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**UNITED STATES INTERNATIONAL TRADE COMMISSION
Washington, D.C.**

In the Matter of

**CERTAIN CERAMIC CAPACITORS AND
PRODUCTS CONTAINING SAME**

Inv. No. 337-TA-692

**ORDER NO. 28: DENYING MOTION BY RESPONDENTS FOR SUMMARY
DETERMINATION OF INVALIDITY OF ALL ASSERTED
CLAIMS OF U.S. PATENT NO. 6,377,439**

(May 21, 2010)

On March 16, 2010, Respondents Samsung Electro-Mechanics Co., Ltd. and Samsung Electro-Mechanics America, Inc. (collectively, "Samsung") filed a motion for summary determination of invalidity of the U.S. Patent No. 6,377,439 ("the '439 patent"). (Motion Docket No. 692-010.) On April 8, 2010, Complainants, Murata Manufacturing Co., Ltd. and Murata Electronics North America, Inc. (collectively, "Murata"), filed an opposition to the present motion. On April 20, 2010, the Commission Investigative Staff ("Staff") filed its response, in support of Samsung's motion for summary determination. On April 20, 2010, Samsung filed a motion for leave, which is hereby DENIED, to file a reply in support of Respondents' motion. (Motion Docket No. 692-019.) On April 26, 2010, Murata filed a motion for leave to respond briefly to new arguments and new evidence in Respondents' "reply" briefs on their summary determination motions on the '439 and '254 patents and to a new argument in the Staff's response to the summary determination motion on the '309 patent. (Motion Docket No. 692-022.) Motion Docket No. 692-022 is hereby DENIED to the extent that it relates to the '439 patent.

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The Commission Rules permit a party to “move with any necessary supporting affidavits for a summary determination in his favor upon all or any part of the issues to be determined in the investigation.” 19 C.F.R. § 210.18(a). Summary determination “shall be rendered if pleadings and any depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a summary determination as a matter of law.” 19 C.F.R. § 210.18(b); *see also DeMarini Sports, Inc. v. Worth, Inc.*, 239 F.3d 1314, 1322 (Fed. Cir. 2001); *Wenger Mfg., Inc. v. Coating Mach. Sys., Inc.*, 239 F.3d 1225, 1231 (Fed. Cir. 2001).

“When ruling on a motion for summary judgment, all of the nonmovant’s evidence is to be credited, and all justifiable inferences are to be drawn in the nonmovant’s favor.” *Xerox Corp. v. 3Com Corp.*, 267 F.3d 1361, 1364 (Fed. Cir. 2001). The trier of fact should “assure itself that there is no reasonable version of the facts, on the summary judgment record, whereby the nonmovant could prevail, recognizing that the purpose of summary judgment is not to deprive a litigant of a fair hearing, but to avoid an unnecessary trial.” *EMI Group N. Am., Inc. v. Intel Corp.*, 157 F.3d 887, 891 (Fed. Cir. 1998).

The moving party bears the initial burden of establishing that there is an absence of a genuine issue of material fact. *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986). “[A] moving party seeking to invalidate a patent at summary judgment must submit such clear and convincing evidence of facts underlying invalidity that no reasonable jury could find otherwise.” *SRAM Corp. v. AD-II Eng’g, Inc.*, 465 F.3d 1351, 1357 (Fed. Cir. 2006). If the moving party satisfies its initial burden, then the burden shifts to the non-movant to demonstrate specific facts that show there is a genuine issue for trial. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 256 (1986).

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Samsung argues that the asserted claims of the '439 patent are invalid as anticipated by an article entitled, "Challenges in Manufacturing 0402 Multilayer Ceramic Capacitors" by KEMET Electronics Corp. ("the KEMET reference"). Samsung also argues that claims 1, 3, and 5 are anticipated by Japanese Patent Application No. H9-129493 to Atsushi Masuda ("the Masuda application"). Additionally, Samsung argues that claim 2 of the '439 patent is invalid as obvious in light of the Masuda application in view of admitted prior art therein. Samsung further argues that the asserted claims of the '439 patent are invalid as obvious in light of Japanese Patent Application Publication No. H10-22161 to Takashi Noji ("the Noji application") in view of Japanese Unexamined Patent Application Publication No. S61-183913 to Kukutsu ("the Kukutsu application"). Similarly, the Staff argues that claims 1, 3, and 5 are anticipated by the Masuda application. The Staff also argues that claim 2 is obvious in light of the Masuda application in view of the KEMET reference or the Noji application. Each allegation of invalidity will be addressed in turn.

