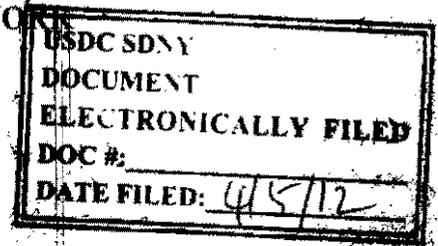


HECKER 1/5/12

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK



----- x

ANVIK CORPORATION, :

Plaintiff, :

v. :

NIKON PRECISION, INC., et al., :

LG.PHILIPS LCD CO., LTD., et al., :

SAMSUNG ELECTRONICS AMERICA, INC., et al., :

CHI MEI OPTOELECTRONICS, et al., :

AU OPTRONICS CORP., et al., :

SHARP CORP., et al., :

INNOLUX DISPLAY CORP., :

HANNSTAR DISPLAY CORP., :

AFPD PTE LTD., and :

IPS ALPHA TECHNOLOGY, LTD, et al. :

Defendants. :

----- x

Civ. No. 05-7891 (AKH)

Civ. No. 07-0816 (AKH)

Civ. No. 07-0818 (AKH)

Civ. No. 07-0821 (AKH)

Civ. No. 07-0822 (AKH)

Civ. No. 07-0825 (AKH)

Civ. No. 07-0826 (AKH)

Civ. No. 07-0827 (AKH)

Civ. No. 07-0828 (AKH)

Civ. No. 08-4036 (AKH)

RESCUED ORDER DISMISSING PLAINTIFF'S CLAIMS WITH PREJUDICE

On March 30, 2012, the Court heard argument in *Anvik Corp. v. Nikon Precision, Inc., et al.* concerning Defendants' Motion for Summary Judgment of Invalidity of U.S. Patents Nos. 4,924,257, 5,285,236, and 5,291,240 for Failure to Disclose Best Mode Under 35 U.S.C. § 112 (the "Motion"). The Court issued an oral ruling granting the Motion for reasons stated orally and transcribed as part of the record of that hearing. (A copy of the transcript is attached hereto as

Appendix A.) The parties stipulated on the record that the Court's ruling on the Motion would apply to all of the above-captioned actions. On April 3, 2012, the Court issued a Summary Order memorializing the oral ruling. (A copy of the Summary Order is attached hereto as Appendix B.)

The Court directed Defendants to confer with Plaintiff and submit an agreed order and form of judgment dismissing all of the above-captioned actions in accordance with the Court's ruling, without prejudice to Plaintiff's right to appeal, as stated on the record of March 30, 2012.

ORDER OF DISMISSAL

IT IS HEREBY ORDERED THAT:

1. Claims 17 and 18 of U.S. Patent No. 4,924,257 are declared invalid for failure to comply with the requirement that "[t]he specification . . . shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. § 112.
2. Claims 23 and 25 of U.S. Patent 5,285,236 are declared invalid for failure to comply with the requirement that "[t]he specification . . . shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. § 112.
3. Claim 25 of U.S. Patent 5,291,240 is declared invalid for failure to comply with the requirement that "[t]he specification . . . shall set forth the best mode contemplated by the inventor of carrying out his invention." 35 U.S.C. § 112.
4. Plaintiff's Complaint or Amended Complaint, as the case may be, in each of the above-captioned actions is dismissed with prejudice.
5. Defendants' Counterclaims, other than those asserting invalidity of U.S. Patents Nos. 4,924,257, 5,285,236, and 5,291,240 in each of the above-captioned actions, are dismissed without prejudice as moot.

6. All other summary judgment motions by Defendants are denied without prejudice as moot.

7. All *Daubert* motions by Defendants are withdrawn, without prejudice, on consent.

8. Defendants have leave to withdraw exhibits of pending motions for which sealing was requested.

9. The Clerk shall enter Judgment in the form attached pursuant to Rules 54 and 58 of the Federal Rules of Civil Procedure.

SO ORDERED:

April 4, 2012
New York, New York


ALVIN K. HELLERSTEIN
United States District Judge

APPENDIX A

SOUTHERN DISTRICT OF NEW YORK
-----x

ANVIK CORPORATION,

Plaintiff,

v.

05-CV-7891 (AKH)

NIKON PRECISION, INC., NIKON
RESEARCH CORPORATION OF
AMERICA, and NIKON
CORPORATION,

Defendants.

Oral Argument

-----x
-----x

NIKON PRECISION, INC., NIKON
RESEARCH CORPORATION OF
AMERICA, AND NIKON
CORPORATION,

Counterclaim Plaintiffs,

v.

ANVIK CORPORATION,

Counterclaim Defendants.

-----x

New York, N.Y.
March 30, 2012
12:30 p.m.

Before:

HON. ALVIN K. HELLERSTEIN,

District Judge

1
2
2
3
3
4
4
5
5
6
6
7
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25

BERNSTEIN LITOWITZ BERGER & GROSSMANN LLP

Attorneys for Plaintiff

BY: CHAD JOHNSON, ESQ.

JAI K. CHANDRASEKHAR, ESQ.

JOSHUA L. RASKIN, ESQ.

MAX W. BERGER, ESQ.

MORRISON & FOERSTER LLP

Attorneys for Defendants

BY: HAROLD J. MCELHINNY, ESQ.

JACK W. LONDEN, ESQ.

ERIC ACKER, ESQ.

KAREN L. HAGBERG, ESQ.

1 (In open court)

2 (Case called)

3 MR. JOHNSON: Good morning, your Honor. Chad Johnson
4 of Bernstein Litowitz on behalf of Anvik. With me are my
5 colleagues, Jai Chandrasekhar, Joshua Raskin, and Max Berger.
6 And we also have Dr. Kantilal Jain, who's the head of Anvik and
7 the inventor of the technology at issue.

8 THE COURT: Thank you.

9 MR. McELHINNY: Good afternoon, your Honor, Harold
10 McElhinny for Nikon and the other defendants on this motion.
11 With me today are Mr. Jack Londen, Mr. Eric Acker, and
12 Ms. Karen Hagberg, who are my partners.

13 THE COURT: Thank you.

14 So you made the motion, Mr. McElhinny. You may speak
15 first.

16 MR. McELHINNY: Thank you, your Honor.

17 First, your Honor, I would like to thank you for
18 accommodating my schedule. I know you have a very busy
19 schedule and hearing us today, I appreciate that you would do
20 that for me.

21 (Discussion off the record)

22 MR. McELHINNY: As we all know, going back to common
23 law time, in fact the United States Constitution, the patent
24 system is a bargain. Inventors, who actually invent something,
25 get a valuable property right in exchange for disclosing their

1 invention immediately and not keeping it a secret and
2 disclosing it to other people in the world so that the
3 invention and progress can continue. The terms of that bargain
4 are also not particularly complicated, and in one of them the
5 best mode requirement, as has been set out in statutes almost
6 since the beginning of the patent statute itself, in a patent
7 application you have to describe the invention --

8 THE COURT: Let's cut to the real issue here.

9 MR. McELHINNY: Yes, your Honor.

10 THE COURT: If this source of illumination is a part
11 of the claim, then the best mode, as the inventor conceived it,
12 if he did conceive it, is critical. If it's not a part of the
13 claim, then, although it still could be a requirement of it, it
14 becomes less important.

15 So there is an expert, Dr. Smith, Professor Smith,
16 Bruce Smith, who said there's a lot of different light sources
17 and any one of them could work just fine. The light source is
18 not part of the claim, part of the invention. Yet at the
19 Markman hearing it was one of the three components of the
20 claim, one being the source of illumination, the second being
21 the mask, and the third being the substrate where the
22 semiconductor image is imprinted. So that suggests that the
23 source of illumination is part of the claim.

