

From: [Bregman, Dion M.](#)
To: [Wolfe, Michael](#)
Cc: [Zeilberger, Daniel](#); [MLB-Lam-IPR-Team](#); [PH-Lam-Inpria-IPR](#)
Subject: [EXT] RE: ProQuest
Date: Thursday, November 14, 2024 1:50:35 PM

--- External Email ---

[Report Suspicious](#)

Michael,

As we previously informed you, we first learned of the new December 2009 date and the purported ProQuest embargo when we read the declaration. ProQuest did not tell us about these changes in position before we read the declaration. We learned of the March 2009 publication date in a call with ProQuest's counsel, and not in any email communication. As such, there is no routine discovery to provide you on this issue.

The following is our updated proposed email to the Board:

Your Honors,

We represent Petitioner in the captioned proceeding, and request authorization to compel production of documents and testimony from the third party ProQuest pursuant to § 42.52.

The following lays out the facts devoid of argument. Petitioner objects to Patent Owner's argumentative section below, that is replete with unfounded accusations and contrary to the facts.

To further corroborate a publication date of the Stowers 2008 Dissertation published by Oregon State University, Petitioner's reached out to a third party publisher, ProQuest, who informed us that they published this dissertation in January 2009. As is customary, we asked them for a declaration attesting to this fact, which they provided to us and we filed with our Reply.

Patent Owner objected to the declaration as not including the full penalty of perjury language, so Petitioners asked ProQuest if they could update the declaration. At their request, Petitioner provided ProQuest with a copy of the schedule and our Reply brief that laid out the relevant facts in dispute, including whether OSU had their own embargo on their separate publication.

While working through this process, ProQuest informed Petitioner on a call that they 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

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Lam Research Corp. v. Inpria Corp.

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the March 2009 publication date was still over a year before the earliest purported priority date.

When ProQuest sent us their supplemental declaration this past Friday (November 18, 2024), to our surprise, they recanted their prior sworn testimony, changing the public availability date from January 2009 to December 2009, and noting for the first time in their new declaration, without explanation, that they had their own embargo on the publication. See attached Supplemental Declaration. The first time that Petitioner learned of the new date and purported ProQuest embargo was when we read the Supplemental Declaration on Friday afternoon. When we spoke to ProQuest's in-house counsel this week Tuesday (November 12, 2024, and two business days after we received the Supplemental Declaration), he informed us that ProQuest had relevant documents, but that he would not share them with Petitioner unless we sought them via subpoena. We then sent the supplemental declaration to Inpria's counsel on the same day (Tuesday November 12, 2024), noting that ProQuest had changed its prior sworn testimony, and that we intended to ask your honors for authorization to file a motion to compel ProQuest to provide the relevant documents and a deposition witness to explain what evidence they originally relied on for the January 2009 date and why they have now changed their prior sworn testimony.

While the ProQuest publication was only being used as corroborating evidence, we are 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.

Before this turn of events, we had facilitated arranging the ProQuest declarant's deposition for this coming Monday (November 18, 2024). Yesterday (November 13, 2024), Quinn Emanuel sent the parties an email saying that they have been engaged to represent ProQuest in this matter and asked for the deposition to be taken off calendar while they investigate the facts.

In light of these extraordinary events, we ask the Board for urgent authorization to file a motion to compel the third party discovery.

Petitioner does not object to Patent Owner's request to file the Supplemental Declaration with their Sur-Reply, but reserves the right to request from the Board the ability to file any additional evidence forthcoming from ProQuest about its publication date. As is clear from Patent Owner's section below, they have their own speculation about the events that led to ProQuest changing their declaration, which provides further impetus to get to the bottom of this issue by compelling ProQuest to provide the requested discovery.

