

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.,
Petitioner.

v.

IMPLICIT, LLC,
Patent Owner.

Case IPR2020-00587
U.S. Patent No. 9,591,104

**PETITIONER'S REPLY TO
PATENT OWNER'S PRELIMINARY RESPONSE**

Application of the two-part framework set forth in *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469 (Feb. 13, 2020) confirms that Juniper’s Petitions should **not** be denied institution under § 325(d). Part 1 of *Advanced Bionics* is not satisfied here as the base references cited in the Petitions (Smith and CheckPoint) were **not** previously before the Office either in form or substance. Moreover, the core arguments in the Petitions—that these base references clearly disclose the trivial “TCP” limitations on which the claims were allowed, and that it was obvious for those references to further incorporate Decasper’s dynamic plugin features—are **completely different** from any the Office previously considered. Part 2 of *Advanced Bionics* also does not support a § 325(d) denial. Rather, to the extent the Office accepted Patent Owner’s prior mischaracterization of Decasper as being limited to an IP router and overlooked the straightforward possibility of incorporating Decasper into the well-known TCP functionality of systems such as Smith or CheckPoint, those errors can and should be corrected by instituting proceedings, as requested in the Petitions.

This case in fact presents the opposite of the situation in *Advanced Bionics*. In *Advanced Bionics*, a prior art reference (“Zimmerling”) that was cited in an office action rejection was overcome with the addition of a claim limitation requiring a rotating magnet. Given that the Office had **expressly** found Zimmerling lacked that element, a later IPR petition relying on Zimmerling in combination with new art that

admittedly *lacked* a rotating magnet was properly denied under § 325(d). *Id.* at 21-22. Conversely, here the Petitions do not seek to effectively overturn a finding by the Office regarding old art, but rather rely on new art, new arguments, and new evidence to satisfy the allegedly missing “TCP” limitations.

Moreover, although Implicit misleadingly describes the challenged patents as being part of a “family of thoroughly-examined patents” on which the “Patent Office has already expended significant resources” (POPR at 5-6, 8-9), it omits the fact that this was almost entirely in connection with *reexamination* proceedings that concluded with the *invalidation* of other patents in the family whose claims did *not* include the “TCP” limitations at issue here.¹ By contrast, during the entire examination of all *six* patents challenged here, there was a grand total of *one* prior art rejection, and there was *no* analysis or rejection by the Office on anything like the art and arguments presented in the Petitions. Accordingly, there is no basis to deny institution here under § 325(d) and *Advanced Bionics*.

¹ For this reason, the reexamination proceedings considered Decasper solely in the context of a router implementation, with only passing mention of the “firewall plugin” as a basis for maintaining state information (Ex. 2001 at 197-202) or to motivate the dynamic configuration of policies (*id.* at 241-244), and not in relation to the TCP limitations introduced in the later patents.

I. *Advanced Bionics* Part 1: The Petitions Present New Art And Argument

First, the grounds proposed in the Petitions clearly do not present the same or substantially the same art or arguments as previously presented to the Office. *See Advanced Bionics* at 13-17 (applying Part 1 on a ground-by-ground basis).

A. *Ground 1: Smith in combination with Decasper*

It is undisputed that Smith was not previously considered by the Office. POPR at 13. Smith is also not “substantially the same” as any art previously presented. Ex. 1011 ¶ 602. Contrary to Implicit’s argument (POPR at 13-14), the critical disclosures of Smith are not limited to generic layer-7 firewall features. For example, Smith describes sophisticated application-layer gateways (“ALGs”) that are “themselves *endpoints of [two] TCP connections*” and therefore expressly execute the TCP protocol consistent with the “TCP” limitations of the challenged patent claims. *See* Petition at 37-38. Those limitations are further supported by Smith’s disclosure of ALG packet processing that operates by “executing TCP and stripping the TCP header.” *See id.* at 37-40. Smith also describes a “Caching Web documents” feature that is cited in the Petition in additional support of these “TCP” limitations. *See id.* at 39-40. Implicit does not even attempt to argue that anything similar to these cited features from Smith was disclosed or suggested in any of the art previously considered during prosecution. To the contrary, the sole “gateway” reference cited

in an office action rejection was expressly found to *lack* TCP processing capabilities. Ex. 1004 at 207.

The arguments presented in the Petitions with respect to Ground 1 are also unlike anything previously considered by the Office during prosecution. For example, the Office was never presented with arguments regarding TCP functionality (e.g., TCP endpoint termination) in an ALG such as Smith. Nor was there any consideration of how the Decasper framework would be beneficially incorporated into this type of ALG. *See* Petition at 2-3; Ex. 1011 ¶ 612. Ground 1 therefore presents new art and arguments under *Advanced Bionics* Part 1.

B. Ground 2: Checkpoint in combination with Decasper

The CheckPoint reference cited in the Petitions was also not previously considered by the Office. Ex. 1011 ¶ 603. This reference consists of a collection of interrelated and linked webpages, including a 1997 Check Point white paper (“CheckPoint97”), all of which were published on CheckPoint’s website as a description of the FireWall-1 product as it existed in 1998. *See* Petition at 17. This is this first time this material has been presented to the Office.

Implicit nevertheless argues that the Checkpoint reference cited here is substantially the same as two earlier papers that were presented to the Office, one from 1994 (“CheckPoint94”) (Ex. 2010) and another from 1995 (“CheckPoint95”) (Ex. 2009). This is not true. Although the POPR quotes language from the earlier

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