UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,

Petitioner,

v.

DAMAKA, INC.,

Patent Owner.

Patent No. 9,578,092
Filing Date: October 19, 2016
Issue Date: February 21, 2017

Inventors: Sivakumar Chaturvedi, Satish Gundabathula, and Rashmi Hiremath
Title: SYSTEM AND METHOD FOR PROVIDING ADDITIONAL FUNCTIONALITY TO EXISTING SOFTWARE IN AN INTEGRATED MANNER

PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION

Case No. IPR2026-00208

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LIST OF EXHIBITS

Exhibit No.	Description of Document
2001	Docket Control Order (Dkt. 41) in *Damaka, Inc. v. Cisco Sys., Inc.*, Case No. 2:25-cv-00593-RWS-RSP, December 5, 2025
2002	Complaint for Patent Infringement (Dkt. 1) in *Damaka, Inc. v. Cisco Sys., Inc.*, Case No. 2:25-cv-00593-RWS-RSP, May 30, 2025
2003	Defendant Cisco Systems, Inc.'s Invalidity and Subject Matter Eligibility Contentions in *Damaka, Inc. v.* Cisco *Sys., Inc.*, Case No. 2:25-cv-00593-RWS-RSP, January 15, 2026
2004	Declaration of Siva Chaturvedi
2005	Webpage capture, Cisco Careers, *available at* https://careers.cisco.com/global/en/search-results?keywords=WebEx (captured March 19, 2026)

I. INTRODUCTION

Pursuant to the Director's March 26, 2025, Memorandum Regarding Interim Processes for PTAB Workload Management, Damaka, Inc. ("Damaka" or "Patent Owner") files this Request for Discretionary Denial of Institution.

The Petition identifies co-pending district court litigation *Damaka, Inc. v. Cisco Sys., Inc.*, Case No. 2:25-cv-00593 (E.D. Tex., May 30, 2025) and *Damaka, Inc. v. The Cigna Grp.*, Case No. 2:25-cv-00594 (E.D. Tex., May 30, 2025) (the District Court Litigation). Pet. at 82. The case against Petitioner is set for jury selection on April 19, 2027. Ex. 2001. Institution of this Petition will result in the issuance of a Final Written Decision by July 20, 2027.[1]

The Director should exercise discretion to deny the Petition under 35 U.S.C. § 314(a). First, the Petitioner asserts four obviousness arguments based on four different references, but does not assert any anticipation. Second, the Petitioner is a Defendant in a parallel proceeding. Third, the District Court Litigation overlaps with the claims at issue in the Petition. Fourth, trial in the District Court Litigation is set for April 19, 2027, over three months prior to the projected statutory deadline

[1] The Notice of Filing Date Accorded to Petition in this action was mailed on January 20, 2026. Paper 3. The July 20, 2027 date for the Final Written Decision is calculated as 18 months from that date.

for a Final Written Decision of this Petition on July 20, 2027. Fifth, the parties have invested significant resources in developing legal and factual issues of validity and infringement in the District Court Litigation and will have invested substantially more resources before any FWD. Sixth, Petitioner has taken inconsistent claim construction positions between this proceeding and the District Court Litigation. Seventh, there are settled expectations regarding the '092 Patent. Eighth, Patent Owner is a small, U.S. manufacturer of products that compete with the Accused Products in the co-pending litigation.

II. THE PETITION SHOULD BE DENIED IN THE DISCRETION OF THE DIRECTOR UNDER 35 U.S.C. § 314(a)

The circumstances of the parallel District Court Litigation necessitate denial of the Petition under the Board's precedent, as every factor considered in relation to efficiency, fairness, and the merits supports denial. *See Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11, at 6 (P.T.A.B. Mar. 20, 2020) (precedential) (hereinafter "*Fintiv*"); *see also NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8, at 20 (P.T.A.B. Sept. 12, 2018) (finding institution would not be consistent with the objective of the AIA to "provide an effective and efficient alternative to district court litigation.") (quoting *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19, at 16–17 (P.T.A.B. Sept. 6, 2017) (precedential)).

A. The Petition's Excessive Number of Grounds and Weak Merits Warrant Discretionary Denial

The Petition does not assert any anticipation. *See* Pet. at 16; *see also Fintiv* at 6 (considering "other circumstances that impact the Board's exercise of discretion, including the merits."). Rather, the Petition asserts a patchwork of obviousness grounds combining ***four*** different references to challenge claims purportedly directed to "[o]rganizing computer software into blocks", strongly weighing in favor of discretionary denial. *See* Pet. at 18-19. Any institution decision addressing so many grounds and motivations to combine, let alone a trial and FWD, would be excessively burdensome. This excessive burden is of Cisco's making and is grossly disproportionate to the resources warranted for the Board to expend on a single patent.

