

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC.,  
Petitioner,

v.

RAMOT AT TEL AVIV UNIVERSITY LTD.,  
Patent Owner

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Case IPR2020-00484  
Patent No. 10,461,866 B2

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**PETITIONER'S NOTICE OF APPEAL**

via E2E  
Patent Trial and Appeal Board

via Hand Delivery  
Director of the United States Patent and Trademark Office  
c/o Office of the General Counsel, 10B20  
Madison Building East  
600 Dulany Street  
Alexandria, VA 22314

via CM/ECF  
United States Court of Appeals for the Federal Circuit

Pursuant to 28 U.S.C. § 1295(a)(4)(A), 5 U.S.C. §§ 701-706, 35 U.S.C. §§ 141(c), 142, and 319, and 28 U.S.C. § 1651, and in accordance with 37 C.F.R. §§ 90.2(a), 90.3, and Federal Circuit Rule 15(a)(1), Petitioner Cisco Systems Inc. (“Petitioner”) provides notice that it appeals to the United States Court of Appeals for the Federal Circuit from the Decision Denying Institution of *Inter Partes* Review of the Patent Trial and Appeal Board (“Board”) entered August 18, 2020 (Paper 10), and from all underlying and related orders, decisions, rulings, and opinions.

In accordance with 37 C.F.R. § 90.2(a)(3)(ii), the expected issues on appeal include, but are not limited to: the Board’s determination to deny institution of the *inter partes* review of claims 7, 8, 10–12, 19, 20, and 22–24 of U.S. Patent 10,461,866 B2 under 35 U.S.C. § 314(a); the Board’s adoption and application of non-statutory institution standards; and any finding or determination supporting or related to that determination, as well as all other issues decided adversely to Petitioner in any orders, decisions, rulings, or opinions.

Pursuant to 35 U.S.C. § 142 and 37 C.F.R. § 90.2(a), a copy of this Notice is being filed with the Director of the United States Patent and Trademark Office and with the Patent Trial and Appeal Board. In addition, a copy of this Notice and the required docketing fees are being filed with the Clerk’s Office for the United States Court of Appeals for the Federal Circuit via CM/ECF.

Respectfully submitted,

Dated: October 20, 2020

/Theodore Foster/

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**CERTIFICATE OF SERVICE**

Pursuant to 37 C.F.R. § 42.6, this is to certify that a true and correct copy of the foregoing "Petitioner's Notice of Appeal" service was made on the Patent Owner as detailed below:

<i>Date of service</i>	October 20, 2020
<i>Manner of service</i>	Electronic mail to lrobinson@bdiplaw.com; cjohanningmeier@bdiplaw.com; BDIP_RamotIPRService@bdiplaw.com
<i>Documents served</i>	Petitioner's Notice of Appeal
<i>Persons served</i>	Lauren N. Robinson Corey Johanningmeier Bunsow De Mory LLP 701 El Camino Real Redwood City, California 94063

Respectfully submitted,

/Theodore Foster/  
Theodore Foster  
Reg. No. 57,456  
Counsel for Petitioner

In accordance with 37 C.F.R. §§ 90.2(a)(1) and 104.2(b), I hereby certify that, in addition to being filed electronically through the Board's E2E system, the original version of the foregoing Notice of Appeal was filed by hand on October 20, 2020, with the Director of the United States Patent and Trademark Office, at the following address:

Director of the United States Patent and Trademark Office  
c/o Office of the General Counsel, 10B20  
Madison Building East  
600 Dulany Street  
Alexandria, VA 22314

In accordance with 37 C.F.R. § 90.2(a)(2), I hereby certify that on October 20, 2020, a true and correct copy of the foregoing Notice of Appeal was filed electronically with the Clerk's Office of the United States Court of Appeals for the Federal Circuit, and delivered by hand, at the following address:

United States Court of Appeals for the Federal Circuit  
717 Madison Place, N.W., Suite 401  
Washington, DC 20439

Respectfully submitted,

Dated: October 20, 2020

/Theodore Foster/  
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Patent 10,461,866 B2

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Before CHRISTOPHER L. CRUMBLEY, MONICA S. ULLAGADDI, and  
JASON M. REPKO, *Administrative Patent Judges*.

