

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.

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

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Case IPR2018-00687  
Patent 6,731,335 B1

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Before JEFFREY S. SMITH, DAVID C. MCKONE, and  
KEVIN W. CHERRY, *Administrative Patent Judges*.

MCKONE, *Administrative Patent Judge*.

DECISION  
PATENT OWNER'S REQUEST FOR REHEARING  
*37 C.F.R. § 42.71(d)*

## I. INTRODUCTION

Nikon Corporation (“Petitioner”) filed a Petition (Paper 2, “Pet.”) to institute an *inter partes* review of claims 1–12 of U.S. Patent No. 6,731,335 B1 (Ex. 1001, “the ’335 patent”). Carl Zeiss AG and ASML Netherlands B.V. (collectively, “Patent Owner”) filed a Preliminary Response (Paper 6, “Prelim. Resp.”). Pursuant to 35 U.S.C. § 314, in our Institution Decision (Paper 7, “Dec.”), we instituted this proceeding as to claims 1–12. Dec. 40–41.

In a Request for Rehearing (Paper 9, “Req.”), Patent Owner contends that we erred by concluding that a skilled artisan would have been motivated to look outside Takahashi (Ex. 1006, EP 0 757 476 A2, Feb. 5, 1997) for ways to eliminate dark current and residual charges. Req. 3. For the reasons below, we deny Patent Owner’s Request for Rehearing.

## II. ANALYSIS

When rehearing a decision on institution, the Board reviews the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). An abuse of discretion may be indicated if a decision is based on an erroneous interpretation of law, if a factual finding is not supported by substantial evidence, or if the decision represents an unreasonable judgment in weighing relevant factors. *See Star Fruits S.N.C. v. U.S.*, 393 F.3d 1277, 1281 (Fed. Cir. 2005); *Arnold P’ship v. Dudas*, 362 F.3d 1338, 1340 (Fed. Cir. 2004); *In re Gartside*, 203 F.3d 1305, 1315–16 (Fed. Cir. 2000). The burden of showing that the Decision should be modified is on Patent Owner, the party challenging the Decision. *See* 37 C.F.R. § 42.71(d). In addition, “[t]he request must specifically identify all matters the party believes the

Board misapprehended or overlooked, and the place where each matter was previously addressed in a motion, an opposition, or a reply.” *Id.*

In the Petition and Preliminary Response, the parties disputed whether it would have been obvious to modify Takahashi to arrive at step 1(a) of claim 1, namely, “(a) fully depleting the first and second photodiodes.” Petitioner presented argument and expert testimony that it would have been obvious. Pet. 23, 26, 38; Ex. 1002 (Declaration of Stuart Kleinfelder Ph.D.) ¶¶ 72–73. Patent Owner argued that Takahashi already taught techniques for reducing dark current and residual charges left in photodiodes and, thus, a skilled artisan “would have had no motivation to modify the art to adopt an alternative technique where, as here, its implementation would be non-productive” and “[a]s such, the art’s disclosure in that regard is a strong teaching away that militates in favor of non-obviousness.” Prelim. Resp. 17–22, 29. In the Institution Decision, we fully considered the parties’ respective arguments and evidence, credited Petitioner’s expert testimony, and preliminarily agreed with Petitioner that a skilled artisan would have had reasons to modify Takahashi. Dec. 16–20.

In the Rehearing Request, Patent Owner reiterates its argument that a skilled artisan “would not have ‘seen a benefit’ to modifying Takahashi with any other teachings on this issue” because “Takahashi includes structural components that eliminate dark current and residual charges”; rather, Patent Owner argues, “neither the Decision nor the Petition identifies any ‘benefit’ that the step of fully depleting the photodiodes would provide to the Takahashi apparatus, especially since Takahashi already had structural solutions for addressing dark current and residual charges.” Req. 3–4 (quoting *KSR Int’l Co. v. Teleflex Inc.*, 550 U.S. 398, 424 (2007)). Patent

Owner then takes issue with our citation to *In re Mouttet*, 686 F.3d 1332 (Fed. Cir. 2012), and argues that we should follow *Winner International Royalty Corp. v. Wang*, 202 F.3d 1340 (Fed. Cir. 2000), instead. Req. 4–8.

We are not persuaded by Patent Owner. Patent Owner does not contend that we overlooked or misapprehended its argument. Indeed, we discussed it in detail. Dec. 16–20. Patent Owner also does not persuade us that we misapprehended the law of obviousness. Rather, Patent Owner simply disagrees with our Institution Decision on this issue. Nevertheless, mere disagreement with our conclusion is not a proper basis for rehearing. Accordingly, we deny Patent Owner’s Request for Rehearing.

We note that our determination that there would have been reasons to modify Takahashi is not final and that Patent Owner is not precluded from raising in its Patent Owner Response the arguments presented in the Request for Rehearing.

### III. CONCLUSION

Patent Owner has not shown that we misapprehended the law or overlooked its arguments. Accordingly, we decline to change our Decision.

### IV. ORDER

For the reasons given:

Patent Owner’s Request for Rehearing is denied.

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