

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LAM RESEARCH CORP.,
Petitioner,

v.

INPRIA CORP.,
Patent Owner.

Case No. IPR2024-00033

Patent No. 9,823,564

**PETITIONER'S MOTION FOR AUTHORIZATION TO COMPEL
TESTIMONY AND PRODUCTION OF DOCUMENTS
UNDER 37 C.F.R. § 42.52(a)**

Pursuant to the Board’s authorization provided on November 16, 2024 (Ex. 3007), Petitioner Lam Research Corp. respectfully moves the Board for authorization to compel discovery and production of documents pursuant to 37 C.F.R. § 42.52(a)—including to issue subpoenas pursuant to 35 U.S.C. § 24 and file any testimony or documents produced therefrom—to address the public availability of the Stowers 2008 Dissertation before August 5, 2010, which is the earliest claimed priority date of the ’564 Patent. The motion is opposed by Patent Owner Inpria Corp.

I. BACKGROUND

To further corroborate a publication date of the Stowers 2008 Dissertation published by Oregon State University (“OSU”), Petitioner previously reached out to a third-party publisher, ProQuest, who informed Petitioner’s counsel that ProQuest published the Dissertation in January 2009. *See* Bregman Decl. ¶5. As is customary, Petitioner’s counsel requested a declaration attesting to this fact. *Id.* ProQuest provided the declaration, which was filed with Petitioner’s Reply. *See* Ex. 1041.

Patent Owner objected to the declaration as not including the full penalty of perjury language. *See* Paper 30. In response, Petitioner asked ProQuest if it could update the declaration. *See* Bregman Decl. ¶6. At ProQuest’s request, Petitioner provided a copy of the Board’s schedule and Petitioner’s Reply, which laid out the relevant facts in dispute, including whether OSU had their own embargo on their separate publication. *Id.*

While working through this process, ProQuest informed Petitioner on a call that it had identified a typographical error in the publication date and that the declaration should have identified March 2009 as the publication date instead of January 2009. *Id.* at ¶7. This change of two months did not materially change the nature of the evidence, as the March 2009 publication date was still over a year before the earliest purported priority date of the '564 Patent. *Id.*

When ProQuest provided its supplemental declaration on November 8, 2024, to the surprise of Petitioner's counsel, ProQuest recanted its prior sworn testimony, changing the public availability date from January 2009 to December 2009 (and not March 2009), and noting for the first time in the new declaration, without explanation, that it had its own embargo on the Stowers 2008 Dissertation. *Id.* at ¶8. The first time that Petitioner learned of the new date and purported ProQuest embargo was when Petitioner's counsel read the draft Supplemental Declaration on November 8, 2024. *Id.*

When Petitioner's counsel spoke to ProQuest's in-house counsel on November 12, 2004 (two business days after receiving the draft Supplemental Declaration), he informed Petitioner's counsel that ProQuest had relevant documents but would not share them with Petitioner unless Petitioner's counsel sought them via a subpoena. *Id.* at ¶9. Petitioner's counsel then sent the supplemental declaration to Inpria's counsel on the same day (November 12, 2024), noting that ProQuest had

changed its prior sworn testimony, and that Petitioner's counsel intended to ask the Board for authorization to file a motion to compel ProQuest to provide the relevant documents and a deposition witness to explain what evidence was originally relied on for the January 2009 date and why their prior sworn testimony changed. *Id.* at ¶10.

Although the ProQuest-published version of the Stowers 2008 Dissertation was only being used as corroborating evidence, Paper 17 at 9-10, Petitioner was troubled by ProQuest changing its sworn testimony and then declining to provide any explanation or evidence that justified this unexpected and dramatic change in position, Bregman Decl. ¶11.

Before these events, Petitioner's counsel had facilitated arranging the ProQuest declarant's deposition for November 18, 2024. *Id.* at ¶12. But, on November 13, 2024, Quinn Emanuel sent the parties an email saying that they were engaged to represent ProQuest in this matter and asked for the deposition to be taken off calendar while they investigate the facts. *Id.*

On November 14, 2024, after conferring with Patent owner's counsel, Petitioner's counsel contacted the Board for authorization to compel production of documents and testimony from ProQuest pursuant to § 42.52. *See* Ex. 3007. On November 15, 2024, the Board authorized the present Motion. *Id.*

II. THE BOARD SHOULD AUTHORIZE A SUBPOENA

Discovery is available when “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5); *see also* 37 C.F.R. § 42.51(b)(2). As discussed below, a subpoena of ProQuest is necessary in the interest of justice according to the five factors set forth in *Garmin International, Inc. v. Cuozzo Speed Techs. LLC*, No. IPR2012-00001, Paper 26 (PTAB Mar. 5, 2013).

