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13 *Attorneys for Plaintiff Finisar Corp.*

14 **UNITED STATES DISTRICT COURT**
15 **NORTHERN DISTRICT OF CALIFORNIA**

16 FINISAR CORPORATION,
17 Plaintiff,

18 v.

19 CAPELLA PHOTONICS, INC.,
20 Defendant.
21
22
23
24

Case No. 5:20-cv-7629

**COMPLAINT FOR DECLARATORY
JUDGMENT OF NON-INFRINGEMENT**

JURY TRIAL DEMANDED

1 (“WSS”) products, discussed and defined below, infringe the ’905 and ’906 Patents. Those
2 Infringement Contentions make clear that the actual accused products are not the identified
3 ROADM products, but the WSSs contained in those ROADM products. The WSSs in the
4 accused ROADMs include Finisar’s DWP, EWP, SLP, and Dual WSS products. Thus, Capella’s
5 suits against the Texas Defendants are suits against customers of the manufacturer of accused
6 products, and under the customer-suit exception to the first-to-file rule, this declaratory judgment
7 suit brought by the manufacturer of accused products in the Texas Actions should proceed
8 against Capella in this venue so that all claims relating to Finisar’s accused WSS products will be
9 decided in this action. Further, the Texas Defendants have filed motions to transfer the Texas
10 Actions to this venue.

11 7. Capella’s pursuit of Finisar’s customers and products through litigation and other
12 conduct has created a substantial and immediate dispute between Finisar and Capella relating to
13 Capella’s allegation of infringement of the ’905 and ’906 Patents. Additionally, Finisar has
14 indemnification obligations to the Texas Defendants relating to Capella’s claims in the Texas
15 Actions.

16 8. This Court has personal jurisdiction over Capella. Capella is a Delaware
17 Corporation with a principal place of business in Mountain View, California, within this District.

18 9. On information and belief, venue is proper in this Court pursuant to 28 U.S.C. §
19 1391(c) because Capella resides in this District.

20 **FACTUAL BACKGROUND**

21 10. Finisar is a leading provider of optical subsystems and components that are used
22 to interconnect equipment in short-distance local area networks, storage area networks, longer
23 distance metropolitan area networks, fiber-to-the-home networks, cable television networks, and
24 wide area networks.

25 11. Finisar’s products include a Wavelength Selective Switch, which is based on
26 Liquid Crystal on Silicon (LCoS) technology.

27 12. Finisar’s WSS products use either the Dynamic Wavelength Processor platform
28 (“DWP”), the Edge Wavelength Processor platform (“EWP”), the single low profile platform

1 (“SLP”), or the Dual platform. The DWP, EWP, SLP, and Dual WSS products are sold to
2 customers, including the Texas Defendants.

3 13. Capella purports to be the owner of U.S. Patent No. RE 47,905 (attached as
4 Exhibit 3) and U.S. Patent No. RE 47,906 (attached as Exhibit 4), (collectively, the “Patents-in-
5 Suit”).

6 14. On February 12, 2014, Capella filed four lawsuits in the Southern District of
7 Florida against Cisco Systems, Inc. (“Cisco”), Ciena Corporation (“Ciena”), Tellabs, Inc.
8 (“Tellabs”), and Fujitsu Network Communications, Inc. (“Fujitsu”), asserting infringement of
9 U.S. Patent Nos. RE 42,678 (“the ’678 Patent”) and RE 42,368 (“the ’368 Patent”). (*See Capella*
10 *Photonics, Inc. v. Cisco Systems, Inc.*, Case No. 1-14-cv-20529-PAS (February 12, 2014);
11 *Capella Photonics, Inc. v. Ciena Corporation*, Case No. 1:14-cv-20530-PAS (February 12,
12 2014); *Capella Photonics, Inc. v. Tellabs, Inc.*, Case No. 0:14-cv-60350-PAS (February 12,
13 2014); *Capella Photonics, Inc. v. Fujitsu Network Communications, Inc.*, 1:14-cv-20531-PAS
14 (February 12, 2014) (collectively, “the Prior Lawsuits”). In the Prior Lawsuits, Capella accused
15 the defendants of infringement of the ’368 and ’678 Patents for making and selling ROADM
16 products. The Prior Lawsuits were transferred to this District in July 2014. (*See Capella*
17 *Photonics, Inc. v. Cisco Systems, Inc.*, Case No. 3:14-cv-03348-EMC, Dkt. 78; *Capella*
18 *Photonics, Inc. v. Ciena Corporation*, Case No. 1:14-cv-20530-PAS, Dkt. 88; *Capella Photonics,*
19 *Inc. v. Tellabs, Inc.*, Case No. 0:14-cv-60350-PAS, Dkt. 76; *Capella Photonics, Inc. v. Fujitsu*
20 *Network Communications, Inc.*, Case No. 1:14-cv-20531-PAS, Dkt. 66).

