

Filed on behalf of Petitioner Corning Optical Communications RF, LLC

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING OPTICAL COMMUNICATIONS RF, LLC
Petitioner

v.

PPC BROADBAND, INC.
Patent Owner

Case No. IPR2013-00342
Patent No. 8,323,060

CORNING RESPONSE TO ORDER ON REMAND

Pursuant to the Order dated May 20, 2016 (Paper 51, “Order”) issued by the Patent Trial and Appeal Board (“PTAB” or “Board”), Petitioner, Corning Optical Communications RF, LLC (“Corning”), and Patent Owner, PPC Broadband, Inc. (“PPC”), have conferred concerning Items (1), (2), and (3) set forth on page 2 of the Order. Because the parties could not reach agreement with respect to Item (1) or Item (2), this separate paper is filed by Corning.

I. Corning’s Response to the Order

A. Issue (1): Matters to be Reconsidered / Reassessed before the Board on Remand

The matters to be reconsidered / reassessed before the Board on remand from the decision of the United States Court of Appeals for the Federal Circuit (“CAFC”) in *PPC Broadband, Inc. v. Corning Optical Communications RF LLC*, 815 F.3d 747 (Fed. Cir. 2016), include whether claims 10-25 of the ‘060 patent are unpatentable under 35 U.S.C. § 103 as being obvious over Matthews in view of Tatsuzuki, in light of the CAFC’s construction of the term “reside around.”

To determine whether claims 10-25 of the ‘060 patent are unpatentable, the CAFC has instructed the Board as to the proper construction of the term “reside around.” *Id.* at 756. The term “reside around” appears in claim 10 (Ex. 1001 at 22:29-36) of the ‘060 patent. The specific issue to be considered on remand is whether the “reside around” recitation is obvious over the combination of prior art previously found to be obvious by the Board (e.g., as shown in Ex. 2007 and/or

Ex. 1034). The Board’s determination in its Final Written Decision that it would have been obvious to combine the prior art was not disturbed by the CAFC.¹ The prior art references to be considered are the references cited in Petitioner’s Reply (Paper 32) and the Final Written Decision (Paper 49), i.e., Matthews, Tatsuzuki, and Bence.²

B. Issue (2): Whether Additional Briefing and / or Submission of New Evidence Is Required or Should Be Permitted

Corning submits that additional briefing and submission of new evidence are not required by the rules of the Board. However, additional briefing should be permitted concerning the matters set forth in section I.A. above, in order to direct the Board’s attention to arguments and evidence of record which demonstrate that claims 10-25 of the ‘060 patent are unpatentable in light of the CAFC’s decision.

Corning submits that new evidence should not be permitted.

¹ In affirming the unpatentability of claims 1-7, 9-15, 17-30, and 32 of the ‘320 patent (*see PPC Broadband Inc. v. Corning Optical Communications RF LLC*, 815 F.3d 734, 747 (Fed. Cir. 2016)), the CAFC upheld the obviousness of the combination of Matthews and Tatsuzuki in light of the evidence of the level of ordinary skill in the art provided by U.S. Patent No. 7,114,990 (“Bence,” Exs. 1005).

² As noted by the Board, Bence “is a reference providing evidence of the level of ordinary skill in the art.” Final Written Decision at 30.

C. Issue (3): Whether the Party Would Request Additional Briefing and / or Submission of New Evidence

Corning hereby requests additional briefing concerning the matters set forth in section I.A. above. Corning does not request submission of new evidence.

D. Real Party-In-Interest Is Not a Matter that Must Be Reconsidered on Remand

PPC's counsel indicated that it will, on remand, challenge the correctness of the real party-in-interest (RPI) identification in the Petition. Corning submits that the Petition correctly identified Corning Gilbert Inc. as the only RPI in this proceeding.³ In the event the Board deems it necessary to reconsider / reassess the correctness of the RPI identification, Corning hereby submits a contingent request to amend its Petition to name as additional RPIs Corning Incorporated and Corning Optical Communications LLC. This request to amend the RPI identification in the Petition is contingent on the Board allowing for such amendment without loss of the original filing date of the Petition. This request is appropriate in view of the fact that the requirement to name all RPIs under 35 U.S.C. § 312(a)(2) is not jurisdictional, and permitting amendment of the RPI identification would be in the

