

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARISTA NETWORKS, INC.,

Petitioner,

v.

ORCKIT CORPORATION,

Patent Owner.

Case No. IPR2024-01238

Patent 8,830,821 B2

**PETITIONER'S AUTHORIZED REPLY TO PATENT OWNER'S
ARGUMENTS UNDER 35 U.S.C. § 325(d)**

TABLE OF CONTENTS

	Page
PETITIONER’S EXHIBIT LIST	ii
I. DISCRETIONARY DENIAL IS INAPPROPRIATE UNDER <i>ADVANCED BIONICS</i>	1
II. INSTITUTION WOULD NOT DUPLICATE EFFORTS OR BE INEFFICIENT	5

PETITIONER’S EXHIBIT LIST

Ex[No.]	Description of Documents
1001	U.S. Patent No. 8,830,821 (“’821 Patent”) to Cohn et al.
1002	Prosecution File History of the ’821 Patent
1003	Declaration of Dr. Paul Min under 37 C.F.R. § 1.68
1004	Reserved
1005	U.S. Patent Application Publication No. 2004/0205239 by Doshi (“Doshi”)
1006	“Definitive MPLS Network Designs,” by Guichard Cisco Press, 2005 (“Guichard”)
1007	U.S. Patent Publication No. 2003/0117950 to Huang (“Huang”)
1008	“MATE: MPLS Adaptive Traffic Engineering” by Elwalid et al., IEEE, 2001
1009	“Traffic Engineering with MPLS,” by Osborne et al., Cisco Press, 2003
1010	“Fast Network Re-optimization Schemes for MPLS and Optical Networks” by Bhatia et al., 2006
1011	RFC 3209
1012	Complaint, <i>Orckit Corporation v. Arista Networks, Inc.</i> , Civil Action No. 1:23-cv-00821 (D. Del., Jul. 28, 2023)
1013	Federal Court Statistics
1014	Stipulation and Order to Stay Action, <i>Orckit Corporation v. Arista Networks, Inc.</i> , Civil Action No. 1:23-cv-00821 (D. Del., Dec. 4, 2023)
1015	Katherine K. Vidal, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)

Ex[No.]	Description of Documents
1016	U.S. Patent Publication No. 2008/0155257
1017	U.S. Patent No. 7,624,142
1018	U.S. Patent Publication No. 2006/0015781
1019	Definitive MPLS Network Designs Guichard, Copyright Public Record(s)
1020	Definitive MPLS Network Designs Guichard, Library of Congress Record(s)
1021	Internet Archive Affidavit, Definitive MPLS Network Designs (Guichard)
1022	RFC 3272
1023	“Multiprotocol Label Switching (MPLS) Traffic Engineering,” Cisco IOS Release 12.0(5)
1024	IETF “Multiple Metrics for Traffic Engineering with IS-IS and OSPF,” Fedyk et al.
1025	U.S. Patent Publication No. 2011/0141877 to Xu et al., (“Xu”)
1026	U.S. Patent No. 5,699,403 to Ronnen (“Ronnen”)
1027	RFC 2026
1028	U.S. Patent No. 8,102,774
1029	U.S. Patent Publication No. 2007/0201513
1030	RFC 3469
1031	U.S. Patent No. 6,980,906
1032	U.S. Patent No. 7,502,884
1033	U.S. Patent No. 7,197,418
1034	U.S. Patent Publication No. 2006/0250948

Ex[No.]	Description of Documents
1035	U.S. Patent Publication No. 2007/0047469
1036	U.S. Patent Publication No. 2006/0291391
1037	WO 2004/068799 by Ashwood Smith (“Ashwood Smith”)
1038	Declaration of Sylvia D. Hall-Ellis

Petitioner Arista Networks, Inc. (“Arista”) submits this authorized reply to Patent Owner’s (“PO”) arguments under 35 U.S.C. § 325(d). There is no merit to PO’s position that institution should be denied because the same or substantially the same prior art or arguments were previously presented to the Office in earlier IPRs. After Arista filed its petition challenging claims 1-20 of U.S. Patent No. 8,830,821 (the “’821 Patent”), claims 1-13 and 17-20 were found unpatentable in IPR2023-00402 (joined with IPR2024-00034) and subsequently cancelled. See EX3001. Accordingly, claims 14-16 remain at issue. Claims 14-16 are challenged under the petition’s Ground 3, which relies on a combination of prior art references—Doshi, Guichard, and Ashwood Smith—that was not considered in any prior IPR. Thus, there is no basis for denying institution under § 325(d).

