

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

THE BOEING COMPANY
Petitioner,

v.

THE REGENTS OF THE UNIVERSITY OF CALIFORNIA
Patent Owner.

Case IPR2024-00761
Patent 7,487,684

PATENT OWNER'S MOTION TO EXCLUDE

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TABLE OF EXHIBITS

Exhibit	Description
2001	“Glass-modified stress waves for adhesion measurement of ultra thin films for device applications,” Gupta et al.
2002	Subpoena for LaTonya Morris and Appendix A (December 19, 2024)
2003	U.S. Patent Trial and Appeal Board Email Authorizing Motion to Apply for Subpoena (November 12, 2024)
2004	Deposition Transcript of LaTonya Morris (January 23, 2025)
2005	LaTonya Morris’s Responses and Objections to Subpoena (December 17, 2024)
2006	IPR2024-00033 - Declaration of Heather Stewart
2007	IPR2024-00033 - Supplemental Declaration of Heather Stewart
2008	U.S. Patent Trial and Appeal Board Email Authorizing Petitioner to File Amended Declaration of Latonya Morris
2009	Deposition Transcript of Junlang Wang (January 16, 2025)
2010	ProQuest Abstract of Wang Thesis Accessed January 22, 2025
2011	Declaration of Vijay Gupta, PhD (February 3, 2025)
2012	Curriculum Vitae of Vijay Gupta, PhD
2013	Deposition Transcript of Junlang Wang (May 29, 2025)

I. Introduction

Pursuant to 37 C.F.R. § 42.64(c), Patent Owner respectfully moves to exclude Petitioner's Exs. 1041-1051, newly submitted with Petitioner's Reply, and improperly relied on to support its belated and impermissible argument that the Wang-Dissertation (Ex.1005) qualifies as prior art under 35 U.S.C. § 102(a).

II. Factual Background

Petitioner's Grounds 1, 2 and 3 are premised on the assertion that the Wang-Dissertation (Ex.2005) qualifies as prior art under 35 U.S.C. § 102(b) in the Petition. Petition ("Pet.") (Paper 1), 4 ("Wang Dissertation published on March 4, 2003, . . . [and it] prior art under at least pre-AIA 35 U.S.C. § 102(b).") The Board also recognized Petitioner's reliance on the Wang-Dissertation as alleged 102(b) prior art in its Institution Decision ("I.D."), Section F, in its listing of the Asserted Grounds and in Section C, noting that "[t]he parties dispute whether Wang qualifies as a printed publication pursuant to Section 102(b)." I.D., Paper 8 at 6-7 and 11. Petitioner did not assert that the Wang-Dissertation (Ex.1005) qualifies as prior art under any other statutory basis, including 35 U.S.C. § 102(a). *See id.* In support of § 102(b) admissibility, Petitioner primarily relied on the testimony of LaTonya Morris, an employee of ProQuest who attested, as the Board relied on in its I.D., that Proquests's "PQDT database included the 'full text' of Wang as of March 4, 2003,

and that the ‘full text’ of Wang was available for sale as of March 4, 2003.” I.D. 17 (citing Ex. 1035 [Original Morris Decl.], ¶¶ 8–9.”).

After the I.D., Morris recanted her sworn testimony and changed the alleged date the full text of the Wang-Dissertation (Ex.1005) was in ProQuest’s database by over six years, from March 4, 2003 to Sept. 6, 2010. Ex.1038 (Redlined Morris Decl.), ¶ 8; Ex.1037 (Amended Morris Decl.), ¶ 8. Faced with this changed testimony, Petitioner sought to change its grounds of unpatentability, asserting a new theory of how the Wang-Dissertation (Ex.1005) qualifies as prior art in its Reply and arguing for the first time that the Wang-Dissertation (Ex.1005) qualifies as prior art under 35 U.S.C. § 102(a). Petitioner’s Reply (“Pet.R.”) (Paper 26), 1 (“Additionally, Dr. Hsieh-Yee’s testimony confirms that Wang-Dissertation is prior art at least under § 102(a).”), 12-13. In support of its new argument that the Wang-Dissertation qualifies as prior art under § 102(a), Petitioner introduced *eleven* new exhibits in its Reply:

