

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 REPLY TO PETITIONER'S OPPOSITION TO
MOTION TO EXCLUDE**

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Statutes

35 U.S.C. §102(a)	<i>passim</i>
35 U.S.C. § 102(b)	<i>passim</i>

Rules

37 C.F.R. § 42.104(b)(2)	1
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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)
2014	Patent Owner’s Oral Hearing Demonstratives

I. The Petition Failed to Include Any Theory Under 35 U.S.C. §102(a)

Petitioner never asserted a 35 U.S.C. § 102(a) ground in the Petition. Its claim that Ground 1 was “broadly” identified as a § 102 challenge, and that citing 35 U.S.C. § 102(b) was “non-limiting”—is misleading. The Petition makes clear that Petitioner relied solely on § 102(b) to establish that the Wang Dissertation (Ex.1005) qualifies as prior art. Pet.Opp. (Paper 36), 3. Both the Board and PO recognized the same.

“It is of the utmost importance that petitioners [] 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-Systems, Inc. v. Illumina Cambridge, Ltd.*, 821 F.3d 1359, 1367-68 (Fed. Cir. 2016); *see also* 37 C.F.R. § 42.104(b)(2) (requiring a petition to specify the specific statutory grounds under 35 U.S.C. § 102). Petitioner attempted to meet this “particularity requirement” by claiming that the Wang Dissertation qualifies as “prior art under at least pre-AIA 35 U.S.C. §102(b).” Pet., 4. Petitioner specifically alleged a prior art date of March 4, 2003, which is more than one year before the Petitioner-acknowledged “earliest effective filing date of the ’684 Patent[,], March 5, 2004[.]” *Id.* Petitioner did not allege any other prior art date in the Petition, including any date that would qualify the Wang Dissertation under § 102(a), nor did Petitioner present any such argument, much less evidence, or even cite to any other prior art statute aside from § 102(b):

Statutes

35 U.S.C. §102(b)	<i>passim</i>
35 U.S.C. § 315(e)	78

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The Board likewise understood Petitioner to only assert § 102(b), and instituted *only on that basis*. I.D. 11, (“The parties dispute whether Wang qualifies as a printed publication pursuant to **Section 102(b)**”); 12 (“the critical date *under 35 U.S.C. § 102(b)* for the ’684 Patent is March 5, 2003”); 18 (“Wang preliminarily qualifies as prior art under pre-AIA **Section 102(b)**.”). Like the Petition, the Institution Decision is silent with respect to § 102(a) and any analysis thereon.

Whether a reference qualifies as prior art under § 102(b) is a separate and distinct issue from whether the reference qualifies as prior art under § 102(a), especially here, where Petitioner relies on new and different facts – raised for the first time in Reply. *In re Stepan Co.*, 660 F.3d 1341, 1346 (Fed. Cir. 2011). To be clear, PO did not understand Petitioner to be asserting that the Wang-Dissertation qualifies as prior art under § 102(a) in the Petition. Rather, PO explained that, if, hypothetically, a § 102(a) argument were to be raised with respect to the Wang Dissertation, PO would be able to antedate. Specifically, PO asserted: “***If 102(a) were to be implicated***, earlier invention could be shown.” POPR, 3. Since Petitioner did not assert that the Wang Dissertation qualifies as prior art under §102(a), and importantly, ***did not assert a §102(a) prior art date***, PO did not, and could not have

antedated the reference (because no specific date was asserted). Petitioner's belated attempt to assert a new §102(a) date in Reply (March 10, 2003 (*see* Pet.R., 12)) deprives PO of due process to address this new date at this late point in time.

Maxlinear, Inc. v. Cresta Tech. Corp., IPR2015-00594, Paper 90, 29-30 (PTAB Aug. 15, 2016) (“If Petitioner had asserted both § 102(a) and § 102(e), perhaps PO would have chosen a different response and the evidence in this proceeding would have developed differently. In the particular circumstances of this case, adding consideration of § 102(a) at this late date would deprive PO of due process. Consequently, we do not consider Petitioner's contention that Favrat is prior art under § 102(a).”)