The KEMET Reference

Samsung alleges that the KEMET reference is prior art to the asserted '439 patent under 35 U.S.C. § 102(b) because it is a printed publication published more than one year prior to the date of the application for the '439 patent in the United States. 35 U.S.C. § 102(b). Specifically, Samsung argues that the KEMET reference was published by KEMET Electronics Corp. in *Tech Topics: The Leading Edge* in November 1996, more than two-and-a-half years before the earliest asserted priority date of the '439 patent. (Mot. Mem. at 8.) Murata responds in its opposition that the KEMET reference is not a proper Section 102(b) reference because it was not publically available more than a year prior to the date of application of the '439 patent. (Opp. at 27-30.)

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Section 102(b) is a bar to patentability if “the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.” 35 U.S.C. § 102(b). “The bar is grounded on the principle that once an invention is in the public domain, it is no longer patentable by anyone.” *In re Hall*, 781 F.2d , 897, 898 (Fed. Cir. 1986). In order to qualify as a printed publication within the meaning of Section 102, a reference “must have been sufficiently accessible to the public interested in the art.” *In re Cronyn*, 890 F.2d 1158, 1160 (Fed. Cir. 1989) (quoting *Constant v. Adv. Micro-Devices, Inc.*, 848 F.2d 1560, 1568 (Fed. Cir. 1988)).

“Because there are many ways in which a reference may be disseminated to the interested public, ‘public accessibility’ has been called the touchstone in determining whether a reference constitutes a ‘printed publication’ bar under 35 U.S.C. § 102(b).” *Hall*, 781 F.2d at 898-99. Whether a reference is publicly accessible is determined on a case-by-case basis according to the “facts and circumstances surrounding the reference's disclosure to members of the public.” *In re Klopfenstein*, 380 F.3d 1345, 1350 (Fed. Cir. 2004). A reference is considered publicly accessible if it has been “disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art exercising reasonable diligence, can locate it.” *Kyocera Wireless Corp. v. Int'l Trade Comm'n*, 545 F.3d 1340, 1350 (Fed. Cir. 2008) (quotation marks omitted).

Because Samsung has the burden of proving by clear and convincing evidence that the KEMET reference invalidates the asserted claims of the ‘439 patent, it is Samsung’s duty to show that the KEMET reference is a prior art “printed publication” within the meaning of Section 102(b), *i.e.*, that the KEMET reference “has been disseminated or otherwise made

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available to the extent that persons interested and of ordinary skill in the subject matter or art, exercising reasonable diligence can locate it and recognize and comprehend therefrom the essentials of the claimed invention without need of further research or experimentation.”

Massachusetts Institute of Technology v. AB Fortia, 774 F.2d 1104, 1109 (Fed. Cir. 1985) (citing *In re Wyer*, 655 F.2d 221, 226 (Fed. Cir. 1981)).

Samsung addresses the issue whether the KEMET reference is prior art under Section 102(b) in the following statement from its memorandum in support of the present motion for summary determination:

In November 1996, more than two-and-a-half years before the earliest asserted priority date of the ‘439 patent, KEMET Electronics Corp. published an article entitled “Challenges in Manufacturing 0402 Multilayer Ceramics Capacitors” in *Tech Topics: The Leading Edge*.

