

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 Motion to Submit Supplemental Information Under 37 C.F.R. §
42.123(a)**

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I. INTRODUCTION AND IDENTIFICATION OF REQUESTED EVIDENCE FOR SUBMISSION

Petitioner Cisco Systems, Inc., moves to submit the supplemental information identified below, all of which is relevant to a claim for which the IPR2014-01166 trial¹ has been instituted.

1. Patent Owner's (PO's) interrogatory responses and documents on

alleged conception, diligence and reduction to practice. PO served its

responses and documents in 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 Litigation").² The

interrogatory responses cover 22 pages in relevant part. The PO identified

only 5 sets of documents in its interrogatory responses, and separately

produced only a handful of additional documents on these issues.

2. The parties' Joint Claim Construction and Prehearing Statement in the

Related Litigation (the "Joint Claim Construction"). (D.I. 151; 100 pages.)

¹ The issues presented in this Motion are identical to those in co-pending IPR2014-01276. Thus, for efficiency, Petitioner requests that the Board consider whether the evidence requested for submission here may also be submitted in IPR2014-01276.

² Petitioner cites to, but does not submit copies of the various exhibits it moves to submit. The Board requested that "the information [Petitioners] seek to submit should not be included as an exhibit" in this Motion. (Rough Tr. of March 5, 2015, Initial Conference with the Board for IPR2014-01166 ("Initial Conf. Tr.")).

3. PO's infringement contentions in the Related Litigation. PO's

contentions consist of a cover pleading and two appendices, together totaling 138 pages.

II. STATEMENT OF FACTS

1. The information Petitioner proposes to submit, above, was either not available when the '368 Petition was filed, or—in the case of PO's infringement contentions—was not relevant to this IPR at the time the IPR was filed. For example, when PO served its infringement contentions, the PO had not yet raised its argument regarding the “continuous” claim term to which the infringement contentions are relevant.
2. The earliest provisional patent application to which U.S. Patent No. 6,798,941 (the “Smith Patent”) claims priority was filed September 22, 2000. In the Related Litigation, the PO claims that the '368 patent on which the Board instituted this IPR is entitled to an August 31, 2000, priority date. (Jan. 16, 2015, Capella Supplemental Response to Interrogatory No. 3 (“Capella currently contends that each claim of the patents in suit was conceived at least by August 31, 2000”) (“Interrogatory Response”).)

III. ARGUMENT

Petitioner moves to submit two categories of supplemental information related to (1) conception, diligence, and reduction to practice; and (2) claim construction. Petitioner first addresses the procedural propriety of this motion, and then addresses the reasons for submitting each category of information.

A. This Motion is procedurally proper

37 C.F.R. § 42.123(a) provides that a motion to submit supplemental information is proper if (1) a request to file such a motion has been filed within one month of the date of institution of a trial; and (2) the supplemental information is relevant to a claim for which a trial has been instituted. *See* 37 C.F.R. § 42.223(a). Petitioner timely filed its request to submit this motion on February 26, 2015. (Paper 10.) The Board granted that Request. (Paper 12.) As discussed below, each of the requested pieces of supplemental information is relevant to, e.g., claim 1 of U.S. Patent RE42,368, as each is relevant to at least one element of that claim.

B. Petitioner should be allowed to submit information regarding priority dates

The Board should allow the Petitioner to submit evidence supporting the prior-art status of the Smith Patent. The reasons for submitting this evidence are summarized here and discussed in detail next. First, this evidence is relevant to the PO's claim in the District Court that the '368 patent deserves an earlier priority

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