Petitioner has conferred with Patent Owner's counsel who requested their position be added to the email:

Inpria opposes Lam's request to file a motion to compel third party discovery, and instead requests authorization from the Board to file with Inpria's sur-reply the new supplemental declaration from Ms. Stewart, along with any materials that may develop related to the supplemental declaration (e.g., emails between Lam and ProQuest). It is plain from the facts that Lam simply did not inform ProQuest that there was evidence that an embargo existed as to Dr. Stowers' thesis, as Dr. Stowers has testified, and when ProQuest investigated the issue in preparation for the deposition, Ms. Stewart was compelled to submit a supplemental declaration correcting the record. Lam's lack of diligence is not a reason for a motion to compel, particularly at this late stage.

For example, on November 6, Lam confirmed to Inpria that Ms. Stewart was available for a deposition. According to Lam, on November 8, it learned that "the ProQuest witness has recanted her prior sworn testimony" and had provided a new supplemental declaration. It was not until November 12 that counsel for Lam emailed Inpria to inform Inpria of this development and provide the supplemental declaration. At the same time, on November 12, Lam indicated it was "unclear whether ProQuest still intends to go forward with the deposition." It appears that ProQuest has decided to put the deposition on hold because of Lam's communications to it regarding demands for documents.

Lam has refused to provide its communications with ProQuest and/or Ms. Stewart even though they are not privileged or confidential (Lam has repeatedly insisted it has no control over ProQuest/Ms. Stewart and that ProQuest/Ms. Stewart is an independent third party). Lam has also not indicated that it made any effort to corroborate Ms. Stewart's original testimony before submitting that testimony. Lam's conduct has been extremely prejudicial to Inpria.

The parties are available for a call at your convenience at the following times:

- Any time today (November 14, 2024).
- Friday, November 15 from 9am to 5pm ET.
- Or if your honors are unavailable this week, please let the parties know your availability next week, and we will confer to find a mutually convenient date and time.

We look forward to receiving your guidance and authorization.

Regards,

-Dion Bregman

Dion M. Bregman

Morgan, Lewis & Bockius LLP

1400 Page Mill Road | Palo Alto, CA 94304-1124

Direct: +1.650.843.7519 | Main: +1.650.843.4000 | Fax: +1.650.843.4001

From: Wolfe, Michael <michaelwolfe@paulhastings.com>
Sent: Thursday, November 14, 2024 8:08 AM
To: Bregman, Dion M. <dion.bregman@morganlewis.com>
Cc: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>
Subject: RE: ProQuest

[EXTERNAL EMAIL]

Dion,

We disagree with your unilateral interpretation of the communications you have been having with ProQuest as being not “mandatory to produce as Routine Discovery.” At a bare minimum, both (1) the email you received from ProQuest sending the supplemental declaration itself, and (2) the communication from ProQuest that “the publication date that should have read March 2009” (which you summarize below) are both information inconsistent with Lam’s position that “ProQuest’s publication of Stowers 2008 on **January 15, 2009** further undermines Inpria’s ‘embargo’ theory.” Reply at 10 (emphasis Lam’s). We are not aware of any inconsistent communications on our end to share with Lam and do not appreciate your repeated tactic of asking us to “confirm” an accusation you implicitly lodge without any basis.

Thank you for confirming you first learned of the ProQuest embargo six days ago as well (at the same time as you said you received the supplemental declaration).

Please see our position added to the email below. If you make further changes, we ask you to send it back to us before sending to the Board.

Thanks,
Michael Wolfe

From: Bregman, Dion M. <dion.bregman@morganlewis.com>
Sent: Wednesday, November 13, 2024 9:10 PM
To: Wolfe, Michael <michaelwolfe@paulhastings.com>
Cc: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>
Subject: [EXT] RE: ProQuest

Michael,

We have sent you the supplemental declaration, we explain all the facts in our proposed email to the Board below, and have no other documents that are mandatory to produce as Routine Discovery. Please confirm that you too have no communications with any third parties that are inconsistent with the position that you have taken regarding the availability of the Stowers 2008 Dissertation. As

we already told you, the first we learned of the new date was when we received the supplemental declaration on Friday afternoon from ProQuest. This was also the first time that we learned of the purported ProQuest embargo.

