

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

CAIHONG DISPLAY DEVICES CO., LTD.,
Petitioner,

v.

CORNING INCORPORATED,
Patent Owner.

IPR2025-00439
Patent 7,851,394

Before CHRISTOPHER M. KAISER, AVELYN M. ROSS, and
DAVID COTTA, *Administrative Patent Judges*.

COTTA, *Administrative Patent Judge*.

ORDER
Conduct of Proceeding
37 C.F.R. § 42.5

I. INTRODUCTION

On January 13, 2025, Caihong Display Devices Co., Ltd. (“Petitioner”) filed a Petition requesting *inter partes* review of U.S. Patent No. 7,851,394 (“the ’394 patent”). Paper 1. The Petition was accompanied by the declaration of Dr. Ashutosh Goel. Ex. 1003. With our prior authorization (Ex. 3001), Petitioner filed the declaration of Dr. Frank Ernst (Ex. 1003)¹ to replace the Goel Declaration. This Order addresses Patent Owner’s motion to strike some of the testimony in the Ernst Declaration on the basis that it untimely introduces new matter and argument and on the basis that it exceeds the scope of replacement we authorized. For the reasons discussed below, we grant Patent Owner’s motion, but authorize to file a Revised Substitute Declaration on terms set forth herein.

II. PROCEDURAL BACKGROUND

On March 21, 2025, Petitioner contacted the Board by email to request authorization to file a motion to replace the declaration of Dr. Ashutosh Goel with that of another declarant because Dr. Goel was “no longer willing to be an expert for [Petitioner].” Ex. 3001. In subsequent email correspondence, Patent Owner agreed that it would not oppose Petitioner’s request provided that “only the biographical information is updated in the declaration, and none of the arguments are changed.” *Id.* We requested that Petitioner advise whether it was amenable to this condition.

¹ There are currently two versions of Exhibit 1003: the originally filed Declaration of Dr. Ashtush Goel and the substitute Declaration of Dr. Frank Ernst. We distinguish between the two by declarant name or by using the terms “original” and “substitute” or “replacement.”

Id. Petitioner responded that it would “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.” *Id.* To avoid any ambiguity, in an April 1, 2025 email, we stated:

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.

Id. We further instructed, “[i]n the event the above understandings are incorrect, for example because replacing Dr. Goel’s declaration requires substantive changes, . . . the parties are instructed to provide their availability for a conference call with the Board.” *Id.* Petitioner responded by stating “Petitioner confirms the Board’s understandings.” *Id.* Petitioner did not request a conference call with the Board.

On April 4, 2025, Petitioner filed the Substitute Declaration of Dr. Frank Ernst. Ex. 1003. On April 18, 2025, Patent Owner contacted the Board by email, requesting authorization to file a motion to strike portions of Dr. Ernst’s Declaration. Ex. 3002. On April 25, 2025, we held a conference call with the parties to discuss Patent Owner’s request, during which we authorized Patent Owner’s requested motion. Paper 9. Patent Owner filed its motion on April 25, 2025. Paper 8 (“Mot.”) We also authorized

Petitioner to file an Opposition. Paper 9. Petitioner filed its Opposition on May 2, 2025. Paper 11 (“Opp.”).

III. ANALYSIS

Patent Owner’s motion presents two grounds for striking portions of Dr. Ernst’s Declaration: 1) it untimely introduces new matter not submitted at the time the Petition was filed, and 2) it exceeds the scope of what we authorize Petitioner to file. Mot. 1. We limit our analysis to determining whether the Substitute Declaration of Dr. Ernst exceeds the scope of what we authorized Petitioner to file. Because it is not necessary to resolve this dispute, we do not determine whether the testimony at issue constitutes new matter or new argument.

We authorized Petitioner to file a substitute declaration with the understanding that it would be “substantively identical” to the original declaration and instructed Petitioner to provide its availability for a conference call if its replacement declaration required substantive changes. Ex. 3001. Petitioner did not request a conference call, and instead unequivocally confirmed our understanding that the replacement declaration would be “substantively identical” to the original declaration. *Id.* (“Petitioner confirms the Board’s understandings.”). Accordingly, the question before us in determining whether Petitioner’s filing exceeds the scope of our authorization is whether the challenged portions of Dr. Ernst’s Declaration are “substantively identical” to the corresponding portions of Dr. Goel’s Declaration.

Patent Owner contends that paragraphs 36, 46, 53, 55, 57, 59, 64, 66, 67, 88, 91, 111, 117, 138, 163, 167, 193, and 225 of the replacement Ernst

Declaration include substantive differences as compared to the corresponding paragraphs of the original Goel Declaration. Mot. 9. Patent Owner provides a chart identifying allegedly substantive changes, paragraph-by-paragraph, in the column at left and explaining why the change is substantive on the right. *Id.* at 8–11.

