

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. RE42,678

Filing Date: June 15, 2010  
Reissue Date: September 6, 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 1-4, 9, 10, 13, 17, 19-23, 27, 29, 44-46, 53, and 61-65 of U.S. Patent No. RE42,678 (Ex. 1001) (“the ’678 patent”).

Petitioner requests institution of IPR and party joinder with the pending, instituted IPR titled, *JDS Uniphase Corporation v. Capella Photonics, Inc.*, IPR2015-00739 (the “JDSU IPR”), based on identical grounds under which the JDSU IPR was instituted. JDS Uniphase (“JDSU”)<sup>1</sup> initiated its proceeding by petitioning the Board on February 14, 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

---

<sup>1</sup> 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 IPR2015-00739 proceeding.

the instituted grounds of the JDSU IPR and will not prejudice the patent owner 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.<sup>2</sup> Further, the Petition cites to the same expert declaration<sup>3</sup> and other evidence that were filed with the JDSU IPR petition.<sup>4</sup> 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

---

<sup>2</sup> The only differences between the JDSU IPR Petition and Petitioner's Petition are shown in redline in Ex. 1048.

<sup>3</sup> 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.

<sup>4</sup> All exhibits filed with the Petition were copied exactly from IPR2015-00739, except that the prefixes of the exhibit numbers from IPR2015-00739 have been redacted. The exhibit numbers are otherwise identical.

resolution of the challenges presented in the Petition and the instituted 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 '678 patent is assigned on its face to Capella Photonics, Inc. ("Capella" or "Patent Owner"). Capella asserted the '678 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 '678 patent is currently being challenged by JDSU in IPR2014-00739, as noted above, as well as by various parties including parties of Petitioner in IPR2014-01276, IPR2015-00894 (joined with IPR2014-01276), and IPR2015-00727.

### **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.

# Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

## Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

## Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

## Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

## API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

## LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

## FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

## E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.