Filed: March 6, 2019

Doug G. Muehlhauser (Reg. No. 42,018) William H. Shreve (Reg. No. 35,678) KNOBBE, MARTENS, OLSON & BEAR, LLP 2040 Main Street, Fourteenth Floor Irvine, CA 92614 Tel.: (949) 760-0404 Fax: (949) 760-9502 E-mail: BoxNomadix@knobbe.com

## UNITED STATES PATENT AND TRADEMARK OFFICE

## BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUEST TEK INTERACTIVE ENTERTAINMENT LTD., Petitioner,

v.

NOMADIX, INC., Patent Owner.

Case IPR2019-00253 Patent 8,626,922

PATENT OWNER'S PRELIMINARY RESPONSE TO PETITION FOR INTER PARTES REVIEW

DOCKET

## **TABLE OF CONTENTS**

I.	INTRODUCTION1				
II.	I. FACTUAL AND PROCEDURAL BACKGROUND				
	A.	Nomadix sues Petitioner2			
	В.	Over the next two years, Petitioner files six IPR petitions			
III.	OVERVIEW OF THE '922 PATENT				
	A.	Sample embodiments described in the specification4			
	B.	Claims 1 and 96			
IV.	PREI	PRELIMINARY CLAIM-CONSTRUCTION REMARKS			
V.	PETI	TITIONER'S ASSERTED GROUNDS8			
VI.	THE BOARD SHOULD DENY THE PETITION9				
	А.	Since it was not sworn or made under penalty of perjury, the Board should not accord Dr. Dordal's testimony any weight9			
	B.	Petitioner fails to carry its burden for Grounds 1 and 310			
		1. Bonomi's comparison of arrival times is not a calculation of a delay period11			
		2. Petitioner has failed to demonstrate that one of ordinary skill in the art would be motivated to combine Bonomi and Borella with a reasonable expectation of success			

## IPR2019-00253 Patent 8,626,922

		а.	Bonomi's traffic-shaping technology is completely reliant on underlying technologies unique to ATM networking	14		
		b.	Borella's technology is completely reliant on the specific packet format that the IP protocol dictates	18		
		c.	The IP-rooted technology of Borella cannot be incorporated into Bonomi, which relies on unique aspects of ATM networks	21		
	3.	ordi com	tioner has failed to demonstrate that one of nary skill in the art would be motivated to bine Bonomi and Teraslinna with a conable expectation of success	25		
C.	Petitioner fails to carry its burden for Ground 2 because it fails to show that Rupp is prior art, let alone prior art that renders the claims obvious					
	1.		tioner has failed to offer evidence that Rupp stitutes a prior-art printed publication	29		
		a.	Petitioner mischaracterizes Mr. Grenier's testimony—he never states that Rupp was published by May 20, 1998	30		
		b.	Mr. Grenier offers no competent evidence of public accessibility early enough to make his Exhibit A prior art, and his Exhibit A is not even the same as Rupp			
		c.	Mr. Grenier's statements about a 1998 conference are not competent evidence that Rupp qualifies as a printed publication	32		

## IPR2019-00253 Patent 8,626,922

	2.	Petitioner fails to carry its burden of demonstrating Rupp is analogous art	\$5
	3.	Even if Rupp were analogous art, one of ordinary skill in the art would neither be motivated to combine Chandran and Rupp nor have a reasonable expectation of succeeding in combining the two to arrive at the claimed	
		inventions	8
VII.	CONCLUS	ION4	13

## **TABLE OF AUTHORITIES**

Acceleration Bay, LLC v. Activision Blizzard Inc., 908 F.3d 765 (Fed. Cir. 2018)	29
<i>Blue Calypso, LLC v. Groupon, Inc.,</i> 815 F.3d 1331 (Fed. Cir. 2016)	34, 35
DePuy Spine, Inc. v. Medtronic Sofamor Danek, Inc., 567 F.3d 1314 (Fed. Cir. 2009)	25, 27, 28
FedEx Corp. v. Ronald A. Katz Tech. Licensing, L.P., Case CBM2015-00053 (PTAB June 29, 2015) (Paper 9)	9, 10
<i>In re Clay</i> , 966 F.2d 656 (Fed. Cir. 1992)	36, 37, 38
<i>In re Cronyn</i> , 890 F.2d 1158 (Fed. Cir. 1989)	29
<i>In re Gordon</i> , 733 F.2d 900 (Fed. Cir. 1984)	25, 27, 28
<i>In re Kahn</i> , 441 F.3d 977 (Fed. Cir. 2006)	35
<i>In re Klein</i> , 647 F.3d 1343 (Fed. Cir. 2011)	
<i>In re Sponnoble</i> , 405 F.2d 578 (C.C.P.A. 1969)	25
Intel Corp. v. Alacritech, Inc., Case IPR2017-01402 (PTAB Nov. 6, 2017) (Paper 8)	10
<i>K-TEC, Inc. v. Vita-Mix Corp.</i> , 696 F.3d 1364 (Fed. Cir. 2012)	35
McGinley v. Franklin Sports, Inc., 262 F.3d 1339 (Fed. Cir. 2001)	

## DOCKET A L A R M



# 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.