(Mot. Mem. at 8; *see also id.* at 16.) Samsung cites only to the KEMET reference in support of this statement. (*Id.* at 8.) Additionally, Dr. Michael S. Randall, whose declaration is attached in support of Samsung’s motion for summary determination, states that “[he had] reviewed and [was] familiar with ‘Challenges in Manufacturing 0402 Multilayer Ceramic Capacitors,’ published by KEMET Corporation (‘KEMET’) in *Tech Topics: The Leading Edge* (November, 1996).” (Mot. Mem., Randall Decl. at ¶ 16.)

Murata argues in opposition that although Dr. Randall stated in his declaration that the KEMET reference was “published” in November 1996, at his deposition he conceded that he had no basis for his statement. (Opp. at 13.) Murata argues that unlike a patent or a technical article in a referred journal where the date of publication is apparent from the document itself, it is not clear when and where the KEMET reference was distributed. (*Id.*) Murata argues that the KEMET reference is merely an advertisement prepared by the company. (*Id.* at 13, 28.) Murata

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also argues that at the bottom of both pages of the KEMET reference there is a footer that states “download this and other documents from www.kemet.com,” but that a search of an Internet Archive (The Wayback Machine at www.archive.org) did not show that the KEMET website existed in 1996. (*Id.* at 28.) Murata also argues that snapshots from the KEMET website from 1997 do not reveal the KEMET reference. (*Id.*) Further, Murata argues that Dr. Randall was unable to confirm at his deposition whether the KEMET website existed in 1996 and admitted that he had not conducted any investigation to determine whether it did. (*Id.*) Further still, Murata argues that even if the KEMET reference was available in PDF form before the critical date, there is no evidence that one of ordinary skill would have been able to find it because at that time web crawlers that compiled listings for search engines were unable to search the contents of PDF files so one of ordinary skill in the art would not have been able to identify whether the subject matter of the reference was relevant. (*Id.* at 28-29.)

As seen above, Samsung only addresses the issue whether the KEMET reference is prior art under Section 102(b) by referring to the KEMET reference itself. Samsung provides no other evidence to show that the KEMET reference was publically available in November of 1996. Although Dr. Randal stated in his declaration in support of the present motion that the KEMET reference was published in November 1996, he admitted at his deposition that he had no basis beyond the KEMET reference for stating that the KEMET reference was published in 1996. (*See Opp.*, Ex. 4 (Randall Depo.) at 111-14.) Moreover, Murata has provided evidence in its opposition that suggests that the KEMET reference may not have been publically available in November 1996, or even in 1997. (*See Id.*, Ulrich Decl. at ¶ 42.) Furthermore, there appears to be a dispute as to whether the KEMET reference, even if available before the critical date, could have been found by one of ordinary skill in the art. (*Id.*, Ulrich Decl. at ¶¶ 40, 41, 43.)

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Viewing the foregoing evidence in the light most favorable to the nonmoving party, *i.e.*, Murata, the Administrative Law Judge finds that genuine issues of material fact exist making summary determination unwarranted. Therefore, insofar as its argument that the KEMET reference anticipates the asserted claims for the '439 patent, Samsung's present motion for summary determination is hereby DENIED.

The Masuda Application

Samsung and the Staff argue that the Masuda application anticipates asserted claims 1, 3, and 5 of the '439 patent. (Mot. Mem. at 20-23; Staff Resp. at 9-12.) Samsung and the Staff also argue that claim 2 of the '439 patent is obvious in light of the Masuda application in view of the admitted prior art therein, the KEMET reference, and the Noji application. (Mot. Mem. at 29-30; Staff Resp. at 12-13.) Claim 1 is an independent claim. Claims 2, 3 and 5 depend from claim 1. Claim 1 reads as follows:

An electronic multilayer ceramic component comprising:

a sintered ceramic block having a first end face, a second end face, upper and lower surfaces connecting said first and second end faces to each other, and a pair of side faces;

a plurality of inner electrodes disposed in the sintered ceramic block such that said plurality of inner electrodes overlap, in a thickness direction, with one another via ceramic layers and such that each said inner electrode extends from said first end face toward said second end face but not reaching said second end face or from said second end face toward said first end face but not reaching said first end face; and

a first outer electrode and a second outer electrode formed such that said first and second end faces are covered with said first and second outer electrodes respectively;

wherein, when the width of the region in which said plurality of inner electrodes are disposed such that said inner electrodes overlap in the thickness direction with one another via ceramic layers is denoted by EW, the width of a side gap region between ends of said inner electrodes and one of side faces of said sintered