Petitioner contends that the Ernst Declaration is “substantively identical” to the originally filed Goel Declaration. Opp. 2. Petitioner contends that the alleged differences between the Ernst and Goel Declarations can be grouped into three categories: “linguistic distinctions; equal but alternative mathematical approaches; and additional color to the CTE temperature range disclosed by Miwa.” Opp. 6. According to Petitioner, “[n]one of these changes is substantive.” *Id.*

We agree with Patent Owner that paragraphs 36, 46, 53, 55, 57, 59, 64, 66, 67, 88, 91, 111, 117, 138, 163, 167, 193, and 225 of the replacement Ernst Declaration are not “substantively identical” to the corresponding paragraphs of the original Goel Declaration. Exemplary differences between the two declarations include: increasing the level of skill in the art and replacing a quantifiable experience level with a subjective experience level (§ 36); deleting a statement describing the challenged patent as teaching that “MgO content and $\Sigma[\text{RO}]/[\text{Al}_2\text{O}_3]$ ratio” are “critical to the glass performance” (§ 46); changing the way the two prior art references are described from disclosing in “certain weight percentages” or in “certain mole percentages” to disclosing “a continuous range of glass compositions” (§§ 53, 57, 163); changing the number of significant figures after the calculation of mole percentage (§ 55); using different terminology to identity

the parameter being optimized by changing optimizing “total concentration of BaO and SrO” in the original declaration to optimizing “combined fraction of BaO and SrO” in the substitute declaration (§ 59) and changing optimizing “total concentrations, i.e., SrO+BaO” to optimizing “combined mass fraction ($W_{\text{SrO}}+W_{\text{BaO}}$) or equivalently, combined mole fraction ($X_{\text{SrO}}+X_{\text{BaO}}$)” (§ 67); providing an equation not present in the original declaration (§ 64); changing the way the prior art is described from disclosing “an alkali-free glass” to disclosing “a range of alkali-free glass” and changing “weight percentage” to “mass fraction (§ 88); changing its characterization of the prior art from disclosing a “concentration” to disclosing a “mole fraction” (§ 91); and adding testimony that a prior art range overlaps with the claimed range (§ 111). Mot. 8–11.

Petitioner’s assertion that paragraphs 36, 46, 53, 57, and 163 reflect mere “linguistic distinctions” (Opp. 6–7) is unpersuasive. Testimony that differs in how the level of skill is defined, whether certain parameters are critical, and whether the prior art discloses a range or discrete embodiments is not “substantively identical.”

Petitioner’s assertion that the changes to paragraphs 55, 59, 64, 66, 67, 88, 91, 117, 167, 193, and 225 reflect “equal but alternative mathematical approaches” (*id.* at 7) is similarly unpersuasive. Petitioner argues that “the values Dr. Ernst proposes to use still fall within the claims” (*id.*), but regardless to their ultimate impact on Petitioner’s unpatentability arguments, we fail to see how changes to the terminology used to describe technical parameters (including parameterized to be optimized), significant figures,

and equations used for calculations result in testimony that can fairly be described as “substantively identical.”

Finally, Petitioner’s assertion that changes to paragraphs 111 and 138 “merely provide[] additional color to the CTE range disclosed by [the prior art]” (*id.*) does not persuade us that the original and substitute paragraphs are “substantively identical.” Paragraphs 111 and 138 of the original Goel declaration were limited to discussion of why “[t]he differences between CTE measured over a temperature range of 0–300°C and 30–380°C are of no consequence.” Original Ex. 1003 ¶¶ 111, 139. Substitute paragraph 111 adds “[s]aid another way, the temperature interval $[T_1, T_2] = [0^{\circ}\text{C}, 300^{\circ}\text{C}]$ referenced in the ’394 Patent, the CTE of Miwa’s glass will overlap with the interval of $[28 \cdot 10^{-7} \text{ K}^{-1}, 34 \cdot 10^{-7} \text{ K}^{-1}]$ reported in the in the [sic] ’394 Patent.” Substitute Ex. 1003 ¶¶ 111, 139. Testimony that a claimed range overlaps with the prior art is not substantively identical to testimony limited to describing the differences between the claimed range and the prior art range as being of “no consequence.” Mot. 11.