³ On March 6, 2014, Corning filed an Updated Mandatory Notice indicating that the RPI, Corning Gilbert Inc., changed its name to Corning Optical Communications RF, LLC.

interests of justice. *See Lumentum Holdings, Inc. v. Capella Photonics, Inc.*, IPR2015-00739, Paper 38 at 4-5 (PTAB Mar. 4, 2016) (precedential).⁴

The assessment of whether the RPI was properly identified in the Petition is not a matter that “must be reconsidered / reassessed before the Board on remand.” Prior PTAB panels have held that briefing on remand should be limited to addressing the effect of the CAFC’s decision on the Final Written Decision, and that no new evidence should be entered on remand. *See, e.g., Microsoft Corp. v. Proxyconn, Inc.*, IPR2012-00026, Paper 77 at 3 (PTAB Sept. 1, 2015) (“briefs shall address the effect of the Federal Circuit’s...decision on our Final Written Decision;” “no new...evidence shall be presented”); *Motivepower, Inc. v.*

⁴ In separate proceedings (IPR2014-00440, -00441 and -00736), the Board issued a combined Decision on August 18, 2015 dismissing those proceedings based on a determination that the Petitions did not name all RPIs. Corning disagrees with this determination and has appealed the vacatur of the institution decisions. The Petitions in IPR2014-00440 and -00441 were filed on February 18, 2014, and the Petition in IPR2014-00736 was filed on May 7, 2014, well after the June 10, 2013 filing date of the Petition in this proceeding. The decisions in such separate proceedings are “not determinative of the question of whether [an entity] is an RPI to this *inter partes* review.” *Aruze Gaming Macau, Ltd. v. MGT Gaming, Inc.*, IPR2014-01288, Paper 13 at 16 (PTAB Feb. 20, 2015).

Cutsforth, Inc., IPR2013-00274, Paper 37 at 3 (PTAB Mar. 31, 2016) (“no new...evidence shall be presented by either party beyond that considered in the Board’s Final Written Decision”). Here, the RPI identification is not a matter that must be reconsidered / reassessed on remand because RPI is not at issue in the Final Written Decision and the CAFC’s decision. *See Cardiac Pacemakers, Inc. v. St. Jude Medical, Inc.*, 576 F.3d 1348, 1355-56 (Fed. Cir. 2009) (any new issue must be “directly related” to an issue ordered for consideration on remand).

Furthermore, PPC did not request the CAFC to remand to the PTAB based on the RPI identification in its opening brief on appeal, despite having sought dismissal of the other IPR proceedings based on RPI almost two months prior to the date on which the opening brief was filed.⁵ Instead, PPC chose to obtain a substantive decision on the merits. Thus, PPC has waived the issue. *See Engel Indus., Inc. v. Lockformer Co.*, 166 F.3d 1379, 1383 (Fed. Cir. 1999) (“[T]he court is entitled to assume that an appellant has raised all issues it deems important against a judgment appealed from. An issue that falls within the scope of judgment appealed from but is not raised by the appellant in its opening brief on appeal is necessarily waived.”). *See also Duty Free Int’l, Inc. v. United States*, 88 F.3d 1046, 1048 (Fed. Cir. 1996) (non-jurisdictional issues are waived if not raised in

⁵ PPC sought dismissal of IPR2014-00440, -00441 and -00736 on March 31, 2015. PPC filed its opening appellate brief on May 26, 2015.

briefing); *Lumentum*, IPR2015-00731 at 4-5 (requirement under § 312(a)(2) is not jurisdictional). Further, RPI identification is not an issue that must be reconsidered on remand because the CAFC did not require the Board to reconsider this issue on remand.⁶

In the event PPC requests for additional briefing and/or submission of new evidence on a matter not requested by Corning, and the Board grants such request, Corning reserves the right to request for additional briefing and/or submission of new evidence on such matter.

Respectfully submitted,

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⁶ PPC mentioned RPI in a footnote in its reply brief filed on September 10, 2015.

CERTIFICATE OF FILING AND SERVICE

I hereby certify that a true and correct copy of the foregoing **CORNING**
RESPONSE TO ORDER ON REMAND is being filed via PRPS and served via
electronic mail this 9th day of June, 2016 on the Patent Owner as follows:

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