24 Then when we got to trying to define it, it was
25 defined in functions, that which will work as part of the

1 claim. It's hard to understand the adequacy of the
2 description. Your motion is not based on an inadequacy of
3 description; it's based on not coming forward with the best
4 source. And I'm confused as to the interplay of all these
5 different criteria.

6 MR. McELHINNY: Fair enough, your Honor. Let me start
7 with the question you didn't ask, but -- the question of
8 whether or not the best mode, the illumination system, is part
9 of the claim is a question of law. It's a question of claim
10 construction and a question --

11 THE COURT: Right. I agree with that. It's right in
12 the claim. It's right in the claim.

13 MR. McELHINNY: That's where I'm going. And as he
14 always is --

15 THE COURT: But if they disclaim it, I guess they can
16 always do that, and we then become focused on the other two
17 parts of the claimed invention.

18 MR. McELHINNY: Not exactly, your Honor, because --
19 this is an important point. As he always is, Dr. Smith was
20 very careful in what he said in his declaration and I think
21 actually created the ambiguity that your Honor is addressing.
22 It is not the requirement that the specific best mode be part
23 of the claim.

24 THE COURT: I understand.

25 MR. McELHINNY: What is required is that the generic

1 element of the claim has to be claimed, and then once that is
2 claimed --

3 THE COURT: And described.

4 MR. McELHINNY: Well, and described, but once it is
5 claimed, then the inventor has the duty to come forward in the
6 specification and say, and in this general system this is what
7 I believe to have been -- to be the best, and in some cases the
8 only way, but in this case the best way to do it.

9 THE COURT: Yes. That's what the law says.

10 MR. McELHINNY: So the concept -- the argument,
11 frankly, the argument that the illumination system wasn't
12 claimed, I think is, as your Honor says, is not accurate. It
13 is spelled out specifically in the claim.

14 THE COURT: It's right in the claim.

15 MR. McELHINNY: And it's in the claim and it's in the
16 claim construction.

17 THE COURT: Right. And I construed it.

18 MR. McELHINNY: And it's not even so general as an
19 illumination system but it's a specific type because it was a
20 specific illumination system that generated a polygonal shape.

21 THE COURT: Providing an illumination subsystem
22 capable of uniformly illuminating a polygon-shaped region on
23 the mask, which I defined it that the phrase means that the
24 illumination subsystem has a capacity to illuminate the mask in
25 such a way that radiation, or light, that falls on the mask

1 forms the shape of a polygon, and the polygon here is the
2 hexagon. And radiation, or light, is uniformly distributed
3 throughout the shape of the polygon. That's what's claimed.

4 MR. McELHINNY: And that's in the '257 patent, your
5 Honor. There are similar claims in the '236 and the '240.

6 THE COURT: Correct.

7 MR. McELHINNY: So to try to argue that this
8 illumination system is not part of the claim I think is --

9 THE COURT: You've got me there. I accept that.

10 MR. McELHINNY: Okay. So once it's part of the
11 claims, or material to it -- but here in this case it is part
12 of the claims -- it's a simple two-part test. The first part,
13 the court tells us, is -- the Federal Circuit tells us, is
14 subjective: Did the inventor have a best mode of practicing
15 this part of the claim.

16 THE COURT: And your claim is that Dr. Jain admitted
17 it. He said --

18 MR. McELHINNY: Yes. That's the punchline.

19 In addition to that, and if you look at these
20 indicia -- if you look, as I'm sure you have, at the U.S.
21 Gypsum case, which is the one that's most directly on point
22 here --

23 THE COURT: Let's read out his testimony. We'll get
24 to the law. Let's focus on his testimony.

25 MR. McELHINNY: Okay. But if I can put it into

1 context for you, because I think the chronology is important.
2 He drew his invention in a notebook. He drew this specific
3 hexagonal tunnel and said, "We will show you how it works," and
4 then he drew this hexagonal tunnel. He then -- and the very
5 first patent application he filed was for that illumination
6 system.

7 He then, when he went to the SPIE conference in 1991,
8 testified that although he described his system, he did not
9 describe that illumination system because it was proprietary
10 and because he had a patent pending for it. He also testified
11 that it's the only illumination system that he ever built in
12 any of the 11 machines he built.

13 So that's the background facts here.

14 And then we have his actual testimony in his
15 deposition, and your Honor has read it, and what was
16 particularly important to me was, it was an unforced statement.
17 The question was, you know, "Why were you at the SPIE
18 conference?" which is years after he actually filed the
19 application. "Why was this important to you?" And he said,
20 "Because this was the best way of doing it that I had thought
21 of as of that date." 1991. Application filed in 1988. As of
22 1991, he volunteers, "That is the best way I had thought of
23 doing it up until 1991." It's as though he had said, "This was
24 my best mode." It is what he said.

25 So again, that's my -- well, there are a number of

1 cases, but we really can't have a more clear admission, and
2 it's not tricked, it's not taken out of context, because these
3 other facts tell us, it's just true.

4 THE COURT: Do you mind if we switch off to now
5 Mr. Johnson, see how he describes it? That's really your whole
6 motion, Mr. McElhinny.

7 MR. McELHINNY: Well, the second part of it, which is
8 another admission, which is, it's not described any place in
9 the patent, it's a box labeled I, and then --

10 THE COURT: We'll get to that.

11 MR. McELHINNY: Yes, your Honor.

12 THE COURT: Okay. Mr. Johnson.

13 MR. JOHNSON: Do you prefer, your Honor, if I'm over
14 at the podium?

15 THE COURT: Yes. Otherwise you block Mr. McElhinny.

16 MR. JOHNSON: First, your Honor, I want to be clear
17 about the fact that there's no argument on our side of this
18 case that an illumination subsystem is not claimed in the
19 asserted patent. That's not an argument being made by anyone
20 in this case. There are other critical arguments that impact
21 this very issue, and one that you were heading towards I
22 believe, your Honor, was the actual testimony, and I would like
23 to refer to that, if you wouldn't mind.

24 THE COURT: Let's read it together.

25 MR. JOHNSON: Very good. I don't know which exhibit

1 is easier for you to look at, but Exhibit 1 to my declaration
2 attached to our opposition papers includes the testimony, and
3 if you start at page 300 of the transcript -- we could talk
4 about all of it, but if we start at 300, it gets to some of the
5 most crucial points here.

6 THE COURT: Okay.

7 MR. JOHNSON: All right. So on 300, the bottom half
8 of that page, you have a question about the invention described
9 in the '257 patent, "your idea of producing the hexagonal
10 shape" and so on. The answer is, referring to this light
11 tunnel, "That's certainly one method." Okay. I'm not ending
12 the point there, but Dr. Jain points out that is one method.

13 And then up on the top of the next page, he again
14 says, "yes, this method is one of the methods I had in mind."

15 Then if you go -- that was on page 301. Further down
16 on page 301, towards the very bottom, there's a question about
17 the '013 patent, which is the light tunnel, and the answer is,
18 "No, that is also limiting. My idea was that one of the
19 methods of doing that would be in the '013 patent."

20 THE COURT: Could I ask you this: If the '013 patent
21 is not referenced in the -- what do you call it, the '237?

22 MR. JOHNSON: '257.

23 THE COURT: -- the '257 patent, does that help the
24 '257 patent at all if it's not referenced?

25 MR. JOHNSON: Does it help the '257 patent?

1 THE COURT: "Help" is a bad word. If the '013 patent
2 description is supposed to provide a description for the '257
3 patent and the '257 patent does not reference the '013 patent,
4 and the '013 patent is secret at the time because it's a patent
5 pending, why does it help understand the '257 patent?

