

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJITSU NETWORK COMMUNICATIONS, INC.
Petitioner

v.

CAPELLA PHOTONICS, INC.
Patent Owner

Case IPR2015-00726
Patent RE42,368

**PATENT OWNER'S OPPOSITION TO PETITIONER'S MOTION
TO FILE SUPPLEMENTAL INFORMATION UNDER 37 C.F.R. § 42.123(b)**

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EXHIBIT LIST

Ex. No.	Description
2001	Patent Owner Response, <i>Cisco Systems, Inc. v. Capella Photonics, Inc.</i> , Case IPR2014-01166, filed May 7, 2015.
2002	Clifford Holliday, Components for R-OADMs '05 (B & C Consulting Services & IGI Consulting Inc. 2005). (“Holliday R-OADMs”)
2003	WavePath 4500 Product Brief, accessed at http://www.capellainc.com/downloads/WavePath%204500%20Product%20Brief%20030206B.pdf . (“WavePath”)
2004	Cisco’s Renewed Motion and Memorandum in Support of Motion for Stays Pending Final Determinations of Validity by the Patent Office, <i>Capella Photonics, Inc. v. Cisco Systems, Inc.</i> , Case No. 14-cv-03348-EMC (N.D. Cal.), filed February 12, 2015. (“Cisco’s Mot. for Stay”)
2005	Order Regarding Cisco’s Pending Motion for Litigation Stay Pending <i>Inter Partes</i> Review, <i>Capella Photonics, Inc. v. Cisco Systems, Inc.</i> , Case Nos. 14-cv-03348-EMC, 14-cv-03350, and 14-cv-3351 (N.D. Cal.), ordered March 3, 2015. (“14-cv-03348 Slip op.”)
2006	U.S. Patent No. 6,768,571 to Azarov et al. (“Azarov”)
2007	The Random House Dictionary of the English Language, 1987, pp. 404, 742 (“Random House Dictionary”)
2008	Provisional Patent Application No. 60/267,285 (“’285 provisional”)
2009	Transcript of Patent Trial and Appeal Board Conference Call for Cases IPR2014-01166 (merged with IPR2015-00816), IPR2014-01276 (merged with IPR2015-00894), IPR2015-00726, and IPR2015-00727, dated September 23, 2015.
2010	Transcript of Patent Trial and Appeal Board Conference Call for Cases IPR2015-00726 and IPR2015-00727, dated October 29, 2015.
2011	Redline Comparison of Paragraph 155 of Drabik Declaration (Ex. 1016) and Ford Declaration (Ex. 1037)

Over two months after institution, Petitioner asks the Board to accept the declaration and credentials of a new expert, Dr. Joseph Ford. The Board should deny this request for two reasons. *First*, the declaration of Dr. Ford (Ex. 1037) contains new testimony regarding the alleged motivation to combine the Bouevitch and Sparks references. *Compare* Ex. 1037, New Ford Decl. ¶ 155; *with* Ex. 1016, Drabik Decl. ¶ 155. *Second*, Petitioner’s explanation for the delay in proffering Dr. Ford’s declaration is insufficient to meet the “interests-of-justice” standard.

Petitioner also says that Drabik’s declaration should remain in the record as evidence in support of the Petition *even if* its motion for supplemental information is granted. Ex. 2010, Conf. Call. Tr. 21:6-22:9. The Board should expunge Drabik’s declaration because reliance on it violates the rules of routine discovery, the rules of evidence, curtails due process, and unfairly prejudices Capella.

A. New Exhibit 1037 is not “substantively identical” to Exhibit 1016; it contains new testimony regarding alleged motivation to combine.

During the October 29, 2015 conference call with the Board, Capella explained that allowing a new declaration at this stage would be unfair because Petitioner could supplement the evidence originally relied upon with the benefit of seeing Capella’s Preliminary Response and the Board’s Institution Decision. Ex. 2010, Conf. Call. Tr. 17:24-18:4. Petitioner assured the Board that it would not do this. *Id.* at 22:15-22 (“Yes, Your Honor. You know, Patent Owner’s suspicion that we would take the opportunity to change the contents of the declaration [is] simply

false.”). And Petitioner affirmatively represented in its motion that the new and originally filed declarations are “substantively identical.” Paper 17, Motion, p. 4 (“Exhibit 1037 is substantively identical to Exhibit 1016”). They are not.

Unlike the originally submitted Drabik Declaration (Ex. 1016), the Ford Declaration (Ex. 1037) contains new testimony relating to the alleged motivation to combine Bouevitch and Sparks—one of the instituted grounds. *Compare* Ex. 1037, Ford Decl. ¶ 155 *with* Ex. 1016, Drabik Decl. ¶ 155; *see also* Ex. 2011 (highlighting new text added to ¶ 155 generated by comparing Ex. 1016 with Ex. 1037). For example, Dr. Ford’s paragraph 155 includes new explanation relating to, among other things: (a) the alleged relatedness of the subject matter between the references; (b) allegedly similar applications to which the references are directed; (c) alleged similarities between the references; (d) new allegations that using aspects of one reference in the other would have been “nothing more than using known techniques to improve similar devices”; and (e) new expert testimony from Dr. Ford relating to what the skilled artisan allegedly would have been motivated to do at the time with respect to specific aspects of each reference. These changes are substantive, extensive, and material to an instituted ground.¹

¹ Petitioner may argue that it has merely replaced the phrase “the motivations to combine of Point 1 are hereby incorporated by reference” with explanation that appears elsewhere in the Drabik Declaration. Capella disagrees. “Point 1” relates to

Permitting Petitioner to supplement its originally filed declaration in this way would contravene 35 U.S.C. § 312(a)(3)(B) and 37 C.F.R. § 42.104(b)(5), which require *the petition* to identify with particularity the evidence supporting the challenge. *See also Mitsubishi Plastics, Inc. v. Celgard, LLC*, IPR2014-00524, Paper 30, pp. 5-6 (Nov. 28, 2014). Indeed, the Board has repeatedly denied requests that attempt to supplement the petition with the unfair benefit of hindsight. *See, e.g., Redline Detection, LLC v. Star Envirotech, Inc.*, IPR2013-00106, Paper 24, p. 4 (Aug. 5, 2013); *ZTE Corp. v. ContentGuard Holdings*, IPR2013-00139, Paper 27, p. 3 (Jul. 30, 2013). The Board should do the same here.

B. The standard for filing supplemental information under Rule 123(b) has not been met; the evidence reasonably *could* have been obtained earlier.

As the proponent of the supplemental information, it is Petitioner's burden to show that it "reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice." 37 C.F.R. § 42.123(b). Petitioner argues that it could not have obtained the supplemental information earlier as it had no reason to seek this information before learning that Dr. Drabik "was deceased." Paper 17, Motion, p. 4. But Petitioner

the disclosure of a different reference, *Smith*. The new explanation attempts to describe the specific features of *Bouevitch* with respect to the specific features of *Sparks*. That is precisely the type of supplementation that should not be permitted.

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