I. Discretionary Denial Is Inappropriate Under *Advanced Bionics*

The first part of the Board’s two-part framework under § 325(d) considers whether the same or substantially the same art or arguments previously were presented to the Office. See *Advanced Bionics, LLC v. Med-El Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 8 (P.T.A.B. Feb. 13, 2020) (precedential). The references relied upon in Ground 3—Doshi, Guichard, and Ashwood Smith—were not considered, individually or in combination, during *ex parte* prosecution. Moreover, the Doshi-Guichard-Ashwood Smith combination was not considered in any prior IPR involving the ’821 Patent. Thus, part one of *Advanced Bionics* is not

satisfied and the Board should not deny institution. *See Verizon Connect Inc. v. Omega Patents, LLC*, IPR2023-01162, Paper 12 at 14 (P.T.A.B. Feb. 21, 2024) (“[A]lthough we agree that Flick ’885 was previously presented to the Office, we determine that the combination of Flick ’885 and Flick ’561 was not previously presented. Consequently, we determine that the same or substantially the same prior art or arguments were not previously presented to the Office[.]”).

Becton Dickinson factors (a), (b), and (d) do not support discretionary denial. The similarities and material differences between Arista’s Ground 3 and the art involved in the prior IPRs, and the extent of the overlap between the arguments, favors institution. As discussed, the Doshi-Guichard-Ashwood Smith combination has not been considered. The Board considered the Doshi-Guichard combination in IPR2023-00402 and concluded that it rendered claims 1-7, 9-11, 13, and 17-20 of the ’821 Patent obvious. Arista’s Ground 3 relies on Doshi and Guichard to teach elements of claims 14-16 that are substantially the same as elements the Board already found are taught by the Doshi-Guichard combination. This overlap between the art and arguments demonstrates the merits of Ground 3 and favors institution. Section 325(d) was never intended to bar a challenge already found meritorious.

The differences between Arista’s Ground 3 and the grounds in the prior IPRs also favor institution. Ashwood Smith was not presented to the Office in any prior IPR. As detailed in the petition and Arista’s request for Director review, Ashwood

Smith discloses “digital logic ... configured to determine a probability of concurrent failure of said working entity and said protection entity,” and it would have been obvious to combine its teachings with Doshi and Guichard to arrive at claims 14-16. *See* Paper 2 at 66-80; Paper 8. Ashwood Smith thus teaches the only limitation the Board found missing from Doshi and Guichard (and a tertiary reference, Xu) in the prior IPRs, which favors institution. *See* IPR2023-00402, Paper 40 at 66-67.

Regarding factor (b), PO’s argument that Ashwood Smith is cumulative of the Doshi-Xu combination asserted in the prior IPRs lacks merit. Paper 6 (“POPR”) at 17-19. Ashwood Smith teaches digital logic configured to determine a probability of concurrent failure because it expressly discloses a computer-implemented method “to take into account the actual probability of failure at a common point” shared by two paths and “to consider . . . a probability of failure at the common point” as part of path selection. EX1037, 10:21-11:9; Petition at 67; EX1003, ¶¶233-234. PO does not, and cannot, identify any corresponding disclosure in Doshi or Xu that would render Ashwood Smith’s teachings cumulative. POPR at 17-18. Indeed, PO does not attempt to compare disclosure in Xu—relied upon in prior IPRs to teach the above-discussed digital logic limitation—with Ashwood Smith. Rather, PO mischaracterizes statements in the petition to incorrectly argue that “Petitioner admits Ashwood Smith is cumulative of at least Doshi.” POPR at 17 (citing Paper 2 at 18, 66). A showing that Ashwood Smith and Doshi are in the same field of

endeavor and pertinent to the same problems as the '821 Patent, however, is not an admission that Ashwood Smith is cumulative for purposes of § 325(d).

