

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.,
Petitioner,

v.

CAPELLA PHOTONICS, INC.,
Patent Owner.

Cases IPR2014-01166 and IPR2014-01276
Patents RE42,368 and RE42,678¹

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

¹ This order addresses issues that are the same in the identified cases. The parties are authorized to use this heading when filing a single paper in each proceeding, provided that such heading includes a footnote attesting that “the word-for-word identical paper is filed in each proceeding identified in the heading.”

In both IPR2014-01166 and IPR2014-01276 we instituted trial on grounds asserted by Petitioner Cisco Systems, Inc., which relied upon U.S. Patent No. 6,798, 941 B2, issued September 28, 2004 (“Smith”). Petitioner contends Smith is 102(e) prior art as of September 22, 2000, the filing date of its corresponding provisional application No. 60/234,683 (the “Smith ’683 Provisional”). On September 16, 2015, Petitioner contacted the Board by email to seek guidance on how to respond to what Petitioner suggests is a recent change in 102(e) law discussed in *Dynamic Drinkware LLC v. Nat’l Graphics, Inc.*, No. 15-1214, 2015 WL 5166366 (Fed. Cir. Sept. 4, 2015). In *Dynamic Drinkware*, the Federal Circuit stated: “A provisional application’s effectiveness as prior art depends on its written description support for the claims of the issued patent of which it was a provisional.” *Id.* at *6. Petitioner requested leave to file supplemental information consisting of a five page claim chart showing where the Smith ’683 Provisional provides written description support for claim 1 of Smith.

Because both Smith and the Smith ’683 Provisional are in the record of these proceedings, we are not persuaded that providing a claim chart, as Petitioner requests, constitutes supplemental information, as opposed to additional argument. We, however, are interested in the parties’ views on the impact, if any, of *Dynamic Drinkware* on these proceedings and, in accordance with § 37 C.F.R. 42.20(d), request additional briefing to address the following:

- (1) what a party must show to establish that a patent is prior art as of the date of its provisional application when relied upon to challenge claims in an *inter partes* review proceeding alleging obviousness under 35 U.S.C. § 103(a), particularly with respect

- to whether *Dynamic Drinkware* altered the required showing;
- (2) whether *Dynamic Drinkware* is consistent with, or conflicts with, *In re Giacomini*, 612 F.3d 1380, 1383 (Fed. Cir. 2010) or *Ex parte Yamaguchi*, 88 U.S.P.Q.2d 1606 (B.P.A.I. 2008);
 - (3) whether the Smith '683 Provisional provides written description support for the claims of Smith.

Each party shall be limited to five (5) pages, not including the cover sheet or certificate of service, for their respective briefs, which shall be strictly limited to the issues identified above. Petitioner may additionally include as an exhibit to its brief a claim chart not to exceed five (5) pages showing where the Smith '683 Provisional provides written description support for the claims of Smith. The claim chart may not include any argument or explanatory text. The same brief should be entered in both IPR2014-01166 and IPR2014-01276.

It is

ORDERED that Petitioner is authorized to file a brief as described in this Order due seven (7) business days after filing of this order; and

FURTHER ORDERED that Patent Owner is authorized to file a brief responsive to Petitioner's as described in this Order due seven (7) business days after the filing of Petitioner's brief.

IPR2014-01166 and IPR2014-01276
Patent RE42,368 and RE42,678

For PETITIONER:

Wayne O. Stacy
Matthew J. Leary
COOLEY LLP
wstacy@cooley.com
CapellaCisco@cooley.com

For PATENT OWNER:

Robert Sterne
Jon E. Wright
Jason D. Eisenberg
Nicholas Nowak
Jonathan Tuminaro
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
rsterne-PTAB@skgf.com
jwright-PTAB@skgf.com
jasone-PTAB@skgf.com
nnowak-PTAB@skgf.com
jtuminar-PTAB@skgf.com