6 MR. JOHNSON: The issue here is, if and only if the
7 light tunnel, which is in the '013, is the best, not just one
8 of, but the superior, the best, the optimum method, then it
9 would have to be disclosed, but still there are even more
10 points that go to that, which I will come to quite quickly.

11 THE COURT: I would think that you don't satisfy the
12 best embodiment rule, Section 112, in the '257 patent unless
13 there's a reference to the '013 patent, and there is none.

14 MR. JOHNSON: Well, that would assume a conclusion,
15 your Honor, that the '013 light tunnel was the subjective best
16 mode that Dr. Jain had in mind.

17 THE COURT: Correct. But you just said to me that it
18 was.

19 MR. JOHNSON: No, your Honor.

20 THE COURT: "Q. You did not disclose in the '257
21 patent how the illumination system provided the nominal
22 hexagonal illumination at the effective source plane; right?"
23 I'm reading from page 301, starting at line 17.

24 "A. That's correct.

25 "Q. Your idea was that that would be in the '013

1 patent; right?

2 "A. No, that is also limiting. My idea was that one
3 of the methods of doing that would be in the '013 patent."

4 MR. JOHNSON: Every time these answers talk about one
5 of the methods, meaning it's not the only method, it's not the
6 best method, it is pointing out that there was not a best
7 method, and so -- but that's not the end of the testimony, as
8 it relates to this. It goes on, to page 302. Again, on line 7
9 there's another answer by Dr. Jain. "That method is one of the
10 methods."

11 THE COURT: Read 303.

12 MR. JOHNSON: Absolutely, your Honor.

13 THE COURT: "Q. When you filed your '013 patent
14 application," that's the light illumination, "and your '257
15 patent application, you considered the '013 hexagonal beam
16 shaper and uniformizer tunnel to have advantages over other
17 methods of providing uniform light to a mask in an illumination
18 system; right?"

19 "A. Over some other methods, correct.

20 "Q. Did you have in mind any method other than the
21 hexagonal beam shaper and uniformizer tunnel that you
22 considered to be better for providing uniform light to the
23 mask?"

24 "A. I do not recall. I certainly may have had.
25 Because this method is providing uniform hexagonal illumination

1 on the substrate certainly is not the only optimum method. And
2 I was quite aware of that.

3 "There may be many variations that I or others may
4 think of. One of the methods was what is described in the
5 '013."

6 MR. JOHNSON: And that answer, your Honor,
7 encapsulates in many ways the issue here in the --

8 THE COURT: You know what it seems to me, he says that
9 the '013 is better than some other methods but maybe there's
10 others, and he starts to fence with the questioner. It's hard
11 for me to accept that there is any credibility whatever to the
12 portion that begins with line 16.

13 MR. JOHNSON: Well, your Honor --

14 THE COURT: He's fencing with the questioner.

15 MR. JOHNSON: Your Honor, what Dr. Jain is saying
16 here, his words, that's not the only optimum method, meaning
17 that -- and it doesn't say any kind of --

18 THE COURT: But he refuses to answer what may be other
19 optimum methods, so that suggests to me that when he says that
20 this is better than other methods and he can't name another
21 method that's equal or better than the '013 method, then he's
22 saying that the '013 method is the best. He knows that.

23 MR. JOHNSON: Well, your Honor, there are a couple
24 issues here. They should not necessarily be conflated; that's
25 for sure.

1 One of the issues is, was the light tunnel Dr. Jain's
2 subjective best mode, and the answers here point out
3 repeatedly, no, it was one of several methods that were
4 available. There are other optimum methods. That's one issue.

5 Another issue is that he was separately seeking a
6 patent on the light tunnel. These are separate inventions.
7 The light tunnel is not limited in its application to the
8 methods in the '257 patent, and the '257 patent is in no way
9 dependent on the use of the light tunnel. So Dr. Jain did what
10 Chief Judge of the Federal Circuit, Judge Rader emphasizes in
11 the Bayer decision patent applicants should do. He filed a
12 separate application for these two inventions, he pointed out
13 in the '257 patent what is needed, and -- here is a third
14 issue, which is critical, and it may be one of the rare areas
15 where we and Nikon agree, your Honor, relates to whether this
16 is even an issue that falls into the area of best mode, because
17 although we and Nikon disagree on so many things, one thing we
18 have to agree on and they concede is that in regard to the
19 question of whether a mode is even subject to the best mode
20 analysis and whether instead it is properly considered a
21 routine detail or a production detail, that is clearly an area
22 for expert testimony. And the caselaw is crystal clear on
23 that.

24 THE COURT: What is the subject of expert testimony?

25 MR. JOHNSON: Whether a mode is a routine detail that

1 someone skilled in the art would be able to look at the '257
2 patent, for instance, and say that's plenty to know how to
3 practice it, we don't need more than what's there. That issue
4 is decided by reference to expert testimony, and even Nikon
5 agrees with that.

6 THE COURT: I think it depends on the definitions and
7 descriptions in the patent. I defined the patent in the
8 Markman hearing, and the definitions of the illumination
9 source, as I observed then and as I observed again today, are
10 ambiguous. You cannot create a specificity where none is in
11 the patent itself. And expert testimony won't help you.

12 MR. JOHNSON: Your Honor, this is not about changing
13 anything regarding the claim construction or the claim itself.

14 THE COURT: The law requires an enablement that is
15 subjective. What was in the inventor's mind? Did he envision
16 a best embodiment? As Section 112 states -- and it's always
17 good to go back to the text -- "The specification shall contain
18 a written description of the invention, and of the manner and
19 process of making and using it, in such full, clear, concise,
20 and exact terms as to enable any person skilled in the art to
21 which it pertains, or with which it is most nearly connected,
22 to make and use the same, and shall set forth the best mode
23 contemplated by the inventor of carrying out his invention."
24 "Shall set forth the best mode contemplated by the inventor of
25 carrying out his invention."

1 So Mr. McElhinny points out to me that when Dr. Jain
2 says that he believed that that which he had set out in the
3 '013 patent was better than something else and he's not able to
4 answer another method that is as good as that set out in the
5 '013, that's a pretty good admission that what he set out in
6 the '013 was the best use he contemplated.

7 MR. JOHNSON: Well, we need to be precise here, your
8 Honor.

9 THE COURT: I'm trying to be precise, as best as my
10 words can do, and I want to put it to you, Mr. Johnson, because
11 I think it's a critical part of this motion. If what he sets
12 out in the '013 is the best mode he contemplated and there's no
13 reference from the '257 to the '013, has Dr. Jain failed to set
14 forth in the '257 patent the best mode he contemplated?

15 MR. JOHNSON: No, because, your Honor, these are
16 different issues that do not get pushed together. Here's what
17 he said. I want to be precise about what he said. He said, in
18 connection with the '013, was that -- he was asked, "Was that
19 the best you had thought of?" Which, in the context of a
20 separate patent application, was understood by Dr. Jain to be
21 focused on, "Was that the best you had invented," as opposed
22 to, "Was that the best way you had thought of to practice the
23 Anvik '257 patent?"

24 THE COURT: Let me rephrase the question. Let's
25 suppose that what Dr. Jain put out in the '013 patent was the

1 best method he contemplated and he failed to reference that in
2 the '257 patent. Is there a failure of the enablement clause
3 in the '257 patent because of the absence of a cross-reference?

4 MR. JOHNSON: If the facts were different, the
5 conclusion should be different, your Honor. I accept that.

6 THE COURT: I don't think you've answered my question.

7 MR. JOHNSON: Yes, your Honor, yes. I mean to say
8 yes. But that's not the facts.

9 THE COURT: In other words, the failure of the
10 cross-reference means there has not been a description of the
11 enablement.