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ceramic block is denoted by WG, the thickness of a region in which said plurality of inner electrodes are disposed such that said inner electrodes overlap in the thickness direction with one another via ceramic layers is denoted by T, and the thickness of one of the outermost ceramic layers parallel to said plurality of inner electrodes and located outside the region in which said plurality of inner electrodes are disposed such that said inner electrodes overlap in the thickness direction with one another via ceramic layers is denoted by G, the following conditions are satisfied:

WG (the width of the side gap region between the ends of the inner electrodes and one of the side faces)/EW \geq 0.3, and

T/G (the thickness of the one outermost ceramic layer) \leq 7.0.

(*Id.*, Ex. 1 (the '439 patent).)

To prove that claim 1 is anticipated by the Masuda application, Samsung must prove by clear and convincing evidence that the Masuda application discloses each and every limitation of claim 1, including “a plurality of inner electrodes disposed in the sintered ceramic block such that said plurality of inner electrodes overlap, in a thickness direction, with one another via ceramic layers.” *See Celeritas Techs. Ltd. v. Rockwell Int’l Corp.*, 150 F.3d 1354, 1360 (Fed. Cir. 1998) (A patent is invalid as anticipated if “each and every limitation is found either expressly or inherently in a single prior art reference”). Samsung, however, does not address the quoted limitation in its memorandum. (*See id.* at 21.) Likewise, Dr. Randall, whose declaration is attached in support of Samsung’s motion for summary determination, also does not discuss this limitation. (*See id.*, Randall Decl. at ¶ 29.) Because Samsung has set forth no indicative evidence that the Masuda application discloses “a plurality of inner electrodes disposed in the sintered ceramic block such that said plurality of inner electrodes overlap, in a thickness direction, with one another via ceramic layers,” the Administrative Law Judge finds that it has failed to prove by clear and convincing evidence that the Masuda application discloses each and every limitation of claim 1 of the ‘439 patent. Therefore, the Administrative Law Judge finds

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that Samsung has failed to prove, clearly and convincingly, that claim 1 is anticipated by the Masuda application. Because Samsung has failed to prove that independent claim 1 is anticipated by the Masuda application, Samsung cannot establish that the Masuda application anticipates dependent claims 3 and 5. *In re Fritch*, 972 F.2d 1260, 1266 (Fed. Cir. 1992) (“dependent claims are nonobvious if the independent claims from which they depend are nonobvious”).

As does Samsung, the Staff argues that the Masuda application anticipates claims 1, 3 and 5 of the ‘439 patent. (Staff Resp. at 1-2.) With regard to the above limitation requiring “a plurality of inner electrodes disposed in the sintered ceramic block such that said plurality of inner electrodes overlap, in a thickness direction, with one another via ceramic layers,” the Staff argues that the Masuda application discloses this limitation in Figures 1 and 6. (*Id.* at 9.) The Staff, however, offers no more than a conclusory statement that “Figures 1 and 6 clearly demonstrate that the inner electrodes overlap the ceramic layers in a thickness direction.” (*Id.* at 9-10.)

Murata argues in opposition that the Masuda application does not anticipate because it does not disclose any capacitor that meets all the elements of any of the asserted claims of the ‘439 patent. (Opp. at 32.) Murata also argues that Samsung inappropriately picks and chooses disclosures from various examples in the Masuda application, combines them in a way not disclosed and then argues that the new combination anticipates. (Opp. at 33 (*citing Net Moneyin, Inc. v. Verisign, Inc.*, 545 F.3d 1359, 1371 (Fed. Cir. 2008)).)

