

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Coriant Operations, Inc.,
Coriant (USA) Inc.,
Ciena Corporation,
Cisco Systems, 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

Coriant Operations, Inc. (formerly Tellabs Operations, Inc.), Coriant (USA), Inc., Ciena Corporation, Cisco Systems, 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, *JDS Uniphase Corporation v. Capella Photonics, Inc.*, IPR2015-00731 (the “JDSU IPR”), based on identical grounds under which the JDSU IPR was instituted.¹ JDS Uniphase (“JDSU”) initiated its proceeding by petitioning the Board on February 13, 2015, and the Board instituted the JDSU IPR on August 25, 2015. Petitioner timely filed this Petition and this motion, within one month of the institution of the JDSU IPR. 37 C.F.R. § 42.122(b).

Joinder will efficiently resolve the challenges presented in the Petition and the instituted grounds of the JDSU IPR and will not prejudice the patent owner

¹ Petitioner understands that by virtue of a re-organization Lumentum Holdings Inc., Lumentum Inc. and Lumentum Operations LLC have succeeded JDSU for purposes of the IPR2015-00731 proceeding.

or the first-petitioner JDSU. Intentionally, the Petition is nearly word-for-word identical to the petition for IPR filed by JDSU in the JDSU IPR, except that the Petition has been limited to only the instituted grounds of the JDSU IPR in an effort to avoid multiplication of issues before the Board.² Further, the Petition includes a copy of the same expert declaration³ and other evidence that were filed with the JDSU IPR petition.⁴ Thus, Petitioner puts forth only arguments and evidence that the Board has already considered and determined to show a reasonable likelihood of Petitioner prevailing with respect to at least one of the claims challenged. Joinder would not complicate or delay the JDSU 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

² The only differences between the JDSU IPR Petition and Petitioner's Petition are shown in redline in Ex. 1037.

³ The PTAB has accepted, in a motion for joinder in another *inter partes* review proceeding, a copy of a previously-submitted expert declaration. *See, e.g.*, IPR2013-00495, Decision – Petitioner's Motion for Joinder (paper no. 13), p. 5.

⁴ All exhibits filed with the Petition were copied exactly from IPR2015-00731, except that the prefixes of the exhibit numbers from IPR2015-00731 have been redacted. The exhibit numbers are otherwise identical.

grounds of the JDSU IPR. In contrast, absent joinder, Petitioner may be prejudiced because its interests may not be adequately represented in the JDSU IPR.

Should the panel join the parties, Petitioner agrees to subordinate itself, allowing JDSU to lead the joined proceedings absent settlement by JDSU, in line with common Board practice. Joinder with the JDSU IPR would minimally affect its procedure and substance. JDSU has informed 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 all parties of Petitioner 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-61629, and *Capella Photonics, Inc. v. Telefonica International Wholesale Services USA, Inc.*, filed July 21, 2014 as 1:14-cv-22701, all of which are currently stayed.

The '368 patent is currently being challenged by JDSU in IPR2014-00731, as noted above, as well as by various parties including parties of Petitioner in IPR2014-01166, IPR2015-00816 (joined with IPR2014-01166), and IPR2015-00726.

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.

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