

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ORACLE CORPORATION,
NETAPP INC. and
HUAWEI TECHNOLOGIES CO., LTD.

Petitioners,

v.

CROSSROADS SYSTEMS, INC.

Patent Owner.

Case IPR2014-01209

U.S. Patent No. 7,051,147

PETITIONERS' REPLY IN SUPPORT OF THE PETITION

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I. The Kikuchi-Bergsten Combination Renders Obvious the Claims Because Patent Owner's Attempt to Antedate Kikuchi Fails and Patent Owner's Critique of the Combined System Ignores the Express Teachings of the References

Crossroads Systems, Inc.'s (Patent Owner's) first argument with respect to the *Kikuchi* and *Bergsten* combination, is that *Kikuchi* is not prior art. Patent Owner's attempt to antedate *Kikuchi* fails because, according to Patent Owner's own purported timeline, about four months of the diligence period was dedicated *only* to developing a product that, Patent Owner also admits, was outside the scope of the claims. Patent Owner unduly delayed and failed to diligently reduce the invention to practice because it could have developed the claimed invention, but chose not to for reasons that the Federal Circuit has held does not excuse delay. Patent Owner made a business decision—unrelated and unnecessary to the testing of the invention—to prioritize the development of another product (and delay development of the claimed invention) in order to provide the company with an earlier return of revenue.

On the merits of the combination, Patent Owner's argument that the combined system does not identify a particular storage device is contrary to the express teachings of *Kikuchi*. Further, Patent Owner's argument that the proposed combination would change the principle of operation of the base references is based on an unduly narrow view of the teaching and applicability of the references. In fact, the proposed combination involves primarily modification of a simple

mapping table which—Patent Owner and its expert do not dispute—is well within the level of ordinary skill in the art.

A. Patent Owner’s Evidence of Diligence Fails

The only diligence chronology provided by the Patent Owner is set forth in an exhibit prepared by Patent Owner’s counsel. Ex. 2311. This chronology spans seven pages and is a prejudicial attempt to circumvent the 60 page limit for the Patent Owner response. 37 C.F.R. § 42.6(a)(3); *Fujian Newland Computer Co., Ltd. v. Hand Held Products, Inc.* IPR2013-00595 (Paper 28, June 13, 2014) at 2 (“[W]e agree with Petitioner that, in the abstract, use of a pointer or citation to declaration testimony, without sufficient arguments and explanation in the response itself, improperly circumvents the page limit[.]”); *Cisco Systems, Inc. v. C-Cation Technologies, LLC*, IPR2014-00454 (Paper 12, Aug. 29, 2014) at 10, (Board refusing to “consider arguments . . . not made in the Petition, but . . . incorporated by reference[.]”). The diligence chronology therefore should not be considered.

Even if the Board considers the chronology, it fails to establish reasonable diligence. Patent Owner’s position appears to be that from August 18, 1997 (the beginning of the critical period) to November 25, 1997, the inventors were engaged in a constructive reduction to practice of the Verrazano bridge product, which Patent Owner claims had to be completed before the claimed subject matter

of the '147 Patent could be reduced to practice. Resp. at 29-32. The period from November 25 to December 31, 1997 (the end of the critical period) was allegedly spent making revisions to a patent application. Each of these two time periods are addressed in turn below.

As a threshold matter, Patent Owner freely acknowledges that the Verrazano bridge does not embody the claimed invention because it lacks the recited access controls. *Id.* at 31; Ex. 2305 at ¶ 4. Rather, Patent Owner argues that it was not able to begin work on the access controls until it had completed its work on the Verrazano bridge and therefore, its work on that bridge should be credited as diligence toward reducing the claimed invention to practice. Resp. at 30.

In *Naber v. Cricchi*, the Court determined that, because the inventor “admittedly ‘possessed the capability of conducting . . . a test [of functionality of the claimed invention],’ it was his burden to reconcile the waiting period with the ‘reasonable diligence’ requirement.” 567 F.2d 382, 385 (Cust. & Pat. App. 1977), *citing Litchfield v. Eigen*, 535 F.2d 72, 76, 190 USPQ 113, 116 (Cust. & Pat.App. 1976). The Court found lack of diligence where both the inventor and his supervisor “admitted that a simple transistor embodying the structure [of the claimed invention] could have been built and tested”, yet the inventor “chose not to proceed to a reduction to practice with a simple transistor, but to wait until work on layer deposition techniques progressed.” *Id.* As noted in *Thompson v. Dunn*, it is

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