

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC. and FORTINET, INC.,
Petitioners,

v.

INFOEXPRESS INC.,
Patent Owner.

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

PATENT OWNER'S MOTION FOR ADDITIONAL DISCOVERY

Exhibit Number	Description
2001	Declaration of Dr. Eric Cole
2002	Curriculum Vitae of Dr. Eric Cole
2003	Declaration of Stacey C. Lum
2004	Diligence Calendar
2005	U.S. Provisional App. No. 60/505,582
2006	U.S. Provisional App. No. 60/513,080
2007	Declaration of Hugh Smith, Ph.D.
2008	Curriculum Vitae of Hugh Smith, Ph.D.
2009	Conception of the '484 Patent
2010	Constructive Reduction to Practice of the '484 Patent
2011	LAN Based Policy Enforcement Engineering Specification
2012	Metadata for Exhibit 2011
2013	CyberGatekeeper Policy Manager
2014	Metadata for Exhibit 2013
2015	Internal InfoExpress Correspondence
2016	Internal InfoExpress Correspondence
2017	Internal InfoExpress Correspondence
2018	Internal InfoExpress Correspondence
2019	Internal InfoExpress Correspondence
2020	Internal InfoExpress Correspondence
2021	Internal InfoExpress Correspondence
2022	Correspondence with Globe Tech
2023	Email attachment to Exhibit 2022
2024	Internal InfoExpress Correspondence
2025	Correspondence with Meetinghouse
2026	Draft Meetinghouse Agreement
2027	Internal InfoExpress Correspondence
2028	Draft Meetinghouse Agreement
2029	Internal InfoExpress Correspondence
2030	Draft Meetinghouse Agreement
2031	Draft Meetinghouse Agreement
2032	Internal InfoExpress Correspondence
2033	Draft Meetinghouse Agreement
2034	Draft Meetinghouse Agreement
2035	Draft Meetinghouse Agreement
2036	Internal InfoExpress Correspondence
2037	Draft Meetinghouse Agreement

Exhibit Number	Description
2038	Draft Meetinghouse Agreement
2039	Internal InfoExpress Correspondence
2040	Draft Meetinghouse Agreement
2041	Draft Meetinghouse Agreement
2042	Draft Meetinghouse Agreement
2043	Draft Meetinghouse Agreement
2044	Internal InfoExpress Correspondence
2045	Draft Meetinghouse Agreement
2046	Draft Meetinghouse Agreement
2047	Internal InfoExpress Correspondence
2048	Correspondence with Globe Tech
2049	Correspondence with Globe Tech
2050	Internal InfoExpress Correspondence
2051	Correspondence with Globe Tech
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2054	Correspondence with Globe Tech
2055	Correspondence with Globe Tech
2056	Draft Globe Tech Agreement
2057	Draft Globe Tech Agreement
2058	Draft Globe Tech Agreement
2059	Draft Globe Tech Agreement
2060	Draft Globe Tech Agreement
2061	Draft Globe Tech Agreement
2062	Draft Globe Tech Agreement
2063	Correspondence with Globe Tech
2064	Draft Globe Tech Agreement
2065	Correspondence with Globe Tech
2066	Network Device Configuration API Engineering Specification
2067	Correspondence with Globe Tech
2068	Correspondence with Globe Tech
2069	Network Device Configuration API Engineering Specification
2070	Network Device Configuration API Engineering Specification
2071	Correspondence with Globe Tech
2072	Network Device Configuration API Engineering Specification
2073	Network Device Configuration API Engineering Specification
2074	Correspondence with Globe Tech

Exhibit Number	Description
2075	Correspondence with Globe Tech
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2079	Email attachment to Exhibit 2078
2080	Correspondence with Globe Tech
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2107	Correspondence with Globe Tech
2108	Internal InfoExpress Correspondence
2109	Correspondence with Globe Tech
2110	Correspondence with Globe Tech
2111	Correspondence with Globe Tech

Exhibit Number	Description
2112	Correspondence with Globe Tech
2113	Internal InfoExpress Correspondence
2114	Correspondence with Globe Tech
2115	Email attachment to Exhibit 2114
2116	Correspondence with Globe Tech
2117	Internal InfoExpress Correspondence
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2119	Correspondence with Globe Tech
2120	Correspondence with Globe Tech
2121	Correspondence with Globe Tech
2122	Correspondence with Globe Tech
2123	Correspondence with J. Ong
2124	Correspondence with Globe Tech
2125	Correspondence with Globe Tech
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2145	Correspondence with Globe Tech
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2147	Correspondence with Globe Tech
2148	Correspondence with J. Ong

Exhibit Number	Description
2149	Correspondence with Globe Tech
2150	Correspondence with J. Ong
2151	Correspondence with Globe Tech
2152	Correspondence with J. Ong
2153	Correspondence with Globe Tech
2154	Correspondence with Globe Tech
2155	Correspondence with Globe Tech
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2161	Correspondence with J. Ong
2162	Correspondence with Globe Tech
2163	Correspondence with C. Tsai
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2165	Correspondence with Globe Tech
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2168	Correspondence with Globe Tech
2169	Correspondence with Globe Tech
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2188	Correspondence with Globe Tech
2189	Correspondence with C. Tsai
2190	Correspondence with Globe Tech
2191	Correspondence with Globe Tech
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2197	Correspondence with Globe Tech
2198	Correspondence with J. Ong
2199	Correspondence with C. Tsai
2200	Correspondence with J. Ong
2201	Cisco Switch Feature Support Matrix
2202	Correspondence with M. Banin
2203	Correspondence with A. Lee
2204	Correspondence with M. Banin
2205	Correspondence with M. Banin
2206	Correspondence with M. Banin
2207	Correspondence with M. Banin
2208	Correspondence with M. Banin
2209	Correspondence with M. Banin
2210	Correspondence with M. Banin
2211	Correspondence with patent counsel
2212	Correspondence with patent counsel
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Exhibit Number	Description
2223	Correspondence with patent counsel
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2227	Correspondence with patent counsel
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2259	Correspondence with patent counsel

