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.

IPR2024-00677
U.S. Patent No. 8,578,444

REQUEST FOR DIRECTOR REVIEW

TABLE OF CONTENTS

Page

I. INTRODUCTION 1

II. LEGAL STANDARD 5

III. ARGUMENT 6

A. PO'S "EVERY LIMITATION" ANALYSIS RELATED TO CONCEPTION IS NOT PRESENT IN ITS PATENT OWNER RESPONSE 6

B. PO'S CLAIM CONSTRUCTION ANALYSIS RELATED TO CONCEPTION IS NOT PRESENT IN ITS RESPONSE 11

C. MUCH OF PO'S DILIGENCE ANALYSIS IS NOT PRESENT IN ITS RESPONSE 12

D. PETITIONERS WERE SIGNIFICANTLY PREJUDICED BY THE BOARD PERMITTING PO TO VIOLATE ITS RULES 14

TABLE OF AUTHORITIES

Page(s)

Cases

Apple Inc. v. Spacetime3D, Inc.,
IPR2023-00344, Paper 47 (P.T.A.B. July 2, 2024) 8

Burroughs Wellcome Co. v. Barr Lab'ys, Inc.,
40 F.3d 1223 (Fed. Cir. 1994) 6

Coleman v. Dines,
754 F.2d 353 (Fed. Cir. 1985) 6, 10

Davis v. Reddy,
620 F.3d 885 (CCPA 1978) 6

DeSilva v. DiLeonardi,
181 F.3d 865 (7th Cir. 1999) 4

Gen. Access Sols., Ltd. v. Sprint Spectrum L.P.,
811 F. App'x 654 (Fed. Cir. 2020) 4

Google LLC v. Sec. First Innovations, LLC,
IPR2024-00212, Paper 42, at 7 (P.T.A.B May 16, 2025) 3

Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.,
821 F.3d 1359 (Fed. Cir. 2016) 6

Jiangu SmartSens Tech. Co., Ltd. v. OmniVision Techs., Inc.,
IPR2019-01263, Paper 48 (P.T.A.B Dec. 18, 2020) 4

Kridl v. McCormick,
105 F.3d 1446 (Fed. Cir. 1997) 10

In re Magnum Oil Tools Int'l, Ltd.,
829 F.3d 1364 (Fed. Cir. 2016) 14

Mahurkar v. C.R. Bard, Inc.,
79 F.3d 1572 (Fed. Cir. 1996) 6

Net MoneyIN, Inc. v. VeriSign, Inc.,
545 F.3d 1359 (Fed. Cir. 2008) 10

Parus Holdings, Inc. v. Google LLC,
70 F.4th 1365 (Fed. Cir. 2023) 3, 13

Purdue Pharma L.P. v. Boehringer Ingelheim GMBH,
237 F.3d 1359 (Fed. Cir. 2001) 10

REG Synthetic Fuels, LLC v. Nestle Oil Oyj,
841 F.3d 954 (Fed. Cir. 2016) 6

Slip Track Sys., Inc. v. Metal-Lite, Inc.,
304 F.3d 1256 (Fed. Cir. 2002) 10

Statutes

35 U.S.C. § 316(a)(8).....2

Other Authorities

37 C.F.R. § 42.6(a)(3) 1, 2, 3, 5, 8

37 C.F.R. § 42.22 1

37 C.F.R. § 42.23(a).....1

37 C.F.R. § 42.23(b) 13

37 C.F.R. § 42.24(a)(2) 15

37 C.F.R. § 42.120 1

USPTO, *Director Review Process*, § 2.B,
https://www.uspto.gov/patents/ptab/decisions/director-review-
process.....5

I. INTRODUCTION

Petitioners Cisco Systems, Inc. and Fortinet, Inc. respectfully submit this request for Director Review of the Board's Final Written Decision in the above-captioned *inter partes* review of U.S. Patent No. 8,578,444 ("the '444 Patent"). The Board's decision should be vacated and remanded for further consideration of the patentability arguments because it was issued in clear violation of the USPTO rules and established Federal Circuit precedent.

In particular, the Board abused its discretion by considering arguments and evidence that were improperly incorporated by reference in the Patent Owner's Response ("Response"), rather than being set forth in the body of the brief as required by USPTO regulations. This procedural error is not a mere technicality; it strikes at the heart of the fairness and integrity of the *inter partes* review process.

