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 B1

PATENT OWNER'S
OPPOSITION TO PETITIONER'S MOTION TO STRIKE

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Patent Owner, Cisco Systems, Inc. ("Cisco"), opposes Petitioner, Arista Networks, Inc.'s ("Arista") Motion to Strike Patent Owner's claim charts on conception and secondary indicia (Exs. 2047, 2015) and evidence cited therein (Exs. 2016-2023, 2027). Petitioner's Motion, coming over five months after Cisco's paper was filed, is untimely and unfounded. Cisco cites to these exhibits as corroborating ***evidence*** for the arguments presented in its Patent Owner Response (POR). The exhibits do not contain argument and therefore the rule against incorporation by reference does not apply. The Board should therefore deny Petitioner's Motion.

I. Cisco Properly Relies on the Copying and Conception Exhibits.

The foundation of Petitioner's argument is its belief that the rule addressing incorporation by reference applies to evidence. But Petitioner is incorrect. Patent Trial and Appeal Board Rule 37 C.F.R. 42.6(a)(3) states that "***arguments*** must not be incorporated by reference from one document into another document." However, there is no rule preventing a party from citing to ***evidence*** to support an argument made in its paper. *Purdue Pharma L.P. v. Depomed, Inc.*, IPR2014-00377, Paper 30 at 2 (P.T.A.B. Nov. 21, 2014). That is exactly the case here. Cisco cites to claim charts provided by its expert to support the conception and copying arguments made in the POR. Petitioner cites no authority that prohibits use of corroborating evidence provided by an expert. *But see REG Synthetic Fuels, LLC v. Neste Oil Oyj*, 841 F.3d 954, 962 (Fed. Cir. 2016) (finding that a Patent Owner in an IPR

proceeding had "proven conception prior to the filing date of [of the prior art reference], based on [two] Exhibits" alone).

The test for whether incorporation by reference is improper is dependent on "whether such incorporation would circumvent page limits." *Silicon Labs., Inc. v. Cresta Tech. Corp.*, IPR2015-00615, Paper 64 at 17 (P.T.A.B. Aug. 11, 2016). Petitioner's argument that Cisco improperly cited to Dr. Almeroth's claim charts is based on an incorrect application of this test. More precisely, Petitioner's argument improperly counts the entire content of the cited exhibit—an exhibit that solely contains ***evidence***, not argument. This approach is not proper—only the actual ***argument*** found in the exhibit, and not evidence, should be counted. Thus, even if the POR argument contained one sentence referencing a large portion of an exhibit, the entire size of the exhibit is not included toward the word count of the paper. *Id.* (rejecting the argument that one sentence incorporating three paragraphs is impermissible).

For this reason, and the additional reasons discussed in detail below, Arista's motion to strike should be denied.

A. Cisco's Evidence Corroborating Conception Was Properly Presented.

With respect to Cisco's evidence corroborating conception (Ex. 2047), the Board should deny Petitioner's motion to strike for at least one fundamental reason—Petitioner's actions demonstrate that its request is moot. Petitioner primarily

uses its motion to strike as an opportunity to further attack the substance of Cisco's conception argument—an argument that should have been fully presented in its Reply. Tellingly, while Petitioner's Reply did raise an incorporation-by-reference argument for at least one exhibit referenced in Cisco's POR (Reply at 26-27), Petitioner's Reply failed to raise any such argument with respect to the conception claim chart. This omission from the Petitioner's Reply is not surprising because Cisco properly established the existence of conception in its POR.

"Conception must include every feature or limitation of the claimed invention," and it "must be proved by corroborating evidence which shows that the inventor disclosed to others his completed thought expressed in such clear terms as to enable those skilled in the art to make the invention." *REG Synthetic Fuels, LLC v. Neste Oil Oyj*, 841 F.3d 954, 962 (Fed. Cir. 2016). Cisco used the product specification (Ex. 2009) to provide corroborating evidence for its conception argument made in the POR. (POR, p. 36 ("The internal Cisco specification… provides exemplary evidence that the invention… was conceived at least as early as [the conception date]."); *see also REG Synthetic Fuels*, LLC 841 F.3d at 962 (finding conception based on exhibits cited by a Patent Owner). And Cisco merely used Dr. Almeroth's claim chart (Ex. 2047) to provide further evidentiary support for the establishment of conception presented in the POR. (POR at 35-37.)

Petitioner mischaracterizes the nature of the claim charts to fit its theory of improper incorporation-by-reference. Exhibit 2047 is not an argument. It is corroborating evidence to support Cisco's conception laid out in over three pages in the POR. (*Id*.) Dr. Almeroth's claim chart (Ex. 2047) cites to excerpts from the product specification that corroborate the conception information set forth in the POR and in the Declaration of the inventor Wayne Ogozaly. This evidence supports Patent Owner's argument that "the evidence establishes that by at least [date] the invention of the '668 patent was fully conceived in the minds of the inventors." (POR at 37.); *see also REG Synthetic Fuels*, LLC 841 F.3d at 962 Accordingly, the Board should deny Petitioner's Motion to Strike Cisco's conception evidence.

The Board should also deny Petitioner's Motion to Strike Dr. Almeroth's corroborating conception chart because it is untimely. When it comes to procedural objections, the Board has warned that such objections should be "raised as soon as possible... to preserve remedial measures which can still be taken by the Board without prejudice to all parties." *Research in Motion Corp. v. Multimedia Ideas LLC*, IPR2013-00036, Paper 15 at 8 (P.T.A.B. Mar. 18, 2013). Petitioner did not timely raise this objection—instead waiting over five months to surprise Cisco with a backdoor procedural attack. The objection made ***after*** Petitioner's Reply deprived Cisco of any remedy at this late stage of the proceeding. *Id*. For example, Cisco could have sought leave to file a replacement POR to reduce the total num-

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