

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF TEXAS
MARSHALL DIVISION**

ORCKIT CORPORATION,

Plaintiff,

v.

CISCO SYSTEMS, INC.,

Defendant.

Civil Action No. 2:22-CV-00276-JRG

JURY TRIAL DEMANDED

DEFENDANT'S FIRST AMENDED INVALIDITY CONTENTIONS

Pursuant to Local Patent Rule 3-3 and the Court's First Amended Docket Control Order (D.I. 45), Cisco Systems, Inc. ("Cisco") hereby sets forth its First Amended Invalidity Contentions concerning U.S. Patent Nos. 6,680,904 ("the '904 Patent"), 7,545,740 ("the '740 Patent"), 8,830,821 ("the '821 Patent"), and 10,652,111 ("the '111 Patent") (collectively, the "Asserted Patents"). Plaintiff Orckit Corporation ("Orckit") has asserted claims 1–26 of the '904 Patent, claims 1–31 of the '740 Patent, claims 1–20 of the '821 Patent, and claims 1–9, 12–24, and 27–31 of the '111 Patent (collectively, the "Asserted Claims"). Cisco contends that each of the Asserted Claims is invalid under at least one or more of 35 U.S.C. §§ 101, 102, 103, and 112.

I. SCOPE OF THESE FIRST AMENDED INVALIDITY CONTENTIONS

These First Amended Invalidity Contentions: (i) identify each prior art reference Cisco is currently aware of that either anticipates or renders obvious one or more of the Asserted Claims; (ii) specify whether each such reference anticipates or renders obvious the applicable claims, and in the event a combination with one or more other such references renders obvious the applicable claims, identify each such combination and the motivation to combine such references; (iii) include charts, for illustrative prior art references, citing exemplary disclosures in those references that

Orckit Exhibit 0014

anticipate or render obvious each of the elements of the applicable claims; and (iv) identify grounds for invalidating asserted claims based on indefiniteness, enablement, lack of patentable subject matter, improper inventorship, or written description or based on lack of disclosed structure under 35 U.S.C. § 112¹. These contentions relate only to invalidity, and do not include any contention or position beyond the issue of invalidity (*e.g.*, non-infringement or claim construction).

Cisco's discovery and investigation in this lawsuit is ongoing, and these contentions are based only on the information Cisco has obtained to date. For example, Cisco has not had the opportunity to conduct third party discovery relating to various third-party prior art and expressly reserves the right to amend these contentions subject to third party discovery. These third parties may include, without limitation, the authors, inventors, or assignees of the prior art publications identified in these contentions. Cisco also reserves the right to amend the contentions due to Orckit's failure to produce prior art known to it, including prior art identified by its own investigations, other accused infringers or third parties as to the Asserted Patents or related patents. Cisco reserves its right to supplement and/or amend its First Amended Invalidity Contentions consistent with the Federal Rules of Civil Procedure, the Local Rules, and any orders from the Court.

These First Amended Invalidity Contentions are based upon Cisco's present understanding of the Asserted Claims, Orckit's November 3, 2022 Disclosure of Asserted Claims and Infringement Contentions Pursuant to P.R. 3-1, and Orckit's January 19, 2023 First Amended Disclosure of Asserted Claims and Infringement Contentions Pursuant to P.R. 3-1 (Orckit's

¹ The '904 Patent, '740 Patent, and '821 Patent were all filed and claim priority before September 16, 2011, and thus pre-AIA sections of 35 U.S.C. apply to them. The '111 Patent was filed after September 16, 2011, and Orckit claims a priority date after September 16, 2011, so AIA sections of 35 U.S.C. apply to the '111 patent. Unless stated otherwise, Cisco's First Amended Contentions refer to pre-AIA or AIA statutes consistent with that understanding.

“Infringement Disclosures”). Cisco does not concede that any (apparent) claim constructions are correct. Even though Cisco contends that all of the Asserted Claims are indefinite, Cisco has disclosed which prior art references render those claims invalid based upon Orckit’s contention that those claims are definite. Cisco’s assertion of prior art is not a concession as to the meaning, definiteness, written description support for, or enablement of any of the Asserted Claims, or that the Asserted Patents properly claim patent eligible subject matter. If Orckit amends its Infringement Disclosures, Cisco reserves the right to amend its First Amended Invalidity Contentions, and Cisco notes that Orckit’s Infringement Disclosures failed to provide sufficient notice of Orckit’s infringement theories as required by the Local Rules. Indeed, Cisco served Orckit correspondence explaining how Orckit’s Infringement Disclosures were deficient on November 16, 2022 and on December 2, 2022, and Cisco met and conferred with Orckit’s counsel to explain these deficiencies in more detail.

