

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.,
Petitioner,

v.

MONARCH NETWORKING SOLUTIONS LLC,
Patent Owner.

U.S. Patent No. 8,693,369

“Method of Routing a Data Packet in a Network and an Associated Device”

IPR2024-00175

**PETITIONER’S REPLY IN SUPPORT OF ITS MOTION TO STAY
EX PARTE REEXAMINATION CONTROL NO. 90/015,315**

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Cases

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<i>NetNut Ltd. v. Bright Data Ltd.</i> , IPR2021-01492 (P.T.A.B. Apr. 7, 2022), Paper 14	4
<i>Nintendo Co. v. Ancora Techs., Inc.</i> , IPR2021-01338 (P.T.A.B. Apr. 1, 2022), Paper 16	4
<i>Nintendo Co. v. Ancora Techs., Inc.</i> , IPR2021-01338 (P.T.A.B. Apr. 26, 2022), Paper 18	3
<i>Samsung Elecs. Co. v. Power2B Inc.</i> , IPR2022-00334 (P.T.A.B. Dec. 22, 2022), Paper 20	4
<i>Toshiba Memory Corp. v. Anza Tech., Inc.</i> , IPR2018-01597 (P.T.A.B. June 28, 2019), Paper 37	4

Other Authorities

MPEP § 1204	3
MPEP § 2273	3
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PETITIONER'S EXHIBIT LIST

EX1036	<i>Ex Parte</i> Reexamination Filing Data, USPTO (Sept. 2023), available at https://www.uspto.gov/sites/default/files/documents/ex_parte_historical_stats_.pdf
EX1037	Reexamination Statistics, USPTO (June 2024), available at https://www.uspto.gov/sites/default/files/documents/reexamination-op-stats.pdf
EX1038	<i>Juniper Networks, Inc. v. Monarch Networking Sol'ns LLC</i> , IPR2024-00565 (P.T.A.B. Aug. 26, 2024), Paper 14

I. All Factors: Patent Owner Ignores the Decisions That Support a Stay

Patent Owner addresses only one of the nine decisions that Petitioner discussed in support of its motion. The eight decisions that PO ignores show that a stay is warranted here, and they stand unopposed.

With respect to the lone decision PO addresses, *SpaceTime3D*, it does so only within the context of factor 6. Paper 17 (“Opp.”), at 8–9. The reasoning in *SpaceTime3D* supports a stay even if the facts are different because this IPR will likely resolve before the EPR. *See infra* § IV.

II. Factor 2: Patent Owner Does Not Deny That References Are Similar

PO’s opposition is non-responsive to Petitioner’s factor 2 argument. PO argues only that the **grounds** in the IPR and Unified Patents EPR are different, Opp. 3–5, but factor 2 asks “whether the same grounds of unpatentability **or the same prior art** are at issue in both proceedings,” Notice, 84 Fed. Reg. at 16,657 (emphasis added). Petitioner pointed out it had “raised additional references in this IPR” and therefore the grounds between the two examinations are not exactly the same. Mot. 12. Petitioner, however, showed that this factor weighs in favor of a stay because of the similarity of the overlapping grounds and **prior art references**. Mot. 7–8.

PO concedes that it previously admitted the Fangman and Biswas references are similar, but PO asserts the Board rejected its prior admissions. Opp. 3. Not true; the Board simply explained that the **grounds** were not identical because “the

reexamination does not involve consideration of the teachings of Kumar,” but concluded that “both proceedings rely on Fangman, and the two Biswas *references* are similar.” Paper 12, at 28 (emphasis added). PO then asserts that Petitioner is “manipulat[ing] the Reexamination to its benefit.” Opp. 3. Also not true; Petitioner’s arguments here are consistent with its petition. In both filings, Petitioner noted that “Biswas I and Biswas II are different patents,” but Petitioner further explained here that they concern similar subject matter, which PO does not deny. Mot. 7. Thus, “[a]t least one of the references” is being considered in both proceedings, and this factor favors stay. *BMW*, IPR2023-01373, Paper 15, at 4.

III. Factor 4: There Is a Potential for Inconsistent Results

PO implies that there is not “a single issue with the potential to result in inconsistent results.” Opp. 6. But even if past “conclusions reached by the Examiner [we]re consistent with the findings [the Board] made in [its] institution decision,” this factor still weighs in favor of a stay when the potential for future inconsistent results exists. *Hope Med.*, IPR2022-00123, Paper 11, at 6. Here, the potential for inconsistent results exists because the Board and Examiner are analyzing similar references. Mot. 9.

