

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.,
Petitioner,

v.

PORTSMOUTH NETWORK CORPORATION,
Patent Owner.

Case IPR2024-00913

Patent 8,014,394

PATENT OWNER'S PRELIMINARY RESPONSE

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Pursuant to 37 C.F.R. § 42.120, Patent Owner Portsmouth Network Corp. (“Patent Owner”) respectfully submits this Preliminary Response to the Petition filed by Petitioner Juniper Networks, Inc. (“Petitioner”) regarding U.S. Patent No. 8,014,394 (EX1001, “’394 patent”).

I. Introduction

The ’394 patent claims a novel and non-obvious system to forward multicast packets in a network. Response time is important for many multicast content applications, like television. For example, when a user switches from one television channel to another, the user’s set-top box must stop receiving one multicast packet stream and start receiving another multicast stream immediately, otherwise the user will notice a considerable delay. This issue becomes even more noticeable if the multicast content application must respond to multiple requests in quick succession.

The ’394 patent discloses techniques and methods to rapidly adapt to such requests to change multicast forwarding configurations. For example, the ’394 patent discloses storing lists in each processing unit indicating which multicast packet streams are allowed to be forwarded over the ports, distributing a multicast content request among multiple processing units, updating the lists for each processing unit, and selectively forwarding multicast packets based on the updated lists in each processing unit. The ’394 patent also discloses ways to adjust to other changes in the network, such as when a new line card is inserted. For example, the

claimed system may disable local ports of the newly-added line card and transmit a multicast status update request, which allows the newly-added processing unit to stay up-to-date.

Petitioner challenges Claims 1–2, 4, 6–7, 11–12, 14, and 16–17, including independent claims 1 and 11, under two different grounds. Petitioner challenges claims 1–2, 4, 6–7, 11–12, 14, and 17 under Ground 1 based on an obviousness combination of *Blease*, *Weyman*, and *Hu*. Petitioner challenges claim 16 under Ground 2 based on an obviousness combination of *Blease*, *Weyman*, *Hu*, and *Deng*. The various reference combinations, however, fail to disclose all of the '394 patent's independent claim limitations and thus fail to establish that any of the challenged claims are invalid.

While *Blease* generally relates to the transmission of multicast traffic, it does so differently than the '394 patent and fails to disclose all of the '394 patent's independent claim limitations. For example, *Blease* does not disclose “wherein operating the network element comprises aggregating two or more of the ports to form a high-capacity port, and wherein aggregating the ports comprises setting an upper limit on a number of the multicast packet streams that are permitted for forwarding over the high-capacity port” as required by claim limitations 1[f] and 1[g.i], and Petitioner appears to acknowledge this deficiency. *See, e.g.*, Petition at 27, 48-51.

Additionally, *Hu* does not disclose “wherein aggregating the ports comprises setting an upper limit on a number of the multicast packet streams that are permitted for forwarding over the high-capacity port” as required by claim limitation 1[g.i]. This deficiency applies to independent claim 1 and the claims which depend therefrom. Petitioner applies the same flawed logic and arguments for its analysis of independent claim 11 and thus Petitioner’s arguments for claim 11 and the claims depending therefrom also fail.

Because of these deficiencies, the Petition fails to establish a reasonable likelihood that Petitioner would prevail in showing the unpatentability of at least one claim.

Institution should also be denied under 35 U.S.C. § 314 based on the *Fintiv* factors. As explained below, of the six factors, five factors weigh in favor of discretionary denial and one factor is neutral.

As explained below, institution should also be denied under 35 U.S.C. § 314 based on the *General Plastic* factors for two reasons. First, Petitioner has requested *inter partes* review of claims 1–2, 4, 6–7, 11–12, 14, 16, and 17 and 8, 9, 10, and 18 in two parallel petitions, IPR2024-00913 and IPR2024-00989 (“the Parallel Petitions”). As explained below, the Parallel Petitions are unnecessary and place a significant burden on the Board. Further, institution should be denied because there

is already another IPR against the '394 patent that has been instituted. As is evidenced by Juniper Networks' Petition, Juniper Networks used the previously-filed IPR as a roadmap to its own petition. Juniper Networks' gamesmanship and harassment of Patent Owner through multiple serial petitions should not be rewarded with substantive consideration of its IPR Petition.

Accordingly, Patent Owner respectfully requests that the Board exercise its discretion and deny institution of the Parallel Petitions. To the extent that the Board refuses to deny institution of both petitions, Patent Owner respectfully requests that the Board exercise its discretion and deny institution of at least IPR2024-00913 for at least the reasons presented in Patent Owner's preliminary response.