21 15. During the Prior Lawsuits, Cisco instituted *Inter Partes* Review proceeding
22 IPR2014-01166 challenging claims of the ’368 Patent on July 15, 2014. (Exhibit 5). Ciena,
23 Tellabs, and Fujitsu also instituted *Inter Partes* Review proceedings against the claims of the ’368
24 Patent. *See Ciena Corporation v. Capella Photonics, Inc.*, IPR2015-00816 (PTAB); *Coriant*
25 *Operations, Inc. v. Capella Photonics, Inc.*, IPR2015-01969 (PTAB); and *Fujitsu Network*
26 *Communications, Inc. v. Capella Photonics, Inc.*, IPR2015-00726 (PTAB). Those proceedings
27 were joined with the Cisco *Inter Partes* Review in September 2015. A Final Written Decision
28 issued by the Patent Trial and Appeal Board (“PTAB”) on January 28, 2016, held that claims 1-6,

1 9-13, and 15-22 of the '368 Patent were invalid. (Exhibit 6).

2 16. The Final Judgments in IPR2014-01166, IPR2015-00816, IPR2015-01969, and
3 IPR2015-00726 were affirmed by the Federal Circuit. *See Capella Photonics, Inc. v. Cisco Sys.,*
4 *Inc.*, 711 F. App'x 642 (Fed. Cir. 2018) (Exhibit 7).

5 17. Thereafter, Capella placed the '368 Patent into a reissue proceeding on June 29,
6 2018, as U.S. Application No. 16/023,127 ("the '127 Application"). (Exhibit 8 (Reissue Patent
7 Application Transmittal)). During prosecution of the '127 Application, Capella requested claims
8 that amended the claims of the underlying '368 Patent that it had asserted against the defendants
9 in the Prior Lawsuits ("Previously Asserted '368 Claims") to replace the "input port" and "one or
10 more other ports," as recited in the Previously Asserted '368 Claims, with a "fiber collimator
11 input port" and "fiber collimator one or more other ports" (*See e.g.*, Exhibit 8 (Applicant's Reply
12 to Office Action of June 26, 2019) at 5).

13 18. The United States Patent Office issued a Notice of Allowance for the '127
14 Application on November 8, 2019. (Exhibit 17). An Issue Notification for the '127 Application
15 was published by the United States Patent Office on February 26, 2020, stating that the '127
16 Application would result in issuance of U.S. Patent RE 47,905 on March 17, 2020. (Exhibit 9).

17 19. Claim 23 is the first independent claim of the '905 Patent. A comparison of claim
18 23 of the '905 Patent against claim 1 of the '368 Patent, which was previously asserted in the
19 Prior Lawsuits, is shown below with the applicant's added language underlined and the
20 applicant's removed language struck through.

21 23. An optical add-drop apparatus comprising an output port and fiber collimators
22 servicing as an input port and one or more other ports, the apparatus comprising:
~~an the fiber collimator~~ input port for an input multi-wavelength optical signal
23 having first spectral channels;
the fiber collimator one or more other ports for second spectral channels;
24 ~~an the output port~~ for an output multi-wavelength optical signal;
25 a wavelength-selective device for spatially separating said spectral channels;
26 a spatial array of beam-deflecting elements positioned such that each element
27 receives a corresponding one of said spectral channels, each of said elements
28 being individually and continuously controllable in two dimensions to reflect its
corresponding spectral channel to a selected one of said output port or the fiber
collimator ports and to control the power of the spectral channel reflected to said
output port or the fiber collimator selected port.

