IN THE UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF DELAWARE

NETSCOUT SYSTEMS, INC., **Plaintiff,** **v.** **PACKET INTELLIGENCE LLC, PACKET INTELLIGENCE HOLDINGS LLC, AND LONGHORN ASSET GROUP LLC,** **Defendants.**	**Civil Action No.: _____** **JURY TRIAL DEMANDED**

COMPLAINT FOR DECLARATORY JUDGMENT

Plaintiff NetScout Systems, Inc. ("NetScout") for its complaint against Defendants Packet Intelligence LLC, Packet Intelligence Holdings LLC, and Longhorn Asset Group LLC ("Defendants"), hereby alleges as follows:

NATURE OF THE ACTION

1. Pursuant to the Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.*, and the patent laws of the United States, 35 U.S.C. § 1 *et seq.*, this is an action for declaratory judgment of non-infringement and invalidity of United States Patent Nos. 6,651,099 (the "'099 patent"), 6,665,725 (the "'725 patent"), 6,771,646 (the "'646 patent"), 6,839,751 (the "'751 patent"), and 6,954,789 (the "'789 patent") (collectively, the "Dietz patents," attached hereto as Exs. A-E), and for such other relief as the Court deems just and proper.

2. NetScout files this Declaratory Judgment Action to resolve unanswered allegations of infringement and invalidity regarding the Dietz patents, including allegations of

infringement that have been asserted against NetScout's "InfiniStream" line of products. Three of the five Dietz patents are at issue in a lawsuit filed against NetScout and its related Texas-based entities in the Eastern District of Texas alleging infringement of a different line of products, known as the "GeoProbe" products. *See Packet Intelligence LLC v. NetScout Systems, Inc., Tektronix Communications and Tektronix Texas, LLC*, No. 2:16-cv-00230, D.I. 1 (E.D. Tex. Mar. 15, 2016) (the "Texas Case"). The Texas Case was filed by a shell corporation, Packet Intelligence LLC, which was created by Defendants Packet Intelligence Holdings LLC and Longhorn Asset Group LLC, for the sole purpose of creating jurisdiction in the Eastern District of Texas. But the Texas Case targets narrow issues relating to only the GeoProbe products, and leaves many allegations relating to the Dietz patents unresolved. This Declaratory Judgment Action seeks to resolve, in a proper venue, allegations regarding the two Dietz patents not at issue in the Texas Case and issues that were neither presented to nor considered by the court in the Texas Case regarding the other three Dietz patents.

3. The Texas Case, which is now in a post-trial stage, is limited to the GeoProbe products, which were originally developed by a Texas-based company called "Tektronix" that was acquired by NetScout in 2015. The Texas Case did not address whether there was infringement by any other NetScout products, including the "InfiniStream" products that NetScout was offering years before the Tektronix acquisition. In fact, the court in the Texas Case specifically ruled that the InfiniStream products were outside the scope of that case. Defendants accused the InfiniStream products of infringing the Dietz patents and moved to have claims against these products added to the Texas Case. But the court in the Texas Case found those claims to be untimely and denied leave for the InfiniStream products to be included.

4. In addition to not addressing the InfiniStream products, the Texas Case will not resolve invalidity of any claims in two of the five Dietz patents (the '099 and '646 patents) and the vast majority of the claims in the other three Dietz patents (the '725, '751, and '789 patents). The Texas Case is only addressing whether a total of six (6) asserted claims from the '725, '751, and '789 patents are patent-ineligible under 35 U.S.C. § 101, invalid as anticipated by a single prior art reference (namely, an early NetScout network probe), and invalid for failing to name the true inventors of the claimed subject matter. As such, the Texas Case will not address at least: (1) invalidity of the '099 and '646 patents on any ground; (2) invalidity of the unasserted claims of the '725, '751, and '789 patents on any ground; and (3) invalidity of the asserted claims of the '725, '751, and '789 patents on other invalidity grounds, including anticipation based on other prior art references and obviousness based on combinations of prior art. Other than anticipation based on an early NetScout probe and incorrect inventorship, no other invalidity issues were addressed at the trial in the Texas Case, including invalidity for obviousness based on combinations of prior art references.

5. NetScout files this Declaratory Judgment Action against Defendants to resolve the issues that will not be resolved in the Texas Case—namely, that the InfiniStream products do not infringe any of the Dietz patents and that the claims of these patents are invalid for myriad reasons.

PARTIES

6. Plaintiff NetScout is a Delaware corporation with its principal place of business at 310 Littleton Road, Westford, MA 01886-4105.

7. Defendant Packet Intelligence LLC ("Packet Intelligence") is a Texas corporation that rents an office at 505 East Travis Street, Suite 209, Marshall, TX 75670. Upon information

and belief, Packet Intelligence may be served with process through its registered agent, National Registered Agents, Inc., 1999 Bryan St., Suite 900, Dallas, TX 75201-3136. Upon information and belief, Packet Intelligence has no employees, owns no real property, and produces no products. Further, upon information and belief, Packet Intelligence exists solely to hold the Dietz patents, their related patent applications, and their foreign counterparts.

8. Defendant Packet Intelligence Holdings LLC ("PI Holdings") is a Delaware corporation. Upon information and belief, PI Holdings can be served with process through its registered agent, National Registered Agents, Inc., 160 Greentree Dr., Suite 101, Dover, DE 19904. Upon information and belief, PI Holdings is the sole member of Packet Intelligence. Further, upon information and belief, PI Holdings' only asset is Packet Intelligence.

9. Defendant Longhorn Asset Group LLC ("Longhorn") is a Delaware corporation. Upon information and belief, Longhorn can be served with process through its registered agent, National Registered Agents, Inc., 160 Greentree Dr., Suite 101, Dover, DE 19904. Upon information and belief, Longhorn's only asset is PI Holdings.

JURISDICTION AND VENUE

10. This action arises under the Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.*, and under the patent laws of the United States, 35 U.S.C. § 1 *et seq.*

11. This Court has jurisdiction over the subject matter of this action pursuant to 28 U.S.C. §§ 1331, 1338(a), 2201, 2202, and the patent laws of the United States, including 35 U.S.C. § 271 *et seq.*

12. This Court has personal jurisdiction over PI Holdings by virtue of its sufficient minimum contacts with this forum such that the exercise of jurisdiction over PI Holdings will not offend traditional notions of fair play and substantial justice.

13. This Court has personal jurisdiction over Longhorn by virtue of its sufficient minimum contacts with this forum such that the exercise of jurisdiction over Longhorn will not offend traditional notions of fair play and substantial justice.

14. This Court has personal jurisdiction over Packet Intelligence because it is a shell corporation that is dominated by Delaware corporations PI Holdings and Longhorn, and that was formed for the sole purpose of creating jurisdiction and venue for patent litigation in the Eastern District of Texas. Packet Intelligence has no independent personnel; no independent ability to make decisions; and no ability to hold funds, disburse funds, or transact business on its own behalf. This Court's exercise of jurisdiction over Packet Intelligence will not offend traditional notions of fair play and substantial justice because, upon information and belief, Packet Intelligence is the alter-ego of PI Holdings and/or Longhorn, is funded entirely by and through PI Holdings and/or Longhorn, and acts solely through PI Holdings and/or Longhorn to the extent that it receives, holds, or disburses funds.

15. Venue is proper in this District under 28 U.S.C. §§ 1391(b) and (c) because Defendants are subject to personal jurisdiction here.

EXISTENCE OF AN ACTUAL CONTROVERSY

16. There is an actual controversy within the jurisdiction of this Court under 28 U.S.C. §§ 2201 and 2202.

17. The Dietz patents are directed to devices and methods for monitoring traffic in a network.

18. NetScout is a provider of application and network performance management products, including network monitors. Among the products manufactured and sold by NetScout is the InfiniStream® family of products, which are used to capture and analyze information from

computer network traffic. In July 2015, NetScout acquired certain communications businesses of Danaher Corporation, including Tektronix Communications. Among the products manufactured and sold by Tektronix was the GeoProbe family of products, which were used to capture and analyze information from service provider (telephone) networks.

19. On March 15, 2016, Packet Intelligence filed a complaint in the Texas Case which alleged that certain GeoProbe products infringed the Dietz patents. In response to Packet Intelligence's complaint, NetScout counterclaimed for a declaration of noninfringement as to the GeoProbe products and invalidity.

20. Defendants asserted the Dietz patents in three other litigations in the past four years. *See Packet Intelligence LLC v. Huawei Device USA Inc.*, No. 2:13-cv-00206 (E.D. Tex.); *Packet Intelligence LLC v. Cisco Systems, Inc.*, Nos. 2:14-cv-00252 and 2:14-cv-01122 (E.D. Tex.); and *Packet Intelligence LLC v. Sandvine Corp.*, No. 2:16-cv-00230 (E.D. Tex.).

21. On or about February 2017, Defendants requested leave to amend their infringement contentions in the Texas Case to accuse NetScout's InfiniStream product family of infringing the Dietz patents. However, on or about April 27, 2017, the Texas court denied Defendants' motion, finding that Defendants had failed to act diligently in investigating whether the InfiniStream products might have infringed the asserted patents.

22. Prior to trial in the Texas Case, Defendants withdrew their claims of infringement as to the '099 and '646 patents, and the Court dismissed NetScout's declaratory judgment counterclaims as to those patents.

23. The Texas Case was tried in October 2017. On October 13, 2017, a jury found NetScout's GeoProbe G10 and GeoBlade products infringed claims 10 and 17 of the '725 patent, claims 1 and 5 of the '751 patent, and claims 19 and 20 of the '789 patent. The jury also found

these claims not to be invalid in light of the anticipation and inventorship defenses presented at trial. Judgment has not yet been entered in the Texas Case, and NetScout anticipates filing motions pursuant to Fed. R. Civ. P. 50 and 59 following entry of judgment, challenging, *inter alia*, the jury's finding that the GeoProbe products infringe these claims and that the claims are not invalid in view of the prior art NetScout probe. Furthermore, the Texas court has ordered briefing pursuant to Fed. R. Civ. P. 52 on the issue of whether the Dietz patents are invalid because they purport to claim ineligible subject matter pursuant to 35 U.S.C. § 101.

COUNT ONE
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '099 PATENT

24. Paragraphs 1 through 23 are incorporated by reference as if fully stated herein.

25. Packet Intelligence claims to own all rights, title, and interest in the '099 patent.

26. In seeking to amend its infringement contentions in the Texas Case to add the InfiniStream family of products, Defendants accused NetScout of infringing at least one claim of the '099 patent by making, using, selling, offering for sale, and/or causing others to make, use, sell, and/or offer for sale, the InfiniStream family of products.

27. Contrary to Defendants' assertions in the Texas Case, the InfiniStream products do not infringe any valid claim of the '099 patent. The InfiniStream products are the current version of the NetScout probe that NetScout has been selling for decades, dating back to well before the Dietz patents. In the Texas Case, NetScout identified the prior art NetScout 6010 probe, version 4.5, ("Prior Art NetScout Probe"), as anticipating the Dietz patents. Packet Intelligence contended at trial in the Texas Case that the Prior Art NetScout Probe was not covered by the claims of the Dietz patents. Many of the same features of the Prior Art NetScout Probe are still present in the InfiniStream products, NetScout's current version of this same platform. The arguments and contentions advanced by Packet Intelligence in the Texas Case

purportedly to distinguish the Prior Art NetScout Probe also distinguish and demonstrate non-infringement of the InfiniStream products. Thus, Defendants are barred by judicial estoppel from asserting infringement based on a theory that directly conflicts with their arguments advanced in the Texas Case.

