

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC. & PALO ALTO NETWORKS, INC.,
Petitioner,

v.

PACKET INTELLIGENCE LLC,
Patent Owner.

IPR2020-00335 (Patent 6,651,099 B1) IPR2020-00336 (Patent 6,665,725 B1)
IPR2020-00337 (Patent 6,771,646 B1) IPR2020-00338 (Patent 6,839,751 B1)
IPR2020-00339 (Patent 6,954,789 B2) IPR2020-00485 (Patent 6,651,099 B1)
IPR2020-00486 (Patent 6,954,789 B2)¹

Before STACEY G. WHITE, CHARLES J. BOUDREAU, JOHN D.
HAMANN, and KRISTI L. R. SAWERT, *Administrative Patent Judges*.

SAWERT, *Administrative Patent Judge*.

ORDER

Granting Petitioner's Request for Additional Briefing
37 C.F.R. § 42.5; 37 C.F.R. § 42.108(c)

¹ We exercise our discretion to enter a single order to be entered in each case. For convenience, we refer to the exhibit numbers entered in IPR2020-00335. The parties are not permitted to use this caption. This is not an expanded panel. The panel for IPR2020-00335, -00336, -00337, and -00485 includes Judges White, Boudreau, and Hamann. The panel for IPR2020-00338, -00339, and -00485 includes Judges Boudreau, Hamann, and Sawert.

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On June 19, 2020, counsel for Petitioner Juniper Networks, Inc. and Palo Alto Networks, Inc. (“Petitioner”) contacted the Board via email to request a conference call seeking authorization to file a Preliminary Reply to Patent Owner’s Preliminary Response in the above-identified proceedings. *See* Ex. 3002. The panels have conferred and determined that a conference call is not necessary. For the reasons explained below, Petitioner is authorized to file a Preliminary Reply and Patent Owner is authorized to file a Preliminary Sur-Reply, subject to the following restrictions.

A. Additional Briefing Directed to the Board’s Discretion Under 35 U.S.C. § 314(a)

Petitioner seeks authorization to file a Preliminary Reply addressing the Board’s order in *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 (PTAB Mar. 20, 2020) (“*Fintiv*”), which was designated as precedential on May 5, 2020. Petitioner states that it could not address *Fintiv* earlier, because the order was “made precedential after each petition was filed.” Ex. 3002. Petitioner states further that Patent Owner will not oppose Petitioner’s request “to specifically address the new precedent so long as Petitioners will not oppose Patent Owner being granted leave” to file a Preliminary Sur-reply. *Id.* Petitioner states that it “agreed to Patent Owner’s proposal.” *Id.*

In *Fintiv*, the Board discussed potential applications of *NHK Spring Co., Ltd. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential) (“*NHK*”), as well as other cases addressing discretionary denial under 35 U.S.C. § 314(a). *Fintiv* identifies a non-exclusive list of factors parties may consider addressing when arguing

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whether a related, parallel district-court action provides any basis for discretionary denial under *NHK*. *Fintiv* at 5–16. Those factors include:

1. whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted;
2. proximity of the court’s trial date to the Board’s projected statutory deadline for a final written decision;
3. investment in the parallel proceeding by the court and the parties;
4. overlap between issues raised in the petition and in the parallel proceeding;
5. whether the petitioner and the defendant in the parallel proceeding are the same party; and
6. other circumstances that impact the Board’s exercise of discretion, including the merits.

Id. at 5–6.

The panels have determined that it would be helpful for the parties to provide additional briefing on the applicability of 35 U.S.C. § 314(a) and the *Fintiv* factors to these proceedings. Thus, we authorize Petitioner to file a Preliminary Reply and Patent Owner to file a Preliminary Sur-Reply in each of these proceedings. *See* 37 C.F.R. §§ 42.20(d), 42.108(c). Specifically, Petitioner is authorized to file a ten-page Preliminary Reply no later than 5:00 PM Eastern Time, one week from the date of this Order. Patent Owner is authorized to file a ten-page Preliminary Sur-Reply, responding to Petitioner’s Preliminary Reply arguments. If Patent Owner elects to file a Preliminary Sur-Reply, it shall be filed no later than 5:00 PM Eastern Time, one week from the date of Petitioner’s Preliminary Reply. No additional

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briefing from either party is authorized at this time. Any portion of the briefing that is not responsive to this Order will not be considered.

B. Exhibits From Related District-Court Litigations

In its email, Petitioner also states that it “at least intend[s] to submit litigation scheduling and hearing transcript documents as exhibits to demonstrate factual inaccuracies of the [Patent Owner’s Preliminary Responses].” Ex. 3002. Petitioner states that “Patent Owner would not agree to the Petitioners supporting their [Preliminary] Reply with exhibits from the litigation.” *Id.*

The panels have determined that it would be helpful for the parties to provide additional documentation from the related district-court litigations that support each parties’ respective arguments on the applicability of 35 U.S.C. § 314(a) and the *Fintiv* factors to these proceedings. Thus, Petitioner may submit, for example, litigation scheduling and hearing transcript documents, as exhibits with its Preliminary Reply, so long as those exhibits are directly responsive to this Order. No other new evidence is permitted at this time.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner’s request for authorization to file a Preliminary Reply to Patent Owner’s Preliminary Response in each of these proceedings is *granted*;

FURTHER ORDERED that each Preliminary Reply is limited to addressing the applicability of 35 U.S.C. § 314(a) and the *Fintiv* factors to each proceeding;

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FURTHER ORDERED that each Preliminary Reply may be no more than ten (10) pages in length;

FURTHER ORDERED that Petitioner shall file any such Preliminary Reply by 5:00 PM Eastern Time, within one week from the date of this Order;

FURTHER ORDERED that, if Petitioner files a Preliminary Reply, Patent Owner is authorized to file a Preliminary Sur-Reply of no more than ten (10) pages in length in each of these proceedings, addressing Petitioner's Preliminary Reply arguments;

FURTHER ORDERED that Patent Owner shall file any such Preliminary Sur-Reply by 5:00 PM Eastern Time, within one week from the date of the Preliminary Reply;

FURTHER ORDERED that in each of these proceedings, the parties are authorized to submit with their supplementary papers new evidence as set forth above for each proceeding and that no other new evidence is permitted;

FURTHER ORDERED that in each of these proceedings, the parties may not submit new declaration evidence; and

FURTHER ORDERED that no additional briefing is permitted.

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