

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.
Petitioner,

v.

OPTIMNET LLC,
Patent Owner,

U.S. Patent No. 9,313,101

Inter Partes Review No.: IPR2026-00321

**PETITIONER’S OPPOSITION TO PATENT OWNER’S REQUEST FOR
DISCRETIONARY DENIAL**

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Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

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PETITIONER'S EXHIBIT LIST

<i>Exhibit #</i>	<i>Description</i>
1001	U.S. Patent No. 9,313,101 (“’101 Patent”)
1002	Prosecution History of the ’101 Patent (“File History”)
1003	Declaration of Petitioner’s Expert
1004	U.S. Pat. App. No. 2013/0231081 (“Mo”)
1005	Certified English Translation of WO 2010/094188 (“Peng”)
1006	3rd Generation Partnership Project (3GPP), "Policy and charging control over Gx/Sd reference point" (3GPP TS 29.212 version 10.5.0 Release 10), ETSI TS 129 212 V10.5.0 (January 2012), available at https://www.etsi.org/deliver/etsi_ts/129200_129299/129212/10.05.0_0_60/ts_129212v100500p.pdf
1007	3rd Generation Partnership Project (3GPP), "Policy and charging control architecture" (3GPP TS 23.203 version 9.9.0 Release 9), ETSI TS 123 203 V9.9.0 (June 2011), available at https://www.etsi.org/deliver/etsi_ts/123200_123299/123203/09.09.0_0_60/ts_123203v090900p.pdf
1008	R. Yavatkar et al., "A Framework for Policy-based Admission Control," IETF RFC 2753 (January 2000), available at https://www.rfc-editor.org/rfc/rfc2753
1009	D. Durham et al., "The COPS (Common Open Policy Service) Protocol," IETF RFC 2748 (January 2000), available at https://www.rfc-editor.org/rfc/rfc2748
1010	K. Chan et al., "COPS Usage for Policy Provisioning (COPS-PR)," IETF RFC 3084 (March 2001), available at https://www.rfc-editor.org/rfc/rfc3084
1011	A. Westerinen et al., "Terminology for Policy-Based Management," IETF RFC 3198 (November 2001), available at https://www.rfc-editor.org/rfc/rfc3198
1012	Cisco IOS “Time-Based Access Lists Using Time Ranges,” Release 12.0(1)
1013	D. Mills et al, "Network Time Protocol Version 4: Protocol and Algorithms Specification," IETF RFC 5905 (June 2010), available at https://www.rfc-editor.org/rfc/rfc5905
1014	JP 2002-374294 (Certified English translation)

<i>Exhibit #</i>	<i>Description</i>
1015	J. Babiarez et al., "Configuration Guidelines for DiffServ Service Classes," IETF RFC 4594 (August 2006), available at https://www.rfc-editor.org/rfc/rfc4594
1016	U.S. Pat. App. No. 2011/0225280 (“Delsesto”)
1017	U.S. Patent No. 6,167,445 (“Gai”)
1018	Email from Joseph A. Powers to OptimNet litigation counsel on July 2, 2026

I. INTRODUCTION

Cisco Systems, Inc. (“Petitioner”) opposes the request by Optimnet LLC (“Patent Owner” or “PO”) for Discretionary Denial of Institution (Paper 6, “Request”). The ’101 Patent never should have issued, as demonstrated by the prosecution of the original claims, and strong, new evidence of invalidity in the Petition.

The Petition is based on prior art that was not before the Patent Office during examination, but would have been if the examiner had done more expansive classification search and used search criteria, especially those tied to the features asserted to distinguish over the prior art. The IPR prior art, U.S. Patent Publication 2013/0231081 (“Mo”) (EX-1004), is nearly identical to the subject matter of the ’101 Patent and discloses the very limitations that were thought to be missing from the prior art as a result of the examiner’s erroneous searches. The resources of the Office should be used to correct these errors.

Underscoring the importance of this Petition to the validity of the ’101 Patent and the integrity of the patent system, PO does not even request denial under 35 U.S.C. § 325(d).