28. NetScout further does not infringe the '099 patent, among other reasons, because the InfiniStream products do not literally or under the doctrine of equivalents meet one or more of the limitations of the claims of the '099 patent. For example, the InfiniStream products do not meet the limitation recited in claim 1 of "(d) a memory storing a flow-entry database including a plurality of flow-entries for conversational flows encountered by the monitor" ("limitation (d) of claim 1"). The InfiniStream products do not meet limitation (d) of claim 1 at least because they do not have a database that includes any, much less a plurality of, flow-entries for "conversational flows," or that performs substantially the same function, in substantially the way, to obtain substantially the same result as storing flow-entries for "conversational flows."

29. In addition, the InfiniStream products do not meet the limitation recited in claim 1 of "(e) a lookup engine connected to the parser subsystem and to the flow-entry database, and configured to determine using at least some of the selected portions of the accepted packet if there is an entry in the flow-entry database for the conversational flow sequence of the accepted packet" ("limitation (e) of claim 1"). The InfiniStream products do not meet limitation (e) of claim 1 at least because they do not have a database that includes a flow-entry for a "conversational flow." In addition, the InfiniStream products never determine using portions of a packet whether there is such a flow-entry in a flow-entry database for the "conversational flow" sequence of the accepted packet, as is also required by limitation (e) of claim 1. The InfiniStream products also do not perform substantially the same function, in substantially the

way, to obtain substantially the same result as storing a flow-entry for a "conversational flow" or determining using portions of a packet whether there is a flow-entry in a flow-entry database for the "conversational flow" sequence of the accepted packet. Thus, the InfiniStream products do not meet limitation (e) of claim 1 under the doctrine of equivalents either.

30. The InfiniStream products do not infringe claim 1 under the doctrine of equivalents for the additional reason that an attempt to assert infringement under the doctrine of equivalents against the InfiniStream products would encompass or ensnare prior art. For example, the Dietz patents—all of which have substantially similar specifications—acknowledge that "[s]ome prior art packet monitors classify packets into connection flows," which is a term "commonly used to describe all the packets involved with a single connection." '789 patent at 2:42-45. If, hypothetically, claim 1 were re-written to literally cover functionality in the InfiniStream products that classifies packets into connection flows, this hypothetical version of claim 1 would be invalid as anticipated or obvious in view of the admitted prior art in the Dietz patents and many other prior art references more fully described below. Because this hypothetical version of claim 1 would ensnare the prior art, Defendants are legally precluded from asserting infringement based on a scope of equivalents that would encompass the InfiniStream products.

31. Further, Defendants are precluded from pursuing any claims of infringement as to the '099 patent based on the InfiniStream products because these products are covered by a license agreement that permits NetScout to use and distribute products that use the intellectual property described and claimed in the Dietz patents.

32. Further, Defendants are precluded from pursuing any claims of infringement as to the '099 patent for any acts relating to InfiniStream products occurring on or after the 12th

anniversary of this patent's grant, namely, November 18, 2015, because the '099 patent expired on this date due to Defendants' failure to pay appropriate maintenance fees to maintain the life of this patent.

33. Defendants are precluded from asserting a claim of infringement against the InfiniStream products because they are barred by the doctrines of claim and issue preclusion, collateral estoppel, and *res judicata* arising from the Texas Case. Specifically, a claim of infringement against the InfiniStream products was a compulsory claim in connection with Defendants' assertion of the Dietz patents against NetScout in the Texas Case. Defendants' belated attempt to assert these claims in the Texas Case was rejected as untimely due to Defendants' failure to diligently pursue the claims. Having failed to timely pursue claims of infringement against the InfiniStream products in the Texas Case, Defendants are now barred from doing so in any other case or matter.

34. Absent a declaration that the claims of the '099 patent are not infringed, Defendants will continue to wrongfully assert the '099 patent against NetScout, thereby causing NetScout irreparable harm and injury.

35. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and NetScout as to whether the claims of the '099 patent are infringed. A judicial declaration is necessary and appropriate so that NetScout may ascertain its rights regarding the '099 patent.

36. Based on the foregoing, NetScout hereby requests a declaration that the claims of the '099 patent are not infringed by the InfiniStream products.

COUNT TWO
DECLARATORY JUDGMENT OF INVALIDITY OF THE '099 PATENT

37. Paragraphs 1 through 36 are incorporated by reference as if fully stated herein.

38. The '099 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 *et seq.*, at least because it purports to claim ineligible subject matter pursuant to 35 U.S.C. § 101.

39. In addition, claim 1 is invalid as anticipated and/or rendered obvious by the Prior Art NetScout Probe, which was publicly available at least as early as October 1998. The Prior Art NetScout Probe is a packet monitor that can examine packets passing through a connection point on a computer network. The Prior Art NetScout Probe implemented the "track sessions" technique, which was openly discussed and standardized by the RMON Working Group in 1996 and described in the RMON TrackSession Publication (Ex. F). The "track sessions" technique tracked disjointed, but related, connection flows that resulted from an activity, such as a client requesting an application or service from a server. As such, the "track sessions" technique discloses the idea of recognizing disjointed flows as belonging to a "conversational flow," which is the Dietz patents' alleged point of novelty.

40. In addition, the claims of the '099 patent are invalid under pre-AIA 35 U.S.C. §§ 102 and/or 103 in view of the prior art cited in NetScout's Invalidity Contentions, NetScout's Notice of Reduction of Asserted Prior Art References, and the Invalidity and Unenforceability Expert Report of Steve Waldbusser served in the Texas Case. Such invalidating prior art includes at least the Prior Art NetScout Probe, and the NetScout 6010 probe with software version 4.0 in combination with the "track sessions" functionality discussed and standardized by the RMON Working Group in 1996 and disclosed in RMON publications, such as Remote Network Monitoring MIB Protocol Identifiers <draft-ietf-rmonmib-rmonprot-v2-00.txt> ("RMON TrackSession Publication"), published November 25, 1996. The claims of the '099 patent are also anticipated and/or rendered obvious by the prior art cited by Cisco and Huawei in

Invalidity Contentions served in previous actions brought by Packet Intelligence in the Eastern District of Texas, and the prior art cited on the face and in the specification of this patent and during the prosecution of this patent. The claims of the '099 patent are also rendered obvious by a prior art network monitor, such as the prior art NetScout 6010 probe, including versions 4.0 and 4.5, in view of the "track sessions" functionality as taught by the RMON TrackSession Publication and the teachings of Cooley *et al.*, Data Preparation for Mining World Wide Web Browsing Patterns, *Journal of Knowledge and Information Systems*, Vol. 1, Issue 1, pp. 5-32 (February 1999) ("Cooley") (attached hereto as Ex. G).

41. In addition, claim 1 is at least rendered obvious by prior art network monitors of the 1990s discussed in the background of the specification for the Dietz patents, in combination with the "track sessions" technique disclosed in RMON Working Group publications, such as the RMON TrackSession Publication. For example, the Dietz patents acknowledge that "[s]ome prior art packet monitors classify packets into connection flows." '789 patent at 2:42-45. It would have been obvious to a person of skill in the art at least by the '099 patent's priority date of June 30, 1999, to implement the "track sessions" functionality in a prior art network monitor capable of classifying packets into connection flows. A person of skill in the art would have been motivated to implement "track sessions" in a prior art network monitor to improve its performance and capabilities. For example, implementing "track sessions" in a network monitor would enable the network monitor to not only classify packets into connection flows, but also to recognize related connection flows resulting from a given activity. A person of skill in the art would have recognized that such a modification was possible and would have yielded predictable results, including those described in the RMON TrackSession Publication. For example, at least by October 1998, such an implementation had been perfected in the Prior Art NetScout Probe,

which implemented the "track sessions" technique described in the RMON TrackSession Publication. A person of skill in the art would have recognized that a prior art network monitor of the 1990s implementing the "track sessions" technique disclosed a network monitor capable of recognizing a "conversational flow." Thus, this combination discloses the only alleged point of novelty of claim 1 and renders this claim obvious.

42. In addition, claim 1 is rendered obvious by the admitted prior art in the Dietz patent, a prior art network monitor implementing the "track sessions" technique, such as the Prior Art NetScout Probe in further view of Cooley (Ex. G). Cooley discloses gathering and storing information about a user's web browsing session, such as the IP address of the computer or other device used by the user to access a website, the URLs of the websites visited, and the URLs of any websites that referred to another website. *See* Cooley at pp. 17-19. Cooley discloses collecting and storing this information in entries in a table, such as the table shown in Figure 6:

#	IP Address	Userid	Time	Method/ URL/ Protocol	Status	Size	Referred	Agent
1	123.456.78.9	-	[25/Apr/1998:03:04:41 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
2	123.456.78.9	-	[25/Apr/1998:03:05:34 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.04 (Win95, I)
3	123.456.78.9	-	[25/Apr/1998:03:05:39 -0500]	"GET L.html HTTP/1.0"	200	4130	-	Mozilla/3.04 (Win95, I)
4	123.456.78.9	-	[25/Apr/1998:03:06:02 -0500]	"GET F.html HTTP/1.0"	200	5096	B.html	Mozilla/3.04 (Win95, I)
5	123.456.78.9	-	[25/Apr/1998:03:06:58 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
6	123.456.78.9	-	[25/Apr/1998:03:07:42 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
7	123.456.78.9	-	[25/Apr/1998:03:07:55 -0500]	"GET R.html HTTP/1.0"	200	8140	L.html	Mozilla/3.04 (Win95, I)
8	123.456.78.9	-	[25/Apr/1998:03:09:50 -0500]	"GET C.html HTTP/1.0"	200	1820	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
9	123.456.78.9	-	[25/Apr/1998:03:10:02 -0500]	"GET O.html HTTP/1.0"	200	2270	F.html	Mozilla/3.04 (Win95, I)
10	123.456.78.9	-	[25/Apr/1998:03:10:45 -0500]	"GET J.html HTTP/1.0"	200	9430	C.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
11	123.456.78.9	-	[25/Apr/1998:03:12:23 -0500]	"GET G.html HTTP/1.0"	200	7220	B.html	Mozilla/3.04 (Win95, I)
12	123.456.78.9	-	[25/Apr/1998:05:05:22 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
13	123.456.78.9	-	[25/Apr/1998:05:06:03 -0500]	"GET D.html HTTP/1.0"	200	1680	A.html	Mozilla/3.04 (Win95, I)

Fig. 6. Sample Information from Access, Referrer, and Agent Logs (The first column is for referencing purposes and would not be part of an actual log).

Cooley at Fig. 6 (annotated with blue boxes). It would have been obvious to a person of skill in the art—at least by the '099 patent's priority date of June 30, 1999—that a prior art network monitor, including implementing "track sessions," could be utilized to monitor, collect, and store flow-entries in a database, such entries including data such as the client IP address, website URL, and referrer, for a user's web browsing that are described in Cooley. Cooley further asserts that this information could be collected using "a remote agent." Cooley at p. 8. A person of skill in the art would have recognized that the "remote agent" referenced in Cooley could be a prior art packet monitor, such as the Prior Art NetScout Probe and the packet monitors discussed in the background of the Dietz patents, and that such a packet monitor could easily be modified to monitor, collect, and store the pieces of information disclosed in Cooley. The Defendants cannot reasonably dispute that such a combination would invalidate the claims because Defendants argued in the Texas Case that gathering and storing the very same information that Cooley

gathers and stores in its table, namely, the client IP address, URL, and Referrer, fully meets the purportedly novel feature of the Dietz patent claims related to "conversational flows."

