would undermine the fundamental purpose of Ke, which is to test a backplane’s interconnects by testing *individual Boards* connected to the backplane *one-at-a-time* while disabling all other boards. Ke teaches that the disabling of all other hardware and testing boards individually is done so that each board’s interconnection can be properly tested, and so that “contention between drivers” can be avoided in connection with the

testing techniques taught in Ke. EX1008, 2:31–33, 3:65–67. The testing method proposed by Lewis necessarily requires testing *between* boards such that multiple boards would need to be activated during testing—directly contradictory to the teachings of Ke. This would undermine the purpose of Ke’s testing, which is to focus on testing the hardware interconnects of the *backplane itself*. The Board in the Dell-Cisco IPR agreed, rejecting the identical argument, holding that “neither Petitioner nor [its expert] adequately explains why or how a person of ordinary skill would have chosen Ke’s teachings for combining with Lewis’s teachings, *when Ke directly warns against testing with more than one board enabled.*” EX2022 at 8.

For these reasons, incorporating test loops such as those taught in Lewis would undermine Ke’s purpose, change Ke’s principles of operation, and run directly contrary to Ke’s teachings, confirming that the references would not have been combined by the POSA as a matter of law. *Adidas AG v. Nike, Inc.*, 963 F.3d 1355, 1359-60 (Fed. Cir. 2020); *Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 F. App’x 755, 759-760 (Fed. Cir. 2015). More specifically, just as the references in *Adidas* were not combinable because they employed “fundamental differences” in seaming techniques, Ke and Lewis are not combinable because they employ fundamentally different hardware testing techniques. *Adidas*, 963 F.3d at 1359-60. Likewise, just as the POSA would not have combined a fluid dispensing system

with a spray nozzle that would have rendered the dispensing system “inoperable for its intended purpose” in *Plas-Pak*, the POSA would not have combined Ke and Lewis here because performing testing that would permit multiple boards or peripherals to be enabled and tested at the same time would render Ke “inoperable for its intended purpose.” *Plas-Pak*, 600 F. App’x at 759-60; *In re Gordon*, 733 F.2d 900 (Fed. Cir. 1984); *In re ICON Health & Fitness, Inc.*, 496 F.3d 1374 (Fed. Cir. 2007).

Petitioner’s alleged reasons that the Ke and Lewis combination “would have been obvious” to the POSA lack merit. *See* Petition at 13–15; EX1016 at 15–17 (having identical argument in Dell and Cisco’s Petition); *see also* EX2023. As a threshold matter, Petitioner’s entire analysis focuses on alleged similarities between Ke and Lewis. Yet, as the Federal Circuit explained in *Adidas*, “[f]undamental differences between the references are central to th[e] motivation to combine inquiry.” *Adidas*, 963 F.3d at 1359–60. Petitioner’s decision to ignore differences between the references (such as those discussed above) is telling.

Meanwhile, the reasons for combinability alleged by Petitioner are superficial and simply reinforce that the POSA would not have combined Ke and Lewis. The first and second reasons given are that both references are “generally directed to testing connections” and that “backplanes are highly configurable” such that testing “should be adaptable and flexible.” Petition at 13–14; EX1016 at 15–

16 (having identical statements in Dell and Cisco’s Petition). But nothing cited by Petitioner is actually a teaching from Ke suggesting that its core purpose of testing boards individually while disabling all others could ever be changed. The third reason given is that the POSA would allegedly have been motivated to test idle lines in light of Ke’s teachings. Petition at 14–15; EX1016 at 17 (having identical argument in Dell and Cisco’s Petition). But the teaching that the Petition cites here mischaracterizes the reference, and is a portion of Ke that refers to the disabling of *all boards* other than the one being tested—not just “certain parts” of the system. See Petition at 14 (citing EX1008, 2:29–35); EX1016 at 17 (having identical statement in Dell and Cisco’s Petition). This concept of *disabling* a board makes it unusable, and is different from the concept of an *idle* board that is not disabled, but might be available for use. This final reason proffered by Petitioner simply reinforces that the POSA would not have combined Lewis with Ke to perform the type of testing Ke contemplates.

