

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

LIFEVAC, LLC,
Petitioner

v.

DCSTAR INC.,
Patent Owner

Case No. IPR2025-00454
Patent No. US 11,478,575

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

Pursuant to the Board's email of July 22, 2025, PO submits this Sur-reply to Petitioner's Reply to Patent Owner's Preliminary Response (Paper 12). Petitioner's assertion the Board cannot consider testimonial evidence prior to institution is unsupported and wrong. The evidence submitted—including *Petitioner's own non-hearsay admissions*—show the subject matter disclosed in Zhongnan was publicly disclosed in the IDEAR reference by inventor Ligui He before Zhongnan's publication date. Petitioner has not and cannot refute this showing. The significant weight of the evidence shows that Zhongnan is not prior art under U.S.C. § 102(b)(1)(B). Without Zhongnan, both Grounds fail, and Petitioner cannot demonstrate a reasonable likelihood of success under 35 U.S.C. § 314(a). Instituting the present *inter partes* review, which fully relies on a disqualified reference, would be a waste of the Board's and the Parties' finite resources and contrary to judicial efficiency. Institution should be denied.

1. Under PTAB rules, the Board can—and should—consider evidence disqualifying Zhongnan as prior art under 35 U.S.C. § 102(b)(1)(B).

Petitioner incorrectly asserts Patent Owner's substantial evidence of an inventor-originated prior public disclosure is hearsay and thus should not be considered in the Board's institution decision. POPR Reply at 3. Petitioner cannot cite to any Board decisions or applicable case law to support its assertion. Instead, Petitioner attempts to distinguish past Board decisions which denied institution

before cross-examination despite hearsay assertions. POPR Reply at 3-5. In this case, however, the evidence is not based on a bare declaration alleging an inventor-originated prior public disclosure. Instead, ***Patent Owner has submitted nineteen separate evidentiary items*** supporting Zhongnan’s disqualification under 35 U.S.C. § 102(b)(1)(B): Exhibits 2001,¹ 2002, 2003, 2004, 2005, 2006, 2007, 2008, 2012, 2020, 2021, 2022, 2023, 2024, 2025, 2026, 2027, 2028, and 2029. Patent Owner’s evidence is specific, credible, corroborative, and sufficiently detailed to establish a complete factual chain demonstrating Zhongnan’s disqualification.

Petitioner argues some of this evidence is hearsay and thus all of it should be ignored. POPR Reply at 3. The Board, however, routinely considers testimonial hearsay evidence at the pre-institution stage. POPR at 19-20. In fact, as noted in the POPR, the Board’s rules and the Trial Practice Guide ***require*** such consideration. 37 C.F.R. § 42.108(c) (“[T]he Board’s decision ***will take into account a [POPR], including any testimonial evidence . . .***”) (emphasis added); 2019 Consolidated Trial Practice Guide, at 49-50 (stating the POPR may include testimonial supporting evidence against institution).

¹ The declaration from RAM.SHAW’s COO reflects the widely accepted practice of company officers providing testimony based on their responsibilities and knowledge—testimony that is routinely accepted by both courts and the PTAB.

As the Board has noted, “[c]ross-examination . . . is not generally available to either party during the preliminary proceeding; the Board routinely makes institution decisions without the benefit of declarant cross-examination.” IPR2017-01308, Paper 8 at 28. Indeed, by Petitioner’s unworkable standard, the Board should not even consider any of Petitioner’s own evidence, including the declaration of its expert Mr. Yamashiro (Ex. 1003). The Board has likewise rejected the notion that testimonial evidence should be given diminished weight solely because the declarant has not yet been subject to cross-examination. IPR2018-00704, Paper 13 at 13-14; IPR2023-00437, Paper 14 at 13 (noting if Patent Owner provided testimonial evidence, the Board would have considered it and given it appropriate weight even though Petitioner had not yet been able to cross examine the witness). The rules and established PTAB practice require consideration of testimonial evidence in deciding institution. Patent Owner has submitted a complete, coherent, and corroborative body of evidence independently supporting that Zhongnan is not prior art under 35 U.S.C. § 102(b)(1)(B). Institution should thus be denied.

2. Patent Owner provided substantial non-hearsay evidence that supports Zhongnan’s disqualification under 35 U.S.C. § 102(b)(1)(B).

Petitioner (incorrectly) argues the Board would have to rely on hearsay evidence to find the IDEAR product constitutes a public disclosure, made prior to

June 10, 2021, by the inventor or another who obtained the subject matter from the inventor.² POPR Reply, Paper 10 at 2-3. In so doing, Petitioner ignores *its own repeated admissions* that the IDEAR product (Ex. 2004) was first available on April 28, 2021. Ex. 2006; Ex. 2007 at 2; POPR, Paper 9 at 13-14. There is no dispute that Petitioner's cease and desist letters constitute party admissions and are *not hearsay* under Federal Rules of Evidence § 801(d)(2). POPR at 13, n.7.

Notably, Petitioner neglected to *even mention* the cease and desist letters in its Reply, instead blindly (and incorrectly) asserting that Patent Owner's evidence is neither corroborated nor detailed. POPR Reply at 5.

