

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

U.S. Patent No. 9,823,564

PATENT OWNER'S SUPPLEMENTAL BRIEF

Lam has failed to meet its burden of proving that Dr. Jason Stowers's dissertation ("Stowers 2008") (EX1008) is prior art. Lam's ever-shifting prior art theories are inconsistent with the evidence. Besides lacking merit, Lam's latest theories were presented too late and are prejudicial. They should be rejected.

Lam's First Theory Fails on the Merits: Lam initially argued Stowers 2008 was publicly accessible based on an "Entered" date for a MARC record. Pet., 19; EX1006, ¶47. But as Inpria explained, "the fact that the library 'Entered' the record on October 21, 2008, does not mean it was accessible to the public as of that date." POR, 27. Dr. Stowers testified that he had placed an embargo on his dissertation to "restrict[it] from public view" and to make it "unavailable to the public until sometime in October 2009." EX2008, ¶¶5-7. His testimony was supported by contemporaneous evidence—an email sent shortly after the embargo was lifted:

On Feb 23, 2010, at 9:14 PM, Jason Stowers wrote:

FYI,

My Dissertation is now past its 1 year publication embargo.

Id., p. 6 (excerpted); *see also* EX2012, 1, 5 (OSU library explaining a "Date Available timestamp ... doesn't necessarily mean it was fully public" at that time because "embargo functionality was handled separately"). Thus, Lam's Petition theory is insufficient and this should end the inquiry on this issue.

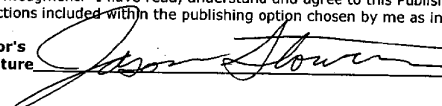
Lam's Second Theory Fails on the Merits: In its Reply and MTA Opposition (filed simultaneously), Lam shifted focus from the MARC record

“Entered” date to attempting to undermine the embargo. Lam complained that Dr. Stowers had “no receipt” or “copy of [the embargo] form.” Pet. Reply, 9. Lam also argued there was no embargo on Stowers 2008 (which Lam’s original librarian declarant, Dr. Hall-Ellis, testified she acquired from ProQuest, EX1006, ¶44) because it purportedly was available in January 2009 on the “ProQuest® Digital Dissertations and Theses database.” Pet. Reply, 9-10; *see also* MTA Opp., 14-15. Lam submitted a declaration from Heather Stewart at ProQuest (EX1041) in support of Lam’s new January 2009 date. In other words, Lam argued Dr. Stowers was simply wrong about the existence of an embargo (despite his sworn testimony), relying on (1) ProQuest’s purported publication; and (2) the absence of documentary evidence of an embargo beyond Dr. Stowers’s declaration and his contemporaneous email. Both arguments are unsupported.

First, ProQuest did not publish Stowers 2008 in January 2009. This became evident when Inpria requested a deposition of Lam’s new witness, Ms. Stewart. Following the request, Ms. Stewart realized that there was a mistake in her original declaration and subsequently submitted a supplemental declaration (EX2013). In preparing her original declaration (EX1041), Ms. Stewart had mistakenly accessed records for a different dissertation and provided incorrect publication information. EX2021, 15:9-16:7, 47:16-49:18, 55:10-56:4. Upon accessing the correct records, she revised her declaration and confirmed that Stowers 2008 was subject to a “1 year

embargo” and unavailable until December 2009. *Id.*, 16:8-22:22; EX2013, ¶¶ 8-9.¹

Second, additional evidence corroborates Dr. Stowers’s testimony regarding the embargo. EX2008. The “OSU packet” (EX2020), produced by Oregon State University (OSU) in response to Lam’s subpoena issued in the parallel district court case, shows that Dr. Stowers requested a “1 year embargo” when he submitted his dissertation to OSU in October 2008:

☒ TR-2 Traditional Copy Sales & Royalties I want to make my work widely available for purchase and I want to be eligible to receive royalties on the sale of my work. I may provide further instructions as indicated below. I understand that I must maintain a current mailing address with ProQuest/UMI in order to be eligible to receive royalties. If no boxes are checked below, your work will be released immediately with no restrictions. <table><tr><td>Release Options*</td><td>Restriction Options:</td></tr><tr><td>☐ 6 month embargo</td><td>☐ No search engine access</td></tr><tr><td>☒ 1 year embargo</td><td>☐ No sales via third-party</td></tr><tr><td>☐ 2 year embargo</td><td></td></tr></table>	Release Options*	Restriction Options:	☐ 6 month embargo	☐ No search engine access	☒ 1 year embargo	☐ No sales via third-party	☐ 2 year embargo		Section V. Author's signature. Acknowledgment: I have read, understand and agree to this Publishing Agreement, including all rights and restrictions included within the publishing option chosen by me as indicated above. Author's signature:  Date: 10-17-08
Release Options*	Restriction Options:								
☐ 6 month embargo	☐ No search engine access								
☒ 1 year embargo	☐ No sales via third-party								
☐ 2 year embargo									

EX2020, 3; *see also* EX2021, 23:22-25:21.

