

United States District Court,
N.D. California.

JSR CORPORATION, and JSR Microelectronics, Inc,
Plaintiffs.

v.
TOKYO OHKA KOGYO CO., LTD., and Ohka America, Inc,
Defendants.

Nos. C 99-20156 JW, 403, 369, 400

Sept. 13, 2001.

**ORDER GRANTING DEFENDANTS' MOTION FOR PARTIAL SUMMARY JUDGMENT THAT
THE ASSERTED CLAIMS OF THE '104 PATENT ARE INVALID AS ANTICIPATED UNDER 35
U.S.C. s. 102(a), (b), AND (g).**

WARE, J.

I. INTRODUCTION

Defendants, Tokyo Ohka Kogyo Co., Ltd. and Ohka America, Inc. (collectively, "TOK"), filed this Motion for Partial Summary Judgment That Asserted Claims Of The '104 Patent Are Invalid As Anticipated Under 35 U.S.C. Sections 102(a), (b), and (g). The Court previously granted the coordinate request by Plaintiffs, JSR Corporation and JSR Microelectronics, Inc. (collectively, "JSR") for continuance until further discovery pursuant to Fed.R.Civ.P. 56(f). (Order of June 5, 2001.) The parties filed supplemental briefs, and the Court conducted a hearing on the matter on July 30, 2001, Based on all of the submitted papers and oral arguments, the motion for partial summary judgment of invalidity is GRANTED.

II. BACKGROUND

The four patents involved in this lawsuit relate to radiation sensitive resin compositions, or photoresist compositions, suitable for use in making integrated circuits. JSR originally asserted that TOK infringed U.S. Patents Nos. 5,405,720 and 5,494,784. On March 27, 2000, JSR added U.S. Patents Nos. 5,215,857 (the " '857 patent") and 6,020,104 (the " '104 patent") to this lawsuit. This motion concerns claims 1, 2, 3, 5, 7, 9, 13, 14, and 15 of the '104 patent, entitled "Radiation-Sensitive Resin Composition Utilizing Monooxymonocarboxylic Acid Ester Solvent." The '104 patent issued on February 1, 2000. It is undisputed that the earliest possible date of invention for the claims of the '104 patent was August 7, 1985, the filing date of the first Japanese Patent Application corresponding to the '104 patent invention. The first U.S. application leading to the '104 patent was filed on July 18, 1986.

The claimed invention relates to radiation-sensitive (photoresist) compositions used in the manufacture of semiconductor chips. FN1 Photoresists generally are comprised of three basic components a radiation sensitive compound, a resin, and a solvent. The sole asserted independent claim in the '104 patent reads:

FN1. TOK provides the following helpful explanation of how a photoresist is used:

In semiconductor fabrication, the photoresist is applied to a wafer as a film. The wafer is then baked so that most of the solvent in the resist evaporates. Radiation is applied to the resist through a mask that defines a

pattern to be transferred to the resist. In the case of positive photoresists, the areas exposed to radiation become soluble in a type of solvent called a developer. Developer is applied to the resist, and the portion of the resist layer that had been exposed to light dissolves and washes away, leaving behind a pattern on the wafer that duplicates that of the mask. When the wafer is etched, the photoresist remaining on the surface protects the layer underneath the photoresist from etching.

(TOK's Opening Brief at 3.)

1. A radiation-sensitive resin composition comprising a solution of an alkali-soluble resin and a radiation-sensitive compound in a solvent comprising a monooxymonocarboxylic acid ester, wherein said monooxymonocarboxylic acid ester solvent is selected so as to be a solvent for both said alkali-soluble resin and said radiation-sensitive compound.

Accordingly, all of the asserted claims require a resin composition comprising (1) an alkali soluble resin; (2) a radiation-sensitive compound; and (3) a solvent comprising monooxymonocarboxylic acid ester, wherein the monooxymonocarboxylic acid ester solvent is a solvent for both the radiation-sensitive compound and the resin. In lieu of claim construction by the Court, the parties submitted a Joint Claim Construction Statement for the newly added '857 and the '104 patents on October 27, 2000.

