UNITED STATES PATENT AND TRADEMARK OFFICE
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BEFORE THE PATENT TRIAL AND APPEAL BOARD
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INTERNATIONAL BUSINESS MACHINES CORPORATION,
Petitioner,

v.

INTELLECTUAL VENTURES II, LLC,
Patent Owner.
_____

Case IPR2014-00587
Patent 6,826,694 B1
_____

Before JAMES T. MOORE, MEREDITH C. PETRAVICK, and
BENJAMIN D.M. WOOD, *Administrative Patent Judges.*

PETRAVICK, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
Inter Partes Review
35 U.S.C §318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

International Business Machines Corporation ("Petitioner") filed a Petition (Paper 4, "Pet.") to institute an *inter partes* review of the sole claim of U.S. Patent No. 6,826,694 B1 ("the '694 patent"). On September 24, 2014, pursuant to 35 U.S.C. § 314, we instituted this trial as to the sole claim on the proposed ground under 35 U.S.C. § 103 over Hughes[1] and Abraham.[2] Paper 13. On December 18, 2014, Intellectual Ventures II, LLC ("Patent Owner") filed a Patent Owner Response (Paper 29, "PO Resp."), and Petitioner filed a Reply (Paper 37, "Pet. Reply") on March 11, 2015.

On April 29, 2015, Patent Owner filed a Motion to Exclude (Paper 40, "PO Mot.") and Petitioner also filed a Motion to Exclude (Paper 42, "Pet. Mot"). Patent Owner filed an Opposition to Petitioner's Motion to Exclude (Paper 46, "Pet. Mot. Opp."), and Petitioner filed a Reply in Support of Petitioner's Motion to Exclude (Paper 51, "Pet. Mot. Reply").

An oral hearing in this proceeding was held on June 3, 2015. A transcript of the hearing is included in the record. Paper 53.

For the reasons that follow, we determine that Petitioner fails to show by a preponderance of the evidence that the sole claim of the '694 patent is unpatentable.

A. The '694 Patent

The '694 patent is titled "High Resolution Access Control" and issued on November 30, 2004. Ex. 1004, 1. The '694 patent claims priority to

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[1] Hughes et al., U.S. Patent No. 5,842,040 (issued Nov. 24, 1998) (Ex. 1006).
[2] Abraham et al., U.S. Patent No. 5,983,270 (issued Nov. 9, 1999) (Ex. 1007).

Provisional Patent Application No. 60/105,188, which was filed on October 22, 1998. *Id.*

The '694 patent discloses a system and method of filtering data packets at a firewall. *See id.* at col. 1, ll. 11–12. The packet includes a header and a payload. *Id.* at col. 1, ll. 16–17. The header includes header parameters, such as source address, destination address, port number, and protocol number. *Id.* at col. 1, ll. 16–26, col. 2, ll. 27–29. The payload includes data intended to be conveyed to the destination, such as a connection request or document data. *Id.* at col. 1, ll. 26–28, col. 2, ll. 28–31.

Figure 1, reproduced below, is a flow chart illustrative of the method.
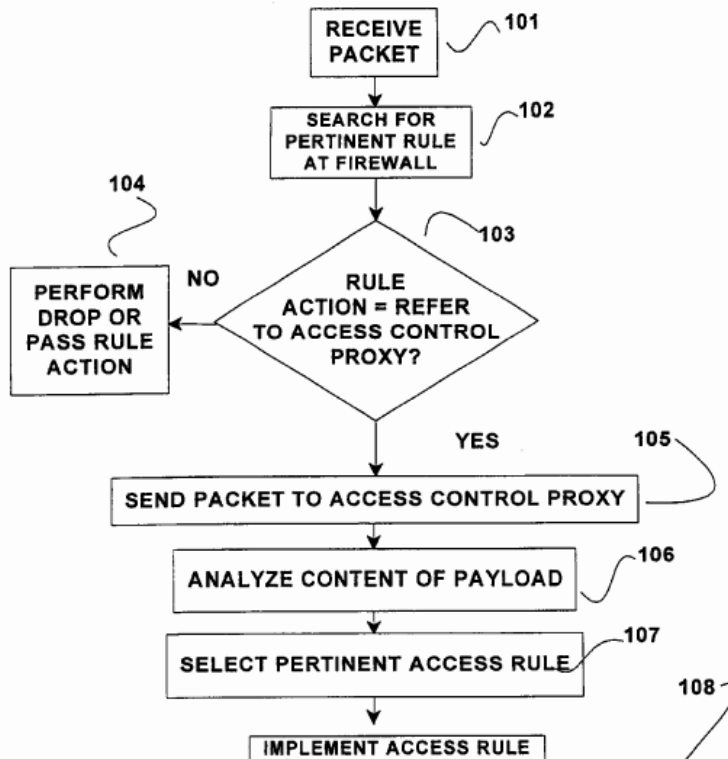