Before the parties received the OSU packet from OSU, Lam described it as “of utmost relevance in this proceeding.” EX3010, 1. Yet Lam did not mention the OSU packet in its next paper to the Board, filed one week after receiving the packet, in which Lam continued to argue that the OSU embargo was ineffective. MTA Sur-

¹ Ms. Stewart was not involved in this proceeding until Lam solicited her testimony to support its theory that the embargo was ineffective. EX1041; Pet. Reply, 9-10; MTA Opp., 14-15. Her revised declaration, which corrected an error in her original declaration, was not solicited by Inpria. EX3013. Indeed, it is likely the mistake occurred because Lam failed to inform her of the embargo issue. EX2021, 15:4-8.

reply, 7-8. The OSU packet, however, provided exactly what Lam claimed was missing—additional evidence of the embargo. EX2020, 1, 3. As the packet shows, OSU instructed Dr. Stowers to complete ProQuest’s publishing agreement for his dissertation, thus tying OSU’s purported publication together with ProQuest’s. *Id.*, 1. Dr. Stowers, in response, placed a “1 year embargo” on his dissertation. *Id.*, 3.

Lam’s Third Theory Fails on the Merits: Lam’s last substantive paper, filed two weeks before the oral hearing (its MTA Sur-reply), shifted its position once again. Lam argued there were “two relevant Stowers 2008 publications,” one from OSU and one from ProQuest, and that Dr. Stowers had only “*request[ed]* an embargo.” MTA Sur-Reply at 7-8. At the Oral Hearing, Lam further modified its theory, referring to it as “**Subjective Evidence of a *Request*.**” EX1048, 30. This “two publications” theory should be rejected as improperly new, introduced only weeks before the oral hearing. Previously, Lam’s declarant, Dr. Hall-Ellis, obtained Stowers 2008 from ProQuest, which she declared was “the custodian to whom the author granted permission to make copies and reproductions.” EX1006, ¶44. Lam relied on ProQuest’s purported publication to argue the absence of an embargo, Pet. Reply, 9-10; MTA Opp., 14-15. Besides being procedurally improper, Lam’s sudden change in position undermines the credibility of this argument—Lam previously *relied* on ProQuest to show no embargo, but now argues that any embargo was coincidentally *limited* to ProQuest.

In any case, Lam's new theory is undermined by the evidence. The OSU packet shows that the embargo request was made and is tied to both OSU and ProQuest. EX2020, 1, 3. Lam also ignores Dr. Stowers's testimony that he understood the website link to his dissertation "did not exist" before the embargo ended. EX2008, p. 6; EX1032, 60:7-21. And ProQuest's implementation of the embargo serves as evidence that Stowers 2008 was properly embargoed. There is no reason to believe that OSU did not apply the embargo when ProQuest did.

Furthermore, the OSU packet indicates Dr. Stowers's intent for his work be "available for purchase" so that he could "receive royalties." EX2020, 3. This option makes no sense if OSU had already published the same dissertation for free. Lam's theory also does not make sense considering the other options on that same form, which were not selected by Dr. Stowers, provided for "OPEN ACCESS" where "global access to the electronic copy of my work via the internet" is available either immediately or after an "embargo" period. *Id.* If, as Lam argues, the embargo did not apply to OSU, this unselected option would be entirely redundant. Dr. Stowers chose a restrictive option to embargo his thesis. Lam has provided no persuasive evidence that OSU acted inconsistently with the form that OSU had Dr. Stowers fill out and that OSU retained in its own files.

In sum, the Board should not consider Lam's new theories as they are untimely and prejudicial. But even if considered, Lam simply has not met its burden.

Respectfully submitted,

Dated: March 5, 2025

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CERTIFICATE OF SERVICE

I certify that I caused to be served on the counsel identified below a true and correct copy of the foregoing Patent Owner's Supplemental Brief by electronic means on March 5, 2025:

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