Patent Owner ("PO") here chose to take on an affirmative burden to antedate the prior art and demonstrate in its Response that it was the first to make its claimed inventions. Once it assumed that burden, it bore the responsibilities that came with it—including submitting a Response that complied with the rules and regulations of the USPTO, which requires not incorporating material by reference pursuant to 37 C.F.R. § 42.6(a)(3) and including "**a detailed explanation** of the significance of the evidence including material facts" pursuant to 37 C.F.R. § 42.22 (emphasis added); *see also* 37 C.F.R. §§ 42.23(a), 42.120.

But the Response omits the **detailed explanations** that were required to meet PO's burden and instead incorporates them by reference—a tactic that obscures its theories on conception and diligence. The claim-by-claim analysis on conception, for example, is supplied through a declaration and an attached claim chart. And PO's diligence evidence—most of which was not explained in the Response—included work done on projects that PO later admitted were unrelated to the claim limitations, a fact that only came to light during cross-examination of the inventor. It was the PO's burden to demonstrate conception and to explain gaps in its diligence activity **in the Response**, and its failure to conduct claim analysis of the conception document and bulk-citing activity (including activity unrelated to the claim limitations) **in its principal brief** was an express violation of the Board's rules, and a failure of its burden.

The Panel therefore violated its own rules by considering arguments by PO related to conception and diligence that were expressly incorporated by reference and not present in its Response. Indeed, pursuant to the USPTO statutory mandate to promulgate rules governing patent owners' submission of evidence under 35 U.S.C. § 316(a)(8), the USPTO issued regulations setting restrictions and requirements on briefs submitted during IPRs. One of those regulations—37 C.F.R. § 42.6(a)(3)—requires that "[a]rguments must not be incorporated by reference from one document into another document":

> [O]ur rules do prohibit incorporating documents by reference. *See* 37 C.F.R. § 42.6(a)(3). Our PTAB Consolidated Trial Practice Guide . . . provides guidance on incorporation by reference: "[P]arties that incorporate expert testimony by reference in their petitions, motions, or replies without providing explanation of such testimony risk having the testimony not considered by the Board." *Id.* at 35–36. . . . Consistent with this guidance, we will focus our analysis on arguments presented in the briefing of the parties and their support. We will not address arguments in either party's declarations that are not discussed in the briefs or arguments that are incorporated by reference from the expert declarations.

Google LLC v. Sec. First Innovations, LLC, IPR2024-00212, Paper 42, at 7 (P.T.A.B May 16, 2025). Despite this prohibition, PO explicitly incorporated by reference arguments into its Response, and the Board permitted it to do so. This was a clear departure from established rules and guidance.

The Federal Circuit recently explained that "there are compelling reasons why these USPTO regulations exist," including preventing unfairness and abuse. *Parus Holdings, Inc. v. Google LLC*, 70 F.4th 1365, 1372 (Fed. Cir. 2023). In *Parus*, as here, the Patent Owner submitted exhibits, including claim charts, but cited only portions of the material "without meaningful explanation." 70 F.4th at 1369. The *Parus* Court explained that the "burden of production cannot be met without some combination of citing the relevant record evidence with specificity

and explaining the significance of the produced material in briefs." *Id*. at 1372. Similarly, in *General Access Solutions, Ltd. v. Sprint Spectrum L.P.,* the Patent Owner attempted to incorporate by reference a lengthy claim chart allegedly evidencing conception of the challenged claims. 811 F. App'x 654, 656 n.1 (Fed. Cir. 2020). The Federal Circuit upheld the Board's decision finding that **the conclusory assertions in the Response were insufficient** to meet the Patent Owner's burden of establishing prior conception. *Id*. at 658; *see also DeSilva v. DiLeonardi*, 181 F.3d 865, 866–67 (7th Cir. 1999) (Incorporation "by reference amounts to a self-help increase in the length of the [] brief," and "is a pointless imposition on the court's time."); *see also Jiangu SmartSens Tech. Co., Ltd. et al. v. OmniVision Technologies, Inc*., IPR2019-01263, Paper 48 at 25 (P.T.A.B Dec. 18, 2020) ("With regard to conception, Patent Owner did not set forth in its Response facts sufficient to establish that all elements of the claims of the [challenged patent] were disclosed in the [alleged conception document]")

In response to PO's flouting of the rules, Petitioners explained in their Reply that, apart from PO's evidence being insufficient to establish conception and diligence, its arguments related to those issues were improperly incorporated by reference in express in violation of the Board's rules because PO was required to put its detailed conception and diligence analysis in its Response, not in its

exhibits. Reply, 21 n.8; *see also id.,* 14. That analysis improperly incorporated by reference should have been disregarded by the Board.

