

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARISTA NETWORKS, INC.,
Petitioner,

v.

ORCKIT CORPORATION,
Patent Owner.

IPR2024-01237
Patent 7,545,740 B2

Before KRISTEN L. DROESCH, MATTHEW J. McNEILL, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

DROESCH, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 314

I. INTRODUCTION

A. Background

Arista Networks, Inc. (“Petitioner”) filed a petition requesting *inter partes* review of claims 1–31 of U.S. Patent No. 7,545,740 B2 (Ex. 1001, “’740 Patent”). Paper 2 (“Petition” or “Pet.”). Petitioner filed a Declaration of Tal Lavian, Ph.D., with its Petition. Ex. 1003. Orckit Corporation (“Patent Owner”) timely filed a preliminary response. Paper 6 (“Preliminary Response,” or “Prelim. Resp.”).

We have authority to determine whether to institute review under 35 U.S.C. § 314 and 37 C.F.R. § 42.4(a). An *inter partes* review may not be instituted unless it is determined that “the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.”

35 U.S.C. § 314(a). “In determining whether to institute . . . , the Director may take into account whether, and reject the petition . . . because, the same or substantially the same prior art or arguments previously were presented to the Office.” 35 U.S.C. § 325(d).

Upon consideration of the Petition and Preliminary Response in view of the present record and for the reasons explained below, we reject the Petition under 35 U.S.C. § 325(d) because the same or substantially the same prior art or arguments previously were presented to the Office.

B. Related Matters

The parties identify the following matters involving the ’740 Patent:

Orckit Corporation v. Arista Networks, Inc., 1-23-cv-00821 (D.Del)

Orckit Corporation v. Juniper Networks, Inc., 1-23-cv-00822 (D.Del)

Orckit Corporation v. Cisco Systems, Inc., 2:22-cv-276 (E.D. Tex.)
Cisco Systems, Inc. v. Orckit Corporation, IPR2023-00401 (“Cisco IPR”)

Juniper Networks, Inc. v. Orckit Corporation, IPR2024-00026.¹
Pet. 2; Paper 3, 1.

C. Brief Overview of the ’740 Patent (Ex. 1001)

The ’740 Patent “relates generally to communication networks, and particularly to methods and systems for link aggregation in network elements.” Ex. 1001, 1:5–7. “Link aggregation (LAG) is a technique by which a group of parallel physical links between two endpoints in a data network can be joined together into a single logical link (referred to as the ‘LAG group’).” *Id.* at 1:11–14.

D. Challenged Claims

Claims 1, 4, 5, 13–15, 17, 19, 20, and 28–30 are independent, and remaining claims 2, 3, 6–12, 16, 18, 21–27, and 31 depend directly or indirectly therefrom, respectively. *See* Ex. 1001, 10:64–16:35.

¹ Juniper Networks, Inc. was joined as a petitioner to the Cisco IPR. Cisco IPR, Paper 28.

E. Asserted Patentability Challenges and Asserted Prior Art

Petitioner asserts that claims 1–31 are unpatentable on the following grounds of unpatentability (Pet. 13–14):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–31	103(a) ²	Bruckman ³
1–31	103(a)	Bruckman, Basso ⁴
11, 26	103(a)	Bruckman, Holdsworth ⁵
11, 26	103(a)	Bruckman, Basso, Holdsworth

II. 35 U.S.C. § 325(d)

Patent Owner urges the Board to deny institution under 35 U.S.C. § 325(d) because the Petition is nearly identical to the Petitions filed in IPR2023-00401 and IPR2024-00026. *See* Prelim. Resp. 15, 17 (citing Prelim. Resp. 2–3, 13–14). According to Patent Owner, instituting review based on this Petition “would require the Board to devote significant resources to entertain the *exact same arguments* that have already been made and evaluated in the -00401 and -00026 IPRs,” and “would be a complete waste of time and resources by the Board and parties.” *Id.* at 17. Patent Owner contends that the prior IPRs “made the same arguments against the same claims using the same grounds and same prior art.” *Id.* (citing *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (PTAB Feb. 13, 2020) (precedential))

² 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 ’740 Patent claims an effective filing date prior to March 16, 2013, we refer to the pre-AIA version of § 103.

³ US 2004/0228278 A1, published Nov. 18, 2004 (Ex. 1005).

⁴ US 2003/0210688 A1, published Nov. 13, 2003 (Ex. 1006).

⁵ Holdsworth et al., *Digital Logic Design*, Elsevier Science, 2002 (ISBN 0 7506 45882) (Ex. 1007).

(“*Advanced Bionics*”) for including AIA post-grant proceedings involving the challenged patent when considering whether the same or substantially the same prior art or arguments previously were presented to the Office).

Petitioner acknowledges that “the arguments presented herein rely on the same grounds as were presented in the petitions filed by Cisco and Juniper.” Pet. 85. Petitioner, however, contends that this does not warrant denying institution because Petitioner was sued separately, has no significant relationship with Cisco and Juniper, and is not a party to the litigations involving Cisco and Juniper. *See id.* According to Petitioner, “the Board should decline to exercise its discretion under 35 U.S.C. § 325(d)” because Petitioner “is entitled to preserve and present its challenge unless and until the arguments are finally resolved against Patent Owner.” *Id.* (citing *Blonder-Tongue Labs. V. University of Ill.*, 402 U.S. 313, 329 (1971)).

