

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 IPR2013-00043 (Patent 7,171,103)  
Case IPR2013-00044 (Patent 6,961,508)  
Case IPR2013-00045 (Patent 6,339,666)  
Case IPR2013-00046 (Patent 6,110,593)  
Case IPR2013-00047 (Patent 6,438,306)  
Case IPR2013-00048 (Patent 6,298,189)  
Case IPR2013-00049 (Patent 6,298,189)  
Case IPR2013-00050 (Patent 6,323,255)  
Case IPR2013-00052 (Patent 7,276,543)  
Case IPR2013-00053 (Patent 7,276,543)<sup>1</sup>

Before GRACE KARAFFA OBERMANN, JENNIFER S. BISK,  
and SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

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<sup>1</sup> This decision addresses issues that are identical in the ten cases. We therefore exercise our discretion to issue one decision to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

## DECISION

### On DSM's Motion to File Supplemental Information and Motion to Compel Compliance with the Decision of June 21, 2013 *37 C.F.R. §§ 42.123(b), 42.120, and 42.52*

On November 8, 2013, counsel for Corning and DSM participated in a conference call with Judges Bisk and Obermann. DSM initiated the conference call to request permission to (1) file a Patent Owner's Supplemental Response addressing late-produced information supplied by Corning on October 25, 2013; (2) file a Supplemental Declaration of Professor Christopher Bowman in support of the requested Patent Owner's Supplemental Response; and (3) compel Corning to produce laboratory protocol and underlying data related to the late-produced information, which in DSM's view, falls within the scope of discovery mandated in our decision of June 21, 2013.

This decision addresses each of these issues.

#### 1. Patent Owner's Supplemental Response

DSM asserts, and Corning does not challenge persuasively, the following facts. On October 25, 2013—two months after DSM filed its Patent Owner's Response and one business day before the deposition of Professor Bowman—Corning produced additional gel permeation chromatography ("GPC") spectra that characterize oligomers synthesized in an attempt to replicate certain prior art. These spectra are dated between May 2011 and August 2012, and fall within the scope of discovery set forth in our decision of June 21, 2013, wherein we ordered Corning to produce "[l]aboratory notebooks and other documents containing protocols followed

in creating and testing the compositions and the underlying data for the test results.” Decision entered June 21, 2013.

In DSM’s view, these late-produced GPC spectra contain information that goes to the heart of the merits of Corning’s inherency theory; therefore, as a direct result of Corning’s failure to produce the spectra during the Patent Owner’s discovery period, DSM was denied an opportunity to address the late-produced spectra in the Patent Owner’s Response.

Based on the information presented, we determine that the GPC spectra produced by Corning on October 25, 2013 reasonably could not have been obtained earlier by DSM, and that consideration of that data is in the interests of justice. 37 C.F.R. § 42.123(b). We authorize DSM to file, by December 13, 2013, a Patent Owner’s Supplemental Response that may be supported by an exhibit consisting of any portion of the deposition transcript of Professor Bowman. The Patent Owner’s Supplemental Response shall be limited to addressing the late-produced GPC spectra, as well as any additional documents produced by Corning in response to this decision.

The Patent Owner’s Supplemental Response shall not exceed five pages, plus one additional page in which DSM may provide any case-specific information. DSM shall file the identical Patent Owner’s Supplemental Response in each of the ten cases in which it is relevant, varying from the others only by its caption and by the additional page of case-specific information.

Corning may file a five-page Reply to Patent Owner’s Supplemental Response, limited to addressing the issues raised therein, by December 20, 2013. The Reply to Patent Owner’s Supplemental Response shall not exceed five pages, plus one additional page in which Corning may provide any case-specific information. Corning shall file the identical Reply

to Patent Owner's Supplemental Response in each of the ten cases in which the Patent Owner's Supplemental Response was filed, varying from the others only by its caption and by the additional page of case-specific information.

## 2. Supplemental Declaration of Professor Bowman

DSM requests permission to file a Supplemental Declaration of Professor Bowman in support of the requested Patent Owner's Supplemental Response. On the one hand, we agree with DSM that Corning's failure to produce the additional GPC spectra in a timely manner denied DSM the opportunity to have Professor Bowman opine upon that information in his declarations of record. *See, e.g.*, IPR2013-00043 Ex. 2030. On the other hand, the spectra were provided to DSM one business day prior to Professor Bowman's deposition, during which he, presumably, was questioned about the factual bases for his opinions pertaining to Corning's inherency theory. *See, e.g., id.*

Based on the particular facts presented in this case, we are not persuaded that the interests of justice, which favor allowing a supplemental declaration, are greater than the interests of economy and efficiency, which weigh against allowing such a filing. Specifically, opening the door to additional testimony and cross-examination at this late stage of the proceeding is a remedy out of proportion to DSM's demonstrated need for such a filing, and would likely derail the schedule set in this case. DSM is provided an opportunity to argue the relevance of the late-produced GPC spectra in a supplemental response as discussed above, and may file as an exhibit thereto any portion of the transcript of Professor Bowman's deposition testimony.

### 3. Request to Compel Discovery

DSM seeks to compel Corning to produce additional material related to the late-produced GPC spectra. Specifically, DSM seeks the laboratory protocol followed in performing Corning's GPC analysis of the respective oligomers as well as the underlying data files. Here again, DSM argues that the requested information goes to the heart of the merits of Corning's inherency theory. In particular, DSM argues that the spectra, produced by Corning on October 25, 2013, omit a region that identifies low-molecular-weight unreacted components, or impurities, which materially affect the performance of the coatings. According to DSM, the presence of peaks in that region would cast doubt on whether the oligomers were made in accordance with the disclosure of the prior art.

We agree with DSM that, to the extent that such information exists, it falls squarely within the scope of discovery compelled in our decision entered June 21, 2013. During the conference call of November 8, 2013, upon direct questioning by the Board on this point, counsel for Corning presented no persuasive argument that the requested information falls outside the scope of that decision. In this regard, Corning simply alluded to (1) DSM's failure to construe Corning's discovery requests so broadly; and (2) DSM's failure to follow up with a specific request for responsive documents, when the possibility that such documents exist was raised during a prior deposition.

Corning's allusions in this regard are not well taken, because neither of these circumstances in any way discharges Corning's burden to comply with the terms of our decision compelling production. Specifically, no reasonable interpretation of our decision, wherein we ordered Corning to produce "[l]aboratory notebooks and other documents containing protocols

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