Exhibit Number	Description
2260	Correspondence between S. Lum and A. Lee
2261	Correspondence between S. Lum and A. Lee
2262	Correspondence with patent counsel
2263	Correspondence with patent counsel
2264	Correspondence with patent counsel
2265	Correspondence with patent counsel
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Exhibit Number	Description
2408	Intentionally left blank
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2411	Tim Greene, <i>InfoExpress Simplifies Security Devices</i> , NetworkWorld (Dec. 6, 2004), available at https://www.networkworld.com/article/875004/lan-wan-infoexpress-simplifies-security-devices.html
2412	InfoExpress's Objections and Responses to Cisco's First Set of Interrogatories (Nos. 1-12), served in <i>InfoExpress Inc. v. Cisco Systems, Inc.</i> , Case No. 4:23-cv-2698-YGR (N.D. Cal.).
2413	Cisco Systems, Inc., <i>Network Admission Control White Paper</i> (2004).
2414	Correspondence with Cisco
2415	Email attachment to EX2414
2416	Correspondence with Cisco
2417	Email attachment to EX2416
2418	Correspondence with Cisco
2419	Correspondence with Cisco
2420	Correspondence with Cisco and KeyLabs
2421	Email attachment to EX2420
2422	Correspondence with Cisco
2423	Correspondence with Cisco
2424	Email attachment to EX2423
2425	Excerpt from InfoExpress Inc.'s Disclosure of Asserted Claims and Infringement Contentions per Patent L.R. 3-1 and 3-2, Exhibit B, served in <i>InfoExpress Inc. v. Cisco Systems, Inc.</i> , Case No. 4:23-cv-2698-YGR (N.D. Cal.).

I. Introduction

Further to the Board’s remarks at the conference on December 5, 2024, and its email to counsel, EX3001, Patent Owner InfoExpress moves for additional discovery. As detailed more fully below, since 2004, InfoExpress has sold its own product, the CyberGatekeeper LAN (“CG LAN”), which embodies the claims of the ‘460 Patent.

During 2004 to 2007, InfoExpress and Petitioner Cisco had a business relationship. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED] After the parties’ relationship ended, Cisco launched its own products, which contained features similar to the CG LAN. Or, to put it bluntly, Cisco copied the CG LAN.

InfoExpress now seeks discovery regarding Cisco’s copying of InfoExpress’s products and technical information. The Federal Circuit deems this type of copying as “strong evidence” of nonobviousness. *Panduit Corp. v. Dennison Mfg. Co.*, 774 F.2d 1082, 1099 (Fed. Cir. 1985). The discovery that InfoExpress seeks is legally meaningful, yet narrowly tailored; InfoExpress only seeks two requests for production and three interrogatories. Addendum 1; Addendum 2. The Board should allow this specific, limited discovery here, just as

it has in similar cases where the petitioner had access to the patent owner's product. *E.g., Brunswick Corp. v. Volvo Penta of the Ams., LLC*, IPR2020-01512, Paper No. 25 (PTAB May 12, 2021).

II. Factual Background

A. Between 2004 and 2007, InfoExpress sent to Cisco the CG LAN software and technical presentations on it.

InfoExpress first sold its network access control (“NAC”) product, the CyberGatekeeper LAN (“CG LAN”), in June 2004. *See* EX2411. The CG LAN embodies the ‘460 Patent, as well as five other of InfoExpress’s patents that are the subject of related IPRs. EX2412 at 16, 22-24. In and around that same time, Cisco launched its *Network Admission Control* product, named Cisco NAC. EX2413 at 4. In late 2004, Cisco launched its NAC Partner Program, and invited InfoExpress and others to join it, which InfoExpress did. *See* EX2414; EX2415.

Over the course of the parties’ relationship, InfoExpress furnished Cisco with the CG LAN software and technical literature describing its functionality. By way of one example, in February 2006, Cisco requested that InfoExpress submit the software for its patented CG LAN product. [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]
[REDACTED]
[REDACTED]
EX2416; *see also* EX2417 (PowerPoint). [REDACTED]

[REDACTED]
[REDACTED] InfoExpress never heard any further details as to what Cisco did with that information.

By way of another example, in March 2005, InfoExpress provided its CG LAN software to Cisco partner KeyLabs to test the CG LAN for interoperability with Cisco NAC. [REDACTED]

[REDACTED]
[REDACTED]
[REDACTED]
[REDACTED] But the trail ran cold with the report. InfoExpress never heard further on what Cisco did upon their “review” of the test report. *See id.*

B. Record evidence already suggests Cisco’s copying.

InfoExpress never learned what exactly Cisco did with the information concerning the CG LAN. To date, that information is known only to Cisco, and is the subject of the present motion. However, what InfoExpress *did* know was that Cisco openly praised InfoExpress’s CG LAN, [REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

[REDACTED]

Now, the parties are also engaged in a district court litigation, where InfoExpress alleges that Cisco’s present NAC product, Identity Services Engine (“ISE”), of infringing the ‘460 Patent (among others). ISE contains features that resemble CG LAN. For instance, Cisco’s ISE has the ability to check the endpoint device for “the latest OS patch, antivirus and antispyware packages with current definition file variables (version, date, etc.), . . . registry settings (key, value, etc.).” EX2425 at 59. [REDACTED]

[REDACTED]

III. Argument

In this IPR, Petitioners' two grounds are both premised on obviousness. Paper No. 1 at, *e.g.*, i-vi. InfoExpress seeks information relating to an objective indicum of nonobvious—copying. InfoExpress has shown evidence of Cisco's copying. Yet what Cisco did with InfoExpress's information regarding its CG LAN is known only to Cisco; thus the additional discovery sought is the only way to obtain it. Thus the discovery is "necessary in the interest of justice."

