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Paper 50
Entered: September 9, 2015

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

EDMUND OPTICS, INC.,
Petitioner,

v.

SEMROCK, INC.,
Patent Owner.

Case IPR2014-00583
Patent 7,068,430 C1

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

CAPP, *Administrative Patent Judge.*

FINAL WRITTEN DECISION
35 U.S.C. § 318(a) and *37 C.F.R. § 42.73*

Edmund Optics, Inc. ("Edmund") filed a Petition (Paper 1, "Pet.") requesting *inter partes* review of claims 1, 18, 21, 26, 27, 30, and 34–41 of US Patent 7,068,430 C1 (Ex. 1001, the "'430 patent"). We instituted an *inter partes* review of claim 1 of the '430 patent. Paper 9. After institution of trial, Semrock, Inc. ("Semrock") filed a Patent Owner's Response (Paper 18, "PO Resp.") and Edmund filed a Reply (Paper 24, "Reply"). This case is before the Board for a Final Written Decision following an Oral Hearing on the merits conducted May 21, 2015, the transcript for which is entered as Paper 49. ("Tr.").

Also before the Board are the following matters:

1. Edmund's Motion to Exclude Evidence (Papers 42, 45, 47)

2. Semrock's Contingent Motion to Amend (Papers, 19, 25, and 29); and

3. Edmund's Objection to the scope of Semrock's Reply to Petitioner's Opposition to Patent Owner's Contingent Motion to Amend (Paper 34).

After considering the evidence and arguments of counsel and for the reasons set forth below, we determine that Edmund has NOT met its burden of showing, by a preponderance of the evidence, that claim 1 of the '430 patent is unpatentable.

I. BACKGROUND

A. The '430 patent (Ex. 1001)

The '430 patent, titled Method of Making Highly Discriminating Optical Edge Filters and Resulting Products, relates to making optical filters that block unwanted light and are used in Raman spectroscopy and fluorescence microscopy. Ex. 1001, 1:22–28. The patent discloses optical

edge filters with alternating layers of material disposed over a transparent substrate and where the thickness of the various layers affects the performance of the filter. *Id.* at claim 18; 3:14–28. There are four aspects to the invention: A) an apparatus programmed to make improved optical edge filters; B) a method of making the improved filters; C) improved filters made by the method; and D) applications of the improved filters. *Id.* at 6:4–9.

In the claimed method, a data processor receives deposition rate data as an input. *Id.* at 8:24–25. The data processor calculates a theoretical transmission of light through a layer of the filter. *Id.* at claim 1. For at least some layers, the data processor calculates an expected time for deposition of material to achieve the desired thickness related to the desired optical properties of a layer. *Id.* at 9:24–26. For these layers, their deposition durations are controlled using an expected deposition time based on a designed thickness and deposition rate. *Id.* For other layers, deposition duration is controlled by optically monitoring transmission levels through the layer. *Id.* at 9:19–23. The data processor determines which layers are optically monitored and which layers are timed using an expected deposition time. *Id.* at 9:26–29.

According to the Specification, the invention achieves edge steepness in optical filters of less than about 0.8%. *Id.* at 14:23–27. The Specification states that the steepness of edge slope achieved by the invention "permits return of response wavelengths closer to excitation wavelength providing an increase in the information content of the returned response, and that the reduction in transmission loss means that the enhanced information return response will be at higher brightness." *Id.* at 16:46–51. Furthermore, the

Specification describes that the greater hardness and durability of the filters permits a more robust and versatile optical analytical instrument. *Id.* at 16:51–54.

