

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 IPR2013-00050
Patent 6,323,255 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); 37 C.F.R. § 42.73

I. INTRODUCTION

A. Background

Petitioner Corning Incorporated (“Corning”) filed a petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1-19 (“the challenged claims”) of U.S. Patent No. 6,323,255 B1 (Ex. 1001) (“the ’255 patent”). The Board instituted trial for the challenged claims on the following grounds of unpatentability asserted by Corning:

References ¹	Basis	Claims challenged
Bishop and Trapasso	§ 103	1-7, 12-17, and 19
Bishop, Trapasso, and Szum	§ 103	6
Bishop, Trapasso, Jackson, and Szum	§ 103	8-11
Szum and Trapasso	§ 103	1-8, 12-14, and 16-19
Szum, Trapasso, and Jackson	§ 103	9-11

Decision to Institute 2 (Paper 11, “Dec.”).

After institution of trial, Patent Owner DSM IP Assets B.V. (“DSM”) filed a Patent Owner Response (Paper 39, “Resp.”), and Corning filed a Reply to the Patent Owner Response (Paper 54, “Reply”). DSM filed a Supplemental Response (Paper 60, “Suppl. Resp.”) with leave of the Board, and Corning filed a Supplemental Reply (Paper 61, “Suppl. Reply”). DSM filed a Motion for Observations on Cross-Examination of Corning Reply

¹ The references relied upon are: U.S. Patent No. 4,849,462 (Ex. 1002) (“Bishop”); U.S. Patent No. 5,664,041 (Ex. 1003) (“Szum”); U.S. Patent No. 5,554,785 (Ex. 1004) (“Trapasso”); and U.S. Patent No. 4,900,126 (Ex. 1005) (“Jackson”).

Declarants (Paper 63, “Obs.”), and Corning filed a Response to the Observations (Paper 68, “Obs. Resp.”).

DSM also filed a Motion to Amend Claims (Paper 40), which DSM later corrected, with leave of the Board, to make clear that the motion is contingent on a finding that the claims sought to be replaced are unpatentable (Paper 75, “Corr. Mot. to Amend”). In it, DSM proposed claims 20, 21, and 22 to substitute for patented claims 1, 15, and 19, respectively. Motion to Amend 1. Corning filed an Opposition to the Motion to Amend Claims (Paper 53). DSM filed a Reply to the Opposition (Paper 62, “Amend Reply”).

DSM also filed a Motion to Exclude certain of Corning’s Evidence (Paper 64, “Mot. to Exclude”). Corning filed an Opposition, (Paper 69, “Excl. Opp.”), and DSM filed a Reply (Paper 72, “Excl. Reply”).

Corning relies upon declarations of Dr. Michael Winningham (Ex. 1006) and Ms. Inna Kouzmina (Ex. 1007) in support of its Petition. DSM relies upon a declaration of Dr. Christopher Bowman (Ex. 2026) in its Response, along with a deposition of Dr. Winningham (Exs. 2021-2025) and portions of Ms. Kouzmina’s deposition (Exs. 2018, 2019). Corning relies upon a responsive declaration of Dr. Winningham (Ex. 1029), along with a deposition of Dr. Bowman (Exs. 1030-1035) and a portion of Ms. Kouzmina’s deposition (Ex. 1036) in its Reply. DSM relies upon a supplemental declaration of Dr. Bowman in its Supplemental Response (*see*

IPR2013-00052, Ex. 2037).² Corning relies upon depositions of Dr. Winningham (Ex. 1038)³ and Dr. Dotsevi Sogah (Ex. 1037) in its Supplemental Reply.

Oral argument was conducted on February 11, 2014. A transcript is entered as Paper 76.

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.

Corning has proved that claims 1-19 of the '255 patent are unpatentable.

DSM's Corrected Motion to Amend Claims is *denied*.

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

B. The Invention

The '255 patent is titled "Radiation-Curable Composition" and generally relates to compositions that may be used as, e.g., optical fiber coatings and exhibit "reduced discoloration over time and/or high

² The Board denied DSM authorization to file Dr. Bowman's supplemental declaration in this proceeding. Paper 57, 4-5. DSM nevertheless cites to this declaration in support of its Supplemental Response argument. Suppl. Resp. *passim*. We exercise our discretion and address Dr. Bowman's supplemental declaration for the limited purpose discussed below. DSM also cites to a declaration of Dr. Dotsevi Sogah in its Supplemental Response. Supp. Resp. 1 (citing IPR2013-00043, Ex. 1060). We exercise our discretion and consider Dr. Sogah's declaration as well.

³ Ex. 1038 is a rough transcript. DSM submitted an official transcript as Ex. 2035.

elongation.” Ex. 1001, 1:4-7. The compositions in particular include “at least one transesterified and/or high-purity monomer,” *id.* at 1:7-9, to which is attributed the improved discoloration and elongation properties. *Id.* at 3:5-13. It is acknowledged in the ’255 patent that Trapasso discloses transesterified monomers having “excellent purity,” but it is asserted that Trapasso does not disclose the usefulness of these monomers in making optical fiber coatings, nor that they improve the discoloration and elongation properties. *Id.* at 2:20-33. Claims 1 and 17, reproduced below, are the independent claims in the ’255 patent and illustrate the claimed subject matter:

1. A radiation-curable composition comprising:

- (i) a radiation-curable oligomer; and
- (ii) at least one transesterified monomer, said transesterified monomer having a purity level of greater than 95% and less than 100 ppm of an organotin catalyst;
- (iii) a silane adhesion promoter;

wherein said composition upon cure has a ΔE value of less than 20 when exposed to low intensity fluorescent light for a period of ten weeks.

17. A radiation-curable composition comprising:

- (i) a radiation-curable oligomer; and
- (ii) at least one transesterified monomer having a purity level of greater than 95% and less than 100 ppm of an organotin catalyst, said at least one transesterified monomer being selected from the group consisting of isodecyl acrylate, isobomyl acrylate, and phenoxyethylacrylate;

wherein said composition upon cure has a ΔE value of less than 20 when exposed to low

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