

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 No. IPR2013-00049
Patent 6,298,189

Held: February 11, 2014

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

APPEARANCES:

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18 The above-entitled matter came on for hearing on Thursday,
19 February 11, 2014, commencing at 3:43 p.m., at the U.S. Patent and
20 Trademark Office, 600 Dulany Street, Alexandria, Virginia.
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24 P R O C E E D I N G S

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26 JUDGE BISK: Let's move on to our next case,
27 which is IPR2013-00049.

28 MR. MERKEL: Thank you, Your Honor, Edwin
29 Merkel again for Petitioner Corning. In this case, we've got
30 a number of grounds that are identified. They all involve
31 the same testing that we've already discussed for IPR 45 and
32 IPR 48. There are only a couple of new formulations.

1 I'd just simply like to point out, since we've
2 already discussed all the testing, and our positions on those,
3 DSM does not attack the combination of coatings from
4 within the Shustack reference, or from within the Szum '928
5 reference. They do not attack the combination of coatings
6 from the Szum '928 in combination with the Shustack
7 reference, that's the third ground there. They do not attack
8 the Szum '928 formulation in combination with the Szum
9 '396 formulation.

10 So, we have no other issues to discuss at this
11 point in time, and we would simply like to reserve the
12 remainder of our time for rebuttal.

13 JUDGE BISK: Okay.

14 MS. ISRAEL: May I ask how much time we have
15 left?

16 JUDGE BISK: Yeah, 21 minutes.

17 MS. ISRAEL: Twenty-one minutes, okay. I just
18 want to correct the record. DSM does contest the
19 obviousness of the combinations, and we will rest on our
20 papers, but we do attack the obviousness of the combinations
21 of the references that Mr. Merkel just discussed.

22 Otherwise, once again, we think that the issues
23 are very similar to the ones that we just discussed with
24 respect to the IPR2013-00048, and that, again, this is a
25 failure of proof case, in particular every claim limitation,

1 among other things, every claim limitation requires change
2 of length when heated is one of the tests, that's just an
3 example of one of the tests that Corning did not meet, and
4 has not met its burden, again, we have a failure of proof, and
5 we will rest on our papers.

6 JUDGE BISK: Can I ask, on this one, in the
7 motion to amend, it says "not in the alternative."

8 MS. ISRAEL: It's contingent. In 49?

9 JUDGE BISK: Yeah. I believe it says they're not
10 proposed in the alternative.

11 MS. ISRAEL: It's contingent.

12 JUDGE BISK: You mean them to be contingent?

13 MS. ISRAEL: It should be contingent.

14 JUDGE KAMHOLZ: On page 1 of your motion to
15 amend, "not in the alternative."

16 MS. ISRAEL: That was an error, it's contingent.

17 JUDGE BISK: Okay. Are you done?

18 MS. ISRAEL: Yes.

19 JUDGE BISK: Obviously you have something to
20 say on that.

21 MR. MERKEL: How is this going to work? Are
22 you going to allow DSM to put in a new paper at this late
23 stage?

24 JUDGE BISK: So, I don't recall in the reply, I
25 don't have the reply right here in front of me. Do they

1 discuss whether it's contingent in their reply, do you
2 remember, in this case? I mean, it's one thing if it's a typo
3 of just one word, but --

4 MR. MERKEL: Well, it doesn't appear that
5 there's anything in the reply to lend any clarity on that issue.

6 JUDGE BISK: It does seem that they've put in a
7 full response on all of the claims.

8 MR. MERKEL: So, if this motion is actually
9 contingent, I guess -- well, at this point, we don't get any
10 say in it.

11 JUDGE BISK: Well, I don't think -- would your
12 opposition have been any different?

13 MR. MERKEL: I was simply going to raise one
14 issue, but if you'll allow me.

15 JUDGE BISK: Well, one issue about what?

16 MR. MERKEL: About their amendment, because
17 I -- it was my -- I would have raised it as part of my main
18 presentation, expecting -- fully expecting that they were
19 going to address their noncontingent amendment.

20 JUDGE OBERMANN: Let me ask you this, if we
21 permit it to be contingent, will you suffer any prejudice at
22 this point?

23 MR. MERKEL: Only if you -- well, that
24 amendment only comes into play if you decide in our favor,
25 so no.

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