From:	Trials
To:	Daniel J. Pereira, Ph.D.; Trials; Jason Eisenberg; Donald McPhail; Kristina Caggiano Kelly; Chase Hammond; Simran Parmar; Maxwell Furigay
Cc:	PTAB Account; PTAB Account
Subject:	RE: IPR2025-00439
Date:	Thursday, April 3, 2025 10:08:36 AM
Attachments:	image001.png

Counsel,

This confirms that the March 4 date provided in our April 1, 2025 email was a typographical error. Petitioner shall file its replacement declaration as soon as possible, but in no event later than April 4, 2025. This email chain will be entered as a 3000 series exhibit.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>
Sent: Wednesday, April 2, 2025 4:24 PM
To: Trials <Trials@USPTO.GOV>; Jason Eisenberg <jasone@sternekessler.com>; Donald McPhail <dmcphail@merchantgould.com>; Kristina Caggiano Kelly <kckelly@sternekessler.com>; Chase Hammond <CHAMMOND@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>
Cc: PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR2025-00439

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Honorable Board:

Petitioner confirms the Board's understandings as set forth in the email below, but requests confirmation that the substitute declaration should be filed by April 4, rather than March 4 as stated in the email.

Petitioner also requests confirmation that this entire email chain will be made a part of the record of these proceedings as Petitioner's Motion to Replace the Declaration of Professor Goel.

Respectfully,
Daniel Pereira (Lead Counsel for Petitioner)

Daniel J. Pereira, Ph.D.
Merchant & Gould P.C.
1900 Duke Street
Suite 600
Alexandria, VA 22314
USA

Telephone (703) 518-4509
Fax (612) 332-9081
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From: Trials <Trials@USPTO.GOV>
Sent: Tuesday, April 1, 2025 8:07 AM
To: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>; Trials <Trials@USPTO.GOV>; Jason Eisenberg <jasone@sternekessler.com>; Donald McPhail <dmcphail@merchantgould.com>; Kristina Caggiano Kelly <kckelly@sternekessler.com>; Chase Hammond <CHAMMOND@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>
Cc: PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR2025-00439

CAUTION - External.

Counsel,

We caution the parties against including argument in their email communications with the Board. We will not consider any of the arguments or assertions in the below email chain in reaching any substantive decisions in this case. We also advise the parties that we do not generally find invective persuasive or helpful.

Petitioner states that it "will not raise any new art or new arguments of unpatentability beyond those set forth in the as-filed Petition and Dr. Goel's

declaration in support thereof." We understand this to mean that the replacement declaration will be substantively identical to that in the originally filed Goel Declaration. With that understanding of Petitioner's statement, we understand that Patent Owner does not object to Petitioner replacing Dr. Goel's declaration. Based on these understandings, we treat Petitioner's email as a Motion to Replace the Declaration of Professor Goel and we GRANT Petitioner's motion. Petitioner shall file its replacement declaration as soon as possible, but in no event later than March 4, 2025.

In the event the above understandings are incorrect, for example because replacing Professor Goel's declaration requires substantive changes, or in the event Petitioner cannot file its replacement declaration by March 4, 2025, the parties are instructed to provide their availability for a conference call with the Board.

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>
Sent: Friday, March 28, 2025 2:09 PM
To: Trials <Trials@USPTO.GOV>; Jason Eisenberg <jasone@sternekessler.com>; Donald McPhail <dmcphail@merchantgould.com>; Kristina Caggiano Kelly <kckelly@sternekessler.com>; Chase Hammond <CHAMMOND@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>
Cc: PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR2025-00439

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Honorable Board:

As an initial matter, Petitioner respectfully submits that Patent Owner is in no position to dictate the terms and conditions under which Petitioner can replace its expert, Dr. Goel, since it is Patent Owner who has forced Petitioner's hand here by engaging in an outrageous (and improper) intimidation/harassment directed towards Dr. Goel, his students and fellow faculty members at Rutgers.

