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Paper 32
Entered: February 5, 2016

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LUMENTUM HOLDINGS, INC., LUMENTUM, INC., and
LUMENTUM OPERATIONS LLC,
Petitioner,

v.

CAPELLA PHOTONICS, INC.,
Patent Owner.

Case IPR2015-00731
Patent RE42,368 E

Case IPR2015-00739
Patent RE42,678 E

Before JOSIAH C. COCKS, KALYAN K. DESHPANDE, and JAMES A. TARTAL, *Administrative Patent Judges*.

TARTAL, *Administrative Patent Judge.*

ORDER
Conduct of the Proceedings
37 C.F.R. § 42.5

On February 2, 2016, a conference call was conducted with Judges Cocks, Deshpande, and Tartal; counsel for Petitioner Lumentum Holdings, Inc., Lumentum, Inc., and Lumentum Operations LLC; and, counsel for Patent Owner Capella Photonics, Inc. to discuss two requests submitted by Patent Owner to the Board by email on January 31, 2016.

By way of background, the Petition was filed on February 13, 2015, and identified JDS Uniphase Corporation ("JDSU") as the real party-in-interest. Paper 1, 1. During late July and early August, 2015, as part of a reorganization, JDSU was renamed Viavi Solutions Inc. ("Viavi"). Additionally, certain assets and obligations associated with communications and commercial optical products were spun out to Lumentum Holdings Inc., Lumentum, Inc. and Lumentum Operations LLC. Paper 22, 1–5; Ex. 1037 (stating that pursuant to a series of agreements entered July 31, 2015, Viavi transferred certain business segments to Lumentum Holdings Inc. pursuant to a distribution effective August 1, 2015.)

On August 25, 2015, a decision instituting trial in this proceeding was entered. On September 15, 2015, an updated mandatory notice was filed stating that, as a result of a reorganization involving JDSU, the real parties-in-interest to this proceeding are Lumentum Holdings Inc., Lumentum, Inc. and Lumentum Operations LLC. Petitioner's updated mandatory notice was not filed within 21 days of the change in name of the real parties-in-interest, as required by 37 C.F.R. §42.8 (a) (3).

On January 15, 2016, we conducted a teleconference with the parties in response to a request by Petitioner to re-caption the proceeding to reflect the change in name of the real parties-in-interest. During that call we

authorized Petitioner to file a motion to re-caption the proceeding, and accepted Petitioner's late-filing of the updated mandatory notice. *See* 37 C.F.R. §42.5(c)(3). On January 22, 2016, Petitioner filed a Motion to Re-Caption the Proceeding (the "Motion"). Paper 22. Patent Owner did not oppose the Motion. The Motion was granted on January 29, 2016. Paper 28. During the teleconference on February 2, 2016, Patent Owner conceded that it has no evidence to dispute the identification of the real parties-in-interest provided by Petitioner.

(1) Request to Compel Production

The Motion stated that "[b]y the Contribution Agreement, Lumentum Operations LLC assumed responsibility of "Assumed Actions," including this proceeding." Paper 22, 3. That statement was supported by a footnote that purportedly contained confidential information which referred to a non-public document identified as "Schedule 5.5(A) of the Contribution Agreement." Our decision granting the Motion did not rely upon the purportedly confidential information. Paper 28, n.1.

Patent Owner seeks to compel Petitioner to produce Schedule 5.5(A) as routine discovery, which includes "any exhibit cited in a paper." 37 C.F.R. §42.51(b)(1)(i). Petitioner opposed production on the ground that Schedule 5.5(A) was not an exhibit that had to be produced because it was not cited as an exhibit.

We determine that by relying upon, expressly referencing, and quoting Schedule 5.5(A) in support of its Motion, Petitioner utilized information contained in Schedule 5.5(A) as an exhibit, regardless of whether Petitioner called it an exhibit. Accordingly, Petitioner is obligated

to produce and file a copy of Schedule 5.5(A) as an exhibit. However, we disagree with Patent Owner's contention that Petitioner must produce a complete, unredacted copy of Schedule 5.5(A). There is no obligation on a party to produce non-relevant information, and Petitioner has asserted that Schedule 5.5(A) contains highly confidential business information entirely unrelated to this proceeding. Accordingly, while production of a complete document is typically preferred, we are persuaded under the specific circumstances presented that Petitioner is required to file Schedule 5.5(A) as an exhibit, but may redact any content from it not relevant to this proceeding.

(2) Request for Authorization to File a Motion to Terminate

Patent Owner also requests authorization to file a motion to terminate. We understand Patent Owner to contend that it will seek to show that the Board lacked jurisdiction to institute *inter partes* review because the Board was not informed of the change in name of the real party-in-interest prior to entry of the institution decision. We note that there is no dispute that the proper real party-in-interest was identified when the Petition was filed, and no evidence to suggest that Petitioner has failed to identify the proper real parties-in-interest after the corporate re-organization. Although not controlling, we also note that in *Elekta, Inc. v. Varian Medical System, Inc.*, IPR2015-01401, December 31, 2015, slip op. at 6 (Paper 19), the Board determined that "35 U.S.C. § 312(a)(2) does not define our jurisdiction with respect to *inter partes* review proceedings." Rather than preclude Patent Owner from addressing what it contends is a jurisdictional issue on the present record in this proceeding, we are authorizing a motion to terminate

as provided for below. In the interests of conserving time and resources, no opposition to the motion is authorized at this time, however, Petitioner will be provided an opportunity to respond if the Board determines such an opposition is necessary.

Accordingly, it is:

ORDERED that Petitioner shall file as an exhibit the "Schedule 5.5(A) of the Contribution Agreement," relied upon in its Motion to Re-Caption the Proceeding, and may redact any content from that exhibit not relevant to this proceeding;

FURTHER ORDERED that Patent Owner is authorized to file substantively identical Motions to Terminate in IPR2015-00731 and IPR2015-00739, not to exceed fifteen (15) pages, and limited only to Patent Owner's contention that the Board lacked jurisdiction to institute *inter partes* review in this proceeding, no later than February 19, 2016; and,

FURTHER ORDERED that no opposition by Petitioner to the Motions to Terminate is authorized at this time.

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