

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

GUEST TEK INTERACTIVE ENTERTAINMENT LTD.,

Petitioner,

v.

NOMADIX, INC.,

Patent Owner.

Case IPR2019-01191

U.S. Patent No. 8,606,917

PETITIONER'S REPLY IN SUPPORT OF ITS PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,606,917

LISTING OF EXHIBITS

Exhibit No.	Description
1001	U.S. Patent No. 8,606,917
1002	Declaration of Dr. Peter Dordal
1003	U.S. Patent Application No. 09/693,060
1004	U.S. Patent No. 8,046,578
1005	David Whyte et al., <u>DNS-based Detection of Scanning Worms in an Enterprise Network</u> , Proceedings of the 12th Annual Network and Distributed System Security Symposium, San Diego, USA (Feb. 3-4, 2005)
1006	U.S. Patent No. 6,463,474
1007	John Wack et al., <u>Keeping Your Site Comfortably Secure: An Introduction to Internet Firewalls</u> , NIST Special Publication 800-10 (Dec. 1994)
1008	Dictionary definitions
1009	U.S. Patent No. 6,226,677
1010	U.S. Patent No. 6,389,462
1011	U.S. Patent No. 6,158,008
1012	Chapter 6 of <i>Building Internet Firewalls</i> by D Brent Chapman and Elizabeth D Zwicky, published in 1995 by O'Reilly & Associates
1013	Secure Public Internet Access Handler (SPINACH), Elliot Poger, Mary G. Baker, Computer Science Department, Stanford University, originally published in the Proceedings of the USENIX Symposium on Internet Technologies and Systems, Monterey, California, December 1997
1014	Chapman, Network (In)Security Through IP Packet Filtering, Published in Proceedings of the Third USENIX UNIX Security Symposium; Baltimore, MD; September, 1992
1015	Duane Wessels Squid and ICP: Past, Present, and Future, Proceedings of the Australian Unix Users Group. September 1997, Brisbane, Australia
1016	TAPI: Transactions for Accessing Public Infrastructure Matt Blaze, John Ioannidis, Sotiris Ioannidis , Angelos D.

	Keromytis , Pekka Nikander , and Vassilis Prevelakis, Proceedings of Personal Wireless Communications: IFIP-TC6 8th international conference, PWC 2003, Venice, Italy, September 23-25, 2003
1017	Wireless Hacking: Projects for Wi-Fi Enthusiasts, by Lee Barken, Eric Bermel, John Eder, Matt Fanady, Alan Koebrick, Michael Mee, and Marc Palumbo, and published in November 2004 by Syngress Publishing
1018	Cisco Subscriber Edge Services Manager Solutions Guide (September 2003)
1019	Affidavit of Christopher Butler of Internet Archive
1020	Printout from www.ndss-symposium.org
1021	U.S. patent application no. 60/160,890
1022	U.S. patent application no. 60/111,497
1023	Excerpts from Nomadix's May 31, 2019 final infringement contentions amending asserted claims
1024	Excerpts from Nomadix's August 30, 2017 infringement contentions asserting '917 patent
1025	Docket Report from parallel district court litigation
1026	Excerpts from Notice of Motion and Motion to Dismiss for Improper Claim Splitting, filed in <i>Nomadix, Inc. v. Guest-Tek Interactive Entertainment Ltd.</i> , 2:19-cv-04980 (D.I. 65)
1027	Excerpts from Expert Report of Dr. Gottesman on behalf of Guest Tek, asserting invalidity based on Guest Tek prior art devices
1028	Excerpts from Guest-Tek's Notice Of Motion And Motion To Exceed Page Limit On Motion For Summary Judgment, filed in <i>Nomadix, Inc. v. Guest-Tek Interactive Entertainment Ltd.</i> , 2:16-cv-08033 (D.I. 442)
1029	Claim Construction Order in <i>Nomadix, Inc. v. Guest-Tek Interactive Entertainment Ltd.</i> , 2:16-cv-08033 (D.I. 420)
1030	Excerpts from Report and Recommendation in <i>Nomadix, Inc. v. Guest-Tek Interactive Entertainment Ltd.</i> , 2:16-cv-08033 (D.I. 438)

Petitioner Guest Tek Interactive Entertainment (“Guest Tek”) submits this reply in accordance with the Board’s Order dated November 6, 2019 (Paper No. 6).

I. THE BOARD SHOULD NOT DENY INSTITUTION UNDER § 314(A)

A. *NHK Spring* supports granting, rather than denying, institution.

The Board requested that Guest Tek address any impact on this proceeding of *NHK Spring Co. v. Intri Plex Techs., Inc.*, IPR2018-00752, Paper 8 (Sept. 12, 2018). In short, *NHK Spring* does not favor denying institution under § 314(a) as Patent Owner (“Nomadix”) suggests. Along with other relevant factors, the factors identified in that decision favor institution.

Nomadix requests denial of institution because of (1) Guest Tek’s alleged delay in filing the petition and (2) the supposedly advanced stage of a parallel district court breach-of-contract case. Resp. § VII.A. First, as to alleged delay, *NHK Spring* held that a petitioner’s awareness of prior art for *ten* years before filing a petition was irrelevant when the petitioner was not time-barred and gained no tactical advantage. IPR2018-00752 (Paper 8) at 19. Similarly, Guest Tek’s petition was timely, which is undisputed. Nomadix suggests that Guest Tek delayed by filing after the § 315(b) deadline. Resp. at 41. But that deadline only applies to patent infringement defendants. Nomadix chose not to allege patent infringement. Guest Tek therefore had every right to file its petition when it did.

Nor was there delay in filing the petition. Guest Tek did not even know

which patent claims Nomadix would assert in the district court until Nomadix served its final infringement contentions on May 31, 2019. Ex. 1023. Moreover, Guest Tek diligently searched for prior art and pursued its IPR after Nomadix first asserted the '917 patent on August 30, 2017. Ex. 1024. The case was stayed, upon Guest Tek's March 2018 motion, pending resolution of whether Nomadix owned the asserted patents and had standing, until February 2019. Ex. 1025 (D.I. 241, 325). Guest Tek did not file an IPR during the stay to preserve resources and attorneys' fees for a case that it thought should be dismissed. After the stay, Guest Tek diligently resumed its prior art search, completed it in April 2019, and diligently prepared and filed its petition in June 2019. There was no delay.

Nor did Guest Tek gain a tactical advantage. Nomadix claims, without explanation, that the time lapse before Guest Tek filed its IPR petition "has given [it] the opportunity to adapt its petition theories to arguments and positions Nomadix had developed in the Lawsuit." Resp. at 41. That is untrue. Nomadix had not addressed *any* of the prior art at issue in the petition in the district court case before Guest Tek filed the petition. Therefore, Guest Tek could not have, and did not, adapt its petition to Nomadix's district court arguments and positions.

Second, as to the stage of the district court case, *NHK Spring* did not suggest or hold that the fact a district court might decide the same invalidity issues before the PTAB was, by itself, enough to deny institution under § 314(a). The

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