

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

**PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. RE42,368 UNDER 35 U.S.C. §§ 311-319 AND
37 C.F.R. §§ 42.1-.80, 42.100-.123**

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TABLE OF CONTENTS

I.	<u>INTRODUCTION</u>	1
II.	<u>MANDATORY NOTICES AND FEES</u>	2
III.	<u>CERTIFICATION OF GROUNDS FOR STANDING</u>	4
IV.	<u>BACKGROUND</u>	5
V.	<u>CLAIM CONSTRUCTION</u>	8
VI.	<u>LEVEL OF ORDINARY SKILL IN THE ART</u>	14
VII.	<u>OVERVIEW OF CHALLENGE AND RELIEF REQUESTED</u>	14
	A. Summary of Grounds for Challenge.....	15
	B. Motivation to Combine References.....	16
	D. Ground 1: Claims 1, 2, 5, 6, 9-12 and 15-21 would have been obvious by the combination of Bouevitch and Carr.....	16
	E. Ground 2: Claims 1-4, 17 and 22 would have been obvious by the combination of Bouevitch and Sparks.....	39
VIII.	<u>CONCLUSION</u>	49
	ATTACHMENT A:	51
	ATTACHMENT B: APPENDIX OF EXHIBITS	52

I. INTRODUCTION

Petitioner Ciena Corp., Coriant Operations, Inc., and Coriant (USA) Inc., (“Petitioner”) requests *inter partes* review of claims 1-6, 9-12, and 15-22 (“Petitioned Claims”) of U.S. Patent No. RE42,368 (“the ‘368 patent”) (Ex. 1001), assigned on its face to Capella Photonics, Inc. (“Capella”).

This Petition relies on one primary reference, U.S. Patent No. 6,498,872 (“Bouevitch”) (Ex. 1002).

Bouevitch was before the Patent Office during the reissue prosecution, but Capella admitted that its original claims were overbroad and invalid over Bouevitch in view of one or more of three additional references. Although Capella amended its claims to purportedly overcome their deficiency, the amended claims fail to distinguish over the prior art references identified herein as Bouevitch in combination with U.S. Patent No. 6,442,307 (“Carr”) (Ex. 1005) or U.S. Patent No. 6,625,340 (“Sparks”) (Ex. 1006) render all of the Petitioned Claims obvious.

The Petitioned Claims are currently being challenged in view of the combination of Bouevitch and Smith in IPR2014-01166 and Bouevitch, Sparks, and Lin in IPR2015-00731. This Petition presents different grounds and prior art references than those addressed in those challenges. This petition presents the same grounds as those instituted in IPR2015-00726, and Petitioner seeks to join IPR2015-00726.

Inter partes review of the Petitioned Claims should be instituted because this petition shows that there is a reasonable likelihood that Petitioner will prevail on the Petitioned Claims. Each limitation of each Petitioned Claim is disclosed by and/or obvious to a person having ordinary skill in the art (“PHOSITA”) in light of the prior art discussed herein. Claims 1-6, 9-12, and 15-22 of the ‘368 patent should be found unpatentable and canceled.

II. MANDATORY NOTICES AND FEES

Real Parties-in-Interest: Petitioner Ciena Corporation, Coriant Operations, Inc. (“COI”), Coriant (USA) Inc. (“CUSA”), are the real parties-in-interest in this petition. Tellabs, Inc., a parent holding company of COI, was accused in litigation identified herein of infringing the ‘368 Patent. Even though Tellabs, Inc. was dismissed on jurisdictional grounds, Tellabs, Inc., and CUSA’s corresponding parent holding company, Coriant International Group LLC (formerly Blackhawk Holding Vehicle LLC), are also identified in this section out of an abundance of caution.

Related Matters: Capella has asserted the ‘368 patent in the following actions: *Capella Photonics, Inc. v. Cisco Systems, Inc.*, No. 3:14-cv-03348; *Capella Photonics, Inc. v. Fujitsu Network Communications, Inc.*, No. 3:14-cv-03349; *Capella Photonics, Inc. v. Tellabs Operations, Inc.*, No. 3:14-cv-03350; *Capella Photonics, Inc. v. Ciena Corporation*, No. 3:14-cv-03351 (collectively,

Petition for *Inter Partes* Review of
U.S. Patent No. RE42,368

“Capella Litigation”). Claims 1-6, 9-12, and 15-22 of the ‘368 patent are asserted in the Capella Litigation. Petitioner is also filing a petition for *inter partes* review against U.S. Patent No. RE42,678, which is the other patent asserted in the Capella Litigation and is related to the ‘368 patent. This Petition is filed with a motion seeking to join *Inter partes* review No. 2015-00726. *Inter partes* review Nos. 2014-01166, 2015-00726, 2015-00731, and 2015-00816 (joined with 2014-01166) are directed to the ‘368 Patent, and *inter partes* review Nos. 2014–01276, 2015-00727, 2015-00739, and 2015-00894 (joined with 2014–01276) are directed to U.S. Patent No. RE42,678.

Counsel: Lead counsel in this case is Matthew J. Moore (PTO Reg. No. 42,012); backup counsel is Robert Steinberg (Reg. No. 33,144), J. Pieter van Es (Reg. No. 37,746), Thomas K. Pratt (Reg. No. 37,210), Jordan N. Bodner (Reg. No. 42,338), and Michael CuvIELLO (Reg. No. 59,255). A power of attorney for each Petitioner accompanies this Petition.

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