II. Claim Construction

A court “look[s] to the words of the claims themselves ... to define the scope of the patented invention.” *Phillips v. AWH Corp.*, 415 F.3d 1303, 1312 (Fed. Cir. 2005) (en banc) (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996)). A claim term is generally given its “ordinary and customary meaning,” which is “the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention.” *Id.* at 1312–13. While courts may deviate from the plain and ordinary meaning in some circumstances, there is a “heavy presumption that a claim term carries its ordinary and customary meaning.” *CCS Fitness, Inc. v. Brunswick Corp.*, 288 F.3d 1359, 1366 (Fed. Cir. 2002) (internal

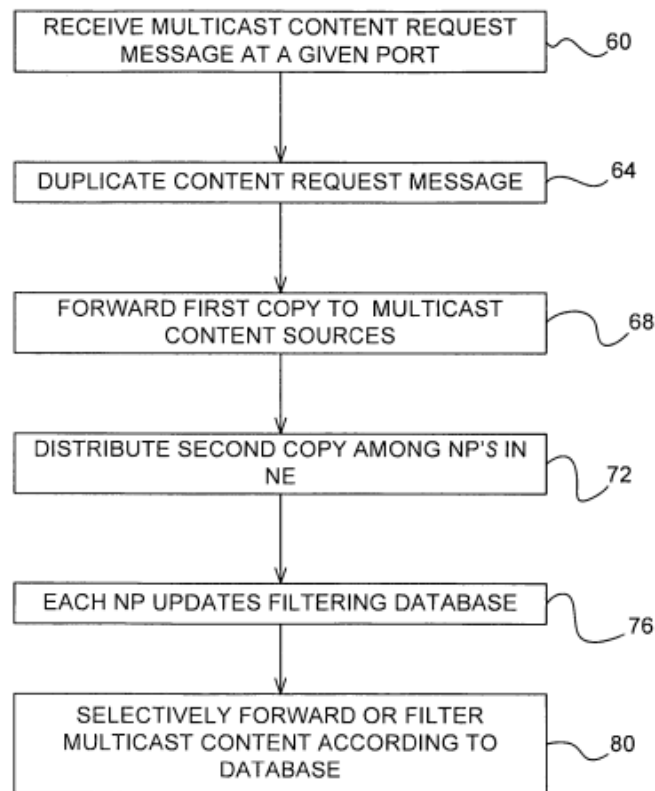
quotations omitted). Under this “exacting” standard, any departure from a claim’s ordinary meaning must be based on language that is “so unmistakable as to be unambiguous.” *Dealertrack Inc. v. Huber*, 674 F.3d 1315, 1322 (Fed. Cir. 2012) (citations omitted).

Here, at this stage in the proceeding, Patent Owner will apply the ordinary and customary meaning to the ’394 patent’s claim terms.

III. Overview of the ’394 Patent

The ’394 patent discloses “methods and systems for delivering multicast traffic over communication networks.” EX1001, 1:6–8. The ’394 patent discloses techniques to rapidly adapt to multicast forwarding requests. *Id.* at 4:60–62. For example, Figure 2 of the ’394 patent is reproduced below.

FIG. 2



EX1001, Figure 2.

Figure 2 of the '394 patent illustrates an exemplary method to respond to a multicast content request. A network element, such as a line card, may first receive a multicast content request (e.g., a request to start or stop receiving certain multicast content). The network element then duplicates the request and forwards a first copy of the request to multicast sources. A second copy of the request is distributed to network processors (e.g., processing units) in the network element. Each network processor that receives the second copy may then update their respective databases

accordingly. The network element may then selectively forward multicast content based on the updated databases. *Id.* at 7:27–8:35.

IV. Arguments

Petitioner challenges claims 1–2, 4, 6–7, 11–12, 14, 16 and 17. Petitioner challenges independent claims 1 and 11 with Ground 1. Independent claims 1 and 11 are reproduced below. For purposes of this Patent Owner Preliminary Response, independent claim 1 is representative of system claim 11.

1[pre] A method for communication, comprising:

1[a.i] operating a network element, wherein the network element further comprises multiple interconnected processing units and multiple ports,

1[a.ii] wherein each processing unit is assigned to a different subset of the multiple ports of the network element, and wherein each processing unit contains a processor for processing packets communicated over the different subset of the multiple ports to which the processing unit is assigned;

1[b] storing in each processing unit a respective list, each list indicating all of one or more multicast packet streams that are permitted for forwarding by the network element, and further indicating which of the one or more ports each multicast packet stream is permitted to be forwarded to;

1[c] receiving from a client a request relating to reception of a given multicast packet stream;

1[d] distributing the request among the multiple processing units within the network element, and updating the respective list in each processing unit responsively to the request; and

1[e] selectively forwarding multicast packets associated with the given multicast packet stream by the processing units in accordance with the respective updated lists,

1[f] wherein operating the network element comprises aggregating two or more of the ports to form a high-capacity port, and

1[g.i] wherein aggregating the ports comprises setting an upper limit on a number of the multicast packet streams that are permitted for forwarding over the high-capacity port,

1[g.ii] wherein the request indicates that the given multicast packet stream is to be forwarded over the high-capacity port, and

1[g.iii] wherein updating the list comprises modifying the list to indicate that the given multicast packet stream is permitted for forwarding over the high-capacity port only when the number of the multicast packet streams that are permitted for forwarding over the high-capacity port, including the given multicast packet stream, does not exceed the upper limit.

