

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.,
Petitioner,

v.

ORCKIT CORPORATION,
Patent Owner.

IPR2024-00034
Patent 8,830,821 B2

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

DROESCH, *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 1–20 of U.S. Patent No. 8,830,821 B2 (Ex. 1001, “the ’821 Patent”). Paper 3 (“Pet.”). Petitioner filed a Declaration of Henry Houh, Ph.D., with its Petition. Ex. 1003. Petitioner also filed a Motion for Joinder seeking to be joined as a party to *Cisco Systems, Inc., v. Orckit Corp.*, IPR2023-00402 (“Cisco IPR”), which involves the same claims of the ’821 Patent, and for which an *inter partes* review was instituted on September 12, 2023. Paper 2 (“Motion” or “Mot.”); *see also* IPR2023-00402, Paper 11. 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

Patent Owner identifies the following related 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.). Paper 5, 1.

C. The ’821 Patent (Ex. 1001)

The ’821 Patent “relates to telecommunications and more particularly, is related to high availability of telecommunication entities.” Ex. 1001,

1:16–19. “[W]hen a failure is detected in a network device or connection, network traffic is switched to a standby network device or connection.”

Id. at 1:27–29. A multiprotocol label switching-transport profile (MPLS-TP) accomplishes a node or span failure recovery by defining a second transport entity by defining a protection entity between the same endpoints as the working transport entity. *See id.* at 1:38–49. “[These] working and protection entities do not share the span or nodes against whose failure protection is required” (*id.* at 1:50–51), but “may not protect against one or several failures affecting both [entities]” (*id.* at 1:64–66). Thus, “there is a need for a protection mechanism to provide . . . recovery in the event of a failure in any of the transport entities.” *Id.* at 2:1–3.

The ’821 Patent discloses

an entity selection method by an MPLS network device
. . . [that] provid[es] a plurality of MPLS transport entities
between a first endpoint and a second endpoint, determin[es] an
overall cost for each pair of entities of the plurality of entities,
select[s] a pair of entities from the plurality of transport entities
based at least in part upon the entity pair cost, and[,] if an entity
pair reselection event occurs, reselect[s] the entity pair.

Ex. 1001, 2:9–18. “The method . . . may further include . . . selecting a working entity from the plurality of transport entities, selecting a protection entity from the plurality of transport entities, and selecting an active entity from the set consisting of the working entity and the protection entity.” *Id.* at 2:22–26.

Figure 1 of the '821 Patent is reproduced below.

