

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

**PETITIONERS' RESPONSE TO PATENT OWNER'S MOTION FOR
ADDITIONAL DISCOVERY PURSUANT TO 37 C.F.R. § 42.51(b)(2)**

LIST OF EXHIBITS

No.	Exhibit Description
1001	U.S. Patent No. 8,051,460
1002	U.S. Patent No. 8,051,460 File History
1003	Declaration of Henry Houh, Ph.D.
1004	CV of Henry Houh, Ph.D.
1005	U.S. Patent Pub. No. 2004/0111520 to Krantz et al.
1006	U.S. Patent Pub. No. 2004/0107360 to Herrmann et al.
1007	IEEE Std 802.1Q-1998 – IEEE Standard for Local and Metropolitan Area Networks: Virtual Bridged Local Area Networks
1008	U.S. Patent No. 6,430,621 to Srikanth et al.
1009	U.S. Patent No. 6,032,194 to Gai et al.
1010	Cisco IOS 12.0 Switching Services (1999)
1011	Microsoft Computer Dictionary 5th Edition (2002)
1012	Webster’s New World Computer Dictionary (2001)
1013	Dictionary of Computer and Internet Terms 8th Edition (2003)
1014	U.S. Patent No. 5,987,611 to Freund
1015	U.S. Patent No. 7,260,726 to Doe et al.
1016	RFC 2716 – PPP EAP TLS Authentication Protocol
1017	Wireless security with 802.1x and PEAP (2003)
1018	Current Participants-Network Admission Control - Cisco Systems
1019	Cisco Identity Services Engine 3.0 - Cisco

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<i>Brunswick Corp. v. Volvo Penta of the Ams., LLC</i> , IPR2020-01512, Paper No. 25 (PTAB May 12, 2021)	5
<i>Douglas Dynamics, L.L.C. v. Myer Prods. LLC</i> , IPR2015-01839, Paper No. 29 (PTAB July 26, 2016)	8
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<i>Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC</i> , IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013)	1, 4, 6
<i>Topgolf Int’l, Inc. v. Agarwal</i> , IPR2017-00928, Paper No. 24 (PTAB Oct. 25, 2017)	4
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The relief sought by Patent Owner InfoExpress (“InfoExpress”) from Petitioner Cisco Systems (“Cisco”) should be unequivocally denied. InfoExpress has failed to meet the considerable burden of demonstrating the necessity or even the utility of this discovery. As established in *Garmin International, Inc. v. Cuozzo Speed Technologies LLC*, IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013) (precedential), the criteria for such discovery are stringent. Rather than meeting these standards, InfoExpress’s request appears to be nothing more than a speculative fishing expedition aimed at supporting an unsubstantiated allegation of copying. The evidence presented by InfoExpress is wholly insufficient and fails to even remotely suggest that Cisco—a pioneer in the networking field—engaged in anything other than professional conduct in its partnership with InfoExpress.

I. BACKGROUND

Founded in 1984, Cisco Systems has emerged as a global leader in networking for the Internet. In 2004, Cisco spearheaded an industry initiative known as Network Admission Control (NAC). This initiative aimed to leverage network infrastructure to enforce security policy compliance on all devices seeking access to network computing resources, thereby mitigating the damage caused by viruses. EX2413, 1.

Soon after its inception, “Cisco opened the NAC program to all endpoint security, compliance, and patch management vendors.” EX2415, 1. This move responded to “increasing customer demand for intelligent collaboration among a

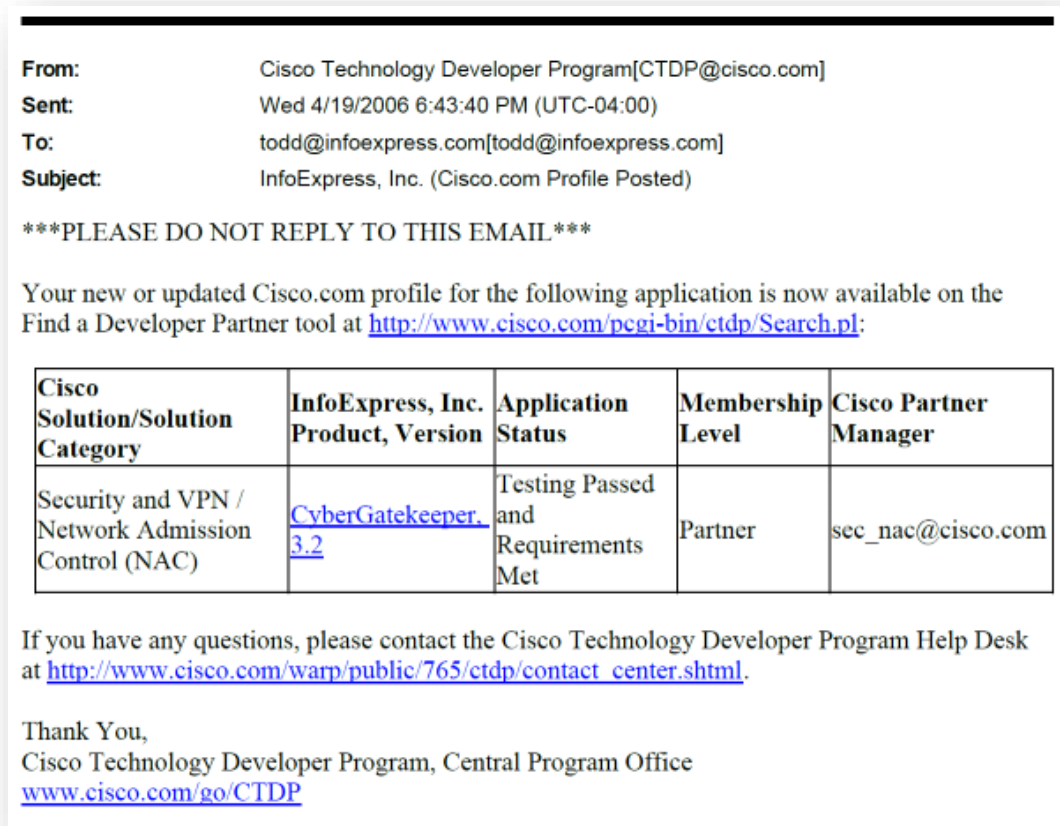
diverse array of vendors to build solutions that protect businesses from security threats.” EX2415, 1. The program was a “vendor-agnostic” and “provid[ed] resources for NAC certification, interoperability, and marketing.” EX2415, 1.