Opinion for the Board filed by *Administrative Patent Judge* REPKO.

Opinion Dissenting filed by *Administrative Patent Judge* CRUMBLEY.

REPKO, *Administrative Patent Judge*.

DECISION  
Denying Institution of *Inter Partes* Review  
35 U.S.C. § 314

## I. INTRODUCTION

Cisco Systems, Inc. (“Petitioner”) filed a petition to institute *inter partes* review of claims 7, 8, 10–12, 19, 20, and 22–24 of U.S. Patent No. 10,461,866 B2 (Ex. 1001, “the ’866 patent”). Paper 2 (“Pet.”). Ramot at Tel Aviv University Ltd. (“Patent Owner”) filed a Preliminary Response. Paper 6 (“Prelim. Resp.”).

To institute an *inter partes* review, we must determine “that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.” 35 U.S.C. § 314(a). But the Board has discretion to deny a petition even when a petitioner meets that threshold. *Id.*; *see, e.g., Cuozzo Speed Techs., LLC v. Lee*, 136 S. Ct. 2131, 2140 (2016) (“[T]he agency’s decision to deny a petition is a matter committed to the Patent Office’s discretion.”); *Gen. Plastic Indus. Co. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2017) (precedential as to § II.B.4.i); *NHK Spring Co. v. Intri-Plex Techs., Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018) (precedential); Patent Trial and Appeal Board Consolidated Trial Practice Guide 64 (Nov. 20, 2019), <http://www.uspto.gov/TrialPracticeGuideConsolidated> (identifying considerations that may warrant exercise of this discretion).

We authorized additional briefing to address discretionary denial of the Petition under § 314(a). Petitioner filed a reply. Paper 7 (“Reply”). And Patent Owner filed a sur-reply. Paper 8 (“Sur-reply”).

For the reasons discussed below, we exercise our discretion under § 314(a) to deny institution here.

## II. BACKGROUND

### *A. Related Matters*

According to the parties, the '866 patent has been asserted in *Ramot at Tel Aviv University Ltd. v. Cisco Systems, Inc.*, No. 2:19-cv-00225 (E.D. Tex. filed June 12, 2019). Pet. 7–8; Paper 4, 2 (Mandatory Notice). The '866 patent is also related to two patents that were challenged in IPR2020-00122 and IPR2020-00123. Pet. 8.

Claims 7, 8, 10–12, 19, 20, and 22–24 of the '866 patent are involved in an *ex parte* reexamination filed on June 9, 2020, which has been assigned control number 90/014,526.

### *B. The '866 patent*

The '866 patent generally relates to optical-signal modulation. *See, e.g.*, Ex. 1001, Abstract. At the time of the invention, analog optics modulation systems typically used Mach-Zehnder Interferometer (MZI) modulators. *Id.* at 1:54–56. MZI modulators, though, have an inherent non-linear response. *Id.* at 1:60–62. This can be a problem in analog applications. *Id.* And solutions at the time were inefficient, complex, or had limited dynamic range. *See id.* at 2:1–29.

To address these problems, the patent describes using a digital-to-digital converter (DDC) to convert the input data to an electrode-actuation pattern that more closely matches an ideal linear response. *Id.* at 7:45–49, 7:58–66. Because the conversion is efficiently performed in the digital domain, the invention can be used in high-frequency systems. *Id.* at 7:59–62.

*C. Claims*

Of the challenged claims, claims 7 and 19 are independent and are reproduced below.

7. A method for converting digital electrical data into one or more modulated optical streams using a modulation system, said method comprising:

inputting into a digital to digital converter coupled to an electrically controllable optical modulator N bits of a digital data word, N being larger than 1;

using the digital to digital converter for mapping a set of N input values corresponding to the N bits of digital data word to a digital drive vector corresponding to M drive voltage values where M is larger than N;

coupling the drive voltage values corresponding to the digital drive vector to the electrically controllable optical modulator, enabled to modulate by pulse modulation one or more unmodulated input optical signals, responsively to the drive voltage values, to provide one or more pulse modulated output optical signals..

Ex. 1001, 18:3–18.