1 20. Claim 23 of the '905 Patent amends claim 1 of the '368 Patent to replace “input
2 port” with “fiber collimator input port,” and replaces “one or more other ports” with “fiber
3 collimator one or more other ports.”

4 21. During the course of reissue proceedings on the '127 Application, which resulted
5 in the '905 Patent, Capella represented that claim 23 of the '905 Patent has the same scope as
6 claim 1 of the underlying '368 Patent, which was asserted against the defendants in the Prior
7 Lawsuits.

8 22. In particular, Capella represented that the ports as recited in the claims of the '368
9 Patent are “fiber collimator ports,” because the '368 Patent “unambiguously uses collimator
10 ports,” and “defines ports in the ‘Summary of the Invention’ to be collimator ports that serve as
11 the input ports and the output ports,” and that “[t]he fact that the very first sentence of the
12 Summary of the Invention expressly provides that fiber collimators are the physical structure of
13 ports is compelling evidence that the claimed ports must be fiber collimators.” (Exhibit 8
14 (Preliminary Amendment) at 12). Capella also explained that “because the physical structure
15 provided for ‘port’ in the Summary of the Invention [of the '368 Patent] is consistent with the
16 characterization as a whole, ‘it is apparent that the patentee was not merely providing examples
17 of the invention, but rather that the patentee intended for’ the term port to have a fiber collimator
18 physical structure.” (*Id.*) The applicant also represented that, in addition to the '368 Patent
19 specification “leav[ing] no ambiguity [that] fiber collimators serve as the physical structure of the
20 claimed ports,” that “[t]he specification repeatedly makes this relationship clear,” and that this
21 “characterization of ‘port’ as a ‘fiber collimator’ is reinforced by the description of the [’368]
22 [P]atent’s figures.” (*See id.* at 13).

23 23. In addition, during prosecution of the '127 Application, the examiner requested
24 that the applicant acknowledge that the “[’127] [A]pplication narrows claim 1 [of the '368
25 Patent] by claiming the ‘input port’ is a ‘fiber collimator input port’ and that the one or more
26 ‘other ports’ are ‘fiber collimator ports’ because merely claiming ‘input port’ and/or ‘other ports’
27 without limiting them to ‘fiber collimator ports’ was unduly broad.” (Exhibit 8 (Applicant’s
28 Reply to Office Action of September 5, 2019) at 12-13). The applicant refused to acknowledge

1 that its amendment narrowed the scope of any claim of the '368 Patent, and instead identified
2 newly added dependent claim 50 as the basis for reissue. (*Id.* at 13).

3 24. As reflected in Capella's statements to the United States Patent Office, Capella
4 contends that the ports in the claims of the '368 Patent were limited to fiber collimators ports, and
5 that there is no difference in scope between claim 1 of the '368 Patent, which it previously
6 asserted in the Prior Lawsuits, and claim 23 of the '905 Patent.

7 25. During the Prior Lawsuits, Cisco instituted *Inter Partes* Review proceeding
8 IPR2014-01276 challenging claims of the '678 Patent on August 12, 2014 (Exhibit 10). Ciena,
9 Tellabs, and Fujitsu also instituted *Inter Partes* Review proceedings against the claims of the '678
10 Patent. *See Ciena Corporation v. Capella Photonics, Inc.*, IPR2015-00894 (PTAB); *Coriant*
11 *Operations, Inc. v. Capella Photonics, Inc.*, IPR2015-01971 (PTAB); and *Fujitsu Network*
12 *Communications, Inc. v. Capella Photonics, Inc.*, IPR2015-00727 (PTAB). Those proceedings
13 were joined with the Cisco *Inter Partes* Review in September 2015. A Final Written Decision
14 issued by the PTAB on February 17, 2016, held that claims 1-4, 9, 10, 13, 17, 19-23, 27, 29, 44-
15 46, 53, and 61-65 of the '678 Patent were invalid. (Exhibit 11).

