

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PANDUIT CORP.,
Petitioner,

v.

CORNING OPTICAL COMMUNICATIONS LLC,
Patent Owner.

IPR2021-01562
Patent 10,444,456 B2

Before JENNIFER MEYER CHAGNON, CHARLES J. BOUDREAU, and
TERRENCE W. McMILLIN, *Administrative Patent Judges*.

McMILLIN, *Administrative Patent Judge*.

DECISION
Denying Institution of *Inter Partes* Review
35 U.S.C. § 325(d)

I. INTRODUCTION

A. *Background and Summary*

Panduit Corp. (“Petitioner”) filed a Petition to institute an *inter partes* review of claims 1–30 of U.S. Patent No. 10,444,456 B2 (Ex. 1001, “the ’456 patent”) pursuant to 35 U.S.C. § 311 *et seq.* Paper 5 (“Petition” or “Pet.”). Corning Optical Communications LLC (“Patent Owner”) filed a Preliminary Response. Paper 16 (“Preliminary Response” or “Prelim. Resp.”). With our authorization, Petitioner filed a Reply to Patent Owner’s Preliminary Response. Paper 19 (“Reply”).

After considering the Petition, the Preliminary Response, the Reply, and the evidence of record, we exercise our discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review as to the challenged claims of the ’456 patent.

B. *Real Parties in Interest*

Petitioner initially identified only Panduit Corp. as the real party in interest to this proceeding. Pet. 75; Paper 9, 2. Patent Owner argues the “Petition’s identification of the real parties-in-interest is fatally defective” because “the RPI identified in the Petition is different from the real parties in interest identified in the Power of Attorney.” Prelim. Resp. 41–42 (citing Pet. 75). In an Updated Mandatory Notice, Petitioner identifies Panduit Corp., The Siemon Company, FS.Com, Inc., and Reichle & De-Massari Holding AG as the real parties in interest. Paper 17, 2. To the extent that the identification of the real parties in interest in the Petition may have been defective because it differed from Petitioner’s Powers of Attorney (*see* Papers 1–4), that defect has been cured in Petitioner’s Updated Mandatory Notice.

C. Related Proceedings

The parties identify *Corning Optical Communications LLC v. Leviton Manufacturing Co.*, No. 1:21-cv-01185 (D. Del.) and *Leviton Manufacturing Co. v. Corning Optical Communications LLC*, No. 2:21-cv-01102 (W.D. Wash.) as related District Court litigations. Pet. 76; Paper 14, 1; Paper 17, 2. The parties also identify *Certain High-Density Fiber Optic Equipment and Components Thereof*, No. 337-TA-1194 (USITC) as a related United States International Trade Commission investigation, currently under appeal before the U.S. Court of Appeals for the Federal Circuit. Pet. 76; Paper 17, 2; Paper 14, 1.

Patents that are in the same patent family as the '456 patent (*see* Ex. 1001, code (60), 1:7–28) were before the Board in IPR2016-01703 (US 8,452,148 B2), IPR2016-01709 (US 8,184,938 B2), and IPR2017-00009 (US 9,020,320 B2). Final Written Decisions have been issued in those *inter partes* reviews (*see* Exs. 1012, 1013, 1016) and those decisions have been affirmed by the Federal Circuit. *Corning Optical Commc'ns LLC, v. Panduit Corp.*, 774 F. App'x 681 (Fed. Cir. Aug. 8, 2019); *Panduit Corp. v. Corning Optical Commc'ns LLC*, 774 F. App'x 682 (Fed. Cir. Aug. 8, 2019).

D. The '456 Patent

The '456 patent is titled “High Density and Bandwidth Fiber Optic Apparatuses and Related Equipment and Methods.” Ex. 1001, code (54). By way of background, the '456 patent explains that “fiber optic equipment is typically included in housings that are mounted in equipment racks to optimize use of space.” *Id.* at 1:55–57. The '456 patent further explains that “[w]hen additional bandwidth is needed or desired, additional fiber optic equipment can be employed” but, “increasing the number of optical fiber

ports can require more equipment rack space.” *Id.* at 1:63–67. As such, a “need exists to . . . minimiz[e] the space needed for such fiber optic equipment.” *Id.* at 2:2–7.