19. A method for converting digital electrical data into one or more modulated optical streams using a modulation system, said method comprising:

inputting into a digital to digital converter coupled to an electrically controllable optical modulator N bits of a digital data word, N being larger than 1;

using the digital to digital converter for mapping a set of N input values corresponding to the N bits of digital data word to a digital drive vector corresponding to M drive voltage values where  $M=N$ ;

coupling the drive voltage values corresponding to the digital drive vector to the electrically controllable optical modulator, enabled to modulate by pulse modulation one or more

unmodulated input optical signals, responsively to the drive voltage values, to provide one or more pulse modulated output optical signals.

Ex. 1001, 19:41–20:10.

*D. Evidence*

Reference	Issued Date	Exhibit No.
US 7,277,603 B1 to Roberts	Oct. 2, 2007	1005
US 6,760,111 B1 to Mark	July 6, 2004	1007
Keang-Po Ho, Phase-Modulated Optical Communication Systems, 2005 (Ex. 1006)		

*E. Asserted Grounds*

Petitioner asserts that claims 7, 8, 10–12, 19, 20, and 22–24 are unpatentable on the following grounds. Pet. 21.

Claim(s) Challenged	pre-AIA <sup>1</sup> 35 U.S.C. §	Reference(s)/Basis
7, 8, and 10–12	103	Roberts, Ho
19, 20, and 22–24	103	Roberts, Ho, and Mark

*F. § 314(a)*

Under § 314(a), the Director has discretion to deny institution. In determining whether to exercise that discretion on behalf of the Director, we are guided by the Board’s precedential decision in *NHK Spring Co. v. Intriplex Technologies, Inc.*, IPR2018-00752, Paper 8 (PTAB Sept. 12, 2018).

In *NHK*, the Board found that the “advanced state of the district court proceeding” was a “factor that weighs in favor of denying” the petition under § 314(a). *NHK*, Paper 8 at 20. The Board determined that “[i]nstitution

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<sup>1</sup> Congress amended § 103 when it passed the Leahy-Smith America Invents Act (AIA), Pub. L. No. 112–29, § 3(c), 125 Stat. 284, 287 (2011). Here, the previous version of § 103 applies.

of an *inter partes* review under these circumstances would not be consistent with ‘an objective of the AIA . . . to provide an effective and efficient alternative to district court litigation.’” *Id.* (citing *Gen. Plastic*, Paper 19 at 16–17 (precedential in relevant part)).

“[T]he Board’s cases addressing earlier trial dates as a basis for denial under *NHK* have sought to balance considerations such as system efficiency, fairness, and patent quality.” *Apple Inc. v. Fintiv, Inc.*, IPR2020-00019, Paper 11 at 5 (PTAB Mar. 20, 2020) (precedential) (collecting cases). *Fintiv* sets forth six non-exclusive factors for determining “whether efficiency, fairness, and the merits support the exercise of authority to deny institution in view of an earlier trial date in the parallel proceeding.” *Id.* at 6. These factors consider

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.* In the sections that follow, we discuss each factor.

*1. Factor 1: whether the court granted a stay or evidence exists that one may be granted if a proceeding is instituted*

“A district court stay of the litigation pending resolution of the PTAB trial allays concerns about inefficiency and duplication of efforts. This fact has strongly weighed against exercising the authority to deny institution under *NHK*.” *Id.*

Here, the district court has denied the motion to stay without prejudice to its refiling if the Board institutes. Ex. 2005. Patent Owner argues that a stay on a renewed motion is unlikely because the Board has denied institution for two of the three patents in suit and the district court proceeding is in an advanced stage. Prelim. Resp. 18.

There is little evidence to suggest that the district court will grant a stay, should another one be requested. Absent specific evidence, we decline to speculate how the district court would rule on another stay request because a court may determine whether or not to stay based on the facts particular to an individual case. *See Sand Revolution II LLC v. Cont'l Intermodal Grp.*, IPR2019-01393, Paper 24, 7 (PTAB June 16, 2020) (informative, designated July 13, 2020) (declining to predict how the district court in the related litigation will proceed). So this factor does not weigh in favor of or against discretionary denial.

*2. Factor 2: proximity of the court's trial date to the Board's projected statutory deadline for a final written decision;*

“If the court's trial date is earlier than the projected statutory deadline, the Board generally has weighed this fact in favor of exercising authority to deny institution under *NHK*.” *Fintiv*, Paper 11 at 9.