Finally, Petitioner’s arguments regarding reasonable expectation of success do not solve its problem. Its argument is simply that “the loop back testing between specific peripherals in Lewis could be employed in Ke.” Petition at 15; EX1016 at 17 (having identical statement in Dell and Cisco’s Petition). But the obviousness inquiry does not merely ask whether a skilled artisan could combine the references, but instead asks whether “they would have been motivated to do

so.” *InTouch Techs., Inc. v. VGO Commc'ns, Inc.*, 751 F.3d 1327, 1352 (Fed. Cir. 2014). Therefore, whether the combination might have been *possible* to implement is irrelevant, particularly in view of Petitioner’s decision to ignore the fundamental differences in the type of testing employed by the references.

b) Even If Ke and Lewis Were Combined, The Petition Fails To Demonstrate That Numerous Limitations Would Have Been Obvious to the POSA

Even if the POSA would have combined Ke and Lewis, the Petition would still fail because the Petition’s limitation-by-limitation analysis for Ground 1 is deficient in numerous respects with respect to numerous claim limitations. *See generally* Petition at 15–33. Indeed, a review of the limitation-by-limitation analysis shows that very few portions of the Ke and Lewis references are cited or analyzed, and that Petitioner does nothing more to cherry-pick portions of the references without considering their full context. Some exemplary additional deficiencies are outlined below.

First, as discussed above, the Petition nowhere addresses how the construed “Order of Steps” in the independent claims would be achieved by the combination. *See supra* Section III.A. Neither Ke nor Lewis articulate principles or procedures behind “selecting lines” (steps 1[a] and 1[c]), providing loop back instructions (1[b]), or configuring a switch to link first or second ports during testing (1[d]). With regard to the “configuring” step (1[d]), moreover, the Petition ignores that—

consistent with the discussion above—“link[ing] the first and second ports” during testing would undermine the core purpose of Ke, which would have avoided linking ports of different boards or peripherals during testing.

Second, the Petition provides no evidence from either Ke or Lewis with respect to limitation 1[f], which recites “reporting that a failure has occurred if the test traffic does not return to the second subsidiary module within a predetermined period of time.” Petition at 22–23. This is unsurprising because neither reference discusses the concept of a “predetermined time” or a timeout for the testing being discussed. And this is particularly unsurprising for Ke because, yet again, Ke does not pertain to—and in fact discourages—testing *between* boards or modules. *See supra* Section III.B.1.a. Given this problem, Petitioner cites an IETF RFC specification for this limitation, essentially using hindsight to suggest that the POSA would have found the claim element obvious. This handwaving reinforces that the Petition should be denied.

Third, Petitioner’s alleged analysis of Claims 16–26 reinforces the deficient and slipshod nature of the Petition. *See* Petition at 32–33. For these claims, in an apparent effort to make an end run around the Board’s word count requirements, Petitioner simply provides subsections incorporating the analysis from prior claims.

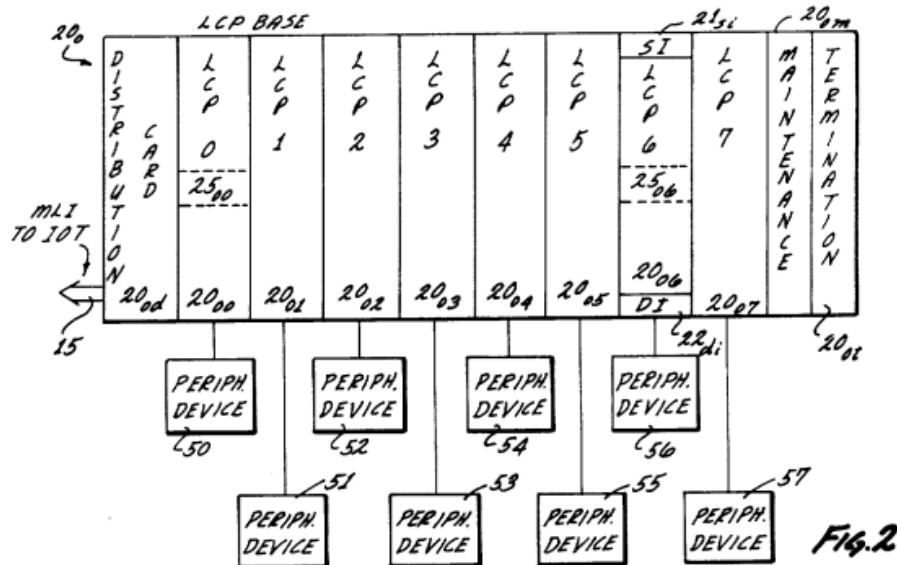
In sum, the deficiencies discussed above, whether viewed individually or collectively, uniformly demonstrate that Petitioner has no likelihood—let alone a reasonable likelihood—of demonstrating that any claims of the ’369 Patent would have been obvious over the combination of Ke and Lewis.

