

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

ORCKIT CORPORATION,
Patent Owner.

Case IPR2023-00554
U.S. Patent No. 10,652,111

**PETITIONER'S OPPOSITION TO PATENT
OWNER'S MOTION TO STAY REEXAMINATION**

I. INTRODUCTION

Petitioner Cisco Systems, Inc. (“Petitioner”) respectfully submits that the Board should deny Orckit Corporation’s (“Patent Owner”) motion to stay *Ex Parte* Reexamination No. 90/015,261 (“the ’261 Reexamination”) involving U.S. Patent No. 10,652,111 (“the ’111 Patent”). The ’261 Reexamination should not be stayed because it involves different patentability arguments and different prior art than that raised in this IPR proceeding (“the ’554 IPR”). Indeed, when granting the ’261 Reexamination, the Office determined that the arguments and prior art in the two proceedings “are not the same or substantially the same.” Moreover, the ’261 Reexamination includes 27 claims of the ’111 Patent that are not challenged in the IPR; thus, resolution of the IPR will not resolve all issues in the reexamination.

Simply put, a stay of the ’261 Reexamination will not lead to greater efficiencies or reduce the resources required to complete these two proceedings. Patent Owner bases its stay request largely on speculation about potential claim construction or possible conflicting decisions in the two proceedings. But these arguments are just that – speculation. Taken to their extreme, Patent Owner’s arguments would dictate that a reexamination proceeding is always stayed when there is a co-pending IPR. That is inconsistent with Patent Office regulations.

Patent Owner’s motion should be denied.

II. LEGAL STANDARD

35 U.S.C. § 315(d) states that “during the pendency of an inter partes review, if another proceeding or matter involving the [same] patent is before the Office, the Director may ... stay, transfer, consolidate[e], or terminat[e]” the other proceeding or matter. *See* 37 C.F.R. § 42.122(a). The party seeking a stay “carries the burden of persuasion” and must show good cause for the stay. *Arctic Cat, Inc. v. Polaris Indus., Inc.*, IPR2015-01781, -01783, Paper 78 at 2 (PTAB Sept. 25, 2018); *see* 37 C.F.R. § 42.20(c). In determining whether good cause exists, the Board utilizes eight guiding factors (discussed individually below) and makes a decision based on the totality of the circumstances. *See* 84 Fed. Reg. 16,654, 16,656-57 (Apr. 22, 2019).

III. THE '261 REEXAMINATION SHOULD NOT BE STAYED

The totality of the circumstances demonstrates that a stay of the '261 Reexamination is not warranted. At least Factors 1-5 and 8 weigh against a stay because the '261 Reexamination involves 27 additional claims, different patentability arguments and different prior art as compared to the '554 IPR. Factor 6 is neutral, and Factor 7 weighs, at most, slightly against a stay.

A. FACTOR 1

Factor 1 relates to “[w]hether the claims challenged in the [IPR] are the same as or depend directly or indirectly from claims at issue in the [reexamination].” *See* 84 Fed. Reg. at 16,656-57. This factor disfavors a stay because **27 out of the 54 total claims involved in the '261 Reexamination proceeding (i.e., 50% of the claims)**

are not challenged in the '554 IPR. The '261 Reexamination was granted on Claims 1-54 of the '111 Patent, whereas the '554 IPR challenges only Claims 1-9, 12-24 and 27-31 of that patent. *See* EX1014; Paper 1. Thus, Claims 10-11, 25-26 and 32-54 of the '111 Patent are involved in the reexamination but not the IPR.

Claims 10-11 and 25-26 recite subject matter that is not claimed in any of the challenged claims in the '554 IPR, including sending the packets to an application server for analysis, utilizing a specific OpenFlow protocol version, or providing an instruction with a Type-Length-Value (TLV) structure. EX1001, Cols. 11:45-54, 12:46-50. In addition, Claims 32-54 do not depend directly or indirectly from any challenged claims in the '554 IPR. *Id.*, Cols. 13:8-14:60. Thus, the '261 Reexamination will involve different analysis than the '554 IPR. As the PTAB explained in *Arctic Cat*, “a stay of the reexamination proceedings would not promote consistency with regard to the added claims, because the proceedings at hand [e.g., the IPR] will not address those [additional] claims.” IPR2015-01781, Paper 78 at 4. Indeed, a stay “would be a waste of resources because action with regard to the new claims would not be completed” by a Final Written Decision in the IPR. *Id.*

Patent Owner argues that the additional claims at issue in the '621 Reexamination are of no import because (1) some of the additional claims have similar limitations to those involved in the '554 IPR and (2) the '554 IPR may “touch on” claim constructions that will affect the disposition of the '261 Reexamination.