43. In addition, the '099 patent is invalid under 35 U.S.C. § 102(f) for failing to name one or more of the proper inventors of the '099 patent who contributed to the claimed invention, including one or more members of the RMON Working Group who contributed to the conception and/or reduction to practice of the claimed invention, including, but not limited to, such claimed features as recognizing "conversational flows." The '099 patent is also invalid under 35 U.S.C. § 102(f) because the named inventors derived the claimed invention from the members of the RMON Working Group, who previously conceived of the invention and communicated the idea of the invention to at least named inventors Russell Dietz and Andrew Koppenhaver—members of the RMON Working Group—as well as named inventor Joseph Maixner, who read RMON Working Group publications, including the RMON TrackSession Publication.

44. A judicial declaration that the '099 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that NetScout can ascertain its rights and duties with respect to the InfiniStream products, which Defendants accuse of infringing the '099 patent.

COUNT THREE
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '099 PATENT

45. Paragraphs 1 through 44 are incorporated by reference as if fully stated herein.

46. The '099 patent is unenforceable due to inequitable conduct perpetrated at the U.S. Patent and Trademark Office ("USPTO") during prosecution of the application which led to the '099 patent.

47. For example, the '099 patent's named inventors and/or the '099 patent's prosecuting patent agent Dov Rosenfeld intentionally withheld prior art information from the USPTO relating to the subject matter of the '099 patent that was material to patentability. Named inventors Russell Dietz and Andrew Koppenhaver were members of the RMON Working Group, attended group meetings, and read RMON Working Group publications, such as the RMON TrackSession Publication, prior to the alleged conception date of the invention disclosed in the '099 patent. Named inventor Joseph Maixner also regularly read RMON Working Group publications prior to the alleged conception date of the invention disclosed in the '099 patent.

48. The named inventors of the '099 patent and/or Dov Rosenfeld not only failed to submit material RMON publications to the USPTO but also intentionally misled the USPTO to believe the RMON publications were not relevant to the prosecution of the '099 patent. *See, e.g.*, '789 patent, 2:33-37 ("Though Netflow® (Cisco Systems, Inc., San Jose, Calif.), *RMON2*, and other network monitors are available for the real-time monitoring of networks, *they lack visibility into application content and are typically limited to providing network layer level information.*") (emphasis added).

49. In addition, by both knowing of the RMON Working Group's publications and failing to identify members of the RMON Working Group as named inventors, the named inventors of the '099 patent and/or Dov Rosenfeld deliberately misrepresented the true inventors' identities before the USPTO. This deliberate misrepresentation was done with an intent to mislead and deceive the USPTO about the identity of the true inventors of the claimed subject matter of the '099 patent.

50. A judicial declaration that the '099 patent is unenforceable due to inequitable conduct is necessary and appropriate at this time so that NetScout can ascertain its rights and

duties with respect to the InfiniStream products, which Defendants accuse of infringing the '099 patent.

COUNT FOUR
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '646 PATENT

51. Paragraphs 1 through 50 are incorporated by reference as if fully stated herein.

52. Packet Intelligence claims to own all rights, title, and interest in the '646 patent.

53. In seeking to amend its infringement contentions in the Texas Case to add the InfiniStream family of products, Defendants accused NetScout of infringing at least one claim of the '646 patent by making, using, selling, offering for sale, and/or causing others to make, use, sell, and/or offer for sale, the InfiniStream family of products.

54. Contrary to Defendants' assertions in the Texas Case, the InfiniStream products do not infringe any valid claim of the '646 patent. The InfiniStream products are the current version of the NetScout probe that NetScout has been selling for decades, dating back to well before the Dietz patents. In the Texas Case, NetScout identified the Prior Art NetScout Probe as anticipating the Dietz patents. Packet Intelligence contended at trial in the Texas Case that the Prior Art NetScout Probe was not covered by the claims of the Dietz patents. Many of the same features of the Prior Art NetScout Probe are still present in the InfiniStream products, NetScout's current version of this same platform. The arguments and contentions advanced by Packet Intelligence in the Texas Case purportedly to distinguish the Prior Art NetScout Probe also distinguish and demonstrate non-infringement of the InfiniStream products. Thus, Defendants are barred by judicial estoppel from asserting infringement based on a theory that directly conflicts with their arguments advanced in the Texas Case.

55. NetScout further does not infringe the '646 patent, among other reasons, because the InfiniStream products do not literally or under the doctrine of equivalents meet one or more

of the limitations of the claims of the '646 patent. For example, the InfiniStream products do not meet the limitation recited in claim 1 of "(b) a memory for storing a database comprising flow-entries for previously encountered conversational flows to which a received packet may belong, a conversational flow being an exchange of one or more packets in any direction as a result of an activity corresponding to the flow" or the limitation recited in claim 7 of "a memory to storing a database of one or more flow-entries for any previously encountered conversational flows, each flow-entry identified by identifying information stored in the flow-entry." The InfiniStream products do not meet these limitations of claims 1 and 7 at least because they do not have a database that includes any, much less a plurality of, flow-entries for "conversational flows," or that performs substantially the same function, in substantially the way, to obtain substantially the same result as storing flow-entries for "conversational flows."

56. In addition, the InfiniStream products do not meet the limitation recited in claim 1 of "(d) a lookup engine coupled to the packet acquisition device and to the cache subsystem and configured to lookup whether a received packet belongs to a flow-entry in the flow-entry database, to looking up being the cache subsystem" or the limitation recited in claim 7 of "a lookup engine coupled to the output of the parser subsystem and to the flow-entry memory and configured to lookup whether the particular packet whose parser record is output by the parser subsystem has a matching flow-entry, the looking up using at least some of the selected packet portions and determining if the packet is of an existing flow." The InfiniStream products do not meet these limitations at least because they do not have a database that includes a flow-entry for a "conversational flow." In addition, the InfiniStream products never determine whether a received packet belongs to a flow-entry for a "conversational flow" or whether a packet has a matching flow-entry for a "conversational flow." The InfiniStream products also do not perform

substantially the same function, in substantially the way, to obtain substantially the same result as storing a flow-entry for a "conversational flow" or determining whether a received packet belongs to a flow-entry for a "conversational flow" flow-entry or whether a packet has a matching flow-entry for a "conversational flow." Thus, the InfiniStream products do not meet these limitations of claims 1 and 7 under the doctrine of equivalents either.

57. The InfiniStream products do not infringe claims 1 and 7 under the doctrine of equivalents for the additional reason that an attempt to assert infringement under the doctrine of equivalents against the InfiniStream products would encompass or ensnare prior art. For example, the Dietz patents—all of which have substantially similar specifications—acknowledge that "[s]ome prior art packet monitors classify packets into connection flows," which is a term "commonly used to describe all the packets involved with a single connection." '789 patent at 2:42-45. If, hypothetically, claims 1 and 7 were re-written to literally cover functionality in the InfiniStream products that classifies packets into connection flows, these hypothetical versions of claims 1 and 7 would be invalid as anticipated or obvious in view of the admitted prior art in the Dietz patents and many other prior art references more fully described below. Because these hypothetical versions of claims 1 and 7 would ensnare the prior art, Defendants are legally precluded from asserting infringement based on a scope of equivalents that would encompass the InfiniStream products.

58. Further, Defendants are precluded from pursuing any claims of infringement as to the '646 patent based on the InfiniStream products because these products are covered by a license agreement that permits NetScout to use and distribute products that use the intellectual property described and claimed in the Dietz patents.

59. Further, Defendants are precluded from pursuing any claims of infringement as to the '646 patent for any acts relating to InfiniStream products occurring on or after the 12th anniversary of this patent's grant, namely, August 3, 2016, because the '646 patent expired on this date due to Defendants' failure to pay appropriate maintenance fees to maintain the life of this patent.

60. Defendants are precluded from asserting a claim of infringement against the InfiniStream products because they are barred by the doctrines of claim and issue preclusion, collateral estoppel, and *res judicata* arising from the Texas Case. Specifically, a claim of infringement against the InfiniStream products was a compulsory claim in connection with Defendants' assertion of the Dietz patents against NetScout in the Texas Case. Defendants' belated attempt to assert these claims in the Texas Case was rejected as untimely due to Defendants' failure to diligently pursue the claims. Having failed to timely pursue claims of infringement against the InfiniStream products in the Texas Case, Defendants are now barred from doing so in any other case or matter.

61. Absent a declaration that the claims of the '646 patent are not infringed, Defendants will continue to wrongfully assert the '646 patent against NetScout, thereby causing NetScout irreparable harm and injury.

62. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and NetScout as to whether the claims of the '646 patent are infringed. A judicial declaration is necessary and appropriate so that NetScout may ascertain its rights regarding the '646 patent.

63. Based on the foregoing, NetScout hereby requests a declaration that the claims of the '646 patent are not infringed by the InfiniStream products.

COUNT FIVE
DECLARATORY JUDGMENT OF INVALIDITY OF THE '646 PATENT

64. Paragraphs 1 through 63 are incorporated by reference as if fully stated herein.

65. The '646 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 *et seq.*, at least because it purports to claim ineligible subject matter pursuant to 35 U.S.C. § 101.

66. In addition, the claims of the '646 patent are invalid under pre-AIA 35 U.S.C. §§ 102 and/or 103 in view of the prior art cited in NetScout's Invalidity Contentions, NetScout's Notice of Reduction of Asserted Prior Art References, and the Invalidity and Unenforceability Expert Report of Steve Waldbusser served in the Texas Case. Such invalidating prior art includes at least the Prior Art NetScout Probe, and the NetScout 6010 probe with software version 4.0 in combination with the "track sessions" functionality discussed and standardized by the RMON Working Group in 1996 and disclosed in RMON publications, such as the RMON TrackSession Publication, published November 25, 1996. The claims of the '646 patent are also anticipated and/or rendered obvious by the prior art cited by Cisco and Huawei in Invalidity Contentions served in previous actions brought by Packet Intelligence in the Eastern District of Texas, and the prior art cited on the face and in the specification of this patent and during the prosecution of this patent. The claims of the '646 patent are also rendered obvious by a prior art network monitor, such as the prior art NetScout 6010 probe, including versions 4.0 and 4.5, in view of the "track sessions" functionality as taught by the RMON TrackSession Publication and the teachings of Cooley.

67. In addition, claims 1 and 7 are invalid as anticipated and/or rendered obvious by the Prior Art NetScout Probe which was publicly available at least as early as October 1998. The Prior Art NetScout Probe is a packet monitor that can examine packets passing through a

connection point on a computer network. The Prior Art NetScout Probe implemented the "track sessions" technique, which was openly discussed and standardized by the RMON Working Group in 1996 and described in the RMON TrackSession Publication (Ex. F). The "track sessions" technique tracked disjointed, but related, connection flows that resulted from an activity, such as a client requesting an application or service from a server. As such, the "track sessions" technique discloses the idea of recognizing disjointed flows as belonging to a "conversational flow," which is the Dietz patents' alleged point of novelty.