In sum, we determine that the challenged testimony in Dr. Ernst’s declaration is not substantively identical to testimony in Dr. Goel’s original declaration. We recognize that the material changed in the paragraphs at issue may be cumulative of testimony elsewhere in the declaration or of arguments presented in the Petition. But Petitioner does not make this argument. Accordingly, we do not address it here. We determine that the challenged testimony in Dr. Ernst’s declaration exceeds the scope of what we authorized in our April 1, 2025 email. Ex. 3001.

Petitioner argues that “unforeseen and extraordinary events far beyond Petitioner’s control warrant reasonable procedural accommodation” and thus we should recognize that “a degree of flexibility is both appropriate and necessary to ensure fairness and the integrity of the proceedings.” Opp. 5. This argument does not provide justification for filing a declaration that exceeds the scope of what we authorized. The alleged “extraordinary events” Petitioner references all occurred before we authorized Petitioner to file a substitute declaration. Indeed, it was these events that provided the basis for authorizing a substitute declaration. Petitioner does not identify any unforeseen and extraordinary events that occurred between our email authorization and the filing of the substitute declaration. Accordingly, there are no extraordinary events that provide a basis for Petitioner to file testimony that exceeds the scope of what we authorized. This is particularly true given that we instructed Petitioner to contact the board in the event the scope of replacement we authorized was insufficient. Ex. 3001 (instructing the parties to “provide their availability for a conference call with the Board” in the event “replacing Dr. Goel’s declaration requires substantive changes.”).

Having determined that the testimony in paragraphs 36, 46, 53, 55, 57, 59, 64, 66, 67, 88, 91, 111, 117, 138, 163, 167, 193, and 225 exceeds the scope of what we authorized, and that the circumstances by which Dr. Goel became unavailable do not justify departure from what we authorized, we strike each of these paragraphs. However, we determine that circumstances do not warrant depriving Petitioner of opportunity to correct its error. Accordingly, we authorize Petitioner to file a Revised Substitute Declaration

on the following conditions: 1) for all paragraphs not addressed in this order, the Revised Substitute Declaration shall be word-for-word identical to the Substitute Declaration, 2) for each of the paragraphs addressed in this motion, Petitioner shall have the option, on a paragraph-by-paragraph basis, to replace the content of the Substitute Declaration with the corresponding paragraph of the original declaration **or** with the statement “This paragraph stricken by Order of the Board.”

We recognize that different experts may, as Petitioner explains, “express opinions in different ways or even emphasize different aspects of a teaching.” Opp. 4. However, taking Petitioner at its word that it considers the differences between the original and substitute declarations to be immaterial, we see no prejudice in limiting Petitioner to the content of its originally filed declaration. *See e.g., id.* at 6 (describing Dr. Ernst as having “slightly modified the language” of the original declaration and as having made “non-substantive edits”), 6–7 (describing certain modifications as “stylistic choices” and “stylistic or explanatory refinement[s]”), 7 (describing other modifications as “non-substantive and therefore inconsequential” and describing still other modifications as “merely provid[ing] additional color”), 8 (characterizing all of Dr. Ernst’s edits as “minor non-substantive changes”). For the same reason, we do not anticipate that Dr. Ernst will object to adhering to the language of the originally filed declaration.

ORDER

In consideration of the foregoing, it is hereby ORDERED that:

Patent Owner's Motion to Strike paragraphs 36, 46, 53, 55, 57, 59, 64, 66, 67, 88, 91, 111, 117, 138, 63, 167, 193, and 225 of the substitute Declaration of Dr. Frank Ernst is granted;

On or before May 19, 2025 Petitioner shall file either: 1) a version of the Substitute Declaration of Dr. Frank Ernst in which paragraphs 36, 46, 53, 55, 57, 59, 64, 66, 67, 88, 91, 111, 117, 138, 63, 167, 193, and 225 are redacted, or 2) a Revised Substitute Declaration in which Petitioner has replaced each of paragraphs 36, 46, 53, 55, 57, 59, 64, 66, 67, 88, 91, 111, 117, 138, 63, 167, 193, and 225 with either the corresponding paragraph of the original Declaration of Dr. Goel or with the statement: "This paragraph stricken by Order of the Board."

If Petitioner opts to file a Revised Substitute Declaration, all paragraphs not specifically addressed in this motion shall be word-for-word identical to the current Substitute Declaration of Dr. Frank Ernst.

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FOR PETITIONER:

Daniel Pereira
Donald McPhail
MERCHANT AND GOULD PC
dpereira@merchantgould.com
dmcphail@merchantgould.com

FOR PATENT OWNER:

Jason Eisenberg
Kristina Kelly
Chase Hammond
STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.
jasone-ptab@sternekessler.com
kckelly-ptab@sternekessler.com
chammond-ptab@sternekessler.com