A. There is more than a possibility and mere allegation that ProQuest has information demonstrating the Stowers 2008 Dissertation’s status as prior art.

Evidence showing that the Stowers 2008 Dissertation was publicly accessible before June 1, 2010 is useful because any such evidence is relevant to determining whether the Stowers 2008 Dissertation qualifies as prior art to the challenged claims. *See Canon Inc. v. Avigilon Fortress Corp.*, Nos. IPR2019-00311, IPR2019-00314, Paper 24 at 5 (PTAB Sept. 6, 2019) (finding factor 1 favored granting petitioner’s request for information regarding publications from the Library of Congress where, *inter alia*, “evidence showing [the publications] were publicly accessible before October 1999 is useful ... because any such evidence is relevant to determining whether Kellogg qualifies as prior art to the challenged claims”).

There is more than a mere possibility or allegation that ProQuest can provide testimony or documents tending to show the prior art status of the Stowers 2008 Dissertation because the evidence of record already shows that ProQuest has

relevant information. *See* Ex. 2041. Moreover, ProQuest’s in-house counsel has represented that ProQuest has additional documents relevant to the Dissertation’s public availability, but would not share them with Petitioner unless Petitioner’s counsel sought them via a subpoena. *See* Bregman Decl. ¶9. And the exchange of the draft Supplemental Declaration has raised certain discrepancies that must be resolved in connection with establishing when ProQuest published the Stowers 2008 Dissertation.

B. The requested subpoena does not request information about Inpria’s litigation positions or the basis for those positions.

The proposed subpoena is limited to information about facts from the third party published ProQuest surrounding the public availability their independent publication of the Stowers 2008 Dissertation. The proposed discovery does not call for any information about Inpria’s litigation positions or underlying basis for them.

C. There is no ability to generate equivalent information by other means.

As a publisher of the Stowers 2008 Dissertation and as the party having already submitted conflicting sworn declarations regarding its public availability (Ex. 2041), ProQuest is in a unique position to corroborate the public availability of the Stowers 2008 Dissertation and resolve the discrepancies raised by the draft Supplemental Declaration. Petitioner attempted to obtain the information from ProQuest without formal discovery, but ProQuest refused to provide the information

voluntarily. *See* Bregman Decl. ¶9.

D. The instructions are easily understandable.

As shown by the draft subpoena at Exhibit A, the instructions are clear and concise. They merely request documents and testimony concerning ProQuest and its declarant's determination of the first date when the Stowers 2008 Dissertation was made publicly available, as well as documents and communications concerning the alleged embargo. The Stowers 2008 Dissertation for which information is sought is clearly and unambiguously described.

E. The requests are not overly burdensome to answer.

As shown by the draft subpoena in Exhibit A, the requests are appropriately tailored for the limited purpose of corroborating the public availability of the Stowers 2008 Dissertation in response to Patent Owner's objections. Because the requests are limited to information about the publication of a single dissertation, because ProQuest has already identified the relevant documents, and because ProQuest had already previously agreed to make the declarant available for a deposition, the request poses no excessive burden on ProQuest in terms of financial cost or human resources.

The limited scope of the subpoena also does not present a burden for meeting the timeline for deciding this *Inter Partes* Review. The narrow issue of the public availability of ProQuest's publication of the Stowers 2008 Dissertation does not

affect Patent Owner's ability to address the substantive positions set forth in the Petition. There is ample time for information to be produced in response to the subpoena and for the information to be considered by the parties in advance of the deadline for motions to exclude evidence in January 2025. *See* Paper 14.

* * *

Petitioner therefore submits that each of the five *Garmin* factors weighs in favor of additional discovery and demonstrates that a subpoena of ProQuest is in the interest of justice.

