

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLIGENT PROTECTION MANAGEMENT CORP.,
Petitioner,

v.

CISCO TECHNOLOGY, INC.,
Patent Owner.

Case IPR2025-01589
U.S. Patent No. 8,941,708

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL
AND *SOTERA*-PLUS STIPULATION**

TABLE OF CONTENTS

I.	PATENT OWNER’S FAILURE TO DISCLOSE ITS OWN KNOWN PRIOR ART DURING PROSECUTION OUTWEIGHS ANY SETTLED EXPECTATIONS AND FAVORS INSTITUTION	6
II.	PETITIONER’S IPR AND DISTRICT COURT CLAIM CONSTRUCTION POSITIONS ARE NOT INCONSISTENT	8
III.	THE DISTRICT COURT TRIAL DATE AND EXPERT DISCOVERY DEADLINES WEIGH IN FAVOR OF INSTITUTION	11
IV.	PETITIONER’S <i>SOTERA</i> -PLUS STIPULATION	12
V.	THE DIRECTOR IS RESPECTFULLY ASKED TO REFER THIS PROCEEDING TO THE MERITS PANEL	13

PETITIONER'S EXHIBIT LIST

Exhibit No.	Description
1001	U.S. Patent No. 8,941,708 (“the ’708 patent”)
1002	File History of U.S. Patent No. 8,941,708
1003	Expert Declaration of Omid Kia, Ph. D.
1004	U.S. Patent 8,421,840 (“Eleftheriadis”), issued Apr. 16, 2013, filed Jun. 9, 2009
1005	U.S. Patent Application Publication No. US 2010/0302130 (“Kikuchi”), published December 2, 2010
1006	U.S. Patent 6,950,097 (“Hojabri”), issued Sep. 27, 2005
1007	Excerpts from Mahemoff, “Ajax Design Patterns: Creating Web 2.0 Sites with Programming and Usability” (O’Reilly 2006) (“Mahemoff”), published June 2006
1008	U.S. Patent Application Publication No. US 2009/0015568 (“Koski”), published Jan. 15, 2009
1009-1010	Reserved
1011	Record of ’708 Patent Case Activity
1012	Reserved
1013	District Court Scheduling Order

In response to the Petition for *Inter Partes* Review (“IPR”) of claims 1-20 of U.S. Patent No. 8,941,708 (“the ’708 patent”), Patent Owner argues three reasons for discretionary denial: Petitioner’s claim construction positions, settled expectations, and the parallel district court litigation. None of these arguments counteracts the strong reasons for the Board to consider the merits in this proceeding—including to correct irregularities in the original prosecution—or otherwise compels discretionary denial.

Notably, during prosecution, neither the Patent Owner nor the Examiner recognized the simple truth that the ’708 patent is directed to a software-based *slider* that is used for selecting a video conference display layout. The word “slider” appears briefly in the specification of the ’708 patent, but does not appear elsewhere in the ’708 patent or its prosecution history. ’708 patent, 5:34-37; Ex. 1002. And rather than being presented with robust disclosures of known uses of sliders in the prior art, the Examiner was presented nothing other than allusions to sliders described in cryptic formats such as “an object configured to be moved by a user along an axis extending across video for a plurality of video conference streams.” ’708 patent, claim 1; Ex. 1002, 38 (adding “extending across video for a plurality of video conference streams” to obtain allowance).

Thus, the strongest reason for rejecting discretionary denial and referring this case to the merits panel relates to Patent Owner’s statements regarding its

robust patent portfolio, along with no citation of any Cisco-owned prior art during prosecution of the '708 patent. Patent Owner tells the Director that “Cisco’s history of innovation is perhaps best showed most clearly by the fact that it has 14,000 issued U.S. patents of its own. As you’ll hear, more than 700 of those patents relate to Webex.” Req., 4 (citing Ex2004 at 51). Despite touting its massive U.S. patent portfolio, during the prosecution of the '708 patent, ***Patent Owner submitted a single IDS citing only the references appearing on a PCT International Search Report, and disclosed none of its own relevant U.S. patents or U.S.-based prior art related to Webex or known uses of sliders to the Office.*** See Ex. 1002, 80 (IDS form); *id.*, 81-85 (international search report). Where a sophisticated company such as Patent Owner trumpets its robust U.S. patent portfolio on one hand but fails to alert the Office of relevant known prior art during examination on the other hand, a second look at patentability is prudent.