68. In addition, claims 1 and 7 are at least rendered obvious by prior art network monitors of the 1990s discussed in the background of the specification for the Dietz patents, in combination with the "track sessions" technique disclosed in RMON Working Group publications, such as the RMON TrackSession Publication. For example, the Dietz patents acknowledge that "[s]ome prior art packet monitors classify packets into connection flows." '789 patent at 2:42-45. It would have been obvious to a person of skill in the art at least by the '646 patent's priority date of June 30, 1999, to implement the "track sessions" functionality in a prior art network monitor capable of classifying packets into connection flows. A person of skill in the art would have been motivated to implement "track sessions" in a prior art network monitor to improve its performance and capabilities. For example, implementing "track sessions" in a network monitor would enable the network monitor to not only classify packets into connection flows, but also to recognize related connection flows resulting from a given activity. A person of skill in the art would have recognized that such a modification was possible and would have yielded predictable results, including those described in the RMON TrackSession Publication. For example, at least by October 1998, such an implementation had been perfected in the Prior Art NetScout Probe, which implemented the "track sessions"

technique described in the RMON TrackSession Publication. A person of skill in the art would have recognized that a prior art network monitor of the 1990s implementing the "track sessions" technique disclosed a network monitor capable of recognizing a "conversational flow." Thus, this combination discloses the only alleged point of novelty of these claims and renders these claims obvious.

69. In addition, claims 1 and 7 are rendered obvious by the admitted prior art in the Dietz patent, a prior art network monitor implementing the "track sessions" technique, such as the Prior Art NetScout Probe, in further view of Cooley (Ex. G). Cooley discloses gathering and storing information about a user's web browsing session, such as the IP address of the computer or other device used by the user to access a website, the URLs of the websites visited, and the URLs of any websites that referred to another website. *See* Cooley at pp. 17-19. Cooley discloses collecting and storing this information in entries in a table, such as the table shown in Figure 6:

#	IP Address	Userid	Time	Method/ URL/ Protocol	Status	Size	Referred	Agent
1	123.456.78.9	-	[25/Apr/1998:03:04:41 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
2	123.456.78.9	-	[25/Apr/1998:03:05:34 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.04 (Win95, I)
3	123.456.78.9	-	[25/Apr/1998:03:05:39 -0500]	"GET L.html HTTP/1.0"	200	4130	-	Mozilla/3.04 (Win95, I)
4	123.456.78.9	-	[25/Apr/1998:03:06:02 -0500]	"GET F.html HTTP/1.0"	200	5096	B.html	Mozilla/3.04 (Win95, I)
5	123.456.78.9	-	[25/Apr/1998:03:06:58 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
6	123.456.78.9	-	[25/Apr/1998:03:07:42 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
7	123.456.78.9	-	[25/Apr/1998:03:07:55 -0500]	"GET R.html HTTP/1.0"	200	8140	L.html	Mozilla/3.04 (Win95, I)
8	123.456.78.9	-	[25/Apr/1998:03:09:50 -0500]	"GET C.html HTTP/1.0"	200	1820	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
9	123.456.78.9	-	[25/Apr/1998:03:10:02 -0500]	"GET O.html HTTP/1.0"	200	2270	F.html	Mozilla/3.04 (Win95, I)
10	123.456.78.9	-	[25/Apr/1998:03:10:45 -0500]	"GET J.html HTTP/1.0"	200	9430	C.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
11	123.456.78.9	-	[25/Apr/1998:03:12:23 -0500]	"GET G.html HTTP/1.0"	200	7220	B.html	Mozilla/3.04 (Win95, I)
12	123.456.78.9	-	[25/Apr/1998:05:05:22 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
13	123.456.78.9	-	[25/Apr/1998:05:06:03 -0500]	"GET D.html HTTP/1.0"	200	1680	A.html	Mozilla/3.04 (Win95, I)

Fig. 6. Sample Information from Access, Referrer, and Agent Logs (The first column is for referencing purposes and would not be part of an actual log).

Cooley at Fig. 6 (annotated with blue boxes). It would have been obvious to a person of skill in the art—at least by the '646 patent's priority date of June 30, 1999—that a prior art network monitor, including implementing "track sessions," could be utilized to monitor, collect, and store flow-entries in a database, such entries including data such as the client IP address, website URL, and referrer, for a user's web browsing that are described in Cooley. Cooley further asserts that this information could be collected using "a remote agent." Cooley at p. 8. A person of skill in the art would have recognized that the "remote agent" referenced in Cooley could be a prior art packet monitor, such as the prior art NetScout 6010 probe and the packet monitors discussed in the background of the Dietz patents, and that such a packet monitor could easily be modified to monitor, collect, and store the pieces of information disclosed in Cooley. The Defendants cannot reasonably dispute that such a combination would invalidate the claims because Defendants argued in the Texas Case that gathering and storing the very same information that Cooley

gathers and stores in its table, namely, the client IP address, URL, and Referrer, fully meets the purportedly novel feature of the Dietz patent claims related to "conversational flows."

70. In addition, the '646 patent is invalid under 35 U.S.C. § 102(f) for failing to name one or more of the proper inventors of the '646 patent who contributed to the claimed invention, including one or more members of the RMON Working Group who contributed to the conception and/or reduction to practice of the claimed invention, including, but not limited to, such claimed features as recognizing "conversational flows." The '646 patent is also invalid under 35 U.S.C. § 102(f) because the named inventors derived the claimed invention from the members of the RMON Working Group, who previously conceived of the invention and communicated the idea of the invention to at least named inventor Russell Dietz—a member of the RMON Working Group.

71. A judicial declaration that the '646 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that NetScout can ascertain its rights and duties with respect to the InfiniStream products, which Defendants accuse of infringing the '646 patent.

COUNT SIX
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '646 PATENT

72. Paragraphs 1 through 71 are incorporated by reference as if fully stated herein.

73. The '646 patent is unenforceable due to inequitable conduct perpetrated at the USPTO during prosecution of the application which led to the '646 patent.

74. For example, the '646 patent's named inventors and/or the '646 patent's prosecuting patent agent Dov Rosenfeld intentionally withheld prior art information from the USPTO relating to the subject matter of the '646 patent that was material to patentability. Named inventor Russell Dietz was a member of the RMON Working Group, attended group

meetings, and read RMON Working Group publications, such as the RMON TrackSession Publication, prior to the alleged conception date of the invention disclosed in the '646 patent.

75. The named inventors of the '646 patent and/or Dov Rosenfeld not only failed to submit material RMON publications to the USPTO but also intentionally misled the USPTO to believe the RMON publications were not relevant to the prosecution of the '646 patent. *See, e.g.*, '789 patent at 2:33-37 ("Though Netflow® (Cisco Systems, Inc., San Jose, Calif.), *RMON2*, and other network monitors are available for the real-time monitoring of networks, *they lack visibility into application content and are typically limited to providing network layer level information.*") (emphasis added).

76. In addition, by both knowing of the RMON Working Group's publications and failing to identify members of the RMON Working Group as named inventors, the named inventors of the '646 patent and/or Dov Rosenfeld deliberately misrepresented the true inventors' identities before the USPTO. This deliberate misrepresentation was done with an intent to mislead and deceive the USPTO about the identity of the true inventors of the claimed subject matter of the '646 patent.

77. A judicial declaration that the '646 patent is unenforceable due to inequitable conduct is necessary and appropriate at this time so that NetScout can ascertain its rights and duties with respect to the InfiniStream products, which Defendants accuse of infringing the '646 patent.

COUNT SEVEN
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '789 PATENT

78. Paragraphs 1 through 77 are incorporated by reference as if fully stated herein.

79. Packet Intelligence claims to own all rights, title, and interest in the '789 patent.

80. In seeking to amend its infringement contentions in the Texas Case to add the InfiniStream family of products, Defendants accused NetScout of infringing at least one claim of the '789 patent by making, using, selling, offering for sale, and/or causing others to make, use, sell, and/or offer for sale, the InfiniStream family of products.

81. Contrary to Defendants' assertions in the Texas Case, the InfiniStream products do not infringe any valid claim of the '789 patent. The InfiniStream products are the current version of the NetScout probe that NetScout has been selling for decades, dating back to well before the Dietz patents. In the Texas Case, NetScout identified the Prior Art NetScout Probe as anticipating the Dietz patents. Packet Intelligence contended at trial in the Texas Case that the Prior Art NetScout Probe was not covered by the claims of the Dietz patents. Many of the same features of the Prior Art NetScout Probe are still present in the InfiniStream products, NetScout's current version of this same platform. The arguments and contentions advanced by Packet Intelligence in the Texas Case purportedly to distinguish the Prior Art NetScout Probe also distinguish and demonstrate non-infringement of the InfiniStream products. Thus, Defendants are barred by judicial estoppel from asserting infringement based on a theory that directly conflicts with their arguments advanced in the Texas Case.

82. NetScout further does not infringe the '789 patent, among other reasons, because the InfiniStream products do not literally or under the doctrine of equivalents meet one or more of the limitations of the claims of the '789 patent. For example, the InfiniStream products do not meet the limitation recited in claim 1 of "(c) looking up a flow-entry database comprising none or more flow-entries for previously encountered conversational flows, the looking up using at least some of the selected packet portions and determining if the packet is of an existing flow"; the limitation recited in claim 19 of "(d) a memory for storing a database comprising none or

more flow-entries for previously encountered conversational flows, each flow-entry identified by identifying information stored in the flow-entry"; or the limitation recited in claim 44 of "(c) looking up a flow-entry database comprising none or more flow-entries for previously encountered conversational flows, the looking up using at least some of the selected packet portions, and determining if the packet is of an existing flow." The InfiniStream products do not meet these limitations of claims 1, 19, and 44 at least because they do not have a database that includes any, much less a plurality of, flow-entries for "conversational flows," or that performs substantially the same function, in substantially the way, to obtain substantially the same result as a database comprising flow-entries for "conversational flows."

83. In addition, the InfiniStream products do not meet the limitation recited in claim 1 of "looking up using at least some of the selected packet portions and determining if the packet is of an existing flow; (d) if the packet is of an existing flow, classifying the packet as belonging to the found existing flow"; the limitation recited in claim 19 of "the lookup engine . . . configured to lookup … the looking up using at least some of the selected packet portions and determining if the packet is of an existing flow; . . . the lookup engine configured such that if the packet is of an existing flow, the monitor classifies the packet as belonging to the found existing flow"; and the limitation recited in claim 44 of "the looking up using at least some of the selected packet portions, and determining if the packet is of an existing flow; (d) if the packet is of an existing flow, obtaining the last encountered state of the flow and performing any state operations specified for the state of the flow starting from the last encountered state of the flow." The InfiniStream products do not meet these limitations at least because they do not have a database that includes a flow-entry for a "conversational flow." In addition, the InfiniStream products never determine whether a received packet belongs to an existing "conversational flow" in a

flow-entry or classifies the packet as belonging to an existing "conversational flow" in a flow-entry. The InfiniStream products also do not perform substantially the same function, in substantially the way, to obtain substantially the same result as storing a flow-entry for a "conversational flow" or determining whether a received packet belongs to an existing "conversational flow" in a flow-entry. Thus, the InfiniStream products do not meet these limitations of claims 1, 19, and 44 under the doctrine of equivalents either.