Paper 20 at 3-4. Patent Owner is wrong. First, as discussed above, some of the additional claims in the '261 Reexamination recite additional limitations that are not at issue in claims of the '554 IPR. Second, the claim construction argument is a red herring because reexaminations and IPRs use different claim construction standards (broadest reasonable construction vs. ordinary and customary meaning). Further, Patent Owner's claim construction argument is speculative because the Board determined that no claim construction was necessary in its Institution Decision in the '554 IPR (Paper 8 at 12), and the Office provided no claim construction in granting the '261 Reexamination. EX1014. Moreover, while Patent Owner raised a claim construction argument for a "controller" in its Patent Owner Response, Patent Owner conceded that "it is not necessary for the Board to choose between the two competing constructions of 'controller'" because the patentability analysis does not "turn on the Board resolving the parties' dispute concerning the construction of 'controller.'" Paper 22 at 16-17. Thus, it is not expected that the Board will issue any constructions because the Board only construes terms if necessary to resolve a controversy. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017). Factor 1 weighs against a stay.

B. FACTOR 2

Factor 2 relates to "[w]hether the same grounds of unpatentability or the same prior art are at issue in both proceedings." *See* 84 Fed. Reg. at 16,656-57. This factor

weighs against a stay because **none of the grounds of unpatentability or the asserted prior art are the same in the '261 Reexamination and the '554 IPR.**

The '261 Reexamination identifies three substantial new questions of patentability that are entirely different from the two grounds of unpatentability raised in the '554 IPR. Paper 1; EX1014. Further, as shown in the table below, the prior art references in the reexamination are entirely different than the prior art references in the IPR:

Prior Art in '261 Reexamination	Prior Art in '554 IPR
US2013/0088967 ("Kusumoto")	U.S. Patent No. 9,264,400 ("Lin")
US2005/0251859 ("Quittek")	US2013/0291088 ("Shieh")
US2010/0208590 ("Dolganow")	US2013/0322242 ("Swenson")
US2016/0219080 ("Huang")	

The **different grounds of unpatentability** and **different prior art** raised in the '261 Reexamination versus the '554 IPR necessarily dictate that the patentability analysis will differ in the two proceedings. Indeed, the Office concluded that the arguments and prior art in the two proceedings "are not the same or substantially the same" in the order granting the '261 Reexamination. EX1014 at 13. The Office analyzed the primary prior art references identified in the '554 IPR (Shieh and Lin) and found them to be different than the primary prior art reference in the '261 Reexamination (Kusumoto). *Id.* at 13-14.

Given the entirely different prior art and arguments in the two proceedings, a stay of the '261 Reexamination does not promote efficiency or Office economy. For example, even if the challenged claims in the '554 IPR are found unpatentable, the

Office will still have to analyze Claims 10-11, 25-26 and 32-54 of the '111 Patent in the '261 Reexamination because those claims are not at issue in the '554 IPR.

Patent Owner's citation to *Google LLC v. Ecofactor, Inc.*, IPR2021-00054, Paper 12 at 4 (PTAB June 28, 2021) is inapposite because the IPR and reexamination proceedings in *Google* both involved the same claims; thus, resolution of the claims in one proceeding resolved all claims in the other proceeding. By contrast, the '621 Reexamination involves 27 additional claims (out of 54 total claims) that are not challenged in this proceeding. Factor 2 weighs against a stay.

C. FACTOR 3

Factor 3 relates to “[w]hether the concurrent parallel Office proceeding will duplicate efforts within the Office.” *See* 84 Fed. Reg. at 16,656-57. Here, the '621 Reexamination involves 27 more claims than the '554 IPR and patentability arguments/prior art that the Office has already determined “are not the same or substantially the same” as those in the '554 IPR. EX1014 at 13. The differences in the claims at issue, patentability arguments and prior art make it unlikely that there will be duplication of efforts in the respective proceedings. As discussed above for Factor 2, even if the '554 IPR resolves the issues as to its challenged claims, there will remain a separate patentability analysis to be performed for the additional claims involved in the '621 Reexamination. This distinguishes this motion from the *Google* ruling relied upon by Patent Owner, where duplicate effort was avoided because

there was complete overlap in the claims in both Office proceedings. IPR2021-00054, Paper 12 at 4. Factor 3 weighs against a stay.

D. FACTOR 4

Factor 4 relates to “[w]hether the concurrent parallel Office proceeding could result in inconsistent results between proceedings (e.g., whether substantially similar issues are presented in the concurrent parallel Office proceeding).” *See* 84 Fed. Reg. at 16,656-57. Here, the concurrent reexamination and IPR proceedings are unlikely to lead to inconsistent results because, as the Office has already determined, the arguments and prior art in the ’261 Reexamination “are not the same or substantially the same” as those in the ’554 IPR. EX1014 at 13. Thus, there are unlikely to be substantially similar issues presented in the parallel proceedings.

Patent Owner points to potential inconsistencies in claim construction as a reason that this factor favors a stay. Paper 20 at 6. However, as explained above in Factor 1, reexaminations and IPRs use different claim construction standards, and the Office previously determined that no claim construction was necessary in instituting the ’554 IPR (Paper 8 at 12) or granting the ’261 Reexamination. EX1014. Moreover, the Patent Owner conceded that “it is not necessary for the Board to choose between two competing constructions of ‘controller’ for purposes of issuing a final written decision.” Paper 22 at 17. Any additional vague reference to “potential or probable differences in record evidence” (Paper 20 at 6) is entirely speculative.

