

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Ciena Corporation, Coriant Operations, Inc., Coriant (USA) Inc., and
Fujitsu Network Communications, Inc.

Petitioner

v.

Capella Photonics, Inc.

Patent Owner

INTER PARTES REVIEW OF U.S. PATENT NO. RE42,368

Filing Date: June 15, 2010
Reissue Date: May 17, 2011

Case IPR: *To Be Assigned*

**MOTION FOR JOINDER UNDER 35 U.S.C. § 315(c),
37 C.F.R. §§ 42.22, AND 42.122(b)**

I. STATEMENT OF PRECISE RELIEF REQUESTED

Ciena Corporation, Coriant Operations, Inc. (formerly Tellabs Operations, Inc.), Coriant (USA) Inc., and Fujitsu Network Communications, Inc. (collectively “Petitioner”) respectfully submit this Motion for Joinder concurrently with a petition (“Petition”) for *inter partes* review (IPR) under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), of claims 1-6, 9-13, and 15-22 of U.S. Patent No. RE42,368 (Ex. 1001) (“the ’368 patent”).

Petitioner requests institution of IPR and party joinder with the pending, instituted IPR titled, *Cisco Systems, Inc. v. Capella Photonics, Inc.*, IPR2014-01166 (the “Cisco IPR”). Cisco initiated its proceeding by petitioning the Board on July 15, 2014; the Board instituted the Cisco IPR on January 30, 2015. Petitioner timely filed this Petition and this motion, within one month of the institution of the Cisco IPR. 37 C.F.R. § 42.122(b).¹

¹ As stated in the Frequently Asked Questions section of the Patent Trial and Appeal Board’s website (available at <http://www.uspto.gov/ip/boards/bpai/prps.jsp>), Petitioner understands that prior authorization for filing a motion for joinder with a petition is not required. As suggested, the Petitioner contacted the Board by email, indicating that Petitioner is

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Joinder will efficiently resolve the challenges presented in the Petition and the instituted grounds of the Cisco IPR and will not prejudice the patent owner or the first-petitioner Cisco. Intentionally, the Petition is nearly word-for-word identical to the instituted grounds of the Cisco IPR in an effort to avoid multiplication of issues before the Board.² Further, the expert declaration submitted with the Petition is from the same declarant and is essentially identical to the declaration submitted in the Cisco IPR.³ Joinder would not complicate or delay the Cisco IPR and would not adversely affect the schedule. Joinder would result in efficient and timely resolution of the challenges presented in the Petition and the instituted grounds of the Cisco IPR. In contrast, absent joinder Petitioner may be prejudiced because its interests may not be adequately represented in the Cisco IPR.

willing to participate in a teleconference to discuss the present joinder request if the Board so desires.

² The only differences between the Cisco IPR Petition and this Petition are shown in redline in Ex. 1039.

³ The only differences between the declaration supporting Cisco's IPR Petition and the declaration supporting this Petition are shown in redline in Ex. 1040.

Should the panel join the parties, Petitioner agrees to subordinate itself, allowing Cisco to lead the joined proceedings absent settlement by Cisco, in line with common Board practice. Joinder with the Cisco IPR would minimally affect its procedure and substance. Cisco has stated to Petitioner that it does not oppose joinder.

II. BACKGROUND AND RELATED PROCEEDINGS

The '368 patent is assigned on its face to Capella Photonics, Inc. ("Capella" or "Patent Owner"). Capella asserted the '368 patent against Petitioner (Ciena Corporation, Coriant Operations, Inc. (formerly Tellabs Operations, Inc.), Coriant (USA) Inc., and Fujitsu Network Communications, Inc.), Cisco, and other parties in S.D. Fla.: *Capella Photonics, Inc. v. Cisco Systems, Inc.*, filed February 12, 2014 as 1:14-cv-20529 (transferred July 24, 2014 to N.D. Cal. as 3:14-cv-03348), *Capella Photonics, Inc. v. Fujitsu Network Communications, Inc.*, filed February 12, 2014 as 1:14-cv-20531 (transferred July 24, 2014 to N.D. Cal. as 3:14-cv-03349), *Capella Photonics, Inc. v. Tellabs, Inc. et al.*, filed February 12, 2014 as 0:14-cv-60350 (transferred July 24, 2014 to N.D. Cal. as 3:14-cv-03350), *Capella Photonics, Inc. v. Ciena Corporation et al.*, filed February 12, 2014 as 1:14-cv-20530 (transferred July 24, 2014 to N.D. Cal. as 5:14-cv-03351), *Capella Photonics, Inc. v. Columbus Networks USA, Inc.*, filed July 15, 2014 as 0:14-cv-

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61629 (stayed), and *Capella Photonics, Inc. v. Telefonica International Wholesale Services USA, Inc.*, filed July 21, 2014 as 1:14-cv-22701 (stayed).

The '368 patent is currently being challenged by Cisco in IPR2014-01166, as noted above.

III. STATEMENT OF REASONS FOR RELIEF REQUESTED

A. Legal Standard

The Leahy–Smith America Invents Act (AIA) allows an IPR party to be joined with a preexisting IPR. *See generally* Pub. L. No. 112-29, 125 Stat. 284 (2011). The statutory provision governing IPR joinder, 35 U.S.C. § 315(c), reads:

(c) JOINDER.--If the Director institutes an inter partes review, the Director, in his or her discretion, may join as a party to that inter partes review any person who properly files a petition under section 311 that the Director, after receiving a preliminary response under section 313 or the expiration of the time for filing such a response, determines warrants the institution of an inter partes review under section 314.

Under its discretion, the Board considers how joinder will affect the substance and procedure of the preexisting proceeding. *See, e.g.*, Decision on Motion for Joinder, *Motorola Mobility LLC v. Softview LLC*, IPR2013-00257, Paper 10 (P.T.A.B. June 20, 2013). In its response to comments on the Board's proposed joinder rule, 37 C.F.R. § 42.122, the PTO indicated that "joinder would

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