

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTELLIGENT PROTECTION MANAGEMENT CORP.,
Petitioner,

v.

CISCO TECHNOLOGY, INC.,
Patent Owner.

Case IPR2025-01588
U.S. Patent No. 8,830,293

**PETITIONER'S OPPOSITION TO PATENT OWNER'S
REQUEST FOR DISCRETIONARY DENIAL
AND *SOTERA*-PLUS STIPULATION**

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PETITIONER'S EXHIBIT LIST

Exh. No.	Description
1001	U.S. Patent No. 8,830,293 (“the ’293 patent”)
1002	File History of U.S. Patent No. 8,830,293
1003	Expert Declaration of Omid Kia, Ph. D.
1004	U.S. Patent No. 8,345,082 (“Tysso”)
1005	U.S. Patent Application No. 61/103,588 (“Tysso Provisional”)
1006	User Manual for GNU Image Manipulation Program (dated May 1, 2007) (“GIMP”)
1007	Printout of https://web.archive.org/web/20070521020845/http://docs.gimp.org/download.html , captured by Internet Archive on May 21, 2007
1008	Screenshot of https://web.archive.org/web/20070512113240/http://docs.gimp.org/en.pdf , captured by Internet Archive on May 12, 2007
1009	Printout of https://archive.org/legal/affidavit
1010	Recorded Assignment of Tysso (Ex. 1004) to Patent Owner
1011	Record of ’293 Patent Case Activity
1012	Docket Navigator Patent Health Report on ’293 Patent
1013	District Court Scheduling Order

In response to the Petition for *Inter Partes* Review (“IPR”) of claims 1-20 of U.S. Patent No. 8,830,293 (“the ’293 patent”), Patent Owner argues three reasons for discretionary denial: settled expectations, the merits of the Petition, and the parallel district court litigation. None of these arguments counteracts the strong reasons for the Board to consider the merits in this proceeding—including to correct irregularities in the original prosecution—or otherwise compels discretionary denial.

The strongest reason for instituting an IPR trial and rejecting discretionary denial relates to Patent Owner’s statements regarding its robust patent portfolio, along with its ownership and failure to disclose primary prior art reference Tyso (Ex. 1004) to the Office during prosecution of the ’293 patent. Patent Owner tells the Director that “Cisco’s history of innovation is perhaps best showed most clearly by the fact that it has 14,000 issued U.S. patents of its own. As you’ll hear, more than 700 of those patents relate to Webex.” Req., 7 (citing Ex2004 at 51). Despite touting its massive U.S. patent portfolio, during the prosecution of the ’293 patent, ***Patent Owner submitted a single IDS citing only a single WIPO publication, and disclosed no relevant U.S. patents or U.S.-based prior art to the Office.*** See Ex. 1001, cover page (noting that all cited U.S. references were found by the examiner); Ex. 1002, 139-140 (IDS citing no U.S. patents or publications); Ex. 1012 (Docket Navigator report on ’293 patent health indicating that “All

citations originated from the examiner.”). Exacerbating Patent Owner’s questionable compliance of its duty of disclosure to the Office during prosecution of the ’293 patent, *Tysso (Ex. 1004) was acquired by Patent Owner prior to issuance of the ’293 patent, but Patent Owner never disclosed Tysso to the Office in an IDS*. Ex. 1010. Where a sophisticated company such as Patent Owner trumpets its robust U.S. patent portfolio on one hand but fails to alert the Office of relevant known prior art during examination on the other hand, a second look at patentability is prudent.

On the issue of settled expectations, Patent Owner is simply wrong that it is entitled to settled expectations where it knew of relevant prior art during prosecution of the ’293 patent, and failed to alert the Office to that known prior art. This failure of disclosure undercuts any possible expectation of validity that Patent Owner should enjoy.

Patent Owner also attempts to impute knowledge of the ’293 patent to the public—and Petitioner—through Patent Owner’s vague prior statement of patent holdings. As noted above, Patent Owner argues that Petitioner was previously made aware of Patent Owner’s “numerous patents in the video technology space.” Req., 6-7. But the details of that alleged disclosure are sweeping and non-specific. Speaking to a jury, Patent Owner’s counsel introduced Patent Owner as a company during opening statements by remarking that “Cisco’s history of innovation is

perhaps best showed most clearly by the fact that it has 14,000 issued U.S. patents of its own. As you'll hear, more than 700 of those patents relate to Webex." Req., 7 (citing Ex2004 at 51). Notably, Patent Owner offers no evidence that the '293 patent was ever specifically identified to Petitioner prior to filing its complaint for patent infringement. In essence, Patent Owner is suggesting that Petitioner should have filed upwards of 14,000 IPRs back in 2021 in response to Patent Owner's opening statement to a jury. This is an untenable strategy under any reasonable standard. Patent Owner also fails to alert the Director that the only time the '293 patent was ever asserted in litigation was against Petitioner, in March 2025, and Patent Owner comes forward with no evidence that the '293 patent was ever commercialized by Patent Owner. *See* Ex. 1011 (identifying only two cases involving the '293 patent).

