

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LAM RESEARCH CORP.,
Petitioner,

v.

INPRIA CORP.,
Patent Owner.

IPR2024-00033
Patent 9,823,564 B2

Before GRACE KARAFFA OBERMANN, CHRISTOPHER M. KAISER,
and DEBRA L. DENNETT, *Administrative Patent Judges*.

OBERMANN, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
*Extending the Due Dates and Modifying the Scope of
Supplemental Briefs on the Prior Art Status of Stowers 2008
37 C.F.R. § 42.5*

I. DISCUSSION

A “pivotal issue” in this proceeding is the prior art status of Stowers 2008,¹ which Petitioner asserts in three of the five patentability challenges stated in the Petition. Paper 51 at 2 (citing portions of the parties’ briefs that set forth the dispute); *see* Paper 1 at 3 (grounds chart); *see also* Paper 53 (correcting and clarifying Paper 51).

This proceeding is nearing conclusion. Final oral arguments were heard on January 30, 2025. *See* Transcript of Final Hearing (PTAB Jan. 30, 2025) (“Tr.”) (presently unavailable; to be filed in due course). A final written decision is statutorily due on April 25, 2025. Paper 14 at 1 (header).

On January 8, 2025, the Board issued an Order instructing the parties to complete routine discovery and authorizing post-hearing Supplemental Briefs, which would provide the parties an opportunity to address the relevancy of that routine discovery. Paper 51 at 2. The routine discovery is limited to a deposition of Ms. Heather Stewart, an individual both parties advance as a declarant in this proceeding, and is strictly limited in scope to factual assertions presented by Ms. Stewart in her declarations. *Id.* at 7–8; *see* Ex. 1041; Ex. 2013 (Ms. Stewart’s declarations).

On January 27, 2025, we denied a request by Patent Owner to file “a ‘packet’ of documents” related to Stowers 2008 that Oregon State University produced to Petitioner “in response to a subpoena in related district litigation.” Ex. 3010, 1. We adopt Patent Owner’s convention and refer to those documents as “the OSU packet.” Ex. 3011, 2. In particular, we

¹ Stowers, Jason K., *Direct patterning of solution deposited metal oxides*. Oregon State University, 2009 (Ex. 1008).

instructed the parties that “the Board will entertain no requests to reopen the record, or permit post-hearing briefing or arguments on newly-entered evidence, at this late stage of the proceeding,” except for the relief provided in Paper 51. Ex. 3010, 1. The instant Order modifies that instruction.

On January 30, 2025, the Board heard final oral arguments in this proceeding. During the hearing, the parties updated the Board on the status of their efforts to secure the appearance of Ms. Stewart for a deposition. *See Tr.* At that time, it was clear that, despite the best efforts of the parties, the deposition of Ms. Stewart would not go forward within the timeframe set forth in our Order (Paper 51).

Further, during the hearing, Patent Owner’s counsel presented additional arguments about the relevance of the OSU packet. Based on those arguments, and notwithstanding our prior denial of Patent Owner’s request (*see Ex. 3010*), we authorized Patent Owner to file the OSU packet as a supporting exhibit to its opening Supplemental Brief, currently due for filing on February 19, 2025. *See Tr.*

In response to a question raised by Petitioner’s counsel, we also indicated that the parties may present documents to Ms. Stewart during the deposition to facilitate questioning and, further, that such documents may be filed by either party in support of its opening Supplemental Brief. *Id.* We further advised the parties that our ability to accommodate any request to extend the time deadlines established in Paper 51 would be limited due to the impending statutory deadline by which the Board must enter any final written decision in this proceeding.

On February 6, 2025, Petitioner requested modification of the schedule set forth in Paper 51. Ex. 3011, 1–2 (setting forth Petitioner’s

request and rationale). Patent Owner opposes that request and, further, counters that the Board should “authorize filing of the OSU packet for consideration as corroborative evidence, without introduction of further depositions/exhibits/briefing.” *Id.* at 2.

Based on the information presented, we *grant* Petitioner’s request to extend the deadlines set forth in Paper 51, with the understanding that no further extensions shall be granted, even if the parties are unable to depose Ms. Stewart within the time newly set herein. Although Petitioner seeks to extend the deadline for Ms. Stewart’s deposition (previously set for February 5, 2025) to February 21, 2025 (Ex. 3010), we permit the parties to conduct that deposition on any mutually-convenient date prior to March 5, 2025. We expressly provide notice that the new date for filing opening Supplemental Briefs (March 5, 2025, as set herein) shall not be extended by the Board. We further *deny* Patent Owner’s request to allow introduction of the OSU packet into the record without any opportunity for the parties to brief their respective positions regarding the relevance of that document.

As emphasized during the hearing, no new declarations may be filed in support of any Supplemental Brief. *See* Tr. A party may file new documentary evidence in support of its opening Supplemental Brief, but only to the extent that the new documentary evidence is presented to Ms. Stewart during her deposition, or as provided below in the event that no timely deposition is conducted. In its opening Supplemental Brief, the party filing new evidence shall explain its relevancy to the dispute surrounding the prior art status of Stowers 2008.

To be clear, in view of the importance of the “pivotal issue” at hand, we enlarge the scope of the opening Supplemental Briefs to address not only

“the relevancy of Ms. Stewart’s deposition testimony” but also any other evidence currently of record (or presented to Ms. Stewart during her deposition and permissibly filed with an opening Supplemental Brief pursuant to this Order) that bears on the prior art status of Stowers 2008. Paper 51 at 2, 10.

Importantly, in the event that the parties are unable to conduct a deposition of Ms. Stewart before March 5, 2025, then the Board shall nonetheless permit Supplemental Briefs on the question of the prior art status of Stowers 2008. In this event, no new documentary evidence shall accompany any Supplemental Brief, except that Patent Owner may file a copy of the OSU packet as an exhibit to its opening Supplemental Brief. Further, in this event, the Supplemental Briefs shall be employed solely to present final arguments about the evidence of record (including the OSU packet) that bears on whether Stowers 2008 qualifies as prior art.

Under no circumstances shall any new evidence be filed in support of any responsive Supplemental Brief.

The above instructions supersede any conflicting provisions set forth in Paper 51 or discussed during the hearing held on January 30, 2025.

II. ORDER

Accordingly, it is

ORDERED that we *grant* Petitioner’s request (Ex. 3011, 1–2) to extend the deadlines set forth in Paper 51 (as modified by Paper 53) according to the conditions set forth in this Order;

FURTHER ORDERED that we *deny* Patent Owner’s request (Ex. 3011, 2) to allow introduction of the OSU packet into the record

without any opportunity for the parties to brief their respective positions regarding the relevance of that evidence;

FURTHER ORDERED that no later than March 5, 2025, each party may file an opening Supplemental Brief consistent with this Order, not to exceed five (5) pages in length;

FURTHER ORDERED that no later than March 12, 2025, each party may file a responsive Supplemental Brief consistent with this Order, not to exceed five (5) pages in length;

FURTHER ORDERED that no later than March 14, 2025, the parties shall meet and confer to resolve whether the Board should conduct a telephonic conference to hear arguments on the Supplemental Briefs; and

FURTHER ORDERED that no later than March 14, 2025, the parties shall jointly file a paper, not to exceed one (1) page in length, indicating their joint position (or, if no joint position is reached, clearly and succinctly setting forth their respective positions) regarding such a conference.

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