Figure 1 is flow chart depicting the method of the '694 patent.

When a packet is received at the firewall (step 101), the system identifies, from a "set of rules stored at the firewall," a rule based upon the packet's header parameters (step 102). *Id.* at col. 3, ll. 9–12. Depending on whether the packet satisfies the rule, the packet is then either dropped or passed (step 104) or referred to an access control proxy (step 105). *Id*. at col. 3, ll. 12–18, col. 4, ll. 47–50.

If the packet is sent to the access control proxy (step 105), the access control proxy then analyzes the content of the payload of the packet (step 106) and selects an "access rule" based on the content of the payload (step 107). *Id*. at col. 3, ll. 18–37. In an alternative embodiment, the access control proxy selects the access rule "based upon a combination of the contents and header parameters of the packet." *Id*. at col. 3, ll. 39–42, col. 4, ll. 36–38. In yet another alternative embodiment, the access control proxy selects the access rule based upon the contents of one or several packet payloads because the information needed to select an access rule is spread across the contents of several packets. *Id*. at col. 4, ll. 38–40, col. 5, ll. 1–19.

The access control proxy then implements the selected access rule for the packet by performing either a PASS or a DROP action (step 108). *Id*. at col. 3, ll. 51–55, col. 4, ll. 30–34.

The '694 patent discloses that filtering packets based upon not only the header information but also upon the information contained in the packet payload differs from known firewall filtering methods and is advantageous because it provides high resolution access control. *Id*. at col. 1, l. 58–col. 2, l. 9.

B. The Claim

Claim 1, reproduced below, is the sole claim of the '694 patent.

1. A method for filtering a packet, including the steps of:

a. receiving a packet having at least one header parameter and a payload;

b. selecting an access rule based upon the contents of the payload of the packet received in step a;

c. implementing the access rule for a packet, wherein the access rule is selected based upon a combination of the contents of the packet received in step a and the contents of at least one other packet.

C. Related Proceedings

The parties state that the '694 patent is involved in numerous district court cases. *See* Pet. 1–2; Paper 9, 2–3. Additionally, the '694 patent is the subject of two additional Petitions for *inter partes* review, *Compass Bank v. Intellectual Ventures II LLC,* Case IPR2014-00786 (PTAB) and *International Business Machines Corp. v. Intellectual Ventures II LLC*, Case IPR2014-01465 (PTAB).

A Final Written Decision in IPR2014-00786 is entered concurrently with this Decision.

II. ANALYSIS

A. Claim Construction

Consistent with the statute and legislative history of the America Invents Act (AIA)[3], the Board interprets claims using the broadest

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[3] Pub. L. No. 112-29, 125 Stat. 284 (2011).

reasonable construction in light of the specification of the patent in which they appear. 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC,* 793 F.3d 1268, 1276–78 (Fed. Cir. 2015). Under the broadest reasonable construction standard, claim terms are given their ordinary and customary meaning, as would be understood by one of ordinary skill in the art in the context of the entire disclosure. *In re Translogic Tech., Inc.*, 504 F.3d 1249, 1257 (Fed. Cir. 2007).

Contents of the Packet

Claim 1's step c recites "wherein the access rule is selected based upon a combination of the contents of the packet received in step a and the contents of at least one other packet." Ex. 1004, col. 6, ll. 41–44.