Figure 1, reproduced below, “is a front perspective view of an exemplary fiber optic equipment rack with an installed exemplary 1-U size chassis supporting high-density fiber optic modules to provide a given fiber optic connection density and bandwidth capability.” Ex. 1001, 3:7–11.

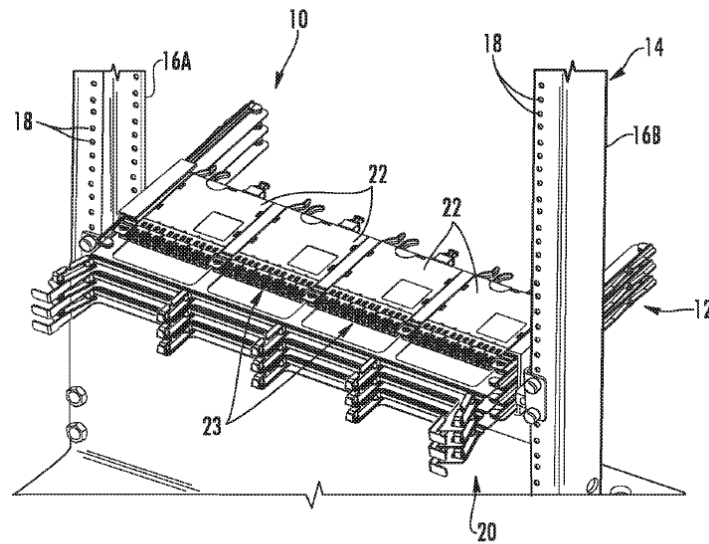


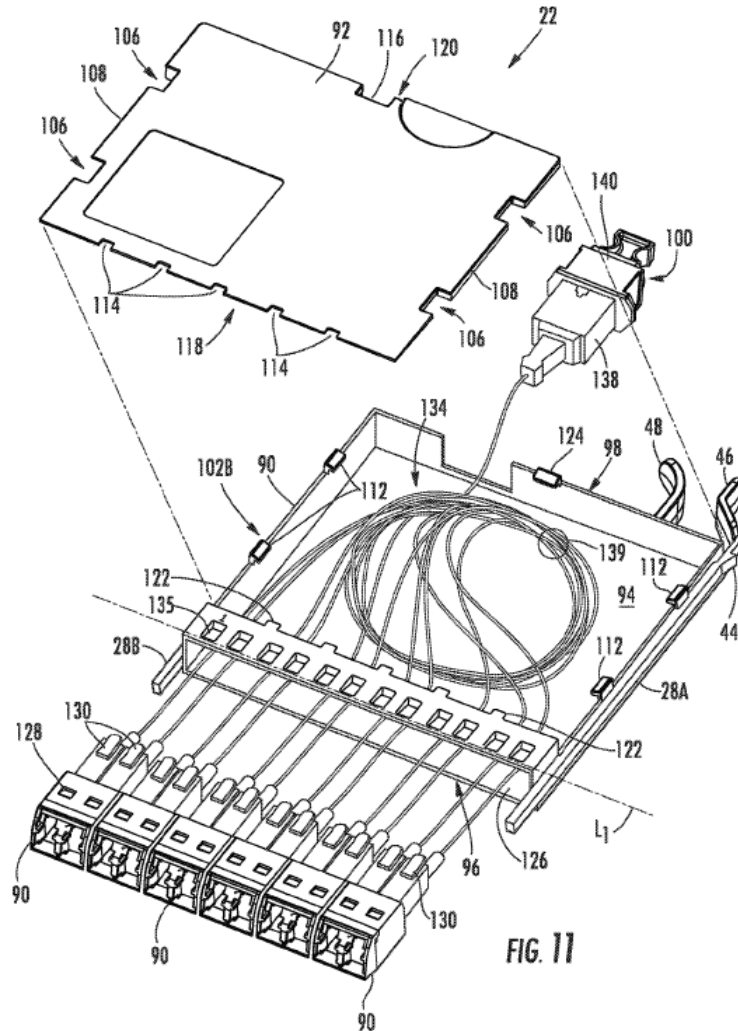
FIG. 1

As shown in Figure 1, fiber optic equipment rack 14 includes spaced apart vertical rails 16A, 16B, and fiber optic equipment chassis 12 is attached to rails 16A, 16B. *Id.* at 5:6–13. In particular, fiber optic equipment chassis 12 “is attached and supported by the fiber optic equipment rack 14 in the form of shelves that are stacked on top of each other within the vertical rails 16A, 16B.” *Id.* at 5:9–12. The shelves are “1-U-sized shelves, with ‘U’ equal to a standard 1.75 inches in height and nineteen (19) inches in width. In certain applications, the width of ‘U’ may be twenty-three (23) inches.” *Id.* at 5:13–17. The ’456 patent explains that “chassis 12 could be provided in a size greater than 1-U as well.” *Id.* at 5:19–21.