12 MR. JOHNSON: Well, your Honor, there is another
13 wrinkle which I did mention and I want to also --

14 THE COURT: I'd like you to answer my question,
15 Mr. Johnson.

16 MR. JOHNSON: Absolutely. And that's why I --

17 THE COURT: What does absolutely mean? The answer is
18 yes or no. Is the absence of a cross-reference critical?

19 MR. JOHNSON: No. And here's why. Can I go through
20 the explanation, your Honor? Is that all right?

21 THE COURT: Yeah. You said no.

22 MR. JOHNSON: Because, your Honor, the caselaw still
23 focuses on whether one skilled in the art would understand from
24 the disclosure that is in the '257 how to practice this
25 invention, and in connection with that very issue, the court

1 has before it on summary judgment only the evidence of Anvik's
2 expert witness. Nikon made a decision not to put forward --

3 THE COURT: I'm not looking at the experts. I'm
4 looking at what Dr. Jain said.

5 Mr. McElhinny, is the failure to state the
6 cross-reference in the '257 patent to the '013 patent critical?

7 MR. McELHINNY: Absolutely, your Honor.

8 THE COURT: Mr. Johnson, is it critical?

9 MR. JOHNSON: It is not determinative, your Honor.

10 THE COURT: Is it critical?

11 MR. JOHNSON: It's relevant, but it does not determine
12 this question.

13 THE COURT: "Shall set forth the best mode
14 contemplated." Let's suppose he contemplated that the best
15 mode was that which he set out in the '013 patent. Has he set
16 forth in the '257 patent the best mode he contemplated? The
17 answer is yes or no.

18 MR. JOHNSON: The answer is yes to that question, your
19 Honor. And, your Honor, I think you stopped reading from the
20 statute, because the statute I believe goes on to talk about --

21 THE COURT: "Shall set forth the best mode
22 contemplated by the inventor of carrying out his invention,"
23 period, close quote.

24 MR. JOHNSON: And the law makes clear that if one
25 skilled in the art from the disclosure provided can perform the

1 invention, that is not a situation that triggers the best mode
2 defense, and let me offer a case that's particularly relevant.

3 THE COURT: That's the first part. The first part of
4 the definition of Section 112 is a description that is so
5 precise that someone skilled in the art can carry out the
6 invention. The second part is the embodiment clause, "shall
7 set forth the best mode contemplated." Look at the statute.
8 "The specification shall contain a written description in such
9 full, clear, concise, and exact terms as to enable any person
10 skilled in the art, to which it pertains or with which it is
11 the most nearly connected, to make and use the same." That's
12 the first clause. The second clause, "and shall set forth the
13 best mode contemplated by the inventor of carrying out his
14 invention." So you can satisfy the first part and fail on the
15 second part and have your patent invalidated; right?

16 MR. JOHNSON: No, your Honor, because the caselaw from
17 the Federal Circuit makes clear that if you have disclosed
18 sufficient information to perform the invention and that is
19 from the perspective of one skilled in the art -- and expert
20 testimony is well recognized by the caselaw to be on point in
21 connection with that issue -- then there is not a best mode
22 violation.

23 THE COURT: So Mr. McElhinny, can you satisfy the
24 enablement clause or part of the clause, not satisfy the best
25 mode part of the clause, and have a valid patent?

1 MR. McELHINNY: You cannot -- you have to -- I'm
2 sorry. You have to satisfy both the enablement and the best
3 mode.

4 THE COURT: So even if a person skilled in the art can
5 know how to make and use the same from the description, if the
6 inventor has failed to set forth the best mode he
7 contemplated --

8 MR. McELHINNY: That's --

9 THE COURT: Invalid patent.

10 MR. McELHINNY: That's exactly this case.

11 THE COURT: The answer is yes.

12 MR. McELHINNY: The answer is yes.

13 MR. JOHNSON: The answer --

14 THE COURT: Mr. Johnson, the answer is no.

15 MR. JOHNSON: And again, let me give you a case that's
16 on point.

17 THE COURT: All right. Give me your case.

18 MR. JOHNSON: All right, your Honor. The Mentor case
19 from the Federal Circuit. I want to give you the actual
20 citation too. 244 F.3d 1365. Most relevant is 1371 through
21 1375. Here's what was at issue in the Mentor case, your Honor.
22 The inventor in that case testified that a particular mode
23 actually was important to performing the invention at issue
24 there and it was not disclosed. The --

25 THE COURT: What date was that case?

1 MR. JOHNSON: I can tell you.

2 MR. McELHINNY: 2001, your Honor.

3 MR. JOHNSON: That's right.

4 THE COURT: All right.

5 MR. JOHNSON: The inventor readily acknowledged -- the
6 record was clear -- that this mode was not disclosed in the
7 patent, and the Federal Circuit overturned the lower court's
8 granting of judgment as a matter of law and emphasized that
9 what that record showed was that although the inventor believed
10 that a particular mode was desirable and even important --
11 sound familiar? -- that that wasn't enough because the question
12 is whether the mode was truly, A, necessary as part of the
13 invention, which here the record is clear it's not, and it's
14 only necessary to disclose that if it's necessary, but beyond
15 that, the Federal Circuit pointed out that one skilled in the
16 art could look at what was in the invention -- even though it
17 didn't say do this thing which is best, do this thing which is
18 important, do this thing which is superior, one skilled in the
19 art could look at that and perform what was contemplated by the
20 patent in suit there. That case, your Honor, is strikingly
21 close to the case that we're dealing with here.

22 And so there can be arguments about this, but there's
23 another point, your Honor. Along the way you did make a
24 reference to the thought that you can't give much credibility
25 to a particular answer by Dr. Jain, but of course that is a

1 classic question not on summary judgment but for the jury
2 ultimately.

3 THE COURT: I'll get to that in a moment, but that's a
4 point that troubles me. And I want to get Mr. McElhinny's take
5 on it, but I want to clarify the law first. In Bayer AG v.
6 Schein Pharmaceuticals, Inc., 301 F.3d 1306, the Federal
7 Circuit found that because the existence of the best mode of
8 carrying out the invention is by definition known only to the
9 inventor, Section 112 demands actual disclosure regardless of
10 whether, as an abstract matter, practicing that mode would be
11 within the knowledge of one of ordinary skill in the art. In
12 other words, both clauses need to be satisfied, both the
13 enablement clause and the best mode clause.

14 MR. JOHNSON: Well, your Honor, Bayer also goes on to
15 specifically note, in the same -- again, the same case -- I'm
16 on page 1323 of Bayer -- to note that --

17 THE COURT: One minute.

18 MR. JOHNSON: Sorry.

19 THE COURT: Let me catch up to you.

20 Used to be an easy method, easy thing to look at the
21 pages. Now, the way things are printed out, it's almost
22 impossible to find the page. What's the page you have, 1323?

23 MR. JOHNSON: Right.

24 THE COURT: Okay.

25 MR. JOHNSON: All right. So in the note there, 5, the

1 court here is approvingly talking about cases such as Sonar
2 Corporation, where it discusses a function that didn't violate
3 the best mode, the failure to disclose function that itself did
4 not violate the best mode requirements because -- it's about
5 software, but it's within the skill of one of the art, not
6 requiring undue experimentation, etc., and noting that it's
7 well established that what is within the skill of art need not
8 be disclosed to satisfy the best mode requirements so long as
9 that mode is described.

10 THE COURT: People write software with different ways,
11 and as is true of writing an English sentence, it's very hard
12 to say that one expression is better or worse than another
13 expression. Although English teachers may be able to grade
14 that, it's not really applicable to objective measurement, and
15 that's different from what we have here.