A. Legal Standard—The *Garmin* Test

The Board may grant additional discovery where necessary "in the interests of justice." 37 C.F.R. § 42.51(b)(2)(i). In assessing additional discovery, the Board applies the five-factor *Garmin* test in assessing "necessary in the interest of justice." *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6-7 (PTAB Mar. 5, 2013). These are (1) whether there exists more than a possibility and mere allegation that something useful will be discovered; (2) whether the requests seek the other party's litigation positions and the underlying basis for those positions; (3) whether the moving party has the ability to generate equivalent information by other means; (4) whether the moving party has provided easily understandable instructions; and (5) whether the requests are overly burdensome to answer. *Id.*

B. There is more than a possibility or mere allegation that the requested discovery will yield useful information.

“Evidence of copying may include internal documents, direct evidence such as photos of patented features or disassembly of products, or *access and similarity* to a patented product.” *Liqwd, Inc. v. L’Oreal USA, Inc.*, 941 F.3d 1133, 1137 (Fed. Cir. 2019). As for Cisco’s access, as shown above, it cannot be disputed that Cisco had access to information on InfoExpress’s CG LAN, including literature and the product software itself. *Supra*, Section II.A. As to similarity, InfoExpress set out above (Section II.B) at least a “threshold showing as to similarities” in line with what the patent owner Volvo showed in *Brunswick* at 7-8.¹ Even more, InfoExpress showed further evidence of Cisco’s copying, [REDACTED]

[REDACTED]

[REDACTED] Thus, InfoExpress has shown more than what Volvo did in *Brunswick*, and the Board should find this factor favors InfoExpress.

C. InfoExpress does not seek Cisco’s litigation positions or their underlying basis.

¹ InfoExpress has adequately shown its CG LAN embodies the ‘460 Patent for this stage of the proceedings, and to the extent Cisco argues otherwise, the Board should reject it. *See Brunswick*, at 5 (patent owner’s pleadings established nexus for purposes of additional discovery).

None of the proposed discovery seeks Cisco's litigation positions or their underlying basis. This second factor also favors InfoExpress.

D. InfoExpress cannot generate equivalent information by other means.

The third *Garmin* factor also favors InfoExpress as the discovery requests narrowly target non-public information that is otherwise unavailable.

E. InfoExpress's requests are easily understandable and not overly burdensome.

The fourth and fifth *Garmin* factors also favor InfoExpress. The document requests are limited to a narrow three-year timeframe; they are easily investigated by keyword searching for terms like "InfoExpress" and "CyberGatekeeper" or "CG LAN." Moreover, InfoExpress provided with the discovery requests samples of its correspondence with Cisco, which at least give Cisco custodians from which to begin their search. Similar can be said for the interrogatories: Cisco is now aware of the specific information that was furnished to Cisco, as well as a few key communications describing it. Cisco cannot reasonably claim that they cannot understand these requests.

To the extent Cisco argues that the searching for documents and information from twenty years ago is overly burdensome (as Cisco suggested at the conference), the Board should reject this. Such an argument is premature here, where the issue is allowing service of the requests, not Cisco's response. After all,

Cisco could have agreed at the outset to allow InfoExpress's requests, searched for relevant documents and information, and, if it came up empty-handed, stated so in its responses. Cisco can *still* respond so—should they come up empty handed after diligent, good faith investigation. But the age of the information should not a ground for denying InfoExpress's requests at the very outset.

Last, Cisco has made the point that InfoExpress was untimely in proposing its discovery request on November 1, 2024. To the extent this is relevant to this factor, the Board should reject this argument. That date was just one week and one day after the Board instituted the last three of Petitioners' IPR challenges to InfoExpress's patents. *Cisco Systems, Inc. v. InfoExpress Inc.*, IPR2024-00675, Paper Nos. 14, 15 (PTAB Oct. 23, 2024). Indeed, this discovery relates equally to these petitions as well. By that measure, InfoExpress was not untimely; it was waiting to see whether other challenges were going forward, and thus whether it would be worth the parties' and the Board's effort and time for it to seek discovery. Moreover, the Board has authorized additional discovery when the proposal was initiated further after institution. *Assoc'd British Foods PLC v. Cornell Res. Found.*, IPR2019-00577, Paper 44 at 10-11 (PTAB Oct. 4, 2019).

IV. Conclusion

For these reasons, InfoExpress respectfully requests that the Board grant its motion for additional discovery.

Respectfully submitted,

Dated: December 9, 2024 Mailing address for all correspondence: Saul Ewing LLP Centre Square West 1500 Market Street, 38th Floor Philadelphia, PA 19102-2186	<u>/Brian R. Landry/</u> Brian R. Landry (Reg. No. 62,074) Saul Ewing LLP 131 Dartmouth Street, Suite 501 Boston, MA 02116 Tel: (617) 912-0969 Brian R. Michalek (Reg. No. 65,816) Saul Ewing LLP 161 North Clark Street, Suite 4200 Chicago, IL 60601 Tel: (312) 876-7151 Joseph M. Kuo (Reg. No. 38,943) Saul Ewing LLP 161 North Clark Street, Suite 4200 Chicago, IL 60601 Tel: (312) 876-7151 Counsel for Patent Owner
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Certification of Service Under 37 C.F.R. § 42.6(e)(4)

The undersigned hereby certifies that the foregoing was served in its entirety by filing through the Patent Trial and Appeal Board P-TACTS, as well as providing a courtesy copy via e-mail to the attorneys of record.

Date: December 9, 2024

/Brian R. Landry/
Reg. No. 62,074

ADDENDUM

[Part 1]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC. and FORTINET, INC.,
Petitioners,

v.

INFOEXPRESS INC.,
Patent Owner.

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

PATENT OWNER'S REQUESTS FOR PRODUCTION

Patent Owner InfoExpress Inc. hereby requests that Petitioner Cisco Systems, Inc. respond to the following requests for production (the “Requests and, each, a “Request”) within 30 days of service in accordance with the following Definitions and Instructions.

I. Instructions

1. In producing documents or other information responsive to these Requests for Production (“RFPs”), Petitioner is to comply with the Board’s Scheduling Order and any other Board order in this proceeding, and the instructions in the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019).

2. If Petitioner finds the meaning of any term in any RFP unclear, Petitioner should assume a reasonable meaning, state what the assumed meaning is, and produce documents and things or provide information on the basis of that assumed meaning.

3. For any document responsive to a RFP that Petitioner withholds on the basis of privilege, Petitioner shall provide a privilege log identifying the document’s date, author(s), recipient(s), subject matter, and the basis of the asserted privilege.

II. Definitions

The follow definitions shall apply to the RFPs below:

1. “CyberGatekeeper LAN” means InfoExpress’s out-of-band NAC product, which InfoExpress first sold in June of 2004, and any components thereof.

