

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

**PATENT OWNER'S RESPONSE TO
PETITIONERS' REQUEST FOR DIRECTOR REVIEW**

TABLE OF CONTENTS

I.	Background.....	1
II.	Legal Standard.....	3
III.	PO’s antedating evidence and argument were properly set out in its POR.....	3
	A. The POR details conception evidence and argument for the claims.....	4
	B. The Board is permitted to review exhibits when the POR sets forth the evidence and argument.	6
	C. Petitioners’ reliance on uncited portions of the Smith Declaration (EX2007) and the LAN Specification (EX2011) shows they had no trouble accessing the evidence.	8
	D. Petitioners agreed that PO’s demonstratives included conception arguments and evidence in the POR.	8
	E. Each and every diligence exhibit is detailed in the POR as corroborating PO’s diligence.	10
IV.	The Board determined that claim construction was not necessary.	12
V.	Petitioners forfeited these arguments.	13
VI.	Petitioners were not prejudiced.	14

TABLE OF AUTHORITIES

FEDERAL CASES

<i>Aortic Innovations LLC v. Edwards Lifesciences Corp.</i> , 2025 WL 2999367 (Fed. Cir. Oct. 27, 2025)	14
<i>Guardant Health, Inc. v. Vidal</i> , 2023 WL 3262962 (Fed. Cir. May 5, 2023)	7
<i>QuikTrip West, Inc. v. Weigel Stores, Inc.</i> , 984 F. 3d 1031 (Fed. Cir. 2021)	14
<i>Radar Indus., Inc. v. Cleveland Die & Mfg.</i> , 424 F. App'x 931 (Fed. Cir. 2011) ...	14
<i>Rembrandt Diagnostics, LP v. Alere, Inc.</i> , 76 F.4th 1376 (Fed. Cir. 2023)	3
<i>SmithKline Beecham Corp. v. Apotex Corp.</i> , 439 F.3d 1312 (Fed. Cir. 2006)	14
<i>In re Stryker</i> , 435 F.2d 1340 (C.C.P.A. 1971)	6

BOARD DECISIONS

<i>Apple Inc. v. Spacetime 3D, Inc.</i> , IPR2023-00344, Paper 47 (PTAB July 2, 2024)	7, 8
<i>Google LLC v. Parus Hldg. Inc.</i> , IPR2020-00846, Paper 14 (PTAB Jan. 13, 2021)	7, 8
<i>Sage Prods., LLC v. PureWick Corp.</i> , IPR2020-01426, Paper No. 30 (PTAB Feb. 14, 2022)	6, 7
<i>W. Digital Techs., Inc. v. Godo Kaisha IP Bridge I</i> , IPR2024-01384, 2025 WL 808198 (PTAB Mar. 13, 2025)	7

FEDERAL STATUTES

35 U.S.C. § 318	3
-----------------------	---

FEDERAL REGULATIONS

37 C.F.R. § 42.6(a)(3)	6, 7
37 C.F.R. § 42.75(a)	3

OTHER AUTHORITIES

U.S. Patent and Trademark Office, <i>Director Review</i> , https://www.uspto.gov/patents/ptab/decisions/director-review-process	3
---	---

The Board properly held all challenged claims not unpatentable. Paper 56 (Final Written Decision (“FWD”)). Petitioners’ Request (Paper 60) is mere dissatisfaction rather than any genuine basis for additional review. The Request—an unsupported “incorporation by reference” challenge—pushes newly raised theories and tries to manufacture a procedural challenge for appeal.

The Director should deny the Request—a retread of that in IPR2024-00539. This is because *the POR established* conception, reasonably continuous diligence, and reduction to practice (Paper 20)—much of which Petitioners *already conceded* and which the Board understood. Further, the Request is riddled with many never-before-raised arguments, and Petitioners were not prejudiced.

I. Background

Patent Owner InfoExpress (“PO”) conceived of the claimed invention no later than November 14, 2002, and exercised reasonably continuous diligence toward a constructive reduction to practice on October 21, 2003. FWD, 14–44; POR, 65–81. Accordingly, the applied references are not prior art. FWD, 43.

The history between the parties is long. Petitioner Cisco tried to create a Network Access Control (“NAC”) product, but failed. POR, 42. Then, Cisco resorted to mining technical information from PO under the mask of a collaboration. *Id.* Cisco studied PO’s technical work, praised it, and copied it. Having what it needed, Cisco abruptly ended the link and launched its copied NAC. *Id.*, 42–65.

