

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CIENA CORPORATION, CORIANT (USA) INC., CORIANT NORTH
AMERICA, LLC, CORIANT OPERATIONS, INC., INFINERA
CORPORATION, FUJITSU NETWORK COMMUNICATIONS, INC.,
HUAWEI TECHNOLOGIES CO. LTD., HUAWEI TECHNOLOGIES
USA INC, AND NOKIA OF AMERICA CORPORATION¹

Petitioner,

v.

OYSTER OPTICS, LLC,
Patent Owner.

Case IPR2018-00070
Patent 8,913,898 B2

Before JAMESON LEE, RAMA G. ELLURU, and JOHN R. KENNY,
Administrative Patent Judges.

KENNY, *Administrative Patent Judge.*

DECISION

Granting Joint Motion to Terminate and
Partially Granting Joint Request to File Settlement Agreement
as Business Confidential Information
37 C.F.R. §§ 42.71(a), 42.74

¹Petitioner has informed the Board that Alcatel-Lucent USA Inc. has
changed its name to Nokia of America Corporation. Paper 17, 1.

Coriant (USA) Inc., Coriant North America, LLC, and Coriant Operations, Inc. (collectively, “Coriant petitioner entities”) and Patent Owner filed a Joint Motion to Terminate, seeking to terminate the Coriant petitioner entities from this proceeding. Paper 24. The Coriant petitioner entities and Patent Owner also filed a settlement agreement (Ex. 2200) and a Joint Request to File Settlement Agreement as Business Confidential Information Pursuant to 35 U.S.C. § 317(b). Paper 25 (“Request to Keep Confidential”). Additionally, the Coriant petitioner entities and Patent Owner filed a copy of their Joint Motion for Dismissal in the related civil action before the U.S. District Court in the Eastern District of Texas, *Oyster Optics, LLC v. Coriant America Inc.*, No. 2:16-cv-01302 (E.D. Tex.), and an Order by the district court granting that motion. Exs. 2201, 2202. The Coriant petitioner entities and Patent Owner certify that there are no other collateral agreements or understanding made in connection with, or in contemplation of, the termination of this *inter partes* review with respect to the Coriant petitioner entities. Paper 24, 3.

In the Request to Keep Confidential, the Coriant petitioner entities and Patent Owner request that:

the Settlement Agreement (confidential Exhibit 2200) (i) be treated as business confidential information, (ii) be maintained separate from the publicly available file of the involved patent, and (iii) be made available only to Federal Government agencies on written request served in advance on Patent Owner and Coriant Petitioners, or to persons showing good cause on written request served in advance on Patent Owner and Coriant Petitioners, pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c).

Paper 25, 2.

We determine that good cause exists to terminate this proceeding with respect to the Coriant petitioner entities. *See* 37 C.F.R. § 42.71(a). This proceeding is at a relatively early stage, with the Patent Owner's Response filed on August 29, 2018. Paper 26. In addition, the Coriant petitioner entities and Patent Owner represent that "[t]he remaining petitioners have indicated that they do not oppose this Motion." Paper 24, 3.

We further determine that the Settlement Agreement should be treated as business confidential information pursuant to 35 U.S.C. § 317(b). But the specific request that such treatment include advance service on the Coriant petitioner entities and on Patent Owner before making the Settlement Agreement available extends beyond what is provided by the relevant statute or regulation. *See* 35 U.S.C. § 317(b) ("At the request of a party to the proceeding, the agreement or understanding shall be treated as business confidential information, shall be kept separate from the file of the involved patents, and *shall* be made available only to Federal Government agencies on written request, or to any person on a showing of good cause.") (emphasis added); 37 C.F.R. § 42.74(c) ("If a timely request is filed, the settlement shall only be available: (1) To a Government agency on written request to the Board; or (2) To any other person upon written request to the Board to make the settlement agreement available, along with the fee specified in §42.15(d) and on a showing of good cause.").

Accordingly, we partially grant the Joint Request to File Settlement Agreement as Business Confidential Information, by treating the Settlement Agreement as business confidential information under 37 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c), but we do not impose any "served in advance on"

Patent Owner and Coriant petitioner entities requirement for access by anyone, as requested by the Coriant petitioner entities and Patent Owner.

It is

ORDERED that the Joint Motion to Terminate (Paper 24) is granted;

FURTHER ORDERED that this proceeding is hereby terminated with respect to Coriant (USA) Inc., Coriant North America, LLC, and Coriant Operations, Inc.;

FURTHER ORDERED that Infinera Corporation, Fujitsu Network Communications, Inc., Huawei Technologies Co. Ltd., Huawei Technologies USA Inc, and Nokia of America Corporation collectively remain as Petitioner in this proceeding, and that the caption of subsequent filings reflect only Infinera Corporation, Fujitsu Network Communications, Inc., Huawei Technologies Co. Ltd., Huawei Technologies USA Inc, and Nokia of America Corporation as Petitioner;

FURTHER ORDERED that the Joint Request to File Settlement Agreement as Business Confidential Information (Paper 25) is partially granted, as discussed above, and no “served in advance on” Patent Owner and Coriant petitioner entities requirement is imposed on anyone for obtaining access to the settlement agreement; and

FURTHER ORDERED that the Settlement Agreement (Ex. 2200) be treated as business confidential information pursuant to 35 U.S.C. § 317(b) and 37 C.F.R. § 42.74(c) and remain designated as “Board and Parties Only” in the Board’s E2E system.

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