Patent Owner accuses Petitioner of gamesmanship relating to Petitioner’s proposed constructions in District Court, but this is a clear attempt by Patent Owner to shoehorn this case into the reasoning underlying *Revvo Technologies, Inc. v. Cerebrum Sensor Technologies, Inc.*, IPR2025-00632, Paper 20 at 5 (Dir. Nov. 3, 2025) (precedential). What Patent Owner fails to acknowledge is that *Revvo* applies when a Petitioner takes ***inconsistent*** claim construction positions in different forums. No such situation exists here. While Patent Owner submits Ex.

2012 and crows that Petitioner identifies eleven claim terms that require construction, Patent Owner fails to tell the Board that the constructions advanced by Petitioner in District Court *are the plain and ordinary meanings* of the terms presented to help the factfinder understand those terms.¹ Patent Owner's next outrage regarding the term, "an object configured to be moved by a user along an axis," relates to Kukuchi's slider that moves along both a horizontal axis and a vertical axis. The fact that Kukuchi satisfies the "axis" claim term both vertically and horizontally does not create insoluble confusion or otherwise warrant discretionary denial.

On the issue of settled expectations, Patent Owner is simply wrong that it is entitled to settled expectations where it failed to alert the Office of its own known prior art during prosecution of the '708 patent. This failure of disclosure undercuts any possible expectation of validity that Patent Owner should enjoy.

¹ As Patent Owner knows, the District of Delaware, where Patent Owner's litigation is pending against Petitioner, requires parties to explain what the "plain and ordinary meanings" of the claim terms are, and cannot simply rely on "plain and ordinary meaning" as a construction. There is nothing inconsistent about providing a construction to help the factfinder understand the plain and ordinary meaning of a claim term.

Patent Owner also attempts to impute knowledge of the '708 patent to the public—and Petitioner—through Patent Owner's vague prior statement of patent holdings. As noted above, Patent Owner argues that Petitioner was previously made aware of Patent Owner's "patents in the very same videoconferencing technology space." Req., 4. But the details of that alleged disclosure are sweeping and non-specific. Speaking to a jury, Patent Owner's counsel introduced Patent Owner as a company during opening statements by remarking that "Cisco's history of innovation is perhaps best showed most clearly by the fact that it has 14,000 issued U.S. patents of its own. As you'll hear, more than 700 of those patents relate to Webex." Req., 4 (citing Ex2004 at 51). Notably, Patent Owner offers no evidence that the '708 patent was ever specifically identified to Petitioner prior to filing its complaint for patent infringement. In essence, Patent Owner is suggesting that Petitioner should have filed upwards of 14,000 IPRs back in 2021 in response to Patent Owner's opening statement to a jury. This is an untenable strategy under any reasonable standard. Patent Owner also fails to alert the Director that the only time the '708 patent was ever asserted in litigation was against Petitioner in March 2025. *See* Ex. 1011 (identifying only two cases involving the '708 patent: the March litigation filed by Patent Owner and this IPR).