Faced with these unfortunate and undeniable facts, counsel for Patent Owner has frankly made matters worse by brazenly denying that Corning has taken any action adverse to Dr. Goel, and

expressly claiming "Corning has continued funding projects and cooperating on papers (including with his students) and presentations." That statement is, at best, a misrepresentation because undersigned counsel for Petitioner has already seen correspondence from a Corning employee to one of Dr. Goel's students and from Corning's outside counsel in the pending parallel ITC proceedings involving the '394 patent, Investigation Nos. 337-TA-1433 and 337-TA-1441 to the head of the School of Engineering at Rutgers. By way of example, the letter from Corning to one of Dr. Goel's students is dated February 14, 2025 and states that "Corning has a lengthy and mutually beneficial relationship with Rutgers University, and we intend to continue this well into the future, ***but we must unfortunately pause our collaboration with Professor Goel as he has taken an adverse position to Corning in legal proceedings involving Corning's intellectual property***." (emphasis added). This letter further states that "[a]s a result of this circumstance . . . ***we are therefore unfortunately unable to collaborate with you going forward***" and "[a]t this point, ***I simply am not in position to provide new data on any of your current and future projects*** , including your request for ^{51}V NMR." (emphasis added). Significantly, Patent Owner cannot argue that the research referenced in Corning's letter has any relevance to this proceeding, since none of the claims of the '394 patent include any reference to vanadium (V) or the vanadium content of glass.

Counsel for Patent Owner also claims that Dr. Goel is in possession of Corning's "confidential" information. But counsel for Patent Owner studiously fails to identify, even generally, what "confidential" information of Corning's might be involved in a proceeding involving an issued U.S. patent (a public document) and the patentability of the claims thereof over prior art patents and publications (all of which are also public documents). This claim is therefore devoid of merit based on the current record. Critically, Patent Owner has not pointed to, much less produced, any purported non-disclosure agreement or similar confidentiality pledge signed by Dr. Goel. In fact, undersigned counsel is informed that no such agreement or pledge exists, which raises, *inter alia*, the question of exactly what steps, if any, Patent Owner has taken in the past to protect its alleged "confidential" information.

Moreover, even assuming that Patent Owner's claims are true – and there is no basis for believing they are at this time – there are established expert disqualification procedures that Patent Owner could have followed if there was a legitimate concern Dr. Goel was in possession of Corning's "confidential" information. *See*, *e.g.*, IPR2015-00503, Paper 13 (Aug. 19, 2015). Patent Owner expressly chose not to follow those procedures, however, and, instead decided to proceed with a full-fledged campaign of targeted intimidation and harassment designed to force Dr. Goel to withdraw his assistance and stay quiet on this matter going forward or be faced with an unrelenting assault on his professional and personal reputation. In view of the unfortunate and shocking facts uncovered thus far, Petitioner therefore intends to seek authorization from the Board to file a motion for sanctions against, at least, Patent Owner.

Nevertheless, to the extent that the Board is inquiring of Petitioner whether it is amenable to Patent Owner's "proposed agreement that it 'will not oppose Petitioner's replacing [Dr. Goel] and [Dr. Goel's] declaration so long as'" certain conditions are met, Petitioner responds that, subject to not waiving its rights to later seek sanctions against, at least, Patent Owner: (1) Petitioner will not raise any new art or new arguments of unpatentability beyond those set forth in the as-filed Petition and Dr. Goel's declaration in support thereof; and (2) Petitioner verifies that, much like Dr. Goel, Petitioner's new expert has no Corning confidential information.

Respectfully,
Daniel Pereira (Lead Counsel for Petitioner)

Daniel J. Pereira, Ph.D.
Merchant & Gould P.C.

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Please consider the environment before printing this email. Thank you.

From: Trials <Trials@USPTO.GOV>
Sent: Wednesday, March 26, 2025 7:39 AM
To: Jason Eisenberg <jasone@sternekessler.com>; Trials <Trials@USPTO.GOV>; Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>; Donald McPhail <dmcphail@merchantgould.com>; Kristina Caggiano Kelly <kckelly@sternekessler.com>; Chase Hammond <CHAMMOND@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>
Cc: PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR2025-00439

CAUTION - External.

Counsel,

We request that Petitioner advise whether it is amenable to Patent Owner's proposed agreement that it "will not oppose Petitioner replacing Petitioner's expert and expert declaration so long as: (1) only the biographical information is updated in the declaration, and none of the arguments are changed and (2) Petitioner verifies to Patent Owner and the Board that Petitioner's new expert has never worked with Corning and has no Corning confidential information."

Regards,

Andrew Kellogg,
Deputy Chief Clerk, Trials
Patent Trial and Appeal Board
USPTO
andrew.kellogg@uspto.gov
(571) 272-5366

From: Jason Eisenberg <jasone@sternekessler.com>
Sent: Monday, March 24, 2025 7:18 PM
To: Trials <Trials@USPTO.GOV>; Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>; Donald McPhail <dmcphail@merchantgould.com>; Kristina Caggiano Kelly <kckelly@sternekessler.com>; Chase Hammond <CHAMMOND@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>
Cc: PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR2025-00439

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Hello,

Thank you for your email.

