

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

Caihong Display Devices Co., Ltd.,

Petitioner,

v.

Corning Incorporated,

Patent Owner.

Case No.: IPR2025-00439

U.S. Patent No. 7,851,394

PETITIONER'S OPPOSITION TO PATENT OWNER'S MOTION TO STRIKE

I. Introduction

Pursuant to 37 C.F.R. §§ 42.5(a) and 42.71(a), Petitioner Caihong Display Devices Co., Ltd. hereby submits its Opposition to the April 25, 2025, Motion to Strike filed by Patent Owner Corning Incorporated (“PO”), Paper No. 8.

II. Petitioner Complied with the Board’s Authorization

Petitioner was compelled to seek authorization to submit a substitute declaration (“Ernst Declaration”) to replace the Declaration of Dr. Ashutosh Goel (“Goel Declaration”), after Dr. Goel was intimidated and harassed by PO such that he withdrew as Petitioner’s expert. (*See generally* Ex. 3001.) In response to Petitioner’s request for authorization, on April 1, 2025, the Board emailed counsel for Petitioner and counsel for PO:

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. EX3001, 2-3.

The Board also authorized Petitioner to file the Ernst Declaration by March 4, 2025, later corrected to April 4, 2025, subject to Petitioner’s confirmation of the Board’s understanding. EX3001, 1-3.

As stated in the email, the Board understood the Ernst Declaration was to be “‘substantively’ identical” to the originally filed Goel Declaration (*id.*) and that is precisely what it is, despite PO’s protestations to the contrary. The Ernst Declaration does not introduce any new prior art or any new arguments of unpatentability. And this is exactly what Petitioner committed to when it responded to the Board’s email reproduced above and confirmed that 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.” EX3001, 2-3) PO’s claim that “Ppetitioner confirmed the Board’s understanding and did not present any need or justification to change the declaration beyond updating the biographical information for the expert” (Paper No. 8 at 4) is not at all supported by the factual record. *See id.*

Significantly, PO does not allege that the Ernst Declaration introduced any new prior art or raised any new arguments of unpatentability, thus neither PO nor the Board is being asked to evaluate any new subject matter. To be clear, the Ernst Declaration does not introduce any new theories, arguments, references, or claim constructions. The petition and the prior art relied upon in the petition remain unchanged and no new arguments or additional evidence were presented.

Without further consideration to PO’s arguments, consistent with Board guidance and prior decisions, PO’s motion to strike should be denied:

In most cases, the Board is capable of identifying new issues or belatedly presented evidence when weighing the evidence at the close of trial, and disregarding any new issues or belatedly presented evidence that exceeds the proper scope of reply or sur-reply. As such, striking the entirety or a portion of a party's brief is an exceptional remedy that the Board expects will be granted rarely.

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See also Twinstrand Biosciences, Inc. v. Guardant Health, Inc., No. IPR2022-01400, 2024 WL 305696, at *19 (P.T.A.B. Jan. 26, 2024) (denying motion to strike where “striking the entirety or a portion of a party’s brief,” or in this case the entirety of both of Petitioner's Reply declarations and related exhibits, is an “exceptional remedy.”) (internal citations removed); *Pfizer, Inc. v. Genentech, Inc.*, No. IPR2017-01923, 2019 WL 237073, at *1 (P.T.A.B. Jan. 16, 2019) (denying Patent Owner’s motion to strike expert report as an extreme measure); *Shure Inc. v. Clearone, Inc.*, No. IPR2017-01785, 2019 WL 342476, at *18 (P.T.A.B. Jan. 24, 2019) (denying Patent Owner’s request for rehearing and affirming the decision to deny its motion to strike expert’s declaration); *Mylan Pharms. Inc. v. Sanofi-Aventis Deutschland GmbH*, No. IPR2017-01526, 2018 WL 6584915, at *4 (P.T.A.B. Dec. 12, 2018) (denying Patent Owner’s motion to strike Petitioner’s reply and expert declaration).

