

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CISCO SYSTEMS, INC.
Petitioner

v.

CAPELLA PHOTONICS, INC.
Patent Owner

Case IPR2014-01276
Patent RE42,678

**CAPELLA PHOTONICS, INC.’S MANDATORY NOTICES
PURSUANT TO 37 C.F.R. §42.8(a)(2)**

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Pursuant to 37 C.F.R. § 42.8(a)(2), Patent Owner, Capella Photonics, Inc., hereby files its Mandatory Notices.

I. 37 C.F.R. § 42.8(b)(1) – REAL PARTY-IN-INTEREST

The patent owner and real party-in-interest is Capella Photonics, Inc.

II. 37 C.F.R. § 42.8(b)(2) – RELATED MATTERS

A. Proceedings Before the USPTO Involving the Patent-at-Issue

Patent Owner notifies the Board of the following proceeding that may affect or be affected by a decision in this proceeding:

- Case IPR2014-01166 – On July 15, 2014, Petitioner Cisco Systems, Inc. filed a Petition for *Inter Partes* Review against Capella’s U.S. Patent No. RE42,368. The ’368 patent stems from the same patent application(s) that resulted in the ’678 patent.

B. Litigations Involving the Patent-at-Issue

Patent Owner notifies the Board of the following litigation proceedings that may affect or be affected by a decision in this proceeding:

- *Capella Photonics, Inc. v. Cisco Systems, Inc.*, Case No. 1:14-cv-20529, filed in the U.S. District Court for the Southern District of Florida on February 12, 2014 (transferred to the Northern District of California on July 24, 2014, now Case No. 3:14-cv-03348).

- *Capella Photonics, Inc. v. Fujitsu Network Communications, Inc.*, Case No. 1:14-cv-20531, filed in the U.S. District Court for the Southern District of Florida on February 12, 2014 (transferred to the Northern District of California on July 24, 2014, now Case No. 3:14-cv-03349).
- *Capella Photonics, Inc. v. Tellabs, Inc.*, Case No. 0:14-cv-60350, filed in the U.S. District Court for the Southern District of Florida on February 12, 2014 (transferred to the Northern District of California on July 24, 2014, now Case No. 3:14-cv-03350).
- *Capella Photonics, Inc. v. Ciena Corporation et al.*, Case No. 1:14-cv-20530, filed in the U.S. District Court for the Southern District of Florida on February 12, 2014 (transferred to the Northern District of California on July 25, 2014, now Case No. 5:14-cv-03351).
- *Capella Photonics, Inc. v. Columbus Networks USA, Inc.*, Case No. 0:14-cv-61629, filed in the U.S. District Court for the Southern District of Florida on July 15, 2014 (currently stayed).
- *Capella Photonics, Inc. v. Telefonica International Wholesale Services USA*, Case No. 1:14-cv-22701, filed in the U.S. District Court for the Southern District of Florida on July 21, 2014 (currently stayed).

C. U.S. Patents and Applications Related to the Patent-at-Issue

Out of an abundance of caution and in accordance with the Office Patent Trial Practice Guide, 77 Fed. Reg. 48756, 48760 (Aug. 14, 2012), Patent Owner notifies the Board of related patents that may affect or be affected by a decision in this proceeding:

- U.S. Patent Application No. 09/938,426, filed August 23, 2001 (now U.S. Patent No. 6,625,346, issued September 23, 2003); and
- U.S. Patent Application No. 11/027,586, filed December 31, 2004 (now U.S. Patent No. RE39,397, issued November 14, 2006).

III. 37 C.F.R. § 42.8(b)(3) – LEAD AND BACK-UP COUNSEL

Patent Owner hereby designates lead and back-up counsel.

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IV. 37 C.F.R. § 42.8(b)(4) – SERVICE INFORMATION

Please address all correspondence to the lead and back-up counsel as shown above. Patent Owner consents to electronic service by e-mail at all e-mail addresses provided above.

The Patent Trial and Appeal Board is hereby authorized to charge any fees associated with IPR2014-01276 to Deposit Account 19-0036.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.

/Robert Greene Sterne/

Robert Greene Sterne
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Lead Counsel for Patent Owner

Date: September 2, 2014

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