According to the current record, the district court trial is scheduled to begin on December 9, 2020. Ex. 3001. The Board may not issue a final decision in this proceeding until approximately August 2021—over eight months after the trial begins.

Because the trial date is substantially earlier than the projected statutory deadline for the Board’s final decision, this factor weighs in favor of discretionary denial.

3. *Factor 3: investment in the parallel proceeding by the court and the parties*

“The Board also has considered the amount and type of work already completed in the parallel litigation by the court and the parties at the time of the institution decision.” *Fintiv*, Paper 11 at 9. “[M]ore work completed by the parties and court in the parallel proceeding tends to support the arguments that the parallel proceeding is more advanced, a stay may be less likely, and instituting would lead to duplicative costs.” *Id.* at 10.

At the time of this decision, Petitioner filed its invalidity contentions in the parallel proceeding, including detailed claim charts that address the same prior art cited in the Petition. *See* Ex. 2011 (invalidity contentions); Ex. 2012 (chart). The parties submitted claim construction charts and briefs. Ex. 2006, 4; Ex. 2007 (Joint Claim Construction Statement). A *Markman* hearing was held on May 11, 2020. Ex. 2008, 1; Prelim. Resp. 12. And a claim construction order has been issued. Ex. 2008, 1.

As for the remaining work, the deadline for expert discovery is August 21, 2020, and a jury trial is scheduled to begin in less than four months. Ex. 3001. By comparison, the Board in *NHK* determined that the parallel proceeding in that case was in an “advanced state” when expert

discovery was scheduled to end in less than two months and a jury trial was scheduled to begin in six months. *NHK*, Paper 8 at 20. In *NHK*, the Board found the case's advanced state to be an additional factor that favored denying institution. *Id.* Here, we determine that the district court case is in an even more advanced state and take this into account in our overall assessment of the investment.

Considering the investment in the parallel proceeding by the court and the parties, this factor weighs in favor of discretionary denial.

4. *Factor 4: overlap between issues raised in the petition and in the parallel proceeding*

“[I]f the petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this fact has favored denial.” *Fintiv*, Paper 11 at 12.

The Petition challenges the same claims involved in the district court proceeding. Pet. 21; Ex. 2012, 2–77 (Petitioner's Invalidation Contentions). And both the Petition and Petitioner's invalidity contentions in the parallel proceeding include obviousness rationales based on Roberts, alone and in combination with Ho or Mark. Pet. 21; Ex. 2012, 2–77. In fact, Petitioner's claim-invalidation chart in the parallel proceeding contains substantially similar assertions to those in the Petition. *Compare* Ex. 2012, 2–77, *with* Pet. 21–77 (§ XII Identification of How the Claims are Unpatentable).

Both proceedings would likely involve similar arguments about the Roberts, Ho, and Mark references. Thus, the parallel proceedings would duplicate effort. This is an inefficient use of Board, party, and judicial resources and raises the possibility of conflicting decisions.

Because the Petition includes the same or substantially the same claims, grounds, arguments, and evidence as presented in the parallel proceeding, this factor favors exercising our discretion to deny institution.

5. *Factor 5: whether the petitioner and the defendant in the parallel proceeding are the same party*

If the petitioner and the defendant in the parallel proceeding are the same and the validity issues are scheduled to be determined in the parallel proceeding first, this factor weighs in favor of discretionary denial. *Fintiv*, Paper 15 at 15 (informative) (applying *Fintiv* factor 5); *Sand Revolution*, Paper 24 at 12 (informative) (“Although it is far from an unusual circumstance that a petitioner in *inter partes* review and a defendant in a parallel district court proceeding are the same or where a district court is scheduled to go to trial before the Board’s final decision would be due in a related *inter partes* review, this factor weighs in favor of discretionary denial.”).

Here, Petitioner is the defendant in the parallel litigation in the United States District Court for the Eastern District of Texas: *Ramot at Tel Aviv University Ltd. v. Cisco Systems, Inc.*, No. 2:19-cv-00225 (E.D. Tex. filed June 12, 2019). Pet. 7–8; Paper 4, 2 (Patent Owner’s Mandatory Notice); *see also* Prelim. Resp. 10 (describing Petitioner’s involvement the case). So this factor weighs in favor of discretionary denial.

