

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.,
Petitioner,

v.

MONARCH NETWORKING SOLUTIONS LLC,
Patent Owner.

IPR2024-00175
Patent 8,693,369 B2

Before THU A. DANG, CHARLES J. BOUDREAU, and
NORMAN H. BEAMER, *Administrative Patent Judges*.

BEAMER, *Administrative Patent Judge*.

ORDER
Granting Stay of Reexamination
35 U.S.C. § 315(d)

I. INTRODUCTION

With our authorization, Petitioner filed a Motion to Stay *Ex Parte* Reexamination No. 90/015,315 of U.S. Patent 8,693,369 B2 in view of the presently instituted *inter partes* review of the same patent. Paper 16 (“Motion”).¹ We instituted review May 8, 2024. Paper 12. Patent Owner filed an Opposition to the Motion, and Petitioner filed a Reply. Paper 17 (“Opp.”), Paper 18 (“Reply”).

For the reasons discussed below, we determine that it is appropriate to stay the ’315 Reexamination pending resolution of the instant IPR.

II. LEGAL STANDARDS

The Board may enter an order staying a reexamination proceeding. 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d); 37 C.F.R. § 42.3(a) “[T]he Board ordinarily will stay a [reexamination] where good cause exists.” *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16654, 16,656 (Apr. 22, 2019) (“Notice”). “Good cause for staying a case may exist if, for example, an on-going [IPR] proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in [the reexamination].” *Id.*

¹ The Request For *Ex Parte* Reexamination Of U.S. Patent 8,693,369 was filed October 23, 2023, by a third party, Unified Patents, LLC. Ex. 1035. An Order Granting Request For *Ex Parte* Reexamination issued January 18, 2024. Ex. 2008. A First Office Action issued June 7, 2024, and Patent Owner filed an Amendment and Response to First Office Action on August 7, 2024. Exs. 3001, 3002.

The Board may consider several factors when deciding whether to stay a reexamination, including:

1. whether the claims challenged in the IPR are the same as or depend directly or indirectly from claims at issue in the reexamination;
2. whether the same grounds of unpatentability or the same prior art are at issue in both the IPR and the reexamination;
3. whether simultaneous conducting the reexamination and IPR will duplicate efforts within the Office;
4. whether the reexamination could result in inconsistent results between proceedings;
5. whether amending the claim scope in one proceeding would affect the claim scope in another proceeding;
6. the respective timeline and stage of each proceeding;
7. the statutory deadlines of the reexamination and IPR; and
8. whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

See id. at 16,657.

III. ANALYSIS

1. *Challenged Claims*

On January 18, 2024, the request for *ex parte* reexamination of claims 1–17 of the '369 patent was granted. Ex. 2008, 19. The Petition in the present IPR challenges the same claims. Pet. 1.

Patent Owner's Response to First Office Action in the Reexamination submitted an amendment that added dependent claims 18–33. Motion 3; Opp. 3; Ex. 3002, 9–11. New claims 18–21 add to independent claims 5 and 6 the same limitations that claims 2 and 3 add to independent claim 1 regarding a “secondary destination address.” Ex. 3002, 11. New claim 22

adds to claim 3 the requirement of a “non-transitory computer medium.” *Id.* New dependent claims 23–33 add features related to home gateways. *Id.* at 12.

As the Reexamination includes all of the claims involved in the IPR, and additional dependent claims added in the Reexamination do not appear to add significantly different issues, this factor weighs in favor of a stay.

2. Grounds and Prior Art

As Patent Owner previously pointed out, in the Order granting the Reexamination Request, the Examiner stated that the “ground presented in the reexam request is based on substantially the same prior art that was presented in the IPR[2024-00175] petition.” Prelim. Resp. 40 (citing Ex. 2008, 22).

The First Office Action in the Reexamination rejects claims 1–17 as anticipated by U.S. Patent No. 7,624,195 to Biswas et al. (“Biswas 1”; Ex. 1015). Ex. 3001, 2, 4. Petitioner here challenges claims 7–14, 16, and 17 as obvious in view of U.S. Patent No. 8,019,889 to Biswas et al. (“Biswas 2”; Ex. 1022) and U.S. Patent No. 7,394,809 to Kumar (“Kumar”; Ex. 1023). Pet. 4. Patent Owner has previously stated that Biswas 1 is “heavily related” to Biswas 2 and is “so similar that it expressly refers to the teachings of [Biswas 2] by application number.” Prelim. Resp. 41–42 (citing Ex. 1015, 5:45–50). Petitioner now agrees that the Biswas references are “similar” in that “both disclose assigning port ranges to internal hosts in order to uniquely identify those hosts and mitigate IPv4 address exhaustion.” Motion 7–8.

