

UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.

Petitioner

v.

ORCKIT CORPORATION

Patent Owner.

Case No. IPR2024-00895

U.S. Patent No. 10,652,111

PATENT OWNER PRELIMINARY RESPONSE

TABLE OF CONTENTS

	<u>Page</u>
I. INTRODUCTION	1
II. RELATED CASES	2
III. THE '111 PATENT	3
IV. CLAIM CONSTRUCTION.....	6
A. “Controller”	6
V. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. §314(a).....	7
A. Discretionary Denial is Warranted Under <i>General Plastic</i>	7
1. Factor 1: Whether the same petitioner previously filed a petition directed to the same claims of the same patent.....	8
2. Factor 2: Whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it.....	18
3. Factor 3: Whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition	20
4. Factor 4: The length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition.....	21
5. Factor 5: Whether the petitioner provides adequate explanation for the time elapsed between the filing of	

**multiple petitions directed to the same claims of the
same patent 22**

**6. Factors 6 and 7: The finite resources of the Board and
the requirement under 35 U.S.C. § 316(a)(11) to issue
a final determination not later than 1 year after the
date on which the Director notices institution of
review 22**

**7. The Petition does not comply with the Consolidated
Trial Practice Guide 24**

VI. CONCLUSION 25

EXHIBIT LIST	
2001	U.S. Patent 9,853,898
2002	Prosecution History of U.S. Patent 9,853,898
2003	U.S. Patent 10,594,604
2004	Prosecution History of 10,594,604
2005	U.S. Patent 10,855,546
2006	Prosecution History of 10,855,546
2007	U.S. Patent 9,038,151

I. INTRODUCTION

Patent Owner Orckit Corporation (“Orckit”) respectfully requests that the Board exercise its discretion and deny the present Petition under 35 U.S.C. §314(a). This Petition is the second filed by Petitioner Juniper Networks, Inc. (“Juniper”) against Orckit’s U.S. Patent No. 10,652,111 (“the ’111 Patent”) and is an unfair follow-on to Juniper’s first petition. Juniper was aware of the prior art asserted in the present Petition years ago. Nonetheless, it chose to wait more than six months after its first petition to file this second Petition. During this time, Juniper was able to review Orckit’s patent owner response to its first IPR against the ’111 patent and strategically adjust its arguments. Moreover, while Juniper’s first petition challenges claims 1-9, 12-24, and 27-31 and this Petition challenges claims 32-54, there are little to no material differences between the two sets of challenged claims and Orckit’s arguments in the first IPR apply equally to this IPR.¹

Despite this, the present Petition contains only a cursory discussion of the facts surrounding the filing of Juniper’s two petitions. Juniper provides no

¹ To the extent there are any material differences between the challenged claims in Juniper’s first IPR and this IPR, Orckit is prepared to stipulate that it will not assert against Juniper any of claims 32-54 with materially different limitations than found in claims 1-9,12-24, and 27-31.

explanation for why a second petition is needed and no explanation to account for the time elapsed between the filings of its multiple petitions. Juniper even fails to comply with Trial Practice Guide's requirement to rank the petitions in the order in which it wishes the Board to consider the merits.

The present Petition thus satisfies all the factors that the Board considers when exercising its discretion weigh against institution.

II. RELATED CASES

Juniper previously filed IPR2024-00037 against the '111 Patent. The -00037 IPR is a copycat petition to IPR2023-00554 filed by Cisco Systems, Inc. On March 26, 2024, the Board joined Juniper's -00037 IPR to Cisco's -00554 IPR. Orckit filed its patent owner response in the consolidated Juniper/Cisco -00037 IPR on January 15, 2024, four months prior to the May 6, 2024 filing date of the -00895 IPR. The Board already held an oral hearing in the -00554 IPR and a final written decision is expected.

In addition to the -00037 IPR filed by Juniper and the -00554 IPR filed by Cisco, the '111 Patent is also at issue in the following cases:

- *Orckit Corporation v. Cisco Systems, Inc.*, No. 2:22-cv-00276 (E.D. Tex.)
- *Orckit Corporation v. Arista Networks, Inc.*, No. 1:23-cv-00821 (D. Del.)

