

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIENA CORPORATION

CORIAN T OPERATIONS, INC., and

CORIAN T (USA) INC.,

Petitioner v.

CAPELLA PHOTONICS, INC.

Patent Owner

Inter Partes Review Case No. Unassigned
Patent No. RE42,368

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

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I. STATEMENT OF PRECISE RELIEF REQUESTED

Coriant Operations, Inc. (“COI”), Coriant (USA) Inc. (“CUSA”), and Ciena Corporation (“Ciena”) (collectively, “Petitioner”) submit this Motion for Joinder concurrently with a Petition for *Inter Partes* Review (IPR) of U.S. Patent No. RE42,368 (“the ‘368 Patent”) (“Petition”) under 35 U.S.C. § 315(c) and 37 C.F.R. §§ 42.22 and 42.122(b), of claims 1-6, 9-12, and 15-22 of U.S. Patent No. RE42,368 (Ex. 1001).

Petitioner requests institution of IPR and party joinder with the pending, instituted IPR, titled *Fujitsu Network Communications, Inc. v. Capella Photonics, Inc.*, IPR2015-00726 (“the FNC IPR”), based on identical grounds that form the basis for the instituted IPR proceeding. FNC initiated its proceeding by petitioning the Board on February 12, 2015; the Board instituted the FNC IPR on August 24, 2015. Petitioner timely filed this Petition and this motion within one month of the institution of the FNC IPR. 37 C.F.R. § 42.122(b).

Joinder will efficiently resolve the challenges presented in the Petition and the instituted grounds of the FNC IPR and will not prejudice the patent owner or the first-petitioner FNC. Intentionally, the Petition is nearly word-for-word identical to the petition filed in the FNC IPR for the instituted grounds in an effort to avoid multiplication of issues before the Board.¹ Further, the expert declaration

¹ The only differences between the FNC IPR Petition and this Petition are shown

submitted with the Petition is from the same declarant and is essentially identical to the declaration submitted in the FNC IPR.²

Should the panel join the parties, Petitioner agrees to subordinate itself, allowing FNC to lead the joined proceedings absent settlement by FNC, in line with common Board practice. Joinder with the FNC IPR would minimally affect its procedure and substance. FNC 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.), and Coriant (USA) Inc.), Fujitsu Network Communications, Inc., (FNC), Cisco, and other parties in S.D. Fla.: *Capella Photonics, Inc. v. FNC 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

in redline in Ex. 1037.

² The only differences between the declaration supporting FNC’s IPR Petition and the declaration supporting this Petition are shown in redline in Ex. 1038.

Motion for Joinder

U.S. Patent No. 42,368

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-61629 (stayed), and *Capella Photonics, Inc. v. Telefonica International Wholesale Services USA, Inc.*, filed July 21, 2014 as 1:14-cv-22701. All district court cases have been stayed. The '368 patent is currently being challenged by FNC in IPR2014-00726, as noted above, and by various parties including parties of Petitioner in IPR2014-01166, IPR2015-00816 (joined with IPR2014-01166), and IPR2014-00731.

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 allow the Office to consolidate issues and to account for timing issues that may arise" when instituting multiple proceedings involving the same patent. Changes to Implement Inter Partes Review Proceedings, 77 Fed. Reg. 48,680, 48,707 (Aug. 14, 2012). Here, joining Petitioner to the FNC IPR is appropriate.

B. Joinder will not affect the Board's ability to timely complete the review.

Intentionally, the Petition is identical to the petition in the FNC IPR for the instituted grounds in an effort to avoid multiplication of issues. For simplicity and efficiency, Petitioner has copied FNC's IPR petition. Petitioner does not seek to reintroduce grounds or combinations of prior art, or claims not instituted in the FNC IPR and seeks only to join the proceeding as instituted. Petitioner is retaining the same expert as FNC, Dr. Timothy Drabik. The supporting declaration of Dr. Drabik is essentially identical to the declaration he previously submitted in the FNC IPR. Capella should not require any discovery beyond that which it may

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