InfoExpress was one such company that joined the NAC program, alongside other notable participants like McAfee Security, Symantec, and IBM. EX1018, 1. InfoExpress prominently highlighted the benefits of its partnership with Cisco in its marketing materials, emphasizing that “as a member of NAC, an industry initiative led by Cisco Systems, InfoExpress brought immediate value to enterprise customers.” EX2424. These materials also featured a “Cisco Compatible” stamp at the bottom of each page and highlighted that “CyberGatekeeper version 3.1 has tested compatible with NAC.” EX2424, 1-3. InfoExpress also underscored that its software was “built to NAC specifications and subsequently certified by Cisco’s independent testing organization, KeyLabs.” EX2424, 2.

The evidence cited by InfoExpress therefore unequivocally demonstrates that InfoExpress actively sought Cisco’s assistance in promoting its products and was aware that the software provided to Cisco and KeyLabs was solely for demonstrating certification and interoperability. EX2420; EX2421, at 7; EX2419.

InfoExpress now presents a different narrative. After providing an evaluation version of its commercially available software and literature to Cisco, it asserts that it “never heard any further details as to what Cisco did with that information.” Mot.

at 3. The evidence, however, contradicts this assertion. It shows that Cisco tested the software, confirmed it met requirements, and reported its findings. EX2419. Cisco even provided resources, including a “Help Desk,” to address any questions InfoExpress might have:



EX2419.

InfoExpress also asserts that “the trail ran cold with the [KeyLabs] report.” Mot. at 3. Yet again, the evidence indicates otherwise. Following KeyLabs certification, Lloyd Tanaka of InfoExpress informed Stacy Lum (inventor of the 460 Patent and CEO of InfoExpress) that he “will be following up with Cisco to now try

and get them to elevate our status.” EX2420, 1. Indeed, one month later, InfoExpress was collaborating with Cisco to finalize marketing materials touting its certifications. EX2023; EX2024.

II. ARGUMENT

A. Factor 1: The Request Does Not Demonstrate More Than a Possibility and Mere Allegation

The first *Garmin* factor mandates that “[t]he party requesting discovery should have evidence to “show **beyond speculation** that in fact something useful will be uncovered.” *Garmin*, slip op. at 6 (emphasis added). Additionally, it requires InfoExpress to demonstrate “a threshold showing of nexus between the claimed invention and the evidence sought.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26, at 6 (PTAB Mar. 5, 2013) (precedential). In other words, “[a]bsent some evidence of nexus, Patent Owner cannot demonstrate that its discovery requests are likely to uncover something useful.” *Topgolf Int’l, Inc. v. Agarwal*, IPR2017-00928, Paper No. 24, at 6 (PTAB Oct. 25, 2017).

InfoExpress acknowledges that the “subject of its present motion” is an alleged uncertainty of Cisco’s actions with the information regarding its product. Mot. at 3. But that assertion—and the implied suggestion of Cisco’s potential misconduct—is inarguably speculative. But apart from that, the evidence demonstrates that speculation to be false. As detailed above, *see* Section I *supra*, InfoExpress was aware that Cisco’s NAC industry initiative aimed to provide its

partners, including InfoExpress, with “NAC certification, interoperability, and marketing.” EX2415, 1. And after InfoExpress supplied Cisco and KeyLabs with its commercially available software and literature to evaluate, it received exactly what it bargained for—NAC certification, interoperability testing, and marketing assistance. EX2415, 1. InfoExpress even highlighted its partnership with Cisco in its own marketing materials. EX2415, 1. Thus, the notion that Cisco used InfoExpress’s commercially available software for purposes other than interoperability testing is nothing less than unfounded speculation.