The following is our proposed email to the Board:

Your Honors,

We represent Petitioner in the captioned proceeding, and request authorization to compel production of documents and testimony from the third party ProQuest pursuant to § 42.52.

The following lays out the facts devoid of argument:

To further corroborate a publication date of the Stowers 2008 Dissertation published by Oregon State University, Petitioner's reached out to a third party publisher, ProQuest, who informed us that they published this dissertation in January 2009. As is customary, we asked them for a declaration attesting to this fact, which they provided to us and we filed with our Reply. Patent Owner objected to the declaration as not including the full penalty of perjury language, so Petitioners asked ProQuest if they could update the declaration. While working through this process, ProQuest informed Petitioner that they had identified a typographical error in the publication date that should have read March 2009 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. When ProQuest sent us their supplemental declaration this past Friday, to our surprise, they recanted their prior sworn testimony, changing the public availability date from January 2009 to December 2009, and noting for the first time in their new declaration, without explanation, that they had their own embargo on the publication. See attached Supplemental Declaration. When we spoke to ProQuest's in-house counsel yesterday, he informed us that ProQuest had relevant documents, but that he would not share them with Petitioner unless we sought them via subpoena. Yesterday, we sent the supplemental declaration to Inpria's counsel noting that ProQuest had changed its prior sworn testimony, and that we intended to ask your honors for authorization to file a motion to compel ProQuest to provide the relevant documents and a deposition witness to explain what evidence they originally relied on for the January 2009 date and why they have now changed their prior sworn testimony. While the ProQuest publication was only being used as corroborating evidence, we are 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. Before this turn of events, we had facilitated arranging the ProQuest declarant's deposition for this coming Monday. Earlier today, Quinn Emanuel sent the parties an email saying that they have been engaged to represent ProQuest in this matter and asked for the deposition to be taken off calendar while they investigate the facts.

In light of these extraordinary events, we ask the Board for urgent authorization to file a motion to compel the third party discovery.

Petitioner has conferred with Patent Owner's counsel who requested their position be added to the email:

Inpria opposes Lam's request to file a motion to compel third party discovery, and instead requests authorization from the Board to file with Inpria's sur-reply the new supplemental declaration from Ms. Stewart, along with any materials that may develop related to the supplemental declaration (e.g., emails between Lam and ProQuest). It is plain from the facts that Lam simply did not inform ProQuest that there was evidence that an embargo existed as to Dr. Stowers' thesis, as Dr. Stowers has testified, and when ProQuest investigated the issue in preparation for the deposition, Ms. Stewart was compelled to submit a supplemental declaration correcting the record. Lam's lack of diligence is not a reason for a motion to compel, particularly at this late stage.

For example, on November 6, Lam confirmed to Inpria that Ms. Stewart was available for a deposition. According to Lam, on November 8, it learned that "the ProQuest witness has recanted her prior sworn testimony" and had provided a new supplemental declaration. It was not until November 12 that counsel for Lam emailed Inpria to inform Inpria of this development and provide the supplemental declaration. At the same time, on November 12, Lam indicated it was "unclear whether ProQuest still intends to go forward with the deposition." It appears that ProQuest has decided to put the deposition on hold because of Lam's communications to it regarding demands for documents.

Lam has refused to provide its communications with ProQuest and/or Ms. Stewart even though they are not privileged or confidential (Lam has repeatedly insisted it has no control over ProQuest/Ms. Stewart and that ProQuest/Ms. Stewart is an independent third party). Lam has also not indicated that it made any effort to corroborate Ms. Stewart's original testimony before submitting that testimony. Lam's conduct has been extremely prejudicial to Inpria.

The parties are available for a call at your convenience at the following times:

- Thursday, November 14 from 9am to 5pm ET.
- Friday, November 15 from 9am to 5pm ET.

We look forward to receiving your guidance and authorization.

