

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

ORCKIT CORPORATION,
Patent Owner.

IPR2023-00554
Patent 10,652,111 B2

Before KRISTEN L. DROESCH, NATHAN A. ENGELS, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

ORDER
Granting Stay of Reexamination
35 U.S.C. § 315(d)

I. INTRODUCTION

With our authorization, Patent Owner filed a Motion to Stay *Ex Parte* Reexamination No. 90/015,261 of U.S. Patent 10,652,111 B2 in view of the presently instituted *inter partes* review of the same patent. Paper 20 (“Motion” or “Mot.”). We instituted review in September 2023. Paper 8. Petitioner filed an Opposition to the Motion. Paper 24 (“Opp.”).

For the reasons discussed below, we determine that it is appropriate to stay the ’261 Reexamination, pending resolution of the instant IPR.

II. LEGAL STANDARDS

The Board may enter an order staying a reexamination proceeding. 37 C.F.R. § 42.122(a); *see also* 35 U.S.C. § 315(d); 37 C.F.R. § 42.3(a) “[T]he Board ordinarily will stay a [reexamination] where good cause exists.” *Notice Regarding Options for Amendments by Patent Owner Through Reissue or Reexamination During a Pending AIA Trial Proceeding*, 84 Fed. Reg. 16654, 16,656 (Apr. 22, 2019) (“Notice”). “Good cause for staying a case may exist if, for example, an on-going [IPR] proceeding, which is subject to statutory deadlines, is addressing the same or overlapping claims of a patent at issue in [the reexamination].” *Id.*

The Board may consider several factors when deciding whether to stay a reexamination, including:

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 conducting the reexamination and IPR will duplicate efforts within the Office;

4. whether the reexamination could result in inconsistent results between proceedings;
5. whether amending the claim scope in one proceeding would affect the claim scope in another proceeding;
6. the respective timeline and stage of each proceeding;
7. the statutory deadlines of the reexamination and IPR; and
8. whether a decision in one proceeding would likely simplify issues in the concurrent parallel Office proceeding or render it moot.

See id. at 16,657.

III. ANALYSIS

We now analyze the facts in view of the above factors.

1. *Challenged Claims*

On October 18, 2023 a request for *ex parte* reexamination of claims 1–54 of the '111 patent was granted. Ex. 1014, 3–4. The Petition in the present IPR challenges claims 1–9, 12–24 and 27–31. Pet. 1.

Claims 10, 11, 25, and 26 all depend from claims challenged in the Petition. Ex. 1001, 11:45–54, 12:46–50. Claim 32 is an independent claim and claims 33–54 depend therefrom. *Id.* at 13:8–14:60.

As the Reexamination includes all of the claims involved in the IPR, and only one other independent claim, this weighs in favor of a stay.

2. *Grounds*

The Parties both agree that the grounds in the Reexamination and IPR are different. Mot. 4–5; Opp. 5; *see also* Ex. 1014, 15–16 (Action granting reexamination determining that that the prior art and arguments presented in the request for *ex parte* reexamination are not the same as those in the present IPR). This weighs against a stay.

3. *Duplicative Effort*

Because both cases are in the early stages, it is difficult to determine to what extent there would be duplication of effort between the two cases. It is clearly possible that there could be issues relevant to both cases, even with the different grounds, such as claim construction. However, this would be largely speculative. Thus, other than the overlap in claims which has already been considered above, this factor is negligible.

4. *Amendments*

Petitioner acknowledges that Patent Owner may yet attempt to amend the claims in the reexamination. Opp. 8–9. Such an amendment in the reexamination would affect the claim scope in the IPR. Accordingly, this factor favors a stay.

5, 6. *Timeline and Statutory Deadlines*

The Reexamination is still at an early stage with no office action yet entered. Opp. 9. The IPR is somewhat further advanced because Patent Owner’s Response (Paper 22) has been filed and the parties have been conducting discovery (*see e.g.*, Paper 17). If requested, oral argument in the IPR will be conducted on July 9, 2024. Paper 9, 11.

Applying the Board’s deadlines under 35 U.S.C. § 316(a)(11), we expect to issue a final written decision on the IPR on or before September 20, 2024. Although reexaminations are conducted with “special dispatch,” they are not subject to specific deadlines. 35 U.S.C. § 305.

We find that these factors favor a stay.

7. *Simplification*

A final determination in this IPR regarding the patentability of the challenged claims of the ’111 patent could simplify issues for the Reexamination given the substantial overlap in the claims at issue.

Conversely, the issuance of a reexamination certificate in the Reexamination before a final decision in this proceeding could simplify or render moot this proceeding. *See M&P Golf, LLC v. Max Out Golf, LLC*, IPR2016-00784, Paper 43 (PTAB Aug. 30, 2017) (Final Written Decision) (entering judgment against Patent Owner as to original claims when Patent Owner amended each of those claims in a reexamination, and the reexamination certificate had issued). However, considering the current stages of the proceedings and the ordinary timeline for reexaminations, that eventuality is unlikely.

This factor favors a stay.

IV. CONCLUSION

Altogether, we find that the above factors weigh in favor of staying the Reexamination. For the reasons discussed above, we grant Patent Owner's motion to stay the Reexamination.

V. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, Patent Owner's motion to stay *Ex Parte* Reexamination No. 90/015,261 is *granted*; and

FURTHER ORDERED that the Reexamination is stayed pending termination of IPR2023-00554;

FURTHER ORDERED that this stay tolls all time periods for filing further papers in the Reexamination, and no further papers will be filed or issued from the Office while this stay remains in place.

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