III. Requests for Production

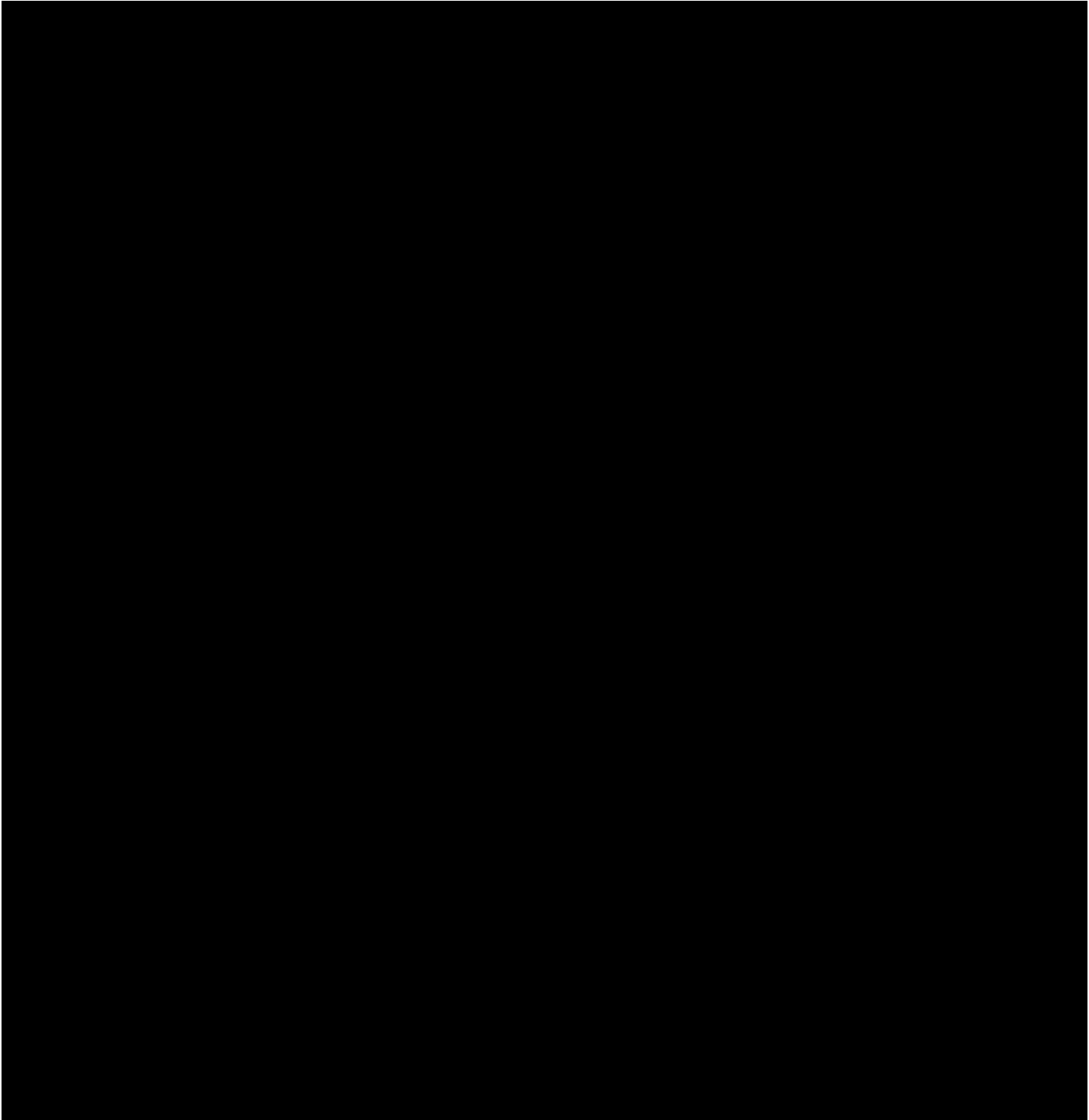
RFP No. 1: Documents dated between January 1, 2005, and December 31, 2008, and that reference InfoExpress and/or the CyberGatekeeper LAN.

RFP No. 2: Documents dated between January 1, 2005, and December 31, 2008, showing any analyses of the CyberGatekeeper LAN, its components (including its agent), and/or any information relating to the CyberGatekeeper LAN, including any analyses of the information that is referenced in Appendices 1 and 2.