B. Challenged Claim and Instituted Ground of Unpatentability

We instituted an *inter partes* review on Edmund's challenge to claim 1 of the '430 patent as anticipated by Starke (Ex. 1003[1]). Decision on Institution (Paper 29), 33. Edmund supports its challenge with declaration testimony from Angus Macleod (Ex. 1011) and Uwe Schallenberg (Ex. 1012). Claim 1, an independent claim, is reproduced below:

> 1. A method of manufacturing an optical filter by determining when deposition of a layer of the optical filter is to terminate, the method comprising:
>
> calculating, with a data processor, a theoretical transmission T_i of light through the layer;
>
> calculating, with the data processor, an expected deposition time t_i of the layer,
>
> measuring, during deposition of the layer for a period less than t_i, a measured transmission T_m of light through the layer;
>
> determining, with the data processor, when deposition of the layer is to terminate based upon the theoretical transmission T_i and the measured transmission T_m.

II. CLAIM INTERPRETATION

In its Petition, Edmund stated that the terms of claim 1 do not require construction and should be afforded their ordinary and customary meaning. Pet. 5. In its Patent Owner Response, Semrock proposes a construction for

[1] Starke et al., *Rapid Prototyping of Optical Thin Film Filters*, 4094 PROC. OF SPIE 83–92 (2000).

"expected deposition time t_i of the layer." PO Resp. 7–11. Semrock also proposes a construction for "measuring during deposition for a period less than t_i, a measured transmission T_m." PO Resp. 11–16. In its Reply, Edmund proposes a competing construction for each term. Reply 3–11.

1. "expected deposition time t_i of the layer"

Edmund's proposed construction:

a calculated prediction of when to expect deposition to cease.

Semrock's proposed construction:

total expected time to deposit the layer.

The difference between Semrock's proposed construction and Edmund's proposed construction is that Semrock's proposed construction contemplates calculating t_i one time for each layer based on the design thickness of the entire layer. In contrast, Edmund's proposed construction contemplates an iterative process whereby t_i is periodically recalculated during deposition of the layer based on progressive changes in the thickness of the layer at different points in time during deposition.

Semrock maintains that "the layer" in the disputed phrase finds antecedent basis in the preamble of claim 1. Semrock argues that "the layer" refers to an entire layer and that expected deposition time t_i, therefore, refers to the amount of time required to deposit the entire layer. PO Resp. 9. Semrock relies on *Varco LP v. Pason Systems USA Corp.*, 436 F.3d 1368, 1373 (Fed.Cir. 2006), to support an argument that its proposed construction is necessary to remain consistent with the preamble of the claim.

Semrock directs our attention to specific passages in the specification as supporting its proposed construction. *Id.* For example, Semrock directs our attention to the following passage:

> The expected deposition time t_i for layer *i* is calculated as the desired thickness d_i divided by estimated deposition rate r_i for the layer or from an average of the rates of the previous layers of like material at 507.

PO Resp. 9–10; Ex. 1001, 9:58–60. Also, for layers that are not optically monitored: "their deposition durations are controlled using an expected deposition time t_i based upon designed ("theoretical") thickness d_i and deposition rate r_i. Ex. 1001, 9:24–26. Semrock argues that the expected deposition time must be the total expected time for deposition of an entire layer. PO Resp. 10–11.

Edmund argues that claim 1 merely requires a calculated prediction of when to expect deposition to cease. Reply 3. In other words, it is the estimated remaining duration to deposit the layer, which can be calculated after the system begins to deposit the layer. Edmund argues that expected deposition time need only be longer than the period during which optical monitoring measurements are taken, as such measurements are used to calculate the remaining deposition duration. *Id.* at 3–4. Edmund argues that the specification equates the expected deposition time t_i of the layer with the expected remaining deposition duration for the layer. *Id.* at 6. Edmund argues that since the expected deposition time t_i "may" be calculated prior to beginning of actual deposition, calculation may occur either before or after deposition of the layer begins. *Id.* at 4. Edmund supports its proposed construction with declaration testimony from its expert, Professor MacLeod. Reply 3; Ex. 1022 ¶¶ 21–23.

The patentability analysis is a two-step process: first, the claim scope is determined in accordance with the principles of claim construction and second, the properly construed claim is compared to the prior art. *See Amazon.com, Inc. v. Barnesandnoble.com, Inc*., 239 F.3d 1343, 1351 (Fed. Cir. 2001). Semrock's contention as to why claim 1 does not read on Starke for purposes of an anticipation analysis is largely a matter of claim construction.

