UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC. and FORTINET, INC.,
Petitioner,

v.

INFOEXPRESS INC.,
Patent Owner.

IPR2024-00539
U.S. Patent No. 8,051,460

PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY RESPONSE

Pursuant to the Board's order of July 23, 2024, Petitioner submits this Reply to Patent Owner's Preliminary Response ("POPR") to address the POPR's procedural and substantive deficiencies regarding the alleged priority date of U.S. Patent No. 8,051,460 (the "Challenged Patent"). And even if those deficiencies did not exist, the evidence identified by Patent Owner ("PO") in support of its arguments, at a minimum, raises disputed issues of material fact that require further discovery and the benefit of a full trial record. For each of the reasons explained below, the Board should reject PO's arguments that the Challenged Patent is entitled to an earlier priority date.

I. Patent Owner's Arguments Regarding Conception, Diligence, and Reduction to Practice are Improperly Incorporated by Reference

The POPR contains no analysis related to the conception of any claim element in relation to the alleged conception documents. Instead, PO asserts that "conception is demonstrated in the claim chart mapping by Dr. Smith showing the LAN Engineering Specification mapped to the challenged claims as set forth in EX2009. EX2007." 460-POPR, 31. The POPR thus incorporates by reference the entirety of Exhibit 2009 (a 28-page claim chart) and the entirety of Exhibit 2007 (a 17-page declaration) to support its arguments attempting to establish a conception date.

Similarly, the POPR contains no analysis related to the reduction to practice of any claim element in relation to the provisional applications underlying the

Challenged Patent. Like its arguments on conception, PO asserts that constructive reduction to practice is shown "[a]s set forth in EX2010 and discussed by Prof. Smith (EX2007)." 460-POPR, 40. The POPR thus incorporates the entirety of Exhibit 2010 (a 57-page claim chart) and again, the entirety of Exhibit 2007 (a 17-page declaration) to support its arguments attempting to establish a reduction to practice date.

The Trial Practice Guide explains that "parties that incorporate expert testimony by reference in their petitions, motions, or replies without providing an explanation of such testimony risk having the testimony not considered by the Board." TPG 35–36 (citing C*isco Sys., Inc. v. C-Cation Techs., LLC,* IPR2014-00454, Paper 12 (PTAB Aug. 29, 2014) (informative)); *see also* 37 C.F.R. § 42.6(a)(3) (2022) ("Arguments must not be incorporated by reference from one document into another document.") As in *Cisco Systems*, PO here "serves to circumvent the page limits imposed on" it "while imposing on [the Board's time] by asking [it] to sift through" dozens of pages to declarations and claim charts. *Id.,* at 10; *see also Sensor Electronic Technology, Inc. v. Lite-On Technology Corporation et al*, IPR2022-00406, Paper 8 at 15-16 (PTAB Jul. 14, 2022) ("Because Patent Owner's arguments and evidence on prior reduction to practice are presented in the inventor's declaration, but not substantively presented in the Preliminary Response, **we do not consider those arguments and evidence**.");

Google LLC v. Parus Holdings, Inc., IPR2020-00846, Paper No. 31 at 13–16 (PTAB Oct. 19, 2021) (similar holding); *General Access Sols., Ltd. v. Sprint Spectrum L.*P., 811 F. App'x 654, 658 (Fed. Cir. 2020) ("This exercise of 'playing archaeologist with the record' is precisely what the rule against incorporation by reference was intended to prevent, 77 Fed. Reg. 48,617, and the Board was within its discretion in excluding the arguments made in the claim chart.") Because the POPR improperly incorporates by reference most of its arguments and evidence on these topics, the Board need not consider them.

II. Patent Owner's Evidence is Not Authenticated

The only evidence offered to establish the authenticity of the more than 200 documents submitted with the POPR (including more than 200 emails) is testimonial evidence from inventor Stacy Lum. *See* EX2003, ¶24. However, "[i]nventor testimony is not sufficient to authenticate a document offered to corroborate the inventor's testimony. The purpose of corroboration is to prevent fraud by providing independent confirmation of the inventor's testimony. A document authenticated by only an inventor does not achieve that purpose because it is not sufficiently independent." *Microsoft Corp. v. Surfcast, Inc.,* IPR2013-00292, Paper 93 at 16-17(PTAB Oct. 14, 2014) (citing *Kridl v. McCormick,* 105 F.3d 1446, 1449 (Fed. Cir. 1997)). Because PO's purported evidence does not comply with Federal Rules of Evidence, the evidence should be excluded or given

little to no weight, and Petitioner will formally object to this evidence upon institution pursuant to 37 CFR § 42.64(b)(1).

III. The Inventor's Testimony is Not Independently Corroborated

Mr. Lum's testimony as to conception, diligence, and reduction to practice "must be corroborated by independent evidence." *Cooper v. Goldfarb*, 154 F.3d 1321, 1330 (Fed. Cir. 1998). The requirement of "independent" corroboration requires evidence other than the inventor's testimony. *In re NTP, Inc.*, 654 F.3d 1279, 1291 (Fed. Cir. 2011). There is no **independent** corroboration here because the only evidence in the record are files the inventor purportedly recovered from his personal archives. *Id.* at 1293 (Fed. Cir. 2011) ("[T]his falls into the circular logic of using the files to corroborate the testimony and the testimony to corroborate the files"); *Apator Miitors APS v. Kamstrup A/S*, 887 F.3d 1293, 1297 (Fed. Cir. 2018) ("Mr. Drachmann's unwitnessed emails and drawings, alone, cannot corroborate his testimony of conception.").

