

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFEVAC, LLC,
Petitioner,

v.

DCSTAR INC.,
Patent Owner.

U.S. Patent No. 11,478,575

Issue Date: October 25, 2022

Title: REMOVAL DEVICE FOR REMOVING OBSTRUCTION IN
RESPIRATORY TRACT AND CONNECTOR

Inter Partes Review No.: IPR2025-00454

**PETITIONER'S REPLY TO PATENT OWNER'S PRELIMINARY
RESPONSE**

The Petition clearly demonstrates that Zhongnan alone or in view of Yuchang discloses each of the elements recited in the Challenged Claims, thus rendering the Challenged Claims as unpatentable as set forth in Grounds 1 and 2. In its POPR, PO does not dispute the merits of Grounds 1 and 2, or that Zhongnan qualifies as prior art under Section 102(a)(1), but instead argues that Zhongnan should be disqualified as prior art under Section 102(b)(1)(B). Thus, the issue before the Board is whether, for purposes of institution, the Board should rely almost entirely on PO's hearsay evidence to disqualify Zhongnan under Section 102(b)(1)(B).

The remaining arguments in the POPR have been rejected by the Director where she determined that "discretionary denial under 35 U.S.C. § 325(d) is inappropriate." (Paper 11 at 2)

As addressed below, the Petitioner should be given the opportunity to take discovery of the testimonial and documentary evidence relied upon by PO, and thus the Board should institute trial to allow it to address PO's assertion based on a fully developed record.

I. Background

Zhongnan (EX-1003, 1004) was filed March 10, 2021, seven weeks before the alleged publication of the IDEAR document on April 28, 2021 (EX-2004), and published on June 10, 2021. There is no dispute that Zhongnan qualifies as prior

art under Section 102(a)(1). However, PO attempts to disqualify Zhongnan under Section 102(b)(1)(B), which reads:

102(b)(1) Disclosures made 1 year or less before the effective filing date of the claimed invention.....

(B) A disclosure shall not be prior art if “the subject matter disclosed had, before such disclosure, been publicly disclosed by the inventor or a joint inventor or another who obtained the subject matter disclosed directly or indirectly from the inventor or a joint inventor.

In order to disqualify Zhongnan, PO must demonstrate that the subject matter of Zhongnan had been publicly disclosed by the inventor or another who had obtained the subject matter from the inventor within one year of the effective filing date of the '575 Patent . Here, PO asserts that “as early as April 28, 2021”, the IDEAR document (EX-2004) was publicly disclosed by others who obtained the subject matter of the IDEAR document directly from the inventor. POPR 6.

In order to prevail at trial, PO must show: 1) the IDEAR document was a printed publication; that 2) it was published prior to Zhongnan (e.g., prior to June 11, 2021) but not prior to August 3, 2020; 3) it was disclosed by another who obtained the subject matter directly or indirectly from the inventor; and 4) it was the same subject matter as Zhongnan.

However, PO's evidence fails to show that the IDEAR document constitutes a public disclosure, that it was disclosed prior to June 10, 2021, or that the IDEAR

document was a disclosure by the inventor or another who obtained the subject matter from the inventor.

II. The Board's Consideration of Evidence During the Institution Phase

All of the evidence relied upon by PO suffers from hearsay and/or hearsay within hearsay. As noted by the Board, evidence is governed by the Federal Rules of Evidence, which clearly excludes hearsay. Unlike a FWD, wherein the board may strike or assign little weight to hearsay based on a fully developed record, including cross-examination depositions and additional briefing, in institution decisions, the Board may consider hearsay evidence, but typically only does so with respect to expert testimony and non-dispositive issues.

In its POPR, PO cites several decisions regarding the use of hearsay evidence by the Board during institution, however, each of those decisions supports Petitioner's position.

First, in IPR2018-00704, the Board held that "More importantly, in the instant proceeding, we are able to assess Mr. Bourlas' credibility and his testimony because the inventor's testimony is corroborated sufficiently by independent evidence in this record. Exs. 2001–2005, 2011–2018." *LG Electronics Inc. et al v. Wi-LAN Inc. et al*, IPR2018-00704, Paper 14 at 15 (PTAB 2018). The Board also noted that petitioner never raised a genuine issue of material fact. *Id.* at 12.

Here, there is no independent evidence in the record, and the Petitioner should be given the opportunity to fully develop the record.