In an *inter partes* review, claims are given their broadest reasonable interpretation consistent with the specification. *See* 37 C.F.R. § 42.100(b); *In re Cuozzo Speed Techs., LLC*, 793 F.3d 1268, 1278–79 (Fed. Cir. 2015). Within this framework, terms generally are given their ordinary and customary meaning. *See In re Translogic Tech., Inc*., 504 F.3d 1249, 1257 (Fed. Cir. 2007). The "ordinary and customary meaning of a claim term" is that meaning that a person of ordinary skill in the art in question, at the time of the invention, would have understood the claim to mean. *Id*.; *accord Phillips v. AWH Corp*., 415 F.3d 1303, 1313 (Fed.Cir. 2005). The Federal Circuit admonishes us that the Board's construction cannot be divorced from the specification and the record evidence. *See Microsoft Corp. v. Proxyconn, Inc*., 789 F.3d 1292 (Fed. Cir. 2015). Rather, "claims should always be read in light of the specification and teachings in the underlying patent." *Id*. at 1298. Thus, a construction that is "unreasonably broad" and which does not "reasonably reflect the plain language and disclosure" will not pass muster. *See id*.

At the outset, we have considered the claim construction testimony of both Patent Owner's Declarant, Dr. Rancourt, and Petitioner's Declarant, Professor MacLeod. We note, however, that "conclusory, unsupported

assertions by experts as to the definition of a claim term are not useful to a court." *Phillips*, 415 F.3d at 1318.[2] In the instant case, the experts' testimony does little more than repeat, without citation to additional evidence, the conclusory arguments of their respective counsel. Thus, we focus primarily on the intrinsic record to construe the term at issue. *Id.* ("extrinsic evidence in general is less reliable than the patent and its prosecution history in determining how to read claim terms").

A claim construction analysis begins with, and is centered on, the claim language itself. *See Interactive Gift Express, Inc. v. Compuserve, Inc.*, 256 F.3d 1323, 1331 (Fed.Cir. 2001). In the instant case, claim 1 is directed to a method of manufacturing an optical filter by determining when deposition of the layer of the optical filter is to terminate. Ex. 1001, claim 1 preamble. Aspects of time or temporal duration appear in three limitations of the claim:

(1) calculating . . . an expected deposition time t_i;
(2) measuring . . . for a period less than t_i; and
(3) determining . . . when deposition . . . is to terminate.

Ex. 1001, claim 1. The first two instances where time is mentioned in the claim, it is in reference to expected deposition time or "t_i". We note that, in these two specific instances, the claim element "t_i" is recited. The third

[2] "[E]xpert testimony can be useful to a court for a variety of purposes, such as to provide background on the technology at issue, to explain how an invention works, to ensure that the court's understanding of the technical aspects of the patent is consistent with that of a person of skill in the art, or to establish that a particular term in the patent or the prior art has a particular meaning in the pertinent field." *Phillips*, 415 F.3d at 1318. In the instant case, the expert testimony relied upon by each of the parties provides no such assistance to the Board.

mention of time relates to determining "when the deposition of the layer is to terminate." In this third instance, there is no corresponding express association with "t_i ".

We turn now to the patent specification, which is always relevant, usually dispositive, and the single best guide to the meaning of a disputed term. *See In re Abbott Diabetes Care Inc.*, 696 F.3d 1142, 1149 (Fed. Cir. 2012) (quoting *Phillips*, 415 F.3d at 1315). The '430 patent divides the layers of an optical filter into two categories: (1) layers that are optically monitored during manufacture; and (2) layers that are not optically monitored.

> the data processor 414 determines which layers are to be optically monitored and which layers are to be timed using an expected deposition time.

Ex 1001, 9:27–29; *see also id.* at 9:30–10:6.