Petitioner’s Exhibit No.	Description
1041	Supp. Declaration of Ingrid Hsieh-Yee (“Supp. Hsieh-Yee Decl.”)
1042	UIUC bibliographic and MARC record for the Wang dissertation
1043	OCLC FirstSearch record for the Wang dissertation
1044	“ProQuest Digital Dissertations” archived by Internet Archive on August 16, 2000.
1045	“About ProQuest Digital Dissertations” archived by Internet Archive on August 15, 2000, and on April 16, 2003.
1046	Steps for accessing ProQuest metadata record, previewing 24 pages of a dissertation, and viewing the full dissertation

1047	“Online Dissertation Services” archived by Internet Archive on February 10, 2003.
1048	Copyright registration record for v. 63, no. 11 of Dissertation Abstracts International that contains the index record for the Wang dissertation, obtained from the public catalog of the US Copyright Registration Office
1049	Copy of the front matter of v. 63, no. 11 of Dissertation Abstracts International and the index record for the Wang dissertation, obtained from the Library of Congress
1050	Comparison file of the original abstract and the abstract in the ProQuest metadata record
1051	Library system of the University of Illinois at Urbana-Champagin archived by Internet Archive on February 11, 2003

Patent Owner (“PO”) timely objected to these exhibits on May 5, 2025 on the grounds of, *inter alia*, lack of relevance. Patent Owner’s Objections (Paper 28).

Each of these new references, including each paragraph of the Supplemental Hsieh-Yee Declaration (Ex.1041) (“Supp. Hsieh-Yee Decl.”) relate only to Petitioner’s new theory that the Wang-Dissertation (Ex.1005) qualifies as under prior art under § 102(a). For example, Petitioner explicitly relies on ¶¶6-12 of the Supp. Hsieh-Yee Decl. and the references cited by Hsieh-Yee¹ for supporting alleged § 102(a) availability of the Wang-Dissertation (Ex.1005). Pet.R., 12 (“PO is also incorrect that Wang-Dissertation is not available as § 102(a) prior art. [] As Dr.

¹ Of the eleven new § 102(a) exhibits, Petitioner only cites to Exs. 1041 (Supp. Hsieh-Yee Decl.), 1045, and 1046 in the Pet.R. See Pet.R., 12-13. The remaining references are relied upon only by Hsieh-Yee in her Supplemental Declaration (Ex.1041).

Hsieh-Yee confirms, an OCLC FirstSearch record for Wang-Dissertation was entered into the WorldCat database on March 10, 2003. Ex-1041, ¶¶1-5 (describing OCLC WorldCat database of MARC records).”)

While Patent Owner cites to ¶¶14-15 of the Supp. Hsieh-Yee Decl., and Ex.1045² in support of its position that the Wang-Dissertation (Ex.1005) still qualifies as prior art under § 102(b), a plain reading of these paragraphs of the Supp. Hsieh-Yee Decl. (Ex.1041) and Ex.1045 dispels any notion that these paragraphs or Ex.1045 are relevant to Petitioner’s § 102(b) prior art argument. In ¶14 of her Supp. Decl. (Ex.1041), Hsieh-Yee testifies as to the veracity of Ex.1045 which is purportedly an August 15, 2000 document purportedly describing the ProQuest archiving system of that date; in ¶15 of her Supp. Decl. (Ex.1041), Hsieh-Yee describes her personal experience since 2000 of searching “the ProQuest dissertation database.” Ex. 1041, ¶¶14-15. Importantly, neither of ¶14 or ¶15 of the Hsieh-Yee Supp. Decl. (Ex.1041) or Ex.1045 provide any first-hand or direct evidence that ProQuest users (“institutional subscribers” or otherwise) would have been able to access and view the Wang-Dissertation (Ex.1005) through the ProQuest system (or any other way) as of March 4, 2003.

² Petitioner does not cite any other paragraphs of Ex.1041, or any of the other nine § 102(a) exhibits (except for Ex. 1045) for supporting the availability of the Wang-Dissertation (Ex.1005) as prior art under § 102(b).