PO sued Petitioners in 2023. *See, e.g.*, Paper 1 (Petition (“Pet.”)), 1. Petitioners filed their Petition in 2024—over ten years after the 2013 grant of the challenged patent. EX1201. The Board instituted on October 11, 2024. Paper 13. Petitioners filed—and lost—seven IPRs collectively challenging six of PO’s patents.

PO’s antedating argument relied on declarations from both inventors, an expert, and over 250 *corroborating* exhibits. POR, 66–81 (citing, e.g., EX2564 (Lum Decl.), EX2429 (Lee Decl.), EX2007 (Smith Expert Decl.); EX2011 (“LAN Specification”)). These are *all discussed in the POR body*.

Petitioners took five depositions including those of inventors Mr. Lum and Ms. Lee and of expert Dr. Smith. EX1223, EX1225; EX1226.

Petitioners *did not* serve any objections to any of InfoExpress’s evidence. Petitioners *did not* file any motion to exclude. Petitioners *did not* submit competing expert testimony. Petitioners also *did not* object to any demonstratives regarding the antedating evidence. In short, Petitioners agreed to the relevance, authenticity, and allowability of *every exhibit* EX2006, EX2011–410, EX2430–44, and EX2557–63.

After 18 months of briefing, depositions, and oral argument, the Board issued its careful FWD finding that Petitioners failed to “show[] by a preponderance of the evidence” that either reference was prior art. *See* FWD, 43. The Board reached the same conclusion in the other instituted IPRs. IPR2024-00539, Paper 60; IPR2024-00675, Paper 56; IPR2024-00676, Paper 54; IPR2024-00679, Paper 56.

II. Legal Standard

37 C.F.R. § 42.75(a) provides for Director Review of final decisions under 35 U.S.C. § 318 “limited to [those] presenting [] an abuse of discretion...” among other reasons. U.S. Patent and Trademark Office, *Director Review*.¹ “An abuse of discretion is found if the decision: (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.” *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1382 (Fed. Cir. 2023) (cleaned up).

III. PO’s antedating evidence and argument were properly set out in its POR.

Petitioners’ Request is a misdirected “incorporation by reference” argument. This summarily fails. **First**, the body of the POR details the antedating evidence and argument. This is dispositive. **Second**, the Board relied on the POR and its accompanying exhibits and evidence. It is permitted to do this, and it understood PO’s antedating argument. Nothing in FWDs suggests that the panel felt forced “to play archeologist with the record.” **Third**, Petitioners relied upon the same evidence in their Reply, which they now complain of in their Request—thus undermining their

¹ <https://www.uspto.gov/patents/ptab/decisions/director-review-process>

argument that PO’s evidence was buried or inaccessible. *Fourth*, Petitioners never raised any of these issues before. Now—at the Director Review stage—is too late.

