

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE PATENT TRIAL AND APPEAL BOARD

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NIKON CORPORATION,  
Petitioner,

v.

CARL ZEISS AG AND ASML NETHERLANDS B.V.,  
Patent Owner.

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Case IPR2018-00686  
Patent 9,728,574 B2

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Before GRACE KARAFFA OBERMANN, BRYAN F. MOORE, and  
AMBER L. HAGY, *Administrative Patent Judges*.

MOORE, *Administrative Patent Judge*.

DECISION  
Denying Petitioner's Request for Rehearing  
*37 C.F.R. § 42.71*

## I. BACKGROUND

Nikon Corporation (“Petitioner”) requests *inter partes* review of claims 1–5,<sup>1</sup> 7–10, 16, 24, and 30–33 of U.S. Patent No. 9,728,574 B2 (“the ’574 patent,” Ex. 1001) pursuant to 35 U.S.C. §§ 311 *et seq.* Paper 2 (“Pet.”). Petitioner relies on the testimony of Dr. Stuart Kleinfelder. Ex. 1011. Carl Zeiss AG and ASML Netherlands B.V. (“Patent Owner”) filed a preliminary response. Paper 6 (“Prelim. Resp.”). Upon consideration of the Petition and Preliminary Response, we concluded the information presented did not show there is not a reasonable likelihood that Petitioner would prevail in establishing the unpatentability of claims 1–5, 7–10, 16, 24, and 30–33 of the ’574 patent. Paper 7, 2 (“Institution Decision,” “Inst. Dec.”).

On October 26, 2018, Petitioner filed a Request for Rehearing (Paper 8 (“Reh’g Req.”)) of our Institution Decision, requesting reconsideration of our decision denying institution of *inter partes* review of claims 1–5, 7–10, 16, 24, and 30–33 of the ’574 patent. Petitioner argues that the “Board misapprehended matters relating to Grounds 1 and 2.” Reh’g Req. 1.

We have considered Petitioner’s Request for Rehearing, and, for the reasons set forth below, Petitioner’s Request is *denied*.

## II. STANDARD OF REVIEW

37 C.F.R. § 42.71(d) provides that:

A party dissatisfied with a decision may file a request for rehearing, without prior authorization from the Board. The burden of showing a decision should be modified lies with the party challenging the decision. *The request must specifically*

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<sup>1</sup> The Petition, in an apparent typographic error, omits claim 5 from its listing of challenged claims on page 1.

*identify all matters the party believes the Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, opposition, or a reply.*

(Emphasis added.) See Office Trial Practice Guide, 77 Fed. Reg. 48756, 48768 (Aug. 14, 2012). Under 37 C.F.R. § 42.71(c), “[w]hen rehearing a decision on petition, a panel will review the decision for an abuse of discretion.” An abuse of discretion occurs when a “decision was based on an erroneous conclusion of law or clearly erroneous factual findings, or . . . a clear error of judgment.” *PPG Indus. Inc. v. Celanese Polymer Specialties Co. Inc.*, 840 F.2d 1565, 1567 (Fed. Cir. 1988) (citations omitted).

### III. DISCUSSION

#### A. 35 U.S.C. § 325(d)

In the Institution Decision, we denied institution of Ground 1 based on our discretion under 35 U.S.C. § 325(d). Inst. Dec. 17. Specifically, we determined that the Kaifu reference relied on by Petitioner was considered during prosecution. *Id.* Petitioner asserts that we misapprehended or overlooked its arguments regarding why its contentions as to Kaifu were not considered by the Examiner.

[S]ubstantial discrepancies between the treatment of Kaifu and Kaifu ‘003 in the file histories of the grandparent application and the ‘574 application suggest that FIGs. 19A and 19B of Kaifu were forgotten [sic] or misapplied by the Examiner during the prosecution of the ‘574 patent . . . [Claims that were] rejected and canceled [over Kaifu ‘003 in the grandparent] were very similar in scope to the challenged claims, and yet during the prosecution of the ‘574 patent, the Examiner apparently forgot that the allegedly missing limitations of the challenged claims were previously found to be disclosed in FIGs. 8a/b of Kaifu ‘003 in the grandparent application.

