

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

ARISTA NETWORKS, INC.,

Petitioner,

v.

ORCKIT CORPORATION,

Patent Owner.

Case No. IPR2024-01239
U.S. Patent No.: 10,652,111 B2

**JOINT MOTION TO TERMINATE *INTER PARTES* REVIEW OF
U.S. PATENT NO. 10,652,111 UNDER 35 U.S.C. § 317 AND 37 C.F.R. §
42.72**

Submitted Electronically

PETITIONER'S EXHIBIT LIST

Ex[No.]	Description of Documents
1001	U.S. Patent No. 10,652,111 (“’111 Patent”)
1002	Declaration of Paul Min, Ph.D.
1003	Prosecution File History of the ’111 Patent
1004	Reserved
1005	U.S. Patent No. 10,097,452 (“Lefebvre”)
1006	U.S. Patent No. 9,264,301 (“Chua”)
1007	U.S. Patent No. 9,813,447 (“Rash”)
1008	M. Liao, et al., “Design and Evaluation of Deep Packet Inspection System: A Case Study,” IET Networks, pp. 1-8 (2012)
1009	A. W. Moore and K. Papagiannaki, “Toward the Accurate Identification of Network Applications,” In: PAM, Springer, vol. 5, pp. 41-54 (2005)
1010	RFC 3654 (available at https://www.rfc-editor.org/rfc/rfc3654)
1011	W. Xia, et al., “A Survey on Software-Defined Networking,” IEEE Communication Surveys & Tutorials, Vol. 17, No. 1, pp. 27-51 (June 13, 2014)
1012	RFC 3746 (available at https://www.rfc-editor.org/in-notes/rfc3746.txt)
1013	N. McKeown, et al., “OpenFlow: Enabling Innovation in Campus Networks,” ACM SIGCOMM Computer Communication Review, vol. 38, No. 2, pp. 69-74 (April 2008)
1014	Steven Levy, “Going with the Flow: Google’s Secret Switch to the Next Wave of Networking” (April 17, 2012) (available at https://www.wired.com/2012/04/going-with-the-flow-google/)

Ex[No.]	Description of Documents
1015	RFC 793 (available at https://www.rfc-editor.org/rfc/pdf/rfc793.txt.pdf)
1016	“About the Open Networking Foundation”
1017	“Open Networking Foundation Specifications,” (available at https://opennetworking.org/software-defined-standards/specifications/)
1018	“OpenFlow Switch Specification”
1019	RFC 5810 (available at https://www.rfc-editor.org/rfc/rfc5810.html)
1020	Declaration of Sylvia D. Hall-Ellis, Ph.D.
1021	Federal Court Statistics
1022	Complaint, <i>Orckit Corporation v. Arista Networks, Inc.</i> , Civil Action No. 1-23-cv-00821 (D. Del., Jul. 28, 2023)
1023	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)
1024	Katherine K. Vidal, Interim Procedure for Discretionary Denials in AIA Post-Grant Proceedings with Parallel District Court Litigation (June 21, 2022)
1025	RFC 2026
1026	U.S. Patent Application Publication No. 2007/0094411 by Mullane (April 26, 2007)
1027	OpenFlow Switch Specification, Version 1.1.0 (available at https://opennetworking.org/wp-content/uploads/2014/10/openflow-spec-v1.1.0.pdf)
1028	Transcript of Deposition of Miguel Gomez (August 29, 2025)

Ex[No.]	Description of Documents
1029	Errata Sheet of Dr. Paul Min, Ph.D., for Transcript of Deposition held on May 30, 2025
1030	Confidential Settlement Agreement

Pursuant to 35 U.S.C. § 317(a), 37 C.F.R. § 42.72, and 37 C.F.R. § 42.74, Petitioner Arista Networks, Inc. (“Arista”) and Patent Owner Orckit Corporation (“Orckit”) (collectively, the “Parties”) jointly move to terminate the above-captioned *inter partes* review proceeding pursuant to the Parties’ settlement of their dispute related to the challenged patent, U.S. Patent No. 10,652,111 B2 (the “’111 Patent”). This joint motion was authorized by the Board in its email dated October 31, 2025.

Pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(b), Petitioner and Patent Owner submit concurrently herewith a true and correct copy of the Confidential Settlement Agreement governing the resolution of this *inter partes* review and the underlying litigation. See Exhibit 1030. There are no other agreements, written or oral, between the Parties made in connection with, or in contemplation of, the termination of this proceeding.

The parties are concurrently filing a joint request that the Confidential Settlement Agreement be treated as business confidential information, be kept separate from the file of the involved patent, and be made available only to Federal Government agencies on written request, or to any person on a showing of good cause pursuant to 35 U.S.C. § 42.74(c). In view of that request, Exhibit 1030 has been filed as available to “Parties and Board Only.”