But the Board's decision never even acknowledged Petitioner's challenge to PO's egregious violation of § 42.6(a)(3) or the *Parus* Court's requirements for a PO to satisfy its burden of production. Instead, the Board analyzed PO's improperly incorporated arguments (in addition to making arguments on PO's behalf that PO never made) at great prejudice to Petitioners and in clear violation of its own rules. Because the PO failed to meet its burden of production, Krantz and Hermann are prior art, and the Director should vacate the FWD and remand the case to the Board to consider the Petition on the merits.

II. LEGAL STANDARD

"Requests for Director Review of a Board's final decision . . . shall be limited to decisions presenting (a) an abuse of discretion, (b) important issues of law or policy, (c) erroneous findings of material fact, or (d) erroneous conclusions of law." USPTO, Director Review Process, §2.B, https://www.uspto.gov/patents/ptab/decisions/director-review-process (last updated Nov. 3, 2025). The Board's FWD is an abuse of discretion if it "(1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact finding; or (4) involves a record that contains no

evidence on which the Board could rationally base its decision." *Intelligent Bio-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1367 (Fed. Cir. 2016).

III. ARGUMENT

A. PO's "Every Limitation" Analysis Related to Conception Is Not Present in Its Patent Owner Response

"Conception is 'the formation, in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice.'" *REG Synthetic Fuels, LLC v. Nestle Oil Oyj*, 841 F.3d 954, 962 (Fed. Cir. 2016) (emphasis omitted) (quoting *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985)). "The idea must be 'so clearly defined in the inventor's mind that only ordinary skill would be necessary to reduce the invention to practice, without extensive research or experimentation.'" *Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996) (quoting *Burroughs Wellcome Co. v. Barr Lab'ys*, Inc., 40 F.3d 1223, 1228 (Fed. Cir. 1994)). As a result, the idea "must include **every feature or limitation of the claimed invention**." *REG*, 841 F.3d at 962 (quoting *Davis v. Reddy*, 620 F.3d 885, 889 (CCPA 1978)) (emphasis added). Put another way, "in establishing conception a party must show **possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception**." *Coleman*, 754 F.2d at 359 (emphasis added).

The Response includes no analysis addressing "every feature or limitation of the claimed invention," and no analysis at all related to the dependent claims. *REG*, 841 F.3d at 962. PO instead shifted those arguments into two exhibits:

> Conception is demonstrated in Dr. Smith's claim chart mapping EX2011 to the Challenged Claims as set forth in EX2009.

Response, 67. Exhibits 2007 and 2009 include a 16-page expert declaration analyzing conception and a 41-page claim-chart including a claim-by-claim analysis. Other statements further demonstrate that PO's analysis exists outside its Response as it repeatedly refers to analysis outside its Response:

> EX2011 details a method for auditing a device (EX2009 at 1-4) during which an EAP (Authentication) Request is sent to the CGAgent running on the device. EX2009 at 5-7. "Devices executing CGAgent connect via a computer network to an access point (e.g. switch). §3.2.2 discloses the use of the 802.1X protocol." EX2009 at 7-9. CyberGatekeeper server (CGS), "asks CGAgent to start [an] audit." EX2009 at 10. "CGS (the gatekeeper configured to control access to a network) receives

audit data from CGAgent running on the user's device." EX2009 at 11. "EX2011 enforces policies" as discussed in the title below. EX2009 at 12-17.

CyberGatekeeper

LAN Based Policy Enforcement
Engineering Specification
Issue 0.1

"As discussed, e.g., in §3.2.2, auditing can be conditioned upon successful authentication. That is, the granting of access to the trusted network reflects both successful authentication followed by successful auditing." EX2009 at 12-17.

Regarding element [22.8], the "CGAgent continued to send updated audit data to the CGS during the MONITOR phase. The MONITOR phase happens after the network access point (e.g. switch) was reconfigured to allow for access." EX2009 at 41.

