

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 OBERMANN,
JENNIFER S. BISK, SCOTT E. KAMHOLZ, and
ZHENYU YANG, *Administrative Patent Judges*.

KAMHOLZ, *Administrative Patent Judge*.

DECISION
Petitioner's Request for Rehearing
37 C.F.R. § 42.71(d)

I. INTRODUCTION

Petitioner Corning Incorporated (“Corning”) requests reconsideration of the Board’s final written decision (“Dec.”), dated May 9, 2014 (Paper 94), to the extent we denied Corning’s request for cancellation of claims 1-4, 6-12, 14-16, 18-28, 30-32, 34-36, 38-44, 46-48, and 50-52 of U.S. Patent No. 6,298,189 B1 (the “189 patent”), which is assigned to Patent Owner DSM IP Assets B.V. (“DSM”). Request for Rehearing 1 (Paper 95 (“Req.”)). We have considered Corning’s request, but we decline to modify the final written decision.

II. STANDARD OF REVIEW

A party challenging a final written decision by way of a request for rehearing must identify specifically all matters the party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d). The challenging party bears the burden of showing that the decision should be modified. *Id.*

III. DISCUSSION

Corning challenges the final written decision with respect to our determinations that Corning failed to demonstrate that the prior art discloses the claimed “ratio of the change in length” and the “modulus of elasticity” of the outer primary coating.

A. *Ratio of change in length*

Corning identifies several points for reconsideration, which we consider in turn.

1. *Experimental methods*

Corning argues that we erred in determining that Corning's petition evidence, as to how it carried out the "change in length" experiments, was sufficient to institute trial yet insufficient to warrant cancellation of the relevant claims. Req. 2-3. According to Corning, if the evidence had been sufficient to institute *inter partes review*, it should also have been sufficient for Corning to prevail in the final written decision. *Id.* at 3. Corning argues that it is unfairly prejudiced by this supposed discrepancy, particularly in view of the estoppel that attaches upon the issuance of a final written decision. *Id.* (citing 35 U.S.C. § 315(e)).

This argument is unpersuasive, because the standard for instituting *inter partes review* is different from the standard for a petitioner to prevail in the final written decision. The standard for institution is set forth in 35 U.S.C. § 314(a), which provides as follows:

THRESHOLD.—The Director may not authorize an inter partes review to be instituted unless the Director determines that the information presented in the petition filed under section 311 and any response filed under section 313 shows that there is a reasonable likelihood that the petitioner would prevail with respect to at least 1 of the claims challenged in the petition.

The petitioner's burden to prevail in the final written decision, in contrast, is set forth in 35 U.S.C. § 316(e), which provides as follows:

EVIDENTIARY STANDARDS.—In an inter partes review instituted under this chapter, the petitioner shall have the burden of proving a proposition of unpatentability by a preponderance of the evidence.

The standards differ in that institution requires the petitioner to show merely a *reasonable likelihood* that it would prevail, whereas actually to prevail requires the petitioner to prove its case by a *preponderance of the evidence*. Compare 35 U.S.C. § 314(a) with 35 U.S.C. § 316(e). Showing a reasonable likelihood of prevailing is less stringent a standard than prevailing by a preponderance of the evidence. It is possible that a case strong enough to show a reasonable likelihood of prevailing, on the incomplete record available at the time the institution decision is made, is insufficient to prove unpatentability by a preponderance of the evidence on the complete record. It is also possible that weaknesses in the petitioner's case become more fully apparent only when considered in the context of the full record developed during the course of trial.

In the present case, consideration of evidence developed and cited during trial highlighted gaps in Corning's petition evidence, as we discussed in the final written decision. Dec. 52-53. In particular, we determined that paragraph 59 of the declaration of Ms. Inna Kouzmina (Ex. 1015), which was the only source of evidence in the Petition addressing the change-in-length calculation, was entitled to little or no weight, because it lacked a meaningful explanation of the experimental method used. *Id.* at 51-52. We did not overlook our determination that Corning's petition evidence was sufficient for instituting *inter partes* review; rather, we explained that the insufficiency of the evidence was underscored upon consideration of the full record. *Id.*

2. *Dr. Winningham's testimony regarding change-in-length experiments*

Corning argues that we should have given consideration to Dr. Winningham's testimony in paragraphs 100-104 of his declaration (Ex. 1014). Req. 3 (citing Dec. 52 n.16).

This argument is unpersuasive. Although Corning argues that paragraphs 100-104 provide the foundation for paragraphs 128 and 132, which themselves *are* cited in the Petition (*see* Pet. 23, 29), Corning still does not identify where in its Petition or other briefing it cited paragraphs 100-104, nor does Corning identify where paragraphs 100-104 are cited as foundation for paragraphs 128 and 132. Moreover, we observed in the final written decision that, even if we gave these paragraphs consideration, they would not have been persuasive, because they provide no more detailed explanation of the measurement and calculation procedures than the evidence we did consider. Dec. 52 n.16.

3. *Witnesses lacking first-hand knowledge*

Corning argues that we criticized its witnesses' evidence on the basis that the witnesses did not perform or observe first-hand the experiments reported, and that Ms. Kouzmina had an "incomplete understanding" of how the experiments were performed. Req. 4 (quoting Dec. 53). Corning asserts that this criticism is at odds with our earlier ruling that declaration testimony directed to experimental testing need not come from the person who actually conducted the testing. Req. 4 (citing Paper 55, 4 (Dec. on Mot. for Discovery)).

We disagree. Corning notes correctly that our rules do not require that the declarant attesting to testing evidence be the person who actually

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