- *Orckit Corporation v. Juniper Networks, Inc.*, No. 1:23-cv-00822 (D. Del.)
- Reexamination No. 90/015,261

III. THE '111 PATENT

The '111 Patent is titled “Method and System for Deep Packet Inspection in Software Defined Networks.” Ex. 1001, abstract. DPI is a technique for examining network communications at the packet level, which can be used to extract data patterns from a data communication channel. Ex. 1001, 1:21-25. The extracted data patterns are useful for a variety of purposes, including network security and data analytics. *Id.*

A software defined network (SDN) is a networking architecture that provides for centralized management of the nodes in a network, as opposed to the distributed architecture utilized by conventional networks. Ex. 1001, 1:30-38. For example, a SDN may utilize a controller to manage network nodes such as vSwitches. *Id.* SDN based architectures typically decouple the data forwarding (e.g. data plane) from control decisions (e.g. control plane), such as routing, resources, and other management functionalities. Ex. 1001, 1:39-49. The decoupling may allow the data plane and the control plane to operate on different hardware, in different runtime environments, and/or operate using different models. *Id.*

The inventors of the '111 Patent recognized that the OpenFlow protocol used by prior art did not support DPI of packets through the various networking layers. Ex. 1001, 1:50-67. This limited the ability of the OpenFlow protocol to support a number of networking features associated with DPI, including detecting security threats. *Id.* The inventors also recognized that “routing all traffic from network nodes to the central controller introduces some significant drawbacks, such as increased end-to-end traffic delays between the client and the server; overflowing the controller capability to perform other networking functions; and a single point of failure for the re-routed traffic.” *Id.* at 2:1-6. The inventors thus explain that “it would be advantageous to provide a solution that overcomes the deficiencies [in prior art SDNs] and allow[s] efficient DPI in SDNs.” *Id.* at 2:7-9. The '111 Patent proposes methods for DPI in a software defined network. Ex. 1001, 2:27-3:3. In one exemplary embodiment, a network system 100 as shown in Fig. 1 includes a controller 111 “configured to perform deep packet inspection on designated packets from designated flows or TCP sessions... the central controller 111 is further configured to instruct each of the network nodes 112 which of the packets and/or sessions should be directed to the controller 111 for packet inspections:”

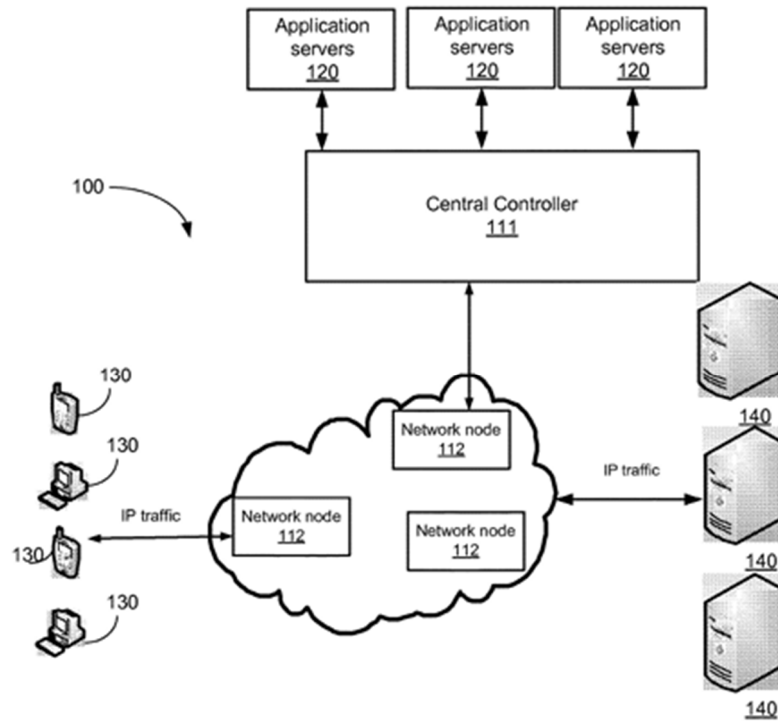


FIG. 1

Ex. 1001, 4:5-11, Fig. 1.

Controller 111 may provide instructions to the network nodes that configure the network nodes to analyze the headers of incoming packets for DPI. Ex. 1001, 4:23-37. For example, the network node may be instructed to either redirect the packet to controller 111 or send the packet to the destination server 140. *Id.*

Alternatively, the controller 111 may instruct the network nodes to mirror a number of bytes within the packet to be sent to controller 111 to perform DPI. *Id.*

The TCP packet's header may include fields such as TCP FLAG SYN, TCP FLAG ACK, TCP FLAG FIN, TCP FLAG RST, which are analyzed by the network node

to execute the instructions sent by the controller, which may vary depending on the contents of the TCP packet's header field. Ex. 1001, 4:23-46.

