

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 OPPOSITION
TO PETITIONER'S MOTION TO EXCLUDE EVIDENCE

TABLE OF CONTENTS

	<u>Page</u>
I. Introduction	1
II. Counterstatement of Material Facts.....	2
III. Relevant Law	4
IV. Argument	4
A. Mr. Juergens and Dr. Sasian Each Authenticated Exhibits 2036-2039	4
B. Exhibits 2036-2039 Are Not Hearsay, and Even if They Were, They Fall within the Hearsay Exception	8
C. Irrespective of Hearsay, Exhibits 2036-2039 May Still Be Relied Upon for the Limited Purpose of Demonstrating that Petitioner's Exhibits 1036 and 1038-1049 Have No Probative Value	11
V. Conclusion	13

TABLE OF AUTHORITIES

<u>Cases</u>	<u>Page</u>
<i>Innovention Toys, LLC v. MGA Entm't, Inc.</i> , 2012 U.S. Dist. LEXIS 158194, at * 6-7 (E.D. La. Nov. 4, 2012)	12
<i>Shu-hui Chen v. Herve Bouchard</i> , 2002 Pat. App. LEXIS 201 (BPAI Aug. 2, 2002)	9
 <u>Rules</u>	
37 C.F.R. § 42.62	3
37 C.F.R. § 42.64	7
Federal Rule of Evidence 801	8
Federal Rule of Evidence 807	9
Federal Rule of Evidence 901	5

I. INTRODUCTION

Petitioner's Motion to Exclude Evidence ignores the fact that Patent Owner's Exhibits 2036-2039 simply include additional results of the lens design that Petitioner and its declarant, Mr. Juergens, omitted from the reply brief and accompanying exhibits. Significantly, Petitioner does not dispute that Mr. Juergens' Supplemental Declaration merely shows how his lens designs affect light originating from only two field points out of the entire field width. Nor does Petitioner appear to dispute that Mr. Juergens' lens designs fail to properly form a usable image – a result that Patent Owner's Exhibits 2036-2039 confirm by showing how the lens designs affect *all* light originating from the *entire* field width.

Petitioner provides no credible basis for excluding the evidence, testimony, or observations that it finds objectionable. Mr. Juergens and Patent Owner's expert, Dr. Sasian, have each authenticated Exhibits 2036-2039. Furthermore, there is no hearsay issue here because the results in Exhibits 2036-2039 are simply the output of Mr. Juergen's lens design. Similar to the way an algebraic function operates on inputs to generate outputs, the effect of the lens design on different field points is immutable. The lens design will always have the same effect on the same light originating from the same field point.

Petitioner has been afforded ample opportunity to verify the effect of Mr. Juergens' lens designs on light originating from *all* of the field points in the field width. Thus, Petitioner has not been prejudiced by its inability to take further depositions – Petitioner could have simply checked the effect of Mr. Juergens' lens designs on the entire field width instead of studiously omitting them from its reply brief and accompanying exhibits.

Accordingly, Petitioner's Motion to Exclude should be denied.

II. COUNTERSTATEMENT 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 for the first time how Petitioner's expert, Mr. Juergens, utilized optical design software to modify a prior art lens system to generate a lens system that falls within the scope of the claims under review. Subsequently, Patent Owner cross-examined Mr. Juergens to demonstrate that his 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). Moreover, Mr. Juergens' cross-examination testimony

Explore Litigation Insights

Docket Alarm provides insights to develop a more informed litigation strategy and the peace of mind of knowing you're on top of things.

Real-Time Litigation Alerts



Keep your litigation team up-to-date with **real-time alerts** and advanced team management tools built for the enterprise, all while greatly reducing PACER spend.

Our comprehensive service means we can handle Federal, State, and Administrative courts across the country.

Advanced Docket Research



With over 230 million records, Docket Alarm's cloud-native docket research platform finds what other services can't. Coverage includes Federal, State, plus PTAB, TTAB, ITC and NLRB decisions, all in one place.

Identify arguments that have been successful in the past with full text, pinpoint searching. Link to case law cited within any court document via Fastcase.

Analytics At Your Fingertips



Learn what happened the last time a particular judge, opposing counsel or company faced cases similar to yours.

Advanced out-of-the-box PTAB and TTAB analytics are always at your fingertips.

API

Docket Alarm offers a powerful API (application programming interface) to developers that want to integrate case filings into their apps.

LAW FIRMS

Build custom dashboards for your attorneys and clients with live data direct from the court.

Automate many repetitive legal tasks like conflict checks, document management, and marketing.

FINANCIAL INSTITUTIONS

Litigation and bankruptcy checks for companies and debtors.

E-DISCOVERY AND LEGAL VENDORS

Sync your system to PACER to automate legal marketing.