A. The POR details conception evidence and argument for the claims.

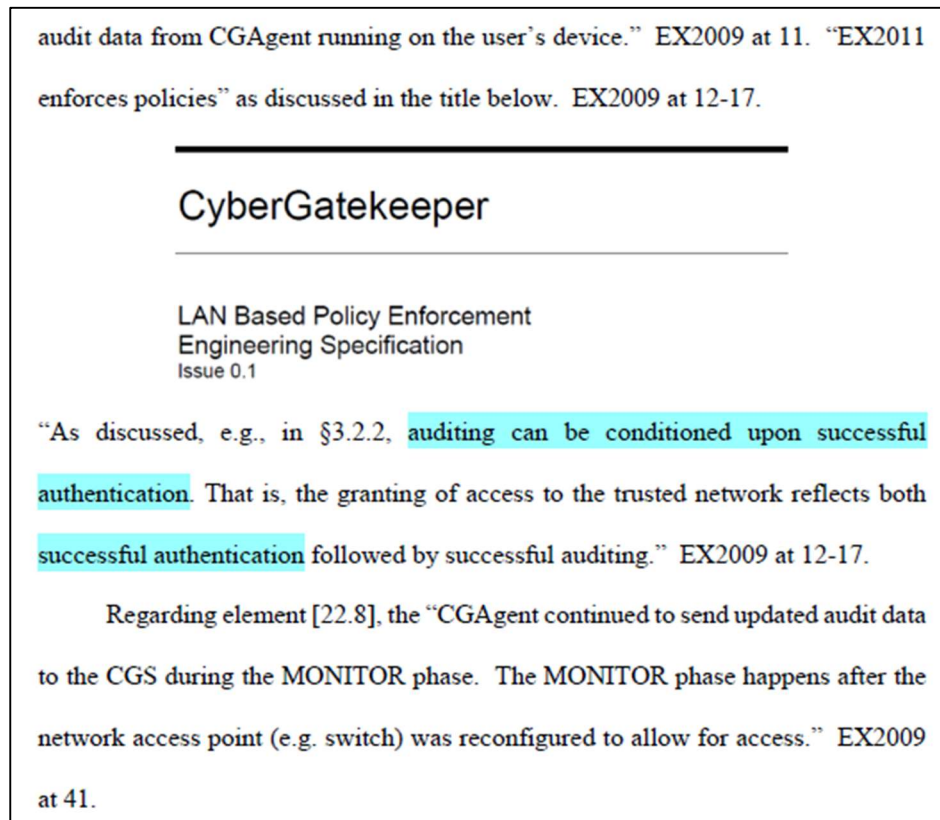
While the Request is a sweeping attack on “every feature or limitation of the claimed invention,” *id.*, 6–7, it only identifies a single limitation purportedly missing from the POR analysis: “performing an authentication using an EAP protocol from the device, the device being connected via a computer network to an access point configured to use an 802.1x protocol.” *Id.*, 9–10. Petitioners never challenged this claim limitation during the IPR. *See* Reply (Paper 36), 21–26.

But the POR *expressly* explains authentication using an Extensible Authentication Protocol (“EAP”). It discusses EAP in the lines preceding Petitioners’ cutoff:²

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

² Petitioners’ Request on page 10 uses a misleading snippet of the POR that omits the discussion of EAP—perplexingly, given that page 7 uses the full paragraph.

POR, 67 (cited in Request, 10). Thus, Petitioners’ hollow conclusion that the POR argued “nothing about EAP” is dead wrong. *Id.*, 9–10. Further, the POR at 68 goes on to discuss other evidence of authentication, including through EAP:



Petitioners specify no other supposedly missing claim limitations. This is telling because the POR explains them. For example, independent claims 1 and 22 also recite the following elements, which are addressed in the POR:

Claim Element	POR Discussion
“sending a request for audit data to an agent running on the device” EX1201, 16:14–15; 17:14–15.	“CyberGatekeeper server (CGS), ‘asks CGAgent to start [an] audit.’” POR, 67 (quoting EX2009 at 10).
“receiving the audit data at a gatekeeper...” <i>Id.</i> , 16:16–19; 17:16–19	“CGS (the gatekeeper configured to control access to a network) receives audit data from CGAgent running on the

Claim Element	POR Discussion
	user’s device.” EX2009 at 11 (quoted in POR, 67–68)
“applying a security policy...” <i>Id.</i> , 16:20–24; 17:20–25	““EX2011 enforces policies’ as discussed in the title [CyberGatekeeper LAN Based <i>Policy Enforcement</i> Engineering Specification].” POR, 68 (quoting EX2009 at 12–17) (cleaned up).
“receiving...updated audit pertaining to the device while the device has access to a less-restricted subset of the network; and re-auditing the device in accordance to the security policy using the received updated audit data.” 17:26–30 (claim 22 only)	“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.’” POR, 68 (quoting EX2009 at 41)

Indeed, Petitioners have not identified any claim elements in their Request that are unsupported in the POR. This also holds true for the dependent claims, which get a passing mention in Petitioners’ Request. *Cf. In re Stryker*, 435 F.2d 1340, 1341–42 (C.C.P.A. 1971) (“It cannot be the law that the same affidavit is insufficient to remove the same reference applied against the slightly narrower claims.”).

