

Filed on behalf of BeSang Inc.

By: Michelle E. Armond

Douglas R. Wilson

Joseph Li

Yue Han

ARMOND WILSON LLP

4685 MacArthur Court, Suite 390

Newport Beach, CA 92660

Telephone: (949) 932-0778

Email: ipr@armondwilson.com

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

INTEL CORPORATION,
Petitioner,

v.

BESANG INC.,
Patent Owner.

Case No. IPR2023-00991
U.S. Patent No. 7,378,702

PATENT OWNER'S MOTION TO EXCLUDE EVIDENCE

Pursuant to 37 C.F.R. § 42.64(c) and the Scheduling Order (Paper 13), Patent Owner BeSang Inc. (“BeSang”) hereby moves to exclude Exhibits 1040-1046, 1048-1050, 1054, and corresponding paragraphs 22-25 of Dr. Sechen’s reply declaration (EX1037). These exhibits are either irrelevant because Intel never cites to them, or are cited to support Intel’s improper new theory on reply. BeSang timely objected to these exhibits. Paper 23.

I. THE BOARD SHOULD EXCLUDE EXHIBITS 1041, 1043-1045, 1048-1050 AND PORTIONS OF EXHIBIT 1037 (¶¶22-25) UNDER 37 C.F.R. § 42.23(b)

Exhibits 1041, 1043-1045, 1048-1050, and corresponding portions of Dr. Sechen’s reply declaration (EX1037 ¶¶22-25) should be excluded because they constitute new evidence and/or new argument exceeding the proper scope of reply. *See* 37 CFR § 42.23(b); *Sotera Wireless v. Masimo Corp.*, IPR2020-00912, 2021 WL 2384365, at *1 (P.T.A.B. June 10, 2021) (“[M]otions to exclude [are] a potential remedy to exclude certain evidence or argument that would exceed the proper scope of a reply.”).

Exhibits 1041, 1043-1045, and 1048-1050 “were not relied upon to support unpatentability in the Petition.” *Intelligent Bio-Sys. v. Illumina Cambridge*, 821 F.3d 1359, 1369-70 (Fed. Cir. 2016) (“[T]he Board did not err in refusing the reply brief as improper under 37 C.F.R. § 42.23(b) because IBS relied on an entirely new rationale to explain why one of skill in the art would have been motivated to combine

Tsien or Ju with a modification of Zavgorodny.”); *see also Fantasia Trading v. CogniPower*, IPR2021-00067, 2022 WL 1613101, at *12 (P.T.A.B. May 11, 2022) (“[I]t is too late to raise a new motivation to combine with the Reply.”).

Intel’s submitted Exhibits 1041, 1043-1045, and 1048-1050 to support its new reply theory that “[p]rocess optimization is a motivation to combine” Lee and Kim or Aspar in Grounds 1C and 1E. Reply at 10 (citing EX1037 ¶¶22-24, EX1044, EX1049-1050); EX1037 ¶¶22-24 (citing EX1041, EX1043-1045, 1048-1050). This new theory was not included in the Petition, nor does Intel even assert that it was. *See generally* Paper 2; Reply at 10. Instead, Intel argues that Dr. Sechen explained this new theory at his deposition. *See* Reply at 10 (citing EX2039 at 91:17-98:9); EX1037 ¶22 (citing same). Even if true, an expert deposition is too late to add new theories that are required to be in the Petition. 35 U.S.C. § 312(a)(3); *Apple v. MemoryWeb*, PGR2022-00006, Paper 43 at 8-9 (P.T.A.B. Aug. 3, 2023) (“Petitioner cannot rely on Dr. Terveen’s deposition to add a new theory to the proceeding. Rather, Petitioner was required to make its case in the Petition.” (internal citation omitted)). Nowhere in Dr. Sechen’s deposition testimony does he opine that “Aspar’s process would have benefited Lee by adding monocrystalline silicon, which improves performance,” as asserted in the Reply. Reply at 10; EX2039 at 91:17-98:9.

