

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 IPR2013-00048
Patent 6,298,189 B1

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

KAMHOLZ, *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 (Paper 6, “Pet.”) to institute an *inter partes* review of claims 1-52 (the “challenged claims”) of U.S. Patent No. 6,298,189 B1 (Ex. 1001 (the “’189 patent”)).¹ The Board instituted trial for the challenged claims on the following grounds of unpatentability asserted by Corning:

Reference(s) ²	Basis	Claims challenged
A. Shustack	§ 102	1-3, 5-7, 9-11, 13-15, 37-39, 45-47, and 49-51
B. Shustack	§ 103	1-3, 5-7, 9-11, 13-15, 37-39, 45-47, and 49-51
C. Szum ’928	§ 102	1, 5, 9, 13, 37, 45, and 49
D. Shustack and Jackson	§ 103	4, 8, 12, 16, 40, 48, and 52
Combination A, B, C, or D; and Chawla	§ 103	17-20
Combination A, B, C, or D; and Hager	§ 103	21-24
Combination A, B, C, or D; and Tortorello	§ 103	25-28

¹ Case IPR2013-00049 concerns claims 53-66 of the ’189 patent.

² The petition relies on the following references: U.S. Patent No. 5,352,712 (Ex. 1003 (“Shustack”)); WO 95/15928 (Ex. 1005 (“Szum ’928”)); U.S. Patent No. 4,900,126 (Ex. 1007 (“Jackson”)); U.S. Patent No. 5,696,179 (Ex. 1008 (“Chawla”)); U.S. Patent No. 5,182,784 (Ex. 1009 (“Hager”)); U.S. Patent No. 5,847,021 (Ex. 1010 (“Tortorello”)); WO 97/46380 (Ex. 1011 (“Botelho”)); U.S. Patent No. 4,707,076 (Ex. 1012 (“Skutnik”)); and U.S. Patent No. 5,408,564 (Ex. 1013 (“Mills”)).

Combination A, B, C, or D; and Botelho	§ 103	29-32
Combination A, B, C, or D; and Skutnik	§ 103	33-36
Combination A, B, C, or D; and Mills	§ 103	41-44

Decision to Institute 3-4 (Paper 15, “Dec.”).

After institution of trial, Patent Owner DSM IP Assets B.V. (“DSM”) filed a Patent Owner Response (Paper 46, “Resp.”), and Corning filed a Reply to the Patent Owner Response (Paper 65, “Reply”). DSM filed a Supplemental Response (Paper 74, “Supp. Resp.”) with leave of the Board, and Corning filed a Supplemental Reply (Paper 75, “Supp. Reply”). DSM filed a Motion for Observations on Cross-Examination of Corning Reply Declarants (Paper 78, “Obs.”), and Corning filed a Response to the Observations (Paper 86, “Obs. Resp.”).

DSM also filed a Motion to Amend Claims (Paper 47, “Motion to Amend”). In it, DSM proposed claims 67, 68, 69, and 70 to substitute for patented claims 6, 7, 14, and 15, respectively. Motion to Amend 1-6. Corning filed an Opposition to the Motion to Amend Claims (Paper 64, “Opp.”). DSM filed a Reply to the Opposition (Paper 76, “Motion Reply”).

DSM also filed a Motion to Exclude certain of Corning’s evidence (Paper 79, “PO Motion to Exclude”). Corning filed an Opposition (Paper 85, “PO Excl. Opp.”), and DSM filed a Reply (Paper 89, “PO Excl. Reply”). Corning filed a Motion to Exclude certain of DSM’s evidence (Paper 82, “Pet. Motion to Exclude”). DSM filed an Opposition (Paper 84), and Corning filed a Reply (Paper 90).

Corning relies upon declarations of Dr. Michael Winningham (Ex. 1014) and Ms. Inna Kouzmina (Ex. 1015) in support of its Petition. DSM relies upon declarations of Dr. Christopher Bowman (Ex. 2034) and Dr. Carl Taylor (Ex. 2032) in its Response, along with a deposition of Dr. Winningham (Exs. 2027-2031) and portions of Ms. Kouzmina's deposition (Exs. 2024-26). Corning relies upon declarations of Dr. Jiann-Wen Woody Ju (Ex. 1035) and Dr. Dotsevi Sogah (Ex. 1068), a responsive declaration of Dr. Winningham (Ex. 1078), along with depositions of Dr. Bowman (Exs. 1070-72, 1075-77) and Dr. Taylor (Exs. 1045-47) and a portion of Ms. Kouzmina's deposition (Ex. 1044) in its Reply. DSM relies upon a supplemental declaration of Dr. Bowman in its Supplemental Response (Ex. 2055). Corning relies upon depositions of Dr. Winningham (Ex. 1080)³ and Dr. Dotsevi Sogah (Ex. 1079) in its Supplemental Reply. DSM relies upon depositions of Dr. Winningham (Ex. 2085), Dr. Sogah (Exs. 2073-74), and Dr. Ju (Exs. 2087-88) in its Motion for Observations on Cross-Examination of Corning Reply Declarants.

Oral argument was conducted on February 11, 2014. A transcript is entered as Paper 93 ("Tr."). Both parties indicated during oral argument that the oral argument in case IPR2013-00045 relates to this proceeding as well. Tr. 3:12-14; 24:19-21. The transcript for case IPR2013-00044 is entered as Paper 89 in that proceeding.

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.

³ Ex. 1080 is a rough transcript. DSM submitted an official transcript as Ex. 2088.

Corning has proved that claims 5, 13, 17, 29, 33, 37, 45, and 49 are unpatentable. Corning has not proved that claims 1-4, 6-12, 14-16, 18-28, 30-32, 34-36, 38-44, 46-48, and 50-52 are unpatentable.

DSM's Motion to Amend Claims is denied without prejudice.

Corning's Motion to Exclude Evidence is dismissed.

DSM's Motion to Exclude Evidence is dismissed-in-part and denied-in-part.

B. The Invention

The '189 patent generally relates to radiation-curable coating compositions for optical glass fibers commonly used in data transmission. Ex. 1001, 1:18-19. In particular, the patent describes optical glass fibers coated with two radiation-cured coatings. *Id.* at 1:26-27. An inner primary coating contacts the glass surface of the fiber. *Id.* at 1:28-30. An outer primary coating overlays the inner coating. *Id.* For identification purposes, the outer primary coating may include colorant or, alternatively, a third colored layer, called an ink coating, which is applied to the outer primary coating. *Id.* at 1:53-58. Figure 1, depicting such an optical glass fiber, is reproduced below.

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