

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

ORCKIT CORPORATION,
Patent Owner.

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

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

I. INTRODUCTION

Petitioner Cisco Systems, Inc. (“Petitioner”) respectfully submits that the Board should deny Orckit Corporation’s (“Patent Owner”) motion to stay *Ex Parte* Reexamination No. 90/015,261 (“the ’261 Reexamination”) involving U.S. Patent No. 10,652,111 (“the ’111 Patent”). The ’261 Reexamination should not be stayed because it involves different patentability arguments and different prior art than that raised in this IPR proceeding (“the ’554 IPR”). Indeed, when granting the ’261 Reexamination, the Office determined that the arguments and prior art in the two proceedings “are not the same or substantially the same.” Moreover, the ’261 Reexamination includes 27 claims of the ’111 Patent that are not challenged in the IPR; thus, resolution of the IPR will not resolve all issues in the reexamination.

Simply put, a stay of the ’261 Reexamination will not lead to greater efficiencies or reduce the resources required to complete these two proceedings. Patent Owner bases its stay request largely on speculation about potential claim construction or possible conflicting decisions in the two proceedings. But these arguments are just that – speculation. Taken to their extreme, Patent Owner’s arguments would dictate that a reexamination proceeding is always stayed when there is a co-pending IPR. That is inconsistent with Patent Office regulations.

Patent Owner’s motion should be denied.

II. LEGAL STANDARD

35 U.S.C. § 315(d) states that “during the pendency of an inter partes review, if another proceeding or matter involving the [same] patent is before the Office, the Director may ... stay, transfer, consolidate[e], or terminat[e]” the other proceeding or matter. *See* 37 C.F.R. § 42.122(a). The party seeking a stay “carries the burden of persuasion” and must show good cause for the stay. *Arctic Cat, Inc. v. Polaris Indus., Inc.*, IPR2015-01781, -01783, Paper 78 at 2 (PTAB Sept. 25, 2018); *see* 37 C.F.R. § 42.20(c). In determining whether good cause exists, the Board utilizes eight guiding factors (discussed individually below) and makes a decision based on the totality of the circumstances. *See* 84 Fed. Reg. 16,654, 16,656-57 (Apr. 22, 2019).

III. THE '261 REEXAMINATION SHOULD NOT BE STAYED

The totality of the circumstances demonstrates that a stay of the '261 Reexamination is not warranted. At least Factors 1-5 and 8 weigh against a stay because the '261 Reexamination involves 27 additional claims, different patentability arguments and different prior art as compared to the '554 IPR. Factor 6 is neutral, and Factor 7 weighs, at most, slightly against a stay.

A. FACTOR 1

Factor 1 relates to “[w]hether the claims challenged in the [IPR] are the same as or depend directly or indirectly from claims at issue in the [reexamination].” *See* 84 Fed. Reg. at 16,656-57. This factor disfavors a stay because **27 out of the 54 total claims involved in the '261 Reexamination proceeding (i.e., 50% of the claims)**

are not challenged in the '554 IPR. The '261 Reexamination was granted on Claims 1-54 of the '111 Patent, whereas the '554 IPR challenges only Claims 1-9, 12-24 and 27-31 of that patent. *See* EX1014; Paper 1. Thus, Claims 10-11, 25-26 and 32-54 of the '111 Patent are involved in the reexamination but not the IPR.

Claims 10-11 and 25-26 recite subject matter that is not claimed in any of the challenged claims in the '554 IPR, including sending the packets to an application server for analysis, utilizing a specific OpenFlow protocol version, or providing an instruction with a Type-Length-Value (TLV) structure. EX1001, Cols. 11:45-54, 12:46-50. In addition, Claims 32-54 do not depend directly or indirectly from any challenged claims in the '554 IPR. *Id.*, Cols. 13:8-14:60. Thus, the '261 Reexamination will involve different analysis than the '554 IPR. As the PTAB explained in *Arctic Cat*, “a stay of the reexamination proceedings would not promote consistency with regard to the added claims, because the proceedings at hand [e.g., the IPR] will not address those [additional] claims.” IPR2015-01781, Paper 78 at 4. Indeed, a stay “would be a waste of resources because action with regard to the new claims would not be completed” by a Final Written Decision in the IPR. *Id.*

Patent Owner argues that the additional claims at issue in the '621 Reexamination are of no import because (1) some of the additional claims have similar limitations to those involved in the '554 IPR and (2) the '554 IPR may “touch on” claim constructions that will affect the disposition of the '261 Reexamination.

Paper 20 at 3-4. Patent Owner is wrong. First, as discussed above, some of the additional claims in the '261 Reexamination recite additional limitations that are not at issue in claims of the '554 IPR. Second, the claim construction argument is a red herring because reexaminations and IPRs use different claim construction standards (broadest reasonable construction vs. ordinary and customary meaning). Further, Patent Owner's claim construction argument is speculative because the Board determined that no claim construction was necessary in its Institution Decision in the '554 IPR (Paper 8 at 12), and the Office provided no claim construction in granting the '261 Reexamination. EX1014. Moreover, while Patent Owner raised a claim construction argument for a "controller" in its Patent Owner Response, Patent Owner conceded that "it is not necessary for the Board to choose between the two competing constructions of 'controller'" because the patentability analysis does not "turn on the Board resolving the parties' dispute concerning the construction of 'controller.'" Paper 22 at 16-17. Thus, it is not expected that the Board will issue any constructions because the Board only construes terms if necessary to resolve a controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). Factor 1 weighs against a stay.

B. FACTOR 2

Factor 2 relates to "[w]hether the same grounds of unpatentability or the same prior art are at issue in both proceedings." *See* 84 Fed. Reg. at 16,656-57. This factor

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.