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

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[1]

PETITIONER'S BRIEFING IN RESPONSE TO PTAB QUESTIONS POSED IN PAPER 22

[1] Case IRP2015-00894 has been joined with this proceeding.

The Board posed three questions related to the Federal Circuit's recent decision in *Dynamic Drinkware, LLC v. National Graphics, Inc*. *Dynamic Drinkware*, 2015 WL 5166366 (Fed. Cir. Sept. 4, 2015). Paper 22. The questions are answered below and a claim chart is attached.

QUESTIONS 1 & 2

The *Dynamic Drinkware* holding can at most add to—but not overturn—the *Giacomini* test for establishing the effective date of a provisional application as prior art. A decision of a Federal Circuit panel is binding on all other panels "unless and until overruled by an intervening Supreme Court or en banc decision." *Deckers Corp. v. U.S.*, 752 F.3d 949, 964 (Fed. Cir. 2014) (internal citations omitted). *Dynamic Drinkware* was decided by a three-judge panel. *Dynamic Drinkware*, 2015 WL 5166366. It cannot overrule *Giacomini*. *See e.g.*, *Deckers*, 752 F.3d at 964. Further, the Supreme Court has not issued an intervening decision. Accordingly, *Giacomini* remains good law. *E.g.*, *id*. *Dynamic Drinkware* can therefore only add to the *Giacomini* test. And it appears to have done just that—adding a new prong to the test for establishing the effective date of a provisional application as prior art.

Reading *Giacomini* and *Dynamic Drinkware* together, the test for establishing the effective date for a provisional application as prior art now has two prongs: (1) common disclosure and (2) priority for at least one claim.

1. **Common disclosure**

Giacomini focuses on the disclosure in the patent and the provisional rather than the 35 U.S.C. § 119 requirement. *Giacomini*, 612 F.3d 1380. *Giacomini* requires that the patent and the provisional both contain the disclosure being relied upon as prior art. *Id*. at 1383. Specifically, Giacomini holds 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.* This holding has not been overruled.

Pointing to the earlier decision in *Application of Klesper*, 397 F.2d 882, 885–86 (C.C.P.A. 1968), the *Giacomini* panel drove home the point about the common disclosure requirement:

> Section 102(e) codified the "history of treating the disclosure of a U.S. patent as prior art as of the filing date of the earliest U.S. application to which the patent is entitled, provided the disclosure as contained in substance in the said earliest application."

Id. at 1385. Accordingly, to satisfy the *Giacomoni* test, the petitioner should show that the invalidating disclosure is found in the issued patent and the corresponding patent application.

2. Priority for at least one claim

Dynamic Drinkware focuses on the claim of priority under § 119 and holds that "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." *Dynamic Drinkware*, 2015 WL 5166366, at *6. This test focuses on the claims of the issued prior-art patent rather than the common disclosure.

To claim priority to a provisional application, only one claim in the issued patent needs to find support in the provisional. Section 119(e)(1) focuses on "an invention" rather than all inventions. 35 U.S.C. § 119(e)(1) (emphasis added). Each claim defines an invention. *See also Jones v. Hardy*, 727 F.2d 1524, 1528 (Fed. Cir. 1984); *Minton v. Nat'l Ass'n of Sec. Dealers, Inc.*, 226 F. Supp. 2d 845, 854 (E.D. Tex. 2002); *Phillips v. AWH Corp.*, No. 97MK212(CBS), 2002 WL 32827996, at *4 (D. Colo. Nov. 22, 2002); *Martin Marietta Materials, Inc. v. Bedford Reinforced Plastics, Inc.*, 227 F.R.D. 382, 386 n.2 (W.D. Pa. 2005). Accordingly to satisfy the *Dynamic Drinkware* test, a petitioner should show that one claim in the prior-art patent is supported by the corresponding provisional.

QUESTION 2

As discussed in relation to Question 1, *Dynamic Drinkware* does not conflict with *Giacomini* because *Giacomini* did not reach the issue addressed in *Dynamic Drinkware*. The *Giacomini* court focused exclusively on the disclosure of the provisional application to determine the provisional application's eligibility as a 35 U.S.C. § 102(e) reference. At most, *Dynamic Drinkware* only adds to the *Giacomini* test.

The *Dynamic Drinkware* decision does, however, conflict with *Ex parte Yamaguchi*, 88 U.S.P.Q.2d 1606 (B.P.A.I. 2008). *Ex parte Yamaguchi* is no longer good law. The Federal Circuit changed the long-standing test relied on by the by the Patent Office and the parties in front of the Patent Office.

The Board did not ask about another precedential case, *Klesper*. 397 F.2d 882. If permitted to do so, Petitioner would address this case also. *Dynamic Drinkware* conflicts with the holding of *Klesper*, a precedential case which focuses exclusively on common disclosure between a provisional application and a non-provisional patent. *Klesper*, 397 F.2d at 885-86. To the extent *Dynamic Drinkware*'s new claim priority step conflicts with *Klesper*, *Dynamic Drinkware* is invalid. *Deckers*, 752 F.3d at 964.

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