B. The Board is permitted to review exhibits when the POR sets forth the evidence and argument.

Petitioners push a brightline rule to prohibit the Board from looking beyond the four corners of the POR. Request, 1. This is not the law.³ 37 C.F.R. § 42.6(a)(3)

³ *Sage Prods., LLC v. PureWick Corp.*, IPR2020-01426, Paper No. 30 at 50 (PTAB Feb. 14, 2022) (“[N]othing in our rules forbids the declaration from having more

provides that “[a]rguments must not be incorporated by reference.” Legal arguments are made in the brief, by marshaling evidence supporting a proposition. PO argued conception in its POR by doing exactly this: describing how each claim element was present in EX2011, supported by citations to EX2011 and expert testimony in EX2009. The Federal Circuit approves. *Guardant Health, Inc. v. Vidal*, 2023 WL 3262962, at *5 n.4 (Fed. Cir. May 5, 2023) (not improper when “response brief *map[ped]* claim [] elements to [embodying product] by relying on the evidence and expert declaration, ***not by incorporating legal arguments***”). The PTAB agrees. *W. Digital Techs., Inc. v. Godo Kaisha IP Bridge I*, IPR2024-01384, 2025 WL 808198, at *16 (PTAB Mar. 13, 2025) (no improper incorporation when “[p]etitioner *ma[de]* arguments and cite[d] to portions of [a] declaration, which is evidence—not argument”) (citing *Guardant*).

Petitioners’ authorities describe the opposite situation—where the Board refused to review baldly cited evidence. *Apple Inc. v. Spacetime 3D, Inc.*, IPR2023-00344, Paper 47 at 70 (PTAB July 2, 2024) (*see* Request, 8), had a patentee conceding on sur-reply that its “nexus” arguments were not in its POR. In *Parus* (Request, 3, 13), the Board refused to consider the patentee’s assertion of conception in a single paragraph with a bald citation to a declaration. *Google LLC v. Parus Hldg.*

detail and reasoning to support the testimony of the declarant.”)

Inc., IPR2020-00846, Paper 14 at 31–32 (PTAB Jan. 13, 2021).

Unlike *Parus* and *Spacetime*, the Board here had no problem understanding the evidence in the POR. Indeed, PO’s conception argument spans pages and contains multiple details from and citations to both Smith’s declaration and EX2011. The POR does not have an incorporation problem.

C. Petitioners’ reliance on uncited portions of the Smith Declaration (EX2007) and the LAN Specification (EX2011) shows they had no trouble accessing the evidence.

Petitioners’ claim of “prejudice[,]” *see* Request, 14, is belied by the fact that their Reply relies expressly on *uncited* portions of EX2011 and Dr. Smith (EX2007).

The Reply argues around an *uncited and not relied on* “Figure 3” of EX2011. Reply,

24. It further contorts other *uncited* portions of EX2007:

- “InfoExpress’s experts agree...[that the patented solution] was to reconfigure the access point so that network traffic ‘can pass from the access device to the less-restricted subset of the network without needing to pass through the gatekeeper.’” *Id.*, 22 (quoting Smith Decl. (EX2007), 13).
- “InfoExpress’s expert Smith...opines that the ‘trusted network’ is a ‘less restricted subset,’...” *Id.*, 25 (quoting EX2007, 14).
- “Smith’s opinion that ‘a DMZ is an example of a “restricted subset”’ [sic] is also incorrect.” *Id.*, 25 (quoting EX2007, 16).

Put differently, Petitioners scoured the evidence, relied on it, and argued it. They cannot now claim that that same evidence was off-limits to the Board.

D. Petitioners agreed that PO’s demonstratives included conception arguments and evidence in the POR.

As set forth in Section V, Petitioners forfeited all the brand-new arguments

they try to shoehorn into their Request. In addition to never raising *any* evidentiary objections, they also never objected to PO’s conception demonstratives (Paper 46), which detail, *e.g.*, conception of a less-restricted subset and access to a protected network (slides 117–20, 129), a restricted subset (121–28), EAP authentication (130–32), switches and/or access points (130–32), applying a security policy and auditing (137–39), (re)configuring (140), using a single gatekeeper (141–42), and updating and monitoring (143–44).⁴ Slide 118 is EX2011 showing possession of a less-restricted subset of a protected network by citation, *e.g.*, to EX2011’s disclosure of VLANs “to break up your existing LAN into multiple logical segments...”.