16 MR. JOHNSON: Then the same passage goes on not to
17 talk about software anymore but to also note, approvingly, in
18 connection with the Chemcast case, that the adequacy of
19 disclosure depends on whether the disclosure is adequate to
20 enable one skilled in the art to practice the best mode.

21 And then, your Honor, I would also note that lower
22 courts as well, beyond the Federal Circuit, have used expert
23 testimony to conclude that an issue is not subject to the best
24 mode defense because it's known by one skilled in the art, and
25 I'd refer your Honor to --

1 THE COURT: What's known by one skilled in the art?

2 MR. JOHNSON: How to do what is claimed by the
3 invention at issue.

4 THE COURT: I disagree with you. And I'll take this
5 language in the Bayer opinion which appears at page 1314,
6 towards the end of the page. "The best mode requirement is
7 separate and distinct from enablement and requires an inventor
8 to disclose the best mode contemplated by him as of the time he
9 executes the application of carrying out the invention. Unlike
10 enablement, the existence of a best mode is a purely subjective
11 matter." And I would interrupt and say that if it's purely
12 subjective, it's not open to expert testimony. "Unlike
13 enablement, the existence of a best mode is a purely subjective
14 matter, depending upon what the inventor actually believed at
15 the time the application was filed. Because of the subjective
16 nature of the best mode inquiry, the best mode disclosure
17 requirements, unlike enablement, cannot be met by mere
18 reference to the knowledge of one of skill in the art," which
19 is the subject on which you want to present expert testimony.
20 "The reason is pragmatic. It is unreasonable, if not
21 impossible, to require the ordinary artisan to peer into the
22 inventor's mind to discover his or her idiosyncratic
23 preferences as of the filing date."

24 All right. That's enough for reading.

25 That's my ruling, Mr. Johnson. And the question on

1 what I'll now put to Mr. McElhinny is the question that
2 Mr. Johnson just started to get to. Aren't we involved in a
3 factual issue which I cannot make on summary judgment,
4 Mr. McElhinny? I don't know if it's you who questioned
5 Dr. Jain or one of your colleagues.

6 MR. McELHINNY: It was Mr. Londen, your Honor.

7 THE COURT: But he pursued this fairly well and he
8 never got a really clear admission from Dr. Jain that now
9 appears in the portion that I read. How can I rule on summary
10 judgment?

11 MR. McELHINNY: Your Honor clearly has read the
12 transcript, and if I can give a little bit of --

13 THE COURT: Don't assume anything, Mr. McElhinny.

14 MR. McELHINNY: All right. Let me give it a little
15 bit of context. Here is what was going on, and it's clear from
16 all of the pages -- you're focused on the right pages, 300 to
17 313. When Mr. Londen was asking Dr. Jain questions about his
18 patent, Dr. Jain thought the issue was whether or not
19 Mr. Londen was trying to limit his patent to the specific
20 embodiment that he drew in his notebook. So when you see the
21 questions, he keeps saying, oh, no, that's not the only one,
22 that's not that -- I knew, you know, I had -- my mind was a
23 furnace and things were churning and I certainly knew about
24 other things and all the rest of that, and every answer is
25 consistent with that, which is there were other possibilities,

1 there were lots of things that could have been done, and it
2 goes like that. And that's important, I mean, because --

3 THE COURT: That seems to be consistent with the claim
4 of the illumination source as part of the innovation.

5 MR. McELHINNY: Well, this is what's important is that
6 we're not claiming that there's only one way to do that.
7 That's not why we're here. What we're claiming is that after
8 saying there were other ways to do it, on page 313, when we
9 jumped ahead from 1988 to 2001 and Mr. Londen is asking
10 Dr. Jain about this conference -- 1991, sorry -- and Mr. Londen
11 is asking Dr. Jain about this conference, what he says was --
12 and Mr. Londen said, "Did you have any other pending patent
13 applications that dealt with uniformization of the light --"

14 THE COURT: Page 313, line 10.

15 MR. McELHINNY: I'm sorry. "-- in an illumination
16 system besides the application that led to the '013 patent?"
17 "So as of 1991, were you pursuing any other patents? And in
18 light of --

19 THE COURT: Wait. Khris, were you able to get that?

20 (Discussion off the record)

21 THE COURT: "Q. Did you have any other pending patent
22 applications that dealt with the uniformization of the light in
23 an illumination system beside the application that led to the
24 '013 patent?

25 "A. I don't recall, but I think what I described in

1 the '013 patent, that configuration for an illumination system
2 to produce uniform polygonal exposure, most likely that was the
3 best I had thought of until then."

4 MR. McELHINNY: So there's no credibility issue.

5 MR. JOHNSON: We'll have something to say in response
6 to this, your Honor, but --

7 MR. McELHINNY: There's no credibility issue. This is
8 all consistent, which is, he may have been thinking of other
9 ways.

10 THE COURT: All right. So what he's saying, this is
11 1991?

12 MR. McELHINNY: Yes, your Honor, as of 1991.

13 THE COURT: And he relates this back to the date of
14 filing, which is '88.

15 MR. McELHINNY: True, that's '88.

16 THE COURT: And this is consistent with the other line
17 that I mentioned before, which was I think on page 305.

18 MR. McELHINNY: It is consistent. The whole --

19 THE COURT: Not 305.

20 MR. McELHINNY: "Better than the others" is what he
21 said.

22 THE COURT: Yes. I just want to locate it.

23 Page 302. "Q. But that method," in the '013 patent,
24 "is the method that you conceived when you wrote your
25 notebook?"

1 "That method is one of the methods that I conceived,
2 and that one method is in the notebook.

3 "When you filed your '013 patent application, you
4 believed that the method it described had advantages over prior
5 art methods; right?"

6 And that's the vein of it.

7 MR. McELHINNY: So at least as I read this, and I
8 believe it's consistent, and I don't think there's a
9 credibility issue.

10 THE COURT: I agree with you. I think he constantly
11 says that there are others, but Mr. Londen does get an
12 admission that he knew of no others, he could not articulate
13 another one that was as good as the '013.

14 I'll give you a chance, Mr. Johnson.

15 MR. McELHINNY: And to be clear, your Honor, in the
16 declaration --

17 THE COURT: This is an important point, and I'll give
18 you both a chance to be as specific as you can in terms of
19 this, but so far, as I see it, Dr. Jain has answered that the
20 best he can think of was the '013 and that although there are
21 many others, he can't think of another one, and he doesn't
22 mention another one that's as good as the '013.

23 MR. McELHINNY: And in his notebook, he says this is
24 the way to do it.

25 But also, even in opposing this motion, when he filed

1 his -- what I call "blood in the water" declaration saying, "I
2 didn't mean what I said in my deposition," he still doesn't set
3 out any other alternative. He had an opportunity in this
4 motion to say, you know, "this was the better one I thought
5 of."

6 THE COURT: He never corrected his testimony.

7 MR. McELHINNY: He never corrected it, your Honor.
8 There is no credibility issue here. This is an admission under
9 all the Second Circuit cases.

10 THE COURT: Mr. Johnson?

11 MR. JOHNSON: Your Honor, there's no need to correct
12 the testimony, but let's talk about the totality of the
13 testimony, all right?

14 First, you focused on page 313. The answer that your
15 Honor was just asking about, "I don't recall. That was most
16 likely the best I had thought of until then." That is talking
17 about the best that he had invented until then. That is a
18 separate point from the best mode of practicing the '257
19 patent. Those are not one and the same, your Honor. They were
20 filed as separate applications because they're separate
21 inventions. And that alone speaks volumes consistent with what
22 Judge Rader said in his concurrence in the Bayer opinion. But
23 that is what good patent applicants do. When they have a
24 situation like this, they file separate applications. What
25 he's answering a question about --

1 THE COURT: Patent applications answer the
2 requirements of Section 112, both as to specificity in terms of
3 description and the disclosure of the best mode they think of.