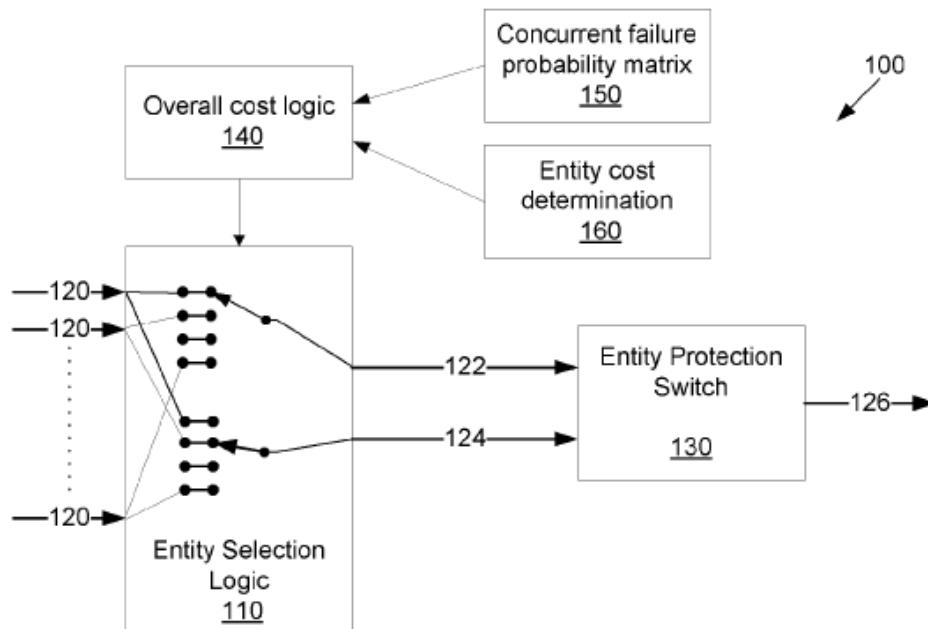


Figure 1 depicts “a block diagram of a first exemplary embodiment of an entity protection system.” Ex. 1001, 2:59–60. “An entity protection switch 130 switches between a working entity 122 and a protection entity 124[, which are] from a set of entities 120 . . . represented within an entity selection logic block 110.” *Id.* at 3:33–36. “Each entity 120 represents a network route between a first endpoint and a second endpoint.” *Id.* at 3:36–37. “An overall cost logic block 140 uses results from a concurrent failure probability matrix 150 and an entity cost determination block 160 to select the working entity 122 and the protection entity 124 from the set of entities 120.” *Id.* at 3:40–44. “[A] pair having multiple spans and/or nodes in common may be more likely to simultaneously fail than a pair having no spans or nodes in common.” *Id.* at 3:47–50.

“Each possible entity pairing is examined for cost.” Ex. 1001, 4:13. “The overall cost may be determined based on the probability of simultaneous failure of the working and protection entities (SFP), . . . the

entity cost, or a combination of SFP and entity cost.” *Id.* at 4:16–19.

“[E]ach entity of the selected entity pair may be selected as a working entity, a protection entity, or an active entity.” *Id.* at 4:30–32. “[E]ntity pair reselection may be triggered when the operational status changes for an entity . . . , when an entity is added . . . , when an entity is removed . . . , or due to combined cost changes in one or more entities.” *Id.* at 4:35–40.

“[An] entity pair may be selected based upon each entity of the pair having the lowest possible probability of individual failure.” Ex. 1001, 5:42–43. “Alternatively, the entity pair may be selected to minimize the probability of a span or node failure simultaneously affecting the working and protection entities, as shown by block 440.” *Id.* at 5:44–46. “An example [approach] would be to minimize SFP . . . by selecting working and protection entity pairs with the lowest SFP, and, if there are multiple pairs with the same SFP within an error margin, . . . choosing the pair that minimizes entity . . . cost [under an interior gateway protocol metric.]” *Id.* at 5:59–66.

D. Illustrative Claim

Claims 1, 14, and 17 are independent, and claims 2–13, 15, 16, and 18–20 depend directly or indirectly therefrom, respectively. *See* Ex. 1001, 7:48–10:20. Claim 1 is reproduced below:

1. An entity selection method performed by a network device, comprising the steps of:
providing a plurality of multi protocol label switching (MPLS) transport entities between a first endpoint and a second endpoint;
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.

Id. at 7:48–67.

E. Asserted Patentability Challenges and Asserted Prior Art

Petitioner asserts that claims 1–20 are unpatentable on the following grounds (Pet. 2):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–7, 9–11, 13, 17–20	103(a) ¹	Doshi, ² Guichard ³
8, 12	103(a)	Doshi, Guichard, Huang ⁴
14–16	103(a)	Doshi, Guichard, Xu ⁵

II. ANALYSIS

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

JOINDER.—If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party

¹ The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011), amended 35 U.S.C. § 103 effective March 16, 2013. Because the '821 Patent claims an effective filing date prior to March 16, 2013, we refer to the pre-AIA version of § 103.

² US 2004/0205239 A1, published Oct. 14, 2004 (Ex. 1005).

³ Guichard et al., *Definitive MPLS Network Designs*, Cisco Press, Indianapolis, IN, 2005 (ISBN: 1-58705-186-9) (Ex. 1006).

⁴ US 2003/0117950 A1, published June 26, 2003 (Ex. 1007).

⁵ US 2011/0141877 A1, published June 16, 2011 (Ex. 1025).

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.

“To join a party to an instituted [*inter partes* review (IPR)], the plain language of § 315(c) requires two different decisions.” *Facebook, Inc. v. Windy City Innovations, LLC*, 973 F.3d 1321, 1332 (Fed. Cir. 2020). “First, the statute requires that the Director (or the Board acting through a delegation of authority . . .) determine whether the joinder applicant’s petition for IPR ‘warrants’ institution under § 314.” *Id.* “Second, to effect joinder, § 315(c) requires the Director to exercise [her] discretion to decide whether to ‘join as a party’ the joinder applicant.” *Id.* The standard for instituting an *inter partes* review is set forth in 35 U.S.C. § 314(a), which provides that an *inter partes* review may not be instituted unless the information presented in the petition and any preliminary response shows “there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

The patentability challenges in the Cisco IPR met the “reasonable likelihood” standard of § 314(a). IPR2023-00402, Paper 11, 30. The Petition here presents the same patentability challenges as those for which a trial was instituted in the Cisco IPR. *See* Mot. 4 (“[This] Petition is substantively identical to the Cisco IPR and relies on identical exhibits.”); *compare* Pet. 1–80, *with* IPR2023-00402, Paper 2, 9–85. According to Petitioner, the “[t]he same claims of the same patent are challenged under the same unpatentability grounds as the Cisco IPR.” Mot. 4. In the present

proceeding, Patent Owner did not file a preliminary response to dispute the merits of Petitioner's patentability challenges.

