

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.

DSM IP ASSETS B.V.  
Patent Owner

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Case IPR2013-00047  
Patent 6,438,306 B1

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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)

I. INTRODUCTION

*A. Background*

This is a final written decision for IPR2013-00047.

The petition (Paper 2 (“Pet.”)) challenges claims 1-14 (all the claims) of U.S. Patent No. 6,438,306 B1 (Ex. 1001) (“the ’306 patent”).

DSM timely filed a preliminary response on February 20, 2013. Paper 10.

On May 13, 2013, a panel of the Board granted the petition as to all proposed grounds of unpatentability urged in the petition. Paper 11 (“Dec.”).

The panel found that Corning had shown a reasonable likelihood that Corning would prevail with respect to the claims challenged in the petition on the following grounds:

<b>Claims Challenged</b>	<b>Basis</b>	<b>Reference(s)<sup>1</sup></b>
1-14	§ 102	Edwards <sup>2</sup>
1-11	§ 102	Coady
1-9 and 12-14	§ 102	Szum

After institution of trial, DSM filed (1) a patent owner response (Paper 40; “Response”) and (2) a supplemental response (Paper 65).

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<sup>1</sup> The references are: (1) U.S. Patent No. 5,416,880 (Ex. 1002) (“Edwards”); (2) U.S. Patent No. 5,219,896 (Ex. 1003) (“Coady”); and (3) U.S. Patent No. 5,664,041 (Ex. 1004) (“Szum”).

<sup>2</sup> Corning has abandoned its reliance on Edwards. Paper 54, p. 1 n.1. Accordingly, we do not further address Corning’s contentions based on Edwards.

DSM did not file a motion to amend.

Corning filed (1) a reply to DSM's response (Paper 54 ("Reply")) and (2) a supplemental reply (Paper 66).

Both Corning and DSM filed motions to exclude. Paper 69 (DSM) and Paper 72 (Corning).

Both motions to exclude were opposed. Paper 74 (DSM) and Paper 76 (Corning).

Replies were also filed. Paper 79 (DSM ) and Paper 80 (Corning).

Oral argument took place on February 11, 2014. *See* Paper 83.

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

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

Corning has failed to show by a preponderance of the evidence that any of challenged claims 1-14 of the '306 patent are unpatentable.

*B. Related proceedings*

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

- (1) IPR2013-00043; (2) IPR2013-00044; (3) IPR2013-00045;
- (4) IPR2013-00046; (5) IPR2013-00048; (6) IPR2013-00049;
- (7) IPR2013-00050; (8) IPR2013-00052; and (9) IPR2013-00053.

*C. The '306 patent*

The '306 patent is titled "Radiation Curable Resin Composition" and relates to coated optical fiber having a cured coating prepared from a radiation curable composition said to have improved cure speed without deteriorating yellowing performance of the cured coating. Ex. 1001, 1:11-14.

The '306 patent (2:51-65) explains:

The present invention provides a coated optical fiber comprising a glass optical fiber with a single protective coating or a combination of an inner and an outer primary coating applied thereon and optionally with a colored coating subsequently applied thereon wherein the inner primary coating or at least a portion of the single coating is prepared from a radiation curable composition which when cured as a capillary film with a 100 W medium pressure mercury lamp has a percentage reacted acrylate unsaturation of at least about 54% after exposure to a dose of about 4.4 mJ/cm<sup>2</sup> or wherein the outer primary coating is prepared from a radiation curable composition which when cured as a capillary film with a 100 W medium pressure mercury lamp has a percentage reacted acrylate unsaturation of at least about 56% after exposure to a dose of about 4.4 mJ/cm<sup>2</sup>.

Claim 1 of the '306 patent reads (paragraphing added):

1. Coated optical fiber comprising a glass optical fiber with

[1(a)] a single protective coating or

[1(b)] a combination of an inner and an outer primary coating [composition] applied thereon and

[2] optionally with a colored coating subsequently applied thereon

[2(a)] wherein the inner primary coating or at least a portion of the single [protective] coating is prepared from a radiation curable composition which when cured as a capillary film with a 100 W medium pressure mercury lamp has a percentage reacted acrylate unsaturation [(%RAU)] of at least about 54% after exposure to a dose of about 4.4 mJ/cm<sup>2</sup> or

[2(b)] wherein the outer primary coating is prepared from a radiation curable composition which when cured has a

capillary film with a 100 W medium pressure mercury lamp has a percentage reacted acrylate unsaturation [(%RAU)] of at least about 56% after exposure to a dose of about 4.4 mJ/cm<sup>2</sup>.

## II. ANALYSIS

### *A. Claim construction*

As a step in our analysis for determining whether the challenged claims are unpatentable, we determine the meaning of the claims. Paper 11, Dec. 4-5.

Claims of an unexpired patent are interpreted using the broadest reasonable construction in light of the specification of the patent. 37 C.F.R. § 42.100(b); Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,766 (Aug. 14, 2012).

The dispositive claim limitations of the '306 patent are limitations [2(a)] and [2(b)], as set out in claim 1 reproduced above.

Corning has failed to prove by a preponderance of the evidence that the prior art inherently describes either limitation.

Under the claim construction Corning proposed in its Petition (Pet. 14-16), Corning has failed to prove its case; accordingly, there is no occasion for further construction of the %RAU language of limitations [2(a)] and [2(b)] in claim 1.

### *B. The position of the parties*

We understand that Corning and DSM agree that both Coady and Szum describe elements [1(a)], [1(b)], and [2], as set out in claim 1 reproduced above.

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