Reh’g Req. 2–3. Petitioner goes on to state that

very similar limitations to the so-called distinguishing features of the '574 patent claims [18–20] were rejected in the grandparent application over figures identical to FIGs. 19A/B of Kaifu and yet inexplicably the next communication in response to applicant's arguments in the '574 patent prosecution history was a notice of allowance. The most apparent conclusion is that, as stated by the Applicant on multiple occasions in the prosecution history of the '574 patent, the Examiner relied solely upon FIG. 1 from Kaifu and forgot about FIGs. 19A/B of Kaifu.

Reh'g Req. 7–8. In other words, Petitioner repeats its contention that the Examiner relied only on Figure 1 of Kaifu and, as support, states that claims similar to the challenged claims were cancelled/rejected over the related Kaifu '003 reference in the grandparent application.

To the extent Petitioner is suggesting we did not consider that some claims were cancelled while others were allowed over Kaifu '003 in the grandparent, we state here that we did consider that fact when evaluating the arguments to reach the Institution Decision. *See* Inst. Dec. 11 (citing Ex. 1007 (file history of grandparent application), 453–454 (rejection of claim 18–20), 493 (indicating claims 18–20 were cancelled). Nevertheless, the fact that some claims were cancelled in the grandparent over Kaifu '003 while others were allowed did not persuade us that the Examiner of the '574 patent overlooked FIGs. 19A/B of Kaifu. Thus, we considered these arguments by Petitioner. Inst. Dec. 14, 17 (“[W]e find it is at least unclear whether the Examiner limited his examination to Figure 1 and did not consider Figures 19A/B . . . we are not convinced the Examiner failed to consider Figures 19A/B of Kaifu.”).

Petitioner also asserts we overlooked the fact that some of Patent Owner's arguments regarding § 325(d) were limited to independent claims 9 and 24 and did not encompass claims 1 and 30. Reh'g Req. 9. Specifically,

Petitioner notes that a limitation allegedly similar to the “currently being scanned” limitation considered in the grandparent application is found only in claims 9 and 24 not claims 1 and 30. *Id.* at 8–9.

We considered this fact. In its Preliminary Response, Patent Owner offers two separate rationales for the application of § 325(d) under different headings—one general argument and one argument specific to claims 9 and 24.<sup>2</sup> We considered both arguments in the Institution Decision. *See* Inst. Dec. 12 (considering general arguments discussed at Prelim. Resp. 42–47); *id.* at 15 (considering arguments specific to claim 9 discussed at Prelim. Resp. 50–52). In sum, we applied a multiple factor test considering all the claims and all the arguments including the fact that the art presented by Petitioner was before the Examiner throughout the prosecution of the ’574 patent, its parent, and its grandparent, and we decided to use our discretion to reject Ground 1 of the Petition. Inst. Dec. 10–17.

For the reasons above, Petitioner’s arguments regarding Kaifu on rehearing are simply expanding or reiterating arguments already made in the Petition. A request for rehearing is not merely the opportunity for the requester to reargue positions, elaborate on previous positions, or to disagree with the analysis or conclusions of the panel. *See Nestlé Purina Petcare Co. v. Oil-Dri Corp. of Amer.*, Case IPR2015–00737, slip op. at 8 (PTAB Feb. 9, 2017) (Paper 39) (“Merely disagreeing with our analysis or conclusions does not serve as a proper basis for a request for rehearing.”). Instead, the

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<sup>2</sup> “V. GROUND 1 IS DEFICIENT BECAUSE KAIFU IS THE SAME PRIOR ART PREVIOUSLY CONSIDERED BY THE OFFICE” (Prelim. Resp. 42–47) and “VI. C. The Office has already found that Kaifu’s Figs. 19A/B fail to disclose or suggest ‘selectively electrically coupling’ as independent claims 9 and 24 recite” (*id.* at 52–54).

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