

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDMUND OPTICS, INC.,
Petitioner,

v.

SEMROCK, INC.,
Patent Owner.

Case IPR2014-00599
Patent 7,119,960 C1

Before WILLIAM A. CAPP, TRENTON A. WARD, and
DAVID C. McKONE, *Administrative Patent Judges*.

CAPP, *Administrative Patent Judge*.

DECISION
Denying Patent Owner's Request for Rehearing
37 C.F.R. § 42.71

Semrock filed a Request for Rehearing (Paper 12, October 3, 2014, “Request”) of the Board’s Decision (Paper 9, September 19, 2014, “Decision”), instituting *inter partes* review of claims 33–36, 39–41, 44, and 45 of Semrock’s Patent 7,119,960 (the “’960 patent”). Semrock contends that we misapprehended the Specification’s discussion of the “performance characteristics of the inventive laser line filters” and that, by instituting *Inter Partes* Review based on such misapprehension, we committed clear legal error that amounts to an abuse of discretion. Request 1.

When rehearing a decision on petition, a panel will review the decision for an abuse of discretion. *See* 37 C.F.R. § 42.71(c). The burden of showing a decision should be modified is on the party challenging the decision. *See* 37 C.F.R. § 42.71(d). Semrock has not sustained its burden and the Request is denied.

ANALYSIS

Semrock’s Request reargues that claims 33–36, 39–41, 44, and 45 of the ’960 patent are limited to thin-film laser line filters that use hard, as opposed to soft, coating materials. Request 1–5; Pet. 10–12. Semrock’s Request states that the Decision misapprehends its argument in the Preliminary Response that the scope of the claims is limited to hard coating materials through claim scope disavowal in the Specification. Request 1–5.

In the request, Semrock argues that references to “inventive laser-line filters” in the Specification should be construed as a disclaimer that limits the claims at issue to hard coatings. Request 1–3. Semrock relies on *Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1341 (Fed. Cir. 2001), for the proposition that a particular feature is deemed

to be outside of the reach of the claims of the patent where the specification makes clear that the invention does not include such feature. Request 2.

We agree with the general proposition expressed in *Scimed* that claim scope may be disclaimed where the specification makes clear that the invention does not include a particular feature. However, Semrock's argument that the data recited in Table 2 limits the claims to hard coating materials is not persuasive. Request 5, *citing* Ex. 1001, 20:45-46; 21:1-23. We have reviewed Table 2 and the recited passages in the Specification and are not persuaded that they "make clear" that the invention is limited to hard coating materials. As discussed in the Decision, the Specification acknowledges that thin-film laser-line filters can be based on hard or soft coatings. Decision 5, *citing* Ex. 1001, 4:28-32. Furthermore, as discussed in the Decision, "it is *not clear* from the Specification as to how the inventor intends to distinguish one embodiment from all other possible embodiments that may share similar features." Decision 6-7 (emphasis added).

In sum, *Scimed* only requires disclaimer where the specification "makes clear" that the invention does not include a particular feature. *Scimed* at 1345. As we pointed out in the Decision, Semrock's Specification does not make "clear" that the invention excludes soft coatings.

CONCLUSION

Semrock's Request is denied.

IPR2014-00599
Patent 7,119,960 C1

For Petitioner:

Lynn E. Rzonca
Daniel A. Nadel
John Chionchio
BALLARD SPAHR LLP
rzoncal@ballardspahr.com
nadeld@ballardspahr.com
chionchioj@ballardspahr.com

For Patent Owner:

James Boyle
Anthony Lombardi
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER, LLP
james.boyle@finnegan.com
anthony.lombardi@finnegan.com