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Paper 12
Entered: September 3, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

NETAPP INC.,
Petitioner,

v.

CROSSROADS SYSTEMS, INC.,
Patent Owner.

Case IPR2015-00772
Patent 7,987,311 B2

Before NEIL T. POWELL, KRISTINA M. KALAN, J. JOHN LEE, and KEVIN W. CHERRY, *Administrative Patent Judges.*

POWELL, *Administrative Patent Judge.*

DECISION
Denying Institution of *Inter Partes* Review
37 C.F.R. § 42.108

I. INTRODUCTION

NetApp Inc. ("Petitioner") filed a Petition (Paper 2, "Pet."), requesting institution of an *inter partes* review of claims 1–28 of U.S. Patent No. 7,987,311 B2 (Ex. 1001, "the '311 patent"). Patent Owner Crossroads Systems, Inc. ("Patent Owner") timely filed a Preliminary Response (Paper 10, "Prelim. Resp."). We have jurisdiction under 35 U.S.C. § 314.

For the reasons below, based on the circumstances of this case, we exercise our discretion under 35 U.S.C. § 325(d) to deny the Petition and, therefore, decline to institute *inter partes* review.

A. The '311 Patent

The '311 patent relates to a storage router and method for providing virtual local storage on remote Small Computer System Interface ("SCSI") storage devices to Fibre Channel ("FC") devices. Ex. 1001, col. 1, ll. 47–50. SCSI is a storage transport medium that provides for a "relatively small number of devices to be attached over relatively short distances." *Id.* at col. 1, ll. 54–57. FC is a high speed serial interconnect that provides "capability to attach a large number of high speed devices to a common storage transport medium over large distances." *Id.* at col. 1, ll. 59–63. Computing devices can access local storage through native low level, block protocols and can access storage on a remote network server through network interconnects. *Id.* at col. 2, ll. 1–13. To access the storage on the remote network server, the computing device must translate its file system protocols into network protocols, and the remote network server must translate network protocols to low level requests. *Id.* at col. 2, ll. 15–24. A storage router can interconnect the SCSI storage transport medium and the

FC high speed serial interconnect to provide devices on either medium with access to devices on the other medium so that no network server is involved. *Id.* at col. 2, l. 61–col. 3, l. 4.

Claims 1 and 16 are the independent claims challenged by this petition, and claim 1 is reproduced below:

> 1. A storage router for providing virtual local storage on remote storage devices, comprising:
>
> a first controller operable to connect to a first transport medium, wherein the first medium is a serial transport medium;
>
> a second controller operable to connect to a second transport medium; and
>
> a processing device coupled to the first controller, wherein the processing device is configured to:
>
> maintain a map to allocate storage space on the remote storage devices to devices connected to the first transport medium by associating representations of the devices connected to the first transport medium with representations of storage space on the remote storage devices, wherein each representation of a device connected to the first transport medium is associated with one or more representations of storage space on the remote storage devices;
>
> control access from the devices connected to the first transport medium to the storage space on the remote storage devices in accordance with the map and using native low level block protocol, further comprising:

> for a device connected to the first transport medium, identifying LUNs for storage space allocated to that device in the map;
>
> presenting to that device only the identified LUNs as available storage space; and
>
> processing native low level block requests directed to the identified LUNs from that device to allow access to the storage space associated with the identified LUNs.

B. Related Proceedings

Petitioner notes that the '311 patent is the subject of the district court proceeding *Crossroads Systems, Inc. v. NetApp, Inc.*, Case No. 1-14-cv-00149 (W.D. Tex.). Pet. 1 (citing Ex. 1027); Paper 9, 2; *see* Paper 8, 2. Additionally, the '311 patent was the subject of a petition filed by Petitioner in IPR2014-01233. Pet. 1; Paper 8, 2; Paper 9, 2. The '311 patent also belongs to a family of patents, a number of which are involved in *inter partes* reviews or are or were the subject of *inter partes* review petitions, including Case Nos. IPR2014-01177, IPR2014-01197, IPR2014-01207, IPR2014-01209, IPR2014-01226, IPR2014-01463, IPR2014-01544, IPR2015-00773, IPR2015-00776, IPR2015-00777, IPR2015-00822, IPR2015-00825, IPR2015-00852, IPR2015-00854, IPR2015-01063, IPR2015-01064, and IPR2015-01066. Paper 8, 2–4; Paper 9, 2–3.

C. Challenges

Petitioner challenges the claims as follows, all on the basis of obviousness:

References	**Claims Challenged**
CRD-5500 User Manual,[1] CRD-5500 Data Sheet,[2] and Smith[3]	1–28
Kikuchi[4] and Bergsten[5]	1–28
Bergsten and Hirai[6]	1–28

II. DISCUSSION

35 U.S.C. § 325(d) provides that "[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31, the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office." In IPR2014-01233, Petitioner filed a Petition challenging claims 1–28 based on the same grounds presented here. *NetApp Inc. v. Crossroads Sys., Inc.*, Case IPR2014-01233, slip op. at 5 (PTAB

