

1                                    RECORD OF ORAL HEARING  
2                                    UNITED STATES PATENT AND TRADEMARK OFFICE  
3                                    -----  
4                                    BEFORE THE PATENT TRIAL AND APPEAL BOARD

5                                    -----  
6                                    CARL ZEISS SMT GmbH  
7                                    Petitioner  
8

v.

9                                    NIKON CORPORATION  
10                                    Patent Owner

11                                    -----  
12                                    Case IPR2013-00362 and IPR2013-00363  
13                                    Patent 7,348,575 B2  
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17                                    Oral Hearing Held: July 17, 2014  
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19                                    Before: SALLY C. MEDLEY, HOWARD B. BLANKENSHIP,  
20                                    MATTHEW R. CLEMENTS (via video conference), *Administrative*  
21                                    *Patent Judges.*  
22

                                  The above-entitled matter came on for hearing on  
23                                    Thursday, July 17, 2014 at the U.S. Patent and Trademark  
24                                    Office, 600 Dulany Street, Alexandria, Virginia at 1:00 p.m.,  
25                                    in Courtroom A.

1 APPEARANCES:

2 ON BEHALF OF THE PETITIONER:

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11 ON BEHALF OF THE PATENT OWNER:

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PROCEEDINGS

(1:00 p.m.)

JUDGE MEDLEY: Good afternoon. This is the hearing for IPR 2013-00362 and 00363 between Petitioner, Carl Zeiss and Patent Owner, Nikon.

Both cases involve the U.S. Patent 7,348,575, the '575 patent. Per the July 10th order that we sent out, each party will have 60 minutes of total time to present arguments for the two cases. Because the cases involve the '575 patent with somewhat similar issues, Petitioner, you will proceed first to present your case with respect to the challenged claims and grounds for which the Board instituted trial for both cases.

Thereafter Patent Owner, you will respond to Petitioner's presentation for both cases. And then, lastly, Petitioner, you may reserve rebuttal time to respond to Patent Owner's presentation with respect to both cases.

At this time we would like the parties to please introduce counsel for the Petitioner.

MR. GLITZENSTEIN: Good afternoon, Your Honors, Kurt Glitzenstein of Fish & Richardson for the Petitioner, Carl Zeiss.

MR. WEFERS: Marc Wefers, Fish & Richardson for Petitioner, Carl Zeiss.

JUDGE MEDLEY: And who will be presenting?

1 MR. GLITZENSTEIN: Your Honor, I will be.

2 JUDGE MEDLEY: Okay. Thank you. And for Patent  
3 Owner?

4 MR. KERN: Good afternoon, Your Honor, John Kern  
5 presenting for Patent Owner, Nikon Corporation.

6 JUDGE MEDLEY: Thank you.

7 MR. MATTSON: Good afternoon, Robert Mattson,  
8 Oblon Spivak for Patent Owner, Nikon Corporation. Mr. Kern  
9 will be presenting.

10 JUDGE MEDLEY: Okay. Thank you.

11 Petitioner, you may begin. And would you like to  
12 reserve rebuttal time?

13 MR. GLITZENSTEIN: I would, Your Honor.

14 I would like to reserve 25 minutes, please.

15 JUDGE MEDLEY: Okay.

16 MR. GLITZENSTEIN: May I proceed, Your Honors?

17 JUDGE MEDLEY: Yes.

18 MR. GLITZENSTEIN: May it please this Court, the  
19 issue with regard to the '362 IPR where I am going to begin  
20 this afternoon is an issue of obviousness, and in particular  
21 the issue of obviousness of combining Terasawa and what we  
22 have termed the immersion references.

23 Now, there are two separate and independent  
24 reasons why it would have been obvious to modify the Terasawa  
25 reference to include an immersion fluid between the boundary

1 lens and the wafer. Those two reasons are to increase the  
2 depth of focus and also, separately, to increase the  
3 numerical aperture or NA.

4 There was motivation in the prior art to do both  
5 and the prior art enabled both. This is not an unpredictable  
6 field. The field of optics is, in fact, highly predictable  
7 and highly deterministic.

8 There was nothing undue about any experimentation  
9 and none has been shown on this record. There is no  
10 enablement impediment to combining these references.

11 Turning first to the issue of depth of focus, the  
12 prior art in this case expressly discloses the desirability  
13 of using immersion to increase depth of focus, including in  
14 catadioptric systems, which are the types of systems recited  
15 in the specification claimed in claim 1 of the Omura patent.  
16 We see that in Nikon's own reference, the Fukami application,  
17 as well as Switkes, an article.

18 Nikon's expert in these IPRs, Dr. Sasian conceded  
19 that there was, in fact, motivation to modify the prior art  
20 in order to achieve an increased depth of focus. And, in  
21 fact, Nikon's position that a person of ordinary skill in the  
22 art would not have been motivated to use immersion in order  
23 to increase depth of focus cannot be squared with the  
24 testimony of its own expert, with the disclosure of its own  
25 patent application Fukami, and in fact, cannot even be

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