Critical events underlying this motion involve the spring 1985 use by employees of Kodak of a positive photoresist composition which incorporates the solvent, ethyl 3-ethoxypropionate ("EEP"). Eugene Sheriff, a chemist who was the Project Leader for the development of a photoresist which incorporated EEP, submitted a declaration on behalf of TOK attesting to the following: (1) his group first tested a photoresist containing an alkali-soluble novolak resin, a 1,2-quinonediazide radiation-sensitive compound, and EEP as the solvent in or about the spring of 1985 (Sheriff Decl., para. 3, 9); (2) his group determined prior to August 5, 1985 that the "photoresist prototype would work for semiconductor fabrication" (id., para. 9); and (3) in 1985, he and Dale Morton met with Robert Lavin Wood and others at IBM's East Fishkill Facility to discuss with IBM the possibility of evaluating a photoresist containing the EEP solvent. Sheriff states that he gave a sample of the photoresist with EEP prepared in Kodak's laboratory to someone from IBM during the 1985 trip to IBM. (Id., para. 14, 15).

George Stepanoff, the Marketing Specialist in Kodak's Graphics Imaging Systems Division during the period from about 1984 to 1987, has submitted a declaration stating that on June 25, 1985, he and Dale Morton met with Robert Lavin Wood and others at IBM to discuss the possibility of IBM evaluating Kodak's photoresist compositions that contained EEP, an alkali soluble resin, and a photoresist compound (Stepanoff Decl., para. 4). Stepanoff further declares that on August 1, 1985, he drafted a memorandum reporting that EEP worked well with KMPR 820, and that quart samples of KMPR-820 were prepared for distribution to customers and others prior to August 1, 1985. (Id. para. 8.)

TOK moves for partial summary judgment pursuant to Fed.R.Civ.P. 56(c) and (d) and 35 U.S.C. s. 102(a), (b), and (g), asserting that all of the asserted claims of the '104 patent are invalid as anticipated by prior art.

III. STANDARDS

Summary judgment is proper "if the pleadings, 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 judgment as a matter of law." Fed.R.Civ.P. 56(c). The purpose of summary judgment "is to isolate and dispose of factually unsupported claims or defenses." *Celotex v. Catrett*, 477 U.S. 317, 323-324 (1986).

The moving party "always bears the initial responsibility of informing the district court of the basis for its motion, and identifying those portions of 'the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any' which it believes demonstrate the absence of a genuine issue of material fact." *Id.* at 323. If he meets this burden, the moving party is then entitled to

judgment as a matter of law when the non-moving party fails to make a sufficient showing on an essential element of his case with respect to which he bears the burden of proof at trial. *Id.* at 322-23.

The non-moving party "must set forth specific facts showing that there is a genuine issue for trial." Fed.R.Civ.P. 56(e). The non-moving party cannot defeat the moving party's properly supported motion for summary judgment simply by alleging some factual dispute between the parties. To preclude the entry of summary judgment, the non-moving party must bring forth material facts, i.e., "facts that might affect the outcome of the suit under the governing law ... Factual disputes that are irrelevant or unnecessary will not be counted." *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 247-48 (1986). The opposing party "must do more than simply show that there is some metaphysical doubt as to the material facts." *Matsushita Elec. Indus. Co. v. Zenith Radio*, 475 U.S. 574, 588 (1986).

The court must draw all reasonable inferences in favor of the non-moving party, including questions of credibility and of the weight to be accorded particular evidence. *Masson v. New Yorker Magazine, Inc.*, 111 S.Ct. 2419, 2434-35 (1991) (citing *Anderson*, 477 U.S. at 255); *Matsushita Elec. Indus. Co. v. Zenith Radio*, 475 U.S. 574, 588 (1986); *T.W. Elec. Service, Inc. v. Pacific Elec. Contractors Ass'n*, 809 F.2d 626, 630 (9th Cir.1987). It is the court's responsibility "to determine whether the 'specific facts' set forth by the nonmoving party, coupled with undisputed background or contextual facts, are such that a rational or reasonable jury might return a verdict in its favor based on that evidence." *T.W. Elec. Service*, 808 F.2d at 631. "[S]ummary judgment will not lie if the dispute about a material fact is 'genuine,' that is if the evidence is such that a reasonable jury could return a verdict for the nonmoving party." *Anderson*, 477 U.S. at 248. However, "[w]here the record taken as a whole could not lead a rational trier of fact to find for the non-moving party, there is no 'genuine issue for trial.'" *Matsushita*, 475 U.S. at 587. When evaluating a motion for summary judgment, the court views the record evidence through the prism of the evidentiary standard of proof that would normally apply at trial. *See Anderson*, 477 U.S. at 252-53; *United States Surgical Corp. v. Ethicon, Inc.*, 103 F.3d 1554, 1563 (Fed.Cir.1997).