Cisco takes no position on any matter of claim construction in its First Amended Invalidity Contentions. Any statement herein describing or tending to describe any claim element is provided solely for the purpose of understanding the relevant prior art. Cisco expressly reserves the right to propose any claim construction it considers appropriate and/or to contest any claim construction it considers inappropriate. Moreover, Cisco’s First Amended Invalidity Contentions are sometimes made in the alternative based upon Orckit’s allegations and should be viewed accordingly. Further, by including in this disclosure prior art that would be anticipatory or render a claim obvious based on a particular scope or construction of the claims, Cisco’s First Amended Invalidity Contentions herein are not, and should in no way be seen as, adoptions or admissions as to the accuracy of such scope or construction. The Court has not yet construed the Asserted Claims, and

Cisco reserves the right to amend these First Amended Invalidity Contentions in accordance with P.R. 3-3, including after the issuance of the Court's claim construction order.

Additionally, Cisco reserves the right to amend its First Amended Invalidity Contentions in light of additional discovery and developments in this case. For example, to date, Orckit has produced 368 documents and discovery is still in its infancy. Cisco expressly reserves the right to amend its First Amended Invalidity Contentions after the production of any additional documents, the production of additional source code, the production of additional financial data, and after depositions are conducted. Both parties have also served subpoenas on third-party companies and are currently engaged in third-party discovery with respect to Cisco's disclosed prior art systems. Cisco expressly reserves the right to amend its First Amended Invalidity Contentions with respect to information received in response to the parties' subpoenas.

II. ORCKIT'S ALLEGED PRIORITY DATES

Orckit contends that the '904 Patent has a priority date of December 27, 1999, that the '740 Patent has a priority date of April 7, 2006, that the '821 Patent has a priority date of June 22, 2011, and that the '111 Patent has a priority date of April 22, 2014. *See* Orckit's Infringement Disclosures at 3–4. Cisco contends that the Asserted Patents can only claim priority to their respective filing dates of the earliest filed non-provisional application. In other words, the earliest possible priority date for the '904 Patent is its filing date of December 27, 1999, the earliest possible priority date for the '740 Patent is its filing date of April 7, 2006, the earliest possible priority date for the '821 Patent is its filing date of December 5, 2011, and the earliest possible priority date for the '111 Patent is its filing date of April 21, 2015.

With respect to the '821 and '111 Patents, Orckit has not met its burden to demonstrate that these patents should be entitled to an earlier priority date than their filing dates.² Pursuant to Local Patent Rule 3-2(b), Orckit is required to disclose “[a]ll documents evidencing the conception, reduction to practice, design, and development of each claimed invention, which were created on or before the date of application for the patent in suit” Orckit’s Infringement Disclosures concede that Orckit has not identified any evidence corroborating a conception date earlier than the filing dates of the '821 or '111 Patents:

II. Production Numbers

Orckit identifies its accompanying document production below.

Category of Documents	Production Range
Local Patent R. 3-1(f)	Plaintiff Orckit Corporation has never made any products.
Local Patent R. 3-2(a)	As of the date of this disclosure, Orckit has not located any documents that would fall into this category.
Local Patent R. 3-2(b)	As of the date of this disclosure, Orckit has not located any documents that would fall into this category.

Orckit’s Infringement Disclosures at 4 (annotation added).

Orckit appears to claim priority to the provisional applications of the '821 and '111, but neither application supports priority of those patents because the provisional applications of the '821 and '111 patents do not disclose each limitation of any claim of the '821 or '111 patents.

For example, the provisional application of the '821 Patent does not set forth an adequate written description or enable the claim scope alleged by Orckit of at least the following claim limitations: “determining an overall cost for each entity pair of said plurality of entities”;

² Orckit’s Infringement Disclosures treat the priority dates of the Asserted Patents as a whole, and Orckit does not forward any claim-by-claim priority analysis.

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