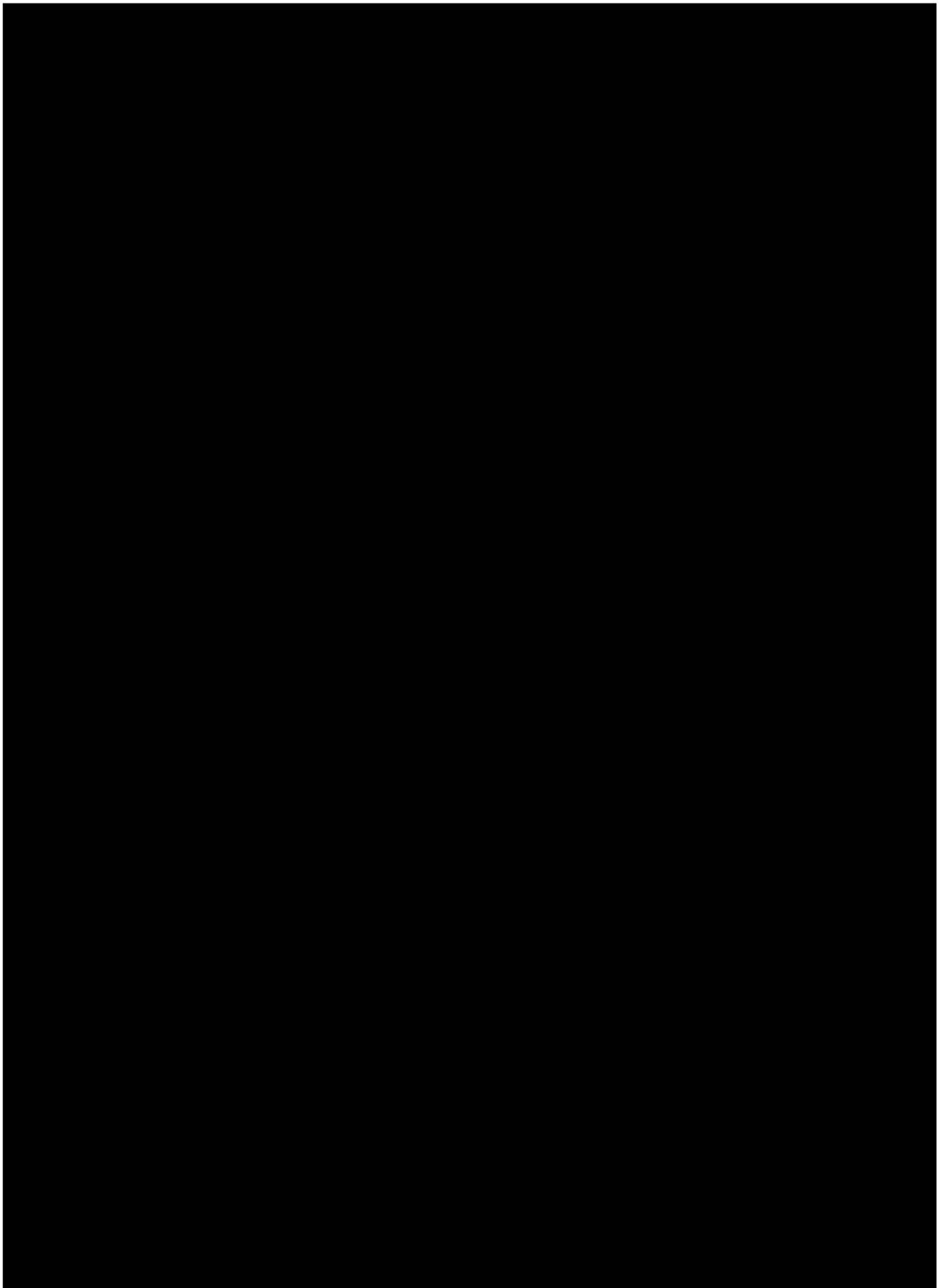
Respectfully submitted,

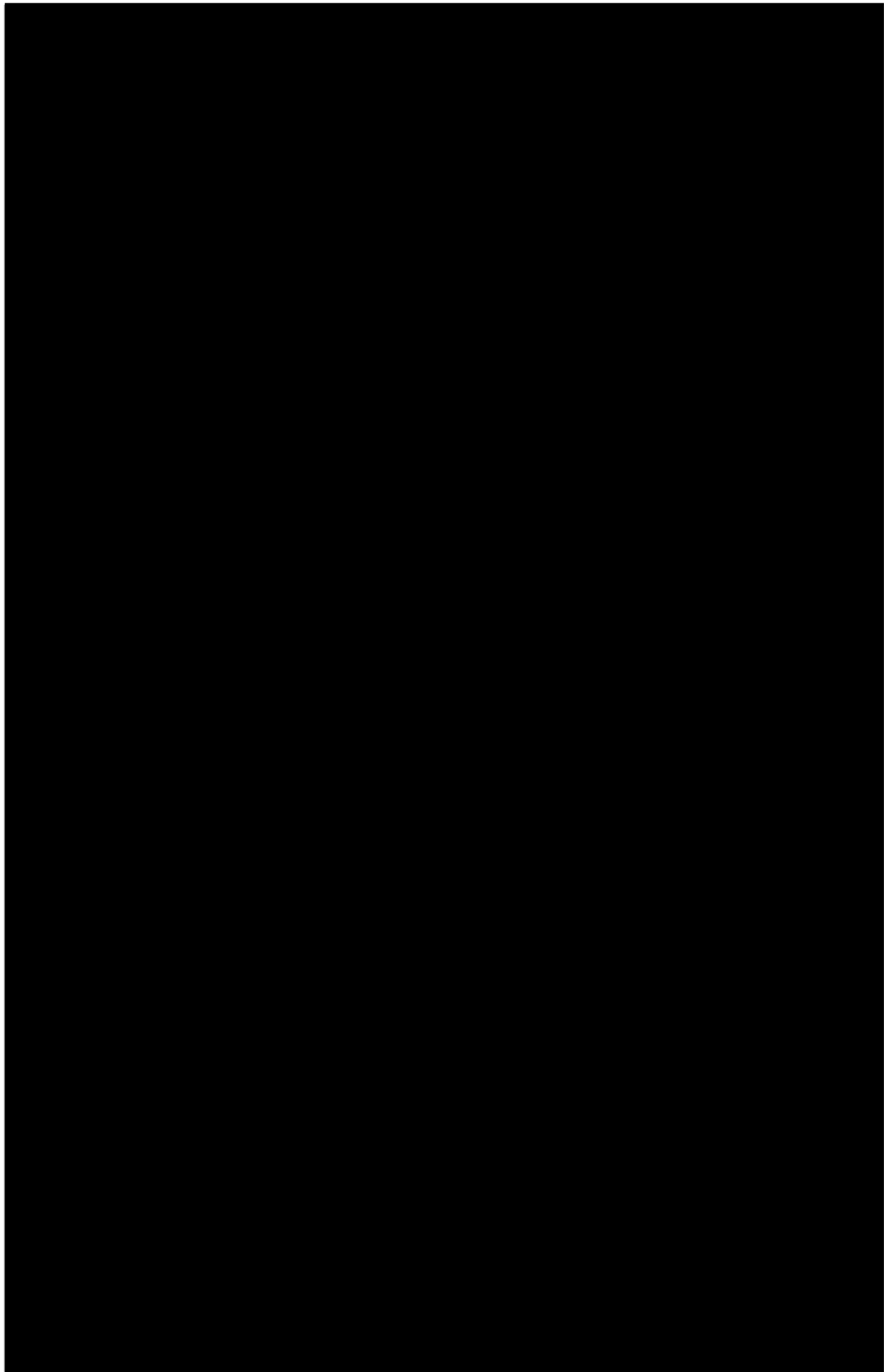
Dated: DATE Mailing address for all correspondence: Saul Ewing LLP Centre Square West 1500 Market Street, 38th Floor Philadelphia, PA 19102-2186	<u>/s/ [DRAFT]</u> Joseph M. Kuo (Reg. No. 38,943) Saul Ewing LLP 161 North Clark Street, Suite 4200 Chicago, IL 60601 Tel: (312) 876-7151 Brian R. Michalek (Reg. No. 65,816) Saul Ewing LLP 161 North Clark Street, Suite 4200 Chicago, IL 60601 Tel: (312) 876-7151 Brian Landry (Reg. No. 62,074) Saul Ewing LLP 131 Dartmouth Street, Suite 501 Boston, MA 02116 Tel: (617) 912-0969 <i>Counsel for Patent Owner</i>
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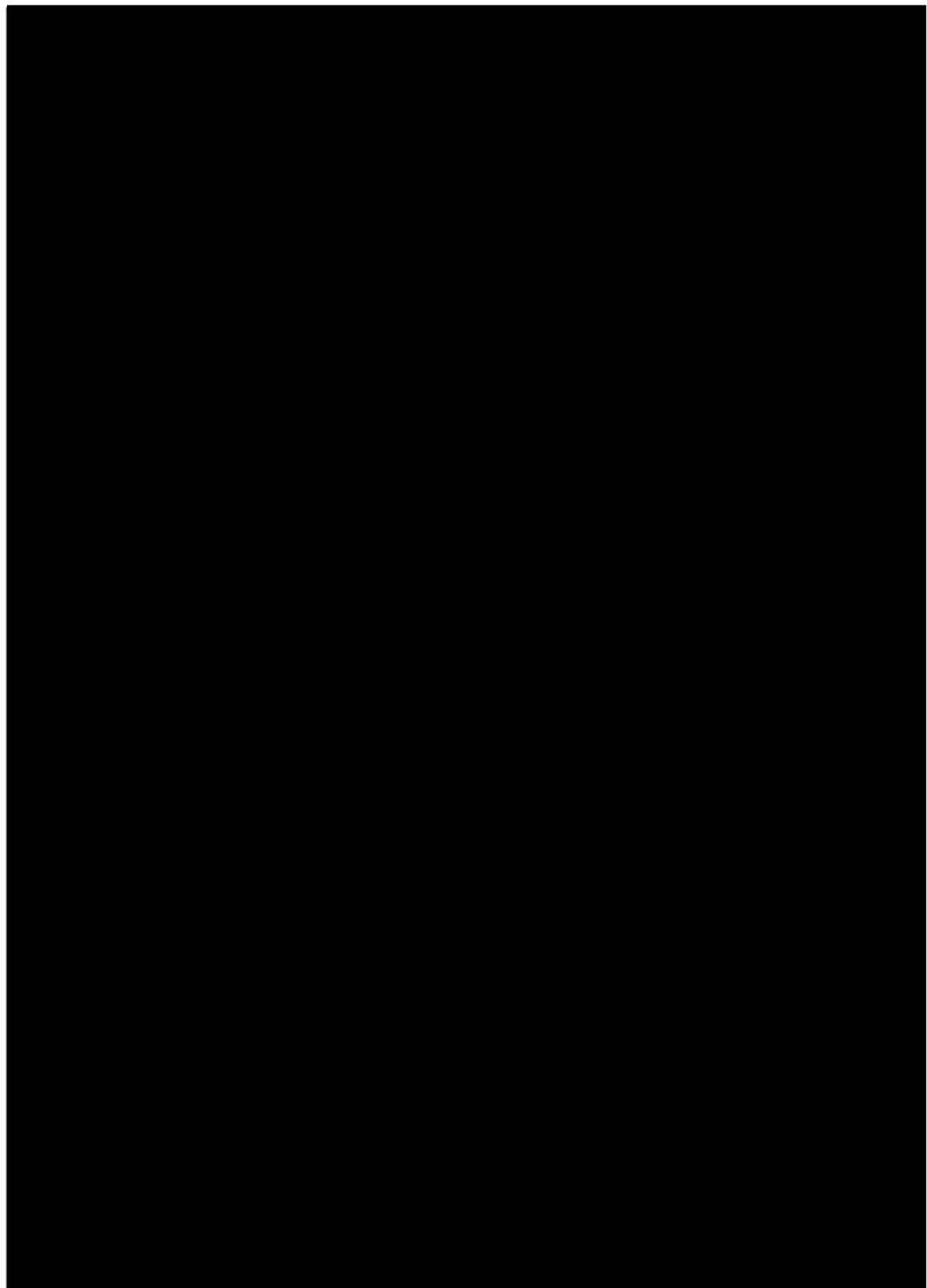
Appendix 1



