

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*.

DECISION

Denying Petitioner's Motion to Submit Supplemental Information
37 .F.R. § 42.123(a)

I. INTRODUCTION

Petitioner, Cisco Systems, Inc., filed a Motion to Submit Supplemental Information under 37 C.F.R. § 42.123(a). Paper 13 (“Motion” or “Mot.”). Patent Owner, Capella Photonics, Inc., opposes Petitioner’s Motion. Paper 14. Pursuant to 37 C.F.R. § 42.123(a), a party may file a motion to submit supplemental information after trial has been instituted if a request to file such a motion is made within one month of the date the trial was instituted and the information is relevant to a claim for which the trial has been instituted. Petitioner, as the moving party, has the burden of proof to establish that it is entitled to the requested relief. 37 C.F.R. § 42.20 (c).

For the reasons that follow, Petitioner’s Motion is denied.¹

II. ANALYSIS

Conception, Diligence, and Reduction to Practice Documents

Petitioner seeks to introduce as supplemental information Patent Owner’s interrogatory responses in district court proceedings concerning U.S. Patent No. RE42,368 (“the ’368 patent”), as well as five sets of documents Patent Owner identified in its interrogatory responses, and “a

¹ Petitioner also requests that we consider whether the information requested for submission in this proceeding may also be submitted in related IPR2014-01276. Mot., n.1. Petitioner has not received authorization to file a motion to submit supplemental information in IPR2014-01276. Accordingly, there is no motion to submit supplemental information pending in IPR2014-01276. The decision in this proceeding, however, should be taken into consideration by Petitioner in determining whether Petitioner intends to continue to seek authorization to file a motion in IPR2014-01276 to submit the same supplemental information.

handful of additional documents” concerning conception, diligence, and reduction to practice. Mot. 1. Petitioner contends that the evidence it seeks to introduce “is relevant to the [Patent Owner’s] claim in the District Court that the ’368 patent deserves an earlier priority date than that of the Smith Patent on which Petitioner’s IPR relies.” Mot. 3–4. Petitioner concedes that at this stage of the proceeding, prior to the filing of Patent Owner’s Response, the issue of an earlier priority date for the ’368 patent has not been raised, but argues it should be permitted to submit evidence now “to anticipate this challenge.” Mot. 4. Petitioner further argues that its request is not premature and is limited to a small number of documents. *Id.* Without further explanation, Petitioner also argues that “[i]t will require no real effort and work no prejudice on [Patent Owner] to produce these documents for submission.”

Petitioner has not identified with sufficient specificity what documents it seeks to introduce associated with the interrogatory responses, or how any particular document is relevant to a claim for which trial has been instituted. A request to submit supplemental information is not an opportunity to broadly request permission to introduce any evidence a party may possess on a particular issue. Moreover, Petitioner implies that it cannot introduce the documents it seeks to provide as supplemental information, but must instead rely on Patent Owner to submit the information. A motion to submit supplemental information, however, is not a proper vehicle for seeking additional discovery.

In this case we are not persuaded by Petitioner’s argument that information relevant to a priority argument raised by Patent Owner in district

court, but not yet asserted by Patent Owner in this proceeding, is relevant to a claim for which trial has been instituted in this proceeding. Petitioner will have an opportunity to respond to the Patent Owner Response in a Reply. Such a Reply, however, may respond only to arguments raised in the Patent Owner Response. 37 C.F.R. § 42.23(b). The Reply may cite new evidence, such as declarations, references, and other documents, as long as that evidence responds to Patent Owner's arguments and is relevant to the grounds as instituted.

Claim Construction Documents

Petitioner seeks to introduce as supplemental information the parties' Joint Claim Construction and Prehearing Statement and Patent Owner's Infringement Contentions from the district court proceeding. Mot. 1–2. Petitioner argues that the information is relevant to how the terms should be construed in this proceeding, arguing that the positions taken by Patent Owner in district court “are far broader and/or very different than those it takes in this proceeding.” Mot. 6. Petitioner also contends that Patent Owner referred to patents and text books in the joint construction statement that “the Board should be able to make reference to,” but Petitioner does not propose introducing those materials as supplemental information. *Id.* Petitioner further asserts that Patent Owner's infringement contentions “are indicative of the structures and processes that the [Patent Owner] says are covered by the various claim elements of the petitioned claims in this IPR.” *Id.* at 8.

In proceedings before the Board, we apply the broadest reasonable construction, which may not be the same standard adopted by the district

court. 37 C.F.R. § 42.100(b). Although a district court's construction may be informative, on this record, the Patent Owner's claim construction and preliminary infringement contentions in district court are too tenuous to be relevant to the Board's application of the broadest reasonable construction standard. At this stage of the proceeding, prior to Patent Owner's Response, Petitioner may only speculate as to the position Patent Owner will assert on claim construction. Indeed, rather than identify specific information on a particular term at issue in dispute, Petitioner seeks to submit 238 pages of information pertaining to various positions initially asserted by Patent Owner in district court. Petitioner has not shown that either the Joint Claim Construction and Prehearing Statement or Patent Owner's Infringement Contentions are relevant to a claim for which the trial has been instituted in this proceeding. As noted above, Petitioner will have an opportunity to bring evidence regarding claim construction to our attention in its Reply, provided the evidence is responsive to an argument made by Patent Owner. *See* 37 C.F.R. § 42.23(b).

III. CONCLUSION

For the reasons discussed above, Petitioner has not met its burden to show that the information it seeks to submit is relevant to a claim for which the trial has been instituted.

IV. ORDER

It is

ORDERED that Petitioner's Motion to Submit Supplemental Information Under 37 C.F.R. § 42.123(a) is DENIED.

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