Petitioner's reliance on *Genzyme Therapeutic Prod. Ltd. P'ship v. Biomarin Pharm. Inc.*, 825 F.3d 1360 (Fed. Cir. 2016) is misplaced. “Genzyme relate[s] to the circumstances under which the Board can rely on evidence not raised in the petitioner's petition to support the grounds that were raised in the petition.[] [This] case[] [does] not concern whether the Board has discretion to institute an inter partes review on a ground of unpatentability not raised in the petitioner's petition.”

Koninklijke Philips N.V. v. Google LLC, 948 F.3d 1330, 1336-37 (Fed. Cir. 2020) (internal citation omitted).

Regardless, even assuming, as Petitioner alleges, that “PO directly addressed the availability of [the] Wang-Dissertation under § 102(a)” in its Preliminary Response, the Preliminary Response is not part of the institutional record and does

not excuse Petitioner’s attempt to belatedly address § 102(a) in its Reply. *Harmonic Inc. v. Avid Tech., Inc.*, 815 F.3d 1356, 1364-65 (Fed. Cir. 2016) (“IPR proceedings involve two distinct phases: (1) the institution phase, beginning with the filing of an IPR petition and culminating in the decision of whether to institute . . . ; and, if instituted, (2) the merits phase, beginning after the Board's institution decision And declining to consider issues not instituted on); *Maxlinear, Inc. v. Cresta Tech. Corp.*, IPR2015-00594, Paper 90 at 29 (finding that Petitioner’s assertion of “prior art under § 102(a) was required to be in the Petition, [] ***the fact that the issue was raised in Patent Owner’s Response does not cure that oversight.***”).

Petitioner’s reliance on *Rembrandt Diagnostics, LP v. Alere, Inc.*, 76 F.4th 1376, 1383 (Fed. Cir. 2023) is also misplaced. As Petitioner concedes, PO did not address § 102(a) in its Reply – because it, along with the Board recognized that the Petition did not raise a § 102(a) prior art ground. Pet.Opp., 1. Here, Petitioner’s generic reliance on its alleged “non-limiting,” “broadly identified,” “‘§102’ ground” is akin to the situation in *Ariosa Diagnostics v. Verinata Health, Inc.*, 805 F.3d 1359, 1364 (Fed. Cir. 2015), where the Federal Circuit held that Petitioner’s “generically argued” obviousness ground raised in the Petition was not specific enough to support Petitioner’s belated attempt in Reply to “switch[] theories”, citing “previously unidentified” new evidence. *Rembrandt*, 76 F.4th, at 1383 (citing *Ariosa*, 805 F.3d at 1368).

II. Exs. 1041-1051 Are Only Relevant (if at all) to Petitioner's Improper §102(a) Ground

Petitioner does not dispute that each of new, belated Exs. 1041-1051 are only relevant, if at all, to whether the Wang-Dissertation qualifies as prior art under §102(a). Knowing it cannot succeed on improper § 102(a) relevance, Petitioner attempts to argue that Exs. 1041-1051 are relevant to generic “public availability.” Pet.Opp, 6. However, mere “public availability” is irrelevant if it is not tied to a specific alleged prior art date. *See Honeywell Int'l, Inc. v. United States*, 81 Fed. Cl. 514, 524 (2008) (“The party claiming prior art must show . . . that the invention at issue existed prior to the date of the patent application in the United States.”) (citing *In re Hall*, 781 F.2d 897, 899 (Fed. Cir. 1986)).

Here, Petitioner relies on different §102(a) (March 10, 2003) and §102(b) (March 4, 2003) dates. *See* Pet., 4; Pet.R., 12. Evidence Petitioner relies upon to support the new §102(a) date does not support the §102(b) date. As Petitioner concedes, in her new declaration (Ex. 1041), “Dr. Hsieh-Yee relies on Exhibits 1042-1043 to confirm” the “March 10, 2003”, § 102(a) date. Pet.Opp., 7.

As for Exs. 1046-1051, Petitioner does not dispute PO's descriptions of these references as being only relevant to the new improper §102(a) theory. Likewise, Petitioner does not dispute that Exs. 1044-1046 are irrelevant to §102(b) because they fail to provide any first-hand or direct evidence of public availability as of March 4, 2003.

Respectfully Submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on this 7th day of July 2025, a copy of the Patent Owner's Reply to Petitioner's Opposition to Motion to Exclude was served by electronic mail on the following counsel of record:

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