Regards,

-Dion Bregman

Dion M. Bregman

Morgan, Lewis & Bockius LLP

1400 Page Mill Road | Palo Alto, CA 94304-1124

Direct: +1.650.843.7519 | Main: +1.650.843.4000 | Fax: +1.650.843.4001

Assistant: Marilyn Jean Doris | +1.650.843.7578 | marilyn.doris@morganlewis.com
dion.bregman@morganlewis.com | www.morganlewis.com

From: Wolfe, Michael <michaelwolfe@paulhastings.com>
Sent: Wednesday, November 13, 2024 3:30 PM
To: Bregman, Dion M. <dion.bregman@morganlewis.com>
Cc: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>
Subject: RE: ProQuest

[EXTERNAL EMAIL]

Dion,

We did answer your question, which we called “baseless and false.” And we answered your parenthetical regarding OSU as well, copied again here: “As to OSU, as you know, we do not represent them, but are likewise not aware of any communications between OSU and ProQuest.” We currently have no knowledge of contact between Jason Stowers, Inpria, or OSU with ProQuest regarding this matter. And given your lack of response to our request—“If you are aware of such communications to support your suggestion, please share them immediately”—it seems you are also unaware of any such communications, and are simply lodging baseless accusations in view of Ms. Stewart providing new testimony inconsistent with your argument.

Please forward your communications with ProQuest so we have all the facts before you approach the Board. We note this is mandatory under the Board’s rules 37 C.F.R. § 42.51(b)(1)(iii) as information inconsistent with a position advanced by Lam during the proceeding.

Thank you for confirming you received the supplemental declaration five days ago. Please confirm that is also the first date you learned of the ProQuest’s embargo of Dr. Stowers’s thesis, or if there is an earlier date. In addition, please confirm whether you have had any communications with ProQuest regarding its embargo.

We received Mr. McKee’s email one hour after we sent Lam our response and are only now aware that they are representing Clarivate. Even though Ms. Stewart works for a third party, it was Lam who introduced her declaration, and accordingly it is Lam’s obligation to make her available for deposition.

Please send us the draft email.

Thanks,
Michael Wolfe

From: Bregman, Dion M. <dion.bregman@morganlewis.com>
Sent: Wednesday, November 13, 2024 3:41 PM
To: Wolfe, Michael <michaelwolfe@paulhastings.com>
Cc: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>

Team@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>

Subject: [EXT] RE: ProQuest

Michael,

We note that you have not answered our question about whether anyone associated with Stowers, Inpria, or OSU contacted ProQuest in connection with the current proceedings (including whether you are aware of OSU contacting ProQuest). Please answer this question so we have all the facts before approaching the Board.

The first we learned of the new date was when we received the supplemental declaration on Friday afternoon, and notified you two business days later, on Tuesday.

We would consider providing communications with ProQuest regarding the publication of Stowers 2008, if it is reciprocal, and you provide any communications with third parties (including ProQuest) regarding the publication of Stowers 2008. We know that relevant documents exist at ProQuest, as we were told on a call yesterday by ProQuest's in-house counsel that they have customer documents, which they will not produce absent a subpoena.

While we helped facilitate the deposition on Monday, ProQuest is a third party publisher not under the control of Lam or Morgan Lewis. We have never suggested to ProQuest that the deposition does not need to proceed. As you know, Quinn Emanuel represents ProQuest, and is investigating the facts.

Once we receive your answers to the questions above, we will send you a draft email to the Board.

Regards,

-Dion

Dion M. Bregman

Morgan, Lewis & Bockius LLP

1400 Page Mill Road | Palo Alto, CA 94304-1124

Direct: +1.650.843.7519 | Main: +1.650.843.4000 | Fax: +1.650.843.4001

Assistant: Marilyn Jean Doris | +1.650.843.7578 | marilyn.doris@morganlewis.com

dion.bregman@morganlewis.com | www.morganlewis.com

From: Wolfe, Michael <michaelwolfe@paulhastings.com>

Sent: Wednesday, November 13, 2024 9:14 AM

To: Bregman, Dion M. <dion.bregman@morganlewis.com>

Cc: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>

Subject: RE:

[EXTERNAL EMAIL]

Dion,

Your email raises many questions and concerns.