11[pre] A network element, comprising;

11[a] multiple ports; and

11[b.i] multiple interconnected processing units,

11[b.ii] wherein each processing unit is assigned to a different subset of the multiple ports of the network element, and

11[b.iii] wherein each processing unit contains a processor for processing packets communicated over the different subset of the multiple ports to which the processing unit is assigned,

11[b.iv] wherein the processing units are configured to process packets that are communicated over respective subsets of one or more of the ports,

11[b.v] to store respective lists, each of which indicates all of one or more multicast packet streams that are permitted for forwarding by the network element and further indicates which of the one or more ports multicast packet stream is permitted to be forwarded to,

11[b.vi] to receive from a client a request relating to reception of a given multicast packet stream, and

11[b.vii.α] to distribute the request among the processing units within the network element so as to update the lists responsively to the distributed request and

11[b.vii.β] to selectively forward multicast packets associated with the given multicast packet stream in accordance with the updated lists,

11[c.i] wherein two or more of the ports are aggregated to form a high-capacity port, and

11[c.ii] wherein an upper limit is set on a number of the multicast packet streams that are permitted for forwarding over the high-capacity port,

11[c.iii] wherein the request indicates that the given multicast packet stream is to be forwarded over the high-capacity port, and

11[c.iv] wherein the processing units are configured to update the lists to indicate that the given multicast packet stream is permitted for forwarding over the high-capacity port only when the number of the multicast packet streams that are permitted for forwarding over the high-capacity port, including the given multicast packet stream, does not exceed the upper limit.

As demonstrated below, Ground 1 of the Petition fails to teach claim limitations 1[f], 1[g.i.], 11[c.i] and 11[c.ii]. The Petition's failures with respect to independent claims 1 and 11 are repeated for Ground 2. Thus, Grounds 1 and 2 do not support institution because they fail to establish a reasonable likelihood that Petitioner would prevail in showing the unpatentability of the '394 patent's independent claims, and therefore also the claims which depend therefrom. Accordingly, the Board should deny institution.

- A. Ground 1 should be denied because *Blease* in view of *Weyman* and *Hu* fails to teach “wherein operating the network element comprises aggregating two or more of the ports to form a high-capacity port, and wherein aggregating the ports comprises setting an upper limit on a number of the multicast packet streams that**

are permitted for forwarding over the high-capacity port” (claim limitations 1[f] and 1[g.i])

As discussed above in connection with Section III, the ’394 patent discloses methods and systems for delivering multicast traffic over communication networks. *See supra*, Section III. For example, claim 1 of the ’394 patent discloses a method for communication involving the forwarding of multicast packet streams. *See* EX1001, claim 1. Therefore, the limitations of claim 1, including limitations 1[f] and 1[g.i], relate to the transmission of multicast packet streams.

Petitioner argues that *Blease* in view of *Weyman* and *Hu* discloses and/or renders obvious claim limitations 1[f] and 1[g.i]. Petition at 26-29, 45-51. With respect to limitation 1[f], which requires aggregating two or more of the ports to transmit multicast packet streams, Petitioner asserts that “Blease discloses that, for communications between a network switch 6 and a network device 4 (of which router 42 is an example), outputs from switch 6 are aggregated to form a high-speed link to the network device.” Petition at 26 (citing *Blease*, 4:18-27, 8:41-43); *see also id.* at 46 (“...Blease’s disclosure that a network switch may aggregate its outputs into a higher-speed link to a network device (e.g., to router 42) (*see* EX1005, 4:24-27)”). But the Petition does not establish that *Blease* discloses “wherein operating the network element comprises aggregating two or more of the ports to form a high-capacity port,” as required by claim 1.

In support of its argument, Petitioner relies on citations to *Blease* related to aggregating an output from a network switch to a network device. *See* Petition at 26, 46. For example, Petitioner asserts that “*Blease* discloses that, for communications between a network switch 6 and a network device 4 (of which router 42 is an example), outputs from switch 6 are aggregated to form a high-speed link to the network device.” *Id.* at 26 (citing EX1005, 4:18-27, 8:41-43). Such citations, however, just disclose that a Broadband Remote Access Server application may aggregate output from switches to a network device and that a router may operate similarly to network device 4, network device 24, or network device 38. They do not disclose “aggregating two or more of the ports to form a high-capacity port” or using such aggregation for forwarding multicast packet streams.