The parties dispute the meaning of "contents of the packet."[4] Petitioner proposes that the broadest reasonable construction of "contents of the packet" is the contents of "the header and/or payload of the packet." Pet. 5–6. Patent Owner proposes a narrower construction: "contents of the header and the payload of the packet." PO Resp. 6–20. According to Patent Owner, its proposed construction requires that the access rules must be selected based on both the contents of the header and the contents of the payload of the packet. *See id*. at 9–20.

i. Petitioner's Argument

Petitioner argues that its construction is consistent with the claim, which sets out that a packet has at least one header parameter and a payload in step a, and with the Specification, which states that a packet includes a

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[4] Neither Petitioner nor Patent Owner asserts that the '694 patent contains a lexicographic definition of this limitation.

header and payload. Pet. 5–6 (citing Ex. 1004, col. 2, ll. 25–27). Petitioner argues that this construction is consistent with the plain meaning in the context of the Specification. Pet. 5–6.

ii. Patent Owner's Argument

Patent Owner first argues that its construction, unlike Petitioner's, is internally consistent with claim 1. PO Resp. 9–14. According to Patent Owner, step a of claim 1 requires that the contents of the packet include a header and a payload. *Id*. at 12–13. Step a recites "a packet having at least one header parameter and a payload." Ex. 1004, col. 1, ll. 37–38. Patent Owner, thus, argues to be consistent with step a, the rule selection of step c must be based upon both the header and payload. PO Resp. 12–14. Patent Owner also argues that this is consistent with the absence of qualifying language, such as "at least a portion of the contents of the packet" and "at least some of the contents of the packet." *Id*. at 13.

Patent Owner also argues that to maintain internal consistency with step b of claim 1, step c's rule selection must be based upon information from both the header and payload of the packet. PO Resp. 10–12. Step b requires that the access rule is selected based upon "the contents of the payload of the packet." Patent Owner contends that one of ordinary skill in the art would understand that step c further limits and clarifies the rule selection in step b. *Id*. at 11. To further limit and clarify step b, the rule selection in step c must be based upon information from the both the header and payload of the packet. *Id*. at 11–12.

According to Patent Owner, under Petitioner's construction, the rule selection of step c could be based upon just the header of the packet and,

thus, step c does not specify a further requirement or clarify step b. PO Resp. 12. Patent Owner argues that Petitioner's construction would improperly replace steps b's "payload" with "header." *Id*.

Patent Owner further argues that its construction is consistent with the Specification. *Id*. 14–20. Patent Owner argues that the Specification states that a packet includes both a header and a payload and that nowhere does the Specification state that the packet includes a header and/or payload. *Id*. at 20.

Patent Owner also argues that, although the Specification describes embodiments where a rule is selected based only on the payload, every packet having a payload inspected for rule selection, for example at the access proxy (e.g., step 106 in Fig. 1) has first its header inspected upon receipt of the packet (e.g., step 102 in Fig. 1). *Id*. at 14–20. Patent Owner argues that Specification supports its construction by disclosing that it is advantageous to provide filtering based not only on header information but upon information contained in the packet payload as well. *Id*. at 14–16.

Patent Owner also argues that we should give Petitioner's construction no weight because Petitioner did not provide any evidence to support its construction. *Id*. at 9–10. Patent Owner contends that Petitioner's declarant Dr. Bellovin's testimony is conclusory and provides no reasoning for support his testimony. *Id*. Patent Owner argues that, in contrast, its construction is supported by the testimony of Dr. Mir. *Id*. at 10; *see id.* at 10–20 (citing Ex. 2018 ¶¶ 40–79). Dr. Mir's testimony, however, substantially repeats Patent Owner's arguments supporting its construction (*see* Ex. 2018 ¶¶ 40–79), and, for the same reasons discussed below with regards to Patent Owner's argument, we find it unpersuasive.

iii. Analysis

We are persuaded by Petitioner that the broadest reasonable construction, in light of the Specification, of "contents of the packet" in step c is the header and/or payload of the packet. Petitioner's construction is supported, sufficiently, by the '694 patent, itself, which discloses embodiments of selecting access rules based upon the header and/or payload of the packet. The '694 patent discloses a first embodiment in which the firewall selects a rule based on header parameters only, and discloses that, based on the header parameters, the packet may be passed or dropped. *See* Ex. 1004, col. 2, ll. 35–37, 40–43, col. 3, ll. 10–12, Fig 1 (path formed by steps 101, 102, 103, and 104).

