

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.,
Petitioner,

v.

MONARCH NETWORKING SOLUTIONS, LLC,
Patent Owner.

Case IPR2024-00175
Patent 8,693,369

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO
STAY *EX PARTE* REEXAMINATION CONTROL NO. 90/015,315**

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TABLE OF CONTENTS

I.	Introduction.....	1
II.	The Reexamination Should Not be Stayed	2
A.	Factor 1: Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding.	3
B.	Factor 2: Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings.	3
C.	Factor 3: Whether the concurrent parallel Office proceeding will duplicate efforts within the Office.	5
D.	Factor 4: Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding).	6
E.	Factor 5: Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding.	6
F.	Factor 6: The respective timeline and stage of each proceeding.....	7
G.	Factor 7: The statutory deadlines of the respective proceedings.....	9
H.	Factor 8: Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.....	10
III.	Conclusion	11

TABLE OF AUTHORITIES

Cases

<i>Apple Inc. et al. v. SpaceTime3d, Inc.</i> , IPR2023-00344, (P.T.A.B. May 29, 2024).....	8
<i>Juniper Networks, Inc., et al. v. Chrimar Systems, Inc.</i> , IPR2016-01389, (P.T.A.B. Sept. 12, 2017).....	2

Statutes

35 U.S.C. § 305	8, 9
35 U.S.C. § 325(d)	3, 5

Other Authorities

37 CFR § 42.20(c).....	11
MPEP § 2240	9
MPEP § 2249	9
MPEP § 2260	5
MPEP § 2262	5
MPEP § 2272	6

I. Introduction

Patent Owner Monarch Networking Solutions LLC (“Monarch” or “Patent Owner”) opposes the stay of *ex parte* reexamination no. 90/015,315 (the “Reexamination”) requested by Juniper Networks, Inc. (“Juniper” or “Petitioner”). *See* Paper 16 (the “Motion”). Though Petitioner suggests its justification for requesting a stay is that “significant time and effort will be saved by staying the Unified Patents EPR,” Motion at 5, the timing of its request undercuts any support for that assertion. Petitioner has been aware of the Reexamination since before it filed its IPR, Pet. at 74, yet it waited to file its motion to stay until *after* Patent Owner had filed both its Office Action Response in the Reexamination and its Patent Owner Response in this proceeding. *See generally* Patent Owner’s Response (Paper 15); Patent Owner’s Amendment and Response to First Office Action, *Ex Parte* Reexamination No. 90/015,315 (Aug. 7, 2024) (the “Reexamination Response”). If saving “time and effort” was Petitioner’s actual concern, then it would have requested the stay *before* the Examiner in the Reexamination drafted the Office Action and *before* Patent Owner had filed the majority of its briefing in both proceedings. The delayed timing of the request means that it can only result in dramatically delaying what little is left of the Reexamination along with pending litigation regarding the ’369 Patent. Petitioner should not be allowed to delay other proceedings after waiting to see the Patent Owner’s positions in those proceedings.

This is not Juniper’s first attempt at such a delay tactic in front of the PTAB. The PTAB has rejected other prior requests from Juniper to stay a related reexamination because it waited too long to seek a stay after finding out about the reexamination. *See, e.g., Juniper Networks, Inc., et al. v. Chrimar Systems, Inc.*, IPR2016-01389, Paper 65 at 4 (P.T.A.B. Sept. 12, 2017) (“We are not persuaded that a motion to stay is appropriate at this time because 1) Petitioner [Juniper Networks, Inc.] knew about the related reexaminations at least since February 6, 2017, but waited until September 1, 2017, to request authorization for a motion to stay the related reexaminations.”). Instead of taking to heart the Board’s prior admonition that 6 months was too long to delay seeking a stay, Juniper has decided to delay even longer this time, waiting more than 9 months to file its motion. *Compare* Pet. at 74 (filed Nov. 10, 2023) *with* Motion (filed Aug. 19, 2024). It should not be rewarded for ignoring the PTAB’s prior guidance.

Given the fact that there is little (if any) efficiency to be gained by staying the Reexamination at this late stage, Petitioner’s request should be denied.

II. The Reexamination Should Not be Stayed

The Board’s August 14, 2024, email requested that the parties address several factors in their briefing. As explained below, these factors favor denying Petitioner’s request to stay the Reexamination.

A. Factor 1: Whether the claims challenged in the AIA proceeding are the same as or depend directly or indirectly from claims at issue in the concurrent parallel Office proceeding.

Petitioner suggests that “*all* claims overlap here.” That is incorrect. Newly added dependent claims 18-33 are pending in the Reexamination. Those claims are not at issue here and will not be addressed in this proceeding.¹ Reexamination Response at 9-11. However, those newly added claims depend from claims at issue in this proceeding. Thus, this factor slightly weighs in favor of a stay.

