

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIENA CORPORATION
CORIANT OPERATIONS, INC., and
CORIANT (USA) INC.,
Petitioner

v.

CAPELLA PHOTONICS, INC.
Patent Owner

Inter Partes Review Case No. IPR2015-01961
Patent No. RE42,678

**CORRECTED PETITION FOR *INTER PARTES* REVIEW OF
U.S. PATENT NO. RE42,678 UNDER 35 U.S.C. §§ 311-319 AND
37 C.F.R. §§ 42.1-.80, 42.100-.123**

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I. INTRODUCTION

Petitioner Ciena Corp., Coriant Operations, Inc., and Coriant (USA) Inc., (“Petitioner”) requests *inter partes* review of claims 1-4, 9, 10, 13, 17, 19-23, 27, 29, 44-46, 53 and 61-65 (“Petitioned Claims”) of U.S. Patent No. RE42,678 (“the ‘678 patent”) (Ex. 1001), assigned on its face to Capella Photonics, Inc. (“Capella”).

This corrected¹ Petition relies on one primary reference: U.S. Patent No.

¹ This corrected Petition is filed pursuant to the Board’s Order at Paper No. 6, which held that the original Petition, Paper No. 4, contained an unspecified 37 C.F.R. § 42.6(a)(B)(iv)(3) defect. Petitioner corresponded with the Board’s trial paralegals and understands that the defect was with Petitioner’s use of internal cross-citations in the claim charts of the declaration to other portions of the same document. To address this, Petitioner has replaced all such internal cross-citations in the declaration with the language referenced elsewhere in the same document. Petitioner corrected both the declaration (Ex. 1039) and this corrected Petition, since the Petition includes this same defect. For this reason only, the claim charts in the declaration (Ex. 1039) and this Petition have lengthened. Otherwise, the corrected Petition and declaration include the same information as originally filed and the same information as the instituted grounds of the petition and declaration in IPR2015-00727, which Petitioner seeks to join. The corrected declaration is left intentionally unsigned as advised by the PTAB clerk. No substantive changes were made to the declaration, but Dr. Timothy Drabik was hospitalized on

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 Carr 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 IPR2014-01276 and Bouevitch, Sparks, and Lin in IPR2015-00739. This Petition presents different grounds and prior art references than those addressed in those challenges. This petition presents the same grounds as IPR2015-00727, and Petitioner seeks to join IPR2015-00727.

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 1-4, 9, 10, 13, 17, 19-23, 27, 29, 44-46, 53 and 61-65 of the ‘678 patent should be found unpatentable and canceled.

II. MANDATORY NOTICES AND FEES

Thursday Oct. 1, 2015 and is not available to review or sign the updated declaration.

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

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