

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC. and FORTINET, INC.,  
Petitioner,

v.

INFOEXPRESS INC.,  
Patent Owner.

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IPR2024-00539  
Patent 8,051,460 B2

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Before CHRISTOPHER M. KAISER, JOHN A. HUDALLA, and  
AARON W. MOORE, *Administrative Patent Judges*.

KAISER, *Administrative Patent Judge*.

ORDER  
Denying Patent Owner's Motion for Additional Discovery  
*37 C.F.R. §§ 42.5(a), 42.51(b)(2)*

## I. INTRODUCTION

Cisco Systems, Inc. and Fortinet, Inc. (collectively, “Petitioner”) filed a Petition (Paper 1, “Pet.”) requesting *inter partes* review of claims 1–6, 10–14, 16–22, 27, 29, and 30 (“the challenged claims”) of U.S. Patent No. 8,051,460 B2 (Ex. 1001, “the ’460 patent”). InfoExpress Inc. (“Patent Owner”) filed a Preliminary Response (Paper 7, “Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response (Paper 11, “Prelim. Reply”), and Patent Owner filed a Preliminary Sur-Reply (Paper 12, “Prelim. Sur-Reply”). After considering the briefing and evidence then of record, we determined that the information presented in the Petition established a reasonable likelihood that Petitioner would prevail with respect to at least one of the challenged claims, and we instituted *inter partes* review on all of the challenged claims based on all of the grounds identified in the Petition. Paper 13.

After institution, and following a telephone conference with the Board at which we authorized it, Patent Owner filed a motion for additional discovery, accompanied by fifteen exhibits. Paper 21 (“Mot.”);<sup>1</sup> Exs. 2411–2425; *see* Ex. 3001 (memorializing telephone conference). Patent Owner’s motion seeks additional discovery under two requests for document production and three interrogatories. Mot. 1. Petitioner filed an opposition to the motion. Paper 22 (“Opp.”). After considering the parties’ briefs and the evidence currently of record, for the reasons discussed below, we deny the motion for additional discovery.

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<sup>1</sup> A public, redacted copy of Patent Owner’s motion is in the record as Paper 20.

## II. ANALYSIS

### A. *Standard for Additional Discovery*

Under the Board’s rules, the moving party “has the burden of proof to establish that it is entitled to the requested relief.” 37 C.F.R. § 42.20(c). When seeking additional discovery, the moving party must show that the additional discovery is “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see* 37 C.F.R. § 42.51(b)(2). Moreover, the moving party must satisfy that standard for each proposed discovery request. *See* 37 C.F.R. § 42.20(c); *Chi Mei Innolux Corp. v. Semiconductor Energy Lab’y Co.*, IPR2013-00028, Paper 25 at 4 (PTAB Apr. 26, 2013).

Because Congress intended *inter partes* reviews to serve as a faster and more cost-effective alternative to litigating validity in district courts, discovery in *inter partes* reviews is limited compared to discovery in the district courts. *See Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 5 (PTAB Mar. 5, 2013) (precedential); 154 Cong. Rec. S9982, S9988–89 (daily ed. Sept. 27, 2008) (statement of Sen. Kyl). “Limited discovery lowers the cost, minimizes the complexity, and shortens the period required for dispute resolution.” *Garmin*, IPR2012-00001, Paper 26 at 5.

### B. *The Garmin Factors*

In *Garmin*, the Board identified the following factors as “important” when considering whether additional discovery is “necessary in the interest of justice”:

1. More than a Possibility and Mere Allegation – The mere possibility of finding something useful, and mere allegation that something useful will be found, are insufficient to demonstrate that the requested discovery is necessary in the interest of justice. The party requesting discovery should already be in possession

of evidence tending to show beyond speculation that in fact something useful will be uncovered.

2. Litigation Positions and Underlying Basis – Asking for the other party’s litigation positions and the underlying basis for those positions is not necessary in the interest of justice. The Board has established rules for the presentation of arguments and evidence. There is a proper time and place for each party to make its presentation. A party may not attempt to alter the Board’s trial procedures under the pretext of discovery.

