

**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

CISCO’S PRELIMINARY SUBJECT MATTER ELIGIBILITY CONTENTIONS

Pursuant to the Court’s Standing Order Regarding Subject Matter Eligibility Contentions Applicable to All Patent Infringement Cases Assigned to Chief District Judge Rodney Gilstrap and the Court’s First Amended Docket Control Order (D.I. 46), Defendant Cisco Systems, Inc. (“Cisco”) hereby sets forth its Preliminary Eligibility Contentions concerning U.S. Patent Nos. 7,545,740 (“the ’740 Patent”), 8,830,821 (“the ’821 Patent”), and 10,652,111 (“the ’111 Patent”) (collectively, the “Ineligible Patents”). Plaintiff Orckit Corporation (“Orckit”) has asserted 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 Asserted Claim is invalid under 35 U.S.C. § 101, among other statutes, because the Asserted Claims are directed to abstract ideas, do not include an inventive concept, and do not claim patent eligible subject matter.

Orckit Exhibit 0020

Among the Asserted Claims, Cisco contends that the following claims are representative of the Asserted Claims for purposes of these Subject Matter Eligibility Contentions:

Patent	Representative Claims	Represented Asserted Claims	Abstract Idea	Chart
'740 Patent	Claim 17	1–31	Selecting two parts of a communications path based on the same computation	A-1
'821 Patent	Claim 1	1–20	Selecting and reselecting a pair of communications paths based on cost	A-2
'111 Patent	Claim 1	1–9, 12–24, and 27–31	Routing data based on information received from a controller	A-3

I. SCOPE OF THESE PRELIMINARY SUBJECT MATTER ELIGIBILITY CONTENTIONS

These Preliminary Subject Matter Eligibility Contentions: (i) identify each exception to eligibility to which each Representative Claim (and by extension Asserted Claim) is directed, including Cisco's supporting factual and legal bases; (ii) describe the industry in which the Representative Claims (and by extension Asserted Claims) are alleged to be well understood, routine, and conventional, including Cisco's supporting factual and legal bases; (iv) describe why each Representative Claim (and by extension Asserted Claim) was well understood, routine, and conventional in the relevant industry, including Cisco's supporting factual and legal bases; and (v) provide Cisco's other factual and legal bases for its contention that the Representative Claims (and by extension Asserted Claims) are invalid under 35 U.S.C. § 101. These contentions relate only to subject matter eligibility, and do not include any contention or position beyond this issue (*e.g.*, other forms of invalidity, non-infringement, or claim construction).

Cisco's discovery and investigation in this lawsuit is ongoing, and these contentions are based on the information Cisco has obtained to date. Cisco reserves the right to supplement and/or amend its Preliminary Eligibility Contentions consistent with the Federal Rules of Civil Procedure,

the Local Rules, and any orders from the Court, including after the Court issues any Claim Construction Order.

These Preliminary Eligibility 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 "Infringement Disclosures"). Cisco does not concede that any of Orckit's (apparent) claim constructions are correct. If Orckit amends its Infringement Disclosures, Cisco reserves the right to update its Preliminary Eligibility Contentions.

II. ORCKIT'S ALLEGED PRIORITY DATES

Orckit contends 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 Ineligible Patents can only claim priority to the respective filing dates of the earliest filed non-provisional application. In other words, 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.¹ 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

¹ Orckit's Infringement Disclosures treat the priority dates of the Ineligible Patents as a whole, and Orckit does not forward any claim-by-claim priority analysis.

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”; “selecting an entity pair from said plurality of transport entities based at least in part upon said overall cost; and”; “if an entity pair reselection event occurs, reselecting said entity pair from the group consisting of said entity pair and a replacement entity pair comprising at least one entity distinct from the entities of said entity pair”; “wherein said entity pair reselection event is selected from a group consisting of adding an entity to said plurality of transport entities, removing an entity from said plurality of transport entities, an operational status change for one of said plurality of transport entities, and a change in overall cost for one of said plurality of transport entities”;

“digital logic configured to select said working entity and said protection entity from said plurality of transport entity descriptors, comprising: logic configured to determine a probability of concurrent failure of said working entity and said protection entity”; “logic configured to determine an entity cost of said plurality of transport entity descriptors”; and “wherein said reselection event is selected from a group consisting of adding an entity to said plurality of transport entities, removing an entity from said plurality of transport entities, an operational status change for one of said plurality of transport entities, and a change in overall cost for one of said plurality of transport entities.”

For example, the provisional application of the '111 Patent does not set forth an adequate written description or enable the claim scope alleged by Orkit of at least the following claim limitations: “controller,” “instruction,” “sending, by the controller to the network node over the packet network, an instruction and a packet-applicable criterion”; “responsive to the packet not satisfying the criterion, sending, by the network node over the packet network, the packet to the second entity”; “responsive to the packet satisfying the criterion, sending the packet, by the network node over the packet network, to an entity that is included in the instruction and is other than the second entity”; “receiving, from the controller, the instruction and the criterion”; “checking if the packet satisfies the criterion; responsive to the packet not satisfying the criterion, sending over the packet network, the packet to the second entity”; and “responsive to the packet satisfying the criterion, sending the packet over the packet network, to an entity that is included in the instruction and is other than the second entity.”

III. FACTUAL AND LEGAL BASES FOR SUBJECT MATTER ELIGIBILITY CONTENTIONS

Cisco contends that the Representative Claims (and by extension Asserted Claims) are invalid under 35 U.S.C. § 101 because they are directed to abstract ideas and none of the elements,

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