B. Factor 2: Whether the same grounds of unpatentability or the same prior art are at issue in both proceedings.

Petitioner asserted in its Petition that discretionary denial under § 325(d) was not proper because “the [Reexamination] does *not* include any of the grounds that are presented in this petition.” Pet. at 75 (emphasis in original). Now that Petitioner wishes to manipulate the Reexamination to its benefit, it has reversed itself and asserts that this factor favors a stay because of how similar the grounds are. Tellingly, Petitioner never addresses its past arguments, such as its argument that “the Biswas patent used in the EPR is not the same patent relied upon in this petition—indeed, the Biswas patent in this petition is not part of the same family as

¹ The newly added ’369 Patent claims depend (directly or indirectly) from existing claims at issue in this proceeding.

the Biswas patent in the EPR, has a different specification, and has a different set of inventors.” Pet. at 76.

Additionally, Petitioner’s section heading does not even address the content of the actual factor and instead asserts that “Patent Owner Has Asserted That Similar Prior Art Is Being Considered in Both Proceedings.” Motion at 7. While it is true that Patent Owner argued in its preliminary response that much of the art was similar between the proceedings, Petitioner conveniently fails to mention that the Board ***rejected*** Patent Owner’s preliminary response argument in its Institution Decision, holding that “unlike this proceeding, the reexamination does not involve consideration of the teachings of Kumar, which as discussed above is ***critical*** to the question of obviousness of using a mask to define a range of port numbers.” Institution Decision at 28 (emphasis added).

The differences in the grounds between the proceedings have been confirmed as the Reexamination has progressed. The “critical” Kumar reference is still not asserted in the Reexamination, and while there are similarities in the Biswas and Fangman references, they are not being used in the same manner. All rejections in the Reexamination are based on anticipation by the individual references, while all Petition grounds in this IPR are based on obviousness combinations, all of which *require* the “critical” Kumar reference. *Compare* Reexamination, June 7, 2024 Office Action at 4, 23 *with* Pet. at 4. Given these differences between the references

in each proceeding (which Petitioner relied on in its Petitioner arguments regarding § 325(d)), this factor weighs strongly against a stay.

C. Factor 3: Whether the concurrent parallel Office proceeding will duplicate efforts within the Office.

Because of Petitioner's delay, there is little risk of duplicative efforts within the Office. The Reexamination Examiner has already issued the non-final office action, which means the bulk of the efforts by the Office in the Reexamination proceeding have been completed. *See, e.g.*, MPEP §§ 2260 (noting the examiner will “make a definitive first *ex parte* action on the merits which should clearly establish the issues which exist between the examiner and the patent owner insofar as the patent is concerned.” (emphasis added)), 2262 (“It is especially important that the examiner’s action in reexamination be thorough and complete in view of the finality of a reexamination proceeding and the patent owner’s inability to file a continuation proceeding.” (emphasis added)). Given the work already performed and the fact that the two proceedings address different theories (anticipation vs. obviousness) and admittedly different references, there is little risk of duplicate effort going forward.

Petitioner suggests that “there is the possibility that the EPR ‘may consider issues that would duplicate the Board’s efforts in settling similar issues.’” Motion at 8-9 (emphasis added). However, despite delaying its motion until it had access to the Reexamination Office Action and Patent Owner’s Responses in both

proceedings, Petitioner was unable to identify a single issue with the potential to result in duplication. Thus, this factor weighs against a stay.

D. Factor 4: Whether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding).

Similar to Factor 3, despite Petitioner delaying its Motion until it had the Office Action and Patent Owner's Responses in both proceedings, Petitioner was unable to identify a single issue with the potential to result in inconsistent results. This factor weighs against a stay.

E. Factor 5: Whether amending the claim scope in one proceeding would affect the claim scope in another proceeding.

Because of the late stage of the Reexamination proceeding, Patent Owner has already proposed additional claims in the Reexamination. However, Patent Owner did not modify any of the existing claims at issue in this proceeding. Reexamination Response at 5-9, 11. At the Reexamination's late stage, the entry of any further claim amendments is unlikely. *See* MPEP § 2272 ("It is intended that prosecution before the examiner in a reexamination proceeding will be concluded with the final action....patent owner cannot, as a matter of right, amend any finally rejected claims, add new claims after a final rejection, or reinstate previously canceled claims."). Nor has Patent Owner proposed any claim amendments in its Response in this

proceeding. Thus, there is little risk that future claim amendments could occur in either proceeding that would affect the claim scope in the other one.

Petitioner suggests that Patent Owner’s newly added dependent claims are relevant to this factor, and states that “the amendments proposed by Patent Owner in the Unified Patents EPR present claims that are patentably indistinct from the challenged claims in this IPR.” Motion at 10. Yet again, Petitioner declines to provide even a single example supporting that argument, instead relying on conclusory assertions. Regardless, Petitioner could not make such a showing if it tried. For example, newly added claims 23-28 and 30-33 recite limitations directed to home gateways which are not found in any prior claims. Reexamination Response at 9-11. Petitioner’s conclusory analysis on this factor does not support a stay and should be rejected. Thus, this factor weighs against a stay.

