IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No.:	6,629,163	Group Art Unit:	To be assigned
Inventors:	Edward Balassanian	Examiner:	To be assigned
Issued:	Sept. 30, 2003	Attorney Docket No.:	159291-0025(163)
Serial No.:	09/474,664	Reexam Control No.:	To be assigned
Title:	METHOD AND SYSTEM FOR DEMULTIPLEXING A FIRST SEQUENCE OF PACKET COMPONENTS TO IDENTIFY SPECIFIC COMPONENTS WHEREIN SUBSEQUENT COMPONENTS ARE PROCESSED WITHOUT RE-IDENTIFYING COMPONENTS	Reexam Filing Date:	To be assigned

REQUEST FOR *INTER PARTES* REEXAMINATION

Mail Stop *Inter Partes* Reexam
Attn: Central Reexamination Unit
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir or Madam:

Juniper Networks, Inc. (hereinafter "Requester") respectfully requests *inter partes* reexamination of U.S. Patent No. 6,629,163 ("the '163 patent") entitled "Method and System for Demultiplexing a First Sequence of Packet Components to Identify Specific Components Wherein Subsequent Components are Processed Without Re-Identifying Components." This Request is made pursuant to 35 U.S.C. §§ 311-316 and 37 C.F.R. §§ 1.906, 1.913 and 1.915. The '163 patent was filed on December 29, 1999 and issued on September 30, 2003. The patent has not yet expired. As a result of *ex parte* reexamination, an Ex Parte Reexamination Certificate (7567th) issued for the '163 patent

on June 22, 2010. Implicit Networks, Inc. ("Implicit") has alleged that it is the current assignee of the '163 patent. A copy of the '163 patent, in the format specified by 37 C.F.R. § 1.915(b)(5), is attached as Exhibit 1. The reexamination certificate is attached as Exhibit 2.

This Request for *Inter Partes* Reexamination ("Request") is being served on the correspondent of record for the '163 patent (Newman Du Wors LLP, 1201 Third Avenue, Suite 1600, Seattle, WA 98101) and on counsel for Implicit (Hosie Rice LLP, Transamerica Pyramid, 34th Floor, 600 Montgomery Street, San Francisco, CA 94111). This Request is also accompanied by the required fee as set forth in 37 C.F.R. § 1.20(c)(2) and the certificate required by 37 C.F.R. § 1.915(b)(6).

For the convenience of the Examiner, following is a table of contents for this Request:

I. INTRODUCTION

The PTO should grant this Request and initiate *inter partes* reexamination proceedings for the '163 patent in light of the invalidating prior art presented herein. Virtually all of the art cited in this Request has never before been considered in connection with the '163 patent claims, and the art clearly discloses every element of the claims to be reexamined—including those elements that the patentee previously alleged during prosecution to be distinguishing features over the prior art. Given the clear teachings of this new prior art as explained below, this Request readily satisfies the threshold requirement of presenting a "reasonable likelihood that the requester would prevail" with respect to one or more of the challenged claims. 35 U.S.C. 312.

The '163 patent describes itself as relating "generally to a computer system for data demultiplexing." Ex. 1 at 1:11-12, 2:57-64. As explained in the background section of the patent, contemporary computer systems "generate data in a wide variety of formats," including bitmap, encryption, and compression formats, and formats used for packet-based communications such as TCP and IP. *Id.* at 1:24-29. To facilitate processing of communications in this multi-format environment, the patent proposes a "method and system for converting a message that may contain multiple packets from [a] source format into a target format." *Id.* at 2:38-40. The packet processing method as claimed employed a "sequence" of components, such that a format conversion could be performed by using a plurality of components taking a message through "various intermediate formats" before reaching the final, target format. *Id.* at 2:47-49. An illustration of such a conversion (from format D1 to D15) is illustrated in Figure 2 of the '163 patent:

P1   P2   P3   P4

D1 | 1 | D2   D2   1   D5   D9 | 1 | D12   D15 | 1 | NULL

D1 | 2 | D3   D10 | 2 | D13
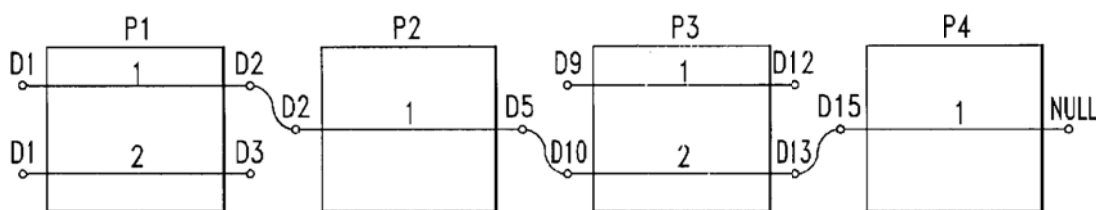
During the original prosecution and prior *ex parte* reexamination proceedings for the '163 patent, the patentee emphasized a few specific features of its purported invention in an attempt to distinguish prior art cited against it. The original claims as filed in 2003 described a method in which (1) a *packet* of a *message* was *received*, (2) a *component* for *processing* the packet was *identified*, and then (3) certain steps relevant to packet processing were performed involving "*state information*." In response to an initial office action rejecting all of the original claims, the patentee cancelled those claims and proposed a new set of claims adding language to the effect that the identification of a *sequence of components* for processing must be *stored*, "so that the sequence *does not need to be re-identified* for *subsequent packets* of the message." In other words, an identification of components was to take place only for the first packet of a given message; that identification was then to be stored and made available for subsequent packets in the message, which could then essentially follow the lead of the first packet through the sequence of components already identified.

The examiner issued a notice of allowance for the claims as thus amended, stating that this new limitation—processing of subsequent packets "without re-identifying" a new sequential order of components—was not taught or suggested in the prior art of record. Indeed, the examiner underscored the importance of the limitation with an examiner's amendment to the patent title which included the words: "*Wherein Subsequent Components are Processed Without Re-Identifying Components*."

Years later, the PTO initiated *ex parte* reexamination proceedings for the '163 patent on the request of a third party that had been accused of infringing the patent.[1] During those proceedings, the patentee offered a new purported point of distinction in an attempt to overcome the primary piece of prior art under consideration in the reexamination—a paper called the "Mosberger" reference. Specifically, the patentee argued that "[t]he '163 invention is about a system that, upon receipt of first message packet, ***dynamically selects*** a sequence of components to create a path for processing the message." Ex. 35-I [Examiner Interview PowerPoint]. In other words, there is a specific, sequential "order to [the] claims – ***first, packet is received***, and ***then, component sequence is identified*** based on packet." *Id.* The patentee pointed to language from the specification suggesting the importance of a "dynamic" approach in avoiding the "overhead" that would otherwise be involved in calculating "each possible series of conversion routines" in advance. Ex. 1 at 1:38-66. The patentee alleged that Mosberger, by contrast, performed its identification of sequences ***before*** the first packet was received, and therefore did not disclose the type of ***dynamic*** identification contemplated by the claims.

After multiple rejections, the patentee was ultimately forced to amend its claims (though purportedly only to "clarify" their original intent) to expressly include the step of "***dynamically*** identifying a ***non-predefined*** sequence of components." The examiners in the reexamination unit subsequently issued a notice of allowance for these claims as amended. The allowance was expressly based on the patentee's argument that "Mosberger does not dynamically identify sequences."

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[1] The litigation matter settled before conclusion of the *ex parte* reexamination proceedings.

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