First, the supplemental declaration includes a November 5 date on its cover page and a November 6 date on its signature page. Either date was early-mid last week. How long have you been aware of this issue? Given Lam was the one that introduced Ms. Stewart's declaration, and now that and she has "recanted her prior sworn testimony," Lam should have immediately notified Inpria and the Board.

Second, with respect to your intended motion for authorization to compel third party discovery from ProQuest and OSU, so that we can consider this request, please share any communications between Lam and ProQuest and/or OSU, including with respect to the embargo on Dr. Stowers's thesis. Such communications would bear on Lam's diligence before filing its Petitioner's Reply and also the likelihood of such materials existing.

Third, your insinuations as to "pressur[ing] [ProQuest] to change the original declaration or to discourage them from sharing the related documentation" are not well received. We remind you of the duty of candor and good faith in PTAB proceedings. Your attempt to impugn the honesty of Dr. Stowers or Inpria is baseless and false. As to OSU, as you know, we do not represent them, but are likewise not aware of any communications between OSU and ProQuest. If you are aware of such communications to support your suggestion, please share them immediately.

Fourth, your statement that "[i]t is unclear whether ProQuest still intends to go forward with the deposition" is confusing. As we have repeatedly reminded you, it is Lam that offered the declaration from Heather Stewart, and it is Lam's responsibility to offer her for a deposition. Please confirm you have not suggested in any way whatsoever to ProQuest that the deposition does not need to proceed. Given it is your burden, please share your communications with Mr. Garry and copy us on communications moving forward to schedule the deposition and coordinate the logistics.

Finally, while we await your responses to our questions above, we remind you that we expect Lam to send us any draft email to the Board before sending it to the Board.

Thanks,
Michael Wolfe

From: Bregman, Dion M. <dion.bregman@morganlewis.com>

Sent: Tuesday, November 12, 2024 7:32 PM

To: Wolfe, Michael <michaelwolfe@paulhastings.com>

Cc: Zeilberger, Daniel <danielzeilberger@paulhastings.com>; MLB-Lam-IPR-Team <MLB-Lam-IPR-Team@morganlewis.com>; PH-Lam-Inpria-IPR <PH-Lam-Inpria-IPR@paulhastings.com>

Subject: [EXT]

Michael,

ProQuest has provided us with a revised declaration from Ms. Stewart. See attached. It is unclear

why the ProQuest witness has recanted her prior sworn testimony, as they are refusing to provide us with records supporting Ms. Stewart's declarations without being subpoenaed to do so. As such, we intend to immediately request Board authorization to file a motion for authorization to compel third party discovery from ProQuest and OSU for all records related to the Stowers 2008 Dissertation, and for a deposition of a knowledgeable witness regarding the Stowers 2008 Dissertation and all related records. Please confirm that no-one associated with Stowers, Inpria, or OSU contacted ProQuest in connection with the current proceedings, including to pressure them to change the original declaration or to discourage them from sharing the related documentation. Please also let us know whether Inpria intends to oppose the request for third party discovery, so we can note this in our email request to the Board.

It is unclear whether ProQuest still intends to go forward with the deposition. Please feel free to contact ProQuest's in-house counsel Ashley Garry (Ashley.Garry@Clarivate.com) to discuss Inpria's noticed deposition, copying us.

Regards,

-Dion

Dion M. Bregman

Morgan, Lewis & Bockius LLP

1400 Page Mill Road | Palo Alto, CA 94304-1124

Direct: +1.650.843.7519 | Main: +1.650.843.4000 | Fax: +1.650.843.4001

Assistant: Marilyn Jean Doris | +1.650.843.7578 | marilyn.doris@morganlewis.com

dion.bregman@morganlewis.com | www.morganlewis.com

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