

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS INC.,
RUCKUS WIRELESS, INC.,
BROCADE COMMUNICATION SYSTEMS, INC.,
and NETGEAR, INC.,
Petitioners,

v.

CHRIMAR SYSTEMS, INC.,
Patent Owner.

Case IPR2016-01399¹
U.S. Patent No. 8,902,760

**PATENT OWNER'S RESPONSE TO PETITIONERS' SUPPLEMENTAL
OPENING BRIEF AS AUTHORIZED BY PAPER 69**

¹ Ruckus Wireless, Inc., Brocade Communication Systems, Inc. and Netgear, Inc. filed a petition in (now terminated) IPR2017-00719, who have been joined to the instant proceeding.

I. Introduction

On January 4, 2017, the Board instituted *Inter Partes* Review of claims 1, 31, 37, 59, 69, 72, 73, 106, 112, 134, 142, and 145 of U.S. Patent No. 8,902,760 under 35 U.S.C. § 314(a). (Paper 8, pp. 20-21.) At that time, claims 73, 106, 112, 134, 142, and 145 (and other claims not relevant here) (“*the Original Claims*”) were being reexamined by the PTO in a separate *anonymous-third-party requested* reexamination proceeding Control No. 90/013,802 filed August 29, 2016.²

In the reexamination, Chrimar (“Patent Owner”) effectively rewrote dependent claim 101—a claim not at issue in this IPR—as an independent claim by amending claim 73 to include the claim 101 language, “the piece of central network equipment is a BaseT Ethernet hub.” On September 18, 2017, the PTO issued a reexamination certificate for the ‘760 patent. The effect of that certificate was to (1) cancel Original Claim 73 and (2) renumber claim 101 as a *new* claim 73, from which claims 106, 112, 134, 142, and 145 depended (“*the New Claims*”).

II. The Board has No Jurisdiction over the New Claims

Because jurisdiction is a relevant issue at all stages of an IPR, Chrimar first addresses that issue before turning to Petitioners’ Opening Brief. The Board has no jurisdiction over the New Claims.

² Claim 73 is an independent claim; the remaining Original Claims depend from claim 73.

Per 35 U.S.C. § 314(a), the Board may authorize *inter partes* review only based on information in a petition, and per § 312(a) a petition must identify “in writing and with particularity, each claim challenged.” The Petition (Paper 1) did not assert that original claim 101 (New Claim 73) was unpatentable, the Board did not institute the IPR with respect to claim 101, and the parties presented no evidence nor arguments about the patentability of claim 101 in their briefs or at the oral hearing. The Board therefore lacks jurisdiction to consider the patentability of the New Claims.

Further, Petitioners cannot challenge original claim 101 (New Claim 73) now for at least two reasons. *First*, per § 315(b), Petitioners’ one-year time for filing a petition has expired. *Second*, Petitioners gave up the opportunity to request that the Board consider, via § 315(d), claims amended during the reexamination. Under § 315(d), the Board may merge an IPR with another co-pending proceeding. But Petitioners “knew about the related reexaminations at least since February 6, 2017” (Order 62 at 3) and chose not to request consolidation under § 315(d).

Considering claims without a petition under § 314(a) or consolidation under § 315(d) prevents the Patent Owner from fully addressing the validity of Petitioners’ arguments and violates Patent Owner’s due process and APA rights. The Federal Circuit determined in *NuVasive* that the agency “violated NuVasive’s rights under the Administrative Procedure Act” by not allowing NuVasive to respond to material

called out in the reply that was relied upon by the Board in making its determination. *In re NuVasive, Inc.*, 841 F.3d 966, 968 (2016). Here, the Patent Owner has been given little opportunity to argue the validity of New Claim 73, and no opportunity to submit supporting evidence, a clear violation of due process. The Board issuing, *sua sponte*, a final decision about the patentability of the New Claims has no statutory basis and would violate the Patent Owner's due process and APA rights. *Id.* at 968, 971.

III. Petitioners' Arguments Regarding the New Claims Treats the Prior Art as a Mere Parts Catalog

Petitioners' obviousness arguments must address the New Claims "as a whole," not as a catalog of separate parts. 35 U.S.C. § 103(a) (2004); *Microsoft Corp. v. Biscotti, Inc.*, ___ F.3d ___, 2017 WL 6613262 at *8 (Fed. Cir. Dec. 28, 2017).³ Petitioners' Supplemental Opening Brief catalogs parts of the various prior

³ "The Board found it particularly unpersuasive that Kenoyer did not link the separate embodiments. [IPR2014-01458] at *___, 2016 Pat. App. LEXIS 7573, at *30-31 (citing *Lindemann Maschinenfabrik GMBH v. Am. Hoist & Derrick Co.*, 730 F.2d 1452, 1458, 1459 (Fed. Cir. 1984), for the proposition that requiring the prior art elements themselves to be 'arranged as in the claim' means that claims cannot be 'treated ... as mere catalogs of separate parts, in disregard of the part-to-part relationships set forth in the claims and that give the claims their meaning'.")"

art references without showing how those separate parts form a whole system as required by the claims or why an ordinary artisan would put the parts together as claimed. *Microsoft* 2017 WL 6613262 at *8. For instance, in their Ground 1 section, Petitioners claim to find various hubs, twisted-pair wiring, and power sources (Paper 70 at 2-4), but fail to show those parts arranged as required by the New Claims. Likewise, in their Ground 2 section, Petitioners find various parts scattered throughout the IEEE references—and even combine Hunter (from Ground 1) with the IEEE references, a combination never before argued. (Paper 70 at 4-5.) But, again, Petitioners fail to show a motivation to put the separate parts arranged as required by the New Claims.

In addition, Petitioners cite no evidence that Ground 1 or Ground 2 disclose a “piece of central network equipment [that] is a BaseT Ethernet hub,” as New Claim 73 requires. In Ground 1, Petitioners cite (p. 3) the “10Base-T repeater” functionality in Hunter’s hub 120. But a “repeater” is not a “hub.” (Ex. 1008 at 29, 32-33 (defining “hub” differently than “repeater”).)⁴ For example, hubs are “network” layer devices while repeaters are “physical” layer devices—

⁴ Normally, Chrimar would support the facts in this Brief—countering Petitioners’ new arguments—with additional evidence, but the Board prohibited Chrimar from including such evidence (Paper 69 at 2) which, again, violates due process.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.