The '694 patent also discloses that an access control proxy selects a rule based on an analysis of the payload of a single or multiple packets. *Id.* at col. 3, ll. 4–8, 18–22, 30–32, col. 4, ll. 28–34, 38–40, Fig. 1 (path formed by steps 106 and 107). The '694 patent further discloses alternate embodiments in which the "access control proxy selects an access rule that pertains to the packet based both on an analysis of the payload and the header parameters of the packet" (Ex. 1004, col. 3, ll. 38–41) and the "access rule is retrieved based upon a combination of the contents and header parameters of the packet" (*id.* at col. 4, ll. 36–38).

We are not persuaded by Patent Owner that Petitioner's construction is unreasonably broad and that "contents of the packet" in step c should be construed, in light of the Specification, to require, more narrowly, that the rule is selected based on information from both the header and the payload. The '694 patent's disclosure that a packet has a header and a payload does

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not require that step c's rule selection must be based on information from both the header and the payload. Nor does the '694 patent's disclosure of first selecting a rule at the firewall based on header parameters (i.e., steps 101, 102, and 103 of Fig. 1) prior to selecting another rule at the access proxy for some packets (i.e., steps 106 and 107 of Fig. 1), require that step c's rule selection must be based on information from both the header and the payload.

Patent Owner's argument attempts to impermissibly import a requirement from the Specification into the claim. If a feature is not necessary to give meaning to what the inventor means by a claim term, it would be "extraneous," and should not be read into the claim. *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249 (Fed. Cir. 1998); *E.I. du Pont de Nemours & Co. v. Phillips Petroleum Co.*, 849 F.2d 1430, 1433 (Fed. Cir. 1988).

We also are not persuaded by Patent Owner that Petitioner's construction makes step c inconsistent with steps a and b of claim 1. Nothing in step a's recitation that "a packet having at least one header parameter and a payload," requires that step c's rule selection be based upon both the header and payload of the packet of step a. Step c requires that the access rule is selected based upon the "contents of the packet received in step a and the contents of at least one other packet" but, unlike step b, step c is silent as to whether the information is from the header or payload portion of the contents of the packets. Step c, thus, does not preclude the information coming from the header or payload portion of the contents of the packets.

Step b requires "selecting an access rule based upon the contents of the payload of the packet received in step a." We do not agree with Patent Owner that Petitioner's construction of "contents of the packet" in step c would replace, effectively, step b's "payload" with "header." Step c does not replace step b's requirement but provides an additional requirement for selecting the access rule. In other words, claim 1 requires that the access rule be selected based upon not only the contents of the payload of the received packet, but additionally requires that the rule be selected based upon a combination of the contents of the header and/or payload of the received packet and the contents of the header and/or payload of at least one other packet. This is consistent with the Specification's disclosure of an embodiment in which the contents of several packets are analyzed to select the access rule. Ex. 1004, col. 5, ll. 1–19.

Upon consideration of both Petitioner's and Patent Owner's arguments, we determine that the broadest reasonable interpretation in light of the Specification of "contents of the packet" in step c is the "contents of the header and/or payload of the packet."

B. Prior Invention

Patent Owner argues that Hughes and Abraham would qualify as prior art only under 35 U.S.C. §§ 102 (a) or 102(e)[5] and seeks to disqualify Hughes and Abraham as prior art by establishing a date of invention prior to their alleged effective dates. PO Resp. 35–54. According to Patent Owner, the alleged effective date of Hughes is June 18, 1996 and of Abraham is

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[5] The '694 patent was filed in 1999, prior to the enactment of the AIA. Thus, pre-AIA 35 U.S.C. § 102 is applicable in this proceeding.

March 11, 1997. *See id*. at 36. Patent Owner alleges that the claimed invention of the '694 patent was actually reduced to practice "at least as early as early 1996 but no later than June 11, 1996." *Id*. at 37.

