UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

PASCAL TECHNOLOGIES

Petitioner

v.

CAMBRIDGE ENTERPRISE LIMITED, UNIVERSITAT DE BARCELONA,

AND UNIVERSITAT POLITÈCNICA DE CATALUNYA,

Patent Owner

IPR2024-01235
Patent 11,230,656 B2

PATENT OWNER'S REQUEST FOR DIRECTOR REVIEW

Patent Owner hereby requests that the Director review the Board's Decision to Institute (Paper 8, the "Decision") in accordance with *U.S. v. Arthrex, Inc.,* 141 S. Ct. 1970 (2021), and the Rules Governing Director Review of Patent Trial and Appeal Board Decisions, 89 Fed. Reg. 79,744 (Oct. 1, 2024).

I. INTRODUCTION

On March 24, 2025, the panel granted institution based on a misapplication of Board precedent on printed publications (*Hulu*) and without knowledge of the unavailability of Petitioner's key witness. Under the correct standard and in view of the witness's unavailability, Director Review should be granted and institution denied. First, the Board granted institution despite Petitioner's failure to provide *any evidence* that the references relied upon qualify as printed publications. Second, the Decision relies heavily on inadmissible hearsay evidence, specifically the Declaration of Mircea Dincă (Ex. 1004), who Petitioner refuses to make available for deposition in the United States in violation of 37 C.F.R. § 42.53(b)(2). Without this testimony, Petitioner's invalidity arguments constitute unsupported attorney argument and do not satisfy the institution requirements. The Petition's deficiencies render it unlikely to meet the burden for institution. The panel's decision to institute should be vacated.

II. ARGUMENT

A. The panel did not follow Board precedent by overlooking Petitioner's failure to present any evidence that its references are printed publications.

Under binding PTAB precedent, to prove a document constitutes a printed publication a petitioner must "identify, ***with particularity***, evidence sufficient to establish a reasonable likelihood that [a] reference was publicly accessible before the critical date of the challenged patent and therefore that there is a reasonable likelihood that it qualifies as a printed publication." *Hulu, LLC v. Sound View Innovations, LLC*, IPR2018-01039, Paper 29 at 13 (PTAB 2019) (precedential) (emphasis added). Moreover, "Petitioner must make a threshold showing that [a] reference is a prior art 'printed publication[].'" *Affordable Drugs*, IPR2015-01076, Paper 33 at 6; *see also Hulu,* IPR2018-01039*,* Paper 29 at 13. In the present case, in contrast, the panel granted institution despite Petitioner's failure to provide ***any*** evidence the references relied upon qualify as printed publications. In fact, rather than holding Petitioner to a threshold showing "with particularity," as required by *Hulu*, the panel's Decision would allow Petitioners to satisfy their initial burden *after* institution. *Hulu* says otherwise. For this reason, it was legal error to grant institution.

Petitioner relies upon the NPL references Xie, Mañosa, Patel, and Tamarit in Grounds 1-5 without showing how any of the references qualify as printed

publications. According to precedent, at the institution stage of an IPR, the Petitioner bears the burden "of establishing by a preponderance of the evidence that a particular document is a printed publication." *Hulu,* IPR2018-01039*,* Paper 29 at 11; s*ee also Affordable Drugs*, IPR2015-01076, Paper 33 at 6 (PTAB 2015) (denying institution and stating "Petitioner, however, offers no probative evidence that supports its assertions, or that is sufficient to support a reasonable inference that [the document] was publicly accessible before the critical date."); *Symantec Corp. v. Trs. of Columbia Univ*., IPR2015-00371, Paper 13 at 5 (PTAB 2015) (denying institution, and indicating it did "not find ***any discussion*** in the Petition in support of the allegation that Cardinale was published in March 1999.") (emphasis added).

In *Hulu*, the Board determined there was a reasonable likelihood that a book constituted a printed publication by a showing of the copyright date, printing date, and ISBN date, ***together with evidence*** the publisher of the book series was well-known and widely discussed in the media as of the critical date. *Hulu*, IPR2018-01039, Paper 29 at 19-20. Conversely, for a research paper, ***providing a date listed as accessible online*** without showing the text was actually accessible to interested persons was held to be insufficient to satisfy the reasonable likelihood standard. *See In-Depth Geophysical, Inc. v. Conocophillips Co.*, IPR2019-00849, Paper 14 at 4-13 (PTAB 2019); *see also Acceleration Bay, LLC v. Activision Blizzard Inc.*, 908

F.3d 765, 77-774 (Fed. Cir. 2018) (affirming Board decision that a ***reference uploaded to a website was not a printed publication*** because petitioner failed to show the website was "meaningfully indexed" such that an interested POSITA could access the reference) (emphasis added).