Within the U-sized shelf space is “a plurality of extendable fiber optic equipment trays 20 that each carries one or more fiber optic modules 22,” which “support high-density fiber optic modules and a fiber optic connection density and bandwidth connections.” Ex. 1001, 5:23–29. Figure 1 shows “fiber optic equipment trays 20 . . . support up to four (4) of the fiber optic modules 22 in approximately the width of a 1-U space, and three (3) fiber optic equipment trays 20 in the height of a 1-U space for a total of twelve (12) fiber optic modules 22 in a 1-U space.” *Id.* at 5:47–51.

Disposed in fiber optic modules 22 are fiber optic components 23, e.g., fiber optic adapters or fiber optic connectors, that support fiber optic connections. Ex. 1001, 5:29–33. The fiber optic components may be simplex or duplex components (i.e., transmit and receive channels). *Id.* at 5:44–46, 5:56–57. Based on the 12 fiber optic modules shown in the embodiment, the chassis supports “a total of one hundred forty-four (144) fiber optic connections.” *Id.* at 5:47–56. Alternatively, the chassis can support “a total of one hundred twenty (120) fiber optic connections” and “chassis 12 also supports at least ninety-eight (98) fiber optic components in a 1-U space wherein at least one of the fiber optic components is a simplex or duplex fiber optic component.” *Id.* at 5:58–67.

Figure 11, reproduced below, is an exploded view detailing fiber optic module 22, showing fiber optic components 23 disposed inside. Ex. 1001, 9:44–47, 9:63–64.



As shown in Figure 11, “fiber optic module 22 is comprised of a main body 90” having “internal chamber 94 . . . disposed inside the main body 90 . . . configured to receive or retain optical fibers or a fiber optic cable harness.” *Id.* at 9:9–14. “The main body 90 is disposed between a front side 96 and a rear side 98 of the 15 main body 90” with “fiber optic components” 23.¹ *Id.* at 9:14–16. “[F]iber optic components 23 are disposed through a front

¹ At the bottom of Figure 11, elements of fiber optic module 22 are labeled 90. Figures 10A and 10B show those same elements labeled as fiber optic components 23. *See* Ex. 1001, 9:16–17, 9:63–66; *see also* Figs. 2–3, 5, 7, 16, 17, 20, 23. As such, we understand that the elements at the bottom of Figure 11 labeled 90 are mislabeled and refer to fiber optic components 23.

opening 126 disposed along a longitudinal axis L1 in the front side 96 of the main body 90” and are “configured to receive fiber optic connectors connected to fiber optic cables.” *Id.* at 9:16–19, 9:63–66. In the embodiment shown, “fiber optic components 23 are duplex LC adapters 128, which support single or duplex fiber connections and connectors.” *Id.* at 9:66–10:1. Further, “cable harness 134 is disposed in the internal chamber 94 with fiber optic connectors 136, 138 disposed on each end of optical fibers 139 connected to the duplex LC adapters 128 and the fiber optic component 100 disposed in the rear side 98 of the main body 90.” *Id.* at 10:6–10. That is, “fiber optic components 23 are connected to a fiber optic component 100 disposed through the rear side 98 of the main body 90,” and “a connection to the fiber optic component 23 creates a fiber optic connection to the fiber optic component 100.” *Id.* at 9:24–28.