In fact, Petitioner’s citations, and *Blease* in general, do not even concern forwarding multicast traffic streams over a high-capacity port. Rather, *Blease* discloses aggregating outputs (*e.g.*, membership requests) from a network switch or subscriber device to a network device (*e.g.*, a router) and not to the end users who request multicast traffic. *See* EX1005, 4:24-27. *Blease* elaborates that its aggregated output forms an uplink to network device 4 and thus does not operate to allow for the forwarding of multicast packet streams to multicast content recipients. Indeed, the aggregated output described in *Blease* travels towards the network device 4 opposite the direction that multicast content should go, namely towards the

subscriber device. Therefore, it is clear that *Blease*'s aggregation does not aggregate two or more ports and is not related to the transmission of multicast packet streams.

Recognizing that *Blease* alone does not disclose limitation 1[f], Petitioner asserts that a POSA would have been motivated to modify *Blease*'s router links to include aggregated ports that form one or more high-capacity ports. *See* Petition at 26. Specifically, Petitioner points to *Hu* for this combination, and argues that *Hu* teaches aggregating a plurality of ports into a single logical port and that *Hu*'s aggregation of ports would help increase the utility of ports because they are able to carry more streams or support higher bitrates. *Id.*; *see also id.* at 46 (“A POSA would have been motivated to modify *Blease* to include aggregated ports in or among links 55A-55N and 56A-56N to, e.g., form high-bandwidth links and provide the ability to balance packets among aggregated ports, as discussed in §VII.A.4.”).

Petitioner also asserts similar arguments for limitation 1[g.i], which Petitioner also recognizes that *Blease* does not disclose. There, Petitioner asserts that a POSA would have been motivated to modify *Blease* “to include aggregated ports that form one or more high-capacity ports and to place limits on those ports.” *Id.* at 26; Petitioner asserts that a POSITA would look to *Hu* for this modification and explains that *Hu*'s link aggregation group would allow the quality of service to be maintained by “ensuring that a limit on the number of connections to a LAG are not exceeded.” *Id.* at 27. Petitioner further argues that a POSITA would have been motivated to

aggregate *Blease*'s ports into a LAG and "to limit the number of streams permitted over those groups to transfer more data (e.g., accommodating more streams or providing higher-quality streams)." *Id.*

However, Petitioner's argument that a POSITA would have been motivated to combine *Blease*'s router with *Hu*'s link aggregation group fails for both of these limitations. Contrary to Petitioner's assertions, *Blease*'s disclosure is clear that the focus of its multicast techniques is to **reduce**, not increase, the amount of multicast traffic flowing through the network. For example, *Blease* discloses that "[t]he multicast transmission techniques described herein may **significantly reduce the amount of multicast traffic** between network device 4 and network switches 6." EX1005, 4:50–52 (emphasis added). *Blease* seeks to limit the amount of multicast traffic flow in the network, which is precisely the opposite of the purported benefit of implementing *Hu*'s high-capacity ports. Therefore, *Blease* actually teaches away from utilizing *Hu*'s link aggregation groups.

Petitioner also argues that a POSITA would have been motivated to combine *Blease*'s router with *Hu*'s link aggregation group because "Blease already discloses aggregating outputs to create high-speed links." Petition at 28 (citing to *Blease*, 4:24-27). Petitioner mischaracterizes *Blease*'s disclosure. The cited portion of *Blease* states that "[a] Broadband Remote Access Server (BRAS) application may aggregate output **from switches 6 into a higher-speed uplink to network device 4.**"

EX1005, 4:24-27 (emphasis added). Although the cited portion of *Blease* mentions aggregating an output, *Blease* is clear that the aggregation is not for a high-capacity port allowing transmission of multicast traffic to subscriber devices. Rather, *Blease* discloses that an output is aggregated for an uplink from a network switch to a network device. *See id.* Additionally, *Blease* mentions aggregating forwarding membership requests to a network device rather than aggregating ports to form a high-capacity port. *See id.* at 5:52-55 (“Membership module 23 aggregates the membership requests from subscriber devices 20 and forwards the membership requests to network device 24 on mapping interface 25.”). Therefore, *Blease*’s disclosure of aggregation relates to a completely different issue than the link aggregation group discussed in *Hu* and it would not have been obvious to modify *Blease* in view of *Hu*.

Accordingly, the Petition fails to establish that limitation 1[f] is disclosed by *Blease* or rendered obvious by *Blease* in view of *Hu*. Claim limitation 1[g.i] suffers a similar fate as for that limitation, Petitioner does not rely on *Blease* at all, correctly recognizing that *Blease* does not disclose “wherein aggregating the ports comprises setting an upper limit on a number of the multicast packet streams that are permitted for forwarding over the high-capacity port.” Petition at 48–51, 63. Thus, Petitioner relies entirely on *Hu* for this element. *See id.* at 27; 48–51. But as it would not have

been obvious for a POSA to modify *Blease* in view of *Hu*, Petitioner’s proposed combination fails to disclose limitation 1[g.i].