3. Petitioner has not met its burden to show Zhongnan is prior art to the '575 Patent.

In an *inter partes* review, it is petitioner's burden "from the onset to show with particularity why the patent it challenges is unpatentable." *Harmonic Inc. v. Avid. Tech., Inc.*, 815 F.3d 1356, 1363 (Fed. Cir. 2016); *see also* 35 U.S.C. § 312(a)(3). That burden includes showing that that art relied upon is, in fact, prior art. *Tech. Licensing Corp. v. Videotek, Inc.*, 545 F.3d 1316, 1327 (Fed. Cir. 2008). *After evidence presented by a patent owner "calls into question the prior art*

² Notably, Petitioner does not dispute IDEAR disclosed the same subject matter as Zhongnan. POPR Reply at 2-3.

status of [a reference],” the petitioner must rebut that evidentiary showing.

IPR2023-00437, Paper 14 at 11, 13 (emphasis added). Particularly, at the institution stage, Petitioner bears the burden to “establish that it has a reasonable likelihood of succeeding despite the arguments and evidence adduced by Patent Owner.” *Id.* at 13. Here, ***Petitioner has not proffered any such evidence*** or refuted in any way the record evidence showing Zhongnan is not prior art.

In particular, Petitioner has not refuted the evidence IDEAR was publicly disclosed prior to Zhongnan’s publication. IDEAR (Ex. 2004) lists a “date first available” of April 28, 2021, shown more clearly in the IDEAR 3-pack amazon listing (Ex. 2021).³ As stated above, Petitioner ***admitted*** in its cease and desist letter the IDEAR product (Ex. 2004) was “first available” on Amazon on April 28, 2021, and even provided a link to the Amazon storefront. Ex. 2007 at 2. The statement “first available date” in reference to an Amazon product is clearly the date the product was posted for public sale on Amazon. Also, the prosecution history of the patent bolsters the public availability of IDEAR. During prosecution of the ’575 Patent, the Examiner confirmed that “***the IDEAR anti-choke device has been listed on sale on Amazon since April 28, 2021.***”⁴ Moreover, Patent

³ The January 2022 archive date has no bearing on the original publication date.

⁴ This statement is not hearsay under the Public Records exception (FRE 803(8)).

Owner's evidence, *including Petitioner's own non-hearsay admissions*⁵ and the prosecution history, establish that IDEAR was publicly disclosed on April 28, 2021, prior to the June 11, 2021 Zhongnan publication date. Exs. 2004, 2007, 2008, 2021.

Again attempting to procedurally exclude evidence without presenting substantive evidence, Petitioner argues the Ligui He declaration submitted during prosecution is somehow insufficient. POPR Reply at 6-7. Petitioner claims the declaration fails to provide context, explanation, or evidence of inventorship. *Id.* On the contrary, the He declaration is a specific, contextualized statement made under oath that provides a clear *explanation* of inventorship. Ex. 1002 at 131 (“IDEAR is based on the conception or development of the subject matter disclosed and claimed in the present application which are attributable to me.”). As further support of He's contribution to the IDEAR product, Patent Owner submitted a corroborating co-development agreement describing He's commission to create the IDEAR product and identifying He as “responsible for the technical development and implementation of [IDEAR].” Ex. 2029 at 2. Additionally, the cooperation agreement between DCSTAR and RAM.SHAW authorized

⁵ Petitioner's cease and desist letters are authorized party admissions and are not hearsay under FRE 801(d)(2).

RAM.SHAW to sell the IDEAR product on Amazon U.S. via the Cultures Inc storefront. He, who was engaged by DCSTAR, developed the product ultimately sold under the IDEAR brand through this channel—confirming He's connection to the disclosed subject matter. Ex. 2028 at 2. This forms a comprehensive and reliable evidentiary chain. Petitioner also claims the He declaration is not compliant with M.P.E.P. § 2155 because “no date was provided . . . nor did the He declaration reference EX-2004.” POPR Reply at 7. Here, Petitioner is simply wrong. The He declaration is dated May 16, 2022 and explicitly references IDEAR (Ex. 2004). *Id.* As the Examiner agreed during prosecution, the He declaration satisfied M.P.E.P. § 2155, and the Board can—and under the rules must—consider it as evidence Zhongnan is not prior art under 35 U.S.C. § 102(b)(1)(B).

Despite ample opportunity to do so in its Petition, its DDB Opposition, and now in its POPR Reply, ***Petitioner has failed to present any evidence showing Zhongnan is not disqualified under 35 U.S.C. § 102(b)(1)(B).*** Petitioner has thus failed to satisfy its burden of refuting the showing that Zhongnan is not prior art. Without Zhongnan, both Grounds 1 and 2 fail, and Petitioner cannot demonstrate a reasonable likelihood of prevailing with respect to at least one challenged claim under 35 U.S.C. § 314(a). Institution should be denied.

US Patent No. 11,478,575
IPR2025-00454

Dated: August 5, 2025

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on August 5, 2025, copies of Patent Owner's Sur-Reply to Petitioner's Reply to Patent Owner's Preliminary Response (Paper 13) have been served via email on Counsel for Petitioner at the email address as indicated in their Mandatory Notices Under 37 C.F.R. § 42.8:

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