E. Illustrative Claim

Petitioner challenges claims 1–30 (all) of the ’456 patent. Of the challenged claims, claim 1, 11, 22, and 27 are independent apparatus claims. Ex. 1001, 20:10–56, 21:43–22:9, 23:4–39, 24:3–38. Claim 1 recites:

1. A fiber optic apparatus, comprising:

a chassis configured to be disposed in an equipment rack, the chassis comprising front and rear ends that are spaced apart from one another in a longitudinal direction, and comprising opposite first and second ends that are spaced apart from one another in a lateral direction that extends crosswise to the longitudinal direction;

a plurality of fiber optic equipment trays supported by the chassis and extendable relative to the chassis in the longitudinal direction; and

a plurality of fiber optic modules configured to be installed in the plurality of fiber optic equipment trays, wherein each fiber optic module of the plurality of fiber optic modules comprises a front

side configured to support a plurality of first fiber optic components, a rear side configured to support at least one second fiber optic component, an internal chamber, and a plurality of optical fibers disposed within the internal chamber and arranged to establish optical connections between the at least one second fiber optic component and the plurality of first fiber optic components;

wherein each fiber optic equipment tray of the plurality of fiber optic equipment trays is configured to receive multiple fiber optic modules of the plurality of fiber optic modules;

wherein the plurality of fiber optic equipment trays and the plurality of fiber optic modules are configured to support a fiber optic connection density of at least ninety-eight (98) fiber optic connections per U space of the chassis, based on using a simplex fiber optic component or a duplex fiber optic component as each fiber optic component of the plurality of first fiber optic components; and

wherein a U space comprises a height of 1.75 inches and comprises a width of 19 inches or 23 inches.

Id. at 20:10–56.

F. The Asserted Grounds

Petitioner challenges claims 1–30 of the '456 patent based on the grounds set forth in the table below.

Claim(s) Challenged	35 U.S.C. §	Reference(s)/Basis
1–8, 10–20, 22–25, 27–29	103(a) ²	Smrha '861, ³ Coburn, ⁴ Corning Fiber Optic Adapters ⁵
9, 21, 26, 30	103(a)	Smrha'861, Coburn, Corning Fiber Optic Adapters, Yamaguchi ⁶

Pet. 7. Petitioner supports its showing of unpatentability of the challenged claims of the '456 patent with the Declaration of Dr. Casimer DeCusatis. (Ex. 1003).

II. ANALYSIS

Patent Owner argues that we should exercise our discretion under 35 U.S.C. § 314(a) or § 325(d) to deny institution. *See* Prelim. Resp. 15–22. With regard to Section 325(d), Patent Owner contends “[t]he art and arguments presented in this Petition were previously presented to the Office multiple times in multiple contexts” (*id.* at 16–19) and that the “Petition . . . does not even attempt to demonstrate why the challenge here is not duplicative of the issues previously considered and rejected by the Office or how the Office erred in that prior consideration” (*id.* at 19–20). Petitioner

² The Leahy-Smith America Invents Act (“AIA”), Pub. L. No. 112-29, 125 Stat. 284, 285–88 (2011), revised 35 U.S.C. § 103 effective March 16, 2013. Because the challenged patent claims priority to applications filed before March 16, 2013, we refer to the pre-AIA version of Section 103. Our opinions on the present record would not change if the AIA versions of Section 103 were to apply.

³ US 7,570,861 B2, issued Aug. 4, 2009 (Ex. 1004).

⁴ US 2008/0175550 A1, published July 24, 2008 (Ex. 1005).

⁵ Corning Cable Systems, LANscape Solutions® Fiber Optic Products Catalog (2005) (Ex. 1006).

⁶ JP 2005-181600, published July 7, 2005 (Ex. 1007). Petitioner also filed an English language version of Yamaguchi. *See id.*

argues that we should decline to exercise our discretion to deny institution. *See* Pet. 70–75; Reply 1–5.

“We address this threshold issue first, and, determine that it is dispositive of our decision of whether to institute *inter partes* review.” *Advanced Bionics, LLC v. MED-EL Elektromedizinische Geräte GmbH*, IPR2019-01469, Paper 6 at 6 (PTAB Feb. 13, 2020) (precedential). We agree with Patent Owner’s contention that the same or substantially the same art and arguments presented in the Petition were previously before the Office and that Petitioner has not established that the Office erred in its previous consideration of Petitioner’s art and arguments. Thus, for the reasons explained below, we exercise our discretion under Section 325(d) to deny institution. Because we exercise our discretion under Section 325(d) to deny institution, we do not reach discretionary denial under Section 314(a).