2. Ground 3 Is Deficient on its Face

a) The POSA Would Not Have Combined Cook and Lewis

The POSA would not have combined Cook and Lewis for similar reasons to those discussed above with respect to Ke and Lewis. Again, the Board in the Dell-Cisco IPR rejected this identical combination and argument. *See* EX2022 at 12 (“Petitioner has not demonstrated a reasonable likelihood of prevailing in its challenge of any of claims 1–26 as being unpatentable in view of Cook and Lewis.”). Cook is a 78-column reference that is titled “Modular Block Unit for Input-Output Subsystem.” The focus of Cook is to facilitate distributed control of a system using “Line Control Processors” (LCPs) that are individually and separately associated with the various peripherals attached to the system. EX1010, Abstract. “The LCPs are made in a variety of types, each designed to operate with a specific type of peripheral device” and adapted “to its own specific peripheral device.” EX1010, 29:43–50. Cook’s focus is on enhancing distributed control of several devices, such that “a large number of peripheral devices” can be handled “independently of intervention by the central processor.” EX1010, Abstract, 1:35–

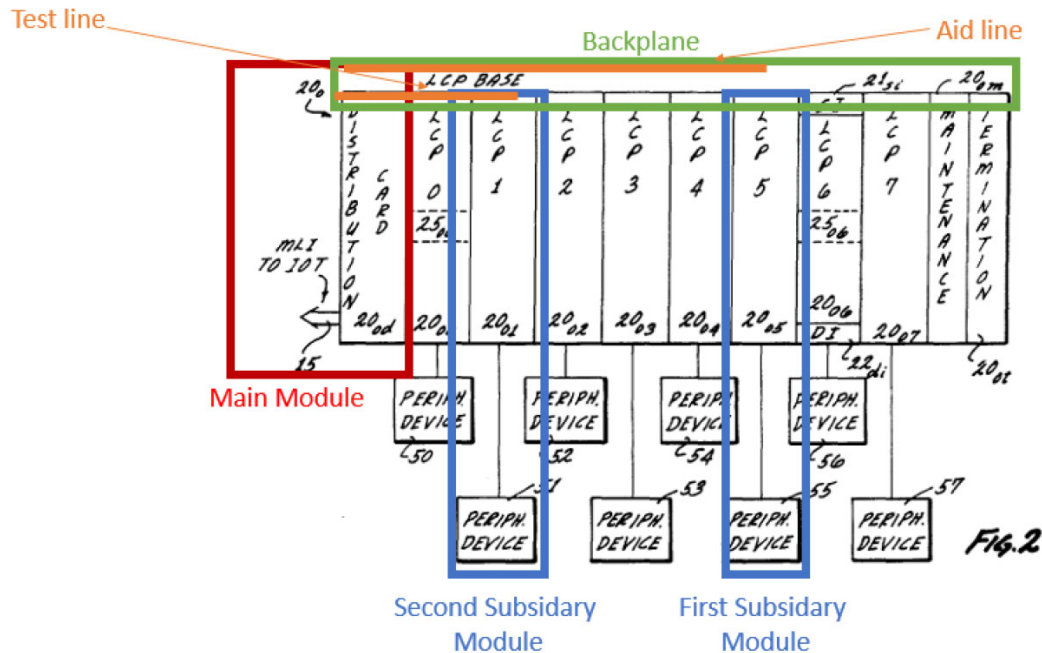
40. Thus, each individual peripheral unit has an individual LCP, and each peripheral has a “separate channel from the Main System to each peripheral unit,” vitiating the “need for data transfers (between a particular peripheral unit and the Main System) to have to wait for the use of a shared communication channel, since each individual peripheral unit is provided with its own channel.” EX1010, 5:34–44. As Cook’s Figure 2 shows, “[e]ach individual Line Control Processor is seen connected by output lines to a particular peripheral device”—indeed, 8 peripherals are shown connected to LCP numbers 0 through 7. EX1010, 18:52–56.



