

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LAM RESEARCH CORP.,
Petitioner

v.

INPRIA CORP.,
Patent Owner.

Case IPR2024-00033
Patent 9,823,564

**PATENT OWNER'S OPPOSITION
TO PETITIONER'S MOTION FOR AUTHORIZATION TO COMPEL
TESTIMONY AND PRODUCTION OF DOCUMENTS**

I. INTRODUCTION

Petitioner Lam's motion represents a remarkable attempt to confuse the record, pointing to smoke of a fire that Lam itself started. As Inpria explained in its Patent Owner's Response, supported by Dr. Stowers' testimony, Stowers 2008 was the subject of an embargo that made it unavailable to the public until October 2009 at the earliest. POR, 25-28. In an attempt to rebut this, Lam reached out to ProQuest to obtain a declaration from Ms. Stewart to support an asserted January 2009 publication date, though it apparently did not mention the embargo issue to ProQuest. When ProQuest learned of the embargo issue, after Ms. Stewart submitted her original declaration, ProQuest investigated and confirmed that, consistent with Dr. Stowers' testimony, there was an embargo on Stowers 2008.

Lam's failure to inform ProQuest of the embargo issue is not a reason for Lam to now be entitled to engage in a futile fishing expedition. Making matters worse, Lam's motion comes near the end of the proceeding, at a time when Inpria will not have a fair opportunity to test any new evidence Lam seeks to introduce—a crucial safeguard given the original, incorrect declaration by Ms. Stewart that Lam asked the Board to credit in its Petitioner's Reply. And Lam has refused to share its own communications with ProQuest, which would be illuminating as to how this issue has arisen and any potential relevant materials that may exist. Lam's motion should be denied.

II. BACKGROUND

Lam's Petition relied on a theory that Stowers 2008 was prior art because, according to Lam, it "published on October 21, 2008." Pet., 19 (citing EX1006, ¶¶44-50). Lam's basis for this argument was library catalog records and MARC records. EX1006, ¶¶44-50. The October 21, 2008 date was based on an "Entered" field in those records. EX1006, 41.

In the Patent Owner's Response, Inpria explained that Stowers 2008 is not prior art because, as Dr. Stowers explained, an embargo prevented Stowers 2008 from publishing until at least October 2009. POR, 25-28 (citing EX2008, ¶¶4-8). Inpria also explained that the "Entered" date that Lam relied on was insufficient to show public accessibility in light of the embargo. POR, 27-28; EX2012.

According to Lam, it contacted ProQuest to request a "customary" declaration confirming that Stowers 2008 purportedly published in January 2009. Mot. 1. Lam does not state whether it told ProQuest about the embargo issue; and, as noted above, Lam refuses to share its communications with ProQuest. EX3007, 3 ("It is plain from the facts that Lam simply did not inform ProQuest before submitting Ms. Stewart's declaration that there was evidence that an embargo existed as to Dr. Stowers' thesis, as Dr. Stowers has testified."); EX2014. Nor does Lam state it requested ProQuest's records when it submitted Ms. Stewart's original declaration, even though Ms. Stewart's declaration referenced such records. EX1041, ¶10. After

sharing Lam’s Petitioner’s Reply with ProQuest, thus putting ProQuest on notice about the embargo at issue in this proceeding, Mot. 1, ProQuest investigated the issue and confirmed there was an “embargo on the Stowers 2008 Dissertation” and that ProQuest did not make Stowers 2008 publicly available until December 2009 pursuant to the embargo. Mot. 2; *see also* EX2013.

III. LAM’S MOTION SHOULD BE DENIED

Additional discovery is only available when “necessary in the interest of justice.” 35 U.S.C. § 316(a)(5)(B); *see also* 37 C.F.R. § 42.51(b)(2)(i). Lam fails to meet this strict standard.