Petitioner also cites to Dr. Lavian’s declaration in support of its arguments. However, the cited portions of the expert declaration merely parrot Petitioner’s flawed logic. *See* EX1003, ¶¶ 92–95. Nothing in the cited portions of *Blease*, *Weyman*¹, or *Hu* actually support Petitioner’s statements or provide any additional motivation to combine that establishes why a POSITA would be motivated to incorporate *Hu*’s link aggregation group in *Blease*’s system.

Therefore, Petitioner has failed to establish that *Blease* in view of *Weyman* and *Hu* discloses “wherein operating the network element comprises aggregating two or more of the ports to form a high-capacity port, and wherein aggregating the ports comprises setting an upper limit on a number of the multicast packet streams that are permitted for forwarding over the high-capacity port.”

Petitioner’s arguments with respect to claim 1 are repeated for claim 11. *See* Petition at 57–61 (citing only to the evidence of claim 1 for every claim limitation in claim 11). Accordingly, the Petition fails to establish a reasonable likelihood that Petitioner would prevail in showing the unpatentability of independent claims 1 and 11.

¹ Petitioner does not rely on *Weyman* for either limitation 1[f] or 1[g.i].

B. Ground 2 does not address any independent claims

Ground 2 addresses only dependent claim 16. Accordingly, it does not remedy the deficiencies in Petitioner’s arguments, as described above with respect to Ground 1.

C. The Board should use its discretion and deny institution under the *Fintiv* factors

Efficiency, fairness, integrity of the system, and the merits support the Board’s exercise of its discretionary denial authority under 35 U.S.C. § 314(a). Seeking to minimize duplication of work, the Board has set forth a set of nonexclusive factors for determining whether to deny a petition in view of parallel litigation (i.e., the “*Fintiv* factors”). *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper No. 11 (P.T.A. B. March 20, 2020) (“*Fintiv I*”). As explained in detail below, the *Fintiv* factors weigh in favor of discretionary denial in this case.

1. *Fintiv* Factor 1: The district courts have not granted a stay

Patent Owner agrees with Petitioner that this factor is neutral. Petitioner notes that it will seek a stay, but because no motion to stay has been granted, the Board should not infer the outcome of such a motion. *Sand Revolution II LLC v. Continental Intermodal Group – Trucking LLC*, IPR2019-01393, Paper No. 24 at 7 (P.T.A.B. June 16, 2020) (informative).

2. *Fintiv* Factor 2: The related Cisco trial is expected to take place approximately six months before the projected statutory deadline for a final written decision

Fintiv factor 2 weighs against institution. Even though the court has not yet entered a schedule or set a trial date for the Juniper case, this factor weighs against institution because trial in the related Cisco case is set to occur approximately 7 months before the projected statutory deadline for a final written decision. The projected statutory deadline for a final written decision in this IPR is around January 2026. Jury selection for the Cisco trial is currently scheduled for June 2, 2025. Thus, the district court trial is set to occur approximately 7 months before the projected statutory deadline for a final written decision. This weighs heavily against institution. *See Fintiv I*, IPR2020-00019, Paper No. 11 at 9 (“If the court’s trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under NHK.”).

Thus, this factor weighs in favor of discretionary denial.

3. *Fintiv* Factor 3: The parties will have invested significant resources in at least the Cisco trial

Fintiv factor 3, which considers the resources invested in the parallel district court proceeding, weighs in favor of the Board’s exercising its discretionary denial authority. Petitioner appears to wrongly limit its analysis of the parties’ investment in the district court proceedings to the stage of those proceedings at the time the petition was filed. Petition at 68. However, *Fintiv* dictates that the proper timeframe for this factor is the investment in the parallel proceeding at the time of the institution

decision. *Fintiv I*, IPR2020-00019, Paper No. 11 at 9–10. The institution decision in this proceeding is expected by January 18, 2025.

While Patent Owner acknowledges that no contentions have been exchanged between the parties in the related district court case against Petitioner, by January 18, 2025, Patent Owner will have expended significant resources in the related Cisco district court proceeding. Patent Owner and Cisco have already exchanged infringement and invalidity contentions for the '394 patent. Fact discovery has already begun under the district court's schedule and will conclude January 6, 2025, shortly before the institution decision is projected to be issued in this case. Furthermore, the claim construction process has already begun in the Cisco case, and Joint Claim Construction hearing is scheduled for December 4, 2024, a little over one month before the expected date of the institution decision.

Accordingly, because the Patent Owner will have expended significant resources by the time the Board issues an institution decision in this case, this factor weighs against institution.