IV. CLAIM CONSTRUCTION

Juniper proposes that, aside from the terms “controller” and “criterion,” the terms of the '111 Patent have their plain and ordinary meaning as understood by a POSITA. Pet., 9-11. Orckit submits that the term “controller” should be construed consistent with its proposed construction in IPR2023-00554, and that no other term requires express construction. *Nidec Motor Corp. v. Zhongshan Broad Ocean Motor Co.*, 868 F.3d 1013, 1017 (Fed. Cir. 2017).

A. “Controller”

Juniper admits that “the district court preliminarily construed the ‘controller’ term to mean ‘an entity that is capable of controlling deep packet inspection.’” Pet., 9. Orckit proposes this same construction for “controller” in IPR2023-00554, and this issue is already before the Board in that IPR. Juniper seeks to modify the district court's construction and substitute “configured to perform deep packet inspection” instead of “capable of controlling deep packet inspection.” Pet., 9.

First, the construction has no bearing on any ground, as the arguments are the same under either construction. Second, the Petition does not explain why the district court's construction requires modification. Instead, Juniper seeks to read a disclosed embodiment from the specification into the claims. Juniper's proposal to

unnecessarily import limitations from the specification into the claims should be rejected. *Superguide Corp. v. DirecTV Enterprises, Inc.*, 358 F.3d 870, 875 (Fed. Cir. 2004).

V. THE BOARD SHOULD DENY INSTITUTION UNDER 35 U.S.C. §314(a)

A. Discretionary Denial is Warranted Under *General Plastic*

Under 35 U.S.C. §314(a) and 37 C.F.R. § 42.108(a), the Director has discretion to deny institution. *Gen. Plastic Indus. Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 at § II.B.4.i. (PTAB September 6, 2016) (“*General Plastic*”). In exercising this discretion, the Board considers the seven *General Plastic* factors:

1. whether the same petitioner previously filed a petition directed to the same claims of the same patent;
2. whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it;
3. whether at the time of filing of the second petition the petitioner already received the patent owner's preliminary response to the first petition or received the Board's decision on whether to institute review in the first petition;

4. the length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition;
5. whether the petitioner provides adequate explanation for the time elapsed between the filings of multiple petitions directed to the same claims of the same patent;
6. the finite resources of the Board; and
7. the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review.

General Plastic at *8-10. Here, all seven factors weigh against institution. The Board should thus deny institution of this petition under 35 U.S.C. § 314(a).

1. Factor 1: Whether the same petitioner previously filed a petition directed to the same claims of the same patent

Juniper previously filed IPR2024-00037 against the '111 Patent. The Board already held an oral hearing in that IPR and a final written decision is expected to issue in a few days, on or before September 20, 2024. The -00895 IPR is thus Juniper's second against the '111 Patent. Juniper downplays this fact because "Petitioner has no relationship with Cisco." Pet., 80. But the law does not give parties a second bite at the apple under *General Plastic* factor 1—such that they can file a second petition—after they have already joined a first petition; and

Petitioner's two filings weigh against institution under factor one. *Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00064, Paper 10 at *10 (May 1, 2019) (“By joining the ongoing 1032 IPR, [the Petitioner] has filed a petition previously directed to the same claims of the same patent under the first *General Plastic* factor.”).

Juniper also argues that the -00895 IPR challenges different claims than the -00037 IPR. As a threshold matter, any alleged lack of overlap in challenged claims is not dispositive. *See Longi Green Energy Tech. Co., Ltd. v. Hanwha Solutions Corp.*, IPR2024-00047, Paper 18 (April 27, 2020) (denying institution under §314(a) even though the second IPR challenged different claims than the first IPR). The purpose of *General Plastic* is to address the potential for multiple petitions to be abused—as the Board recognized, “[m]ultiple, staggered petitions challenging the same patent and same claims raise the potential for abuse” by allowing Petitioners to craft their follow-on filings using arguments made in the earlier filings as a roadmap. *General Plastic* at *17.

