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.

IPR2024-00540
U.S. Patent No. 8,347,350

PATENT OWNER'S PRELIMINARY SUR-REPLY

I. Introduction

Patent Owner ("PO") InfoExpress Inc. submitted substantial testimony and irrefutable corroborating evidence that its invention pre-dates Petitioners' references. This includes scores of emails, technical specifications, source code, and third-party documents. Petitioners' Preliminary Reply (Paper 11) is little more than a scattershot effort to manufacture procedural and factual "disputes" that do not exist.

Petitioners complain procedurally about a supposed "incorporation by reference" of PO's claim charts and word count limitations. But PO included the claim charts in its word count certification. Next, Petitioners claim that an inventor cannot authenticate documents. But such a broad-strokes rule is not correct, and the Exhibits are properly authenticated under several FRE provisions including by testimony from InfoExpress's CEO Stacey Lum. Petitioners also claim the evidence cannot be corroborating because it came from Mr. Lum's "personal archives." This, however, is misdirection. The corroborating evidence was maintained on "InfoExpress's e-mail and file servers" and includes inventor, non-inventor, and third-party documents.

Finally, Petitioners wrongly seek to jettison § 314(a)'s "reasonable likelihood" standard for a summary-judgment style "material issue of fact." But even the "issues" glossed upon by Petitioners do not justify institution.

Petitioners knew about PO's antedating position before it filed this Petition. Yet, they chose anyway to rely on references that cannot be prior art. Their Reply cannot now cure that decision, nor can it change facts. The Board should deny institution given this antedating evidence. *See, e.g.*, *LG Elecs., Inc. v. Wi-LAN Inc.*, IPR2018-00704, Paper No. 14 (PTAB Sept. 5, 2018).

II. Patent Owner properly set out its claim chart analysis.

EX2009 and EX2010 are claim chart analyses of conception and reduction to practice, respectively. Petitioners argue that these exhibits were improperly incorporated by reference into the POPR to circumvent the word count limits. Reply at 1-3. This is not correct as EX2009 and EX2010 ***were*** counted consistent with the *Consolidated Trial Practice Guide* at 44. The total machine word count for ***EX2009, EX2010, and the POPR*** is 13,365 words. Accordingly, there is no circumvention. Proper word count aside, there is no reason to treat the charts differently as exhibits, and presenting this exhibit analysis does not mean that others must now "play archaeologist" with the record. *See* Reply at 3.

III. The Exhibits are properly authenticated.

Petitioners' only challenge to authenticity is that "inventor testimony is not sufficient to authenticate a document offered to corroborate the inventor's testimony." Reply at 3. This is not correct. *See Comcast Cable Commc'ns, LLC v. Veveo, Inc.*, IPR2019-00290, Paper No. 59 at 26, 74 (PTAB Aug. 12, 2020). Indeed,

in *Comcast*, the named inventor ***was*** qualified to authenticate email (among other documents) because "as CTO of Veveo, he would have had knowledge of the system used to prepare the documents at the time they were created." *Id.* at 74.

Here, Mr. Lum is not only an inventor but he founded InfoExpress in 1993 and has been its CEO. EX2003, ¶4. He has knowledge of PO's electronic records, including the Exhibits (which are dated 2002-2003):

> The exhibits listed were maintained by InfoExpress in the course of the regularly conducted activity of InfoExpress. Specifically, the exhibits listed herein . . . were maintained on InfoExpress's e-mail and file servers. Individual InfoExpress personnel had latitude to backup their e-mail accounts. I did so; accordingly, most of the e-mails cited herein are from my archives. EX2003, ¶24.

Given his knowledge (as CEO), Mr. Lum's testimony is sufficient to authenticate the Exhibits under FRE 901(b)(1). *Comcast*, *supra*.

InfoExpress's documents are also authenticated under 901(b)(4) because they contain "distinctive characteristics." For example, PO's emails all contain "sender, recipient, subject line, and content fields" which is enough to authenticate them. *See Siemens v. Seagate Tech.*, No. SACV 06–788JVS (ANx), 2009 WL 8762978, *9 (C.D. Cal. 2009). Similar can be said for PO's non-emails like its LAN specification, which are conspicuously marked with InfoExpress Inc. *E.g.*, EX2011 at 1.

The Exhibits are also authenticated under FRE 901(b)(8). In this case, there are no real suspicions about the exhibits' authenticity—Petitioners' intimations

aside. They were "maintained on [PO's] e-mail and file servers" and thus were from a place where "if authentic, they would likely be." Last, they date to 2003 and earlier, and thus are 20 years old.

IV. Mr. Lum's testimony is corroborated by the authenticated Exhibits.

Petitioners challenge Mr. Lum's testimony for lacking "independent" corroboration "because the only evidence in the record are files the inventor purportedly recovered from his personal archives." Reply at 4. This is false, as Mr. Lum explained that "The exhibits listed were maintained by InfoExpress in the course of the regularly conducted activity . . . [and] were maintained on InfoExpress's e-mail and file servers." EX2003, ¶24.