Appendix 2







Appendix 3

Message

HIGHLY CONFIDENTIAL—ATTORNEYS' EYES ONLY

ADDENDUM

[Part 2]

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC. and FORTINET, INC.,
Petitioners,

v.

INFOEXPRESS INC.,
Patent Owner.

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

PATENT OWNER'S INTERROGATORIES

Pursuant to Federal Rule of Civil Procedure 36 and the Patent Trial and Appeal Board Consolidated Trial Practice Guide, Patent Owner InfoExpress Inc., Patent Owner InfoExpress Inc. hereby requests that Petitioner Cisco Systems, Inc. respond to the following interrogatories within 30 days of service in accordance with the following Definitions and Instructions.

I. Instructions

1. In responding to these Interrogatories, Petitioner is to comply with the Board's Scheduling Order and any other Board order in this proceeding, and the instructions in the Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019).

2. If Petitioner finds the meaning of any term in any Interrogatory unclear, Petitioner should assume a reasonable meaning, state what the assumed meaning is, and respond on the basis of that assumed meaning.

II. Definitions

The follow definitions shall apply to the Interrogatories below:

1. "Cisco NAC" or "CNAC" means Cisco's network access control ("NAC") product referenced in the email attached herewith as Appendix 1.

2. "CyberGatekeeper LAN" means InfoExpress's NAC product, which InfoExpress first sold in June of 2004, and any components thereof.

III. Interrogatories

Interrogatory No. 1: Explain what efforts that Cisco took, if any, to prevent its personnel involved in the development of its CNAC product from accessing information regarding the CyberGatekeeper LAN, including but not limited to information that was confidential to InfoExpress.

Interrogatory No. 2: Describe all analyses regarding the CyberGatekeeper LAN, which were performed by Cisco or at its direction or request. This includes (but is in no way limited to) [REDACTED]
[REDACTED] and any analyses of information that InfoExpress sent to Cisco (see Appendix 2).