In any event, Petitioner is wrong that the challenged claims are different than those at issue in the -0037 IPR. The claims Juniper seeks to challenge with its second petition are either identical to or have no material differences in scope from

the claims at issue in Juniper’s first petition (the prior -00037 IPR)², as shown by the following chart highlighting the identical language shared by the challenged claims:

IPR2024-00037 Challenged Claim	IPR2024-00895 Challenged Claim
[1.2] receiving, by the network node from the controller, the instruction and the criterion; receiving, by the network node from the first entity over the packet network, a packet addressed to the second entity	[32.1] receiving [by the network node], from the controller, the instruction and the criterion [32.2] receiving [by the network node], from the first entity over the packet network, a packet addressed to the second entity;
[1.3] checking, by the network node, if the packet satisfies the criterion; [1.4] responsive to the packet not satisfying the criterion, sending, by the network node over the packet network, the packet to the second entity; and	[32.3] checking [by the network node] if the packet satisfies the criterion; responsive to the packet not satisfying the criterion, sending [by the network node] over the packet network, the packet to the second entity; and
[1.5] responsive to the packet satisfying the criterion, sending the packet, by the network node over the	[32.4] responsive to the packet satisfying the criterion, sending the packet [by the network node] over the

² To the extent there are any material differences between the challenged claims in Juniper’s first IPR and this IPR, Orckit is prepared to stipulate that it will not assert against Juniper any of claims 32-54 with materially different limitations than found in claims 1-9,12-24, and 27-31.

packet network, to an entity that is included in the instruction and is other than the second entity.	packet network, to an entity that is included in the instruction and is other than the second entity.
[2] 2. The method according to claim 1, wherein the instruction is ‘probe’, ‘mirror’, or ‘terminate’ instruction, and upon receiving by the network node the ‘terminate’ instruction, the method further comprising blocking, by the network node, the packet from being sent to the second entity and to the controller.	[33] The method [by the network node] according to claim 32, wherein the instruction is ‘probe’, ‘mirror’, or ‘terminate’ instruction, and upon receiving the ‘terminate’ instruction, the method further comprising blocking, the packet from being sent to the second entity and to the controller.
[3] The method according to claim 1, wherein the instruction is a ‘probe’, a ‘mirror’, or a ‘terminate’ instruction, and upon receiving by the network node the ‘mirror’ instruction and responsive to the packet satisfying the criterion, the method further comprising sending the packet, by the network node, to the second entity and to the controller.	[34] The method [by the network node] according to claim 32, wherein the instruction is a ‘probe’, a ‘mirror’, or a ‘terminate’ instruction, and upon receiving the ‘mirror’ instruction and responsive to the packet satisfying the criterion, the method further comprising sending the packet to the second entity and to the controller.
[5] The method according to claim 1, further comprising responsive to the packet satisfying the criterion and to the instruction, sending the packet or a	[36] The method [by the network node] according to claim 32, further comprising responsive to the packet satisfying the criterion and to the

portion thereof, by the network node, to the controller.	instruction, sending the packet or a portion thereof to the controller.
[7] The method according to claim 5, further comprising responsive to the packet satisfying the criterion and to the instruction, sending a portion of the packet, by the network node, to the controller.	[37] The method [by the network node] according to claim 36, further comprising responsive to the packet satisfying the criterion and to the instruction, sending a portion of the packet to the controller.
[8] The method according to claim 7, wherein the portion of the packet consists of multiple consecutive bytes, and wherein the instruction comprises identification of the consecutive bytes in the packet.	[38] The method [by the network node] according to claim 37, wherein the portion of the packet consists of multiple consecutive bytes, and wherein the instruction comprises identification of the consecutive bytes in the packet.
[16] The method according to claim 1, wherein the packet comprises distinct header and payload fields, the header comprises one or more flag bits, and wherein the packet-applicable criterion is that one or more of the flag bits is set.	[39] The method [by the network node] according to claim 32, wherein the packet comprises distinct header and payload fields, the header comprises one or more flag bits, and wherein the packet-applicable criterion is that one or more of the flag bits is set.
[17] The method according to claim 16, wherein the packet is an Transmission Control Protocol (TCP) packet, and wherein the one or more flag bits	[40] The method according to claim 39, wherein the packet is an Transmission Control Protocol (TCP) packet, and wherein the one or more flag bits