Last, Patent Owner argues that there is substantial overlap between the district court litigation and this proceeding, but that is wrong. Notably, Patent

Owner fails to alert the Director of the district court's scheduling order. *See* Ex. 1013. A pretrial conference is not scheduled until October 22, 2027, with trial scheduled for November 1, 2027. *Id.*, 14. Based on the date of the Office's **Notice of Filing Date Accorded** of November 10, 2025, this IPR would reach a final written decision no later than May 10, 2027, *roughly six months before trial in district court*. Even the opening expert reports are not due in district court until January 15, 2027, which would likely occur *near the time of the oral hearing* in this proceeding. *Id.* Thus, even if the district court case remains on the current schedule and is not delayed or stayed pending IPR, the entirety of the briefing and possibly even oral argument in this IPR will be concluded before any expert reports would be required to address validity. And a FWD here would issue roughly six months before any trial would occur in district court. These timings weigh against discretionary denial, not in favor.

Finally, Petitioner submits a *Sotera-Plus* stipulation to avoid any risk of duplication in district court and these proceedings.

For these reasons, the Director should reject Patent Owner's request for discretionary denial and instead refer this proceeding to the merits panel.

I. PATENT OWNER'S FAILURE TO DISCLOSE ITS OWN KNOWN PRIOR ART DURING PROSECUTION OUTWEIGHS ANY SETTLED EXPECTATIONS AND FAVORS INSTITUTION

As introduced above, the strongest reason for allowing the Office to look at the '708 patent for a second time and rejecting discretionary denial relates to Patent Owner's statements regarding its robust patent portfolio, along with its failure to disclose any of its own known prior art to the Office during prosecution of the '708 patent.

Patent Owner alleges that its U.S. patent portfolio as of 2021 was in the realm of "14,000 issued U.S. patents," with "more than 700 of those patents relat[ing] to Webex." Req., 4 (citing Ex2004 at 51). Despite this massive U.S. patent portfolio, Patent Owner submitted a single IDS citing only the references appearing on a PCT International Search Report, without submitting any of its own known prior art related to videoconferencing displays or sliders. *See* Ex. 1002, 80-85 (IDS citing only prior art identified on a PCT International Search Report).

Given Patent Owner's questionable compliance with its duty of disclosure, Patent Owner is not entitled to any settled expectations because it knew of relevant prior art during prosecution of the '708 patent, and failed to alert the Office to that known prior art. This failure of disclosure undercuts any possible expectation of validity that Patent Owner should enjoy.

Moreover, Patent Owner is wrong to insinuate that Petitioner somehow delayed bringing this IPR.

First, Patent Owner's disclosure of its 14,000 patents was not provided in the context of infringement notice. If anything, Patent Owner was trying to convince a jury of its own dedication to innovation at trial, rather than alerting Petitioner of some potential infringement problem. *See* Ex. 2004, 50-52 (discussing Cisco's history of innovation as part of introducing Cisco to the jury). Indeed, the fact that Patent Owner identified 14,000 patents in its portfolio, and 700 patents related to Webex indicates strongly that Patent Owner had no particularized infringement theory against Petitioner at that time.² Until Patent Owner filed its complaint for patent infringement against Petitioner in March 2025, Petitioner had no prior notice of any infringement allegations from Patent Owner. Moreover, the only time the '708 patent was ever asserted by Patent Owner in litigation was against

² As one district court judge explained, "Saying you knew about [a patent] family is not too far a step from saying you knew there was this PTO in Virginia, and you should just go check everything there and see if anything there applies. It's too nebulous." *See Intell. Ventures I LLC v. T-Mobile USA, Inc.*, Hearing Tr. 61:2-9, No. 2:17-cv-00577-JRG, Dkt. 297 (E.D. Tex. Jan. 3, 2019).

Petitioner, with the filing of the subject complaint. *See* Ex. 1011 (identifying only two cases involving the '708 patent).