Furthermore, InfoExpress does not allege that Cisco accessed proprietary information or source code—quite the opposite. Instead, InfoExpress concedes that it had already been selling its product as of June 2004, Mot. at 2, and when it provided its product for testing to Cisco approximately two years later, it provided evaluation software, Mot. at 2, EX2416, and literature including a PowerPoint presentation. *Id.* Even the literature that it provided was not marked confidential, *see, e.g.*, EX2416, so any suggestion that Cisco had *access* to anything that might be able to provide insight into how InfoExpress’s software worked is simply false.

InfoExpress cites to *Brunswick*, but the fact pattern there is inapposite. In *Brunswick*, the Petitioner had access to the patented engine at a boat show—not merely the boat. *Brunswick Corp. v. Volvo Penta of the Ams., LLC*, IPR2020-01512, Paper No. 25, at 7-8 (PTAB May 12, 2021). Access to commercially available (or

evaluation) software does not equate to access to the software’s source code, the “engine” of the software, and none of the evidence suggests Cisco had access to anything other than the software itself.

Regarding the purported objective indicia of nonobviousness here—i.e., copying—InfoExpress must demonstrate a nexus between any alleged copying and the claimed invention. *Garmin*, IPR2012-00001, Paper 26, at 6. InfoExpress fails to establish such a nexus, further justifying denial of its motion.

For example, InfoExpress provides no evidence linking Cisco’s product accused of infringing—the Identity Services Engine 3.0 (“ISE”), released in September 2020—to the alleged acts of copying between 2004 and 2007. EX2425, 2-3, EX1019. Additionally, it is not sufficient that an accused product merely be within the scope of a claim; any presumption of nexus requires a showing that the product not only practices the claim but is *coextensive* with the claim such that the product “is the invention disclosed and claimed.” *Fox Factory, Inc. v. SRAM, LLC*, 944 F.3d 1366, 1377 (Fed. Cir. 2020) (citation omitted). InfoExpress has not done that. Even the features InfoExpress identifies in ISE as “resembling features” in their own product—e.g., “Cisco’s ISE has the ability to check the endpoint device for ‘the latest OS patch, antivirus and antispymware packages with current definition file variables,’” Mot. at 4—were the same features the NAC initiative identified years before InfoExpress provided its evaluation software to Cisco. EX2413, 2

(“NAC allows network access to compliant and trusted endpoint devices. . . . Network access decisions can be based on such information as **the endpoint’s antivirus state, operating system version, operating system patch level**” (emphasis added)).

B. Factors 4 and 5: The Request Is Burdensome and Overly Broad

Given the expedited nature of IPRs, InfoExpress’s requests are overly burdensome due to the age of the information sought and the delay in seeking it. Nevertheless, Cisco has searched for and will produce several documents it has located responsive to RFPs 1 and 2. However, the proposed Interrogatories are far more burdensome and would require Cisco to track down unnamed individuals with knowledge about decisions related to one of the numerous companies Cisco was partnered with nearly 20 years ago. Even identifying the individuals who might have such knowledge will be a time-consuming and expensive process, and certainly not one that is likely to be completed before InfoExpress’s responses are due in mid-January because, among other things, Cisco’s company-wide annual holiday shutdown. In addition, as a preview of the difficulty in the proposed Interrogatories, interviews with long-tenured Cisco employees earlier this year demonstrated no knowledge of InfoExpress or its products.

Furthermore, InfoExpress’s delay in seeking this information further burdens Cisco, making the request untimely. According to 37 C.F.R. § 42.25(b),

“[a] party should seek relief **promptly** after the need for relief is identified. Delay in seeking relief may justify a denial of relief sought.” InfoExpress cannot dispute that it has held its alleged theory of copying since at least the November 2, 2023 service of its interrogatory responses in the related litigation, EX2412, 29. Nor can it dispute that all of the evidence it cites in its motion was already in its possession. Yet InfoExpress waited until November 1, 2024 to contact Petitioners about its request, more than a month after this proceeding was instituted on September 24, 2024. This delay also weighs against granting its motion.

Boards have consistently held that delay such as this warrants denial of a request for additional discovery. *See, e.g., Douglas Dynamics, L.L.C. v. Myer Prods. LLC*, IPR2015-01839, Paper No. 29, at 8-9 (PTAB July 26, 2016) (denying motion for additional discovery where movant sought authorization to file the motion one month before the due date for its response); *Apple Inc. v. Koss Corp.*, IPR2021-00255, Paper 29, at 3-4 (PTAB Sept. 1, 2021) (determining that Patent Owner’s request for additional discovery one month after institution was untimely). Indeed, the parties were directed to contact the Board within **one month** of the September 24, 2024 institution “if there is a need to discuss . . . proposed motions that have not been authorized in this Order or other prior Order or Notice.” Paper No. 14, at 2. InfoExpress did not do that.

Dated: December 18, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

I hereby certify that on this 18th day of December, 2024, I caused to be served
a true and correct copy of the foregoing paper by electronic mail on the following:

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