In evaluating arguments under § 325(d), we use

[a] two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of [the] first part of the framework is satisfied, whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics at 8; *see also Becton, Dickinson & Co. v. B. Braun Melsungen AG*, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to Section III.C.5, first paragraph) (listing factors to consider in evaluating the applicability of § 325(d)) (“*Becton, Dickinson*”).

Under *Advanced Bionics*, *Becton, Dickinson* factors (a), (b), and (d) are to be considered in the evaluation of whether the same or substantially the same art or arguments were previously presented to the Office.

Advanced Bionics at 10. *Becton, Dickinson* identifies these factors as:

- (a) the similarities and material differences between the asserted art and the prior art involved during examination;
- (b) the cumulative nature of the asserted art and the prior art evaluated during examination; and
- (d) the extent of the overlap between the arguments made during examination and the manner in which Petitioner relies on the prior art or Patent Owner distinguishes the prior art.

Becton, Dickinson at 17–18. If the first part of the *Advanced Bionics* framework is satisfied, we turn to the second part where *Becton, Dickinson* factors (c), (e), and (f) are considered in the evaluation of whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims. *Becton, Dickinson* identifies these factors as:

- (c) the extent to which the asserted art was evaluated during examination, including whether the prior art was the basis for rejection;
- (e) whether petitioner has pointed out sufficiently how the examiner erred in its evaluation of the asserted prior art; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the prior art or arguments.

Id. Furthermore, as pointed out by Patent Owner, “[t]he proceedings in which the art was previously presented include . . . AIA post-grant proceedings involving the challenged patent.” *Advanced Bionics* at 8.

Patent Owner contends that “*Becton, Dickinson* factors (a),(b), and (d) favor denying institution.” Prelim Resp. 19. According to Patent Owner, under factor (a), the Cisco IPR “asserted identical prior art in identical grounds against the same claims with nearly identical arguments.” *Id.* Patent Owner points out that the Cisco IPR “resulted in a final written decision that is currently being appealed.” *Id.* In addressing factor (b), Patent Owner asserts that “[t]he references here are completely duplicative

of the references considered in [the Cisco IPR].” *Id.* at 20. According to Patent Owner, in evaluating factor (d), “the arguments advanced in this [Petition] are almost identical to the arguments advanced in [the Cisco IPR].” *Id.* at 20–21. Petitioner does not address the *Becton, Dickinson* factors (a),(b), and (d) with respect to the Cisco IPR.⁶ *See* Pet. 85.

We have reviewed the Petition and the petition filed in the Cisco IPR and concur with Patent Owner that the Petition presents the same prior art, same grounds of unpatentability, and the same arguments as those previously presented in the Cisco IPR. *Compare* Pet. 13–15, 24–80 with, Cisco IPR, Paper 2 at 18–79. Accordingly, we agree that the first part of the *Advanced Bionics* framework is satisfied. Therefore, we turn to the second part of the *Advanced Bionics* framework to resolve whether Petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Patent Owner asserts that “*Becton, Dickinson* factors (c),(e), and (f) each favor noninstitution.” Prelim. Resp. 22. Addressing factor (c), Patent contends that “the prior art was evaluated extensively during [the Cisco IPR], resulting in a final written decision . . . invalidating the challenged claims over Bruckman.” *Id.* at 22–23. Patent Owner contends that, under *Becton, Dickinson* factor (d), “Petitioner presumably will not allege the Board erred in the final written decision for [the Cisco IPR].” *Id.* at 23. According to Patent Owner, in evaluating factor (f), “Petitioner identifies (and P[atent]O[wner] is aware of) no additional evidence or facts in this

⁶ Petitioner otherwise presents extensive arguments addressing the consideration of the references during prosecution, as well as alleged error by the Examiner in considering the teachings of Bruckman. *See* Pet. 85 (citing Ex. 1002, 44; Cisco IPR, Paper 10 at 18).

[Petition] that was not already addressed in the [Cisco IPR].” *Id.* at 23–24. Petitioner does not address the *Becton, Dickinson* factors (c),(e), and (f) with respect to the Cisco IPR. *See* Pet. 85.

We have reviewed the Petition, and conclude that Petitioner has not demonstrated the Office erred in a manner material to the patentability of challenged claims in the Cisco IPR. *See* Pet. 85. Any error that Petitioner could allege is belied by the fact that the Petition presents the same prior art, same grounds, and the same arguments as those previously presented in the Cisco IPR, which proceeded to a Final Written Decision that held all of the challenged claims unpatentable. *Compare* Pet. 13–15, 24–80 *with*, Cisco IPR, Paper 2 at 18–79; *see* Cisco IPR, Paper 39.

In sum, we determine the same art and arguments previously were presented to the Board during the Cisco IPR, and that Petitioner has not demonstrated that the Board erred in a manner material to the patentability of challenged claims. For the foregoing reasons, we exercise our discretion under 35 U.S.C. § 325(d) and deny institution based on this Petition.

III. CONCLUSION

For the foregoing reasons, we exercise our discretion to deny institution of *inter partes* review under 35 U.S.C. § 325(d).

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is denied, and no trial is instituted.

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