With regard to the limitation of claim 1 which requires “a plurality of inner electrodes disposed in the sintered ceramic block such that said plurality of inner electrodes overlap, in a

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thickness direction, with one another via ceramic layers,” Murata argues that the Masuda application does not disclose this limitation. In support, Murata relies on Figure 5 of the Masuda application arguing that Figure 5 shows “a middle region where no portions of the internal electrodes ‘overlap in the thickness direction.’” (Opp. at 35 (*citing* Ulrich Dec. at ¶¶ 59-63).) Murata also notes that the specification of the Masuda application describes the middle region, labeled “22a” in Figure 5, as a “slit.” (Opp. at 35.) Murata further argues that the Masuda application fails to describe any type of electrode overlap or any type of positional relationship in the thickness direction. (*Id.* at 36.)

Based on the arguments discussed above, the Administrative Law Judge finds that at a minimum there is a dispute between the parties as to the meaning, *i.e.*, claim construction, of the phrase “such that said plurality of inner electrodes overlap, in the thickness direction.” While the Staff, and presumably Samsung, appear to argue that the configuration of the inner electrodes depicted in the Masuda application satisfies this limitation, Murata argues that the inner electrodes depicted do not overlap in the thickness direction because there is a gap that runs down the middle of the inner electrodes, *i.e.*, the “slit,” where the electrodes do not overlap in the thickness direction. None of the parties, however, address or reconcile this claim construction issue. Determination of whether a prior art reference anticipates a claim under 35 U.S.C. § 102 is a two step inquiry: the first step is the proper construction of the claims and the second step is the comparison of the properly construed claims to the prior art. *See, e.g., Medichem, S.A. v. Rolabo, S.L.*, 353 F.3d 928, 933 (Fed. Cir. 2003). Because the parties do not address the proper construction of the phrase “such that said plurality of inner electrodes overlap, in the thickness direction,” the Administrative Law Judge finds that summary determination is inappropriate and that a hearing on the merits is necessary before arriving at a correct claim interpretation. *See,*

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e.g., In the Matter of Certain Semiconductor Chips with Minimized Chip Package Size and Products Containing Same, Inv. No. 337-TA-432, Order No. 20 at 1 n.1 (U.S.I.T.C., March 19, 2001). Accordingly, the Administrative Law Judge finds that the Staff also has failed to prove by clear and convincing evidence that, as a matter of law, claims 1, 3, and 5 are anticipated by the Masuda application. *See* 19 C.F.R. § 210.18(b) (Summary determination “shall be rendered if . . . there is no genuine issue as to any material fact *and* that the moving party is entitled to a summary determination as a matter of law.”) (emphasis added).

As previously stated, Samsung and the Staff argue that dependent claim 2 of the ‘439 patent is obvious in light of the Masuda application, in view of the admitted prior art therein; the KEMET reference; or the Noiji application. In particular, Samsung and the Staff argue that the Masuda application discloses all of the limitations of independent claim 1; that the additional limitation of dependent claim 2 requiring that “said sintered block has a size equal to or less than 1.6 mm in length, 0.8 mm in width, and 0.9 mm in thickness” was already known in the prior art; and that one of ordinary skill in the art would find claim 2 obvious in light of the Masuda application in view of the admitted prior art therein, the KEMET reference, or the Noiji application.¹ (Mot. Mem. at 29-30; Staff Resp. at 12-13.) Because both Samsung and the Staff rely entirely on the Masuda application for disclosure of all the limitations of claim 1, Samsung’s and the Staff’s obviousness arguments do not resolve the issues discussed above with regard to claim 1 of the ‘439 patent. Accordingly, for the same reasons discussed with regard to claim 1, the Administrative Law Judge finds that Samsung and the Staff have failed to establish by clear

¹ Claim 2 depends from claim 1 and therefore includes all the limitations of claim 1. 35 U.S.C. § 112, ¶ 4 (2000) (“[A] claim in dependent form shall contain a reference to a claim previously set forth and then specify a further limitation of the subject matter claimed. A claim in dependent form shall be construed to incorporate by reference all the limitations of the claim to which it refers.”).

and convincing evidence that dependent claim 2 is obvious in light of the Masuda application in view of the admitted prior art disclosed therein.