To establish an actual reduction to practice, the patentee must prove that he (1) constructed an embodiment or performed a process that meets all the claimed limitations of the invention, and (2) determined that the invention worked for its intended purpose. *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998). "The essential inquiry here is whether the advance in the art represented by the invention . . . was embodied in a workable device that demonstrated that it could do what it was claimed to be capable of doing." *Scott v. Finney*, 34 F. 3d 1058, 1063 (Fed. Cir. 1994) (emphasis omitted) (quoting *Farrand Optical Co. v. United States*, 325 F.2d 3278, 333 (2d Cir. 1963)). "In order to establish an actual reduction to practice, an inventor's testimony must be corroborated by independent evidence. . . . [A] 'rule of reason' analysis is applied to determine whether an inventor's testimony regarding reduction to practice has been sufficiently corroborated." *Cooper*, 154 f.3d at 1330 (citation omitted); *see also Mahurkar v. C.R. Bard, Inc.*, 79 F.3d 1572, 1577 (Fed. Cir. 1996) (corroboration requirement "arose out of a concern that inventors testifying in patent infringement cases would be tempted to remember facts favorable to their case by the lure of protecting their patent or defeating another's patent").

The sufficiency of corroboration is determined according to a "rule of reason." *Price v. Symsek*, 988 F.2d 1187, 1195 (Fed. Cir. 1993). This, however, does not dispense with the requirement that some independent evidence provide corroboration. *Coleman v. Dines*, 754 F.2d 353, 360 (Fed.

Cir. 1985). The requirement of "independent" corroboration requires evidence other than the inventor's testimony. *In re NTP, Inc.*, 654 F.3d 1279, 1291–92 (Fed. Cir. 2011).

To support its argument, Patent Owner proffers the testimony of inventor Mr. Partha Dutta, (Ex. 2006) and, to corroborate Mr. Dutta's testimony, Patent Owner proffers testimony of non-inventor Dr. Dalibor Vrsalovic (Ex. 2014) and a collection of allegedly contemporaneous documents regarding AT&T's GeoPlex project (Exs. 2007–13, collectively "AT&T documents"). PO Resp. 36–37.

For the reasons discussed below, we are persuaded by Patent Owner that the claimed invention was reduced to practice prior to the effective filing date of Hughes and Abraham.

a. Partha Dutta's Testimony

Partha Dutta testifies that the inventors worked on a project called GeoPlex at AT&T and that GeoPlex included an access control mechanism or gate, which contained a packet filter/firewall. Ex. 2006 ¶¶ 5–13; PO Resp. 36–37. According to Mr. Dutta, a working prototype of the GeoPlex gate was built at least as early as February 1996 but no later than June 11, 1996. Ex. 2006 ¶ 21.

Mr. Dutta testifies that the GeoPlex gate filtered packets to and from a GeoPlex cloud. *Id.* ¶ 23. The packets were allowed to pass through or were blocked at the gate according to access control and parental control rules for each user. *See id.* ¶¶ 24, 31. The rules were selected and loaded into the firewall for each user by identifying the user based upon the source IP address contained in the headers of received packets, authenticating a user

based upon information in the contents of the payloads of the packets, and identifying the service the user was attempting to access based upon the addresses of the service in the headers and payloads of multiple received packets. *Id.* ¶¶ 26–42, 45, 46.

b. AT&T Documents

Mr. Dutta contends that the prototype code of the GeoPlex gate is no longer available. *Id.* ¶ 26. Therefore, Mr. Dutta relies upon Exhibits 2008–2011 to corroborate his testimony that the filter/firewall of the GeoPlex gate selected an access rule based upon information from the headers and payloads of multiple packets. Ex. 2006 ¶ 22. Mr. Dutta refers to Exhibits 2007, 2012, and 2013 to provide an overview and additional examples of the GeoPlex project, but does not substantively rely upon these exhibits to establish prior invention. Ex. 2006 ¶¶ 9, 68.