84. The InfiniStream products do not infringe claims 1, 19, and 44 under the doctrine of equivalents for the additional reason that an attempt to assert infringement under the doctrine of equivalents against the InfiniStream products would encompass or ensnare prior art. For example, the Dietz patents—all of which have substantially similar specifications—acknowledge that "[s]ome prior art packet monitors classify packets into connection flows," which is a term "commonly used to describe all the packets involved with a single connection." '789 patent at 2:42-45. If, hypothetically, claims 1, 19, and 44 were re-written to literally cover functionality in the InfiniStream products that classifies packets into connection flows, these hypothetical versions of claims 1, 19, and 44 would be invalid as anticipated or obvious in view of the admitted prior art in the Dietz patents and many other prior art references more fully described below. Because these hypothetical versions of claims 1, 19, and 44 would ensnare the prior art, Defendants are legally precluded from asserting infringement based on a scope of equivalents that would encompass the InfiniStream products.

85. Further, Defendants are precluded from pursuing any claims of infringement as to the '789 patent based on the InfiniStream products because these products are covered by a license agreement that permits NetScout to use and distribute products that use the intellectual property described and claimed in the Dietz patents.

86. Further, Defendants are precluded from pursuing any claims of infringement as to the '789 patent for any acts relating to InfiniStream products occurring on or after the 12th anniversary of this patent's grant, namely, October 11, 2017, because the '789 patent expired on this date due to Defendants' failure to pay appropriate maintenance fees to maintain the life of this patent.

87. Defendants are precluded from asserting a claim of infringement against the InfiniStream products because they are barred by the doctrines of claim and issue preclusion, collateral estoppel, and *res judicata* arising from the Texas Case. Specifically, a claim of infringement against the InfiniStream products was a compulsory claim in connection with Defendants' assertion of the Dietz patents against NetScout in the Texas Case. Defendants' belated attempt to assert these claims in the Texas Case were rejected as untimely due to Defendants' failure to diligently pursue the claims. Having failed to timely pursue claims of infringement against the InfiniStream products in the Texas Case, Defendants are now barred from doing so in any other case or matter.

88. Absent a declaration that the claims of the '789 patent are not infringed, Defendants will continue to wrongfully assert the '789 patent against NetScout, thereby causing NetScout irreparable harm and injury.

89. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and NetScout as to whether the claims of the '789 patent are infringed. A judicial declaration is necessary and appropriate so that NetScout may ascertain its rights regarding the '789 patent.

90. Based on the foregoing, NetScout hereby requests a declaration that the claims of the '789 patent are not infringed by the InfiniStream products.

COUNT EIGHT
DECLARATORY JUDGMENT OF INVALIDITY OF THE '789 PATENT

91. Paragraphs 1 through 87 are incorporated by reference as if fully stated herein.

92. The '789 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 *et seq.*, at least because it purports to claim ineligible subject matter pursuant to 35 U.S.C. § 101.

93. In addition, the claims of the '789 patent are invalid under pre-AIA 35 U.S.C. §§ 102 and/or 103 in view of the prior art cited in NetScout's Invalidity Contentions, NetScout's Notice of Reduction of Asserted Prior Art References, and the Invalidity and Unenforceability Expert Report of Steve Waldbusser served in the Texas Case. Such invalidating prior art includes at least the Prior Art NetScout Probe, and the NetScout 6010 probe with software version 4.0 in combination with the "track sessions" functionality discussed and standardized by the RMON Working Group in 1996 and disclosed in RMON publications, such as the RMON TrackSession Publication, published November 25, 1996. The claims of the '789 patent are also anticipated and/or rendered obvious by the prior art cited by Cisco and Huawei in Invalidity Contentions served in previous actions brought by Packet Intelligence in the Eastern District of Texas, and the prior art cited on the face and in the specification of this patent and during the prosecution of this patent. The claims of the '789 patent are also rendered obvious by a prior art network monitor, such as the prior art NetScout 6010 probe, including versions 4.0 and 4.5, in view of the "track sessions" functionality as taught by the RMON TrackSession Publication and the teachings of Cooley.

94. In addition, claims 1, 19, and 44 are invalid as anticipated and/or rendered obvious by the Prior Art NetScout Probe which was publicly available at least as early as October 1998. The Prior Art NetScout Probe is a packet monitor that can examine packets

passing through a connection point on a computer network. The Prior Art NetScout Probe implemented the "track sessions" technique, which was openly discussed and standardized by the RMON Working Group in 1996 and described in the RMON TrackSession Publication (Ex. F). The "track sessions" technique tracked disjointed, but related, connection flows that resulted from an activity, such as a client requesting an application or service from a server. As such, the "track sessions" technique discloses the idea of recognizing disjointed flows as belonging to a "conversational flow," which is the Dietz patents' alleged point of novelty.

95. In addition, claims 1, 19, and 44 are at least rendered obvious by prior art network monitors of the 1990s discussed in the background of the specification for the Dietz patents, in combination with the "track sessions" technique disclosed in RMON Working Group publications, such as the RMON TrackSession Publication. For example, the Dietz patents acknowledge that "[s]ome prior art packet monitors classify packets into connection flows." '789 patent at 2:42-45. It would have been obvious to a person of skill in the art at least by the '789 patent's priority date of June 30, 1999, to implement the "track sessions" functionality in a prior art network monitor capable of classifying packets into connection flows. A person of skill in the art would have been motivated to implement "track sessions" in a prior art network monitor to improve its performance and capabilities. For example, implementing "track sessions" in a network monitor would enable the network monitor to not only classify packets into connection flows, but also to recognize related connection flows resulting from a given activity. A person of skill in the art would have recognized that such a modification was possible and would have yielded predictable results, including those described in the RMON TrackSession Publication. For example, at least by October 1998, such an implementation had been perfected in the Prior Art NetScout Probe, which implemented the "track sessions"

technique described in the RMON TrackSession Publication. A person of skill in the art would have recognized that a prior art network monitor of the 1990s implementing the "track sessions" technique disclosed a network monitor capable of recognizing a "conversational flow." Thus, this combination discloses the only alleged point of novelty of these claims and renders these claims obvious.

96. In addition, claims 1, 19, and 44 are rendered obvious by the admitted prior art in the Dietz patent, a prior art network monitor implementing the "track sessions" technique, such as the Prior Art NetScout Probe, in further view of Cooley (Ex. G). Cooley discloses gathering and storing information about a user's web browsing session, such as the IP address of the computer or other device used by the user to access a website, the URLs of the websites visited, and the URLs of any websites that referred to another website. *See* Cooley at pp. 17-19. Cooley discloses collecting and storing this information in entries in a table, such as the table shown in Figure 6:

#	IP Address	Userid	Time	Method/ URL/ Protocol	Status	Size	Referred	Agent
1	123.456.78.9	-	[25/Apr/1998:03:04:41 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
2	123.456.78.9	-	[25/Apr/1998:03:05:34 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.04 (Win95, I)
3	123.456.78.9	-	[25/Apr/1998:03:05:39 -0500]	"GET L.html HTTP/1.0"	200	4130	-	Mozilla/3.04 (Win95, I)
4	123.456.78.9	-	[25/Apr/1998:03:06:02 -0500]	"GET F.html HTTP/1.0"	200	5096	B.html	Mozilla/3.04 (Win95, I)
5	123.456.78.9	-	[25/Apr/1998:03:06:58 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
6	123.456.78.9	-	[25/Apr/1998:03:07:42 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
7	123.456.78.9	-	[25/Apr/1998:03:07:55 -0500]	"GET R.html HTTP/1.0"	200	8140	L.html	Mozilla/3.04 (Win95, I)
8	123.456.78.9	-	[25/Apr/1998:03:09:50 -0500]	"GET C.html HTTP/1.0"	200	1820	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
9	123.456.78.9	-	[25/Apr/1998:03:10:02 -0500]	"GET O.html HTTP/1.0"	200	2270	F.html	Mozilla/3.04 (Win95, I)
10	123.456.78.9	-	[25/Apr/1998:03:10:45 -0500]	"GET J.html HTTP/1.0"	200	9430	C.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
11	123.456.78.9	-	[25/Apr/1998:03:12:23 -0500]	"GET G.html HTTP/1.0"	200	7220	B.html	Mozilla/3.04 (Win95, I)
12	123.456.78.9	-	[25/Apr/1998:05:05:22 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
13	123.456.78.9	-	[25/Apr/1998:05:06:03 -0500]	"GET D.html HTTP/1.0"	200	1680	A.html	Mozilla/3.04 (Win95, I)

Fig. 6. Sample Information from Access, Referrer, and Agent Logs (The first column is for referencing purposes and would not be part of an actual log).

Cooley at Fig. 6 (annotated with blue boxes). It would have been obvious to a person of skill in the art—that a prior art network monitor, including implementing "track sessions," could be utilized to monitor, collect, and store flow-entries in a database, such entries including data such as the client IP address, website URL, and referrer, for a user's web browsing that are described in Cooley. Cooley further asserts that this information could be collecting using "a remote agent." Cooley at p. 8. A person of skill in the art would have recognized that the "remote agent" referenced in Cooley could be a prior art packet monitor, such as the prior art NetScout 6010 probe and the packet monitors discussed in the background of the Dietz patents, and that such a packet monitor could easily be modified to monitor, collect, and store the pieces of information disclosed in Cooley. The Defendants cannot reasonably dispute that such a combination would invalidate the claims because Defendants argued in the Texas Case that gathering and storing the very same information that Cooley gathers and stores in its table,

namely, the client IP address, URL, and Referrer, fully meets the purportedly novel feature of the Dietz patent claim related to "conversational flows."

97. In addition, the '789 patent is invalid under 35 U.S.C. § 102(f) for failing to name one or more of the proper inventors of the '789 patent who contributed to the claimed invention, including one or more members of the RMON Working Group who contributed to the conception and/or reduction to practice of the claimed invention, including, but not limited to, such claimed features as recognizing "conversational flows." The '789 patent is also invalid under 35 U.S.C. § 102(f) because the named inventors derived the claimed invention from the members of the RMON Working Group, who previously conceived of the invention and communicated the idea of the invention to at least named inventors Russell Dietz and Andrew Koppenhaver—members of the RMON Working Group—as well as named inventor Joseph Maixner, who read RMON Working Group publications, including the RMON TrackSession Publication.

98. A judicial declaration that the '789 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that NetScout can ascertain its rights and duties with respect to the InfiniStream products, which Defendants accuse of infringing the '789 patent.

COUNT NINE
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '789 PATENT

99. Paragraphs 1 through 98 are incorporated by reference as if fully stated herein.

100. The '789 patent is unenforceable due to inequitable conduct perpetrated at the USPTO during prosecution of the application which led to the '789 patent.

101. For example, the '789 patent's named inventors and/or the '789 patent's prosecuting patent agent Dov Rosenfeld intentionally withheld prior art information from the

USPTO relating to the subject matter of the '789 patent that was material to patentability. Named inventors Russell Dietz and Andrew Koppenhaver were members of the RMON Working Group, attended group meetings, and read RMON Working Group publications, such as the RMON TrackSession Publication, prior to the alleged conception date of the invention disclosed in the '789 patent. Named inventor Joseph Maixner also regularly read RMON Working Group publications prior to the alleged conception date of the invention disclosed in the '789 patent.

102. The named inventors of the '789 patent and/or Dov Rosenfeld not only failed to submit material RMON publications to the USPTO but also intentionally misled the USPTO to believe the RMON publications were not relevant to the prosecution of the '789 patent. *See, e.g.*, '789 patent, 2:33-37 ("Though Netflow® (Cisco Systems, Inc., San Jose, Calif.), *RMON2*, and other network monitors are available for the real-time monitoring of networks, *they lack visibility into application content and are typically limited to providing network layer level information.*") (emphasis added).