IV. The POPR Raises Disputed Issues of Material Fact that Require Further Discovery

PO's arguments and evidence raise several disputed issues of material fact with respect to the Challenged Patent's priority date that cannot be resolved prior to institution and would benefit from a full trial record. For example:

(1) Whether the alleged conception documents—which have no indication of authorship—demonstrate the complete "formation of an idea in the mind[s] of the

inventor[s]." *Burroughs Wellcome Co. v. Barr Labs., Inc.,* 40 F.3d 1223, 1228 (Fed. Cir. 1994). Apart from appearing to comprise two distinct inventions (including one apparent prior art device, *see* EX2013), the alleged conception documents give no indication of **who,** *i.e.,* which inventor, conceived of the purported inventions or whether they were conceived as a single complete and operative invention rather than a compilation of ideas from the company. But **InfoExpress Inc**., the only party identified on the alleged conception documents, cannot form ideas in **its** mind. *New Idea Farm Equipment Corp. v. Sperry Corp.,* 916 F.2d 1561, 1566 n. 4 (Fed. Cir. 1990) (recognizing that people conceive, not companies); *see also Froson v. W. Litho Plate & Supply Co.,* 853 F.2d 1568, 1575 (Fed. Cir. 1988) ("Corporations don't invent; people do.") (overturned on other grounds). Indeed, Mr. Lum does not even assert that he (or inventor Lee) authored EX2011, an alleged conception document—instead, he states that "InfoExpress personnel drafted EX2011." EX2003, ¶22. Further, the metadata provided by PO only identifies an unnamed "software developer" as being the last to edit EX2011.

(2) Whether the alleged conception documents describe every element of the challenged claims, including whether the alleged conception documents disclose the concept of a less-restricted network. *REG Synthetic Fuels, LLC v. Neste Oil Oyj*, 841 F.3d 954, 962 (Fed. Cir. 2016) ("Conception must include every feature or limitation of the claimed invention.").

(3) Whether the documents that PO alleges show diligence in reducing the invention to practice demonstrate the required **reasonably continuous** diligence or whether they instead show delays "caused by an inventor's efforts to refine an invention to the most marketable and profitable form," which the Federal Circuit has held "have not been accepted as sufficient excuses for inactivity." *Griffith v. Kanamaru*, 816 F.2d 624, 627 (Fed. Cir. 1987).

(4) Whether there is an explanation for the numerous and lengthy gaps (some several weeks long) that exist in the nearly one-year alleged diligence period and whether such inactivity constitutes unreasonable delay. Indeed, at least one email identified by Mr. Lum appears to include a concession of unreasonable delay as it states that "we dragged [the license agreement] out for about 3 months now." *See* Ex2036, 1.

(5) The origin and authenticity of the more than two hundred exhibits filed to support the alleged date of conception and reasonably continuous diligence that were not produced in the parallel litigation despite PO's requirement to do so. For example, Mr. Lum admits that InfoExpress had these relevant documents before this case was filed, as they were maintained on "InfoExpress's e-mail and file servers." EX2003, ¶24. Mr. Lum also states that he provided many of the e-mails cited in InfoExpress's POPRs from his personal archives. *Id.* However, in the parallel district court litigation, InfoExpress was required to produce all of its

relevant alleged conception, diligence, and reduction to practice documents pursuant to the Local Rules. For example, Patent L.R. 3-2(b) required that InfoExpress produce "[a]ll documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit or the priority date identified pursuant to Patent L.R. 3-1(f)" by October 3, 2023. Yet, InfoExpress did not produce these emails in the district court litigation, and Cisco has only been able to see and consider them now. In addition, numerous of the e-mails filed by PO are either incomplete e-mail chains, *e.g.,* EX2024, EX2025, EX2074, EX2078, EX2081, EX2082, EX2083, EX2084, or fail to include documents purported to be attached, *e.g.,* EX2098, EX2104, EX2142, EX2219.

At the very least, these disputed issues of material fact should be explored following institution, including through cross-examination of each of PO's three declarants. *Nespresso USA Inc. v. K-Fee System GMBH,* IPR2023-0485, Paper 9 at 15 fn10 (PTAB Sept. 13, 2023) (finding "at most, the parties identify a material issue of fact" related to whether a priority document disclosed two claim elements)*; Canon USA Inc. et al v. Slingshot Printing LLC,* IPR2022-01541, Paper 7 at 15 (PTAB May 22, 2023) ("[A]t a minimum, we are left with a disputed issue of material fact . . . that is best resolved on a full trial record.").

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Respectfully Submitted,

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Certificate of Service

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 30th day of July, 2024, I caused to be served a true and correct copy of the via electronic service on the following:

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