For example, the prior art is different in the two proceedings, so there should be no inconsistencies in interpretation of the scope of the art or in motivations to combine. In fact, the Board's (un)patentability findings in one proceeding would have no bearing on the other because the claims may be found (un)patentable over one set of prior art references but not over the other. In addition, Patent Owner provides no explanation as to why there would be differences in the level of skill in the art or the analysis of objective indicia of nonobviousness in the two proceedings. Indeed, the order granting the '621 Reexamination discussed the '554 IPR, demonstrating that the Office is aware of both proceedings and can avoid inconsistent results between them. EX1014 at 13. Factor 4 weighs against a stay.

E. FACTOR 5

Factor 5 relates to “[w]hether amending the claim scope in one proceeding would affect the claim scope in another proceeding.” *See* 84 Fed. Reg. at 16,656-57. Patent Owner's analysis of this factor is based on the speculative possibility that “amendments or new claims in the reexamination would have significant and unpredictable effect on this IPR.” Paper 20 at 6-7. But that is entirely within the control of the Patent Owner. Moreover, Patent Owner had a chance to proffer claim amendments in the IPR proceeding, but chose not to do so. As such, proffering claim amendments in the '621 Reexamination of Claims 1-54 that potentially affects the claim scope in the IPR proceeding would entirely be attributable to Patent Owner's

attempt to concoct a tension that could have been avoided. And any amendments to the Claims 10-11, 25-26 and 32-54 or new claims in the '621 Reexamination will not affect the IPR proceeding. The mere possibility of some future amendment or new claims should not weigh in favor of a stay. Rather, Factor 5 weighs against a stay; at most, Factor 5 is neutral.

F. FACTOR 6

Factor 6 relates to “[t]he respective timeline and stage of each proceeding.” *See* 84 Fed. Reg. at 16,656-57. Here, both proceedings are at an early stage. The Office granted the '621 Reexamination but has not yet issued an office action. In this proceeding, the Patent Owner Response has been served only on January 15, 2024. Factor 6 is at best neutral in these circumstances. IPR2021-00054, Paper 12 at 4-5.

G. FACTOR 7

Factor 7 relates to “[t]he statutory deadlines of the respective proceedings.” *See* 84 Fed. Reg. at 16,656-57. As Patent Owner notes, the '544 IPR has been instituted and is subject to the one-year statutory deadline for issuing a Final Written Decision. *See* 35 U.S.C. § 316(a)(11). The '621 Reexamination has no deadline, but it should be “conducted with special dispatch within the Office.” *See* 35 U.S.C. § 305. However, this factor should weigh only slightly against a stay because the final resolution of the '554 IPR will not address the 27 additional claims involved in the '621 Reexamination. *See Arctic Cat*, IPR2015-01781, Paper 78 at 4.

H. FACTOR 8

Factor 8 relates to “[w]hether a decision in [the IPR] would likely simplify issues in the concurrent [reexamination] or render it moot.” *See* 84 Fed. Reg. at 16,656-57. Here, there is no evidence that a decision in the IPR will simplify the issues in the reexamination because, as the Office determined, the arguments and prior art in the ’261 Reexamination “are not the same or substantially the same” as those in the ’554 IPR. EX1014 at 13. Even if the challenged claims are found unpatentable in the IPR, the Office will have to analyze 27 additional claims in the reexamination. And in the unlikely event the claims are not found unpatentable in the IPR, the Office will still have to analyze the separate patentability questions in the reexamination. Further, Patent Owner’s claim construction arguments (Paper 20 at 8) fail because there are different standards in the different proceedings and the Board likely will not engage in claim construction. Factor 8 weighs against a stay.

I. ADDITIONAL CONSIDERATIONS AGAINST A STAY

Finally, Patent Owner is incorrect in its argument that a stay would not prejudice Petitioner. Paper 20 at 8-9. Petitioner would be prejudiced by the delay caused by a stay of the ’621 Reexamination because there are 27 claims involved in the reexamination that would not be resolved by a decision in the ’554 IPR.

IV. CONCLUSION

For the foregoing reasons, Patent Owner’s motion to stay the ’261 Reexamination should be denied.

Date: January 19, 2024

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that the preceding documents was served on the Patent Owner as detailed below:

<i>Date of service</i>	January 19, 2024
<i>Manner of service</i>	Email (by agreement between the Parties)
<i>Documents served</i>	Petitioner's Opposition to Patent Owner's Motion To Stay Reexamination
<i>Persons served</i>	James Carmichael Stephen McBride Minghui Yang CARMICHAEL IP, PLLC 8607 Westwood Center Drive Suite 270 Tysons, VA 22182 Tel: (703) 646-9248 Email: jim@carmichaelip.com stevemcbride@carmichaelip.com mitch@carmichaelip.com

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