Petitioners also make no distinction between these exhibits which include documents and e-mails from those other than Mr. Lum. *See, e.g.*, EX2068, EX2071, EX2118, and EX2128. Indeed, emails from both inventors and non-inventors ***can*** be proper corroboration. *See E.I. du Pont De Nemours & Co. v. Unifrax I LLC*, 921 F.3d 1060, 1076-77 (Fed. Cir. 2019) ("Documentary evidence, including a 2009 email sent by [inventor] Dr. Kawka describing an adhesive layer . . . corroborated Dr. Kawka's testimony."); *see also In re Jolley,* 308 F.3d 1317, 1324-1326 (Fed. Cir. 2002) (affirming Board's ruling that emails from inventors were sufficient corroboratory evidence).

Further, PO's metadata identified in EX2012 and EX2014 is additional

independent corroborating evidence of the dates.

Apator Miitors APS v. Kamstrup A/S, 887 F.3d 1293 (Fed. Cir. 2018) is distinguishable. There, the patent owner attempted to establish prior conception through (alleged) email ***attachments*** where the emails themselves lacked any "indicia in either the body or header of the email indicating a file [wa]s attached." *Id.* at 1296. Most fatal to the patent owner was the fact that the drawings themselves indicated that they had been "modified" in 2012—after the asserted conception date of 2010. *Id. Apator* simply does not apply here. Indeed, the Board rejected a similar attempt to over-read *Apator* this year in *Google LLC v. Valtrus Innovations Ltd.,* IPR2022-01545, Paper No. 76 at 17-20 (PTAB Apr. 10, 2024). In *Valtrus*, the Board rejected the petitioner's argument of insufficient corroboration because "[t]he metadata and the documents themselves were provided with [the inventor's] declaration as separate corroboration of his testimony" regarding date of conception. *Id.* at 18. The same is true here. *See* EX2012 and EX2014.

V. Petitioners' attempts to manufacture issues of fact fail.

A. Conception

Petitioners make threadbare complaints about conception to try to create fact issues. First, they conjure an "authorship" issue (Reply at 4-5) surrounding EX2011. But EX2011 (including its metadata EX2012)—regardless of author—corroborates the inventors' conception. Just because the document itself was generated or kept by

PO does not mean that the ideas memorialized therein were not conceived by the inventors. Petitioners' out-of-context case excerpts (*id.* at 5) do not refute this.

Second, Petitioners baldly conclude that PO's conception evidence lacks "the concept of a less restricted network." Reply at 5. This is made without explanation or even citation. There is no fact issue as EX2011 ***does*** disclose this. *See, e.g.,* EX2009 at 8-9 (citing EX2011 at 9, 14-15).

B. Diligence and Reduction to Practice

PO exercised reasonably continuous diligence to reduce the invention to practice. *See Perfect Surgical Techs., Inc. v. Olympus Am., Inc*., 841 F.3d 1004 (Fed. Cir. 2016). Petitioners make no showing that "the invention was . . . abandoned or unreasonably delayed." *Id.* at 1009. Rather, Petitioners only point to a single exhibit —EX2036— for support. Reply at 6. EX2036 is an isolated excerpt about a potential license agreement. In singling out a single exhibit, they ***ignore*** a flurry of other corroborating diligence evidence from that ***same time*** in February 2003. *See* POPR at 40-41. The purpose of diligence is not to "scour the patent owner's corroborating evidence in search of intervals of time where the patent owner has failed to substantiate some sort of activity." *Perfect Surgical*, 841 F.3d at 1009. Even if Petitioners substantiated the alleged "several weeks long" gaps, Reply at 6, those "gaps" would still be shorter than those in *Monsanto Co. v. Mycogen Plant Science Inc*., 261 F.3d 1356 (Fed. Cir. 2001), which ran for several months, and did not

preclude a finding of reasonable diligence in view of "activity in every month of the critical period[,]" *id.* at 1369-70.

C. Petitioners knew of Patent Owner's antedating in the district court prior to filing their petitions.

Petitioners' claim that these Exhibits were not produced in the parallel district court cases is misdirection. Reply at 6-7. Well before this Petition was filed, PO had told Petitioners of its October 2002 priority claim,[1] and it produced Exhibits including the conception document (EX2011). *See also* EX2026, 2030-31, 2033-35, 2037-38, 2040-43, 2045-46, 2202-04.[2] The other email Exhibits were subject to the parties' email discovery protocols which required specific requests, keyword agreement and collaboration. Fortinet never served e-mail requests. And it was not until March 7, 2024—a day before the first Petition was filed—that Cisco served its amended e-mail requests. Then on April 19, 2024, Petitioners moved to stay the District Court litigations prior to finalizing keyword search agreement.

VI. Conclusion

For these reasons, Patent Owner respectfully requests that the Board reject the Petition and not institute an *inter partes* review of the Challenged Claims.

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[1] PO is mindful of the Board's order that neither party may file evidence. PO would be happy to file evidence supporting this or any statement herein upon request.

[2] These Exhibits bear the Bates production numbering from the Cisco litigation.

Respectfully submitted,

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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: August 6, 2024

/Brian R. Landry/
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