III. PETITIONER'S REQUEST IS TIMELY

Petitioner's request is timely, having been made less than one month after Inpria's objections to Exhibit 1041. *See* Paper 30 (objecting to Exhibit 1041). The Board's decisions in other cases confirm this timeline is not grounds for denying the requested discovery. *See, e.g., Google, LLC v. IPA Techs., Inc.*, No. IPR2019-00730, Paper 55 at 2-4 (Apr. 14, 2020) (granting petitioner's request for additional discovery almost seven months after institution of trial); *Marvell Semiconductor, Inc. v. Intellectual Ventures I LLC*, No. IPR2014-00552, Paper 29 at 1-3 (Feb. 11, 2015) (granting post-institution motion to compel testimony and production).

Granting this Motion will not adversely affect the proceeding's schedule. The requested discovery is narrowly tailored to address one issue: the public availability of ProQuest's publication of the Stowers 2008 Dissertation. Patent Owner will have

the opportunity to address any evidentiary concerns arising from the discovery in a motion to exclude, which is not due until January 2025. *See* Paper 14.

IV. CONCLUSION

Petitioner respectfully requests permission to apply for issuance of a subpoena to ProQuest pursuant to 35 U.S.C. § 24.

Dated: November 19, 2024

Respectfully Submitted,

/ Dion M. Bregman /
Dion M. Bregman (Reg. No. 45,645)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), it is hereby certified that on November 19, 2024 an electronic copy of this PETITIONER’S MOTION FOR AUTHORIZATION TO COMPEL TESTIMONY AND PRODUCTION OF DOCUMENTS UNDER 37 C.F.R. § 42.52(a) and EXHIBIT A were served via email to Patent Owner’s counsel of record in this proceeding:

Naveen Modi (naveenmodi@paulhastings.com)
Phillip Citroen (phillipcitroen@paulhastings.com)
Eric Dittmann (ericdittmann@paulhastings.com)
Isaac Ashkenazi (isaacashkenazi@paulhastings.com)
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Michael Wolfe (michaelwolfe@paulhastings.com)

Dated: November 19, 2024

/ Dion M. Bregman /

Dion M. Bregman, Reg. No. 45,645

EXHIBIT A

REQUESTS FOR PRODUCTION OF DOCUMENTS

REQUEST NO. 1: The documents and information on which ProQuest and its declarant, Heather Stewart, originally relied to determine that the dissertation titled “Direct patterning of solution deposited metal oxides” by Jason K. Stowers with a dissertation presentation date of August 14, 2008 and copyright date of 2008 was first made publicly available by ProQuest in January 2009. *See* IPR2024-00033, Ex. 2041.

REQUEST NO. 2: The documents and information on which ProQuest and its declarant, Heather Stewart, relied to determine that the dissertation titled “Direct patterning of solution deposited metal oxides” by Jason K. Stowers with a dissertation presentation date of August 14, 2008 and copyright date of 2008 was first made publicly available by ProQuest in March 2009.

REQUEST NO. 3: The documents and information on which ProQuest and its declarant, Heather Stewart, relied to determine that the dissertation titled “Direct patterning of solution deposited metal oxides” by Jason K. Stowers with a dissertation presentation date of August 14, 2008 and copyright date of 2008 was first made publicly available by ProQuest in December 2009.

REQUEST NO. 4: Documents and communications concerning any embargo placed on the public release of the full text of the Stowers 2008 Dissertation.

REQUEST NO. 5: Communications with Inpria, Dr. Stowers, or Oregon State University, or any party on their behalf, regarding the Stowers 2008 Dissertation.

REQUEST FOR DEPOSITION TOPICS

TOPIC NO. 1: The date on which the dissertation titled “Direct patterning of solution deposited metal oxides” by Jason K. Stowers with a dissertation presentation date of August 14, 2008 and copyright date of 2008 was first made publicly available by ProQuest.

TOPIC NO. 2: The manner by which ProQuest and its declarant, Heather Stewart, determined that the dissertation titled “Direct patterning of solution deposited metal oxides” by Jason K. Stowers with a dissertation presentation date of August 14, 2008 and copyright date of 2008 was first made publicly available by ProQuest in January 2009. *See* IPR2024-00033, Ex. 2041.

TOPIC NO. 3: The manner by which ProQuest and its declarant, Heather Stewart, determined that the dissertation titled “Direct patterning of solution deposited metal oxides” by Jason K. Stowers with a dissertation presentation date of August 14, 2008 and copyright date of 2008 was first made publicly available by ProQuest in March 2009.

TOPIC NO. 4: The manner by which ProQuest and its declarant, Heather Stewart, determined that the dissertation titled “Direct patterning of solution deposited metal oxides” by Jason K. Stowers with a dissertation presentation date of August 14, 2008 and copyright date of 2008 was first made publicly available by ProQuest in December 2009.