On the other hand, Patent Owner now relies, in its Opposition, on previous assertions by Petitioner that Biswas 2 “is not part of the same family [Biswas 2], has a different specification, and has a different set of

inventors.” Opp. 2–3 (citing Pet. 76). Indeed, Biswas 1 is relied on by the Examiner as disclosing the critical claim requirement of the use of a “port mask defining a range of port numbers to which the destination port number belongs.” Ex. 3001, 5 (citing Biswas 1, 4:56–60); *see also* Pet. 8 (alleging that Biswas 1 “disclose[s] masks that can be used to define a port range”). In contrast, Petitioner here relies on Kumar, in combination with Biswas 2, for that requirement. Pet. 21–26.

The First Office Action also rejects claims 1–8, 10, 11, and 13–17 as anticipated by U.S. Patent No. 8,363,647 to Fangman et al. (“Fangman 1”). Ex. 3001, 2, 23. Petitioner here challenges claims 1–3, 5, 6, and 15 as obvious in view of U.S. Patent No. 7,068,647 to Fangman et al. (“Fangman 2”; Ex. 1024) and Kumar. Pet. 4. The parties agree that Fangman 1 and Fangman 2 have identical specifications. Motion 7; Prelim. Resp. 41. However, in the Reexamination, the Examiner relies on Fangman 1 for the critical port mask requirement of the claims, whereas Petitioner here relies on Kumar, in combination with Fangman 2, for that requirement. Ex. 3001, 23 (citing Fangman 1, 17:60–18:9); Pet. 43–47.

Although the anticipation grounds of the Reexamination, based on Biswas 1 and Fangman 1, are different from the obviousness grounds of the present IPR, based on Biswas 2 and Fangman 2 in combination with Kumar, the two Biswas references have some common subject matter, and the two Fangman references are identical in all pertinent respects. This somewhat weighs in favor of a stay. Reply 1–2.

3. Duplicative Effort and Inconsistent Results

Given the substantial overlap in claims, the identical Fangman references, and the critical port mask claim requirement at issue in both proceedings, there is a likelihood of duplication of efforts within the Office.

Claim interpretation issues could give rise to inconsistent results. Also, inconsistencies have already surfaced in resolving the issue of whether or not the Fangman references are sufficient, standing alone, to disclose or teach the critical port mask requirement of the claims.

Patent Owner argues that there is little risk of duplicative efforts given that the Examiner has already issued the non-final First Office Action. Opp. 5. However, further Office actions and possible appeals present ample opportunity for duplicative efforts, in addition to the above noted issues regarding the port mask requirement. Therefore, this factor weighs in favor of a stay.

4. Amendments

As noted, Patent Owner has submitted new dependent claims 18–33 in the Reexamination and has the opportunity to submit additional amendments affecting claim scope. Patent Owner argues that further amendments are unlikely and that the new dependent claims are sufficiently patentably distinct so as to not affect the scope of the claims at issue in this IPR. Opp. 6–7. Nonetheless, this factor somewhat favors a stay.

5, 6. Timeline and Statutory Deadlines

The statutory deadline for this IPR is May 8, 2025. Although the Reexamination is to be conducted with “special dispatch,” it is not subject to a specific deadline. 35 U.S.C. § 305. Based on reexamination statistics, Petitioner argues that the Reexamination is not likely to conclude before November 2025. Reply 3. Currently the Examiner is presumably beginning to review Patent Owner’s August 7, 2024 Amendment and Response to First Office Action, and so a stay would avoid the Examiner’s duplicating the Board’s efforts in considering similar issues in responding to Patent Owner’s amendments and remarks. We find that these factors favor a stay.

7. *Simplification*

A final determination in this IPR regarding the patentability of the challenged claims of the '369 patent could simplify issues for the Reexamination given the substantial overlap in the claims at issue and identical Fangman references. This factor favors a stay.

IV. CONCLUSION

We find that the above factors weigh in favor of staying the Reexamination and therefore grant Petitioner's motion to stay the Reexamination.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, Petitioner's motion to stay *Ex Parte* Reexamination No. 90/015,315 is *granted*; and

FURTHER ORDERED that the Reexamination is stayed pending the termination or completion of IPR2024-00175;

FURTHER ORDERED that this stay tolls all time periods for filing further papers in the Reexamination, and no further papers will be filed or issued from the Office while this stay remains in place. Upon lifting of this stay, the Office will file a paper to reset any applicable time periods.

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