I. ARGUMENT

A joint motion to terminate generally must “(1) include a brief explanation as to why termination is appropriate; (2) identify all parties in any related litigation involving the patents at issue; (3) identify any related proceedings currently before the Office; and (4) discuss specifically the current status of each such related litigation or proceeding with respect to each party to the litigation or proceeding.” *Heartland Tanning, Inc. v. Sunless, Inc.*, IPR2014-00018, Paper 26 at 2 (P.T.A.B. July 28, 2014).

a. Brief Explanation as to Why Termination Is Appropriate

Good cause exists to terminate this proceeding. “The Board expects that a proceeding will terminate after the filing of a settlement agreement, unless the Board has already decided the merits of the proceeding.” Patent Trial and Appeal Board Consolidated Trial Practice Guide (Nov. 2019) at 86; *see also id.* (“There are strong public policy reasons to favor settlement between the parties to a proceeding.”); 35 U.S.C. § 317(a) (“An inter partes review instituted under this chapter shall be terminated with respect to any petitioner upon the joint request of the petitioner and the patent owner, unless the Office has decided the merits of the proceeding before the request for termination is filed”). Here, the Parties respectfully submit that termination is appropriate because they have reached an agreement that resolves all disputes between the Parties involving the ’111 Patent at issue in the above-

captioned *inter partes* review and the Parties have not completed briefing in this proceeding. See EX1030. The Parties stipulated to November 10, 2025, as the due date of Patent Owner's Sur-reply. See Paper 25. The Board has not held oral argument, decided the merits of the proceeding, or issued a final written decision. The Parties agree that neither Petitioner nor Patent Owner will be prejudiced by termination of this proceeding. Terminating the proceeding now would serve the interests of judicial economy as well as the mutual interest of the Parties.

Pursuant to 37 C.F.R. § 42.74(b), the Parties acknowledge that, as of the filing of this Motion, Exhibit 1030 represents the entire agreement or understanding between the Parties made in connection with, or in contemplation of, the termination of this proceeding, and further, that Exhibit 1030 is a true and accurate copy of the agreement between the Parties that resolves the present proceeding. The Parties certify that there are no other written or oral agreements or understandings, including any collateral agreements, between them, including but not limited to licenses, covenants not to sue, confidentiality agreements, payment agreements, or other agreements of any kind that have been made in connection with or in contemplation of the termination of the instant proceeding.

b. Identification of Parties and Status of Litigation

The underlying district court litigation between the Parties, captioned *Orckit Corporation v. Arista Networks, Inc.*, No. 1:23-cv-00821 (D. Del.), is stayed and

will be dismissed by stipulation pursuant to the Parties' Confidential Settlement Agreement. Patent Owner is the plaintiff in the district court litigation. Petitioner is the named defendant in the district court litigation and the only Petitioner in this proceeding, meaning that this proceeding can be terminated in its entirety pursuant to this motion.

The '111 Patent is at issue in other litigation not involving Arista. In particular, the '111 Patent is at issue in *Orckit Corporation v. Juniper Networks Inc.*, Case No. 1-23-cv-00822 (D. Del.), which is currently stayed pending the outcome of this *inter partes* review. See *Orckit Corporation v. Juniper Networks Inc.*, No. 1-23-cv-00822, Dkt. 18, 19 (D. Del.) (Apr. 7, 2025). The '111 Patent is also at issue in *Orckit Corporation v. Cisco Systems, Inc.*, Case No. 2-25-cv-00181 (E.D. Tex.), which is pending. At least because Arista is not a party to the other pending litigations involving the '111 Patent, and because the Parties have settled their dispute regarding the '111 Patent, the Parties respectfully submit that termination of this proceeding is appropriate.

c. Identification and Status of Proceedings Before the USPTO

The Parties have now resolved their dispute and reached agreement to terminate this proceeding as well as *inter partes* review proceeding IPR2024-01238 (concerning U.S. Patent No. 8,830,821). The Parties are also jointly moving to terminate IPR2024-01238. The USPTO can conserve its resources by terminating

now, removing the need for the Board to further consider the arguments and to render a Final Written Decision.

Therefore, for the foregoing reasons, the parties jointly and respectfully request termination of the present proceeding, IPR2024-01239, without prejudice to either party.

Respectfully submitted,

Date: November 3, 2025

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CERTIFICATE OF SERVICE

In accordance with 37 C.F.R. § 42.6(e), the undersigned certifies that on November 3, 2025, a complete and entire copy of the **JOINT MOTION TO TERMINATE INTER PARTES REVIEW OF U.S. PATENT NO. 10,652,111 UNDER 35 U.S.C. § 317 AND 37 C.F.R. § 42.72** and Exhibit 1030 were served on Patent Owner via email at the following correspondence addresses:

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