

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC.,  
Petitioner

v.

ORCKIT CORPORATION,  
Patent Owner.

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Case IPR2023-00554  
Patent No. 10,652,111

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**PATENT OWNER'S MOTION TO STAY REEXAMINATION**

## **I. STATEMENT OF RELIEF REQUESTED**

As authorized by the Board on December 21, 2023, Patent Owner Orckit Corporation (“Patent Owner”) respectfully moves under 35 U.S.C. § 315(d) and 37 C.F.R. § 42.122(a) to stay *Ex Parte* Reexamination No. 90/015,261 of U.S. Patent 10,652,111 filed by Petitioner Cisco Systems, Inc.’s (“Petitioner”). Patent Owner requests that the ’261 reexamination be stayed until a final written decision is entered in this proceeding.

## **II. PROCEDURAL HISTORY**

On February 21, 2023, Petitioner filed this IPR challenging claims of the ’111 Patent. The Board instituted this IPR on September 20, 2023. On July 20, 2023, Petitioner filed the ’261 Reexamination challenging many of the same claims of the ’111 Patent challenged in this IPR. No Office action has yet issued in the ’261 Reexamination. To avoid duplicative efforts by the Parties and the Patent Office and potentially inconsistent results, Patent Owner now respectfully moves to stay the ’261 Reexamination pending resolution of this IPR.

## **III. LEGAL STANDARD**

When another matter involving the same patent is pending before the United States Patent and Trademark Office, the Board may “stay, transfer, consolidat[e], or terminat[e] . . . any such matter or proceeding.” 35 U.S.C. § 315(d); *see also* 37 C.F.R. §§ 42.122(a), 42.3(a).

To obtain a stay of a reexamination, the party seeking the stay must show good cause. *See Fox Factory, Inc. v. SRAM, LLC*, IPR2017-01440, Paper 32 at 3 (PTAB June 4, 2018). The Board routinely finds good cause exists in circumstances such as those in this matter, where the IPR “is subject to statutory deadlines [and] is addressing the same or overlapping claims of [the] patent at issue in [the] parallel reexamination proceeding.” Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding (Notice Regarding Options for Amendments), 84 Fed. Reg. 16,654, 16,656 (Apr. 22, 2019); *see also id.* (good cause found where claims between reexamination and IPR overlapped); *Gnosis S.P.A., et al. v. Merck & CIE*, IPR2013-00117, Paper 10 at 2-3 (PTAB Apr. 3, 2013) (same); *CBS Interactive v. Helferich Patent Licensing*, IPR2013-00033, Paper 15 at 2 (PTAB Nov. 6, 2012) (same).

In determining whether good cause exists for staying a reexamination, the Board may consider the factors set out in the Notice Regarding Options for Amendments:

- (1) whether the claims challenged in the IPR are the same as or depend directly or indirectly from claims at issue in the reexamination;
- (2) whether the same grounds of unpatentability or the same prior art are at issue in both the IPR and the reexamination;

(3) whether simultaneous conduct of the reexamination and IPR will duplicate efforts within the Office;

(4) whether the reexamination could result in the inconsistent results with the IPR;

(5) whether amending the claim scope in one proceeding would affect claim scope in the other;

(6) the respective timelines and stages of each proceeding;

(7) the statutory deadlines of the reexamination and IPR; and

(8) whether a decision in the IPR would likely simplify issues presented in the reexamination or render it moot.

*See* 84 Fed. Reg. at 16,657 (collecting cases). As explained below, these factors collectively favor staying the '261 reexamination.

#### **IV. THE '261 REEXAMINATION SHOULD BE STAYED**

##### **A. Factor 1**

The instant IPR and the '261 reexamination challenge overlapping claims of the '111 Patent. For example, the instant IPR challenges claims 1-9, 12-24, 27-29, and 31 of the '111 Patent (in addition to claim 30). Likewise, the '261 reexamination also challenges claims 1-9, 12-24, 27-29, and 31 of the '111 Patent (in addition to other dependent claims of claims 1 and 32). Thus, the instant IPR and the '261 reexamination are certain to implicate multiple identical issues (such

as claim construction). Moreover, independent claim 1 at issue in both proceedings share much of the same claim language as the sole other independent claim (claim 32) challenged in the reexamination, including “packet network,” “network node,” “transporting packets between first and second entities under control of a controller that is external to the network node,” an “instruction,” a “criterion,” “a packet addressed to the second entity,” “if the packet satisfies the criterion,” and “responsive to the packet satisfying the criterion, sending the packet...to an entity that is included in the instruction and is other than the second entity.” It is anticipated that the Final Written Decision in this proceeding will touch on the constructions of these terms which will affect the disposition of the reexamination. In similar circumstances, the Board has found that where, as here, “there is some overlap in the claim language in the claims challenged [in the IPR and the reexamination], Factor 1 weights slightly in favor of granting the Motion to Stay.” *Samsung Elecs. Co., Ltd. et. al. v. POWER2B Inc.*, IPR2022-00334, Paper 26, at \*5-6 (PTAB Feb. 21, 2023).

## **B. Factor 2**

While the instant IPR and the '261 reexamination rely on different prior art (Lin, Shieh, and Swenson in the IPR; and Kasumoto, Quittek, Dolganow, and Huang in the reexamination), the Board has stayed reexaminations pending an IPR even when, as here, there was no overlap in the subject prior art. *See, e.g., Google*

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