16 26. The Final Judgments in IPR2014-01276, IPR2015-00894, IPR2015-01971, and
17 IPR2015-00727 were affirmed by the Federal Circuit. *See Capella Photonics, Inc. v. Cisco Sys.,*
18 *Inc.*, 711 F. App'x 642 (Fed. Cir. 2018) (Exhibit 7).

19 27. Thereafter, Capella placed the '678 Patent into a reissue proceeding on June 29,
20 2018, as U.S. Application No. 16/023,183 ("the '183 Application"). (Exhibit 12 (Reissue Patent
21 Application Transmittal)). During prosecution of the '183 Application, Capella requested claims
22 that amended the claims of the underlying '678 Patent that it had asserted against the defendants
23 in the Prior Lawsuits ("Previously Asserted '678 Claims") to replace the "input port" and "output
24 ports," as recited in the Previously Asserted '678 Claims, with a "fiber collimator input port" and
25 "fiber collimator output ports" (*See e.g.*, Exhibit 12 (Second Preliminary Amendment) at 37).

26 28. The United States Patent Office issued a Notice of Allowance for the '183
27 Application on November 8, 2019. (Exhibit 13). An Issue Notification for the '183 Application
28 was published by the United Stated Patent Office February 26, 2020, stating that the '183

1 Application would result in issuance of U.S. Patent RE 47,906 on March 17, 2020. (Exhibit 14).

2 29. Claim 68 is the first independent claim of the '906 Patent. A comparison of claim
3 68 of the '906 Patent against claim 1 of the '678 Patent, which was previously asserted in the
4 Prior Lawsuits, is shown below with the applicant's added language underlined and the
5 applicant's removed language struck through.

6 68. A wavelength-separating-routing apparatus, comprising:

- 7 a) multiple fiber collimators, providing and serving as an input port for a multi-
wavelength optical signal and a plurality of output ports;
- 8 b) a wavelength-separator, for separating said multi-wavelength optical signal
from said fiber collimator input port into multiple spectral channels;
- 9 c) a beam-focuser, for focusing said spectral channels into corresponding spectral
spots; and
- 10 d) a spatial array of channel micromirrors positioned such that each channel
11 micromirror receives one of said spectral channels, said channel micromirrors
being pivotal about two axes and being individually and continuously controllable
12 to reflect corresponding received spectral channels into any selected ones of said
fiber collimator output ports and to control the power of said received spectral
13 channels coupled into said fiber collimator output ports.

14 30. Claim 68 of the '906 Patent amends claim 1 of the '678 Patent to replace "input
15 port" with "fiber collimator input port," and replaces "output ports" with "fiber collimator output
16 ports."

17 31. During the course of reissue proceedings on the '183 Application, which resulted
18 in the '906 Patent, Capella represented that claim 68 of the '906 Patent has the same scope as
19 claim 1 of the underlying '678 Patent, which was asserted against the defendants in the Prior
20 Lawsuits.

21 32. In particular, Capella represented that the ports as recited in the claims of the '678
22 Patent are "fiber collimator ports," because the '678 Patent "unambiguously uses collimator
23 ports," and "defines ports in the 'Summary of the Invention' to be collimator ports that serve as
24 the input ports and the output ports," and that "[t]he fact that the very first sentence of the
25 Summary of the Invention expressly provides that fiber collimators are the physical structure of
26 ports is compelling evidence that the claimed ports must be fiber collimators." (Exhibit 12
27 (Preliminary Amendment) at 19). Capella also explained that "because the physical structure
28 provided for 'port' in the Summary of the Invention [of the '678 Patent] is consistent with the

1 characterization as a whole, ‘it is apparent that the patentee was not merely providing examples
2 of the invention, but rather that the patentee intended for’ the term port to have a fiber collimator
3 physical structure.” (*Id.*) The applicant also represented that, in addition to the ’678 Patent
4 specification “leav[ing] no ambiguity [that] fiber collimators serve as the physical structure of the
5 claimed ports,” that “[t]he specification repeatedly makes this relationship clear,” and that this
6 “characterization of ‘port’ as a ‘fiber collimator’ is reinforced by the description of the [’678]
7 [P]atent’s figures.” (*See id.* at 20).