4. *Fintiv* Factor 4: The issues in the petition and district court proceeding significantly overlap

Fintiv factor 4 weighs in favor of the Board's exercising its discretionary denial authority the issues in the Petition and the parallel district court proceeding overlap. Furthermore, Petitioner has not provided a *Sotera*-style stipulation or

stipulation of any kind regarding the estoppel effects of this proceeding in the district court proceeding.

Accordingly, this factor weighs in favor of exercising the Board's discretion to deny institution.

5. *Fintiv* Factor 5: Petitioner is a defendant in the district court proceeding

Fintiv factor 5 favors denial of institution because Petitioner is a defendant in a parallel district court proceeding. *Fintiv* factor 5 considers whether the Petitioner and the defendants in the parallel proceeding are the same party. *Fintiv I*, IPR2020-00019, Paper No. 11 at 6. Petitioner is the defendant in the case in which Patent Owner asserts infringement of the '394 patent. Thus, Factor 5 weighs in favor of denial.

Petitioner argues that this factor should be neutral because Petitioners in IPR proceedings are often defendants in litigation. *See* Petition at 68. Petitioner's argument is contrary to numerous Board decisions. For example, in *Nokia*, the Board unequivocally held that "Petitioner is the defendant in the parallel proceeding. Thus, this factor weighs in favor of exercising our discretion to deny the Petition." *Nokia of America Corporation et al. v. Godo Kaisha IP Bridge 1*, IPR2022-00755, Paper No. 9 at 13.

Furthermore, Petitioner's argument that this factor should not be a basis for denying institution despite having the same parties in the parallel district court

proceeding fails a simple logic test. If Petitioner’s argument were true, then this factor could *never* favor denial. Factors by their very nature lie along a scale of: weighing in favor, being neutral, or weighing against. Petitioner would have this Board remove this factor’s ability to weigh in favor of patent owners entirely and only provide benefits to Petitioner. Such a determination is contrary to the very nature of factors, is bad public policy, and likely only a power available to the Director.

For all the reasons above, *Fintiv* factor 5 favors denial of institution.

6. *Fintiv* Factor 6: Petitioner’s grounds do not rise to the level of “compelling evidence of unpatentability”

Fintiv factor 6 weighs against institution because, as shown above, the merits of the petition are weak and include numerous deficiencies, which cannot meet the high compelling merits standard needed to overcome *Fintiv* factors 1–5 strongly favoring denial of institution.

To meet the standard for a compelling unpatentability challenge, the Petition must present challenges “in which the evidence, if unrebutted in trial, would plainly lead to a conclusion that one or more claims are unpatentable by a preponderance of the evidence.” *Commscope Techs. LLC v. Dali Wireless, Inc.*, IPR2022-01242, Paper No. 23 at 3 (P.T.A.B. Feb. 27, 2023) (citing Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation at 4. (June 21, 2022) (“Guidance Memo”).) “[T]he compelling merits

standard is a higher standard than the standard for institution set by statute.” *Commscope Techs.*, IPR2022-01242, Paper No. 23 at 3 (citing Guidance Memo at 4–5). Under the compelling merits standard, “[a] challenge can only ‘plainly lead to a conclusion that one or more claims are unpatentable’ if it is **highly likely** that the petitioner would prevail with respect to at least one challenged claim.” *Id.* at 3–4 (quoting *OpenSky Indus., LLC v. VLSI Tech. LLC*, IPR2021-01064, Paper No. 102 at 49–50 (P.T.A.B. Oct. 4, 2022) (precedential)) (emphasis added).

The compelling merits determination does not replace a *Fintiv* analysis; rather, “PTAB panels ... only consider compelling merits if they first determine[] that *Fintiv* factors 1-5 favor[] a discretionary denial.” *Commscope Techs, LLC*, IPR2022-01242, Paper No. 23 at 4 (P.T.A.B. Feb. 27, 2023). Where the Board finds compelling merits, it “must provide reasoning to explain and support its determination as to compelling merits sufficient to allow the parties to challenge that finding and sufficient to allow for review of that decision.” *Id.* at 5–6. Here, *Fintiv* Factors 1–5 plainly favor discretionary denial thus requiring Petitioner to show compelling merits, which they cannot do.

As discussed above, Petitioner’s prior art grounds contain critical deficiencies and do not demonstrate a reasonable likelihood of—let alone plainly lead to—a conclusion that at least one claim is unpatentable. *See supra* Sections IV.A–B.

In sum, five factors (2–6) weigh in favor of discretionary denial, whereas one factor (1) is neutral. Accordingly, Patent Owner respectfully requests that the Board exercise its discretion and deny institution.