A patent claim is invalid under 35 U.S.C. s. 102 when all of the elements and limitations recited in the claim are described in a single prior art reference. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 545 (Fed.Cir.1998). "[E]very limitation of a claim must identically appear in a single prior art reference for it to anticipate the claim." *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed.Cir.1997). Furthermore, the prior art reference must satisfy the enablement requirement of 35 U.S.C. s. 112, para. 1 with respect to the disclosure that is alleged to be anticipating. *PPG Indus., Inc. v. Guardian Indus. Corp.*, 75 F.3d 1558, 1566 (Fed.Cir.1996). The party asserting anticipation has the burden of establishing invalidity at trial by clear and convincing evidence. *United States Surgical Corp.*, 103 F.3d at 1563.

IV. DISCUSSION

TOK contends that the asserted claims are invalid based on several independent references. The following chart correlates the claims with the purportedly anticipating references:

(Reference [](Asserted Claims ->)	1	2	3	5	7	9	13	14	15
KMPR 820 with EEP	XX	X	X	X	X				
U.S. Patent No. 4,421,841	X	X							
Great Britain Patent No. 861,871	X	X							
U.S. Patent No. 4,499,171	XX		X	X					
U.S. Patent No. 4,212,935	XX		X	X	X	X	X	X	X

For the reasons discussed below, the Court concludes that the asserted claims are invalid as anticipated by Kodak's invention of KMPR 820 with EEP and by U.S. Patents Nos. 4,421,841, 4,499,171, 4,212,935, and 3,666,473. In light of this conclusion, the Court does not reach the question of whether Great Britain Patent No. 861,871 also serves as a basis for invalidating the asserted '104 patent claims.

A. U.S. Patent No. 4,421,841

JSR asserts that the disclosure in the '841 patent does not anticipate claims 1 and 3 of the '104 patent, because the '841 patent does not disclose a radiation-sensitive compound, and because the monooxymonocarboxylic acid ester solvent is not chosen to be a solvent for both a radiation-sensitive compound and the alkali soluble resin. (Willson Decl., para. 8, 9.) The Court finds that JSR has failed to identify a material issue of fact to overcome summary judgment as to anticipation of claims 1 and 3 by the '841 patent.

Although JSR argues that the '841 patent fails to disclose a radiation-sensitive compound, JSR's declarant does not support such a broad statement. "Radiation-sensitive compound" has been defined by the parties as "a compound sensitive to radiation, such as ultraviolet rays, far-ultraviolet rays, x-rays, electron beams, molecular beams, gamma-rays, synchrotron radiation, proton beams and the like." (Frechet Decl. Exh. B (Jt. Claim Construction Statement) at 2, 8.) JSR's expert, Grant Willson, asserts that the photosensitive polyesters require a photoinitiator to begin polymerization in response to irradiation. (Willson Decl., para. 8.) However, Willson does not address the photo-crosslinking response of the photosensitive polyester, which occurs directly in response to radiation independent of the photoinitiator. (Frechet Reply Decl., para. 6-11.) Moreover, even if Willson's assertion that *photo* sensitive polyesters are not radiation sensitive is true, Willson nevertheless admits that, the "photoinitiator responds to irradiation." (*Id.*) Therefore, at a minimum, the photoinitiator is a radiation-sensitive compound in the resin composition. This element of claims 1 and 3 is therefore disclosed in the '841 patent.

JSR also argues that the '841 patent does not describe a photoresist composition where both the photosensitive polyester and the alkali soluble resin are dissolved in the same monooxymonocarboxylic acid ester solvent. While conceding that the '841 patent discloses a "variety of solvents suitable for the [photoresist] composition," Willson asserts that when the solvent is a monooxymonocarboxylic acid ester, it does not teach that the resin as well as the photosensitive polyester may be dissolved in the solvent. (*Id.*, para. 9.) The Court rejects Willson's reading of the patent, which contradicts the plain disclosure in column 10, lines 12-16 of the '841 patent. The patent states, "[t]he photosensitive composition ... is generally produced by dissolving the photosensitive polyester as mentioned above into a solvent and, *optionally, also dissolving other ingredients in the solution.*" (emphasis added.) JSR argues that this general statement does not refer to the monooxymonocarboxylic acid ester category of solvents. JSR contends that when the patent refers to methyl lactate and ethyl lactate, two monooxymonocarboxylic acid ester solvents, the patent does not disclose these particular solvents as solvents for anything other than the photosensitive polyester. The relevant portion of the patent reads:

In the case where the content of the dicarboxylic acid unit containing sulfonate group is higher, the solubility thereof changes greatly and in this case there are some combinations which are less soluble in the solvents as mentioned above.