Lines connected to the Distribution Card “must be gated to individual LCPs. This gating is enabled only when the LCP for a particular peripheral “is in the ‘connected’ state; when the LCP disconnects, the gating is disabled.” EX1010, 29:10–12.

Given that Cook is concerned with distributed control by ensuring that each peripheral has a separate LCP and its own distinct control line, the only testing disclosed in Cook is a “Poll Test,” which “is an algorithm used by the LCP Base Module to establish a connection *between the Base Module and a particular LCP.*” EX1010, 23:43–48 (emphasis added); *see also* EX2022 at 10 (determining in Dell-Cisco IPR that “Cook teaches poll testing backplanes with gated lines dedicated for *each LCP.*”). The testing in Cook does not test connections *between different peripherals or modules* that are connected to Cook’s “Base Module” (such as testing between a first and second subsidiary module)—consistent with the fact that Cook intends to promote its goal of distributed and independent control of the peripherals using LCPs that are connected directly to the distribution card.

Despite this, much like with Ke, Petitioner attempts to use Cook as a base reference to suggest that the POSA would employ testing between peripherals governed by separate LCP. Petitioner’s annotated version of Figure 2 once again superimposes the ’369 Patent’s claim requirements onto Cook, suggesting that testing would occur between two separate peripheral devices, which it labels as the “First Subsidiary Module” and “Second Subsidiary Module” recited in the claims. Petition at 40; EX1016 at 43 (having identical annotations in Dell and Cisco’s Petition).



Id. Ignoring the principles of separate and distributed control using the LCPs and separate control lines for each peripheral, Petitioner argues as follows:

The main module would set up an aid line with the first subsidiary module and a test line with the second subsidiary module, as disclosed in Lewis. The backplane modules in Cook would then perform the loop back test described in Lewis set forth above, where the main module routes the test packet between the first and second subsidiary modules over the test and aid lines. EX1009, 4:42-54.

Petition at 42; EX1016 at 45 (having identical statements in Dell and Cisco's Petition).

As with the Ke-Lewis combination, the Cook-Lewis combination makes little sense, and would not have been implemented by the POSA. Lewis makes no mention of distributed control, and relies on a centralized control processor 7 that

communicates via a central bus 8, as shown in Lewis’s Figure 2 below. *See* EX1009, Fig. 2, 3:47–60. The notion that the distributed control system of Cook would be used with Lewis is grounded in hindsight, as nothing in Cook references loop back testing or contemplates testing between peripherals in its system. *See* EX2022 at 10 (determining in Dell-Cisco IPR that “[Cook’s] teachings are inconsistent with Petitioner’s annotated Figure 2 and proposed loopback testing . . .”). Indeed, performing such testing would again undermine the purpose of Cook to ensure that efficient, distributed control of the peripherals is maintained throughout the system. *Adidas AG v. Nike, Inc.*, 963 F.3d 1355, 1359-60 (Fed. Cir. 2020); *Plas-Pak Indus., Inc. v. Sulzer Mixpac AG*, 600 F. App’x 755, 759-760 (Fed. Cir. 2015). This is why the concept of “loop-based” testing is not mentioned once across Cook’s 78 columns. The Board in the Dell-Cisco IPR agreed, rejecting the identical argument, holding that “neither Petitioner nor [its expert] adequately explains why or how ‘a POSITA would have been motivated to combine the backplane testing described in Cook with the loopback testing described in Lewis.’” EX2022 at 11.

