

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

CAPELLA PHOTONICS, INC.,
Patent Owner.

Case IPR2014-01166
Patent RE42,368

Before JOSIAH C. COCKS, KALYAN K. DESHPANDE, and
JAMES A. TARTAL, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge*.

ORDER

Conduct of the Proceeding
37 C.F.R. § 42.5

An initial conference call took place on March 5, 2015. The parties were represented by their respective counsel. Administrative Patent Judges Cocks, Deshpande, and Tartal participated.

1. Petitioner's Request for Authorization to File Motion to Submit Supplemental Information (Paper 10)

Petitioner requested authorization to file a motion to submit supplemental information pursuant to 37 C.F.R. § 42.123(a). Petitioner identified the general nature of the information as (1) documents filed in the related district court proceeding, or referenced in those filings, and (2) “[e]xpected deposition testimony and documents of party and third-party witnesses.” Paper 10, 1–2. Patent Owner opposed the request for authorization to file a motion. Petitioner’s request concerning “expected” deposition testimony and documents was denied as premature and speculative because the information sought to be supplemented does not currently exist. Petitioner’s request for authorization to file a motion with respect to documents filed or referenced in district court proceedings is granted, as set forth in the Order below.

2. Petitioner's Request for Authorization to File a Motion for Additional Discovery

Petitioner’s List of Proposed Motions includes a motion for additional discovery pursuant to 37 C.F.R. § 42.51(b)(2). Paper 11, 1–2. Petitioner states in its list of proposed motions that any motion for additional discovery “would be contingent on the arguments PO makes.” *Id.* at 2. During the March 5th teleconference, Petitioner stated it sought additional discovery at

this time concerning the priority date of the challenged patent, U.S. Patent No. RE42,368 (“the ’368 patent”). Patent Owner opposed the request for various reasons, including that it was premature and speculative since Patent Owner had not yet taken a position in this proceeding on the priority date of the ’368 patent. Patent Owner’s Response to the Petition is not due until April 30, 2015.

At this stage of the proceeding a request for additional discovery regarding the priority date of the ’368 patent is premature. Petitioner has no present knowledge of the positions Patent Owner will adopt in this proceeding, and, therefore, cannot conclusively anticipate what information may be in dispute or where additional, contrary information is most likely to be found. The proceeding is structured with the expectation that Petitioner will have an opportunity to pursue discovery regarding Patent Owner’s positions after Patent Owner has provided a Response to the Petition. In the absence of extraordinary circumstances, we are not persuaded that Petitioner’s request for additional discovery is warranted in this case at this time.

We further remind the parties that rule 42.51(b)(2) provides that “[t]he parties may agree to additional discovery between themselves,” and encourage the parties to make every reasonable effort to resolve discovery disputes prior to raising the dispute with the Board. To the extent that a dispute arises between the parties relating to discovery, the parties shall meet and confer to resolve such a dispute before contacting the Board. If attempts to resolve the dispute fail, a party may request a conference call with the Board and the other party in order to seek authorization to move for relief.

In any request for a conference call with the Board to resolve a discovery dispute, the requesting party shall: (a) certify that it has conferred with the other party in an effort to resolve the dispute; (b) identify with specificity the issues for which agreement has not been reached; (c) identify the precise relief to be sought; and (d) propose specific dates and times at which both parties are available for the conference call.

3. Other Proposed Motions

Petitioner's "List of Proposed Motions" (Paper 11) includes various other listed items, beyond those motions discussed above, and advanced generally as "proposed" in order "to preserve its right to file them." Paper 11, 1. During the conference call, Petitioner indicated that, at this time, it did not contemplate actively the filing of any of the additional "proposed" motions, and that they were essentially "place-holder" motions. It is not necessary to include such "place-holder" motions as a part of a proposed motions list, nor can a party "preserve" any rights in filing such motions.

The parties are reminded that, except as otherwise provided in the Rules, Board authorization is required before filing a motion. 37 C.F.R. § 42.20(b). A party seeking to file a motion should request a conference to obtain authorization to file the motion, with the exception of motions for which prior authorization is not practical (*see* Office Trial Practice Guide at 77 Fed. Reg. at 48,762).

4. Depositions

With respect to depositions in this proceeding, the duration provided for under 37 C.F.R. § 42.53(c) applies to each separate *inter partes* review proceeding absent a stipulation among the parties. The parties are advised that the Testimony Guidelines appended to the Office Patent Trial Practice

Guide, 77 Fed. Reg. 48,756, 48,772 (Aug. 14, 2012) (Appendix D), apply to this proceeding. The Board may impose an appropriate sanction for failure to adhere to the Testimony Guidelines. 37 C.F.R. § 42.12. For example, reasonable expenses and attorneys' fees incurred by any party may be levied on a person who impedes, delays, or frustrates the fair examination of a witness.

Whenever a party submits a deposition transcript as an exhibit in this proceeding, the submitting party shall file the full transcript of the deposition rather than excerpts of only those portions being cited. After a deposition transcript has been submitted as an exhibit, all parties who subsequently cite to portions of the transcript shall cite to the first-filed exhibit rather than submitting another copy of the same transcript.

ORDER

In consideration of the foregoing, it is hereby:

ORDERED that Petitioner's Request for Authorization to File a Motion to Submit Supplemental Information (Paper 10) is GRANTED-IN-PART;

FURTHER ORDERED that Petitioner is authorized to file a Motion to Submit Supplemental Information of no more than 10 pages no later than March 12, 2015, and shall address only the documents filed or referenced in district court proceedings identified in its request (Paper 10) as items 1–4;

FURTHER ORDERED that Petitioner is not authorized to file a Motion to Submit Supplemental Information concerning expected deposition testimony and documents;

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