

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIENA CORPORATION, CORIANT OPERATIONS, INC., CORIANT
(USA) INC., AND FUJITSU NETWORK COMMUNICATIONS, INC.,
Petitioner,

v.

CAPELLA PHOTONICS, INC.,
Patent Owner.

Case IPR2015-00816
Patent RE42,368

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

TARTAL, *Administrative Patent Judge*.

DECISION
Granting Motion for Joinder
37 C.F.R. § 42.122(b)

I. INTRODUCTION

Petitioner, Ciena Corporation, Coriant Operations, Inc., Coriant (USA) Inc., and Fujitsu Network Communications, Inc., (“Petitioner” or “Ciena”) filed a Motion for Joinder in connection with *inter partes* review proceeding *Cisco Systems, Inc. v. Capella Photonics, Inc.*, IPR2014-01166 (“IPR2014-01166”) pursuant to 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b). Paper 6 (“Motion” or “Mot.”). Both IPR2014-01166 and this proceeding involve claims 1–6, 9–13, and 15–22 of U.S. Patent No. RE42,368 (“the ’368 patent”). Petitioner filed the Motion with its Petition on February 26, 2015, within thirty days of the institution of trial in IPR2014-01166 on January 30, 2015. *See* IPR2014-01166, Paper 8.

Petitioner represents that Cisco Systems, Inc. (“Cisco”), petitioner in IPR2014-01166, does not oppose the Motion. Mot. 3. Patent Owner, Capella Photonics, Inc., did not file a response to the Motion.

Petitioner’s Motion for Joinder is *granted*.

II. DISCUSSION

The Leahy-Smith America Invents Act, Pub. L. No. 112-29, 125 Stat. 284 (2011) (“AIA”) permits joinder of like review proceedings. The Board, acting on behalf of the Director, has the discretion to join an *inter partes* review with another *inter partes* review. *See* 35 U.S.C. § 315(c).¹ Joinder may be authorized when warranted, but the decision to grant joinder is

¹ 35 U.S.C. § 315(c) reads:

Joinder.—If the Director institutes an *inter partes* review, the Director, in his or her discretion, may join as a party to that *inter partes* review any person who properly files a petition under section 311 that the Director, after receiving a

discretionary. 35 U.S.C. § 315(c); 37 C.F.R. § 42.122. When exercising its discretion, the Board is mindful that patent trial regulations, including the rules for joinder, must be construed to secure the just, speedy, and inexpensive resolution of every proceeding. *See* 35 U.S.C. § 316(b); 37 C.F.R. § 42.1(b).

In our Decision on Institution of *Inter Partes* Review (Paper 11), entered concurrently with this Decision on Motion for Joinder, we instituted trial with respect to claims 1–6, 9–13, and 15–22 of the ’368 patent. In that regard, we determined that Petitioner has shown a reasonable likelihood of prevailing in its assertion that those claims are unpatentable over the cited prior art. The grounds of unpatentability proposed by Petitioner are the same as in IPR2014-01166. Petitioner states that “[j]oinder would not complicate or delay [IPR2014-01166] and would not adversely affect the schedule.” Mot. 3. Petitioner represents that the Petition is nearly identical to the instituted grounds in IPR2014-01166 and is supported by a declaration from the same declarant that is essentially identical to the declaration submitted in IPR2014-01166. *Id.* According to Petitioner, “The Petition presents no new substantive issues relative to [IPR2014-01166] and does not seek to broaden the scope of [IPR2014-01166] or request additional discovery.” *Id.* at 6. Petitioner further agrees that Cisco’s counsel will act as lead counsel as long as Cisco remains in the proceeding, and submits that the current schedule can stay unchanged. *Id.* at 6–7. Additionally, the issues raised by Patent Owner in opposition to institution of trial in IPR2015-00816

preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

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mirror the contentions Patent Owner asserts in its Patent Owner Response in IPR2014-01166. *See* Paper 10; *see also* IPR2014-01166, Paper 19.

In consideration of the foregoing, we determine that it is appropriate to grant Petitioner's Motion for Joinder.

III. ORDER

Accordingly, it is

ORDERED that Petitioner's Motion for Joinder with IPR2014-01166 is *granted*;

FURTHER ORDERED that the instant proceeding is joined with IPR2014-01166;

FURTHER ORDERED that the grounds of unpatentability on which trial was instituted in IPR2014-01166 are unchanged, and trial will proceed on those grounds based on the record in IPR2014-01166;

FURTHER ORDERED that the parties will file all papers in IPR2014-01166, and that IPR2015-00816 is hereby terminated under 37 C.F.R. § 42.72;

FURTHER ORDERED that the joined proceeding will follow the schedule effective in IPR2014-01166 as of the date of this Decision;

FURTHER ORDERED that in IPR2014-01166, Cisco Systems, Inc., ("Cisco") and Ciena Corporation, Coriant Operations, Inc., Coriant (USA) Inc., and Fujitsu Network Communications, Inc., (collectively "Ciena") will file papers, except for motions that do not involve the other party, as consolidated filings. Cisco will identify each such filing as a consolidated filing and will be responsible for completing all consolidated filings. Ciena may file an additional paper, not to exceed five pages, which may address only points of disagreement with contentions in Cisco's consolidated filing.

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Any such filing by Ciena must identify specifically and explain each point of disagreement. Ciena may not file separate arguments in support of points made in Cisco's consolidated filing;

FURTHER ORDERED that, in addition to responding to any consolidated filing, Patent Owner may respond separately to any separate Ciena filing. Any such response by Patent Owner to a Ciena filing may not exceed the number of pages in the Ciena filing, and is limited to issues raised in the Ciena filing;

FURTHER ORDERED that Cisco and Ciena will designate attorneys to conduct cross-examination of any witnesses produced by Patent Owner and redirect any witnesses produced by Cisco and Ciena within the timeframe normally allotted by the rules to one party. Cisco and Ciena will not receive any separate cross-examination or redirect time. Cisco is permitted to ask questions before Ciena at depositions if it so chooses;

FURTHER ORDERED that Cisco is permitted to present argument before Ciena at any oral argument if it so chooses;

FURTHER ORDERED that the case caption in IPR2014-01166 shall be changed to reflect the joinder with this proceeding in accordance with the attached example; and

FURTHER ORDERED that a copy of this Decision shall be entered into the file of Case IPR2014-01166.

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