PO's remaining arguments are unavailing and demonstrate that Ashwood Smith is not cumulative of Doshi. PO argues that "Doshi teaches a shorthand heuristic where it ignores the probability of concurrent failure for two disjoint paths" while Ashwood Smith discusses "the probability of failure for a single point" shared between two paths. POPR at 18. PO does not explain why one teaching is cumulative of the other (they are not) and instead relies on unsupported attorney argument that both references ignore the probability of concurrent failure (an argument that is directly contradicted by express disclosure in Ashwood Smith). POPR at 18. Ultimately, Ashwood Smith provides materially different teachings not found in Doshi or Xu and discretionary denial under § 325(d) is thus not appropriate.

Though the Board need not reach them because part one of the *Advanced Bionics* test is not satisfied, *Becton Dickinson* factors (c), (e), and (f) also favor institution. The Board considered the Doshi-Guichard combination in the prior IPRs and correctly found that it taught all elements of claims 1-7, 9-11, 13, and 17-20 of the '821 Patent, including elements in claims 14-16. Through no fault of its own, because Ashwood Smith was not in front of it at the time, the Office erred by allowing claims 14-16 despite all elements being taught by the Doshi-Guichard-Ashwood Smith combination. The additional evidence and facts presented in the

petition—including the disclosure in Ashwood Smith and the analysis provided by Arista’s expert, Dr. Min—warrant reconsideration of Doshi and Guichard in view of Ashwood Smith in the context of claims 14-16.

II. Institution Would Not Duplicate Efforts or Be Inefficient

PO’s argument that institution “would require the Board to devote significant resources to entertain nearly the same arguments” from prior IPRs lacks merit. POPR at 14. The scope of this proceeding has been narrowed precisely because Doshi and Guichard teach the bulk of the claimed subject matter, and PO is now precluded from making arguments inconsistent with the final written decision in the prior IPRs. 37 C.F.R. § 42.73(d)(3). Considering Ashwood Smith, as it relates to claims 14-16, in combination with Doshi and Guichard would not duplicate any earlier efforts and would be a good use of Board resources. The public and market participants benefit from clarity regarding the scope of enforceable patent rights. Exercising discretion as to claims 14-16 without reaching the merits—particularly when all other claims of the ’821 Patent have already been found unpatentable—creates lingering uncertainty and undermines the goal of providing clear notice to the public. Completing the review ensures transparency, promotes confidence in the patent system, and conserves future judicial and administrative resources.

Respectfully Submitted,

June 25, 2025

/Eliot D. Williams/
Eliot D. Williams (Reg. No. 50,822)

BAKER BOTTS L.L.P.
700 K Street, N.W.
Washington, D.C. 20001-5692
Tel: 202-639-1334
eliot.williams@bakerbotts.com

*Attorneys for Petitioner, Arista Networks,
Inc.*

CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on June 25, 2025, a complete and entire copy of the **PETITIONER’S AUTHORIZED REPLY TO PATENT OWNER’S ARGUMENTS UNDER 35 U.S.C. § 325(d)** was served on Patent Owner via email at the correspondence addresses below:

James T. Carmichael
jim@carmichaelip.com

Stephen McBride
stevemcbride@carmichaelip.com

Minghui Yang
mitch@carmichaelip.com

ORCKIT-IPRS@CARMICHAELIP.COM

Date: June 25, 2025

/Eliot D. Williams/
Eliot D. Williams (Reg. No. 50,822)
BAKER BOTTS L.L.P.
700 K Street, N.W
Washington, D.C. 20001-5692
Tel: 202-639-1334
eliot.williams@bakerbotts.com

*Attorneys for Petitioner, Arista Networks,
Inc.*