F. Factor 6: The respective timeline and stage of each proceeding.

At least two rounds of briefing (Petitioner’s Reply and Patent Owner’s Sur-Reply) and oral argument remain in this proceeding before any decision can be reached. The statutory deadline is May 8, 2025—more than 8 months away.

On the other hand, Petitioner suggests that the Reexamination “is still in its early stages,” Motion at 11, but as discussed above for Factor 3, the bulk of the work in the Reexamination is complete. The remaining required step (a Final Rejection or Notice of Intent to Issue) “will be conducted with special dispatch within the Office.”

35 U.S.C. § 305. The Reexamination (which was filed before this proceeding) is at a much later stage than this proceeding.

Petitioner also mischaracterizes the *SpaceTime3D* opinion that it quotes for support. See Motion at 11 (citing *Apple Inc. et al. v. SpaceTime3d, Inc.*, IPR2023-00344, Paper 46 at 7 (P.T.A.B. May 29, 2024)). In *SpaceTime3D*, a third party filed a request for reexamination almost a year *after* the IPR had been filed. Compare *SpaceTime3D*, Paper 2 (showing a Dec. 13, 2022 filing date) with *SpaceTime3D*, Paper 46 at 2 (noting the reexamination was filed on Dec. 27, 2023). The Patent Owner in *SpaceTime3D* sought to stay the reexamination less than two weeks after the reexamination request was granted (while Petitioner here waited more than 7 months after the '369 Patent reexamination request was granted). *SpaceTime3D*, Paper 46 at 2. In *SpaceTime3D*, for Factor 6 the PTAB found that because the IPR was in such an advanced stage (and would most likely complete before the CRU even issued a *first* office action) that “[t]he period the CRU has to wait before a final decision is brief, **and will not impact the requirement that the [] Reexamination Proceeding be ‘conducted with special dispatch.’**” *Id.* at 9 (emphasis added). Here, the Reexamination was filed first, the bulk of the work is finished, and a Final Written Decision in the IPR could still be 8 months away. The PTAB in *SpaceTime3D* did not want the CRU to “work towards issuing a *first* action” when a final written decision in the IPR was imminent and would “conserve those efforts.”

Id. (emphasis added). Here, Petitioner delayed its motion far too long to plausibly suggest that any similar conservation of effort is possible. This factor weighs against Petitioner's request for a stay.

G. Factor 7: The statutory deadlines of the respective proceedings.

For the reasons discussed above for Factor 6, this Factor also supports denying a stay. The statutory deadline in this proceeding is 8 months away, while the bulk of the work in the Reexamination is done. To stay the Reexamination at this late stage would be incompatible with the statutory instruction that the Reexamination be “conducted with special dispatch.” 35 U.S.C. § 305.

Petitioner's suggestion that “[i]t took nearly eight months for a first, non-final Office Action to issue in the Unified Patents EPR,” Motion at 11, and that the Examiner might “maintain[] that pace,” Motion at 12, for the final office action is very unlikely given how the reexamination process works. An examiner does not begin working on an office action the second a reexamination request is filed. The Office first goes through a process of considering whether the request presents a substantial new question of patentability (which can take up to three months), followed by a two-month window of time in which the Patent Owner can file a statement and amendments. *See* MPEP §§ 2240, 2249. For the Reexamination, that period did not expire until March 18, 2024—two months after the January 18, 2024 Order Granting Request for *Ex Parte* Reexamination. That means that between

March 18, 2024 and June 7, 2024 (a period of less than three months), the proceeding was docketed to the Examiner and the Examiner produced the Non-Final Office Action. Even if the Examiner “maintains that pace” as Petitioner suggests, the Final Rejection or Notice of Intent to Issue will be completed well before this proceeding. Petitioner’s speculation about possible appeals is just that—speculation. This factor weighs against Petitioner’s request for a stay.

H. Factor 8: Whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

As discussed above, neither proceeding can moot all issues in the other concurrent proceeding, and no simplification is likely: the invalidity theories are different (anticipation vs. obvious), there are differences in the asserted references, this proceeding relies on a reference that the Board previously found to be “critical” to the invalidity theories (Kumar) while the Reexamination does not, and there are newly added claims in the Reexamination with a different claim scope than anything currently pending in the IPR. Petitioner’s argument that “the Board will likely issue a final decision prior to the completion of the Unified Patents EPR” is unsupported. Petitioner provides no support for the suggestion that it will somehow take the Examiner more than 8 months to issue a Final Rejection or Notice of Intent to Issue in the Reexamination. Thus, this factor weighs against a stay.

III. Conclusion

Petitioner has provided conclusory analysis of certain factors and omitted positions it has taken in its own Petition regarding other factors. In short, Petitioner has failed to carry its burden to show that a stay is warranted. 37 CFR § 42.20(c). As detailed above, seven of the eight factors weigh against Petitioner's requested stay. For these reasons, Monarch respectfully requests that the Board deny the Motion.

Dated: August 26, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a copy of the foregoing PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION TO STAY EX PARTE REEXAMINATION CONTROL NO. 90/015,315 was served via email to lead and backup counsel of record for Petitioner as follows:

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