

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

JUNIPER NETWORKS, INC.,
Petitioner,

v.

ORCKIT CORPORATION,
Patent Owner.

IPR2024-00895
Patent 10,652,111 B2

Before KRISTEN L. DROESCH, NATHAN A. ENGELS, and
BRENT M. DOUGAL, *Administrative Patent Judges*.

DOUGAL, *Administrative Patent Judge*.

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

I. INTRODUCTION

A. *Background and Summary*

Petitioner, Juniper Networks, Inc., requests that we institute an *inter partes* review challenging the patentability of claims 32–54 (the “challenged claims”) of U.S. Patent 10,652,111 B2 (Ex. 1001, “the ’111 patent”). Paper 2 (“Petition” or “Pet.”). Patent Owner, Orckit Corp., argues that Petitioner’s request, which is the second petition filed by Petitioner against the ’111 patent, should be denied. Paper 9 (“Preliminary Response” or “Prelim. Resp.”).

For the reasons discussed below, we determine that it is appropriate to exercise our discretion under § 314(a) to deny the Petition.

B. *Related Matters*

The parties identify the following related district court litigation: *Orckit Corp. 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.); and *Orckit Corporation v. Juniper Networks, Inc.*, No. 1:23-cv-00822 (D. Del.). Pet. xii; Paper 3, 1.

The parties identify the following related matters before the USPTO: *Ex Parte* Reexamination Control No. 90/015,261; IPR2023-00554 (“Cisco IPR”); and IPR2024-00037. *Id.*; Pet. xii.

C. *The ’111 Patent*

The ’111 patent is titled “Method and System for Deep Packet Inspection in Software Defined Networks.” Ex. 1001, code (54). Deep Packet Inspection (“DPI”) is a technique for examining network communications that can be used to extract data patterns from a data communication channel. *Id.* at 1:21–25. The extracted data patterns are

useful for a variety of purposes, including network security and data analytics. *Id.*

D. Evidence

Petitioner’s grounds of unpatentability rely on the following evidence:

Name	Patent Document	Exhibit¹
Lefebvre	US 10,097,452 B2 (Oct. 9, 2018)	1005
Chua	US 9,264,301 B1 (Feb. 16, 2016)	1006
Rash	US 9,813,447 B2 (Nov. 7, 2017)	1007

E. Asserted Grounds

Petitioner asserts the following grounds of unpatentability (Pet. 2), supported by the declaration of Dr. Nader R. Mir. (Ex. 1003):

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
32–36, 39–54	103	Lefebvre, Chua
37–38	103	Lefebvre, Chua, Rash

II. DISCRETION UNDER 35 U.S.C. § 314(A)

Patent Owner contends the Board should exercise its discretion to deny institution under 35 U.S.C. § 314, citing the discretionary-denial factors articulated in *General Plastic Industries Co., Ltd. v. Canon Kabushiki Kaisha*, IPR2016-01357, Paper 19 (PTAB Sept. 6, 2016) (precedential as to § II.B.4.i) (“*General Plastic*”). Prelim. Resp. 7–23.

The Director has discretion to deny institution of an *inter partes* review, which discretion has been delegated to the Board. *See* 35 U.S.C. § 314(a); 37 C.F.R. § 42.4(a); *SAS Inst. v. Iancu*, 584 U.S. 357, 366 (2018)

¹ Throughout our Decision, we refer to “Corrected” exhibits 1000–1019. Petitioner’s original exhibits were filed without page numbers, but have since been correctly refiled. *See* Papers 5, 7.

(“[Section] 314(a) invests the Director with discretion on the question whether to institute review” (emphasis omitted)).

In *General Plastic*, the Board set forth a non-exhaustive list of factors to consider in evaluating whether to exercise discretion, under § 314(a), to deny a petition challenging a patent previously challenged before the Board. Those factors include:

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 16 (citing *NVIDIA Corp. v. Samsung Elecs. Co.*, IPR2016-00134, Paper 9 at 6–7 (PTAB May 4, 2016)). These factors are “a non-exhaustive list” and “additional factors may arise in other cases for consideration, where appropriate.” *Id.* at 16, 18.

When a petitioner files more than one petition covering the same patent, we encourage the petitioner to provide:

(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).

Consolidated Trial Practice Guide, 59–60 (Nov. 2019).² Petitioner does address the *General Plastic* factors, but does not expressly address the additional considerations highlighted above from the Consolidated Trial Practice Guide, or provide a ranking of the petitions. *See* Pet. 80–81.