III. The Board Has Authority to and Should Enter the Ernst Declaration

Patent Owner seeks to limit the Board’s authorization by suggesting the Board

has no authority to allow the substitution of the Ernst Declaration for the Goel Declaration. (Paper 8, at 1.) To the undersigned's knowledge, however, the present circumstances have never been addressed by the Board. Significantly, this entire situation was precipitated solely by PO's misconduct and that inconvenient truth should not be overlooked. Indeed, had PO not resorted to witness intimidation, the Goel Declaration would never have needed to be replaced.

Furthermore, two seasoned experts may, and often do, express opinions in different ways or even emphasize different aspects of a teaching. Particularly under these circumstances, where this whole situation has arisen because of PO's malfeasance, Dr. Ernst should be permitted to articulate his opinions in his own words, based on his independent review of the evidence and his performance of any analyses that the prior expert was afforded the opportunity to conduct. *Abbott v. Lockheed Martin Corp.*, No. 06-cv-0701, 2014 WL 6613148, at *2 (S.D. Ill. Nov. 21, 2014) (“[T]he caselaw does not clearly require a line-by-line (or even a rough) comparison of old and new expert reports, so long as the conclusions are the same.”); *Lincoln Nat. Life Ins. Co. v. Transamerica Fin. Life Ins. Co.*, No. 04-cv-396, 2010 WL 3892860, at *3 (N.D. Ind. Sept. 30, 2010) (“Although the substitute expert's testimony and report are generally restricted to the same subject matter as the prior expert, the substitute is not normally required to simply adopt the prior expert's

conclusions verbatim—in effect, doing little more than authenticating and confirming the prior expert's conclusions.”); *Morel v. Daimler-Chrysler Corp.*, 259 F.R.D. 17, 22 (D.P.R. 2009) (“Mr. Keefer [the replacement expert] should have the opportunity to express his opinions in his own language after reviewing the evidence and performing whatever tests prior experts on both sides were allowed to perform.”).

Moreover, courts routinely recognize that, in certain exceptional circumstances, a degree of flexibility is both appropriate and necessary to ensure fairness and the integrity of the proceedings. *See, e.g., Cornell Rsch. Found., Inc. v. Hewlett-Packard Co.*, No. 01-cv-1974, 2006 WL 5097357, at *17 (N.D.N.Y. Nov. 13, 2006), *order clarified*, No. 01-cv-1974, 2007 WL 4324094 (N.D.N.Y. May 16, 2007), *aff'd sub nom. Cornell Univ. v. Hewlett-Packard Co.*, No. 01-CV-1974, 2007 WL 4302778 (N.D.N.Y. July 23, 2007) (allowing plaintiffs to reopen fact discovery should it be required “[t]o ensure fundamental fairness” after defendant provided a tactical “document dump” upon plaintiff).

This case presents precisely such a situation, where unforeseen and extraordinary events far beyond Petitioner’s control warrant reasonable procedural accommodation. Particularly where, as here, the underlying analysis, methodology,

and conclusions remain consistent with the original positions advanced in the first declaration.

IV. Non-Substantive Differences Between the Declarations Should Be Permitted

PO asks the Board to exclude portions of the Ernst Declaration on the basis that certain paragraphs are purportedly not “substantively identical” to those found in the Goel Declaration. Paper 8, at 1. However, while Dr. Ernst may have slightly modified the language used within such paragraphs, the underlying theories are all precisely the same and are fully consistent with the opinions expressed in the Goel Declaration. Indeed, far from adding “new” information, Dr. Ernst simply made non-substantive edits to the opinions provided by Dr. Goel to align with the verbiage necessary to impart his opinions in a way familiar to him.

Specifically, PO’s the alleged “differences” between the Ernst Declaration “differs” and the Goel Declaration that PO has specifically identified are all non-substantive. Paper 8, at 8 – 11. Indeed, these alleged “differences” can be grouped into three main categories: linguistic distinctions; equal but alternative mathematical approaches; and additional color to the CTE temperature range disclosed by Miwa. None of these changes is substantive.