On the merits of the Petition, Patent Owner relies on attorney argument only to complain that the merits of the challenges are weak because Petitioner allegedly failed to establish the filing date of Tyssso's provisional application as Tyssso's priority date. This is wrong. Not only did Petitioner tie the disclosures of the provisional application to every claimed feature in Tyssso, but Petitioner's citations were supported by expert testimony, while Patent Owner comes forward with only attorney argument on this point. To the extent there is a legitimate dispute on Tyssso's priority date, and not just a manufactured argument to try to get this case

denied on Director discretion, this dispute should be resolved on more fulsome briefing. Patent Owner's ownership position in Tyso, and its failure to cite Tyso to the Office during examination of the '293 patent, also warrants this second look at patentability.

Last, Patent Owner argues that there is substantial overlap between the district court litigation and this proceeding, but that is wrong. Notably, Patent Owner failed to alert the Director of the district court's scheduling order. *See Ex. 1013*. A pretrial conference is not scheduled until October 22, 2027, with trial scheduled for November 1, 2027. *Id.*, 14. Based on the date of the Office's **Notice of Filing Date Accorded** of October 9, 2025, this IPR would reach a final written decision no later than April 9, 2027, *roughly seven months before trial in district court*. Even the opening expert reports are not due in district court until January 15, 2027, which would likely occur *after the oral hearing* in this proceeding. *Id.* Thus, the entirety of the briefing and oral argument in this IPR will be concluded before any expert reports would be required to address validity. And a FWD here would issue roughly seven months before any trial would occur in district court. These timings weigh against discretionary denial, not in favor.

Finally, Petitioner submits a *Sotera-Plus* stipulation to avoid any risk of duplication in district court and these proceedings.

For these reasons, the Director should reject Patent Owner's request for discretionary denial and instead refer this proceeding to the merits panel.

I. PATENT OWNER'S FAILURE TO DISCLOSE TYSSO TO THE EXAMINER DURING PROSECUTION OUTWEIGHS ANY SETTLED EXPECTATIONS AND FAVORS INSTITUTION

As introduced above, the strongest reason for allowing the Office to look at the '293 patent for a second time and rejecting discretionary denial relates to Patent Owner's statements regarding its robust patent portfolio, along with its ownership and failure to disclose primary prior art reference Tyssso (Ex. 1004) to the Office during prosecution of the '293 patent. Patent Owner acquired prior art reference Tyssso in November, 2011, while the '293 patent's prosecution was pending. Ex. 1010, 7, 15 (each identifying the Tyssso application, 12/576,018, among the patent rights acquired by Patent Owner in 2011). The '293 patent *issued almost three years later*, on September 9, 2014, without Tyssso ever being submitted as a relevant prior art reference to the Office by Patent Owner.

Further, Patent Owner alleges that its U.S. patent portfolio as of 2021 was in the realm of "14,000 issued U.S. patents," with "more than 700 of those patents relat[ing] to Webex." Req., 7 (citing Ex2004 at 51). Despite this massive U.S. patent portfolio—and at least one particularly relevant prior art reference (again, Tyssso)—Patent Owner submitted a single IDS citing only a single WIPO publication, and disclosed no relevant U.S. patents or U.S.-based prior art to the

Office. *See* Ex. 1001, cover page (noting that all cited U.S. references were found by the examiner); Ex. 1002, 139-140 (IDS citing no U.S. patents or publications); Ex. 1012 (Docket Navigator report on '293 patent health indicating that "All citations originated from the examiner."). And to reiterate, Patent Owner knew of and owned Tyso, but never disclosed it to the Office during the prosecution of the '293 patent.

Given Patent Owner's questionable compliance with its duty of disclosure, Patent Owner is not entitled to any settled expectations where it knew of relevant prior art during prosecution of the '293 patent, and failed to alert the Office to that known prior art. This failure of disclosure undercuts any possible expectation of validity that Patent Owner should enjoy.