4 MR. JOHNSON: But your Honor, there is no better,
5 there's no superior way. There's no requirement in connection
6 with the '257 in any sense to use the light tunnel. In fact,
7 the testimony is that one could make perfectly valid decisions
8 to use other methods that are other optimum methods, and
9 Dr. Jain testified about that very fact.

10 But let's talk about page 313 for a moment. If you go
11 up to a little bit higher on the page, to put this in further
12 context, what Dr. Jain says on lines 4 through 6 is that
13 several other types of beam uniformization or illumination
14 systems were possible, further emphasizing the point that
15 there's nothing about his light tunnel that was superior, your
16 Honor, and when he was asked squarely, "Is the best way to use
17 the '257 patent your technology that's in the '013?" the answer
18 was, "Not right."

19 THE COURT: But then did he ever mention a single
20 other alternative?

21 MR. JOHNSON: He wasn't required to.

22 THE COURT: He was pushed very hard.

23 MR. JOHNSON: Your Honor, there was no -- there's no
24 need. There's no requirement.

25 THE COURT: He was pushed very hard. He didn't say,

1 "I have another one but I'm not telling you."

2 MR. JOHNSON: That doesn't mean, your Honor, that he
3 had a best mode in mind. He's saying there are several optimum
4 methods.

5 THE COURT: I understand your point, Mr. Johnson.

6 MR. JOHNSON: I mean, your Honor --

7 THE COURT: What efficacy should I make for his
8 deposition? Is it what he was saying in his testimony or is it
9 something new?

10 MR. JOHNSON: It's not contradictory and it's
11 absolutely --

12 THE COURT: Does it tell me anything new from what
13 your gloss of his testimony is?

14 MR. JOHNSON: It does flesh out the point that further
15 questioning by Nikon is the real problem here, your Honor. The
16 testimony was, "That is not right. That is not the best mode.
17 There's no particular best mode. There are several optimum
18 methods available." And under the circumstances of a record
19 like this, there is and should be no realistic way for a
20 credibility determination to be made at the summary judgment
21 level. It's not even a preponderance of the evidence standard
22 we're dealing with, of course. It is a requirement that Nikon
23 show, by clear and convincing evidence, the lack of material
24 disputed facts.

25 What about, your Honor -- I mean, Dr. Jain is here.

1 If there's any question, we could clarify this. The
2 questioning by Nikon did not go further, your Honor. And
3 frankly, the declaration didn't go further either because it's
4 not attempting to do that. But Dr. Jain is present, is
5 involved.

6 I note, your Honor, this testimony was taken three
7 years ago. There's nothing about this issue that couldn't have
8 been raised by the other side at that point or at any point
9 until now. Six years into this litigation, we're hearing this.
10 If there's any need to further flesh this out because of the
11 lack of follow-up by Nikon in its deposition questioning,
12 Dr. Jain is here.

13 THE COURT: You mean there's something more he could
14 testify about that he hasn't already?

15 MR. JOHNSON: Very well could be, your Honor, because
16 frankly, the questioning didn't go as far as it could have.

17 THE COURT: Anything else?

18 MR. JOHNSON: Your Honor, if there's any doubt, we
19 would strongly encourage the court the opportunity for Dr. Jain
20 to address this because he is here.

21 THE COURT: That's the purpose of deposition. It's to
22 save the time of a hearing. If a hearing is required, then I
23 should deny the motion for summary judgment. If I feel I can
24 grant the motion for summary judgment, there's no point in
25 testimony.

1 What do you think, Mr. McElhinny?

2 MR. McELHINNY: I think three things, your Honor.

3 One: Well, the Second Circuit has a clear rule here. I mean,
4 this is exactly what happens, which is somebody gives honest
5 and open testimony under oath in a deposition and all of a
6 sudden the circumstances come home to them and they either
7 submit a declaration or now, I guess, we're going to get an
8 offer -- actually, it would scare me to put Dr. Jain on the
9 stand under these circumstances in terms of the pressures that
10 would be on him, frankly, for his testimony.

11 THE COURT: That's not your problem, is it?

12 MR. McELHINNY: It is not, your Honor, but the idea
13 that you can defeat a summary judgment by --

14 THE COURT: By bringing your witness to the courtroom
15 at the time of argument, that's not a very good idea, is it?

16 MR. McELHINNY: But the point, the final point I just
17 want to make, which is intent is not --

18 THE COURT: Usually at a deposition a witness is
19 presumed to mean what he said and say what he meant.

20 MR. McELHINNY: Intent is not a part of best mode, but
21 we don't have to prove that, but what Dr. Jain conceded, what
22 is in the --

23 THE COURT: I don't need you to repeat that.

24 MR. McELHINNY: Thank you, your Honor.

25 MR. JOHNSON: Your Honor, the issue here is,

1 inferences -- what Nikon wants are inferences drawn in their
2 favor as opposed to what the Federal Circuit and the Second
3 Circuit emphasized is required under the circumstances. The
4 inferences here -- if your Honor thinks the record somehow
5 favors Nikon, the inferences absolutely need to be drawn in
6 Anvik's favor. The testimony we pointed out by Dr. Jain about
7 how there are other optimum methods, about how it was not right
8 to suggest that this was his best mode, those inferences must
9 lead to the conclusion, especially under a clear and convincing
10 standard, that the record does not support summary judgment
11 here.

12 (Discussion off the record)

13 MR. JOHNSON: Your Honor, if I can offer one example
14 of something that was not asked. And there may be others. The
15 question was not asked: In connection with practicing the '257
16 patent, are there or were there other equally optimum, or
17 equally superior -- whatever the right word -- best methods of
18 providing an illumination source for that? That question was
19 not asked. Obviously no reason to answer a question not asked.
20 And so looking at the record and saying, oh, he didn't offer
21 that on his own does not itself provide a basis for concluding
22 an answer couldn't have been given to that that would flesh
23 this out. It also wouldn't be alone enough anyhow, because of
24 the testimony that's in there, but he wasn't asked that
25 question.

1 THE COURT: All right. I'd like to proceed to rule on
2 the motion.

3 Defendant has moved for summary judgment of invalidity
4 for failure of the critical patents in dispute, the '257
5 patent, the '236 patent, and the '240 patent, to satisfy the
6 requirement of Section 112 that the application set forth the
7 best mode contemplated by the inventor of carrying out his
8 invention. The motion is granted.

9 Let me go back and describe the parties, the
10 jurisdiction, and my reasoning.

11 And I understand that my rulings on these three
12 patents affect all the seven that are in dispute in the claim,
13 that the other four in effect are derivative of these three.
14 Am I correct on that?

15 MR. JOHNSON: I don't know, honestly, your Honor.
16 We're not asserting the other four at the moment so I
17 haven't --

18 THE COURT: But if I grant the motion, I dismiss the
19 complaint and the complaint does allege seven --

20 MR. JOHNSON: I agree, your Honor. I agree with that.

21 THE COURT: Plaintiff Anvik Corporation is a New York
22 corporation with a principal place of business in Hawthorne,
23 New York.

24 There are three Nikon entities that are the
25 defendants. Nikon Corporation is a Japanese corporation with

1 its principal place of business in Tokyo. Nikon Precision,
2 Inc. is a California corporation with its principal place of
3 business in Belmont, California, and it is a wholly owned
4 subsidiary of Nikon Corporation. Nikon Research Corporation of
5 America is a California corporation with its principal place of
6 business in Belmont, California, and is also a wholly owned
7 subsidiary of Nikon Corporation.

