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 IPR2015-00739
Patent RE42,678

PATENT OWNER'S MOTION TO TERMINATE

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I. INTRODUCTION

On February 5, 2016, the Board authorized Capella to file a Motion to Terminate to further explain the Board's lack of jurisdiction to institute *inter partes* review in this proceeding. *See* Order, Paper 31. Capella argues that Petitioner failed to meet its statutory requirements under § 312(a)(2) and that the petition was incomplete. Since the Board should not have considered the petition when it instituted review, this proceeding should be terminated.

II. PETITIONER'S FAILURE TO MEET STATUTORY REQUIREMENTS REQUIRES TERMINATION.

1. The petition did not meet the statutory requirements of 35 U.S.C. § 312(a)(2).

The Patent Trial and Appeal Board may only consider a petition for *inter partes* review if the petition meets certain statutory requirements, including identification of all real parties-in-interest. 35 U.S.C. § 312(a)(2). Further, PTAB rules require that petitioners file and timely update mandatory notices that "[i]dentify each real party-in-interest for the party." 37 C.F.R. § 42.8. The Board has dismissed or terminated proceedings where the petition was incomplete and should not have been considered. *See Atlanta Gas Light Company v. Bennett Regulator Guards, Inc*. IPR2013-00453, Paper 88 (P.T.A.B., Jan. 6, 2015).

Petitioner filed this petition on February 14, 2015 and identified the RPI as only JDS Uniphase Corporation. Petition at 1. On July 31, 2015, JDSU transferred its interest in the instant action to Lumentum Operations LLC, an entity owned by

a subsidiary of Lumentum Holdings Inc. On the same day, JDSU became Viavi Solutions. Under 37 C.F.R. § 42.8, JDSU had 21 days to inform the Board of the change in RPI. On August 25, 2015, under the false belief that JDSU was still the correct RPI, the Board instituted trial. After the Board instituted trial and 25 days after the deadline to file an updated mandatory notice, Petitioner finally notified the Board of the RPI change, on September 15, 2015.

Petitioner contends that it has complied with § 312(a) because "[§]312(a) requires [only] that the petition identify the real parties in interest at the time of filing." Ex. 2035, 26:11-14. This interpretation is inconsistent with the language of the statute and PTAB practices. The petition must identify the RPI for it to be considered, and consideration does not occur at the moment of filing. Rather, when terminating proceedings, the Board has made clear that consideration takes place "at the time of institution." *See Corning Optical Communications RF, LLC, v. PPC Broadband, Inc*., IPR2014-00440, Paper 68 at 25 (P.T.A.B., Aug. 18, 2015)(terminating proceedings, stating the Board "cannot consider the Petitions, and should not have considered them at the time of institution"); *see also Medtronic v. Robert Bosch Healthcare Systems, Inc.,* IPR2014-00488, Paper 52 at 19 (P.T.A.B., March 16, 2015). The instant case exemplifies why Petitioner's interpretation of the statute is nonsensical—between the time a petition is filed and when the Board renders a decision to institute various events could occur that

might change key facts of a case, including the RPIs. Identifying the RPI solely at the time of filing and failing to timely update mandatory notices is insufficient and opens the door to gamesmanship and obfuscation.

Petitioner confuses the Board's initial presumptions of the petition with the statutory requirements. While the Board generally accepts the petitioner's identification of RPI *at the time of filing* the petition, this is merely a rebuttable presumption—one that is not only refutable, but also does not relieve the petitioner of its obligation to update the Board if there are any changes to the RPI. 77 Fed. Reg. 48612, 48695 (Aug. 14, 2012); 37 C.F.R. § 42.8. If § 312(a)(2) meant that the petitioner only needed to identify the RPI at filing, there would be no purpose to the rules on updating mandatory notices.

2. The petition is no longer correctable.

When a petition is incomplete, the corrected petition must be assigned a new filing date. 37 C.F.R. § 42.106(b). But the law is unclear if a petition can be amended under § 42.106 *post*-institution. *See Atlanta Gas Light*, IPR2013-00453, Paper 88 at 13; *see also Askeladden LLC v. Sean I. McGhie and Brian Buccheit*, IPR2015-00122, Paper 16 at 5 (P.T.A.B., Feb. 17, 2015)("Correcting a petition after institution may not be feasible."). Particularly where, as here, the Petitioner had the opportunity to correct the petition prior to the statutory deadline for institution, but elected not to do so, the petition cannot be amended under §

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