Moreover, Patent Owner is wrong to insinuate that Petitioner somehow delayed bringing this IPR.

First, Patent Owner's disclosure of its 14,000 patents was not provided in the context of infringement notice. If anything, Patent Owner was trying to convince a jury of its own dedication to innovation at trial, rather than alerting Petitioner of some potential infringement problem. *See* Ex. 2004, 50-52 (discussing Cisco's history of innovation as part of introducing Cisco to the jury). Indeed, the fact that Patent Owner identified 14,000 patents in its portfolio, and 700 patents related to Webex indicates strongly that Patent Owner had no particularized infringement

theory against Petitioner at that time.¹ Until Patent Owner filed its complaint for patent infringement against Petitioner in March 2025, Petitioner had no prior notice of any infringement allegations from Patent Owner. Moreover, the only time the '293 patent was ever asserted by Patent Owner in litigation was against Petitioner, with the filing of the subject complaint, and Patent Owner comes forward with no evidence that the '293 patent was ever commercialized by Patent Owner. *See* Ex. 1011 (identifying only two cases involving the '293 patent).

Second, Patent Owner's insinuation that Petitioner should have filed upwards of 14,000 IPR petitions back in 2021 is not tenable. Even at its peak, the Board was handling fewer than 3,000 new IPR petitions a year. Notwithstanding the administrative burden that would have resulted from this scorched-earth tactic, the filing fees alone would have been approximately 581 million dollars, all because Cisco announced in open court that it held a portfolio of 14,000 patents. And even if Petitioner could have somehow correctly identified the 700+

¹ As one district court judge explained, "Saying you knew about [a patent] family is not too far a step from saying you knew there was this PTO in Virginia, and you should just go check everything there and see if anything there applies. It's too nebulous." *See Intell. Ventures I LLC v. T-Mobile USA, Inc.*, Hearing Tr. 61:2-9, No. 2:17-cv-00577-JRG, Dkt. 297 (E.D. Tex. Jan. 3, 2019).

“WebEX” patents in that bunch, a cost of even 30 million dollars in filing fees would have been equally prohibitive. Rather than burdening the Board with countless unnecessary petitions, Petitioner quickly filed two petitions (IPR2025-01588 and IPR2025-01589) once Patent Owner particularized its belief that these were the patents of interest in this dispute between the parties. This is not indicative of a Petitioner who sat on its hands for years.

II. THE MERITS OF THE CHALLENGES ARE STRONG AND DO NOT SUFFER FROM THE ALLEGED DEFECT OF FAILING TO ESTABLISH PRIORITY TO TYSSO'S PROVISIONAL

Patent Owner contends, based on attorney argument only, that the Petition failed to establish that Tyssso was supported by Tyssso's provisional application and filing date. This is wrong. As explained in the Petition with the support of credible expert testimony, there is no meaningful difference between Tyssso and the Tyssso Provisional. The Tyssso Provisional contains the same or substantially the same disclosure as Tyssso and supports all claims of Tyssso. *See, e.g.*, Ex1003, ¶43. In the detailed discussion of the Grounds, Petitioner cited to both Tyssso and the corresponding portions of the Tyssso Provisional to establish that Tyssso and all the relied-upon disclosures therein are available as of the provisional application's filing date.

Moreover, Patent Owner's attorney argument is wrong as a matter of law. 35 U.S.C. §112 does not “demand any particular form of disclosure, or that the

specification recite the claimed invention *in haec verba*.” See *Ariad Pharmaceuticals, Inc. v. Eli Lilly and Co.*, 598 F.3d 1336, 1352 (Fed. Cir. 2010) (en banc). Here, Patent Owner relies upon such cases as *Duke Univ. v. Sandoz Inc.*, No. 24-1078, 2025 WL 3210322 (Fed. Cir. Nov. 18, 2025) and *Juno Therapeutics, Inc. v. Kite Pharma, Inc.*, 10 F.4th 1330, 1337 (Fed. Cir. 2021), which address unpredictable and uncertain biological chemical arts, rather than predictable and comprehensible videoconferencing technology at issue in Tysso. Patent Owner then contends that the Tysso Provisional does not disclose “combining” processed participant image data “to generate a merged image data of participants” because “the Tysso Provisional does not use the word ‘combining’.” Req., 12 (also suggesting an open questions of “whether merging is the same as combining, or where such merging occurs.”). This is false.