First, the linguistic distinctions made to the POSITA paragraph (Ernst Decl. at ¶ 36) and those used to describe the prior art (Ernst Decl. at ¶¶ 46, 53, 57, and

163) are merely that: stylistic choices. The discussion of the POSITA's education and background and the changes to the descriptions of the prior art reflect non-substantive differences in language, nothing more. And each of these points is entirely consistent with Dr. Goel's analysis and opinions; Dr. Ernst's choice of words simply represents a stylistic or explanatory refinement—not a departure from the positions previously advanced.

Second, Dr. Ernst uses a few equal but alternative mathematical approaches to those that Dr. Goel used. Ernst Decl. at ¶¶ 55, 59, 64, 66, 67, 88, 91, 117, 167, 193, and 225. More particularly, Dr. Ernst explains the numerical data through the lens of his unique expertise, focusing on what the figures signify from a mathematical and analytical standpoint. His discussion emphasizes how the numbers inform his conclusions and align with the broader framework of his analysis, which aligns with the opinion of Dr. Goel. Importantly, the values Dr. Ernst proposes to use still fall within the claims. Accordingly, any purported “differences” are non-substantive and therefore inconsequential.

Third, Dr. Ernst's categorization of Miwa merely provides additional color to the CTE temperature range disclosed by Miwa (Ernst Decl. at ¶¶ 111, and 138) and thus serves only to provide additional context of the conclusions in the Goel Declaration based on Ernst's personal knowledge and experience. PO does not (and

cannot) dispute that the arguments for unpatentability remain the same and the prior art upon which such arguments are based remain the same.

In sum, while Dr. Ernst has made some minor non-substantive changes, he has done so only to try and make the Goel Declaration more his own. Importantly, PO studiously fails to mention that Dr. Ernst will be subject to cross-examination in this proceeding and any issues about his declaration can be addressed in that context, versus the extraordinary remedy of granting a motion to strike. *Securus Techs., Inc. v. Glob. Tel*link Corp.*, No. 2016-cv-00044, 2017 WL 4082473, at *1 (P.T.A.B. Sept. 13, 2017) (denying motion to strike because at the time of the order, the Patent Owner had “the opportunity to cross-examine Petitioner’s Reply Declarant.”); *BLK Enters., LLC v. Unix Packaging, Inc.*, No. 18-cv-2151, 2018 WL 5993839, at *3 (C.D. Cal. Oct. 2, 2018); *see also Enters v. AT & T*, No. 98-cv-3660, 2005 WL 3988698, at *1 (D.N.J. Sept. 8, 2005) (denying a motion to exclude a supplemental expert opinion after the close of expert discovery: “the Court deems the sanction of exclusion *too extreme*. . . . Consequently, there is insufficient prejudice to warrant exclusion, and defendants could *remedy* that prejudice fairly easily.”) (emphasis in original). Here, PO will have “adequate time to prepare for cross-examining [Dr, Ernst], and any implied prejudice caused by [his timely] disclosure will be cured by

the ability to fully respond with a rebuttal expert.” *Abbott v. Lockheed Martin Corp.*, No., 06-cv-0701, 2014 WL 6613148, at *2 (S.D. Ill. Nov. 21, 2014).

This is particularly appropriate in the current situation where, but for PO’s egregious actions, Dr. Ernst must now take a seat in the witness chair rather than Dr. Goel.

V. Conclusion

For the foregoing reasons, Petitioner Caihong respectfully opposes PO’s Motion to Strike.

Dated: May 2, 2025

Respectfully Submitted,

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CERTIFICATE OF SERVICE (37 C.F.R. § 42.6(e)(1))

The undersigned hereby certifies that the above document was served on May 2, 2025, by filing this document through the Patent Trial and Appeal Board P-TACTS System, as well as delivering a copy via express mail upon the following attorneys of record for the Patent Owner:

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