8 33. In addition, during prosecution of the ’183 Application, the examiner requested
9 that the applicant acknowledge that the “[’183] [A]pplication narrows claim 1 [of the ’678
10 Patent] by claiming the ‘output port’ of the wavelength-separating-routing apparatus is a ‘fiber
11 collimator output port’ because merely claiming ‘output port’ without limiting the ‘output port’
12 to a ‘fiber collimator output port’ was unduly broad.” (Exhibit 12 (Applicant’s Reply to Office
13 Action of September 5, 2019) at 20). The applicant refused to acknowledge that its amendment
14 narrowed the scope of any claim of the ’678 Patent, and instead identified newly added
15 dependent claim 135 as the basis for reissue. (*Id.*)

16 34. As reflected in Capella’s statements to the United States Patent Office, Capella
17 contends that the ports in the claims of the ’678 Patent were limited to fiber collimators ports, and
18 that there is no difference in scope between claim 1 of the ’678 Patent, which it previously
19 asserted against Cisco, and claim 68 of the ’906 Patent.

20 35. On February 26, 2020, the United States Patent and Trademark office issued a
21 notice that the ’905 Patent and the ’906 Patent would issue on March 17, 2020.

22 36. On March 16, 2020, Cisco filed suit against Capella in this District, seeking a
23 declaratory judgment of non-infringement with respect to the ’905 and ’906 Patents. *Cisco*
24 *Systems, Inc. v. Capella Photonics, Inc.*, Case No. 20-cv-01858-EMC. The complaint in that
25 action is attached as Exhibit 15. After Capella filed a motion to dismiss Cisco’s complaint, Cisco
26 filed an amended complaint on June 1, 2020, which Capella answered on June 15, 2020. On July
27 7, 2020, Cisco filed a motion for judgment on the pleadings, asking the Court to either find that
28 the scope of the reissue claims in the ’905 and ’906 Patents is substantively narrower than the

1 scope of the original claims so as to bar pre-issuance damages or the scope of the reissue claims
2 must be substantially identical to the original claims so as to collaterally estop Capella from
3 asserting the '905 and '906 Patents. On August 21, 2020, the court issued an order granting
4 Cisco's motion, finding that "if the scope of the reissue claims is substantially identical to the
5 scope of the original claims, those claims would be invalid under principles of collateral estoppel.
6 If the reissue claims are in fact narrower than the original claims, Capella would not be entitled to
7 pre-issue damages pursuant to 35 U.S.C § 252. Under either scenario, Capella will not be
8 entitled to pre-issue damages." The court accordingly ordered that "Capella may not seek pre-
9 issue damages in this case." *Cisco Systems, Inc. v. Capella Photonics, Inc.*, Case No. 20-cv-
10 01858-EMC, Dkt. No. 48 (attached as Exhibit 16).

11 37. On March 16 and 17, 2020, Capella respectively filed suit against the Texas
12 Defendants alleging infringement of the Patents-in-Suit in *Capella Photonics, Inc. v. Fujitsu*
13 *Network Communications, Inc*, Case No. 2-20-cv-00076 (E.D. Tex.) and *Capella Photonics, Inc.*
14 *v. Infinera Corporation et al*, Case No. 2-20-cv-00077 (E.D. Tex.) The complaints filed in the
15 Texas Actions are attached as Exhibits 1, 2.