Intel also cites to Dr. Sechen’s original declaration, Reply at 10 (citing EX1003 ¶¶196, 213), but that does not make Intel’s new reply evidence and argument proper. *See, e.g., Caterpillar v. Wirtgen Am.*, IPR2022-01310, 2024 WL 457826, at *17 (P.T.A.B. Feb. 6, 2024) (“[W]here the Reply introduces a new argument relying on structure never identified in the Petition, and based on a ‘state-of-the-art-reference’ only cited in an expert declaration, we decline to consider the new argument.”). Paragraphs 196 and 213 of Dr. Sechen’s original declaration do “not try to make the new argument in the Reply.” *Caterpillar*, 2024 WL 457826, at *17. These two paragraphs instead set forth Dr. Sechen’s opinion that stacking would “allow[] for more efficient quality control” for the Lee/Kim ground 1C, EX1003 ¶196, or the Lee/Aspar ground 1E, EX1003 ¶213. They do not provide the new process optimization motivation Dr. Sechen now offers on reply for these grounds. *Compare* EX1003 ¶¶196, 213 (Sechen original decl.), *with* EX1037 ¶¶22-24 (reply decl.).

Even if Intel’s improper new “process optimization” theory were considered, Intel and Dr. Sechen’s assertion that “Aspar’s process would have benefited Lee by adding monocrystalline silicon, which improves performance,” Reply at 10 (citing EX1037 ¶24), provides no motivation to look to Aspar’s (or Kim’s) stacking, and Dr. Sechen’s concession that monocrystalline silicon layers can be added “using epitaxy” refutes any motivation to combine. Paper 25 at 14-15 (citing EX1037 ¶24).

In sum, Exhibits 1041, 1043-1045, and 1048-1050 “should be excluded from evidence and ... the corresponding portions of the reply should not be considered.” *Dexcom v. Waveform Techs.*, IPR2016-01680, 2018 WL 1137089, at *12-13 (P.T.A.B. Feb. 28, 2018) (internal citation omitted). Paragraphs 22-25 of Dr. Sechen’s reply declaration relying on these exhibits should be excluded for the same reasons. *Acceleration Bay v. Activision Blizzard*, 908 F.3d 765, 775 (Fed. Cir. 2018) (affirming Board’s refusal to consider new reply declaration opinion because “petitioner[] had an opportunity to present this argument in its petition, but chose not to.”).

II. THE BOARD SHOULD EXCLUDE EXHIBITS 1040, 1042, 1046, AND 1054 UNDER FRE 401-402

Exhibits 1040, 1042, 1046, and 1054 should be excluded because they are irrelevant and therefore inadmissible. Intel filed these four exhibits with its Reply (Paper 21). However, because neither Intel nor its expert cites or relies on these four exhibits, they are not relevant to any issue in this IPR and should be excluded under FRE 401-402. *See* Reply; EX1037; Fed. R. Civ. P. 402 (“Irrelevant evidence is not admissible.”); *SK Innovation v. Celgard*, IPR2014-00680, 2015 WL 5722451, at *16 (P.T.A.B. Sept. 25, 2015) (granting motion to exclude “[b]ecause Patent Owner does not explain where it cited [the exhibits] in this proceeding”).

III. CONCLUSION

For the reasons stated above, Patent Owner respectfully requests the Board exclude Exhibits 1040-1046, 1048-1050, 1054, and Exhibit 1037 ¶¶22-25.

ARMOND WILSON LLP

Dated: August 21, 2024

By: /Michelle E. Armond/
Michelle E. Armond (Reg. No. 53,954)
Douglas R. Wilson (Reg. No. 54,542)
Joseph Li (Reg. No. 74,998)
Yue Han (Reg. No. 80,950)
Attorneys for BeSang Inc.

CERTIFICATE OF SERVICE

The undersigned certifies that pursuant to 37 C.F.R. § 42.6(e), a true copy of the foregoing **PATENT OWNER’S MOTION TO EXCLUDE EVIDENCE** is being served electronically on August 21, 2024 to the following counsel for Petitioner to the following email addresses:

Jessica Kaiser
kaiser-ptab@perkinscoie.com

Tyler Bowen
bowen-ptab@perkinscoie.com

ARMOND WILSON LLP

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Michelle E. Armond (Reg. No. 53,954)
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Joseph Li (Reg. No. 74,998)
Yue Han (Reg. No. 80,950)
Attorneys for BeSang Inc