

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

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

v.

CAPELLA PHOTONICS, INC.
Patent Owner

Case IPR2014-01276¹
Patent RE42,678

**PATENT OWNER'S REQUEST FOR REHEARING
OF THE JUDGMENT AND FINAL WRITTEN DECISION**

Mail Stop "PATENT BOARD"
Patent Trial and Appeal Board
U.S. Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450

¹ Case IPR2015-00894 has been joined with this proceeding.

TABLE OF CONTENTS

I. Statement of Relief Requested.....1

II. The Facts Support Only One Conclusion: Bouevitch Teaches Away From Misalignment to Control Power.....1

 A. Bouevitch Teaches Away from Smith’s Power-Control Method.2

 1. Bouevitch Explicitly Discourages the Power-Control Method Disclosed in Smith.3

 2. A POSA, After Reading Bouevitch, Would Have Been Led Down a Divergent Path.....5

 B. Petitioner’s Argument is Factually Incorrect6

III. Combining Bouevitch and a Two-Axis Mirror Would Disrupt Bouevitch’s Principle of Operation.....10

IV. Conclusion12

I. Statement of Relief Requested

The Board should rehear and reverse its Final Written Decision because the Board overlooked key facts Capella raised in its Patent Owner Response and misinterpreted Capella's arguments on the combinability of U.S. Patent No. 6,498,872 to Bouevitch et al. and U.S. Patent No. 6,798,941 to Smith et al.

In its Patent Owner Response, Capella primarily relied on two reasons why a person having ordinary skill in the art at the time of the invention ("POSA") would not have combined Bouevitch and Smith: (1) Bouevitch teaches away from using misalignment and angular displacement to control power; and (2) combining Bouevitch and a two-axis mirror would change the basic principle under which Bouevitch was designed to operate. For the first reason, the Board erred because it credited Petitioner's arguments, which are factually incorrect. For the second reason, the Board misinterpreted Capella's arguments. Accordingly, Capella requests rehearing under 37 C.F.R. §42.71(d).

II. The Facts Support Only One Conclusion: Bouevitch Teaches Away From Misalignment to Control Power

Capella argued in its Patent Owner Response that a POSA would not have combined Bouevitch and Smith because Bouevitch teaches away from misalignment and angular displacement—the method Smith uses to control power. POR, Paper 15, pp. 27-30. The Board disagreed with Capella's arguments and credited Petitioner with showing that certain embodiments in Bouevitch disclose

misalignment. Final Written Decision, Paper 40, p. 38 (citing Pet. Reply, pp. 3-5; Ex. 1028, ¶ 76). But under the proper legal standard described below, the facts prove that Bouevitch teaches away from misalignment and angular displacement to control power—the power-control method in Smith.

A. Bouevitch Teaches Away from Smith’s Power-Control Method

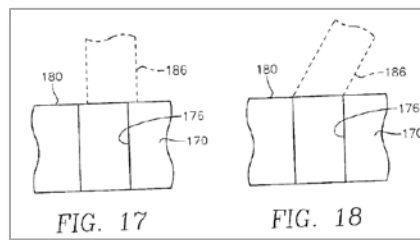
“A reference may be said to teach away when a person of ordinary skill, upon reading the reference, *would be discouraged* from following the path set out in the reference, *or would be led in a direction divergent from the path that was taken by the applicant.*” *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994) (emphasis added); *see also In re Fulton*, 391 F.3d 1195, 1200 (“A case on point is *In re Gurley*”); *DePuy Spine, Inc. v. Medtronic Sofamor Danek*, 567 F.3d 1314, 1326-29 (Fed. Cir. 2009).²

² *In re Fulton*, the case the Board relied on, is distinguishable because the reference in that case did not criticize or discourage use of alternatives; the reference merely chose a preference. *In re Fulton*, 391 F.3d 1195, 1200-01 (Fed. Cir. 2004) (a reference must “criticize, discredit, or otherwise discourage” to teach away); *see also In re Mouttet*, 686 F.3d 1322, 1334 (Fed. Cir. 2012) (a disclosure of an “inferior” alternative is insufficient for a teaching away unless the reference criticizes, discredits, or otherwise discourages such a combination). This case is

As explained below, Bouevitch's disclosure meets this standard. In particular, after reading Bouevitch, a POSA (1) would have been discouraged from using misalignment to control power; and (2) would have been led down a divergent path.

1. Bouevitch Explicitly Discourages the Power-Control Method Disclosed in Smith

Smith teaches a method to control power in an optical system—misaligning or angularly displacing an output beam to an output port. *See* Smith, Ex. 1004, 17:24-38; *see also id.* at FIGS. 17, 18 (reproduced below); POR, pp. 27-30.



Bouevitch, however, explicitly teaches away from this method. According to Bouevitch, the prior art “is limited in that the add/drop beams of light are angularly displaced relative to the input/output beams of light. ***This angular displacement is disadvantageous*** with respect to coupling the add/drop and/or input/output beams of light into parallel optical waveguides” Bouevitch, Ex. 1003, 2:1-7. To

distinguishable because Bouevitch includes the explicit criticism and

discouragement lacking in *In re Fulton* and *In re Mouttet*. *See infra* Part II.A.1.

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.