In fact, Tysso **does use** the term “combining” as a virtual synonym for the term “merging.” Tysso says, “The **combining** unit 53 **merges** the processed participant images into a **merged** data wherein the participant images are overlapped and a participant that is speaking is highlighted.” Tysso, 5:17-22 (emphasis added). Thus, when the Tysso Provisional discloses “merging” of processed images, it also discloses “combining” them. Further reinforcing this fact, Tysso states the following about FIG. 1 of Tysso:

FIG. 1 is a diagram of *combining* participant image data of participants situated at different locations to display the participants of a video conference as being located in a same room, in accordance with an exemplary embodiment of the present disclosure

Tysso, 2:39-43 (emphasis added). FIG. 1 of Tysso is depicted as follows:

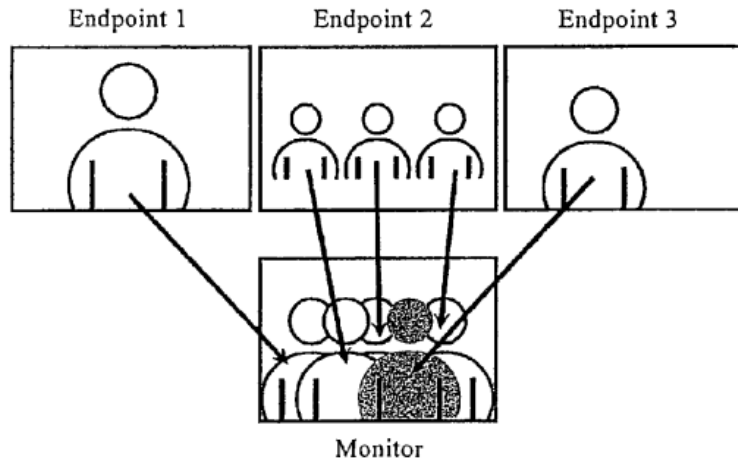


Fig. 1

Notably, the Tysso Provisional has the same illustration as Tysso:

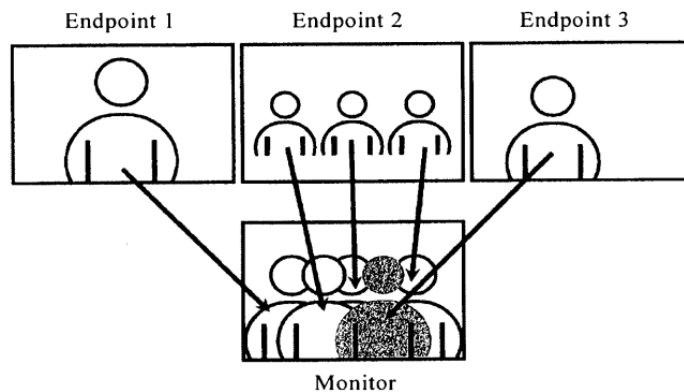


Fig. 1

Ex. 1005, 17. That the Tyso Provisional describes its Figure 1 as illustrating “a plurality of participants located at different locations merged and presented on a single monitor” (Tyso, 3:1-2; *see also id.*, 3:15-17) fully supports “combining” images. Specifically, it shows that the disclosure of “merging” in the Tyso Provisional supports the claiming of “combining” in Tyso.

Patent Owner's other arguments also fail. Patent Owner suggests that there is no disclosure of the MCU of the Tyso Provisional performing merging/combining or “extracting” participant image data from video data (Req., 10; *see also id.*, 13-14), but this is also wrong. Initially, the Tyso Provisional states that “pictures from the different endpoints are processed by performing *a method comprising different steps performed in an MCU* connected to said endpoints.” Tyso Provisional, 3:18-20; *see also id.*, 2:10-25 (“the following steps performed in an MCU connected to said endpoints through a network”).

As explained in the Tyso Provisional, “the first step of the inventive method is to receive video signals comprising sound- and image data of the participants at each endpoint.” Tyso Provisional, 3:21-22. With regard to “extracting,” the Tyso Provisional discloses, “the endpoint comprises means for extracting image data from each participant from the background.” Tyso Provisional, 3:26-29. But such “extracting” is not exclusively performed at endpoints, as Tyso then explains, the “second step is to process and extract image data of participants from

their backgrounds, *if this has not already been done at one or more endpoints as said above.*" Tyssso Provisional, 3:31-35; *see also id.*, 6:36-37.

