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Paper 19
Date: November 23, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

FUJITSU NETWORJ COMMUNICATIONS, INC.,
Petitioner,

v.

CAPELLA PHOTONICS, INC.,
Patent Owner.

Case IPR2015-00726
Patent RE42,368 E

Before JOSIAH C. COCKS, KAYLAN K. DESPHANDE and JAMES A. TARTAL, *Administrative Patent Judges.*

COCKS, *Administrative Patent Judge.*

DECISION
Motion to File Supplemental Information
37 C.F.R. § 42.123(b)

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1. Introduction

As was authorized (*see* Paper 14), Petitioner, Fujitsu Network Communication, Inc. ("Fujitsu" or "Petitioner") filed a "Petitioner's Motion to File Supplemental Information Under 37 C.F.R. § 42.123(b)." Paper 17, "Motion." As also authorized, Patent Owner, Capella Photonics, Inc. ("Capella" or "Patent Owner") filed a "Patent Owner's Opposition To Petitioner's Motion To File Supplemental Information Under 37 C.F.R. § 42.123(b)." Paper 18, "Opposition." For the reasons set forth below, Fujitsu's Motion is *granted*.

2. Discussion

Pursuant to 37 C.F.R. § 42.123(b), a party seeking to submit supplemental information more than one month after the date a trial is instituted, "must show why the supplemental information reasonably could not have been obtained earlier, and that consideration of the supplemental information would be in the interests-of-justice." Here, Fujitsu's request for the late submission of supplemental information arises due to the unexpected death of its declarant, Dr. Timothy Drabik, which occurred before Capella had opportunity to cross-examine Dr. Drabik. The supplemental information that Fujitsu seeks to enter into this proceeding is a substitute Declaration of Dr. Joseph E. Ford (Ex. 1037) along with Dr. Ford's curriculum vitae (Ex. 1038). Fujitsu represents that Dr. Ford's Declaration is "substantively identical" to that of Dr. Drabik. Motion 3. Fujitsu also represents that "consideration of the supplemental information is in the interests-of-justice because it accommodates Patent Owner's demand for cross-examination and there is no prejudice." *Id*. at 4.

Capella opposes entry of Dr. Ford's Declaration on the ground that it is not substantively identical to the Declaration of Dr. Drabik. In that respect, Capella contends that paragraph 155 of Dr. Ford's Declaration includes additional text

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directed to motivation to combine aspects of Sparks[1] and Bouevitch[2] that was not articulated in the same manner in Dr. Drabik's Declaration.[3] Opposition 2–3. Capella also contends that Fujitsu "provides no reason why Ford's declaration could not have been submitted earlier," and that Fujitsu should have sought to have that Declaration entered earlier as supplemental information. *Id*. at 3–4. Capella, thus, urges that Dr. Ford's Declaration should not be entered into this proceeding. Lastly, Capella also requests that Dr. Drabik's Declaration be expunged or stricken because Capella did not have opportunity to cross-examine Dr. Drabik. *Id*. at 5.

In considering the respective positions of the parties, we are mindful of the unfortunate event –Dr. Drabik's death– that necessitates consideration of the issues noted above. We turn first to Capella's contention that Fujitsu should have submitted Dr. Ford's Declaration earlier. There is nothing in the record before us that suggests that Fujitsu attempted to conceal any health consideration of Dr. Drabik, or prohibit Capella from cross-examining Dr. Drabik. Indeed, the record reflects that around the middle of September, Capella sought to schedule a deposition of Dr. Drabik in October, and we do not discern any reason on the present record to conclude that Fujitsu was aware, at such time, that Dr. Drabik's health might interfere with that scheduling. We also do not see cause to question Fujitsu's representations that when it became aware of Dr. Drabik's health issues on September 28, 2015, Fujitsu fully expected Dr. Drabik to recover so as to be deposed on schedule. *See* Motion 2.

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[1] U.S. Patent No. 6,625,340 B1 (Ex. 1006).

[2] U.S. Patent No. 6,498,872 B2 (Ex. 1002).

[3] Sparks and Bouevitch are both involved in grounds upon which trial was instituted in this proceeding.

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By all accounts, it appears that Dr. Drabik's health deteriorated quickly, culminating in his death toward the end of October. Under the circumstances presented here, we do not conclude that Fujitsu was remiss in seeking to have a supplemental Declaration entered into the record, in lieu of that of Dr. Drabik, so as to give opportunity to Capella to provide appropriate cross-examination in connection with the testimony underlying Fujitsu's Petition.

With respect to the difference in wording vis-à-vis Dr. Drabik's and Dr. Ford's testimony appearing at paragraph 155 of each Declaration, we are cognizant that there is some variation between those paragraphs. Nevertheless, in carefully evaluating the nature of the variation, we do not discern that substantive content has been added to Dr. Ford's Declaration that was not already expressed as a part of Dr. Drabik's Declaration. In that respect, in lieu of a statement made by Dr. Drabik directed to "incorporat[ion] . . . by reference" of rationales to combine presented previously for a combination of Bouevitch and Carr[4] and applied in connection with Sparks and Bouevitch (Ex 1016 ¶ 155), Dr. Ford expresses those rationales within paragraph 155. We do not conclude that the express recitation in Dr. Ford's paragraph 155 of material that previously was incorporated by reference operates as a substantive addition. We also observe that Capella has opportunity to cross-examine Dr. Ford concerning his testimony.

Lastly, we decline Capella's request that we expunge or strike Dr. Drabik's Declaration. That Declaration served, in-part, as the evidentiary basis on which the panel instituted trial in this proceeding. In the interest of the clarity of the record, we conclude, at this time, that it should remain as an exhibit in this proceeding. Contrary to Capella's assertions, Cappella will not be prejudiced if Dr. Drabik's

[4] U.S. Patent No. 6,442,307 B1 (Ex. 1005).

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Declaration remains in the record, as, going forward, the panel will not consider the content of that Declaration as a part of any Final Written Decision.

3. Conclusion

For the foregoing reasons, we conclude that Fujitsu has met its burden in showing why the supplemental information it seeks to enter reasonably could not have been obtained earlier, and that it is in the interests-of-justice that its supplemental information be considered.[5]

4. Order

It is

ORDERED that Fujitsu's "Motion to File Supplemental Information Under 37 C.F.R. § 42.123(b)" (Paper 17) is *granted*.

[5] In e-mail correspondence to Board personnel, Fujitsu sought permission to file a reply to Capella's Opposition. No reply is authorized.

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