

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CORNING INCORPORATED
Petitioner

v.

DSM IP ASSETS B.V.
Patent Owner

Case IPR2013-00043 (Patent 7,171,103)
Case IPR2013-00044 (Patent 6,961,508)
Case IPR2013-00045 (Patent 6,339,666)
Case IPR2013-00046 (Patent 6,110,593)
Case IPR2013-00047 (Patent 6,438,306)
Case IPR2013-00048 (Patent 6,298,189)
Case IPR2013-00049 (Patent 6,298,189)
Case IPR2013-00050 (Patent 6,323,255)
Case IPR2013-00052 (Patent 7,276,543)¹

Before GRACE KARAFFA OBERMANN, JENNIFER S. BISK, and
SCOTT E. KAMHOLZ, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

¹ This Decision addresses issues that are identical in nine of the ten related cases (the Request for Rehearing at issue in this decision was not filed in IPR2013-00053). We therefore exercise our discretion to issue one Order to be filed in each of the nine cases. The parties are not authorized to use this style heading for any subsequent papers.

DECISION
Request for Rehearing
37 C.F.R. § 42.71(d)

Corning filed a Motion for Discovery on October 7, 2013. On October, 16, 2013, the Board entered a decision denying that motion. On October 30, 2013, Corning filed a Request for Rehearing. Upon consideration of the information presented, we grant the Request for Rehearing in part, and to the extent set forth below.

We are persuaded that Corning is entitled to production of the following categories of documents:

(1) Documents identifying wet film thickness for cure dose testing performed by DSM employees and the results relied upon by DSM expert witnesses;

(2) Documents illustrating the GPC assignments of the different oligomer blocks (mono, di-,tri-,etc.) about which Dr. Bowman testifies, for the several oligomers made by DSM employees and the GPC analyses of those oligomers relied upon by Dr. Bowman;

(3) Documents illustrating the results of DSM's water soak delamination test, for the water soak delamination testing performed by DSM employees and the results relied upon by DSM expert witnesses; and

(4) Documents illustrating the pull-out friction test identifying normal force required, about which Dr. Taylor testifies, for the pull-out friction testing performed by DSM employees and the results relied upon by Dr. Taylor.

In view of the information set forth in the Request for Rehearing, DSM is instructed to conduct a reasonable search for all documents falling within the above four categories, and serve Corning all discoverable

documents not already produced, falling within the above four categories, by November 5, 2013. By November 6, 2013, counsel for DSM is directed to file a certification with the Board attesting that, upon reasonable search and inquiry, all discoverable documents falling within the above four categories have been produced or that such documents do not exist.

Accordingly, it is hereby:

ORDERED that Corning's Request for Rehearing is *granted* as to the four categories of documents identified in this Decision;

FURTHER ORDERED that DSM must serve Corning the discoverable documents identified in this Decision by November 5, 2013;

FURTHER ORDERED that DSM's counsel shall file a certification as described in this Decision by November 6, 2013; and

FURTHER ORDERED that Corning's Request for Rehearing is *denied* as to all other requests for discovery.

PETITIONER:

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