8 I have jurisdiction under the federal question
9 jurisdiction section, Sections 1331 and 1338 of Title 28, and
10 venue is proper in this district and is not challenged. Am I
11 correct on that, that there's no dispute about venue?

12 MR. McELHINNY: That's correct, your Honor.

13 THE COURT: Plaintiff filed this action for
14 infringement of patent relating to the scanning
15 microlithography system. Microlithography systems are used in
16 the production of a variety of microelectronic devices -- for
17 example, fabrication of semiconductors.

18 There are three elements to the patent in dispute -- a
19 source of light, a mask through which the source of light
20 passes and which causes a certain design to fall on the third
21 element, the substrate below, which is etched by the light and
22 is used for the fabrication of semiconductors. It is a very
23 oversimplified description of the patent and the purpose of the
24 patent, but I think it suffices for this case.

25 I held a Markman hearing on September 26th, 2011,

1 and issued an order on September 28th, 2011, which
2 incorporated a schedule that defined the disputed parts of the
3 claim. I would rely on that for my rulings.

4 The patents in issue are 4,924,257, a patent for scan
5 and repeat high-resolution projection lithography system;
6 number 5,285,236, large-area, high-throughput, high-resolution
7 projection imaging system; and 5,291,240,
8 nonlinearity-compensated large-area patterning system.

9 These, the '257 patent, the '236 patent, and the '240
10 patent, are those that were the subject of the Markman hearing
11 and are the subject of this motion and the ruling on them
12 controls the other four patents also identified in the
13 complaint.

14 As a motion for summary judgment, the moving party
15 must show that there is no genuine dispute as to any material
16 fact and that the moving party is entitled to judgment as a
17 matter of law. That's stated in Rule 656 of the Federal Rules
18 of Civil Procedure. Patents issued by the Patent Office are
19 entitled to a presumption of validity. That's provided by
20 '35 U.S.C. Section 282. "A party who seeks to invalidate a
21 patent must submit clear and convincing evidence of
22 invalidity."

23 In deciding a motion for summary judgment, the
24 evidence of the nonmoving party is to be believed and all
25 justifiable inferences are to be drawn in favor of the

1 nonmoving party, and that's held by Boston Scientific Corp. v.
2 Johnson & Johnson, 647 F.3d 1353 (Fed. Cir. 2011). We're
3 construing 35 U.S.C. Section 112, and I'll quote it again for
4 convenience. "The specification shall contain a written
5 description of the invention and of the manner and process of
6 making and using it in such full, clear, concise, and exact
7 terms as to enable any person skilled in the art, to which it
8 pertains, or with which it is most nearly connected, to make
9 and use the same and shall set forth the best mode contemplated
10 by the inventor of carrying out his invention."

11 The burden of the motion, as I understand it, is that
12 the patent applicant, here the plaintiff Anvik Corporation, or
13 its predecessor, failed to set forth the best mode that was
14 contemplated by the inventor, Dr. Jain, in carrying out the
15 invention.

16 Whether or not the inventor had done that is a matter
17 of subjective intent, and generally speaking, it is a question
18 of fact, as was held by Bayer AG v. Schein Pharmaceuticals,
19 Inc., 301 F.3d 1306, 1312 (Fed. Cir. 2012), and we've quoted
20 extensively from that.

21 The '257 patent application was filed October 5, 1988,
22 and it was issued May 8th, 1990. The inventor is
23 Dr. Kantilal Jain. The patent discloses a scanning lithography
24 method that performs seamless, partially overlapping scans with
25 uniform exposure to produce a pattern on a mask which then

1 passes on to a substrate, such as a semiconductor. Radiation,
2 or light, from the illumination subsystem illuminates the mask,
3 passes through the subsystem of the mask, and projects the
4 image of the mask onto the substrate.

5 As I defined the patent at the Markman hearing and as
6 set out in my order of September 28, 2011, Section 17(c) of the
7 claim speaks of providing an illumination subsystem capable of
8 uniformly illuminating a polygon-shaped region on the mask so
9 that the subsystem then causes the imaging of the said
10 polygon-shaped illuminating region on the mask to pass on to
11 the substrate.

12 I defined "providing an illumination subsystem" as
13 follows: The phrase means that the illumination subsystem has
14 the capacity to illuminate the mask in such a way that
15 radiation, or light, that falls on the mask forms the shape of
16 a polygon, and radiation, or light, is uniformly distributed
17 throughout the shape of the polygon.

18 The term "polygon" means a two-dimensional space
19 formed by straight lines that connect with each other to create
20 a closed space.

21 So there's more elaboration that went on at the
22 Markman hearing and the record that was created at the Markman
23 hearing which also provided an example the parties produced to
24 teach me the system and to create the record for the system.

25 So the issue is what Dr. Jain had in mind when he

1 claimed this invention. And to go into that was the subject of
2 the deposition that was carried out of Dr. Jain on
3 August 17th, 2009. The parties defined on this motion the
4 portion of that transcript that is relevant as that which is
5 transcribed starting with page 300 and going on to page 313.
6 Mr. Londen, questioning Dr. Jain, pressed him in terms of what
7 he had in mind as the best mode.

8 "Q. When you conceived of the invention that you were
9 describing in the '257 patent, your idea of the way to produce
10 the nominal hexagon shape and the effective source plane
11 providing uniform light to the mask was to use the hexagonal
12 beam shaper and uniformizer tunnel that's depicted in the
13 notebook," Dr. Jain's notebook that was an exhibit at the
14 deposition, "at page 21; right?"

15 Dr. Jain answered, page 300, line 21: "That's
16 certainly one method, and that's what I had in mind as one of
17 the many things. This is what I wrote down. Many things were
18 evolving between April and October and since. So yes, this
19 method is one of the methods I had in mind."

20 "Q. Well, it is the specific method that you
21 diagrammed in your notebook for providing uniform light in a
22 nonlinear hexagonal shape on the mask; right?"

23 And I digress for the moment. The importance of
24 uniform light was demonstrated to me by the movement of the
25 substrate and the mask across the light. If the light were

1 denser at a particular point because of the way the hexagonal
2 shapes moved from one place to another and the light was moved
3 from one place to another, that density would disturb the
4 uniform qualities, so it was critical to have something that
5 was uniform throughout. Continuing:

6 A. Line 8, page 301. "That is in the notebook
7 describing the illumination system, and the illumination system
8 details are not described in the patent '257. They are
9 described in the patent '013. Patent '013 describes the
10 illumination system only. Patent '257 describes the
11 lithography system overall. And the notebook describes both.

12 "Q. You did not disclose in the '257 patent how the
13 illumination system provided the nominal hexagonal illumination
14 as the effective source plane; right?

15 "A. That's correct.

16 "Your idea was that that would be in the '013 patent;
17 right?

18 "A. No. That is also limiting. My idea was that one
19 of the methods of doing that would be in the '013 patent."

20 Now page 302. "Q. So that method is the method that
21 you conceived when you wrote your notebook."

22 "A. That method is one of the methods that I
23 conceived, and that one method is in the notebook.

24 "Q. When you filed your '013 patent application, you
25 believed that the method as described had advantages over prior

1 art methods; right?

2 "A. Right."

3 And I understand that as saying that the method
4 described in the '013 patent was better than anything in the
5 prior art, and I also understand that there was no reference in
6 the '257 patent to the '013 patent. So to the extent that one
7 might argue that the application, which was a secret
8 application, not known to anyone else but the Patent Office, of
9 the illumination method and the '013 patent, that did not
10 satisfy any requirement of the description or best mode in the
11 '257 patent.