D. The Board should also use its discretion under Section 314(a) and the application of the *General Plastic* factors to deny institution

As discussed in connection with Section IV.C, the Director has discretion to deny a petition under 35 U.S.C. § 314(a). *See supra* Section IV.C. The Board may consider various factors when exercising discretion on behalf of the Director. *See General Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357 (PTAB Sept. 6, 2017) (Paper 19) (Section II.B.4.i. designated as precedential) (stating factors considered in Board’s exercise of discretion under 35 U.S.C. § 314(a)). As discussed below, the Petition should be denied under *General Plastic* for two reasons.

1. Maintaining parallel petitions is unnecessary and a significant burden on the Board

Although the facts in *General Plastic* related to serial petitions, the Board has applied the *General Plastic* factors to a variety of situations involving multiple IPR petitions being filed against the same patent, recognizing that maintaining multiple, parallel proceedings for one patent may place a substantial and unnecessary burden on the Board. *See, e.g., Comcast Cable Commc’ns, LLC v. Rovi Guides, Inc.*, IPR2019-00224, Paper 10 (PTAB Apr. 3, 2019) (“Maintaining multiple, concurrent

proceedings per patent presents a significant burden for the Board, because, among other things, the Board endeavors to assign all such cases to the same panel.”).

Here, Petitioner has requested *inter partes review* of claims 1-2, 4, 6-7, 11-12, 14, 16, and 17 and 8, 9, 10, and 18 in two parallel petitions, IPR2024-00913 and IPR2024-00989 (“the Parallel Petitions”). As expressly acknowledged in the Patent Trial and Appeal Board’s Consolidated Trial Practice Guide, however, “[b]ased on the Board’s experience, one petition should be sufficient to challenge the claims of a patent in most situations.” *See* Office Consolidated Trial Practice Guide, 84 Fed. Reg. 64280, 59 (Nov. 20, 2019) (“Practice Guide”). While the Board recognizes that there may be circumstances in which more than one petition may be necessary, and provides examples of (1) “when the patent owner has asserted a large number of claims in litigation,” or (2) “there is a dispute about priority date requiring arguments under multiple prior art references,” the Board is clear that “multiple petitions by a petitioner are not necessary in the vast majority of cases.” *Id.*

While Petitioner claims that two petitions are necessary “due to word count constraints and different limitations found in each of the independent claims of the ’394 patent,” these arguments fall flat. *See Juniper Networks, Inc. v. Portsmouth Network Corp.*, IPR2024-00913, Paper 3, 1–2 (PTAB May 31, 2024). Infringement contentions have not yet been served, Petitioner only challenges 14 claims, and there is no priority date dispute that would necessitate different invalidity grounds based

on multiple, differently dated, prior art references. In fact, Petitioner relies on the same prior art references raised in this Petition in the parallel petition (i.e., *Blease, Weyman, Hu, and Deng*). Further, every petition for *inter partes* review faces the same word count constraint, and to allow multiple petitions to circumvent the word count limit would render the word count limit itself meaningless.

Accordingly, Patent Owner respectfully requests the Board deny institution of both petitions.

2. The *General Plastic* factors favor denial in view of Cisco’s IPR against the ’394 patent

Institution should also be denied because there is already another IPR against the ’394 patent, IPR2024-00506, that has been instituted (“the Cisco IPR”). As explained below, denial of institution here is supported by each of the *General Plastic* factors.

a. Factor 1: Whether the same petitioner previously filed a petition directed to the same claims of the same patent

This factor favors denying institution because the Petition challenges the same claims of the same patent as the Cisco IPR petition and, while the Petitions are not filed by the same Petitioner, there is a significant relationship between Juniper and Cisco. As the Board has found, even if the petitioners are not the same, Factor 1 weighs against institution when there is a “significant relationship” between the parties that have filed the IPR petitions and the IPR petitions challenge the same

claims of the same patent. *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR 2019-00062, Paper 11 at 9–10 (PTAB Apr. 2, 2019) (precedential). That is the case here.

Juniper argues that there is no significant relationship between Juniper and Cisco, asserting that they have different interests that may involve unique claim constructions and infringement theories. *See* Petition at 70. Juniper’s assertion is mistaken. Juniper chose to use the Cisco IPR petition as a roadmap and thus “implicitly created such a relationship by using [Cisco’s] work as a menu and picking and choosing from their work product.” *Ericsson Inc. v. Uniloc 2017, LLC*, IPR2019-01550, Paper 8 at 11–12 (P.T.A.B. Mar. 17, 2020) (“The instant Petitioner’s decision to use the prior petitions as a roadmap for its own petition ties the interests of all of the petitioners together.”). For example, Juniper uses the same prior art reference, *Weyman*, as was asserted in the Cisco IPR . Further, it is undisputed that every claim Juniper challenges has already been challenged in the Cisco IPR.

Juniper’s Petition is the epitome of road mapping. Juniper had ample time to study and analyze the Cisco IPR petition and add additional prior art and obviousness arguments to those claim limitations that it deemed vulnerable to a denial of institution on the merits. Juniper’s gamesmanship in staggering its Petition after the Cisco IPR petition should not be rewarded with institution.