EX2011 Shows the Inventors’ Possession of a Less-Restricted Subset

2 Overview

Users can access the corporate network from their systems on the LAN that may have the following security capability:

- **Port Filtering**
Switches have ports that connect all the nodes on a network, and allow communication between them. The switch’s Access Control List (ACL) can be programmed to allow users to access the trusted network only if connections are from ports with certain IP addresses (IP Port Filtering) or MAC addresses (MAC-address Port Filtering).
- **VLAN**
Switches provide dedicated bandwidth at every port. They can also be used for segmenting your network. You can use VLANs (Virtual Local Area Network) to break up your existing LAN into multiple logical segments, which are isolated from each other so that traffic from one cannot flow into the other. A VLAN can be created based on ports, MAC address, Layer 3 protocols, or IP multicast. E.g. with port-based VLANs you can take several ports from a switch or switches, and put them in one VLAN. Each VLAN would be isolated from the rest and the traffic won’t flow out of it.
- **802.1X**
Extensible Authentication Protocol (EAP) defines a standard message exchange that allows a server to authenticate a client based on an authentication protocol agreed. It’s a general protocol to support multiple authentication mechanisms over wired and wireless network. Supported authentication mechanisms include EAP-MD5, EAP-TLS, EAP-TTLS, PEAP, LEAP. IEEE 802.1X is a standard for passing EAP over a wired or wireless LAN for port-based network access control. The following shows mixed 802.1X protocol deployment in a LAN network with EAP-MD5, EAP-TTLS and LEAP authentication mechanisms supported:

See ‘460 Patent POR at 66; ‘460 Patent Sur-Reply at 21-23; ‘444 Patent POR at 68; ‘444 Patent Sur-Reply at 19-21; ‘450 Patent POR at 63; ‘450 Patent Sur-Reply at 18-20; ‘484 Patent (-00675 IPR) POR at 66; ‘484 Patent (-00675 IPR) Sur-Reply at 21-23; ‘484 Patent (-00679 IPR) POR at 65; ‘484 Patent (-00679 IPR) Sur-Reply at 21-23.

EX2011 at 5 (annotated); see also EX2007 (Hugh Smith Report), ¶ 28(a) (460 Patent), ¶ 33(a) (other IPRs).

Cisco Systems, Inc. and Fortinet, Inc. v. InfoExpress Inc., IPR2024-00539, -00675, -00676, -00677, -00679
Patent Owner’s DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

118

⁴ Petitioners carefully scrutinized PO’s demonstratives for alleged extensions beyond the POR, but did not lodge any objections to any of the antedating slides.

Similarly, slide 132 is EX2011 showing possession of the claimed “802.1x” and “EAP” authentication, by disclosing EAP “defines a standard message exchange that allows a server to authenticate a client based on an authentication protocol agreed.”

EX2011 Shows the Inventors' Possession of Switches and/or Access Points

2 Overview

Users can access the corporate network from their systems on the LAN that may have the following security capability:

- **Port Filtering**
Switches have ports that connect all the nodes on a network, and allow communication between them. The switch's Access Control List (ACL) can be programmed to allow users to access the trusted network only if connections are from ports with certain IP addresses (IP Port Filtering) or MAC addresses (MAC-address Port Filtering).
- **VLAN**
Switches provide dedicated bandwidth at every port. They can also be used for segmenting your network. You can use VLANs (Virtual Local Area Network) to break up your existing LAN into multiple logical segments, which are isolated from each other so that traffic from one cannot flow into the other. A VLAN can be created based on ports, MAC address, Layer 3 protocols, or IP multicast. E.g. with port-based VLANs you can take several ports from a switch or switches, and put them in one VLAN. Each VLAN would be isolated from the rest and the traffic won't flow out of it.
- **802.1X**
Extensible Authentication Protocol (EAP) defines a standard message exchange that allows a server to authenticate a client based on an authentication protocol agreed. It's a general protocol to support multiple authentication mechanisms over wired and wireless network. Supported authentication mechanisms include EAP-MD5, EAP-TLS, EAP-TTLS, PEAP, LEAP. IEEE 802.1X is a standard for passing EAP over a wired or wireless LAN for port-based network access control. The following shows mixed 802.1X protocol deployment in a LAN network with EAP-MD5, EAP-TTLS and LEAP authentication mechanisms supported.

See '460 Patent POR at 66, '460 Patent Sur-Reply at 23-25; '444 Patent POR at 67-68, '444 Patent Sur-Reply at 22-24; '450 Patent POR at 63, '450 Patent Sur-Reply at 21-23; '484 Patent (-00675 IPR) POR at 66; '484 Patent (-00675 IPR) Sur-Reply at 23-25; '484 Patent (-00679 IPR) POR at 65; '484 Patent (-00679 IPR) Sur-Reply at 24-26.