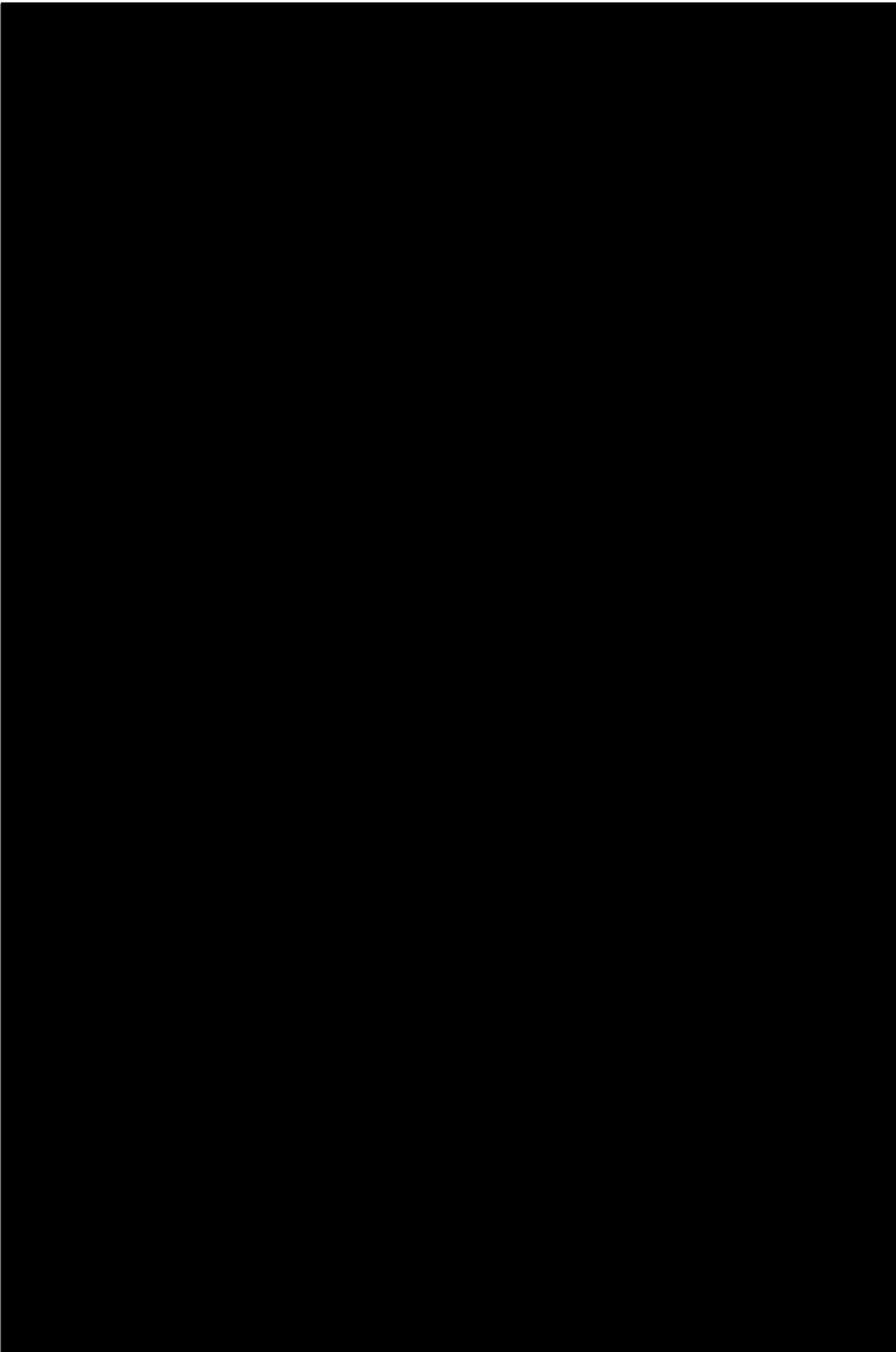
Interrogatory No. 3: [REDACTED]
[REDACTED]
[REDACTED]
[REDACTED]