Layers that are not optically monitored have their deposition terminated at the expiration of t_i. *Id.* at 10:1–4. The specification explains that t_i is calculated as a function of designed (theoretical) thickness and deposition rate.

> For layers that are predicted to have little error between the designed thickness d and a simulated actual thickness, deposition duration is controlled by optically monitoring transmission levels T_m through the layer during deposition. For the other layers, their deposition durations are controlled using an expected deposition time t_i based upon designed ("theoretical") thickness d_i and deposition rate r_i.

Id. at 9:19–26.

In view of the foregoing, with respect to layers that are not optically monitored, t_i has a fixed and unambiguous meaning. Namely, it is the expected deposition time for an entire layer and is calculated with respect to

the designed thickness of the entire layer and expected deposition rate applicable to deposition of an entire layer. This follows from explanation in the specification that the thickness parameter in the calculation is the designed, or theoretical, thickness of the entire layer as opposed to a measured or derived intermediate thickness determined sometime during the deposition process.

We now turn to whether t_i has an alternative, broader meaning when used in connection with optically monitored layers. The specification explains that if a current layer is to be optically monitored, the actual transmission T_m is measured as a function of actual time transpired *t*. *Id.* at 10:7–9. This continues until about 95% of t_i has elapsed. *Id.* at 10:7–12. At this time (95% of t_i), a "new deposition duration" is calculated. *Id.* This calculated "new deposition duration" is never referred to in the specification as "t_i".

From this disclosure, we conclude that the t_i referred to in line 10 of column 10 is the same t_i referred to in connection with layers that are not optically monitored. If, as Edmund contends, t_i represents an estimated remaining time until deposition is terminated and is calculated repeatedly and intermittently reset during deposition, the time represented by t_i becomes a moving target and the time represented by 95% of t_i becomes increasingly smaller until it approaches and becomes essentially equal to the "new deposition time" identified in line 11 as the time difference between a hypothetical continually recalculated t_i and a "new deposition time" approaches zero. *See* Ex. 1001, 10:11.

We think the better interpretation is that the t_i identified in line 11 is a different and distinct time from the "new deposition duration" identified

later in the same line of the specification. In other words, for optically monitored layers, t_i is calculated one time at or before commencement of deposition of an optically monitored layer. Another time, represented by 95% of t_i is then calculated one time such that it becomes a fixed moment in time for initiation of a calculation of a "new deposition duration." Thus, based on our review of the specification, the term "expected deposition time t_i" has the same meaning for layers that are optically monitored and layers that are not optically monitored.

In view of the foregoing, we construe "expected deposition time t_i of the layer" to mean a time based upon the designed ("theoretical") thickness d_i and deposition rate r_i where the designed thickness d_i represents the thickness of an entire layer, not a portion thereof.

2. "measuring during deposition for a period less than t_i, a measured transmission T_m"

Semrock's proposed construction:

continually ascertaining during deposition throughout a period less than t_i, a measured transmission T_m

Edmund's proposed construction:

a sufficient number of measurements are taken in order to generate a suitable transmission curve for the layer

The parties' dispute centers on the frequency with which measurements are taken during the deposition period. Semrock contends that measurements are taken "continually." Semrock contends that its proposed construction represents the plain meaning of the term, however, Semrock provides no cogent explanation of what it means to measure "continually." PO Resp. 13–16. Semrock does not identify any language in

the specification that discloses how long it takes to complete a "measurement." Semrock does not identify any particular number of measurements that are needed. Neither does Semrock identify any language in the specification that specifies a minimum frequency for taking measurements or that delineates the permissible length of an interlude between taking measurements, if any. Semrock merely argues that transmission measurement produces a measured curve of T_m vs. t until about 95% of t_i has elapsed. PO Resp. 15 (citing Ex. 1001, 13:24–28). Semrock argues that such disclosure indicates that measurement occurs continually through the time period ending at 95% of the expected deposition time t_i, otherwise it would not be possible to produce a curve. PO Resp. 15.