III. Legal Standard

Federal Rule of Evidence 401 provides that “[e]vidence is relevant if: (a) it has any tendency to make a fact more or less probable than it would be without the evidence; and (b) the fact is of consequence in determining the action.” Fed.R.Evid. 401. Irrelevant evidence is not admissible. *See* Fed.R.Evid. 401.

An IPR Petition must identify “***with particularity, each claim challenged, the grounds on which the challenge to each claim is based, and the evidence that supports the grounds for the challenge to each claim.***” 35 U.S.C. § 312(a)(3) (emphasis added).

Petitioners cannot raise new arguments or present new evidence in its Reply. *Henny Penny Corp. v. Frymaster LLC*, 938 F.3d 1324, 1330-1331 (Fed. Cir. 2019). “It is of the utmost importance that petitioners in the IPR proceedings adhere to the requirement that the initial petition identify ‘with particularity’ the ‘evidence that supports the grounds for the challenge to each claim.’” *Intelligent Bio-Sys., Inc. v. Illumina Cambridge Ltd.*, 821 F.3d 1359, 1369 (Fed. Cir. 2016). “Any marked departure from the grounds identified with particularity in the petition would impose ‘unfair surprise’ on the patent owner and, consequently, violate both the Administrative Procedure Act and the inter partes review statute.” *Intel Corp. v. Besang, Inc.*, IPR2023-00991, Paper 39, 32 (PTAB Dec. 11, 2024) (citing *Arthrex Inc. v. Smith & Nephew, Inc.*, 935 F.3d 1319, 1328 (Fed. Cir. 2019)).

The Board does not consider new petitioner arguments on reply. *See Henny Penny*, 938 F.3d at 1330-1331; *Intelligent Bio-Sys.*, 821 F.3d at 1369; *Axonics, Inc. v. Medtronic, Inc.*, IPR2020-00712, Paper 42, 20 (PTAB Sept. 22, 2021).

Evidence that is not relevant to a ground raised in the Petition should be excluded. *See Google, Inc. v. Performance Price Holdings, LLC.*, CBM2016-00049, Paper 37, 38 (PTAB Sept. 13, 2017) (excluding irrelevant evidence) (“But the fact that these Exhibits could be relevant if certain arguments were made does not make them relevant in all circumstances. . . . Without these [waived] arguments [] there is no basis for admitting these Exhibits.”)

Even if relevant to a ground in the petition, belated evidence should be excluded if not submitted with the Petition. *Kingston Tech. Co. v. SPEX Techs., Inc.*, 798 F. App'x 629, 635 (Fed. Cir. 2020) (“We acknowledge that the Board's rules prohibit a petitioner from submitting new evidence or new argument in reply that the petitioner could have presented earlier.”); *see Henny Penny Corp.* 938 F.3d, at 1330-31; *Blackberry Corp. v. Zipit Wireless, Inc.*, IPR2014-01507, Paper 50 (PTAB Mar. 29, 2016) (Board excluding untimely evidence).

IV. Argument

Each of Petitioner's Exs. 1041-1051 should be excluded in their entirety for lack of relevance.

**A. Ex. 1041, ¶¶1-13 and 18-24; and Exs. 1042-1043 and 1046-1051
Should be Excluded as Irrelevant To Any Issue In The Case**

Paragraphs 1-13 and 18-24 of the Supp. Hsieh-Yee Decl. (Ex.1041) and Exs. 1042-1043 and 1046-1051 are not relevant to any ground of invalidity Petitioner raised in the Petition. Rather, these identified paragraphs and references are only relevant to whether the Wang-Dissertation (Ex.1005) qualifies as prior art under 35 U.S.C. § 102(a), an improper new theory raised by Petitioner in its Reply.

Paragraphs 1-5, 18, and 22-24 of the Supp. Hsieh-Yee Decl. (Ex.1041), and Exs. 1045 and 1050 provide background information of generalized library record keeping practices relied on by Hsieh-Yee for proving availability of the Wang-Dissertation as prior art under § 102(a). Petitioners do not explicitly rely on these paragraphs of the Supp. Hsieh-Yee Decl. in their Reply.