Noji in View of Kukutsu

Samsung argues that the asserted claims of the '439 patent are obvious in light of the Noji application in view of the Kukutsu application.² Samsung argues that the Noji application is directed to the same problem allegedly addressed by the '439 patent, *i.e.*, preventing cracking and improving durability of small-sized capacitors, and that the Noji application discloses all of the limitations of the claim 1 of the '439 patent except the limitation requiring a WG/EW ratio of 0.32. (Mot. Mem. at 26-27.) Samsung argues that the Kukutsu application teaches a WG/EW ratio of 0.32 and that one of ordinary skill in the art at the time of the invention would have found it obvious to combine the ratio disclosed in Kukutsu with the capacitor disclosed by the Noji application. (*Id.*)

Murata argues that the Noji and Kukutsu applications do not disclose all of the limitations of the asserted claims of the '439 patent and that the references address entirely different concerns than those dealt with in the '439 patent. (Opp. at 41.) In particular, Murata argues that the Noji application does not address or teach techniques related to thermal shock and humidity reliability concerns. (*Id.*) According to Murata, the Koji application only addresses the handling of forces inflicted from the outside, not thermal stresses from the inside. (*Id.*) Murata notes that

² Samsung argues that the USPTO recently granted Samsung's request for reexamination of claims 1-5 of the '439 patent and that the patent office rejected claims 1-5 of the '439 patent as obvious over the Noji and Kukutsu applications. (Mot. Mem. at 25.) The Administrative Law Judge rejects this argument. An office action that is issued prior to completion of the reexamination process does not constitute a final determination on the merits regarding patent validity and thus is irrelevant to the present motion for summary determination. *See Synthes v. Reis*, 2010 U.S. Dist. LEXIS 15121, at *6 (S.D. Cal. Feb. 22, 2010) (citing 35 U.S.C. 314, 315). Additionally, the Administrative Law Judge notes that "litigation and reexamination are distinct proceedings, with distinct parties, purposes, procedures and outcomes." *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988).

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the solution contemplated in the Noji application involves constraining certain dimensional ratios to a pre-determined range of values, but argues that Noji only addresses this issue on one plane while the '439 patent covers both the vertical and horizontal axes. (*Id.*) Murata also argues that there is nothing in the Koji application that discloses or discusses the importance of the Side Width Ratio, nor the relationship between the Side Width Ratio and the Thickness Ratio. (*Id.*) With regard to the Kukutsu application, Murata argues that the application is directed to a method of increasing the yield of an MLCC by preventing the external electrodes from evaporating during firing of the capacitor. (*Id.*) Unlike the '439 patent, Murata argues that the problem addressed by Kukutsu is not a mechanical problem at all, but rather a problem with the electrode material being susceptible to evaporation. (*Id.*) According to Murata, the Kukutsu application does not discuss cracking, delamination, or part reliability in any way. Murata further argues that Kukutsu does not discuss the importance of the Side Width Ratio or the Thickness Ratio that are the essence of the '439 patent. (*Id.* at 41-42.)

Obviousness is a question of law based on underlying findings of fact. *Source Search Techs., LLC v. LendingTree, LLC*, 588 F.3d 1063, 1069 (Fed. Cir. 2009). The underlying factual considerations include “(1) the scope and content of the prior art, (2) the differences between the prior art and the claimed invention, (3) the level of ordinary skill in the art, and (4) any relevant secondary considerations.” *Id.*; see also *Ball Aerosol and Specialty Container, Inc. v. Limited Brands, Inc.*, 555 F.3d 984, 991 (Fed. Cir. 2009) (citing *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966)). A patent claim is invalid for obviousness “if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.” 35 U.S.C. § 103. Factual disputes regarding the

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underlying considerations for obviousness preclude a ruling of summary determination of invalidity. *Source Search Techs.*, 588 F.3d at 1073; *Certain 3G Mobile Handsets and Components*, Inv. No. 337-TA-613, Order No. 30 at 2 (U.S.I.T.C., April 14, 2008).