Edmund contends that the broadest reasonable interpretation requires only that a sufficient number of measurements be taken in order to generate a suitable transmission curve for the layer. Reply 7. We agree. Claim 1 requires that the data processor determines when deposition of the layer is to terminate based on the theoretical transmission T_i and the measured transmission T_m. Ex. 1001, claim 1. The claim does not require that any particular number of transmission measurements T_m must be taken for the data processor to make its determination. Neither does the specification teach that the measurements be taken at any particular interval. Thus, any number of measurements that are sufficient to permit the data processor to determine when deposition of the layer is to terminate satisfies the claim limitation.

Thus, we construe "*measuring during deposition for a period less than t_i, a measured transmission T_m.*" to mean "a sufficient number of

measurements are taken in order to determine, with a data processor, when deposition of the layer is to terminate."

III. ANTICIPATION BY STARKE

To anticipate a patent claim under 35 U.S.C. § 102, "a reference must describe . . . each and every claim limitation and enable one of skill in the art to practice an embodiment of the claimed invention without undue experimentation." *Am. Calcar, Inc. v. Am. Honda Motor Corp.*, 651 F.3d 1318, 1341 (Fed. Cir. 2011) (citing *In re Gleave*, 560 F.3d 1331, 1334 (Fed. Cir. 2009)). Anticipation of a patent claim is a question of fact. *See In re Montgomery*, 677 F.3d 1375, 1379 (Fed. Cir. 2012). As the party challenging the patentability of claim 1, Edmund bears the burden of proving anticipation by a preponderance of the evidence. *See* 35 U.S.C. § 316(e).

Whether a patent is anticipated is a two-step inquiry. *Power Mosfet Tech., LLC. v. Siemens AG*, 378 F.3d 1396, 1407 (Fed.Cir. 2004). The first step requires construction of the claims. *See id*. The second step in the analysis requires a comparison of the properly construed claim to the prior art. *See id*.

Starke describes an ion beam sputtering coating process for the automated fabrication of optical coatings. Ex. 1003, 83. Starke discloses that several procedures and devices are commonly used in the coating industry for layer thickness control. *Id.* Starke discloses that single-wavelength optical monitoring devices are commercially available. *Id.*

Starke discloses an optical monitoring system that includes a data acquisition and processing environment known as LabVIEW. *Id.* at 85. During deposition, the LabVIEW program triggers a spectrophotometer to

perform transmittance measurements. *Id.* at 86. After plotting the actual thickness of a layer against the measurement time, the actual coating rate is computed for estimation of the remaining coating duration. *Id.*

Edmund furnishes a claim chart that purports to read all of the limitations of claim 1 onto Starke. Pet. 23–33. Edmund supports its contentions with declaration testimony from Professor MacLeod and Uwe Schallenberg. Ex. 1017 ¶¶ 53–54; Ex. 1018 ¶¶ 51–54. Semrock argues that Starke fails to satisfy two limitations of claim 1: (1) the "measuring, during deposition . . ." limitation; and (2) the "calculating . . . an expected deposition time t_i" limitation.

A. The "Measuring, During Deposition . . ." Limitation

Semrock argues that Starke does not measure "continually" during deposition. PO Resp. 19–20. Semrock contends that Starke rotates a filter substrate intermittently into and out of a measurement beam and that measurements are only taken when the substrate is rotated into position in the measurement beam. *Id.* According to Semrock, because the measurements are only taken intermittently when the substrate is rotated into position, the measurements are not taken "continually." *Id.* Semrock argues that measurements must be taken "continually" to satisfy the claim language. *Id.*

Edmund argues that the claim language is satisfied by the taking of periodic, intermittent measurements during deposition. Reply 12–15. We agree.

The dispute between Semrock and Edmund over this limitation is a matter of claim construction. According to our construction, the claim language is satisfied by periodic, intermittent measurements during

deposition, provided that they are sufficient in number to permit a data processor to determine when deposition of the layer is to terminate. Starke deposits coating material on substrates that are rotated into and out of a measurement beam. Ex. 1003, 85. Measurements are taken "during each rotation cycle" until there is less than 15 seconds remaining in a deposition cycle. *Id.* Deposition is then terminated based on a calculated duration of time.

