

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FINISAR CORPORATION

Petitioner

v.

THOMAS SWAN & CO. LTD.

Patent Owner

Inter Partes Review Case No. Unassigned

**PETITION FOR *INTER PARTES* REVIEW OF U.S. PATENT NO. 8,335,033
UNDER 35 U.S.C. §§ 311-319 AND 37 C.F.R. §§ 42.1-.80, 42.100-.123**

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I. INTRODUCTION

Petitioner Finisar Corporation (“Finisar”) request *inter partes* review of claims 1, 29, 60, 63 66, 71-73, 76 and 91 of U.S. Patent No. 8,335,033 (“the ’033 patent”) (Ex. 1001), assigned on the face of the patent to Thomas Swan & Co. Ltd. (“Thomas Swan”). The claims of the ’033 patent are generally directed to “optical processors” that use a “dispersion device” to disperse light beams of multiple frequencies into channels and a “focussing device” to focus the light onto a two-dimensional spatial light modulator (“SLM”) having an “array of controllable elements. “ The optical processor includes circuitry that displays “holograms” on the SLM in order to control the direction of light emerging from the SLM. The technology claimed in the ’033 patent has applications in fiber optic communications. The original patent application that led to the issuance of the ’033 patent was filed in the United Kingdom on September 3, 2001.

As explained further below, the named inventor on the ’033 patent, Melanie J. Holmes, improperly claimed as her own subject matter that was previously developed and published by her former colleagues at the University of Cambridge (“Cambridge”). For about a decade prior to the filing of the priority application in 2001, students and researchers at Cambridge, working in Professor William Crossland’s Photonics & Sensors group, had investigated and published research relating to the use of liquid crystal SLMs for performing all kinds of optical

functions for use in optical communication and other applications. This work is well documented and described in numerous publications emanating from Prof.

Crossland's group in the 1990s. See Ex. 1014, <http://www->

[g.eng.cam.ac.uk/photronics_sensors/people/bill-crossland.htm](http://www-eng.cam.ac.uk/photronics_sensors/people/bill-crossland.htm) (biography of Prof.

Crossland: "Bill Crossland held the position of Group Leader of the Photonics &

Sensors Group . . . from 1992 . . . until his retirement at the end of September 2009. .

. He is generally regarded as the founding father of liquid crystal over silicon

(LCOS) technologies.") and Ex. 1015, <http://www->

[g.eng.cam.ac.uk/photronics_sensors/publications/index.htm](http://www-eng.cam.ac.uk/photronics_sensors/publications/index.htm) (providing an exemplary

listing of publications from the Photonics & Sensors group).

In the years prior to the filing of the U.K. priority application, Dr. Holmes collaborated with Cambridge on the development and use of liquid crystal SLMs for optical beam routing and other applications. The collaboration began in at least 1995 (Ex. 1010) (article entitled "Low Crosstalk Devices for Wavelength-Routed Networks," by M. J. Holmes, W. Crossland *et al.*, IEE Colloquium on Guided Wave Optical Signal Processing, IEE Dig. No. 95-128 London, UK) and continued through at least 2001 (Ex. 1011) (article entitled "Holographic Optical Switching: The 'ROSES' Demonstrator," by W. A. Crossland, K.L. Tan, M.J. Holmes *et al.*, *Journal of Lightwave Technology*, Vol. 18, No. 12, Dec. 2000, at 1845-54). During this time, there were three particular students that worked in Prof. Crossland's group that are

relevant to this petition: Michael C. Parker, Stephen T. Warr and Kim L. Tan. Each of these students conducted research relating to liquid crystal SLMs for use in optical routing that culminated in Ph.D. dissertations published by Cambridge. These three Ph.D. dissertations form the basis of this petition along with a United States patent application filed by Prof. Crossland, each of which are prior art under either § 102(b) or § 102(e).

As explained further below, it is apparent that Dr. Holmes claimed as her own the work of Drs. Parker, Warr, and Tan and Prof. Crossland after learning about their research through her collaboration with Cambridge. A review of the publication history of the Cambridge group preceding Dr. Holmes's U.K. priority application makes clear that the researchers in the group worked closely together—sometimes even in the same laboratory using the same devices—and openly shared their ideas with each other. In addition, these researchers frequently cite each other's work in their publications. Thus, by the time of Dr. Holmes filed her U.K. priority application, a person having ordinary skill in the art ("PHOSITA"¹) would have understood that the inventions claimed in the '033 patent were rendered obvious by the prior work of others at Cambridge. Given the working environment at Cambridge and the long history of cross-cited publications, a PHOSITA would have

¹ All references to the knowledge or understanding of a PHOSITA are as of September 3, 2001 unless otherwise specified.

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