

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CARL ZEISS SMT GMBH
Petitioner

v.

NIKON CORPORATION
Patent Owner

Case IPR2013-00363
Patent 7,348,575 B2

Before HOWARD B. BLANKENSHIP, SALLY C. MEDLEY, and
MATTHEW R. CLEMENTS, *Administrative Patent Judges*.

CLEMENTS, *Administrative Patent Judge*.

DECISION
ON REQUEST FOR REHEARING
37 C.F.R. § 42.71

I. INTRODUCTION

On December 27, 2013, Carl Zeiss SMT GmbH (“Petitioner”) filed a request for rehearing (Paper 10, “Req.”) of the Board’s decision (Paper 7, “Dec.”), dated December 16, 2013, which instituted *inter partes* review of claims 55-67 of Nikon Corporation’s (“Patent Owner”) U.S. Patent No. 7,348,575 B2 (Ex. 1101, “the ’575 patent”). The Board granted Petitioner’s petition filed June 17, 2013, an instituted *inter partes* review of (1) claims 55-63 and 65-67 under 35 U.S.C. § 102 as anticipated by Mann; and (2) claim 64 under 35 U.S.C. § 103 as obvious over Mann and Asai. Dec. 17. The Board denied all other asserted grounds as being redundant in light of the grounds for which review was instituted for the same claims. Dec. 18. Petitioner seeks reconsideration of the decision to deny institution on the following grounds:

1. Claims 55, 59, 60, 62, 63, and 65-67 as anticipated by Takahashi;
2. Claim 61 as obvious over Takahashi, Suwa, and Ulrich; and
3. Claim 64 as obvious over Takahashi and Asai.

For the reasons set forth below, the request for rehearing is *denied*.

II. STANDARD OF REVIEW

When rehearing a decision on institution, the Board will review the decision for an abuse of discretion. 37 C.F.R. § 42.71(c). An abuse of discretion may be determined 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. *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); and *In re Gartside*, 203 F.3d 1305, 1315-16 (Fed. Cir. 2000). The request must identify, with specificity, all matters that the moving party believes the Board misapprehended or overlooked. 37 C.F.R. § 42.71(d).

III. DISCUSSION

Petitioner argues that that the Board overlooked the reasons set forth in the Petition explaining why the grounds based on Takahashi are not redundant in view of the grounds based on Mann. Req. 3. Specifically, Takahashi is prior art under 35 U.S.C. § 102(b), whereas Mann is prior art under 35 U.S.C. § 102(e). As a result, it is possible that Patent Owner may antedate Mann. Petitioner argues that, if Patent Owner antedates Mann, the aforementioned non-instituted grounds will not be redundant to the instituted ground of anticipation by Mann because, without Mann, no other reference will be before the Board on which claims 55 and 59-67 could be found unpatentable. *Id.*

The Board is charged with securing the just, speedy, and inexpensive resolution of every proceeding and has the discretion to deny some grounds to ensure that objective is met. 37 C.F.R. §§ 42.1(b), 42.108(b). In our decision, we instituted *inter partes* review based on grounds covering all of the challenged claims, going forward on the grounds that the Board determined to be the most sufficient substantively. In that regard, the Board determined that Mann discloses more clearly the limitations of the challenged claims.

For example, Mann is alleged to anticipate claims 55-63 and 65-67, whereas Takahashi is alleged to anticipate only claims 55, 59, 60, 62, 63, and 65-67. Req. 4-5; *see also* Pet. 19-38. And none of Takahashi-based Grounds 4, 5, or 6 challenge claims 56, 57, and 58. In addition, Mann more clearly discloses “a third unit . . . comprising at least two negative lenses,” as recited in independent claim 55. Specifically, Mann discloses that “[I]ens element E7 is a *negative lens* . . . lens element E10 is a *negative lens*.” Ex. 1110 ¶ 0050 (emphasis added); *see also* Ex. 1116 (Juergens Decl.) ¶ 98. In contrast, Takahashi discloses that L31 and L32, which Petitioner contends are the recited “third unit,” are each a “negative *meniscus lens*.” Ex. 1114 ¶ 0090; *see also* Juergens Decl. ¶ 137. Similarly, Mann more clearly discloses “a fourth unit . . . comprising at least three positive lenses,” as recited in claim 55. For Mann, Petitioner identifies lens elements E11-E20 as the recited “fourth unit.” Mann discloses that “lens element E11 is a *positive lens*, lens element E12 is a negative lens, lens elements E13-E16 are *positive lenses*, lens element E17 is a negative lens, lens elements E18-E20 are *positive lenses*.” Ex. 1110 ¶ 0050 (emphasis added). For Takahashi, Petitioner identifies lenses L33-L38 (Pet. 35 (citing Ex. 1114, ¶¶ 0090-92, Table 2; Ex. 1116, ¶¶ 43, 46, 52, 139), which are described as:

a biconvex lens L33 having an aspherical convex surface set facing toward the wafer, an aperture stop AS, a biconvex lens L34 having an aspherical convex surface set facing toward the reticle, a *positive meniscus lens* L35 having a convex lens set facing toward the reticle side, a *positive meniscus lens* L36 having an aspherical concave surface set facing toward the wafer, a *positive meniscus lens* L37 having a convex lens set

facing toward the reticle and a biconvex lens L38 having an aspherical convex surface set facing toward the wafer.

Ex. 1114, ¶ 0090 (emphasis added). Thus, although Takahashi discloses two negative *meniscus* lenses and three positive *meniscus* lenses, Mann discloses literally “negative lenses” and “positive lenses,” as recited in the claim. As a result, Mann discloses more clearly the limitations of claim 55. For the reasons discussed above, we determine that Petitioner fails to demonstrate that the Board abused its discretion in not instituting *inter partes* review of (1) independent claim 55; (2) independent claims 63, 66, and 67, which incorporate claim 55 by reference; and (3) dependent claims 59, 60, 62, and 65.

CONCLUSION

Petitioner’s request for rehearing is *denied*.

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