Trials@uspto.gov
Tel: 571-272-7822

Paper 16
Entered: May 28, 2013

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 IPR2013-00052
Patent 7,276,543 B2

Before MICHAEL P. TIERNEY, JENNIFER S. BISK, and SCOTT E. KAMHOLZ, *Administrative Patent Judges.*

KAMHOLZ, *Administrative Patent Judge*.

DECISION
On Request for Rehearing
37 C.F.R. § 42.71

I. INTRODUCTION

Corning filed a request for rehearing of the Board's decision ("Decision"), dated May 2, 2013 (Paper 13), which instituted *inter partes* review of claims 11-34 of DSM's U.S. Patent 7,276,543 B2 (the "'543 patent"). Corning contends that the Board should have instituted review on claim 31 as being anticipated by each of Szum and Snowwhite.

We deny the request.

II. STANDARD OF REVIEW

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). *See also* 37 C.F.R. § 42.71(d) ("The request must specifically identify all matters the party believes the Board misapprehended or overlooked").

III. DISCUSSION

Corning argues that the Board's decision not to institute *inter partes* review of claim 31 based on anticipation by Szum or Snowwhite "resulted from an erroneous view of the law." Req. Reh'g. 3. Specifically, Corning contends that the language in claim 31 specifying that the claimed composition is cured "with a lamp having at least 6% of its emission in the range between 280 and 320 nm" is a product-by-process limitation to which the Board should have accorded no weight. *Id.* at 6-7. Corning argues that it made out a prima facie case of anticipation by Szum and Snowwhite in showing that both disclose

curing, among the other limitations, and that "it is appropriate for the burden to shift to the patent owner to demonstrate that the lamp and spectral conditions used for curing impart distinctive structural characteristics to the final product," akin to the procedural mechanism used in regular prosecution and reexamination. *Id.* at 11.

We disagree. Corning failed, in its Petition, to provide evidence sufficient to "demonstrate that there is a reasonable likelihood" that claim 31 is anticipated by Szum or Snowwhite. Decision 10, 12; *see* 37 C.F.R. § 42.108(c). Corning merely asserted that the "with a lamp . . ." recitation is entitled to no patentable weight. Corning did not support this assertion with adequate explanation or credible evidence and so left its anticipation propositions incomplete. The challenges to claim 31 based on anticipation by Szum and Snowwhite were, therefore, correctly denied. Corning has shown no abuse of discretion in the Decision.

IV. CONCLUSION

The request for rehearing has been considered but is *denied*.

REHEARING DENIED

For PETITIONER:

Michael Goldman
Michael.Goldman@leclairryan.com

Jeffrey Townes
Jeffrey.Townes@leclairryan.com

For PATENT OWNER:

Sharon Israel
sisrael@mayerbrown.com

Joseph Mahoney
jmahoney@mayerbrown.com