16 38. On information and belief, Capella seeks *inter alia*, pre-issuance damages. (*See*
17 *e.g.*, Exhibit 1 (Infinera Complaint) ¶ 37; Exhibit 2 (Fujitsu Complaint) ¶ 26). Finisar has sold
18 DWP, EWP, SLP, and Dual WSS products to customers, including the Texas Defendants, prior
19 to the issuance of the Patents-in-Suit. On information and belief, based on Capella's allegations
20 against the Texas Defendants, which seeks, *inter alia*, damages prior to issuance of the Patents-
21 in-Suit, Capella intends to seek damages from the Texas Defendants for products containing
22 Finisar's DWP, EWP, SLP and Dual WSS products for alleged infringement of the Patents-in-
23 Suit that were sold prior to the issuance of those patents.

24 39. Capella has asserted Claims 23-29, 31-35, 37, 39, and 44-54 of the '905 Patent
25 against the Texas Defendants.

26 40. Capella alleges that products of the Texas Defendants incorporating Finisar's
27 DWP, EWP, and Dual WSS products infringe the '905 Patent.

28 41. Finisar's DWP, EWP, SLP, and Dual WSS products do not infringe each and

1 every claim of the '905 Patent for at least the reason that they do not contain a “beam-deflecting
2 element” as required by the claims of the '905 Patent.

3 42. Finisar’s DWP, EWP, SLP, and Dual WSS products use Liquid Crystal on Silicon
4 (LCoS) technology and do not contain micromirrors. Therefore, Finisar’s DWP, EWP, SLP, and
5 Dual WSS products do not contain a “beam-deflecting element” and do not infringe the claims of
6 the '905 Patent.

7 43. Capella has asserted Claims 68-72, 79-85, 87-92, 96-100, 106, 115-118, 122-127,
8 129-135, and 137-139 of the '906 Patent against the Texas Defendants.

9 44. Capella alleges that products of the Texas Defendants incorporating Finisar’s
10 DWP, EWP, SLP, and Dual WSS products infringe the '906 Patent.

11 45. Finisar’s DWP, EWP, SLP, and Dual WSS products do not infringe each and
12 every claim of the '906 Patent for at least the reason that they do not contain “micromirrors” or
13 “beam-deflecting element” as required by the claims of the '906 Patent.

14 46. Finisar’s DWP, EWP, SLP, and Dual WSS products use Liquid Crystal on Silicon
15 (LCoS) technology and do not contain micromirrors. Therefore, Finisar’s DWP, EWP, SLP, and
16 Dual WSS products do not contain the claimed “micromirrors” or a “beam-deflecting element”
17 and do not infringe the claims of the '906 Patent.

18 **FIRST CAUSE OF ACTION**

19 **(Declaratory Judgment of Non-Infringement of the '905 Patent)**

20 47. Finisar incorporates by reference the allegations contained in paragraphs 1-46 of
21 this Complaint as though fully set forth herein.

22 48. There exists an actual and justiciable controversy regarding the non-infringement
23 of the '905 Patent by Finisar at least because Capella contends that products of the Texas
24 Defendants incorporating Finisar’s DWP, EWP, SLP, and Dual WSS products infringe literally
25 or under the doctrine of equivalents the '905 Patent, and Finisar denies infringement.

26 49. Finisar’s DWP, EWP, SLP, and Dual WSS products do not literally infringe or
27 infringe under the doctrine of equivalents, directly or indirectly, each and every claim of the '905
28 Patent. Accordingly, Finisar requests a judicial determination of its rights, duties, and obligations

1 with regard to non-infringement of each of the claims of the '905 Patent.

2 50. Finisar is also entitled to a declaratory judgment that Finisar's customers have not
3 infringed and are not now infringing, directly, contributorily, or by inducement, any valid claim
4 of the '905 Patent by making, using, selling, offering for sale, or importing Finisar's DWP, EWP,
5 SLP, and Dual WSS products, separately, or in combination with or upon incorporation into
6 another device or system.

7 51. A judicial declaration is necessary and appropriate so that Finisar may ascertain its
8 rights regarding the '905 Patent.

9 **SECOND CAUSE OF ACTION**

10 **(Declaratory Judgment of Non-Infringement of the '906 Patent)**

11 52. Finisar incorporates by reference the allegations contained in paragraphs 1-51 of
12 this Complaint as though fully set forth herein.