Exhibit 2008 is a slide presentation referred to as Parthas proxy.ppt and was created by Mr. Dutta and last modified on January 18, 1996. Ex. 2006 ¶¶ 24–25; Ex. 2017, 4. Exhibit 2009 is a slide presentation referred to as geoplex-slides2.ppt and was created by Dr. Vrsalovic and last saved on June 17, 1995. Ex. 2006 ¶ 47; Ex. 2017, 5. Ex. 2011 is a slide presentation referred to as Geosecurity2.ppt and was created by Karal A. Siil and last saved on June 11, 1996. Ex. 2006 ¶ 57; Ex. 2017, 7.

Exhibit 2010 is a technical memorandum referred to as ControlDaemon copy.doc. Ex. 2006 ¶ 52; Ex. 2017, 5. ControlDaemon copy.doc indicates that the memorandum is from Karl A. Siil and is dated March 8, 1996. Ex. 2010, 1. The meta data for ControlDaemon copy.doc indicates that ControlDaemon copy.doc was last saved on November 11,

1998, by Michah Lerner, a named inventor of the '694 patent. Ex. 2017, 5. Mr. Dutta, however, testifies that ControlDaemon copy.doc "accurately represents my understanding of the Gate in early 1996." Ex. 2006 ¶ 53.

Mr. Dutta testifies that certain figures and statements from Exhibits 2008–2011 demonstrate that the GeoPlex filter/firewall functioned to block unwanted traffic between peers, as well as between a peer and a cloud. Ex. 2006 ¶¶ 27, 28, 32–35, 48–49, 53–54, 58, 59, 62–66. According to Mr. Dutta, the relied upon figures and statements demonstrate that the GeoPlex filter/firewall was configured to authenticate a user, to implement parental controls based upon a user's profile, and to allow parental controls over telnet sites, ftp sites, certain URLs, and other content for each user. *Id*.

Petitioner argues that the AT&T documents do not sufficiently demonstrate that the GeoPlex filter/firewall performed step c of the claim. Pet. Reply 13–15. According to Petitioner, Mr. Dutta admitted during cross-examination that the AT&T documents only "sort of" relate to the '694 patent and Mr. Dutta admitted that the AT&T documents are simply high-level PowerPoint slides that he is unable to correlate to the actual claim language. Pet. Reply 13–14 (citing Ex. 1033, 66:15–67:4, 85:3–12, 90:13–91:17, 92:4–11, 95:1–15).

Upon review of the cited portions of the AT&T documents, we are persuaded that the documents themselves depict high level architecture of the GeoPlex gate and do not sufficiently disclose the GeoPlex gate performing a rule selection based on the contents of multiple packets. It is Mr. Dutta's added explanation, and not the AT&T documents, that sufficiently describes and explains features of the GeoPlex project that correspond to the claimed rule selection. The requirement of "independent"

corroboration requires evidence other than the inventor's testimony. *In re NTP, Inc.*, 654 F.3d 1279, 1291–92 (Fed. Cir. 2011). We are persuaded by Petitioner that the AT&T documents fail to provide sufficient corroboration for Mr. Dutta's testimony.

c. Dr. Vrsalovic's Testimony

Dr. Vrsalovic testifies that he was employed as the Senior Vice President of Advanced Technology at AT&T from 1995 to 1999 (Ex. 2014 ¶ 4) and was responsible for directing the GeoPlex project (*id*. ¶ 10). Dr. Vrsalovic testifies that as head of the GeoPlex project, he oversaw the work of the inventors of the '694 patent. *Id*. ¶ 14. Dr. Vrsalovic testifies that:

> [t]o the best of my knowledge, a working prototype of the Gate firewall was built at least as early as between March and May of 1996. I know this because I personally reviewed the software code of the prototype in this timeframe and because I sat in design review meetings in this timeframe with Partha Dutta, where Partha would perform tests of the working prototype for my review.

Id. ¶ 19. Dr. Vrsalovic testifies that the prototype gate verified who the user was based upon the IP address of the user found in the headers of packets, as well as based upon authentication information found in the payloads of packets (*id*. ¶ 25) and that the prototype gate selects firewall rules based upon the users, as well as information in the packets' headers and payloads about which GeoPlex service the users were attempting to access (*id*. ¶ 26).