Paragraphs 6-9 of the Supp. Hsieh-Yee Decl. and Ex. 1042 describe library records for the Wang-Dissertation (Ex.1005) purportedly being available as of March 10, 2003, Petitioner's belatedly asserted § 102(a) prior art date. Petitioners explicitly rely on these paragraphs of the Supp. Hsieh-Yee Decl. (Ex. 1041) as supporting its new argument that the Wang-Dissertation (Ex.1005) qualifies as prior art under § 102(a). Pet.R., 12-13.

Paragraphs 10-12 of the Hsieh-Yee Decl. (Ex.1041) and Exs. 1051 and 1043 likewise purport to describe availability of the Wang-Dissertation (Ex.1005) in a different library database (WorldCat) as of March 10, 2003, Petitioner's § 102(a)

prior art date. Petitioners explicitly rely on these paragraphs of the Supp. Hsieh-Yee Decl. as supporting its new argument that the Wang-Dissertation (Ex.1005) qualifies as prior art under § 102(a). Pet.R., 12-13.

Paragraphs 19-21 of the Hsieh-Yee Decl. (Ex.1041) and Exs. 1048, 1049, purport to describe the availability of the Wang-Dissertation (Ex.1005) between “May 15, 2003, and . . . June 16, 2003,” which is after March 4, 2003, the date Petitioner relied upon for establishing the Wang-Dissertation as prior art under § 102(b) in the Petition. Pet., 4.

Since none ¶¶1-13 and 18-24 of the Supp. Hsieh-Yee Decl. nor Exs. 1042-1043 and 1046-1051 are relevant to or support Petitioner’s relied upon § 102(b) purported prior art date as set forth in the Petition (CITE), they should be excluded as irrelevant. *See Google, Inc. v. Performance Price Holdings, LLC.*, CBM2016-00049, Paper 37, 38 (PTAB Sept. 13, 2017) (excluding irrelevant evidence).

B. Ex. 1041, ¶¶13-17 and Exs.1044-1046 Should be Excluded as Irrelevant

Paragraphs 13-17 of the Supp. Hsieh-Yee Decl. (Ex.1041) and Exs. 1044-1046 purport to describe availability of the Wang-Dissertation (Ex.1005) in the ProQuest Database as of March 4, 2003 — Petitioner’s relied upon § 102(b) prior art date as set forth in the Petition. However, none of these paragraphs provide any first-hand or direct evidence that ProQuest users (“institutional subscribers” or otherwise) would have been able to access and view the Wang-Dissertation (Ex.1005) through the

ProQuest system (or any other way) as of March 4, 2003. Indeed, Petitioner's evidence proves the thesis was not uploaded to the Proquest database until Sept. 2010. Ex.1038 (Redlined Morris Decl.), ¶ 8; Ex.1037 (Amended Morris Decl.), ¶ 8.

Exs.1044 and 1045 are respectively, August 16, 2000 and August 15, 2000 webpage documents purportedly describing availability of details on academic Dissertations.

Paragraphs 13-14 of the Supp. Hsieh-Yee Decl. (Ex.1041) include Hsieh-Yee's testimony thereon.

Paragraph 15 of the Supp. Hsieh-Yee Decl. (Ex.1041) purportedly described vague and temporally ambiguous "personal experience since 2000" of Hsieh-Yee, while ¶16 of the Supp. Hsieh-Yee Decl. (Ex.1041) and Ex.1046 purport to describe current-day practices of locating references on the ProQuest database.

Finally, ¶17 of the Supp. Hsieh-Yee Decl. (Ex.1041) includes Hsieh-Yee's testimony on the Amended Morris Declaration.

Since none of ¶¶ 13-17 the Supp. Hsieh-Yee Decl. (Ex.1041) nor Exs. 1044-1046 are relevant to or support Petitioner's relied upon § 102(b) purported prior art date as set forth in the Petition (Pet., 4), they should be excluded as irrelevant. See *Google, Inc. v. Performance Price Holdings, LLC.*, CBM2016-00049, Paper 37, 38 (PTAB Sept. 13, 2017) (excluding irrelevant evidence).

V. Conclusion

For the foregoing reasons, Petitioner's Exs. 1041-1051 should be excluded in their entirety.

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on this 23rd day of June 2025, a copy of the Patent Owner's Motion to Exclude was served by electronic mail on the following counsel of record:

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