

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

SILVER PEAK SYSTEMS, INC.,
Petitioner,

v.

RIVERBED TECHNOLOGY, INC.,
Patent Owner.

Case IPR2014-00128
Patent 8,271,688 B2

Before JUSTIN T. ARBES, FRANCES L. IPPOLITO, and
CHRISTOPHER M. KAISER, *Administrative Patent Judges.*

IPPOLITO, *Administrative Patent Judge.*

FINAL WRITTEN DECISION

35 U.S.C. § 318(a) and 37 C.F.R. § 42.73

I. INTRODUCTION

Petitioner Silver Peak Systems, Inc. filed a Petition to institute an *inter partes* review of claims 1–11 of U.S. Patent No. 8,271,688 B2 (“the ’688 patent”) pursuant to 35 U.S.C. §§ 311-319. Paper 3 (“Pet.”). Patent Owner Riverbed Technology, Inc. waived the Preliminary Response to the Petition. Paper 10. On May 2, 2014, we granted the Petition as to claims 1, 2, 5–9, and 11 of the ’688 patent, and instituted trial on one asserted ground of unpatentability. Paper 11 (“Dec. on Inst.”).

Subsequent to institution, Patent Owner filed a Motion to Amend, requesting the cancellation of all the claims involved in this *inter partes* review (i.e., claims 1, 2, 5–9, and 11 of the ’688 patent), such that after the cancellation Patent Owner would have no remaining claim in the trial. Paper 19 (“Mot. to Amend”).

The Board has jurisdiction under 35 U.S.C. § 6(c). This Decision is a final written decision under 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

Patent Owner’s Motion to Amend, requesting cancellation of claims 1, 2, 5–9, and 11, is granted.

A. *Related Proceedings*

The ’688 patent is the subject of federal district court proceedings in *Riverbed Technology, Inc. v. Silver Peak Systems, Inc.*, No. CV-13-2980 (N.D. Cal.). Pet. 1. Commonly-owned and related U.S. Patent No. 8,321,580 also is involved in this district court case and is the subject of an *inter partes* review designated IPR2014-00149. *Id.*

Additionally, commonly-owned and related U.S. Patents Nos. 7,428,573 (“the ’573 patent”) and 7,849,134 (“the ’134 patent”) are involved in *inter partes* reexaminations in which Petitioner is the third-party

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requestor.¹ Pet. 1. Both of these related patents also are the subject of federal district court proceedings in *Riverbed Technology, Inc. v. Silver Peak Systems, Inc.*, C.A. No. 11-484 (D. Del.). *Id.*

B. The Asserted Ground of Unpatentability

We instituted trial on the asserted ground that claims 1, 2, 5–9, and 11 of the '688 patent would have been obvious under 35 U.S.C. § 103(a) over Singh,² RFC 3135,³ and APA.⁴

II. MOTION TO AMEND

In its Motion to Amend, Patent Owner seeks to cancel all of the claims at issue in the instant proceeding, namely claims 1, 2, 5–9, and 11 of the '688 patent. Mot. to Amend. In email correspondence to Board administrative staff dated July 17, 2014 and July 18, 2014, counsel for Petitioner indicated that Petitioner does not oppose Patent Owner's Motion to Amend.⁵ Patent Owner's Motion to Amend, cancelling claims 1, 2, 5–9, and 11, is *granted*.

¹ Control Nos. 95/002,308 and 95/002,310, respectively. The '688 patent is a continuation of the '134 patent, which in turn is a continuation of the '573 patent. Ex. 1001, col. 1, ll. 8-15. The '688 patent is not the subject of either reexamination proceeding.

² U.S. Patent No. 6,856,651 B2 (issued Feb. 15, 2005) (Ex. 1004).

³ J. Border et al., *RFC 3135 – Performance Enhancing Proxies Intended to Mitigate Link-Related Degradations*, The Internet Society, Network Working Group (June 2001) (Ex. 1005).

⁴ Admitted Prior Art – Petitioner relies on statements made in the “Background of the Invention” section of the '688 patent as “describing work of others that is prior art to the '688 patent.” Pet. 10.

⁵ In the same email correspondence, counsel for Patent Owner and Petitioner indicated that neither party objects to the Board proceeding to judgment in the instant proceeding.

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Pursuant to 37 C.F.R. § 42.73(b), a party may request judgment against itself at any time during a proceeding. Cancellation of one or more claims, such that the patent owner has no remaining claim in the trial, is construed to be a request for adverse judgment. 37 C.F.R. § 42.73(b)(2). Here, Patent Owner requests cancellation of all claims of the '688 patent on which a trial was instituted, such that Patent Owner would have no remaining claim in the trial. Thus, it is appropriate to enter judgment at this time.

III. ORDER

For the reasons given, it is:

ORDERED that Patent Owner's Motion to Amend requesting cancellation of claims 1, 2, 5–9, and 11 of the '688 patent is treated as a request for adverse judgment and is *granted*;

FURTHER ORDERED that judgment is entered against Patent Owner with respect to claims 1, 2, 5–9, and 11 of the '688 patent; and

FURTHER ORDERED that because this is a final Decision, parties to the proceeding seeking judicial review of the Decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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