EX2011 at 5 (annotated); see also EX2007 (Hugh Smith Report), ¶ 29(a) (460 Patent), ¶ 34(a) (other IPRs).

Cisco Systems, Inc. and Fortinet, Inc. v. InfoExpress Inc., IPR2024-00539, -00675, -00676, -00677, -00679
Patent Owner's DEMONSTRATIVE EXHIBIT – NOT EVIDENCE

132

Thus, these were the issues discussed by the Board, Petitioners, and PO. Indeed, Petitioners never raised any incorporation by reference issue to the Board because there was none.

E. Each and every diligence exhibit is detailed in the POR as corroborating PO's diligence.

The POR quotes Inventor Lum's ground-breaking idea from October 7, 2002:

“All, It may be possible to use 802.1x to audit [enforce] a system rather than switching them between VLANs. There's an authentication specific component in 802.1x, so we might be able to use that instead of VLANs.” POR, 69 (quoting EX2015, EX2016).

These inventions were memorialized in EX2011. The POR explains that “InfoExpress diligently reduced the inventions to practice from conception until constructive [reduction to practice]...Diligence is shown by evidence including: i. emails; ii. Technical specifications and analyses; and iii. the declarations of [inventors] Lum (EX2564) and...Lee (EX2429).” *Id.*

Indeed, Petitioners already conceded applicability of a significant amount of the diligence evidence, *i.e.*, everything after “late March[.]” Paper 53, 123:5–9.⁵ Notwithstanding, Petitioners now backtrack to re-characterize the diligence evidence as “generic.” Request, 12. But InfoExpress identified, relied, and ***explained how all*** 250+ exhibits in its POR related to the claim limitations and corroborated diligence. For example, the POR explained the following for diligence towards the “802.1x” and “configuring” limitations:

- “InfoExpress tested and experimented with Cisco switches to evaluate potential authentication and **802.1X functionality [configuring] for use with the claimed gatekeeper.** EX2200; EX220.” POR, 72.
- “InfoExpress continued to work with GTI on **port-reconfiguration solution eventually relating to reconfiguring of access point.** GTI corresponded regarding updated status and design document on March 3, 2003. EX2290-EX2295. GTI provided a status report and source code on March 10, 2003. EX2296-EX2301. InfoExpress responded on March 11, 2003. EX2110. *See*

⁵ Petitioners at oral hearing: “Certainly, we don’t dispute that in July, or later, they were working on a CyberGatekeeper product and certainly showed some diligence in those later times.” Paper 53, 123:5–9.

also EX2111; EX2112. GTI provided status report and source code on March 17, 2003. EX2113; EX2114; EX2116; EX2117. InfoExpress responded on March 18 and 19, 2003. EX2118-EX2120. GTI provided updated status report and source code on March 24, 2003. EX2121-EX2123. Follow-up occurred on March 25, 26 and 31, 2003. EX2124-EX2128.” POR, 74

The other corroborating diligence in the POR is similarly detailed and complete.

Lastly, the Request spins confusion around “NDCA” correspondence. *Id.*, 14. PO’s citation to the NDCA on sur-reply was proper given Petitioners’ challenges on Reply, and considering the evidence itself included this specific acronym.⁶ Further, all of the PO and GTI exhibits are independently explained in the POR at 70–80.

IV. **The Board determined that claim construction was not necessary.**

Petitioners’ new construction-based argument made at Director Review is inapt. Request, 10. Petitioners’ claim-construction position was that “the Board *need not expressly construe the claim terms.*” Pet., 7. The Board ruled that it “‘*need not expressly construe the claim terms.*’” FWD, 10 (quoting Pet., 7). Petitioners got exactly what they wanted. Notwithstanding, they raise a new claim construction

⁶ Petitioners identify correspondence directed to a different PO product called CyberArmor. Request, 13–14. As PO explained, the CyberArmor correspondence was included because it was part of the correspondence PO had with its patent attorneys that happened to be discussing both the products. Paper 53, 119:2–120:7 (cited in FWD, 41–42).

issue regarding “configuring the communication port.” This claim-construction issue makes little sense. First, independent claim 1 of the ‘444 Patent does not even recite a “configuring” limitation. Second, as discussed above, the POR details conception of “(re)configuring” by way of its discussion of post-(re)configuration monitoring.⁷

“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.