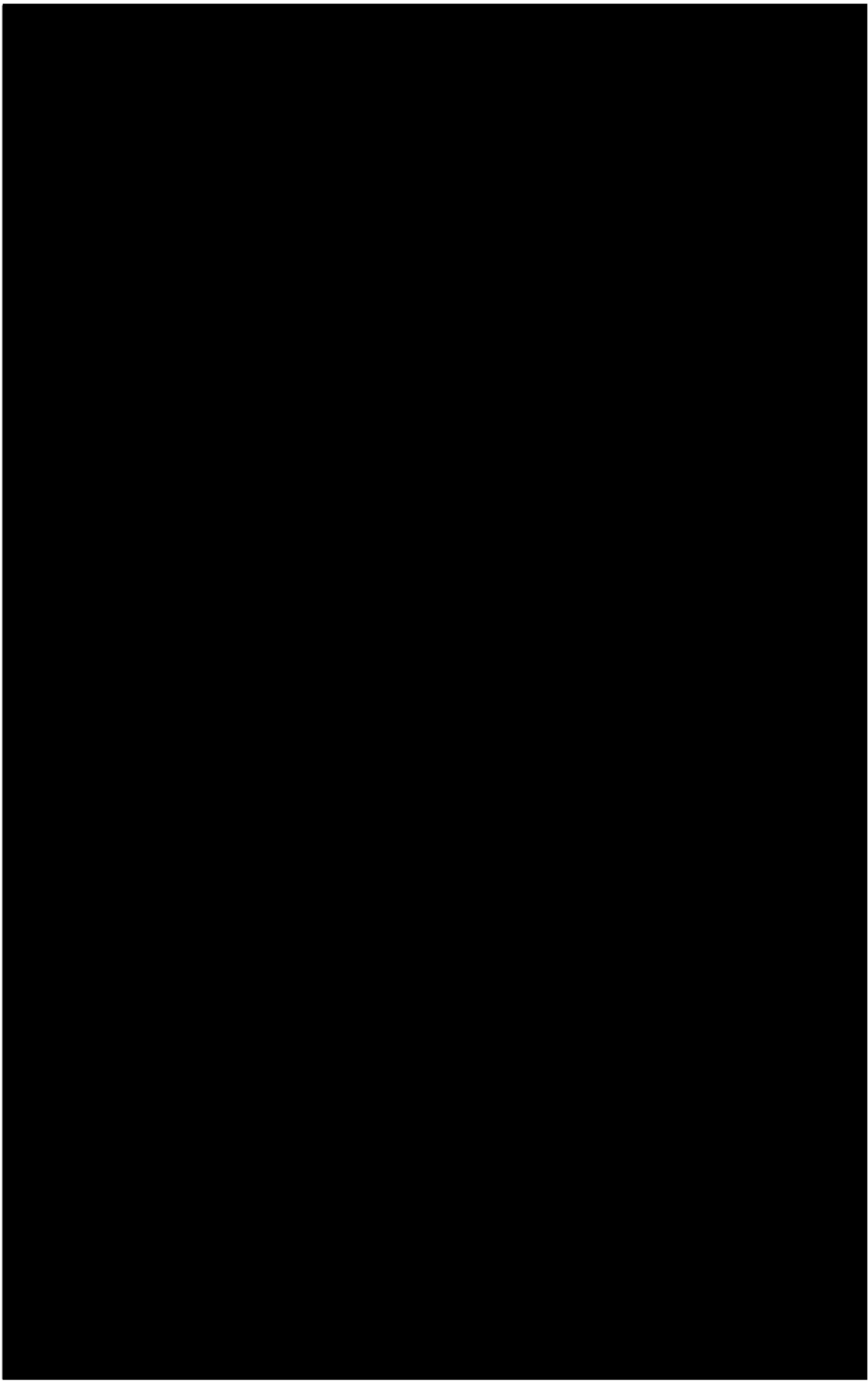
Respectfully submitted,

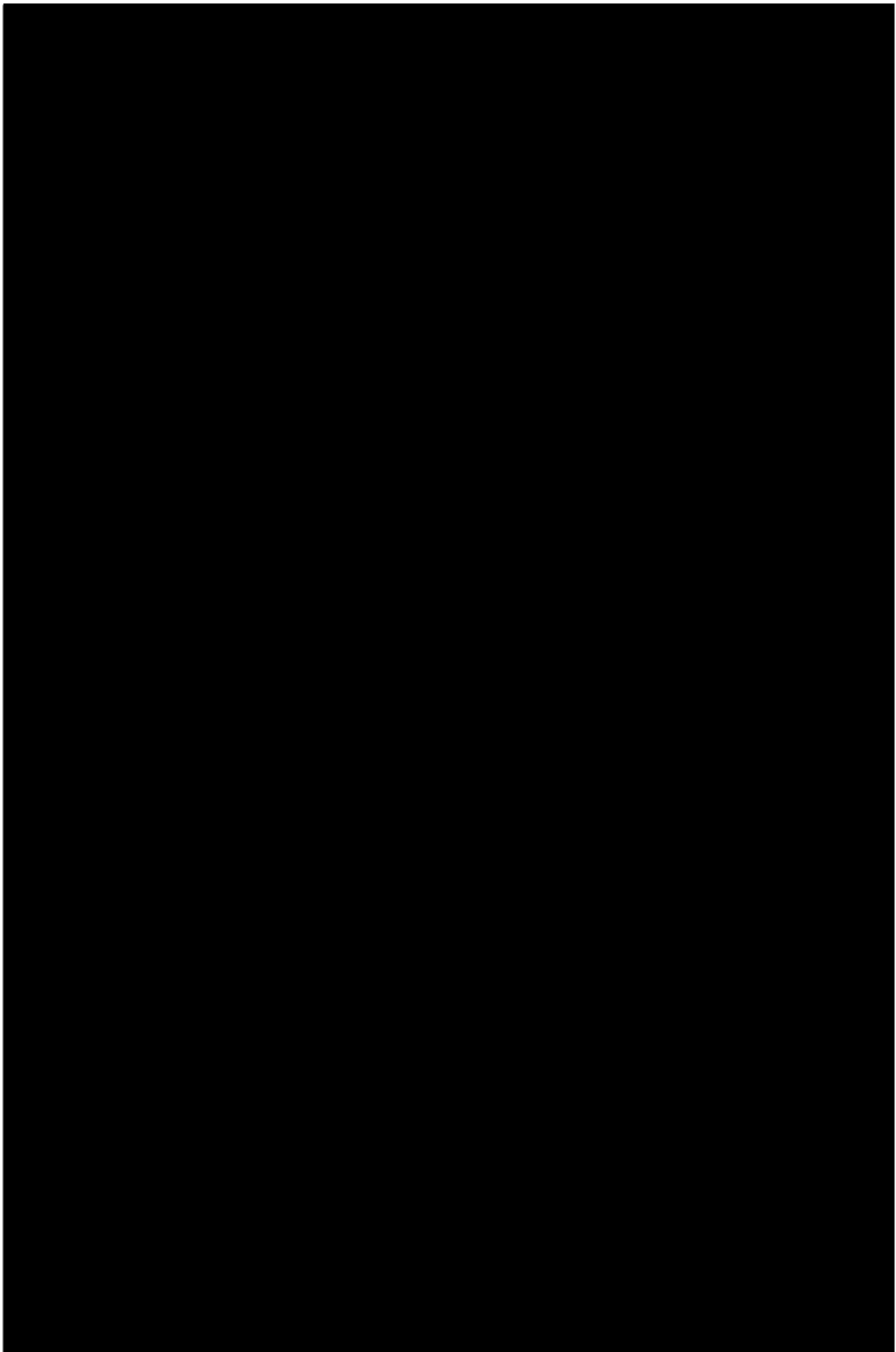
Dated: DATE Mailing address for all correspondence: Saul Ewing LLP Centre Square West 1500 Market Street, 38th Floor Philadelphia, PA 19102-2186	<u>/s/ [DRAFT]</u> Joseph M. Kuo (Reg. No. 38,943) Saul Ewing LLP 161 North Clark Street, Suite 4200 Chicago, IL 60601 Tel: (312) 876-7151 Brian R. Michalek (Reg. No. 65,816) Saul Ewing LLP 161 North Clark Street, Suite 4200 Chicago, IL 60601 Tel: (312) 876-7151 Brian Landry (Reg. No. 62,074) Saul Ewing LLP 131 Dartmouth Street, Suite 501 Boston, MA 02116 Tel: (617) 912-0969 <i>Counsel for Patent Owner</i>
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Appendix 1

Appendix 2







Appendix 3