Once again, Petitioner’s discussion of motivations to combine ignores the differences between the references and provides superficial reasons that the references could be combined, rather than providing reasons that the POSA would have actually combined them. *See* Petition at 41–44; EX1016 at 45–48 (having

identical argument in Dell and Cisco's Petition). Petitioner's arguments boil down to assertions that the references would be combined because "both references are generally directed to testing connections," and both references discuss peripherals that are connected to a system. Petition at 42; EX1016 at 46 (having identical argument in Dell and Cisco's Petition). But other than providing a conclusory statement that "there are times when the different boards in a backplane need to communicate with each other," Petition at 43; EX1016 at 46 (having identical statement in Dell and Cisco's Petition), there is no discussion showing that Cook is ever concerned about communications between boards or peripherals. *See* EX2022 at 11. Indeed, that each peripheral and LCP gets its own control line in Cook, and that there are *not* shared communications, suggests just the opposite and that Petitioner's analysis is hindsight-driven. The Petition's discussion of testing of "idle" lines is likewise hindsight-driven and is based on the claim language.

Finally, Petitioner's reasonable expectation of success discussion again reinforces that the Cook and Lewis references would not have been combined. In particular, Petitioner admits that "Cook happens to disclose a 'poll test,'" but tries to dismiss that disclosure as being "interchangeable" to other undisclosed tests. Petition at 44. But as noted above, the disclosure in Cook of a poll test reinforces that testing in Cook is concerned with ensuring that the base module can communicate with individual LCPs, consistent with the goal of distributed control.

Petitioner points to nothing other than a generic discussion in Cook about the “LCP Base Module Backplane” to suggest that the references could be combined, while again ignoring the references’ differences. Ultimately, the Board should not credit Petitioner’s cursory motivation to combine analysis with respect to Cook and Lewis, just as with the Ke and Lewis ground discussed above. For this reason alone, Ground 3 should be rejected in its entirety.

b) Even If Cook and Lewis Were Combined, The Petition Fails To Demonstrate That Numerous Limitations Would Have Been Obvious to the POSA

Again, even if the POSA would have combined Cook and Lewis, the cursory and slipshod nature of Petitioner’s element-by-element analysis reinforces that the ground lacks merit and that institution should be denied. *See generally* Petition at 44–62. The same concerns discussed above with respect to the conclusory and hindsight-driven nature of the Ke and Lewis ground apply here, *see supra* Section III.B.1.b., including the concerns that Petitioner (1) never addresses the “Order of Steps” construction that flows through several claim limitations; (2) provides a conclusory discussion of certain limitations without even addressing the reasons that the references would not be combined (e.g., limitations 1[d] and 1[e] provide no reference to how Cook would support “linking ports” or transmitting test traffic between modules controlled by separate LCPs that employ separate control lines); (3) addresses limitations without even referencing either Cook or Lewis (e.g.,

limitation 1[f]); and (4) provide a conclusory subsections at the end of the ground to support that alleged obviousness of Claims 16–26. *See generally id.* This simply reinforces that Ground 3 lacks merit, just as Ground 1 lacked merit.

C. GROUNDS 2 AND 4 FAIL FOR THE SAME REASONS

Grounds 2 and 4 of the Petition simply address certain dependent claims and add the Sarkinen reference to the aforementioned proposed combinations of Ke-Lewis (Ground 1) and Cook-Lewis (Ground 3). These grounds do not address or rectify the numerous deficiencies of those prior grounds with respect to the independent claims of the '369 Patent. *See* EX2022 at 8, 12. Therefore, Grounds 2 and 4 necessarily fail for the reasons given above in Sections III.A. and III.B.

IV. 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. Mar. 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

On September 11, 2023, in *Corrigent Corp. v. Arista Networks, Inc.*, No. 1:22-cv-00497 (D. Del.) (“*Arista* case”), Petitioner filed a motion to stay pending IPR proceedings. However, Petitioner has not presented evidence that the District Court will stay the case if a proceeding is instituted. This factor is neutral because 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 strongly militates against institution in this case due to the fact that the *Cisco* case is scheduled to proceed to trial approximately 8 months before the anticipated statutory deadline for a final written decision in this IPR, which is December 14, 2024, as per 37 C.F.R. § 42.100(c). In contrast, the *Cisco* case is set for trial on April 15, 2024. *See* EX2015 at 3; EX2007 at 3; EX2001 at 1 (*Markman* hearing held on March 17, 2023). This timeline established by the District Court aligns with the statistical median time to trial for the Western District of Texas over the past two years, even considering the challenges posed by the COVID pandemic. *See* EX2002. These statistics indicate that the median time to trial for cases in the district was 24 months after filing. *Id.* In this instance, the

trial is also set approximately 24 months after the case was originally filed. *See* EX2015 at 3; EX2007 at 3; EX2001 at 1; EX2003 (case filed April 19, 2022). Consequently, the District Court trial is on track to take place approximately 8 months before the projected statutory deadline for a final written decision, and this fact strongly weighs against the 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*.”).²