POR, 68. There is no issue with the construction that Petitioners sought.

V. Petitioners forfeited these arguments.

Petitioners never raised any of these arguments. All Petitioners can do is point to a conclusory footnote in their Reply. *Id.*, 21 n.8 (“InfoExpress’s arguments as to the inventors’ conception and diligence are also improperly incorporated by

⁷ The Request recites “configuring the communication port,” which is not recited in any of the ‘444 Patent’s claims. This appears to be a copy-and-paste artifact. Nevertheless, it—along with the rest of the Request—is not applicable here.

reference for the same reasons described above.”) (cited in Request, 4–5). But this brief footnote provides no notice. And nothing in the Request was before the Board.

As explained by the Federal Circuit, “issues adverted to in a perfunctory manner, unaccompanied by some effort at developed argumentation, are...waived.” *Radar Indus., Inc. v. Cleveland Die & Mfg. Co.*, 424 F. App’x 931, 936 n.5 (Fed. Cir. 2011) (cleaned up); *Aortic Innovations LLC v. Edwards Lifesciences Corp.*, 2025 WL 2999367 at *6 (Fed. Cir. Oct. 27, 2025) (forfeiture where brief below “did not otherwise develop any argument”). This holds especially true for “arguments raised in footnotes, [which] are not preserved.” *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1320 (Fed. Cir. 2006). Even if Petitioners had not forfeited these arguments, the Board was not required to address every issue—or anticipate Petitioners’ novel permutations on Director Review—and “failure to explicitly discuss every issue...does not alone establish that the tribunal did not consider it.” *QuikTrip West, Inc. v. Weigel Stores, Inc.*, 984 F. 3d 1031, 1036 (Fed. Cir. 2021).

Petitioners’ attempt to incubate a single-sentence footnote into a 15-page litany of alleged faults to be litigated for the first time upon Director Review is fundamentally unfair to the Director, the Board, and PO.

VI. Petitioners were not prejudiced.

Petitioners’ “prejudice” section is nothing more than a word-count dispute. Request, 14. Petitioners received additional words. *See* Reply, 31. Indeed, in the very

same email chain that Petitioners cite, *see* Request, 14–15, the Board’s final word on the issue was to commend the parties for their self-resolution of the issue, noting it “appreciate[d] the parties’ candor and efforts to resolve the word-count issue amicably.”

Petitioners identify no other “prejudice.”⁸ Instead, after upsetting settled expectations by challenging a patent ten years after its grant, Petitioners laid in wait and now seek to delay and to manufacture issues they never developed during the IPR. Petitioners cannot use Director Review for a second bite at the apple.

⁸ Petitioners knew early on of PO’s critical date. In November 2023—well before the IPR petitions—PO explained to Petitioner Cisco that “inventors Stacey Lum and Alice Lee conceived of the inventions...on or around October 25, 2002[.]” Petitioners knew Krantz and Herrmann were not prior art but decided to use them anyway.

Respectfully submitted,

Dated: <u>November 17, 2025</u> Mailing address for all correspondence: Saul Ewing LLP 1735 Market Street, Suite 3400 Philadelphia, PA 19103-7504	<u>/Brian R. Landry/</u> Brian R. Michalek (Reg. No. 65,816) Saul Ewing LLP 161 North Clark Street, Suite 4200 Chicago, IL 60601 Tel: (312) 876-7151 brian.michalek@saull.com Joseph M. Kuo (Reg. No. 38,943) Saul Ewing LLP 161 North Clark Street, Suite 4200 Chicago, IL 60601 Tel: (312) 876-7151 joseph.kuo@saull.com Brian Landry (Reg. No. 62,074) Saul Ewing LLP 131 Dartmouth Street, Suite 501 Boston, MA 02116 Tel: (617) 912-0969 Brian.Landry@saull.com Andrew Schwerin (Reg. No. 72,999) Saul Ewing LLP 1735 Market Street, Suite 3400 Philadelphia, PA 19103 7504 Tel: (215) 972-7184 Andrew.Schwerin@saull.com Counsel for Patent Owner
---	---

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: November 17, 2025

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