comprises comprise a SYN flag bit, an ACK flag bit, a FIN flag bit, a RST flag bit, or any combination thereof.	comprises comprise a SYN flag bit, an ACK flag bit, a FIN flag bit, a RST flag bit, or any combination thereof.
[18] The method according to claim 1, wherein the packet comprises distinct header and payload fields, the header comprises at least the first and second entities addresses in the packet network, and wherein the packet-applicable criterion is that the first entity address, the second entity address, or both match a predetermined address or addresses.	[41] The method according to claim 32, wherein the packet comprises distinct header and payload fields, the header comprises at least the first and second entities addresses in the packet network, and wherein the packet-applicable criterion is that the first entity address, the second entity address, or both match a predetermined address or addresses.
[19] The method according to claim 18, wherein the addresses are Internet Protocol (IP) addresses.	[42] The method according to claim 41, wherein the addresses are Internet Protocol (IP) addresses.
[20] The method according to claim 1, wherein the packet is an Transmission Control Protocol (TCP) packet that comprises source and destination TCP ports, a TCP sequence number, and a TCP sequence mask fields, and wherein the packet-applicable criterion is that the source TCP port, the destination TCP port, the TCP sequence number, the TCP sequence	[43] The method according to claim 32, wherein the packet is an Transmission Control Protocol (TCP) packet that comprises source and destination TCP ports, a TCP sequence number, and a TCP sequence mask fields, and wherein the packet-applicable criterion is that the source TCP port, the destination TCP port, the TCP sequence number, the TCP sequence

mask, or any combination thereof, matches a predetermined value or values.	mask, or any combination thereof, matches a predetermined value or values.
[21] The method according to claim 1, wherein the packet network comprises a Wide Area Network (WAN), Local Area Network (LAN), the Internet, Metropolitan Area Network (MAN), Internet Service Provider (ISP) backbone, datacenter network, or inter-datacenter network.	[44] The method according to claim 32, wherein the packet network comprises a Wide Area Network (WAN), Local Area Network (LAN), the Internet, Metropolitan Area Network (MAN), Internet Service Provider (ISP) backbone, datacenter network, or inter-datacenter network.
[22] The method according to claim 1, wherein the first entity is a server device and the second entity is a client device, or wherein the first entity is a client device and the second entity is a server device.	[45] The method according to claim 32, wherein the first entity is a server device and the second entity is a client device, or wherein the first entity is a client device and the second entity is a server device.
[23] The method according to claim 22, wherein the server device comprises a web server, and wherein the client device comprises a smartphone, a tablet computer, a personal computer, a laptop computer, or a wearable computing device.	[46] The method according to claim 45, wherein the server device comprises a web server, and wherein the client device comprises a smartphone, a tablet computer, a personal computer, a laptop computer, or a wearable computing device.
[24] The method according to claim 22, wherein the communication between	[47] The method according to claim 45, wherein the communication with the

the network node and the controller is based on, or uses, a standard protocol.	controller is based on, or uses, a standard protocol.
[27] The method according to claim 1, wherein the network node comprises a router, a switch, or a bridge.	[50] The method according to claim 32, wherein the network node comprises a router, a switch, or a bridge.
[28] The method according to claim 1, wherein the packet network is an Internet Protocol (IP) network, and the packet is an IP packet.	[51] The method according to claim 32, wherein the packet network is an Internet Protocol (IP) network, and the packet is an IP packet.
[29] The method according to claim 28, wherein the packet network is an Transmission Control Protocol (TCP) network, and the packet is an TCP packet.	[52] The method according to claim 51, wherein the packet network is a Transmission Control Protocol (TCP) network, and the packet is an TCP packet.
[30] The method according to claim 1, further comprising: receiving, by the network node from the first entity over the packet network, one or more additional packets; checking, by the network node, if any one of the one or more additional packets satisfies the criterion; responsive to an additional packet not satisfying the criterion, sending, by the network node over the packet network, the additional packet to the second entity; and responsive to	[53] The method [by the network node] according to claim 32, further comprising: receiving, from the first entity over the packet network, one or more additional packets; checking, if any one of the one or more additional packets satisfies the criterion; responsive to an additional packet not satisfying the criterion, sending over the packet network, the additional packet to the second entity; and responsive to the additional packet

the additional packet satisfying the criterion, sending the additional packet, by the network node over the packet network, in response to the instruction.	satisfying the criterion, sending the additional packet over the packet network, in response to the instruction.
[31] The method according to claim 1, wherein the packet network is a Software Defined Network (SDN), the packet is routed as part of a data plane and the network node communication with the controller serves as a control plane.	[54] The method according to claim 32, wherein the packet network is a Software Defined Network (SDN), the packet is routed as part of a data plane and the communication with the controller serves as a control plane.

Further, PO did not assert these claims in its patent infringement lawsuit against Cisco (the Petitioner in the -554 IPR), does not intend to assert them against Petitioner, and is willing to stipulate to this effect.