As the solvent for such photosensitive polyester, those solvents are particularly effective including keto alcohols such as diacetone alcohol, methyl lactate, ethyl lactate, n-butyl lactate and i-butyl lactate, or hydroxy-containing aliphatic acid esters, as well as water.

(See id. at col.10:39-48.) The Court finds JSR's interpretation of column 10 unreasonably narrow in view of examples 1-8 of the '841 patent, and particularly examples 5-8. It is undisputed that in examples 5-8, diacetone alcohol is used as the sole solvent to dissolve a film-forming resin and a photosensitive polyester. (Frechet Reply Decl. para. 14; '841 patent col. 13:59-62.) Diacetone alcohol, like methyl lactate and ethyl lactate, is referred to only as "the solvent for such photosensitive polyester" in column 10 of the patent. However, examples 5-8 clearly show that the general statement at column 10:12-16 that "other ingredients" are optionally dissolved in "the solution" applies to diacetone alcohol and, likewise, to methyl lactate and ethyl lactate.

The Court also rejects JSR's claim that the '841 patent fails to disclose that "the solvent should be selected such that it dissolves both components." To the extent that the disclosure teaches that the solvent can be used to dissolve both components, the disclosure meets this limitation of the claim. Because JSR has failed to raise a genuine dispute of fact regarding anticipation by the '841 patent, the motion is granted as to this reference.

B. U.S. Patents Nos. 4,499,171, 4,212,935, and 3,666,473

TOK contends that claims 1, 2, 5, 7, 9, 13, 14, and 15 of the '104 patent are anticipated by U.S. Patents Nos. 4,499,171, 4,212,935, and 3,666,473 ("the ECA patents"). JSR's sole defense to TOK's allegations of anticipation by these references is that the solvent, ethyl cellosolve acetate ("ECA"), which is used in each of the references, is not a monooxymonocarboxylic acid ester solvent as required by the '104 patent.

Although claim construction is purely a matter of law, to be decided by the Court (Markman v. Westview Instruments, Inc., 517 U.S. 370, 387 (1996)), the Local Rules require the parties to file, early in the lawsuit, a Joint Claim Construction Statement that contains, *inter alia*, "[t]he construction of those claim terms, phrases or clauses on which the parties agree" as well as each party's proposed construction of each disputed claim term. (Patent Local Rule 4-3 (2000) and Civil Local Rule 16-11 (1999).) The parties agreed in their Joint Claim Construction Statement that, for the purposes of the '104 patent, a monooxymonocarboxylic acid ester is:

a compound having a single carboxylic acid ester moiety and an additional moiety containing a single oxygen. A carboxylic acid ester moiety is understood by one of ordinary skill in the art to be a moiety of the general formula:

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A moiety containing a single oxygen includes by way of example, hydroxy groups, alkoxy groups, ethers, acyl groups.

(Frechet Decl., Exh. B (Joint Claim Construction Statement) at 8.) JSR now challenges this construction of the term, asserting that "monooxymonocarboxylic acid ester" "has the structural definition as described in formula I, 2:21 of the '104 patent and the several examples listed in column 2." (Willson Decl., para. 16.) JSR essentially proposes a construction that it *never before* identified or disclosed and implores the Court to adopt JSR's latest definition, which would exclude ECA as a solvent. The Court is not inclined to alter a stipulated claim construction that has been operative for nine months simply because JSR has, upon receipt of TOK's summary judgment motion, recognized that its prior attempt to construe the claim scope broadly inevitably leads to a holding of invalidity in view of the prior art. In particular, the Court is unpersuaded by JSR's apparent position during the hearing that its current definition was intended, though not explicitly included, in the stipulated definition. In fact, the definition that JSR now embraces appears to be the very definition adopted as the stipulated claim construction for the term "monooxymonocarboxylic acid ester" with respect to the '857 patent. FN2 (Joint Claim Construction Statement for U.S. Patent Nos. 5,215,857 and 6,020,104 at 2.) JSR could have agreed to a comparably narrow definition of "monooxymonocarboxylic acid ester" as it is used in the '104 patent, but it did not.

FN2. The narrower definition adopted for the '857 patent is the result of the express reference to

"monooxymonocarboxylic acid esters represented by the following formulas" in claim 1 of the '857 patent.