3. Ability to Generate Equivalent Information by Other Means – Information a party can reasonably figure out or assemble without a discovery request would not be in the interest of justice to have produced by the other party. In that connection, the Board would want to know the ability of the requesting party to generate the requested information without need of discovery.

4. Easily Understandable Instructions – The questions should be easily understandable. For example, ten pages of complex instructions for answering questions is prima facie unclear. Such instructions are counter-productive and tend to undermine the responder’s ability to answer efficiently, accurately, and confidently.

5. Requests Not Overly Burdensome to Answer – The requests must not be overly burdensome to answer, given the expedited nature of *Inter Partes* Review. The burden includes financial burden, burden on human resources, and burden on meeting the time schedule of *Inter Partes* Review. Requests should be sensible and responsibly tailored according to a genuine need.

*Garmin*, IPR2012-00001, Paper 26 at 6–7.

*C. Application of the Garmin Factors to Patent Owner’s Proposed Discovery Requests*

*1. Garmin Factor 1: More than a Possibility and Mere Allegation*

*a) Patent Owner’s Contentions*

Patent Owner argues that, during trial, it intends to argue that Petitioner’s copying of Patent Owner’s CG LAN product is objective

evidence of the nonobviousness of the challenged claims. Mot. 1. To do so, Patent Owner intends to rely on evidence that Petitioner had access to Patent Owner's CG LAN product, including both literature about the product and the product software itself, and that Petitioner subsequently released a similar product. *Id.* at 6.

On the access point, Patent Owner argues that evidence currently in hand shows that Petitioner received certain software from Patent Owner, along with “documentation for installing and configuring” that software,” as well as “a PowerPoint presentation.” *Id.* at 2–3 (citing Ex. 2416; Ex. 2417). Patent Owner also argues that, after acknowledging receipt, Petitioner “analyzed the CG LAN software, finding that ‘testing [was] passed and requirements [were] met.’” *Id.* at 3 (citing Ex. 2418; Ex. 2419). Separately, Patent Owner argues that Petitioner's partner, KeyLabs, received the CG LAN software “to test the CG LAN for interoperability with [Petitioner's] Cisco NAC,” finding that “[t]here were no issues encountered during testing and it [wa]s recommended that [Patent Owner's product] CyberGatekeeper version 3.0 pass [Interoperability Verification Testing].” *Id.* (citing Ex. 2420; Ex. 2421, 7). According to Patent Owner, this evidence shows that Petitioner had access to Patent Owner's product and related literature, suggesting a potential for copying that product. *Id.* (arguing that Patent Owner “never heard any further details as to what [Petitioner] did with” Patent Owner's software, documentation, and PowerPoint presentation and that Patent Owner “never heard further on what [Petitioner] did upon their ‘review’ of [KeyLabs'] test report”). The motion for additional discovery seeks information about “what exactly Cisco did with the

information concerning the CG LAN,” which PO characterizes as “information [that] is known only to Cisco.” *Id.*

On the similarity point, Patent Owner argues that information presently in hand shows that Petitioner’s Cisco NAC product lacked features present in Patent Owner’s CG LAN product, as well as that those features are present in Petitioner’s newer ISE product. *Id.* at 4 (citing Ex. 2422; Ex. 2423; Ex. 2424, 1–2; Ex. 2425, 59<sup>2</sup>).

*b) Petitioner’s Contentions*

Regarding access to information relevant to the copying issue, Petitioner argues that Patent Owner has shown no more than speculation that any access to Patent Owner’s information led to copying of Patent Owner’s product by Petitioner. This argument is based on Patent Owner’s acknowledgement “that the ‘subject of its present motion’ is an alleged uncertainty of Cisco’s actions with the information regarding its product.” Opp. 4 (quoting Mot. 3). Petitioner argues that “the implied suggestion of [Petitioner’s] potential misconduct . . . is inarguably speculative.” *Id.* Moreover, Petitioner argues that the purpose of the testing carried out on Patent Owner’s product was “NAC certification, interoperability, and marketing assistance,” all of which Patent Owner received, showing what Petitioner did with the information, and rendering any other use speculative. *Id.* at 4–5 (citing Ex. 2415, 1). In addition, Petitioner notes that the

