

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CISCO SYSTEMS, INC., CIENA CORPORATION,  
CORIANT OPERATIONS, INC., CORIANT (USA) INC., and  
FUJITSU NETWORK COMMUNICATIONS, INC.,  
Petitioner,

v.

CAPELLA PHOTONICS, INC.,  
Patent Owner.

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Case IPR2014-01166<sup>1</sup>  
Patent RE42,368

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

TARTAL, *Administrative Patent Judge*.

DECISION  
*Denying Request for Rehearing*  
37 C.F.R. § 42.71(d)

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<sup>1</sup> IPR2015-00816 was joined with IPR2014-01166 on September 4, 2015, by Order in IPR2015-00816, Paper 12 (IPR2014-01166, Paper 26).

## I. INTRODUCTION

In the Final Written Decision concerning U.S. Patent No. RE42,368 (“the ’368 patent”), we determined Petitioner Cisco Systems, Inc., Ciena Corporation, Coriant Operations, Inc., Coriant (USA) Inc., and Fujitsu Network Communications, Inc., had shown by a preponderance of the evidence that, under 35 U.S.C. § 103(a), claims 1–6, 9–11, 13, and 15–22 would have been obvious over Bouevitch,<sup>2</sup> Smith,<sup>3</sup> and Lin;<sup>4</sup> and, claim 12 would have been obvious over Bouevitch, Smith, Lin, and Dueck.<sup>5</sup> (Paper 44, “Final Decision” or “Dec.”). Patent Owner, Capella Photonics, Inc., requests rehearing of the Final Written Decision. Paper 45 (“Request” or “Req. Reh’g.”). For the reasons discussed below, Patent Owner’s Request is denied.

## II. DISCUSSION

“When rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” 37 C.F.R. § 42.71(c). The requirements for a request for rehearing are set forth in 37 C.F.R. § 42.71(d), which provides in relevant part:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. The request must specifically identify all matters the party believes the Board misapprehended

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<sup>2</sup> U.S. Patent No. 6,498,872 B2, issued December 24, 2002 (Ex. 1003, “Bouevitch”)

<sup>3</sup> U.S. Patent No. 6,798,941 B2, issued September 28, 2004 (Ex. 1004, “Smith”).

<sup>4</sup> U.S. Patent No. 5,661,591, issued August 26, 1997 (Ex. 1010, “Lin”)

<sup>5</sup> U.S. Patent No. 6,011,884, issued January 4, 2000 (Ex. 1021, “Dueck”)

or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.

A. *Patent Owner's Contention that Bouevitch Teaches Away from Misalignment to Control Power*

In its Request, Patent Owner first argues that “the facts prove that Bouevitch teaches away from misalignment and angular displacement to control power.” Req. Reh’g. 2. We are not persuaded that we misapprehended or overlooked this argument. The Final Decision states:

As explained by Dr. Marom, Bouevitch discloses the use of variable attenuation for power control, and a person of ordinary skill in the art would understand that the necessary level of control required to balance the optical power differentials among the wavelength channels is achieved in Bouevitch with continuous control over the mirror tilt via analog voltage control. *See Ex. 1028 ¶ 58, see also Ex. 1003, 7:35–37* (“The degree of attenuation is based on the degree of deflection provided by the reflector (i.e., the angle of reflection).”

Dec. 23. Patent Owner’s “teaching away” argument was further addressed at length in the Final Decision:

Next, Patent Owner argues that a person of ordinary skill in the art would not have been motivated to combine Smith’s tiltable mirrors with Bouevitch because it would disrupt Bouevitch’s explicit teaching of parallel alignment,” and “Bouevitch discourages, if not teaches away from, misalignment to control power.” PO Resp. 26–30. “The prior art’s mere disclosure of more than one alternative does not constitute a teaching away from any of these alternatives because such disclosure does not criticize, discredit, or otherwise discourage the solution claimed in the ... application.” *In re Fulton*, 391 F.3d 1195, 1201 (Fed. Cir. 2004). While Bouevitch discusses how angular displacement is disadvantageous in certain respects (*see Ex. [1003], 2:1–7*), we are not persuaded such discussion is sufficient to constitute a teaching away. To the contrary, Petitioner has shown persuasively that Bouevitch uses angular misalignment to control

power in at least some embodiments of Bouevitch. Pet. Reply 3–5; *see also* Ex. 1028 ¶ 71.

Dec. 32. Patent Owner directs us to no additional expert testimony in support of its argument that we overlooked, and cites no testimony from its expert, Dr. Sergienko, in support of its attorney argument. To the extent Dr. Sergienko’s testimony “that Bouevitch could control power using misalignment” failed to support Patent Owner’s argument, Patent Owner instead argues that it was “mischaracterized” by Petitioner. Req. Reh’g. 7. Thus, we determine that Patent Owner fails to identify any matter that we misapprehended or overlooked. Req. Reh’g. 2

Furthermore, Patent Owner fails to address in its Request Bouevitch’s disclosure, as quoted in the Final Decision, that the “degree of attenuation is based on the degree of deflection provided by the reflector (i.e., the angle of reflection).” Dec. 23 (quoting Ex. 1003, 7:35–37). Instead, Patent Owner argues that “Bouevitch’s embodiments comprising MEMS do not *necessarily* control power using misalignment.” Req. Reh’g. 9. Patent Owner’s focus on whether a disclosed feature was “necessarily” used is misplaced. The challenged claims were found to have been obvious over the asserted prior art, and even if we were to consider Patent Owner’s argument, Patent Owner fails to address what would have been understood by one of ordinary skill in the art at the time of the invention. Patent Owner has not established that we overlooked an argument or evidence regarding “teaching away,” and has not shown that we erred in determining that Bouevitch does not teach away from the power-control method taught in Smith.

*B. Patent Owner's Contention that Combining Bouevitch with a Two-Axis Mirror Would Change Its Basic Principle of Operation*

In its Request, Patent Owner argues second that we misinterpreted its argument that a person of ordinary skill “would not have combined Bouevitch and a two-axis mirror because the combination would disrupt Bouevitch’s polarization-based switch.” Req. Reh’g. 10.

The Final Decision states:

Patent Owner also argues that a person of ordinary skill in the art would not have combined Bouevitch and Smith for various reasons. PO Resp. 22–31. Patent Owner argues that Petitioner has not reconciled “the technical differences between the references,” or explained whether the components “would continue to operate as desired.” *Id.* at 23. Patent Owner lists many considerations an optical system architect would have to take into account purportedly not addressed in the Petition. *Id.* at 23–24. Patent Owner further asserts that Dr. Marom has designed a two-axis mirror to replace a two-axis mirror, and that “[r]e-designing micromirrors is not a simple substitution because the redesign is complex.” *Id.* at 24–25. In this proceeding, however, Dr. Sergienko was asked whether such technical considerations presented problems that could not be overcome by one of skill in the art, and indicated “no.” Ex. 1039, 266:16–267:25. Moreover, “[t]he test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference. . . . Rather, the test is what the combined teachings of those references would have suggested to those of ordinary skill in the art.” *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

Dec. 30–31. Patent Owner asserts that it “did not argue that Bouevitch and Smith are not combinable because Smith’s mirrors cannot be bodily incorporated into Bouevitch.” Req. Reh’g. 9. Patent Owner’s argument misrepresents the thrust of Patent Owner’s Response. Patent Owner argued that replacing a single axis mirror with a two-axis mirror was not a simple

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