

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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**CAPELLA PHOTONICS, INC.’S RESPONSE TO CISCO’S  
BRIEF REGARDING LACK OF SUPPORT IN CISCO’S  
PETITION TO SHOW SMITH IS PRIOR ART**

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U.S. Patent and Trademark Office  
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<sup>1</sup> Case IPR2015-00816 has been joined with this proceeding.

## I. Introduction

The Board asked three questions: (1) what must a party show to establish that a patent is entitled to its provisional application's filing date; (2) whether *Dynamic Drinkware* is consistent with precedent; and (3) whether the '683 Provisional provides § 112 support for the Smith patent's claims.

## II. Answer 1: The law has held for at least 34 years that a patent is prior art as of its provisional application's filing date only for subject matter carried over from the provisional application and only if the patent's claims have § 112 support in the provisional application.

When relying on a provisional's filing date for a § 103 rejection, a petitioner must show: (1) the subject matter was carried over from the provisional application and (2) the patent's claims have § 112 support in the provisional application.

These two requirements stem from case law for determining a CIP application priority date. The CCPA held in 1967 that a CIP application only receives its parent application's priority date for subject matter "carried over" from the parent application. *In re Lund*, 376 F.2d 982, 988 (CCPA 1967). The CCPA then modified this carried-over test in *Wertheim* to further require §112 support. *In re Wertheim*, 646 F.2d 527, 539 (CCPA 1981) ("[*Lund*] is hereby modified to further include the requirement that the application . . . must disclose, pursuant to

§§ 120/112, the invention claimed in the reference patent.”)<sup>2</sup> In *Wertheim*, when determining whether a patent had § 112 support in a parent application, the CCPA compared the patent’s claims to the earlier-filed parent application. The CCPA determined that “two claim limitations of the reference patent [were] missing from [the parent application].” *Id.* As a result, the patent was not prior art. *Id.* at 537 (“[O]nly an application disclosing the patentable invention before the addition of new matter . . . can be relied upon to give a reference disclosure the benefit of its filing date for the purpose of supporting a §§ 102(e)/103 rejection”).

In 2010, the Federal Circuit extended both the carried-over requirement *and* the § 112 requirement from CIP applications to applications claiming priority to provisional applications. *In re Giacomini*, 612 F.3d 1380, 1383-84 (Fed. Cir. 2010). For the carried-over requirement, the Federal Circuit reiterated that “an applicant is not entitled to a patent if another’s patent discloses the same invention, which was carried forward from an earlier U.S. provisional application or U.S. non-provisional application.” *Id.* at 1383. For the § 112 requirement, the Federal Circuit reiterated that “the provisional application must provide written description support for the claimed invention.” *Id.* As previously established in *Wertheim*, the “claimed invention” can only be discussed by reference to the claims:

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<sup>2</sup> In *Dynamic Drinkware*, the Federal Circuit cited to *Wertheim* for this point of law. *Infra* Part III.

It is axiomatic in patent law that questions of description . . . can only be discussed with reference to a specific claim which identifies “the invention” referred to in the statutes. Thus, the determinative question here is whether the invention claimed in the Pfluger patent finds a supporting disclosure in compliance with § 112 . . . Without such support, the invention, and its accompanying disclosure, cannot be regarded as prior art as of that filing date.

*Wertheim*, 646 F.2d at 537 (emphasis omitted).

Accordingly, *as has been held for over 34 years*, to establish that a patent is prior art as of its provisional application’s filing date, a party must show that (1) the subject matter was carried over from the provisional application<sup>3</sup> and (2) the claims of the reference patent have § 112 support in the provisional application.

**III. Answer 2: *Dynamic Drinkware* did not change the law and rather, cites to 34 year-old precedent.**

*Dynamic Drinkware* did not change this 34-year old precedent, *e.g.*, it did not disparage or contrast any other case, or remand for the Board to follow a new

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<sup>3</sup> Cisco distances itself from the “carried over” requirement, stating that the law requires a “common disclosure.” (Paper 34, pp. 2-3.) Cisco’s argument on this point is misleading. Courts do not look at a patent and a provisional application generally to determine whether the disclosures have commonalities. Instead, courts look to whether the claimed subject matter was “carried over” from an earlier application. *Lund*, 376 F.2d at 988.

test. *Supra* Part II. Cisco contends that “[*Dynamic Drinkware*] appears to have . . . add[ed] a new prong to the test for establishing the effective date of a provisional application as prior art” because *Giacomini* did not focus on the §§ 119/112 requirement. (Paper 34, pp. 1-2.) But *Giacomini* addressed the §§ 119/112 requirement. *Supra* Part II. The only reason the Federal Circuit did not “focus” on the requirement is because *Giacomini* waived any arguments under this issue. *Giacomini*, 612 F.3d at 1383-84. Further, the two requirements are in *Wertheim*. So, when the Federal Circuit in *Dynamic Drinkware* specifically cited to *Wertheim* for the proposition that “[a] reference patent is only entitled to claim the benefit of the filing date of its provisional application if the disclosure of the provisional application provides support for the claims in the reference patent in compliance with § 112,” the Federal Circuit’s statement was not new law.

As the law stands,<sup>4</sup> and as the law stood pre-*Dynamic Drinkware*, a party that relies on a provisional application’s filing date for § 102(e) prior art must show that (1) the subject matter was carried over from the provisional application and (2) the claims of the reference patent have § 112 support in the provisional application.

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<sup>4</sup> Capella agrees with Cisco that *Yamaguchi* is no longer good law. (Paper 34, p. 4)

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