

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Cisco Systems, Inc.
Petitioner

v.

Capella Photonics, Inc.
Patent Owner

Patent No. RE42,368
Filing Date: June 15, 2010
Reissue Date: May 17, 2011

Title: RECONFIGURABLE OPTICAL ADD-DROP MULTIPLEXERS WITH
SERVO CONTROL AND DYNAMIC SPECTRAL POWER MANAGEMENT
CAPABILITIES

Inter Partes Review No. 2014-01166

**Petitioner's Request for Authorization to File Motion to Submit Supplemental
Information Under 37 C.F.R. § 42.123(a)**

Petitioner requests authorization under 37 C.F.R. § 42.123(a) to file a motion to submit supplemental information relevant to a claim for which the trial has been instituted. Because the date to request authorization is prior to the initial conference call with the Board, Petitioner makes this motion here instead of during that call. Petitioner expects shortly to jointly request a call with the Board. Petitioner requests authorization to file a motion to submit the following supplementation information, the need for which is outlined briefly below:

1. Patent Owner's ("PO") interrogatory responses on alleged conception, diligence and reduction to practice. PO served these responses as part of the related District Court litigation, *Capella Photonics, Inc. v. Cisco Systems, Inc.*, Case Nos. 3:14-cv-03348, -3349, -3350, -3351-EMC (N.D. Cal., 2014) (the "Related Cases"). This information is relevant to the PO's expected attempt to swear behind the currently-asserted prior art in this IPR.
2. Documents referenced in PO's interrogatory responses regarding priority dates. This information is also relevant to the issues of alleged conception and reduction to practice.

3. The parties' Joint Claim Construction and Prehearing Statement in the Related Cases. This information is relevant to the BRIs that the PO indicated it will pursue in its Preliminary response.
4. PO's infringement contentions in the Related Cases. This information is also relevant to the BRIs in this IPR.
5. Expected deposition testimony and documents of party and third-party witnesses regarding alleged conception, diligence and reduction to practice. These witnesses are expected to include the named inventors on the RE42,368 patent at issue in this IPR.¹ This information is relevant to the priority date of the patent at issue in this IPR.

This request meets the requirements of 37 C.F.R. § 42.123(a) – specifically:

- (1) this request is being made within one month of the trial institution date of January 30, 2015; and
- (2) the supplemental information is relevant to a claim (i.e., claim 1) for which the trial has been instituted.

Petitioner's request for authorization to file a motion to submit supplemental information should be granted because:

¹ As discussed below, Petitioner plans to separately request the Board's permission to take discovery of the named inventors of the RE42,368 patent to refute Patent Owner's expected claims to an earlier priority date for that patent.

1. The information that Petitioner proposes to submit, above, was not available to Petitioner when the Petition was filed.
2. PO's interrogatory responses were not served until January 16, 2015. Those responses for the first time revealed PO's intent to claim an August 31, 2000, priority date for the '368 patent. PO contends that this date is earlier than the currently-asserted prior art. The allegedly-supporting evidence for this date is uniquely in the possession of PO and prior PO employees. In the interests of justice, Petitioner must be able to explore and test these allegations and the evidence behind them.
3. The District Court's schedule has not yet opened up discovery on the issues of alleged conception and reduction to practice. And Petitioner expects that the Related Cases will soon be stayed in favor of this proceeding. Thus, this proceeding is the sole opportunity for Petitioner to take this discovery prior to the IPR trial.
4. Third party discovery will be especially important in this IPR. This discovery is important because the only independent individuals of whom Petitioner is aware who could refute PO's priority claims are people such as the named inventors of the '368 patent who no longer work for PO. There may also be a need for discovery from other third parties depending on what

the PO relies upon. For example, PO indicated previously that information relevant to priority dates may be in the sole possession of the named inventor's prior employers.

5. Petitioner appreciates that the need for information regarding priority date issues is contingent on the positions that PO eventually takes in its response. However, it appears that PO will attempt to back-date the prior art. Thus, given the short time-to-trial and the time it takes to obtain and enforce third-party subpoenas, starting the discovery process now will help prevent scheduling delays in this IPR and prejudice to the Petitioner.
6. PO produced documents regarding priority date issues after the Petition was filed. Petitioner requested on February 4, 2015, that PO de-designate (under the Protective Order in the Related Cases) those documents. PO referenced those documents in its interrogatory responses regarding alleged conception, diligence and reduction to practice in the Related Cases. Petitioner made its request in order to allow Petitioner to submit those documents in this proceeding. As of the filing of this motion, PO still had not provided a response as to whether it would de-designate the documents.
7. Although PO served its Infringement Contentions prior to the filing of the Petition, it was not until after the Petition that PO said that it was accusing

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