Indeed, the Board has previously denied institution in cases where there were similar or even shorter time gaps between the final written decision and the trial. *See, e.g., EClinicalWorks, LLC v. Decapolis LLC*, IPR2022-00229, Paper

² Petitioner asserts that “[n]o date has been set for trial” in the *Cisco* case, Petition at 68, but this is misleading as the original scheduling order stated that the trial would take place “52 weeks after *Markman* hearing (or as soon as practicable).” EX2005 at 4. There is no dispute that the Markman hearing in *Cisco* occurred on March 17, 2023, and that March 18, 2024 was “as soon as practicable” one year after that date. Now, moreover, the Court has expressly clarified its original scheduling order and has adopted the trial date of April 15, 2024, which is less than a month after the March 18, 2024 date. EX2007 at 3.

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 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 of 28.3 months” and that the District of Delaware is much longer, Petitioner wrongly focuses only on the most recent twelve-month period in its cited statistics. *See* Petition at 68 (citing EX1014; EX1015). 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 one averages out the median

time-to-trial statistics for the past six years in the Western District of Texas, the average median time-to-trial is 23 months, which is consistent with Corrigent's median time-to-trial evidence and the trial date in the *Cisco* case.³ See EX2020. If one averages out the median time-to-trial statistics for the past six years in the District of Delaware, the average median time-to-trial is 37 months. See EX2021.

Petitioner also fails to disclose that it filed its Petition approximately *one year* after the District Court action 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 in the *Cisco* case 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.

In sum, because the District Court trial in *Cisco* is currently set and expected to occur approximately 8 months before the projected statutory deadline for a final written decision in this IPR, this factor weighs heavily against institution.

³ Scheduling orders in the *Dell* and *Arista* cases set trial for April 14, 2025.

EX2012 at 14; EX2017 at 14. However, this does not change the fact that at least one Court will have reached a decision on invalidity with respect to the '369 Patent before any Final Written Decision could possibly be issued in this proceeding.

C. *Fintiv* Factor 3: The parties will have invested significant resources in *Arista* case, as well as, in *Dell* and *Cisco* cases

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 68. 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 December 14, 2023. By December 14, 2023, Corrigent will have (and, indeed, already has) expended significant resources.

In the *Arista* case, Corrigent identified the accused products on June 9, 2023, and Petitioner produced its core technical documents on July 21, 2023. EX2017 at 3. Corrigent will have served initial infringement contentions on or before September 22, 2023, and Petitioner will have served initial invalidity contentions on or before November 3, 2023. *See* EX2017 at 3; EX2018 at 1; EX2019 at 1.

In the *Cisco* case, 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 '369 Patent, including

the “Order of Steps” construction discussed above. *Id.*⁴ 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 I*, 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, Corrigent and Cisco have exchanged infringement contentions and invalidity contentions for the ’369 Patent, in August 2022 and September 2022, respectively. *See* EX2006; EX2004. Fact discovery on the ’369 Patent has already begun under the District Court’s schedule and will conclude approximately 1.5 months *before* the institution decision is projected to be issued in this case. *See* EX2007 at 1 (confirming October 13, 2023 close of fact discovery); EX2015 at 1 (submitting Joint Stipulation Regarding Second Amended Scheduling Order extending close of fact discovery to October 27, 2023). Indeed, both Corrigent and Cisco have already propounded initial sets of requests for production and interrogatories, there have been substantive responses to the initial requests for production and interrogatories from each side. Furthermore, Corrigent

⁴ Therefore, the Petition is wrong to suggest that “investment” in the co-pending litigations “has been minimal.” Petition at 68.

and Cisco will have to serve final infringement and invalidity contentions, as well as, opening technical expert reports approximately 2.5 months and 1 month *before* the projected institution decision date, respectively. *See* EX2007 at 1 (granting scheduling order with contentions deadline on September 15, 2023, expert reports deadline on October 20, 2023); EX2015 at 1 (submitting Joint Stipulation Regarding Second Amended Scheduling Order extending contentions deadline to September 29, 2023, and expert reports deadline to November 7, 2023).