For the reasons set forth in the Cisco IPR, we conclude that Petitioner has demonstrated a reasonable likelihood of prevailing with respect to the challenged claims of the '821 Patent. *See* IPR2023-00402, Paper 11, 14–39. We accordingly determine that the Petition warrants institution under § 314, and turn to Petitioner's request for joinder.

As the moving party, Petitioner has the burden of proof in establishing entitlement to the requested relief. 37 C.F.R. §§ 42.20(c), 42.122(b). Petitioner filed the Motion on October 11, 2023, within one month of institution of the Cisco IPR. *See* 37 C.F.R. § 42.122(b). Petitioner asserts that the Motion should be granted because the joinder “won't impact the Cisco IPR trial schedule in any meaningful way.” Mot. 5. Petitioner also agrees to take an “understudy” role in the Cisco IPR. *See* Mot. 5–7. Specifically, Petitioner agrees to the following: (1) Petitioner “won't make any substantive filings, and . . . agrees that Cisco alone will be responsible for all substantive petitioner filings in the joined proceeding;” (2) “to be bound by all filings by Cisco in the joined proceeding, except for filings regarding termination and settlement;” (3) Petitioner “must obtain prior Board authorization to file any paper or to take any action on its own in the joined proceeding;” (4) Petitioner “shall not be permitted to raise any new grounds not already instituted by the Board in the Cisco IPR, or introduce any argument or discovery not already introduced by Cisco;” (5) Petitioner “shall be bound by any agreement between Patent Owner and Cisco concerning discovery and depositions;” (6) Petitioner “will not cross-examine or defend any witness at deposition;” (7) “Cisco will be responsible

for any oral hearing presentation, including the preparation of demonstrative exhibits”; and (8) “Should Cisco cease participation in the proceeding[, Petitioner] would assume a primary role, meaning it would take over the role previously filled by Cisco.” Mot. 6. As mentioned before, Patent Owner did not file an opposition to the Motion.

Because Petitioner will take an understudy role that will not impact the Cisco IPR which was instituted on identical grounds, we determine that it is appropriate under these circumstances to join Petitioner as a party to the Cisco IPR.

III. 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 1–20 of the ’821 Patent is instituted with respect to all of the grounds set forth in the Petition; and

FURTHER ORDERED that Petitioner’s Motion for Joinder with IPR2023-00402 is granted, and Petitioner is hereby joined as a petitioner in IPR2023-00402;

FURTHER ORDERED that the grounds on which trial in IPR2023-00402 were instituted are unchanged, and no other grounds are added in IPR2023-00402;

FURTHER ORDERED that the Scheduling Order entered in IPR2023-00402 (Paper 12) and the schedule changes agreed to by the parties in IPR2023-00402 (Paper 21) shall govern the trial schedule in IPR2023-00402;

IPR2024-00034
Patent 8,830,821 B2

FURTHER ORDERED that Petitioner's role in IPR2023-00402 shall be limited as stated by Petitioner in the Motion for Joinder (Paper 3, 5–7) unless and until Cisco is terminated from that proceeding;

FURTHER ORDERED that the case caption in IPR2023-00402 shall be changed to reflect joinder of Juniper Networks, Inc. in accordance with the attached example;

FURTHER ORDERED that a copy of this Decision be entered into the record of IPR2023-00402; and

FURTHER ORDERED that all further filings shall be made in IPR2023-00402.

IPR2024-00034
Patent 8,830,821 B2

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IPR2024-00034
Patent 8,830,821 B2

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IPR2023-00402
Patent 8,830,821 B2

⁶ Juniper Networks, Inc. filed a motion for joinder and a petition in IPR20240-00034, which were granted. Accordingly, Juniper Networks, Inc has been joined as a petitioner in this proceeding.