G. Ground 7: Yu does not constitute prior art

The Board has previously found antedating prior art references is sufficient grounds for denying *inter partes* review ~~institution~~. *LG Elec.s, Inc. v. Wi-LAN Inc.*, No. IPR2018-00704, Paper No. 14 at 20 (PTAB Sept. 5, 2018) ("[W]e determine that Patent Owner has provided sufficient evidence to antedate ZTE . . . [and therefore] Petitioner has not demonstrated a reasonable likelihood of prevailing[.]").

Yu was made of record before the examiner during prosecution of the '794 patent. EX1001, References Cited. Yu, however, does not qualify as prior art under 35 U.S.C. § 102(e) (pre-AIA) because the "date of invention" for the '794 patent predates the July 31, 2006, filing date of Yu.

Patent Owner submitted the declarations of Steven Altamura, the inventor, during prosecution of the '794 patent and during prosecution of the earlier-filed application for U.S. 11,096,252, describing how he documented conception of the invention and then built a working prototype in order to show it to a customer. EX1002 at 99-100 ¶¶ 2, 7 ('794 application); EX2016 at 110-11 ¶¶ 2, 7 ('252 application).

Mr. Altamura's declarations establish diligence in the filing of the application following conception. However, his actual reduction to practice—before Yu's filing date—renders irrelevant the issue of reasonable diligence. *Shindlear v. Holdeman*, 628 F.2d 1337, 1341 (C.C.P.A. 1980); *Paulik v. Rizkalla*, 760 F. 2d 1270, 1273 (Fed. Cir. 1985). Because the Altamura declarations establish a reduction to practice before Yu's filing date, Yu is removed as reference that could sustain the Petition's request for cancellation.

1. Legal Standard

A reference is prior art only if filed before the date of "the invention by the [patent owner]." 35 U.S.C. § 102(e) (pre-AIA). *See, e.g., Sequenom v. Leland Stanford Junior Univ.*, No. IPR2013-00390, at 5 (PTAB Nov. 25, 2014). A patent owner may antedate an asserted prior art patent by showing conception of the claimed invention prior to the critical date and either actual reduction to practice prior to the critical date **<u>or</u>** "reasonably continuous diligence" in reducing the invention to practice until its effective filing date. *Medtronic, Inc. v. Teleflex Innov. S.À.R.L.*, 68 F.4th 1298, 1303 (Fed. 2023).

To establish actual reduction to practice before the critical date, it must have been shown that "(1) [the inventors] constructed an embodiment or performed a process that met all the limitations of the [claimed invention]; and (2) [the inventors] determined that the invention would work for its intended purpose." *Id*., quoting *Cooper v. Goldfarb*, 154 F.3d 1321, 1327 (Fed. Cir. 1998). Inventor testimony may serve as evidence of reduction to practice, but it must be corroborated by independent evidence. *Medtronic*, 68 F.4th at 1307; *Perfect Surgical Techniques, Inc. v. Olympus Am., Inc.*, 841 F.3d 1004, 1009 (Fed. Cir. 2016).

In an IPR, the petitioner bears the ultimate burden of persuasion on invalidity, which never shifts to the patent owner. *Medtronic*, 68 F.4th at 1303, citing *Dynamic Drinkware, LLC v. Nat'l Graphics, Inc.*, 800 F.3d 1375, 1378-79 (Fed. Cir. 2015). When a patent owner seeks to antedate an asserted prior art reference, the patent owner takes on a temporary burden of production. *Id*. Once that burden is met, the burden shifts back to the petitioner. *Id*.

Moreover, the "law does not impose an impossible standard of `independence' on corroborative evidence by requiring that every point of a reduction to practice be corroborated by evidence having a source totally independent of the inventor; indeed, such a standard is the antithesis of the rule of reason." *Medtronic*, 68 F.4th at 1307, quoting *Knorr v. Pearson*, 671 F.2d 1368, 1374 (C.C.P.A. 1982).

2. The Inventor Reduced the Claimed Invention to Practice Before the July 2006 Critical Date of Yu

Here, the '794 patent claims priority to Provisional Application No. 62/876,868, filed on December 22, 2006, after the July 31, 2006, critical date for Yu. EX2004. Patent Owner submitted the declaration of Steven Altamura, inventor of the '794 patent, during prosecution in 2020 of U.S. 11,096,252, describing conception and reduction to practice before July 31, 2006. EX1016 at 110-11 ¶¶ 2, 7. A revised declaration from Mr. Altamura was submitted by Patent Owner during subsequent prosecution of the '794 patent, a continuation of U.S. 11,096,252. EX1002 at 99-100.

Mr. Altamura's declaration describes how he built a functioning prototype of the invention at least as early as January 15, 2006, in order to have it reviewed by a customer. EX1002 at 99-100 ¶¶ 2, 7. The exhibits are unquestionably attached to the revised declaration. *Id*.

Exhibits A, B, C, and D to the declaration documents Mr. Altamura's conception of the invention. EX1002 ¶ 7. Exhibit A is his first documentation of the invention and is dated January 12, 2006. *Id.* ¶ 6. Mr. Altamura documented in writing further refinements of the bypass concept on January 31, 2006, and February 27, 2006, as shown by Exhibits B, C, and D. *Id.* ¶ 7. Mr. Altamura built the prototype of the invention shown in his drawings "at least as early as 15 Jan 2006, in order to have it reviewed by a customer." EX1002 ¶ 7.

Here, Mr. Altamura's declaration testimony regarding reduction to practice is sufficiently corroborated under the rule of reason standard. Making and using the invention to show to a customer establishes that the invention worked for its intended purpose and provides independent corroboration sufficient to carry Patent Owner's burden of production.

Petitioner's argument against giving the Altamura declarations weight essentially boils down to that the Examiner would not have considered the declarations during prosecution because they were unsolicited and without reference to a specific prior art rejection. Pet. 71. But just because

the Examiner did or did not consider them during prosecution, the declarations stand on their own as evidence of conception and reduction to practice of the invention. Patent Owner has established its burden of production to remove Yu from consideration as prior art. Petitioner was aware of Mr. Altamura's declarations before filing the Petition, and offer no rebuttal in the Petition. Because Patent Owner has offered unrebutted evidence of a prior invention eliminating Yu as prior art, Petitioner has failed to show a reasonable probability that the claims are unpatentable based on Yu.

REDLINE PREPARATION NOTES

This is a comparison of only the text of the POPR Sec G and POR Sec G regarding the status of Yu as prior art.

The comparison was performed by Microsoft Word using the POPR as the original (base) document and the POR as the revised document.