In *Corrigent Corp. v. Dell Technologies et al.*, No. 1:22-cv-00496 (D. Del.) (“*Dell* case”), Corrigent identified the accused products on June 9, 2023, and Dell produced its core technical documents on July 21, 2023. EX2012 at 3. Corrigent will have served initial infringement contentions on or before October 27, 2023, and Petitioner will have served initial invalidity contentions on or before November 22, 2023. *See* EX2012 at 3; EX2013 at 1; EX2014 at 1. These are significant efforts in the *Dell* case as well.

Accordingly, because the parties will have (and already have) expended *significant* resources by the time the Board issues an institution decision in not only the *Arista* case, but also the *Dell* and *Cisco* cases, this factor weighs heavily against institution.

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

Fintiv Factor 4 favors not exercising discretion to deny institution because the issues in the Petition and the parallel District Court proceeding overlap. *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. Invalidity contentions have not been served in the *Arista* case. However, invalidity contentions in the *Cisco* case were served on Corrigent on September 28, 2022. EX2004. Notably, the prior art references Petitioner asserts in its Petition are identical to prior art being litigated to trial in the *Cisco* case. EX2004 at 11–12 (identifying Ke, Lewis, and Cook in invalidity contentions). Therefore, this factor marginally favors 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 Arista is a defendant in the parallel District Court proceeding. *Fintiv* Factor 5 considers whether the petitioner and the defendants in the parallel proceeding are the same parties. *Fintiv I*, IPR2020-00019, Paper No. 11 at 6. Petitioner Arista is a defendant in the respective *Arista* case in which Corrigent asserts infringement of the '369 Patent. EX2016. Thus, Factor 5 weighs in favor of denial.

Petitioner argues that even if it is the same party that is the defendant in the parallel litigation, this factor should only be neutral based on a citation to a single case. Petition at 69. 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. Moreover, Petitioner mischaracterizes the *HP* case they cite in the Petition, which analyzed Factor 5 "collectively" with other factors, and ***did not*** hold that Factor 5 in particular was neutral. *HP Inc. v. Slingshot Printing LLC*, IPR2020-01084, Paper 13 at 9 (P.T.A.B. Jan. 14, 2021). Accordingly, consistent with Board decisions in other proceedings, this factor favors denial of institution because Petitioner is the defendant in the parallel District Court proceeding.

Second, Petitioner's argument that this factor should be neutral despite the Petitioner being the same as the defendant 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.*, IPR2022-01242, 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.” *Id.* 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 “[t]he merits of Petitioner’s arguments are compelling because they lead to a strong conclusion that one or more claims are unpatentable by a preponderance of the evidence.” Petition at 69. 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 III.A, and III.B.), the Petition does not assert any grounds of anticipation, let alone any strong obviousness grounds that have any meaningful

merit. The Petition instead uses a primary reference, Ke, that would never be combined with Lewis without destroying its principle of single-board testing, and Cook, another outdated reference that would never be combined with Lewis either. Neither combination is adequately explained, is grounded in hindsight, and does not even address the “Order of Steps” construction. 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, five factors (2, 3, 4, 5, and 6) weigh strongly in favor of discretionary denial, whereas one factor (1) is neutral. Accordingly, Corrigent respectfully requests that the Board exercise its discretion under *Fintiv* and deny institution.

