

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)
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)¹

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

KAMHOLZ, *Administrative Patent Judge*.

¹ This Order addresses issues that arise in all ten cases. We therefore exercise our discretion to issue one Order to be filed in each case. The parties are not authorized to use this style heading for any subsequent papers.

DECISION
On Request for Rehearing and Other Matters
37 C.F.R. § 42.71

1. DSM's Request for Rehearing

DSM requests rehearing of the Board's decisions, entered November 18, 2013, in each of the above-captioned cases, denying DSM's motion to file a supplemental response declaration of Professor Christopher Bowman with its Supplemental Response. The Board grants the requests to the extent explained below.

In its initial motion, DSM requested leave to file a supplemental response and supplemental response declaration by Professor Bowman to address new gel permeation chromatography data that Corning produced to DSM on October 25, 2013. In the November 18, 2013 decisions, we granted DSM's request for leave to file a supplemental response but denied DSM's request to file a supplemental response declaration by Professor Bowman. We explained that the interest of justice favors allowing DSM to file a supplemental response declaration by Professor Bowman, but that allowing additional testimony and cross-examination at this stage would be disruptive to the proceedings and was a remedy out of proportion to DSM's need for the supplemental response declaration.

DSM now argues, among other things, that since entry of the Board's decisions on November 18, 2013, Corning has produced more new gel permeation chromatography data and protocols and submitted a declaration of Dr. Dotsevi Y. Sogah directed to this newly-produced information, in

support of its Reply to DSM's Response.² DSM argues that the late production of these materials prevented Professor Bowman from giving testimony upon them in support of DSM's Response to the Petition. DSM now seeks leave to file a supplemental response declaration by Professor Bowman directed to "issues raised by [Corning's] late production" of the data. DSM also seeks an extension of the deadline to file its Supplemental Response and supplemental response declaration from December 13, 2013 to December 27, 2013.

DSM represents that it intends to file a reply declaration by Professor Bowman in support of its Reply to Corning's Opposition to DSM's Motion to Amend, and that Corning may cross-examine Professor Bowman on his supplemental response declaration when it cross-examines him on his reply declaration, so that concerns over economy and efficiency are moot. DSM also seeks to limit briefing by Corning on this subject to motions for observation regarding cross-examination.

Upon consideration of the changed circumstances occasioned by Corning's late production of relevant information, we are now persuaded that DSM has shown sufficient need to justify the authorization of a supplemental response declaration concerning the new information. Professor Bowman's testimony must be limited, however, to addressing the newly-produced gel permeation chromatography information directly; it may not be directed to other issues "raised" by Corning's late production of the data.

We are also persuaded that DSM's proposed timing of the

² It is not clear to us whether Dr. Sogah's declaration actually addresses the newly-produced information, because DSM does not identify specific paragraphs in which the new information is discussed.

supplemental response declaration and cross-examination will not unduly disturb the schedule for these proceedings.

We note that, although DSM has filed rehearing requests on the above-described basis in proceedings IPR2013-00050 and -00052, Corning did not file declarations by Dr. Sogah in those cases, and DSM's Responses in those cases do not appear to address any gel permeation chromatography data. We are not persuaded, therefore, that DSM has demonstrated sufficient need to justify filing a supplemental response declaration in those two cases.

We deny DSM's request for an extension of time. A request for an extension of time requires a showing of good cause. 37 C.F.R. § 42.5(c)(2). DSM does not explain why it requires the additional time, let alone show good cause. Moreover, DSM's requested due date of December 27, 2013 leaves an unreasonably short time—only four business days—for Corning to conduct cross-examination of Professor Bowman and to prepare a motion on observation of cross-examination, before Due Date 4 (January 6, 2014).

2. Authorization for DSM to file motion for observation regarding cross-examination

DSM submitted a request by email (copy attached) for a conference call to seek authorization to file motions for observation regarding cross-examination of certain Corning witnesses. DSM represents that Corning does not oppose the request but wants to be able to reply to the motions.

In the interest of efficiency, we authorize DSM to file any motions for observation regarding cross-examination of Corning reply witnesses by Due Date 4, and we authorize Corning to file replies to them by Due Date 5.

3. DSM's request to expunge certain Corning evidence

Also in its email, DSM asked that the declaration of Clifford R.

Pollock, and certain paragraphs of the responsive declarations of Michael Winningham, be expunged.

We dismiss DSM's request. The appropriate mechanism is a Motion to Exclude Evidence, authorization for which we gave in the Scheduling Orders.

It is hereby

ORDERED that DSM's Request for Rehearing is *granted* to the extent that:

1. DSM is authorized to submit a supplemental response declaration of Professor Christopher Bowman with its Supplemental Response in IPR2013-00043, -00044, -00045, -00046, -00047, -00048, -00049, and -00053;
2. The deadline for DSM to submit the Supplemental Response and supplemental response declaration of Professor Bowman remains set at December 13, 2013;
3. DSM is not authorized to submit a supplemental response declaration of Professor Christopher Bowman with its Supplemental Response in IPR2013-00050 or in IPR2013-00052;
4. The scope of Professor Bowman's supplemental response declaration in each case is limited to testimony upon gel permeation chromatography data and protocols produced to DSM by Corning on or after October 25, 2013;
5. If DSM submits any further declaration by Professor Bowman to accompany its Supplemental Response or Reply, DSM shall make Professor Bowman available for cross-examination by Corning before Due Date 4;
6. The scope of cross-examination may not exceed that of the direct

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