Second, PO cites to *Safe Haven Wildlife Removal and Property Mgmt. Experts LLC v. Meridian Wildlife Svcs. LLC.*, explaining that the Board “deny[ed] institution despite argument that a declaration was hearsay prior to cross-examination. ” POPR 19. However, the Patent Owner in that case objected to the expert declaration submitted by the Petitioner Safe Haven as hearsay because it was submitted in a previous IPR by a different Petitioner and the expert agreed that he had never been engaged by Petitioner Safe Haven, compensated by Safe Haven, or otherwise provided consulting services for Safe Haven. The Board denied institution on the merits and stated, “we do not address Patent Owner’s arguments that Dr. Chamberlain’s Declaration is inadmissible.” *Safe Haven Wildlife Removal and Property Mgmt. Experts LLC v. Meridian Wildlife Svcs. LLC* IPR2023-01340, Paper 12 at 8. In the present IPR, the submitted declarations are not from experts but fact witnesses, and do not go to the merits but instead attempt to remove a reference as prior art. While expert testimony is the type of evidence that a Board can independently evaluate based on the Board’s technical background, the same is not true for factual evidence which weighs heavily in instituting trial to allow Petitioner to cross-examine the declarants to develop a full record.

Lastly, PO cites to *Dish Network LLC v. Sound View Innovations LLC* for the Board “denying institution without addressing petitioner’s argument a declaration is inadmissible hearsay prior to cross-examination.” POPR 19, 20. In *Dish Network*, the PO submitted a declaration regarding secondary considerations to rebut Petitioner’s challenge based on obviousness. The Board denied institution on the merits finding “Petitioner has not sufficiently shown the combination of references teaches the inventions as recited in claims 1, 7-9 13 and 16” and therefore stated that it did not need to address Petitioner’s argument that the secondary consideration declaration was hearsay. *Dish Network LLC v. Sound View Innovations LLC*, IPR2020-00969, Paper 23 at 12-13. Thus, in *Dish Network*, the hearsay evidence wasn’t considered because the Board found that Petitioner did not meet its burden to show obviousness. In the present IPR, the merits are so strong that the Board should institute and allow the Petitioner to take discovery to fully develop the record for the Board to consider Patent Owner’s argument.

III. PO’s Evidence

PO’s evidence, both documentary and testimonial lack the corroboration and detail that would allow the Board to assess its credibility at the institution stage.

To establish the date of the alleged prior disclosure by the inventor, PO relies upon a nearly illegible document (EX-2004) having no identifiable date of

publication, no accompanying declaration regarding authentication of the document, nor any rationale or explanation as to why the “Date first available” would be the date of the prior public disclosure¹, nor why this date would have any intrinsic credibility. Even if EX-2004 was not hearsay, it fails to establish the public availability of the IDEAR document prior to June 11, 2021 (the 102(b)(1)(B) critical date) and later than August 3, 2020. It is also important to note the Examiner accessed the IDEAR document on March 22, 2022 and only remarked with respect to a date is that “the IDEAR anti-chock device has been listed on sale on Amazon since April 28, 2021,” again failing to credibly establish the date of the prior disclosure. EX-1002 135.

The Declaration of RAM.SHAW PTE.LTD (EX-2001) signed by the COO, besides being rank hearsay and not admissible, does not establish whether the COO is attesting to his personal knowledge or that of the company.

The Declaration of Ligui He (EX-2002) executed in 2022 was submitted to the Examiner as a declaration of attribution under 37 CFR 1.130(a). The declaration is hearsay, contains nothing more than a conclusory statement, and lacks any context regarding the IDEAR document. Declarations must be specific

¹ Both EX-2008 and EX-2021 which also list “Date first available” of April 28, 2021 but have internet archive dates of Jan 23, 2022.

and factually supported—conclusory assertions are insufficient. The He declaration does not disclose any context regarding the attribution of the IDEAR document to him. An affidavit or declaration under 37 CFR 1.130(a) that is only a naked assertion of inventorship and that fails to provide any context, explanation or evidence to support that assertion is insufficient. See *EmeraChem Holdings, LLC v. Volkswagen Grp. of Am., Inc.*, 859 F.3d 1341, 123 USPQ2d 1146 (Fed. Cir. 2017). MPEP 2155.

In addition, contrary to the requirements under MPEP 2155, no date was provided in the He declaration, nor did the He declaration reference EX-2004. Thus, on its face it is ineffective to exclude Zhongnan.

The remaining exhibits, including Exhibit 2020-2029 in addition to being hearsay with no indicia of credibility, fail to establish at least the date of the prior disclosure (EX-2004) as well as the details regarding the origin of the image.

IV. Conclusion

The factual declarations submitted by PO do not include indicia of credibility and thus should be given little if any weight at this stage of the proceeding. In addition, the evidence fails to establish the IDEAR document's date of public availability. Thus, Board should institute trial so that the issue of the public availability of the IDEAR can be addressed after the record is fully developed.

Petitioner's Reply to POPR

Respectfully submitted,

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Dated: July 29, 2025

CERTIFICATION OF SERVICE ON PATENT OWNER

Pursuant to 37 C.F.R. §§42.6(e), 42.8(b)(4) and 42.105, the undersigned certifies that on July 29, 2025, a complete and entire copy of this **Petitioners' Reply to Patent Owner's Preliminary Response** was served in its entirety via filing through the Patent Trial and Appeal Case Tracking System (P-TACTS), as well as by delivering copies via electronic mail to the following:

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Respectfully submitted,

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