13 53. There exists an actual and justiciable controversy regarding the non-infringement
14 of the '906 Patent by Finisar at least because Capella contends that products of the Texas
15 Defendants incorporating Finisar's DWP, EWP, SLP, and Dual WSS products infringe literally
16 or under the doctrine of equivalents the '906 Patent, and Finisar denies infringement.

17 54. Finisar's DWP, EWP, SLP, and Dual WSS products do not literally infringe or
18 infringe under the doctrine of equivalents, directly or indirectly, each and every claim of the '906
19 Patent. Accordingly, Finisar requests a judicial determination of its rights, duties, and obligations
20 with regard to non-infringement of each of the claims of the '906 Patent.

21 55. Finisar are also entitled to a declaratory judgment that Finisar's customers have
22 not infringed and are not now infringing, directly, contributorily, or by inducement, any valid
23 claim of the '906 Patent by making, using, selling, offering for sale or importing Finisar's DWP,
24 EWP, SLP, and Dual WSS products, separately, or in combination with or upon incorporation
25 into another device or system.

26 56. A judicial declaration is necessary and appropriate so that Finisar may ascertain its
27 rights regarding the '906 Patent.

28

THIRD CAUSE OF ACTION

(Declaratory Judgment of No Liability for Pre-Issuance Damages)

57. Finisar incorporates by reference the allegations contained in paragraphs 1-56 of this Complaint as though fully set forth herein.

58. There exists an actual and justiciable controversy regarding Capella's request for damages pre-dating the issuance of the Patents-in-Suit at least because Capella contends in the Texas Actions that it is entitled to damages for infringement prior to the issuance of the Patents-in-Suit.

59. The reissue claims of the Patents-in-Suit at issue here are substantively narrower, not substantially identical, to the original claims of the '368 Patent and '678 Patent. Alternatively, if the scope of the reissue claims is substantially identical to the scope of the original claims of the '368 Patent and '678 Patent, those claims would be invalid under principles of collateral estoppel. Accordingly, Finisar requests a judicial determination of its rights, duties, and obligations with regard to its lack of liability for pre-issuance damages under either scenario.

60. A judicial declaration is necessary and appropriate so that Finisar may ascertain its rights regarding its liability for pre-issuance damages.

PRAYER FOR RELIEF

WHEREFORE, Finisar prays for a declaratory judgment against Capella as follows:

A. A declaration that the '905 Patent is not and has not been infringed literally or under the doctrine of equivalents, directly or indirectly by Finisar;

B. A declaration that the '905 Patent is not and has not been infringed by any third party who makes, uses, sells, offers to sell, or imports Finisar's DWP, EWP, SLP, and Dual WSS products separately, or in combination with or upon incorporation into another device or system;

C. A declaration that the '906 Patent is not and has not been infringed literally or under the doctrine of equivalents, directly or indirectly by Finisar;

D. A declaration that the '906 Patent is not and has not been infringed by any third party who makes, uses, sells, offers to sell, or imports Finisar's DWP, EWP, SLP, and Dual WSS products separately, or in combination with or upon incorporation into another device or system;

1 E. A declaration that Capella is not entitled to damages for alleged infringement prior
2 to the issuance of the Patents-in-Suit;

3 F. A preliminary and permanent injunction enjoining Capella from commencing or
4 proceeding with any legal action arising out of the '905 Patent and '906 Patent against any of
5 Finisar's customers whose products incorporate Finisar's DWP, EWP, SLP, and Dual WSS
6 products;

7 G. A declaration against Capella that this is an exceptional case within the meaning
8 of 35 U.S.C. § 285; and

9 H. An award of costs and attorneys' fees to Finisar.

10 I. Any such other and further relief as the Court may deem just and fair.

11 **JURY DEMAND**

12 Finisar hereby demands a jury trial on all issues so triable under the laws as provide by
13 Rule 38(b) of the Federal Rules of Civil Procedure.

14 Dated: October 29, 2020

Respectfully Submitted,

15 /s/Cheryl S. Chang

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