

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Cisco Systems, Inc.
Petitioner

v.

Capella Photonics, Inc.
Patent Owner

Patent No. RE42,678
Filing Date: June 15, 2010
Reissue Date: September 6, 2011

Title: RECONFIGURABLE OPTICAL ADD-DROP MULTIPLEXERS WITH
SERVO CONTROL AND DYNAMIC SPECTRAL POWER MANAGEMENT
CAPABILITIES

Inter Partes Review No. 2014-01276

**Petitioner's Request for Authorization to File Motion to Submit Supplemental
Information Under 37 C.F.R. § 42.123(a)**

Petitioner requests authorization under 37 C.F.R. § 42.123(a) to file a motion to submit supplemental information relevant to a claim for which the trial has been instituted. Petitioner requests authorization to file a motion to submit the following supplementation information, the need for which is outlined briefly below:

1. Patent Owner's ("PO") interrogatory responses on alleged conception, diligence and reduction to practice. PO served these responses as part of the related District Court litigation, *Capella Photonics, Inc. v. Cisco Systems, Inc.*, Case Nos. 3:14-cv-03348, -3349, -3350, -3351-EMC (N.D. Cal., 2014) (the "Related Cases"). This information is relevant to the PO's expected attempt to swear behind the currently-asserted prior art in this IPR.
2. Documents referenced in PO's interrogatory responses regarding priority dates. This information is also relevant to the issues of alleged conception and reduction to practice.
3. The parties' Joint Claim Construction and Prehearing Statement in the Related Cases. This information is relevant to the BRIs that the PO indicated it will pursue in its Preliminary response.
4. PO's infringement contentions in the Related Cases. This information is also relevant to the BRIs in this IPR.

This request meets the requirements of 37 C.F.R. § 42.123(a) – specifically:

(1) this request is being made within one month of the trial institution date of February 18, 2015; and (2) the supplemental information is relevant to a claim (i.e., claim 1) for which the trial has been instituted.

Petitioner's request for authorization to file a motion to submit supplemental information should be granted because:

1. The information that Petitioner proposes to submit, above, was not available to Petitioner when the Petition was filed.
2. PO's interrogatory responses were not served until January 16, 2015. Those responses for the first time revealed PO's intent to claim an August 31, 2000, priority date for the '678 patent. PO contends that this date is earlier than the currently-asserted prior art. The allegedly-supporting evidence for this date is uniquely in the possession of PO and prior PO employees. In the interests of justice, Petitioner must be able to explore and test these allegations and the evidence behind them.
3. PO produced documents regarding priority date issues after the Petition was filed. Petitioner requested on February 4, 2015, that PO de-designate (under the Protective Order in the Related Cases) those documents. PO referenced those documents in its interrogatory responses regarding alleged conception,

diligence and reduction to practice in the Related Cases. Petitioner made its request in order to allow Petitioner to submit those documents in this proceeding. As of the filing of this motion, PO still had not provided a response as to whether it would de-designate the documents.

4. Although PO served its Infringement Contentions prior to the filing of the Petition, it was not until after the Petition that PO said that it was accusing devices using non-movable mirrors. This late accusation of such devices may affect the scope of discovery and claim construction.
5. PO served its claim construction positions well after the Petition was filed. While Petitioner appreciates that the rules for claim interpretation used in district court litigation are different than the "broadest reasonable interpretation in light of the specification" used for these IPR proceedings, Petitioner believes that PO's earlier statements regarding claim construction will be relevant to these proceedings.

Accordingly, Petitioner requests authorization for Petitioner to file a motion to submit supplemental information under 37 C.F.R. § 42.123.

Case No. 2014-01276

Atty. Docket No. CSCO-002/00US [034855-2015] (RE42,678)

Petitioner's Request for Authorization for Motion to Submit Suppl. Info.

Dated: March 16, 2015

Respectfully submitted,
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