Juniper’s second petition here is a classic example of road mapping, *i.e.*, the type of harm *General Plastic* seeks to address. Orckit filed its patent owner response in the -00037 IPR four months before Juniper’s second IPR. And Juniper appears to have selected its prior art using Orckit’s patent owner response arguments as a roadmap. For example, Orckit argued in its Patent Owner response to Juniper’s first IPR that the prior art did not disclose “a controller configured to perform or capable of controlling DPI [deep packet inspection]” because the prior art controller performed a different process—deep *flow* inspection. IPR2023-

00554, Paper 22 at *23-31. In response, Juniper's second IPR alleges that Chua "discloses programming an SDN controller to perform DPI." Pet., 18, 21.

Similarly, Orckit's POR in the prior IPR argued that the claims required using a single criterion to determine whether to send a packet to a second entity or an entity other than the second entity, but the prior art used two separate criteria.

IPR2023-00554, Paper 22 at *39-42. In response, Juniper's second IPR alleges that Lefebvre teaches "one criterion." Pet., 34.

Juniper's dependent claim arguments here contain more examples of roadmapping. For claim 7, Orckit argued in the prior IPR that the prior art did not disclose sending "a portion of a packet" because the prior art sent multiple packets and not a portion of any packet. IPR2023-00554, Paper 22 at *52-54. In response, Juniper's second IPR relies upon a third reference, Rash, for analogous claim 37 specifically to allege "sending a portion of the packet to the controller." Pet., 75-76. For claim 30, Orckit argued in the prior IPR that the prior art did not disclose checking if "one or more additional packets" satisfied the criterion because the prior art checked the criterion once for all packets in a flow. IPR2023-00554, Paper 22 at *57-59. In response, Juniper's second IPR alleges "Lefebvre discloses how multiple packets are 'processed and steered' to the next node in their assigned service paths, which a POSITA would've understood discloses sending the additional packet over the packet network in response to the instruction." Pet., 67.

Though PO contests Juniper’s allegations, it is clear that Juniper drafted its second petition to respond to Orckit’s arguments made in the Patent Owner Response to Juniper’s first IPR. This is precisely the type of strategic abuse of the IPR process that was at issue in *General Plastic*, and the Board should not permit it here.

Factor one thus weighs heavily in favor of denying institution.

2. Factor 2: Whether at the time of filing of the first petition the petitioner knew of the prior art asserted in the second petition or should have known of it

Factor two also weighs heavily in favor of denying institution because Petitioner was aware of the prior art asserted in its second petition years ago. Juniper argues that “Petitioner wasn’t aware of Lefebvre, Chua, and Rash at the first petition’s filing,” but there is evidence that this is not true.

For example, Juniper is the applicant and assignee of U.S. Patent 9,853,898. Ex. 2001. The examiner relied upon U.S. Patent Pub. No. 2013/0272305 in a rejection of Juniper’s ’898 Patent prior to its issuance. Ex. 2002, 57. U.S. Patent Pub. No. 2013/0272305 to Lefebvre is a publication of an application that subsequently issued as U.S. Patent No. 10,097,452 to Lefebvre, which Juniper relies on as its primary reference. Ex. 1005, 1 (Lefebvre listing US 2013/0272305 under Prior Publication Data). Thus, Juniper was aware of Lefebvre at least as early as the 2017 prosecution of its ’898 Patent.

Juniper was also aware of Chua and Rash for similar reasons. The patent application publication (US 2014/0282823) that subsequently issued as Rash was cited during the prosecution of Juniper's U.S. Patent No. 10,594,604. Ex. 2003; Ex. 2004, 326 (rejecting Juniper's '604 Patent as being anticipated by US 2014/0282823); Ex. 1007, 1 (Rash listing US 2014/0282823 under Prior Publication Data). And U.S. Patent No. 9,038,151 to Chua was cited during the prosecution of Juniper's U.S. Patent No. 10,855,546. Ex. 2005; Ex. 2006, 70. Chua's '151 patent is in the same family as Chua's '301 patent relied upon in this IPR. Ex. 1006, 1 (claiming priority to 61/703,692); Ex. 2007, 1 (claiming priority to 61/703,692). In each case, PTO examiners made Juniper aware of the asserted prior art years before either of its IPRs against Orckit's '111 Patent.