Second, Patent Owner's insinuation that Petitioner should have filed upwards of 14,000 IPR petitions back in 2021 is not tenable. Even at its peak, the Board was handling fewer than 3,000 new IPR petitions a year. Notwithstanding the administrative burden that would have resulted from this scorched-earth tactic, the filing fees alone would have been approximately 581 million dollars, all because Cisco announced in open court that it held a portfolio of 14,000 patents. And even if Petitioner could have somehow correctly identified the 700+ "WebEX" patents in that bunch, a cost of even 30 million dollars in filing fees would have been equally prohibitive. Rather than burdening the Board with countless unnecessary petitions, Petitioner quickly filed two petitions (IPR2025-01588, *which has been referred to the merits panel*, and IPR2025-01589) once Patent Owner particularized its belief that these were the patents of interest in this dispute between the parties. This is not indicative of a Petitioner who sat on its hands for years.

II. PETITIONER'S IPR AND DISTRICT COURT CLAIM CONSTRUCTION POSITIONS ARE NOT INCONSISTENT

Patent Owner accuses Petitioner of gamesmanship relating to Petitioner's proposed constructions in District Court, but stumbles in trying to apply *Revvo*

Technologies, Inc. v. Cerebrum Sensor Technologies, Inc., IPR2025-00632, Paper 20 (Dir. Nov. 3, 2025) (precedential) to this case. Req., 5-7.

What Patent Owner fails to acknowledge is that *Revvo* applies when a Petitioner takes ***inconsistent*** claim construction positions in different forums. No such situation exists here. While Patent Owner submits Ex. 2012 and crows that Petitioner identifies eleven claim terms that require construction, Patent Owner fails to tell the Board that the constructions advanced by Petitioner in District Court ***are the plain and ordinary meanings*** of the terms presented to help the District Court understand those terms, as required in the District of Delaware. *See* n.1, *supra*.

Patent Owner argues that the proposed construction for “an object configured to be moved by a user along an axis” is broader in District Court than in this IPR because Petitioner interprets “an axis” as “a single axis.” Req., 7-8. But again this is a plain meaning explanation of “an axis” and does not raise issues of broad-versus-narrow interpretations. Patent Owner’s discussion of prior-art reference Kukuchi’s slider that moves along both a horizontal axis and a vertical axis is also of no moment—the fact that Kukuchi satisfies the “axis” claim term both vertically and horizontally does not create insoluble confusion or otherwise warrant discretionary denial.

Patent Owner next attempts to manufacture confusion regarding whether prior-art reference Mahemoff's "line" satisfies an "axis" as claimed because the Petition never explains where the start value, end value, or intermediate values of Mahemoff's "line" are. Req., 9 (discussing Pet., 22). This complaint ignores the Petition's detailed discussion of Mahemoff's slider allowing a user to specify a value from among a data range set by the values associated along the slider. Pet., 8-10. Patent Owner's decision to turn to a blind eye to salient discussions in the Petition, in an attempt to create a dispute over the "axis" term, does not establish any inconsistency in Petitioner's discussion of the scope of the claims.

Patent Owner next complains about Petitioner's explanation of a "composite video signal" for the Court's benefit, and seemingly takes issue with the technical discussion of a "composite" video signal being a "spatial mix" of video conference streams. There is nothing inconsistent about these constructions, despite Patent Owner's attempt to convince the Board otherwise, and Patent Owner explains no reason why the plain and ordinary meaning of a composite video signal would not be a spatial mix.

Finally on the issue of "inconsistent" claim constructions, Patent Owner complains that Petitioner's antecedent basis construction for claims 10 and 16 is somehow inconsistent with a construction for claims 1 and 17, namely that an "interval" (in "a layout, ... associated with an interval") is somehow inconsistent

with a “position or range of positions” (also describing “the [same] interval”).

Req., 10. Clearly Patent Owner is focusing on whether the words are identical without considering that those words describe the exact same concepts and are not inconsistent. Simply put, understanding whether a position or zone on a slider is associated with a displayed layout, and whether the Petition makes the case that this feature is disclosed in the prior art, does not require any mental gymnastics or playing archeologist with the record.