JSR made the strategic decision to agree to a broad construction of the term, and it now essentially asks the Court for permission to renege on its agreement and to amend the Joint Claim Construction Statement to avoid invalidity. But TOK and the Court relied on the stipulated construction. The parties and the Court abandoned a timely claim construction hearing, and TOK prepared and filed its summary judgment motion. The Court finds that, to ignore the stipulated construction and to consider a never before identified construction of the term in the '104 patent would encourage the "vexatious shuffling of positions" that the patent local rules were designed to avoid. *See Atmel Corp. v. Information Storage Devices, Inc.*, No. C95-1987FMS, 1998 WL 775115 at 2 (N.D.Cal.1998) (refusing to allow amendment of claim charts after claim construction).

Because JSR does not present any evidence to dispute that ECA is a "compound having a single carboxylic acid ester moiety and an additional moiety containing a single oxygen," ECA satisfies the stipulated definition of monooxymonocarboxylic acid ester. JSR's failure to identify any other material disputes of fact would ordinarily result in invalidation of the subject claims and would prevent JSR from asserting these claims against any other defendant. *Blonder Tongue Labs., Inc. v. University of Illinois Found.*, 402 U.S. 313, 346-50 (1971). The Court recognizes that this would be an extraordinarily harsh result given the specific facts in this case. Because the invalidation rationale in this case relies upon a stipulation between the parties in this lawsuit, the Court grants TOK's Partial Summary Judgment motion of invalidity as to anticipation of claims 1, 2, 5, 7, 9, 13, 14, and 15 by the ECA patents only for the purposes of this case.

C. KMPR820 with EEP

TOK also asserts that claims 1, 2, 3, 5, and 7 are invalid under 35 U.S.C. s.s. 102(g), (a), and (b) based upon prior invention, use, and offer for sale of Kodak's KMPR 820 Photoresist with EEP. TOK has established that the KMPR 820 with EEP falls within the scope of these claims, and that the KMPR 820 with EEP was invented prior to JSR's earliest established invention date for the '104 patent. Therefore, the Court concludes that claims 1, 2, 3, 5, and 7 are invalid under 35 U.S.C. s. 102(g).

To establish prior invention under 35 U.S.C. s. 102(g), TOK must show that, before the date of invention by the patentee, the claimed invention was invented by another who did not abandon, suppress, or conceal it. *See Checkpoint Sys., Inc. v. ITC*, 54 F.3d 756, 762 (Fed.Cir.1995). A party is considered the first to invent if it is the first to conceive the invention and then reduces the invention to practice in a reasonably diligent manner. *Mahurkar v. C.R. Bard, Inc.* 79 F.3d 1572, 1577 (Fed.Cir.1996). The Federal Circuit has defined conception as "the formation, in the mind of the inventor of a definite and permanent idea of the complete and operative invention, as it is thereafter to be applied in practice." *Coleman v. Dines*, 754 F.2d 353, 359 (Fed.Cir.1985). The earliest date of invention claimed by JSR is August 7, 1985, the filing date for the related Japanese Patent Application.

TOK has established that the KMPR 820 Photoresist with EEP, prepared and tested in the spring of 1985, satisfies all of the limitations of claims 1, 2, 3, 5, and 7. Eugene Sheriff, who was the project leader for the Kodak Photo Resist Development Program, submits a declaration which states that a KMPR 820 with EEP sample that was made in the spring of 1985 and provided to IBM contains an alkali soluble resin (either CN-53 or CN-73) (Sheriff Decl., para. 16) and a radiation-sensitive compound, which was a 1,2-naphthoquinonediazide (*id.*). Furthermore, Sheriff states that the EEP in KMPR 820 with EEP is selected as a solvent for both the radiation-sensitive compound and the resin. (*Id.*) Sheriff declares that the resist "was a homogeneous solution, with the solid components completely dissolved in the liquids, all liquids thoroughly mixed together, and all components ... uniformly distributed throughout the solution." (*Id.*)

Sheriff's testimony is corroborated by documentary evidence in the form of the Kodak memorandum of July

