

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 IPR2013-00046
Patent 6,110,593

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

BISK, *Administrative Patent Judge.*

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

I. INTRODUCTION

A. Background

Petitioner, Corning Incorporated (“Corning”), filed a petition on November 15, 2012, for *inter partes* review of all claims, 1-9, of U.S. Patent No. 6,110,593 (“the ’593 patent”) pursuant to 35 U.S.C. §§ 311-319. Paper 2 (“Pet.”). Patent Owner, DSM IP Assets B.V. (“DSM”), filed a preliminary response on February 20, 2013. Paper 11 (“Prelim. Resp.”). On May 13, 2013, the Board granted the petition as to a subset of the proposed grounds. Paper 12 (“Dec.”). We found that Corning had shown a reasonable likelihood of showing that the challenged claims were unpatentable based on the following grounds:

Claim(s) Challenged	Basis	Reference(s)¹
1, 2, and 7	§ 102	Edwards
1, 2, and 7	§ 103	Edwards
1-3 and 7-9	§ 103	Szum and Edwards or Broer
1, 2, and 7-9	§ 103	Shustack and Edwards or Broer
3	§ 103	Shustack, Edwards or Broer, and Jackson
4-6	§ 103	Shustack or Szum, Broer or Edwards, and Botelho

After institution, DSM filed a short patent owner response stating that “DSM chooses not to substantively respond to Corning’s Petition and instead submits a Motion to Amend under 37 C.F.R. § 42.121.”² Paper 43,

¹ The references are: U.S. Patent No. 5,416,880 (Ex. 1003) (“Edwards”); WO 95/15928 (Ex. 1002) (“Szum”); U.S. Patent No. 4,904,051 (Ex. 1006) (“Broer”); U.S. Patent No. 5,352,712 (Ex. 1005) (“Shustack”); U.S. Patent No. 4,900,126 (Ex. 1007) (“Jackson”); and WO 97/46380 (Ex. 1008) (“Botelho”).

² DSM also includes a footnote stating that it incorporates by reference its arguments from the preliminary response. Paper 43, 1 n.1. Our rules explicitly forbid incorporation by reference. 37 C.F.R. § 42.6(a)(3). We, therefore, consider only arguments made in the response itself.

1-2. DSM's motion to amend proposes new claims 10-13 for claims 1-3 and 7, respectively. Paper 44 ("Mot. to Amend"). Corning filed a reply to the patent owner response (Paper 60, "Reply") and an opposition to DSM's motion to amend. DSM then filed a reply in support of its motion to amend. Paper 68.

Corning filed and fully briefed a motion to exclude. Paper 72 ("Mot. to Exclude"); Paper 74; Paper 76. Oral hearing was held February 11, 2014. Paper 79.

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.

Corning has shown by a preponderance of the evidence that claims 1-9 are unpatentable.

DSM's motion to amend claims is *denied*.

B. Related Proceedings

Corning and DSM simultaneously are involved in nine other *inter partes* reviews based on patents claiming similar subject matter: IPR2013-00043; IPR2013-00044; IPR2013-00045; IPR2013-00047; IPR2013-00048; IPR2013-00049; IPR2013-00050; IPR2013-00052; and IPR2013-00053.

C. The '593 Patent (Ex. 1001)

The '593 patent generally relates to radiation-curable, optical fiber coating systems. Ex. 1001, 1:5-7. In particular, the patent describes optical glass fibers coated with two radiation-cured coatings: an inner primary coating and an outer primary coating. For identification purposes, the outer primary coating includes colorant or, alternatively, a third colored layer, called an ink coating, is applied to the outer primary coating. *Id.* at 1:42-47.

To create a cable or ribbon assembly, used in the construction of multi-channel transmission cables, a plurality of coated optical fibers is bonded together in a matrix material. *Id.* at 1:30-37. In order to connect the fibers of multiple ribbons, the surface of a glass fiber must be accessible. *Id.* at 1:62–2:16. This often is accomplished by a process known as “ribbon stripping”—removing the coatings and the matrix material, preferably as a cohesive unit. *Id.* The ’593 patent is directed to a ribbon assembly having improved ribbon stripping capabilities. *Id.* at 2:48-54. As described in the Background of the Invention, the prior art discloses ribbon assemblies composed of multiple optical glass fibers with both an inner and outer coating and an optional outer ink layer. *Id.* at 1:30-50.

II. ANALYSIS

A. Claims 1-9 of the ’593 Patent

DSM’s patent owner response states that “DSM chooses not to substantively respond to Corning’s Petition.” Paper 43, 1-2. Thus, DSM provides no substantive arguments beyond those previously asserted in its preliminary response (Paper 11). We previously considered those arguments, but did not find them persuasive. Dec. 6-23. For the reasons set forth in our Decision to Institute, we conclude that Corning has shown, by a preponderance of the evidence, that the challenged claims are unpatentable based on the following grounds: (1) claims 1, 2, and 7 based on anticipation by Edwards; (2) claims 1, 2, and 7 based on obviousness over Edwards; (3) claims 1-3 and 7-9 based on obviousness over Szum and Edwards or Broer; (4) claims 1, 2, and 7-9 based on obviousness over Shustack and Edwards or Broer; (5) claim 3 based on obviousness over Shustack, Edwards

or Broer, and Jackson; and (6) claims 4-6 based on obviousness over Shustack, Szum, Broer or Edwards, and Botelho.

Therefore, we determine that claims 1-9 of the '593 patent are unpatentable.

B. DSM's Motion to Amend Claims

DSM proposes four substitute claims 10-13 to replace original independent claims 1-3 and 7. Mot. to Amend 5.

As the moving party, DSM bears the burden of proof to establish that it is entitled to the relief requested. 37 C.F.R. § 42.20(c). The proposed amendment is not entered automatically, but only upon DSM's having demonstrated the patentability of the substitute claims.

In support of its motion, DSM proffers a declaration of Carl R. Taylor, Ph.D. Ex. 2032. We have reviewed DSM's motion and supporting evidence. For the reasons stated below, DSM's motion to amend claims is *denied*. The substitute claims will not be incorporated into the '593 patent.

In its motion, DSM proposes substitute claims 10-13. Mot. to Amend 1-4. Substitute claims 10-12 are independent, and substitute claim 13 depends from substitute claim 10. *Id.* The proposed substitute claims are reproduced below with markings to show the changes made relative to the original claims they are proposed to replace:

10. (Proposed substitute for claim 1) A system for coating an optical glass fiber comprising a radiation-curable inner primary coating composition and a radiation-curable outer primary coating composition wherein:

said radiation-curable inner primary coating composition comprising an oligomer comprising a polyol residue selected from the group consisting of a polyether polyol residue, a polycarbonate polyol residue, and combinations thereof, and at least one strip enhancing component;

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