TOPIC NO. 5: Documents and communications concerning any embargo placed on the public release of the full text of the Stowers 2008 Dissertation.

TOPIC NO. 6: Communications with Inpria, Dr. Stowers, or Oregon State University, or any party on their behalf, regarding the Stowers 2008 Dissertation.

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DECLARATION OF DION M. BREGMAN

I, Dion M. Bregman, do hereby declare as follows:

1. I am an attorney with the law firm Morgan, Lewis & Bockius LLP, and I am one of the attorneys for Petitioner Lam Research Corp. in the above-captioned matter.

2. I am a member in good standing of the Bar of the State of California.

3. I am over the age of 18, competent, and if called to testify concerning the contents of this declaration, would do so truthfully.

4. I submit this declaration in accordance with 28 U.S.C. § 1746(2) and in support of Petitioner's Motion for Authorization to Compel Testimony and Production of Documents under 37 C.F.R. § 42.52(a).

5. To further corroborate a publication date of the Stowers 2008 Dissertation published by Oregon State University ("OSU"), Petitioner previously reached out to a third-party publisher, ProQuest, who informed Petitioner's counsel that ProQuest published the Dissertation in January 2009. One of my firm's research analysts contacted ProQuest to request a declaration attesting to this fact. ProQuest provided the declaration, which was filed with Petitioner's Reply. *See* Ex. 1041.

6. In response to Patent Owner's objection to the declaration as not including the full penalty of perjury language, Petitioner's counsel asked ProQuest if it could update the declaration. At ProQuest's request, Petitioner's counsel provided a copy of the Board's schedule and Petitioner's Reply, which laid out the

relevant factual disputes, including whether OSU had its own embargo on their separate publication.

7. While working through this process, ProQuest informed me on a telephone call that it had identified a typographical error in the publication date and that the declaration should have identified March 2009 as the publication date instead of January 2009. This change of two months did not materially change the nature of the evidence, as the March 2009 publication date was still over a year before the earliest purported priority date of the '564 Patent.

8. When ProQuest provided its supplemental declaration on November 8, 2024, to the surprise of me and my team, ProQuest recanted its prior sworn testimony, changing the public availability date from January 2009 to December 2009 (and not March 2009), and noting for the first time in the new declaration, without explanation, that it had its own embargo on the Stowers 2008 Dissertation. The first time that we learned of the new date and purported ProQuest embargo was when Petitioner's counsel read the draft Supplemental Declaration on November 8, 2024.

9. On November 12, 2004, which was two business days after receiving the draft Supplemental Declaration with the December 2009 date, I spoke with ProQuest's in-house counsel. ProQuest's in-house counsel informed me that

ProQuest had relevant documents but would not share them unless we sought the documents via a subpoena.

10. On November 12, 2024—the same day on which I spoke with ProQuest’s in-house counsel—I sent the supplemental declaration to Inpria’s counsel, noting that ProQuest’s declarant had purportedly recanted her prior sworn testimony, and that we intended to ask the Board for authorization to file a motion to compel ProQuest to provide the relevant documents and a deposition witness to explain what evidence was originally relied on for the January 2009 date and why the prior sworn testimony purportedly changed.

11. Although the ProQuest-published version of the Stowers 2008 Dissertation was only being used as corroborating evidence, Paper 17 at 9-10, we were troubled by ProQuest changing its sworn testimony and then declining to provide any explanation or evidence that justified this unexpected and dramatic change in position.

12. Before these events, we had facilitated arranging the ProQuest declarant’s deposition for November 18, 2024. But, on November 13, 2024, Quinn Emanuel sent the parties an email saying that they were engaged to represent ProQuest in this matter and asked for the deposition to be taken off calendar while they investigate the facts.

Dated: November 19, 2024

Respectfully Submitted,

/ Dion M. Bregman /

Dion M. Bregman (Reg. No. 45,645)

CERTIFICATE OF SERVICE

Pursuant to 37 C.F.R. § 42.6(e)(4), it is hereby certified that on November 19, 2024 an electronic copy of this DECLARATION OF DION M. BREGMAN was served via email to Patent Owner's counsel of record in this proceeding:

Naveen Modi (naveenmodi@paulhastings.com)
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Dated: November 19, 2024

/ Dion M. Bregman /

Dion M. Bregman, Reg. No. 45,645