6. *Factor 6: Other Circumstances that Impact the Board’s Exercise of Discretion, Including the Merits*

“[I]f the merits of a ground raised in the petition seem particularly strong on the preliminary record, this fact has favored institution.” *Fintiv*,

Paper 11 at 14–15. We have reviewed the Petition and determine that its merits are not particularly strong here.

*a) Obviousness based on Roberts, Ho, and Mark*

Petitioner asserts that claims 7, 8, 10–12, 19, 20, and 22–24 are obvious over Roberts and a combination of teachings from Ho or Mark. Pet. 21.

*(1) “mapping”*

Both independent claims recite a mapping function. In particular, claim 7 recites, in part, “mapping a set of  $N$  input values corresponding to the  $N$  bits of digital data word to a digital drive vector corresponding to  $M$  drive voltage values where  $M$  is larger than  $N$ .” Ex.1001, 18:3–18.

Similarly, claim 19 recites, in part, “mapping a set of  $N$  input values corresponding to the  $N$  bits of digital data word to a digital drive vector corresponding to  $M$  drive voltage values where  $M=N$ .” *Id.* at 19:41–20:10.

For example, Figures 2A and 2B, below, illustrate the same four electrodes before and after mapping. *See* Ex. 1001, 7:41–49.

FIG. 2A  
(PRIOR ART)

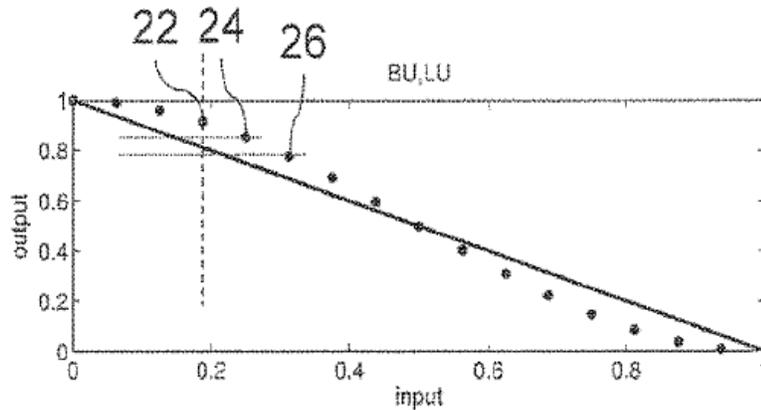
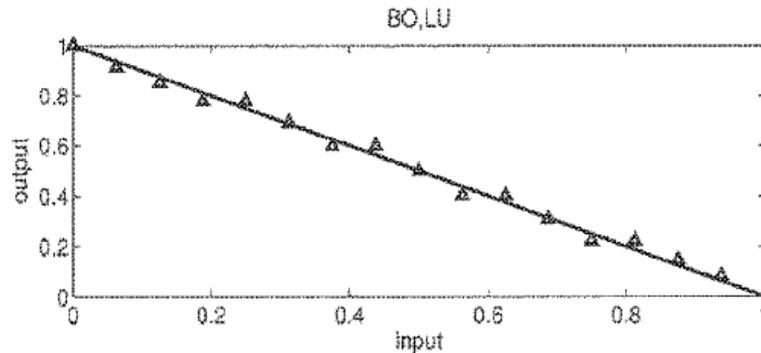


FIG. 2B



In Figure 2A, above, output point 22, corresponding to an input point of 0011, is higher than the ideal linear response, which is represented by a solid line. *Id.* at 7:49–51. Output point 26 is closest to the ideal response. *Id.* at 7:51–53. That point has a corresponding value of 0101. *Id.* To better approximate the linear response, the system converts electrode actuation pattern 0011 to 0101. *Id.* at 7:51–57. Figure 2B, above, shows the result of converting all input values in this way. *Id.* at 7:41–45.