We now consider the *General Plastic* factors enumerated above, and ultimately exercise our discretion to deny institution.

A. Factor 1

The first *General Plastic* factor asks “whether the same petitioner previously filed a petition directed to the same claims of the same patent.” *General Plastic* at 16. Petitioner acknowledges that it previously filed a petition directed to certain claims of the ’111 patent. Pet. 80.

However, Petitioner argues that the same claims are not involved in both petitions. *Id.* Petitioner argues that “[t]he petition in IPR2024-00037 mirrored Cisco’s [IPR2023-00554] for purposes of joinder and couldn’t challenge claims 32-54 in that proceeding.” *Id.* Petitioner further asserts that “claims 32-54 . . . don’t relate to claims 1-31.” *Id.*

Petitioner does not provide any analysis to support its assertion that claims 32–54 do not relate to claims 1–31. Patent Owner responds that in fact, “[t]he claims [Petitioner] seeks to challenge with its second petition are

² Available at <https://www.uspto.gov/TrialPracticeGuideConsolidated>.

either identical to or have no material differences in scope from the claims at issue in [the] first petition.” Prelim. Resp. 9–10. We agree with Patent Owner.

A quick comparison of independent claims 1 and 32, as provided by Patent Owner, reveals the inaccuracy of Petitioner’s assertion

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
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.

Id. at 10–11.

As can be seen above, claims 1 and 32 are substantially similar in scope. Notably the above chart does not include claim 1's requirement of "sending, by the controller to the network node over the packet network, an instruction and a packet-applicable criterion." Ex. 1001, 10:56–58. However, like claim 1, claim 32 also requires that the network node "receiv[e] from the controller, the instruction and the criterion." *Id.* at 13:13–14; *see id.* at 10:59–60 (claim 1). Thus, we agree with Patent Owner that there is no material difference between independent claims 1 and 32.

Patent Owner also compares the claim language of claims 33, 34, 36–47, and 50–54 to claims 2, 3, 5, 7, 8, 16–24, 27–31. Prelim. Resp. 11–16. This chart shows that these claims, that Petitioner asserts are not "relate[d] to claims 1-31," are actually identical, except that they depend from claim 32. Similarly, claims 48–49 are identical to claims 25–26, with the exception of their dependencies. *See* Ex. 1001, 12:46–50, 14:35–39. Finally, dependent claim 35 is substantially similar to claim 4 with no material differences in essentially the same way as claims 1 and 32 discussed above, again, with the exception of its dependency. *Id.* at 11:17–26, 13:35–41.

Thus, under the first *General Plastic* factor, we determine that the same petitioner previously filed a petition directed to materially³ the same claims of the '111 patent, as all claims include language that is either identical to previously challenged claims or is not materially different from the previously challenged claims.

³ As noted above, *General Plastic* outlines "a non-exhaustive list" of factors and thus encourages a flexible approach to the analysis. *General Plastic* at 16, 18.

B. Factor 2

The second factor asks whether, at the time of filing (October 11, 2023) the petition in IPR2024-00037, Petitioner knew or should have known of the references asserted in this Petition. *General Plastic* at 16. The Petition states that “Petitioner wasn’t aware of Lefebvre, Chua, and Rash at the first petition’s filing.” Pet. 80. Petitioner does not cite any evidence in support of this statement, or provide any details of when it became aware of Lefebvre, Chua, or Rash.

Patent Owner provides evidence that Petitioner was aware of Lefebvre, Chua, and Rash before filing IPR2024-00037. Prelim. Resp. 18–20. Patent Owner provides evidence that Petitioner was aware of Lefebvre “at least as early as . . . 2017.” *Id.* at 18 (citing Exs. 2001; 2002, 57; 1005, 1) (discussing how the application publication that became Lefebvre was cited in a rejection by a patent examiner in the prosecution of Petitioner’s patents). Patent Owner provides evidence that Petitioner was aware of Rash at least as early as 2016. Ex. 2004, 323–326; *see also* Prelim. Resp. 19 (citing Exs. 2003; 2004, 326; 1007, 1) (discussing how Rash was similarly cited against Petitioner’s patents). Patent Owner provides evidence that Petitioner was aware of the disclosure of Chua at least as early as 2020. Ex. 2006, 68–70; *see also* Prelim. Resp. 19 (citing Exs. 2005; 2006, 70; 1006, 1) (discussing how a patent (Ex. 2007) in the same family as Chua was similarly cited against Petitioner’s patents).