2, 1985 (Sheriff Decl., Exh. E), which refers to the use of EEP as a "replacement solvent" for KMPR 820; Kodak's "one Liter Formula" for the KMPR 820 (Sheriff Decl., Exh. B); and Stepanoff's August 1, 1985 memorandum (Stepanoff Decl., Exh. D). Sheriff's testimony is further corroborated by (1) the testimony of Robert Lavin Wood, who was present in a June 25, 1985 meeting between Kodak and IBM representatives in which the KMPR 820 photoresist containing EEP was discussed (Wood Decl., para. 3); (2) the testimony of George Stepanoff, who declares that he met with IBM representatives prior to August 7, 1985 to discuss KMPR820 with EEP as the solvent, and further declares that KMPR-820 with EEP comprised an alkali soluble resin and a photoactive compound which were both dissolved in EEP (Stepanoff Decl., para. 4); and (3) the testimony of Dale Morton, who also states that prior to August 7, 1985, he discussed with IBM the possible evaluation of KMPR 820 with EEP. (Morton Decl., para. 3, 4.) The extensively corroborated testimony of Sheriff, who undisputedly is a disinterested witness in this case, provides clear and convincing evidence that KMPR 820 with EEP was conceived prior to August 7, 1985. *See* *Finnegan Corp. v. Internat'l Trade Comm'n*, 180 F.3d 1354, 1368 (Fed.Cir.1999), *Thomson, S.A. v. Quixote Corp.*, 166 F.3d 1172, 1176 (Fed.Cir.1999).

JSR fails in its attempts to raise a dispute of fact regarding whether KMPR 820 with EEP falls within the scope of the claims. It is irrelevant, for example, that Sheriff may not be certain as to which alkali soluble resin or which radiation sensitive compound in particular is used in the photoresist, because Sheriff testifies, and JSR does not dispute, that the composition contains *an* alkali soluble resin and *a* radiation sensitive compound as required by the claim. JSR also asserts that the presence of 4-butyrolactone in the composition provided to IBM in spring of 1985 suggests that EEP was not selected as a solvent for the radiation-sensitive compound and the resin. However, JSR provides no evidentiary support for the proposition that the presence of 4-butyrolactone in a homogeneous solution precludes EEP from being a solvent for the radiation-sensitive compound and the resin. Sheriff's testimony stands uncontested, and is sufficient to establish that KMPR 820 with EEP is a composition falling within the scope of claims 1, 2, 3, 5, and 7.

JSR asserts that the particular formulation of KMPR 820 with EEP that was to be commercialized as KMPR 825 with EEP was "in flux" prior to August 7, 1985. (Opposition Brief at 25-26.) However, the reduction to practice of a commercialized formulation is irrelevant to the question of the conception date followed by diligent reduction to practice. JSR does not dispute, nor can it dispute, that conception of using the EEP solvent with KMPR occurred prior to JSR's invention date. Moreover, JSR does not dispute diligent reduction to practice by Kodak. Even if reduction to practice occurred after August 7, 1985 as JSR asserts, that fact would not alter the fact of Kodak's earlier invention, as long as the reduction to practice occurred diligently after conception.

JSR does not argue that the invention at Kodak was abandoned, suppressed, or concealed. FN3 Accordingly, the Court concludes that a composition falling within the scope of claims 1, 2, 3, 5, and 7 was conceived prior to August 7, 1985 and thereafter diligently reduced to practice. Claims 1, 2, 3, 5, and 7 are thus invalid under 35 U.S.C. s. 102(g). The Court finds it unnecessary to address the merits of whether the claims are also invalid under s.s. 102(a) and (b).

FN3. The question of confidentiality of the invention is irrelevant to the analysis of prior invention under 102(g).

D. Great Britain Patent Specification 861.871

In view of the Court's conclusion that the '841 patent anticipates claims 1 and 3 of the '104 patent, the Court finds it unnecessary to determine whether the '871 specification also renders these claims invalid.

V. CONCLUSION

For the foregoing reasons, TOK's Motion for Partial Summary Judgment is GRANTED. On the basis of U.S. Patent No. 4,421,841, claims 1 and 3 are invalid under 35 U.S.C. s.s. 102(a). In view of Kodak's invention of a photoresist within the scope of claims 1, 2, 3, 5, and 7, these claims are invalid under 35 U.S.C. s.s. 102(g). In addition, claims 1, 2, 5, 7, 9, 13, 14, and 15 are hereby found to be invalid under 35 U.S.C. s.s. 102(a) and 102(b) for the purposes of this case only, in light of the stipulated claim construction and U.S. Patents Nos. 4,499,171, 4,212,935, and 3,666,473.

IT IS SO ORDERED.

N.D.Cal.,2001.

JSR Corp. v. Tokyo Ohka Kogyo Co., Ltd.

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