

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING INCORPORATED
Petitioner

v.

DSM IP ASSETS B.V.
Patent Owner

Case IPR2013-00043 (Patent 7,171,103 B2)
Case IPR2013-00044 (Patent 6,961,508 B2)

Before FRED E. McKELVEY, GRACE KARAFFA OBERMANN,
JENNIFER S. BISK, SCOTT E. KAMHOLZ, and ZHENYU YANG,
Administrative Patent Judges.

McKELVEY, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and 37 C.F.R. § 42.73(b)

IPR2013-00043 (Patent 7,171,103 B2)
IPR2013-00044 (Patent 6,961,508 B2)

I. INTRODUCTION

A. Background

Petitioner, Corning Incorporated (“Corning”) filed ten petitions in November of 2012, challenging patents owned by DSM Assets B.V. (“DSM”).

All ten petitions were at least partially granted, and therefore, progressed into the trial phase of an *inter partes* review.

This is the final written decision for IPR2013-00043 and IPR2013-00044, both of which raise common issues.

1. IPR2013-00043

The petition in IPR2013-00043 (Paper 3) challenges claims 1-18 (all of the claims) of U.S. Patent No. 7,171,103 B2 (Ex. 1001 (“the ’103 patent”)).

Patent Owner, DSM, filed a preliminary response on February 21, 2013. Paper 13 (“Prelim. Resp. 43”).

On May 13, 2013, the Board granted the petition as to all of the proposed grounds. Paper 14.

The Board found that there was a reasonable likelihood that Corning would prevail with respect to the claims challenged in the petition on the following grounds:

IPR2013-00043 (Patent 7,171,103 B2)

IPR2013-00044 (Patent 6,961,508 B2)

| Claims Challenged | Basis | Reference(s) ¹ |
|-------------------|-------|--|
| 1-15 | § 102 | Szum '157 |
| 1-15 | § 103 | Szum '157 and Szum '041 |
| 16 and 17 | § 103 | Szum '157 and Yamazaki |
| 16 and 17 | § 103 | Szum '157, Szum '041, and Yamazaki |
| 18 | § 103 | Szum '157, Yamazaki, and Winningham |
| 18 | § 103 | Szum '157, Szum '041, Yamazaki, and Winningham |

After institution of trial, DSM filed a patent owner response (Paper 43 (“PO Resp. 43”)) and a supplemental response (Paper 75).

DSM also filed a motion to amend claims submitting proposed new claim 19 for claim 12. Paper 45.

Corning filed (1) a reply to the patent owner response (Paper 64), (2) a supplemental reply (Paper 76), and (3) an opposition to DSM’s motion to amend (Paper 63).

DSM then filed a reply in support of its motion to amend. Paper 77.

2. IPR2013-00044

The petition in IPR2013-00044 (Paper 2) challenges claims 1-22 (all of the claims) of U.S. Patent No. 6,961,508 B2 (Ex. 1001 (“the ’508 patent”)).

DSM filed a preliminary response on February 21, 2013. Paper 11.

On May 13, 2013, the Board granted the petition as to all of the proposed grounds. Paper 12.

¹ The references are: (1) WO 98/21157 (Ex. 1002) (“Szum ’157” also referred to in the record as “Szum ’21157”); (2) U.S. Patent No. 5,664,041 (Ex. 1003) (“Szum ’041”); (3) EP 0 874 012 A1 (Ex. 1004) (“Yamazaki”); and (4) WO 01/49625 A1 (Ex. 1005) (“Winningham”).

IPR2013-00043 (Patent 7,171,103 B2)
IPR2013-00044 (Patent 6,961,508 B2)

The Board found that there was a reasonable likelihood that Corning would prevail with respect to the claims challenged in the petition on the following grounds:

| Claims Challenged | Basis | Reference(s)² |
|--------------------------|--------------|-----------------------------------|
| 1-8, 10-13, and 15-22 | § 103 | Szum '157 and Szum '041 |
| 9 and 14 | § 103 | Szum '157, Szum '041, and Edwards |

After institution of trial, DSM filed (1) a patent owner response (Paper 42), and (2) a supplemental response (Paper 71).

DSM also filed a motion to amend claims by submitting proposed new claim 19 for claim 12. Paper 44.

Corning filed (1) a reply to the patent owner response (Paper 60), (2) a supplemental reply (Paper 72), and (3) an opposition to DSM's motion to amend (Paper 59).

DSM then filed a reply in support of its motion to amend. Paper 73.

3. Summary

Oral argument for both cases took place on February 11, 2014. *See* IPR2013-00043, Paper 94; IPR2013-00044, Paper 91 (Transcripts of Oral Argument).

The Board has jurisdiction under 35 U.S.C. § 6(c).

This final written decision is issued pursuant to 35 U.S.C. § 318(a) and 37 C.F.R. § 42.73.

² The references are: (1) WO 98/21157 (Ex. 1002) ("Szum '157" also referred to in the record as "Szum '21157"); (2) U.S. Patent No. 5,664,041 (Ex. 1003) ("Szum '041"); and (3) U.S. Patent No. 5,416,880 (Ex. 1004) ("Edwards").

IPR2013-00043 (Patent 7,171,103 B2)

IPR2013-00044 (Patent 6,961,508 B2)

Corning has failed to show by a preponderance of evidence that any of challenged claims 1-18 of the '103 patent and challenged claims 1-22 of the '508 patent are unpatentable.

Because we do not find any of the challenged claims unpatentable, we need not consider DSM's motions to amend claims, and therefore, the motions to amend claims in both IPR2013-00043 and IPR2013-00044 are *dismissed* as moot.

B. Related Proceedings

Corning and DSM are simultaneously involved in eight other *inter partes* reviews based on patents claiming similar subject matter:

- (1) IPR2013-00045; (2) IPR2013-00046; (3) IPR2013-00047;
- (4) IPR2013-00048; (5) IPR2013-00049; (6) IPR2013-00050;
- (7) IPR2013-00052; and (8) IPR2013-00053.

C. The '103 Patent

The '103 patent is titled "Coated Optical Fibers" and relates to coated optical fibers having primary and secondary coatings and to radiation-curable primary coating compositions. Ex. 1001, 1:14-16.

The patent explains that the "soft 'cushioning'" primary coating is usually in contact with the fiber, while the "relatively hard" secondary coating surrounds the primary coating. *Id.* at 1:23-26.

The coatings confer "microbending" resistance on the optical fiber, thereby helping to reduce attenuation of optical power along the fiber. *Id.* at 1:27-29.

The patent is directed, in particular, to coated optical fibers in which the primary coating provides "good microbending resistance," and

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