> After plotting the actual thickness against the measurement time, the actual coating rate is computed for the estimation of the remaining coating duration. If this remaining time is shorter than 15 seconds, the program waits until it terminates the actual layer and changes the coating material if needed.

Ex. 1003, 86.

In view of the foregoing, Edmund has demonstrated that this claim limitation is satisfied by Starke.

B. The "Expected Deposition Time t_i" Limitation.

Semrock argues that Starke fails to disclose "calculating . . . an expected deposition time t_i of the layer." PO Resp. 17. Semrock argues that Starke first determines the thickness of a layer that is already in the process of being deposited, compares that intermediate/in-process thickness with a time to determine a deposition rate, and then uses that information to compute an estimated remaining coating duration. PO Resp. 17–18.

Edmund concedes that Starke does not start calculating the remaining deposition time until after deposition has commenced. Tr. 13 ("It is after deposition"). Edmund relies on the fact that Starke calculates estimated remaining deposition time during deposition as satisfying the claim limitations directed to "expected deposition time t_i." Reply 11.

Edmund's position on whether Starke calculates an "expected deposition time t_i" is predicated on the Board adopting Edmund's proposed claim construction. We do not adopt that construction. Starke's system depends on taking optical monitoring transmission measurements after deposition has commenced. Edmund fails to identify any disclosure in Starke that a data processor calculates an expected deposition time t_i based on the design thickness of an entire layer. Thus, Starke does not satisfy the limitation directed to calculating an "expected deposition time t_i" as we have construed that limitation.

"Anticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548 (Fed. Cir. 1983). Inasmuch as Starke fails to disclose all elements of claim 1, we find that Edmund has failed to establish, by a preponderance of the evidence, that Starke anticipates claim 1.

IV. EDMUND'S MOTION TO EXCLUDE EVIDENCE

Edmund moves the Board to exclude the following testimony of the parties' respective experts, Professor MacLeod and Dr. Rancourt:

1. Exhibit 2008, a deposition transcript of Professor MacLeod, taken in IPR2014-00599 (the '599 case) on April 7, 2015;
2. Exhibit 2013, an excerpt from the declaration testimony of Professor MacLeod, originally submitted by and on behalf of Edmund in the '599 case;
3. Exhibit 2009, 90:3–21, deposition testimony of Professor MacLeod;
4. Exhibit 2010 ¶¶ 32–34, declaration testimony by Dr. Rancourt; and
5. Exhibit 2010 ¶¶ 36–37, declaration testimony by Dr. Rancourt.

A. MacLeod's Deposition Testimony from the '599 Case

Edmund seeks to exclude cross-examination testimony elicited from its own expert, Professor MacLeod, in a different, but related, *inter partes* review. Edmund argues that it is improper to take cross-examination testimony obtained in one case and then use it another case. Edmund also argues that the cross-examination exceeds the scope of direction examination. Paper 45. The testimony in question goes to an issue of claim construction. We have previously explained that our claim construction in this case is based primarily on the intrinsic record and that the parties' proffered expert testimony is neither needed nor helpful in assisting our claim construction efforts.[3]

Nevertheless, we DENY Edmund's motion to exclude Professor MacLeod's Exhibit 2008 deposition testimony, but afford the testimony little weight.

B. MacLeod's Declaration Testimony from the '599 Case

Edmund seeks to exclude Exhibit 2013, an excerpt from Professor MacLeod's declaration testimony in the '599 case, among other things, on the grounds of relevancy. Semrock did not cite to this declaration testimony in its Patent Owner's Response. In opposing Edmund's motion to exclude, Semrock did not explain the relevancy of this testimony. The relevance of this testimony is not readily apparent to us.

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[3] We are not, however, inclined to adopt a blanket rule that cross-examination testimony obtained in one case can never be used in another case. For example, it may permissible, in an appropriate situation, to impeach a witness with a prior inconsistent statement made in another proceeding.