(2) Roberts

Roberts modulates optical signals using an MZ modulator. Ex. 1005, 6:18–19. Roberts uses a digital signal processor (“DSP”) that functions as a digital filter and non-linear compensator. *Id.* at 6:31–33. The digital-filtering capabilities compute a target modulation and the non-linear compensator addresses the non-ideal electrical to optical transfer functions from the electrodes. *Id.* at 6:34–40. The DSP generates a pair of multi-bit sample

streams  $V_x(n)$ . *Id.* at 8:11–14. These streams represent the desired phase modulation applied to each branch of the MZ modulator. *Id.*

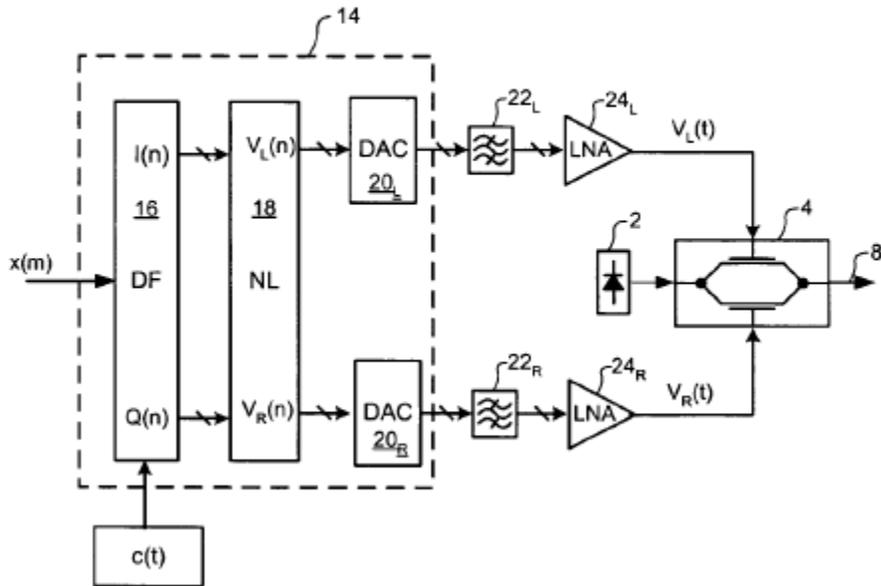
*(3) Merits of the Obviousness Grounds*

Petitioner relies on a non-linear compensator discussed by Roberts as the recited digital-to-digital converter in the independent and dependent claims. *See, e.g.*, Pet. 25, 37 n.6 (independent claim 7), 46–51 (claims 10–12), 62–63 (independent claim 19). The claims require using the digital-to-digital converter for mapping. Ex. 1001, 18:9 (claim 7), 20:1 (claim 19). According to Petitioner, “A POSITA would have found it obvious that Roberts’ non-linear compensator 18 is a ‘*digital to digital converter*’ because it is part of a digital signal processor 34 and converts a digital signal from one form to another.” Pet. 63 (emphasis in original); *see also* Pet. 46–51.

Patent Owner argues that Roberts mentions non-linear compensator 18 in the context of Figure 2, which is labeled as prior art. Prelim. Resp. 61 (citing Ex. 1005, 6:31–37). Patent Owner argues that Roberts does not explain how the non-linear compensator is used for mapping, as required by the claims. *Id.* at 60.

Roberts’s Figure 2 is reproduced below.

Figure 2  
(Prior Art)



According to Roberts, Figure 2, above, schematically illustrates a complex optical synthesizer from another patent application. Ex. 1005, 5:14–17.

Petitioner asserts that “a POSITA would have found it obvious that the  $I(n)$  and  $Q(n)$  signals represent  $N$  bits of a digital data word because the  $I(n)$  and  $Q(n)$  signals are illustrated with a parallel bit signal and are part of a digital signal process,” in independent claim 19. Pet. 65 (citing Blumenthal Decl. ¶ 193); *see also* Pet. 37 n.6 (discussing the compensator in connection with independent claim 7). Petitioner, though, provides little explanation of how Roberts’s non-linear compensator 18 teaches or suggests the specific relationship recited in the claims: “mapping a set of  $N$  input values corresponding to the  $N$  bits of digital data word to a digital drive vector corresponding to  $M$  drive voltage values where  $M$  is larger than  $N$ ” (Ex. 1001, 18:3–18), in claim 7, and “mapping a set of  $N$  input values corresponding to the  $N$  bits of digital data word to a digital drive vector

corresponding to  $M$  drive voltage values where  $M=N$ ” (Ex. 1001, 19:41–20:10), in claim 19.