There is no basis to give the invalidity of the ’101 Patent a pass under *Fintiv*, given the strong evidence of apparent examiner error here. Further, the Petitioner

has issued a *Sotera* Plus stipulation so there will be no overlap in validity issues between the District Court and the PTAB.

In view of the erroneous issuance of the '101 Patent, there is no basis to shield it from review using the “settled expectations” doctrine.

II. STIPULATIONS

Petitioner stipulates that if the Board grants the Petition and institutes an *inter partes* review, unless institution is later vacated, reversed or otherwise withdrawn by rehearing or Director Review, Petitioner will not pursue in the Litigation the specific grounds that it raised in the Petition, nor any other ground that Petitioner could have reasonably raised in an IPR against the challenged claims of the '101 Patent, nor any invalidity ground based on system prior art corresponding to the printed publication asserted in the specific invalidity ground that it raised in the IPR petition. *See Sotera Wireless, Inc. v. Masimo Corp.*, Case IPR2020-01019, Paper 12 (Dec. 1, 2020) (precedential); *Magnolia Medical Technologies, Inc. v. Kurin, Inc.*, IPR2026-00097, Paper 17 at 3 (Director, May 14, 2026) (precedential); EX-1018. Moreover, given the Director’s new guidance in decisions designated informative on May 13, 2026, Petitioner stipulates that it will not pursue in the Litigation any indefiniteness ground under 35 U.S.C. §112

against any claim of the '101 Patent.¹

III. INSTITUTION IS WARRANTED TO CORRECT THE ERRONEOUS ORIGINAL ISSUANCE OF THE '101 PATENT

A. The '101 Patent Should Never Have Been Issued

The '101 Patent issued without a robust examination by the examiner, Instead the examiner indicated that claims 2-7 were allowable, but did not include a reason for allowance or even acknowledge the Applicant's arguments. The examiner initially rejected each of Claims 1-7 to which the Applicant responded by amending Claim 2 (issued Claim 1) to add the limitation “ *and wherein the execution time point reflects a time condition that is provided independently from the traffic.*” In response, the examiner then rejected Claim 2 based on Riddle and Friedman. In response to the rejection, the Applicant further amended Claim 2, to include “ *wherein the time-based policy is set based on the tuple information that is included in a packet from the traffic and the time condition by the policy server*” and argued Claim 2 was non-obvious over Riddle and Friedman because they failed to teach or suggest the latter feature.

¹ By email sent to PO's counsel on July 2, 2026, Petitioner entered the above (i) “*Sotera Plus*” stipulation, *i.e.*, a conventional *Sotera* stipulation with additional assurances regarding certain system prior art, which the Board has found favorable to institution, and (ii) “*No Indefiniteness*” stipulation. *See* EX-1018.

However, in response to the Patent Owner's argument, it appears that the examiner only updated the classification search on May 18, 2015. The updated search failed to include the classifications either of the international classifications or US classifications of Mo (EX-1004) (International classes H04 W 4/26, H04 W 72/04 and US Classification 455/405. No search terms were used to search for prior art--instead the examiner only relied on classification searching. Thereafter, without comment, the examiner allowed Claims 2-7 on the next office action. However, Mo discloses the features that were added during the amendment. Like the '101 Patent claims, Mo discloses using the re-authorization scheduler to control QoS using tuple information combined with Next Re-Authorization time, which reads on the *wherein the time-based policy is set based on the tuple information that is included in a packet from the traffic and the time condition by the policy server* as described in the Petition. A reasonable search including the additional classifications as well as search terms would have resulted in the examiner finding the primary reference Mo and the disclosure of the limitation upon which it appears allowance was granted. Thus, it was the examiner's error that erroneously allowed the claims to issue.

PO does not dispute that Mo discloses the very limitations that it appears the examiner thought were missing from the prior art. PO also does not make any §325(d) arguments, effectively conceding that the Petition's grounds present an important challenge never considered by the Office. Thus, as a threshold matter, the

Office's prosecution failed to uncover or consider the art and grounds of this Petition, which are neither cumulative nor redundant to the examination upon which the patent rests for its validity. See *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6, p. 8 (Feb. 13, 2020).