- b. Factor 2: Whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it*

Factor 2 also favors denying institution. Under the second *General Plastic* factor, the Board considers “whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it.” *General Plastic* at 9-10. Juniper does not specifically address this factor in its Petition.

Juniper cannot dispute that it had knowledge of, or should have known of, the prior art asserted in its Petition at the time the Cisco IPR petition was filed. Juniper acknowledges that it knew of the Cisco IPR petition and even uses the same prior art reference, *Weyman*, that was used in the Cisco IPR petition. *See* Petition at 5. The references that Juniper uses that are not in the Cisco IPR petition are *Blease*, *Hu*, and *Deng*. However, Juniper knew or should have known of two of the three references (i.e. primary reference *Blease* and *Deng*). For example, Juniper knew or should have known of *Blease* because *Blease* is assigned to Juniper. *See* Petition at 70. Furthermore, Juniper knew or should have known of *Deng* because *Deng* was disclosed and substantively discussed in the '394 patent prosecution history. Thus, it can be inferred that Juniper did know of, or should have known of, the prior art asserted in its Petition at the time the Cisco IPR petition was filed.

- c. Factor 3: Whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition*

Factor 3 is at least neutral. Patent Owner admits that when Juniper filed its Petition, Patent Owner had not yet filed its preliminary response in the Cisco IPR. Juniper, however, strategically delayed filing the instant Petition until two months after Cisco's IPR petition was filed. Petitioner should not be rewarded for its gamesmanship under Factor 3. Accordingly, Factor 3 should be at least neutral.

- d. Factor 4: The length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition*

Factor 4 also favors denying institution. Juniper makes no attempt to explain why it waited two months after Cisco filed its petition, which disclosed at least *Weyman*. See generally Petition. Juniper also does not explain why it waited to file its Petition despite knowing that *Deng* is included in the 394 patent's file history and that *Blease* is assigned to Petitioner. *Id.* Accordingly, this factor weighs in favor of denying institution. *Apple Inc. v. Uniloc 2017 LLC*, IPR2020-00854, Paper 9 at 11 (P.T.A.B. Oct. 28, 2020) ("Because of the lack of explanation, we conclude that this fourth General Plastic factor weighs in favor of denying institution of the proceeding.").

- e. Factor 5: Whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent*

This fifth factor also weighs in favor of denying institution because Juniper provides no explanation for the delay in filing this Petition. As stated above with respect to Factor 4, Juniper does not explain why it waited two months to file this Petition after the filing of the Cisco IPR petition, which first disclosed at least *Weyman*. Accordingly, this factor weighs in favor of denying institution. *Apple*, IPR2020-00854, Paper 9 at 11 (“For the same reasons stated above, for instance, Apple’s lack of explanation, we conclude that this fifth *General Plastic* factor also weighs in favor of denying institution.”).

- f. Factor 6: The finite resource of the Board*

There is already a pending *inter partes* review challenging all of the same claims of the ’394 patent based upon the same prior art reference *Weyman*. Juniper fails to explain why the Board should further extend its resources to consider an additional, substantially similar *inter partes* review. Instead of seeking to join Cisco’s IPR, Juniper instead waited two months after the Cisco IPR petition was filed to file its own similar Petition. Juniper’s gamesmanship is an unnecessary waste of the Board’s finite resources and should result in denial of institution.

- g. Factor 7: The requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after*

the date on which the director notices institution of review

There is no indication that the Board could not issue a decision within 1 year after institution. Although factor 7 may be considered neutral to the analysis, the remaining *General Plastic* factors (and, thus, the factors as-a-whole) clearly favor discretionary denial of Juniper's Petition.

Accordingly, Patent Owner respectfully requests the Board deny institution of both petitions. To the extent that the Board refuses to deny institution of both petitions, Patent Owner respectfully requests that the Board exercise its discretion and deny institution of at least IPR2024-00913 for at least the reasons presented in Patent Owner's preliminary response.

V. Conclusion

As discussed above, Petitioner has failed to establish a reasonable likelihood it will prevail in showing the unpatentability of the challenged claims. Accordingly, the Board should deny institution.

Date: October 18, 2024

Respectfully submitted,

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CERTIFICATION UNDER 37 C.F.R. § 42.24

Under the provisions of 37 C.F.R. § 42.24, the undersigned hereby certifies that the foregoing document contains 6,586 words, and thus complies with the word-count limits of 37 C.F.R. § 42.24.

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of the foregoing PATENT OWNER'S PRELIMINARY RESPONSE was served on October 18, 2024 by filing this document through the P-TACTS platform as well as by delivering a copy via the delivery method indicated to the attorneys of record for the Petitioner as follows:

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