

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.

U.S. Patent No. 7,523,484

**PETITIONER'S EXPLANATION REGARDING THE NECESSITY FOR
MULTIPLE PETITIONS**

Petitioner has filed two petitions challenging United States Patent No. 7,523,484 (“the 484 Patent”). Two petitions were required because the analysis of all 33 challenged claims (31 of which are asserted in the parallel litigation) of the 484 Patent could not reasonably fit within the word limit for a single petition. In considering how best to divide the analysis between the petitions, Petitioner determined that addressing different sets of *independent* claims in each petition was most efficient given the differences between independent claim 1 (Petition 1 - IPR2024-00675) and independent claims 28, 41, 56, and 57 (Petition 2 - IPR2024-00679).

Further, pursuant to the Trial Practice Guide recommendations, Petitioner identifies the following sections as the sections that are substantively identical across the two petitions:

IPR2024-00675	IPR2024-00679
Introduction	Introduction
Mandatory Notices	Mandatory Notices
Requirement for <i>Inter Partes</i> Review	Requirement for <i>Inter Partes</i> Review
The 484 Patent	The 484 Patent
Claim Construction	Claim Construction
Principal Prior Art	Principal Prior Art

The differences in the petitions are based on the difference in scope between claim 1—which is a system claim addressing limitations of which a “*network gatekeeper*” is comprised of—and claims 28, 41, 56, and 57—which are method

claims each of which address “[a] *method of granting access to a protected network.*”

Finally, Petitioner recognizes that November 2019 Consolidated Trial Practice Guide states that a petitioner filing multiple petitions against the same patent “should” identify “a ranking of the petitions in the order in which [the petitioner] wishes the Board to consider the merits.” *See* pg. 60. Petitioner respectfully suggests that doing so here would be somewhat difficult, as this is not a situation where the petitions challenge the same claims on different prior art bases. Accordingly, given the numbers of claims in the 484 Patent, and the length of each challenged claim, Petitioner respectfully requests that the Board consider and institute *Inter Partes* reviews on both petitions. Nevertheless, to the extent the Board deems it necessary to only consider a single petition, Petitioner ranks IPR2024-00679 slightly ahead of IPR2024-00675 simply because of the greater number of independent claims that are addressed.

Dated: April 18, 2024

Respectfully Submitted,

/Scott M. Border/

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CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6I, I hereby certify that on this 18th day of April, 2024, I caused to be served a true and correct copy of the foregoing by priority mail on the following:

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