Response, 67-68. This does not provide the "**every feature or limitation**" analysis required to be in the Response. The Board has explained that "it is improper, under our rules, to incorporate such arguments by reference from the Declaration into the Patent Owner Response." *Apple Inc. v. Spacetime3D, Inc.*, IPR2023-00344, Paper 47 at 66 (P.T.A.B. July 2, 2024) (citing 37 C.F.R. § 42.6(a)(3)). The *Spacetime3D* Board held that incorporated arguments by the PO were "forfeited and []

disregarded." *Id.*, at 66. It was an abuse of discretion for the Board to arrive at an opposite result here.

Yet the Board did arrive at the opposite result. Rather than disregarding PO's arguments related to conception, the Board dug into the evidence and credited (or created) arguments that PO itself failed to advance. For example:

> Claim 1 recites "performing an authentication using an EAP protocol from the device, the device being connected via a computer network to an access point configured to use an 802.1x protocol." Ex. 1201, 16:9–24**. Patent Owner alleges that evidence of record establishes that the inventors of the '444 patent conceived of this subject matter** before the effective date of either Krantz or Herrmann. PO Resp. 66-68 (citing Ex. 2009; Ex. 2011; Ex. 2429; Ex. 2564).

Decision, 18-19 (emphasis added)[1]. But the Board is wrong—there is nothing on pages 66-68 of the Response that demonstrates that PO advanced that argument, and certainly nothing about EAP:

[1] The Board analyzed each limitation in this way, **including the dependent claims (which are not mentioned in the Response at all**).

EX2009 at 5-7. "Devices executing CGAgent connect via a computer network to an access point (e.g. switch). §3.2.2 discloses the use of the 802.1X protocol." EX2009 at 7-9. CyberGatekeeper server (CGS), "asks CGAgent to start [an] audit." EX2009

At best, PO includes a few partial claim terms in its Response, but never does it analyze (to borrow a concept from anticipation) the claim limitations "arranged or combined in the same way as recited in the claim." *Net MoneyIN, Inc. v. VeriSign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008). Conception is the formation in the mind of the inventor of "a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." *Purdue Pharma L.P. v. Boehringer Ingelheim GMBH*, 237 F.3d 1359, 1365 (Fed. Cir. 2001). Conception must include every feature or limitation of the claimed invention. *Slip Track Sys., Inc. v. Metal–Lite, Inc.*, 304 F.3d 1256, 1263 (Fed. Cir. 2002) (citing *Kridl v. McCormick*, 105 F.3d 1446, 1449 (Fed. Cir. 1997)). *See also Coleman*, 754 F.2d at 359 ("[I]n establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception").

PO failed to demonstrate conception **in its Response** because it failed to demonstrate "every feature or limitation of the claimed invention." The fact that it included a separate declaration or separate claim chart does not relieve PO of its

burden to provide that detailed analysis in its Response. The Board's failure to enforce its rules against incorporation by reference was an abuse of discretion.

B. PO's Claim Construction Analysis Related to Conception Is Not Present in Its Response

In the Response, PO attempts to distinguish the prior art based on constructions related to the phrase "*configuring the communication port.*" Response, 12-13, 18-222. It devotes approximately 7 pages to that analysis, but does not identify where these claims terms as construed can be found in the alleged conception document. But even if that analysis exists—and it is not clear that it does—it can be found only in either of Exhibits 2007 or 2009, because none of that analysis is present in the Response.

For example, PO asserts that the claimed "*configuring the communication port*" "as part of applying a security policy" refers to "changing the configuration of the previously configured access point. Importantly, the claims specify the access point itself is configured, not that the access point configures something else." Response, 12-13. None of these features, nor the phrase "*configuring the communication port*" appear anywhere in PO's conception analysis. Response, 66-68. To the extent it exists, it is in a different document. This is improper incorporation by reference and a violation of the Board's rules, and the Board's finding that the conception document discloses "*configuring the communication port*" was an abuse of discretion.

C. Much of PO's Diligence Analysis Is Not Present in Its Response

Like its conception analysis, PO's diligence analysis is buried in nearly 600 exhibits incorporated by reference into its Response, including in declarations and emails purportedly relating to the inventors over 10 months of diligence from December 2002 to October 2003 in reducing the purported invention to practice.