A. Lam’s Motion Is Untimely and Prejudicial

The interest of justice standard is not met where a motion is untimely. *See, e.g., Apple Inc. v. Koss Corp.*, IPR2021-00255, Paper 29 at 3-5 (Sept. 1, 2021); *Google LLC v. Cywee Grp. Ltd.*, IPR2018-01257, Paper 97 at 9-10 (June 20, 2019); *UPL Ltd. v. Agrofresh Inc.*, IPR2017-01919, Paper 14 at 2-4 (Mar. 23, 2018). Lam’s motion was filed much later than it could have been, and that delay is prejudicial to Inpria. That alone compels denial of Lam’s motion.

Inpria filed its POR and Dr. Stowers’s declaration putting Lam on notice of the embargo four months ago, on July 31, 2024. Although Lam has refused to share its communications with ProQuest with Inpria (which would make clear the timing and content of those communications), it appears Lam contacted ProQuest sometime

in early August. *See* EX1041, 1 (bearing an “August 13, 2024” date). Lam has never indicated it raised the embargo issue with ProQuest at that time. Ms. Stewart completed and signed her original declaration three months ago, on August 28, 2024. *Id.*, 4. This declaration indicated that “the Record and the full Dissertation” were attached to Ms. Stewart’s declaration. *Id.*, ¶10; *see also id.*, ¶¶3-9. Exhibit 1041 included no attachments whatsoever. This was the timeframe that Lam should have investigated ProQuest’s records—after the declaration was completed and signed in August 2024 and before submitting the declaration with Lam’s Reply on October 23, 2024.

Instead of investigating the missing records, Lam chose to submit the bare declaration without any attachments (also including a deficient oath in the declaration). *See* Paper 30 (objecting to the failure to include both the “necessary oath” and “sufficient facts or data”). According to Lam’s motion, it was not until Inpria objected to Ms. Stewart’s declaration that it reached out to ProQuest to see if ProQuest “could update the declaration.” Mot. 1. It was only then that Lam “laid out the relevant facts in dispute” regarding the embargo, by providing its Reply to ProQuest. *Id.* In other words, Lam did not provide the “relevant facts” regarding the embargo to Ms. Stewart before she signed her declaration and did not investigate the missing records before Lam submitted the declaration.

Lam’s delay is prejudicial to Inpria. Under the existing schedule, Inpria’s Sur-Reply and its Reply in support of its Motion to Amend (or revised Motion to Amend) are both due December 4, only eight days after the filing of this opposition. Thus, it is apparent that any new evidence developed by Lam based on its motion, if granted, would come after Inpria’s papers are due. Inpria would not have a fair opportunity to test the veracity of any new evidence Lam submits—a significant concern given Lam’s submission of Ms. Stewart’s original, incorrect declaration that was signed before Lam presented her the “relevant facts” of the embargo and submitted before Lam investigated the missing records.

B. Lam’s Motion Does Not Meet the *Garmin* Factors

i. Possibility and Mere Allegation

Lam alleges there is more than a mere possibility or allegation that relevant evidence exists by pointing to Ms. Stewart’s original declaration. Mot. 5.¹ As discussed above, this only shows that Lam could have (and should have) addressed this issue sooner but chose not to. *Supra* Section III.A. Lam also alleges that

¹ Throughout its motion, Lam refers to Exhibit “2041,” an Inpria exhibit number that has not yet been assigned. It appears that Lam intended to refer to its own Exhibit 1041, which is Ms. Stewart’s original declaration, which highlights that it was Lam’s submission of this evidence (not Inpria) that has led to this issue.

ProQuest “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.” Mot. 5. As an initial matter, Lam provides no evidence of this communication, as Lam apparently “spoke” to ProQuest and does not appear to have requested that ProQuest memorialize this request in an email. Bregman Decl., ¶¶7, 9.