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<sup>2</sup> Patent Owner cites to page 59 of Exhibit 2425 as support for Petitioner’s ISE product having certain features. Mot. 4. There is no page 59 of Exhibit 2425, which ends at page 9. Because it is unclear what evidence Patent Owner intended to cite for this point, we assume for purposes of deciding this motion that there is evidence to support the ISE product having the features that Patent Owner discusses.

information that Patent Owner argues Petitioner had access to was not “proprietary information or source code,” but merely commercially available software and associated literature, none of which was marked confidential. *Id.* at 5–6 (citing Mot. 2; Ex. 2416).

Regarding the similarity of Petitioner’s and Patent Owner’s products, Petitioner argues that information presently in hand shows that Petitioner identified these features as desirable “years before [Patent Owner] provided its evaluation software to [Petitioner].” *Id.* at 6–7 (citing Ex. 2413, 2).

*c) Analysis*

On the present record, we are not persuaded that Patent Owner has identified evidence tending to show beyond speculation that something useful will be uncovered.

Patent Owner directs us to some evidence that may be supportive of its copying theory. On the similarity issue, an employee of Petitioner stated that Petitioner’s Cisco NAC product “would be useless without all the information that products like CyberGatekeeper can feed it” because it “does not have and will not have such in depth abilities to gather data from an endpoint.” Ex. 2422, 1. Petitioner’s later ISE product, however, has these same features. Mot. 4.<sup>3</sup>

On the other hand, a white paper written by Petitioner tends to show that Petitioner had in mind a product with these same features at least as early as 2004, which is before the dates in March 2005 and February 2006 when Patent Owner provided its CG LAN software to KeyLabs and Petitioner, respectively. Mot. 2–3; Ex. 2413, 1–2. The fact that Petitioner

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<sup>3</sup> As noted above, we assume for purposes of deciding this motion that the ISE product has the features that Patent Owner alleges it has.

identified checking the endpoint device's status before it ever gained access to Patent Owner's product quite strongly suggests that Petitioner did not appropriate the idea via some unknown misuse of Patent Owner's product. Thus, even if evidence of such misuse were to exist, Patent Owner has not shown that the evidence would lead to anything useful in proving copying.

Moreover, Patent Owner admits that its copying theory is merely speculative. Mot. 3 (arguing that Patent Owner "never learned what exactly [Petitioner] did with the information concerning CG LAN" and that, "[t]o date, that information is known only to Cisco, and is the subject of the present motion"). Thus, this *Garmin* factor weighs against granting the motion.

2. *Garmin Factor 2: Litigation Positions and Underlying Basis*

Patent Owner argues that "[n]one of the proposed discovery seeks [Petitioner's] litigation positions or their underlying basis." Mot. 7. Petitioner does not oppose this argument. Opp. 4–8. Accordingly, we determine that this factor weighs in favor of granting the motion.

3. *Garmin Factor 3: Ability to Generate Equivalent Information by Other Means*

Patent Owner argues that "the discovery requests narrowly target non-public information that is otherwise unavailable." Mot. 7. Petitioner does not oppose this argument. Opp. 4–8. Accordingly, we determine that this factor weighs in favor of granting the motion.

4. *Garmin Factor 4: Easily Understandable Instructions*

The instructions provided with Patent Owner's proposed discovery requests are short, simple, and easy to understand. Mot. at Addendum (Part 1), 1, Addendum (Part 2), 1. Petitioner does not argue to the contrary.



Opp. 4–8. Accordingly, we determine that this factor weighs in favor of granting the motion.