V. THE BOARD SHOULD ALSO EXERCISE ITS DISCRETION TO DENY INSTITUTION UNDER *GENERAL PLASTIC*

A. *General Plastic* Factors 1–6

With respect to Factor 1, Corrigent agrees that Petitioner has not previously filed a petition directed to the same claims of the same patent. However, application of the *General Plastics* factors is not limited solely to instances where multiple petitions are filed by the same petitioner. Rather, when different petitioners challenge the same patent, the Board considers any relationship between those petitioners when weighing the *General Plastics* factors. *Valve*

Corp. v. Elec. Scripting Prod., Inc., IPR2019-00062, Paper No. 11 at 9 (P.T.A.B. Apr. 2, 2019) (precedential). In *Valve*, a different petitioner had filed an earlier petition challenging the same claims of the same patent challenged by the petitioner in the proceeding at issue, and the two petitioners were co-defendants in district court litigation and were both accused of infringing the challenged patent based on the same product. *Id.* at 9–10. The Board found that, although the petitioners were different in the two proceedings, the complete overlap in the challenged claims and the significant relationship between the petitioners favored denying institution. *Id.* at 10. Here, Corrigan agrees that the record does not establish a “significant relationship” among Petitioner, Dell, and Cisco. However, they are defendants in co-pending District Court actions and have all been accused of infringing the ’369 Patent. As discussed above, the Petition challenges the same claims of the ’369 Patent as the earlier-filed petition in the Dell-Cisco IPR. Therefore, Factor 1 weighs against exercising discretion to deny institution, but only moderately because of the complete overlap in the challenged claims between the Petition and that in the Dell-Cisco IPR. *See United Fire Protection Corp. v. Engineered Corrosion Solutions, LLC*, IPR2018-00991, Paper 18 at 8–9 (P.T.A.B. Oct. 10, 2019).

Factor 2 is neutral with different parties filing the respective petitions.

NetApp Inc. v. Realtime Data LLC, IPR2017-01660, Paper No. 17 at 10 (P.T.A.B. Jan. 25, 2018)

With respect to Factor 3, Corrigent agrees that Patent Owner Preliminary Response in Dell-Cisco IPR was filed after Petitioner filed its Petition. This factor marginally favors not exercising discretion to deny institution.

Factors 4 and 5 weigh against institution because Petitioner certainly knew, or should have known references cited in the Dell-Cisco IPR Petition. The Petition in the Dell-Cisco IPR was filed on January 23, 2023, and Petitioner filed its Petition in this IPR approximately three months thereafter on April 18, 2023. Petitioner states only conclusively that Factor 4 weighs against discretionary denial, “[g]iven the relatively short time” between the two filings. Petition at 71. This argument is not persuasive because the Petition in the earlier-filed Dell-Cisco IPR rely on the same references Petitioner cites in the instant Petition. *See NetApp Inc.*, IPR2017-01660, Paper No. 17 at 10–11; *NetApp Inc. v. Realtime Data LLC*, IPR2017-01195, Paper No. 9 at 11–12 (P.T.A.B. Oct. 12, 2017). Petitioner also has not identified when it learned of the references and, therefore, has not explained sufficiently why the amount of time that lapsed was reasonable. *See F5 Networks, Inc. v. Radware Ltd.*, IPR2018-00161, Paper No. 7 at 11 (P.T.A.B. Apr. 26, 2018). Thus, Factors 4 and 5 weigh in favor of denying institution.

Factors 6 and 7 weigh heavily against institution. The Petition in the Dell-Cisco IPR, which has the identical grounds based on the same prior art, and substantially identical arguments and evidence in its challenge to the same patent and claims as the instant Petition, has been denied institution on the merits. Petitioner provides no compelling explanation for its tardy filing and could have minimized the burden on the Board and Corrigent by raising its present arguments at an earlier date accompanied by a motion for joinder (instead of merely proposing it in its untimely Petition). There would be no offsetting conservation of the District Courts' judicial resources because the Final Written Decision in this proceeding would not issue until well after at least the *Cisco* case in Western District of Texas. Instituting a separate proceeding now, after the Dell-Cisco IPR institution has been denied, also would result in significant prejudice to Corrigent, which already spent approximately seven months successfully defending the patentability of the '369 Patent in the Dell-Cisco IPR. These repetitive attacks implicate the efficiency concerns underpinning *General Plastic*, and, thus, favor denying institution.

In sum, four factors (4, 5, 6, 7) weigh strongly in favor of discretionary denial. Accordingly, Corrigent respectfully requests that the Board exercise its discretion under *General Plastic* and deny institution.

VI. CONCLUSION

For the foregoing reasons, the Board should deny institution.

Date: September 14, 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 10,734 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 September 14, 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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