

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.,
Petitioner,

v.

ORCKIT CORPORATION,
Patent Owner.

IPR2024-00037
Patent 10,652,111 B2

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

DOUGAL, *Administrative Patent Judge*.

DECISION

Granting Institution of *Inter Partes* Review
35 U.S.C. § 314, 37 C.F.R. § 42.4

Granting Motion for Joinder
35 U.S.C. § 315(c); 37 C.F.R. § 42.122

I. INTRODUCTION

A. Background

Juniper Networks, Inc. (“Petitioner”) filed a Petition requesting *inter partes* review (“IPR”) of claims 1–9, 12–24, and 27–31 of U.S. Patent No. 10,652,111 B2 (Ex. 1001, “the ’111 Patent”). Paper 3 (“Pet.”). Petitioner also filed a Motion for Joinder seeking to be joined as a party to *Cisco Systems, Inc., v. Orckit Corp.*, IPR2023-00554 (“Cisco IPR”). Paper 2 (“Motion” or “Mot.”). Orckit Corporation (“Patent Owner”) did not file a preliminary response or an opposition to the Motion.

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). For the reasons provided below, we determine that institution of *inter partes* review is warranted on the same grounds instituted in the Cisco IPR, and we grant Petitioner’s Motion for Joinder.

B. Related Matters

The parties identify the following related District Court proceedings: *Orckit Corporation v. Juniper Networks, Inc.*, No. 1:23-cv-00822 (D. Del.); *Orckit Corporation v. Cisco Systems, Inc.*, No. 2:22-cv-00276 (E.D. Tex.); and *Orckit Corporation v. Arista Networks, Inc.*, No. 1:23-cv-00821 (D. Del.). Pet. x; Paper 7, 1. Patent Owner also identifies *Ex Parte* Reexamination No. 90/015,261. Paper 7, 1.

C. Prior Art and Asserted Grounds

In the Cisco IPR, we instituted an *inter partes* review of the challenged as unpatentable on the following grounds:

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–9, 12–24, 27–31	103	Lin ¹ , Swenson ²
1, 5–9, 12–24, 27–30	103	Shieh ³ , Swenson

See Cisco IPR, Paper 8, 5 (PTAB Sept. 20, 2023) (“Cisco Dec.”).

II. INSTITUTION OF *INTER PARTES* REVIEW

The Petition in this proceeding asserts the same grounds of unpatentability as the ones on which we instituted review in the Cisco IPR. *Compare* Pet. 2, with Cisco Dec. 5. Indeed, Petitioner contends that the present Petition and the Cisco IPR Petition are substantively identical with respect to the asserted ground, based on the same prior art combination and supporting evidence, and asserted against the same claims. Mot. 4–5. This includes relying on the same expert declaration as the Cisco IPR. *Id.* at 5.

Patent Owner did not file a Preliminary Response.

For the same reasons set forth in our institution decision in the Cisco IPR, we determine that Petitioner has shown a reasonable likelihood that at least one claim is unpatentable. We therefore institute trial as to all challenged claims on all grounds stated in the Petition.

¹ US 9,264,400 B1, iss. Feb.16, 2016 (Ex. 1005) (“Lin”).

² US 2013/0322242 A1, pub. Dec. 5, 2013 (Ex. 1007) (“Swenson”).

³ US 2013/0291088 A1, pub. Oct. 31, 2013 (Ex. 1006) (“Shieh”).

III. MOTION FOR JOINDER

Joinder for purposes of an *inter partes* review is governed by 35 U.S.C. § 315(c), which states:

If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an *inter partes* review under section 314.

As the moving party, Petitioner bears the burden of proving that it is entitled to the requested relief. 37 C.F.R. § 42.20(c). A motion for joinder should: set forth the reasons joinder is appropriate; identify any new grounds of unpatentability asserted in the petition; and explain what impact (if any) joinder would have on the trial schedule for the existing review. *See Kyocera Corp. v. Softview LLC*, IPR2013-00004, Paper 15 at 4 (PTAB Apr. 24, 2013).

Petitioner timely filed the Motion no later than one month after institution of the Cisco IPR. *See* 37 C.F.R. § 42.122(b). As noted, the Petition in this case asserts the same unpatentability grounds on which we instituted review in the Cisco IPR. *See* Mot. 4–5. Petitioner also relies on the same prior art analysis and expert testimony submitted by the Cisco petitioner. *See id.* at 5. Indeed, the Petition is nearly identical to the petition filed by the Cisco petitioner. *See id.* Thus, this *inter partes* review does not present any ground or matter not already at issue in the Cisco IPR. *Id.*

If joinder is granted, Petitioner agrees to assume an “‘understudy’ role” and agrees that this role shall apply unless the Cisco petitioner ceases to participate in the instituted IPR. *Id.* at 6–7. Petitioner further represents

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that it will not advance any arguments separate from those advanced by the Cisco petitioner in the consolidated filings. *Id.* Because Petitioner expects to participate only in a limited capacity, Petitioner submits that joinder will not impact the trial schedule for the Cisco IPR. *Id.* at 5.

Patent Owner did not file an Opposition to the Motion for Joinder.

Based on the above, we determine that joinder with the Cisco IPR is appropriate under the circumstances. Accordingly, we grant Petitioner's Motion for Joinder.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that, pursuant to 35 U.S.C. § 314(a), an *inter partes* review of claims 1–9, 12–24, and 27–31 of the '111 Patent is instituted;

FURTHER ORDERED that the Motion for Joinder with IPR2023-00554 is granted;

FURTHER ORDERED that IPR2024-00037 is joined with IPR2023-00554, pursuant to 37 C.F.R. §§ 42.72, 42.122, wherein Petitioner will maintain a secondary role in the proceeding, unless and until the current IPR2023-00554 petitioners cease to participate as a petitioner in the *inter partes* review;

FURTHER ORDERED that all future filings in the joined proceeding are to be made only in IPR2023-00554;

FURTHER ORDERED that the case caption in IPR2022-00554 shall be changed to reflect the joinder in accordance with the below example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the record of IPR2023-00554.

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