A. 35 U.S.C. § 325(d)

Section 325 of Title 35 of the United States Code deals with the relation of proceedings before the Board with other proceedings. Section 325(d) provides, in part, that “[i]n determining whether to institute or order a proceeding under this chapter, chapter 30, or chapter 31,^[7] the Director may take into account whether, and reject the petition or request because, the same or substantially the same prior art or arguments previously were presented to the Office.” In evaluating arguments under Section 325(d), we use

[a] two-part framework: (1) whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to the Office; and (2) if either condition of first part of the framework is satisfied, whether the petitioner has

⁷ Chapter 31 (35 U.S.C. §§ 311–319) relates to *inter partes* review.

demonstrated that the Office erred in a manner material to the patentability of challenged claims.

Advanced Bionics, IPR2019-01469, Paper 6 at 8. When deciding whether to exercise our discretion under Section 325(d) in view of the *Advanced Bionics* framework, we weigh the following nonexclusive factors:

- (a) the similarities and material differences between the asserted references and the prior art involved during prosecution;
- (b) the cumulative nature of the asserted references and the prior art evaluated during prosecution;
- (c) the extent to which the asserted references were evaluated during prosecution, including whether a rejection rested on any reference;
- (d) the extent of overlap between the arguments made during prosecution and Petitioner’s reliance on the asserted references or Patent Owner’s contentions concerning them;
- (e) whether Petitioner has pointed out sufficiently how the Examiner erred in analyzing the asserted references; and
- (f) the extent to which additional evidence and facts presented in the petition warrant reconsideration of the asserted references or arguments.

See Becton, Dickinson & Co. v. B. Braun Melsungen AG, IPR2017-01586, Paper 8 at 17–18 (PTAB Dec. 15, 2017) (precedential as to § III.C.5, first paragraph).

1. Part One of the Advanced Bionics Framework

Under the *Advanced Bionics* framework, we initially consider *Becton, Dickinson* factors (a), (b), and (d) in determining “whether the same or substantially the same art previously was presented to the Office or whether the same or substantially the same arguments previously were presented to

the Office.” *Advanced Bionics*, IPR2019-01469, Paper 6 at 8, 10. *Becton, Dickinson* factors (a) and (b) “broadly provide guidance as to whether the art presented in the petition is the ‘same or substantially the same’ as the prior art previously presented to the Office during *any* proceeding.” *Id.* at 10 (emphasis in the original). *Advanced Bionics* states that “[p]reviously presented art . . . includes art provided to the Office by an applicant, such as on an Information Disclosure Statement (IDS) [or] in the prosecution history of the challenged patent,” and that “[t]he proceedings in which art was previously presented include . . . examination of the underlying patent application . . . and AIA post-grant proceedings involving the challenged patent.” *Id.* at 7–8. In *Advanced Bionics*, the Board exercised its discretion to deny institution under Section 325(d), finding that the newly asserted art by the petitioner was the same or substantially the same as art previously presented to the Office and that the petitioner had not demonstrated the Office erred when considering the prior art or arguments. *Id.* at 22.

The discussion of Section 325(d) in the Petition is short. Pet. 74–75. Petitioner argues that the “challenges do not advance the ‘same or substantially the same prior art or arguments [that] previously were presented to the Office.’” *Id.* at 74 (bracketed material in original). With regard to the application for the ’456 patent, the Petition states, “[t]he USPTO did not issue any Office Actions during the prosecution of the ’456 Patent and no art was substantively discussed in the Notice of Allowance.” *Id.* at 75 (citing Ex. 1002, 6). Petitioner cites the first action Notice of Allowability issued by the Office, in which the Examiner wrote:

Claims 1-30 are allowed. The prior art of record does not disclose or suggest a fiber optic apparatus which includes fiber optic modules having all the recited structure and which

provides the recited fiber optic connection density based on using simplex or duplex fiber optic components or adapters.