B. The Petition Does Not Allege an Examiner Error

The application that would become the '092 Patent was never subject to a prior art rejection. Pet. at 11-12 (citing Ex. 1002). The Petition does not allege or state that the '092 Patent was the subject of any Examiner error. This weighs in favor of discretionary denial.

C. The Parallel District Court Litigation and the Petition Involve the Same Real Parties-in-Interest

There exists a parallel district court litigation between the same parties regarding the same subject patent (the '092 Patent). Pet. at 82. Petitioner is a

Defendant in the District Court Litigation. *Id.* The District Court Litigation involves causes of action asserting the '092 Patent against Petitioner's products, which include videoconferencing systems. Ex. 2002, ¶ 15. Petitioner waited almost eight months after Patent Owner filed its Complaint against Petitioner in the District Court Litigation on May 30, 2025 before filing its Petition on January 13, 2026. Ex. 2002.

Accordingly, this factor weighs strongly in favor of discretionary denial.

D. The Parallel District Court Litigation Involves Substantially the Same Claims

There is overlap between the claims and grounds at issue in this Petition and the District Court Litigation because the Petition challenges Claims 1-30 of the '092 Patent, including Claims 1-5, 7-8, 10, 12-19, 22-25, and 27 asserted in the District Court Litigation, under the same grounds asserted in the District Court Litigation. Pet., 18. In particular, Cisco's Invalidity Contentions in the District Court Litigation challenge the Challenged Claims using U.S. Patent App. Pub. No. 2011/0249077 ("Abuan") (Ex. 1005), U.S. Patent App. Pub. No. 2012/0092438 ("Guzman") (Ex. 1006), U.S. Patent App. Pub. No. 2013/0019297 ("Lawson") (Ex. 1007), and U.S. Patent No. 5,689,641 ("Ludwig") (Ex. 1009), the exact references asserted in this proceeding. *Compare* Pet. at 18 *with* Ex. 2003 at 22.

"In at least these ways, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility

of conflicting decisions." *Cisco Sys., Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 at 10 (P.T.A.B. May 15, 2020).

Accordingly, this factor weighs strongly in favor of discretionary denial.

E. Proximity of the District Court's Trial Date

The proximity of the District Court Litigation's trial date to the Board's projected statutory deadline for a Final Written Decision weighs strongly in favor of discretionary denial. The trial in the District Court Litigation is scheduled for April 19, 2027. Ex. 2001. Pursuant to 35 U.S.C. §§ 314(b)(1) and 316(a)(11), the projected statutory deadline for a Final Written Decision of this Petition is July 20, 2027. As the District Court Litigation's trial will be over three months before the projected statutory deadline, this factor weighs strongly in favor of denying institution. *See Next Caller Inc. v. TRUSTID, Inc.*, IPR2019-00961, -00962, Paper 10, at 8-16 (P.T.A.B. Oct. 16, 2019) (denying institution where trial was scheduled to conclude "several months," before a final decision would be due); *F5 Networks, Inc. v. WSOU Invs., LLC,* IPR2022-00239, Paper 12 at 7-8 (P.T.A.B. May 19, 2022) (denied when trial predates FWD by six months); *Google LLC v. EcoFactor, Inc.*, IPR2021-00488, Paper 12 at 11-12 (P.T.A.B. Aug. 11, 2021) (denied when trial predates FWD by six months); *Cisco Sys., Inc. v. Oyster Optics, LLC,* IPR2021-00238, Paper 10 at 11-13 (P.T.A.B. Jun. 1, 2021) (denied when trial predates FWD by seven months); *Samsung Elecs. Co. v. Truesight Commc'ns LLC*, IPR2025-

00123, Paper 12, at 6-7 (P.T.A.B. Apr. 22, 2025) (denied when trial predates FWD by six months). The three month differential between the trial date and the FWD justifies discretionary denial.

Accordingly, this factor weighs in favor of discretionary denial.

F. Significant Investment in the Parallel Proceeding

The parties' investment in the parallel District Court Litigation weighs strongly in favor of discretionary denial. The parties have already exchanged infringement and invalidity contentions, and claim construction disclosures begin on June 23, 2026. The deadline for substantial completion of document production will also pass on September 15, 2026. Ex. 2001. By the deadline for a FWD, the case will have completed claim construction, fact discovery, expert discovery, and will have obtained a jury verdict. The substantial investments in the District Court Litigation weigh strongly in favor of denial of institution.