103. In addition, by both knowing of the RMON Working Group's publications and failing to identify members of the RMON Working Group as named inventors, the named inventors of the '789 patent and/or Dov Rosenfeld deliberately misrepresented the true inventors' identities before the USPTO. This deliberate misrepresentation was done with an intent to mislead and deceive the USPTO about the identity of the true inventors of the claimed subject matter of the '789 patent.

104. A judicial declaration that the '789 patent is unenforceable due to inequitable conduct is necessary and appropriate at this time so that NetScout can ascertain its rights and duties with respect to the InfiniStream products, which Defendants accuse of infringing the '789 patent.

COUNT TEN
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '751 PATENT

105. Paragraphs 1 through 104 are incorporated by reference as if fully stated herein.

106. Packet Intelligence claims to own all rights, title, and interest in the '751 patent.

107. In seeking to amend its infringement contentions in the Texas Case to add the InfiniStream family of products, Defendants accused NetScout of infringing at least one claim of the '751 patent by making, using, selling, offering for sale, and/or causing others to make, use, sell, and/or offer for sale, the InfiniStream family of products.

108. Contrary to Defendants' assertions in the Texas Case, the InfiniStream products do not infringe any valid claim of the '751 patent. The InfiniStream products are the current version of the NetScout probe that NetScout has been selling for decades, dating back to well before the Dietz patents. In the Texas Case, NetScout identified the Prior Art NetScout Probe as anticipating the Dietz patents. Packet Intelligence contended at trial in the Texas Case that the Prior Art NetScout Probe was not covered by the claims of the Dietz patents. Many of the same features of the Prior Art NetScout Probe are still present in the InfiniStream products, NetScout's current version of this same platform. The arguments and contentions advanced by Packet Intelligence in the Texas Case purportedly to distinguish the Prior Art NetScout Probe also distinguish and demonstrate non-infringement of the InfiniStream products. Thus, Defendants are barred by judicial estoppel from asserting infringement based on a theory that directly conflicts with their arguments advanced in the Texas Case.

109. NetScout further does not infringe the '751 patent, among other reasons, because the InfiniStream products do not literally or under the doctrine of equivalents meet one or more of the limitations of the claims of the '751 patent. For example, the InfiniStream products do not meet the limitation recited in claim 1 of "(b) for each received packet, looking up a flow-entry

database for containing one or more flow-entries for previously encountered conversational flows, the looking up to determine if the received packet is of an existing flow" or the limitation recited in claim 17 of "(b) a memory for storing a database for containing one or more flow-entries for previously encountered conversational flows to which a received packet may belong." The InfiniStream products do not meet these limitations of claims 1 and 17 at least because they do not have a database that contains any, much less a plurality of, flow-entries for "conversational flows," or that performs substantially the same function, in substantially the way, to obtain substantially the same result as a database containing flow-entries for "conversational flows."

110. In addition, the InfiniStream products do not meet the limitation recited in claim 1 of "looking up to determine if the received packet is of an existing flow . . . (c) if the packet is of an existing flow, identifying the last encountered state of the flow, performing any state operations specified for the state of the flow, and updating the flow-entry of the existing flow including storing one or more statistical measures kept in the flow-entry" or the limitation recited in claim 17 of "(c) an analyzer subsystem coupled to the packet acquisition device configured to lookup for each received packet whether a received packet belongs to a flow-entry in the flow-entry database, to update the flow-entry of the existing flow including storing one or more statistical measures kept in the flow-entry in the case that the packet is of an existing flow." The InfiniStream products do not meet these limitations at least because they do not have a database that includes a flow-entry for a "conversational flow." In addition, the InfiniStream products never determine whether a received packet belongs to a flow-entry for a "conversational flow" and then update the flow-entry for that "conversational flow." The InfiniStream products also do not perform substantially the same function, in substantially the way, to obtain substantially the

same result as storing a flow-entry for a "conversational flow" or determining whether a received packet belongs to a flow-entry for a "conversational flow" and then updating that flow-entry. Thus, the InfiniStream products do not meet these limitations of claims 1 and 17 under the doctrine of equivalents either.

111. The InfiniStream products do not infringe claims 1 and 17 under the doctrine of equivalents for the additional reason that an attempt to assert infringement under the doctrine of equivalents against the InfiniStream products would encompass or ensnare prior art. For example, the Dietz patents—all of which have substantially similar specifications—acknowledge that "[s]ome prior art packet monitors classify packets into connection flows," which is a term "commonly used to describe all the packets involved with a single connection." '789 patent at 2:42-45. If, hypothetically, claims 1 and 17 were re-written to literally cover functionality in the InfiniStream products that classifies packets into connection flows, these hypothetical versions of claims 1 and 17 would be invalid as anticipated or obvious in view of the admitted prior art in the Dietz patents and many other prior art references more fully described below. Because these hypothetical versions of claims 1 and 17 would ensnare the prior art, Defendants are legally precluded from asserting infringement based on a scope of equivalents that would encompass the InfiniStream products.

112. Further, Defendants are precluded from pursuing any claims of infringement as to the '751 patent based on the InfiniStream products because these products are covered by a license agreement that permits NetScout to use and distribute products that use the intellectual property described and claimed in the Dietz patents.

113. Further, Defendants are precluded from pursuing any claims of infringement as to the '751 patent for any acts relating to InfiniStream products occurring on or after the 12th

anniversary of this patent's grant, namely, January 4, 2017, because the '751 patent expired on this date due to Defendants' failure to pay appropriate maintenance fees to maintain the life of this patent.

114. Defendants are precluded from asserting a claim of infringement against the InfiniStream products because they are barred by the doctrines of claim and issue preclusion, collateral estoppel, and *res judicata* arising from the Texas Case. Specifically, a claim of infringement against the InfiniStream products was a compulsory claim in connection with Defendants' assertion of the Dietz patents against NetScout in the Texas Case. Defendants' belated attempt to assert these claims in the Texas Case was rejected as untimely due to Defendants' failure to diligently pursue the claims. Having failed to timely pursue claims of infringement against the InfiniStream products in the Texas Case, Defendants are now barred from doing so in any other case or matter.

115. Absent a declaration that the claims of the '751 patent are not infringed, Defendants will continue to wrongfully assert the '751 patent against NetScout, thereby causing NetScout irreparable harm and injury.

116. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and NetScout as to whether the claims of the '751 patent are infringed. A judicial declaration is necessary and appropriate so that NetScout may ascertain its rights regarding the '751 patent.

117. Based on the foregoing, NetScout hereby requests a declaration that the claims of the '751 patent are not infringed by the InfiniStream products.

COUNT ELEVEN
DECLARATORY JUDGMENT OF INVALIDITY OF THE '751 PATENT

118. Paragraphs 1 through 117 are incorporated by reference as if fully stated herein.

119. The '751 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 *et seq.*, at least because it purports to claim ineligible subject matter pursuant to 35 U.S.C. § 101.

120. In addition, the claims of the '751 patent are invalid under pre-AIA 35 U.S.C. §§ 102 and/or 103 in view of the prior art cited in NetScout's Invalidity Contentions, NetScout's Notice of Reduction of Asserted Prior Art References, and the Invalidity and Unenforceability Expert Report of Steve Waldbusser served in the Texas Case. Such invalidating prior art includes at least the Prior Art NetScout Probe, and the NetScout 6010 probe with software version 4.0 in combination with the "track sessions" functionality discussed and standardized by the RMON Working Group in 1996 and disclosed in RMON publications, such as the RMON TrackSession Publication, published November 25, 1996. The claims of the '751 patent are also anticipated and/or rendered obvious by the prior art cited by Cisco and Huawei in Invalidity Contentions served in previous actions brought by Packet Intelligence in the Eastern District of Texas, and the prior art cited on the face and in the specification of this patent and during the prosecution of this patent. The claims of the '751 patent are also rendered obvious by a prior art network monitor, such as the prior art NetScout 6010 probe, including versions 4.0 and 4.5, in view of the "track sessions" functionality as taught by the RMON TrackSession Publication and the teachings of Cooley.

121. In addition, claims 1 and 17 are invalid as anticipated and/or rendered obvious by the Prior Art NetScout Probe which was publicly available at least as early as October 1998. The Prior Art NetScout Probe is a packet monitor that can examine packets passing through a connection point on a computer network. The Prior Art NetScout Probe implemented the "track sessions" technique, which was openly discussed and standardized by the RMON Working

Group in 1996 and described in the RMON TrackSession Publication (Ex. F). The "track sessions" technique tracked disjointed, but related, connection flows that resulted from an activity, such as a client requesting an application or service from a server. As such, the "track sessions" technique discloses the idea of recognizing disjointed flows as belonging to a "conversational flow," which is the Dietz patents' alleged point of novelty.

122. In addition, claims 1 and 17 are at least rendered obvious by prior art network monitors of the 1990s discussed in the background of the specification for the Dietz patents, in combination with the "track sessions" technique disclosed in RMON Working Group publications, such as the RMON TrackSession Publication. For example, the Dietz patents acknowledge that "[s]ome prior art packet monitors classify packets into connection flows." '789 patent at 2:42-45. It would have been obvious to a person of skill in the art at least by the '751 patent's priority date of June 30, 1999, to implement the "track sessions" functionality in a prior art network monitor capable of classifying packets into connection flows. A person of skill in the art would have been motivated to implement "track sessions" in a prior art network monitor to improve its performance and capabilities. For example, implementing "track sessions" in a network monitor would enable the network monitor to not only classify packets into connection flows, but also to recognize related connection flows resulting from a given activity. A person of skill in the art would have recognized that such a modification was possible and would have yielded predictable results, including those described in the RMON TrackSession Publication. For example, at least by October 1998, such an implementation had been perfected in the Prior Art NetScout Probe, which implemented the "track sessions" technique described in the RMON TrackSession Publication. A person of skill in the art would have recognized that a prior art network monitor of the 1990s implementing the "track sessions"

technique disclosed a network monitor capable of recognizing a "conversational flow." Thus, this combination discloses the only alleged point of novelty of these claims and renders these claims obvious.