IV. THE *FINTIV* FACTORS WARRANT INSTITUTION

As explained above, instituting this IPR to correct the Examiner's material error "serves the interest of overall system efficiency and integrity." *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 15 (PTAB Mar. 20, 2020) (precedential). Additionally, as demonstrated below, the Petitioner's broad stipulation "reduces the concern of inconsistent outcomes or significant duplication of efforts" and thus counsels against discretionary denial." *Tesla, Inc. v Bulletproof Property Management, LLC*, IPR2026-00204, Paper 14 at 3 (PTAB June 15, 2026)(informative). The *Fintiv* factors warrant consideration of the merits and institution because, as explained below, they either favor institution or are neutral.

A. Factor 1: Likelihood of a Stay

No party has requested a stay, and the district court has not indicated whether a stay would be granted. Therefore, this factor is neutral. See *Hulu, LLC v. SITO Mobile, Ltd.*, IPR2021-00298, Paper 11, 10-11 (PTAB May 19, 2021).

B. Factor 2: Timing of Trials

Factor 2 is neutral. Patent Owner admits that the trial date is scheduled only 47 days before the Final Written Decision is expected to issue. Given the

tendencies of trial dates to slip it is only speculation to assume that the trial will occur before the FWD issues, particularly where Judge Gilstrap's practice is to schedule multiple cases on the exact same date.

C. Factor 3: Investment in Parallel Proceedings

Factor 3 favors institution. As held by the Board in *Fintiv*, “[i]f, at the time of the institution decision, the district court has not issued orders related to the patent at issue in the petition, this fact weighs against exercising discretion to deny institution.” *Fintiv*, 10. Here, the district court will not issue its Markman order until after the Markman hearing scheduled for February 18, 2027, which will occur after the institution decision. EX-2002

D. Factor 4: Overlap of Issues

Factor 4 favors institution. In view of Petitioner's *Sotera* Plus stipulation, there will be no overlap between the issues raised in the Petition and issues to be adjudicated in the Litigation.

E. Factor 5: Overlap of Parties

Factor 5 is neutral. The Board has long recognized that it is commonplace for petitioners to be defendants and does **not** weigh in favor of denial. *See, e.g., HP Inc. v. Slingshot Printing LLC*, IPR2020- 01084, Paper 13 at 9 (Jan. 14, 2021).

F. Factor 6: The Petition's Merits, and Demonstration of Apparent Examiner Error, Strongly Favor Institution

As explained above, the evidence of invalidity in the Petition is

overwhelming, presents prior art unlike any considered by the examiner when deciding to issue the Challenged Claims, and demonstrates apparent examiner error as being the reason that Mo was not previously before the Office. Moreover, the Patent Owner's argument regarding expert testimony should find no favor, as the Patent Owner has identified limitations not supported by applied art.

Integrity of the patent system compels that the Director should not exercise discretion to prevent correcting this error in the original patent grant and reexamination proceeding by considering the merits of the critical evidence of invalidity presented in the Petition. *Magnolia*, 6-8; *Fintiv*, 14-15.

V. THE SETTLED EXPECTATIONS DOCTRINE DOES NOT WARRANT SHIELDING THE '101 PATENT FROM REVIEW

When a patent has been erroneously issued by the Patent Office, the settled expectation doctrine should not trump the purpose of IPRs of serving "the interest of overall system efficiency and integrity" particularly where the Patent Owner only acquired its rights to the '101 Patent three months before the filing the litigation *Fintiv, Inc.*, Paper 11 at 15.

VI. CONCLUSION

PO has identified no legitimate basis for the Director to deny institution on any discretionary factors. Institution should be granted.

Respectfully submitted,

DUANE MORRIS LLP

Dated: July 2, 2026

/ Patrick D. McPherson /

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CERTIFICATION OF SERVICE ON PATENT OWNER

Pursuant to 37 C.F.R. §§ 42.6(e), 42.8(b)(4) and 42.105, the undersigned certifies that on the 2nd of July, 2026, a complete and entire copy of this Petitioner's Opposition to Patent Owner's Request for Discretionary Denial and supporting exhibit were served via email and/or electronic download by agreement of Patent Owner, to the Patent Owner's counsel of record in this manner.

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