It is well-established that a "[p]etitioner cannot simply state that [a reference] is prior art to satisfy its initial burden of production." *Affordable Drugs*, IPR2015-01076, Paper 33 at 6. Instead, a petitioner "must make a threshold showing that the reference is a prior art 'printed publication'." *Id*. Further, arguments of counsel cannot take the place of factually supported objective evidence. *Estée Lauder Inc. v. L'Oréal, S.A*., 129 F.3d 588, 596 (Fed. Cir. 1997).

Here, Petitioner disregards the Board's mandate for all four of its NPL references, failing to make any evidentiary showing on the printed publication issue—let alone one "with particularity." Instead, the Petition blindly states the dates the references were allegedly "***publicly available***" (Pet. at 24), "***published***" (Pet. at 27), "***public online***" (Pet. at 30), or "***published online***" (Pet. at 36). Such conclusory statements represent the totality of Petitioner's argument that these references qualify as printed publications. The Petition does not include or cite to any information to show public accessibility at the relevant time, how a copy might be obtained, or whether it was reasonably accessible to those skilled in the art through generally available means. Petitioner's conclusory statements fall far short

of PTAB requirements. *See, e.g., Affordable Drugs*, IPR2015-01076, Paper 33 at 6; *see also Power Integrations, Inc. v. Semi-Conductor Components Indus., LLC*, IPR2017-01903, Paper 9 at 11-12 (PTAB 2018) (holding petitioner's "single sentence," "naked assertion" that article was prior art was "not supported by the record.…").

The Petition's treatment of Xie is demonstrative of its greater failure to make any showing that its NPL references constitute printed publications. Petitioner claims, ***without any citation to evidence***, that Xie was "submitted and publicly available on September 26, 2016." Pet. at 24. In addition to the failure to cite evidence on this issue, Xie (Ex. 1006) itself provides no indication it was submitted to the website, let alone any indication of a publication date as argued by Petitioner. Nowhere does Xie indicate its origin and no declaratory evidence has been submitted attesting to its origin or public accessibility at the relevant time.[1] Nothing in the evidence of record shows the origin of Xie or attempts to prove public accessibility as of September 26, 2016. By failing to present any evidence

[1] Petitioner's submission of a declaration (Ex. 1024) regarding Català (Ex. 1011) reflects Petitioner's awareness of the importance of submitting testimony on this issue. Critically, however, Petitioner filed no similar declarations for any of the NPL references relied upon in Grounds 1-5.

on public accessibility, Petitioner has not met its burden of production in showing that Xie constitutes a printed publication. *See Elmos Semiconductor SE v. Texas Instruments, Inc.*, IPR2024-00802, Paper 9 at 28 (PTAB 2024) (denying institution and stating a reference's purported publication date alone is not a sufficient showing of public accessibility required to establish a reference as a printed publication when the reference does not bear a date on its face).

For each of the references, Petitioner fails to show or even state that the full text of the reference was available as of the purported public availability date. Further, there is no discussion of the notoriety of the sources in which these references allegedly published. For example, the Petition is silent on the impact factor of any of these sources. The Petition also makes no allegation or showing that Xie, Mañosa, Patel, and Tamarit were reasonably accessible to those skilled in the art as of the critical date. *See Microsoft Corporation, v. Throughputer, Inc.,* IPR2023-00852, Paper 18 at 17-18 (PTAB 2023) (denying institution and stating "the Petition is devoid of any substantive explanation as to how [the reference] qualifies as a prior art printed publication…. ***Petitioner's failure to develop any argument*** regarding the prior art status of [the reference] ***represents a fatal flaw in the Petition***.") (emphasis added).

Petitioner has provided no evidence as to when, where, or to whom any of the cited NPL references were allegedly accessible. The Petition simply concludes,

without evidence, that these references were publicly available. Pet. at 24, 27, 30, and 36. Absent any proffered evidence, Petitioner has failed to meet its burden of production on the printed publication issue under 35 U.S.C. § 311(b) and PTAB precedent (*Hulu*). As such, none of the references relied upon for Grounds 1-5 have been shown to constitute "printed publications" for purposes of § 311(b). For this reason alone, Petitioner is unlikely to prevail, and institution should have been denied.