Thus, we agree with Patent Owner that at the time of filing (October 11, 2023) the petition in IPR2024-00037, Petitioner knew of Lefebvre and Rash, and knew of the disclosure of Chua, if not Chua itself. We note that this knowledge of the references may be in a different context than the present *inter partes* review, however, Petitioner provides no

evidence to support its arguments concerning this factor. Thus, the only evidence shows that Petitioner was aware of these references.

C. Factor 3

The third *General Plastic* factor asks whether Petitioner had already received Patent Owner's preliminary response or our institution decision in IPR2024-00037 prior to filing the present Petition. *General Plastic* at 16.

The institution decision in IPR2024-00037 was issued on March 26, 2024. At that time, IPR2024-00037 was also joined to the Cisco IPR. In the joint proceeding, the Patent Owner Response was filed on January 15, 2024, and the Petitioner's Reply was filed April 8, 2024.

The Petition here was filed on May 6, 2004, after all of these events.

Thus in IPR2024-00037, not only had Petitioner already received Patent Owner's preliminary response and our institution decision, but all other papers other than the Patent Owner Sur-reply had been filed.

D. Factor 4

The fourth *General Plastic* factor asks us to consider the length of time that elapsed between the time Petitioner learned of the prior art asserted here and the filing of the present Petition. *General Plastic* at 16.

Petitioner asserts that "[a]fter discovering Lefebvre, Chua, and Rash, Petitioner diligently worked to prepare and file this Petition." Pet. 80. Petitioner does not cite any evidence in support of this statement, or provide any details on when it became aware of Lefebvre, Chua, or Rash.

As discussed above under factor 2, Patent Owner's evidence shows that Petitioner was aware of the cited references for some years before filing of the present Petition. Petitioner provides no evidence that Petitioner was diligent in its preparation of the present Petition.

E. Factor 5

The fifth *General Plastic* factor asks “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.” *General Plastic* at 16.

Petitioner states that “Patent Owner filed its complaint on July 31, 2023” and that for purposes of joinder it “couldn’t challenge claims 32-54 in” the prior proceeding. Pet. 80. Petitioner states that its first petition was filed on October 11, 2023. *Id.* As noted above, Petitioner asserts that “[a]fter discovering Lefebvre, Chua, and Rash, Petitioner diligently worked to prepare and file this Petition.” Petitioner does not otherwise address the time between October 11, 2023 and May 6, 2004, when the present Petition was filed.

As discussed above, under factor 2, Patent Owner’s evidence shows that Petitioner was aware of the cited references for some years before filing of the present Petition. Thus, Petitioner does not provide adequate explanation for the time elapsed between the filings of the two petitions.

F. Factor 6

The sixth *General Plastic* factor addresses “the finite resources of the Board.” *General Plastic* at 16. In support of its argument Petitioner argues “[b]ecause this Petition challenges claims 32-54 of the ’111 Patent, which don’t relate to claims 1-31, the finite resources of the Board aren’t implicated.” Pet. 80.

As discussed above under factor 1, we determine that the challenged claims are materially the same as the claims previously challenged by Petitioner. We further determine that addressing the same claim language and at least some of the same or similar issues as already addressed in the

prior IPR2024-00037, in which a final written decision has already issued (IPR2024-00037, Paper 12), would not be an efficient use of Board resources.

G. Factor 7

The last *General Plastic* factor pertains to the requirement under 35 U.S.C. § 316(a)(11) that we must issue a final determination within one year of institution. *General Plastic* at 16. Petitioner argues that “nothing prevents issuance of the final written decision within a year of institution.” Pet. 80.

Because the final written decision has already issued in IPR2024-00037, there is no possibility of the present proceeding being consolidated with IPR2024-00037. As a result, this proceeding did not impact the Board’s ability to timely issue a final determination in IPR2024-00037. Further, this proceeding would have its own schedule, and we see no reason why the Board would not be able to timely issue a final determination in the current circumstance.

H. Conclusion

The first six *General Plastic* factors favor exercising our discretion to deny institution and the last factor is neutral. Therefore, based on our assessment of these factors, we exercise our discretion to deny institution of *inter partes* review.

III. CONCLUSION

For the reasons above, we exercise our discretion under 35 U.S.C. § 314(a) to deny institution of *inter partes* review.

IV. ORDER

Accordingly, it is:

ORDERED that the Petition is *denied*, and no *inter partes* review is instituted.

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