123. In addition, claims 1 and 17 are rendered obvious by the admitted prior art in the Dietz patent, a prior art network monitor implementing the "track sessions" technique, such as the Prior Art NetScout Probe, in further view of Cooley (Ex. G). Cooley discloses gathering and storing information about a user's web browsing session, such as the IP address of the computer or other device used by the user to access a website, the URLs of the websites visited, and the URLs of any websites that referred to another website. *See* Cooley at pp. 17-19. Cooley discloses collecting and storing this information in entries in a table, such as the table shown in Figure 6:

#	IP Address	Userid	Time	Method/ URL/ Protocol	Status	Size	Referred	Agent
1	123.456.78.9	-	[25/Apr/1998:03:04:41 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
2	123.456.78.9	-	[25/Apr/1998:03:05:34 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.04 (Win95, I)
3	123.456.78.9	-	[25/Apr/1998:03:05:39 -0500]	"GET L.html HTTP/1.0"	200	4130	-	Mozilla/3.04 (Win95, I)
4	123.456.78.9	-	[25/Apr/1998:03:06:02 -0500]	"GET F.html HTTP/1.0"	200	5096	B.html	Mozilla/3.04 (Win95, I)
5	123.456.78.9	-	[25/Apr/1998:03:06:58 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
6	123.456.78.9	-	[25/Apr/1998:03:07:42 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
7	123.456.78.9	-	[25/Apr/1998:03:07:55 -0500]	"GET R.html HTTP/1.0"	200	8140	L.html	Mozilla/3.04 (Win95, I)
8	123.456.78.9	-	[25/Apr/1998:03:09:50 -0500]	"GET C.html HTTP/1.0"	200	1820	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
9	123.456.78.9	-	[25/Apr/1998:03:10:02 -0500]	"GET O.html HTTP/1.0"	200	2270	F.html	Mozilla/3.04 (Win95, I)
10	123.456.78.9	-	[25/Apr/1998:03:10:45 -0500]	"GET J.html HTTP/1.0"	200	9430	C.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
11	123.456.78.9	-	[25/Apr/1998:03:12:23 -0500]	"GET G.html HTTP/1.0"	200	7220	B.html	Mozilla/3.04 (Win95, I)
12	123.456.78.9	-	[25/Apr/1998:05:05:22 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
13	123.456.78.9	-	[25/Apr/1998:05:06:03 -0500]	"GET D.html HTTP/1.0"	200	1680	A.html	Mozilla/3.04 (Win95, I)

Fig. 6. Sample Information from Access, Referrer, and Agent Logs (The first column is for referencing purposes and would not be part of an actual log).

Cooley at Fig. 6 (annotated with blue boxes). It would have been obvious to a person of skill in the art—at least by the '751 patent's priority date of June 30, 1999—that a prior art network monitor, including implementing "track sessions," could be utilized to monitor, collect, and store flow-entries in a database, such entries including data such as the client IP address, website URL, and referrer, for a user's web browsing that are described in Cooley. Cooley further asserts that this information could be collecting using "a remote agent." Cooley at p. 8. A person of skill in the art would have recognized that the "remote agent" referenced in Cooley could be a prior art packet monitor, such as the prior art NetScout 6010 probe and the packet monitors discussed in the background of the Dietz patents, and that such a packet monitor could easily be modified to monitor, collect, and store the pieces of information disclosed in Cooley. The Defendants cannot reasonably dispute that such a combination would invalidate the claims because Defendants argued in the Texas Case that gathering and storing the very same information that Cooley gathers and stores in its table, namely, the client IP address, URL, and Referrer, fully meets the purportedly novel feature of the Dietz patent claim related to "conversational flows."

124. In addition, the '751 patent is invalid under 35 U.S.C. § 102(f) for failing to name one or more of the proper inventors of the '751 patent who contributed to the claimed invention, including one or more members of the RMON Working Group who contributed to the conception and/or reduction to practice of the claimed invention, including, but not limited to, such claimed features as recognizing "conversational flows." The '751 patent is also invalid under 35 U.S.C. § 102(f) because the named inventors derived the claimed invention from the members of the RMON Working Group, who previously conceived of the invention and communicated the idea of the invention to at least named inventors Russell Dietz and Andrew Koppenhaver—members of the RMON Working Group—as well as named inventor Joseph

Maixner, who read RMON Working Group publications, including the RMON TrackSession Publication.

125. A judicial declaration that the '751 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and appropriate at this time so that NetScout can ascertain its rights and duties with respect to the InfiniStream products, which Defendants accuse of infringing the '751 patent.

COUNT TWELVE
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '751 PATENT

126. Paragraphs 1 through 125 are incorporated by reference as if fully stated herein.

127. The '751 patent is unenforceable due to inequitable conduct perpetrated at the USPTO during prosecution of the application which led to the '751 patent.

128. For example, the '751 patent's named inventors and/or the '751 patent's prosecuting patent agent Dov Rosenfeld intentionally withheld prior art information from the USPTO relating to the subject matter of the '751 patent that was material to patentability. Named inventors Russell Dietz and Andrew Koppenhaver were members of the RMON Working Group, attended group meetings, and read RMON Working Group publications, such as the RMON TrackSession Publication, prior to the alleged conception date of the invention disclosed in the '751 patent. Named inventor Joseph Maixner also regularly read RMON Working Group publications prior to the alleged conception date of the invention disclosed in the '751 patent.

129. The named inventors of the '751 patent and/or Dov Rosenfeld not only failed to submit material RMON publications to the USPTO but also intentionally misled the USPTO to believe the RMON publications were not relevant to the prosecution of the '751 patent. *See, e.g.*, '789 patent, 2:33-37 ("Though Netflow® (Cisco Systems, Inc., San Jose, Calif.), *RMON2*, and other network monitors are available for the real-time monitoring of networks, *they lack*

visibility into application content and are typically limited to providing network layer level information.") (emphasis added).

130. In addition, by both knowing of the RMON Working Group's publications and failing to identify members of the RMON Working Group as named inventors, the named inventors of the '751 patent and/or Dov Rosenfeld deliberately misrepresented the true inventors' identities before the USPTO. This deliberate misrepresentation was done with an intent to mislead and deceive the USPTO about the identity of the true inventors of the claimed subject matter of the '751 patent.

131. A judicial declaration that the '751 patent is unenforceable due to inequitable conduct is necessary and appropriate at this time so that NetScout can ascertain its rights and duties with respect to the InfiniStream products, which Defendants accuse of infringing the '751 patent.

COUNT THIRTEEN
DECLARATORY JUDGMENT OF NON-INFRINGEMENT OF THE '725 PATENT

132. Paragraphs 1 through 131 are incorporated by reference as if fully stated herein.

133. Packet Intelligence claims to own all rights, title, and interest in the '725 patent.

134. In seeking to amend its infringement contentions in the Texas Case to add the InfiniStream family of products, Defendants accused NetScout of infringing at least one claim of the '725 patent by making, using, selling, offering for sale, and/or causing others to make, use, sell, and/or offer for sale, the InfiniStream family of products.

135. Contrary to Defendants' assertions in the Texas Case, the InfiniStream products do not infringe any valid claim of the '725 patent. The InfiniStream products are the current version of the NetScout probe that NetScout has been selling for decades, dating back to well before the Dietz patents. In the Texas Case, NetScout identified the Prior Art NetScout Probe as

anticipating the Dietz patents. Packet Intelligence contended at trial in the Texas Case that the Prior Art NetScout Probe was not covered by the claims of the Dietz patents. Many of the same features of the Prior Art NetScout Probe are still present in the InfiniStream products, NetScout's current version of this same platform. The arguments and contentions advanced by Packet Intelligence in the Texas Case purportedly to distinguish the Prior Art NetScout Probe also distinguish and demonstrate non-infringement of the InfiniStream products. Thus, Defendants are barred by judicial estoppel from asserting infringement based on a theory that directly conflicts with their arguments advanced in the Texas Case.

136. NetScout further does not infringe the '725 patent, among other reasons, because the InfiniStream products do not literally or under the doctrine of equivalents meet one or more of the limitations of the claims of the '725 patent. For example, the InfiniStream products do not meet or have an equivalent to the limitation recited in claim 10 of "wherein the protocol specific operations include one or more parsing and extraction operations on the packet to extract selected portions of the packet to form a function of the selected portions for identifying the packet as belonging to a conversational flow" or the limitation in claim 17 of "wherein the packet belongs to a conversational flow of packets having a set of one or more states, and wherein the protocol specific operations include one or more state processing operations that are a function of the state of the conversational flow of the packet, the state of the conversational flow of the packet being indicative of the sequence of any previously encountered packets of the same conversational flow as the packet."

137. The InfiniStream products do not infringe claims 10 and 17 under the doctrine of equivalents for the additional reason that an attempt to assert infringement under the doctrine of equivalents against the InfiniStream products would encompass or ensnare prior art. For

example, the Dietz patents—all of which have substantially similar specifications—acknowledge that "[s]ome prior art packet monitors classify packets into connection flows," which is a term "commonly used to describe all the packets involved with a single connection." '789 patent at 2:42-45. If, hypothetically, claims 10 and 17 were re-written to literally cover functionality in the InfiniStream products that classifies packets into connection flows, these hypothetical versions of claims 10 and 17 would be invalid as anticipated or obvious in view of the admitted prior art in the Dietz patents and many other prior art references more fully described below. Because these hypothetical versions of claims 10 and 17 would ensnare the prior art, Defendants are legally precluded from asserting infringement based on a scope of equivalents that would encompass the InfiniStream products.

138. Further, Defendants are precluded from pursuing any claims of infringement as to the '725 patent based on the InfiniStream products because these products are covered by a license agreement that permits NetScout to use and distribute products that use the intellectual property described and claimed in the Dietz patents.

139. Further, Defendants are precluded from pursuing any claims of infringement as to the '725 patent for any acts relating to InfiniStream products occurring on or after the 12th anniversary of this patent's grant, namely, December 16, 2015, because the '725 patent expired on this date due to Defendants' failure to pay appropriate maintenance fees to maintain the life of this patent.

140. Defendants are precluded from asserting a claim of infringement against the InfiniStream products because they are barred by the doctrines of claim and issue preclusion, collateral estoppel, and *res judicata* arising from the Texas Case. Specifically, a claim of infringement against the InfiniStream products was a compulsory claim in connection with

Defendants' assertion of the Dietz patents against NetScout in the Texas Case. Defendants' belated attempt to assert these claims in the Texas Case were rejected as untimely due to Defendants' failure to diligently pursue the claims. Having failed to timely pursue claims of infringement against the InfiniStream products in the Texas Case, Defendants are now barred from doing so in any other case or matter.

141. Absent a declaration that the claims of the '725 patent are not infringed, Defendants will continue to wrongfully assert the '725 patent against NetScout, thereby causing NetScout irreparable harm and injury.

142. An actual, substantial, and justiciable controversy of sufficient immediacy and reality exists between Defendants and NetScout as to whether the claims of the '725 patent are infringed. A judicial declaration is necessary and appropriate so that NetScout may ascertain its rights regarding the '725 patent.

143. Based on the foregoing, NetScout hereby requests a declaration that the claims of the '725 patent are not infringed by the InfiniStream products.

COUNT FOURTEEN
DECLARATORY JUDGMENT OF INVALIDITY OF THE '725 PATENT

144. Paragraphs 1 through 143 are incorporated by reference as if fully stated herein.

145. The '725 patent is invalid under the patent laws of the United States, 35 U.S.C. § 101 *et seq.*, at least because it purports to claim ineligible subject matter pursuant to 35 U.S.C. § 101.

146. In addition, the claims of the '725 patent are invalid under pre-AIA 35 U.S.C. §§ 102 and/or 103 in view of the prior art cited in NetScout's Invalidity Contentions, NetScout's Notice of Reduction of Asserted Prior Art References, and the Invalidity and Unenforceability Expert Report of Steve Waldbusser served in the Texas Case. Such invalidating prior art

includes at least the Prior Art NetScout Probe, and the NetScout 6010 probe with software version 4.0 in combination with the "track sessions" functionality discussed and standardized by the RMON Working Group in 1996 and disclosed in RMON publications, such as the RMON TrackSession Publication, published November 25, 1996. The claims of the '725 patent are also anticipated and/or rendered obvious by the prior art cited by Cisco and Huawei in Invalidity Contentions served in previous actions brought by Packet Intelligence in the Eastern District of Texas, and the prior art cited on the face and in the specification of this patent and during the prosecution of this patent. The claims of the '725 patent are also rendered obvious by a prior art network monitor, such as the prior art NetScout 6010 probe, including versions 4.0 and 4.5, in view of the "track sessions" functionality as taught by the RMON TrackSession Publication and the teachings of Cooley. In addition, claims 1 and 2 of the '725 patent are anticipated and/or rendered obvious by the prior art, including the WO 97/23076 ("Baker") reference, that was relied on by the Patent Trial and Appeal Board to institute an *Inter Partes* Review (Case IPR2017-00863) of these claims.