[1] CMD Technology, Inc., *CRD-5500 SCSI RAID Controller User's Manual*, (1996) (Ex. 1003).
[2] *CRD-5500 RAID Disk Array Controller* (Dec. 4, 1996), http://web.archive.org/web/19961226091552/http:/www.cmd.com/brochure/crd5500.htm (last visited July 23, 2014) (Ex. 1004).
[3] Judith A. Smith and Meryem Primmer, *Tachyon: A Gigabit Fibre Channel Protocol Chip*, 1996 Hewlett-Packard J. 1–17 (Ex. 1005).
[4] U.S. Pat. No. 6,219,771 B1, iss. Apr. 17, 2001 (Ex. 1006).
[5] U.S. Pat. No. 6,073,209, iss. June 6, 2000 (Ex. 1007).
[6] Japanese Patent Application Publication No. HEI 5[1993]-181609, pub. July 23, 1993 (Ex. 1008).

Aug. 1, 2014) (Paper 1) ("the 1233 Petition" or "1233 Pet."). Specifically, the 1233 Petition challenged (1) claims 1–28 as obvious over the CRD-5500 User Manual, the CRD-5500 Data Sheet, and Smith; (2) claims 1–28 as obvious over Kikuchi and Bergsten; and (3) claims 1–28 as obvious over Bergsten and Hirai. *Id.*

The 1233 Petition did not demonstrate a reasonable likelihood of prevailing on any of the foregoing grounds with respect to any claim. IPR2014-01233, slip op. at 2, 8–12, 15–17, 18–21 (PTAB Feb. 10, 2015) (Paper 8) ("the 1233 Institution Decision" or "1233 Inst. Dec."). Specifically, the 1233 Institution Decision noted that the 1233 Petition did not address adequately certain limitations of the independent claims and improperly relied on incorporation by reference of explanation presented in a supporting declaration. *Id.* at 9–12, 15–20. The 1233 Institution Decision also found that the 1233 Petition did not address adequately certain limitations, because the 1233 Petition grouped certain limitations and discussed them collectively, without clearly explaining which of the cited references allegedly teach which claim limitations. *Id.* at 11, 16–17, 20.

To address the claim limitations that the 1233 Petition did not address adequately, the present Petition includes in the Petition itself explanation from a supporting declaration (Ex. 1010), rather than simply citing to a supporting declaration for that explanation, as the 1233 Petition did. *Compare* Pet. 13–17, 32–36, 48–51, *with* 1233 Pet. 20–23, 36–38, 49–52; *see* 1233 Inst. Dec. 10–12, 16–17, 19–20. Additionally, with respect to the claim limitations that the 1233 Petition inadequately addressed as a group, the present Petition addresses these claim limitations separately. *Compare* Pet. 14–17, 33–36, 49–51, *with* 1233 Pet. 20–23, 36–38, 50–52; *see* 1233

Inst. Dec. 11, 16–17, 20. Petitioner asserts that the "the Board declined to institute [the grounds presented in the 1233 Petition] on the basis that the evidence was not presented in the petition in the manner required by the rules" (Pet. 59) and contends that "this petition properly presents the prior art by identifying all of the prior art evidence within the four corners of the petition" (*id.* at 60).

By filing the present Petition, Petitioner effectively asks for a second chance at arguing unpatentability of the same claims that were challenged in the 1233 Petition based on the same combinations of prior art that were presented in the 1233 Petition. Petitioner filed the present Petition shortly after the 1233 Institution Decision was mailed, allowing Petitioner to use the 1233 Institution Decision as a guide for preparing the present Petition. Generally, these considerations weigh in favor of exercising our discretion under 35 U.S.C. § 325(d) to deny the Petition. *See, e.g.*, *Samsung Electronics, Co., Ltd. v. Rembrandt Wireless Techs., LP*, Case IPR2015-00118, slip op. at 6–7 (PTAB Jan. 28, 2015) (Paper 14); *CustomPlay, LLC v. ClearPlay, Inc.*, Case IPR2014-00783, slip op. at 8–9 (PTAB Nov. 7, 2014) (Paper 9); *Butamax Advanced Biofuels LLC v. Gevo, Inc.*, Case IPR2014-00581, slip op. at 12–13 (PTAB Oct. 14, 2014) (Paper 8).

Petitioner notes the provisions of § 325(d) and argues that "the Board should . . . give this petition due and full consideration." Pet. 59–60. Petitioner explains how the present Petition does not include the deficiencies that the 1233 Institution Decision identified in the 1233 Petition. *Id.* As discussed above, Petitioner's use of the guidance in the 1233 Institution Decision to improve the present Petition weighs in favor of exercising our discretion to deny the Petition, not in favor of granting the Petition.

Petitioner further asserts that the present Petition "is not filed for any improper purpose such as harassment or delay." *Id.* at 60. We do not find this a persuasive reason to allow a second bite at the apple on the same three grounds of unpatentability based on the same combinations of references that Petitioner presented in the 1233 Petition. Considering the totality of the facts before us, we exercise our discretion under § 325(d) to deny the Petition.

III. CONCLUSION

For the foregoing reasons, based on the circumstances of this case, we exercise our discretion under 35 U.S.C. § 325(d), and deny the Petition in this proceeding.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied as to claims 1–28 of the '311 patent.

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