Ex. 1002, 6; Ex. 2005, 500. The “recited fiber optic connection density” referred to by the Examiner is in the second “wherein” clause of claim 1, which states, in full: “wherein the plurality of fiber optic equipment trays and the plurality of fiber optic modules are configured to support a fiber optic connection density of at least ninety-eight (98) fiber optic connections per U space of the chassis, based on using a simplex fiber optic component or a duplex fiber optic component as each fiber optic component of the plurality of first fiber optic components.” Contrary to Petitioner’s contention, the Notice of Allowability, although brief, does substantively discuss the art and specifically finds that the “prior art of record does not disclose or suggest” the invention claimed in the ’456 patent and specifically refers to “the recited fiber optic connection density” limitations in the claims of the ’456 as a reason for allowance.

And, in the Petition, Petitioner fails to acknowledge that Smrha ’861, Coburn, and Yamaguchi were presented to the Office during prosecution of the ’456 patent and that these references are listed under “References Cited” in the ’456 patent. *See* Ex. 1001, code (56), 6 (Smrha ’861), 8 (Coburn), 11 (Yamaguchi); Ex. 2005, 164, 246, 424 (showing Smrha ’861, Coburn, and Yamaguchi submitted in an IDS), 514, 579, 601 (showing Smrha ’861, Coburn, and Yamaguchi were considered by the Examiner). In addition, both the petition and a declaration of Dr. DeCusatis⁸ from IPR2017-00009

⁸ As noted above, Petitioner supports its Petition in this proceeding with a Declaration of Dr. DeCusatis (Ex. 1003). Petitioner also relied on Declarations of Dr. DeCusatis in IPR2016-01703, IPR2016-01709, and IPR2017-00009, in which patents in the same family as the ’456 patent were

were also presented to the Office during the prosecution of the '456 patent (Ex. 1001, code (56), 14). In IPR2017-00009, Petitioner argued the asserted prior art teaches or suggests the fiber optic connection density limitation⁹. *See* IPR2017-00009, Paper 38 (Final Written Decision) (Ex. 1016), 11–28 (discussing claim 1 of US 9,020,320). As discussed in more detail *infra*, the Board found in the Final Written Decision in IPR2017-00009 that Petitioner failed to establish that the asserted prior art teaches or suggests the fiber optic connection density limitation, and that Decision was appealed by Petitioner and affirmed by the Federal Circuit. Further, the art relied on by Petitioner in IPR2017-00009, including, *inter alia*, “Smhra '551,” the parent application of Smhra '861 currently asserted, was before the Office during prosecution of the '456 patent. *Compare id.* at 7, *with* Ex. 1001, code (56). Thus, three out of four references relied upon in the Petition (Smrha '861, Coburn, and Yamaguchi) were before the Office during prosecution of the '456 patent.

The fourth reference (Corning Fiber Optic Adapters) was not before the Office during prosecution of the '456 patent. This reference is cited in the Petition as teaching the fiber optic connection density limitation (*see*

challenged, and each of the DeCusatis Declarations from those earlier proceedings was before the Office during prosecution of the '456 patent. Ex. 1001, code (56), 14. It should also be noted that, in IPR2017-00009, the Board found that Dr. DeCusatis's declaration testimony relating to the obviousness of the fiber optic connection density limitation was conclusory and entitled to “minimal weight.” IPR2017-00009, Paper 38, 24.

⁹ Similar to the claims challenged here, claim 1 of US 9,020,320, challenged in IPR2017-00009, recites, in part, “the fiber optic connection equipment configured to support a fiber optic connection density of at least ninety-eight (98) fiber optic connections per U space, based on using at least one simplex fiber optic component or at least one duplex fiber optic component.” *See* Ex. 1016, 6.

Pet. 22–40). As discussed *supra*, both Petitioner’s previously asserted prior art from IPR2017-00009 and Petitioner’s arguments that this limitation was disclosed in that prior art were before the Office during prosecution of the ’456 patent. At least in broad aspect, the same argument that Petitioner made in IPR2017-00009 (and that was rejected by the Office) relating to the fiber optic connection density limitation that the prior art renders obvious this limitation is the same argument that is made by Petitioner here.