Despite Patent Owner's best efforts to create a *Revvo* situation in this IPR, *Revvo* does not compel denial where a petitioner advances plain meaning in an IPR and then provides a technical explanation of that plain meaning for the benefit of the Court's understanding, as required by the Court. Petitioner's claim construction positions are not inconsistent and do not warrant discretionary denial.

III. THE DISTRICT COURT TRIAL DATE AND EXPERT DISCOVERY DEADLINES WEIGH IN FAVOR OF INSTITUTION

Last, Patent Owner argues that there is substantial overlap between the district court litigation and this proceeding, but that is wrong as the district court's scheduling order confirms. *See* Ex. 1013. A pretrial conference is not scheduled until October 22, 2027, with trial scheduled for November 1, 2027. *Id.*, 14. Based on the date of the Office's **Notice of Filing Date Accorded** of November 10, 2025, this IPR would reach a final written decision no later than May 10, 2027, *roughly six months before trial in district court*. And a decision whether to

institute this IPR would occur in May 2026, seventeen months before trial in district court, and could very well alter what occurs in district court before labor intensive activities on invalidity commence. Even the opening expert reports are not due in district court until January 15, 2027, which would likely occur *very close to the oral hearing* in this proceeding. *Id.* Thus, even if the district court case were not stayed or otherwise delayed, the entirety of the briefing and oral argument in this IPR will be concluded before any expert reports would be required to weigh in on validity. And a FWD here would issue roughly six months before any trial would occur in district court. These timings weigh against discretionary denial, not in favor, because a FWD decision cancelling the claims of the '708 patent would make a jury consideration of the '708 patent unlikely.

Further, given an institution deadline of May 10, 2026 and Petitioner's *Sotera-Plus* stipulation below, the parties will be able to adjust the scope of any remaining invalidity challenges in district court in light of the Board's institution decision long before the January 15, 2027 deadline for filing opening expert reports. Thus, any risk of duplication between the district court litigation and this proceeding is *de minimis*.

IV. PETITIONER'S *SOTERA-PLUS* STIPULATION

Sotera: To mitigate any duplication concerns, if this IPR is instituted, Petitioner will not pursue in District Court litigation the grounds asserted in this

proceeding, or any other ground that was raised or could have been reasonably raised in an IPR. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential); *BMW of No. Am., LLC v. Northstar Systems LLC*, IPR2023-01017, Paper 12 at 10 (PTAB Dec. 8, 2023).

PLUS: Additionally, if this IPR is instituted, Petitioner will not pursue in District Court litigation any invalidity theory based on system prior art in combination with one or more of the references asserted as part of a ground raised in this proceeding.

V. THE DIRECTOR IS RESPECTFULLY ASKED TO REFER THIS PROCEEDING TO THE MERITS PANEL

Petitioner believes that discretionary denial is unwarranted, and respectfully asks that the Director refer this proceeding to the merits panel for consideration of the merits of Petitioner's challenges.

Dated: February 9, 2026

/Wayne M. Helge/

Wayne M. Helge, Reg. No. 56,905

James T. Wilson, Reg. No. 41,439

BUNSOW DE MORY LLP

277 S. Washington St., Suite 210 #1088

Alexandria, VA 22314

T: (571) 208-0186

Email: whelge@bdiplaw.com

Email: jwilson@bdiplaw.com

Lead Counsel for Intelligent Protection
Management Corp.

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing document was served via email on this date, by consent, to Patent Owner by serving the correspondence email addresses of record as follows:

YHA@DESMARAISLLP.COM;

TCHO@DESMARAISLLP.COM;

CISCO-IPMC-IPR-SERVICE@DESMARAISLLP.COM

Dated: February 9, 2026

/Wayne M. Helge/

Wayne M. Helge (Reg. No. 56,905)

BUNSOW DE MORY LLP

277 S. Washington St., Suite 210, #1088

Alexandria, VA 22314

Email: whelge@bdiplaw.com

Telephone: 571-208-0186

Lead Counsel for Petitioner Intelligent
Protection Management Corp.