

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

PETITIONER'S REQUEST FOR REHEARING UNDER 37 CFR § 42.71(d)

I. BACKGROUND AND RELIEF REQUESTED

Petitioner, Carl Zeiss SMT GmbH (“Carl Zeiss”), requests rehearing of the Board’s Decision in Paper 7 (hereinafter the “Decision”) declining to institute a trial as to Grounds 4-6 identified at p. 6 of Carl Zeiss’ Petition (Paper 3) (hereinafter the “Petition”), which requests *inter partes* review (“IPR”) of claims 55-67 of U.S. Patent No. 7,348,575 B2 (“the Omura Patent”). In the Decision, the Board ordered a trial on the following grounds of unpatentability asserted in the Petition:

Ground 1: Claims 55-63 and 65-67 as anticipated by US 2005/0036213 (“Mann”); and

Ground 2: Claim 64 as obvious over Mann in view of Satori Asai et al., “Resolution Limit for Optical Lithography Using Polarized Light Illumination,” Jpn. J. Appl. Phys. Vol. 32, pp. 5863- 5866 (1993) (“Asai”).

The Board denied all other grounds as redundant. Decision at 16-17.

Carl Zeiss respectfully requests rehearing of the denial of a trial on the grounds that were not instituted involving WO 02/035273 (“Takahashi”).

Specifically, the grounds involving Takahashi are:

Ground 4: Claims 55, 59-60, 62-63, and 65-67 as anticipated by Takahashi;

Ground 5: Claim 61 as obvious over Takahashi in view of US 5,825,043

(“Suwa”) and Willi Ulrich et al., “The Development of Dioptric Projection Lenses for DUV Lithography,” Proc. SPIE Vol. 4832, pp. 158-169 (2002) (“Ulrich”); and

Ground 6: Claim 64 as obvious over Takahashi in view of Asai.

Carl Zeiss respectfully submits that the Board overlooked the express reasons set forth in the Petition explaining why the additional grounds are not redundant. Specifically, at pages 5-6 of the Petition, Carl Zeiss explained how Mann is only prior art under Section 102(e), whereas Takahashi is prior art under Section 102(b). On the other hand, the Petition explained that Mann is anticipatory for certain claims, whereas Takahashi does not anticipate these claims. Because it is possible that the Patent Owner (“Nikon”) could present evidence to antedate Mann and remove it as prior art, but this is not possible for Takahashi, the grounds based on Takahashi are not redundant in view of those based on Mann.

Conversely, because Mann anticipates certain claims that Takahashi does not, the grounds based on Mann are not redundant in view of those based on Takahashi.

This request is timely and does not require prior authorization from the Board under 37 C.F.R. § 42.71 (d). Granting this request will not require substantially more work or technical understanding by the Board than that for the grounds on which this case has already been instituted.

II. LEGAL STANDARDS

“When rehearing a decision on petition, a panel will review the decision for

an abuse of discretion.” 37 C.F.R. § 42.71 (c). The Board has held that to avoid a determination that a requested ground of review is redundant of another requested ground, a petitioner must articulate a meaningful distinction in terms of relative strengths and weaknesses with respect to application of the prior art reference disclosures to one or more claim limitations. *Scentair Technologies, Inc. v. Prolitec*, IPR2013-00180, Paper 18 at 3-4, *citing Liberty Mutual Ins. Co. v. Progressive Casualty Inc. Co.*, CBM2012-0003, Paper 7 at 2-12.

III. REASONS FOR THE RELIEF REQUESTED

The requested grounds relying on Mann are not redundant with the grounds relying on Takahashi. There is a meaningful distinction in the relative strengths of these references because Mann has a later prior art date than Takahashi and is prior art under a different section of 35 U.S.C. § 102 than Takahashi. Specifically, Mann has a filing date of Aug. 12, 2003, making it prior art to the Omura Patent under 35 U.S.C. § 102(e). Takahashi published on May 2, 2002, making Takahashi prior art to the Omura Patent under 35 U.S.C. § 102(b). Thus, it is possible that the Nikon could present evidence to antedate Mann and remove it as prior art, but this is not possible for Takahashi.

On the other hand, with respect to the claims of the Omura Patent for which Carl Zeiss requests IPR, the disclosure in Mann is better than that in Takahashi. Specifically, the disclosure in Mann is sufficient to anticipate claims 55-63 and 65-

67, whereas the disclosure in Takahashi is only sufficient to anticipate claims 55, 59-60, 62-63, and 65-67. In short, there is a meaningful distinction between Mann and Takahashi because Mann is stronger with respect to *what* it discloses, but Takahashi is stronger with respect to *when* it discloses what it discloses.

The Petition explained these distinctions when it set forth the various proposed grounds for rejection at pp. 4-6. For example, the Petition said:

Mann, Takahashi, and Omura ‘387 are not redundant. Mann has a later filing date than Takahashi and Omura ‘387 and is prior art under a different section of 35 U.S.C. § 102 than Takahashi and Omura ‘387. Furthermore, each of these references anticipates a different subset of the Challenged Claims relative to the others. For example, Mann anticipates certain claims (e.g., claim 61, requiring “a medium having a refractive index lager [sic] than 1.1 is interposed in an optical path between the lens nearest to the second surface, and the second surface”), while Takahashi and Omura ‘387 do not. Furthermore, Takahashi provides disclosure relevant to certain claims that is not expressly provided by Mann or Omura ‘387 (e.g., “developing the exposed photosensitive substrate”). On the other hand, Omura ‘387 provides additional disclosure that is relevant to certain other dependent claims (e.g., requiring a third reflecting mirror that “bend[s] the light into a direction toward the optical axis.”) Finally, because Zeiss cannot know what rebuttal arguments Nikon will make, we respectfully submit that using three primary references is not contrary to securing “the just, speedy, and inexpensive resolution” of this proceeding required by 37 C.F.R. § 42.1(b).

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