Although the panel's Decision discusses *Hulu,* its conclusion contradicts the Board's basic tenet: Petitioner, ***at the institution stage***, must identify, "with particularity," evidence to establish a reasonable likelihood the reference qualifies as a printed publication. *Hulu*, IPR2018-01039, Paper 29 at 13. Specifically, the Decision incorrectly concluded that a copyright or publication date alone on the face of a reference is sufficient to satisfy *Hulu* without pointing to any evidence or mention of public accessibility in the Petition (there was none). Decision at 22-24. This conclusion constitutes a misapplication of the *Hulu* precedent. Although copyright or publication dates ***together with*** other evidence of public accessibility (e.g., notoriety of the publisher or expert declarations on public accessibility) may be sufficient to establish a reasonable likelihood the reference qualifies as a printed publication, a copyright date ***alone*** is insufficient. *Hulu*, IPR2018-01039, Paper 29

at 19-20 (emphasis added). Petitioner's failure to provide evidence or argument on public accessibility fails to satisfy the required threshold for institution.

The Decision also incorrectly concludes that Petitioner may satisfy Hulu's requirements *after* filing a petition. The panel cites *Hulu's* discussion of providing evidence of a printed publication status in a reply under 37 C.F.R. § 42.23. Decision at 20, n. 5. As the Decision acknowledged, however, Petitioner did not submit a reply under 37 C.F.R. § 42.23 and did not even seek leave to do so. The Decision supposes *Hulu* could still be satisfied because the Petitioner can move to submit supplemental information under 37 C.F.R. § 42.123 showing a reference qualifies as a printed publication. Decision at 20, n. 5. Under this reading, every petition for Inter Partes Review would satisfy the printed publication standard, and the principle of *Hulu*—that evidence must be put forth at the institution stage—is rendered meaningless. Further, the panel's reading clearly contradicts *Hulu*, which states in reference to replies under 37 C.F.R. § 42.23 and supplemental information submissions under 37 C.F.R. § 42.123, "***[w]hile the petitioner must submit evidence sufficient to meet the reasonable likelihood standard***, ***some limited opportunities exist for the petitioner to present new evidence later***…." Simply put, because Petitioner could submit supplemental information does not absolve Petitioner from putting forth the requisite printed publication showing in the Petition itself under *Hulu*. In fact, the panel conceded that "Petitioner does not

support [the public accessibility] statement with sufficient evidence at this stage," yet still decided to leave the printed publication issue for trial, contradicting *Hulu*. Decision at 21.

In view of the panel's misapplication of the threshold standard specified in *Hulu*, the Director should grant review and deny institution.

B. Petitioner's obviousness arguments rely on inadmissible hearsay evidence and are unlikely to prevail.

The Director also should grant review and deny institution because Petitioner's invalidity arguments rely heavily on inadmissible hearsay, the declaration of Dr. Mircea Dincă (Ex. 1004), who Petitioner refuses to make available for deposition in the United States. Unaware of its inadmissibility, the panel relied heavily on the Dincă Declaration in its Decision. *See, e.g.*, Paper 8 at 35 (citing the Dincă Declaration ***at least nine times*** and indicating that the institution decision was based on "the supporting Declaration of Dr. Dincă (Ex. 1004)."). It follows that, without this supporting expert testimony, Petitioner's obviousness arguments fall apart making it unlikely that Petitioner will prevail on at least one claim. For this reason also, Director Review should be granted and institution denied.

One week after the Board granted institution, Petitioner's counsel emailed Patent Owner's counsel indicating that Dr. Dincă is in Spain and will not return to the United States "until late July 2025." Patent Owner later learned that Dr. Dincă

was on a pre-planned year-long sabbatical. Instead of making Dr. Dincă available for deposition in the United States, as required by 37 C.F.R. § 42.53(b)(2), Petitioner proposed a "remote deposition." Counsel for Patent Owner declined that proposal and asked that Petitioner respond by April 7 (the deadline for filing this Request) on whether Petitioner would agree to make Dr. Dincă available in the United States for deposition. Patent Owner also indicated that absent such agreement, "we will understand that Petitioner refuses to make Dr. Dincă available in the United States for deposition." Patent Owner reiterated its request in an additional email on April 7. Rather than agree to make its witness available, Petitioner indicated it would "raise this issue with the Board"—confirming its refusal to make him available for deposition in the United States.[2]

Pursuant to 37 C.F.R. § 42.53(b)(2), "[e]xcept as the Board otherwise orders, during the testimony period, deposition testimony may be taken at any reasonable time and ***location within the United States*** . . . ." (emphasis added). Further, "[u]ncompelled deposition testimony outside the United States ***may only be taken upon agreement of the parties or as the Board specifically directs***." 37 C.F.R. § 42.53(b)(3) (emphasis added); *see also* Consolidated Trial Practice Guide at 33

[2] With Director approval, Patent Owner will file the relevant correspondence pursuant to Rule 42.75(c)(3).