More significantly, Lam does not allege, much less provide evidence, that any of ProQuest’s records are inconsistent with Ms. Stewart’s supplemental, corrected declaration. And indeed it would make no sense for Ms. Stewart to change her declaration from true testimony to false testimony. Rather, the simple explanation is that Ms. Stewart felt compelled to correct her declaration after she investigated the embargo issue. *Supra* Section II. Inpria does not dispute that ProQuest likely has records dealing with the publication date of Stowers 2008, but Lam has offered nothing beyond speculation that any of ProQuest’s records would be inconsistent with Ms. Stewart’s corrected, supplemental declaration. “The party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something *useful* will be uncovered.” *Garmin Int’l, Inc. v. Cuozzo Speed Techs. LLC*, IPR2012-00001, Paper 26 at 6 (Mar. 5, 2013) (precedential) (emphasis added). Here, Lam has offered nothing to suggest anything *useful* will be uncovered. Indeed, rather than openly sharing the basis for its belief

that something useful exists in the records, *e.g.*, by disclosing its written communications with ProQuest, Lam chooses to keep those communications to itself and only offer characterizations of the conversations in its motion and declaration. EX2014.

For Lam's Request No. 5 and Topic No. 6, Lam's requests are entirely baseless. That is, not only will nothing "useful" be uncovered, but Lam has provided nothing to suggest that anything at all will be uncovered. Indeed, Inpria confirmed the same to Lam by email. EX2014, 2.

ii. Litigation Positions

Inpria does not allege that Lam is seeking Inpria's litigation positions.

iii. Ability to Generate Equivalent Information

Lam misses the point in alleging that it "attempted to obtain the information from ProQuest without formal discovery." Mot. 5. Lam has been in contact with ProQuest since before it filed its Petitioner's Reply. Lam chose not to seek ProQuest's records at that time even though Ms. Stewart directly referenced them in her original declaration. EX1041, ¶10; *see also id.*, ¶¶3-9; *supra* Section II. Instead, Lam chose to not to tell ProQuest about the embargo issue, obtained testimony that it thought was favorable (but unsupported by records), and only now complains because when ProQuest carefully dug into its records, ProQuest felt compelled to correct Ms. Stewart's declaration. *Supra* Section II.

In addition, it bears noting that Inpria itself has consistently requested Ms. Stewart's deposition. Such a deposition would afford the parties an opportunity to generate equivalent information. ProQuest previously offered a deposition date, only took the date off the calendar following the phone conversations between Lam and ProQuest, and indicated that it still intends to "reschedul[e] her deposition as soon as possible." EX2015; EX2016. Paradoxically, Lam's motion and communications with ProQuest have created a new issue in which ProQuest is now concerned it will face two separate depositions and ProQuest, in response, has requested to delay any deposition due to this concern. EX2015. Lam is currently leveraging this double-deposition concern and has recently suggested that Inpria wait to take Ms. Stewart's deposition until after the Board acts on Lam's motion, despite Inpria's papers being due eight days from the filing of this opposition. *Id.*

iv. Instructions

Inpria does not allege that Lam's instructions cannot be understood.

v. Burden

Inpria has no information regarding what burden ProQuest would have in responding to Lam's requests. However, to the extent ProQuest produces new evidence and/or a new witness, that would be prejudicial and burdensome for Inpria to address at this stage of the proceeding for the reasons discussed above. *Supra* Section III.A.

IV. CONCLUSION

Patent Owner Inpria respectfully requests that Petitioner Lam's motion be denied.²

Respectfully submitted,

Dated: November 26, 2024

By: /Daniel Zeilberger/
Daniel Zeilberger (Reg. No. 65,349)
Counsel for Patent Owner

² In opposing Lam's motion, Inpria is not waiving its own separate right to depose Ms. Stewart in view Lam's submission of her original declaration pursuant to routine discovery. 37 C.F.R. § 42.51(b)(1)(ii). Indeed, Inpria requested Ms. Stewart's deposition, and ProQuest only withdrew her availability after Lam accused Ms. Stewart of "recant[ing] her prior sworn testimony." EX2014.

CERTIFICATE OF SERVICE

I hereby certify that on November 26, 2024, I caused a true and correct copy of the foregoing Patent Owner's Opposition to Petitioner's Motion for Authorization to Compel Testimony and Production of Documents to be served by electronic mail on Petitioner at the following correspondence address of record:

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