To address this recited mapping, Petitioner relies on DSP 34, which appears in another embodiment. Pet. 37 n. 6 (referring to the rationale in the dependent claims), 46–51, 64–65. In fact, the diagram for this embodiment, Figure 7, does not show non-linear compensator 18. Ex. 1005, Fig. 7.

Figure 7

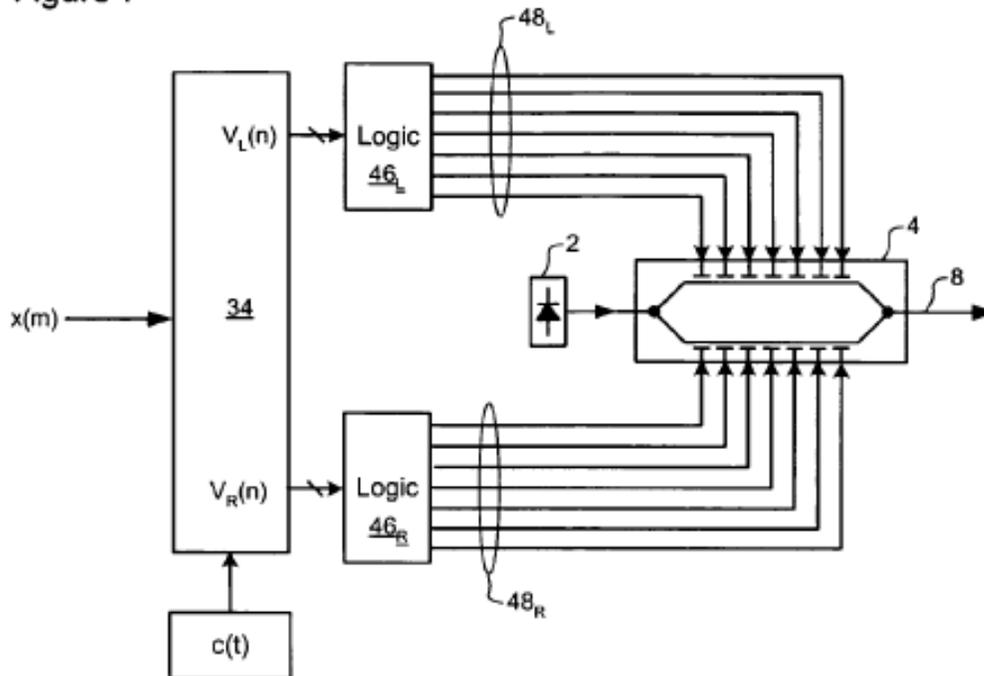


Figure 7, above, shows a complex optical synthesizer from an embodiment of the “present invention,” not the prior art shown in Figure 2. *Id.* at 5:28–30. In this embodiment, Roberts states that “the DSP 34 may incorporate the functionality of the digital filter 16 and non-linear compensator 18 of the complex driver 14 described above with reference to FIG. 2.” *Id.* at 8:7–10. That is, the embodiment of Figure 7 replaces non-linear compensator 18 with DSP 34. *Compare id.* Fig. 2, with *id.* Fig. 7.

Petitioner does not sufficiently explain how DSP 34 is used for mapping, as recited in claims 7 and 19, when functioning as non-linear compensator 18. For instance, Petitioner does not sufficiently explain how the compensator's  $I(n)$  and  $Q(n)$  signals—which are not shown in Figure 7—represent the recited  $N$  bits in this embodiment. *See* Pet. 65 (citing Blumenthal Decl. ¶ 193). Also, Petitioner asserts that Roberts's Table 1 is a mapping. *Id.* at 24. But logic circuits 46<sub>L</sub> and 46<sub>R</sub>—not non-linear compensator 18—implement the truth table of Robert's table 1. Ex. 1005, 8:17–30. In this way, Petitioner chooses features from multiple embodiments in Roberts with little explanation to support their combination. *Accord* Prelim. Resp. 60–61.

Thus, the merits of the obviousness grounds based on Roberts do not “seem particularly strong on the preliminary record.” *See Fintiv*, Paper 11 at 14–15. “[I]f the merits of the grounds raised in the petition are a closer call, then that fact has favored denying institution when other factors favoring denial are present.” *Id.* at 15.