To the extent Juniper's IPR counsel were not personally unaware of Lefebvre, Chua, and Rash, factor two also considers whether petitioner "should have known" of the asserted prior art. The fact that the Office readily located these references in response to Juniper's own patent applications shows that Juniper should have known of Lefebvre, Chua, and Rash when it filed its first petition. It is disingenuous for Juniper, a party with extensive resources, to represent to the Board that it was not able for months to locate prior art that was publicly available, cited in prior prosecutions, and easily located by the USPTO. Allowing Juniper to plead ignorance (as it does here) would be an open invitation to parties wishing to

game the system to strategically wait until the eleventh hour to challenge claims based on prior art that they knew or should have known of all along. Factor two thus weighs in favor of denying institution.

3. Factor 3: Whether at the time of filing of the second petition the petitioner already received the patent owner’s preliminary response to the first petition or received the Board’s decision on whether to institute review in the first petition

Factor three heavily favors denying institution because, at the time of filing of the current Petition, Juniper had already received the patent owner’s preliminary response to the first petition, as well as the Board’s institution decision and Orckit’s patent owner response, which Orckit filed in the -00037 IPR on January 15, 2024, almost four months before the May 6, 2024 filing date of Juniper’s second petition. Thus, Juniper was able to monitor how arguments evolved during its prior IPR and strategically craft its second petition to gain an unfair advantage against the Patent Owner.

As discussed above, the claims at issue in Juniper’s second petition IPR present little or no material differences in language and scope from those at issue in Juniper’s first petition. *Supra*. And Juniper appears to have used arguments made in Orckit’s prior patent owner response as a roadmap to select prior art responsive to those arguments. *Supra*. The law is clear that “the filing of sequential attacks against the same claims, with the opportunity to morph positions along the

way, imposes inequities on Patent Owner.” *General Plastic* at *11. Juniper’s morphed positions based on Orckit’s prior patent owner response is inequitable and the exact conduct that factor 3 seeks to protect against. Factor three thus heavily weighs in favor of denying institution.

4. Factor 4: The length of time that elapsed between the time the petitioner learned of the prior art asserted in the second petition and the filing of the second petition

The fact that Juniper had known or should have known of the prior art asserted in this petition for years as of the time it filed its petition and allowed seven months (by which time it had received the papers and unfair advantage addressed in factor 3) to elapse before filing its second petition favors denying institution under factor four. Juniper was aware of the asserted prior art but chose not to raise it in its earlier petition. *See Valve Corp. v. Elec. Scripting Prods., Inc.*, IPR2019-00062, Paper 11 (Apr. 2, 2019) (determining that the fourth factor weighed against a petitioner that waited five months to file a second petition). Here, Juniper’s seven-month wait after filing its first petition to file a second follow-on petition is longer than Valve’s five month wait and weighs heavily against institution under factor four.

5. Factor 5: Whether the petitioner provides adequate explanation for the time elapsed between the filing of multiple petitions directed to the same claims of the same patent

The Petition fails to explain why Juniper waited seven months to file its follow-on petition. Pet., 80. Juniper suggests that it “wasn’t aware of Lefebvre, Chua, and Rash at the first petition’s filing” and “[a]fter discovering Lefebvre, Chua, and Rash, Petitioner diligently worked to prepare and file this Petition.” *Id.* As discussed *supra*, this is clearly false. Juniper knew or should have known of Lefebvre, Chua, and Rash for years when it filed its first petition. Juniper does not (and cannot) explain why it did not assert these references earlier (at the very least before receiving Orckit’s POPR, the Institution Decision, and Orckit’s POR in Juniper’s first IPR, for which there has already been an oral hearing) even though it knew of Lefebvre, Chua, and Rash all along. Juniper waited until it had months of opportunity to review Orckit’s patent owner response arguments in the prior IPR to file its second petition. Under these facts, factor five heavily favors discretionary denial of institution.

6. Factors 6 and 7: The finite resources of the Board and the requirement under 35 U.S.C. § 316(a)(11) to issue a final determination not later than 1 year after the date on which the Director notices institution of review

Factors six and seven are “efficiency considerations” that seek to streamline challenges to the same patent. *Valve*, IPR2019-00064 at *15. “[H]aving multiple

petitions challenging the same patent, especially when not filed at or around the same time as in this case, is inefficient and tends to waste resources.” *Id.* at *16.

Here, both factors six and seven weigh against institution. As discussed above, the claims at issue in Juniper’s second petition are either identical or have no material differences to the claims challenged in Juniper’s first IPR, which is nearing its resolution, with a final written decision expected no later than September 20, 2024. If the Board were to institute Juniper’s second IPR, Juniper would essentially be granted a second attempt at the same limitations. This is duplicative and a waste of Board resources. *Apple*, IPR2020-00854 at *11-12.