Specifically, in IPR2017-00009, Petitioner relied upon an industry standard called “FOCIS”¹⁰ as disclosing the size of LC-type connectors and adapters to establish that the recited fiber optic connection density limitation could be met using known components. *See* IPR2017-00009, Paper 2 (Petition), 26–28, 76. FOCIS was cited in an IDS (Ex. 2005, 428) and considered by the Examiner during prosecution of the ’456 patent (Ex. 2005, 583). FOCIS is listed under “References Cited” in the ’456 patent. Ex. 1001, code (56), 15. In the current proceeding, Petitioner relies on Corning Fiber Optic Adapters as disclosing the size of LC-type connectors and adapters to establish that the recited fiber optic connection density limitation could be met using known components. Pet. 27 (stating, under the heading “Corning Fiber Optic Adapter’s Relevant Disclosures,” that “Corning Fiber Optic Adapters discloses the dimensions for known LC-type duplex fiber optic adapters”), 28–37. Accordingly, we find that, because it is relied upon for the same proposition as previously presented prior art, Corning Fiber Optic Adapters alone or in combination with the other cited art in this proceeding contains teachings analogous to the previously

¹⁰ TIA/TIA-604-10-A, TIA/EIA Standard FOCIS 10, “Fiber Optic Connector Interchangeability Standard – Type LC,” U.S.A. (IPR2017-00009, Ex. 1007).

presented prior art (i.e., is substantially the same as the previously presented prior art) and is cumulative to previously presented prior art (i.e., the relevant teachings provide nothing more than what was taught by previously presented prior art). Thus, we disagree with Petitioner that the same or substantially the same art and arguments were not previously presented to the Office during the prosecution of the '456 patent.

Rather, for the reasons discussed above, we conclude, under the first part of the *Advanced Bionics* framework, that the Petition “presents to the Office the same or substantially the same art previously presented to the Office.” *See Advanced Bionics*, IPR2019-01469, Paper 6 at 7.

2. *Part Two of the Advanced Bionics Framework*

Because the Petition “presents to the Office the same or substantially the same art previously presented to the Office,” we turn to the second part of the *Advanced Bionics* framework and consider *Becton, Dickinson* factors (c), (e), and (f) in determining “whether the petitioner has demonstrated that the Office erred in a manner material to the patentability of challenged claims.” *See Advanced Bionics*, IPR2019-01469, Paper 6 at 7–8, 10.

Notably, in discussing Section 325(d), the Petition contains no contention that the Office erred in a manner material to the patentability of the challenged claims. *See* Pet. 74–75. After Patent Owner argued Petitioner failed to even argue in the Petition that the Office erred in allowing the claims of the '456 patent (*see* Prelim. Resp. 19–20), Petitioner attempted to cure this fatal defect in its argument in the Reply. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 8 (“If the petitioner fails to show that the Office erred, the Director may exercise his discretion not to institute *inter partes* review.”). In the Reply, Petitioner acknowledges that

Smrha '861, Coburn, and Yamaguchi were previously presented to the Office but argues that the Examiner erred in evaluating these references.

Reply 2–3. The Reply states:

Had the Examiner properly considered Smrha, Coburn, and Yamaguchi, they would have realized (as demonstrated in the Petition) that the combination renders obvious the fiber optic connection density claimed in the '456 Patent. With this realization, the Examiner would have rejected the challenged claims during prosecution. The only reasonable explanation for the Examiner's failure to reject the claims over the combination of Smrha, Coburn, and Yamaguchi is that they misapprehended or overlooked the prior art's teachings during prosecution. *See Mylan Pharm. Inc. v. Merck Sharp & Dohm[e] Corp.*, IPR2020-00040, Paper 21 at 18 (PTAB May 12, 2020). The Examiner thus erred in a manner material to the patentability of the '456 Patent's claims.

Id.

Patent Owner, on the other hand, contends that, “[t]he Examiner had the benefit of the records from the previous challenges . . . and all the cited art to consider in a focused, track-one application. And the Examiner allowed all the claims.” Prelim. Resp. 4.

We find Petitioner's assertion of Examiner error in the Reply to be conclusory and non-persuasive. This critical contention is unsupported. Petitioner cites no evidence in support of its contention that the Examiner erred, and its conclusion (“[t]he only reasonable explanation for the Examiner's failure . . . is that they misapprehended or overlooked the prior art's teachings during prosecution”) is not a meaningful identification of error by the Office. And, as shown above, the same or substantially the same art and arguments that Petitioner had relied upon in a previous *inter partes* review proceeding were before the Examiner during prosecution of

the '456 patent and the Examiner came to the same conclusion as the Board in that previous proceeding—that the fiber optic connection density limitation was not taught or suggested.¹¹ We are not persuaded that Petitioner has persuasively shown that the Office erred in a manner material to the patentability of challenged claims during prosecution of the '456 patent. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 9 (“If reasonable minds can disagree regarding the purported treatment of the art or arguments, it cannot be said that the Office erred in a manner material to patentability.”).