147. In addition, claims 10 and 17 are invalid as anticipated and/or rendered obvious by the Prior Art NetScout Probe which was publicly available at least as early as October 1998. The Prior Art NetScout Probe is a packet monitor that can examine packets passing through a connection point on a computer network. The Prior Art NetScout Probe implemented the "track sessions" technique, which was openly discussed and standardized by the RMON Working Group in 1996 and described in the RMON TrackSession Publication (Ex. F). The "track sessions" technique tracked disjointed, but related, connection flows that resulted from an activity, such as a client requesting an application or service from a server. As such, the "track

sessions" technique discloses the idea of recognizing disjointed flows as belonging to a "conversational flow," which is the Dietz patents' alleged point of novelty.

148. In addition, claims 10 and 17 are at least rendered obvious by prior art network monitors of the 1990s discussed in the background of the specification for the Dietz patents, in combination with the "track sessions" technique disclosed in RMON Working Group publications, such as the RMON TrackSession Publication. For example, the Dietz patents acknowledge that "[s]ome prior art packet monitors classify packets into connection flows." '789 patent at 2:42-45. It would have been obvious to a person of skill in the art at least by the '725 patent's priority date of June 30, 1999, to implement the "track sessions" functionality in a prior art network monitor capable of classifying packets into connection flows. A person of skill in the art would have been motivated to implement "track sessions" in a prior art network monitor to improve its performance and capabilities. For example, implementing "track sessions" in a network monitor would enable the network monitor to not only classify packets into connection flows, but also to recognize related connection flows resulting from a given activity. A person of skill in the art would have recognized that such a modification was possible and would have yielded predictable results, including those described in the RMON TrackSession Publication. For example, at least by October 1998, such an implementation had been perfected in the Prior Art NetScout Probe, which implemented the "track sessions" technique described in the RMON TrackSession Publication. A person of skill in the art would have recognized that a prior art network monitor of the 1990s implementing the "track sessions" technique disclosed a network monitor capable of recognizing a "conversational flow." Thus, this combination discloses the only alleged point of novelty of these claims and renders these claims obvious.

149. In addition, claims 10 and 17 are rendered obvious by the admitted prior art in the Dietz patent, a prior art network monitor implementing the "track sessions" technique, such as the prior art NetScout probe in further view of Cooley (Ex. G). Cooley discloses gathering and storing information about a user's web browsing session, such as the IP address of the computer or other device used by the user to access a website, the URLs of the websites visited, and the URLs of any websites that referred to another website. *See* Cooley at pp. 17-19. Cooley discloses collecting and storing this information in entries in a table, such as the table shown in Figure 6:

#	IP Address	Userid	Time	Method/ URL/ Protocol	Status	Size	Referred	Agent
1	123.456.78.9	-	[25/Apr/1998:03:04:41 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
2	123.456.78.9	-	[25/Apr/1998:03:05:34 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.04 (Win95, I)
3	123.456.78.9	-	[25/Apr/1998:03:05:39 -0500]	"GET L.html HTTP/1.0"	200	4130	-	Mozilla/3.04 (Win95, I)
4	123.456.78.9	-	[25/Apr/1998:03:06:02 -0500]	"GET F.html HTTP/1.0"	200	5096	B.html	Mozilla/3.04 (Win95, I)
5	123.456.78.9	-	[25/Apr/1998:03:06:58 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
6	123.456.78.9	-	[25/Apr/1998:03:07:42 -0500]	"GET B.html HTTP/1.0"	200	2050	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
7	123.456.78.9	-	[25/Apr/1998:03:07:55 -0500]	"GET R.html HTTP/1.0"	200	8140	L.html	Mozilla/3.04 (Win95, I)
8	123.456.78.9	-	[25/Apr/1998:03:09:50 -0500]	"GET C.html HTTP/1.0"	200	1820	A.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
9	123.456.78.9	-	[25/Apr/1998:03:10:02 -0500]	"GET O.html HTTP/1.0"	200	2270	F.html	Mozilla/3.04 (Win95, I)
10	123.456.78.9	-	[25/Apr/1998:03:10:45 -0500]	"GET J.html HTTP/1.0"	200	9430	C.html	Mozilla/3.01 (X11, I, IRIX6.2, IP22)
11	123.456.78.9	-	[25/Apr/1998:03:12:23 -0500]	"GET G.html HTTP/1.0"	200	7220	B.html	Mozilla/3.04 (Win95, I)
12	123.456.78.9	-	[25/Apr/1998:05:05:22 -0500]	"GET A.html HTTP/1.0"	200	3290	-	Mozilla/3.04 (Win95, I)
13	123.456.78.9	-	[25/Apr/1998:05:06:03 -0500]	"GET D.html HTTP/1.0"	200	1680	A.html	Mozilla/3.04 (Win95, I)

Fig. 6. Sample Information from Access, Referrer, and Agent Logs (The first column is for referencing purposes and would not be part of an actual log).

Cooley at Fig. 6 (annotated with blue boxes). It would have been obvious to a person of skill in the art—at least by the '725 patent's priority date of June 30, 1999—that a prior art network monitor, including implementing "track sessions," could be utilized to monitor, collect, and store flow-entries in a database, such entries including data such as the client IP address, website URL,

and referrer, for a user's web browsing that are described in Cooley. Cooley further asserts that this information could be collecting using "a remote agent." Cooley at p. 8. A person of skill in the art would have recognized that the "remote agent" referenced in Cooley could be a prior art packet monitor, such as the prior art NetScout 6010 probe and the packet monitors discussed in the background of the Dietz patents, and that such a packet monitor could easily be modified to monitor, collect, and store the pieces of information disclosed in Cooley. The Defendants cannot reasonably dispute that such a combination would invalidate the claims because Defendants argued in the Texas Case that gathering and storing the very same information that Cooley gathers and stores in its table, namely, the client IP address, URL, and Referrer, fully meets the purportedly novel feature of the Dietz patent claim related to "conversational flows."

150. In addition, the '725 patent is invalid under 35 U.S.C. § 102(f) for failing to name one or more of the proper inventors of the '725 patent who contributed to the claimed invention, including one or more members of the RMON Working Group who contributed to the conception and/or reduction to practice of the claimed invention, including, but not limited to, such claimed features as recognizing "conversational flows." The '725 patent is also invalid under 35 U.S.C. § 102(f) because the named inventors derived the claimed invention from the members of the RMON Working Group, who previously conceived of the invention and communicated the idea of the invention to at least named inventors Russell Dietz and Andrew Koppenhaver—members of the RMON Working Group—who read RMON Working Group publications, including the RMON TrackSession Publication.

151. A judicial declaration that the '725 patent is invalid because it fails to satisfy the conditions for patentability specified in Title 35 of the United States Code is necessary and

appropriate at this time so that NetScout can ascertain its rights and duties with respect to the InfiniStream products, which Defendants accuse of infringing the '725 patent.

COUNT FIFTEEN
DECLARATORY JUDGMENT OF UNENFORCEABILITY OF THE '725 PATENT

152. Paragraphs 1 through 151 are incorporated by reference as if fully stated herein.

153. The '725 patent is unenforceable due to inequitable conduct perpetrated at the USPTO during prosecution of the application which led to the '725 patent.

154. For example, the '725 patent's named inventors and/or the '725 patent's prosecuting patent agent Dov Rosenfeld intentionally withheld prior art information from the USPTO relating to the subject matter of the '725 patent that was material to patentability. Named inventors Russell Dietz and Andrew Koppenhaver were members of the RMON Working Group, attended group meetings, and read RMON Working Group publications, such as the RMON TrackSession Publication, prior to the alleged conception date of the invention disclosed in the '725 patent.

155. The named inventors of the '725 patent and/or Dov Rosenfeld not only failed to submit material RMON publications to the USPTO but also intentionally misled the USPTO to believe the RMON publications were not relevant to the prosecution of the '725 patent. *See, e.g.*, '789 patent, 2:33-37 ("Though Netflow® (Cisco Systems, Inc., San Jose, Calif.), *RMON2*, and other network monitors are available for the real-time monitoring of networks, *they lack visibility into application content and are typically limited to providing network layer level information.*") (emphasis added).

156. In addition, by both knowing of the RMON Working Group's publications and failing to identify members of the RMON Working Group as named inventors, the named inventors of the '725 patent and/or Dov Rosenfeld deliberately misrepresented the true inventors'

identities before the USPTO. This deliberate misrepresentation was done with an intent to mislead and deceive the USPTO about the identity of the true inventors of the claimed subject matter of the '725 patent.

157. A judicial declaration that the '725 patent is unenforceable due to inequitable conduct is necessary and appropriate at this time so that NetScout can ascertain its rights and duties with respect to the InfiniStream products, which Defendants accuse of infringing the '725 patent.

PRAYER FOR RELIEF

WHEREFORE, NetScout respectfully requests that this Court enter judgment in its favor and prays that the Court grant the following relief:

A. A declaration that NetScout's InfiniStream products do not infringe any claim of the '099 patent;

B. A declaration that the '099 patent is invalid under the patent laws of the United States, 35 U.S.C. §§ 101 *et seq.*;

C. A declaration that the '099 patent is unenforceable;

D. A declaration that NetScout's InfiniStream products do not infringe any claim of the '646 patent;

E. A declaration that the '646 patent is invalid under the patent laws of the United States, 35 U.S.C. §§ 101 *et seq.*;

F. A declaration that the '646 patent is unenforceable;

G. A declaration that NetScout's InfiniStream products do not infringe any claim of the '751 patent;

H. A declaration that the '751 patent is invalid under the patent laws of the United States, 35 U.S.C. §§ 101 *et seq.*;

I. A declaration that the '751 patent is unenforceable;

J. A declaration that NetScout's InfiniStream products do not infringe any claim of the '789 patent;

K. A declaration that the '789 patent is invalid under the patent laws of the United States, 35 U.S.C. §§ 101 *et seq.*;

L. A declaration that the '789 patent is unenforceable;

M. A declaration that NetScout's InfiniStream products do not infringe any claim of the '725 patent;

N. A declaration that the '725 patent is invalid under the patent laws of the United States, 35 U.S.C. §§ 101 *et seq.*;

O. A declaration that the '725 patent is unenforceable;

P. An order that Defendants, and their officers, directors, employees, agents, attorneys, and all persons in active concert or participation with them, are restrained and enjoined from further instituting or further prosecuting any action against NetScout with respect to any of the Dietz patents;

Q. A declaration that this case is exceptional within the meaning of 35 U.S.C. § 285;

R. An award to NetScout of its costs and attorneys' fees; and

S. Such other and further relief at law or equity as this Court deems just and proper.

DEMAND FOR JURY TRIAL

In accordance with Federal Rule of Civil Procedure 38 and Local Rule 38.1, NetScout respectfully demands a jury trial of all issues triable to a jury in this action.

November 10, 2017

Respectfully submitted,

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