For much of the evidence, PO provides generic statements like "GTI corresponded further on January 8-10, 2003" (citing three emails, EX2053-EX2055) in its Response as evidence that "InfoExpress explored and negotiated collaboration with GTI for a port-configuration solution eventually relating to the reconfiguring of the access point." Response, 70. This limited analysis left it to Petitioners (and the Board) to dig through the hundreds of emails to parse what evidence was directly related to diligence and thus improperly shifted that burden to Petitioner (and the Board). As another example, PO's vague explanation that its diligence, including that it "explored and negotiated collaboration" with GTI for months regarding a port-configuration, is not consistent with the "*[re]configuring the communication port*" limitation or its construction. If that analysis exists, it is not in the Response.

Additionally, in response to Petitioners' challenge of the sufficiency of this evidence, PO responded with a new argument that "the GTI collaboration is independently sufficient to satisfy the diligence period," and took a sampling (of 5 emails) of the nearly 600 exhibits it attached to its Response and highlighted the

term "SNMP" (simple network management protocol) as evidence purportedly showing those emails were related to diligence. Sur-Reply, 29-37. Not only was this a new argument in violation of 37 C.F.R. § 42.23(b), but it also failed to explain how the evidence was directly related to the diligence. PO's sampling of 5 emails over the 10-month diligence period in its Sur-Reply underscores its earlier failure.

The "compelling reasons" for prohibiting incorporation by reference are present here. *Parus Holdings*, 70 F.4th at 1372. After Petitioners dug through the mountain of unexplained evidence submitted by PO, it discovered that PO's diligence calendar was riddled with evidence that was either a) irrelevant to the CyberGatekeeper project or b) disproving of PO's conception theory. Reply, at 26-29 (Lum testifying that certain emails cited in the diligence calendar were related to the "CyberArmor" project, not "CyberGatekeeper LAN"). At the hearing, PO suggested to the Board that it should "discount" such unrelated evidence without ever specifying which evidence needed to be discounted. Decision, 41-42. Thus, apart from being improperly incorporated by reference, the diligence calendar and the associated exhibits were admitted by PO to contain irrelevant exhibits.

PO tacitly recognized its violation of the Board's rules in footnote 5 of its Sur-Reply arguing that "Petitioner casts certain diligence evidence as unrelated CyberArmor correspondence," but "never challenges the actual substance of the evidence." Sur-Reply at 29, n.5. Yet *PO* held the burden to establish that the relied-

on evidence was directly related, not Petitioners. *In re Magnum Oil Tools Int'l, Ltd.*, 829 F.3d 1364, 1376 (Fed. Cir. 2016) ("[A] patentee bears the burden of establishing that its claimed invention is entitled to an earlier priority date than an asserted prior art reference.").

PO further argued that the evidence was related "since the vast majority of evidence references the NDCA project name." Sur-Reply, at 29, n.5. But "NDCA" is not mentioned a single time in the Response. Again, through its incorporation by reference, PO shifted the burden to Petitioners to connect the dots. And instead of holding PO to its burden, the Board accepted PO's incorporation by reference to its "diligence calendar" which was submitted to corroborate the inventor's testimony, but the inventor never reviewed this evidence to distinguish which items did or did not relate to the patented invention. Reply, 26-27. The Board permitting such incorporated arguments was an abuse of discretion.

D. Petitioners Were Significantly Prejudiced by the Board Permitting PO to Violate Its Rules

The violation of the Board's rule against incorporation by reference is significantly prejudicial to Petitioners. It is particularly prejudicial here given that PO admittedly exceeded the word count by 534 words in its Response—*see* March 5, 2025 Letter from PO's Counsel Brian Landry to the Board, and March 6, 2025 Letter from Andrew Kellog to the Parties (which the Board did not enter as an exhibit but Petitioners are available to provide and file). It is also significantly prejudicial

because PO filed nearly 600[2] exhibits. If PO had needed even more room to explain its positions, it could have sought leave to exceed its word count under 37 C.F.R. § 42.24(a)(2) or reallocated more of its briefs to its antedating arguments. It did not do so, and Petitioners should not be left to suffer the consequences of its violation of the Board's rules (and the Board permitting such violation).

Dated: November 6, 2025

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[2] Nearly all exhibits filed by InfoExpress related to conception and diligence were not produced in the parallel District Court case despite InfoExpress's obligation to do so. Indeed, InfoExpress represented multiple times in the District Court that the priority date of the '444 Patent was the filing date of the provisional, and never previously asserted an earlier date in the parallel District Court litigation.

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e), I hereby certify that on this 6th day of November, 2025, I caused to be served a true and correct copy of the via electronic service on the following:

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