

DOCKET NO: 418599US

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARL ZEISS SMT GMBH

Petitioner

v.

NIKON CORPORATION

Patent Owner

Case IPR2013-00362

Patent 7,348,575

**PATENT OWNER'S CONDITIONAL MOTION TO EXCLUDE
EVIDENCE**

PURSUANT TO 37 C.F.R. § 42.64(C)

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I. Statement of the Precise Relief Requested

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner Nikon conditionally moves to exclude Exhibits 1036 and 1038-1049, including a supplemental declaration and accompanying computer-assisted lens designs, submitted in support of Petitioner's Reply (Doc. No. 22). If Patent Owner's Exhibits 2036-2039 remain in the evidentiary record for consideration of the merits of this trial, then Patent Owner will withdraw this motion because Exhibits 2036-2039 demonstrate that Exhibits 1036 and 1038-1049 support Patent Owner's contention that the prior art does not enable or render obvious the claimed invention.¹ If Patent Owner's Exhibits 2036-2039 are excluded or otherwise do not remain part of the evidentiary record, then Patent Owner submits this conditional motion to exclude Petitioner's Exhibits 1036 and 1038-1049.

II. Statement of Material Facts

On May 28, 2014, Petitioner Zeiss filed its Reply to Patent Owner's Response (Doc. No. 22) along with several corresponding exhibits, including Exhibits 1036 and 1038-1049 that purportedly show how one of ordinary skill in the art could utilize the latest version of CODE V computer software to modify a prior art lens system to arrive at the claimed invention. Patent Owner timely

¹ Patent Owner anticipates that Petitioner will file a motion to exclude Exhibits 2036-2039, based on a prior telephone conference with the panel. (Ex. 2042.)

served objections to evidence on June 4, 2014. (Ex. 2041.) Subsequently, Patent Owner cross-examined Petitioner's expert, Mr. Juergens. (Ex. 2040.) The cross-examination shows that the computer-assisted lens designs described in Exhibits 1036 and 1038-1049 are inoperable, specifically because those lens designs fail to properly form an image that is focused. (Ex. 2040, 110:12 – 111:21, 115:2 – 117:14, 123:22 – 125:19). Additionally, some of the lens designs are inoperable because they suffer from beam separation problems.² (Ex. 2040, 117:15 – 120:1).

Accordingly, Exhibits 1036 and 1038-1049 are irrelevant to Petitioner's positions on obviousness and enablement, but are nonetheless conditionally relevant to Patent Owner's position that the challenged claims are *not* obvious and that the prior art is *not* enabling, in view of Mr. Juergens' cross-examination testimony and related Exhibits 2036-2039.

III. Relevant Law

The Federal Rules of Evidence ("FRE") apply to the current proceedings.
37 C.F.R. § 42.62.

² Patent Owner has submitted observations on Mr. Juergens' deposition testimony that reveal in further detail the severity of the problems with his computer-assisted lens designs.

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