Likewise, Juniper agreed to follow the procedural schedule in the -00037 IPR, and to allow Juniper to proceed with a second petition on a different procedural schedule is an inefficient use of resources. *Valve*, IPR2019-00064 at *16 (“Having the Office address one set of challenges in the 1032 IPR on its procedural schedule (which Valve agreed to follow) and these three petitions on their own procedural schedule, which Valve seeks here, is an inefficient use of resources.”).

Under these facts, factors six and seven weigh in favor of discretionary denial.

7. The Petition does not comply with the Consolidated Trial Practice Guide

Finally, the Consolidated Trial Practice Guide (“CTPG”) states that “multiple petitions by a petitioner are not necessary in the vast majority of cases.” CTPG at *59. In the rare event where a second petition may be necessary, the CTPG requires the petitioner to (1) rank the petitions in order on the merits and (2) explain why multiple petitions are merited:

[I]f a petitioner files two or more petitions challenging the same patent, then the petitioner should, in its petitions or in a separate paper filed with the petitions, identify: (1) a ranking of the petitions in the order in which it wishes the Board to consider the merits, if the Board uses its discretion to institute any of the petitions, and (2) a succinct explanation of the differences between the petitions, why the issues addressed by the differences are material, and why the Board should exercise its discretion to institute additional petitions if it identifies one petition that satisfies petitioner’s burden under 35 U.S.C. § 314(a).

CTPG at *60-61.

Here, Juniper has provided neither a ranking of its petitions nor an explanation for any differences between its two petitions and why the Board should institute a second petition. The failure to provide a ranking as required by the CTPG renders Juniper’s petition defective on its face. And as shown by the table comparing the claims in Juniper’s prior IPR with the claims in this IPR, there

are no material differences between the claims challenged in that IPR and here. Juniper only asserts that this second IPR uses different references with different teachings and relies on the opinion of a different expert than the prior IPR. Pet., 79. But Juniper does not explain why the differences between its -00037 IPR and the present -00895 IPR are sufficiently material for the Board to institute both IPRs, when neither new references nor a new expert are factors that weigh in favor of institution under *General Plastic*. Its failure to explain directly undermines its argument that no basis for discretionary denial exists. Orckit has shown that all seven *General Plastic* factors favor denial of institution. Juniper does not provide any reason for the Board to institute both IPRs.

VI. CONCLUSION

Juniper's -00895 IPR is an improper follow-on petition to Juniper's prior -00037 IPR. The Board should exercise its discretion under § 314(a) and deny institution.

Date: September 13, 2024

Respectfully submitted,

/Minghui Yang/
Minghui Yang (Reg. No. 71,989)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive
Suite 270
Tysons, VA 22182
Tel: (703) 646-9248
mitch@carmichaelip.com

Counsel for Patent Owner

CERTIFICATE OF COMPLIANCE WITH TYPE-VOLUME LIMITS

This Patent Owner Preliminary Response consists of 5,751 words, excluding table of contents, table of authorities, certificate of service, this certificate, or table of exhibits. The Response complies with the type-volume limitation of 14,000 words as set forth in 37 C.F.R. § 42.24. In preparing this certificate, counsel has relied on the word count of the word-processing system used to prepare the paper (Microsoft Word).

Dated: September 13, 2024

/ Minghui Yang /
Minghui Yang (Reg. No. 71,989)
CARMICHAEL IP, PLLC
8607 Westwood Center Drive
Suite 270
Tysons, VA 22182
Tel: (703) 646-9248
mitch@carmichaelip.com

Counsel for Patent Owner

CERTIFICATE OF SERVICE

The undersigned hereby certifies that the following documents were served by electronic service, by agreement between the parties, on the date below:

**PATENT OWNER PRELIMINARY RESPONSE
EXHIBITS 2001-2005**

The names and email addresses of the parties being served are as follows:

Kyle K. Tsui
FISCH SIGLER LLP
5301 Wisconsin Avenue NW
Suite 400
Washington, DC 20015
Email: kyle.tsui@fischllp.com

Ken K. Fung
FISCH SIGLER LLP
400 Concar Drive
San Mateo, CA 94402
Email: ken.fung@fischllp.com

ipr@fischllp.com

Respectfully submitted,

/Minghui Yang/

Date: September 13, 2024