

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

---

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

**TABLE OF CONTENTS**

	<b><u>Page</u></b>
I. INTRODUCTION .....	1
II. STATEMENT OF MATERIAL FACTS .....	2
A. Mr. Juergens' Expertise in Past Versions of CODE V Software .....	2
B. Mr. Juergens' Optimization of His Calculations for Two Field Points .....	6
III. ARGUMENT .....	7
A. Patent Owner's Arguments Go to Weight, not Relevance .....	7
B. Federal Rule of Evidence 403 Has Limited Relevance to This Proceeding ...	9
C. Mr. Juergens' Opinion is Probative as to the Relevant State of the Art at the Time of Invention .....	11
IV. CONCLUSION .....	14

**TABLE OF AUTHORITIES**

	<b>Page(s)</b>
<b>Statutes</b>	
37 C.F.R. § 42.62(a).....	7
37 C.F.R. § 42.64(c).....	1
Federal Rule of Evidence 401.....	8
Federal Rule of Evidence 403.....	10, 11
Federal Rule of Evidence 802.....	2
Federal Rule of Evidence 901.....	2
 <b>Cases</b>	
<i>Abbott Labs. v. Alra Labs., Inc.</i> , Case No. 92-5806, 1997 U.S. Dist. LEXIS 16611 (N.D. Ill. Oct. 20, 1997).....	13
<i>Amazon.com, Inc. v. Barnesandnoble.com, Inc.</i> , 239 F.3d 1343 (Fed. Cir. 2001).....	12
<i>Ariad Pharms., Inc. v. Eli Lilly &amp; Co.</i> , 598 F.3d 1336 (Fed. Cir. 2010).....	12
<i>Comm. Union v. Boston Edison</i> , 591 N.E.2d 165 (Mass. 1992).....	13
<i>Donnelly Garment Co. v. NLRB</i> , 123 F.2d 214 (8th Cir. 1941).....	11
<i>Genentech, Inc. v. Trs. of the Univ. of Pa.</i> , 871 F. Supp. 2d 963 (N.D. Cal. 2010).....	12, 13
<i>Gnosis S.p.A. v. Merck &amp; CIE</i> , IPR2013-00117, Paper No. 71 (PTAB June 20, 2014).....	11

*Gulf States Utils. Co. v. Ecodyne Corp.*,  
635 F.3d 517 (5th Cir. 1981) ..... 10

*Kimberly–Clark Corp. v. Johnson & Johnson*,  
745 F.2d 1437 (Fed. Cir. 1984) ..... 12

*Lorraine v. Markel Am. Ins. Co.*,  
241 F.R.D. 534 (D. Md. 2007) ..... 13

*Schultz v. Butcher*,  
24 F.3d 626 (4th Cir. 1994) ..... 10

*Siemens AG v. Seagate Tech.*,  
369 F. App'x 118 (Fed. Cir. 2010)..... 12

*United States v. Preston*,  
706 F.3d 1106 (9th Cir. 2013) ..... 10

## I. INTRODUCTION

Petitioner Carl Zeiss SMT GmbH (“Zeiss”) now opposes Patent Owner Nikon’s Conditional Motion to Exclude Evidence Pursuant to 37 C.F.R. § 42.64(c) (Paper No. 32) in its entirety. Patent Owner seeks to exclude Exhibits 1036 and 1038-1049 (“the Challenged Exhibits”), arguing that these have no “probative value and no relevance to any issues raised by the parties *unless* Nikon’s Exhibits 2036-2039 are also included in the record.” (Paper No. 32 at 8) (emphasis added). In other words, Patent Owner’s Motion to Exclude is based on the convoluted proposition that the Challenged Exhibits lack probative value unless viewed through the lens of Patent Owner’s competing exhibits. In this way, Patent Owner’s presentation of this Motion as “Conditional” belies its merits; the presence of competing Exhibits in the action has no bearing on whether the Challenged Exhibits are relevant. Rather, each of Patent Owner’s arguments go to the *weight* of each Challenged Exhibit, not its relevance. As recognized by the Board in a recent Order, a Motion to Exclude is an improper forum for such arguments. Notably, Petitioner’s concurrently-filed Motion to Exclude (Paper No. 35) does not seek exclusion of Exhibits 2036-2039 on the basis of relevance.<sup>1</sup>

---

<sup>1</sup> Petitioner seeks to exclude Exhibits 2036-2039 on the bases of 1) lack of authentication under FRE 901, (2) as inadmissible hearsay under FRE 802, and 3) as untimely. (*See, e.g.*, Paper No. 35 at 1).

# 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.