

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARISTA NETWORKS, INC.,
Petitioner,

v.

CISCO SYSTEMS, INC.,
Patent Owner.

Case IPR2016-00308 (Patent 7,162,537 B1)
Case IPR2016-00309 (Patent 7,224,668 B1)¹

Before BRYAN F. MOORE, MATTHEW R. CLEMENTS, and
PETER P. CHEN, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

ORDER
Conduct of Proceedings
37 C.F.R. § 42.5

A conference call in the above proceeding was held on February 7, 2017. Counsel for Petitioner and Patent Owner participated in each call with Judges Moore, Quinn², Clements, and Chen. The purpose of the call was to discuss three issues brought to the Board's attention by email: 1) Narrowing

¹ This order addresses issues in both identified cases. We exercise our discretion to issue one order to be filed in each case. The parties are not authorized to use this style heading in subsequent papers.

² Judge Quinn is paneled on cases related to the two cases at issue.

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Petitioner's objections to evidence filed as Paper 22; 2) Petitioner's proposed motion to strike Exhibits 2015–2023, 2027, and 2047 in IPR2016-00309; and 3) Patent Owner's proposed motion to strike Petitioner's Reply in IPR2016-00308 and to strike Petitioner's Reply in IPR2016-00309. A transcript of the call was recorded and filed in IPR2016-00309 as Exhibit 1028 (“Tr.”).

Narrowing Petitioner's Objections

Petitioner indicated on the call that it has agreed with Patent Owner to narrow its objections reflected in IPR2016-00309, Paper 22. Additionally, Patent Owner indicated it does not object to Petitioner correcting the filing provided the record reflects the narrowed scope of objections. The parties requested the Board's approval in correcting the filing, and guidance as to how the Board would like them to reflect the narrowed scope of objections in what they file. We authorized Petitioner, by oral order, to file corrected objections by February 10, 2017. Subsequent to the call, on February 9, 2017, Petitioner filed the corrected objections. To avoid any confusion in the record, we now expunge Paper 22 filed in IPR2016-00309.

Additionally, Patent Owner asked for ten business days from the filing of the corrected objections to respond and provide supplemental evidence. Petitioner initially objected to this request. We indicated that we were inclined to grant that request. With that understanding, Petitioner withdrew its objection. Thus, Patent Owner shall have ten business days, as provided by 37 CFR 42.64(b)(2), from the filing of the corrected objections to respond and provide supplemental evidence.

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*Petitioner's Proposed Motion to Strike Exhibits 2015–2023,
2027, and 2047 in IPR2016-00309*

Petitioner indicated on the call that it seeks leave to file a motion to strike the claim charts at Exhibits 2015 and 2047 and other exhibits that are allegedly cited meaningfully only in those charts (namely, Exs. 2016-2023, and 2027) on the grounds that they contain additional argument beyond what is contained in the Patent Owner Response and, as such, violate the word count prescribed for the Patent Owner Response by 37 C.F.R. § 42.24. Petitioner provided examples of the alleged violations of the page count. For example, Petitioner stated

Exhibit 2015 is a claim chart that purports to map the claims of the '668 patent to certain Cisco and Arista products in the attempt to demonstrate copying. The response itself contains no such mapping, instead states only that, quote, Arista's copying is well-documented and evidences a deliberate effort to duplicate the claim that's subject matter, close quote; and then cites Exhibit 2015.

Tr. 9:12–20. Petitioner cited to similar examples in Exhibit 2047.

Patent Owner responded that Petitioner's request is untimely, and also moot, because Petitioner addressed Exhibit 2015, but not Exhibit 2047, in its Reply to the Patent Owner Response. Additionally, Patent Owner argued that the argument regarding copying is in the Patent Owner Response and that the claim chart and declaration contained in the exhibits simply corroborates that argument.

Upon consideration of the arguments presented, we authorize Petitioner to file, within seven calendar days of the date this order is entered, a five-page Motion to Strike Exhibits 2015–2023, 2027, and 2047 in IPR2016-00309, not limited to the arguments made during the February 7

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call.. Patent Owner is authorized to file, within seven calendar days of the filing of the motion to strike, a five-page opposition, limited to the issues raised in the motion to strike. No reply is authorized at this time.

*Patent Owner's Proposed Motions to
Strike Petitioner's Reply in IPR2016-00308 and to
Strike Petitioner's Reply in IPR2016-00309*

Patent Owner indicated on the call that it seeks authorization to file a motion to strike Petitioner's Reply in IPR2016-00308 and to strike Petitioner's Reply in IPR2016-00309. According to Patent Owner, both Replies contain new arguments, exceeding the scope permitted by 37 C.F.R. § 42.23(b). Patent Owner provided some examples of the arguments allegedly exceeding the scope of the Patent Owner Response. For example, as to IPR2016-00308, Patent Owner states

Arista is arguing that the combination of Sandick and AgentX and Math[eny] teach [] certain elements under their proposed claim instruction. But in the institution decision, the board declined to institute the AgentX, Sandick and Math[eny] grounds; nevertheless, in the Petitioner's reply, the Petitioner is re-raising the Math[eny] ground. So we believe that that's a clear example of something that exceeds the scope permitted by the reply.

Tr. 20:20–21:5. Patent Owner also asserted Petitioner's Declarant, Dr. Mohapatra, admitted at his deposition that using the CLI as the router configuration subsystem is a new argument presented in the Reply. As to IPR2016-00309, Patent Owner argued that an exhibit purporting to support the public availability of the CoreBuilder reference is untimely because it should have been filed with the Petition rather than with the Reply.

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Additionally, Patent Owner argues that the Reply relies on a different element of the Amara reference than the one relied on in the Petition.

As to IPR2016-00308, Petitioner responded that the CLI argument in the Reply is in response to an issue raised in the Patent Owner Response. Additionally, Petitioner responded that “the combination of AgentX, Sandick and Math[eny], that was addressed [] on page 40 of the Patent Owner’s [P]reliminary [Response], and our [R]epley is just addressing the arguments that were raised there.” Tr. 26:10–14. We asked Petitioner why a non-instituted ground which was argued in the Patent Owner’s Preliminary Response is relevant to the trial as instituted. Petitioner responded,

It’s our understanding that the F[ederal] Circuit has said that the [B]oard is not bound by any findings it’s made in an institution decision, and we understand that the [B]oard can change its mind with regard to claim construction, and claim construction is the issue that continue -- continuing. So we argue the claim construction issue as part of our reply, and we want to show the relevance of the claim construction [] to show that it's not an academic exercise and that it impacts the grounds that the board would institute on. And I think if the board were to change its mind and adopt our claim construction, the rules specifically allow for the board to extend a schedule by six months and account for the grounds -- the rejected grounds and reconsider them. So that’s why we included that information.

Tr. 27:11–28:3. We are not persuaded by that argument. Arguments presented in a preliminary response but not made in patent owner’s response are waived and, therefore, should not be addressed in a petitioner’s reply. The Office has instructed that such improper reply argument will not be considered:

A reply may only respond to arguments raised in the corresponding opposition. [37 C.F.R.] § 42.23. While replies can help crystalize issues for decision, a reply that raises a new

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