Considering the arguments and evidence of the parties, Petitioner has failed to establish that the Office erred in a manner material to patentability during the prosecution of the '456 patent. Petitioner has not made any developed argument that justifies finding that the Office erred during the prosecution of the '456 patent. Accordingly, we are persuaded by Patent Owner’s argument that Petitioner has failed to establish any error by the Office during the prosecution of the '456 patent.

¹¹ In particular, independent claims 1 and 25 of related patent US 9,020,320 B2 challenged in IPR2017-00009 include a similar “fiber optic connection density limitation.” *See* IPR2017-00009, Ex. 1001, 19:52–59 (claim 1), 19:55–59 (claim 25). And indeed, in the Final Written Decision in that case, the Board focused its unpatentability analysis on the “fiber optic connection density” limitation. *See* IPR2017-00009, Paper 38, 15–28. The Board concluded that Petitioner had failed to show the asserted prior art teaches or suggests the “fiber optic connection density” limitation. *See id.* at 20 (“Having considered the entire record, Petitioner does not provide sufficient arguments and credible evidence to support a finding that the combination of Wheeler, EIA, and FOCIS would teach or suggest the fiber optic connection density limitation”), 28 (“[B]ased on the complete record, we are not persuaded by Petitioner’s arguments and evidence that the proposed combination of Wheeler, EIA, and FOCIS satisfies the fiber optic connection density limitation recited in claims 1 and 25.”).

The prior art asserted in IPR2017-00009 was different than the prior art asserted in the current Petition. In IPR2017-00009, Petitioner did not rely on Corning Fiber Optic Adapters. However, as discussed above, we find Corning Fiber Optic Adapters is relied upon by Petitioner for teachings substantially similar to art that was cited in IPR2017-00009 (i.e., FOCIS) and the art cited here is cumulative to the art cited in IPR2017-00009. We assume that Petitioner put forth the best prior art it had knowledge of in that proceeding and that Petitioner believed that the cited art taught or suggested the fiber optic connection density limitation as it alleged in that previous Office proceeding. *See* IPR2017-00009, Paper 2 (Petition), 58–59 (claim 1), 71–72 (claim 25).

In the present Petition, the art and arguments from IPR2017-00009 are not discussed. *See generally* Pet. Thus, Petitioner does not even attempt to establish that the Board erred in a manner material to the patentability of challenged claims in IPR2017-00009. *Id.* Nor could Petitioner credibly argue that the Board erred in concluding the challenged claims were not unpatentable based on the fiber optic connection density limitation in IPR2017-00009. The Board’s decision in IPR2017-00009 was appealed by Petitioner and affirmed by the Federal Circuit. *Panduit Corp. v. Corning Optical Commc’ns LLC*, 774 F. App’x 682 (Fed. Cir. Aug. 8, 2019).¹²

B. Summary

We find that the same or substantially the same art and arguments were before the Office in the prosecution of the ’456 patent and in a previous *inter partes* review (certain portions of which also were expressly

¹² The Federal Circuit did not issue a substantive opinion instead affirming the Board’s decision in a one-line order pursuant to Federal Circuit Rule 36.

of record during prosecution of the '456 patent) and that no error by the Office in these proceedings relating to patentability has been shown. For these reasons, we believe it is appropriate to exercise our discretion under 35 U.S.C. § 325(d) to deny institution. *See Advanced Bionics*, IPR2019-01469, Paper 6 at 9 (“At bottom, th[e two-part] framework [set forth in *Advanced Bionics*] reflects a commitment to defer to previous Office evaluations of the evidence of record unless material error is shown.”).

III. CONCLUSION

We exercise our discretion under 35 U.S.C. § 325(d) to deny institution of *inter partes* review.

IV. ORDER

In consideration of the foregoing, it is hereby:

ORDERED that the Petition is *denied* as to all challenged claims, and no trial is instituted.

IPR2021-01562
Patent 10,444,456 B2

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