

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FINISAR CORP.
Petitioner

v.

THOMAS SWAN & CO. LTD.
Patent Owner

Case IPR2014-00460
Patent 7,145,710

PRELIMINARY RESPONSE BY PATENT OWNER UNDER 37 C.F.R. § 42.107

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EXHIBIT LIST

- TS 2001 PCT Publication WO 01/90823 A1
- TS 2002 U.S. Patent No. 6,975,786
- TS 2003 Joint Claim Construction and Prehearing Statement, Thomas Swan & Co. Ltd. V. Finisar Corp., 2:13-cv-178 (E.D. Texas).
- TS 2004 Fiber Optics Standard Dictionary, 3rd Edition (1997) (“Fiber Optics Standard Dictionary”)
- TS 2005 B. Bahadur, Liquid Crystals - Applications and Uses (Vol. 3), World Scientific (1996) (“Bahadur”)

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Patent Owner Thomas Swan & Co. Ltd. ("Patent Owner") submits this Preliminary Response to the Petition seeking inter partes review ("IPR") in this matter. It is being filed within three months of the March 7, 2014 mailing date of the Notice according the Petition a filing date of February 26, 2014, and is thereby timely under 35 U.S.C. § 313 and 37 C.F.R. § 42.107.¹ A trial should not be instituted because the Petition does not establish a reasonable likelihood of Petitioner prevailing with respect to the challenged claims of the U.S. Patent No. 7,145,710 (the '710 patent) as required by 37 CFR § 42.108(c).

I. Overview

The '710 patent contains 14 claims, of which 3 claims are independent. Notably, this IPR Petition stems from the ongoing litigation in which Finisar is accused of infringing only certain dependent claims of the '710 patent. Therefore, to streamline issues for the Board at this stage, this Preliminary Response specifically focuses on the litigated claims. Patent Owner does not concede that the remaining claims addressed in the IPR are unpatentable and will address their patentability in more detail if the Patent Trial and Appeal Board ("PTAB") institutes an IPR trial.

With respect to certain litigated claims, the Petition proposes several grounds of unpatentability. The grounds are based two alternative and generally cumulative primary

¹ Because June 7, 2014 and June 8, 2014 fall on a Saturday and a Sunday, respectively, the timely filing deadline for this Preliminary Response is June 9, 2014.

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