

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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CORNING INCORPORATED  
Petitioner,

v.

PATENT OF DSM IP ASSETS B.V.  
Patent Owner.

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Case No. IPR2013-00047  
Patent 6,438,306

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Held: February 11, 2014

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

APPEARANCES:

ON BEHALF OF THE PETITIONER:

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17  
18 The above-entitled matter came on for hearing on Thursday,  
19 February 11, 2014, commencing at 1:21 p.m., at the U.S. Patent and  
20 Trademark Office, 600 Dulany Street, Alexandria, Virginia.  
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P R O C E E D I N G S

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JUDGE BISK: Okay. This is IPR2013-00047.

27

28 questions on this case.

29

30 hope.

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32 JUDGE McKELVEY: First of all, there's three  
33 grounds anticipation. Have you withdrawn your petition as  
to Edwards?

1           MR. GOLDMAN: We're not -- I guess the answer  
2 would be directly we're not relying on it, so I guess yes, we  
3 will withdraw.

4           JUDGE McKELVEY: So, that's a yes, you're not  
5 relying on it. Now, the next thing is, is there was some  
6 evidence put in with the reply brief which is the subject of a  
7 motion to exclude, and at the reply stage, are you no longer  
8 relying on the case you made in the petition, based on the  
9 discovery that occurred at some point, or not?

10           MR. GOLDMAN: Well, I think that's a very hard  
11 question to answer, to be very frank. We have, I think, been  
12 quite forthcoming in acknowledging that there were some  
13 scientific errors that were in the initial case. So, we have  
14 that issue. On the other hand, we have a patent that is quite  
15 broad, claim-wise, and --

16           JUDGE McKELVEY: Okay, that's fine, it's got a  
17 broad --

18           MR. GOLDMAN: So, the issue is, then, well,  
19 how relevant or not relevant is that data, given that we have  
20 claims that are virtually impossible to fathom the scope of.

21           JUDGE McKELVEY: Well, so I'm trying to  
22 figure out whether we have to analyze the initial data in  
23 light of what your witnesses discovered and what the  
24 opposition says, I guess it's the Patent Owner's response, or

1 is the merits solely based on the new evidence that came in  
2 with the reply.

3 MR. GOLDMAN: I think our primary view is  
4 that you should rely on the reply evidence. Like I said,  
5 given the breadth of the claims, and the indefinite nature of  
6 them, I am not entirely comfortable with saying that the  
7 early data is totally irrelevant. There is a scientific error  
8 with it, but there's no indication -- there's not much  
9 indication in the claims of how you do the test and there's  
10 not much indication in the spec of how you do the test.

11 So, our -- you know, that's -- I'm troubled to say,  
12 well, just ignore the data, but I'd say, you know, our primary  
13 reliance is on the later data.

14 JUDGE BISK: Can I ask why this wouldn't be  
15 supplemental evidence that you shouldn't have filed a motion  
16 to supplement to bring it in?

17 MR. GOLDMAN: I guess we looked at it as  
18 evidence to respond to their criticisms of our case in their  
19 opposition papers.

20 JUDGE OBERMANN: But what I'm hearing is  
21 it's required to make out your case in chief. Is that correct?  
22 Could you rest on your petition evidence at this point?

23 MR. GOLDMAN: We think the -- as far as the --  
24 on the art, there is issues with the science, and so I think  
25 unless you're going to -- if you're going to say the claims are

1 so broad that they read on doing an RAU test in any way,  
2 which might be true, we can't rely on the initial data. You  
3 know, if you're going to say you can't rely on the initial data  
4 because of the scientific errors that occurred there, then, you  
5 know, I don't see how we can rely on it.

6 JUDGE OBERMANN: So, just to be clear, if the  
7 universe of the evidence were your petition evidence, you  
8 would lose?

9 MR. GOLDMAN: I don't think I quite said that,  
10 but I think it all depends how you construe the claims. I  
11 think if you construe the claims as very broad, that it could  
12 read on any percentage RAU test that was done, I think it's  
13 conceivable that you could read the results on that, but like I  
14 said, there's a scientific issue with the results.

15 JUDGE YANG: Counsel, I understand there is an  
16 overlapping issue with this case and 52, right?

17 MR. GOLDMAN: Yes.

18 JUDGE YANG: Do you plan to argue something  
19 similar in 52, or we should just direct all the questions here?

20 MR. GOLDMAN: I have a little bit to say about  
21 52, but not very much. They're very similar issues.

22 JUDGE McKELVEY: So, what changed -- were  
23 you done?

24 JUDGE YANG: I do have a follow-up question.  
25 So, you said your test depends on the claim construction, but

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