IV. Factors 3–8: Patent Owner’s Speculation About Trial Timelines and Petitioner’s Motivations Is Incorrect

PO incorrectly argues that the Unified Patents EPR is at a “late stage” and will resolve soon because a final action is forthcoming. *See* Opp. 2, 6–10. PO provides

no support for this conclusory assertion and fails to note that it attached nearly 2,000 pages in non-patent literature to its recent response to the non-final office action. There is also no guarantee that a final action will resolve the EPR. If the Examiner maintains the rejection, PO would need to appeal the final action, as it did recently in a similar EPR for another patent. Notice of Appeal, Control No. 90/019,246 (Aug. 5, 2024); *see* MPEP §§ 1204, 2273. These are some of the many reasons why the average time from filing an EPR to its conclusion is 25.2 months. EX1036, 2. In light of these statistics, at best, the Unified Patents EPR may conclude in late November 2025 (25 months from the October 23, 2023 filing date).¹ This IPR, on the other hand, will conclude before the statutory deadline of May 8, 2025. PO decries this as “speculation,” Opp. 10, but the Board consistently relies on this so-called “speculation” when analyzing motions to stay. In *Nintendo*, for example, the Board determined that a pending EPR was “not likely to conclude” within two years of filing. *Nintendo*, IPR2021-01338, Paper 18, at 6. Thus, the Unified Patents EPR is still at an early stage and will likely conclude after this IPR.

PO wrongly claims that Petitioner is engaging in a “delay tactic,” but Petitioner’s actions are consistent with those of other petitioners and the Board. In

¹ The Unified Patents EPR is behind the average schedule. The average time from filing to first action is ~6.5 months, EX1037, 2, and here it took 7.5 months.

the cited cases listed in the Table of Authorities in the opening brief, the petitioners moved to stay or the Board *sua sponte* issued a stay ***after*** institution. *BMW*, IPR2023-01373, Paper 15, at 3 (requested *sua sponte* one month after institution); *SpaceTime3D*, IPR2023-00344, Paper 41 (filed nine months after institution); *Samsung*, IPR2022-00334, Paper 20 (filed five months after institution); *Hope Med.*, IPR2022-00123, Paper 11 (ordered *sua sponte* concurrent with institution); *NetNut*, IPR2021-01492, Paper 14, at 2 (requested *sua sponte* two days after institution); *Nintendo*, IPR2021-01338, Paper 16 (filed three months after institution); *G&H*, PGR2021-00078, Paper 17, at 2 (requested *sua sponte* two months after institution); *Lab. Corp.*, IPR2021-00902, Paper 19 (filed two months after institution); *Toshiba*, IPR2018-01597, Paper 37 (filed three months after institution).² In fact, the Board has denied motions to stay as premature when they were filed before institution. *E.g.*,

² Patent Owner cherry picks one prior request to stay that is distinguishable. Opp. 2. Unlike here, the parties in *Chrimar* did not inform the Board of the pending EPR until seven months after institution; the EPR was at a “very advanced stage,” having “concluded with a notice of intent to issue a reexamination certificate”; and the EPR and IPR shared only one reference that “was applied to claims that [we]re not at issue in the instant” IPR. *Juniper Networks, Inc. v. Chrimar Sys., Inc.*, IPR2016-01389 (P.T.A.B. Sept. 12, 2017), Paper 65, at 3–4.

Barn Light Elec. Co. v. Ohai, IPR2017-00145 (P.T.A.B. Feb. 6, 2017), Paper 8, at 5; *Apple Inc. v. Summit 6, LLC*, IPR2015-00686 (P.T.A.B. Mar. 12, 2015), Paper 8, at 2. Petitioner therefore did not “delay” its motion; it followed these decisions.

V. Factors 5 and 8: Patent Owner Intends to Deprive Petitioner of Its Right to Challenge Claims in IPR

Finally, PO reveals its intent to take advantage of the Unified Patents EPR to circumvent the Board's review and prevent Petitioner from challenging any potential new claims in this IPR. Instead of amending the original claims or submitting its amendments in this IPR, PO made the calculated decision to draft new claims in the Unified Patents EPR so that they would “not [be] at issue here and will not be addressed in this proceeding.” Opp. 3. PO's underhanded strategy further underscores the need for a stay: Not only would a decision here simplify issues in the EPR by potentially canceling claims that the Examiner is simultaneously reviewing, but it would also prevent PO from obtaining these new claims, which are not patentably distinct from the original claims at issue here. *See* 37 C.F.R. §42.73(d)(3). The new claims add an arbitrary limitation that “the piece of terminal equipment is connected to a home gateway.” Opp. 7. As the Board in IPR2024-00565 recognized, this “home gateway” term does not overcome the prior art, especially because PO has previously construed “home gateway” to broadly include “*any equipment* for interconnecting a private network and a network operated by a service provider.” EX1038, 28–29. These factors therefore weigh in favor of a stay.

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CERTIFICATE OF SERVICE

The undersigned certifies that the foregoing Petitioner's Reply in Support of Its Motion to Stay *Ex Parte* Reexamination Control No. 90/015,315 was served via e-mail pursuant to 37 C.F.R. §42.6(e) in its entirety to all counsel of record, as follows:

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