G. Inconsistent Claim Construction Positions

While the Petition alleges that "no terms require express construction" in this Proceeding, Petitioner stated in the litigation that ***21*** individual claim terms "are indefinite under 35 U.S.C. § 112(b) for failure to inform, with reasonable certainty, those skilled in the art about the scope of the invention." Ex. 2003, 60, 61-62. Petitioner provides no explanation for these inconsistent positions, even though it alleges that numerous terms are means-plus-function without disclosed structure. *Id.*

By doing so, "Petitioner has engaged in the same inconsistency *Tesla* discourages; namely, arguing indefiniteness in district court and plain and ordinary meaning in this proceeding." *Carbyne, Inc. v. Tritech Software Sys.*, IPR2025-00959, Paper 20 at 4 (Director Feb. 19, 2026). As the Director stated, "this approach 'detracts from[] the Office's goal of 'providing greater predictability and certainty in the patent system.'"" *Id.*

Petitioner's inconsistent claim construction positions, offered with no explanation, also justify denial of institution. *Id.*

H. Settled Expectations of the Parties

The '092 Patent was granted February 21, 2017, more than nine years from this writing. It further claims priority to U.S. Patent No. 9,027,032, which was filed on September 11, 2013, and issued on May 5, 2015, which is more than 10 years before Petitioner filed its Petition. Ex. 1001. As such, Patent Owner has settled expectations at this point. The Board has previously discretionarily denied institution because "the challenged patent has been in force almost eight years, creating settled expectations." *Dabico Airport Sols. Inc. v. AXA Powers Aps*, IPR2025-00408, Paper 21 at 2 (P.T.A.B. June 18, 2025). The Board also noted that "the longer the patent has been in force, the more settled expectations should be" and equated this approach to the six-year damages period related to filing infringement lawsuits. *Id*. at 3. The situation is no different here, as "actual notice

of a patent or of possible infringement is not necessary to create settled expectations." *Id.* This factor weighs strongly in favor of discretionary denial.

I. Patent Owner's U.S. Investment and Manufacturing Favors Discretionary Denial

Finally, Damaka's domestic investment and development of patented technology weigh in favor of discretionary denial. *See* March 11, 2026 Memorandum re Additional Discretionary Institution Considerations - U.S. Manufacturing and Small Business Use of AIA Proceedings (considering "(1) the extent to which any products accused of infringement in a parallel proceeding are manufactured in the United States or are related to investments in American manufacturing operations; (2) the extent to which any products made, sold, or licensed by the patent owner that compete with the accused products are manufactured in the United States; and (3) whether the petitioner is a small business that has been sued for infringement of the patent at issue.") Damaka is a U.S. corporation with its principal place of business in Texas, headed by Mr. Siva Chaturvedi, Founder and CEO, since 2004. Ex. 2004, ¶ 2. Damaka offers software and software development kits for sale in the United States including Nirvana (a meeting platform for video and collaboration), Moca (a fully encrypted UCC solution), Triton (a carrier and enterprise grade collaboration platform using WebRTC technology and SIP), and Vcare (a healthcare platform using WebRTC

technology). Ex. 2004, ¶ 5. All of Damaka's products were designed and architected in the United States, and the core code and functionality for each product was developed and programmed in the United States. *Id.*, ¶¶ 6-7. Damaka's products directly compete with Cisco's WebEx, the Accused Product in the District Court Litigation. *Id.*, ¶ 8. Moreover, while Cisco has U.S. employees with responsibilities related to WebEx, much of the development work for WebEx appears to be overseas. For example, a search for "WebEx" on Cisco's careers site yields 41 job listings, only 4 of which are in the United States. Ex. 2005. Additionally, Cisco is not a small business.

III. CONCLUSION

For the foregoing reasons, Patent Owner respectfully requests that the Director exercise discretion to deny institution of the Petition.

Respectfully submitted,

Dated: March 20, 2026 By: /*Jacob Ostling* /

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CERTIFICATE OF WORD COUNT

The undersigned hereby certifies that the portions of the above-captioned PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION has 1,884 words in compliance with the 14,000 word limit set forth in 37 C.F.R. § 42.24. This word count was prepared using Microsoft Word for Office 365.

Respectfully submitted,

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CERTIFICATE OF SERVICE

A copy of the foregoing PATENT OWNER'S REQUEST FOR DISCRETIONARY DENIAL OF INSTITUTION and Exhibits 2001 through 2005 have been served on Petitioner's counsel of record as follows:

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