12 Continuing, page 302, line 15:

13 "And in the preferred embodiment of an illumination --
14 of a lithography system practicing the methods of the '257
15 patent, your design at the time you filed your patent
16 application used light provided by a hexagonal beam shaper and
17 uniformizer tunnel to provide nominal hexagon shape and uniform
18 light; right?

19 "A. Not right."

20 I'll leave out the objections. Now page 303:

21 "Q. When you filed your '013 patent application and
22 your '257 patent application, you considered the '013 hexagonal
23 beam shaper and uniformizer tunnel to have advantages over
24 other methods of providing uniform light to a mask in an
25 illumination system; right?

1 "A. Over some other methods, correct."

2 So again, this is another admission that the
3 description in the '013 patent was better than other methods
4 which Dr. Jain was familiar with.

5 It goes on, line 11, page 303:

6 "Q. Did you have in mind any method other than the
7 hexagonal beam shaper and uniformizer tunnel that you
8 considered to be better for providing uniform light to the
9 mask?

10 "A. I do not recall. I certainly may have had,
11 because this method of providing uniform hexagonal illumination
12 on the substrate certainly is not the only optimum method and I
13 was quite aware of that. There may be many variations that I
14 or others may think of. One of the methods was what I
15 described in the '013."

16 I understand from this that Dr. Jain admitted that the
17 '013 was better than anything in the prior art and anything of
18 which he was aware and which he could remember at the time.
19 But he hedges and says there may be other things that are
20 equally good or better. But he does not articulate any. He's
21 called upon to do that.

22 "Q. Again, did you have in mind any method other than
23 the hexagonal beam shaper and uniformizer tunnel," referring to
24 the '013 patent, "that you considered to be better for
25 providing uniform light to the mask?"

1 He was invited to articulate any one that was equal or
2 better, and he declined to do so. And I think that's a telling
3 admission. The question goes on:

4 "Is it correct to say that you have no recollection
5 that you actually thought of a preferable method for providing
6 uniform hexagon-shaped light in the illumination system of your
7 '257 patent than the hexagonal beam shaper and uniformizer
8 tunnel described in your '013 patent?"

9 "A. I think that would be a bit too rigid way to
10 describe that. I was thinking of many, many things those days.
11 My mind was a furnace. Just too many things were churning. I
12 wanted to get some things out in patents, whatever I was able
13 to do in a short time frame. Maybe sometime at a later point I
14 may think, oh, I may remember something in my mind which I may
15 have filed as a patent application later on. So I cannot
16 categorically say that there were no other ideas in my mind at
17 that time."

18 Well, of course -- again, this is my interpolation --
19 anything is possible, anything is logically possible. If
20 Dr. Jain had identified something that he identified as better
21 and that was in the '013 patent, better than anything in the
22 prior art, better than anything of which he was aware, and
23 although there was logical possibility that there could be
24 something else, he could not identify anything else. That
25 answers the subjective requirement. He knew of something that

1 subjectively was the best. He did not declare it; he did not
2 disclose it. He therefore failed to satisfy the particular
3 clause in Section 112.

4 I don't think I need to continue reading because I
5 don't think anything changes as we go along. Unless the
6 parties want me to read anything else from there on to
7 page 313, I'll stop here.

8 Hearing none, I'll stop.

9 I find that there is no issue of fact, that Dr. Jain
10 was clear in his admission, as I described it before, and he
11 therefore failed to satisfy what is clearly set out in
12 Section 112. That was the holding of the Bayer case, which I
13 described and cited before. It's my holding in this case. I
14 therefore grant the motion for summary judgment.

15 And that applies to the '236 and '240 patents as well.

16 With regard to Dr. Jain's declaration filed in
17 opposition to this motion, I've read this. It is a brief. At
18 various points throughout his declaration, he picks up
19 references to his deposition testimony, repeating it back and
20 forth over and over again and trying to discuss what he really
21 meant, but what he really meant was what he said. Witnesses
22 are sworn to tell the truth, the whole truth, and nothing but
23 the truth when they give depositions. I take it they mean what
24 they say and they say what they mean, and I take Dr. Jain's
25 words for what they are. The declaration as a gloss of what he

1 may have wanted to mean or may have tried to mean or how he
2 wanted to argue is beside the point, and they don't contribute
3 anything at all.

4 So that's my ruling on the motion.

5 There's also a motion to seal. What is there to seal
6 and why should I seal? Who's the moving party on this motion?

7 MR. McELHINNY: Nikon was the moving party, your
8 Honor.

9 THE COURT: What's that?

10 MR. McELHINNY: There was a Daubert motion that was --
11 there are two Daubert motions, I guess, that have confidential
12 information.

13 THE COURT: I'm not even getting to that.

14 MR. McELHINNY: If you let us withdraw them so that
15 they're -- we don't want them to be public record. They talk
16 about finances, they talk about profitability.

17 THE COURT: Is there any objection to withdrawing the
18 Daubert motion?

19 MR. JOHNSON: No, your Honor.

20 THE COURT: Then they'll be withdrawn.

21 MR. McELHINNY: Thank you, your Honor.

22 THE COURT: And there are two pending or three pending
23 additional motions for summary judgment, which I believe are
24 redundant, and I'm not going to deal with them. We'll just
25 terminate that because the case is dismissed.

1 MR. McELHINNY: Right. And just so it's clear, when I
2 say withdraw them, would you allow -- I think we'll need an
3 order actually to have the clerk return them.

4 THE COURT: Work it out with the clerk. If you need
5 an order, I'll sign it. Without objection.

6 MR. McELHINNY: Thank you, your Honor.

7 THE COURT: All right. These are my findings and
8 conclusions. I do not intend to write on this any further. So
9 we'll file a summary order today if we're ambitious, more
10 likely Monday, and Mr. Johnson can file his appeal if he so
11 desires.

12 MR. McELHINNY: May I raise one small point. The
13 Federal Circuit teaches us that best mode is done on a
14 claim-by-claim basis, and so can I note for the record that the
15 claims of the '257 patent that were asserted were claims 17 and
16 18; the claims of the '236 patent were claims 23 and 25; and
17 the claims of the '240 patent were 24 and 25. And I take it
18 your order applies to those claims.

19 THE COURT: You're right. And I should have done
20 that, but I didn't. And I can just check my Markman order.

21 (Discussion off the record)

22 MR. JOHNSON: Your Honor, what Mr. McElhinny said was
23 correct. If we're just talking about the claims, it's the ones
24 he identified on the record, so there's no issue.

25 THE COURT: Okay. Fine. Thank you.

1 Is there anything else I need to do?

2 MR. McELHINNY: Just to be very technical, is your
3 Honor vacating the hearing set for next Tuesday?

4 THE COURT: Yes. The case is dismissed.

5 MR. McELHINNY: And we will submit an order. Having
6 invalidated these claims, I assume it will apply to all the
7 customer cases on the same patent, and we'll work on a form of
8 order.

9 THE COURT: Is that okay, Mr. Johnson?

10 MR. JOHNSON: I think that's right, your Honor.

11 THE COURT: All right. So I'll do a summary order and
12 provide in the summary order that the more formal and complete
13 order will be submitted by the parties by when, Mr. Johnson?

14 (Discussion off the record)

15 THE COURT: We will issue summary order today or
16 Monday morning. The parties will submit a more formal and
17 complete order by Wednesday noon. I would prefer that that
18 order be on consent as to form. And that will not prejudice
19 Mr. Johnson in any way. He reserves all objections. But to
20 the extent that both of you cooperate on proper form, I would
21 appreciate it. I think it would benefit you as well. So would
22 you work out when you should exchange your papers together so
23 that you have enough time to work out any disagreements.

24 MR. LONDEN: We will, your Honor.

24 THE COURT: Okay. Thanks very much.

25 ALL COUNSEL: Thank you, your Honor.

25 o0o