("the testimony may be taken at any reasonable location in the United States."). This requirement would be rendered meaningless and cannot be simply avoided by offering a witness for "remote deposition."

Petitioner offered Dr. Dincă as a declarant (Ex. 1004) knowing he would be subject to cross-examination. Dr. Dincă's testimony is thus uncompelled. The parties do not agree that his deposition should take place outside the United States, and the Board has not directed Dr. Dincă's deposition to be taken outside the United States. The parties also have not agreed to a remote deposition. Petitioner's refusal to make Dr. Dincă available in the United States for deposition thus violates 37 C.F.R. § 42.53(b)(2), and Petitioner's declaration (Ex. 1004) constitutes improper hearsay evidence and should be stricken.

The Board has consistently enforced 37 C.F.R. § 42.53(b)(2) in prior proceedings. *See, e.g., Square, Inc. v. REM Holdings 3, LLC*, IPR2014-00312, Paper 37 at 2-3 (PTAB 2014); *Vudu, LLC v. Ideahub, Inc.,* IPR2020-01689, Paper 48 at 9 (PTAB 2022); *Ventex Co., Ltd. v. Columbia Sportswear North America, Inc.*, IPR2017-00651, Paper 93 at 3-4 (PTAB 2018). In fact, enforcement of the principles underlying 37 C.F.R. § 42.53(b)(2) dates back to pre-AIA practice. *See Ventex,* IPR2017-00651, Paper 93 at 3-4 (citing *Quadrant Drug Delivery, Ltd. v. Nektar Therapeutics*, 76 U.S.P.Q.2d 1518, 1519 (B.P.A.I. 2005)) (noting "[o]ur predecessor Board also observed, in an analogous situation, that "***[t]aking of***

testimony, compelled or not, outside of the United States is disfavored and requires specific authorization from this Board.") (emphasis added).

By refusing to make its declarant available for depositions in the United States, Petitioner violates 37 C.F.R. § 42.53(b)(2), and Petitioner's declaration (Ex. 1004) must be stricken as inadmissible hearsay evidence. The Petition cites to Ex. 1004 on nearly every page of its obviousness analysis, as shown below.

Ground	**Petitioner's Analysis Solely Relying on Ex. 1004 (All citations to Petition)**
1: Obviousness Over Xie	• Motivation to combine. (45, n. 13). • Xie's alleged disclosure of various claim features (44-52, 56-58).
2: Obviousness over Mañosa and Patel	• Motivation to combine and reasonable expectation of success. (58-62, 65-66, 69-70, 72). • Mañosa's alleged disclosure of various claim features (66-69, 71-76).
3: Obviousness over Mañosa and Tamarit	• Motivation to combine and reasonable expectation of success. (76-79, 81, 85). • Mañosa's alleged disclosure of various claim features. (79-82). • Tamarit's alleged disclosure of various claim features. (83- 86). • Substitution of a hydroxyl group for a methyl group. (83, 86).
4: Obviousness over Tamarit and Xie	• Motivation to combine and reasonable expectation of success. (86-87).

5: Obviousness over Mañosa and Patel	• Motivation to combine and reasonable expectation of success. (86-87).

Petitioner's reliance on inadmissible Ex. 1004 as the sole support for its obviousness contentions, in particular for its motivation to modify or combine the alleged prior art, constitutes a fatal defect with the Petition. As such, Petitioner's assertions in Grounds 1-5 are conclusory, unsupported by competent testimony, and are in no way sufficient to satisfy the requisite reasonable likelihood of prevailing on at least one claim standard. For this reason also, the Director should grant Director Review and deny institution.

III. CONCLUSION

The panel's Decision granting institution despite Petitioner's failure to provide *any* evidence the references relied upon qualify as printed publications constitutes a misapplication of binding Board precedent. Additionally, while the panel could not have known at the time it rendered its Decision, the Decision rests on inadmissible hearsay evidence, without which Petitioner's obviousness contentions fail to satisfy the reasonable likelihood of prevailing standard.

For these reasons, coupled with the importance of balancing PTAB workload, Director Review should be granted, the Decision vacated, and institution denied.

Respectfully submitted,

Filed: April 7, 2025

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CERTIFICATE OF SERVICE

The undersigned certifies that on April 7, 2025, copies of Patent Owner's Request for Director Review (Paper 10) and Notice of Patent Owner Objections to Petitioner's Evidence (Paper 11) have been served via email on Counsel for Petitioner at the email address as indicated in their Mandatory Notices Under 37 C.F.R. § 42.8:

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