Petitioner questions the reliability of Dr. Vrsalovic's testimony because his testimony concerns events that occurred 20 years ago, Mr. Dutta only indirectly reported to Dr. Vrsalovic around the time of the alleged reduction to practice, and because Dr. Vrsalovic and Mr. Dutta are "very

good friends." *Id*. (citing Ex. 1036, 65:15–66:12, 76:3–6; Ex. 1033, 34:19–35:20).

Upon review of the evidence, we are persuaded that Dr. Vrsalovic's testimony provides sufficient corroboration for Mr. Dutta's testimony. We credit Dr. Vrsalovic's testimony that he personally reviewed the software code of the working prototype and that he sat in on a design review meeting where the working prototype was tested, during the relevant time frame. Ex. 2014 ¶ 19. We also credit Dr. Vrsalovic's testimony that the GeoPlex gate selected and loaded a rule based upon information found in the headers and payloads of multiple packets. Ex. 2014 ¶¶ 19–20, 25–26, 30.

Although Dr. Vrsalovic stated during cross-examination that he could not recall precisely what type of authentication technique was used because of "too much time," Dr. Vrsalovic did recall that the authentication technique used a token in the payload of a GeoPlex request in addition to the IP address because of a concern about spoofing of the IP address. Ex. 1036, 65:15–66:12.

d. Petitioner's Argument Regarding Mr. Kumar

Petitioner argues that the claimed subject matter could not have been reduced to practice in 1996 because a named inventor, Mr. Kumar, did not work at AT&T until approximately July 1997. Pet. Reply 10–12. Patent Owner contends that the '694 patent erroneously names Mr. Kumar as an inventor. Paper 48, 5. We are persuaded by Patent Owner that the discrepancy between Mr. Kumar's alleged date of employment and the alleged date of reduction to practice may be the result of an error in

ascribing inventorship, and is not persuasive evidence that the claimed subject matter could not have been reduced to practice in 1996.

e. Analysis

Petitioner bears the burden of persuasion to show, by a preponderance of the evidence, that the challenged claim is unpatentable. 35 U.S.C. § 316(e). This burden includes, *inter alia*, showing that any reference on which it relies is prior art under 35 U.S.C. § 102. *See Mahurkar,* 79 F.3d at 1576 (holding that accused infringer "bore the burden of persuasion . . . on all issues relating to the status of [the asserted reference] as prior art"). Hughes and Abraham presumptively constitute prior art under 35 U.S.C. §§ 102(a) or 102(e) because their filing dates are prior to the '694 patent's earliest effective filing date, giving rise to Patent Owner's burden of coming forward with evidence supporting a date of invention before September 9, 1998. *Mahurkar*, 79 F.3d at 1576–77; *see Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008) (finding that when party challenging validity came forward with art that is prior to the challenged patent's application date, the patentee has the burden of going forward with evidence that "the asserted claim is entitled to the benefit of a filing date prior to the alleged prior art").

Upon consideration of the all the evidence, we are persuaded that Patent Owner has met its burden of coming forward with sufficient evidence to corroborate independently inventor Mr. Dutta's testimony that the inventors of the '694 patent reduced to practice the claimed invention "at least as early as early 1996 but no later than June 11, 1996" (PO Resp. 36).

Thus, we are not persuaded that Hughes and Abraham are prior art under 35 U.S.C. §§ 102(a) or 102(e).

C. Obviousness over Hughes and Abraham

Petitioner fails to demonstrate that claim 1 is unpatentable under 35 U.S.C. § 103 because Petitioner has not demonstrated that Hughes and Abraham are prior art.