5. *Garmin Factor 5: Requests not Overly Burdensome to Answer*

a) *Petitioner's Contentions*

Petitioner argues that answering Patent Owner's proposed interrogatories would "require [Petitioner] to track down unnamed individuals with knowledge about decisions related to one of the numerous companies [Petitioner] was partnered with nearly 20 years ago," noting further that "[e]ven identifying individuals who might have such knowledge will be a time-consuming and expensive process." Opp. 7. Petitioner states that it has already carried out "interviews with long-tenured Cisco employees" and that these interviews "demonstrated no knowledge of InfoExpress or its products." *Id.*

b) *Patent Owner's Contentions*

Patent Owner argues that its proposed discovery requests are not overly burdensome because, if Petitioner "come[s] up empty handed after diligent, good faith investigation," Petitioner can merely respond that it does not have any relevant documents or information. Mot. 7–8. Thus, according to Patent Owner, the fact that the requests seek information from twenty years ago does not render the requests overly burdensome. *Id.*

c) *Analysis*

Despite arguing that Patent Owner's "requests are overly burdensome due to the age of the information sought and the delay in seeking it," Petitioner nonetheless has already "searched for and will produce several documents it has located responsive to RFPs 1 and 2." Opp. 7. Although we do not know whether Petitioner's intended production represents the full

scope of responsive documents, Petitioner's success in finding at least some responsive documents tends to show that Patent Owner's requests for production are not overly burdensome.

Notwithstanding, Petitioner shows convincingly that Patent Owner's proposed interrogatories are "far more burdensome." Opp. 7. The interrogatories seek information about the "efforts Cisco took, if any, to prevent its personnel involved in the development of its CNAC product from accessing information regarding the CyberGatekeeper LAN," "all analyses regarding the CyberGatekeeper LAN, which were performed by Cisco or at its direction or request," including "the interoperability studies performed by KeyLabs," and Cisco's "decisions (a) to terminate its NAC Partner Program and (b) to work 'on [Cisco's] common approach' only with certain partners who were 'in the process of developing integrated solutions.'" Mot. at Addendum (Part 2), 2. These requests seek information about Petitioner's actions with respect to a product that has been sold "since 2004" and a relationship that Petitioner and Patent Owner had between 2004 and 2007. *Id.* at 1. Given Petitioner's statement that it has not found any employee with relevant information, we credit Petitioner's argument that simply identifying people who have relevant information, let alone subsequently collecting, organizing, and reporting that information to Patent Owner, would be time-consuming and burdensome. As for Patent Owner's argument that Petitioner is not required to produce any information in response to the requests and that all that is required is a "diligent, good faith investigation," this is true of literally all proposed discovery requests, so it cannot form the basis for a discovery request being sufficiently non-burdensome.

On balance, we credit Petitioner’s showing that the age of the information sought makes responding to Patent Owner’s discovery requests significantly burdensome, but note that this showing is tempered by Petitioner’s indication that it has already gathered and will be producing some responsive documents. Thus, we determine that this *Garmin* factor weighs somewhat against granting the motion.

6. *Conclusion*

Patent Owner has shown that the second, third, and fourth *Garmin* factors weigh in favor of granting the motion for additional discovery. However, given that the first factor weighs so heavily against granting the motion, and given that the fifth factor weighs somewhat against granting the motion, we determine that the *Garmin* factors as a whole do not indicate that the proposed additional discovery is “necessary in the interest of justice.”

III. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Patent Owner’s motion for additional discovery is denied.

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FOR PETITIONER:

Scott M. Border  
Joseph C. Masullo  
WINSTON & STRAWN LLP  
[sborder@winston.com](mailto:sborder@winston.com)  
[jmasullo@winston.com](mailto:jmasullo@winston.com)

Patrick D. McPherson  
Patrick Muldoon  
David C. Dotson  
DUANE MORRIS LLP  
[PDMcPherson@duanemorris.com](mailto:PDMcPherson@duanemorris.com)  
[PCMuldoon@duanemorris.com](mailto:PCMuldoon@duanemorris.com)  
[DCDotson@duanemorris.com](mailto:DCDotson@duanemorris.com)

FOR PATENT OWNER:

Brian R. Michalek  
Joseph M. Kuo  
SAUL EWING LLP  
[brian.michalek@saul.com](mailto:brian.michalek@saul.com)  
[joseph.kuo@saul.com](mailto:joseph.kuo@saul.com)