Corning objects to Petitioner's characterization of the situation and unilateral email to the Board.

In response to Petitioner's emails, Counsel and Corning were preparing a proposal that we hoped would address the situation in a way that would end in an agreement between the parties to move forward jointly and without the need to waste the Office's resources, which is outlined below. But rather than waiting until the end of the day for Corning's response as agreed, Petitioner unilaterally sent it's own factually inaccurate and unnecessarily inflammatory email in lieu of the proposed joint email.

Dr. Goel breached ethical conflicts taking on this project based on decades of his, his department's, his students', and his university's engagements with Corning and knowledge of Corning confidential information. It is therefore foreseeable that following his assistance with the Petition, Corning would take steps to limit at least Dr. Goel's access to Corning and its confidential information going forward. Corning's conduct is not "intimidation and harassment."

Corning has actually gone out of its way to avoid "intimidation and harassment" of Dr. Goel. For example, after discovering Dr. Goel was Petitioner's expert, Corning asked the university to take no action on Corning's behalf against Dr. Goel. And Corning has continued funding projects and cooperating on papers (including with his students) and presentations.

If requested, Corning is willing to share with the Board - under seal - emails and letters that demonstrate Corning's proper conduct.

In the end, Corning does not wish to escalate this situation further and would rather reach an amicable agreement to avoid unnecessarily wasting any more Board resources.

To answer the Board's questions below, Corning consents to and will not oppose Petitioner replacing Petitioner's expert and expert declaration so long as: (1) only the biographical information is updated in the declaration, and none of the arguments are changed and (2) Petitioner verifies to

Patent Owner and the Board that Petitioner's new expert has never worked with Corning and has no Corning confidential information.

Patent Owner is open to the Board's guidance on how to proceed, and are available for a call with the Board if requested.

Thank you.
Jason Eisenberg, for Patent Owner

Jason Eisenberg (he/him/his)
Director
Sterne, Kessler, Goldstein & Fox P.L.L.C.
Email: jasone@sternekessler.com
Mobile: 301.448.9871 **Office Direct:** 202.772.8645

From: Trials <Trials@USPTO.GOV>
Sent: Monday, March 24, 2025 3:01 PM
To: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>; Donald McPhail <dmcphail@merchantgould.com>; Jason Eisenberg <jasone@sternekessler.com>; Kristina Caggiano Kelly <kckelly@sternekessler.com>; Chase Hammond <CHAMMOND@sternekessler.com>; Simran Parmar <SPARMAR@sternekessler.com>; Maxwell Furigay <MFurigay@sternekessler.com>
Cc: Trials <Trials@USPTO.GOV>; PTAB Account <PTAB@sternekessler.com>; PTAB Account <PTAB@sternekessler.com>
Subject: RE: IPR2025-00439

EXTERNAL EMAIL: Use caution before clicking links or attachments.

Counsel,

We request that Patent Owner advise: 1) whether it has any objection to authorizing Petitioner to file a motion to replace its current technical expert, Prof. Goel, with another expert, and 2) if such motion is filed, whether Patent Owner expects to oppose the substitution.

Regards,

Franchesca I. Alicea Villanueva
Supervisory Paralegal
Patent Trial & Appeal Board
U.S. Patent & Trademark Office

From: Daniel J. Pereira, Ph.D. <dpereira@merchantgould.com>
Sent: Friday, March 21, 2025 5:21 PM
To: Trials <Trials@USPTO.GOV>
Cc: Donald McPhail <dmcphail@merchantgould.com>; Jason Eisenberg <jasone@sternekessler.com>; Kristina Caggiano Kelly <kckelly@sternekessler.com>; Chase Hammond <chammond@sternekessler.com>; Simran Parmar <sparmar@sternekessler.com>; Maxwell Furigay <mfurigay@sternekessler.com>
Subject: IPR2025-00439

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Honorable Board

Petitioner, Caihong Display, requests a teleconference with the Board to seek authorization to file a motion to replace its current technical expert, Prof. Goel, with another expert. Prof. Goel is no longer willing to be an expert for Caihong in this IPR due to intimidation and harassment by Patent Owner, Corning. Petitioner has therefore identified a new expert to fill this role.

Counsel for Petitioner emailed counsel for Patent Owner (Corning) about this request on March 18 and discussed the same with counsel for Patent Owner on March 19, but counsel for Patent Owner has thus far declined to state whether Patent Owner will oppose or not oppose this request despite follow-up emails from counsel for Petitioner on March 20 and 21.

Daniel Pereira (Lead Counsel for Petitioner)
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