

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CAVIUM, INC.,

*Petitioner,*

v.

ALACRITECH INC.,

*Patent Owner*

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Case IPR2017-01729

U.S. Patent 8,805,948

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**PATENT OWNER'S PRELIMINARY RESPONSE  
PURSUANT TO 35 U.S.C. § 313 AND 37 C.F.R. § 42.107**

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**TABLE OF AUTHORITIES**

**Cases**

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### Additional Authorities

Andrew S. Tanenbaum, <i>Computer Networks</i> (3rd ed. 1996).....	2, 40
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