The Petition tries to create a strawman argument about what it means in the Tyssso Provisional to extract participant images "from the background" (Req., 14-16) without understanding that the "background" is part of the complete "image data" of the received "video signals." Patent Owner similarly seems to fail to understand that "image data" for a frame of video can include background image data ("image data belonging to the background") and participant image data ("image data of one of more participants"), such that extracting image data "of participants from their background" is plainly supported in the Tyssso Provisional, because the root source of the "background" is the received video signals with the image and sound data of participants.

Further, after the extracting and other processing of image data received at the MCU, the MCU of the Tyssso Provisional performs the merging/combining of the image data from the individual endpoints. As the Tyssso Provisional explains, "the MCU processes the data *before sending the resulting processed video signals to respective endpoints.*" Tyssso Provisional, 6:26-30 (also noting the "participants at the endpoints receiving the resulting processed video signals will not be included *in the merged image*") (emphasis supplied); *see also* Tyssso Provisional, 2:22-25.

Given these clear disclosures in the Tyso Provisional, and the expert support provided along with the Petition, Patent Owner's attorney argument on the sufficiency of the Tyso Provisional disclosures is underdeveloped and wrong. To the extent there is a legitimate dispute on Tyso's priority date, and not just a manufactured argument to try to get this case denied on Director discretion, this dispute should be resolved on more fulsome briefing. Patent Owner's ownership position in Tyso, and its failure to cite Tyso to the Office during examination of the '293 patent, also warrants this second look at patentability.

III. THE DISTRICT COURT TRIAL DATE AND EXPERT DISCOVERY DEADLINES WEIGH IN FAVOR OF INSTITUTION

Last, Patent Owner argues that there is substantial overlap between the district court litigation and this proceeding, but that is wrong as the district court's scheduling order confirms. *See* Ex. 1013. A pretrial conference is not scheduled until October 22, 2027, with trial scheduled for November 1, 2027. *Id.*, 14. Based on the date of the Office's **Notice of Filing Date Accorded** of October 9, 2025, this IPR would reach a final written decision no later than April 9, 2027, *roughly seven months before trial in district court*. And a decision whether to institute this IPR would occur on April 2026, eighteen months before trial in district court, and could very well alter what occurs in district court well before labor intensive activities on invalidity commence. Even the opening expert reports are not due in district court until January 15, 2027, which would likely occur *after the oral*

hearing in this proceeding. *Id.* Thus, even if the district court case were not stayed or otherwise delayed, the entirety of the briefing and oral argument in this IPR will be concluded before any expert reports would be required to weigh in on validity. And a FWD here would issue roughly seven months before any trial would occur in district court. These timings weigh against discretionary denial, not in favor, because a FWD decision cancelling the claims of the '293 patent would make a jury consideration of the '293 patent unlikely.

Further, given an institution deadline of April 9, 2026 and Petitioner's *Sotera-Plus* stipulation below, the parties will be able to adjust the scope of any remaining invalidity challenges in district court in light of the Board's institution decision long before the January 15, 2027 deadline for filing opening expert reports. Thus, any risk of duplication between the district court litigation and this proceeding is *de minimis*.

IV. PETITIONER'S *SOTERA-PLUS* STIPULATION

Sotera: To mitigate any duplication concerns, if this IPR is instituted, Petitioner will not pursue in District Court litigation the grounds asserted in this proceeding, or any other ground that was raised or could have been reasonably raised in an IPR. *See Sotera Wireless, Inc. v. Masimo Corp.*, IPR2020-01019, Paper 12 (PTAB Dec. 1, 2020) (precedential); *BMW of No. Am., LLC v. Northstar Systems LLC*, IPR2023-01017, Paper 12 at 10 (PTAB Dec. 8, 2023).

PLUS: Additionally, if this IPR is instituted, Petitioner will not pursue in District Court litigation any invalidity theory based on system prior art in combination with one or more of the references asserted as part of a ground raised in this proceeding. Further, because Ex. 1006 is the User Manual for GNU Image Manipulation Program (dated May 1, 2007), if this IPR is instituted, Petitioner will not pursue in District Court litigation any invalidity theory based on the GNU Image Manipulation Program.

V. THE DIRECTOR IS RESPECTFULLY ASKED TO REFER THIS PROCEEDING TO THE MERITS PANEL

Petitioner believes that discretionary denial is unwarranted, and respectfully asks that the Director refer this proceeding to the merits panel for consideration of the merits of Petitioner's challenges.

Dated: January 9, 2026

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CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing document was served via email on this date, by consent, to Patent Owner by serving the correspondence email addresses of record as follows:

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