As stated above, Samsung argues that the Noji application discloses all of the limitations of claim 1 of the '439 patent except the limitation requiring a WG/EW ratio of 0.32. Thus, according to Samsung, the Noji application discloses the limitation of claim 1 of the '439 patent requiring "a plurality of inner electrodes disposed in the sintered ceramic block such that said plurality of inner electrodes overlap, in a thickness direction, with one another via ceramic layers." However, Samsung does not address this limitation in its memorandum in support of its motion for summary determination. (*See Mot. Mem.* at 26-28.) Samsung merely states that "[t]he capacitor of Noji's Figure 1 also satisfies element (b) because it discloses a plurality of inner electrodes that extend from one side face of the ceramic part to the opposite side face without reaching it." (*Id.* at 26.) Nowhere does Samsung specifically discuss whether the Noji application discloses that the inner electrodes overlap in a thickness direction. Dr. Randall, whose declaration is attached in support of the motion for summary determination, also does not discuss whether the inner electrodes overlap in a thickness direction, other than to state in conclusory fashion that the "internal electrodes [shown in Figure 1] are the same feature as described in the second paragraph of claim 1 of the '439 patent." (*See Id.*, Randall Decl. ¶ 44.)

Although neither Samsung nor Dr. Randall explains where the Noji application discloses inner electrodes that overlap in a thickness direction, both rely on Figure 1 of the Noji application in support of their argument, and thus an examination of Figure 1 is in order. Looking at Figure 1 of the Noji application, the Administrative Law Judge finds that it is not possible to discern whether in fact the inner electrodes overlap in a thickness direction. Figure 1

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only shows a single aspect view of the inner electrodes in the ceramic block. Without seeing other perspectives, *e.g.*, an isometric view, one cannot determine whether the electrodes truly overlap in a thickness direction.

For the reasons discussed above, the Administrative Law Judge finds that Samsung has failed to prove by clear and convincing evidence that the Noji application discloses “a plurality of inner electrodes disposed in the sintered ceramic block such that said plurality of inner electrodes overlap, in a thickness direction, with one another via ceramic layers.” As discussed above, Samsung relies entirely on the Koji application for the disclosure of the above limitation, thus Samsung has failed to prove that the Noji application combined with the Kukutsu application discloses all the limitations of independent claim 1 of the ‘439 patent. For these reasons, the Administrative Law Judge concludes that Samsung has failed to prove by clear and convincing evidence that claim 1 of the ‘439 patent is obvious in light of the Noji application in view of the Kukutsu application. Because Samsung has failed to prove that independent claim 1 is obvious, Samsung cannot establish that the Noji application in view of the Kukutsu application renders obvious dependent claims 2, 3 and 5.

For the reasons discussed above, the Administrative Law Judge finds that Samsung and the Staff have failed to prove by clear and convincing evidence that the asserted claims of the ‘439 patent are invalid as either anticipated or obvious. Accordingly, Samsung’s motion for summary determination of invalidity, Motion Docket No. 692-010, is hereby DENIED in full.

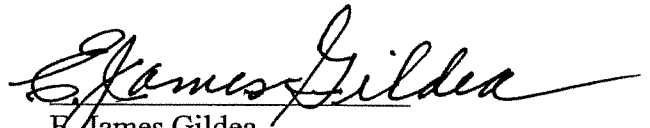
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Any party seeking to have any portion of this document deleted from the public version thereof must submit to this office a copy of this document with red brackets indicating any portion asserted to contain confidential business information. The parties' submissions concerning the public version of this document need not be filed with the Commission Secretary.

SO ORDERED.


James Gildea
Administrative Law Judge

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I, Marilyn R. Abbott, hereby certify that the attached **ORDER** has been served by hand upon, the Commission Investigative Attorney, **Aarti Shah, Esq.**, and the following parties as indicated on June 7, 2010.


Marilyn R. Abbott, Secretary
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**IN THE MATTER OF CERTAIN CERAMIC
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