D. Motions to Exclude
i. Patent Owner's Motion

Patent Owner moves to exclude Exhibits 1032, 1034, 1035, and 1038 in their entirety. PO Mot. We do not rely on these exhibits in reaching our Decision and, thus, dismiss Patent Owner's motion to exclude these exhibits as moot.

ii. Petitioner's Motion

Petitioner moves to exclude the entirety of Exhibits 2012 and 2013, paragraphs 22, 23, and 26 of Exhibit 2006, and paragraphs 13 and 23–30 of Exhibit 2014. Pet. Mot. 1. Petitioner withdrew its objection to paragraph 31 of Exhibit 2014. Pet. Mot. Reply. 5–6.

a. Exhibits 2012 and 2013

Because we do not rely on Exhibits 2012 and 2013 in reaching our Decision, we dismiss Petitioner's motion to exclude these exhibits as moot.

b. Exhibit 2006

Petitioner moves to exclude paragraphs 22, 23, and 26 of Exhibit 2006 under Federal Rule of Evidence ("FRE") 602. Pet. Mot. 4–5; Pet. Mot. Reply 1–3. FRE 602 states that "[a] witness may testify to a matter only if evidence is introduced sufficient to support a finding that the witness has personal knowledge of the matter. Evidence to prove personal knowledge may consist of the witness's own testimony." Fed. R. Evid. 602.

Exhibit 2006 is the Declaration of Partha Dutta. According to Petitioner, in paragraphs 22, 23, and 26, Mr. Dutta testimony contains statements that require an understanding of the proper legal scope of the '694 patent, but there is insufficient evidence to support a finding Mr. Dutta has personal knowledge of that proper legal scope of the '694 patent. *Id*. at 4.

We dismiss Petitioner's motion to exclude paragraphs 22, 23, and 26 paragraphs of Exhibit 2006 as moot because we do not rely upon the statements made in these paragraphs that Petitioner alleges to require an understanding of the proper legal scope of the '694 patent in reaching our decision. Although we cite to paragraphs 22, 23, and 26 of Ex. 2006 above, we only rely upon other statements in those paragraphs, which do not address the legal scope of the '694 patent, such as "the prototype code is no longer available." Ex. 2006 ¶ 26.

c. Exhibit 2014

Petitioner moves to exclude paragraphs 13 and 23–30 of Exhibit 2014 under FRE 602 as not being based upon Dr. Vrsalovic's personal knowledge. Pet. Mot. 6–7; Pet. Mot. Reply 3–4. According to Petitioner,

there is insufficient evidence to establish that Dr. Vrsalovic had personal knowledge of the functionality of the GeoPlex gate detailed in paragraphs 13 and 23–30 of Exhibit 2014. *Id.*

Patent Owner argues that Dr. Vrsalovic's testimony satisfies FRE 602 because Dr. Vrsalovic testifies that: he has personal knowledge of the matters of his testimony (Ex. 2014 ¶ 1); he directed the GeoPlex project and oversaw the work of the inventors (*id.* ¶¶ 10, 14); he personally reviewed the source code of the prototype GeoPlex gate (*id.* ¶ 19); and he personally observed tests of the working prototype GeoPlex gate (*id.* ¶¶ 19–22). Pet Mot. Opp. 4–8.

Upon review of the evidence, we are persuaded by Patent Owner that there is sufficient evidence that Dr. Vrsalovic has personal knowledge of the functionality of the GeoPlex gate. Petitioner's motion to exclude as to paragraphs 13 and 23–30 of Exhibit 2014 is denied.

III. CONCLUSION

Petitioner fails to demonstrate by a preponderance of the evidence that claim 1 is unpatentable under 35 U.S.C. § 103 over Hughes and Abraham.

Patent Owner's Motion to Exclude Evidence is dismissed; and

Petitioner's Motion to Exclude Evidence is dismissed as to Exhibits 2012 and 2013, and paragraphs 22, 23, and 26 of Exhibit 2006, and is denied as to paragraphs 13 and 23–30 of Exhibit 2014.

This is a Final Written Decision of the Board under 35 U.S.C. § 318(a). Parties to the proceeding seeking judicial review of this decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that claim 1 of U.S. Patent No. 6,826,694 B has not been shown to be unpatentable;

FURTHER ORDERED that Patent Owner's Motion to Exclude as to Exhibits 2012 and 2013, paragraphs 22, 23, and 26 of Exhibit 2006 is *dismissed*; and

FURTHER ORDERED that Petitioner's Motion to Exclude paragraphs 13 and 23–30 of Exhibit 2014 is *denied*.

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