#### *b) Other Circumstances*

Petitioner also argues that factors three through five “are present in nearly every IPR proceeding, as the majority of cases involve patents asserted in co-pending litigation initiated by the patent owner.” Pet. Reply 1. Yet we do not base our decision on these three factors in isolation. Rather, we weigh each factor consistent with our precedential decisions, taking “a holistic view of whether efficiency and integrity of the system are best served by denying or instituting review.” *Fintiv*, Paper 11 at 6.

#### *7. Conclusion*

All *Fintiv* factors weigh in favor of exercising our discretion to deny institution under § 314(a) except for one, which is neutral. Considering the

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*Fintiv* factors as part of a holistic analysis, instituting would be an inefficient use of Board, party, and judicial resources. *See NHK*, Paper 8 at 20. Thus, efficiency and integrity of the system are best served by denying review. *See Consolidated TPG* at 58 (quoting 35 U.S.C. § 316(b)).

### III. CONCLUSION

We exercise our discretion under § 314(a) to deny institution.

### IV. ORDER

It is

ORDERED that the Petition is *denied*.

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Patent Owner.

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Patent 10,461,866 B2

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Before CHRISTOPHER L. CRUMBLEY, MONICA S. ULLAGADDI, and  
JASON M. REPKO, *Administrative Patent Judges*.

CRUMBLEY, *Administrative Patent Judge*, dissenting.

I respectfully dissent from the majority's decision to exercise the Board's discretion to deny institution of trial, rather than examining whether the Petition establishes a reasonable likelihood of success in demonstrating that at least one of the challenged claims is unpatentable. 35 U.S.C. § 314(a). I have previously set forth my views regarding the application of the Board's precedential *Fintiv* factors in two related cases. *Cisco Systems, Inc. v. Ramot at Tel Aviv Univ. Ltd.*, IPR2020-00122, Paper 15 (PTAB May 15, 2020) (Crumbley, dissenting); *Cisco Systems, Inc. v. Ramot at Tel Aviv*

*Univ. Ltd.*, IPR2020-00123, Paper 14 (PTAB May 15, 2020) (Crumbley, dissenting). I need not repeat my reasoning a third time, and incorporate my prior dissents by reference here. But this case presents a slightly different procedural posture due to the three-month passage of time since our decisions in the prior related cases; I will address these differences briefly below.

As the majority correctly notes, certain factors under the *Fintiv* framework have arguably been strengthened in favor of discretionary denial in the three months since we issued our prior decisions. For example, the District Court’s December trial date is three months closer (factor two), and the court and parties have invested more time and effort in the parallel proceedings (factor three). But I hesitate to find that these factors weigh more heavily for discretionary denial here than in the prior cases. It is not as if the Petitioner here filed the two petitions in IPR2020-00122 and IPR2020-00123 in November of 2019, and then decided to simply delay for three months the filing of the instant Petition. Rather, the three-month lag between these cases—and the reason for further development of the district court case now—was directly caused by Patent Owner’s decision to amend its district court complaint to add counts alleging infringement of the ’866 patent that is the subject of this proceeding. I find it difficult to hold the increased proximity of the district court trial date, and the greater investment in that proceeding, against the Petitioner here when the delay was outside its control.

My prior dissents also addressed an additional consideration under *Fintiv* factor six, which took into account the Petitioner’s diligence in filing its petition as an “other circumstance” relevant to discretionary denial. *See* IPR2020-00122, dissent at 11. I noted that the petitions in those cases had

been filed within two months of receiving the Patent Owner's infringement contentions. *Id.* If anything, the present case provides an even stronger example of the Petitioner acting diligently to file its Petition. The Amended Complaint that added the '866 patent to the district court suit was filed on December 12, 2019, six months after the original complaint was filed. Paper 7, 2. Petitioner filed the instant Petition challenging the claims of the '866 patent on January 31, 2020, less than seven weeks later. Paper 2.

For these reasons, and despite the passage of three months since our consideration of the two related petitions, on balance I believe the *Fintiv* framework still weighs in favor of not exercising our discretion to deny institution of trial. I maintain my analysis of the factors as expressed in my prior dissents, and once again respectfully dissent from the majority's decision to the contrary.

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Patent 10,461,866 B2

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