Nevertheless, we DENY the motion to exclude Professor MacLeod's Exhibit 2013 declaration testimony, but afford such testimony little weight.

C. MacLeod's Exhibit 2009 Deposition Testimony

Edmund seeks to exclude cross-examination of its own expert, Professor MacLeod taken in the instant *inter partes* review. Paper 42, 4–6. Edmund contends that Professor MacLeod does not understand the legal significance of the term "disclosed" in a patent lawsuit. Edmund argues that the term "disclose" has a separate, distinct, and specialized meaning in patent litigation than in other contexts in the English language. *Id.*

Professor MacLeod is an expert witness, hired by Edmund, among other things, to give expert testimony on whether certain patent claim limitations are disclosed in the prior art. Professor MacLeod uses the word "disclose," or variations thereof, more than 50 times in his initial declaration submitted in support of Edmund's Petition. *See* Exhibit 1017. Edmund does not explain how the meaning of the word "disclose" is materially different when used by Professor MacLeod in his declaration as compared to his challenged deposition testimony.

Edmund's Motion to Exclude testimony from Exhibit 2009 is DENIED.

D. Dr. Rancourt's Declaration Testimony

1. Ex. 2010 ¶¶ 32–34.

Edmund moves to exclude this testimony as an improper attempt to rehabilitate a witness following cross-examination. Edmund contends that, after Dr. Rancourt, was cross-examined during his deposition, any attempt to rehabilitate him as a witness should have been accomplished by re-direct

examination during the deposition rather than through subsequent declaration testimony.

In the instant case, Edmund concedes that Semrock did not cite or otherwise rely on this testimony in its briefs. We accord this testimony little, if any weight, but otherwise DENY Edmund's Motion to Exclude paragraphs 32–34.

2. Exhibit 2010 ¶¶ 36, 37

Edmund seeks to exclude declaration testimony of Dr. Rancourt, Semrock's expert, directed to an issue of claim construction. The challenged testimony of Dr. Rancourt is expert opinion testimony. In paragraphs 36 and 37, Dr. Rancourt expresses an observation and opinion on certain expert testimony that Edmund elicited from its own expert, Professor MacLeod, in the '599 case. Edmund seeks its exclusion as hearsay. Paper 42, 2–4. However, Edmund has not shown that Dr. Rancourt's statements, in the first instance, constitute hearsay. *See* Fed. R. Evid. 801(d)(2)(D).

We have previously explained that our claim construction in this case is based primarily on the intrinsic record and that the parties' proffered expert testimony is neither needed nor helpful in assisting our claim construction efforts. Thus, we accord Dr. Rancourt's challenged testimony little or no weight, but otherwise, DENY Edmund's motion to exclude the paragraph 36, 37 declaration testimony.

V. SEMROCK'S CONTINGENT MOTION TO AMEND

Semrock moved to amend claim contingent upon a finding of unpatentability of claim 1. Paper 19, 1. Inasmuch as we find that Edmund

has failed to establish that claim 1 is unpatentable, we do not reach Semrock's Contingent Motion to Amend.

VI. EDMUND'S OBJECTION TO THE SCOPE OF SEMROCK'S REPLY TO PETITIONER'S OPPOSITION TO PATENT OWNER'S CONTINGENT MOTION TO AMEND

Inasmuch as we do not reach Semrock's Contingent Motion to Amend, we DISMISS Edmund's Objection to the scope of Semrock's Reply to Petitioner's Opposition to Patent Owner's Contingent Motion to Amend as MOOT.

VII. ORDER

In view of the foregoing, it is ORDERED that Claim 1 of US Patent 7,119,430 C1 has not been shown to be unpatentable as anticipated by the Starke. This is a Final Written Decision under 35 U.S.C. § 318(a). Parties to the proceeding seeking judicial review of the decision must comply with the notice and service requirements of 37 C.F.R. § 90.2.

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