UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARISTA NETWORKS, INC.,
Petitioner

v.

CISCO SYSTEMS, INC.,
Patent Owner

Case IPR2016-00309
Patent 7,224,668

PETITIONER'S MOTION TO STRIKE

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I. STATEMENT OF THE PRECISE RELIEF REQUESTED

Pursuant to 37 C.F.R. § 42.20 and the Board's February 17, 2017, Order (Paper 40), Petitioner hereby moves to strike Exhibits 2015-2023, 2027, and 2047 on the grounds that they improperly contain additional argument beyond what is contained and developed in the Patent Owner Response (Paper 19, "POR").

II. STATEMENT OF THE REASONS FOR THE RELIEF REQUESTED

A. The Board Should Strike Exhibits Improperly Incorporated by Reference into the Patent Owner Response

Exhibits 2015-2023, 2027, and 2047 should be stricken because they are a textbook example of material improperly incorporated by reference in violation of 37 C.F.R. §§ 42.24, 42.6(a)(3). These exhibits are claim charts purporting to establish secondary indicia of nonobviousness (Ex. 2015) and the conception date (Ex. 2047), and exhibits discussed exclusively therein (Exs. 2016-2023, 2027).[1]

The practice of referring to external claim charts containing argument not fully developed in the briefs amounts to improper incorporation by reference. *E.g.*, *Cisco Sys., Inc. v. C-Cation Techs., LLC*, IPR2014-00454, Paper 12 at 7-10 (PTAB Aug. 29, 2014) ("[C]iting to other claim charts in another document also amounts to incorporation by reference."). As the Board explained in *Masterimage 3D, Inc.*

[1] Exhibits 2016-2023 are cited in passing in the POR, but they are not substantively discussed. *See* POR at 56.

v. RealD Inc., IPR2015-00040, Paper 85 (PTAB Apr. 14, 2016), considering "more specific evidence" of secondary indicia of nonobviousness than that explained in the patent owner response "would amount to incorporation of material from one document by reference into another, which is inappropriate under 37 C.F.R. § 42.6(a)(3)" and "would be unjust to Petitioner." *Id.* at 37-38. That is particularly true here, where the improperly incorporated claim charts contain over 6,000 additional words, comprising nearly half the permissible length of the entire POR.

This is not a case where Cisco's argument is fully presented and developed in the POR and the exhibits merely provide additional evidence. Under well-established law, proof of both conception and secondary considerations based on a commercial embodiment requires an element-by-element comparison to the claims at issue. *See, e.g.*, *Coleman v. Dines*, 754 F.2d 353, 359 (Fed. Cir. 1985) ("[I]n establishing conception a party must show possession of every feature recited in the count, and that every limitation of the count must have been known to the inventor at the time of the alleged conception."); *In re Huai-Hung Kao*, 639 F.3d 1057, 1068 (Fed. Cir. 2011). Here, the POR contains no such analysis whatsoever, instead expressly directing the reader to the voluminous claim charts of Ex. 2047 and Ex. 2015 for the "element-by-element" analysis. POR at 36, 56. The rule against incorporating material by reference forbids precisely this approach. *Masterimage 3D*, Paper 85 at 37-38. If the parties' briefs could simply refer to

external claim charts presenting the entire element-by-element analysis—as Cisco has done here—then the word limit would have little practical effect.

Accordingly, Cisco's claim charts containing additional argument beyond what is explained and developed in the POR (Exs. 2015, 2047) constitute improper incorporation by reference and should be stricken. Further, because Exhibits 2016-2023 and 2027 are substantively discussed in only those charts and not the POR, those exhibits also should be stricken as lacking supporting argument in the POR.

B. Petitioner's Motion To Strike Is Timely and Not Moot

Petitioner's motion is timely. Unlike objections to admissibility, which can be waived by a party if not raised timely, only the Board can waive non-compliance with its briefing rules, and there is no basis for such a waiver here. *See* 37 C.F.R. § 42.5(b). The rules of practice governing *Inter Partes* Review proceedings do not set forth any specific deadline for a motion to strike, instead leaving timing to the Board's discretion. 37 C.F.R. §§ 42.25, 42.64.

Cisco was not deprived of the opportunity to file a "corrected" POR by Petitioner's not raising the issue earlier. Cisco's suggestion that it could have filed a corrected Response is not credible given that the claim charts contained over 6,000 words of additional substantive argument. Even if Cisco could somehow have condensed those 6,000 words of element-by-element analysis into a revised brief, its decision to emphasize other issues in its POR was a tactical one. Indeed,

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